PATENT LAWS

AND

PRACTICE OF OBTAINING

LETTERS PATENT

FOR INVENTIONS

IN

THE UNITED STATES AND FOREIGN COUNTRIES;

INCLUDING

COPY-RIGHT AND TRADE-MARK LAWS.

BY CHARLES SIDNEY WHITMAN,

OF THE BAR OF THE SUPREME COURT OF THE UNITED STATES.

SECOND EDITION—REVISED AND ENLARGED.

"The end of our foundation is the enlarging of the human empire to the effecting of all things possible."—LORD BACON: *New Atlantis.*

WASHINGTON:
W. H. & O. H. MORRISON.
1875.

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PREFACE.

The compiler of the following pages lays no claim to the authorship of an original work upon the law of patents. Entertaining the opinion that the speculations even of the most learned are of but little importance to those who are seeking to know simply what the law is, and actuated by a desire to render the work strictly authoritative and practical, he has adopted, almost exclusively, the conclusions of those whose opinions have been dignified with the mantle of official authority.

The work is the result of an endeavor to compile from various sources, some of which are not easily accessible, reliable and practical information, which the author has found to be indispensable in the course of his own professional practice, and which he believes will be useful to others.

Although intended to convey practical information to inventors, patentees, manufacturers, and others who have occasion to inform themselves particularly concerning patent matters, it is believed that the work will be found useful to members of the legal profession generally, since it sets forth the state of the law resulting from decisions more recent than those of any other work published up to the present time, and contains the exact text of the late act of Congress, by which the entire legislation in respect to patents and copy-

right was repealed, and a more complete and carefully-drawn law substituted.

In the preparation of Part II the author has freely availed himself of the publications of the British Patent Office and the standard European authorities. In preparing those portions of the work which relate to the practice of obtaining patents in the United States, he has been greatly indebted to the labors of the late able Commissioner of Patents, Mr. S. S. FISHER, many of whose decisions he has given *in extenso*. The author is also under obligations to other officers of the Patent Office, as well as to members of the bench and bar of the District of Columbia, for valuable assistance and timely counsel, which he desires most sincerely to acknowledge.

CHARLES S. WHITMAN.

529 SEVENTH STREET,
WASHINGTON, D. C., *January* 4, 1871.

PREFACE TO THE SECOND EDITION.

The first edition of this work was published in 1871. Since that time a new law has been passed in Canada, under the provisions of which non-residents and foreigners may secure patents. This law, together with the latest edition of the regulations of the Canada Patent Office, will be found in the Appendix.

WASHINGTON, D. C., *March* 1, 1875.

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PART I.

PATENT, COPY-RIGHT, AND TRADE-MARK LAWS

OF

THE UNITED STATES,

AS

REVISED, CONSOLIDATED, AND AMENDED BY THE ACT APPROVED JULY 8, 1870.

PATENT, COPYRIGHT, AND TRADE-MARK LAWS

OF

THE UNITED STATES.

THE PATENT OFFICE.

I. Of Organization, Duties, and General Provisions.

SEC.

1. Patent Office established.
2. Officers and employees.
3. Additional employees.
4. Salaries
5. Oath of Office.
6. Official bonds.
7. Duties of Commissioner.
8. Franking privilege.
9. Annual report.
10. Duties of examiners-in-chief.
11. Acting Commissioner.
12. Seal of office.
13. Display of models.
14. Restoring models.
15. Library.
16. Employees not to acquire interest in patents.
17. Refusal to recognize agent.
18. Printing papers.
19. Power of the Commissioner to make rules.
20. Printing patents, drawings, &c.

Patent Office established.

4 July, 1836, ch. 357, § 1, v. 5, p. 117. 3 Mar., 1849, ch. 108, § 2, v. 9, p. 395.

1. There shall be attached to the Department of the Interior the office, heretofore established, known as the Patent Office, wherein all records, books, models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved.

Officers and employees.

4 July, 1838, ch. 357, § 2, v. 5, p. 118.

2. The officers and employees of said office shall continue to be one Commissioner of Patents, one Assistant Commissioner, and

3 Mar., 1837, ch. 45, § 11, v. 5, p. 194.
3 Mar., 1839, ch. 88, § 1, v. 5, p. 353.
27 May, 1848, ch. 47, §§ 1, 3, v. 9, pp. 231, 232.
3 Mar., 1851, ch. 32, § 2, v. 9, p. 617.
31 Aug., 1852, ch. 108, § 1, v. 10, p. 96.
3 Mar., 1853, ch. 97, §§ 1, 3, v. 10, pp. 209, 211.
3 Mar., 1855, ch. 175, § 10, v. 10, p. 670.
18 Aug., 1856, ch. 129, § 9, v. 11, p. 91.
2 Mar., 1861, ch. 88, §§ 2, 7, v. 12, pp. 246, 247.
29 Mar., 1867, ch. 17, § 1, v. 15, p. 10.
3 Mar., 1869, ch. 121, § 1, v. 15, p. 293.

three examiners-in-chief, to be appointed by the President, by and with the advice and consent of the Senate; one chief clerk, one examiner in charge of interferences, twenty-two principal examiners, twenty-two first assistant examiners, twenty-two second assistant examiners, one librarian, one machinist, five clerks of class four, six clerks of class three, fifty clerks of class two, forty-five clerks of class one, and one messenger and purchasing clerk, all of whom shall be appointed by the Secretary of the Interior, upon nomination of the Commissioner of Patents.

Additional employees.

3 Mar., 1869, ch. 121, § 1, v. 15, p. 293.

3. The Secretary of the Interior may also appoint, upon like nomination, such additional clerks of classes two and one, and of lower grades, copyists of drawings, female copyists, skilled laborers, laborers, and watchmen, as may be from time to time appropriated for by Congress.

Salaries.

27 May, 1848, ch. 47, § 1, v. 9, p. 231.
31 Aug., 1852, ch. 108, § 1, v. 10, p. 95.
3 Mar., 1853, ch. 97, §§ 1, 3, v. 10, pp. 209, 211.
22 Apr., 1854, ch. 52, §§ 1, 2, v. 10, p. 276.
3 Mar., 1855, ch. 175, §§ 10, 25, v. 10, pp. 670, 674.
2 Mar., 1861, ch. 88, § 4, v. 12, p. 247.
3 Mar., 1869, ch. 121, § 1, v. 15, pp. 287, 293.

4. The annual salaries of the officers and employees of the Patent Office shall be as follows:

Of the Commissioner of Patents, four thousand five hundred dollars.

Of the Assistant Commissioner, three thousand dollars.

Of the examiners-in-chief, three thousand dollars each.

Of the chief clerk, two thousand five hundred dollars.

Of the examiner in charge of interferences, two thousand five hundred dollars.

Of the principal examiners, two thousand five hundred dollars each.

Of the first assistant examiners, one thousand eight hundred dollars each.

Of the second assistant examiners, one thousand six hundred each.

Of the librarian, one thousand eight hundred dollars.

Of the machinist, one thousand six hundred dollars.

Of the clerks of class four, one thousand eight hundred dollars each.

Of the clerks of class three, one thousand six hundred dollars each.

Of the clerks of class two, one thousand four hundred dollars each.

Of the clerks of class one, one thousand two hundred dollars each.

Of the messenger and purchasing clerk, one thousand dollars.

Of laborers and watchmen, seven hundred and twenty dollars each.

Of the additional clerks, copyists of drawings, female copyists, and skilled laborers, such rates as may be fixed by the acts making appropriations for them.

Oath of office.

4 July, 1836, ch. 357, § 3, v. 5, p. 118

5. All officers and employees of the Patent Office shall, before entering upon their duties, make oath or affirmation truly and faithfully to execute the trusts committed to them.

Official bonds.

4 July, 1836, ch. 357, § 3, v. 5, p. 118.
31 Aug., 1852, ch. 108, § 1, v. 10, p. 95.

6. The Commissioner and 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 duties, and that they will render to the proper officers of the Treasury a true account of all money received by virtue of their office.

Duties of Commissioner.

4 July, 1836, ch. 357, § 1, v. 5, p. 117.
3 Mar., 1849, ch. 108, § 2, v. 9, p. 395.

1 Wood. & Min., 254.
2 Blatchf., 35.

7. It shall be the duty of the Commissioner, under the direction of the Secretary of the Interior, to superintend or perform all the duties respecting the granting and issuing of patents which herein are, or may hereafter be, by law directed to be done; and he shall have charge of all books, records, papers, models, machines, and other things belonging to said office.

Franking privilege.

4 July, 1836, ch. 357, § 1, v. 5, p. 117.
27 May, 1848, ch. 47, § 4, v. 9, p. 232.

8. The Commissioner may send and receive by mail, free of postage, letters, printed matter, and packages relating to the business of his office, including Patent Office reports.

Annual Report.

3 Mar., 1837, ch. 45, § 14, v. 5, p. 195.
3 Mar., 1859, ch. 80, § 4, v. 11, p. 422.
20 July, 1868, ch. 177, § 7, v. 15, p. 119.

9. The Commissioner 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 expensee; a list of all patents which were granted during the preceding year, designa-

ting under proper heads the subjects of such patents; an alphabetical list of the patentees, with their places of residence; a list of all patents which have been extended during the year; and such other information of the condition of the Patent Office as may be useful to Congress or the public.

Duties of examiners-in-chief.

2 Mar., 1861, ch. 88, § 2, v. 12, p. 216.

10. 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 reissues 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.

Acting Commissioner.

23 July, 1868, ch. 227, § 3, v. 16, p. 168.
12 July, 1870. 1 Wood. & Min., 254.
17 How., 41.

11. In case of the death, resignation, absence, or sickness of the Commissioner, his duties shall devolve upon the Assistant Commissioner until a successor shall be appointed or such absence or sickness shall cease.

Seal of office.

4 July, 1836, ch. 357, § 4, v. 5, p. 118.

4 McLean, 371.
2 Blatchf., 12.
14 How., 583.

12. The Commissioner shall cause a seal to be provided for said office, with such device as the President may approve, with which all records or papers issued from said office, to be used in evidence, shall be authenticated.

Display of models.

13. The Commissioner shall cause to be

4 July, 1836, ch. 357, § 20, v. 5, p. 125.

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 said office; and said rooms and galleries shall be kept open during suitable hours for public inspection.

Restoring models.

2 Mar., 1861, ch. 88, § 5, v. 12, p. 247.

14. The Commissioner 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.

4 July, 1836, ch. 357, § 19, v. 5, p. 125.

15. There shall be purchased, for the use of said 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 by Congress for that purpose.

Employees not to acquire interest in patents.

4 July, 1836, ch. 357, § 2, v. 5, p. 118.

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

Refusal to recognize agent.

17. For gross misconduct the Commis-

sioner 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.

2 Mar., 1861, ch. 88, § 8, v. 12, p. 247. 14 How., 575.

18. The Commissioner 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 papers.

2 Mar., 1861, ch. 88, § 8, v. 12, p. 247.

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

Power of Commissioner to make rules.

6 Pet., 218.

20. The Commissioner may print or cause to be printed copies of the specifications of all letters patent and of the drawings of the same, and copies of the claims of current issues, and copies of such laws, decisions, rules, regulations, and circulars as may be necessary for the information of the public.

Printing patents, drawings, &c.

2 Mar., 1861, ch. 88, § 14, v. 12, p. 249.

II. Of Patents.

SEC.
21. Issuing, signing, and recording patents.
22. Contents and grant of patents.
23. Date of patents.
24. What may be patented.
25. Foreign inventions may be patented.
26. Description and specification.
27. Drawings.
28. Specimen of ingredients.
29. Model.
30. Oath of applicant; before whom taken.
31. Examination of application.
32. Time to complete and prosecute applications.

SEC.
33. Patents may issue to assignees.
34. Patents may issue to legal representatives.
35. Renewed application in lapsed, withdrawn, and rejected cases.
36. Assignments, grants, and conveyances.
37. Right of purchasers before patent.
38. Patented articles to be marked.
39. False marking.
40. Caveats.
41. References upon rejection.
42. Interferences.
43. Affidavits and depositions.
44. Duty of clerk of court.
45. Fees and rights of witnesses.
46. Appeal to examiners-in-chief.
47. Appeal to Commissioner.
48. Appeal to Supreme Court of District of Columbia.
49. When to court, duty of appellant.
50. Duty of court.
51. Duty of appellant and Commissioner.
52. Bill in equity.
53. Reissues.
54. Disclaimers.
55. Actions; where cognizable.
56. Appeal to Supreme Court of United States.
57. Copies of records and foreign patents.
58. Proceedings in equity in interfering patents.
59. Damages for infringement.
60. Actions for infringement prior to disclaimer.
61. Notice of special matter.
62. Prior knowledge or use in foreign country.
63. Extension of patent; duty of applicant.
64. Notice of application to be published.
65. Case to be referred to examiner.
66. Hearing of case; granting of extension.
67. Extension; how far for the benefit of assignees.
68. Patent fees.
69. Patent fees; to whom paid; who to disburse money.
70. Money paid by mistake.

Issuing, signing, and recording patents.

4 July, 1836, ch. 357, § 5, v. 5, p. 118.
3 Mar., 1849, ch. 108, § 2, v. 9, p. 395.

21. 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, and they shall be recorded, together with the specification, in said office, in books to be kept for that purpose.

22. 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 said invention or discovery throughout the United States and the Territories thereof, referring to the specification for the particulars thereof; and a copy of said specifications and of the drawings shall be annexed to the patent and be a part thereof.

Contents and grant of patents.

4 July, 1836, ch. 357, § 5, v. 5, pp. 118, 119.
3 Mar., 1837, ch. 45, § 6, v. 5, p. 193.
2 Mar., 1861, ch. 88, § 16, v. 12, p. 249.

Baldwin, 322.
4 Ohio, 310.
7 Pet., 319.
15 Wend., 395.
2 McLean, 178.
3 McLean, 297.
2 Blatchf., 23.
2 Wash., 120.
Pet., C. C., 341.
1 Paine, 460.
Bald., 314.
2 Story, 614, 621.

2 Blatchf., 9. 4 How., 711. 6 How., 478.

23. Every patent shall 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 shall not be paid within that period, the patent shall be withheld.

Date of patents.

4 July, 1836, ch. 357, § 8, v. 5, pp. 120, 121.
3 Mar., 1863, ch. 102, § 3, v. 12, p. 796.

24. 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 duty required by law, and

What may be patented.

4 July, 1836, ch. 357, §§ 6, 7, v. 5, pp. 119, 120.
3 Mar., 1839, ch. 88, § 7, v. 5, p. 354.
29 Aug., 1842, ch. 263, § 3, v. 5, pp. 543, 544.
2 Mar., 1861, ch. 88, § 11, v. 12, p 248.

Pet., C. C., 341, 400.
4 Wash., 12.
1 How., 208.
15 How., 267.
10 How., 496.
1 Gall., 480.
3 Wheat., 516.
2 Story, 411.

11 How., 265.
14 How., 175.
2 Wall., Jr., 360.
3 Sum., 518.

other due proceedings had, obtain a patent therefor.

Brightly 99. 4 McLean, 180, 461. 4 Wash., 62. 1 Blatchf., 248, 463, 494. 1 Wash., 171. 3 Wash., 198. 1 Gall., 439, 470. 2 Gall., 63.

Foreign inventions may be patented.

4 July, 1836, ch. 357, § 8, v. 5, pp. 120, 121.
3 Mar., 1839, ch. 88, § 6, v. 5, p. 354.

5 McLean, 78, 80.
15 How., 112.

25. 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; provided the same shall not have been introduced into public use in the United States for more than two years prior to the application, and that the patent shall 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; but in no case shall it be in force more than seventeen years.

Description and specification.

4 July, 1836, ch. 357, § 6, v. 5, p. 119.

3 Wash., 198.
Pet., C. C., 401.
1 Mass., 187, 476.
2 Mass., 118.
4 Wash., 14, 73.
1 Paine, 207, 450.
7 Wheat., 434.
1 Story, 285, 292.
3 McLean, 260, 441, 444, 447.
2 Blatchf., 9.
3 Wood. & Min., 30, 56.
5 McLean, 55.
11 How., 606.
15 How., 119, 267.
5 How., 5.
2 Wall., Jr., 363.
2 Brock., 309.
Bald., 314.
24 How., 168.
2 Story, 440.
22 How., 139.
1 Blatchf., 378.
1 Curt., 263.

26. Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner, 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; and said specification and claim shall be signed by the inventor and attested by two witnesses.

Drawings.

4 July, 1836, ch. 357, § 6, v. 5, p. 119.
3 Mar., 1837, ch. 45, § 6, v. 5, p. 103.

4 Mass., 9.
3 McLean, 201.
3 Story, 133.

27. 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 said drawings, to be furnished by the Patent Office, shall be attached to the patent as part of the specification.

Specimen of ingredients.

4 July, 1836, ch. 357, § 6, v. 5, p. 119.

28. 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.

Model.

4 July, 1836, ch. 357, § 6, v. 5, p. 119.

6 How., 485.
Bald., 314.
20 How., 109.

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

Oath of applicant; before whom taken.

4 July, 1836, ch. 357, § 6, v. 5, p. 110.
3 Mar., 1857, ch. 45, § 12, v. 5, p. 104.
29 Aug., 1842, ch. 263, § 4, v. 5, p. 544.

1 Gall., 433.
6 How., 482.
1 Met., 101.
3 Fish., 536.

30. The applicant shall make oath or affirmation 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 be-

fore known or used; and shall state of what country he is a citizen. And said oath or affirmation 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.

Examination of application.

4 July, 1836, ch. 357, § 7, v. 5, pp. 119, 120.

2 Pet., 18.
2 Blatchf., 34.
1 Wall, jr., 349.
1 Blatchf. 509.

31. On the filing of any such application, and the payment of the duty required by law, the Commissioner 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.

Time to complete and prosecute applications.

2 Mar., 1861, ch. 88, § 12, v. 12, pp. 248, 249.

32. All applications for patents shall be completed and prepared for examination within two years after the filing of the petition, 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 that such delay was unavoidable.

Patents may issue to assignees

33. Patents may be granted and issued or

reissued to the assignee of the inventor or discoverer, the assignment thereof being first entered of record in the Patent Office; but in such case the application for the patent shall be made and the specification sworn to by the inventor or discoverer; and also, if he be living, in case of an application for reissue.

3 Mar., 1837, ch. 45, § 6, v. 5, p. 193.

1 Blatchf., 500.
6 Cra., 327.
1 Gall., 430.
3 Fish., 343.

34. 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 shall be 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.

Patents may issue to legal representatives.

4 July, 1836, ch. 357, § 10, v. 5, p. 121.

2 Fish., 499.

35. 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 has failed 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

Renewed application in lapsed, withdrawn, and rejected cases.

25 June, 1864, ch. 159, § 1, v. 13, p. 194.
3 Mar., 1865, ch. 112, § 1, v. 13, p. 533.

1 Wall., 317.
2 Fish., 1.
3 Fish., 87.
3 Fish., 134.

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: *Provided*, That the second application 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, as aforesaid, was ordered to issue, prior to the issue thereof: *And provided further*, That when an application for a patent has been rejected or withdrawn, prior to the passage of this act, the applicant shall have six months from the date of such passage to renew his application or to file a new one; and, if he omit to do either, his application shall be held to have been abandoned. Upon the hearing of such renewed applications abandonment shall be considered as a question of fact.

Assigm'ts, grants, and conveyances.

4 July, 1836, ch. 357, § 11, v. 5, p. 121.

3 McLean, 428.
2 Blatchf., 50, 148.
5 McLean, 132.
10 How., 494.
14 How., 549.
18 How., 294.
4 Mass., 15.
2 Story, 542, 615.
3 Story, 131.
4 How., 711.
15 Barb., S. C., 315.
19 How., 221.
17 How., 451.
1 Fish., 327.

36. 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; and said 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.

37. Every person who may have purchased of the inventor, or with his knowledge and consent may have constructed, any newly-invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or sold or used 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.

Right of purchasers before patent.

3 Mar., 1839, ch. 88, § 7, v. 5, p. 354.

2 Blatchf., 254.
1 How., 208.
4 How., 403.
2 Curt., 655.
3 Story, 406.
1 Wood. & Min. 301.
21 How., 330.
1 Blatchf., 250.

38. 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 word "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 inclosed, 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.

Patented articles to be marked.

2 Mar., 1861, ch. 88, § 13, v. 12, p. 249.

3 Fish., 249, 374.

39. If any person shall, in any manner, mark 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

False marking.

29 Aug., 1842, ch. 263, § 5, v. 5, p. 544.

2 Curt., 506.

1 Fish., 647.
3 Fish., 72.

any person who has obtained a patent therefor, without the consent of such patentee or his assigns or legal representatives; or shall in any manner mark upon or affix 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 shall in any manner mark upon or affix to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public, he shall be liable for every such offense to a penalty of not less than one hundred dollars, with costs; one moiety 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.

Caveats.

4 July, 1836, ch. 357, §§ 8, 12, v. 5, pp. 120, 121.
2 Mar., 1861, ch. 88, § 9, v. 12, p. 247.

6 McLean, 304.
18 How., Pr., 9.
1 Fish., 479.

40. Any citizen of the United States who shall have made any new invention or discovery, and shall desire further time to mature the same, may, on payment of the duty 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; and 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 shall be 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 filing the caveat, who, if he would avail himself of his caveat, shall file his description, specification, drawings, and model within three months from the time of placing said 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. And an alien shall have the privilege herein granted, if he shall have resided in the United States one year next preceding the filing of his caveat, and made oath of his intention to become a citizen.

References upon rejection.

4 July, 1836, ch. 357, § 7, v. 5, pp. 119, 120.

41. Whenever, on examination, any claim for a patent is rejected for any reason whatever, 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 shall persist in his claim for a patent, with or without altering his specifications, the Commissioner shall order a re-examination of the case.

Interferences.

4 July, 1836, ch. 357, § 8, v. 5, pp. 120, 121.

42. 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 shall be adjudged the prior inventor, unless the adverse party shall appeal 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.

Affidavits and depositions.

3 Mar., 1839, ch. 88, § 12, v. 5, p. 355.

2 Mar., 1861, ch. 88, § 1, v. 12, p. 246.

43. The Commissioner 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.

Duty of clerk of court.

2 Mar., 1861, ch. 88, § 1, v. 12, p. 246.

44. The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any con-

tested case pending in the Patent Office, shall, upon the application of any party thereto, or his agent or attorney, issue subpœna for any witness residing or being within said district or Territory, commanding him to appear and testify before any officer in said district or Territory authorized to take depositions and affidavits, at any time and place in the subpœna stated; and if any witness, after being duly served with such subpœna, shall neglect or refuse to appear, or, after appearing, shall refuse 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.

Fees and rights of witnesses.

2 Mar., 1861, ch. 88, § 1, v. 12, p. 246.

45. 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, 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, nor 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.

Appeal to examiners-in-chief.

2 Mar., 1861, ch. 83, § 2, v. 12, p. 243.
3 Mar., 1837, ch. 45, § 8, v. 5, p. 193.
27 June, 1866, ch. 143, § 1, v. 14, pp. 76, 77.

46. Every applicant for a patent or the reissue 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 interference, in such case to the board of examiners-in-chief, having once paid the fee for such appeal provided by law.

Appeal to Commissioner.

2 Mar., 1861, ch. 83, § 2, v. 12, p. 240.

47. If such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the duty required by law, appeal to the Commissioner in person.

Appeal to supreme court of District of Columbia.

3 Mar., 1839, ch. 88, §§ 10, 11, v. 5, pp. 354, 355.
30 Aug., 1852, ch. 107, § 1, v. 10, p. 75.

48. 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.

When to court; duty of appellant.

3 Mar., 1839, ch. 88, § 11, v. 5, pp. 354, 355.

49. 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.

Duty of court.

4 July, 1836, ch. 357, § 12, v. 5, p. 121.
3 Mar., 1839, ch. 88, § 11, v. 5, pp. 354, 355.
30 Aug., 1852, ch. 107, §§ 1, 2, v. 10, p. 75.

50. It shall be the duty of said court, on petition, to hear and determine such appeal, and to 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, notifying the Commissioner of the time and place of hearing; and the revision shall be

confined to the points set forth in the reasons of appeal. And, 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 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.

Duty of appellant and Commissioner.

3 Mar., 1839, ch. 88, § 11, v. 5, pp. 354, 355.

51. On receiving notice of the time and place of hearing such appeal, the Commissioner shall notify all parties who appear to be interested therein, in such manner as the court may prescribe. 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 it 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 machine or other thing for which a patent is demanded.

Bill in equity.

3 Mar., 1839, ch. 88, § 10.

2 Fish., 83.

52. Whenever a patent on application is refused, for any reason whatever, either by the Commissioner 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 requisitions of law. And in all cases where there is no opposing party a copy of the bill shall be served on the Commissioner, and all expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.

Reissues.

4 July, 1836, ch. 357, § 13, v. 5, p. 122.
3 Mar., 1837, ch. 45, § 8, v. 5, p. 193.

6 Pet., 242.
7 Pet., 314.
14 Pet., 462.
2 Story, 430.
3 Story, 744, 753.
1 Sumn., 488.
4 How., 402, 688.
15 How., 112, 220.
17 How., 83.
3 Wood. & Min., 126.
1 Wood. & Min., 262, 302.
1 Blatchf., 169.
2 Wood. & Min., 139.
2 Wall., jr., 102.
2 McLean, 37, 176.
5 McLean, 166.

53. 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 specifications, to be issued to the patentee, or, in the case of his death or assignment of

the whole or any undivided part of the original patent, to his executors, administrators, or assigns, for the unexpired part of the term of the original patent, the surrender of which shall take effect upon the issue of the amended patent; and 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 reissue for each of such reissued letters patent. And the specification and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. And the patent so reissued, together with the corrected specification, shall have the effect and operation in law, on the trial of all actions for causes thereafter arising, as though 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.

11 Cush., 571.
1 Fish., 133.
2 Fish., 543.
2 Fish., 490.
3 Fish., 294.
3 Fish., 343.
8 Wall., 445.
9 Wall., —.

54. Whenever, through inadvertence, acci- Disclaimers.

3 Mar., 1837, ch. 45, § 7, 9, v. 5, pp. 193, 194.
Bald., 313.
1 Story, 294, 600.
3 McLean, 349, 44.
5 McLean, 56.
5 Denio, 318.
2 Whar. Dig., 413.
1 Blatchf., 245, 450, 461.
3 Blatchf., 199.
2 Blatchf., 198.
14 How., 221.
15 How., 121.
19 How., 106.
20 How., 387.
3 Fish., 197.
3 Fish., 400.

dent, 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 duty 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; said 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.

Actions where cognizable.

4 July, 1836, ch. 357, § 17, v. 5, p. 124.
1 Blatchf., 630.
6 Cranch, 327.
1 Gall., 430.
4 Mass., 15.
4 Wash., 684.
2 Paine, 240.

55. All actions, suits, controversies, and cases arising under the patent laws of the United States shall be originally cognizable, as well in equity as at law, by the circuit courts of the United States, or any district court having the powers and jurisdiction of

a circuit court, or by the supreme court of the District of Columbia, or of any Territory; and the court shall have power, upon bill in equity filed by any party aggrieved, 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 *claimant* [complainant] has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction, and the court shall have the same powers to increase the same in its discretion that are given by this act to increase the damages found by verdicts in actions upon the case; but all actions shall be brought during the term for which the letters patent shall be granted or extended, or within six years after the expiration thereof.

1 Wood. & Min., 37.
1 Blatchf., 480, 630.
3 Conn., 14.
14 How., 519.
40 Maine, 434.
20 How., 56, 215.
7 John., 144.
8 Page, 134.
16 Conn., 414.
3 Fish., 116.

56. A writ of error or appeal to the Supreme Court of the United States shall lie from all judgments and decrees of any circuit court, or of any district court exercising the jurisdiction of a circuit court, or of the supreme court of the District of Columbia or of any Territory, in any action, suit, controversy, or case, at law or in equity, touch-

Appeal to the Supreme Court of United States.

4 July, 1836, ch. 357, § 17, v. 5, p. 124.
18 Feb., 1861, ch. 37, § 1, v. 12, p. 130.

1 Blatchf., 544.
6 How., 477.
7 How., 657.
10 How., 101, 346.
15 How., 465. 557.
16 How., 103.
20 How., 56, 204.

14 How., 220.

ing patent rights, in the same manner and under the same circumstances as in other judgments and decrees of such circuit courts, without regard to the sum or value in controversy.

Copies of records and foreign patents.

4 July, 1836, ch. 357, § 4, v. 5, p. 118.
2 Mar., 1861, ch. 88, § 15, v. 12, p. 249.
23 July, 1868, ch. 227, § 3, v. 15, p. 168.

3 McLean, 431.
2 Blatchf., 12.
4 McLean, 371.
1 Wood. & Min., 260.
14 How., 583.
9 Wend., 44.

57. Written or printed copies of any records, books, papers, or drawings belonging to the Patent Office, and of letters patent under the signature of the Commissioner or Acting Commissioner, with the seal of office affixed, shall be competent 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. And copies of the specifications and drawings of foreign letters patent, certified in like manner, shall be *prima facie* evidence of the fact of the granting of such foreign letters patent, and of the date and contents thereof.

Proceedings in equity in interfering patents.

4 July, 1836, ch. 357, § 16, v. 5, pp. 123, 124.

3 Fish., 489.
3 Fish., 522.

58. Whenever there shall be interfering patents, any person interested in any one of such interfering patents, or in the working of the invention claimed under either of such patents, 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 having cognizance thereof, as hereinbefore provided, 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 rights of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

Damages for infringement.

4 July, 1836, ch. 357, § 14, v. 5, p. 123.

1 Story, 341.
3 Story, 136, 410.
2 Wood. & Min., 147.
1 Blatchf., 245, 406.
2 Blatchf., 39, 201, 494.
15 How., 559.
16 How., 489.
23 How., 488.
1 Fish., 380.
2 Fish., 37.
2 Fish., 62.
2 Fish., 154.
2 Fish., 207.
2 Fish., 588.
3 Fish., 116

59. Damages for the infringement of any patent may be recovered by action on the case in any circuit court of the United States, or district court exercising the jurisdiction of a circuit court, or in the supreme court of the District of Columbia, or of any Territory, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict shall be 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.

Actions for infringem't prior to disclaimer.

3 Mar., 1837, ch. 45, § 9, v. 5, p. 194.

5 McLean, 56, 84.
3 McLean, 449.
2 Story, 621.
1 Story, 294, 600.

60. Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, a patentee shall have (in his specification) claimed to be the original and first inventor or discoverer of any material or

1 Blatchf., 245.
2 Blatchf., 198.
15 How., 122.
19 How., 100.
20 How., 387.
5 Denio, 318.
3 Fish., 197.
3 Fish., 400.

substantial part of the thing patented, of which he was not the original and first inventor or discoverer as aforesaid, 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, provided it shall be a material and substantial part of the thing patented, and be definitely distinguishable from the parts so claimed, without right as aforesaid, notwithstanding the specifications may embrace more than that of which the patentee was the original or 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; nor shall he be entitled to the benefits of this section if he shall have unreasonably neglected or delayed to enter said disclaimer.

Notice of special matter.

4 July, 1836, ch. 357, § 15, v. 5, p. 123.
3 Mar., 1839, ch. 88, § 7, v. 5, p 354.

Pet. C. C., 348.
7 Wheat., 469.
4 McLean, 179, 371, 525.
3 Wheat., 503.
4 Wash., 74, 705.
14 Pet., 459.
1 Wall., jr., 195.
1 Blatchf., 376.
14 How., 222.

61. 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

15 How., 110,141.
23 How., 7.
24 How., 168.
1 Blatchf., 597.
5 McLean, 61.
17 How., 84.
2 Story, 441.
1 Fish., 465.
1 Fish., 615.
2 Fish., 52.
3 Fish., 464.

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.

Prior knowledge or use in foreign country.

4 July, 1836, ch. 357, § 15, v. 5, p. 123.

5 McLean, 61.
6 McLean, 313.
1 Fish., 516.
1 Fish., 586.

62. Whenever it shall appear that the 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.

Extension of patent. Duty of applicant.

4 July, 1836, ch. 357, § 18, v. 5, p. 124.

2 Mar., 1861, ch. 88, §§ 12, 16, v. 12, pp. 248, 249.

63. 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 his patent beyond the original term of its limitation, he shall make application therefor, in writing, to the Commissioner, 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 said invention or discovery.

And said 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 said original term.

Notice of application to be published.

4 July, 1836, ch. 357, § 18, v. 5, p. 124.
2 Mar., 1861, ch. 88, § 12, v. 12, p. 248.

64. Upon the receipt of such application, and the payment of the duty 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.

Case to be referred to examiner.

27 May, 1848, ch. 47, § 1, v. 9, p. 231

65. On the publication of such notice the Commissioner shall refer the case to the principal examiner having charge of the class of inventions to which it belongs, who shall make to said Commissioner a full report of the case, and particularly whether the invention or discovery was new and patentable when the original patent was granted.

Hearing of case, granting extension.

4 July, 1836, ch. 357, § 18, v. 5, p. 124.
27 May, 1848, ch. 47, § 1, v. 9, p. 231.

66. 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

2 Fish., 499.
3 Fish., 536.
9 Wall., —.

shall appear to his satisfaction 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 said Commissioner shall make a certificate thereon, renewing and extending the said patent for the term of seven years from the expiration of the first term, which certificate shall be recorded in the Patent Office, and thereupon the said patent shall have the same effect in law as though it had been originally granted for twenty-one years.

Extension, how far for the benefit of assignees.

4 July, 1836, ch. 357, § 18, v. 5, p. 125.

67. 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.

4 How., 682.
4 McLean, 355.

3 Fish., 9. 3 Fish., 410.

Patent fees.

2 Mar., 1861, ch. 88, § 10, v. 12, p. 248.
27 June, 1866, ch. 143, § 1, v. 14, p. 76.

68. The following shall be the rates for patent fees:

On filing each original application for a patent, fifteen dollars.

On issuing each original patent, twenty dollars.

On filing each caveat, ten dollars.

On every application for the reissue 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, 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.

Patent fees, to whom paid; who to disburse money.

6 Aug., 1846, ch. 90, § 15, v. 9, p. 62.
20 July, 1868, ch. 177, § 7, v. 15, p. 119.
3 Mar., 1869, ch. 121, § 1, v. 15, p. 293.

69. Patent fees may be paid to the Commissioner, 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, who shall give the depositor a receipt or certificate of deposit therefor. And 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;

and all disbursements for said office shall be made by the disbursing clerk of the Interior Department.

Money paid by mistake.

29 Aug., 1842, ch. 263, § 1, v. 5, p. 543.

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

III. Of Design Patents.

SEC.
71. Designs may be patented.
72. Models of designs.
73. Term of design patents.
74. Extension of design patents.
75. Fees for design patents.
76. Other provisions to apply to design patents.

Designs may be patented.

20 Aug., 1842, ch. 263, § 3, v. 5, pp. 543, 544.
2 Mar., 1861, ch. 88, § 11, v. 12, p. 249.

4 McLean, 180.
1 Blatchf., 248.
2 Fish., 583.

71. Any person who, by his own industry, genius, efforts, and expense, has invented or 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, 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 duty required by law, and other due proceedings had, the same as in cases of inventions or discoveries, obtain a patent therefor.

Models of designs.

2 Mar., 1861, ch. 88, § 5, v. 12, p. 247.

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

Term of design patents.

2 Mar., 1861, ch. 88, § 11, v. 12, p. 248.

73. 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.

Extension of design patents.

2 Mar., 1861, ch. 88, § 11, v. 12, p. 248.

74. Patentees of designs issued prior to March two, 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.

Fees for design patents.

2 Mar., 1861, ch. 88, §§ 10, 11, v. 12, p. 248.

75. The following shall be the rates of fees in design cases:

For three years and six months, ten dollars.

For seven years, fifteen dollars.

For fourteen years, thirty dollars.

For all other cases in which fees are re-

quired, the same rates as in cases of inventions or discoveries.

Other provisions to apply to design patents.

29 Aug., 1842, ch. 263, § 3, v. 5, p. 543.

76. That all the regulations and provisions which apply to the obtaining or protection of patents for inventions or discoveries, not inconsistent with the provisions of this act, shall apply to patents for designs.

IV. Of Trade-Marks.

SEC.
77. Who entitled to trade-marks, and requirements concerning the same.
78. Term for which trade-marks shall remain in force.
79. Remedy for wrongful use of trade-marks.
80. Proof of registration.
81. Rules for transfer of trade-marks.
82. Penalty for fraudulent registration.
83. Common law remedies preserved.
84. No action to be sustained on fraudulent or deceptive trade-marks.

Who entitled to trade-marks, and requirements concerning the same.

77. Any person or firm domiciled in the United States, and any corporation created by the authority of the United States, or of any State or Territory thereof, and any person, firm, or corporation resident or located in any foreign country which by treaty or convention affords similar privileges to citizens of the United States, and who are entitled to the exclusive use of any lawful trade-mark, or who intend to adopt and use any trade-mark for exclusive use within the United States, may obtain protection for such lawful trade-mark by complying with the following requirements, to wit:

First. By causing to be recorded in the Patent Office the names of the parties and their residences and place of business who desire the protection of the trade-mark.

Second. The class of merchandise and the particular description of goods comprised in such class, by which the trade-mark has been or is intended to be appropriated.

Third. A description of the trade-mark itself, with *fac similes* thereof, and the mode in which it has been or is intended to be applied and used.

Fourth. The length of time, if any, during which the trade-mark has been used.

Fifth. The payment of a fee of twenty-five dollars, in the same manner and for the same purpose as the fee required for patents.

Sixth. The compliance with such regulations as may be prescribed by the Commissioner of Patents.

Seventh. The filing of a declaration, under the oath of the person, or of some member of the firm or officer of the corporation, to the effect that the party claiming protection for the trade-mark has a right to the use of the same, and that no other person, firm, or corporation has the right to such use, either in the identical form or having such near resemblance thereto as might be calculated to deceive, and that the description and *fac similes* presented for record are true copies of the trade-mark sought to be protected.

Term for which trade-marks shall remain in force.

78. Such trade-mark shall remain in force for thirty years from the date of such registration, except in cases where such trade-mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of any 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 same time that it becomes of no effect elsewhere; and during the period that it remains in force it shall entitle the person, firm, or corporation registering the same to the exclusive use thereof, so far as regards the description of goods to which it is appropriated in the statement filed under oath as aforesaid, and no other person shall lawfully use the same trade-mark, or substantially the same, or so nearly resembling it as to be calculated to deceive, upon substantially the same description of goods: *Provided*, That six months prior to the expiration of said term of thirty years application may be made for a renewal of such registration, under regulations to be prescribed by the Commissioner of Patents, and the fee for such renewal shall be the same as for the original registration; certificate of such renewal shall be issued in the same manner as for the original registration, and such trade-mark shall remain in force for a further term of thirty years: *And provided further*, That nothing in

this section shall be construed by any court as abridging or in any manner affecting unfavorably the claim of any person, firm, corporation, or company to any trade-mark after the expiration of the term for which such trade-mark was registered.

Remedy for wrongful use of trade-marks.

79. Any person or corporation who shall reproduce, counterfeit, copy, or imitate any such recorded trade-mark, and affix the same to goods of substantially the same descriptive properties and qualities as those referred to in the registration, shall be liable to an action on the case for damages for such wrongful use of said trade-mark, at the suit of the owner thereof, in any court of competent jurisdiction in the United States, and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of his trade-mark and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful use. The Commissioner of Patents shall not receive and record any proposed trade-mark which is not and cannot become a lawful trade-mark, or which is merely the name of a person, firm, or corporation only, unaccompanied by a mark sufficient to distinguish it from the same name when used by other persons, or which is identical with a trade-mark appropriate to the same class of merchandise and belonging to a different owner, and already registered

or received for registration, or which so nearly resembles such last-mentioned trade-mark as to be likely to deceive the public: *Provided*, That this section shall not prevent the registry of any lawful trade-mark rightfully used at the time of the passage of this act.

Proof of registration.

80. The time of the receipt of any trade-mark at the Patent Office for registration shall be noted and recorded, and copies of the trade-mark and of the date of the receipt thereof, and of the statement filed therewith, under the seal of the Patent Office, certified by the Commissioner, shall be evidence in any suit in which such trade-mark shall be brought in controversy.

Rules for transfer of trade-marks.

81. The Commissioner of Patents is authorized to make rules, regulations, and prescribe forms for the transfer of the right to the use of such trade-marks, conforming as nearly as practicable to the requirements of law respecting the transfer and transmission of copyrights.

Penalty for fraudulent registration.

82. Any person who shall procure the *the* registry of any trade-mark, or of himself as the owner thereof, or an entry respecting a trade-mark, in the Patent Office, under this act, by making any false or fraudulent representations or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay damages, in consequence of any such registry or entry, to the person in-

jured thereby, to be recovered in an action on the case before any court of competent jurisdiction within the United States.

Common law remedies preserved.

83. 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 this act had not been passed.

No action to be sustained on fraudulent or deceptive trade-marks.

84. No action shall be maintained under the provisions of this act by any person claiming the exclusive right to any trade-mark which is used or claimed in any unlawful business, or upon any article which is injurious in itself, or upon any trade-mark which has been fraudulently obtained, or which has been formed and used with the design of deceiving the public in the purchase or use of any article of merchandise.

V. Of Copyrights.

SEC.

85. Librarian of Congress to have charge of copyrights.
86. What may be copyrighted.
87. Term of copyright.
88. Extension of copyright.
89. Assignment of copyrights to be recorded.
90. Recording copyright; duty of applicant.
91. Recording copyright; duty of Librarian.
92. Fees.
93. Library of Congress to have copyright articles.
94. Penalty for not delivering.
95. May be sent to Library by mail free.
96. Duty of postmaster in regard to.
97. Notice of copyright.
98. Penalty for false notice.
99. Infringement of copyright book.
100. Infringement of copyright map, &c.
101. Infringement of copyright dramatic composition.
102. Infringement of manuscripts.
103. Foreign works may be printed or imported.

SEC.
104. Limitation of time of action.
105. Pleading.
106. Actions cognizable by circuit court.
107. Appeals to Supreme Court U. S.
108. Full cost to be allowed.
109. Transfer of books, &c., to Library of Congress.

Librarian of Congress to have charge of copyrights.

5 Feb., 1859, ch. 22, § 8, v. 11, pp. 380, 381.

85. 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.

Shall have seal.

The Librarian shall cause a seal to be provided for said office, with such device as the Joint Committee on the Library may approve, with which all records or papers issued from said office, and to be used in evidence, shall be authenticated.

Give bond.

He shall also give an additional 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.

And make annual report.

He shall also make an annual report to Congress of the number and description of copyright publications for which entries have been made during the year. And the Librarian of Congress shall receive a yearly compensa-

tion of four thousand dollars, to commence when this act shall take effect.

What may be copyrighted.

3 Feb., 1831, ch. 16, § 1, v. 4, p. 436.
18 Aug., 1856, ch. 169, § 1, v. 11, pp. 138, 139.
3 Mar., 1865, ch. 126, § 1, v. 13, p. 540.

8 Pet., 662.
14 How., 530.
Hopk. Ch., 351.
1 Blatchf., 625.
1 Story, 17.
3 Story, 778.
4 McLean, 316, 517.
5 McLean, 37.
2 Wood. & Min., 46.
2 Blatchf., 46, 170, 366.
2 Paine, 383.

86. Any citizen of the United States, or resident therein, who shall be 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, statue, statuary, and of models or designs intended to be perfected as works of the fine arts, and his executors, administrators, or assigns, shall, upon complying with the provisions of this act, 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 may reserve the right to dramatize or to translate their own works.

Term of Copyright.

3 Feb., 1831, ch. 16, § 1, v. 4, p. 436.

87. Copyrights shall be granted for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed.

Extension of copyright.

3 Feb., 1831, ch. 16, §§ 2, 3, v. 4, pp. 436, 437.

2 Wood. & Min., 42.
8 Pet., 663.

88. The author, inventor, or designer, if he be still living and a citizen of the United States or resident therein, 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.

Assignment of copyrights to be recorded.

30 June, 1834, ch. 157, § 1, v. 4, p. 728.

8 Wend., 565.
2 Wood. & Min., 42, 510.
5 McLean, 41.
8 Pet., 661.
18 How., 171.

89. 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.

Recording copyright; duty of applicant.

3 Feb., 1831, ch. 16, § 4, v. 4, p. 437.

2 Blatchf., 83.
1 Blatchf., 620.
5 McLean, 332.

90. No person shall be entitled to a copyright unless he shall, before publication, deposit in the mail a printed copy of the title of the book or other article, or a description of the painting, drawing, chromo, statue, statuary, or model or design for a work of the fine arts, for which he desires a copyright, addressed to the Librarian of Congress, and, within ten days from the publication thereof, deposit in the mail two copies of such copyright book or other article, or, in case of a painting, drawing, statue, statuary, model or design for a work of the fine arts, a photograph of the same, to be ad-

dressed to said Librarian of Congress, as hereinafter to be provided.

91. 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 ———, anno Domini ———, 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 said proprietor, whenever he shall require it.

Recording copyright; duty of Librarian.

3 Feb., 1831, ch. 16, § 4, v. 4, p. 437.

92. For recording the title or description of any copyright book or other article, the Librarian of Congress shall receive, from the person claiming the same, fifty cents; and for every copy under seal actually given to such person or his assigns, fifty cents: and for recording any instrument of writing for the assignment of a copyright, fifteen cents for every one hundred words; and for every copy thereof, ten cents for every one

Fees.

3 Feb., 1831, ch. 16, § 4, v. 4, p. 437. 30 June, 1834, ch. 157, § 2, v. 4, p. 728. 26 Feb., 1853, ch. 80, § 1, v. 10, p. 163.

hundred words, which moneys, so received, shall be paid into the Treasury of the United States.

Library of Congress to have copyright articles.

3 Mar., 1865, ch. 126, §§ 2, 4, v. 13, pp. 540, 541.
18 Feb., 1867, ch. 43, § 1, v. 14, p. 395.

93. The proprietor of every copyright book or other article shall mail to the Librarian of Congress at Washington, within ten days after its publication, two complete printed copies thereof, of the best edition issued, or description or photograph of such article as hereinbefore required, and a copy of every subsequent edition wherein any substantial changes shall be made.

Penalty for not delivering.

18 Feb., 1867, ch. 43, § 1, v. 14, p. 395.

94. In default of such deposit in the post office, said proprietor shall be liable to a penalty of twenty-five dollars, to be collected by the Librarian of Congress, in the name of the United States, in an action of debt, in any district court of the United States within the jurisdiction of which the delinquent may reside or be found.

May be sent to Library by mail free.

18 Feb., 1867, ch. 43, § 2, v. 14, p. 395.

95. Any such copyright book or other article may be sent to the Librarian of Congress by mail, free of postage, provided the words "Copyright matter" are plainly written or printed on the outside of the package containing the same.

Duty of postmaster in regard to.

18 Feb., 1867, ch. 43, § 2, v. 14, p. 395.

96. 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 without cost to the proprietor.

Notice of copyright.

97. 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 portion of the face or front thereof, or on the face 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."

3 Feb., 1831, ch. 16, § 5, v. 4, p. 437.
1 Blatchf., 620.

98. If any person shall insert or impress such notice, or words of the same purport, in or upon any book, map, chart, musical composition, print, cut, engraving, or photograph, or other articles herein named, for which he has not obtained a copyright, every person so offending shall forfeit and pay one hundred dollars; one moiety thereof to the person who shall sue for the same, and the other to the use of the United States, to be recovered by action in any court of competent jurisdiction.

Penalty for false notice.
3 Feb., 1831, ch. 16, § 11, v. 4, p. 448.
1 Blatchf., 154.

99. If any person, after the recording of the title of any book as herein provided, shall within the term limited, and without the consent of the proprietor of the copyright,

Infringement of copyright book.
3 Feb., 1831, ch. 16, § 6, v. 4, pp. 437, 438.
1 Story, 19.

2 Story, 115.
2 Blatchf., 47, 85.
4 McLean, 315.
4 Wash., 490.
7 How., 811.

first obtained in writing, signed in presence of two or more witnesses, print, publish, or import, or, knowing the same to be so printed, published, or imported, shall sell or expose to sale any copy of such book, such offender shall forfeit every copy thereof to said 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.

Infringement of copyright map, &c.

3 Feb., 1831, ch. 16, § 7, v. 4, p. 438.

1 Story, 18.
2 Story, 115.
2 Blatchf., 47.
3 Story, 787.
2 Wood. & Min., 512.
4 McLean, 301, 305.

100. If any person, after the recording of the title of any map, chart, 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 herein provided, shall, 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, engrave, etch, work, copy, print, publish, 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, or imported, shall sell or expose to sale any copy of such map or other article, as aforesaid, he shall forfeit to the said 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 posession, or which have by him been sold or exposed for sale; one moiety thereof to the proprietor and the other to the use of the United States, to be recovered by action in any court of competent jurisdiction.

Infringement of copyright dramatic composition.

18 Aug., 1856, ch. 169, § 1, v. 11, pp. 138, 139.

101. 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, to be recovered by action in any court of competent jurisdiction; said 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.

Infringement of manuscripts.

3 Feb., 1831, ch. 16, § 9, v. 4, p. 438.
5 McLean, 41, 332.
22 How., Pr., 207.
8 Pet., 657.
4 McLean, 301.

102. Any person who shall print or publish any manuscript whatever, without the consent of the author or proprietor first obtained, (if such author or proprietor be a citizen of the United States or resident therein,) shall be liable to said author or proprietor for all damages occasioned by such injury, to be recovered by action on the case in any court of competent jurisdiction.

Foreign works

103. Nothing herein contained shall be

may be printed or imported.

3 Feb., 1831, ch. 16, § 8, v. 14, p. 438.

construed to prohibit the printing, publishing, importation, or sale of any book, map, chart, dramatic or musical composition, print, cut, engraving, or photograph, written, composed, or made by any person not a citizen of the United States nor resident therein.

Limitation of time of action.

3 Feb., 1831, ch 16, § 13, v. 4, p. 439.

104. 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.

Pleading.

3 Feb, 1831, ch. 16, § 10, v. 4, p. 438.

105. In all actions arising under the laws respecting copyrights the defendant may plead the general issue, and give the special matter in evidence.

Actions cognizable by circuit court.

15 Feb., 1819, ch. 19, § 1, v. 3, p. 481.

5 McLean, 38, 336.

2 Wood. & Min., 27.

4 McLean. 401.

17 How., 455.

4 Duer, 382.

106. All actions, suits, controversies, and cases arising under the copyright laws of the United States shall be originally cognizable, as well in equity as at law, whether civil or penal in their nature, by the circuit courts of the United States, or any district court having the jurisdiction of a circuit court, or in the supreme court of the District of Columbia, or any Territory. And the court shall have power, upon bill in equity filed by any party aggrieved, to grant injunctions to prevent the violation of any right secured by said laws, according to the course and principles of courts of equity, on such terms as the court may deem reasonable.

Appeals to Supreme Court, United States.

107. A writ of error or appeal to the Supreme Court of the United States shall lie

from all judgments and decrees of any court, in any action, suit, controversy, or case touching copyrights, in the same manner and under the same circumstances as in other judgments and decrees of such courts, without regard to the sum or value in controversy.

18 Feb., 1861, ch. 37, § 1, v. 12, p. 130.

108. In all recoveries under the copyright laws, either for damages, forfeitures, or penalties, full costs shall be allowed thereon.

Full cost to be allowed.

3 Feb., 1831, ch. 16, § 12, v. 4, pp. 438, 439.

109. All books, maps, charts, and other publications, of every nature whatever, heretofore deposited in the Department of the Interior, according to the laws regulating copyrights, together with all the records of said department, and all records concerning the same which were removed by the Department of the Interior from the Department of State, shall be removed to and be under the control of the Librarian of Congress, who is hereby charged with all the duties pertaining to copyrights required by law.

Transfer of books, &c., to Library of Congress.

110. The clerk of each of the district courts of the United States shall transmit forthwith to the Librarian of Congress all books, maps, prints, photograp[h]s, music, and other publications, of every nature whatever, deposited in the said clerk's office, and not heretofore sent to the Department of the Interior, at Washington, together with all records of copyright in his possession, including the

titles so recorded, and the dates of record: *Provided*, That where there are duplicate copies of legal, scientific, or mechanical works, one copy of each may be deposited in the library of the Patent Office, for which a receipt shall be given by the Commissioner of Patents to the Librarian of Congress.

VI. Repealing Clause and Schedule.

111. Repeal and its effect.

Repeal and its effect.

111. The acts and parts of acts set forth in the schedule of acts cited, hereto annexed, are hereby repealed, without reviving any acts or parts of acts repealed by any of said acts, or by any clause or provisions therein: *Provided, however*, That the repeal hereby enacted, shall not affect, impair, or take away any right existing under any of said laws; but all actions and causes of action, both in law and in equity, which have arisen under any of said laws, may be commenced and prosecuted, and, if already commenced, may be prosecuted to final judgment and execution in the same manner as though this act had not been passed, excepting that the remedial provisions of this act shall be applicable to all suits and proceedings hereafter commenced: *And provided also*, That all applications for patents pending at the time of the passage of this act, in cases where the

duty has been paid, shall be proceeded with and acted on in the same manner as though filed after the passage thereof: *And provided further*, That all offenses which are defined and punishable under any of said acts, and all penalties and forfeitures created thereby and incurred before this act takes effect, may be prosecuted, sued for, and recovered, and such offenses punished, according to the provisions of said acts, which are continued in force for such purpose.

Schedule of statutes cited and repealed, as printed in the Statutes at Large, including such portions only of the appropriation bills referred to as are applicable to the Patent Office.

PATENTS.

Act of July 4, 1836, chapter 357, volume 5, page 117.

Act of March 3, 1837, chapter 45, volume 5, page 191.

Act of March 3, 1839, chapter 88, volume 5, page 353.

Act of August 29, 1842, chapter 263, volume 5, page 543.

Act of August 6, 1846, chapter 90, volume 9, page 59.

Act of May 27, 1848, chapter 47, volume 9, page 231.

Act of March 3, 1849, chapter 108, volume 9, page 395.

Act of March 3, 1851, chapter 32, volume 9, page 617.

Act of August 30, 1852, chapter 107, volume 10, page 75.

Act of August 31, 1852, chapter 108, volume 10, page 76.

Act of March 3, 1853, chapter 97, volume 10, page 209.

Act of April 22, 1854, chapter 52, volume 10, page 276.

Act of March 3, 1855, chapter 175, volume 10, page 643.

Act of August 18, 1856, chapter 129, volume 11, page 81.

Act of March 3, 1859, chapter 80, volume 11, page 410.

Act of February 18, 1861, chapter 37, volume 12, page 130.

Act of March 2, 1861, chapter 88, volume 12, page 246.

Act of March 3, 1863, chapter 102, volume 12, page 796.

Act of June 25, 1864, chapter 159, volume 13, page 194.

Act of March 3, 1865, chapter 112, volume 13, page 533.

Act of June 27, 1866, chapter 143, volume 14, page 76.

Act of March 29, 1867, chapter 17, volume 15, page 10.

Act of July 20, 1868, chapter 177, volume 15, page 119.

Act of July 23, 1868, chapter 227, volume 15, page 168.

Act of March 3, 1869, chapter 121, volume 15, page 293.

COPYRIGHTS.

Act of February 15, 1819, chapter 19, volume 3, page 481.

Act of February 3, 1831, chapter 16, volume 4, page 436.

Act of June 30, 1834, chapter 157, volume 4, page 728.

Act of August 18, 1856, chapter 169, volume 11, page 138.

Act of February 5, 1859, chapter 22, volume 11, page 380.

Act of February 18, 1861, chapter 37, volume 12, page 130.

Act of March 3, 1865, chapter 126, volume 13, page 540.

Act of February 18, 1867, chapter 43, volume 14, page 395.

Approved July 8, 1870.

PART II.

SYNOPSIS

OF THE

LAWS AND PRACTICE OF LETTERS PATENT

FOR INVENTION

IN THE PRINCIPAL FOREIGN STATES.

SYNOPSIS OF THE LAWS OF LETTERS PATENT

FOR INVENTION

IN THE PRINCIPAL FOREIGN STATES.

I. The Argentine Republic.

SEC.
1. Law and date.
2. Kinds of patents.
3. Previous examination.
4. Duration.
5. Government fees.
6. Documents required.

SEC.
7. Working.
8. Assignment.
9. Specifications, &c., inspection and publication of.
10. Infringements.
11. Other legal provisions.

1. LAW AND DATE.—28th September, 1864. Promulgated 11th October, 1864. (See *Commissioners of Patents' Journal*, [*vide infra*, § 71,] Nos. 1393, 1394, and 1453, An., 1867.)

2. KINDS OF PATENTS.—Patents of inventions granted to inventors or their assignees. Reissue of foreign patents. Certificates of addition or improvement. Provisional patents.

3. PREVIOUS EXAMINATION.—By the sub-commissioners. The following are not patentable: Pharmaceutical compositions; financial schemes; discoveries or inventions known or published abroad, or in the Republic; theoretical schemes: and inventions contrary to morals and to law.

4. DURATION.—Patents of inventions, five, ten, or fifteen years. Reissues of foreign patents limited to ten

years, and never to exceed the term of the original foreign patent. Provisional patents one year, and renewable each subsequent year.

5. GOVERNMENT FEES.—According to article 26 of the patent regulations, a stamp duty of twenty-five pesos (dollars) for the letters patent, and by yearly installments; eight pesos for patents of five years; ten pesos for patents of ten years; and for patents of fifteen years eleven pesos during the first five years, and twelve pesos during the remaining ten years. According to article 6 of the patent law, eighty pesos fuertes for a patent of five years; two hundred pesos for a patent of ten years; and three hundred and fifty pesos for a patent of fifteen years, one half to be paid at the time of application, and the other half by successive yearly installments. Patentees to accept and sign bills in common with another person (to be approved of by the commissioner) as collateral security for the payment of the annual installments. Certificates of addition subject to the same formalities as patents, original patentees paying only one fourth of the patent fees, but others than the patentee one half. Provisional patents fifty pesos, to be deducted in case letters patent or certificates of addition for said invention are taken out subsequently.

6. DOCUMENTS REQUIRED.—A petition to the Commissioner of Patents, (twenty-five pesos stamp duty,) a description, (in the Spanish language,) with proper drawings on a metrical scale, patterns, (models or chemical samples,) all in duplicate, and a list of the objects presented. A deposit of one half of the Government fees, one half only of which is returned in case of refusal; and when, in the latter case, an appeal is made to the Minister of

the Interior, (within ten days,) and the refusal is upheld by him, the whole deposit becomes forfeited.

7. WORKING.—Within two years, and not to be interrupted for the same period, except by showing good cause for delay.

8. ASSIGNMENT.—By notarial act of registration at the Patent Office. Payment of the entire fees required.

9. SPECIFICATIONS, ETC., INSPECTION AND PUBLICATION OF.—Open to public inspection at the Patent Office, (except provisional patents.) Published yearly. Copies obtained by paying the stamp duty on paper.

10. INFRINGEMENTS.—Punishable by a fine of from *fifty to five hundred pesos*, or by imprisonment of from one to six months, and the forfeiture of the counterfeit articles, besides damages. Participators subject to the same penalty. In case of a second offense within five years, said penalty to be doubled. All fines to be divided between the treasury and the informers.

11. OTHER LEGAL PROVISIONS.—Patent actions to be instituted by the interested parties before the sectional tribunals. Decisions summary. Longest term granted for showing cause, (in exceptional cases,) six months. Within ten days of the expiration of the term allowed, judge to deliver judgment and to award costs. Appeals to the superior court (for final decision) to be entered within three days.

II. Austria.

SEC.
12. Law, date, and where recorded.
13. Kinds of patents.
14. Previous examination.
15. Duration.
SEC.
16. Government fees.
17. Documents required, and where to be left.
18. Working and prolongation.

SEC.
19. Assignments.
20. Other legal provisions.
21. Specifications, inspection, copies.
SEC.
22. List of patents delivered.
23. Specifications published.
24. Proceedings to obtain a patent.

12. LAW, DATE, AND WHERE RECORDED.—Imperial decree of 15th August, 1852. (See *Commissioners of Patents' Journal*, [*vide infra*, § 71,] No. 291, An., 1856.)

13. KINDS OF PATENTS.—Exclusive privileges for new discoveries, inventions, or improvements granted to natives or foreigners residing or represented in Austria.

14. PREVIOUS EXAMINATION.—None as to novelty or utility. No guaranty by the Government. No patents are granted for preparations of food, beverages, and medicines, or for such inventions as cannot be worked for reasons of public health, morals, or safety, or as being contrary to the general interest of the State.

15. DURATION.—Fifteen years at most from the date of the exclusive privilege. Imported inventions for the unexpired term of the foreign patent. The latter grants are made to the foreign patentee only, or his proxy, provided the invention has not yet been worked in the empire.

16. GOVERNMENT FEES.—Twenty florins for each of the first five years; thirty florins sixth year; thirty-five florins seventh year; forty florins eighth year; forty-five florins ninth year; fifty florins tenth year; sixty florins eleventh year; seventy florins twelfth year; eighty florins thirteenth year; ninety florins fourteenth year; one hundred florins fifteenth year—equals seven hundred florins for fifteen years, or one hundred florins for the first five years, two hundred florins for the following five years, and four hundred florins for the last five years.

(Ten florins equal one pound.) The fees paid for patents, which subsequently have been annulled on public grounds, are to be repaid in proportion to the unexpired term.

17. DOCUMENTS REQUIRED, AND WHERE TO BE LEFT.—A petition of the inventor or his proxy; power of attorney, (in the latter case;) the Government fees or receipt for the same; a specification, sealed, and in German, or the language of the respective State of the empire; drawings, models, or patterns; statement whether the invention is to be kept secret or not, and, if the former, for how long. In the case of importations, the original letters patent or an authenticated copy of the same. Deposited at the offices of the governors of provinces or of the authorities of districts. Specifications may be amended.

18. WORKING AND PROLONGATION.—To be worked within one year, and not to be interrupted for two years. The longest term extended by special grant of the Emperor.

19. ASSIGNMENTS.—Registered at the Ministry of Commerce and Trades, and published in the *Vienna Gazette*, monthly.

20. OTHER LEGAL PROVISIONS.—The following cases are to be considered as infringements: 1. Imitating the object of a patent; 2. Importing counterfeit articles; 3. Selling such counterfeit articles. Infringements of patents with specifications kept secret not punishable in the first instance. Fines, which are to be paid into the poor-box, from fifty shillings to one hundred pounds. Imprisonment at the rate of one day for ten shillings.

21. SPECIFICATIONS, INSPECTION, AND COPIES OF.—In the

record office of patents, at the Ministry of Commerce and Trades, Vienna. Copies to be had of specifications which are not to be kept secret or which belong to an extinct patent.

22. LIST OF PATENTS DELIVERED.—Monthly and annual synoptical tables of privileges granted, prolonged, assigned, and become void. (*Vienna Gazette*, monthly, and *Commissioners of Patents' Journal*, [*vide infra*, § 71.])

23. SPECIFICATIONS PUBLISHED.—In various technical periodicals and official publications kept at the Public Free Library of the Patent Office.

24. PROCEEDINGS TO OBTAIN A PATENT.—Petitions for patent may be addressed by the applicant or his agent to the governors of provinces or to the different authorities of districts. They must contain the Christian and surname, profession, and residence of the applicant; and, if not resident in the empire, the name, profession, and residence of a proxy domiciled there. If the process is intended to be worked by a firm bearing a different name, that name must also be stated. The comprehensive title of the invention must be given, and the number of years for which the patent is demanded, which must not exceed fifteen, except by special grant of the Emperor. Foreign patents are limited in duration to that of the original. Applicant must also state whether he desires that the invention shall be kept secret or not. The tax may be paid to a public treasurer, and his receipt must be given in with the application. If made by an agent, a power of attorney must be put in; and if there be a foreign patent, the original or an authenticated copy must be produced. The description of the invention must be under a sealed cover, indorsed with

the title of the invention, and the address of applicant or his agent.

Specifications must be written in German or in the language of the province where the application is made, and must contain such a clear, unambiguous, and complete detail of the invention as to enable any competent man to manufacture the article.

Should the authority to whom an application is made think the invention unfit to be patented, he is to inform the petitioner thereof, requiring him to withdraw it, and give a receipt for the sealed specification. An appeal is allowed to the Minister of Commerce and Trades. A defective specification may be amended.

No examination of the novelty or merit of the invention is made, the patent being delivered at the mere risk and expense of the applicant.

The privilege of a patent extends to the whole of the Austrian dominions; that is to say, to Austria proper, Bohemia, Austrian Italy, the Polish provinces, Istria, Salzburg, Styria, Silicia, Moravia, and the Tyrol.

Form of Petition for a Patent.

[*Insert address of the authorities of the respective district or province.*

I [*or we, as the case may be, Christian and surname, profession, and domicil*] beg to state that have made a new discovery, [*invention, improvement,*] consisting essentially in [*insert the comprehensive title.*]

The complete specification, drawn up according to the provisions of section twelve of the patent law of is subjoined in the appendix.

[*Insert whether the specification is to be kept secret, and state the exact number of the drawings, models, patterns, &c., if any.*]

For this discovery [*invention, improvement*], announced and duly specified, which the undersigned petitioner believe , to the best of knowledge, to be patentable and new, according to the provisions of the said patent law, and legal for obtaining an exclusive privilege at own risk and responsibility, solicit such a privilege for the stated discovery, [*invention, improvement,*] in the manner as represented in the annexed sealed specification, under the legal clauses and conditions, for the term of years, for which purpose pay the entire patent tax of florins, due according to section eleven of the said patent law, and request the delivery of an official certificate for securing prior claims.

[*Address and date.*] [*Signature.*]

Where not the money, but the receipt of a public pay office is tendered with the application for patent, such receipt must contain the name of petitioner, the title of the invention, the number of years for which the tax has been paid, and the amount in words at length. Any deficiency or defect in this document must be remedied before the petition can be received.

The tax being paid, and the petition being found worded and directed according to prescription, the parties being present, an official memorandum is to be inscribed on the cover of the sealed specification, stating the day and hour when the petition was delivered and the amount of tax paid, and the applicant or his agent

must also sign it. Of this formality an official certificate is to be delivered to the applicant.

These formalities being fulfilled, the petition is to be forwarded within three days to the governor of the respective province, unless the delivery took place in the chief town of the province, whence, if found correct, all the documents are to be forwarded to the Minister of Commerce and Trades, with a report from the governors.

The petition having been found correct, or its defects having been corrected, and the article having been deemed patentable, letters patent are then issued, the minister having the power to impose on the working of the patent such conditions or restrictions as may be considered necessary.

III. The Grand Duchy of Baden, and Petty States of Germany.

25. No special patent legislation.

25. No Special Patent Legislation.—The Minister of the Interior, however, grants privileges for inventions, after an examination as to novelty and utility by competent commissioners. The Government fees amount to 40 or 50 florins, (12 fls.=£1.) The term for which patents are granted is five and ten years. (Annual lists of patents published in the *Commissioners of Patents' Journal*, *vide infra*, § 71.)

In the following States there is no special legislation, but the respective Governments grant privileges to inventors for the exclusive use or working of their inventions:

Anhalt-Dessau.
Anhalt-Bernberg.
Anhalt-Cothen.
Brunswick.
Bremen.
Frankfort.
Hamburgh.
Hesse-Cassel.
Hesse-Darmstadt.
Hesse-Homburg.
Hohenzollen-Sigmarigen.
Lippe-Detmold.
Lippe-Schaumburg.
Lubeck.
Mecklenburg-Schwerin.
Mecklenburg-Strelitz.
Nassau.
Oldenburgh.
Reuss-Schleitz.
Reuss-Ebersdorf.
Reuss-Greiz.
Sachsen-Altenburg.
Sachsen-Coburg-Gotha.
Sachsen-Meinengen.
Sachsen-Weimar-Eisenach.
Schwarzburg-Rudolstadt.
Schwarzburg-Sonderhausen.
Waldeck.

IV. Bavaria.

Sec.		Sec.	
26.	Law, date, and where recorded.	33.	Working and extension.
27.	Kinds of patents.	34.	Assignments.
28.	Previous examination.	35.	Other legal provisions.
29.	Duration.	36.	Specifications, inspection and copies of.
30.	Annulment.	37.	List of patents delivered.
31.	Government fees.	38.	Specifications published.
32.	Documents required and where to be left.	39	Proceedings to obtain a patent.

26. LAW, DATE, AND WHERE RECORDED.—Royal ordinance of 11th September, 1825, and organic law for the regulation of trades, dated 17th December, 1853. (See *Commissioners of Patents' Journal*, [*vide infra*, § 71,] No. 262, An., 1856.)

27. KINDS OF PATENTS.—Patents for inventions, improvements, and importations granted to natives and

foreigners residing or represented in Bavaria. No guaranty as to novelty.

28. PREVIOUS EXAMINATION.—By the Minister of Commerce and Public Works, as to novelty, utility, and for sanitary reasons.

29. DURATION.—From one to fifteen years. Imported inventions according to duration of original patent.

30. ANNULMENT.—In case of the invention not being new, or the description thereof having been published in German or foreign works.

31. GOVERNMENT FEES.—Two guineas for one year; £2 10s. for two years; £3 7s. for three years; four guineas for four years; £5 for five years; £6 for six years; £7 10s. for seven years; £9 for eight years; £10 17s. for nine years; £12 10s. for ten years; £14 12s. for eleven years; £16 14s. for twelve years; £18 for thirteen years; £21 for fourteen years; £23 for fifteen years; besides a stamp duty of five shillings.

32. DOCUMENTS REQUIRED AND WHERE TO BE LEFT.—A petition of the inventor or his proxy, (with power of attorney,) addressed to the Minister of Commerce and Public Works; the fees and stamp duty; a description, with drawings, models, or patterns. In cases of importation, the original patent, (or a legalized copy thereof.)

33. WORKING AND EXTENSION.—Original terms extended to fifteen years at most. Patents for less than six years to be worked within the first half of the period allowed; patents for six years and more, within three years; patents of importation, within one year. Working not to be interrupted for two years.

34. ASSIGNMENTS.—To be recorded at the Ministry of Commerce and Public Works within three months.

35. OTHER LEGAL PROVISIONS.—Infringement punishable by a fine of from £8 to £41, (half to the poor-box.) Counterfeits confiscated. Injuries done unknowingly and in good faith punishable by the interdiction only of the illegal undertaking.

36. SPECIFICATIONS, INSPECTION AND COPIES OF.—Specifications of patents that have become extinct, or such as are not to be kept secret, may be inspected at the above ministry.

37. LIST OF PATENTS DELIVERED.—In the official gazette, in a register at the above ministry, and in every chief provincial town; in the *Commissioners of Patents' Journal.*

38. SPECIFICATIONS PUBLISHED.—At the expiration of the patent, if deemed interesting, (mostly in the *Bayrische Kunst und Gewerbeblatt.*) May be consulted at the Public Free Library of the Patent Office.

39. PROCEEDINGS TO OBTAIN A PATENT.—The petition for a patent must be addressed to the Minister of Commerce and Public Works; it must contain the Christian and surname of the applicant, his calling and place of abode, and, if a foreigner, those of his agent in Bavaria, the general but characteristic designation, of the invention, and must state the number of years for which the patent is demanded. The petition must be accompanied by a detailed, complete, and true description, in German, or accompanied by a German translation, of the invention, with drawings, models, &c., when necessary. The specification may be open or under cover, at the option of the petitioner. The documents must be indorsed with the exact day and hour of the deposit, and a certificate to the same effect must be given to the peti-

tioner. The application must always be accompanied with the amount of the tax and stamp duty of three florins. Where the specification is found defective, it will be returned for correction.

V. Belgium.

SEC.
40. Law, date, and where recorded.
41. Kinds of patents.
42. Previous examination.
43. Duration.
44. Government fees.
45. Documents required, &c.
46. Working and extension.
47. Assignments.
48. Specifications, copies of.
49. List of patents delivered.

SEC.
50. Specifications published.
51. Originals of specifications.
52. Legal proceedings.
53. Causes of nullity.
54. Proceedings to obtain a patent.
55. Declaration.
56. Form of a patent.
57. Form of transfer of patent.
58. Form of certificate of reception of a patent by transfer.

40. LAW, DATE, AND WHERE RECORDED.—Royal decrees of 24th May, 1854, and 27th March, 1857. (See *Commissioners of Patents' Journal*, [*vide infra*, § 71,] Nos. 292 and 348.)

41. KINDS OF PATENTS.—Patents of invention, importation, and improvement granted to natives or foreigners residing or represented in Belgium.

42. PREVIOUS EXAMINATION.—None.

43. DURATION.—Twenty years at most from the date of the deposit. Foreign inventions according to the longest term granted abroad.

44. GOVERNMENT FEES.—Ten francs the first year, twenty francs the second year, and so on till the twentieth year, when the fees are two hundred francs, (one franc, equal ten pence.) Original patentees exempt from fees for patents of improvement. Patentees having

forfeited their rights by not making the annual payment in due time may recover them within six months following the expiration of their patent, by paying a penalty of ten francs, (eight shillings.)

45. DOCUMENTS REQUIRED, AND WHERE TO BE LEFT.—A petition of the inventor, or his proxy, on stamped paper, to the Minister of the Interior; a specification, (two copies,) in French, Flemish, or German, (foreign specifications, however, only in French;) drawings (two copies) on a metrical scale, models or patterns; an acknowledgment of the receipt of ten francs paid to the *receveur-général;* a memorandum of the various documents. Deposited at the registrar's office of the respective provincial governments, or at the office of the commissary of a district, or at the Ministry of the Interior at Brussels.

46. WORKING AND EXTENSION.—The working of the invention must take place within one year from its having been worked abroad, and not be interrupted, without good reason, for one year. Prolongations granted for one year, by applying two months previously. Patents of improvement, taken out by others than by the patentee of the original invention, cannot be worked together with the original invention without the consent of the original inventor, and *vice versâ.*

47. ASSIGNMENTS.—By notarial act, registered at the Ministry of the Interior on payment of ten francs, and published quarterly in the official publication of specifications, together with the list of patents annulled or expired.

48. SPECIFICATIONS, INSPECTION AND COPIES OF.—Inspection free at the Ministry of the Interior three months

after the delivery of the patent. Copies on payment of costs.

49. LIST OF PATENTS DELIVERED.—Published every fortnight in the *Moniteur Belge* and in the *Commissioners of Patents' Journal.* Lists of patents that have become void published quarterly in the *Moniteur Belge.*

50. SPECIFICATIONS PUBLISHED.—Three months after the grant of the patent in full, or in the form of extracts. At all events, patentees may have their specifications published in full, at their own expense, by giving previous notice thereof to the administration one month at least before the expiration of said term. Said publications are kept at the library of the United States Patent Office.

51. ORIGINALS OF SPECIFICATIONS, (MODELS.)—Deposited at the expiration of the patent in the Museum of Industry, Brussels.

52. JURISDICTION AND LEGAL PROCEEDINGS.—The Tribunal de 1re Instance. Legal proceedings to be ruled by article 587 of the Code Civil.

53. CAUSES OF NULLITY.—Want of novelty; non-payment of the annual fees; fraudulent or defective description; previous publication, except official foreign publications of inventions patented abroad, and for which patents of importation are sought in Belgium.

54. PROCEEDINGS TO OBTAIN A PATENT.—The applicant for a patent, or his agent, must make application to one of the provincial governments of the kingdom, or at the office of one of the district commissioners, if situated at a distance from the chief town of the province. To this application must be added in a sealed envelope—

1. A specification of the objects invented.

2. The drawings, patterns, or specimens necessary to understand the specification.

3. A duplicate, certified as being in conformity with the specification and drawings.

4. A list of the objects deposited.

All these documents must be signed by the applicant or his agents.

A receipt, showing that the first year's fee of ten francs has been paid, must be deposited with the above.

The application must be on stamped paper, and contain the Christian and surname of the inventor, his profession, and his address, real or elected, in the kingdom, and it must express the object of the invention distinctly and concisely. It must be confined to one principal invention, with its details and applications. If a patent of importation, it must state the duration of the original patent and the country where granted. An agent must produce a power to act. (The decree says this must be in due legal form, but the practice is not to require that the power be legalized by notaries, magistrates, or consuls.)

The specifications must be in French, Flemish, or German, and, if not in French, with a French translation. When the inventor is not resident in Belgium, the specification should be without interlineation or erasure, and any words interlined or erased should be counted, certified, and the pages and references indicated. The specification must be clear and distinct, and conclude with a summary of the matter of which it consists.

The drawings should be in ink, to a metrical scale, properly indicating the invention in plan, sections, and elevations, and the parts which contain the invention patented should be of a different color to the rest.

A statement must be drawn up and signed by the applicant and the registrar of the provincial government, or by the commissioner of the district, containing the day and hour of the deposit and the title of the invention, the inventor's Christian and surname, calling, and address, or those of his agent. If a patent of importation, that fact must be mentioned, with the date and duration of the patent in the country where it originated, and the name of the patentee. This document must also contain an acknowledgment of the payment of the first annual fee, and be attached to the packet containing the specification and drawings. A copy gratis will be given to the applicant.

The offices for registration of patents are open daily from 10 a. m. to 2 p. m.

A register of all documents secured at the offices will be open to public inspection at the office of the Minister of the Interior.

In case of omissions or irregularity of form, rectifications may be made, and a note of such alterations mentioned in the register.

A certificate of the Minister of the Interior will be given to the applicant without delay, stating that the prescribed formalities have been complied with. This certificate will constitute his patent right. The first copy will be given gratis, but all others must be paid for.

55. DECLARATION.

PROVINCE OF .

This day, [*day of the month*, 18 ,] at o'clock, Mr. has deposited in our hands the present package, sealed with his seal, which he has informed us contains all the descriptive documents of [*title of patent*], for which he solicits a patent of invention [or importation] for five, ten, or fifteen years, as is indicated in the petition annexed. Mr.

has declared to us that he is the inventor [or importer of the said object.]

Done at the secretarial of the provincial government the

day of .

56. Form of a Patent of Invention, Importation, or Improvement.—

We, Leopold, King of the Belgians, to all present and to come, greeting: Seeing the demand of Mr. , domiciled , tending to obtain, according to the law of 25th January, 1817, a patent of for years, for [*the title*], of which he declares himself to be the inventor, [or importer,] as appears by the procès-verbal made on the deposit of the documents at the secretarial of the province of , the

Seeing the drawings and descriptions, as follows:

We have decreed and decree:

A patent of years is granted to Mr. for the above described.

This patent guaranties the following rights to its possessor:

1. To make and sell exclusively in the whole kingdom, during the whole term of the patent, the patented objects, or to cause them to be made or sold by others whom he may authorize.

2. To pursue in the courts of law those who in any way infringe on the exclusive rights which have been accorded him, and to proceed against them at law for the purpose of obtaining confiscation for his profit of the objects made according to his pattern model, but not yet sold, and of the amount for which any such objects may have been sold, as likewise to institute actions for damages and interest, if there be any. The Government guaranties in nowise the novelty or the merits of the invention, and it may declare the present patent null, and publish the invention for one of the causes named in article 8 of the law of 25th January, 1817.

The objects patented shall be made in the country, and the patentee or his assigns shall (at the expiration of the delay fixed by letter C of article 8 of the law, and earlier if the patent so stipulates) be required to produce to the Minister of Interior, at any time he may require it, a sufficient proof of the patented object having been put into activity in an established and regular way, so that it may be considered as being usefully in activity in the country.

The Government reserves to itself the faculty of quashing the patent and giving the object to the public if these obligations be not strictly complied with.

Given the

57. FORM OF ACT OF TRANSFER OF PATENT.—

This day, , 184 , Mr. presented himself at our secretarial of the provincial government, to require a procès-verbal to be made up of the transfer which he has made to Mr. by notarial act, of the whole or part of the patent which was granted to him the for , which procès-verbal the parties interested have signed with us, after having paid the dues indicated in the arrangement for the delivery of the patent.

Done at the secretarial of the province of the .

58. FORM OF CERTIFICATE OF RECEPTION OF A PATENT BY TRANSFER.—

This day, , 184 , Mr. presented himself at our secretarial, to obtain a procès-verbal of the acquisition which he has made, as proved by act of the notary by right of succession, of the whole or part of a patent of invention which we delivered the , for to Mr. , deceased.

Which procès-verbal the interested party has signed with us, after having paid the dues indicated in the tariff of the arrangement for the delivery of patents.

Done at the secretarial of the province of , the .

Enacted by his Majesty the 26th March, 1817.

The Secretary of the Department of Instruction of the Arts and Sciences.

VI. Great Britain and Ireland.

SEC.
59. Law, date, and where recorded.
60. Kinds of patents.
61. Previous examination.
62. Duration.
63. Stamp duties to be paid.
64. Documents required at the Patent Office.
65. Assignments and licenses.
66 List of patents at different stages.
67. Specifications, disclaimers, alterations, provisional specifications, assignments, licenses.
68. Specifications, disclaimers, alterations, and indexes.
69. Originals of specifications, etc.
70. Free Public Library of the Commissioners of Patents.
71. Commissioners of Patents' Journal.
72. Infringements.
73. Other legal provisions.

59. LAW, DATE, AND WHERE RECORDED.—Acts 15 and 16 Vict., cap. 83; 16 Vict., cap. 5; 16 and 17 Vict., cap. 115. In operation since 1st October, 1852. (Patent Law Amendment, Patent Office 25 Southampton Buildings, Chancery Lane.)

60. KINDS OF PATENTS.—Letters patent, disclaimers, and memoranda of alteration issued to British subjects and aliens residing or represented in the United Kingdom. Provisional protection during six months. Valid for the whole of the United Kingdom, the Channel Islands, and the Isle of Man. Medicines vended under a Government stamp as "patent medicines" have never been the subject of letters patent.

61. PREVIOUS EXAMINATION.—None as to novelty or utility.

62. DURATION.—Patents are issued for fourteen years, subject to prolongation by Privy Council. Patents expire at the end of the third or seventh year, if the requisite payments in stamp duties are not made. Letters patent are dated from the day of application, and when antedated are to be of the same validity as if sealed on the day of the date. Letters patent for patented foreign inventions according to the term of foreign patent.

63. STAMP DUTIES TO BE PAID.—On petition, £5; on certificate of record on notice to proceed, £5; on warrant for letters patent, £5; on the sealing of letters patent, £5; on specification, £5; on the letters patent before the expiration of the third year, £50; on the letters patent before the expiration of the seventh year, £100: *i. e.*, £175 for a patent of fourteen years; on certificate of record on notice of objections, £2; for every search and inspection, 1*s.*; for entry of assignment or license, 5*s.*;

on certificate of assignment or license, 5*s.*; on application for disclaimer, £5; on caveat against disclaimer, £2; on office copies of documents, for every seventy-two words, 2*d.* The payments for the above stamp duties are made at Somerset House, (Inland Revenue Department,) and the certificates for such payments are delivered at the Patent Office, (gratis.) *Fees to be paid to the law officers and to their clerks:* By the person opposing a grant of letters patent, £3 10*s.*; by the petitioner on the hearing of the case of opposition, £3 10*s.*; by the petitioner for the hearing previous to the first allowing a disclaimer or memorandum of alteration in letters patent and specification, £3 5*s.*; by the person opposing the allowance of such disclaimer, £3 5*s.*; by the petitioner for the first allowing a disclaimer or memorandum of alteration in letters patent and specification, £3 15*s.* 6*d.*

64. DOCUMENTS REQUIRED AT THE PATENT OFFICE.—A petition to the Queen by the inventor or his agent; a declaration of the inventor or his agent, made before a master in chancery, or justice of the peace, or a British consul abroad; a provisional or complete specification, (two copies of the latter, one on parchment,) together with the necessary drawings, (two copies on parchment,) one inch to a foot recommended; an abridgement (two copies) of provisional specification, or of complete specification, when filed with the petition and declaration; notice to proceed, eight weeks clear before the expiration of six months; warrant and great seal, twelve clear days before the expiration of six months, (upon special circumstances the Lord Chancellor may allow a further extension of time;) notice of opposition to be given within twenty-one days after the date of notice to pro-

ceed in the gazette, or, in case of opposition to great seal, twelve days before the expiration of provisional protection. (N. B.—Application by letter cannot be entertained.) For the Great Seal Patent Office, the initials are W. C., the district being western central. In the direction of a letter, these initials should be legibly written in a separate line, and should in all cases end the address, thus:

THE COMMISSIONERS OF PATENTS,
Great Seal Patent Office,
25 *Southampton Buildings,*
London,
W. C.

65. ASSIGNMENTS AND LICENSES.—Recorded in the Register of Proprietors at the Patent Office. Entries may be expunged.

66. LIST OF PATENTS AT THEIR DIFFERENT STAGES.—Published in the London Gazette and in the Commissioners of Patents' Journal, within five days of the application and notice to proceed and within a fortnight of the sealing of the Patent; also, List of Patents on which the stamp duty of £50 and £100 has been paid, &c. (Compare *Commissioners of Patents' Journal,* [*vide infra,* § 71.])

67. SPECIFICATIONS, DISCLAIMERS, MEMORANDA OF ALTERATIONS, PROVISIONAL SPECIFICATION, ASSIGNMENTS, AND LICENSES.—Open to the inspection of the public at the Patent Office, London; at the Enrollment Office of the Court of Chancery, in Dublin; and at the office of the Directory of Chancery in Scotland. (N. B. Not within the term of provisional protection.)

68. SPECIFICATIONS, DISCLAIMERS, MEMORANDA OF ALTERATIONS, AND INDEXES.—Published by the Commission-

ers of Patents, and sold at cost price, at the Patent Office, within a month of the issue of the letters patent. All old specifications have been published likewise, and are sold at cost price. In course of publication and partly published, (thirty-six classes,) Abridgments (in classes and chronologically arranged) of all Specifications of Patented Inventions, from the earliest enrolled to those published under the act of 1852.

69. ORIGINALS OF SPECIFICATION, ETC., (MODELS.)—Kept at the Patent Office. Models are not required, but when presented or lent, they are deposited in the Museum of the Commissioners of Patents, South Kensington, which is open daily to the public free of charge.

70. FREE PUBLIC LIBRARY OF THE COMMISSIONERS OF PATENTS.—The Reading-Room in the office of the Commissioners of Patents is open daily from 10 till 4 o'clock. In addition to the printed specifications, indexes, and other publications of the Commissioners of Patents, the Library includes the official publications of foreign patents and a collection of the leading British and foreign scientific journals and text-books, in the various departments of science and art, (about sixty thousand volumes.) The Commissioners of Patents' publications may be consulted at the public libraries of the chief continental States, the British Colonies, and America.

71. COMMISSIONERS OF PATENTS' JOURNAL.—Published on Tuesdays and Fridays: price, 2d; by post, 3d. Contents: 1. Applications for letters patent; 2. Grants of provisional protection for six months; 3. Inventions protected for six months by the deposit of a complete specification; 4. Notices to proceed; 5. Patents sealed; 6. Patents extended; 7. Patents canceled; 8. Patents on

which the third year's stamp duty has been paid; 9. Patents which have become void by non-payment of the stamp duty of £50 before the expiration of the third year; 10. Patents on which the seventh year's stamp duty has been paid; 11. Patents which have become void by non-payment of the stamp duty of £100 before the expiration of the seventh year; 12. Colonial patents and patent law; 13. Foreign patents and patent law; 14. Weekly price lists of printed specification, &c.; 15. Official advertisements and notices of interest to patentees and inventors generally.

The patent laws of the colonies of Great Britain and of foreign States are published in full in about eighty numbers of the *Commissioners of Patents' Journal*, the official organ of the British Patent Office, which should be found, as well as all other publications of the British Commissioners, in the Patent Office, Washington; Peabody Institute, Baltimore; Franklin Institute and Philadelphia Library, Philadelphia; Astor Library, New York; Free Library, Boston; Young Men's Association Library, Chicago; Wisconsin Historical Society, Madison; and Cornell University, Ithaca, New York, to which institutions they have been presented by the British Government.

The following is a list of the foreign States the laws of which have been published in the *Commissioners of Patents' Journal:*

Argentine Republic, Nos. 1393, 1394, 1453.
Austria, 291.
Baden and petty States of Germany, 325.
Bavaria, 262.
Belgium, 292, 348.
British Guiana, 798.
Canada, 279, 625, 856, 1106, 1188, 1629.

Cape of Good Hope, 727.
Ceylon, 648.
Cuba, 498.
Dutch West Indies, 322.
France, 228, 229, 947, 948, 949, 1386.
Germany, 435.
Greece, 325.
Hanover, 321.
India, 240, 348, 552, 578.
Italy, 1061, 1064, 1656.
Jamaica, 660.
Lucca, 321.
Mauritius, 1282.
Mexico, 496.
Netherlands, 289, 1643.
Newfoundland, 858.
New South Wales, 386.
New Zealand, 861, 1639.
Norway, 665.
Parma, Piacenza, and Guastalla, 321.
Poland, 335.
Portugal, 325, 1026.
Prussia, 313, 329.
Queensland, 859.
Roman States, 319.
Russia, 334, 508.
Sardinia, 233, 235, 636, 637, 639, 640.
Saxony, 236.
Sicilies, (the Two,) 316.
South Austria, 1442.
Spain, 323.
Sweden, 327, 354.
Tasmania, 860.
Trinidad, 883, 1698.
Victoria, 186, 359, 1622.
Wurtemburg, 314, 995.

72. INFRINGEMENTS.—In actions for infringement of letters patent particulars are to be delivered, and no evidence allowed not mentioned therein. Courts of common law may grant injunction in case of infringement. Particulars to be regarded in taxation of costs.

73. OTHER LEGAL PROVISIONS.—Letters patent granted to the first inventor not to be invalidated by protection obtained in fraud of the first inventor. Specification and objections to be referred to law officer. Power of law officer to order by or to whom costs shall be paid. Nothing to affect the prerogative of the Crown in granting or withholding grant of letters patent. Nothing to

give effect to any letters patent granted in any colony. Letters patent may be granted to personal representatives of the applicant during the term of protection, or within three months after applicant's decease. If letters patent be destroyed or lost other letters patent may be issued. Letters patent not to prevent the use of inventions in foreign ships resorting to British ports, except ships of foreign States in whose ports British ships are prevented from using foreign inventions. Certified copies of specifications, &c., as printed by Queen's printers, to be evidence. Copies or extracts of letters patent, &c., certified and sealed, filed at Commissioners' office, to be received in evidence. Power for more than twelve persons to have a legal interest in letters patent. Falsification or forgery of entries a misdemeanor.

VII. Analysis of the British Patent Laws.

SEC.
74. Acts of Parliament; rules.
75. Commissioners.
76. Seal.
77. Petition and declarations.
78. Only one invention to be included in a patent.
79. Copy of specification with application.
80. Petitions, &c., to be left at office; size.
81. Size of drawings.
82. Applications referred.
83. Law officer may amend title.
84. Applicant may not amend provisional specification.
85. Nature of invention.
86. Fee on leaving petition.

SEC.
87. Provisional protections.
88. Complete specifications.
89. Fraud.
90. Complete specification advertised.
91. Complete specification stamp £5.
92. Notice to proceed.
93. Notice to proceed advertised.
94. Opposition.
95. Applications for or against sealing.
96. Notice to proceed fee £3.
97. Objections to be referred.
98. Law officer to decree cost.
99. Warrant for sealing patent.
100. Complete specification filed.

SEC.
101. Patent fee £5; stamp £5.
102. Future payments.
103. Issue of letters patent.
104. Issued three months from warrant.
105. Accidental delay.
106. Case of death.
107. If lost, new patent may issue.
108. Date of letters patent.
109. Patents for foreign inventions.
110. Foreign ships.
111. Copy of drawings.
112. Size of specifications.
113. Size of drawings and scale.
114. Extra copy of specification.
115. Documents to be legibly signed.
SEC.
116. Period of notice.
117. Public inspection of documents.
118. Documents to be printed.
119. Documents evidence in courts.
120. Chronological register; copy of license may be had and is evidence.
121. Number of persons interested.
122. Falsification of register.
123. Entries in register expunged.
124. Disclaimers.
125. Confirmation of prolongation.
126. Infringement.
127. Judge's order.
128. Taxing costs.
129. Schedules of fees and stamps

74. ACTS OF PARLIAMENT; RULES.—The following is an analysis of the patent law amendment act, 1852, (15 and 16 Vict., ch. 83,) with which are embodied the rules which have been made from time to time by the Lord Chancellor and the Commissioners, also such parts of the 5 and 6 William IV., ch. 83, and 7 and 8 Vict., ch. 89, and 12 and 13 Vict., ch. 109, as are retained as forming part of the present law by the act of 1852, and the act of the 16 and 17 Vict., ch. 115, to amend the act of 1852:

75. COMMISSIONERS.—

The Lord Chancellor.
The Master of the Rolls.
The Attorney General and Solicitor General for England.
The Lord Advocate and Solicitor General for Scotland.
The Attorney General and Solicitor General for Ireland.

The Crown has power to appoint other persons as Commissioners.

The powers of the act may be exercised by any three

Commissioners, the Lord Chancellor or Master of the Rolls being one. (§ 1.)

76. SEAL.—They are authorized to have a seal made for sealing patents, and to vary such seal from time to time. (§ 2.) They may make rules (not inconsistent with this act) for conducting the business of the office, and for the purpose of the act may provide officers and employ clerks. (§§ 3, 4, 5.)

77. PETITION AND DECLARATIONS.—The petition for the grant of letters patent and the declarations required to accompany such petition shall be left at the office of the Commissioners, and also a statement in writing, called the provisional specification, signed by or on behalf of the applicant, and describing the notion of his invention. The day of the delivery of these documents at the office is to be indorsed upon them, and a certificate to that effect given to the depositor. (§ 6.)

78. ONLY ONE INVENTION TO BE INCLUDED IN A PATENT. Every application for letters patent, and every title of invention and provisional specification, must be limited to one invention only, and no provisional protection will be allowed or warrant granted where the title or the provisional specification embraces more than one invention. (3d Set of Rules, December 12, 1853.) The title of the invention must point out distinctly and specifically the nature and object of the invention. (*Ib.*) The expression "invention" shall mean any manner of new manufacture in the meaning of the act 21 James I., ch. 3. (§§ 6, 7.)

79. COPY OF SPECIFICATION, &C., TO ACCOMPANY APPLICATION.—A true copy, under the hand of the patentee, or applicant, or his agent, of every specification and com-

plete specification, with the drawings accompanying the same, if any, shall be left at the office on filing such specification or complete specification. (16 and 17 Vict., ch. 115.)

80. PETITIONS, &C., TO BE LEFT AT OFFICE; SIZE.—All petitions for letters patent, and all declarations and provisional specifications, are to be left at the office. They are to be written on sheets of paper twelve inches in length and eight and a half inches in breadth, leaving a margin of one and a half inch on each side of each page. (1st Set of Rules, October 1, 1852.)

81. SIZE OF DRAWINGS.—Drawings to accompany provisional specifications to be on sheets of paper, parchment, or cloth, twelve inches long, eight and a half inches broad, or twelve inches broad and seventeen inches long, leaving a margin of one inch on every side of each sheet. (1st Set of Rules, October 1, 1853.)

82. APPLICATIONS REFERRED TO A LAW OFFICER, WHOSE CERTIFICATE FOR FILING GIVES PROVISIONAL PROTECTION FOR SIX MONTHS.—The application for letters patent shall be referred by the Commissioners to one of the law officers, (who are the attorneys and solicitors general for England and Ireland, and lord advocate and solicitor general for Scotland.) (§ 55.) The law officer may call to his aid a scientific or other person and fix his remuneration, which is to be paid by the applicant. If satisfied with the provisional specification, the law officer shall give a certificate to that effect, to be filed at the Patent Office, and thereupon the invention may be used and published during a term of six months, the protection thus afforded being termed provisional protection.

83. LAW OFFICER MAY AMEND TITLE.—The law officer

has the power to cause the title of the invention to be amended, if too large or insufficient. (§§ 7, 8.)

84. APPLICANT MAY NOT AMEND PROVISIONAL SPECIFICATION.—No amendment or alteration at the instance of the applicant will be allowed in a provisional specification after the same has been recorded, except for the correction of clerical errors or of omissions made *per in curiam.*

85. PROVISIONAL SPECIFICATION MUST STATE DISTINCTLY NATURE OF INVENTION.—The provisional specification must state distinctly and intelligibly the whole nature of the invention, so that the law officer may be apprized of the improvement and of the means by which it is to be carried into effect. (2d Set of Rules, October 15, 1852.)

86. FEE ON LEAVING PETITION £5.—The fee to be paid on leaving petition for grant of letters patent is £5. (Schedule of Act.)

87. PROVISIONAL PROTECTIONS TO BE ADVERTISED IN GAZETTE.—Provisional protections are to be advertised in the *London Gazette,* with the name and address of the petitioner, the title of his invention, and the date of the application. (1st Set of Rules, Oct. 1, 1852.)

88. COMPLETE SPECIFICATION MAY BE AT ONCE DEPOSITED.—The applicant may, instead of the provisional specification, deposit with the petition and declaration an instrument, under his hand and seal, called a complete specification, particularly describing the nature of his invention, the same to be mentioned in such declaration, and the day of delivery of these documents at the office shall be registered there and indorsed on the petition, declaration, and specification, and a certificate thereof

shall be given to the applicant or his agent. This proceeding shall afford protection to the applicant in the use of his patent for six months. (§ 9.)

89. PREVIOUS PATENTS NOT INVALIDATED BY SUBSEQUENT PROTECTION OBTAINED BY FRAUD.—Letters patent granted to the first inventor shall not be invalidated by reason of provisional or other protection obtained in fraud by any other person. (§ 10.)

90. COMPLETE SPECIFICATION TO BE ADVERTISED IN GAZETTE.—Every invention protected by the deposit of a complete specification shall be forthwith advertised in the London *Gazette*, the advertisement setting forth the name and address of the petitioner, the title of the invention, the date of the application, and that a complete specification has been deposited. (1st Set of Rules, Oct. 1, 1852.)

91. COMPLETE SPECIFICATION STAMP £5.—The stamp duty on a complete specification is £5. (Schedule of Act.)

92. AFTER PROTECTION OBTAINED APPLICANT MAY GIVE NOTICE TO PROCEED; HOW APPLICATION MAY BE OPPOSED. The applicant, after obtaining a provisional protection or depositing a complete specification, may give notice to the Commissioners of his intention to proceed with his application for letters patent, which notice the Commissioners shall advertise. Any person having an interest in opposing the grant of such letters patent may do so in writing, at such time and place, and according to such regulations, as the Commissioners may appoint.

93. NOTICE TO PROCEED TO BE ADVERTISED IN GAZETTE.—When, after provisional protection or the deposit of a complete specification, the petitioner shall give no-

tice in writing, at the office, of his intention to proceed with his application for letters patent, the same is to be forthwith advertised in the London *Gazette*, with the name and address of the petitioner, and the title of his invention.

94. OPPOSITION MUST BE IN WRITING WITHIN TWENTY-ONE DAYS.—Any person may, within twenty-one days thereafter, leave particulars in writing, at the office, of objections to the application.

95. APPLICATIONS FOR OR AGAINST SEALING TO BE BY NOTICE IN WRITING LEFT AT OFFICE.—Every application to the Lord Chancellor against or in relation to the sealing of letters patent shall be by notice, and such notice shall be left at the Commissioners' office, and shall contain particulars in writing of the objections to the sealing of such letters patent. (Chancellor's Order, Oct. 15, 1852.)

96. NOTICE TO PROCEED FEE £5.—The fee on giving notice to proceed is £5. (Schedule of Act.)

97. OBJECTIONS TO BE REFERRED TO LAW OFFICER.—The time for making objection having expired, the provisional or complete specification, with the particulars of the objections, (if any,) shall be referred to the law officer to whom the original application had been referred.

98. LAW OFFICER TO DECREE COST AND BY WHOM PAID. The law officer, in case of objection, is to order the costs incurred thereby to be paid by such person as he shall fix, and has power to enforce payment. (§§ 13, 14.)

99. LAW OFFICER MAY THEN ISSUE WARRANT FOR SEALING PATENT.—After such hearing, the law officer may issue a warrant, sealed with the Commissioners' seal, for sealing the letters patent, setting forth their

tenor and effect, and directing the insertion of such restrictions and conditions as he may deem proper pursuant to the act. (§ 15.)

100. PROVISION INSERTED THAT COMPLETE SPECIFICATION SHALL BE FILED WITHIN SIX MONTHS.—A provision is to be inserted in all letters patent, in respect whereof a provisional and not a complete specification shall be left on the application for the same, requiring the specification to be filed within six months from the date of application. (2d Set of Rules, Oct. 15, 1852.)

101. PATENT FEE £5, AND STAMP £5.—The fee for the law officer's warrant is £5, and the stamp on letters patent is also £5. (Schedule of Act.)

102. LETTERS PATENT VOID IF BEFORE EXPIRY OF THREE YEARS £50 BE NOT PAID, AND IF BEFORE EXPIRY OF SEVEN YEARS £100 BE NOT PAID.—Letters patent thus granted shall be subject to the condition of becoming void, unless before the expiration of three years a further fee of £40 and a stamp duty of £10 (in all £50) be paid, and unless before the expiration of seven years a further fee of £80 and stamp duty of £20 (in all £100) be paid. Memoranda of such payments shall be indorsed on the warrant for the letters patent, and a certificate of the same given, and also indorsed on the letters patent.

103. ISSUE OF LETTERS PATENT, THEIR EXTENT AND LIMIT.—The Commissioners, when required by the applicant, shall then cause letters patent to be prepared according to the warrant, which shall be sealed with the great seal of the United Kingdom. Such letters patent shall extend to the whole of England, Scotland, and Ireland, to the Channel Islands, and to the Isle of Man. Should the warrant so direct, the letters patent may also

apply to any colonies or plantations abroad which may be specified. But they will have no authority in any colonies where the law in force in such colonies would render them invalid. A transcript of the letters patent is to be transmitted to the director of chancery in Scotland, which transcript is to be received in evidence in all Scottish courts of law. (§ 18.)

104. MUST BE ISSUED WITHIN THREE MONTHS FROM WARRANT, AND DURING PROVISIONAL PROTECTION, UNLESS DELAYED BY CAVEAT.—Patents cannot be issued unless applied for within three months from the date of the warrant, and during the six months of provisional protection or complete specification, unless delayed by a caveat, or application to the Lord Chancellor against sealing the letters patent. In such case they may be sealed at such time as the Lord Chancellor may direct. (See Instruction 41, §§ 19, 20.)

105. BUT LORD CHANCELLOR MAY ALLOW MONTH'S LIMIT IF DELAY BE PURELY ACCIDENTAL.—But by the sixth clause of the act of the 16 and 17 Vict., ch. 115, the Lord Chancellor may seal letters patent after the expiration of provisional protection, provided the delay in such sealing has arisen from accident, and not from the neglect or willful default of the applicant, the sealing to be dated as of any day before the expiring of provisional protection, and in like manner he may extend the time for filing the specification; such extension, however, is not to exceed one month.

106. IN CASE OF DEATH PATENT GRANTED TO REPRESENTATIVES WITHIN THREE MONTHS.—In case of the death of the applicant during the period of protection, letters patent may be granted to the personal representatives

during such period, or within three months of the death of the applicant. (§ 21.)

107. IF LOST, NEW PATENT MAY ISSUE ACCORDING TO COMMISSIONERS' REGULATIONS.—In case letters patent be lost or destroyed, others of like effect may be issued, subject to such regulations as the Commissioners may make. (§ 22.)

108. DATE OF LETTERS PATENT.—Letters patent are to be dated as of the day of the application for the same, and if bearing date prior to the day of actual sealing, are to be equally valid. (§§ 23, 24.)

109. PATENTS FOR FOREIGN INVENTIONS EXPIRE WITH ORIGINAL FOREIGN PATENT.—Patents for foreign inventions, previously patented abroad, shall only continue in force in the United Kingdom as long as they shall be valid in the foreign country where the patent is already obtained, and where more than one patent is taken out abroad, the termination of the British patent shall take place when the first of such foreign patents shall expire. (§ 25.)

110. PATENTS NOT TO PREVENT FOREIGN SHIPS USING THE INVENTION.—Letters patent granted under this act shall not prevent the use of the invention thereby secured on board of foreign ships resorting to British ports, except when the government to which such ships belong shall forbid the use by British ships of foreign patented inventions. (§ 26.)

111. SPECIFICATIONS TO BE FILED WITH COPY OF DRAWINGS.—Specifications are to be filed at the office with an extra copy of any drawings. (§§ 27, 28.) But by the 16 and 17 Vict., ch. 115, a true copy of every specification and complete specification, with the drawings

accompanying them, are to be left at the office on filing such specification or complete specification.

112. SIZE OF SPECIFICATIONS.—All specifications, in pursuance of the conditions of letters patent, and all complete specifications accompanying petitions for the grant of letters patent, shall be respectively written bookwise upon a sheet or sheets of parchment, each of the size of twenty-one and a half inches long by fourteen and three-quarter inches broad. The same may be written on both sides of the sheet, but a margin must be left of one and a half inch on every side of each sheet.

113. SIZE OF DRAWINGS AND SCALE.—The drawings accompanying such specifications shall be on a sheet or sheets of parchment, each twenty-one and a half inches long by fourteen and three-quarter inches broad, or twenty-one inches broad by twenty-nine and a half inches long, with a margin of one and a half inch on every side of each sheet.

[It is recommended to applicants and patentees to make their elevation drawings according to the scale of one inch to a foot. Lord Chancellor's order, October 1, 1852.]

114. EXTRA COPY OF SPECIFICATION TO BE LEFT WITH ORIGINAL; SIZE, &c.—An extra copy of the provisional specification or complete specification is to be left at the office with the original. It is to be written on sheets of brief or foolscap paper, briefwise, and on one side only. The extra copy of drawings must be according to the directions given above. (See Instruction 36.) (3d Set of Rules, Dec. 12, 1853.)

115. DOCUMENTS TO BE LEGIBLY SIGNED.—All specifica-

tions, copies of specifications, provisional specifications, petitions, notices, and other documents left at the office of the Commissioners, and the signatures of petitioners or agents, must be written in a large and legible hand. (*Ib.*)

116. NOTICE TO PROCEED MUST BE GIVEN EIGHT WEEKS, AND APPLICATION FOR WARRANT TWELVE CLEAR DAYS BEFORE END OF PROVISIONAL PROTECTION.—The notice of the applicant to proceed for letters patent must be left at the office eight weeks at least before the expiration of the provisional protection, and the application for the warrant of the law officer and for the letters patent must be made at the office twelve clear days at least before the expiration of the provisional protection. But the Lord Chancellor reserves to himself the power to grant a further extension of time under the special circumstances provided for by the 6th § of the 16 and 17 Vict., ch. 115. (See Instruction 29, *ib.*)

117. PROVISIONAL SPECIFICATIONS, AFTER SIX MONTHS, AND ALL OTHER DOCUMENTS OPEN FOR PUBLIC INSPECTION. True copies of provisional specifications, after the expiration of six months, and of all other specifications, disclaimers, and memoranda of alterations, are to be open to public inspection at the offices in London, Edinburgh, and Dublin.

118. DOCUMENTS TO BE PRINTED AND SOLD AND INDEXES OPEN FOR PUBLIC INSPECTION.—Specifications, disclaimers, and memoranda of alterations are to be printed and sold at such prices as the Commissioners shall direct. [This price is fixed by the Commissioners' rules at twopence for every ninety words.] Indexes of all patents and documents relating thereto are also to be prepared,

and to be open for public inspection and for sale, and printed copies of patents and other documents are to be received as evidence in courts of law. (§§ 30, 32, 33.)

119. PRINTED OR MANUSCRIPT COPIES, &C., WITH COMMISSIONERS' SEAL, AND DOCUMENTS RECORDED AND FILED, EVIDENCE IN COURTS OF LAW.—But by the 4th § of the 16 and 17 Vict., ch. 115, it is declared that printed or manuscript copies, or extracts certified and sealed with the seal of the Commissioners, specifications, disclaimers, and all other documents recorded and filed at the office, are to be received as evidence in all the courts of the United Kingdom, and other places to which the patent shall extend, without the production of the originals.

120. CHRONOLOGICAL REGISTER OF DOCUMENTS TO BE KEPT, INCLUDING LICENSES; COPY OF LICENSE MAY BE HAD, SUCH COPY TO BE EVIDENCE.—A chronological register of patents and other documents shall be kept and be open to public inspection, and also a register of proprietors, to include the assignment of any patent or share thereof, any license under letters patent, with the district to which such license relates, and any other matter affecting the proprietorship of letters patent; and a copy of such entry, properly certified, shall be given to any applicant on payment of a fee, the copy to be evidence. Until such entry shall have been made, the grantee of the patent is to be considered the sole proprietor. Copies of the registers are to be kept at Edinburgh and Dublin. (§§ 34, 35.)

121. ANY NUMBER OF PERSONS MAY BE INTERESTED IN A PATENT.—A larger number than twelve may have a legal interest in a patent. (§ 36.)

122. FALSIFICATION OF REGISTER A MISDEMEANOR.—

Falsification of the register of proprietors is a misdemeanor. (§ 37.)

123. ENTRIES IN REGISTER MAY BE EXPUNGED BY JUDGE'S ORDER.—Entries in the registry of proprietors may be expunged by application to Master of the Rolls, or any common law court. The costs of such application to be paid as the judge shall decree. (§ 38.)

124. DISCLAIMERS.—The provisions of the 5 and 6 Wm. IV, ch. 83, and 7 and 8 Vict., ch. 69, relating to disclaimers and memoranda of alterations in letters patent and specifications, to apply to this act, except as hereafter provided. By the common law, letters patent became wholly void for any partial defect; for instance, the want of novelty in a very small part. The act of 5 and 6 Wm. IV, ch. 83, allows a patentee to put in a disclaimer of any part of either the title or specification, stating the reason for such disclaimer, or enter a memorandum of alteration; but any other person may enter a caveat *against such disclaimer or memorandum of alteration*, the caveat giving the objector a right to be heard in opposition to the disclaimer or alteration. In case of no opposition, or of the disallowance of any caveat, the disclaimer or memorandum of alteration may be filed and enrolled, and be deemed part of the letters patent and specification. (§ 39.) But the disclaimer or alteration is not to affect any action pending at the time, and the law officer to whom the case shall be referred may require the party applying to advertise such disclaimer or alteration. (*Ib.*) The 7 and 8 Vict. allows a patentee the same faculty of disclaimer or alteration in concert with any party to whom he may have wholly or in part *transferred a property in his patent.* (*Ib.*)

125. CONFIRMATION AND PROLONGATION OF A PATENT. The provisions of the 5 and 6 Wm. IV, ch. 83, and the 2 and 3 Vict., ch. 67, and the 7 and 8 Vict., ch. 69, as to confirmation and prolongation of patents, are to apply to patents under this act. The new letters patent are to be available only for such places as the original patent extended to, and are to bear date on the day after the expiration of the term of the original letters patent. (§ 40.) The fourth section of the act of William enacts, that any patentee may advertise three times in the *London Gazette*, and in three London papers, and three times in some country paper, of or near the town where he may reside or carry on his manufacture, (or in some paper published in the county where he carries on his manufacture or lives, in case there should be no paper in the town,) his intention to petition the Privy Council for a prolongation of his patent, and that any other person may enter a caveat at the council's office. Thereupon the case may be heard before the judicial committee of the Privy Council, and should the report of the committee be in favor of the patentee, the patent may be prolonged for seven years. The second section of the 2 and 3 Vict., ch. 67, allows a patentee to obtain an extension of his patent, though the application for such extension may not have been prosecuted with effect before the expiration thereof. But the petition must be presented six calendar months at least before the expiration of the original patent. The second section of the 7 and 8 Vict., ch. 69, extends the term for which a patent may be prolonged to fourteen years.

126. INFRINGEMENT.—In actions for infringement of patents the plaintiff is to deliver with his declaration the

particulars of the breaches complained of, and the defendant shall also deliver with his pleas particulars of any objection on which he means to rely, and at the trial no evidence shall be allowed not contained in such particulars. Similar particulars are obligatory on any prosecutor seeking to repeal the patent. The prosecutor must also particularize the place or places where, and the manner in which, the invention is alleged to have been used prior to the date of the letters patent. But the judge may allow the plaintiff, defendant, or prosecutor to amend his particulars. The defendant, in any suit for repealing his patent, has a right to begin and give evidence of his case, and be entitled to reply. (§ 41.)

127. JUDGE'S ORDER IN CASE OF INFRINGEMENT.—The judge of any court where an action may be brought for infringement of patent to make order for injunction, inspection, or account, and give such directions respecting the action, &c., as the court or judge may see fit. (§ 42.)

128. TAXING COSTS IN CASE OF INFRINGEMENT.—In taxing costs in actions for infringement regard is to be had to the particulars delivered in such actions, and costs are only to be allowed on such particulars as the judge may certify to. Other enactments are also made respecting taxed costs. (§ 43.)

129. SCHEDULES OF FEES AND STAMP DUTIES.—Fees and stamp duties are to be paid according to schedule annexed to the act. The stamp duties are to be under the management of the Commissioners of Inland Revenue, and the fees to be paid into the Exchequer, and form part of the consolidated fund. (§§ 44, 45, 46.)

SCHEDULE TO WHICH THE ACT REFERS, CONSOLIDATED.

	£	s.	d.
On leaving the petition for grant of letters patent.....	5	0	0
On notice of intention to proceed with the application.....	5	0	0
On warrant of law officer for letters patent.....	5	0	0
On sealing of letters patent.....	5	0	0
On filing specifications.....	5	0	0
At or before expiration of the third year.....	50	0	0
At or before expiration of the seventh year.....	100	0	0
On leaving notice of objections.....	2	0	0
Every search and inspection.....	0	1	0
Entry of assignment or license.....	0	5	9
Certificate of assignment or license.....	0	0	5
Filing application for disclaimer.....	5	0	0
Caveat against disclaimer.....	2	0	0

The fees to be paid to the law officers and to their clerks shall be—

By a person opposing a grant of letters patent:

	£	s.	d.
To the law officer.....	2	12	6
To his clerk.....	0	12	6
To his clerk for summons.....	0	5	0
	£3	10	0

By the petitioner on the hearing of the case of opposition:

	£	s.	d.
To the law officer.....	2	12	6
To his clerk.....	0	12	6
To his clerk for summons.....	0	5	0
	£3	10	0

By the petitioner for the hearing, previous to the fiat of the law officer allowing a disclaimer or memorandum of alteration in letters patent or specification:

	£	s.	d
To the law officer	2	12	6
To his clerk	0	12	6
	£3	5	0

By the person opposing the allowance of such disclaimer or memorandum of alteration on the hearing of the case of opposition.

	£	s.	d.
To the law officer	2	12	6
To his clerk	0	12	6
	£3	5	0

By the petitioner for the fiat of the law officer allowing a disclaimer or memorandum of alteration, or letters patent and specification.

	£	s.	d.
To the law officer	3	3	0
To his clerk	0	12	6
	£3	15	6

NOTE.—The following is an abstract of the comparative cost of patents in the principal foreign States in British currency:

France, £4 per annum for fourteen years.

Great Britain, (provisional protection,) £5.
Sealed, £25.
At the end of three years, £50 additional.
At end of seven years, £100 additional.

Belgium, 8s. first year, and increasing progressively for twenty years up to £8 for last year.

Austria, £10 for first five years.
£20 for second five years.
£40 for third five years.

Italy, 8*s*. 4*d*. per year, paid at once.
£1 12*s*. per annum first three years.
£2 12*s*. per annum second three years.
£3 12*s*. per annum third three years.
£4 12*s*. per annum fourth three years.
£5 12*s*. per annum fifth three years.
Saxony, £4 10*s*. for first five years.
£8 for second five years.
Sweden, fees not fixed, and expenses of advertising.
Victoria, (Australia,) £7 4*s*. 6*d*. for first three years.
Prussia, £20 and upwards from six months to fifteen years.
Bavaria, £2 for first year, increasing by degrees annually to £23 for fifteen years.
Netherlands, £12 10*s*. for five years.
From £25 to £33 for ten years.
From £50 to £62 for fifteen years.
Russia, £14 10*s*. for three years.
£24 10*s*. for five years.
£72 10*s*. for ten years.

VIII. Forms and Proceedings to obtain a Patent.

SEC.
130. Form of petition.
131. How to be written, and stamp.
132. Declaration to accompany petition.
133. Petition and declaration, accompanied by specification.
134. Reference indorsed on petition.
135. Form provisional specification.
136. Form of complete specification.
137. Reference to law officer.
138. Notice to proceed to be made two months before end of provisional term.
139. Form of warrant.
140. Form of letters patent.
141. The specification.

130. FORM OF PETITION FOR LETTERS PATENT.—

No. —.

To the Queen's Most Excellent Majesty

The humble petition of , of , in the county of , showeth—

That your petitioner is in possession of an invention for [*here insert the*

title of the invention,] which invention he believes will be of great public utility; that he is the first and true inventor thereof, [*if the invention be a communication from abroad, here insert the words,* "within the realm,"] and that the same is not in use [*if from abroad, insert the word* "therein"] by any other person or persons, to the best of his knowledge and belief. *Your petitioner therefore humbly prays that your Majesty will be pleased* to grant unto him, his executors, administrators, and assigns, your royal letters patent, for the United Kingdom of Great Britain and Ireland, the Channel Islands, and the Isle of Man, for the term of fourteen years, pursuant to the statutes in that case made and provided.

And your petitioner will ever pray.

131. How to be Written, and Stamp.—This petition must be written distinctly, or printed, on a £5 stamp, specially provided for the purpose by the Stamp Office, and care must be taken to conform exactly to the instructions given in the act, respecting the dimensions, payments, and other details.

132. Declaration to Accompany Petition.—

No. —.

I, , of , in the county of , do solemnly and sincerely declare, that I am in possession of an invention for, &c., [*the title as in the petition,*] which invention I believe will be of great public utility; that I am the true and first inventor thereof; and that the same is not in use by any other person or persons, to the best of my knowledge and belief, [*where a complete specification is to be filed with the petition and declaration, insert these words,* "and that the instrument in writing under my hand and seal, hereunto annexed, particularly describes and ascertains the nature of said invention, and the manner in which the same is performed;"] and I make this declaration conscientiously, believing the same to be true; and by virtue of the provisions of an act made and passed in the session of Parliament, held in the fifth and sixth years of the reign of his late Majesty King William the Fourth, intituled "An act to repeal an act of the present session of Parliament, intituled 'An act for the more effectual abolition of oaths and affirmations taken and made in various departments of the State, and to substitute declarations in lieu thereof, and for the more entire suppression of voluntary and extra-judicial oaths and affidavits,' and to make other provisions for the abolition of unnecessary oaths."

A. B.

Declared at , this day of , A. D. , before me, ——— ———,

A Commissioner to Administer Oaths in Chancery, or Justice of the Peace.

133. PETITION AND DECLARATION MUST BE ACCOMPANIED BY SPECIFICATION.—The petition and declaration must be accompanied by either a provisional specification or a complete specification, at the option of the inventor. A provisional specification need only give the general principle of the invention, but it must be stated with sufficient distinctness to enable the law officer to whom it is referred to judge of the nature of the improvements discovered, and of the manner in which they are to be carried into effect. The inventor will then have an interval of six months for maturing his invention, and may introduce into his complete specification any improvements or development not inconsistent with the title, or with the principle enounced in the provisional specification.

134. REFERENCE TO BE INDORSED ON THE PETITION.—The following is to be indorsed on the petition:

"Her Majesty is pleased to refer this petition to [*name of law officer,*] to consider what may be properly done therein."

135. FORM OF PROVISIONAL SPECIFICATION.—

No.—.

I, , do hereby declare the nature of the said invention for [*insert title as in petition*] to be as follows [*here insert description*]:

Dated this day of , A. D. .

[*To be signed by applicant or his agent.*]

[It will be for the inventor to judge whether it will be most to his interest to content himself with a provisional specification or proceed at once to a complete specification; by following the former course he will have abundant leisure to perfect his discovery; by adopting the latter he will be able the sooner to bring it into commercial

operation, a point worthy of consideration, since the six months of provisional protection form part of the term for which the patent is granted.]

136. Form of Complete Specification.—

To all to whom these presents shall come:

I, , of , send greeting:

Whereas I am in possession of an invention for (*here insert title*), and have petitioned Her Majesty to grant unto me, my executors, administrators, and assigns, her royal letters patent for the same, and have made solemn declaration that I really believe myself to be the first and true inventor thereof: *Now*, know ye that I, the said , do hereby *declare that the following complete specification, under my hand and seal*, fully describes the nature of my said invention and the manner in which the same is to be performed (that is to say): [*Here insert description.*]

Dated this day of , A. D. .

[*To be signed by applicant or his agent.*]

[The drawing up of the complete specification is an operation which requires the utmost care, skill, and attention on the part of the person undertaking so delicate a duty, for the validity of the patent will depend on this document being clear, explicit, and circumstantial. Few inventors will venture to assume a task which is calculated to try the capacity and experience of the most able professional man. "In the specification the invention must be accurately ascertained and particularly described; it must be set forth in the most minute detail. The disclosure of the secret is considered as the price which the patentee pays for this limited monopoly, and therefore it ought to be full and correct, (for the benefits thus secured to him are great and certain,) in order that the subject of his patent may, at its expiration, be well known, and that the public may reap from it the same advantages as have accrued to him." (Godson on Patents, ch. iv.)

In the case of mechanical inventions drawings are almost always necessary, but they are merely intended to illustrate the description, so as to make it more clearly understood; but the law requires that the specification itself should be so explicit, that any one acquainted with the subject should be able to carry out the invention without any other aid. Want of sufficient exactness in this respect would therefore be a ground for invalidating a patent.]

137. REFERENCE TO LAW OFFICER, (EITHER ATTORNEY OR SOLICITOR GENERAL FOR ENGLAND.)—Having complied with the requirements of the act in all these respects, the application is then referred to one of the law officers, (practically either the Attorney or Solicitor General for England,) and, if he is satisfied with the accuracy and propriety of the description. he grants a certificate of protection for six months, which is generally published in the *London Gazette* on the Friday after.

138. NOTICE TO PROCEED TO BE ON £5 STAMP, AND MADE TWO MONTHS BEFORE END OF PROVISIONAL PROTECTION.—The next step is the notice to proceed, which must be on a £5 stamp, and be deposited at the office at least two months before the expiration of the six months' protection. This is usually published in the ensuing Tuesday's *Gazette*, accompanied by a notice, "that all parties having an interest in opposing such application are at liberty to leave particulars in writing of their objections to such application at the office of the Commissioners within twenty-one days after the date of the *Gazette* in which the notice is issued." Should no opposition appear within this period, application may be made for the

warrant for letters patent. This must be done at least twelve days before the protection expires. The warrant will be issued in due course.

139. FORM OF WARRANT.—

In humble obedience to Her Majesty's command, referring to me the petition of , of , to consider what may be properly done therein, I do hereby certify as follows: That the said petition sets forth that the petitioner [*here follow the allegations of the petition*], and the petitioner prays [*prayer of the petitioner*]:

That in support of the allegations contained in the said petition the declaration of the petitioner has been laid before me, whereby he solemnly declares that [*here follow the allegations of the declaration*]:

That there has also been laid before me [a provisional specification, signed , and also a certificate ,] or [a complete specification, and a certificate of the filing thereof], whereby it appears that the said invention was provisionally protected [or protected] from the day of , A. D. , in pursuance of the statute.

That it appears that the said application was duly advertised.

Upon consideration of all the matters aforesaid, and as it is entirely at the hazard of the said petitioner whether the said invention is new or will have the desired success, and as it may be reasonable for Her Majesty to encourage all arts and inventions which may be for the public good, I am of opinion that Her Majesty may grant her royal letters patent unto the petitioner, his executors, administrators, and assigns, for his said invention, within the United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, [*colonies to be mentioned, if any,*] for the term of fourteen years, according to the statute in that case made and provided, if Her Majesty shall be graciously pleased so to do, to the tenor and effect following: [*See next form.*]

Given under my hand this day of , A. D. .

140. FORM OF LETTERS PATENT.—

Victoria, by the grace of God of the United Kingdom of Great Britain and Ireland Queen, Defender of the Faith:

To all to whom these presents shall come, greeting:

Whereas hath by his petition humbly represented unto us that he is in possession of an invention for , which the petitioner conceives will be of great public utility; that he is the true and first inventor thereof; and that the same is not in use by any other person or

persons, to the best of his knowledge and belief. The petitioner therefore most humbly prayed that we would be graciously pleased to grant unto him, his executors, administrators, and assigns, our royal letters patent for the sole use, benefit, and advantage of his said invention, within our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, [*colonies to be mentioned, if any,*] for the term of fourteen years, pursuant to the statutes in that case made and provided:

[And whereas the said hath particularly described and ascertained the nature of the said invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and has caused the same to be duly filed in]:

And we, being willing to give encouragement to all arts and inventions which may be for the public good, are graciously pleased to condescend to the petitioner's request: Know ye, therefore, that we, of our especial grace, certain knowledge, and mere motion, have given and granted, and by these presents, for us, our heirs and successors, do give and grant unto the said , his executors, administrators, and assigns, our especial license, full power, sole privilege and authority, that he, the said , his executors, administrators, and assigns, and every of them, by himself and themselves, or by his and their deputy or deputies, servants or agents, or such others as he, the said , his executors, administrators, or assigns, shall at any time agree with, and no others, from time to time, and at all times hereafter during the term of years herein expressed, shall and lawfully may make, use, exercise, and vend his said invention within our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, in such manner as to him, the said , his executors, administrators, and assigns, or any of them, shall in his or their discretion seem meet; and that he, the said , his executors, administrators, and assigns, shall and lawfully may have and enjoy the whole profit, benefit, commodity, and advantage, from time to time coming, growing, accruing, and arising by reason of the said invention, for and during the term of years herein mentioned; to have, hold, exercise, and enjoy the said licenses, powers, privileges, and advantages, hereinbefore granted or mentioned to be granted, unto the said , his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years from the day of , A. D. , next and immediately ensuing, according to the statute in such case made and provided; and to the end that he, the said , his executors, administrators, and assigns, and every of them, may have and enjoy the full benefit and the sole use and exercise of the said invention, according to our gracious inten-

tion hereinbefore declared, we do by these presents, for us, our heirs and successors, require and strictly command all and every person and persons, bodies politic and corporate, and all other our subjects whatsoever, of what estate, quality, degree, name, or condition soever they be, within our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, [*colonies to be mentioned, if any*] that neither they nor any of them, at any time during the continuance of the said term of fourteen years hereby granted, either directly or indirectly, do make, use, or put in practice the said invention, or any part of the same, so attained unto by the said as aforesaid, nor in anywise counterfeit, imitate, or resemble the same, nor shall make, nor cause to be made, any addition thereunto or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, deviser or devisers thereof, without the consent, license, or agreement of the said , his executors, administrators, or assigns, in writing, under his or their hands and seals, first had and obtained in that behalf, upon such pains and penalties as can and may be justly inflicted on such offenders for their contempt of this our royal command, and further to be answerable to the said , his executors, administrators, and assigns, according to law, for his and their damages thereby occasioned.

And, moreover, we do by these presents, for us, our heirs and successors, will and command all and singular the justices of the peace, mayors, sheriffs, bailiffs, constables, headboroughs, and all other officers and ministers whatsoever, of us, our heirs and successors, for the time being, that they or any of them do not, nor shall at any time during the said term hereby granted, in anywise molest, trouble, or hinder the said , his executors, administrators, or assigns, or any of them, or his or their deputies, servants, or agents, in or about the due and lawful use or exercise of the aforesaid invention or anything relating thereto: Provided always, and these our letters patent are and shall be upon this condition, that if, at any time during the said term hereby granted, it shall be made to appear to us, our heirs or successors, or any six or more of our or their Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof, or that the said is not the true and first inventor thereof within this realm as aforesaid, these our letters patent shall forthwith cease, determine, and be utterly void, to all intents and purposes, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided also that these our letters patent, or anything herein contained, shall not extend or be construed to extend to

give privilege unto the said ; his executors, administrators, or assigns, or any of them, to use or imitate any invention or work whatsoever which hath heretofore been found out or invented by any other of our subjects whatsoever, and publicly used or exercised, unto whom our like letters patent or privileges have been already granted for the sole use, exercise, and benefit thereof: It being our will and pleasure that the said , his executors, administrators, or assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practice their several inventions, by them invented and found out, according to the true intent and meaning of the same respective letters patent and of these presents: Provided likewise, nevertheless, and these our letters patent are upon this express condition, [that if the said shall not particularly describe and ascertain the nature of his said invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and cause the same to be filed in within calendar months next and immediately after the date of these our letters patent;] [and also if the said instrument in writing, filed as aforesaid, does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed;] and also if the said , his executors, administrators, or assigns, shall not pay or cause to be paid at the office of our Commissioners of Patents for inventions, that is to say, the sum of £50 stamp duty before the expiration of three years from the date hereof, and also £100 stamp duty before the expiration of seven years from the date of these our letters patent, and produce these our letters patent stamped with a proper stamp to these amounts respectively, pursuant to the provisions of the act of the sixteenth year of our reign, chapter 5; and also if the said , his executors, administrators, or assigns, shall not supply, or cause to be supplied, for our service all such articles of the said invention as he or they shall be required to supply by the officers or commissioners administering the department of our service for the use of which the same shall be required, in such manner, at such times, and at and upon such reasonable prices and terms, as shall be settled for that purpose by the said officers or commissioners requiring the same, that then, and in any of the said cases, these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine, and become void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted; and, lastly, we do by

these presents, for us, our heirs and successors, grant unto the said , his executors, administrators, and assigns, that these our letters patent, on the filing thereof, shall be in all and by all things, good, firm, valid, sufficient, and effectual in the law, according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favorable and beneficial sense for the best advantage of the said , his executors, administrators, and assigns, as well in all our courts of record as elsewhere, and by all and singular the officers and ministers whatsoever of us, our heirs and successors, in our United Kingdom of Great Britain and Ireland, the Channel Islands, and the Isle of Man, [*colonies to be mentioned, if any,*] and amongst all and every the subjects of us, our heirs and successors, whatsoever and wheresoever, notwithstanding the not full and certain describing the nature or quality of the said invention, or of the materials thereunto conducting and belonging. In witness whereof we have caused these our letters to be made patent, this day of , A. D. , and to be sealed and bear date as of the said day of , A. D. , in the year of our reign.

141. THE SPECIFICATION.—Should the applicant have preferred in the first instance to file a provisional specification, his next step will be the complete specification.

To all to whom these presents shall come:

I, , of , send greeting:

Whereas Her most Excellent Majesty Queen Victoria, by her royal letters patent, bearing date the day of , A. D. , in the year of her reign, did for herself, her heirs and successors, give and grant unto me, the said , her special license, that I, the said , my executors, administrators, and assigns, or such others as I, the said , my executors, administrators, and assigns, should at any time agree with, and no others, from time to time, and at all times thereafter during the term therein expressed, should, and lawfully might, make, use, exercise, and vend, within the United Kingdom of Great Britain and Ireland, the Channel Islands, and the Isle of Man, [*the colonies to be mentioned if, any,*] an invention for [*insert title as in letters patent*], upon the condition (amongst others) that I, the said , by an instrument in writing under my hand and seal, should particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, and cause the same to be filed in

within calendar months next and immediately after the date of the said royal letters patent: Now, know ye that I, the said , do hereby declare the nature of my said invention, and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement, that is to say: [*Describe the invention.*]

In witness whereof I, the said , have hereunto set my hand and seal, this day of , A. D. .

[*Signed by the applicant.*]

This will complete all the proceedings necessary for obtaining a patent in cases where no opposition is made.

Patentees are reminded that unless before the expiration of the third year a further sum of £50, and before the expiration of the seventh year a further sum of £100, be paid at the Patent Office, the letters patent will become void.

IX. Patent Laws of the Dominion of Canada.

Sec.		Sec.	
142.	Patent Office constituted.	145.	Deputy Commissioner.
143.	Seal.	146.	Report.
144.	Rules and regulations.		

[Note.—The new patent law of the Dominion came in force on the 1st of July, 1869, and abrogated the local provincial laws which previously to that time had been in force in the different provinces. Patents granted under those late laws will, however, still continue in force in the provinces for which they were granted for the unexpired periods they have to run. It will also be seen that, under certain conditions, those local patents may be extended over the entire Dominion.

During the passage of the patent bill through Parlia-

ment strong efforts were made to obtain a more liberal law than the one we now publish—a law which would assimilate with those of other civilized countries, in not demanding residence as a necessary preliminary to the application for a patent, and also in extending the right of a patent to all inventors, irrespective of nationality.*]

142. PATENT OFFICE CONSTITUTED.—There shall be attached to the Department of Agriculture, as a branch thereof, an office to be named the Patent Office; and the Minister of Agriculture for the time being shall be the Commissioner of Patents of invention; and it shall be the duty of the said Commissioner to receive all applications, fees, papers, documents, and models for patents, and to perform such acts and things respecting the granting and issuing of patents for new and useful inventions, discoveries, and improvements as are herein provided for; and he shall have the charge and custody of the books, records, papers, models, machines, and other things belonging to the said office. (§ 1.)

143. SEAL.—The Commissioner shall cause a seal to be made for the purposes of this act, and may cause to be sealed therewith letters patent and other instruments and copies proceeding from the Patent Office; and all courts, judges, and other persons whomsoever

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*Since the publication of the first edition of this work, a law has been passed by the Parliament of Canada, under the provisions of which citizens of the United States and other countries may obtain patents. This law, together with the latest edition of the rules of the Canada Patent Office, for which I am indebted to the courtesy of the Canadian Minister of Agriculture, will be found in the Appendix.

shall take notice of such seal, and receive impressions thereof in evidence, in like manner as impressions of the great seal are received in evidence, and shall also take notice of and receive in evidence, without further proof and without production of the originals, all copies or extracts certified under the seal of the said office to be copies of or extracts from documents deposited in such office. (§ 2.)

144. RULES AND REGULATIONS.—The Commissioner may from time to time, subject to the approval of the Governor in council, make such rules and regulations, and prescribe such forms, as may appear to him necessary and expedient for the purposes of this act, and notice thereof shall be given in the *Canada Gazette;* and all documents executed after the same and accepted by the Commissioner shall be held valid so far as relating to proceedings in the Patent Office. (§ 3.)

145. DEPUTY COMMISSIONER.—The Deputy of the Minister of Agriculture shall be the Deputy Commissioner of Patents of Invention; and the Governor may from time to time appoint such clerks and officers under him as may be necessary for the purpose of this act, and such clerks and officers shall hold office during pleasure. (§ 4.)

146. REPORT.—The Commissioner shall cause a report to be prepared annually and laid before Parliament of the proceedings under this act, and shall from time to time, and at least once in a year, publish in the *Canada Gazette* a list of patents granted, and may, with the approval of the Governor in council, cause such specifications and drawings as may be deemed of interest, or essential parts thereof, to be printed from time to time for distribution or sale. (§ 5.)

X. Who may Obtain Patents.

SEC.
147. Who may obtain a patent.
148. An original inventor, having foreign patent, must apply within six months.
149. Right of assignment.
SEC.
150. A resident may obtain, but not vend a patent.
151. Joint applications to be made by joint inventors, and patents issue accordingly.

147. WHO MAY OBTAIN A PATENT.—Any person having been a resident of Canada for at least one year next before his application, and having invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used by others before his invention or discovery thereof, or not being at the time of his application for a patent in public use or on sale in any of the provinces of the Dominion, with the consent or allowance of the inventor or discoverer thereof, may, on a petition to that effect presented to the Commissioner and on compliance with the other requirements of this act, obtain a patent, granting to such person an exclusive property therein; and the said patent shall be under the seal of the Patent Office and the signature of the Commissioner, or the signature of another member of the Privy Council, and shall be good and valid to the grantee, his heirs, assigns, or other legal representatives, for the period mentioned in such patent; but no patent shall issue for an invention or discovery having an illicit object in view, nor for any mere scientific principle or abstract theorem. (§ 6.)

148. AN ORIGINAL INVENTOR, HAVING FOREIGN PATENT, MUST APPLY WITHIN SIX MONTHS.—An original and true inventor or discoverer shall not be deprived of the right to a patent for his invention or discovery by reason of his having, previously to his application, taken out a patent therefor in any other country, at any time within six months next preceding the filing of his specification and drawing, as required by this act. (§ 7.)

149. RIGHT OF ASSIGNMENT.—The patent may be granted to any person to whom the inventor or discoverer entitled under the sixth section to obtain a patent has assigned or bequeathed the right of obtaining the same and the exclusive property in the invention or discovery in Canada, or, in default of such assignment or bequest, to the executor or administrator of the deceased inventor or discoverer, or other legal representative. (§ 8.)

150. A RESIDENT MAY OBTAIN, BUT NOT VEND A PATENT. Any person, having been a resident of Canada for at least one year next before his application, and who has invented or discovered any improvement on any patented invention or discovery, may obtain a patent for such improvement, but shall not thereby obtain the right of vending or using the original invention or discovery, nor shall the patent for the original invention or discovery confer the right of vending or using the patented improvement. (§ 9.)

151. JOINT APPLICATIONS TO BE MADE BY JOINT INVENTORS AND PATENTS ISSUE ACCORDINGLY.—In cases of joint applications, the patent shall be granted in the names of all the applicants; and in such cases any assignment from one of the said applicants or patentees to the other

shall be registered in the manner of other assignments. (§ 10.)

XI. Conditions and Formalities.

SEC.

152. Oath or affirmation as to invention must be made by applicants.
153. Applicants to elect a domicil in Canada.
154. Nature of petition and specifications.
155. Drawings to be furnished in duplicate, with references.
156. Working model of invention, or samples of ingredients, if a discovery, required.

152. OATH OR AFFIRMATION AS TO INVENTION MUST BE MADE BY APPLICANTS.—Every applicant for a patent, before he can obtain the same, shall make oath, or, when entitled by law to make an affirmation instead of an oath, shall make an affirmation, that he verily believes that he is, or that the person whose assignee or representative he is, is or was the true inventor or discoverer of the invention or discovery for which the patent is solicited, and that he, or the person whose assignee or representative he is, was a resident of Canada for one year next before the application, or, in case of death of the inventor or discoverer, for one year next before such death. Such oath or affirmation may be made before any justice of the peace in Canada; but if the applicant is not at the time in Canada, the oath or affirmation may be made before any minister plenipotentiary, *chargé d'affaires*, consul or consular agent, holding commission under the Government of the United Kingdom, or any judge of the country in which the applicant happens at the time to be. (§ 11.)

153. APPLICANT TO ELECT A DOMICIL IN CANADA.—The

petitioner for a patent shall, for all the purposes of this act, elect his domicil at some known and specified place in Canada, and mention the same in his petition for a patent, and he shall in the same petition state the place or places in Canada at which he, or, if his application be as assignee or representative, the person whose assignee or representative he is, was resident during the year of residence required by this act, and the period of residence at each such place. (§ 12.)

154. NATURE OF PETITION AND SPECIFICATIONS.—The applicant shall in his petition for a patent insert the title or name of his invention or discovery, its object, and a short description of the same, and shall distinctly allege all the facts which are necessary under this act to entitle him to a patent therefor, and shall, with the petition, send in a written specification, in duplicate, of his invention or discovery, describing the same in such full, clear, and exact terms as to distinguish it from all contrivances or processes for similar purposes. (§ 13.)

155. DRAWINGS TO BE FURNISHED IN DUPLICATE, WITH REFERENCES.—The specification shall correctly and fully describe the mode or modes of operating contemplated by the applicant, and shall state clearly and distinctly the contrivances and things which he claims as new, and for the use of which he claims an exclusive property and privilege; it shall bear the name of the place where it is made, the date, and be signed by the applicant and two witnesses. In the case of a machine, the specification shall fully explain the principle and the several modes in which it is intended to apply and work out the same; in the case of a machine, or in any other case where the invention or discovery admits of illustration by means

of drawings, the applicant shall also with his application send in drawings in duplicate, showing clearly all parts of the invention or discovery, and each drawing shall bear the name of the inventor or discoverer, and shall have written references corresponding with the specification, and a certificate of the applicant that it is the drawing referred to in the specification; but the Commissioner may require any greater number of drawings than those above mentioned, or dispense with any of them, as he may see fit; one duplicate of the specification and of the drawings, if any drawings, shall be annexed to the patent of which it forms an essential part, and the other duplicate shall remain deposited in the Patent Office. (§ 14.)

156. WORKING MODEL OF INVENTION, OR SAMPLES OF INGREDIENTS, IF A DISCOVERY, REQUIRED.—The applicant shall also deliver to the Commissioner, unless specially dispensed from so doing for some good reason, a neat working model of his invention or discovery, on a convenient scale, exhibiting its several parts in due proportion, whenever the invention or discovery admits of such model; and shall deliver to the Commissioner specimens of the ingredients and of the composition of matter sufficient in quantity for the purpose of experiment, whenever the invention is a composition of matter, provided such ingredients and composition are not of an explosive character or otherwise dangerous, in which case they are to be furnished only when specially required by the Commissioner, and then with such precautions as shall be prescribed in the said requisition. (§ 15.)

XII. Contents, Duration, Surrender, Reissue of Patents, and Disclaimers.

SEC.
157. Contents of the patent and powers granted thereby.
158. Duration of patent.
159. Patent to be examined and certified by minister of justice before delivery.
160. New patent in case of error.
161. Patentee may make disclaimer.

157. CONTENTS OF THE PATENT AND POWERS GRANTED THEREBY.—Every patent granted under this act shall recite briefly the substance of the petition on which it is granted, and shall contain the title or name of the invention or discovery and a short description of the same, referring for a fuller detail to the specification, and shall grant to the patentee, his assigns and legal representatives, or in trust, as the case may be, for the period therein mentioned from the granting of the same, the exclusive right, privilege, and liberty of making, constructing, and using, and vending to others to be used, the said invention or discovery, and shall contain a condition that it is nevertheless subject to adjudication before any court of competent jurisdiction. (§ 16.)

158. DURATION OF PATENT.—Patents of invention or discovery issued by the Patent Office shall be valid for a period of five years; but at or before the expiration of the said five years the holder thereof may obtain an extension of the patent for another period of five years, and after those second five years may again obtain further extension for another period of five years; and the instrument delivered by the Patent Office for such extension of time shall be in the form which may be from time to time adopted, and shall be made in duplicate,

one duplicate to remain of record and be duly registered, and the other to be attached, with reference, to the patent, under the seal of the Patent Office and signature of the Commissioner, or any other privy councillor in case of absence of the Commissioner. (§ 17.)

159. PATENT TO BE EXAMINED AND CERTIFIED BY MINISTER OF JUSTICE BEFORE DELIVERY.—Every such patent, and every instrument for granting a further extension of any patent, shall, before it is signed by the Commissioner or any other member of the privy council, and before the seal hereinbefore mentioned is affixed to it, be examined by the Minister of Justice, who, if he finds it conformable to law, shall certify accordingly, and such patent or instrument may then be signed and the seal affixed thereto, and, being duly registered, shall avail to the grantee thereof and be delivered to him. (§ 18.)

160. IN CASE OF ERROR THE COMMISSIONER MAY CAUSE NEW PATENT TO BE ISSUED.—Whenever any patent shall be deemed defective or inoperative by reason of insufficient description or specification, or by reason of the patentee claiming more than he had a right to claim as new, but at the same time it appears that the error arose from inadvertence, accident, or mistake, without any fraudulent or deceptive intention, the Commissioner may, upon the surrender of such patent and the payment of the further fee hereinafter provided, cause a new patent, in accordance with an amended description and specification to be made by such patentee, to be issued to him for the same invention or discovery, for any part or the whole of the then unexpired residue of the five years period for which the original patent was or might have been, as hereinbefore directed, granted. In case of the

death of the original patentee, or of his having assigned the patent, a like right shall vest in his assignee or legal representative: The new patent and the amended description and specification shall have the same effect in law, on the trial of any action thereafter commenced for any cause subsequently accruing, as if the same had been originally filed in such corrected form before the issue of the original patent. (§ 19.)

161. PATENTEE MAY MAKE DISCLAIMER.—Similarly, whenever, by any mistake, accident, or inadvertence, and without any willful intent to defraud or mislead the public, a patentee has made his specification too broad, claiming more than that of which he or the party through whom he claims was the first inventor or discoverer, or has in the specification claimed that he or the party through whom he claims was the first inventor or discoverer of any material or substantial part of the invention or discovery patented, of which he was not the first inventor or discoverer, and had no legal right thereto, the patentee may, on payment of the fee hereinafter provided, make disclaimer of such parts as he shall not claim to hold by virtue of the patent or the assignment thereof; such disclaimer shall be in writing and in duplicate, and attested in the manner hereinbefore prescribed for a patent, one copy to be filed and recorded in the office of the Commissioner, the other copy to be attached to the patent and made a part thereof by reference, and such disclaimer shall thereafter be taken and considered as part of the original specification. Such disclaimer shall not affect any action pending at the time of its being made, except in so far as may relate to the question of unreasonable neglect or delay in mak-

ing it. In case of the death of the original patentee, or of his having assigned the patent, a like right shall vest in his assigns or legal representatives respectively, any of whom may make disclaimer. The patent shall thereafter be deemed good and valid for so much of the invention or discovery as is truly the disclaimant's own and not disclaimed, provided it be a material and substantial part of the invention or discovery, and definitely distinguished from other parts claimed without right; and the disclaimant shall be entitled to maintain a suit for such part accordingly. (§ 20.)

XIII. Assignment and Infringement of Patents.

SEC.
162. Government of Canada may use any patented invention by making reasonable compensation.
163. Patents to be assignable.
164. Penalty for infringement.
165. Prosecution for infringement.
166. Court may discriminate in certain cases.
167. Defense in such cases.

162. GOVERNMENT OF CANADA MAY USE ANY PATENTED INVENTION BY MAKING REASONABLE COMPENSATION.—The Government of Canada may always use any patented invention or discovery, paying to the patentee such sum as the Commissioner may report to be a reasonable compensation for the use thereof. (§ 21.)

163. PATENTS TO BE ASSIGNABLE.—Every patent for an invention or discovery, whensoever issued, shall be assignable in law, either as to the whole interest or as to any part thereof, by any instrument in writing; but such assignment, and also every grant and conveyance of any exclusive right to make and use, and to grant to others

the right to make and use, the invention or discovery patented, within and throughout the Dominion of Canada, or within and throughout any one or more of the Provinces of Ontario, Quebec, Nova Scotia, or New Brunswick, or any part of any of such Provinces or of the Dominion, shall be registered in the office of the Commissioner; and every assignment affecting a patent for invention or discovery shall be deemed null and void against any subsequent assignee, unless such instrument is registered, as hereinbefore prescribed, before the registering of the instrument under which such subsequent assignee may claim. (§ 22.)

164. PENALTY FOR INFRINGEMENT OF PATENT.—Every person who, without the consent in writing of the patentee, makes, constructs, or puts in practice any invention or discovery for which a patent has been obtained under this act, or procures such invention or discovery from any person not authorized to make or use it by the patentee, and uses it, shall be liable to the patentee in an action of damages for so doing; and the judgment shall be enforced, and the damages and costs as may be adjudged shall be recovered, in like manner as in other cases in the court in which the action is brought. (§ 23.)

165. PROSECUTION FOR INFRINGEMENT.—An action for the infringement of a patent may be brought before any court of record having jurisdiction to the amount of damages asked for, and having its sittings within the Province in which the infringement is said to have taken place, and being at the same time, of the courts of such jurisdiction within such Province, the one of which the place of holding is nearest to the place of residence or of business of the defendant, and such court shall decide

the case and determine as to costs. In any action for the infringement of a patent, the court, if sitting, or any judge thereof in chambers if the court be not sitting, may, on the application of the plaintiff or defendant respectively, make such order for an injunction restraining the opposite party from further use, manufacture, or sale of the subject matter of the patent, and for his punishment in the event of disobedience to such order, or for inspection or account, and respecting the same and the proceedings in the action, as the court or judge may see fit; but from such order an appeal shall lie under the same circumstances and to the same court as from other judgments or orders of the court in which the order was made. (§ 24.)

166. COURT MAY DISCRIMINATE IN CERTAIN CASES.—Whenever the plaintiff fails to sustain his action, because his specification and claim embrace more than that of which he was the first inventor or discoverer, and it appears that the defendant used or infringed any part of the invention or discovery justly and truly specified and claimed as new, the court may discriminate, and the judgment may be rendered accordingly. (§ 25.)

167. DEFENSE IN SUCH CASES.—The defendant in any such action may specially plead as matter of defense any fact or default which by this act or by law would render the patent void; and the court shall take cognizance of that special pleading and of the facts connected therewith, and shall decide the case accordingly. (§ 26.)

XIV. Nullity, Impeachment, and Voidance of Patents.

SEC.
168. Patents to be void in certain cases, or only valid for part.
169. Patents to be conditioned on manufacture in Canada within three years; importing the article patented.
SEC.
170. Proceedings for impeachment of patent.
171. Certificate of judgment voiding patent to be entered.
172. Judgment to be subject to appeal.

168. PATENT TO BE VOID IN CERTAIN CASES, OR ONLY VALID FOR PART.—A patent shall be void if any material allegation in the petition or declaration of the applicant be untrue, or if the specification and drawings contain more or less than is necessary for obtaining the end for which they purport to be made, such omission or addition being willfully made for the purpose of misleading; but if it shall appear to the court that such omission or addition is simply an involuntary error, and it is proved that the patentee is entitled to the remainder of his patent *pro tanto*, the court shall render a judgment in accordance with the facts, and determine as to costs, and the patent shall be held valid for such part of the invention described, and two office copies of such judgment shall be furnished to the Patent Office by the patentee, one to be registered and to remain of record in the office, and the other to be attached to the patent and made a part of it by a reference. (§ 27.)

169. PATENTS TO BE CONDITIONED ON MANUFACTURE IN CANADA WITHIN THREE YEARS; IMPORTING THE ARTICLE PATENTED.—Every patent granted under this act shall be subject, and expressed to be subject, to the condition that such patent, and all the rights and privileges thereby

granted, shall cease and determine and the patent shall be null and void at the end of three years from the date thereof, unless the patentee shall, within that period, have commenced, and shall after such commencement carry on in Canada, the construction or manufacture of the invention or discovery patented, in such manner that any person desiring to use it may obtain it, or cause it to be made for him, at a reasonable price, at some manufactory or establishment for making or constructing it in Canada, and that such patent shall be void if, after the expiration of eighteen months from the granting thereof, the patentee or his assignee or assignees, for the whole or a part of his interest in the patent, imports or causes to be imported into Canada the invention or discovery for which the patent is granted. (§ 28.)

170. PROCEEDINGS FOR IMPEACHMENT OF PATENT.—Any person desiring to impeach any patent issued under this act may obtain a sealed and certified copy of the patent, and of the petition, declaration, drawings, and specification thereunto relating; and may have the same filed in the office of the prothonotary or clerk of the superior court for the Province of Quebec, or of the court of queen's bench or common pleas for the Province of Ontario, or of the supreme court in the Province of Nova Scotia, or of the court of queen's bench in the Province of New Brunswick, according to the domicil elected by the patentee as aforesaid, which courts shall adjudicate on the matter and decide as to costs. The patent and documents aforesaid shall then be held as of record in such court, so that a writ of *scire facias* under the seal of the court, grounded upon such record, may issue for the repeal of the patent for legal cause as aforesaid, if upon

proceedings had upon the writ in accordance with the meaning of this act the patent be adjudged to be void. (§ 29.)

171. CERTIFICATE OF JUDGMENT VOIDING PATENT TO BE ENTERED.—A certificate of the judgment voiding any patent shall, at the request of any person or party filing it to be of record in the Patent Office, be entered on the margin of the enrollment of the patent in the office of the Commissioner, and the patent shall thereupon be, and be held to have been, void and of no effect, unless and until the judgment be reversed on appeal, as hereinafter provided. (§ 30.)

172. JUDGMENT TO BE SUBJECT TO APPEAL.—The judgment declaring any patent void shall be subject to appeal to any court of appeal having appellate jurisdiction in other cases over the court by which the same was rendered. (§ 31.)

XV. Patents Issued under Former Laws.

SEC.
173. Existing provincial patents to remain in force.
174. Handing over records of patent offices to Commissioner.

173. EXISTING PROVINCIAL PATENTS TO REMAIN IN FORCE.—All patents issued under any act of the legislature of the late Province of Canada, or of Nova Scotia, or of New Brunswick, and all patents issued for the Provinces of Ontario and Quebec, under the act of the late Province of Canada, to the date of the coming into operation of the present act, shall remain in force for the same term and for the same extent of territory as if the act under which they were issued had not been re-

pealed, but subject to the provisions of this act in so far as applicable to them.

2. And it shall be lawful for the Commissioner, upon the application of the patentee named in any such patent, being the inventor or discoverer of the subject-matter of the patent and a British subject, or a resident in any Province of Canada for upwards of a year, if the subject-matter of the patent had not been known or used, nor with the consent of the patentee on sale in any of the other Provinces of the Dominion, to issue, on payment of the proper fees in that behalf, a patent under this act, extending such provincial patent over the whole of the Dominion, subject to the provisions of the seventeenth section; but no patent so issued shall extend beyond the remainder of the term mentioned in the provincial patent. (§ 32.)

174. HANDING OVER OF RECORDS OF PROVINCIAL PATENT OFFICE TO THE COMMISSIONER.—All the records of the Patent Offices of the late Province of Canada, and of the Provinces of Ontario and Quebec, of Nova Scotia and New Brunswick, shall be handed over by the officers in charge of them to the Commissioner of Patents of invention or discovery, to form part of the records of the Patent Office for the purposes of this act. (§ 33.)

XVI. Tariff of Fees.

SEC.		SEC.	
175–178.	With reference to fees, how and to whom to be paid.	179.	The Commissioner to have the power of returning one half of the Government fee.

175. FEES HOW AND TO WHOM TO BE PAID.—The following fees shall be payable to the Commissioner before

an application for any of the purposes hereinafter mentioned shall be entertained, that is to say:

On petition for a patent for five years	$20 00
On petition for extension from five to ten years	20 00
On petition for extension from ten to fifteen years	20 00
On lodging a caveat	5 00
On asking to register a judgment *pro tanto*	4 00
On asking to register an assignment	2 00
On asking to attack a disclaimer to a patent	4 00
On asking for a copy of patent with specification	4 00
On petition to reissue a patent after surrender and on petition to extend a former patent to the Dominion the fee shall be at the rate of for every unexpired year of duration of such patent.	4 00

On office copies of documents, not above mentioned, the following charges shall be exacted:

For every single or first folio of certified copy	50
For every subsequent hundred words, (fractions from and under fifty being not counted, and over fifty being counted for one hundred)	25

(§ 34.)

176. FEES, &c.—For every copy of drawings the party applying shall pay such sum as the Commissioner considers a fair remuneration for time and labor expended thereon by an officer of the department or person employed to perform such service. (§ 35.)

177. FEES, &c.—The said fees shall be in full of all services performed under this act in any such case by the Commissioner or any person employed in the Patent Office. (§ 36.)

178. FEES, &c.—All fees received under this act shall be paid over to the Receiver General, and form part of the consolidated revenue fund of Canada, except such sums as may be paid for copies of drawings when made by persons not receiving salaries in the Patent Office. (§ 37.)

179. COMMISSIONER HAS POWER TO RETURN ONE HALF OF GOVERNMENT FEE.—No fee shall be made the subject of exemption in favor of any person; and no fee, once paid, shall be returned to the person who paid it, except:

1. When the invention is not susceptible of being patented;

2. When the petition for a patent is withdrawn.

And in every such case the Commissioner may return one half of the fee paid;

And in the case of withdrawal, a fresh application shall be necessary to revive the claim, as if no proceeding had taken place in the matter. (§ 38.)

XVII. Miscellaneous Provisions.

SEC.

180. Applicant may file a caveat.
181. Causes why Commissioner may refuse to grant a patent.
182. Commissioner to notify applicant of rejection.
183. Appeal to Governor in Council.
184. Interfering applications.
185. Documents in Patent Office to be open to inspection of the public, except caveats.
186. Clerical errors.
187. Lost or destroyed patent may be replaced.
188. Use of patented inventions allowed in foreign ships.

SEC.

189. Patent not to affect previous purchaser of invention.
190. Patented articles to be stamped with date of patent.
191. Punishment of parties who stamp an article as patented when such is not the case.
192. Punishment of offenders for making false entry or copy.
193. All acts inconsistent with present act repealed.
194. Title of act: The Patent Act of 1869.
195. Act to commence and take effect July 1, 1869.

180. INTENDING APPLICANT MAY FILE A CAVEAT.—An intending applicant for a patent, who has not yet perfected his invention or discovery and is in fear of being despoiled of his idea, may file in the Patent Office a description of his invention or discovery so far, with or without plans, at his own will; and the Commissioner, on reception of the fee hereinbefore prescribed, shall cause the said document to be preserved in secrecy, with the exception of delivering copies of the same whenever required by the said party or by any judicial tribunal—the secrecy of the document to cease when he obtains a patent for his invention or discovery; and such document shall be called a caveat. Provided always that if application shall be made by any other person for a patent for any invention or discovery with which such caveat may in any respect interfere, it shall be the duty of the Commissioner forthwith to give notice by mail to the person who has filed such caveat, and such person shall within three months after the date of mailing the notice, if he would avail himself of the caveat, file his petition and take the other steps necessary on an application for patent, and if, in the opinion of the Commissioner, the applications are interfering, like proceedings may be had in all respects as are by this act provided in the case of interfering applications. Provided further, that unless the person filing any caveat shall, within four years from the filing thereof, have made application for a patent, the caveat shall be void. (§ 39.)

181. CAUSES WHY COMMISSIONER MAY REFUSE TO GRANT A PATENT.—The Commissioner may object to grant a patent in the following cases:

1. When he is of opinion that the alleged invention or discovery is not patentable in law;

2. When it appears that the invention or discovery is already in the possession of the public with the consent or allowance of the inventor;

3. When it appears that the invention or discovery has been described in a book or other printed publication before the date of the application, or otherwise in the possession of the public;

4. When it appears that the invention or discovery has already been patented, except, however, when the case is one within the seventh section of this act, or one in which the Commissioner has doubts as to whether the patentee or the applicant is the first inventor or discoverer. (§ 40.)

182. COMMISSIONER TO NOTIFY APPLICANT OF REJECTION.—Whenever the Commissioner objects to grant a patent, as aforesaid, he shall notify the applicant to that effect, and shall state the ground or reason therefor with sufficient detail to enable the applicant to answer, if he can, the objection of the Commissioner. (§ 41.)

183. APPEAL TO GOVERNOR IN COUNCIL.—Every applicant who has failed to obtain a patent by reason of the objection of the Commissioner, as aforesaid, may, at any time within six months after notice thereof has been addressed to him or his agent, appeal from the decision of the Commissioner to the Governor in Council. (§ 42.)

184. INTERFERING APPLICATIONS.—In cases of interfering applications for a patent the same shall be submitted to the arbitration of three skilled persons, one of whom shall be chosen by each of the applicants, and the third person shall be chosen by the Commissioner, or by his deputy, or the person appointed to perform the duty

of that office; and the decision or award of such arbitrators, or any two of them, delivered to the Commissioner in writing, and subscribed by them, or any two of them, shall be final as far as respects the granting of the patent.

2. If either of the applicants refuses or fails to choose an arbitrator, when required so to do by the Commissioner, the patent shall issue to the opposite party; and when there are more than two interfering applicants, and the parties applying do not all unite in appointing three arbitrators, the Commissioner or his deputy, or person appointed to perform the duty of that office, may appoint the three arbitrators for the purposes aforesaid. (§ 43.)

185. DOCUMENTS IN PATENT OFFICE TO BE OPEN TO INSPECTION OF THE PUBLIC, EXCEPT CAVEATS.—All specifications, drawings, models, disclaimers, judgments, and other papers, except caveats, shall be open to the inspection of the public at the Patent Office, under such regulations as may be adopted in that behalf. (§ 44.)

186. CLERICAL ERRORS.—Clerical errors happening in the framing or copying of any instrument of the Patent Office shall not be construed as invalidating the same, but when discovered they may be corrected under the authority of the Commissioner. (§ 45.)

187. LOST OR DESTROYED PATENT MAY BE REPLACED.—In case any letters patent shall be destroyed or lost, others of the like tenor, date, and effect may be issued in lieu thereof, on the party paying the fees hereinbefore prescribed for office copies of documents. (§ 46.)

188. USE OF PATENTED INVENTIONS ALLOWED IN FOREIGN SHIPS.—No letters patent shall extend to prevent the use of any invention or discovery in any foreign ship

or vessel, where such invention or discovery is not so used for the manufacture of any goods to be vended within or exported from Canada. (§ 47.)

189. PATENT NOT TO AFFECT PREVIOUS PURCHASER OF INVENTION.—Every person who, before the issuing of a patent, has purchased, constructed, or acquired any invention or discovery, for which a patent has been obtained under this act, shall have the right of using and vending to others the specific art, machine, manufacture, or composition of matter patented, so purchased, constructed, or acquired before the issue of the patent therefor, without being liable to the patentee or his representatives for so doing; but the patent shall not be held invalid as regards other persons by reason of such purchase, construction, or acquisition, or use of the invention or discovery by the person first aforesaid, or by those to whom he may have sold the same, unless the same was purchased, constructed, or acquired, or used for a longer period than one year before the application for a patent therefor. (§ 48.)

190. PATENTED ARTICLES TO BE STAMPED WITH DATE OF PATENT.—Every patentee under this act shall stamp or engrave on each patented article sold, or offered for sale, by him, the year of the date of the patent applying to such article, thus: "Patented 1869," or as the case may be; and any such patentee selling or offering for sale any such patented article not so marked, shall be liable to the punishment of a fine not to exceed $100, and in default of the payment of such fine to imprisonment not to exceed two months. (§ 49.)

191. PUNISHMENT OF PARTIES WHO STAMP AN ARTICLE AS PATENTED WHEN SUCH IS NOT THE CASE.—Whosoever

writes, paints, prints, molds, casts, carves, engraves, stamps, or otherwise marks upon anything made or sold by him, and for the sole making or selling of which he is not the patentee, the name, or any imitation of the name, of any patentee for the sole making or selling of such thing, without the consent of such patentee, or without the consent of the patentee writes, paints, prints, molds, casts, carves, engraves, stamps, or otherwise marks upon anything not purchased from the patentee, the words "patent," "letters patent," "Queen's patent," "patented," or any word or words of like import, with the intent of counterfeiting or imitating the stamp, mark, or device of the patentee, or of deceiving the public and inducing them to believe that the thing in question was made or sold by or with the consent of the patentee, shall be deemed to have committed a misdemeanor, and shall, on conviction, be punished therefor by fine or by imprisonment, or both, in the discretion of the court before which the conviction shall be had; but the fine shall not exceed $200, nor shall the imprisonment exceed three months. (§ 50.)

192. PUNISHMENT OF OFFENDERS FOR MAKING FALSE ENTRY OR COPY.—Any person willfully making or causing to be made any false entry in any register or book, or any false or altered copy of any document relating to the purposes of this act, or who shall produce or tender any such false or altered document, knowing the same to be such, shall be guilty of a misdemeanor, and shall be punished by fine and imprisonment accordingly. (§ 51.)

193. ALL ACTS INCONSISTENT WITH PRESENT ACT REPEALED.—Chapter thirty-four of the Consolidated Statutes of the late Province of Canada, respecting patents

for inventions, chapter one hundred and seventeen of the Revised Statutes of Nova Scotia, (third series,) chapter one hundred and eighteen of the Revised Statutes of New Brunswick, and any act amending any of the said chapters or any other act, are hereby repealed, in so far as they or any of them may be inconsistent with this act, or make any provision in any matter provided for by this act, except only as respects all rights acquired and penalties or liabilities incurred under the said laws, or any of them, before the coming into force of this act. (§ 52.)

194. TITLE OF ACT: THE PATENT ACT OF 1869.—When citing this act it shall be sufficient to call it "The Patent Act of 1869." (§ 53.)

195. ACT TO COMMENCE AND TAKE EFFECT JULY 1, 1869.—This act shall commence and take effect on the first day of July, 1869. (§ 54.)

XVIII. Rules, Regulations, and Forms of the Canadian Patent Office.

SEC.
196. Date of approval.
197. Personal appearance.
198. Applicant responsible.
199. Correspondence.
200. Clerical requirements.
201. Address.
202. Forms.
203. Petition.
204. Joint application.
205. Oath.
206. Specification.
207. Drawings.
208. Extension.
209. Form of patent.
210. Model.
211. Fees.
212. Time for perfecting application.
213. Separate inventions cannot be claimed in one application.
214. Protest.
215. Cases of doubt.
216. Caveat.
217. Intricate cases.
218. General remarks.

196. DATE OF APPROVAL.—The following rules were

approved by the Governor in Council on the 2d of July, 1869, under the patent act of 1869.

197. PERSONAL APPEARANCE.—There is no necessity for any personal appearance at the Patent Office, unless specially called for by order of the Commissioner or the Deputy Commissioner, every transaction being carried on by writing. (Rules of 2d July, 1869.)

198. APPLICANT RESPONSIBLE.—In every case the applicant or depositor of any paper is responsible for the merits of his allegations, and of the validity of the instruments furnished by him or his agent. (*Ib.*)

199. CORRESPONDENCE.—The correspondence is carried on with the applicant, or with the agent who has remitted or transmitted the papers to the office, but with one person only. (*Ib.*)

200. CLERICAL REQUIREMENTS.—All papers to be clearly and neatly written on foolscap paper, and every word of them is to be distinctly legible, in order that no difficulty should be met with in taking cognizance of and in registering and copying them. (*Ib.*)

201. ADDRESS.—All communications are to be addressed in the following words: "To the Commissioner of Patents, Ottawa." (*Ib.*)

202. FORMS.—As regards proceedings not specially provided for in the following forms, any form being conformable to the letter and spirit of the laws will be accepted, and if not so conformable will be returned for correction. (*Ib.*)

203. PETITION.—The petition asking for the granting of a patent of invention shall be made after the following form: (*Ib.*)

To the Commissioner of Patents,

Ottawa:

The petition of [*Christian name or names in full of inventor, inventors, assignee, or other legal representative of inventor*], of the [*city, town, or other locality, as the case may be*], in the Province of [*as the case may be*], [*trade or profession*], showeth: That your petitioner has been a resident of Canada for at least one year next before the present application [*mention to be made of place, and changes of residence*]; that he hath discovered [*or "invented," as the case may be*] a certain new and useful [*art, "machine," "manufacture," or "composition of matter," as the case may be, or certain new and useful "improvements"*], on a certain [*art, "machine," "manufacture," or "composition of matter," as the case may be*], now in ordinary use for [*stating the use or object of the art, &c., as the case may be*], to be called or known as ["*name of invention or improvement*"], and that such his discovery [*or "invention," as the case may be*], was and is not known or used by others before his discovery [*or "invention," as the case may be*] thereof, and was and is not, at the time of this application, in public use or for sale with his consent or allowance as such inventor [*or discoverer, as the case may be*]; and that the oath or affirmation, drawings, descriptions, and specifications thereof, in duplicate, are transmitted herewith, pursuant to the statute in such case made and provided; the said invention being [*insert here a very short description of the invention and of its object*].

Your petitioner, being desirous of obtaining an exclusive property in the said invention or discovery [*as the case may be*], therefore prays that a patent may be granted to your petitioner therefor for the term allowed by law; and, for the purposes of the patent act of 1869, your petitioner elects his domicil in the [*city, town, or locality, as the case may be*], in the county of [*name of county*], in the Province of [*name of Province*].

[*Signature of inventor.*]

[*Place and date.*]

204. JOINT APPLICATION.—In case of joint applications, in cases of applications from assignees, heirs, or other legal representatives, the petition should, otherwise being made after the above given form, be altered, according to the circumstances of the case, to meet the requirements of the statute, particularly of §§ 8, 10, 11, 12. (*Vide supra* pp. 116, 117, 118.)

205. OATH.—The oath to be subscribed by an appli-

cant for a patent of invention shall be made after the following form: (*Ib.*)

Canada, Province of
county of

I, , of , in the county of , in the Province of , make oath and solemnly swear, that I verily believe that I am the inventor [*or discoverer*] of the invention which I call [*name of the invention*], and for which I solicit a patent by my petition to the Commissioner of Patents, dated the [*insert date of petition*], and I further make oath that I have been a resident of Canada for one year next before my application. [*Signature of deponent.*]

Sworn and signed before me this [*day of month and year*], at [*name of place*].

[*Signature of J. P.*],
Justice of the Peace.

The same general form is to be adopted, with such alterations as may be necessitated by circumstances, where the application is made abroad, or by joint inventors, by assignees, heirs, or other legal representatives, in conformity with the patent act, § 11. (*Ib.*)

206. SPECIFICATION.—The specification accompanying a petition for a patent of inventions shall be made in duplicate, and after the following form: (*Ib.*)

To all whom it may concern:

Be it known that I, [*name of inventor or discoverer, as the case may be,*] of [*place of residence and trade or profession; if more than one inventor, add his or their names, place of residence, and trade or profession, and word the specification throughout according to circumstances*], have invented a new and useful [*art, "machine," &c., same as in petition*], and I do hereby declare that the following is a full, clear, and exact description of the construction and operation of the same. [*Reference being had to the annexed drawings, where the nature of the case admits of drawings; describe the several drawings, and refer to the parts by letters. Here describe the principle, and the several modes in which the applicant contemplates the application of that principle or character, by which the invention or discovery may be dis-*

tenor and effect, and directing the insertion of such restrictions and conditions as he may deem proper pursuant to the act. (§ 15.)

100. PROVISION INSERTED THAT COMPLETE SPECIFICATION SHALL BE FILED WITHIN SIX MONTHS.—A provision is to be inserted in all letters patent, in respect whereof a provisional and not a complete specification shall be left on the application for the same, requiring the specification to be filed within six months from the date of application. (2d Set of Rules, Oct. 15, 1852.)

101. PATENT FEE £5, AND STAMP £5.—The fee for the law officer's warrant is £5, and the stamp on letters patent is also £5. (Schedule of Act.)

102. LETTERS PATENT VOID IF BEFORE EXPIRY OF THREE YEARS £50 BE NOT PAID, AND IF BEFORE EXPIRY OF SEVEN YEARS £100 BE NOT PAID.—Letters patent thus granted shall be subject to the condition of becoming void, unless before the expiration of three years a further fee of £40 and a stamp duty of £10 (in all £50) be paid, and unless before the expiration of seven years a further fee of £80 and stamp duty of £20 (in all £100) be paid. Memoranda of such payments shall be indorsed on the warrant for the letters patent, and a certificate of the same given, and also indorsed on the letters patent.

103. ISSUE OF LETTERS PATENT, THEIR EXTENT AND LIMIT.—The Commissioners, when required by the applicant, shall then cause letters patent to be prepared according to the warrant, which shall be sealed with the great seal of the United Kingdom. Such letters patent shall extend to the whole of England, Scotland, and Ireland, to the Channel Islands, and to the Isle of Man. Should the warrant so direct, the letters patent may also

apply to any colonies or plantations abroad which may be specified. But they will have no authority in any colonies where the law in force in such colonies would render them invalid. A transcript of the letters patent is to be transmitted to the director of chancery in Scotland, which transcript is to be received in evidence in all Scottish courts of law. (§ 18.)

104. MUST BE ISSUED WITHIN THREE MONTHS FROM WARRANT, AND DURING PROVISIONAL PROTECTION, UNLESS DELAYED BY CAVEAT.—Patents cannot be issued unless applied for within three months from the date of the warrant, and during the six months of provisional protection or complete specification, unless delayed by a caveat, or application to the Lord Chancellor against sealing the letters patent. In such case they may be sealed at such time as the Lord Chancellor may direct. (See Instruction 41, §§ 19, 20.)

105. BUT LORD CHANCELLOR MAY ALLOW MONTH'S LIMIT IF DELAY BE PURELY ACCIDENTAL.—But by the sixth clause of the act of the 16 and 17 Vict., ch. 115, the Lord Chancellor may seal letters patent after the expiration of provisional protection, provided the delay in such sealing has arisen from accident, and not from the neglect or willful default of the applicant, the sealing to be dated as of any day before the expiring of provisional protection, and in like manner he may extend the time for filing the specification; such extension, however, is not to exceed one month.

106. IN CASE OF DEATH PATENT GRANTED TO REPRESENTATIVES WITHIN THREE MONTHS.—In case of the death of the applicant during the period of protection, letters patent may be granted to the personal representatives

during such period, or within three months of the death of the applicant. (§ 21.)

107. IF LOST, NEW PATENT MAY ISSUE ACCORDING TO COMMISSIONERS' REGULATIONS.—In case letters patent be lost or destroyed, others of like effect may be issued, subject to such regulations as the Commissioners may make. (§ 22.)

108. DATE OF LETTERS PATENT.—Letters patent are to be dated as of the day of the application for the same, and if bearing date prior to the day of actual sealing, are to be equally valid. (§§ 23, 24.)

109. PATENTS FOR FOREIGN INVENTIONS EXPIRE WITH ORIGINAL FOREIGN PATENT.—Patents for foreign inventions, previously patented abroad, shall only continue in force in the United Kingdom as long as they shall be valid in the foreign country where the patent is already obtained, and where more than one patent is taken out abroad, the termination of the British patent shall take place when the first of such foreign patents shall expire. (§ 25.)

110. PATENTS NOT TO PREVENT FOREIGN SHIPS USING THE INVENTION.—Letters patent granted under this act shall not prevent the use of the invention thereby secured on board of foreign ships resorting to British ports, except when the government to which such ships belong shall forbid the use by British ships of foreign patented inventions. (§ 26.)

111. SPECIFICATIONS TO BE FILED WITH COPY OF DRAWINGS.—Specifications are to be filed at the office with an extra copy of any drawings. (§§ 27, 28.) But by the 16 and 17 Vict., ch. 115, a true copy of every specification and complete specification, with the drawings

accompanying them, are to be left at the office on filing such specification or complete specification.

112. SIZE OF SPECIFICATIONS.—All specifications, in pursuance of the conditions of letters patent, and all complete specifications accompanying petitions for the grant of letters patent, shall be respectively written bookwise upon a sheet or sheets of parchment, each of the size of twenty-one and a half inches long by fourteen and three-quarter inches broad. The same may be written on both sides of the sheet, but a margin must be left of one and a half inch on every side of each sheet.

113. SIZE OF DRAWINGS AND SCALE.—The drawings accompanying such specifications shall be on a sheet or sheets of parchment, each twenty-one and a half inches long by fourteen and three-quarter inches broad, or twenty-one inches broad by twenty-nine and a half inches long, with a margin of one and a half inch on every side of each sheet.

[It is recommended to applicants and patentees to make their elevation drawings according to the scale of one inch to a foot. Lord Chancellor's order, October 1, 1852.]

114. EXTRA COPY OF SPECIFICATION TO BE LEFT WITH ORIGINAL; SIZE, &c.—An extra copy of the provisional specification or complete specification is to be left at the office with the original. It is to be written on sheets of brief or foolscap paper, briefwise, and on one side only. The extra copy of drawings must be according to the directions given above. (See Instruction 36.) (3d Set of Rules, Dec. 12, 1853.)

115. DOCUMENTS TO BE LEGIBLY SIGNED.—All specifica-

tions, copies of specifications, provisional specifications, petitions, notices, and other documents left at the office of the Commissioners, and the signatures of petitioners or agents, must be written in a large and legible hand. (*Ib.*)

116. NOTICE TO PROCEED MUST BE GIVEN EIGHT WEEKS, AND APPLICATION FOR WARRANT TWELVE CLEAR DAYS BEFORE END OF PROVISIONAL PROTECTION.—The notice of the applicant to proceed for letters patent must be left at the office eight weeks at least before the expiration of the provisional protection, and the application for the warrant of the law officer and for the letters patent must be made at the office twelve clear days at least before the expiration of the provisional protection. But the Lord Chancellor reserves to himself the power to grant a further extension of time under the special circumstances provided for by the 6th § of the 16 and 17 Vict., ch. 115. (See Instruction 29, *ib.*)

117. PROVISIONAL SPECIFICATIONS, AFTER SIX MONTHS, AND ALL OTHER DOCUMENTS OPEN FOR PUBLIC INSPECTION. True copies of provisional specifications, after the expiration of six months, and of all other specifications, disclaimers, and memoranda of alterations, are to be open to public inspection at the offices in London, Edinburgh, and Dublin.

118. DOCUMENTS TO BE PRINTED AND SOLD AND INDEXES OPEN FOR PUBLIC INSPECTION.—Specifications, disclaimers, and memoranda of alterations are to be printed and sold at such prices as the Commissioners shall direct. [This price is fixed by the Commissioners' rules at twopence for every ninety words.] Indexes of all patents and documents relating thereto are also to be prepared,

and to be open for public inspection and for sale, and printed copies of patents and other documents are to be received as evidence in courts of law. (§§ 30, 32, 33.)

119. PRINTED OR MANUSCRIPT COPIES, &C., WITH COMMISSIONERS' SEAL, AND DOCUMENTS RECORDED AND FILED, EVIDENCE IN COURTS OF LAW.—But by the 4th § of the 16 and 17 Vict., ch. 115, it is declared that printed or manuscript copies, or extracts certified and sealed with the seal of the Commissioners, specifications, disclaimers, and all other documents recorded and filed at the office, are to be received as evidence in all the courts of the United Kingdom, and other places to which the patent shall extend, without the production of the originals.

120. CHRONOLOGICAL REGISTER OF DOCUMENTS TO BE KEPT, INCLUDING LICENSES; COPY OF LICENSE MAY BE HAD, SUCH COPY TO BE EVIDENCE.—A chronological register of patents and other documents shall be kept and be open to public inspection, and also a register of proprietors, to include the assignment of any patent or share thereof, any license under letters patent, with the district to which such license relates, and any other matter affecting the proprietorship of letters patent; and a copy of such entry, properly certified, shall be given to any applicant on payment of a fee, the copy to be evidence. Until such entry shall have been made, the grantee of the patent is to be considered the sole proprietor. Copies of the registers are to be kept at Edinburgh and Dublin. (§§ 34, 35.)

121. ANY NUMBER OF PERSONS MAY BE INTERESTED IN A PATENT.—A larger number than twelve may have a legal interest in a patent. (§ 36.)

122. FALSIFICATION OF REGISTER A MISDEMEANOR.—

Falsification of the register of proprietors is a misdemeanor. (§ 37.)

123. ENTRIES IN REGISTER MAY BE EXPUNGED BY JUDGE'S ORDER.—Entries in the registry of proprietors may be expunged by application to Master of the Rolls, or any common law court. The costs of such application to be paid as the judge shall decree. (§ 38.)

124. DISCLAIMERS.—The provisions of the 5 and 6 Wm. IV, ch. 83, and 7 and 8 Vict., ch. 69, relating to disclaimers and memoranda of alterations in letters patent and specifications, to apply to this act, except as hereafter provided. By the common law, letters patent became wholly void for any partial defect; for instance, the want of novelty in a very small part. The act of 5 and 6 Wm. IV, ch. 83, allows a patentee to put in a disclaimer of any part of either the title or specification, stating the reason for such disclaimer, or enter a memorandum of alteration; but any other person may enter a caveat *against such disclaimer or memorandum of alteration*, the caveat giving the objector a right to be heard in opposition to the disclaimer or alteration. In case of no opposition, or of the disallowance of any caveat, the disclaimer or memorandum of alteration may be filed and enrolled, and be deemed part of the letters patent and specification. (§ 39.) But the disclaimer or alteration is not to affect any action pending at the time, and the law officer to whom the case shall be referred may require the party applying to advertise such disclaimer or alteration. (*Ib.*) The 7 and 8 Vict. allows a patentee the same faculty of disclaimer or alteration in concert with any party to whom he may have wholly or in part *transferred a property in his patent.* (*Ib.*)

125. CONFIRMATION AND PROLONGATION OF A PATENT. The provisions of the 5 and 6 Wm. IV, ch. 83, and the 2 and 3 Vict., ch. 67, and the 7 and 8 Vict., ch. 69, as to confirmation and prolongation of patents, are to apply to patents under this act. The new letters patent are to be available only for such places as the original patent extended to, and are to bear date on the day after the expiration of the term of the original letters patent. (§ 40.) The fourth section of the act of William enacts, that any patentee may advertise three times in the *London Gazette*, and in three London papers, and three times in some country paper, of or near the town where he may reside or carry on his manufacture, (or in some paper published in the county where he carries on his manufacture or lives, in case there should be no paper in the town,) his intention to petition the Privy Council for a prolongation of his patent, and that any other person may enter a caveat at the council's office. Thereupon the case may be heard before the judicial committee of the Privy Council, and should the report of the committee be in favor of the patentee, the patent may be prolonged for seven years. The second section of the 2 and 3 Vict., ch. 67, allows a patentee to obtain an extension of his patent, though the application for such extension may not have been prosecuted with effect before the expiration thereof. But the petition must be presented six calendar months at least before the expiration of the original patent. The second section of the 7 and 8 Vict., ch. 69, extends the term for which a patent may be prolonged to fourteen years.

126. INFRINGEMENT.—In actions for infringement of patents the plaintiff is to deliver with his declaration the

particulars of the breaches complained of, and the defendant shall also deliver with his pleas particulars of any objection on which he means to rely, and at the trial no evidence shall be allowed not contained in such particulars. Similar particulars are obligatory on any prosecutor seeking to repeal the patent. The prosecutor must also particularize the place or places where, and the manner in which, the invention is alleged to have been used prior to the date of the letters patent. But the judge may allow the plaintiff, defendant, or prosecutor to amend his particulars. The defendant, in any suit for repealing his patent, has a right to begin and give evidence of his case, and be entitled to reply. (§ 41.)

127. JUDGE'S ORDER IN CASE OF INFRINGEMENT.—The judge of any court where an action may be brought for infringement of patent to make order for injunction, inspection, or account, and give such directions respecting the action, &c., as the court or judge may see fit. (§ 42.)

128. TAXING COSTS IN CASE OF INFRINGEMENT.—In taxing costs in actions for infringement regard is to be had to the particulars delivered in such actions, and costs are only to be allowed on such particulars as the judge may certify to. Other enactments are also made respecting taxed costs. (§ 43.)

129. SCHEDULES OF FEES AND STAMP DUTIES.—Fees and stamp duties are to be paid according to schedule annexed to the act. The stamp duties are to be under the management of the Commissioners of Inland Revenue, and the fees to be paid into the Exchequer, and form part of the consolidated fund. (§§ 44, 45, 46.)

SCHEDULE TO WHICH THE ACT REFERS, CONSOLIDATED.

	£	s.	d.
On leaving the petition for grant of letters patent.....	5	0	0
On notice of intention to proceed with the application.....	5	0	0
On warrant of law officer for letters patent.....	5	0	0
On sealing of letters patent.....	5	0	0
On filing specifications.....	5	0	0
At or before expiration of the third year.....	50	0	0
At or before expiration of the seventh year.....	100	0	0
On leaving notice of objections.....	2	0	0
Every search and inspection.....	0	1	0
Entry of assignment or license.....	0	5	9
Certificate of assignment or license.....	0	0	5
Filing application for disclaimer.....	5	0	0
Caveat against disclaimer.....	2	0	0

The fees to be paid to the law officers and to their clerks shall be—

By a person opposing a grant of letters patent:

	£	s.	d.
To the law officer.....	2	12	6
To his clerk.....	0	12	6
To his clerk for summons.....	0	5	0
	£3	10	0

By the petitioner on the hearing of the case of opposition:

	£	s.	d.
To the law officer.....	2	12	6
To his clerk.....	0	12	6
To his clerk for summons.....	0	5	0
	£3	10	0

By the petitioner for the hearing, previous to the fiat of the law officer allowing a disclaimer or memorandum of alteration in letters patent or specification:

	£	s.	d
To the law officer	2	12	6
To his clerk	0	12	6
	£3	5	0

By the person opposing the allowance of such disclaimer or memorandum of alteration on the hearing of the case of opposition.

	£	s.	d.
To the law officer	2	12	6
To his clerk	0	12	6
	£3	5	0

By the petitioner for the fiat of the law officer allowing a disclaimer or memorandum of alteration, or letters patent and specification.

	£	s.	d.
To the law officer	3	3	0
To his clerk	0	12	6
	£3	15	6

NOTE.—The following is an abstract of the comparative cost of patents in the principal foreign States in British currency:

France, £4 per annum for fourteen years.

Great Britain, (provisional protection,) £5.
Sealed, £25.
At the end of three years, £50 additional.
At end of seven years, £100 additional.

Belgium, 8s. first year, and increasing progressively for twenty years up to £8 for last year.

Austria, £10 for first five years.
£20 for second five years.
£40 for third five years.

Italy, 8*s*. 4*d*. per year, paid at once.
£1 12*s*. per annum first three years.
£2 12*s*. per annum second three years.
£3 12*s*. per annum third three years.
£4 12*s*. per annum fourth three years.
£5 12*s*. per annum fifth three years.
Saxony, £4 10*s*. for first five years.
£8 for second five years.
Sweden, fees not fixed, and expenses of advertising.
Victoria, (Australia,) £7 4*s*. 6*d*. for first three years.
Prussia, £20 and upwards from six months to fifteen years.
Bavaria, £2 for first year, increasing by degrees annually to £23 for fifteen years.
Netherlands, £12 10*s*. for five years.
From £25 to £33 for ten years.
From £50 to £62 for fifteen years.
Russia, £14 10*s*. for three years.
£24 10*s*. for five years.
£72 10*s*. for ten years.

VIII. Forms and Proceedings to obtain a Patent.

SEC.
130. Form of petition.
131. How to be written, and stamp.
132. Declaration to accompany petition.
133. Petition and declaration, accompanied by specification.
134. Reference indorsed on petition.
135. Form provisional specification.
136. Form of complete specification.
137. Reference to law officer.
138. Notice to proceed to be made two months before end of provisional term.
139. Form of warrant.
140. Form of letters patent.
141. The specification.

130. FORM OF PETITION FOR LETTERS PATENT.—

No. —.

To the Queen's Most Excellent Majesty

The humble petition of , of , in the county of , showeth—

That your petitioner is in possession of an invention for [*here insert the*

title of the invention,] which invention he believes will be of great public utility; that he is the first and true inventor thereof, [*if the invention be a communication from abroad, here insert the words,* "within the realm,"] and that the same is not in use [*if from abroad, insert the word* "therein"] by any other person or persons, to the best of his knowledge and belief. *Your petitioner therefore humbly prays that your Majesty will be pleased* to grant unto him, his executors, administrators, and assigns, your royal letters patent, for the United Kingdom of Great Britain and Ireland, the Channel Islands, and the Isle of Man, for the term of fourteen years, pursuant to the statutes in that case made and provided.

And your petitioner will ever pray.

131. How to be Written, and Stamp.—This petition must be written distinctly, or printed, on a £5 stamp, specially provided for the purpose by the Stamp Office, and care must be taken to conform exactly to the instructions given in the act, respecting the dimensions, payments, and other details.

132. Declaration to Accompany Petition.—

No. —.

I, , of , in the county of , do solemnly and sincerely declare, that I am in possession of an invention for, &c., [*the title as in the petition,*] which invention I believe will be of great public utility; that I am the true and first inventor thereof; and that the same is not in use by any other person or persons, to the best of my knowledge and belief, [*where a complete specification is to be filed with the petition and declaration, insert these words,* "and that the instrument in writing under my hand and seal, hereunto annexed, particularly describes and ascertains the nature of said invention, and the manner in which the same is performed;"] and I make this declaration conscientiously, believing the same to be true; and by virtue of the provisions of an act made and passed in the session of Parliament, held in the fifth and sixth years of the reign of his late Majesty King William the Fourth, intituled "An act to repeal an act of the present session of Parliament, intituled 'An act for the more effectual abolition of oaths and affirmations taken and made in various departments of the State, and to substitute declarations in lieu thereof, and for the more entire suppression of voluntary and extra-judicial oaths and affidavits,' and to make other provisions for the abolition of unnecessary oaths."

A. B.

Declared at , this day of , A. D. , before me, ——— ———,

A Commissioner to Administer Oaths in Chancery, or Justice of the Peace.

133. PETITION AND DECLARATION MUST BE ACCOMPANIED BY SPECIFICATION.—The petition and declaration must be accompanied by either a provisional specification or a complete specification, at the option of the inventor. A provisional specification need only give the general principle of the invention, but it must be stated with sufficient distinctness to enable the law officer to whom it is referred to judge of the nature of the improvements discovered, and of the manner in which they are to be carried into effect. The inventor will then have an interval of six months for maturing his invention, and may introduce into his complete specification any improvements or development not inconsistent with the title, or with the principle enounced in the provisional specification.

134. REFERENCE TO BE INDORSED ON THE PETITION.—The following is to be indorsed on the petition:

"Her Majesty is pleased to refer this petition to [*name of law officer,*] to consider what may be properly done therein."

135. FORM OF PROVISIONAL SPECIFICATION.—

No.—.

I, , do hereby declare the nature of the said invention for [*insert title as in petition*] to be as follows [*here insert description*]:

Dated this day of , A. D. .

[*To be signed by applicant or his agent.*]

[It will be for the inventor to judge whether it will be most to his interest to content himself with a provisional specification or proceed at once to a complete specification; by following the former course he will have abundant leisure to perfect his discovery; by adopting the latter he will be able the sooner to bring it into commercial

operation, a point worthy of consideration, since the six months of provisional protection form part of the term for which the patent is granted.]

136. Form of Complete Specification.—

To all to whom these presents shall come:

I, , of , send greeting:

Whereas I am in possession of an invention for (*here insert title*), and have petitioned Her Majesty to grant unto me, my executors, administrators, and assigns, her royal letters patent for the same, and have made solemn declaration that I really believe myself to be the first and true inventor thereof: *Now*, know ye that I, the said , do hereby *declare that the following complete specification, under my hand and seal*, fully describes the nature of my said invention and the manner in which the same is to be performed (that is to say): [*Here insert description.*]

Dated this day of , A. D. .

[*To be signed by applicant or his agent.*]

[The drawing up of the complete specification is an operation which requires the utmost care, skill, and attention on the part of the person undertaking so delicate a duty, for the validity of the patent will depend on this document being clear, explicit, and circumstantial. Few inventors will venture to assume a task which is calculated to try the capacity and experience of the most able professional man. "In the specification the invention must be accurately ascertained and particularly described; it must be set forth in the most minute detail. The disclosure of the secret is considered as the price which the patentee pays for this limited monopoly, and therefore it ought to be full and correct, (for the benefits thus secured to him are great and certain,) in order that the subject of his patent may, at its expiration, be well known, and that the public may reap from it the same advantages as have accrued to him." (Godson on Patents, ch. iv.)

In the case of mechanical inventions drawings are almost always necessary, but they are merely intended to illustrate the description, so as to make it more clearly understood; but the law requires that the specification itself should be so explicit, that any one acquainted with the subject should be able to carry out the invention without any other aid. Want of sufficient exactness in this respect would therefore be a ground for invalidating a patent.]

137. REFERENCE TO LAW OFFICER, (EITHER ATTORNEY OR SOLICITOR GENERAL FOR ENGLAND.)—Having complied with the requirements of the act in all these respects, the application is then referred to one of the law officers, (practically either the Attorney or Solicitor General for England,) and, if he is satisfied with the accuracy and propriety of the description. he grants a certificate of protection for six months, which is generally published in the *London Gazette* on the Friday after.

138. NOTICE TO PROCEED TO BE ON £5 STAMP, AND MADE TWO MONTHS BEFORE END OF PROVISIONAL PROTECTION.—The next step is the notice to proceed, which must be on a £5 stamp, and be deposited at the office at least two months before the expiration of the six months' protection. This is usually published in the ensuing Tuesday's *Gazette*, accompanied by a notice, "that all parties having an interest in opposing such application are at liberty to leave particulars in writing of their objections to such application at the office of the Commissioners within twenty-one days after the date of the *Gazette* in which the notice is issued." Should no opposition appear within this period, application may be made for the

warrant for letters patent. This must be done at least twelve days before the protection expires. The warrant will be issued in due course.

139. FORM OF WARRANT.—

In humble obedience to Her Majesty's command, referring to me the petition of , of , to consider what may be properly done therein, I do hereby certify as follows: That the said petition sets forth that the petitioner [*here follow the allegations of the petition*], and the petitioner prays [*prayer of the petitioner*]:

That in support of the allegations contained in the said petition the declaration of the petitioner has been laid before me, whereby he solemnly declares that [*here follow the allegations of the declaration*]:

That there has also been laid before me [a provisional specification, signed , and also a certificate ,] or [a complete specification, and a certificate of the filing thereof], whereby it appears that the said invention was provisionally protected [or protected] from the day of , A. D. , in pursuance of the statute.

That it appears that the said application was duly advertised.

Upon consideration of all the matters aforesaid, and as it is entirely at the hazard of the said petitioner whether the said invention is new or will have the desired success, and as it may be reasonable for Her Majesty to encourage all arts and inventions which may be for the public good, I am of opinion that Her Majesty may grant her royal letters patent unto the petitioner, his executors, administrators, and assigns, for his said invention, within the United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, [*colonies to be mentioned, if any,*] for the term of fourteen years, according to the statute in that case made and provided, if Her Majesty shall be graciously pleased so to do, to the tenor and effect following: [*See next form.*]

Given under my hand this day of , A. D. .

140. FORM OF LETTERS PATENT.—

Victoria, by the grace of God of the United Kingdom of Great Britain and Ireland Queen, Defender of the Faith:

To all to whom these presents shall come, greeting:

Whereas hath by his petition humbly represented unto us that he is in possession of an invention for , which the petitioner conceives will be of great public utility; that he is the true and first inventor thereof; and that the same is not in use by any other person or

persons, to the best of his knowledge and belief. The petitioner therefore most humbly prayed that we would be graciously pleased to grant unto him, his executors, administrators, and assigns, our royal letters patent for the sole use, benefit, and advantage of his said invention, within our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, [*colonies to be mentioned, if any,*] for the term of fourteen years, pursuant to the statutes in that case made and provided:

[And whereas the said hath particularly described and ascertained the nature of the said invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and has caused the same to be duly filed in]:

And we, being willing to give encouragement to all arts and inventions which may be for the public good, are graciously pleased to condescend to the petitioner's request: Know ye, therefore, that we, of our especial grace, certain knowledge, and mere motion, have given and granted, and by these presents, for us, our heirs and successors, do give and grant unto the said , his executors, administrators, and assigns, our especial license, full power, sole privilege and authority, that he, the said , his executors, administrators, and assigns, and every of them, by himself and themselves, or by his and their deputy or deputies, servants or agents, or such others as he, the said , his executors, administrators, or assigns, shall at any time agree with, and no others, from time to time, and at all times hereafter during the term of years herein expressed, shall and lawfully may make, use, exercise, and vend his said invention within our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, in such manner as to him, the said , his executors, administrators, and assigns, or any of them, shall in his or their discretion seem meet; and that he, the said , his executors, administrators, and assigns, shall and lawfully may have and enjoy the whole profit, benefit, commodity, and advantage, from time to time coming, growing, accruing, and arising by reason of the said invention, for and during the term of years herein mentioned; to have, hold, exercise, and enjoy the said licenses, powers, privileges, and advantages, hereinbefore granted or mentioned to be granted, unto the said , his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years from the day of , A. D. , next and immediately ensuing, according to the statute in such case made and provided; and to the end that he, the said , his executors, administrators, and assigns, and every of them, may have and enjoy the full benefit and the sole use and exercise of the said invention, according to our gracious inten-

tion hereinbefore declared, we do by these presents, for us, our heirs and successors, require and strictly command all and every person and persons, bodies politic and corporate, and all other our subjects whatsoever, of what estate, quality, degree, name, or condition soever they be, within our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, [*colonies to be mentioned, if any*] that neither they nor any of them, at any time during the continuance of the said term of fourteen years hereby granted, either directly or indirectly, do make, use, or put in practice the said invention, or any part of the same, so attained unto by the said as aforesaid, nor in anywise counterfeit, imitate, or resemble the same, nor shall make, nor cause to be made, any addition thereunto or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, deviser or devisers thereof, without the consent, license, or agreement of the said , his executors, administrators, or assigns, in writing, under his or their hands and seals, first had and obtained in that behalf, upon such pains and penalties as can and may be justly inflicted on such offenders for their contempt of this our royal command, and further to be answerable to the said , his executors, administrators, and assigns, according to law, for his and their damages thereby occasioned.

And, moreover, we do by these presents, for us, our heirs and successors, will and command all and singular the justices of the peace, mayors, sheriffs, bailiffs, constables, headboroughs, and all other officers and ministers whatsoever, of us, our heirs and successors, for the time being, that they or any of them do not, nor shall at any time during the said term hereby granted, in anywise molest, trouble, or hinder the said , his executors, administrators, or assigns, or any of them, or his or their deputies, servants, or agents, in or about the due and lawful use or exercise of the aforesaid invention or anything relating thereto: Provided always, and these our letters patent are and shall be upon this condition, that if, at any time during the said term hereby granted, it shall be made to appear to us, our heirs or successors, or any six or more of our or their Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof, or that the said is not the true and first inventor thereof within this realm as aforesaid, these our letters patent shall forthwith cease, determine, and be utterly void, to all intents and purposes, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided also that these our letters patent, or anything herein contained, shall not extend or be construed to extend to

give privilege unto the said ; his executors, administrators, or assigns, or any of them, to use or imitate any invention or work whatsoever which hath heretofore been found out or invented by any other of our subjects whatsoever, and publicly used or exercised, unto whom our like letters patent or privileges have been already granted for the sole use, exercise, and benefit thereof: It being our will and pleasure that the said , his executors, administrators, or assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practice their several inventions, by them invented and found out, according to the true intent and meaning of the same respective letters patent and of these presents: Provided likewise, nevertheless, and these our letters patent are upon this express condition, [that if the said shall not particularly describe and ascertain the nature of his said invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and cause the same to be filed in within calendar months next and immediately after the date of these our letters patent;] [and also if the said instrument in writing, filed as aforesaid, does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed;] and also if the said , his executors, administrators, or assigns, shall not pay or cause to be paid at the office of our Commissioners of Patents for inventions, that is to say, the sum of £50 stamp duty before the expiration of three years from the date hereof, and also £100 stamp duty before the expiration of seven years from the date of these our letters patent, and produce these our letters patent stamped with a proper stamp to these amounts respectively, pursuant to the provisions of the act of the sixteenth year of our reign, chapter 5; and also if the said , his executors, administrators, or assigns, shall not supply, or cause to be supplied, for our service all such articles of the said invention as he or they shall be required to supply by the officers or commissioners administering the department of our service for the use of which the same shall be required, in such manner, at such times, and at and upon such reasonable prices and terms, as shall be settled for that purpose by the said officers or commissioners requiring the same, that then, and in any of the said cases, these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine, and become void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted; and, lastly, we do by

these presents, for us, our heirs and successors, grant unto the said , his executors, administrators, and assigns, that these our letters patent, on the filing thereof, shall be in all and by all things, good, firm, valid, sufficient, and effectual in the law, according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favorable and beneficial sense for the best advantage of the said , his executors, administrators, and assigns, as well in all our courts of record as elsewhere, and by all and singular the officers and ministers whatsoever of us, our heirs and successors, in our United Kingdom of Great Britain and Ireland, the Channel Islands, and the Isle of Man, [*colonies to be mentioned, if any,*] and amongst all and every the subjects of us, our heirs and successors, whatsoever and wheresoever, notwithstanding the not full and certain describing the nature or quality of the said invention, or of the materials thereunto conducting and belonging. In witness whereof we have caused these our letters to be made patent, this day of , A. D. , and to be sealed and bear date as of the said day of , A. D. , in the year of our reign.

141. THE SPECIFICATION.—Should the applicant have preferred in the first instance to file a provisional specification, his next step will be the complete specification.

To all to whom these presents shall come:

I, , of , send greeting:

Whereas Her most Excellent Majesty Queen Victoria, by her royal letters patent, bearing date the day of , A. D. , in the year of her reign, did for herself, her heirs and successors, give and grant unto me, the said , her special license, that I, the said , my executors, administrators, and assigns, or such others as I, the said , my executors, administrators, and assigns, should at any time agree with, and no others, from time to time, and at all times thereafter during the term therein expressed, should, and lawfully might, make, use, exercise, and vend, within the United Kingdom of Great Britain and Ireland, the Channel Islands, and the Isle of Man, [*the colonies to be mentioned if, any,*] an invention for [*insert title as in letters patent*], upon the condition (amongst others) that I, the said , by an instrument in writing under my hand and seal, should particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, and cause the same to be filed in

within calendar months next and immediately after the date of the said royal letters patent: Now, know ye that I, the said , do hereby declare the nature of my said invention, and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement, that is to say: [*Describe the invention.*]

In witness whereof I, the said , have hereunto set my hand and seal, this day of , A. D. .

[*Signed by the applicant.*]

This will complete all the proceedings necessary for obtaining a patent in cases where no opposition is made.

Patentees are reminded that unless before the expiration of the third year a further sum of £50, and before the expiration of the seventh year a further sum of £100, be paid at the Patent Office, the letters patent will become void.

IX. Patent Laws of the Dominion of Canada.

Sec.		Sec.	
142.	Patent Office constituted.	145.	Deputy Commissioner.
143.	Seal.	146.	Report.
144.	Rules and regulations.		

[Note.—The new patent law of the Dominion came in force on the 1st of July, 1869, and abrogated the local provincial laws which previously to that time had been in force in the different provinces. Patents granted under those late laws will, however, still continue in force in the provinces for which they were granted for the unexpired periods they have to run. It will also be seen that, under certain conditions, those local patents may be extended over the entire Dominion.

During the passage of the patent bill through Parlia-

ment strong efforts were made to obtain a more liberal law than the one we now publish—a law which would assimilate with those of other civilized countries, in not demanding residence as a necessary preliminary to the application for a patent, and also in extending the right of a patent to all inventors, irrespective of nationality.*]

142. PATENT OFFICE CONSTITUTED.—There shall be attached to the Department of Agriculture, as a branch thereof, an office to be named the Patent Office; and the Minister of Agriculture for the time being shall be the Commissioner of Patents of invention; and it shall be the duty of the said Commissioner to receive all applications, fees, papers, documents, and models for patents, and to perform such acts and things respecting the granting and issuing of patents for new and useful inventions, discoveries, and improvements as are herein provided for; and he shall have the charge and custody of the books, records, papers, models, machines, and other things belonging to the said office. (§ 1.)

143. SEAL.—The Commissioner shall cause a seal to be made for the purposes of this act, and may cause to be sealed therewith letters patent and other instruments and copies proceeding from the Patent Office; and all courts, judges, and other persons whomsoever

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*Since the publication of the first edition of this work, a law has been passed by the Parliament of Canada, under the provisions of which citizens of the United States and other countries may obtain patents. This law, together with the latest edition of the rules of the Canada Patent Office, for which I am indebted to the courtesy of the Canadian Minister of Agriculture, will be found in the Appendix.

shall take notice of such seal, and receive impressions thereof in evidence, in like manner as impressions of the great seal are received in evidence, and shall also take notice of and receive in evidence, without further proof and without production of the originals, all copies or extracts certified under the seal of the said office to be copies of or extracts from documents deposited in such office. (§ 2.)

144. RULES AND REGULATIONS.—The Commissioner may from time to time, subject to the approval of the Governor in council, make such rules and regulations, and prescribe such forms, as may appear to him necessary and expedient for the purposes of this act, and notice thereof shall be given in the *Canada Gazette;* and all documents executed after the same and accepted by the Commissioner shall be held valid so far as relating to proceedings in the Patent Office. (§ 3.)

145. DEPUTY COMMISSIONER.—The Deputy of the Minister of Agriculture shall be the Deputy Commissioner of Patents of Invention; and the Governor may from time to time appoint such clerks and officers under him as may be necessary for the purpose of this act, and such clerks and officers shall hold office during pleasure. (§ 4.)

146. REPORT.—The Commissioner shall cause a report to be prepared annually and laid before Parliament of the proceedings under this act, and shall from time to time, and at least once in a year, publish in the *Canada Gazette* a list of patents granted, and may, with the approval of the Governor in council, cause such specifications and drawings as may be deemed of interest, or essential parts thereof, to be printed from time to time for distribution or sale. (§ 5.)

X. Who may Obtain Patents.

SEC.
147. Who may obtain a patent.
148. An original inventor, having foreign patent, must apply within six months.
149. Right of assignment.
SEC.
150. A resident may obtain, but not vend a patent.
151. Joint applications to be made by joint inventors, and patents issue accordingly.

147. WHO MAY OBTAIN A PATENT.—Any person having been a resident of Canada for at least one year next before his application, and having invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used by others before his invention or discovery thereof, or not being at the time of his application for a patent in public use or on sale in any of the provinces of the Dominion, with the consent or allowance of the inventor or discoverer thereof, may, on a petition to that effect presented to the Commissioner and on compliance with the other requirements of this act, obtain a patent, granting to such person an exclusive property therein; and the said patent shall be under the seal of the Patent Office and the signature of the Commissioner, or the signature of another member of the Privy Council, and shall be good and valid to the grantee, his heirs, assigns, or other legal representatives, for the period mentioned in such patent; but no patent shall issue for an invention or discovery having an illicit object in view, nor for any mere scientific principle or abstract theorem. (§ 6.)

148. AN ORIGINAL INVENTOR, HAVING FOREIGN PATENT, MUST APPLY WITHIN SIX MONTHS.—An original and true inventor or discoverer shall not be deprived of the right to a patent for his invention or discovery by reason of his having, previously to his application, taken out a patent therefor in any other country, at any time within six months next preceding the filing of his specification and drawing, as required by this act. (§ 7.)

149. RIGHT OF ASSIGNMENT.—The patent may be granted to any person to whom the inventor or discoverer entitled under the sixth section to obtain a patent has assigned or bequeathed the right of obtaining the same and the exclusive property in the invention or discovery in Canada, or, in default of such assignment or bequest, to the executor or administrator of the deceased inventor or discoverer, or other legal representative. (§ 8.)

150. A RESIDENT MAY OBTAIN, BUT NOT VEND A PATENT. Any person, having been a resident of Canada for at least one year next before his application, and who has invented or discovered any improvement on any patented invention or discovery, may obtain a patent for such improvement, but shall not thereby obtain the right of vending or using the original invention or discovery, nor shall the patent for the original invention or discovery confer the right of vending or using the patented improvement. (§ 9.)

151. JOINT APPLICATIONS TO BE MADE BY JOINT INVENTORS AND PATENTS ISSUE ACCORDINGLY.—In cases of joint applications, the patent shall be granted in the names of all the applicants; and in such cases any assignment from one of the said applicants or patentees to the other

shall be registered in the manner of other assignments. (§ 10.)

XI. Conditions and Formalities.

SEC.

152. Oath or affirmation as to invention must be made by applicants.
153. Applicants to elect a domicil in Canada.
154. Nature of petition and specifications.
155. Drawings to be furnished in duplicate, with references.
156. Working model of invention, or samples of ingredients, if a discovery, required.

152. OATH OR AFFIRMATION AS TO INVENTION MUST BE MADE BY APPLICANTS.—Every applicant for a patent, before he can obtain the same, shall make oath, or, when entitled by law to make an affirmation instead of an oath, shall make an affirmation, that he verily believes that he is, or that the person whose assignee or representative he is, is or was the true inventor or discoverer of the invention or discovery for which the patent is solicited, and that he, or the person whose assignee or representative he is, was a resident of Canada for one year next before the application, or, in case of death of the inventor or discoverer, for one year next before such death. Such oath or affirmation may be made before any justice of the peace in Canada; but if the applicant is not at the time in Canada, the oath or affirmation may be made before any minister plenipotentiary, *chargé d'affaires*, consul or consular agent, holding commission under the Government of the United Kingdom, or any judge of the country in which the applicant happens at the time to be. (§ 11.)

153. APPLICANT TO ELECT A DOMICIL IN CANADA.—The

petitioner for a patent shall, for all the purposes of this act, elect his domicil at some known and specified place in Canada, and mention the same in his petition for a patent, and he shall in the same petition state the place or places in Canada at which he, or, if his application be as assignee or representative, the person whose assignee or representative he is, was resident during the year of residence required by this act, and the period of residence at each such place. (§ 12.)

154. NATURE OF PETITION AND SPECIFICATIONS.—The applicant shall in his petition for a patent insert the title or name of his invention or discovery, its object, and a short description of the same, and shall distinctly allege all the facts which are necessary under this act to entitle him to a patent therefor, and shall, with the petition, send in a written specification, in duplicate, of his invention or discovery, describing the same in such full, clear, and exact terms as to distinguish it from all contrivances or processes for similar purposes. (§ 13.)

155. DRAWINGS TO BE FURNISHED IN DUPLICATE, WITH REFERENCES.—The specification shall correctly and fully describe the mode or modes of operating contemplated by the applicant, and shall state clearly and distinctly the contrivances and things which he claims as new, and for the use of which he claims an exclusive property and privilege; it shall bear the name of the place where it is made, the date, and be signed by the applicant and two witnesses. In the case of a machine, the specification shall fully explain the principle and the several modes in which it is intended to apply and work out the same; in the case of a machine, or in any other case where the invention or discovery admits of illustration by means

of drawings, the applicant shall also with his application send in drawings in duplicate, showing clearly all parts of the invention or discovery, and each drawing shall bear the name of the inventor or discoverer, and shall have written references corresponding with the specification, and a certificate of the applicant that it is the drawing referred to in the specification; but the Commissioner may require any greater number of drawings than those above mentioned, or dispense with any of them, as he may see fit; one duplicate of the specification and of the drawings, if any drawings, shall be annexed to the patent of which it forms an essential part, and the other duplicate shall remain deposited in the Patent Office. (§ 14.)

156. WORKING MODEL OF INVENTION, OR SAMPLES OF INGREDIENTS, IF A DISCOVERY, REQUIRED.—The applicant shall also deliver to the Commissioner, unless specially dispensed from so doing for some good reason, a neat working model of his invention or discovery, on a convenient scale, exhibiting its several parts in due proportion, whenever the invention or discovery admits of such model; and shall deliver to the Commissioner specimens of the ingredients and of the composition of matter sufficient in quantity for the purpose of experiment, whenever the invention is a composition of matter, provided such ingredients and composition are not of an explosive character or otherwise dangerous, in which case they are to be furnished only when specially required by the Commissioner, and then with such precautions as shall be prescribed in the said requisition. (§ 15.)

XII. Contents, Duration, Surrender, Reissue of Patents, and Disclaimers.

SEC.
157. Contents of the patent and powers granted thereby.
158. Duration of patent.
159. Patent to be examined and certified by minister of justice before delivery.
160. New patent in case of error.
161. Patentee may make disclaimer.

157. CONTENTS OF THE PATENT AND POWERS GRANTED THEREBY.—Every patent granted under this act shall recite briefly the substance of the petition on which it is granted, and shall contain the title or name of the invention or discovery and a short description of the same, referring for a fuller detail to the specification, and shall grant to the patentee, his assigns and legal representatives, or in trust, as the case may be, for the period therein mentioned from the granting of the same, the exclusive right, privilege, and liberty of making, constructing, and using, and vending to others to be used, the said invention or discovery, and shall contain a condition that it is nevertheless subject to adjudication before any court of competent jurisdiction. (§ 16.)

158. DURATION OF PATENT.—Patents of invention or discovery issued by the Patent Office shall be valid for a period of five years; but at or before the expiration of the said five years the holder thereof may obtain an extension of the patent for another period of five years, and after those second five years may again obtain further extension for another period of five years; and the instrument delivered by the Patent Office for such extension of time shall be in the form which may be from time to time adopted, and shall be made in duplicate,

one duplicate to remain of record and be duly registered, and the other to be attached, with reference, to the patent, under the seal of the Patent Office and signature of the Commissioner, or any other privy councillor in case of absence of the Commissioner. (§ 17.)

159. PATENT TO BE EXAMINED AND CERTIFIED BY MINISTER OF JUSTICE BEFORE DELIVERY.—Every such patent, and every instrument for granting a further extension of any patent, shall, before it is signed by the Commissioner or any other member of the privy council, and before the seal hereinbefore mentioned is affixed to it, be examined by the Minister of Justice, who, if he finds it conformable to law, shall certify accordingly, and such patent or instrument may then be signed and the seal affixed thereto, and, being duly registered, shall avail to the grantee thereof and be delivered to him. (§ 18.)

160. IN CASE OF ERROR THE COMMISSIONER MAY CAUSE NEW PATENT TO BE ISSUED.—Whenever any patent shall be deemed defective or inoperative by reason of insufficient description or specification, or by reason of the patentee claiming more than he had a right to claim as new, but at the same time it appears that the error arose from inadvertence, accident, or mistake, without any fraudulent or deceptive intention, the Commissioner may, upon the surrender of such patent and the payment of the further fee hereinafter provided, cause a new patent, in accordance with an amended description and specification to be made by such patentee, to be issued to him for the same invention or discovery, for any part or the whole of the then unexpired residue of the five years period for which the original patent was or might have been, as hereinbefore directed, granted. In case of the

death of the original patentee, or of his having assigned the patent, a like right shall vest in his assignee or legal representative: The new patent and the amended description and specification shall have the same effect in law, on the trial of any action thereafter commenced for any cause subsequently accruing, as if the same had been originally filed in such corrected form before the issue of the original patent. (§ 19.)

161. PATENTEE MAY MAKE DISCLAIMER.—Similarly, whenever, by any mistake, accident, or inadvertence, and without any willful intent to defraud or mislead the public, a patentee has made his specification too broad, claiming more than that of which he or the party through whom he claims was the first inventor or discoverer, or has in the specification claimed that he or the party through whom he claims was the first inventor or discoverer of any material or substantial part of the invention or discovery patented, of which he was not the first inventor or discoverer, and had no legal right thereto, the patentee may, on payment of the fee hereinafter provided, make disclaimer of such parts as he shall not claim to hold by virtue of the patent or the assignment thereof; such disclaimer shall be in writing and in duplicate, and attested in the manner hereinbefore prescribed for a patent, one copy to be filed and recorded in the office of the Commissioner, the other copy to be attached to the patent and made a part thereof by reference, and such disclaimer shall thereafter be taken and considered as part of the original specification. Such disclaimer shall not affect any action pending at the time of its being made, except in so far as may relate to the question of unreasonable neglect or delay in mak-

ing it. In case of the death of the original patentee, or of his having assigned the patent, a like right shall vest in his assigns or legal representatives respectively, any of whom may make disclaimer. The patent shall thereafter be deemed good and valid for so much of the invention or discovery as is truly the disclaimant's own and not disclaimed, provided it be a material and substantial part of the invention or discovery, and definitely distinguished from other parts claimed without right; and the disclaimant shall be entitled to maintain a suit for such part accordingly. (§ 20.)

XIII. Assignment and Infringement of Patents.

SEC.
162. Government of Canada may use any patented invention by making reasonable compensation.
163. Patents to be assignable.
164. Penalty for infringement.
165. Prosecution for infringement.
166. Court may discriminate in certain cases.
167. Defense in such cases.

162. GOVERNMENT OF CANADA MAY USE ANY PATENTED INVENTION BY MAKING REASONABLE COMPENSATION.—The Government of Canada may always use any patented invention or discovery, paying to the patentee such sum as the Commissioner may report to be a reasonable compensation for the use thereof. (§ 21.)

163. PATENTS TO BE ASSIGNABLE.—Every patent for an invention or discovery, whensoever issued, shall be assignable in law, either as to the whole interest or as to any part thereof, by any instrument in writing; but such assignment, and also every grant and conveyance of any exclusive right to make and use, and to grant to others

the right to make and use, the invention or discovery patented, within and throughout the Dominion of Canada, or within and throughout any one or more of the Provinces of Ontario, Quebec, Nova Scotia, or New Brunswick, or any part of any of such Provinces or of the Dominion, shall be registered in the office of the Commissioner; and every assignment affecting a patent for invention or discovery shall be deemed null and void against any subsequent assignee, unless such instrument is registered, as hereinbefore prescribed, before the registering of the instrument under which such subsequent assignee may claim. (§ 22.)

164. PENALTY FOR INFRINGEMENT OF PATENT.—Every person who, without the consent in writing of the patentee, makes, constructs, or puts in practice any invention or discovery for which a patent has been obtained under this act, or procures such invention or discovery from any person not authorized to make or use it by the patentee, and uses it, shall be liable to the patentee in an action of damages for so doing; and the judgment shall be enforced, and the damages and costs as may be adjudged shall be recovered, in like manner as in other cases in the court in which the action is brought. (§ 23.)

165. PROSECUTION FOR INFRINGEMENT.—An action for the infringement of a patent may be brought before any court of record having jurisdiction to the amount of damages asked for, and having its sittings within the Province in which the infringement is said to have taken place, and being at the same time, of the courts of such jurisdiction within such Province, the one of which the place of holding is nearest to the place of residence or of business of the defendant, and such court shall decide

the case and determine as to costs. In any action for the infringement of a patent, the court, if sitting, or any judge thereof in chambers if the court be not sitting, may, on the application of the plaintiff or defendant respectively, make such order for an injunction restraining the opposite party from further use, manufacture, or sale of the subject matter of the patent, and for his punishment in the event of disobedience to such order, or for inspection or account, and respecting the same and the proceedings in the action, as the court or judge may see fit; but from such order an appeal shall lie under the same circumstances and to the same court as from other judgments or orders of the court in which the order was made. (§ 24.)

166. COURT MAY DISCRIMINATE IN CERTAIN CASES.—Whenever the plaintiff fails to sustain his action, because his specification and claim embrace more than that of which he was the first inventor or discoverer, and it appears that the defendant used or infringed any part of the invention or discovery justly and truly specified and claimed as new, the court may discriminate, and the judgment may be rendered accordingly. (§ 25.)

167. DEFENSE IN SUCH CASES.—The defendant in any such action may specially plead as matter of defense any fact or default which by this act or by law would render the patent void; and the court shall take cognizance of that special pleading and of the facts connected therewith, and shall decide the case accordingly. (§ 26.)

XIV. Nullity, Impeachment, and Voidance of Patents.

SEC.
168. Patents to be void in certain cases, or only valid for part.
169. Patents to be conditioned on manufacture in Canada within three years; importing the article patented.
SEC.
170. Proceedings for impeachment of patent.
171. Certificate of judgment voiding patent to be entered.
172. Judgment to be subject to appeal.

168. PATENT TO BE VOID IN CERTAIN CASES, OR ONLY VALID FOR PART.—A patent shall be void if any material allegation in the petition or declaration of the applicant be untrue, or if the specification and drawings contain more or less than is necessary for obtaining the end for which they purport to be made, such omission or addition being willfully made for the purpose of misleading; but if it shall appear to the court that such omission or addition is simply an involuntary error, and it is proved that the patentee is entitled to the remainder of his patent *pro tanto*, the court shall render a judgment in accordance with the facts, and determine as to costs, and the patent shall be held valid for such part of the invention described, and two office copies of such judgment shall be furnished to the Patent Office by the patentee, one to be registered and to remain of record in the office, and the other to be attached to the patent and made a part of it by a reference. (§ 27.)

169. PATENTS TO BE CONDITIONED ON MANUFACTURE IN CANADA WITHIN THREE YEARS; IMPORTING THE ARTICLE PATENTED.—Every patent granted under this act shall be subject, and expressed to be subject, to the condition that such patent, and all the rights and privileges thereby

granted, shall cease and determine and the patent shall be null and void at the end of three years from the date thereof, unless the patentee shall, within that period, have commenced, and shall after such commencement carry on in Canada, the construction or manufacture of the invention or discovery patented, in such manner that any person desiring to use it may obtain it, or cause it to be made for him, at a reasonable price, at some manufactory or establishment for making or constructing it in Canada, and that such patent shall be void if, after the expiration of eighteen months from the granting thereof, the patentee or his assignee or assignees, for the whole or a part of his interest in the patent, imports or causes to be imported into Canada the invention or discovery for which the patent is granted. (§ 28.)

170. PROCEEDINGS FOR IMPEACHMENT OF PATENT.—Any person desiring to impeach any patent issued under this act may obtain a sealed and certified copy of the patent, and of the petition, declaration, drawings, and specification thereunto relating; and may have the same filed in the office of the prothonotary or clerk of the superior court for the Province of Quebec, or of the court of queen's bench or common pleas for the Province of Ontario, or of the supreme court in the Province of Nova Scotia, or of the court of queen's bench in the Province of New Brunswick, according to the domicil elected by the patentee as aforesaid, which courts shall adjudicate on the matter and decide as to costs. The patent and documents aforesaid shall then be held as of record in such court, so that a writ of *scire facias* under the seal of the court, grounded upon such record, may issue for the repeal of the patent for legal cause as aforesaid, if upon

proceedings had upon the writ in accordance with the meaning of this act the patent be adjudged to be void. (§ 29.)

171. CERTIFICATE OF JUDGMENT VOIDING PATENT TO BE ENTERED.—A certificate of the judgment voiding any patent shall, at the request of any person or party filing it to be of record in the Patent Office, be entered on the margin of the enrollment of the patent in the office of the Commissioner, and the patent shall thereupon be, and be held to have been, void and of no effect, unless and until the judgment be reversed on appeal, as hereinafter provided. (§ 30.)

172. JUDGMENT TO BE SUBJECT TO APPEAL.—The judgment declaring any patent void shall be subject to appeal to any court of appeal having appellate jurisdiction in other cases over the court by which the same was rendered. (§ 31.)

XV. Patents Issued under Former Laws.

SEC.
173. Existing provincial patents to remain in force.
174. Handing over records of patent offices to Commissioner.

173. EXISTING PROVINCIAL PATENTS TO REMAIN IN FORCE.—All patents issued under any act of the legislature of the late Province of Canada, or of Nova Scotia, or of New Brunswick, and all patents issued for the Provinces of Ontario and Quebec, under the act of the late Province of Canada, to the date of the coming into operation of the present act, shall remain in force for the same term and for the same extent of territory as if the act under which they were issued had not been re-

pealed, but subject to the provisions of this act in so far as applicable to them.

2. And it shall be lawful for the Commissioner, upon the application of the patentee named in any such patent, being the inventor or discoverer of the subject-matter of the patent and a British subject, or a resident in any Province of Canada for upwards of a year, if the subject-matter of the patent had not been known or used, nor with the consent of the patentee on sale in any of the other Provinces of the Dominion, to issue, on payment of the proper fees in that behalf, a patent under this act, extending such provincial patent over the whole of the Dominion, subject to the provisions of the seventeenth section; but no patent so issued shall extend beyond the remainder of the term mentioned in the provincial patent. (§ 32.)

174. HANDING OVER OF RECORDS OF PROVINCIAL PATENT OFFICE TO THE COMMISSIONER.—All the records of the Patent Offices of the late Province of Canada, and of the Provinces of Ontario and Quebec, of Nova Scotia and New Brunswick, shall be handed over by the officers in charge of them to the Commissioner of Patents of invention or discovery, to form part of the records of the Patent Office for the purposes of this act. (§ 33.)

XVI. Tariff of Fees.

SEC.		SEC.	
175–178.	With reference to fees, how and to whom to be paid.	179.	The Commissioner to have the power of returning one half of the Government fee.

175. FEES HOW AND TO WHOM TO BE PAID.—The following fees shall be payable to the Commissioner before

an application for any of the purposes hereinafter mentioned shall be entertained, that is to say:

On petition for a patent for five years	$20 00
On petition for extension from five to ten years	20 00
On petition for extension from ten to fifteen years	20 00
On lodging a caveat	5 00
On asking to register a judgment *pro tanto*	4 00
On asking to register an assignment	2 00
On asking to attack a disclaimer to a patent	4 00
On asking for a copy of patent with specification	4 00
On petition to reissue a patent after surrender and on petition to extend a former patent to the Dominion the fee shall be at the rate of for every unexpired year of duration of such patent.	4 00

On office copies of documents, not above mentioned, the following charges shall be exacted:

For every single or first folio of certified copy	50
For every subsequent hundred words, (fractions from and under fifty being not counted, and over fifty being counted for one hundred)	25

(§ 34.)

176. FEES, &c.—For every copy of drawings the party applying shall pay such sum as the Commissioner considers a fair remuneration for time and labor expended thereon by an officer of the department or person employed to perform such service. (§ 35.)

177. FEES, &c.—The said fees shall be in full of all services performed under this act in any such case by the Commissioner or any person employed in the Patent Office. (§ 36.)

178. FEES, &c.—All fees received under this act shall be paid over to the Receiver General, and form part of the consolidated revenue fund of Canada, except such sums as may be paid for copies of drawings when made by persons not receiving salaries in the Patent Office. (§ 37.)

179. COMMISSIONER HAS POWER TO RETURN ONE HALF OF GOVERNMENT FEE.—No fee shall be made the subject of exemption in favor of any person; and no fee, once paid, shall be returned to the person who paid it, except:

1. When the invention is not susceptible of being patented;

2. When the petition for a patent is withdrawn.

And in every such case the Commissioner may return one half of the fee paid;

And in the case of withdrawal, a fresh application shall be necessary to revive the claim, as if no proceeding had taken place in the matter. (§ 38.)

XVII. Miscellaneous Provisions.

SEC.

180. Applicant may file a caveat.
181. Causes why Commissioner may refuse to grant a patent.
182. Commissioner to notify applicant of rejection.
183. Appeal to Governor in Council.
184. Interfering applications.
185. Documents in Patent Office to be open to inspection of the public, except caveats.
186. Clerical errors.
187. Lost or destroyed patent may be replaced.
188. Use of patented inventions allowed in foreign ships.

SEC.

189. Patent not to affect previous purchaser of invention.
190. Patented articles to be stamped with date of patent.
191. Punishment of parties who stamp an article as patented when such is not the case.
192. Punishment of offenders for making false entry or copy.
193. All acts inconsistent with present act repealed.
194. Title of act: The Patent Act of 1869.
195. Act to commence and take effect July 1, 1869.

180. INTENDING APPLICANT MAY FILE A CAVEAT.—An intending applicant for a patent, who has not yet perfected his invention or discovery and is in fear of being despoiled of his idea, may file in the Patent Office a description of his invention or discovery so far, with or without plans, at his own will; and the Commissioner, on reception of the fee hereinbefore prescribed, shall cause the said document to be preserved in secrecy, with the exception of delivering copies of the same whenever required by the said party or by any judicial tribunal—the secrecy of the document to cease when he obtains a patent for his invention or discovery; and such document shall be called a caveat. Provided always that if application shall be made by any other person for a patent for any invention or discovery with which such caveat may in any respect interfere, it shall be the duty of the Commissioner forthwith to give notice by mail to the person who has filed such caveat, and such person shall within three months after the date of mailing the notice, if he would avail himself of the caveat, file his petition and take the other steps necessary on an application for patent, and if, in the opinion of the Commissioner, the applications are interfering, like proceedings may be had in all respects as are by this act provided in the case of interfering applications. Provided further, that unless the person filing any caveat shall, within four years from the filing thereof, have made application for a patent, the caveat shall be void. (§ 39.)

181. CAUSES WHY COMMISSIONER MAY REFUSE TO GRANT A PATENT.—The Commissioner may object to grant a patent in the following cases:

1. When he is of opinion that the alleged invention or discovery is not patentable in law;

2. When it appears that the invention or discovery is already in the possession of the public with the consent or allowance of the inventor;

3. When it appears that the invention or discovery has been described in a book or other printed publication before the date of the application, or otherwise in the possession of the public;

4. When it appears that the invention or discovery has already been patented, except, however, when the case is one within the seventh section of this act, or one in which the Commissioner has doubts as to whether the patentee or the applicant is the first inventor or discoverer. (§ 40.)

182. COMMISSIONER TO NOTIFY APPLICANT OF REJECTION.—Whenever the Commissioner objects to grant a patent, as aforesaid, he shall notify the applicant to that effect, and shall state the ground or reason therefor with sufficient detail to enable the applicant to answer, if he can, the objection of the Commissioner. (§ 41.)

183. APPEAL TO GOVERNOR IN COUNCIL.—Every applicant who has failed to obtain a patent by reason of the objection of the Commissioner, as aforesaid, may, at any time within six months after notice thereof has been addressed to him or his agent, appeal from the decision of the Commissioner to the Governor in Council. (§ 42.)

184. INTERFERING APPLICATIONS.—In cases of interfering applications for a patent the same shall be submitted to the arbitration of three skilled persons, one of whom shall be chosen by each of the applicants, and the third person shall be chosen by the Commissioner, or by his deputy, or the person appointed to perform the duty

of that office; and the decision or award of such arbitrators, or any two of them, delivered to the Commissioner in writing, and subscribed by them, or any two of them, shall be final as far as respects the granting of the patent.

2. If either of the applicants refuses or fails to choose an arbitrator, when required so to do by the Commissioner, the patent shall issue to the opposite party; and when there are more than two interfering applicants, and the parties applying do not all unite in appointing three arbitrators, the Commissioner or his deputy, or person appointed to perform the duty of that office, may appoint the three arbitrators for the purposes aforesaid. (§ 43.)

185. DOCUMENTS IN PATENT OFFICE TO BE OPEN TO INSPECTION OF THE PUBLIC, EXCEPT CAVEATS.—All specifications, drawings, models, disclaimers, judgments, and other papers, except caveats, shall be open to the inspection of the public at the Patent Office, under such regulations as may be adopted in that behalf. (§ 44.)

186. CLERICAL ERRORS.—Clerical errors happening in the framing or copying of any instrument of the Patent Office shall not be construed as invalidating the same, but when discovered they may be corrected under the authority of the Commissioner. (§ 45.)

187. LOST OR DESTROYED PATENT MAY BE REPLACED.—In case any letters patent shall be destroyed or lost, others of the like tenor, date, and effect may be issued in lieu thereof, on the party paying the fees hereinbefore prescribed for office copies of documents. (§ 46.)

188. USE OF PATENTED INVENTIONS ALLOWED IN FOREIGN SHIPS.—No letters patent shall extend to prevent the use of any invention or discovery in any foreign ship

or vessel, where such invention or discovery is not so used for the manufacture of any goods to be vended within or exported from Canada. (§ 47.)

189. PATENT NOT TO AFFECT PREVIOUS PURCHASER OF INVENTION.—Every person who, before the issuing of a patent, has purchased, constructed, or acquired any invention or discovery, for which a patent has been obtained under this act, shall have the right of using and vending to others the specific art, machine, manufacture, or composition of matter patented, so purchased, constructed, or acquired before the issue of the patent therefor, without being liable to the patentee or his representatives for so doing; but the patent shall not be held invalid as regards other persons by reason of such purchase, construction, or acquisition, or use of the invention or discovery by the person first aforesaid, or by those to whom he may have sold the same, unless the same was purchased, constructed, or acquired, or used for a longer period than one year before the application for a patent therefor. (§ 48.)

190. PATENTED ARTICLES TO BE STAMPED WITH DATE OF PATENT.—Every patentee under this act shall stamp or engrave on each patented article sold, or offered for sale, by him, the year of the date of the patent applying to such article, thus: "Patented 1869," or as the case may be; and any such patentee selling or offering for sale any such patented article not so marked, shall be liable to the punishment of a fine not to exceed $100, and in default of the payment of such fine to imprisonment not to exceed two months. (§ 49.)

191. PUNISHMENT OF PARTIES WHO STAMP AN ARTICLE AS PATENTED WHEN SUCH IS NOT THE CASE.—Whosoever

writes, paints, prints, molds, casts, carves, engraves, stamps, or otherwise marks upon anything made or sold by him, and for the sole making or selling of which he is not the patentee, the name, or any imitation of the name, of any patentee for the sole making or selling of such thing, without the consent of such patentee, or without the consent of the patentee writes, paints, prints, molds, casts, carves, engraves, stamps, or otherwise marks upon anything not purchased from the patentee, the words "patent," "letters patent," "Queen's patent," "patented," or any word or words of like import, with the intent of counterfeiting or imitating the stamp, mark, or device of the patentee, or of deceiving the public and inducing them to believe that the thing in question was made or sold by or with the consent of the patentee, shall be deemed to have committed a misdemeanor, and shall, on conviction, be punished therefor by fine or by imprisonment, or both, in the discretion of the court before which the conviction shall be had; but the fine shall not exceed $200, nor shall the imprisonment exceed three months. (§ 50.)

192. PUNISHMENT OF OFFENDERS FOR MAKING FALSE ENTRY OR COPY.—Any person willfully making or causing to be made any false entry in any register or book, or any false or altered copy of any document relating to the purposes of this act, or who shall produce or tender any such false or altered document, knowing the same to be such, shall be guilty of a misdemeanor, and shall be punished by fine and imprisonment accordingly. (§ 51.)

193. ALL ACTS INCONSISTENT WITH PRESENT ACT REPEALED.—Chapter thirty-four of the Consolidated Statutes of the late Province of Canada, respecting patents

for inventions, chapter one hundred and seventeen of the Revised Statutes of Nova Scotia, (third series,) chapter one hundred and eighteen of the Revised Statutes of New Brunswick, and any act amending any of the said chapters or any other act, are hereby repealed, in so far as they or any of them may be inconsistent with this act, or make any provision in any matter provided for by this act, except only as respects all rights acquired and penalties or liabilities incurred under the said laws, or any of them, before the coming into force of this act. (§ 52.)

194. TITLE OF ACT: THE PATENT ACT OF 1869.—When citing this act it shall be sufficient to call it "The Patent Act of 1869." (§ 53.)

195. ACT TO COMMENCE AND TAKE EFFECT JULY 1, 1869.—This act shall commence and take effect on the first day of July, 1869. (§ 54.)

XVIII. Rules, Regulations, and Forms of the Canadian Patent Office.

SEC.
196. Date of approval.
197. Personal appearance.
198. Applicant responsible.
199. Correspondence.
200. Clerical requirements.
201. Address.
202. Forms.
203. Petition.
204. Joint application.
205. Oath.
206. Specification.
207. Drawings.
208. Extension.
209. Form of patent.
210. Model.
211. Fees.
212. Time for perfecting application.
213. Separate inventions cannot be claimed in one application.
214. Protest.
215. Cases of doubt.
216. Caveat.
217. Intricate cases.
218. General remarks.

196. DATE OF APPROVAL.—The following rules were

approved by the Governor in Council on the 2d of July, 1869, under the patent act of 1869.

197. PERSONAL APPEARANCE.—There is no necessity for any personal appearance at the Patent Office, unless specially called for by order of the Commissioner or the Deputy Commissioner, every transaction being carried on by writing. (Rules of 2d July, 1869.)

198. APPLICANT RESPONSIBLE.—In every case the applicant or depositor of any paper is responsible for the merits of his allegations, and of the validity of the instruments furnished by him or his agent. (*Ib.*)

199. CORRESPONDENCE.—The correspondence is carried on with the applicant, or with the agent who has remitted or transmitted the papers to the office, but with one person only. (*Ib.*)

200. CLERICAL REQUIREMENTS.—All papers to be clearly and neatly written on foolscap paper, and every word of them is to be distinctly legible, in order that no difficulty should be met with in taking cognizance of and in registering and copying them. (*Ib.*)

201. ADDRESS.—All communications are to be addressed in the following words: "To the Commissioner of Patents, Ottawa." (*Ib.*)

202. FORMS.—As regards proceedings not specially provided for in the following forms, any form being conformable to the letter and spirit of the laws will be accepted, and if not so conformable will be returned for correction. (*Ib.*)

203. PETITION.—The petition asking for the granting of a patent of invention shall be made after the following form: (*Ib.*)

To the Commissioner of Patents,

Ottawa:

The petition of [*Christian name or names in full of inventor, inventors, assignee, or other legal representative of inventor*], of the [*city, town, or other locality, as the case may be*], in the Province of [*as the case may be*], [*trade or profession*], showeth: That your petitioner has been a resident of Canada for at least one year next before the present application [*mention to be made of place, and changes of residence*]; that he hath discovered [*or "invented," as the case may be*] a certain new and useful [*art, "machine," "manufacture," or "composition of matter," as the case may be, or certain new and useful "improvements"*], on a certain [*art, "machine," "manufacture," or "composition of matter," as the case may be*], now in ordinary use for [*stating the use or object of the art, &c., as the case may be*], to be called or known as ["*name of invention or improvement*"], and that such his discovery [*or "invention," as the case may be*], was and is not known or used by others before his discovery [*or "invention," as the case may be*] thereof, and was and is not, at the time of this application, in public use or for sale with his consent or allowance as such inventor [*or discoverer, as the case may be*]; and that the oath or affirmation, drawings, descriptions, and specifications thereof, in duplicate, are transmitted herewith, pursuant to the statute in such case made and provided; the said invention being [*insert here a very short description of the invention and of its object*].

Your petitioner, being desirous of obtaining an exclusive property in the said invention or discovery [*as the case may be*], therefore prays that a patent may be granted to your petitioner therefor for the term allowed by law; and, for the purposes of the patent act of 1869, your petitioner elects his domicil in the [*city, town, or locality, as the case may be*], in the county of [*name of county*], in the Province of [*name of Province*].

[*Signature of inventor.*]

[*Place and date.*]

204. JOINT APPLICATION.—In case of joint applications, in cases of applications from assignees, heirs, or other legal representatives, the petition should, otherwise being made after the above given form, be altered, according to the circumstances of the case, to meet the requirements of the statute, particularly of §§ 8, 10, 11, 12. (*Vide supra* pp. 116, 117, 118.)

205. OATH.—The oath to be subscribed by an appli-

cant for a patent of invention shall be made after the following form: (*Ib.*)

Canada, Province of
county of

I, , of , in the county of , in the Province of , make oath and solemnly swear, that I verily believe that I am the inventor [*or discoverer*] of the invention which I call [*name of the invention*], and for which I solicit a patent by my petition to the Commissioner of Patents, dated the [*insert date of petition*], and I further make oath that I have been a resident of Canada for one year next before my application. [*Signature of deponent.*]

Sworn and signed before me this [*day of month and year*], at [*name of place*].

[*Signature of J. P.*],
Justice of the Peace.

The same general form is to be adopted, with such alterations as may be necessitated by circumstances, where the application is made abroad, or by joint inventors, by assignees, heirs, or other legal representatives, in conformity with the patent act, § 11. (*Ib.*)

206. SPECIFICATION.—The specification accompanying a petition for a patent of inventions shall be made in duplicate, and after the following form: (*Ib.*)

To all whom it may concern:

Be it known that I, [*name of inventor or discoverer, as the case may be,*] of [*place of residence and trade or profession; if more than one inventor, add his or their names, place of residence, and trade or profession, and word the specification throughout according to circumstances*], have invented a new and useful [*art, "machine," &c., same as in petition*], and I do hereby declare that the following is a full, clear, and exact description of the construction and operation of the same. [*Reference being had to the annexed drawings, where the nature of the case admits of drawings; describe the several drawings, and refer to the parts by letters. Here describe the principle, and the several modes in which the applicant contemplates the application of that principle or character, by which the invention or discovery may be dis-*

tinguished from other inventions or discoveries.] What I claim in my invention is, [*here express the nature and character of the invention in short, without reference to its advantages, and identify the parts claimed, separately or in combination. If the specification is for an improvement or improvements, the original invention should be disclaimed, and the improvement or improvements clearly and separately enumerated, as distinguished from the original object so improved.*]

[*Place, date, and year.*]

[*Signature of inventor.*]

Signed in the presence of—

[*Signatures of two witnesses, and to be the same as those who attest the drawing.*]

207. DRAWINGS.—The drawings illustrating the specification filed with an application for a patent of invention shall be made in accordance with the following directions and form, and furnished in duplicate:

The drawings are to be made on tracing linen, each sheet to be of the size of a foolscap sheet of paper, and the said sheets as few in number as possible. The different figures of the drawings are to be marked thus: Fig. 1, front view; fig. 2, side view, &c., &c.; and the separate parts are to be marked with letters in the specification and on the drawing sheet itself; the drawing must bear the name of the invention, and be signed by the inventor and the two same witnesses who signed the specification, all after the following general form. The drawings are to be neatly executed, and without colors:

[*Title of the invention.*]

Fig. 1, front view.
[*Drawing.*]

Fig. 2, side view.
[*Drawing.*]

Fig. 3, cross section.
[*Drawing.*]

Fig. 4, wheel.
[*Drawing.*]

Reference for example:

a. Shaft;
b. Valve;
c. Regulator;
&c., &c., &c.

Certified that this is the drawing referred to in the specification hereunto annexed.

[*Signature of the applicant.*]

[*Place and date.*]

[*Signature of inventor.*]

[*Signature.*]
[*Signature.*] } Witnesses.

208. EXTENSION.—An application to obtain the extension of a former patent to the whole of the Dominion must be accompanied with the former patent itself, with neat duplicate copies of the original specification and drawing, certified by the inventor before the same two witnesses signing the petition; and the said petition shall be made after the following form: (*Ib.*)

To the Commissioner of Patents,

Ottawa:

I, [*names,*] of the [*locality of residence*], in the county of [*name of county*], in the province of [*or elsewhere, as the case may be*], being a British subject, [*or a resident of Canada for upwards of a year,*] and being the discoverer [*or inventor*] of the subject-matter of a patent granted to me on [*day, month, and year*], in the province of [*Nova Scotia, New Brunswick, or former Province of Canada, or for the Provinces of Ontario and Quebec, as the case may be*], which I now produce, and the said subject-matter of my said invention and patent called [*name of invention*] being not, with my consent, known or used nor on sale in any of the other Provinces of the Dominion, I hereby therefore pray that a patent, under the "Patent Act of 1869," be granted to me, extending the privileges of my former patent over the whole of the Dominion for the remainder of the term mentioned in my former patent, namely, to the [*insert day, month, and year at which the former patent was to expire.*]

In testimony thereof I have signed in the presence of the two undersigned witnesses at the place and date hereunder mentioned.

[*Place and date.*]

[*Signature of the applicant.*]

[*Signatures of the two witnesses.*]

209. FORM OF PATENT.—A patent of invention will be made after the following form: (*Ib.*)

Canada Patent of Invention.

[SEAL.] Whereas in accordance with an act of the Parliament of Canada, called "The Patent Act of 1869," [*names of patentee*], of the [*name of locality*], in the province of [*name of province*], being a resident of Canada, having elected his domicil, for the purpose of the present patent, in [*designation in full of domicil elected*], having otherwise complied with the requirements of the said act to obtain a patent, and having furnished specification and drawings, one duplicate of each being hereunto annexed as part essential of this present patent, the said specification and drawings being the description and illustration of the said invention called [*name of the invention or improvement*], of which the said [*names*] declares himself to be the inventor.

The present patent is granted to him, his heirs, assigns, or other legal representatives, for the period of five years from the date thereof, subject to extension of further periods, in accordance with "The Patent Act of 1869," to confer on the said patentee all the privileges intended to be conferred by the said act, or by the patentee complying with the further obligations required by the said act.

Provided always that the validity of this present patent rests on the truthfulness of the allegations, description, and specification of the said patentee.

The present patent, however, shall cease and determine and be null and void at the end of three years from the date thereof, unless the patentee shall within that period have commenced, and after such commencement carry on, in Canada the construction or manufacture of the said invention, and shall cease and determine and be null and void at the end of eighteen months from the granting thereof, if the patentee or his legal representatives import, or cause to be imported, into Canada the invention for which the patent is granted.

In testimony whereof the present patent has been signed according to the said act, sealed with the seal of the Patent Office, and countersigned in the Department of Agriculture, on the [*date, month, and year written in full and prominently.*]

[*Signature of the Commissioner of Patents or of a member of the Privy Council.*]

Countersigned:

Deputy Commissioner.

This specification will be attached to the patent to form an essential part thereof, and the first folio of the said specification will be sealed at one corner with the seal of the Patent Office. (*Ib.*)

The present form, otherwise remaining the same, will be altered in some particulars to meet the circumstances of the case when the patent is given to joint inventors, to an assignee or assignees, to legal representatives, or when it is a patent extending a former patent to the whole of the Dominion, or is a reissue, or in any other special case. (*Ib.*)

210. MODEL.—The models required by law must be neat and substantial working models, the dimensions of which are not to exceed, in any case, eighteen inches in their longest side, unless otherwise allowed by special permission previously obtained. Such models must be so constructed as to show exactly every part of the invention and its mode of working. In cases where samples of ingredients and samples of the composition made of such ingredients (neither of which being dangerous or explosive substances) are required by law, they must be contained in glass bottles, properly arranged. Both models and bottles must bear the name of the inventor, the title of the invention, and the date of the application; and they must be furnished to the Patent Office free of every charge, and delivered in good order.

211. FEES.—All fees required by law shall be transmitted with the application to which they appertain in values not subject to any discount, and be better made, whenever practicable, in post-office money-orders, inclosed in registered letters. (*Ib.*)

212. APPLICATIONS TO BE PERFECTED WITHIN TWO

YEARS.—All applications must be proceeded with and perfected within two years after the lodging of the petition, in default of which it will be regarded as abandoned, and all previous proceedings and payment of fees will be held at the expiration of that period as of no avail. (*Ib.*)

213. SEPARATE INVENTIONS CANNOT BE CLAIMED IN ONE APPLICATION.—Two or more separate inventions cannot be claimed in one application, nor patented in one patent, unless they are so dependent of and connected with each as to be necessarily taken together to obtain the end sought for by the inventor; and in this latter case the Commissioner of Patents is the judge as to whether or not the pretensions of the applicant are founded in fact and reason. (*Ib.*)

214. PROTEST.—The filing of a protest against the issuing of a patent shall not be taken in itself as a sufficient reason to withhold the granting of such patent to an applicant. (*Ib.*)

215. CASES OF DOUBT.—In cases of doubt, and in accordance with the letter and meaning of the law, patents may be issued for an invention already patented, a trial before a judicial tribunal being in such cases the only means of discovering who is the real or first inventor.

216. CAVEAT.—A caveat must be composed of a specification, (and drawings,) and as long as it remains uninterfered with, and that the filer is not called upon to lodge his application in due form on account of an interfering application, the said proprietor thereof can lodge with it additional papers, provided these papers are relevant exclusively to the perfecting of the same invention in progress of completion. (*Ib.*)

217. INTRICATE CASES.—All cases connected with the intricate and multifarious proceedings issuing from the working of a law of patents of invention, which are not specially defined and provided for in these rules, shall be decided, in accordance with the merits of each case, by authority of the Commissioner of Patents, and the decision shall be communicated to the interested parties through the departmental correspondent of the Patent Office. (*Ib.*)

218. GENERAL REMARKS.—The correspondence with the department is carried through the Canadian mail free of postage. The forwarding of any paper should always be accompanied by a letter, and a separate letter should be written in relation to each distinct subject.

It is particularly recommended that reference should be made to the law before writing on any subject to the department, in order to avoid unnecessary explanations and useless loss of time and labor; and it is also recommended in every case to have the papers and drawings prepared by a competent person, for the interest both of the applicant and of the public service.

A sufficient margin should be left on paper, and especially on specifications and assignments, for the insertion of references or certificates and for the affixing of the seal thereto.

Although it is optional for the applicant to annex drawings to the specification of a caveat or not, still it is important in the party always to attach drawings to the said specification.

It must be remembered, that the better papers are executed the sooner the work is dispatched at the office,

and the surer the regularity of the proceedings is guarantied.

It must be remembered, when drawing the petition for a patent of inventions, that if a charge in the residence mentioned has taken place during the year next to the date of the petition, the change or changes should be mentioned, in accordance with the twelfth section of the patent act of 1869. (*Ib.*)

XIX. Cape of Good Hope.

Sec.		Sec.	
219.	Law, date, and where recorded.	223.	Documents, where to be left.
220.	Kinds of patents.	224.	Assignments.
221.	Duration.	225.	Specifications and drawings.
222.	Government fees.	226.	Other legal provisions.

219. Law, Date, and where Recorded.—Act No. 17, of 1860, dated 30th August, 1860. (See *Commissioners of Patents' Journal, vide supra* 71, No. 727, An., 1860.)

220. Kinds of Patents.—Letters patent granted to the true and first inventor. Disclaimer and alterations. English patents granted *before* the 1st July, 1860, to be valid in the colony.

221. Duration.—Fourteen years. Patents to expire at the end of the third or seventh year, if the requisite payments are not made. Letters patent for foreign inventions not to continue after expiration of foreign patent. Extension for a term not exceeding fourteen years after the expiration of the first term.

222. Government Fees.—On deposit of specification, £2 10*s.*; to the Attorney General for any appointment, £2 4*s.* 6*d.*; on obtaining letters patent, £2 10*s.*; at or

before the expiration of third year, £10; at or before the expiration of seventh year, £20; to the Attorney General with particulars of objections, £2 4*s.* 6*d.*; on presenting petition for examination or confirmation, £2 10*s.*; every search and inspection, 1*s.*; entry of assignment or license, 10*s.*; certificate of assignment or license, 10*s.*; filing memorandum of alteration or disclaimer, £2 10*s.*; entering any caveat, £2 10*s.*; copy or extract of any writing, per common law folio, 1*s.*

223. DOCUMENTS REQUIRED, AND WHERE TO BE LEFT.—A complete specification (two copies) and drawings and models, if any, to be deposited at the office of the Colonial Secretary. Notice to proceed to be given to the Attorney General for publication in the government gazette and two local papers. Grant for letters patent issued by Attorney General after one month's notice. Letters patent, bearing date of deposit of specification, to be issued within three months after said warrant, or during the protection.

224. ASSIGNMENTS.—Registered as above, and legal copies thereof to be had. More than twelve persons may have a legal and beneficial interest in one patent.

225. ORIGINALS OF SPECIFICATIONS AND DRAWINGS, DISCLAIMERS, &C.—To be filed at the end of six months, at a proper office, with indexes, registers, &c., for public inspection.

226. OTHER LEGAL PROVISIONS.—Patent of true inventor not to be affected by specification of pretended inventor. Letters patent may be repealed or withheld and specification canceled by writ of the supreme court, in the nature of a writ of *scire facias* in England. Letters patent not to prevent the use of invention in foreign

ships resorting to ports in the colony. Penalty for unauthorized uses of word "patent," £100.

XX. Ceylon.

Sec.		Sec.	
227.	Law, date, and where recorded.	231.	Documents, where to be left.
228.	Kinds of patents.	232.	Specification, inspec'n, copies.
229.	Duration.	233.	Assignments.
230.	Government fees.	234.	Other legal provisions.

227. LAW, DATE, AND WHERE RECORDED.—Inventions ordinance, 1859. (See *Commissioners of Patents' Journal, vide supra* 71, No. 684, An., 1860.)

228. KINDS OF PATENTS.—Patents for invention and importation. English patents granted prior to the date of this ordinance admissible. Prerogative of Crown saved.

229. DURATION.—Fourteen years. Extension of fourteen years more on petition presented not more than one year and not less than six months before the expiration of original term.

230. GOVERNMENT FEES.—Stamp of petition, £10.

231. DOCUMENTS REQUIRED AND WHERE TO BE LEFT.—Petition of the inventor, or his authorized agent, addressed to the Government, for leave to file specification, to be left with the Colonial Secretary of Government. Crown to refer petition for inquiry and report. Specification and declaration signed by inventor or his proxy.

232. SPECIFICATION, INSPECTION AND COPIES OF.—At the office of the Colonial Secretary. Fee, 5*s*. Certificate copies to be *prima facie* evidence.

233. ASSIGNMENTS.—Registered at the office of the

Colonial Secretary, and open to public inspection without fee.

234. OTHER LEGAL PROVISIONS.—False statement in declaration punishable as perjury. Invention not publicly used or known before application to file specification, or known only by fraudulent means, to be deemed new invention. Exclusive jurisdiction vested in the district court of Colombo. Causes of forfeiture: Invention not new; petitioner not the inventor; invention not described in specification; fraud in petition or specification; false statement in petition; fraudulent misdescription of part of invention in specification. Actual inventors entitled to assignment of an exclusive privilege fraudulently obtained.

XXI. Cuba, Porto Rico, and the Philippine Islands.

SEC.	SEC.
235. Law, date, and where recorded.	239. Government fees.
236. Kinds of patents.	240. Specifications, inspection of.
237. Duration.	241. Assignments.
238. Documents, where to be left.	242. Working.

235. LAW, DATE, AND WHERE RECORDED.—Royal decree of the 30th July, 1833. (See *Commissioners of Patents' Journal, vide supra* 71, No. 498, An., 1858.)

236. KINDS OF PATENTS.—Letters patent for inventions, improvements, and importation, (the latter under certain restrictions when relating to agriculture.) Letters patent to be taken up by their owner within three months of application.

237. DURATION.—Patent for invention, five, ten, and fifteen years; patent for importation, five years; exten-

sion, five years for patent of invention of five years, to be reckoned from the day of delivery.

238. DOCUMENTS REQUIRED AND WHERE TO BE LEFT.—A petition of the inventor, or his agent, addressed to the Governor General of Cuba, together with a correct description, plan, or model, (all sealed up.) Grants of patents to be published in the government papers and in the *Madrid Gazette.*

239. GOVERNMENT FEES.—Patent of five years, $70 (pesos;) patent of ten years, $210 (pesos;) patent of fifteen years, $420 (pesos;) patent of importation, $210 (pesos; besides $8 for delivery of letters patent.

240. SPECIFICATIONS, INSPECTION OF.—Public register at the chambers of commerce. Specification and models open to the public after expiration of patent.

241. ASSIGNMENTS.—Certificates of assignments to be delivered within sixty days from their date.

242. WORKING.—Not to be interrupted for one year and one day.

XXII. France.

SEC.
243. Law, date, and where recorded.
244. Kinds of patents.
245. Previous examination.
246. Duration.
247. Government fees.
248. Documents required, and where to be left.
249. Working and prolongation.
250. Assignments.
251. Specifications, inspection and copies of.
252. List of patents delivered.
253. Specifications published.
254. Originals of specifications, (models.)
255. Jurisdiction, local proceedings.
256. Proceedings to obtain a patent.
257. Form of French letters patent.

243. LAW, DATE, AND WHERE RECORDED.—Royal decree

of 5th July, 1844. (See *Commissioners of Patents' Journal, vide supra* 71, Nos. 228, 229, 947, 948, and 949.)

244. KINDS OF PATENTS.—Patents of invention and certificates of addition for France and the French Colonies granted to natives or foreigners residing or represented in France. (Certificates of addition preferably to the original patentee within the first year.)

245. PREVIOUS EXAMINATION.—None. Neither medicines nor financial schemes can be patented. Patent articles to bear the mark "S. g. d. G.," (without guaranty of the Government,) under a penalty of from £2 to £40.

246. DURATION.—Five, ten, or fifteen years from the date of deposit. Foreign inventions according to the term of the original foreign patent.

247. GOVERNMENT FEES.—One hundred francs each year. In case of transfer, the whole term originally demanded must be paid at once. Certificates of addition, twenty francs. (1 fr.=10d.)

248. DOCUMENTS REQUIRED AND WHERE TO BE LEFT.—A petition of the inventor, or his proxy, to the Minister of Commerce and Public Works; a specification, (two copies,) drawings, (two copies,) on a metrical scale, or specimens; an acknowledgment of the receipt of one hundred francs paid to the Receveur Général; a memorandum of the various documents deposited at the secrétariat of the respective préfecture; at Paris, at the Hôtel de Ville. In the Colonies, three copies of said documents to be delivered to the Director of the Interior.

249. WORKING AND PROLONGATION.—Working within two years; not to be interrupted for two years. Prolongation only by a special law.

250. ASSIGNMENTS.—Made before notary public and

registered at the préfecture; a register also kept at the Ministry of Agriculture and Commerce. In the Colonies, assignments are registered at the office of the Director of the Interior.

251. SPECIFICATIONS, INSPECTION AND COPIES OF.—Inspection fee, at the Ministry of Commerce and Public Works; copies on payment of twenty-five francs; drawings extra; copies of certificates of addition twenty francs.

252. LIST OF PATENTS DELIVERED.—Published monthly within six months of the date of application; also in the *Commissioners of Patents' Journal.*

253. SPECIFICATIONS PUBLISHED.—After payment of the second annual fee, in full or in the form of extracts. Kept at the Secrétariat of the Préfecture of each Department, also at the Public Free Library of the Patent Office, together with alphabetical and subject-matter indexes of all the specifications published under the old law of 1791 and new law of 1844.

254. ORIGINALS OF SPECIFICATIONS, (MODELS.)—Deposited, at the expiration of the patent, in the library of the Conservatoire des Arts et Métiers.

255. JURISDICTION AND LOCAL PROCEEDINGS.—Actions to be tried before the Tribunaux Civils de Première Instance, according to article 405 and following of the Code Civil; in the Colonies, before the court of appeal. Fines for infringement, from £4 to £80, with seizure of the goods or machines, damages to the patentee, and costs of publication of judgment; in case of a second offense, imprisonment of from one to six months, according to article 463 of the Penal Code.

256. PROCEEDINGS TO OBTAIN A PATENT.—The appli-

cant must deposit at the office of the Secretary of the Prefect of the Seine, (*au Secrétariat de la Préfecture*,) or in the provinces at the departmental prefectures, a sealed packet, containing the following documents, which must be in the French language, and without alterations or interlineations; any words erased must be counted and verified with the initials of the applicant and references to the pages; and when stating weights or measures those only must be employed which are decreed by the law of the 4th July, 1837:

1. A letter to the Minister of Agriculture and Commerce, containing a request for a patent.

2. A description of the discovery, invention, or application forming the subject of the patent.

3. A duplicate of the same.

4. The drawings or patterns necessary for understanding the description.

5. A duplicate of the same.

6. A list of the above documents.

The request for a patent must be limited to one principal object, with its constituent details and proposed application.

It shall mention the number of years for which the patent is solicited, and contain neither restrictions, conditions, nor reserves.

It shall indicate by a title the summary and precise designation of the object invented.

The drawings must be traced in ink, according to a metrical scale.

All the documents must be signed by the applicant or his agent. An agent must be authorized by a written power of attorney. This power ought, according to the

regulations, to be legalized, but in practice this is not required.

Besides the sealed packet containing the above documents, the applicant must hand in a receipt for one hundred francs, being the first year's payment of the patent tax. The Paris office, at which these payments are to be made, is that of the Receveur Central, Rue Neuve des Mathurins, No. 36.

These requirements fulfilled, the applicant receives a certificate stating the day and hour of depositing the documents. The patent commences from this date.

The documents are then transmitted by the prefect to the Minister of Agriculture and Commerce, and the patent is returned to the applicant in regular order. The patent consists in a decree of the minister declaring the regularity of the patent, accompanied by one of the copies of the description and drawings, duly certified.

The patent is delivered at the risk of the applicant, and without guaranty from the Government either as to the reality, the novelty, or the merit of the invention, or the accuracy of the description.

257. Form of French Letters Patent.—

Patent of Invention without guaranty of the Government.

The Minister Secretary of State, at the Department of Agriculture, Commerce, and Public Works, considering the law of the 5th July, 1844, considering the declaration made on the , at forty minutes past three, at the office of the Secretary General of the Preference of the Department of , and which establishes the delivery made by , of an application for a patent of invention for [*title of the patent*], decrees as follows:

Art. 1. A patent of invention for years, to begin from , for [*title*] is herewith delivered to , without previous examination, at his own risk, and without guaranteeing either the reality, novelty, or merit of the invention, or the correctness of the description.

ART. 2. The present decree constituting letters patent is delivered to prove his title. This decree will be accompanied with one of the duplicates of the description delivered in support of the application, the conformity between the descriptive documents having been duly established.

PARIS, the .

For the Minister and by Delegation
the Director of the Commerce of the Interior.
[Signed] E. JULIEN.

For true copy,
[L. S.]

The Chief Clerk,
L. SMITH.

XXIII. Greece.

258. Government may grant privileges for inventions.

258. GOVERNMENT MAY GRANT PRIVILEGES FOR INVENTIONS.—According to a law passed in 1843 the Government is empowered to grant privileges for inventions, subject to the approbation of the Senate.

XXIV. British Guiana.

SEC.
259. Law, date, and where recorded.
260. Kinds of patents.
261. Previous examination.
262. Duration.
263. Government fees.
SEC.
264. Documents required, and where to be left.
265. Assignments.
266. Originals of specifications, &c.
267. Other legal provisions.

259. LAW, DATE, AND WHERE RECORDED.—Ordinance No. 13, of the year 1861. (See *Commissioners of Patents' Journal, vide supra* 71, No. 798, An., 1861.)

260. KINDS OF PATENTS.—Letters patent to the true and first inventor; disclaimer and alterations; under the seal of the colony. English patents not to be affected by this ordinance.

261. PREVIOUS EXAMINATION.—By the Attorney General as to correctness of description.

262. DURATION.—Fourteen years. Patents to expire if before the end of the first seven years the required stamp duty has not been paid. Letters patent for foreign invention not to continue after expiration of foreign patent. Extension of original to another term not exceeding seven years by six months' previous notice.

263. GOVERNMENT FEES.—*To be paid at the Attorney General's office:* On examining provisional specification to be paid on filing petition, $25; on reporting an application for letters patent after notice to proceed, $25; on giving notice of disclaimer or alterations, $25; on entering caveat, $25. *Stamp duties to be paid at the Government Secretary's office:* On notice to proceed, $5; on the sealing of the letters patent, $20; on the letters patent or a duplicate thereof before the expiration of the seventh year, $100; on petition for confirmation or prolongation of patent, $50; on the sealing of grant confirming or prolonging letters patent, $100. *Fees to be paid at the Register office:* On recording letters patent, 5 cents; on depositing complete specification, including copy, $15; on entering disclaimer or alteration, including copy and notification in the official gazette, $10; on entering caveat, including copy and notification in the official gazette, $10. For copy of any of the before-mentioned documents, or of any provisional specification deposited, per page, 25 cents. On inspecting register of patents, for each patent and all documents connected therewith, 48 cents. (N. B. For copies of drawing, extra.)

264. DOCUMENTS REQUIRED, AND WHERE TO BE LEFT.—Petition, affidavit, and provisional (or complete) specifi-

cation, by inventor or his proxy, to be left at the office of the Government Secretary for provisional protection during twelve months. Provisional protection and notice to proceed to be advertised in the official gazette. Warrant to be issued after one month's notice.

265. ASSIGNMENTS.—Registered as above.

266. ORIGINALS OF SPECIFICATIONS, DISCLAIMERS, DRAWINGS, &c.—To be copied in the register of patents at the end of twelve months, and kept at a proper office, with indexes, &c., for public inspection.

267. OTHER LEGAL PROVISIONS.—Letters patent not to prevent the use of invention in foreign ships resorting to ports in the colony, (provided English ships enjoy the same privilege in the respective foreign ports.)

XXV. India.

SEC.	
268.	Law, date, and where recorded.
269.	Kinds of patents.
270.	Duration.
271.	Government fees.
272.	Documents, where to be left.
273.	Extension.
274.	Disclaimer.
275.	Specification, inspection, copies.
276.	Assignments.
277.	List of patents delivered.
278.	Jurisdiction.
279.	Chief legal provisions.
280.	Proceedings to obtain a patent.
281.	Form of petition.
282.	Form of declaration to accompany petition.
283.	Form of declaration to accompany specification.
284.	Form of declaration by agent.
285.	Form of petition.

268. LAW, DATE, AND WHERE RECORDED.—Act XV, An., 1859. Dated Osborne, 19th March, 1859. Promulgated in India on the 21st May, 1859. (See *Commissioners of Patents' Journal, vide supra* 71, Nos. 552 and 578.)

269. KINDS OF PATENTS.—Exclusive privileges granted to the original inventor, whether a native or alien, or his

authorized agent in India, subject, however, to any such conditions and restrictions as the Governor General may think expedient.

270. DURATION.—Fourteen years from the date of filing the specification.

271. GOVERNMENT FEES.—A stamp duty of one hundred rupees on the petition for leave to file a specification, and a reasonable fee for an inquiry and report, if any, on the petition.

272. DOCUMENTS REQUIRED AND WHERE TO BE LEFT.—A petition of the inventor, or his authorized agent in India, to the Governor General of India in Council, for leave to file a specification; a declaration of the original inventor, or, if absent, of his agent; a specification, with drawings, (five copies,) within six months of the order authorizing the filing of the specification. To be left with the Secretary to the Government of India in the Home Department.

273. EXTENSION.—By the Governor General in Council, for a further term, not exceeding fourteen years from the expiration of the fourteen years, upon petition, to be presented at any period not more than one year and not less than six calendar months before the expiration of the exclusive privilege.

274. DISCLAIMER.—Petitioner, after the filing of his specification, may apply for leave to file amended specification, having the same effect as the specification first filed.

275. SPECIFICATIONS, INSPECTION AND COPIES OF.—At the Government of India in the Home Department, of Bengal, of Fort St. George, of Bombay, of the North-western Provinces. Open to public inspection on pay-

ment of one rupee. Copies to be had at the office of the Secretary to the Government of India on paying the expense of copying.

276. ASSIGNMENTS.—Original inventors have power to assign their patents to other parties. Patents, however, fraudulently obtained, must, on the complaint of the original or actual inventor, made within two years of the filing of specification, be assigned to the latter, the profits thereof, at the same time, having to be accounted for and paid over to the said original or actual inventor.

277. LIST OF PATENTS DELIVERED.—Open at the office of the Secretary to the Government of India on payment of one rupee. Published in the *Commissioners of Patents' Journal.*

278. JURISDICTION.—Her Majesty's courts of judicature.

279. CHIEF LEGAL PROVISIONS.—No person is entitled to an exclusive privilege if the invention is of no utility, if invention is not new, if the petitioner is not the inventor, if the specification does not describe the invention, if petition or specification contains fraudulent mis-statements (false statements in declaration being punishable as perjury.) Exclusive privilege to cease if the Government declares it mischievous, &c., to the public, or if the Government, upon breach of condition proved, declares that it shall cease. Importer of an invention, if not the actual inventor, not to be deemed the inventor. An invention not publicly used or known in the United Kingdom or in India, before the application for leave to file the specification, to be deemed a new invention, (the right of the original inventor being still reserved during the first six months.) Defect in specification or petition, or

want of novelty in invention, &c., no defense to action for infringement. The actual use of an invention in India or the United Kingdom, before date of petition, a defense to such action. Amendment of specification may be ordered by the court. Certified copy to be *prima facie* evidence.

280. PROCEEDINGS TO OBTAIN A PATENT.—The inventor of any new manufacture may petition the Governor General of India in Council for leave to file a specification. The petition must be in writing, signed by the petitioner, or, in case of his absence from India, by his authorized agent, and shall state the name, addition, and place of abode of petitioner, and the nature of the invention. (§ 1.)

281. FORM OF PETITION.—

To the Governor General of India in Council:

The petition of [*here insert name, addition, and place of residence*], for leave to file a specification under act No. .

Showeth,

That your petitioner is in possession of an invention for [*state title of invention*], which invention he believes will be of public utility; that he is the inventor thereof, [*or, as the case may be, the assignee, or the executor or administrator of the inventor;*] and that the same is not publicly known or used in India or any part of the United Kingdom of Great Britain and Ireland, to the best of his knowledge and belief.

The following is a description of the invention, [*here describe it.*]

Your petitioner therefore prays for leave to file a specification of the said invention, pursuant to the provision of Act No. .

And your petitioner, &c.

The day of .

[*Signed.*]

On such a petition the Governor General may make an order authorizing the petitioner to file a specification.

Before making such order the Governor General in Council may refer the petition to any person or persons for inquiry and report, the fee for which is to be paid, the

amount of which, in case of dispute. to be settled by one of the courts of judicature in a summary manner. (§ 3.)

On obtaining such order the petitioner may, within six months, cause a specification of his invention to be filed, and, having done so, he and his legal representatives shall have a right to the exclusive use, &c., of his invention for fourteen years, and for a further term of not exceeding fourteen years, should the Governor General in Council so direct, upon petition from inventor, presented not more than a year nor less than six calendar months before the expiration of the first period of privilege. (§ 4.)

The order may be made subject to such restrictions as the Governor General in Council may think expedient. (§ 5.)

The specification shall be in writing, it shall be signed by petitioner, and shall particularly describe the nature of the invention and in what manner the same is to be performed. (§ 6.)

The petition and specification shall be left with the Secretary to the Government of India in the Home Department, and each petition and specification shall be accompanied by a declaration in writing in the following forms:

282. FORM OF DECLARATION TO ACCOMPANY PETITION.—

I, [*name, addition, and place of residence,*] do solemnly and sincerely declare, that I am in possession of an invention for [*title*]; that I believe the said invention will be of public utility; that I am the inventor thereof, [*or the assignee, or executor, or administrator of the inventor,*] and that the same is not publicly known or used in India or in any part of the United Kingdom of Great Britain and Ireland, to the best of my knowledge and belief; and that, to the best of my knowledge and belief, my said invention is truly described in my petition for leave to file a specification thereof.

The day of

[*Signed.*]

283. FORM OF DECLARATION TO ACCOMPANY SPECIFICATION.—

I, [*name, addition, and residence,*] do solemnly and sincerely declare, that I am in possession of an invention for [*nature of invention*]; which invention I believe will be of public utility; that I am the inventor thereof, [*or the assignee, executor, or administrator of the inventor,*] and that the same is not publicly known or used in India or in any part of the United Kingdom of Great Britain and Ireland, to the best of my knowledge and belief; and that, to the best of my belief, the instrument in writing under my hand, herewith annexed, particularly describes and ascertains the nature of the said invention and in what manner the same is to be performed.

The day of .

[*Signed.*]

If the inventor be absent from India, the petition and specification are to be accompanied also by a declaration from the agent, to the effect that he verily believes that the declaration was signed by the inventor and that the contents are true. The agent's declaration is to be in similar form to that of the inventor, and the date of delivery of the petition and specification is to be indorsed on them and recorded at the office of the secretary. Any false statement in such declaration is punishable as perjury. (§§ 7, 8.)

284. FORM OF DECLARATION BY AGENT WHEN AN INVENTOR IS ABSENT FROM INDIA.—

I, , of , do solemnly and sincerely declare, that I have been appointed by the said his agent, for the purpose of ; and I verily believe that the declaration purporting to be the declaration of the said , marked ( ), was signed by him, and that the contents thereof are true.

The day of .

[*Signed.*]

The fees under the act, and also the fees (if any) of the person to whom the petition may have been referred,

must be paid before filing the specification. (§ 9.) No fee is mentioned in the act, the only stipulation being that the petition for the original grant of exclusive privilege or for its extension must be written on stamped paper of the value of 100 rupees, (£10.) (§ 37.)

An inventor having obtained letters patent in the United Kingdom may, within twelve calendar months from the date of the letters patent, petition the Governor General for the exclusive privilege in India. He must state in his petition that such letters patent have been granted, with the date and term during which they are to be in force. The Indian privilege will cease in case of the revocation of the original letters patent, and shall not exceed the original term, unless the same be renewed. (§ 20.)

285. FORM OF PETITION.—

That your petitioner [*or that A. B., of whom your petitioner is the assignee, or executor, or administrator*] has obtained Her Majesty's letters patent, dated the day of , for [*title of invention*], and that such letters patent are to continue in force for years; that your petitioner believes that the said invention is not now and has not hitherto been publicly known or used in India.

The following is a description of the invention, [*here describe it.*]

Your petitioner therefore prays for leave to file a specification of the said invention, pursuant to the provisions of act No. .

And your petitioner, &c.

The day of .

[*Signed.*]

XXVI. Italy

SEC.
286. Law, date, and where recorded.
287. Kinds of patents.
288. Previous examination.
289. Duration.
290. Government fees.
291. Documents required, and where to be left.
292. Working and prolongation.

SEC.
293. Annulment.
294. Infringements.
295. Assignments.
296. Specifications, inspection and copies of.
297. List of patents delivered.
298. Specifications published.
299. Proceedings to obtain a patent.
300. Petition.
301. Description.
302. Memorandum.

286. LAW, DATE, AND WHERE RECORDED.—Royal decree of 31st January, 1864. (See *Commissioners of Patents' Journal, vide supra* 71, Nos. 1061, 1064, 636, 1656.

287. KINDS OF PATENTS.—Patent certificates, (letters patent;) certificates of addition; certificates of reduction, (disclaimers;) certificates of prolongation; delivered to natives or aliens residing or represented in Italy.

288. PREVIOUS EXAMINATION.—None as to novelty and utility, except with regard to inventions concerning beverages and food, which are to be referred to the board of health.

289. DURATION.—From one to fifteen years, to begin from the last day of either March, June, September, or December which follows nearest to the day of application. Foreign patents not to exceed their term allowed abroad. Original term of less than fifteen years prolonged to fifteen years.

290. GOVERNMENT FEES.—A proportional tax of as many 10 lire as there are years in the duration of the respective patent, and an annual tax of 40 lire for each of the first three years; 65 lire for each of the fourth, fifth, and sixth years; 90 lire for each of the seventh, eighth, and ninth years; 115 lire for each of the tenth, eleventh, and twelfth years; and 140 lire for each of the last three years. The first annuity and proportional tax to be paid at the time of application. Certificates of addition, 20

lire; certificates of prolongation, 40 lire; certificates of reduction, (disclaimers to be filed within the first six months,) 40 lire; extra copy of any certificate, 15 lire; (1 lira=8*d.*)

291. DOCUMENTS REQUIRED, AND WHERE TO BE LEFT.—An application of the inventor, or his proxy, to the Minister of Finances; a description, in French or Italian, and drawings, (three copies,) or a model and two drawings; a receipt for the fees paid into the treasury. Original or legalized copy of foreign letters patent. A memorandum of the documents and objects delivered. To be left at the Ministry of Finances, at Florence. Certificates of addition granted within the first six months, in preference to original patentees. Deficiencies in documents to be made good within fifteen days. Appeals (50 lire) to be submitted to a special commission.

292. WORKING AND PROLONGATION.—Patents of five years and less to be worked within one year, and the working not to be interrupted for one year. Patents of more than five years to be worked within two years, and the working not to be interrupted for two years, except by showing good cause for delay.

293. ANNULMENT.—By summary process before the provincial tribunals, with experts, (if desired.)

294. INFRINGEMENTS.—Punishable by a fine up to 500 lire, and confiscation of counterfeit machines, goods, &c., for the benefit of the patentee, who besides may claim damages. Actions not to be delayed beyond a week.

295. ASSIGNMENTS.—Registered at the Central Patent Office, and published in the official gazette, on the payment of 5 lire. The whole patent fees to be paid previous to registration.

296. SPECIFICATIONS, INSPECTION AND COPIES OF.—At the Central Patent Office, three months after the delivery of certificates. Copies to be had by paying for stamped paper, and 2 cents per line. Drawings extra.

297. LIST OF PATENTS DELIVERED.—Every three months, in the official gazette and in the *Commissioners of Patents' Journal.*

298. SPECIFICATIONS PUBLISHED.—Every six months, in full or in the form of extracts. Kept at the Public Free Library of the Patent Office.

299. PROCEEDINGS TO OBTAIN A PATENT.—Applications for patent are to be addressed to the head of an office in the Ministry of Finance specially appointed for the purpose. They must be presented by the inventor or his agent, and contain—

1. The Christian and surname of the inventor, the place of his birth and abode, and of his agent, if any.

2. A summary and precise designation of the nature and object of the invention, to form the title of it.

3. The number of years for which the patent is solicited.

Each application must be for one patent only, and one patent cannot include several inventions.

The following documents must accompany the application:

1. The description of the invention or discovery.

2. The drawings, if they can be made, as well as the models which the inventor may judge useful to explain his invention.

3. A receipt for the payment into the public treasury of the tax due on the patent.

4. The original or copy in due form of the foreign

patent, when the invention shall already have been patented abroad.

5. The power of attorney of the agent, (if any,) which must be drawn up by an authentic deed, or, if by private deed, the signature of the inventor must be certified by a notary or by the syndic of his place of residence.

6. A list of the documents thus presented.

The description must be in French or Italian, and contain a clear and complete description, such as will enable a person conversant with the subject to put the invention *into practice*.

The description and drawings are to be in triplicate, the applicant alone being answerable for their correctness; when the application is accompanied by a model, the copies of drawings must also be sent in, or at least drawings of such parts of the model as constitute the invention.

[NOTE.—A recent rule requires the drawings filed with the specification to be executed in India ink, on the smallest practical metrical scale. The prescribed sizes are: First, $5\frac{7}{8}$ inches by $7\frac{7}{8}$ inches; second, $7\frac{7}{8}$ inches by $11\frac{3}{4}$ inches; and third, $11\frac{3}{4}$ inches by $15\frac{3}{4}$ inches, according to the character of the invention. Drawings made to a larger scale than the officials deem necessary will be returned to the applicant for reduction, and in the meantime the application will be suspended.]

300. PETITION.—

[*Stamp, cent.* 50.]

To the Minister of Agriculture, Industry, and Commerce:

Mr. Annibale Ugazzi, born in Turin, and residing in Milan, [*represented, as the case may be, by his special attorney, Antonio Arrisabini, of Bologna, and residing at Naples,*] begs to apply for a patent of six years for his

invention, entitled [*machine for carding cotton*], with a view of acquiring the legal right of exclusively using his invention or industry, and also of exclusively manufacturing and selling the same.

[*Date of application.*]

[*Signature of applicant.*]

301. DESCRIPTION.—

[*Stamp*, 50 *cent.*]

Description of the invention entitled [*machine for carding cotton*].

[*Here follows description.*]

[*Signature of applicant.*]

The Secretary.

302. MEMORANDUM.—

[*Stamp*, 50 *cent.*]

Memorandum of the papers and objects delivered by Mr. Annibale Ugazzi, [*represented, as the case may be, by his special attorney, Mr. Alfonso Reccaboni,*] at the office of the secretary of the prefecture of for the purpose of obtaining a patent for an invention entitled [*machine for carding cotton*].

1st. The application.

2d. Three copies of the description.

3d. Three copies of drawings in six sheets, or two copies of drawings in four sheets, and a model.

4th. The receipt for the due payment of the tax.

5th. The present memorandum.

[*If other documents are filed, state them.*]

[*Date of application.*]

[*Signature of the applicant.*]

XXVII. Jamaica.

SEC.
303. Law, date, and where recorded.
304. Kinds of patents.
305. Previous examination.
306. Documents required, and where to be left.
307. Working.
308. Duration.
309. Assignments.
310. Specifications, inspection and copies of.
311. Penalty for use, or for imitation, or counterfeit without consent.
312. Government fees.

303. LAW, DATE, AND WHERE RECORDED.—The patent law amendment act, 1857. (See *Commissioners of Patents' Journal, vide supra* 71, No. 660.)

304. KINDS OF PATENTS.—Patents for invention or improvement and addition granted by the Governor to the true inventor or his attorney; disclaimer; patent for amended specification; caveats against disclaimers or alterations, entered at the Office of the Island Secretary.

305. PREVIOUS EXAMINATION.—By the Attorney General himself, or aided by other persons.

306. DOCUMENTS REQUIRED, AND WHERE TO BE LEFT.—Declaration in writing before a justice of the peace. Petition to the Governor. Written description or specification, drawings, and models, (if possible,) attested by two witnesses. Deposit of £5 by way of fee to the Attorney General. Notice to be given of application, with description in general terms, in the *Jamaica Gazette* and another newspaper, for at least four weeks. Letters patent to be applied for within three months after filing of petition, and in case of death of applicant within three months after his death.

307. WORKING.—Within two years.

308. DURATION.—Fourteen years. Foreign invention according to the term of the original patent.

309. ASSIGNMENTS.—Recorded in the Office of the Island Secretary and open to the public. Assignments of foreign patents (for a good consideration) recorded at the same place.

310. SPECIFICATIONS, INSPECTION AND COPIES OF.—Lodged, filed, and preserved in the Office of the Island, with proper indexes thereto, and all other documents. Copies (certified) to be evidence in all courts.

311. PENALTY FOR USE, OR FOR IMITATION, OR COUNTERFEIT WITHOUT CONSENT.—Treble damages, and for using the name of a patentee for the sale of an unpatented invention, £50; one half to Her Majesty, and the other to any person who shall sue for the sum.

312. GOVERNMENT FEES.—Letters patent, £5; petition, 1*s.* 6*d.*; declaration, 1*s.* 6*d.*; specification, 5*s.*; reference, certificate, or warrant of Attorney General, disclaimer or memorandum of alteration, 1*s.* 6*d.*; assignment, 10*s.*

XXVIII. Mauritius and Dependencies.

SEC.	SEC.
313. Law, date, and where recorded.	317. Specification, &c., copies.
314. Kinds of patents.	318. Duration.
315. Government fees.	319. Annulment.
316. Documents required.	320. Working.

313. LAW, DATE, AND WHERE RECORDED.—Ordinance, No. 11, of 1835, respecting letters patent. (See *Commissioners of Patents' Journal, vide supra* 71, No. 1,282, An., 1866.)

314. KINDS OF PATENTS.—Letters patent granted by the Government for home and foreign inventions and improvements.

315. GOVERNMENT FEES.—Duty to be fixed by Government, but not to exceed £100.

316. DOCUMENTS REQUIRED.—An application, with an exact description, drawings, and plans.

317. SPECIFICATION, INSPECTION AND COPIES OF.—To be published after the expiration of or annulment of patent.

318.—DURATION.—Term not to exceed fourteen years.

319. ANNULMENT.—Patents may be annulled for omission or unfaithful description; for previous discovery; for non-exercise of privilege; if patent should be obtained for the same object in a foreign country; if invention should appear to be dangerous.

320. WORKING.—Within two years of grant.

XXIX. Mexico.

SEC.	SEC.
321. Jurisdiction of patents.	323. Prolongation of patents.
322. Applications to Government or local authorities.	324. Fees.
	425. Who patentee may employ.

321. JURISDICTION OF PATENTS.—Patents for new inventions and improvements are granted for all the States of the Confederation. Patents for inventions shall be in vigor for ten years, and those for improvements for six years. Importers of any branch of industry, which the General Congress might think of great importance, may obtain an exclusive privilege by making an application through the Government to the Congress. (§ 1.)

322. APPLICATION TO GOVERNMENT OR LOCAL AUTHORITIES.—Application for patents may be made directly to Government or else to the local authorities. A precise description of the invention, with drawings, models, or whatever may be considered necessary for distinctly explaining the invention, is to be signed by applicant and delivered to the authorities. The petition is to be published three times in the gazette, to enable other parties to raise claims of priority. The patent may then be granted at the risk of the applicant as to the novelty and utility of the invention. (§ 2.)

323. PROLONGATION OF PATENTS.—Patents may be prolonged by application to Congress through the Government. (§ 3.)

324. FEES.—The patent fees vary between $10 and $300, (2 guineas and 60 guineas.) (§ 4.)

325. WHO MAY BE EMPLOYED BY PATENTEE.—Half the number of men employed by the patentee in mechanical works must be citizens of the United States of Mexico, if such may be had. (§ 5.)

XXX. The Netherlands.

SEC.	SEC.
326. Law, date, and where recorded.	332. Working and extension.
327. Kinds of patents.	333. Assignments.
328. Previous examination.	334. Annulment.
329. Duration	335. List of patents delivered.
330. Government fees.	336. Specifications published.
331. Documents, where to be left.	337. Proceedings to obtain patent.

326. LAW, DATE, AND WHERE RECORDED.—Decree of 25th January, 1817. (See *Commissioners of Patents' Journal, vide supra* 71, No. 289.)

327. KINDS OF PATENTS.—Patents of invention, improvement, or importation granted to natives or foreigners represented in the Netherlands. No guaranty as to priority or merit.

328. PREVIOUS EXAMINATION.—By the Commissioner General of Instruction, Arts, and Sciences, and sometimes also by the Royal Institute of the Netherlands.

329. DURATION.—Five, ten, and fifteen years. Foreign inventions according to the duration of the foreign patent.

330. GOVERNMENT FEES.—£12 10s., (150 fl.,) for five years; from £25 to £33 10s., (accordance to importance,) for ten years; from £50 to £62 10s., for fifteen years. To be paid to the Treasurer of the Province, at the delivery of the patent by the respective Governors. The remainder of taxes on patents annulled to be returned.

331. DOCUMENTS REQUIRED, AND WHERE TO BE LEFT.—A petition to the King. A specification and drawings. To be left with the Registrar of the States for the Commissioner General of Instruction, Arts, and Sciences.

332. WORKING AND EXTENSION.—Original term prolonged by applying to the Commissioner General of Instruction, Arts, and Sciences. To be worked within two years.

333. ASSIGNMENTS.—By authorization of the King. To be registered at the Record Office of the Province, and at the Ministry of Instruction, Arts, and Sciences. Fees, 15s.

334. ANNULMENT.—In case of, 1st, deficient or fraudulent specification; 2d, previous publication; 3d, not being worked within two years; 4th, obtaining a foreign patent at a posterior date; 5th, for reasons of public safety.

335. LIST OF PATENTS DELIVERED.—At the Ministry of Public Instruction, in the official gazette, in the *Commissioners of Patents' Journal.*

336. SPECIFICATIONS PUBLISHED.—At the expiration or annulment of patents, except there be political or commercial reasons for withholding such publication.

337. PROCEEDINGS TO OBTAIN A PATENT.—Application must be by petition, stating general object of the invention, giving applicant's name, domicil, &c., naming the

term for which the patent is demanded, with an exact and detailed specification, under sealed cover, annexed with the necessary drawings, &c. These shall be published at the expiration of the patent, unless the Government shall, for important reasons, postpone such publication.

The Commissioner General shall send patents of invention, importation, or improvement, granted and signed by the King, to the Governor of the Province where the applicant resides, the patent to be delivered to applicant on his proving that he has paid to the receiver of the Province the tax fixed by the tariff.

[NOTE.—The Dutch patent laws were repealed by the law of the 15th of July, 1869, enacting the abrogation of grants of exclusive rights for inventions and improvements of objects of art and industry. The law is as follows:

ART. 1. From and after the day of the promulgation of the present law, no more patents for inventions and improvements, or importation of objects of art and industry, will be granted, except such as may have been applied for previous to this date.]

(See *Commissioners of Patents' Journal*, *vide supra* 71, No. 1,643.)

XXXI. Newfoundland.

SEC.		SEC.	
338.	Law, date, and where recorded.	342.	Specifications, copies of.
339.	Documents required, and where to be left.	343.	Assignments.
340.	Duration.	344.	Working.
341.	Kinds of patents.	345.	Government fees.
		346.	Other legal provisions.

338. LAW, DATE, AND WHERE RECORDED.—An act to repeal the patent acts of this colony, and to make other provisions in lieu thereof, passed 12th May, 1856. (See *Commissioners' of Patents' Journal, vide supra* 71, No. 358, An., 1862.)

339. DOCUMENTS REQUIRED, AND WHERE TO BE LEFT.—Petition to the Governor, with description. Declaration as to novelty (in foreign parts before a British consul.) Drawings, models, (if not too costly,) or specimens of ingredients. To be left at the office of the Colonial Secretary. Notice, with description, in the royal gazette and one local paper.

340. DURATION.—Term not exceeding fourteen years. Extension seven years. Foreign patents according to original term.

341. KINDS OF PATENTS.—Letters patent for invention and improvements under the great seal of the Island. Disclaimer, reissue patents granted in England and extending to the colonies, to be filed or lodged (in copies) in the office of the Colonial Secretary for obtaining certificate thereof.

342. SPECIFICATIONS, COPIES OF.—To be obtained at the office of the Colonial Secretary.

343. ASSIGNMENTS.—To be recorded in the office of the Colonial Secretary. Real assignees of foreign inventors patented abroad may obtain letters patent.

344. WORKING.—Within two years.

345. GOVERNMENT FEES.—£5, besides the usual fees charged on documents issued under the great seal of the Island.

346. OTHER LEGAL PROVISIONS.—Infringers liable to forfeit and pay to the patentee a sum equal to three

times the actual damage sustained by him, together with costs.

XXXII. New South Wales.

Sec.	Sec.
347. Law, date, and where recorded.	350. Duration.
348. Kinds of patents.	351. Documents required.
349. Government fees.	352. Proceedings to obtain a patent.

347. LAW, DATE, AND WHERE RECORDED.—Act of the Legislative Council, assented to 6th December, 1852. (See *Commissioners of Patents' Journal, vide supra* 71, No. 386, An., 1857.)

348. KINDS OF PATENTS.—Letters of registration for invention and improvement granted to inventors, their agents or assignees. Letters of registration may be repealed by writ of *scire facias*.

349. GOVERNMENT FEES.—£20, payable to Colonial Treasurer.

350. DURATION.—Not less than seven, and not more than fourteen years.

351. DOCUMENTS REQUIRED.—Petition to the Government by the inventor, agent, or assignees, with description and receipt from Colonial Treasurer.

352. PROCEEDINGS TO OBTAIN A PATENT.—The applicant for patents is to present a petition to the Governor, setting forth that he is the author or designer of a certain invention, or his agent, or his assignee, stating the particulars of the invention, and that he has deposited the patent fee with the Colonial Treasurer. The petition is then to be referred to one or more competent persons, and, their report being favorable, the letters of registra-

tion may be granted, the same to be registered within three days, at the supreme court, on pain of nullity.

XXXIII. New Zealand.

Sec.	Sec.
353. Law, date, and where recorded.	357. Documents required, where left.
354. Kinds of patents.	358. Assignments.
355. Duration.	359. Specifications, inspection, &c.
356. Government fees.	360. Other legal provisions.

353. Law, Date, and where Recorded.—Patents act, 1860. (See *Commissioners of Patents' Journal, vide supra* 71, Nos. 861, 1639, An., 1862.)

354. Kinds of Patents.—Letters patent; letters of registration (for foreign patents); disclaimer; memoranda of alteration; additional patent; royal prerogative saved.

355. Duration.—Fourteen years. Patents of invention patented abroad according to the term of the foreign patent.

356. Government Fees.—£10 to be deposited with the Colonial Treasurer at the time of filing petition. Costs of examiners, if called in by the Government and in case of objections being raised, extra. Amended specification, 10*s*. Additions to former inventions, £10. Letters of registration for English or foreign patents, £10.

357. Documents Required, and where to be Left.—A petition to the Governor. Specification in duplicate and drawings, or specimens of the ingredients or of the composition of matter, (for experiment.) Notice to be inserted in the Government gazette and in one local

paper. Objections to be raised within four months of said notice.

358. ASSIGNMENTS.—Assignments and licenses to be recorded within six months from the execution thereof, in the office of the Colonial Secretary. Fees 10s. More than twelve persons may have a legal and beneficial interest in letters patent.

359. SPECIFICATIONS, INSPECTION AND COPIES OF.—At the office of the Colonial Secretary. Certified copies received in evidence in all courts.

360. OTHER LEGAL PROVISIONS.—Letters patent may be repealed by writ of *scire facias*. Penalty for counterfeiting, £50. If in any action or suit a verdict or decree shall pass for the patentee, the judge may grant a certificate, which shall entitle the patentee, upon a verdict in his favor, to receive treble costs. Plaintiff in any action shall file with declaration notice of objections on which he means to rely at trial. Judge at chambers on summons may allow other objections at his discretion.

XXXIV. Portugal.

SEC.
361. Law, date, and where recorded.
362. Kinds of patents.
363. Previous examination.
364. Duration.
365. Government fees.
366. Documents, where to be left.
367. Working and prolongation.
368. Assignments.
369. Annulment.
370. Other provisions.
371. Specifications, inspection and copies of, (models.)

361. LAW, DATE, AND WHERE RECORDED.—Royal decree of 31st December, 1852. (See *Commissioners of Patents' Journal, vide supra* 71, No. 1026. An., 1863.)

362. KINDS OF PATENTS.—Patents of invention, improvement, and importation granted to natives and foreigners. Food, drugs, theoretical principles, and ornamentation excluded. Government may buy up patent rights by private contract. Patents subject to expropriation for public utility. Original inventors to have a prior right to patents of importation during one year.

363. PREVIOUS EXAMINATION.—No guaranty as to truth, priority, or merit. No opposition or forfeiture at the expiration of the first half of the term for which the patent was granted.

364. DURATION.—Fifteen years at most for patents of invention, five years at most for patents of importation; the latter granted by open competition. Term of patent to reckon from date of patent, priority from date of deposit.

365. GOVERNMENT FEES.—Five thousand reis per annum. To be applied to industrial improvements.

366. DOCUMENTS REQUIRED, AND WHERE TO BE LEFT.—Deposit at the respective Civil Governor of a description, (in Portuguese,) drawings on a metrical scale and in ink, models, and duplicate of the same, (all sealed;) the latter to be returned to the patentee. A petition to the Secretary of State for Commerce, or a certificate stating that no other similar patent has been recorded. A receipt for the Government fees.

367. WORKING AND PROLONGATION.—Within one year. Prolongation of five years for patents of invention only.

368. ASSIGNMENTS.—At the Ministry of Commerce.

369. ANNULMENT.—For reasons of public safety and for being contrary to law; for defective or false description;

for want of novelty; for not being worked within the prescribed time.

370. OTHER PROVISIONS.—Revivals of industrial processes lost sight of to be considered as discoveries. New means of producing known articles held to be an invention. Inventions known abroad or in Portugal not patentable in Portugal, but when not worked in Portugal at the time of application they may be protected by a patent of importation.

371. SPECIFICATIONS, INSPECTION AND COPIES OF, (MODELS.)—At the Ministry of Commerce. At the Museum of Industry.

XXXV. Prussia.

SEC.		SEC.	
372.	Law, date, and where recorded.	379.	Assignments.
373.	Kinds of patents.	380.	Other legal provisions.
374.	Previous examination.	381.	Specifications, inspection and copies of.
375.	Duration.	382.	List of patents delivered.
376.	Government fees.	383.	Specifications published.
377.	Documents required, and where to be left.	384.	Proceedings to obtain a patent.
378.	Working.		

372. LAW, DATE, AND WHERE RECORDED.—Royal ordinance of 14th October, 1815 and 18th September, 1828. Convention between the States of the Zollverein of 29th June, 1843. (See *Commissioners of Patents' Journal, vide supra* 71, Nos. 313, 329, and 231.)

373. KINDS OF PATENTS.—Patents of invention, improvement, and importation delivered by the Minister of Commerce and Public Works to Prussians and foreigners naturalized or represented by Prussians.

374. PREVIOUS EXAMINATION.—By the Royal Polytechnic Commission as to the novelty and peculiar character of the invention, without any consideration as to its utility and appropriateness, except in cases of patents for a real improvement of existing apparatus or methods. The Minister of Commerce may order a new examination to take place. No guaranty by Government. Parts of inventions already known not protected by patent. Patents are annulled whenever the supposition of the invention being new and peculiar is shown to be unfounded.

375. DURATION.—Six months at least and fifteen years at most.

376. GOVERNMENT FEES.—A stamp duty of 1*s.* 6*d.* (15 sgr.) besides the legal trade tax.

377. DOCUMENTS REQUIRED, AND WHERE TO BE LEFT.—An application to the respective Provincial Administration; a description, drawings, or models. Statement as to whether the patent is to be granted for the entire monarchy or not.

378. WORKING.—Before the expiration of six months, at the latest, from the day of the delivery of the patent.

379. ASSIGNMENTS.—To Prussian citizens.

380. OTHER LEGAL PROVISIONS.—Cases of infringement to be settled by the Provincial Administration of the place where the infringer resides, with option of appeal to the Minister of Commerce. Infringers to pay the costs of inquiry only, but not subject to confiscation of tools, &c., or damages, except in case of a second offense.

381. SPECIFICATIONS, INSPECTION AND COPIES OF.—At the Ministry of Commerce and Public Works.

382. LIST OF PATENTS DELIVERED.—A summary notice in the Prussian *Gazette*, and in the official provincial pa-

pers, within six weeks after the delivery of the patent. (Titles in the *Commissioners of Patents' Journal.*)

383. SPECIFICATIONS PUBLISHED.—In the *Verhandlungen des Gewerbe-Vereins* and other technical periodicals. Kept at the Public Free Library of the Patent Office.

384. PROCEEDINGS TO OBTAIN A PATENT.—Applications must be accompanied by a precise description and illustration by models, drawings, or writings; and, if possible, by all these three means. Applicants must state if the patent is required for the whole or only part of the kingdom, and for how long a period. Experts are to examine the applications, and report thereon to the Minister of Commerce and Public Works as to the object, the extent, and duration of the patent. This minister is to execute and deliver the patent, and to control the custody of models, drawings, and specifications. The shortest term for a patent is six months, the longest fifteen years.

XXXVI. Queensland.

385. (See *Commissioners of Patents' Journal*, No. 859.) No patent laws have been enacted in the Colony of Queensland since its separation from New South Wales, but the colonial act, (New South Wales,) 16 Vict., No. XXIV., (see No. 386 of the *Commissioners of Patents' Journal*,) was continued in force in the Colony by an order in Council of the 6th November, 1859.

XXXVIII. Russia.

SEC.	SEC.
386. Law, date, and where recorded.	389. Duration.
387. Kinds of patents.	390. Government fees.
388. Previous examination.	391. Documents, where to be left.

Sec.
392. Working and prolongation.
393. Assignments.
394. Specification, inspection, copies.
Sec.
395. Lists of patents delivered.
396. Specifications published.
397. Proceedings to obtain patent.

386. LAW, DATE, AND WHERE RECORDED.—Statutes of the Russian Empire, vol. iv., book 1, part 3, chap. 3. (See *Commissioners of Patents' Journal, vide supra* 71, No. 334.)

387. KINDS OF PATENTS.—Exclusive privileges and patents of invention, improvement, and importation granted to natives and aliens.

388. PREVIOUS EXAMINATION.—By the Board of Manufactures, as to novelty, legal or technical forms, and public utility. No guaranty by the Government. Reasons for refusal published in the Moscow and St. Petersburg newspapers.

389. DURATION.—Three, five, and ten years at most from the day on which the patent has been signed. Six years at most for patents of importation.

390. GOVERNMENT FEES.—Patents of invention: 90 silver roubles for three years; 150 s. r. for five years; 450 s. r. for ten years. Patents of importation: 60 s. r. for one year; 120 s. r. for two years; 180 s. r. for three years; 240 s. r. for four years; 300 s. r. for five years; 360 s. r. for six years. (1 s. r.=3*s.* 8*d.*) The surplus accruing from patent fees to be applied to the purchase of books, models, &c.

391. DOCUMENTS REQUIRED, AND WHERE TO BE LEFT.—A petition to the Board of Commerce and Trades; a description, (in Russian,) and, in case of a patent of importation, (also in the original language,) drawings and models. Payment of the fees. Defective specifications may be amended.

392. WORKING AND PROLONGATION.—No prolongation.

To be worked within the first quarter of the term specified. A certificate from the local administration to be sent to the respective ministry within six months of the working. No company to work patents without special grant of the Government.

393. ASSIGNMENTS.—To be reported to the respective department to which the patent belongs and published.

394. SPECIFICATIONS, INSPECTION AND COPIES OF.—At the respective ministry.

395. LISTS OF PATENTS DELIVERED.—In the Moscow and St. Petersburg papers.

396. SPECIFICATIONS PUBLISHED.—In the journal of the respective ministry, in the reports of the Senate, and the Moscow and St. Petersburg papers.

397. PROCEEDINGS TO OBTAIN A PATENT.—Applicants may apply personally, or through an agent authorized by power of attorney. Such agent is to undertake to pay the tax in case the privilege be granted.

Petitions for patents are examined by the Board of Industry, to ascertain whether a previous patent had not been granted for the same object; whether the description be full, clear, and exact; whether any public benefit be derivable from the invention; whether it contain anything injurious to human health and safety.

The invention being found free from these objections, the patent may be issued.

When two parties apply for a patent for the same invention, neither can obtain it without establishing by decree of a court of law his prior right.

When patents are refused the tax is refunded.

XXXVIII. Saxony.

Sec.	Sec.
398. Law, date, and where recorded.	404. Working and extension.
399. Kinds of patents.	405. Assignments.
400. Previous examination.	406. Annulment.
401. Duration.	407. Lists of patents delivered.
402. Government fees, stamps, &c.	408. Specifications.
403. Documents, where to be left.	409. Proceedings to obtain a patent.

398. LAW, DATE, AND WHERE RECORDED.—Royal decree of 20th January, 1858. (See *Commissioners of Patents' Journal, vide supra* 71, No. 236.

399. KINDS OF PATENTS.—Patents for new or unpublished (abroad or in Germany) inventions and improvements granted to natives, naturalized citizens of the German States, or foreigners residing or represented in Saxony. Drugs, food, and scientific principles excluded. Patent articles, other than machines or manufacturing tools, may be imported, used, and sold by third parties.

400. PREVIOUS EXAMINATION.—Technical examination.

401. DURATION.—Five years; extended to ten years by applying four weeks at the latest before the expiration of the original term.

402. GOVERNMENT FEES, STAMPS, AND TAXES.—£3 10*s.* for five years. £7 10*s.* on applying for extension to ten years. £1 4*s.* for technical examination on applying for patent. 12*s.* on applying for extension of time for working, besides the usual stamp duty (on papers.)

403. DOCUMENTS REQUIRED, AND WHERE TO BE LEFT.—An application to the Minister of the Interior; a speci-

fication and drawings or models, (all papers stamped;) the cost of technical examination.

404. WORKING AND EXTENSION.—Within one year from the date of grant; subject to trade regulations. Term extended, on showing good cause for delay, by applying to the Minister of the Interior four weeks at the latest before the expiration of the year.

405. ASSIGNMENTS.—To natives or naturalized citizens of Saxony or other German States.

406. ANNULMENT.—By the Minister of the Interior. For want of novelty, (partly or entirely;) false statement as to nationality, or being the original inventor or his assignee; defective specification; for not being worked in due time.

407. LISTS OF PATENTS DELIVERED.—In the *Leipzig Gazette* and in the *Commissioners of Patents' Journal.*

408. SPECIFICATIONS.—Published in the *Polytechnische Centralblatt* and other technical periodicals. Originals kept at the Ministry of the Interior.

409. PROCEEDINGS TO OBTAIN A PATENT.—Applications for the grant or extension of a patent must be made in writing, addressed to the Minister of the Interior, accompanied by a specification and drawings or models so distinct that any skilled person may work the invention by such instruction. The novel points must be clearly indicated. The tax No. 1 is to be paid at the same time. The applicant will then learn whether the application can be granted and when he is to pay the tax No. 2. The payment is immediately followed by the announcement of the grant of the patent.

XXXIX. Spain.

Sec.	
410.	Law, date, and where recorded.
411.	Kinds of patents.
412.	Previous examination.
413.	Duration.
414.	Government fees.
415.	Documents, where to be left.
416.	Working and extension.
417.	Infringements.
418.	Assignments.
419.	Specifications, inspection and copies of.
120.	List of patents delivered.
421.	Originals of specifications (models.)
422.	Proceedings to obtain a patent.
423.	Form of petition to the king.

410. LAW, DATE, AND WHERE RECORDED.—Royal decree of 27th March, 1826, 14th June, 1829, 23d December, 1829. (See *Commissioners of Patents' Journal, vide supra* 71, No. 323.)

411. KINDS OF PATENTS.—Patents for inventions and importations to natives and foreigners.

412. PREVIOUS EXAMINATION.—None as to novelty or utility.

413. DURATION.—Five, ten, or fifteen years for patents of invention; five years for patents of importation, prolonged to ten years. To begin from the date of the patent.

414. GOVERNMENT FEES.—1,000 reis for five years; 3,000 reis for ten years; 6,000 reis for fifteen years; 3,000 reis for patents of importation for five years, besides 80 reis on the delivery of the patent in addition to the above sums. (1 real=5*d.*)

415. DOCUMENTS REQUIRED, AND WHERE TO BE LEFT.—An application of inventor or his attorney to the Queen; a description and plan of model, (sealed,) with an annexed memorandum pointing out the chief claims of the inventor.

416. WORKING AND EXTENSION.—To be worked within and not to be interrupted for one year and one day.

417. INFRINGEMENTS.—Punishable by confiscation of machines, utensils, apparatus, and manufactured goods, and by a fine of three times their value, for the benefit of the patentee.

418. ASSIGNMENTS.—Registered at the Royal Conservatory of Arts within thirty days of date.

419. SPECIFICATIONS, INSPECTION AND COPIES OF.—Open to the public at the Royal Conservatory at the expiration of the patent.

420. LIST OF PATENTS DELIVERED.—In the *Madrid Gazette;* in a public register at the Conservatory of Arts.

421. ORIGINALS OF SPECIFICATIONS, (MODELS.)—At the Royal Conservatory of Arts.

422. PROCEEDINGS TO OBTAIN A PATENT.—Patents must be solicited by the applicant or his agent by means of a memorial (in Spanish) in the following form:

To the Governor of the Province of

N. domiciled [*or residing*] at , [*state profession*], begs respectfully to state, that for the purpose of securing the property of a machine [*instrument, apparatus, process, method*] invented [*imported*] by him for [*state object*], and conformably to the royal regulations, he presents to you the required memorial for his Majesty, and a closed and sealed packet, [*or case,*] and the following inscription [*copy of inscription.*]

I request you to sign the said packet [*or case*], to deliver the proper certificate to me, and to let me have the required official letter to his excellency the Secretary of State and of the Exchequer, that I may deliver the whole into his hands, according to the regulations.

[*Address and date.*]

[*Signature.*]

This memorial is to be accompanied by a petition to the King, on stamped paper, mentioning the object of the patent, whether original or imported, and its dura-

tion. Each application must not contain more than one object.

423. FORM OF PETITION TO THE KING.—

N. domiciled [*or residing*] at , [*state profession*], submits to your Majesty, with profound respect, that for the purpose of securing the property of a machine [*instrument, apparatus, process, method*] invented [*imported*] by him [*state object*], and conformably to the regulations made by your Majesty, he solicits from your Majesty the delivery of letters patent for years; and he will ever pray, &c.

[*Signature.*]

There must likewise be sent with the memorial and petition a plan or model, with the description and explanation of the mechanism or process, clearly and correctly, so that no doubt may ever arise of its object or particular nature, with a declaration that the invention has never been worked in that form before. Models must be in a sealed case and plans and descriptions in a sealed cover, both bearing the following inscription:

Application for letters patent presented by N. domiciled at , to the Governor of , for [*insert title of invention, as mentioned in the petition to his Majesty, month, year, day, and hour.*]

[*Signature of Governor.*]
[*Name of the Applicant.*]
[*Number of Register.*]

The petition, having been examined by the General Commission of Commerce, Money, and Mines, and approved, is granted, and letters patent are delivered on the production of a receipt showing that taxes have been paid to the Royal Conservatory of Arts.

After delivery of the patent the closed and sealed documents shall be deposited in a room of the Royal Conservatory of Arts, and shall only be opened in case of litigation, and by order of the judge. Grants of patent

are to be published in the *Royal Gazette*. A register of patents is to be kept open to public inspection.

A note is to be annexed to the description and explanation which accompany the petition for a patent, pointing out clearly, distinctly, and solely that part, mechanism, substance, or process which is the object of the patent and which the applicant desires to secure, and the letters patent shall apply only to the contents of the said note. This note is to be verified by the Council of the Exchequer.

XL. Sweden.

SEC.
424. Law, date, and where recorded.
425. Kinds of patents.
426. Previous examination.
427. Duration.
428. Government fees.
429. Documents required and where to be left.
430. Working and extension.
431. Assignments.
432. Other legal provisions.
433. Specifications, inspection, and copies of.
434. List of patents delivered.
435. Specifications published.
436. Originals of specifications, (models.)

424. LAW, DATE, AND WHERE RECORDED.—Royal ordinance, dated 19th August, 1856, in force since October 1, 1856. (See *Commissioners of Patents' Journal, vide supra* 71, No. 354, and for Norway, No. 655.)

425. KINDS OF PATENTS.—Patents of invention and improvement granted to the original inventor only, whether a native or alien, residing or represented in the country. No patents are granted for pharmaceutical preparations, or for invention contrary to existing laws, to public safety, or morality.

426. PREVIOUS EXAMINATION.—By the Chamber of

Commerce, as to the invention being contrary to existing laws, to public safety, or morality. Official publications of foreign inventions do not prevent grants of patents. No guaranty as to novelty or utility.

427. DURATION.—Three years at least, and fifteen years at most, according to the nature and importance of the invention. Patents for foreign inventions not to exceed the term granted abroad.

428. GOVERNMENT FEES.—None except the costs of publishing the specification in the "*Post & Inrikes Tidningar.*"

429. DOCUMENTS REQUIRED AND WHERE TO BE LEFT.—A petition to the Chamber of Commerce, (*Kommers-Kollegium;*) a declaration as to whether the invention be new or an improvement; a full description of the means of working the invention, drawings or models, (if required.) N. B. A month's time is allowed, if applied for, for delivering the complete specification.

430. WORKING AND EXTENSION.—To be worked within one, two, or four years of the date of patent, according to the nature and importance of the invention, such working not to be interrupted for one year.

431. ASSIGNMENTS.—To parties residing in the kingdom, by permission of the Chamber of Commerce.

432. OTHER LEGAL PROVISIONS.—Infringements punishable by a fine of from 100 to 200 rix-dollars (£23 to £46) for the first offense, and from 200 to 400 rix-dollars (£46 to £92) for the second offense; besides by damages, half of which belong to the patentee, and the other going towards the relief of the poor of the parish.

433. SPECIFICATIONS, INSPECTION, AND COPIES OF.—In the records of the Chamber of Commerce.

434. LIST OF PATENTS DELIVERED.—Placarded in the Hall of the Chamber of Commerce, and published in the "*Post & Inrikes Tidningar.*"

435. SPECIFICATIONS PUBLISHED.—Three times within two months of the grant, in the "*Post & Inrikes Tidningar.*"

436. ORIGINALS OF SPECIFICATIONS, (MODELS.)—In the records of the Chamber of Commerce, Stockholm.

XLI. Tasmania.

SEC.	SEC.
437. Law, date, and where recorded.	441. Documents required, &c.
438. Kinds of patents.	442. Assignments.
439. Duration.	443. Originals of specifications, &c.
440. Government fees.	444. Other legal provisions.

437. LAW, DATE, AND WHERE RECORDED.—Act 22 Vict., dated 5th November, 1858. (See *Commissioners of Patents' Journal, vide supra* 71, No. 860, Au., 1862.)

438. KINDS OF PATENTS.—Letters patent and grants of privilege to the true and first inventor, under the seal of the colony; disclaimer and alteration; English patent granted before the 30th June, 1859, to be valid in the colony.

439. DURATION.—Fourteen years. Patents to expire at the end of the third or seventh year, if the required grant-fees are not paid. Letters patent for foreign invention not to continue after expiration of foreign patent. Extension for a term not exceeding fourteen years after the expiration of the first term.

440. GOVERNMENT FEES.—On depositing specification, £2 10*s.*; to the law officer for any appointment, £2 4*s.*

6*d.*; on obtaining letters patent, £2 10*s.*; at or before the expiration of third year, £15; at or before the expiration of seventh year, £20; to the law officer with particulars of objection, £2 4*s.* 6*d.*; on presenting petition for extension or confirmation, £2 10*s.*; every search and inspection, 1*s.*; entry of assignment or license, 10*s.*; certificate of assignment or license, 10*s.*; filing disclaimer or memorandum of alteration, £2 10*s.*; entering any caveat, £2 10*s.*; copy or extract of any writing, per common law folio, 1*s.*

441. DOCUMENTS REQUIRED AND WHERE TO BE LEFT.—Petition to the Government; declaration of being the first inventor, with annexed specification (and copy) of a certain size, and drawings, if any, for provisional protection of six months. Notice to proceed to be published in the Government gazette and two local papers. Warrant for letters patent issued by Attorney General after one month's notice. Letters patent bearing date of deposit of specification to be issued within three months after said warrant, and during the protection.

442. ASSIGNMENTS.—Registered as above, and legal copies thereof to be had.

443. ORIGINALS OF SPECIFICATIONS, DISCLAIMERS, DRAWINGS, &c.—To be filed at the end of six months, at a proper office, with indexes, registers, &c., for public inspection.

444. OTHER LEGAL PROVISIONS.—*Letters patent* may be repealed or withheld, and specifications canceled by writ of the supreme courts, in the nature of a writ of *scire facias* in England. Letters patent not to prevent the use of invention in foreign ships resorting to ports in the colony, (provided there be reciprocity in this

behalf.) Penalty for unauthorized use of word *patent*, £100.

XLII. Trinidad.

SEC.
445. Law, date, and where recorded.
446. Duration.
447. Government fees.
448. Kinds of patents.
449. Documents required, &c.
450. Specifications.

445. LAW, DATE, AND WHERE RECORDED.—Separate ordinance. (See *Commissioners of Patents' Journal, vide supra* 71, No. 883, An., 1862.)

446. DURATION.—Fourteen years.

447. GOVERNMENT FEES.—On presentation of bill, $50; government printer's charge, $10=$60, (£12 10*s.*)

448. KINDS OF PATENTS.—Bill for granting for a limited time the exclusive benefit of a certain invention.

449. DOCUMENTS REQUIRED AND WHERE TO BE LEFT.—Petition to the Government. Specifications to be delivered within six months after the passing of ordinance to the Registrar General.

450. SPECIFICATIONS.—Recorded in the office of the Registrar General.

XLIII. Victoria, (Australia.)

SEC.
451. Law, date, and where recorded.
452. Kinds of patents.
453. Previous examination.
454. Duration.
455 Government fees.
456. Documents, where to be left.
457. Assignments.
458. Specifications and indexes.
459. Lists of patents delivered.
460. Penalties and fines.
461. Proceedings to obtain a patent.
462. Form of application.

451. LAW, DATE, AND WHERE RECORDED.—Act of the

Lieutenant Governor of the Colony of Victoria, Anno Decimo Septimo Victoriæ Reginæ. Assented to 31st March, 1854. Repealed 11th March, 1857, and superseded by act Anno Vicesimo Victoriæ Reginæ. Dated 11th March, 1857. (See *Commissioners of Patents' Journal, vide supra* 71, Nos. 186 and 359.)

452. KINDS OF PATENTS.—Letters patent for inventions and for imported inventions granted by the Queen to the true and first inventor of manufactures. Letters patent granted in the United Kingdom of Great Britain and Ireland, on or before the 31st December, 1857, to be also valid in Victoria. (N. B. Letters patent not to prevent the use of inventions in foreign ships resorting to ports in Victoria, except reciprocal rights be denied to British ships in such foreign ports as they belong to.)

453. PREVIOUS EXAMINATION.—By the Law Officer, and, if required, by one or more competent person or persons appointed by him, in case of opposition raised within one month of the notice to proceed, inserted in the Government gazette and two other papers, both applicant and opponent being present.

454. DURATION.—Original inventions fourteen years. Imported inventions according to the duration of the foreign patent, or, if more than one, according to the shortest duration. Letters patent may be repealed by *scire facias*. Extension of term, not exceeding fourteen years, by petition to Government six months before the expiration of the patent.

455. GOVERNMENT FEES.—On depositing specification, £2 10*s.*; to the Law Officer for any appointment, £2 4*s.* 6*d.*; on obtaining letters patent, £2 10*s.*; at or before the expiration of the third year, £15; at or before the expi-

ration of the seventh year, £20; to the Law Officer with particulars of objections, £2 4s. 6d.; on presenting petition for extension or confirmation, £2 10s.; every search and inspection, 1s.; entry of assignment or license, 10s.; certificate of assignment or license, 10s.; filing memorandum of alteration or disclaimer, £2 10s.; entering any caveat, £2 10s.; copy or extract of any writing, per common law folio, 1s.

456. DOCUMENTS REQUIRED, AND WHERE TO BE LEFT.—An instrument in writing (and copy) describing invention, (with drawing, if any,) and deposited at the office of the Chief Secretary at Melbourne for provisional protection for six months. Such specification, on parchment, twenty inches by fifteen, may be amended within said term. Notice to proceed within six months of deposit. Opposition open for one month, before the Law Officer appointed to hear applications and objections and to award costs. Warrant for letters patent issued by said Law Officer. Letters patent to be sealed within three months after the date of said warrant and during the term of provisional protection; said term may be prolonged for one month by the Governor. Disclaimer or memorandum of alteration entered with or without public notice.

457. ASSIGNMENTS.—Entered in the Register of Proprietors.

458. SPECIFICATIONS AND INDEXES TO SPECIFICATIONS.—Open to the public at all reasonable times. Certified copies to be evidence.

459. LISTS OF PATENTS DELIVERED.—Applications published in the Government gazette; also in the Registry of Patents and Proprietors, open to the public.

460. PENALTIES AND FINES.—Falsification or forgery of entries punishable as a misdemeanor by labor on the roads or other public works, for any term not exceeding five years, or by fine and imprisonment. Penalty for unauthorized uses of the word patent £100; one half to her Majesty and the other half, with full costs of suit, to any person who shall sue for the said penalty by action of debt.

461. PROCEEDINGS TO OBTAIN A PATENT.—The applicant is to deposit at the office of the Chief Secretary an instrument under his hand seal, a particular description of his invention, with a copy of the instrument, and of drawings, if any, by doing which he obtains six months' protection, with the privilege of letters patent for that period. The specification may be amended during the six months.

The specification is to be on skins of parchment, written on both sides, twenty-one inches long by fifteen broad, with a margin of an inch and a half on each side. The drawings may be on larger sheets of parchment, with a margin of an inch and a half. The copies of specification and drawings are to be on sheets of paper of the same size as the parchment.

After making a deposit of these documents he is to give notice, at the chambers of the Attorney or Solicitor General, of his intention to proceed for a patent, stating the title of the invention and date of deposit, and produce at the same time the certificate of the deposit. The Law Officer is then to give the applicant an appointment in due form, which he is to publish in the Government gazette and in some Melbourne newspaper, and twice in

some newspaper published at or near where the applicant uses the invention or resides.

The letters patent are to be issued by the Chief Secretary within three months after the Law Officer's warrant and during the protection; but if the sealing has been delayed by accident, and not by the willful neglect of the applicant, it may be done within one month after the expiration of the protection, with the sanction of the Governor.

462. FORM OF APPLICATION FOR PATENT.—

I, , of , [*state address and profession,*] send greeting. Whereas I am desirous of obtaining royal letters patent for securing unto me her Majesty's special license, that I, my executors, administrators, and assigns, and such others as I or they should at any time agree with, and no others, should, and lawfully might, from time to time, and at all times during the term of fourteen years, (to be computed from the day on which this instrument shall be left at the office of the Chief Secretary,) make, use, exercise, and vend, within the Colony of Victoria and its dependencies, an invention for [*insert the title of the invention*]; and in order to obtain the said letters patent I must, by an instrument in writing, under my hand and seal, particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, and must also enter into the covenant hereafter contained. Now, know ye, that the motive of the said invention, and the manner in which the same is to be performed, is particularly described and ascertained in and by the following statement, that is to say, [*describe the invention.*] And I do hereby, for myself, my heirs, executors, and admistrators, covenant with her Majesty, her heirs and successors, that I believe the said invention to be a new invention as to the public use and exercise thereof, and that I do not know or believe that any other person than myself is the true and first inventor of the said invention, and that I will not deposit these presents at the office of the Chief Secretary with any such knowledge or belief as last aforesaid.

In witness, &c.

XLIV. West Indies, (Dutch.)

Sec.
463. Law, date, and where recorded.
464. Kinds of patents.
465. Duration.
466. Government fees.
467. Documents required, &c.
468. Working.
469. Assignments.
470. Annulment.
471. List of patents delivered.
472. Specifications published.
473. Originals of specifications, (models.)

463. LAW, DATE, AND WHERE RECORDED.—Decree of 4th July, 1844. (See *Commissioners of Patents' Journal, vide suprá* 71, No. 322.)

464. KINDS OF PATENTS.—Patents of invention, improvement, and of importation.

465. DURATION.—Five, ten, and fifteen years at most. Original term prolonged. Foreign inventions according to the duration of the original patent.

466. GOVERNMENT FEES.—£15 for five years; from £30 to £40 (according to importance) for ten years; from £60 to £70 for fifteen years. Inventions already patented in the Netherlands are subject only to the usual stamp duties. The remainder of taxes of pateuts annulled returned.

467. DOCUMENTS REQUIRED AND WHERE TO BE LEFT.—An application to the Governor General, at Paramaribe; a description and drawings, &c., (sealed;) an undertaking to supply the patent article within two years, and to take up the patent within three months of its date, and to pay the fees thereon.

468. WORKING.—Within two years from the date of patent.

469. ASSIGNMENTS.—By consent of the Governor General. Registration fee, £2.

470. ANNULMENT.—In case of—1. Defective or false specification; 2. Previous publication; 3. Not being worked within two years; 4. Obtaining patents abroad, except the Netherlands and their colonies; 5. Not supplying the patent article within two years at a moderate price; 6. For reasons of public safety; 7. For neglecting to register assignments.

471. LIST OF PATENTS DELIVERED.—In the Surinam *Courant*, and in a special register, open to applicants for patents.

472. SPECIFICATIONS PUBLISHED.—At the expiration or annulment of patents, unless it be found advisable to delay such publication.

473. ORIGINALS OF SPECIFICATIONS, (MODELS.)—At the Governor General's, at Paramaribe. A copy at the Colonial Ministry at the Hague.

XLV. Wurtemberg.

SEC.
474. Law, date, and where recorded.
475. Kinds of patent.
476. Previous examination.
477. Duration.
478. Government fees.
479. Documents required and where to be left.
480. Working and prolongation.
481. Assignments.
482. Specifications, inspection, and copies of.
483. Annulment.
484. List of patents delivered.
485. Specifications published.
486. Other provisions.
487. Proceedings to obtain a patent.

474. LAW, DATE, AND WHERE RECORDED.—Royal decree of 5th August, 1836. Law of the 29th June, 1842. (See *Commissioners of Patents' Journal, vide supra* 71, Nos. 314, 995.)

475. KINDS OF PATENTS.—Patents of invention and importation granted to natives of Wurtemberg and of the Zollverein.

476. PREVIOUS EXAMINATION.—For novelty. No guaranty as to priority or utility.

477. DURATION.—Ten years at most. Prolonged by legislative act. Patents of importation become extinct at the expiration of the foreign patent.

478. GOVERNMENT FEES.—From 8*s.* 4*d.* to £1 14*s.* annually.

479. DOCUMENTS REQUIRED AND WHERE TO BE LEFT.—A petition of inventor or importer to the Minister of the Interior; a description, drawings, and models, or patterns. To be left with the magistrate of the district.

480. WORKING AND PROLONGATION.—To be worked within and not to be interrupted for two years, except patentee shows good cause for delay. Original terms prolonged to ten years, if applied for before the beginning of the last year, and in cases of importation before the expiration of the first half of the original term.

481. ASSIGNMENTS.—Published.

482. SPECIFICATIONS, INSPECTION AND COPIES OF.—By natives and by consent of the patentee in the last year of the legal term of the patent. Patents of importation in the latter half of their legal term. Free when expired. At the Ministry of the Interior.

483. ANNULMENT.—For want of novelty; for having been known or worked abroad or in Wurtemberg; for false statements and incorrect descriptions, whereby patentees, moreover, incur a penalty.

484. LIST OF PATENTS DELIVERED.—In the Wurtemberg *Gewerbeblatt.*

485. SPECIFICATIONS PUBLISHED.—In the Wurtemberg *Gewerbeblatt* and other technical periodicals.

486. OTHER PROVISIONS.—Parties using a patent process in complete ignorance of the patent right of a third party are liable to confiscation and damages. Patent articles may be imported without consent of the patentee.

487. PROCEEDINGS TO OBTAIN A PATENT.—Applicants must deliver a petition to the authorities of the district in which they reside or intend to carry on their works, with a complete and true specification, and the required drawings, models, or plans. Specifications must be under a sealed cover, not to be opened by the district authorities. The authorities are then to give to applicants a certificate stating the day and hour when the delivery took place, and forward the documents to the Minister of the Interior.

PART III.

PROCEDURE

IN THE

UNITED STATES PATENT OFFICE,

WITH

FORMS, NOTES, AND AUTHORITIES.

PROCEDURE IN UNITED STATES PATENT OFFICE,

WITH

FORMS, NOTES, AND AUTHORITIES.

I. Caveat.

SEC.

1. Requisites and term of caveat.
2. Proceedings in case of an interfering application.
3. When an alien may file a caveat.
4. No notice given of pending applications.
5. Renewal.
6. Description.
7. Drawings.
8. Purpose of caveat.

SEC

9. Omission to give notice.
10. Effect of a caveat upon a subsequent patent.
11. Papers not to be withdrawn, copies.
12. Caveat as evidence.
13. Notice to the Commissioner only.
14. Petition.
15. Description.
16. Oath.

1. REQUISITES AND TERM OF CAVEAT.—Any citizen of the United States who shall have made any new invention or discovery, and shall desire further time to mature the same, may, on payment of the duty required by law, ($10,) 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; and such caveat shall be filed in the confidential archives of the office and preserved in se-

crecy, and shall be operative for the term of one year from the filing thereof. (*Act of July* 8, 1870, § 40.)

2. PROCEEDINGS IN CASE OF AN INTERFERING APPLICATION.—If application shall be 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 filing the caveat, who, if he would avail himself of his caveat, shall file his description, specifications, drawings, and model within three months from the time of placing said 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. (*Ib.*)

3. WHEN AN ALIEN MAY FILE A CAVEAT.—An alien shall have the privilege of filing a caveat if he shall have resided in the United States one year next preceding the filing of his caveat, and made oath of his intention to become a citizen. (*Ib.*)

4. NO NOTICE GIVEN OF PENDING APPLICATIONS.—The caveator will not be entitled to notice of any application pending at the time of filing his caveat, nor of any application filed after the expiration of one year from the date of filing the caveat. (*Patent Office Rules, July*, 1870.)

5. RENEWAL.—The caveator may renew his caveat at the end of one year by paying a second caveat fee of $10, which will continue it in force for one year longer, and so on from year to year as long as the caveator may desire. (*Ib.*)

6. DESCRIPTION.—A caveat need not contain as partic-

ular a description of the invention as is requisite in a specification; but still the description should be sufficiently precise to enable the office to judge whether there is a probable interference when a subsequent application is filed. (*Ib.*)

It is to set forth the "design and purpose" of the invention and its "distinguishing characteristics;" but it is *not* necessary that it should explain the principle involved, or the modes in which it can be applied, nor how it is distinguished from other inventions. (11 *Opinions of Attorneys General*, 65.)

Nor is it necessary to accompany the caveat with specimens of ingredients, or compounds, or model. (*Ib.*)

It is not required to be specific in its terms, nor is it presumed to describe the whole invention of the party but is filed in the office rather as a warning that the inventor is in the exercise of due diligence in the pursui and perfection of his discovery. (*Collins* v. *White*, *MS Appeal Cases*, *D. C.*, 1860.)

7. DRAWINGS.—When practicable, the caveat must be accompanied by drawings or sketches. (*Patent Office Rules*, *July*, 1870.)

8. PURPOSE OF CAVEAT.—A caveat answers a double purpose: first, to give notice of the inventor's claim; and, second, to prevent a patent from issuing to another for the same thing. (*Allen* v. *Hunter*, 6 *McLean*, 304.)

Its office is to save the discoverer of an invention from the effect of the rule of law, that gives to the inventor who first adapts his invention to practical use the right to the grant of a patent; and if the Commissioner complies with the terms of § 12 of the act of 1836, as to giving the caveator notice of any interfering application,

it is to secure him against the effect of the rule. (*Phelps, Dodge & Co.* v. *Brown Bros.*, 18 *How., Pr.* 8.)

The effect of a caveat is to protect the claim of an inventor from all interfering applications made within one year after its filing, by requiring the office to notify him of such applications, that he may resist the interference if he chooses. But if, during the time which elapses between the filing of his caveat and his application, he allows his invention to go into public use, his caveat will not protect him. (*Bell* v. *Daniels*, 1 *Fish.*, 372.)

9. OMISSION TO GIVE NOTICE.—If the Commissioner accidentally omits to give the caveator the notice required, his rights will not be prejudiced thereby. (*Phelps, Dodge & Co.* v. *Brown Bros.*, 18 *How., Pr.* 8.)

A patent should not operate to the prejudice of a subsequent applicant, if he had a caveat on file embracing the invention when the application was filed on which the patent issued. (*Hamilton* v. *Foster*, *Commissioner's Decisions*, 1869, p. 30.)

And if a conflicting caveat is in force when an application is filed, though the application is rejected, and the rejection is not set aside until after the caveat has expired, yet the caveator is then entitled to be notified. (*Kenney ex parte*, *Commissioner's Decisions*, 1869, p. 97.)

In the case of *Kenney ex parte* the Commissioner says:

"The application in this case was filed August 19, 1869, was rejected by the examiner and examiners-in-chief and allowed by the Commissioner. The examiner now reports 'that a caveat covering the same device, apparently, was filed September 23, 1868.' The year would, therefore, expire September 23, 1869, or thirty-five days after the filing of Kenney's application. No notice of

Kenney's application was given to the caveator. The act of July 4, 1836, § 12, provides that 'if an application be made by any other person (than the caveator) within one year from the time of filing said caveat, * * * it shall be the duty of the Commissioner to give notice to the person filing such caveat.'

"But it has not been the practice of the office to give this notice, unless the device presented was deemed patentable. In any other case the caveator would be put to unnecessary expense; for the office would not inform him in advance that the device was not considered novel. Such a notice would, in fact, constitute a preliminary examination.

"When the device is, *prima facie*, novel and patentable, the notice has been given, if an application has been filed even within the last moment of the prescribed year.

"The question presented by the examiner for consideration under the foregoing state of facts is, should notice now be given to the caveator, and three months be allowed him to complete his invention?

"It is obvious that at the time of the filing of Kenney's application the caveator was entitled to notice of it; for it is now decided that the invention was patentable. This made a clear case, under the statute, of an application made within one year from the time of filing said caveat. The fact that the three months' notice could not be given within the year was not material, for the language of the section is so unequivocal that, if an application were filed on the last day of the year, the caveator would be entitled to notice, and to three months for the purpose of completing his inven-

tion, although the effect would be to extend the protection given by the caveat to fifteen months instead of twelve.

"But it is said that when this application was filed it was not believed that the invention was patentable, and that, therefore, under the practice of the office, notice was properly withheld; that, meanwhile, the year has expired, and the caveat, not having been renewed or followed by an application, can now afford no protection, nor can notice be now given to the caveator. The answer is, that while the office practice of withholding notice until the question of patentability is determined is wise, yet that practice must not be used to work a wrong instead of a benefit to the caveator. When the question of patentability is finally determined in favor of the applicant, it relates back to the filing of the application. It is a determination that there was then a patentable subject-matter, and one that interfered with the caveat. It is a judgment that the case was one in which the caveator ought to have been notified when the application was filed.

"It must not be forgotten that the caveator is no party to the delay. He knows nothing of the interfering application, nothing of the disputed question of patentability. He is helpless, except as his rights are protected by the statute, which ought, therefore, to be liberally construed in his favor.

"If the application had been filed a few days after the caveat, and the question of patentability had been discussed for the remainder of the year, being finally determined only a few days after its expiration, it would be thought a very harsh rule that should deprive the cave-

ator of notice. He would be justified in saying that, if he had been notified at the time of filing the application, he would, under the spur of the interference, have completed his invention long before, and that the law, in providing for notice, and three months afterward for the completion of the invention, intended to give him the benefit of that spur.

"But the case is not relieved from any of its difficulty by the fact that the invention was filed just before the year covered by the caveat expires. On the contrary, the lapse of time increases the presumption that the caveator, and not the applicant, was the first inventor. At all events, whether first or second, he is entitled to the notice provided for by law, to which the practice of the office, however expedient, must always be subordinate.

"I am of opinion that the caveator in this case must be notified to complete his application within three months, and the case must be suspended to await his action." (*Commissioner's Decisions*, 1869, p. 97.)

10. EFFECT OF A CAVEAT UPON A SUBSEQUENT PATENT.—In the case of *Johnson* v. *Root* the ruling of Sprague, J., was as follows:

"It is contended, on the part of the defendant, that the caveat itself is conclusive evidence that the invention was not perfected. You will observe that the application, which is in the caveat before you, made to the Patent Office by Mr. Johnson for leave to file a caveat, sets forth that he has made a certain new and useful improvement in the sewing machine, and that he is then making experiments to perfect it, and he asks leave to file a caveat to secure it. The defendant insists that that application is of itself conclusive evidence that he has

not perfected it. We will look at it, gentlemen, and see. I do not instruct you that it is conclusive evidence, but it is evidence for you to take into view in connection with the other evidence, and in connection with the other parts of the same instrument, in which he begins by saying that he has made a new and useful invention in the sewing machine. Now, gentlemen, although a caveat is understood to be, and in this instance is, filed in order to allow the party to perfect his machine, yet if, in point of fact, the invention had been perfected in the eye of the law, as I have explained to you, then, if you are satisfied of that from the evidence, you may deem it, for the purposes of this trial, as perfected. Or it may happen that a person may choose to file a caveat while he is going on and making improvements upon an invention which he has already completed, so as to be of practical utility. Therefore, gentlemen, I would say to you that you will take into consideration the declaration of the plaintiff himself in the application, that he had made a new and useful improvement in sewing machines, and the further declaration that he is making experiments in order to perfect his invention, and the subsequent declaration that he has made a new and useful improvement, and the other evidence in relation to the case—that is, what is described in the caveat and the model made in 1848—and see if that exhibits to you a perfect machine; and then such further evidence as you have as of the actual operation of the machine that will be before you.

"Now, gentlemen, if he had perfected it, then he had a right to embrace it in a patent that he should afterwards take out. If he had not perfected it, then another

question will arise, and that is, had he invented the feeding mechanism at that time, and did he use due diligence to perfect that and put it into a perfect machine, so as to make it of some practical utility?

"If the invention was perfected, as I have already said, or, if not perfected, if Mr. Johnson used reasonable diligence to perfect it, then he had a right to have it incorporated into his patent, and to supersede those that had intervened between his first discovery and his subsequent taking out of the patent. If he had not perfected it, and did not use due diligence to carry it into effect, and, in the mean time, before he got his patent, some one else had invented and used and incorporated into a practical useful machine that mode of feeding, then he could not, by subsequent patent, appropriate to himself what was embraced in the former machine between his caveat and the obtaining of his patent." (1 *Fish.*, 351.)

The fact that a patent is granted to one person while another has a caveat pending and in force will not of itself vacate the patent granted nor authorize the Commissioner to grant a patent to the caveator. (*Cochrane* v. *Waterman, MS. Appeal Cases, D. C.*, 1844.)

11. CAVEAT PAPERS CANNOT BE WITHDRAWN FROM THE OFFICE nor undergo alteration after they have once been filed; but the caveator, or any person properly authorthorized by him, can at any time obtain copies of the caveat papers at the usual rates. (*Patent Office Rules, July*, 1870.)

12. CAVEAT AS EVIDENCE.—A caveat may be resorted to to assist in construing a patent. (*Smith* v. *Downing*, 1 *Fish.*, 64.)

And it is evidence as to an invention, so far as it ex-

tends to the *description* of the invention and the machinery which was then constructed. (*Jones* v. *Wetherell, MS. Appeal Cases, D. C.*, 1855.)

But a caveat is not conclusive evidence that an invention is not perfected. (*Johnson* v. *Root*, 1 *Fish.*, 351.)

A filed a caveat in the Patent Office April 17, 1854. B made application for a patent for the same invention November, 1854. No notice was given to A of this application, but a patent was granted to B January 9, 1855. A patent was subsequently granted to A. In a suit of the assignees of B against the assignees of A, *held* that the omission to give notice to A might be set up as one of the defenses under § 15 of the act of July 4, 1836, as proof that B "had surreptitiously or unjustly obtained the patent for that which was in fact discovered by another," &c. (*Phelps* v. *Brown Bros.*, 1 *Fish.*, 479.)

13. CAVEAT NOTICE TO THE COMMISSIONER ONLY.—The caveat gives no notice to the world or even to the interfering applicant. It is notice to the Commissioner only. (*Hildreth* v. *Heath, MS. Appeal Cases, D. C.*, 1841.)

But the Commissioner can perform no act upon a caveat but filing it, nor in consequence of it, except to give the caveator notice of a conflicting application when made. (11 *Opinions Attorneys General*, 65.)

14. FORM OF PETITION.—

The petition of Frank Foresight, of Brandenberg, in the county of Mead, and State of Kentucky, respectfully represents—

That he has made certain improvements in velocipedes, 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.

FRANK FORESIGHT.

15. DESCRIPTION.—

The following is a description of my newly-invented velocipede, which is as full, clear, and exact as I am able at this time to give, reference being had to the drawing heroto annexed:

This invention relates to that class of velocipedes in which there are two wheels connected by a beam, forming a saddle for the rider, the feet being applied to cranks that revolve the front wheel.

The object of my invention is to render it unnecessary to turn the front wheel so much as heretofore, and at the same time to facilitate the turning of sharp curves. This I accomplish by fitting the front and the hind wheels on vertical pivots, and connecting them by means of a diagonal bar, as shown in the drawing, so that the turning of the front wheel also turns the back wheel with a position at an angle with the beams, thereby enabling it easily to turn a curve.

In the drawing A is the front wheel, B the hind wheel, and C the standards extending from the axle of the front wheel to the vertical pivot *a* in the beam *b*, and D is the cross-bar upon the end of *a*, by which the steering is done. The hind wheel B is also fitted with jaws *c* and a vertical pivot *d*.

FRANK FORESIGHT.

Witnesses: ANDREW AXLE.
WILLIAM WHEELWRIGHT.

16. OATH.—No caveat can be filed in the secret archives of the office unless accompanied by an oath of the caveator that he is a citizen of the United States, or, if he is an alien, that he has resided for one year last past within the United States and has made oath of his intention to become a citizen thereof; nor unless the applicant also states, under oath, that he believes himself the original inventor of the art, machine, or improvement set forth in his caveat. (*Patent Office Rules, July*, 1870.)

The form of oath will be substantially that provided for original applications, except that, as a caveat can only be filed by a citizen, or an alien who has resided for one year last past in the United States, and made oath of his intention to become a citizen, the oath should be modified accordingly. (*Ib., vide infra*, § 323.)

II. Subject-Matter of the Application.

SEC.
17. What may be patented.
18. Inventions patented abroad.
19. Abstract principle.
20. Application of a law of nature.
21. Effect.
22. New application; double use.
23. Mechanical equivalents.
24. Mechanical skill.
25. Discovery.
26. Novelty.
27. Presumption of novelty.
28. Utility.
29. Harmful inventions not patentable.
30. Art.
SEC.
31. Process.
32. Machine.
33. Machines classified.
34. Form.
35. Manufacture.
36. Identity of principle.
37. Composition of matter.
38. Improvement.
39. Priority of invention.
40. Lost art.
41. Prior experiments.
42. Prior publication.
43. Prior foreign patent.
44. Unity or diversity of invention.
45. Division of the application.

17. WHAT MAY BE PATENTED.—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 duty required by law and other due proceedings had, obtain a patent therefor. (*Act of July* 8, 1870, § 24.)

18. INVENTIONS FIRST PATENTED ABROAD MAY BE PATENTED IN THE UNITED STATES.—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, provided the same shall not have been introduced into public use in the United States for more than two years prior to the application, and that the patent shall 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; but in no case shall it be in force more than seventeen years. (*Ib.*, § 25.)

19. AN ABSTRACT PRINCIPLE NOT PATENTABLE UNLESS REDUCED TO PRACTICE.—A discovery of some new principle, theory, or elementary truth, abstracted from its application, is not a new invention, and cannot be protected by a patent. To entitle himself to a patent the applicant must reduce it to practice, must embody it in some practical machine or method of rendering it available or useful. (*Whitney* v. *Emmett*, *Bald.*, 311; *Evans* v. *Eaton*, *Pet. C. C.*, 341, 342.)

And when the discovery is reduced to practice by any means, old or new, resulting usefully, it is patentable, independent of the machinery by which the application is made. (*Foote* v. *Silsby*, 2 *Blatchf.*, 265.)

20. APPLICATION OF A LAW OF NATURE.—He who first discovers that a law of nature can be applied, and, having devised machinery to make it operative, introduces it in practical form to his fellow-men, is the inventor not merely of the mechanism, but of the force which operates through the mechanical medium. He may assert and establish his property not only in the formal device for which mechanical ingenuity can at once, as soon as the principle is known, imagine a thousand substitutes, but in the essential principle which his machine was the first

to embody and announce to mankind. (*Parker* v. *Hulme*, 1 *Fish.*, 44.)

Thus, where a patentee claimed the application of the expansive and contractive power of a metallic rod, by different degrees of heat, to open and close a damper which governs the admission of air into a stove, it was *held*, that it was a valid claim, not being for a principle, and that the patent was good. (*Silsby* v. *Foote*, 20 *How.*, 385.)

21. A PATENT CAN IN NO CASE BE FOR AN EFFECT ONLY, but for an effect produced in a given manner or by a peculiar operation. No patent can be obtained for the admeasurement of time or the expansive operations of steam, but only for a new mode or new application of machinery to produce these effects; and therefore if new effects are produced by an old machine in its unaltered state, no patent can be legally supported, for it is a patent for an effect only. (*Whittemore* v. *Cutter*, 1 *Gall.*, 480.)

The application of ether to surgical purposes was an effect produced by old agents, operating by old means upon old subjects. The effect alone was new, and was a mere discovery, which, however novel and important, is not patentable. (*Morton* v. *New York Eye Infirmary*, 2 *Fish.*, 320.)

An end to be accomplished is not the subject of a patent; only the new and useful means to accomplish it. (*Carver* v. *Hyde*, 16 *Pet.*, 519.)

But the discovery of the application of some property in nature never before known or in use, by which is produced a *new and useful result*, is the subject of a patent, independently of any peculiar or new arrangement of

machinery for the purpose of applying such new property. (*Foote* v. *Silsby*, 2 *Blatchf.*, 264.)

And the inventor has the right to use any means, new or old, in the application of the new property to produce the new and useful result, to the exclusion of all other means. (*Ib.*)

Where a result is in a greatly improved manufacture, it may become the test of invention, and from which invention may be inferred. (*Treadwell* v. *Fox*, *MS. Appeal Cases*, *D. C.*, 1859.)

22. New Application; Double Use.—The application of an old thing to a new purpose is not patentable. The thing itself which is patented must be new, and not a mere application of it to a new purpose or object. (*Bean* v. *Smallwood*, 2 *Story*, 411.)

The inventor of a machine has made it for all the uses to which it is applicable, and no one can obtain a second patent for the machine by applying it to a new use. (*Woodman* v. *Simpson*, 3 *Fish.*, 98.)

But a new adaptation and *arrangement* of applying and using old articles for a certain purpose—for example, using old parts of a caster adapted to furniture in a manner before unknown—may be the subject of letters patent. (*Blake* v. *Sperry*, 2 *N. Y. Legal Obs.*, 251.)

And though a combination of machinery is not new in the abstract, yet it is patentable if used and applied in connection with the practical development of a newly discovered principle producing a new and useful result. (*Tatham* v. *Le Roy*, *MS. N. Y.*, 1849.)

Where the principle of the alleged invention has been discovered and applied before, the new application will

be what is called a double use. (*Blandy ex parte, MS. Appeal Cases, D. C.*, 1858.)

The application of a thing already known to a new and useful purpose may be the subject of a patent, provided the new use is not analogous to the old, and requires the exercise of inventive faculties. (*Winans* v. *Schenectady and Troy Railroad*, 2 *Blatchf.*, 293.)

If the patentee was the first and original inventor of the application and use of plaster of Paris to the filling of fire-proof safes, and this application produced a new and useful result, it cannot be doubted that it is a proper subject of a patent. (*Rich* v. *Lippincott*, 2 *Fish.*, 1.)

An invention or arrangement of parts, though already used for a particular purpose, is patentable, if in the new use it performs any new function, or an old function in a better manner, or makes a better or cheaper manufacture. (*Newman ex parte, MS. Appeal Cases, D. C.*, 1859.)

The substitution of a jewel in place of glass in a sewing machine to prevent friction in the passage of the thread is not patentable; it is but the double use of an old contrivance, with no new effect or result. (*Berry ex parte, MS. Appeal Cases, D. C.*, 1859.)

The making of an instrument of india rubber and silver, if a useful effect is seeured thereby, may be the subject of a patent, though such article may have before been made entirely of metal and also entirely of rubber. Such an invention is not a double use. (*Adams ex parte, MS. Appeal Cases, D. C.*, 1860.)

23. MECHANICAL EQUIVALENTS.—The substitution of a known mechanical equivalent is not an invention within the patent law. (*Blanchard's Gun-Stock Turning Company* v. *Warner*, 1 *Blatchf.*, 278.)

There are different well-known devices, any one of which may be adapted to effect a given result, according to the judgment of the constructor. The mere substitution of one of these for another does not belong to the subject of invention, but of construction. (*Foster* v. *Moore*, 1 *Curt.*, 291.)

By equivalents in machinery is usually meant the mere substitution of one mechanical power for another, or one obvious and customary mode for another, to effect a like result. (*Smith* v. *Downing*, 1 *Fish.*, 64.)

The term "equivalents" has two meanings, as used in patent cases. The one relates to the results that are produced, and the other to the mechanism by which these results are produced. (*Johnson* v. *Root*, 1 *Fish.*, 352.)

A mechanical equivalent, as generally understood, is when one thing may be adopted instead of another, by a person skilled in the art, from his knowledge of the art. (*Ib.*)

By an "equivalent" is meant something that does the same thing in substantially the same way. (*Cahoon* v. *Ring*, 1 *Fish.*, 397.)

When a party has discovered a result, as well as the machinery that produces it, he has a right to invoke the doctrine of equivalents in reference to infringers. (*Singer* v. *Walmsley*, 1 *Fish.*, 558.)

But where he is only the original inventor of a device, he can only recover against an infringer, if he shows that he has substantially copied his invention. In other words, being an improver himself, he cannot invoke the doctrine of equivalents to help him. (*Ib.*)

Where a patent is granted for a composition made of several ingredients, it covers and embraces known equiv-

alents of each of the ingredients. (*Matthews* v. *Skates*, 1 *Fish.*, 602.)

An equivalent of any substance is another substance having similar properties and producing substantially the same effect. (*Ib.*)

An equivalent device is such as a mechanic of ordinary skill in the construction of similar machinery, having the plaintiff's specification and machine before him, could substitute in the place of the mechanism described, and without the exercise of the inventive faculties. (*Burden* v. *Corning*, 2 *Fish.*, 477.)

In the case of *Foster* v. *Moore*, Mr. Justice Curtis charged the jury as follows: "The term 'equivalent,' gentlemen, has two meanings, as used in this class of cases. The one relates to the results that are produced, and the other to the mechanism by which those results are produced. Two things may be equivalent, that is, the one equivalent to the other, as producing the same result, when they are not the same mechanical means. Mechanical equivalents are spoken of as different from equivalents that produce the same result. A mechanical equivalent, I suppose, as generally understood, is where the one may be adopted instead of the other, by a person skilled in the art, from his knowledge of the art. Thus an instrumentality is used as a mechanism. You wish to produce a pressure downward; well, it can be done by a spring or it can be done by a weight. A machine is presented to a person conversant with machines. He sees that the force applied downward in the one before him is by weight; from a knowledge of his art he can pass at once to another force—the spring to press it downward; and these are mechanical equivalents. But,

gentlemen, there may be equivalents in producing the same results, each of which is an independent matter of invention, and in that sense they are not mechanical equivalents. To illustrate my meaning, suppose in early days the problem was to get water from a well to the surface of the earth: one man takes a rope made of grass and draws up a pail of water; another would see that, as a mechanical equivalent, a rope of hemp would accomplish the same result. But suppose that another person comes and for the first time invents a pump: that is equivalent in the result to bringing the water to the surface of the ground; in that respect it is equivalent, as producing that result, to hauling it up by a rope, but it is not mechanically equivalent; it brings into operation, as you know, different powers and forces, and would require invention to introduce it. (1 *Curtis C. C.*, 279.)

24. MECHANICAL SKILL.—There must be embodied in the invention, over and beyond the skill of the mechanic, that inventive element of the mind which is to be found in every invention that is the proper subject of a patent. (*Tatham* v. *Le Roy*, 2 *Blatchf.*, 488.)

Mere mechanical skill can never rise to the sphere of invention. The latter involves higher thought and brings into activity a different faculty. Their domains are distinct. The line which separates them is sometimes difficult to trace; nevertheless, in the eye of the law, it always subsists. (*Blandy* v. *Griffith*, 3 *Fish.*, 609.)

It is difficult to determine where ordinary mechanical skill ends and invention begins. The best practical principle is, that where the combination of known elements produces new and useful results to the public not before

attained, then the person who discovers and applies the combination is an inventor, within the true intent and meaning of the patent law. (*Smith ex parte, MS. Appeal Cases, D. C.*, 1860.)

25. DISCOVERY.—Discovery is synonymous with invention, under the Constitution and laws of the United States respecting patents. (*Kemper ex parte, MS. Appeal Cases, D. C.*, 1841.)

A patent cannot be granted for the discovery of a fact which long before existed; there is no invention, nothing contrived or produced. (*Ib.*)

In its naked and ordinary sense a discovery is not patentable. It is only when the explorer has gone beyond the mere domain of discovery, and has laid hold of the new principle, force, or law, and connected it with some particular medium or mechanical contrivance, by which, or through which, it acts on the material world, that he can secure the exclusive control of it under the patent laws. He then controls the discovery through the means by which he has brought it into practical action, or their equivalent, and it is then an invention, although it embraces a discovery. (*Morton* v. *New York Eye Infirmary*, 2 *Fish.*, 320.)

A discovery may be the *soul* of an invention, but it cannot be the subject of the exclusive control of the patentee, or the patent law, until it inhabits a body, no more than can a disembodied spirit be subjected to the control of human law. (*Ib.*)

He who has discovered some new element or property of matter may secure to himself the ownership of his discovery, but the mental conception must have been embodied in some mechanical device or some process

of art. The patent must be for a thing, not for an idea merely. (*Vide supra, p.* 219; *Deimold* v. *Reeves*, 1 *Fish.*, 127.)

The discovery of a fact, that a given natural substance will, in appropriate methods of administration, produce a particular physiological or pathological effect on the human body, is not a thing patentable under any existing statute. (*Morton's Anæsthetic Patent*, 8 *Opinions Attorneys General*, 272.)

A new process is generally the result of discovery—a machine of invention. (*Corning* v. *Burden*, 15 *How.*, 267.)

26. NOVELTY.—As to the novelty of the invention, the rule is that it must be new as to all the world; not the abstract discovery, but the thing invented; not the new secret principle, but the manufacture resulting from it. (*Whitney* v. *Emmett*, *Bald.*, 309.)

The thing itself which is patented must be new, not merely the purpose to which it is applied. (*Bean* v. *Smallwood*, 2 *Story*, 411.)

The question is whether the thing has been known before. In case of a machine, whether it has been substantially constructed before; in case of an improvement of a machine, whether that improvement has ever been applied to such a machine before, or whether it is substantially a new combination. (*Earle* v. *Sawyer*, 4 *Mason*, 6, 7.)

The question is not whether the invention is better or worse than its predecessor, but whether it is new and useful, and different from anything before used or known. (*Blandy* v. *Griffith*, 3 *Fish.*, 609.)

The law does not require any degree of utility; it does not exact that the subject of the patent shall be better

than anything invented before or that shall come after. (*Hoffheim* v. *Brandt*, 3 *Fish.*, 218.)

A novelty in principle may consist in a new and valuable mode of applying an old power, effecting it not merely by a new instrument or form of the machine, or any mere equivalent, but by something giving it a new or greater advantage. (*Hovey* v. *Stevens*, 1 *Wood & Min.*, 290.)

In the allowance of a patent the question of novelty should not be too rigorously questioned, but the benefit of any doubt should be given to the applicant, as, if his application is rejected and his invention have real patentable novelty, irremediable injury would be produced; but if the patent is allowed, the novelty can still be inquired into by a jury. (*Cole ex parte*, *MS. Appeal Cases*, *D. C.*, 1857.)

It was formerly necessary among us, as in England, that the whole of the improvements claimed as such should be new, and if the novelty of any one of them failed, though it might not be one used by the defendant, an action could not be sustained. But the law now provides (*ut supra*, p. 27, § 60) that the patent shall be deemed good and valid for so much of the invention or discovery as shall be truly and *bona fide* the invention or discovery of the patentee, if it is a material and substantial part of the thing patented, and definitely distinguished from the other parts which the patentee had no right to claim, notwithstanding the specification may be too broad, if it was so made without willful default. (*Curtis on Patents*, § 334.)

27. PRESUMPTIONS OF NOVELTY.—Presumptions of the novelty of a patented invention may arise from some or

all of the following grounds: 1. The oath of the patentee that he was the first and original inventor; 2. The action of the Patent Office in granting the patent after full examination; 3. Undisturbed enjoyment of all the benefits of the exclusive rights granted by the patent; 4. Direct adjudications, either at law or in equity, establishing the validity of the patent; 5. Injunctions granted to restrain infringement of the patent. (*Hussey* v. *Whitely*, 2 *Fish.*, 120.)

28. UTILITY.—The word useful is used in contradistinction to mischievous or immoral. All that the law requires is that the invention should not be frivolous or injurious to the well-being, good policy, or sound morals of society. Whether the invention is more or less useful is a circumstance of no importance to the public. It is sufficient if the invention has any utility. (*Lowell* v. *Lewis*, 1 *Mason*, 186; *Kneas* v. *Schuylkill Bank*, 4 *Wash.*, 12.)

The degree of the utility of an invention is not a subject for consideration in determining whether an invention is patentable. (*Seely ex parte*, *MS. Appeal Cases*, *D. C.*, 1853.)

It is the *duty* of the Commissioner to grant a patent, if in his opinion the thing is sufficiently useful and important. But the degree of usefulness or importance is not described or limited by the statute; nor is it material if the matter interferes with no prior right or claim and is in itself innocent. If good may be the result of granting a patent and evil cannot, it ought to be granted. (*Aiken ex parte*, *MS. Appeal Cases*, *D. C.*, 1850.)

But the invention must be, in some small measure at least, beneficial to the community. An invention for folding thread or cotton in a more ornamental manner,

by which the article would sell quicker and at a higher price, but which made no change in the article, is not a useful invention within the patent laws, although useful to the patentee. (*Langdon* v. *De Groot*, 1 *Paine*, 204, 206.)

The presumption on the face of a patent is that it is of some utility, for the applicant is obliged to swear that the invention is useful before he can secure a patent. (*Coleman* v. *Liesor*, *MS.*, *Ohio*, 1859.)

29. HARMFUL INVENTIONS NOT PATENTABLE.—In the case of *George B. Morris and Samuel Watson ex parte* the Commissioner says: Applicants described in their original specification what they called "a new process for making butter, to be used in place of ordinary butter." They say, "the nature of our invention consists in preparing ordinary butter, and combining it with milk and other ingredients, whereby it is increased in bulk and weight." Again they say, "to prepare the *Western Dairy Butter* take say about ten pounds of ordinary butter, and wash the same as cold as it can be worked in clear lime water, in which about four ounces of lime to the gallon of water have been dissolved," &c. They next warm the butter, and mix it with sweet milk and flour into a paste. They then color it with eggs, carrots, or anotta and tumeric, until at length the precious mess produces "about eighteen pounds of good solid butter, which may be printed in cakes or made into rolls or packed." Subsequently applicants amended this application, by changing the title to a process for making "A Substitute for Butter;" but the remainder of the specification, the process itself, the title of "Western Dairy Butter," and the statement of the nature of the invention, remain unchanged.

This application was rejected by the primary examiner, but was allowed by a majority of the board of examiners-in-chief on appeal. The examiner now presents the matter for the judgment of the Commissioner in person.

Fortunately the law vests the Commissioner with ample powers to protect the public against the advertisement of such mixtures under the sanction of this office.

Section 31, act of July 8, 1870, provides that "the Commissioner 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."

In the opinion of the Commissioner, this invention, whether regarded as a new process of making butter, which it is not, or as "a new process for making a substitute for butter," is not sufficiently useful or important to warrant the grant of letters patent for it. (*Commissioner's Decision, July* 23, 1870.)

The feasi lity of an invention in point of expense is not for the office to consider; nor will an invention be condemned on the ground that it is too costly for use. (*R. A. Cheesborough ex parte, Commissioner's Decisions,* 1859, p. 18.)

30. ART.—In order to make a new process or method of working, or of producing an effect or result in matter a subject of a patent in England, a somewhat liberal construction of the term "manufacture" became necessary, by which an improvement in the art or process of making or doing a thing was made constructively to be represented by the term which, ordinarily, would mean only

the thing itself, when made or done. It was, doubtless, to avoid the necessity for this kind of construction that the framers of our legislation selected a term which, *pro prio vigore*, would embrace those inventions where the particular machinery or apparatus, or the particular substance employed, would not constitute the discovery, so much as a newly-invented mode or process of applying them, in respect to the order, or position, or relations in which they are used. Thus, for example, in the art of dyeing or tanning, it is obvious that an old article of manufacture may be produced by the use of old materials, but produced by the application of those materials in new relations. In such cases it might not be practicable to claim the article itself, when made, as a new manufacture, for it might, as an article of commerce or consumption, differ in no appreciable way from the same kind of article produced by the old and well-known method; at the same time the new method of producing the article might be a great improvement, introducing greater cheapness, rapidity, or simplicity in the process itself. Again, other cases may be supposed, where the manufacture itself, as produced by a new process, would be better than the same manufacture produced by the old process, as in the different modes of making iron from the native ore; and yet the really new discovery in such cases could not well be described as a new "manufacture" or a new "composition of matter," without a figurative use of those terms, which it is desirable to avoid. This difficulty is avoided by the use of the term "art," which was intended to embrace those inventions where the particular apparatus or materials employed may not be the essence of the discovery, but where that

essence consists in using apparatus or materials in new processes, methods, or relations, so as to constitute a new mode of attaining an old result, or a mode of attaining a new result, in a particular department of industry, which result may not of itself be any new machine, manufacture, or composition of matter; or, finally, an entirely new process of making or doing something which has not been made or done before by an old process. (*Curtis on Patents*, § 9.)

The patent may be for a new and useful art, but it must be practical; it must be applicable and referable to something which may prove it to be useful. A mere abstract principle is unsusceptible of appropriation by patent. (*Vide supra*, p. 219, § 19.)

The applicant for a patent must show how the principle is to be used and applied to some useful purpose. (*Evans* v. *Eaton*, 1 *Pet. C. C.*, 341.)

Art, as the subject of a patent, is not art in the abstract, without a specification of the manner in which it is to operate as a manufacture or otherwise, but it is the art explained in the specification, and illustrated by a machine or model or drawing. It is the art so represented or exemplified, like the principle thus embodied, which alone the patent laws are designed to protect. In the English patent acts the word art is not used at all. (*Smith* v. *Downing*, 1 *Fish.*, 64.)

The word art means a useful art or a manufacture which is beneficial, which is required to be described with exactness in its mode of operation, and which can be protected only in the mode used to the extent thus described. (*Ib.*)

An *art* is entitled to protection as well as the machin-

ery or process which the art teaches, employs, or makes useful. (*French* v. *Rogers*, 1 *Fish.*, 133.)

A patent for "an improvement in the art of making nails, *by means* of a machine which cuts and heads the nail at one operation," is not a grant of an abstract principle, nor is it a grant of the different parts of any machine, but an improvement applied to a practical use effected by a combination of various mechanical parts to produce a new result. (*Gray* v. *James*, *Pet. C. C.*, 400, 401.)

An improvement in an art, as of casting iron by giving an angular direction to the tube which conducts the metal to the mold, so that the flog or drop will be thrown into the center instead of the surface, is patentable. (*McClurg* v. *Kingsland*, 1 *How.*, 209, 210.)

A mode or tabular form of keeping mercantile accounts, whereby a balance sheet and statement of assets is constantly shown, is not an invention of an art, machine, or composition of matter, and is not patentable. (*Dixon ex parte*, *MS. Appeal Cases*, *D. C.*, 1860.)

31. PROCESS.—A process *eo nomine* is not the subject of a patent under our laws, but it is included under the general term "useful art," and an art may require one or more processes or machines in order to produce a certain result or manufacture. (*Corning* v. *Burden*, 15 *How.*, 252.)

Where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods, or operations are called "processes." The arts of tanning, dyeing, making water-proof cloth, vulcanizing india rubber, smelting ores, &c., are usually

carried on by "processes," as distinguished from machines. One person may discover an improvement in a process, irrespective of any particular form of machinery, and another may invent a labor-saving machine by which the operation or process may be performed, and each may be entitled to a patent—the first, for a process, but not for a machine; the second, for a machine, but not for a process. It is when the term "*process*" is used to represent some means or method of producing a result, that a process is patentable, and thus used the term includes all means which are not effected by mechanism or mechanical combinations. (*Ib.*)

A principle, so far embodied and connected with corporeal substances as to be in a condition to act and to produce effects in any art, trade, mystery, or manual occupation, becomes the practical manner of doing a particular thing. It is no longer a principle, but a process. Mr. Watts's invention was the discovery of a practical means of lessening the consumption of steam, by protecting the cylinder from the external air, and keeping it at a temperature not below that of steam itself. He thus brought a principle into practical application, by the invention of a process carried on by a newly-contrived machine. (*Curtis on Patents*, § 5.)

The application of an old process to the manufacture of an article to which it had never been before applied is not patentable. (*How* v. *Abbot*, 2 *Story*, 190, 1842.)

The inventor is entitled to separate claims for the process and the product which it produces; and while such claims may properly be embraced in one patent, it is a matter within the discretion of the Commissioner so to

include them, or to issue separate patents for each. (*Goodyear* v. *Wait*, 3 *Fish.*, 242.)

If the patentee be the inventor of a new composition of matter, not known or used by others before his discovery, his sole right to use, and vend to others to be used, is the new composition or substance itself. The product and process constitute one discovery. (*Goodyear* v. *The Railroads*, 2 *Wall., jr.*, 360.)

Where the specification showed that the invention was not merely an improved method or process, but a new product, fabric, or manufacture, *held*, that the patentee had a right to prohibit the sale or use of the composition, as the product and process both were new. (*Ib.*)

32. MACHINE.—Machines may be regarded merely as devices, by the instrumentality of which the laws of nature are made applicable and operative to a particular result. (*Parker* v. *Hulme*, 1 *Fish.*, 50.)

A machine is rightfully the subject of a patent whenever a new or an old effect is produced by mechanism new in its combinations, arrangements, or mode of operation.

If the subject of the invention or discovery is not a mere function, but a function embodied in some particular mechanism, whose mode of operation and general structure are pointed out, and which is designed to accomplish a particular purpose, function, or effect, it will be a machine, in the sense of the patent law. A machine is rightfully the subject of a patent when well-known effects are produced by machinery entirely new in all its combinations, or when a new or an old effect is produced by mechanism of which the principle or *modus operandi* is new. The word "machine" in the statute

includes new combinations of machines, as well as new organizations of mechanism for a single purpose. There may be a patent for a new combination of machines to produce certain effects, whether the machines constituting the combination be new or old. In such cases the thing patented is not the separate machines, but the combinations. A single instance of such a combination is presented by the telescope, in which a convex and concave glass of different refracting powers are combined to make the object-glass. (*Curtis on Patents*, § 21.)

The word "machine" in the statute includes new combinations as well as new organizations of mechanism, and hence there may be a patent for new combinations of machinery to produce certain effects, whether the machines constituting the combination be new or old. (*Wintermute* v. *Redington*, 1 *Fish.*, 240.)

Invention, as respects machines, is any new arrangement or combination of machinery, whether of old or new parts or materials, producing a useful result. (*McCormick* v. *Seymour*, *MS.*, *N. Y.*, 1857.)

A machine may be new, and the product or manufacture proceeding from it may be old. In that case the former would be patentable, and the latter not. The machine may be substantially old and the product new. In that event the latter, and not the former, would be patentable. Both may be new, or both may be old. In the former case, both would be patentable; in the latter, neither. The same remarks apply to processes and their results. Patentability may exist as to either, neither, or both, according to the fact of novelty, or the opposite. The patentability, or the issuing of a patent as to one, in nowise affects the rights of the inventor or discover in

respect to the other. They are wholly disconnected and independent facts. (*Rubber Company* v. *Goodyear*, 9 *Wallace*, 796.)

33. INVENTIONS PERTAINING TO MACHINES MAY BE DIVIDED INTO FOUR CLASSES.—1. Where the invention embraces the entire machine. Under such a patent, the patentee holds the exclusive right to make and use, and vend to others to be used, the entire machine; and if another, without license, makes, uses, or vends any portion of it, he invades the right of the patentee.

2. Those which embrace one or more elements of a machine. In patents of this class any person may make, use, or vend all other parts of a machine, and he may employ the same part or element of a machine, provided it be substantially different from that embraced in the patent.

3. Those which embrace both a new element and a new combination of elements previously used and well known. The property of the patentee in such a case consists in the new element and the new combination.

4. Those where all the elements of the machine are old, and where the invention consists in a new combination of those elements, whereby a new and useful result is obtained.

Most of the modern inventions are of this latter kind, and many of them are of great utility and value: (*Union Sugar Refinery* v. *Matthiessen*, 2 *Fish.*, 600.)

34. FORM, (*vide supra*, p. 225.)—A mere change of the form or proportions of any machine cannot, *per se*, be deemed a new invention. (*Lowell* v. *Lewis*, *Mason*, 190.)

There must be a substantial difference in the principle, and the application of it, to constitute such an improve-

ment as the law will protect. (*Smith* v. *Pearce*, 2 *McLean*, 178.)

But if by changing the form and proportion a new effect is produced, there is not simply a change of form and proportion, but a change of principle also. (*Davis* v. *Palmer*, 2 *Brock.*, 310.)

If an improvement in form and structure enables the operator to do the work in a better manner, or with more ease, or less expense, or in less time, it is a patentable improvement. (*Bain* v. *Morse*, *MS. Appeal Cases*, *D. C.*, 1849.)

35. MANUFACTURE.—The term "manufacture" was used in the English statute (21 *Jac.* I) to denote anything made by the hand of man; so that it embraces, in the English law, machinery as well as substances or fabrics produced by art and industry. It came by construction to include the process of making a thing, or the art of carrying on a manufacture; so that all the various objects which are now held in England to be the subjects of letters patent are included under this term, which alone saves them out of the prohibition of the statute of monopolies.

Our statute, however, having made an enumeration of the different classes of subjects which in England are held to be patentable, it is to be presumed that this term was used to describe one of these classes only, namely, fabrics or substances made by the art or industry of man, not being machinery. It may sometimes require a nice discrimination to determine whether one of these classes does not run into the other in a given case: as, for instance, when a tool or instrument of a novel or improved construction is produced, to be used in connection with

other machinery or to be used separately. As an article of merchandise, found and sold separately in the market, such a production would be a manufacture; but, regarded with reference to its use and intended adaptation, it might be considered as a machine or part of a machine. In determining in such cases how the patent for the article should be claimed, it would probably be correct to range it under the one or the other of these classes, according to the following test: if the article is produced and intended to be sold and used separately as a merchantable commodity, and the merit of it as an invention consists in its being a better article than had been before known, or in its being produced by a cheaper process, then it may properly be considered simply as a manufacture; but if its merit appears only after its incorporation with some mechanism with which it is to be used, and consists in producing, when combined with such mechanism, a new effect, then it should be regarded as a machine, or an improvement of an existing machine.

The fact that a result is a new and valuable article of manufacture affords ground to presume invention. (*Woodruff ex parte, MS. Appeal Cases, D. C.*, 1859.)

A new manufacture, as the use of a new composition, which results in a new and useful article, is the proper subject of a patent, though the means employed to adapt the new composition to a useful purpose are old and well known. (*Hotchkiss* v. *Greenwood*, 11 *How.*, 265.)

There is a wide difference between the invention of a new method or process, by which a known fabric, product, or manufacture is produced in a better and cheaper way, and the discovery of a new compound, substance,

or manufacture, having qualities never found to exist together in any other material.

In the first case, the inventor can patent nothing but his process; in the latter, both the process and composition of matter are patentable. (*Goodyear* v. *The Railroads*, 2 *Wall., jr.*, 360.)

Where the result or effect is a greatly-improved article of manufacture, it may become the test from which invention may be inferred. (*Treadwell* v. *Fox*, *MS. Appeal Cases*, *D. C.*, 1859.)

Where the claim was for a particular method of forming hoop-skirts, which rendered necessary the use of a former, it was held, the inventor had a right to claim the use of the apparatus as incidental and subsidiary to the practical purpose of the idea constituting his invention; and that therefore it was immaterial that the apparatus of the former was old. (*Mann ex parte*, *MS. Appeal Cases*, *D. C.*, 1860.)

36. IDENTITY OF PRINCIPLE.—The word *principle* means the operative cause by which a certain effect is produced, the combination of certain mechanical powers, the mode of operation, the mode or manner of operation; and hence there may be two structures, widely different in appearance or dimensions, which are yet identical in principle. Whatever is essential to produce the appropriate result of a machine, independent of its mere form, is a matter of principle. (*Latta* v. *Shawk*, 1 *Fish.*, 465.)

One machine or manufacture is not a violation of another, within the purview of the patent system, unless it is substantially the same. It need not be identical, but it must be similar in the principle or mode of operation. (*Smith* v. *Downing*, 1 *Fish.*, 64.)

The identity that is to be looked to in an action of infringement respects that which constitutes the essence of the invention, namely, the application of the principle. If the mode adopted by the defendant shows that the principle admits of the same application in a variety of forms, or by a variety of apparatus, such mode is a piracy of the invention. (*Wintermute* v. *Redington*, 1 *Fish.*, 239.)

But if the defendant has adopted variations which show that some other law, or rule of practice or science, is made to take the place of that which the patentee claims as the essence of his invention, then there is no infringement. (*Ib.*)

If the same result is produced by the defendant as by the patentee, but by means substantially different, there is no infringement, for a patent is not granted for a mere result; but, otherwise, if the defendant produces the result by contrivances substantially the same in principle. (*Morris* v. *Barrett*, 1 *Fish.*, 461.)

If the parts of two machines, having the same mode of operation, do the same work in substantially the same way, and accomplish substantially the same result, those parts are the same, although they may differ in name, form, or shape. (*Union Sugar Refinery* v. *Matthiessen*, 2 *Fish.*, 600.)

Two structures are "substantially" the same when they are of the same material, if material is important; of the same thickness, if thickness is important; or of the same form, when form contributes to the result.—(*Adams* v. *Edwards*, 1 *Fish.*, 1.)

The identity or diversity of two machines depends, not on the employment of the same elements or powers

of mechanism, but upon producing the given effect by substantially the same mode of operation or substantially the same combination of powers. One device cannot be said to be a well-known substitute of another, which cannot be used for it. (*Crompton* v. *Belknap Mills*, 3 *Fish.*, 563.)

Where a patent is for a combination of distinct and designated parts, it is not infringed by a combination which varies from that patented, in the omission of one of the operative parts and the substitution therefor of another part, substantially different in its construction and operation, but serving the same purpose. (*Eames* v. *Godfrey*, 1 *Wallace*, 78.)

"Substantial identity" excludes immaterial variations or fraudulent evasions. That is a substantial identity which comprehends the application of the principle of the invention. If a party adopts a different mode of carrying the same principle into effect, and the principle admits of a variety of forms, there is an identity of principle though not an identity of mode. (*Page* v. *Ferry*, 1 *Fish.*, 298.)

37. COMPOSITION OF MATTER.—The term "composition of matter" includes medicines, compositions used in the arts, and other combinations of substances intended to be sold separately. In such cases the subject-matter of the patent may be either the composition itself, the article produced, or it may be the mode or process of compounding it. Generally speaking the patent covers both, because, if the composition is itself new, the process by which it is made must also be new, and the law will protect both as the subjects of invention. (*Curtis on Patents*, § 28.)

It is no ground for the rejection of an application for a patent for a composition of matter that the thing invented is an imitation of a real existing substance or material, *e. g.*, artificial honey. (*Corbin & Marllett ex parte, MS. Appeal Cases, D. C.*, 1857.)

It is not necessary, to render a composition patentable, that every ingredient or that any one ingredient used by the patentee in his invention should be new or unused before for the purpose intended. The question is, whether the combination of materials used by the patentee is substantially new. Each of the ingredients may have been in extensive common use, and some may have been used for the same purpose; but if they have never been combined together in the manner stated in the patent, but the combination is new, the invention of the combination is patentable. (*Ryan* v. *Goodwin*, 3 *Sumn.*, 518.)

The inventor of a new compound, wholly unknown before, is not limited to the use always of the same precise ingredients in making that compound; and if the same purpose can be accomplished by him by the substitution in part of other ingredients in the composition, which have never been so used before, he is at liberty to extend his patent so as to embrace them also. Thus, where an inventor claimed as his invention the combination of phosphorus with chalk or any other absorbent earth or earthy material, or glue or any other glutinous substance, using the materials in the proportions substantially as set forth in the specification, in making matches, it was held, that the patent was not void as being too broad and comprehensive. (*Ib.*, 521.)

The question is, not whether the compositions are iden-

tical, but are they substantially the same. (*Streel* v. *Silver*, *Brightley*, 100.)

Where a patent is claimed for a discovery of a new substance, by means of chemical combinations of known materials, it should state the component parts of the new manufacture claimed with clearness and precision, and not leave the person attempting to use the discovery to find it out by "experiment." (*Tyler* v. *Boston*, 7 *Wallace*, 327.)

38. IMPROVEMENT.—Improvement, applied to machinery, is where a specific machine already exists, and an addition is made to produce the same effects in a better manner, or some new combinations are added to produce new effects. (*Fultz ex parte*, *MS. Appeal Cases*, *D. C.*, 1853.)

If the discovery be an improvement only, it must be an improvement on the principle of the machine, art, or manufacture, before known or in use. If only in the form or proportion, it has not the merit of discovery, which can entitle the party to a patent. (*Evans* v. *Eaton*, *Pet. C. C.*, 342.)

If a machine substantially existed before, and a person has made an improvement only thereon, he is entitled to a patent for such improvement only, and not for the whole machine. (*Woodcock* v. *Parker*, 1 *Gall.*, 439.)

Where a specific machine already exists, producing certain effects, if a mere addition is made to such machine, *to produce the same effects* in a better manner, a patent cannot be taken for the whole machine, but for the improvement only. The case of the watch is a familiar instance. The inventor of the patent lever, without doubt, added a very useful improvement to it, but his right to a patent could not be more extensive than his

invention. The patent could not cover the whole machine, but barely the actual improvement. The same illustration might be drawn from the steam engine, so much improved by Messrs. Watt and Boulton. In like manner, if to an old machine some new combinations are added to produce new effects, the right to a patent is limited to the new combination. (*Whittemore* v. *Cutter*, 1 *Gall.*, 480.)

On the other hand, if well-known effects are produced by machinery, in all its combinations *entirely new*, a patent may be claimed for the whole machine. (*Ib.*, 480.)

A slight alteration in the structure of a machine, or in the improvement of it, will not entitle an individual to a patent. There must be a substantial difference in the principle and the application of it to constitute such an improvement as the law will protect. (*Smith* v. *Pearce*, 2 *McLean*, 178.)

An improvement on a combination is the subject of a patent, but at the same time the improvement cannot be used without the consent of the original patentee. (*Foster* v. *Moore*, 1 *Curtis*, 293.)

An improvement in a process may be discovered irrespective of any particular form of machinery. (*Corning* v. *Burden*, 15 *How.*, 267.)

A man may improve a patented machine so as to entitle him to a patent for his improvement; but that will not give him the right to use the invention of the first patentee without his license. (*Foss* v. *Herbert*, 2 *Fish.*, 31.)

Because a substance may be an improvement upon a product previously patented, and may be patentable as an improvement, it does not follow that it can be made

and used without the permission of the owner of the prior patent. (*Goodyear Dental Vulcanite Company* v. *Evans*, 3 *Fish.*, 390.)

An improvement on a patented invention may entitle the party making it to a patent, but he cannot pirate the original invention. (*Goodyear* v. *Mullee*, 3 *Fish.*, 420.)

When the improvements claimed are only improvements upon a well-known machine, the patentee cannot treat as infringers others who have improved the previously existing organization by the use of a different arrangement or combination, which, though performing the same functions, does it in a different, simpler, or better manner. (*Seymour* v. *Osborne*, 3 *Fish.*, 555.)

When a man conceives a machine, no one knows except himself; when he describes it, no one knows except himself and those to whom he describes it. This is, from the nature of the case, the testimony upon which reliance must be placed. (*Sayles* v. *Hapgood*, 3 *Fish.*, 632.)

A patentee is not bound in a new patent to refer to his former one. All that is required is, that he shall not claim what is covered by a former invention. (*O'Reilly* v. *Morse*, 15 *How.*, 122.)

39. PRIORITY OF INVENTION.—If it appears that the plaintiff was not the original inventor, in reference to other parts of the world as well as America, he is not entitled to a patent. This point has been decided otherwise in England, in consequence of the expression in the statute of James I, which speaks of new manufactures within the realm. (*Reutgen* v. *Kanowers*, 1 *Wash.*, 170.)

The first inventor who has put the invention into practice, and he only, is entitled to a patent. Every sub-

sequent patentee, although an origiual inventor, may be defeated of his patent right upon proof of such prior invention put into actual use. The law in such case adopts the rule, *qui prior est in tempore, potior est in jure.* In order to defeat a subsequent patent, it is not necessary to prove that the invention has been previously in general use and generally known. It is sufficient if the same invention has been previously known and put in actual use, however limited the use or the knowledge of the invention might have been. (*Bedford* v. *Hunt*, 1 *Mason*, 302; *Whitely* v. *Swayne*, 1 *Wall.*, 685.)

The intent of the statute was to guard against defeating patents by setting up a prior invention which has never been reduced to practice. If it were the mere speculation of a philosopher or a mechanician, which had never been tried by the test of experience, and never put into actual operation by him, the law would not deprive a subsequent inventor, who had employed his labor and his talents in putting it into practice, of the reward due to his ingenuity and enterprise. But if the first inventor reduced his theory to practice, and put his machine or other invention in use, the law never could intend that the greater or less use in which it might be, or the more or less widely the knowledge or existence might circulate, should constitute the criterion by which to decide upon the validity of any subsequent patent for the same invention. (*Ib.*, 305.)

And though the patentee had no knowledge of the previous use or previous description, still his patent is void: the law supposes he may have known it. (*Evans* v. *Eaton*, 3 *Wheat.*, 514.)

By knowledge and use, referred to in the act, is meant

knowledge and use existing in a manner accessible to the public. (*Gayler* v. *Wilder*, 10 *How.*, 497.)

Prior machines relied upon to defeat a subsequent patent must have been working machines, which have either done work or been capable of doing it. (*Woodman* v. *Stimson*, 3 *Fish.*, 98.)

And if a prior machine were merely got up for the purpose of experiment, and was not practically tested, it would not constitute a practical invention. (*Swift* v. *Whisen*, 3 *Fish.*, 343.)

If a previous patent so far describes a machine covered by a subsequent patent that any mechanic of ordinary skill could, from the description in the first patent, construct or supply all essential parts of the mechanism described in the second patent, the latter is void. (*Woodman* v. *Stimson*, 3 *Fish.*, 98.

Clifford, J., in delivering the opinion of the court in the case of *White* v. *Allen*, (2 *Fish.*, 444,) said: "Original and first inventors are entitled to the benefits of their inventions, if they reduce them to practice and seasonably comply with the requirements of the patent law in procuring letters patent for the protection of their exclusive rights. While the suggested improvement, however, rests 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." (*Gayler* v. *Wilder et al.*, 10 *How.*,

498; *Parkhurst* v. *Kinsman*, 1 *Blatchf.*, 494; *Curtis on Patents.*, § 43.)

"Mere discovery of an improvement does not constitute it the subject-matter of a patent, although the ideas which it involves may be new; but the new set of ideas, in order to become patentable, must be embodied into working machinery and adapted to practical use." (*Sickles* v. *Borden*, 3 *Blatchf.*, 535.)

"'Whoever first perfects a machine and makes it capable of useful operation,' says Judge Story, 'is entitled to a patent,' and he accordingly held, in *Reed* v. *Cutter*, (1 *Story C. C.*, 599,) 'that an imperfect and incomplete invention, resting in mere theory, or in intellectual notion, or in uncertain experiments, and not actually reduced to practice and embodied in some distinct machinery, apparatus, manufacture, or composition of matter, was not patentable under the patent laws of the United States.' Pursuant to that rule, the same learned judge also held, 'that he is the first inventor, in the sense of the patent act, and entitled to a patent for his invention, who has first perfected and adapted the same to use, and that, until the invention is so perfected and adapted to use, it is not patentable under the patent laws.'" (*Washburn* v. *Gould*, 3 *Story C. C.*, 33; *Woodcock* v. *Parker et al.*, 1 *Gall. C. C.*, 121.)

Mr. Justice Nelson says, in *Winans* v. *New York and Harlem Railroad Company*, (*Franklin Journal*, 3 series, vol. 61, p. 322:) "The circumstance that a person has had an idea of an improvement in his head, or has sketched it upon paper, has drawn it, and then gives it up, neglects it, does not in judgment of law constitute, or have the effect to constitute, him a first and original inventor.

It is not the person who has only produced the idea that is entitled to protection as an inventor, but the person who has embodied the idea into a practical machine and reduced it to practical use. He who has first done that, is the inventor who is entitled to protection."

In *Ducheman* v. *Richardson*, (*Decisions*, *April* 7, 1870,) referring to the doctrine stated by Justice Clifford in *White* v. *Allen*, the Commissioner says: "On the other hand, there can be no doubt that the Patent Office has, in the main, accepted a lower standard of invention. Sketches, drawings, models, or machines of the crudest description, and mere conversations, have in some cases been held sufficient to constitute invention.

"The practice in the Patent Office has grown up from the perversion of a principle, which is referred to by Mr. Justice Clifford, in *White* v. *Allen*, as a limitation of the doctrine cited. He says: 'Taken as a general rule, no doubt is entertained of the correctness of the proposition as stated; but it must be regarded as subject to the qualification that he who invents first shall have the prior right, if, as is prescribed in § 15 of the patent act, he is using reasonable diligence in adapting and perfecting the same within the meaning of that provision.'" (*Reed* v. *Cutter*, 1 *Story*, 600; *Marshall* v. *Mee*, *Law's Dig.*, 426; *Bartholomew* v. *Sawyer*, 1 *Fish.*, 516.)

"Undoubtedly, where two men have hit upon the same idea, and are both diligently engaged in experimenting or in perfecting their inventions, it is proper to go back to the very beginning of the invention, to its first embodiment in any form, to determine which of them is prior in point of time. But where one of the parties has been negligent, or has not perfected the invention at

all, or the other party has not only perfected but has patented his device, then the rule as administered in the courts should prevail, and no evidence of priority should be received that falls short of a reduction to practice in working mechanism." (*Cahoon* v. *Ring*, 1 *Fish.*, 397; 1 *Clifford*, 592.)

40. LOST ART.—If any one should discover a lost art, and it was a useful improvement, he would be entitled to a patent; for, although not literally the original and first inventor, he would be the first to confer on the public the benefit of the invention. (*Gayler* v. *Wilder*, 10 *How.*, 497.)

41. INVENTOR MAY AVAIL HIMSELF OF PRIOR EXPERIMENTS.—If a prior inventor fall short of making a complete machine, practically useful, those who come after him may secure to themselves the advantages of his invention. To constitute prior invention, the inventor must have proceeded so far as to entitle himself to a patent. (*Howe* v. *Underwood*, 1 *Fish.*, 160.)

Thus, where a patent has been granted for improvements which, after a full and fair trial, resulted in unsuccessful experiments, and have been finally abandoned, if another person takes up the subject of the improvements and is successful, he is entitled to the merit of them as an original inventor. (*Whitely* v. *Swayne*, 7 *Wallace*, 685.)

42. PRIOR PUBLICATION.—A *bona fide* inventor in this country, and who believed himself to be the original and first inventor at the time of his application, is entitled to a patent for his invention, though the same invention may have been known or used in a foreign country, provided it had not been patented or described in any printed

publication. (*Parker* v. *Stiles*, 5 *McLean*, 61; *Swift* v. *Whisen*, 3 *Fish.*, 343.)

But it will be fatal to the right of the patentee if the thing invented or discovered has been described in any foreign publication. This goes upon the presumption, if such foreign publication has been made, the patentee may have acquired a knowledge of it. (*Allen* v. *Hunter*, 6 *McLean*, 313.)

Unless such publication was prior in point of time to the *invention* of the patentee it will not avoid the patent. It is not sufficient that such publication was prior to the *application* of the patentee for his patent. (*Bartholomew* v. *Sawyer*, 1 *Fish.*, 516.)

It must appear that the improvement which has been known in a foreign country has been so clearly described that the invention could be constructed by a competent mechanic. (*Judson* v. *Cope*, 1 *Fish.*, 615.)

An imperfect description would not be sufficient to defeat the American patent; and, in order to find a patented invention anticipated in a prior printed publication, the jury must find from the evidence that the description embodies substantially the same *organized mechanism*, operating substantially in the same manner as that described in the patent. (*Clark Patent Steam and Fire-Regulator Company* v. *Copeland*, 1862, 2 *Fish.*, 221.)

And the defendant in a patent cause may show that the thing patented, or some substantial part thereof, existed in a foreign country, and was known to the patentee before his application for a patent, and may have put to the jury the question, whether the patentee believed himself to be the original inventor, though such foreign invention had not previously been patented or

described in any printed publication. (*Forbush* v. *Cook*, 2 *Fish.*, 668.)

43. PRIOR FOREIGN PATENT.—A foreign patent, to destroy a patent granted in this country, must have been granted before the invention here, not merely before the application for letters patent. (*Howe* v. *Morton*, 1 *Fish.*, 586.)

An invention is not "patented" in England, within the meaning of the acts of Congress, until the specification is enrolled. The enrolled specification takes effect only from the date of its enrollment, and not from the date of the provisional specification. (*Ib.*)

In determining the proper reading of a disputed translation of a foreign patent, the following considerations are applicable: 1. Which translation is most literal; 2. The question should be examined in view of the other parts of the instrument not involved in any doubt; 3. Recurrence should be made to the nature of the invention, to see if it is consistent with either or both readings; and, 4. If it be found that one of the translations is repugnant to other parts of the instrument, and the other is consistent with the other parts, it will be safe to adopt the latter. (*White* v. *Allen*, 2 *Fish.*, 440.)

44. UNITY OR DIVERSITY OF INVENTION.—A single patent cannot embrace two machines, which are wholly independent of each other and distinct inventions for unconnected objects, nor for several distinct improvements upon different machines having no common connection or common purpose; but a single patent may be taken out for several inventions or improvements, if they conduce to the accomplishment of one and the same general end. (*Wythe* v. *Stone*, 1 *Story*, 288, *et seq.*)

In the case of *Atwood ex parte*, the Commissioner says:

"There would seem to be an obvious impropriety in allowing an inventor to make application and obtain a patent for some trifling improvement, and then come in at any time within two years, as suggested by counsel, and claim another patent covering broadly the machine improved and already described in the first patent, so that the first patent would become tributary to the second, and the unlucky purchaser of the first would become an infringer of the second in the hands of his grantor.

"The law gives ample facilities for patenting every improvement shown in an application. It provides a system of re-examinations and appeals before the patent goes out; and, even after the issue of a patent, it permits the owner to reissue it and to subdivide it, until nothing is left upon which to found a claim. All claims granted upon the thing described have a common origin—the original application. The monopoly founded upon them has a common duration—the lifetime of the original patent. This is just to the inventor, and it is just to the public. It is a sound practice, and the only safe one.

"I answer the questions of the examiner as follows: 1. The case of *Suffolk Company* v. *Hayden* in no way controls the practice in the Patent Office. 2. When an application is filed, every invention contained in that application must be patented under it, or under such divisions of it as the wishes of the applicant and the rules of the office may permit." (*Commissioner's Decisions*, 1869, p. 98.)

45. THE QUESTION OF THE DIVISION OF AN INVENTION INTO SEPARATE PATENTS IS WITHIN THE DISCRETION OF THE COMMISSIONER.—It is difficult, perhaps impossible, to lay down any general rule by which to determine when a

given invention or improvement should be embodied in one, two, or more patents; some discretion must necessarily be left on this subject to the head of the Patent Office. It is often a nice and perplexing question. (*Bennett* v. *Fowler*, 8 *Wall.*, 445.)

The case of *Hogg* v. *Emerson* (6 *How.*, 483) has usually been relied upon as authorizing the union of several devices, machines, or improvements, under a single patent. In that case letters patent had been granted covering an improvement in a spiral propelling wheel and in a capstan. This was an extreme case, and the defendant contended that the patent was void. The court say: "The next objection is, that this description in the letters thus considered covers more than one patent, and is therefore void.

"There seems to have been no good reason at first, unless it be a fiscal one on the part of the Government when issuing patents, why more than one, in favor of the same inventor, should not be embraced in one instrument, like more than one tract of land in one deed or patent of land." (*Phillips on Pat.*, 217.)

"Each could be set out in separate articles or paragraphs, as different counts for different matters in libels in admiralty or declarations at common law, and the specifications could be made distinct for each, and equally clear.

"But, to obtain more revenue, the public officers have generally declined to issue letters for more than one patent described in them." (*Renouard*, 293; *Phillips on Pat.*, 218.) "The courts have been disposed to acquiesce in the practice, as conducive to clearness and certainty; and if letters issue otherwise, inadvertently, to hold them, as

a general rule, null. But it is a well-established exception, that patents may be united if two or more, included in one set of letters, relate to a like subject, or are in their nature or operation connected together." (*Phillips on Pat.*, 218, 219; *Barrett* v. *Hall*, 1 *Mason C. C.*, 447; *Moody* v. *Fiske*, 2 *Mason C. C.*, 112; *Wythe et al.* v. *Stone et al.*, 1 *Story*, 273.)

"Those here of that character, being all connected with the use of the improvements in the steam-engine as applied to propel carriages or vessels, and may therefore be united in one instrument."

In *Root* v. *Ball & Davis* (4 *McLean*, 179) the court say:

"It is objected to the plaintiff's patent that two distinct things cannot be united in the same patent. This is true when the inventions relate to two distinct machines; and the reason assigned is, that it would deprive the officers of the Government of their fees, and in other respects would be inconvenient. But the same patent may include a patent for a combination and an invention of some of the parts of which the combination consists."

The doctrine of both of these cases seems to be, that while the rule which assigns distinct inventions to distinct patents is a proper one, and one which the Commissioner may properly enforce, yet, if the patent actually issue, the courts will sustain it. It is certainly nowhere asserted that it is the duty of the Commissioner to include two or more inventions in one patent, but it is evidently referred to his discretion. There are numerous cases in which it has been held, that a patent once granted is to be liberally construed; that it is to be presumed that public officers do their duty; that the court will not inquire into slight defects or mere informalities

in the grant of letters patent, where there is a meritorious invention. Yet it would be a grave error to found upon such decisions a rule of action for the Commissioner; for it by no means follows, because a patent has been sustained, notwithstanding certain informalities in the issue, that every succeeding patent is to exhibit the same informalities. In *Tompkins* v. *Gage* (2 *Fish.*, 580) it was held, that the second claim of the patent under consideration was but a repetition of the first; but that "duplicity of claim" did not affect the validity of the patent. It could hardly be gravely contended, however, that upon the authority of this decision the Commissioner should encourage or permit the granting of duplicate claims.

The whole question is one of discretion in the Commissioner.

It may be conceded that it is difficult to establish any general rule for the division of inventions into separate patents, which shall apply to all cases, or which shall not be subject to many exceptions. In both of the cases quoted, it is suggested that the union of many inventions in one patent would deprive the Government of its proper fees: This is a legitimate consideration. A fee of $15 is now charged for examination into the novelty, utility, and patentability of an invention. This is a very reasonable charge, and is much less than it would cost to make the examination in any other way. Indeed, the fees for all services in the Patent Office are less than are charged in any other country, while the service performed for the applicant by the office is much greater.

It would be unjust to the Government, to the public at large, and to other inventors, to permit one of their number to present a batch of inventions for examination

under a single fee, for he would receive more of the time of the examiner than he had paid for. Another consideration, which is not less important, is found in the classification of the various subjects of invention, and the assignment of the different classes to different examiners. This division of labor is absolutely essential to the prompt and thorough examination of applications. It is adopted to facilitate the transaction of the public business, and the inventor himself is directly and immediately benefitted by a strict adherence to it. Any union of inventions in one patent, that would seriously impair this classification, ought not to be permitted. Besides the delay and increased difficulty in making the examination, if the patent covers devices which enter into two classes, the drawing, which is single, must be deposited in the portfolio of the one class, and be wanting in the portfolio of the other. It may thus be overlooked in the examination of the next case.

It may therefore be said in general, that when two or more distinct inventions are united in one application that are capable of division, and which belong to different classes, or involve a double labor of examination, or have no community of operation, it is not only the right, but it becomes the duty of the Commissioner to require the application to be divided. (*Linus Yale, jr., ex parte, Commissioner's Decisions*, 1869, p. 110.)

III. Requisites of the Application.

SEC.	SEC.
46. Application made to Commissioner.	48. Clerical requirements.
47. Time to complete application.	49. Completion of the application.
	50. Rules of correspondence.

SEC.
51. Pending applications preserved in secrecy.
52. Information furnished after a patent has been issued or the application abandoned.
53. Inquiries not answered.
54. Two years' use allowed.
55. Public use, common use.
SEC.
56. Delays at the Patent Office.
57. Abandonment within two years.
58. Delay unimportant, unless evidence of abandonment.
59. Continuing application.
60. Commissioner may refuse a patent which would be sustained by the courts.

46. APPLICATION TO BE MADE TO THE COMMISSIONER OF PATENTS.—Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner, &c. (*Act of July* 8, 1870, § 26.)

47. TIME TO COMPLETE AND PROSECUTE APPLICATIONS.—All applications for patents shall be completed and prepared for examination within two years after the filing of the petition, 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, ey shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable. (*Act of July* 8, 1870, § 32.)

48. CLERICAL REQUIREMENTS.—The application must be in writing, in the English language, and addressed to the Commissioner of Patents. The petition and specification must be separately signed by the inventor. All claims and specifications filed in this office (including amendments) must be written in a fair, legible hand, without interlineations or erasures, except such as are clearly stated in a marginal or foot note, written on the same sheet of paper; otherwise the office may require

them to be printed. All the papers constituting the application must be attached together. (*Patent Office Rules, July*, 1870.)

49. APPLICATION SHOULD BE COMPLETE WHEN FILED.—No application can be examined, nor can the case be placed upon the files for examination, until the fee is paid, the specification, with the petition and oath, filed, and the drawings and model or specimen (when required) filed or deposited. It is desirable that everything necessary to make the application complete should be deposited in the office at the same time. If otherwise, a letter should accompany each part stating to what application it belongs. (*Ib.*)

50. RULES OF CORRESPONDENCE.—All correspondence must be in the name of the "Commissioner of Patents," and all letters and other communications intended for the office must be addressed to him. If addressed to the Acting or Assistant Commissioner, chief clerk, examiners, or any of the other officers, they will not be noticed, unless it should be seen that the mistake was owing to inadvertence. A separate letter should in every case be written in relation to each distinct subject of inquiry or application, the subject of the invention and the date of filing being always carefully noted. (*Ib.*)

When an agent has filed his power of attorney, duly executed, the correspondence will, in ordinary cases, be held with him only. A double correspondence with him and his principal, if generally allowed, would largely increase the labor of the office. For the same reason the assignee of an entire interest in an invention is entitled to hold correspondence with the office to the exclusion of the inventor. If the principal becomes dissat-

isfied, he must revoke his power of attorney and notify the office, which will then communicate with him. (*Ib.*)

Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney, the examiner in charge will notify each of said principal parties of this fact, and also the attorney. (*Ib.*)

All communications to and from the Commissioner upon official business are carried in the mail free of postage. (*Ib.*)

All business with the office should be transacted in writing. Unless by the consent of all parties, the action of the office will be predicated exclusively on the written record. No attention will be paid to any alleged verbal promise or understanding in relation to which there is any disagreement or doubt. (*Ib.*)

51. PENDING APPLICATIONS PRESERVED IN SECRECY.—After a second rejection, none of the papers can be inspected, save in the presence of a sworn officer, nor will any of the papers be returned to the applicant or agent. (*Ib.*)

Aside from the caveats which are required by law to be kept secret, all pending applications are, as far as practicable, preserved in like secrecy. No information will therefore be given those inquiring whether any particular case is before the office, or whether any particular person has applied for a patent. (*Ib.*)

Information in relation to pending cases is given so far as it becomes necessary in conducting the business of the office, but no further. Thus, when an interference is declared between two pending applications, each of the contestants is entitled to a knowledge of so much of his

antagonist's case as to enable him to conduct his own understandingly. (*Ib.*)

52. INFORMATION FURNISHED AFTER A PATENT HAS BEEN ISSUED OR THE APPLICATION ABANDONED.—Information is given in relation to any case after a patent has issued, or after a patent has been refused and the further prosecution of the application is abandoned or barred by lapse of time. (*Ib.*)

The models, in such cases, are so placed as to be subject to general inspection. The specifications and drawings in any particular case can be seen by any one having particular occasion to examine them, and copies thereof, as well as of patents granted, will be furnished at the cost of making them. Copies will be made on parchment, at the request of the applicant, on his paying the additional cost. (*Ib.*)

Even after a case is rejected, the application is regarded as pending, unless the applicant allows the matter to rest for two years without taking any further steps therein, in which case it will be regarded as abandoned, and will no longer be protected by any rule of secrecy. The specification, drawings, and model will then be subject to inspection in the same manner as those of patented or withdrawn applications. (*Ib.*)

53. INQUIRIES WHICH WILL NOT BE RESPONDED TO.—The office cannot respond to inquiries as to the novelty of an alleged invention in advance of an application for a patent, nor upon inquiries founded upon brief and imperfect descriptions, propounded with a view of ascertaining whether such alleged improvements have been patented, and, if so, to whom; nor can it act as an expounder of the patent law, nor as counsellor for individuals, except

as to questions arising within the office. A copy of the rules, with this section marked, sent to the individual making an inquiry of the character referred to, is intended as a respectful answer by the office. (*Ib.*)

54. TWO YEARS' USE PRIOR TO APPLICATION ALLOWED.—Inventors may permit the use of their inventions, by individuals, for a period of two years prior to the application for a patent, and still obtain a valid patent, notwithstanding such use. But if the use thus allowed extends over a period of more than two years prior to the application, or if it amounts to an abandonment of the invention to the public, whether for a longer or shorter period, the patent will be invalid. (*Curtis on Patents*, § 103.)

The statute (*ut supra*, p. 9, § 24,) is inflexible, as to the time when the patent is to be applied for, with reference to the prior use and sale of the invention. The neglect to apply within two years after such sale or use is invariably fatal. Whenever this fact appears, the patent falls. But beyond this the provisions of the statute are silent. (*Blandy* v. *Griffith*, 3 *Fish.*, 617.)

55. PUBLIC USE, COMMON USE.—A "public" use has been defined to be a use in public; and a single well-authenticated instance of a use in public by the inventor, or any one else, constitutes a legal public use.

A "common" use is a use by the public; and has been defined to refer to cases where the invention has become the subject of sale, known to the trade, or so situated that the public, or any portion thereof, can and does avail itself of the improvement at pleasure. (*Hormant* v. *Gilmore, Commissioner's Decisions*, 1870.)

It is not necessary that the use should have been a continuing use, extending over a longer period than two years

prior to the application, in order to render the patent void. It is sufficient if it be a public use or sale at any time, or for any length of time, occurring more than two years before the filing of the application. (*Sanders* v. *Logan*, 2 *Fish.*, 167.)

A fortiori if an inventor suffers his invention to get into general use it will have been in public use. But where the patentee alone makes the thing for the purpose of experiment and completion, without selling it to be used by others, the term public use is not applicable. (*Shaw* v. *Cooper*, 7 *Pet.*, 292.)

56. DELAYS AT THE PATENT OFFICE.—By application filed in the Patent Office the inventor makes a full disclosure of his invention, and gives public notice of his claim for a patent. It is conclusive evidence that the inventor does not intend to abandon it to the public. The delay afterwards interposed, either by the mistakes of public officers, or the delays of courts, where gross laches cannot be imputed to the applicant, cannot affect his right. (*Adams* v. *Jones*, 1 *Fish.*, 527.)

Such delays are sufficiently onerous to a meritorious inventor, if his patent is allowed to have full operation after it is granted. But it would be very great injustice to hold, that any delay which the inventor could not prevent should, under any circumstances, affect the validity of his patent. (*Dental Vulcanite Company* v. *Wetherbee*, 3 *Fish.*, 87.)

And if an earlier application by the inventor is for the same subject-matter as he afterwards patents, and if such application was not withdrawn by him, but the delay was caused by the conduct of the Commissioner of Patents in refusing to grant a patent, then the inventor should

not be considered to have abandoned his invention to the public, unless he abandoned it before the first application. (*Rich* v. *Lippincott*, 2 *Fish.*, 1.)

57. ABANDONMENT WITHIN TWO YEARS.—The mere use or sale of invention within two years will not alone or of itself work an abandonment. The use or sale must be accompanied by some declarations or acts, going to establish an intention on the part of the inventor to give to the public the benefit of the improvement. But the mere expression of an intention not to take out a patent, or the mere declaration of intention to dedicate an invention to the public, cannot be regarded as an actual dedication. Abandonment or dedication is in the nature of a forfeiture of a right, which the law does not favor, and it should be made out beyond all reasonable doubt. (*Pitts* v. *Hall*, 2 *Blatchf.*, 237.)

In the case of *Ransom* v. *The Mayor of New York*, Hall, J., charged the jury as follows:

"If the plaintiffs did not use reasonable diligence to perfect the invention patented after the idea of it was first conceived, and in the meantime other persons not only conceived the idea, but perfected the invention and practically applied it to public use before the invention of the plaintiffs had been so far perfected that it could be applied to practical use, the plaintiffs' patent is void, because they were not the original and first inventors of the thing patented. And if the plaintiffs, after they had perfected their invention, unreasonably delayed their application for a patent, and other persons, before such application was made, actually perfected and applied the same invention to practical use and gave the knowledge thereof to the public, and the plaintiffs, after the knowledge

of such subsequent invention or discovery and its public use, failed to make objection and to apply without unreasonable delay for a patent for their invention, they cannot sustain their patent, because they failed to give the public the consideration for the grant of exclusive privileges, upon which all valid patents must be based; and if the plaintiffs, after their invention was perfected, knowingly allowed it to be used in public for more than two years before they applied for letters patent, it is conclusive of a dedication of such invention to the public, and their patent is void. And so also, if the plaintiffs, after their invention was perfected, acquiesced in its use in public for a less term than two years without applying for a patent, and the jury shall be satisfied, from such acquiescence and other facts of the case, that the plaintiffs in fact abandoned their invention, concluding not to patent, but to dedicate it to the public use, they could not recall such dedication or defeat such abandonment by a subsequent application for a patent, and their patent is therefore void." (1 *Fish.*, 273.)

58. DELAY UNIMPORTANT, UNLESS IT AMOUNTS TO EVIDENCE OF ABANDONMENT.—The statute does not limit any time in which the inventor must apply for a patent, nor does it declare a forfeiture by reason of any delay. Delay, therefore, is unimportant, unless it amounts to evidence of the abandonment of the claim. (*Hildreth* v. *Heath, Appeal Cases, D. C.*, 1841.)

But, although merely withholding an invention from the public does not amount to abandonment, it may, in connection with other circumstances, pile up difficulties, if too long continued, in the way of asserting and proving priority over another inventor who applies for a

patent. (*Babcock* v. *Degener*, *MS. Appeal Cases*, *D. C.*, 1859.)

59. CONTINUING APPLICATION.—If a party chooses to withdraw his application for a patent and pay the forfeit, intending at the time of such withdrawal to file a new petition, and accordingly does so, the two petitions are to be considered as parts of the same invention and as constituting a continuous application within the meaning of the laws. (*Godfrey* v. *Evans*, 1 *Wall.*, 317.)

And where the patentee made public use and sale of his invention for less than two years before his original application for a patent, but subsequently, and more than two years after such public use and sale, withdrew such application and filed a second one, upon which a patent was granted, it was *held*, that the continuity of the application was not necessarily destroyed, and, in the absence of proof of abandonment or dedication, the patent was not avoided by reason of the public use and sale for more than two years before the final application. (*Howe* v. *Newton*, 2 *Fish.*, 531.)

Where a patent was applied for May 3, 1856, and rejected August 30, 1856, amended specification filed September 22, 1856, and finally rejected, upon appeal to the Commissioner, June 15, 1857, but not withdrawn, a new application made May 26, 1858, and a patent granted August 3, 1858: *held*, that the last application was in the nature of a petition for review of the previous rulings and related back to the prior application; and that the action of the Commissioner was not original and independent, but a renewal and elongation of the former proceedings and a reversal of the former rejections. To an action of this revisory character the statute imposes no

limitation, and, under such circumstances, the public use to avoid the patent must be for two years before the first application. (*Blandy* v. *Griffith*, 3 *Fish.*, 609.)

Where an application was withdrawn and the withdrawal fee received back, and no further steps were taken for eight years, when a new application was filed, and in the meantime several patents had been granted in which the invention was incorporated, the latter application was *held* not to be a continuation of the former, and was rejected. (*J. W. Cochran ex parte*, *Commissioners' Decisions*, 1859, p. 30.)

After the withdrawal of an application, it is for the Commissioner to determine whether a second one is filed within a reasonable time, so as to constitute a continuance of the first. (*Ib.*)

And if, after an application is withdrawn, another is not filed in two years, it may reasonably be presumed that the applicant has no intention of renewing it. (*Ib.*)

60. THE COMMISSIONER MAY REFUSE A PATENT WHICH WOULD BE SUSTAINED BY THE COURT IF ISSUED.—When the patent has been granted, and its validity is called in question, a court may so far respect the action of the Commissioner and the grant of the Government as to adopt a rule to save and sustain the patent, which it would be very unwise and unsafe to adopt as the uniform practice in granting patents. The courts have held that the omission of the oath is not fatal. (*Crompton* v. *Belknap Mills*, 3 *Fish.*, 536.) And, doubtless, if the patent were actually issued, with but a single witness to the specification, or without a petition or the payment of a fee, these informalities would not avoid the patent; and yet he would be a bold Commissioner who should knowingly proceed

to issue patents without petition, witnesses, oath, or fees. In *Hogg* v. *Emerson* (6 *How.*, 437) it was held, that inventions very dissimilar might be united in the same patent; and in *Goodyear* v. *Wait* (3 *Fish.*, 242) it was held, that the process and the product might be separated, and claimed in two reissues, the court remarking that this was within the discretion of the Commissioner. So in the case of *Suffolk Company* v. *Hayden*, it was held, that an invention might be included in a subsequent patent which was described in a preceding one.

Yet in all these cases there can be no doubt that it is within the discretion of the Commissioner to say that each patent shall cover but one invention, or that the subject-matter of a reissue is incapable of division, or that all the inventions, or parts of an invention, described in an application, shall be included in one patent, or in divisions founded upon that application. (*L. J. Atwood ex parte, Commissioners' Decisions*, 1869, p. 100.)

IV. The Applicant and Petition.

SEC.

61. Application to be by way of petition.
62. Application by actual inventor.
63. Form of petition by a sole inventor.
64. Joint inventors.
65. Relations subsisting between joint inventors.
66. Form of petition by joint inventors.
67. Assignment before patent.
68. Assignment after rejection of application valid.

SEC.

69. Assignment of incomplete invention.
70. Partial assignment.
71. Office to be requested to issue patent to assignee.
72. No appeal in case of refusal.
73. Correspondence in the name of assignee.
74. Recording assignment.
75. Stamp required.
76. Legal formalities.
77. Definition of the terms assignee, grantee, and licensee.

SEC.
78. Form of petition for assignee.
79. Legal representatives.
80. Form of petition by administrator.
81. Form of petition by executor.
82. Attorneys.
83. Commissioner may refuse to recognize an attorney.
84. Correspondence held with attorney only.
SEC.
85. Clause of substitution.
86. Associate attorney.
87. Revocation.
88. Stamp required.
89. Form of petition, with power of attorney.
90. Form of power of attorney.
91. Form of associate power.
92. Form of revocation of power of attorney.

61. APPLICATION IS BY WAY OF PETITION.—The law (*ut infra*, p. 10, § 26) requires an inventor who desires to obtain a patent to "*make application in writing* to the Commissioner of Patents," &c. This application in writing has, from the origin of the Government, been by way of petition, generally with the specification annexed and referred to, or accompanied by the specification, filed at the same time. The form of the petition is not material. When filed, it is to be presumed to adopt the specification or schedule filed at the same time, and to ask for a patent for the invention therein described. (*Curtis on Patents*, § 271; *Hogg* v. *Emerson*, 6 *How.*, 437, 480.)

62. THE APPLICATION MUST BE MADE BY THE ACTUAL INVENTOR, IF ALIVE, even if the patent is to issue or reissue to an assignee; but, where the inventor is dead, the application and oath may be made by the executor or administrator. (*Patent Office Rules, July*, 1870.)

63. FORM OF PETITION BY A SOLE INVENTOR.—

To the Commissioner of Patents:

Your petitioner prays that letters patent may be granted to him for the invention set forth in the annexed specification. JOHN SMITH.

64. JOINT INVENTORS.—Joint inventors are entitled to a joint patent; neither can claim one separately; but

independent inventors of separate improvements in the same machine cannot obtain a joint patent for their separate inventions, nor does the fact that one man furnishes the capital and the other makes the invention entitle them to take out a joint patent. (*Patent Office Rules, July*, 1870.)

A joint patent may well be granted upon a joint invention. There is no difficulty in supposing, in point of fact, that a complicated invention may be the gradual result of the combined mental operations of two persons acting together, *pari passu*, in the invention; and if this be true, then, as neither of them could justly claim to be the sole inventor in such case, it must follow that the invention is joint, and that they are jointly entitled to a patent; but a joint patent cannot be sustained upon a sole invention. (*Barrett* v. *Hall*, 1 *Mason*, 472.)

And if the circumstances are such as to show that two parties contributed to an invention, so as to make them joint inventors, a joint patent should be taken out. (*Thomas* v. *Weeks*, 2 *Paine*, 103.)

For if the invention patented, as in a joint patent, is the sole invention of one of the patentees, and not the joint invention of both, the patent is void. (*Ransom* v. *Mayor, &c., of New York*, 1 *Fish.*, 252.)

One of two or more joint inventors is not *the* inventor, within the meaning of the act; and if he applies for a patent the Commissioner is bound to refuse it. (*Arnold* v. *Bishop*, *MS. Appeal Cases*, *D. C.*, 1841.)

The man who reduces to practice the theory of another, who assists in the reduction of it to practice, cannot be considered as the sole inventor of the machine; and if one suggest the mode of operation or the principle of a machine, and the other reduce it to practice, neither can

be considered as the sole inventor, but the invention is joint. (*Ib.*)

If one of two joint inventors, without the other relinquishing his claim to a joint interest in the patent right, obtains a patent in his own name, he will be deemed guilty of a fraud, and will, in equity, be considered as the trustee of the other. (*Reutgen* v. *Kanowers*, 1 *Wash.*, 171.)

65. RELATIONS SUBSISTING BETWEEN JOINT INVENTORS. In the case of joint patentees, where no agreement or copartnership exists, the relation of copartners does not result from their connection as joint patentees; and when one joint owner of a patent transfers his undivided interest to a stranger, the assignee does not become the partner of his co-proprietor. In both cases the parties interested in the patent are simply joint owners, or tenants in common, of the rights and property secured by the patent, and their rights, powers, and duties, as respects each other, must be substantially those of the joint owners of a chattel. Part owners of goods and chattels are either joint owners or tenants in common, each having a distinct, or at least an independent, although an undivided, interest in the property. Neither can transfer or dispose of the whole property; nor can one act for the other in relation thereto, but merely for his own share, and to the extent of his own several rights and interest; and at common law the one had no action of account against the other, from his share of the profits derived from the common property. (*Pitts* v. *Hall*, 3 *Blatchf.*, 201 206; *Story on Partnership*, § 89.)

One tenant in common has as good a right to use and to license third persons to use the thing patented as the

other tenant has. Neither can come into a court of equity and assert a superior equity, unless it has been created by some contract underlying the rights which belong to them as tenants in common; and, no such contract existing, one tenant in common cannot enjoin the other from use and sale. (*Clum* v. *Brewer*, 2 *Curtis C. C.*, 506.)

Some agreement becomes necessary to enable them to work the invention at their joint expense and for their joint benefit. (*Parkhurst* v. *Kinsman*, 1 *Blatchf.*, 496.)

If the partial owner is not a wrong-doer in exercising the rights secured by the patent, no property has been appropriated which belongs to the other proprietor of the patent, and the ground of damages fails. That this is the real relation of the parties, would seem to follow from their situation as tenants in common of a right to the exercise of the patent privileges. In respect to the disposal of the title to those privileges, they stand upon the same footing as tenants in common, or joint owners of other chattels, namely, each can dispose of his own share only. (*Curtis on Patents*, § 190.)

66. FORM OF PETITION BY JOINT INVENTORS.—

To the Commissioner of Patents:

Your petitioners pray that letters patent may be granted to them, as joint inventors, for the invention set forth in the annexed specification.

JOHN SMITH,
THOMAS BROWN.

67. ASSIGNMENT BEFORE PATENT.—Patents may be granted and issued or reissued to the assignee of the inventor or discoverer, the assignment thereof being first entered of record in the Patent Office; but in such case the application for the patent shall be made and the specification sworn to by the inventor or discoverer; and

also, if he be living, in case of an application for reissue. (*Act of July* 8, 1870, § 33.)

The patentee is not necessarily the inventor; for, whether an invention is or is not assignable at common law before any patent for it has been obtained, it has been deemed expedient to make it so assignable by statute. Accordingly, provision has been made for the issuing of a patent to an assignee of the inventor, provided the application is made and the specification duly sworn to by the inventor himself, and the assignment is duly recorded. When so granted, the exclusive interest is vested as a legal estate in the assignee, who thus becomes the patentee of the invention, and the inventor himself is divested of the legal title; but the assignee of the inventor, who has become such before the patent has issued, does not become the holder of the legal title to the patent until it has issued, although he becomes the holder of a right to obtain the patent. (*Curtis on Patents*, §§ 168, 169; *Herbert* v. *Adams*, 4 *Mason*, 15.)

68. ASSIGNMENT AFTER REJECTION OF APPLICATION VALID.—An assignment of an invention before patent issued is valid, although it is made after the rejection of the assignor's application by the Commissioner, and after his appeal to the chief justice of the circuit court of the District of Columbia from such decision. (*Gay* v. *Cornell*, 1 *Blatchf.*, 509.)

The thing to be assigned is not the mere parchment, but the monopoly conferred—the right of property which it creates; and when the party has acquired an inchoate right, an assignment of it is legal. (*Gayler* v. *Wilder*, 10 *How.*, 498.)

69. ASSIGNMENT OF AN INCOMPLETE INVENTION ONLY

VALID AS A CONTRACT.—But the statute which authorizes the assignment of an invention before patent embraces only the cases of perfected or completed inventions. There can, properly speaking, be no assignment of an inchoate or incomplete invention, although a contract to convey a future invention may be valid, and may be enforced by a bill for specific performance. The legal title can pass to another only by a conveyance, which operates upon the thing invented after it has become capable of being made the subject of an application for a patent; and a contract to convey a future invention cannot alone authorize a patent to be taken by the party in whose favor such contract was intended to operate. (*Curtis on Patents*, § 170; *Nesmith* v. *Calvert*, 1 *Wood. & Min.*, 34.)

70. PARTIAL ASSIGNMENT.—The assignee has no legal claim to the patent if the assignment be only partial, though the part excepted is small. In such case it must be issued in the name of the inventor, and be held by him in trust for the use of the assignee, to the extent of the equities he has by virtue of his contract. (9 *Opinions of Attorneys General*, 403.)

Nor can patents issue jointly to the inventor as such and to the assignee of a partial interest; but they may issue to the assignee or assignees of the whole interest. (4 *Opinions of Attorneys General*, 401.)

71. PATENT MAY ISSUE TO INVENTOR UNLESS THE OFFICE IS REQUESTED TO ISSUE IT TO ASSIGNEE.—A patent will, *upon request*, issue directly to the assignee or assignees of the entire interest in any invention, or to the inventor and the assignee jointly, when an undivided part only of the entire interest has been conveyed. (*Patent Office Rules, July*, 1870.)

The language of the law (*ut supra*, p. 9, § 33) is "*may* be granted and issued," not "shall be," and it has been the constant practice of the office to issue patents to the inventor, unless otherwise specially requested by him. The mere facts of assignment and record do not impose upon the Commissioner the duty of issuing the letters patent to the assignee without further request, and the omission to do so is not therefore a mistake on his part. The rights of the assignee in the patent are precisely the same, whether the patent be issued to him or to the inventor, and whether it issue to the one or the other is a matter of form rather than of substance. (*Havemeyer ex parte, Commissioners' Decisions, February* 10, 1870.)

72. NO APPEAL LIES FROM THE REFUSAL OF THE COMMISSIONER TO ISSUE A PATENT TO AN ASSIGNEE, and a mandate from the appellate judge requiring it will not be regarded. The jurisdiction of the supreme court of the District of Columbia does not extend to the ministerial acts of the Commissioner. (*Whitely ex parte, Commissioners' Decisions*, 1869, p. 79; but see 6 *Wall.*, 522.)

73. CORRESPONDENCE IN THE NAME OF ASSIGNEE.—The assignee of an entire interest in an invention is entitled to hold correspondence with the office to the exclusion of the inventor, and when the patent is to issue in the name of the assignee, the entire correspondence should be in his name. (*Patent Office Rules, July*, 1870.)

74. ASSIGNMENT MUST BE RECORDED FIVE DAYS BEFORE ISSUE OF THE PATENT.—In every case where a patent issues or reissues to an assignee, the assignment must be recorded in the Patent Office at least five days before the issue of the patent, and the specification must be sworn to by the inventor. (*Ib.*)

The receipt of assignments is not generally acknowledged by the office. They will be recorded in their turn within a few days after their reception, and then transmitted to the persons entitled to them. (*Ib.*)

75. STAMP REQUIRED.—A five-cent revenue stamp is required for each sheet or piece of paper on which an assignment, grant, or license may be written. (*Ib.*)

76. LEGAL FORMALITIES.—No particular form of words is necessary to constitute a valid assigument, nor need the instrument be sealed, witnessed, or acknowledged. (*Ib.*)

The statute prescribes no particular form of instrument. Any instrument in writing which evinces an intention to vest the whole interest in the assignee, and to authorize him to take the patent in his own name, is a sufficient conveyance. (*Curtis on Patents*, § 171.)

An assignee, by an assignment executed before patent issued, has the legal title, even though the patent issued to the inventor. (*Gayler* v. *Wilder*, 10 *How.*, 494.)

77. DEFINITION OF THE TERMS ASSIGNEE, GRANTEE, AND LICENSEE.—An *assignee* is one who has transferred to him, in writing, the whole interest of the patent, or any undivided part of such whole interest, in every portion of the United States.

A *grantee* is one who has transferred to him, in writing, the exclusive right, under the patent, to make and use, and grant to others to make and use, the thing patented, within and throughout some specified portion or part of the United States; and such right must be an exclusive sectional right, excluding the patentee therefrom.

A *licensee* is one who, in writing or orally, has transferred to him a less interest than either the interest in

the whole patent or an undivided part thereof, or an exclusive sectional interest.

The terms assignee and grantee have separate and distinct meanings, and are not synonymous. (*Potter* v. *Holland*, 1 *Fish.*, 327.)

78. FORM OF PETITION BY AN INVENTOR FOR AN ASSIGNEE.—

To the Commissioner of Patents:

Your petitioner prays that letters patent may be granted to Joel Thomas, as his assignee, for the invention set forth in the annexed specification.

JAMES GREENFIELD.

79. LEGAL REPRESENTATIVES MAY MAKE APPLICATION.—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 shall be 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. (*Act of July* 8, 1870, § 34.)

The statute contemplates a perfected invention or discovery, for which the inventor, if living, could have taken out a patent under the other provisions of the act. (*Curtis on Patents*, 177.)

If the inventor die before he has obtained a patent for his invention, no person other than his executor or administrator can apply for a patent for such invention, and the patent must be issued to such person in trust for the

heirs at law or devisees of the inventor. It need not, however, be expressed in the patent that it is issued to such executor in trust for those entitled to it. It will be sufficient that the patent set forth that it was issued to the grantee as executor. What the executor does in relation to the property of the devisor, he does in trust for those to whom such property is given by the will. (*Stimson* v. *Rogers*, 4 *Blatchf.*, 333.)

When the patent was granted by the Government to C. G., as executor, the suffix of executor signified the trustee character in which he assumed to act and in which he was recognized and dealt with by the Commissioner. The designation and the trust which it implied did not prevent the passage of the legal title or qualify the estate which accompanied it. It follows, from this view of the subject, that the grantee can sustain a suit on the patent in all respects as if he had been designated in it as trustee, instead of executor. (*Rubber Company* v. *Goodyear*, 9 *Wallace*, 792.)

80. FORM OF PETITION BY AN ADMINISTRATOR.—

To the Commissioner of Patents:

Your petitioner, William Davis, administrator of the estate of George Owen, 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 George Owens, set forth in the annexed specification.

WILLIAM DAVIS,
Administrator, &c.

81. FORM OF PETITION BY AN EXECUTOR.—

To the Commissioner of Patents:

Your petitioner, Samuel Wilson, executor of the last will and testament of Henry Somers, 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 Henry Somers, set forth in the annexed specification.

SAMUEL WILSON,
Executor, &c.

82. ATTORNEYS.—Any person of intelligence and good moral character may appear as the attorney in fact or agent of an applicant upon filing a proper power of attorney. As the value of patents depends largely upon the careful preparation of the specification and claims, the assistance of competent counsel will, in most cases, be of advantage to the applicant, but the value of their services will be proportioned to their skill and honesty. So many persons have entered this profession of late years without experience that too much care cannot be exercised in the selection of a competent man. The office cannot assume responsibility for the acts of attorneys, nor can it assist applicants in making a selection. It will, however, be a safe rule to distrust those who boast of the possession of special and peculiar facilities in the office for procuring patents in a shorter time or with more extended claims than others. (*Patent Office Rules, July* 8, 1870.)

83. COMMISSIONER MAY REFUSE TO RECOGNIZE AN ATTORNEY.—For gross misconduct the Commissioner 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. (*Act of July* 8, 1870, § 17.)

And for lesser offenses attorneys may be refused the privilege of oral interviews, and be required to transact all business with the office in writing. (*Patent Office Rules, July*, 1870.)

84. CORRESPONDENCE HELD WITH ATTORNEY ONLY.—When an agent has filed his power of attorney, duly executed, the correspondence will, in ordinary cases, be

held with him only. A double correspondence with him and his principal, if generally allowed, would largely increase the labor of the office. (*Ib.*)

85. CLAUSE OF SUBSTITUTION.—Powers of attorney must contain a clause of substitution, to authorize the attorney to substitute for, or associate, with, himself a second agent; but such powers will not authorize the second agent to appoint a third. (*Ib.*)

86. ASSOCIATE ATTORNEY.—A power of attorney must be filed in every case, both by original and associate attorneys, before such attorney will be allowed to inspect papers or take action of any kind; but a revenue stamp need be affixed to original powers only. (*Ib.*)

87. REVOCATION.—If the principal becomes dissatisfied, he must revoke his power of attorney and notify the office, which will then communicate with him. (*Ib.*)

88. STAMP REQUIRED.—A stamp of the value of fifty cents is required upon each power of attorney authorizing an attorney or agent to transact business with this office relative to an application for a patent, reissue, or extension. The person using or affixing the stamp must cancel the same, by writing thereupon the initials of his name and the date. (*Ib.*)

89. FORM OF PETITION, WITH POWER OF ATTORNEY.—

To the Commissioner of Patents:

Your petitioner prays that letters patent may be granted to him for the invention set forth in the annexed specification; and he hereby appoints Solomon Sharp, of the city of Washington, District of Columbia, his attorney, 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 herewith.

[10 cent revenue stamp.] PETER PENDENT.

[If the power of attorney be given at any time other

than that of making application for patent, it will be in substantially the following form:]

90. FORM OF POWER OF ATTORNEY.—

To the Commissioner of Patents:

The undersigned having, on or about the 20th day of July, 1859, made application for letters patent for an improvement in a horse-power, hereby appoints Lawrence Legal, of the city of Washington, District of Columbia, his attorney, 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.

Signed at Brooklyn, county of Kings, and State of New York, this 27th day of July, A. D. 1869. CHARLES CAUTIOUS.

[50 cent revenue stamp.]

91. FORM OF ASSOCIATE POWER.—

To the Commissioner of Patents:

SIR: Will you please recognize Solomon Sharp, of Washington, D. C., as my agent and associate in examining and amending the application of Peter Pendant for an improvement in horse-power, filed April 23, 1870, and address all communications in relation thereto to him. C. P. RUSSELL.

92. FORM OF REVOCATION OF POWER OF ATTORNEY.—

The undersigned having, on or about the 26th day of December, 1867, appointed Thomas Tardy, of the city of New York, New York, his attorney, to prosecute application for letters patent for an improvement in the running-gear of wagons, hereby revokes the power of attorney then given.

Signed at Richmond, Virginia, this 21st day of July, 1869.

RALPH WHITMAN.

V. The Specification.

SEC.

93. Specification and drawing a part of the patent.
94. Statute requisites.
95. Rules of the Patent Office concerning the specification.
96. Patent and specification construed together.
97. Object of the specification twofold.
98. Specification addressed to persons of competent skill.
99. What need not be stated.
100. Variable proportions may be stated.

SEC.
101. Office of the claim.
102. Language employed.
103. Strictures upon the words "substantially as described," "as herein set forth," and the like.
104. How improvements should be set forth.
105. Implication in regard to parts not claimed.
106. Invention should not be described as a mode, function, or abstract principle.
107. Vagueness and ambiguity of description.
108. Fraudulent concealment, false suggestion.
109. Descriptive title.
110. Order of the specification.
111. Object of the invention.
112. Description of detail.
113. The claim.
114. Form of specification for a machine by a sole inventor.
115. Form of specification for a process by joint inventors.
116. Form of specification of a composition of matter by an administrator.

93. SPECIFICATION AND DRAWING A PART OF THE PATENT.—A copy of the specifications and of the drawings shall be annexed to the patent, and be a part thereof. (*Act of July* 8, 1870, § 22.)

94. STATUTE REQUISITES OF THE SPECIFICATION.—Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner, 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, improve-

ment, or combination which he claims as his invention or discovery; and said specification and claim shall be signed by the inventor and attested by two witnesses. (*Act of July* 8, 1870, § 26.)

95. RULES OF THE PATENT OFFICE CONCERNING THE SPECIFICATION.—The applicant must set forth in his specification the precise invention for which he claims a patent; and in all applications for mere improvements, the specification must distinguish between what is admitted to be old and what is described and claimed to be the improvement, so that the office and the public may understand exactly for what the patent is granted.

Two or more distinct and separate inventions may not be claimed in one application; but where several inventions are necessarily connected each with the other, they may be so claimed.

If more than one invention is claimed in a single application, and they are found to be of such a nature that a single patent may not be issued to cover the whole, the office requires the inventor to divide the application into separate applications, or to confine the description and claim to whichever invention he may elect.

The specification should describe the drawings, (where there are drawings,) and refer by letters and figures to the different parts; and, having fully described the art, machine, manufacture, composition, or improvement, it should particularly specify and point out the part, improvement, or combination which is claimed as the invention or discovery.

The specification must be signed by the inventor, or by his executor or administrator, and must be attested by two witnesses. Full names must be given, and all names,

whether of applicant or witnesses, must be legibly written. (*Patent Office Rules, July*, 1870.)

96. PATENT AND SPECIFICATION CONSTRUED TOGETHER.—The specification, under our law, occupies a relation to the patent somewhat different to the rule in England. In England the specification does not form a part of the patent, so as to control its construction; but the rights of the inventor are made to depend upon the description of his invention inserted in the title of the patent, and cannot be helped by the specification, the office of which is to describe the mode of constructing, using, or compounding the invention mentioned in the patent. But in the United States the invention is drawn up and filed before the patent is granted, and is referred to in the patent itself, a copy being annexed. It is, therefore, a settled rule in this country that the patent and specification are to be construed together, in order to ascertain the subject-matter of the invention, and that the specification may control the generality of the terms of the patent of which it forms a part. In like manner, drawings annexed to a specification, in compliance with the statute, are held to form a part of it, and are to be regarded in the construction of the whole instrument; and, when the term patent is used, it is understood to include the specification and drawings annexed to it. (*Curtis on Patents*, § 221; *Phillips on Patents*, 223; *Godson on Patents*, 108; *Hogg* v. *Emerson*, 6 *How.*, 437, 479.)

The whole patent, including the specification and drawings, is to be taken into consideration; but we look to them only for the purpose of putting a proper construction upon the claim.) *Pitts v. Wemple*, 2 *Fish.*, 10.)

97. OBJECT OF THE SPECIFICATION TWO-FOLD.—The object

of the provisions of the statute requiring an inventor to describe his invention in as full, clear, and exact terms, as to enable a skillful person to construct it, is two-fold: first, that when the term has expired, and the invention becomes public property, such means of information will be accessible through the Patent Office as to enable others to avail themselves of its benefits; and, second, that while the patent is in force others may be informed of the precise claim of the patentee, and not ignorantly infringe his exclusive rights. (*Parker* v. *Stiles*, 5 *McLean*, 55.)

98. SPECIFICATION ADDRESSED TO PERSONS OF COMPETENT SKILL.—The law does not require that the specification should contain an explanation level with the capacity of every one, which would often be impossible. It allows the patentee to address himself to persons of competent skill in the art, and it requires him to use such full, clear, and exact terms as will enable that class of persons to reproduce the thing described from the description itself. If, therefore, clear ideas are conveyed to men of mechanical skill in the subject-matter, by which they could make or direct the making of the machine by following the directions given, the specification is good within the acts of Congress. (*Curtis on Patents*, § 253; *Lowell* v. *Lewis*, 1 *Mason*, 182; *Whitney* v. *Emmett*, *Bald.*, 319.)

In all descriptions of patented machines something must be left to the judgment and discretion of the mechanic who constructs the machine. It will, perhaps, rarely happen, even when the utmost vigilance and care are observed, that the machine or structure will be so accurately described as that the description can be literally and strictly followed in every particular. The skillful mechanic will see that in some particulars there is

some vagueness, and some discretion is required; but that fault will not invalidate the patent. (*Swift* v. *Whisen*, 8 *Fish.*, 343.)

The persons whose judgment is appealed to are not those who possess the highest degree of skill or knowledge in the particular art or science to which the subject-matter belongs, nor are they day laborers; they are practical workmen, or persons of reasonably competent skill in the particular art, science, or branch of industry to which the invention relates.

The description should be accommodated to the comprehension of persons of competent skill and knowledge, without taxing their genius or inventive powers, and should specify the means used so fully and exactly as to enable them, by using the means specified, without addition or subtraction, to produce the result described. (*Gray* v. *James*, *Pet. C. C.*, 401; *O'Reilly* v. *Morse*, 15 *How.*, 119.)

99. WHAT NEED NOT BE STATED.—The specification need not describe that which is within the ordinary knowledge of any workman having a competent knowledge of the work, who may be employed to construct the machine, nor is it necessary for the specification to describe the mode of making everything which is used, or detail known processes, or explain the terms appropriate to the particular art, or science, or branch of industry to which the invention belongs. (*Page* v. *Ferry*, 1 *Fish.*, 298; *Curtis on Patents*, § 260.)

Nor is it necessary in the description of a machine to state of what material every part should be made, unless a particular material be essential to its successful operation. (*Brooks* v. *Bicknell*, 3 *McLean*, 250, 261.)

Where the invention consists of a machine, the inventor must fully explain the principle and the several modes in which he has contemplated the application of that principle, by which it may be distinguished from other inventions; but he is not required to specify such well-known substitutes for any particular element of his invention as any constructor acquainted with the art fully understands is usually employed for the accomplishment of the same function. (*Union Sugar Refinery* v. *Matthiessen*, 2 *Fish.*, 600.)

In the case of *C. Rubens ex parte*, (*Commissioners' Decisions*, *May* 28, 1870,) the Commissioner says: "The mechanism employed by applicant is not new, aside from the combination of it with a spring dispensing with a fixed stop, and such a spring is covered by the letters patent of Adrian Philippe. Moreover, no such spring or mechanism is shown in the drawings of applicant or set forth in his specification, except by the reference to Adrian Philippe's patent. The language of the reference is: 'A mechanism, such, for instance, as shown in the patent of Adrian Philippe, of July 5, 1864, is used.'

"Two points have arisen in the discussion of this case which are worthy of consideration: First, whether the patented invention of another can form an element of a legitimate combination; and, second, whether a legitimate combination can be claimed which includes an element not shown or specifically described in the specification and drawings. The second question may be answered in the affirmative with entire confidence. A well-known form of mechanism may be incorporated into and become an element of a legitimate combination without a detailed description. The specification is addressed to.

those skilled in the art to which the invention relates, and things well known to them need not be described, because the general public may not fully understand the details of the invention. The first point presents more difficulty. Undoubtedly there are many cases in which it would prove a great hardship to permit patents to issue for every combination in which an improvement previously patented might form a part. Instances are given in the cases *James Murphy*, (*Commissioners' Decisions*, 1869, p. 24,) and *Nathan Martz*, (*Commissioners' Decisions*, 1870, p. 18.) If, for example, an improvement be made in a feed-water heater, it would be an abuse of the doctrine of combination to apply it in turn to every species of boiler, and claim a patent upon every variation. In this way the patentee of the heater might be absolutely prevented from applying it to any boiler whatsoever.

"There is, however, another class of combinations, into which patented improvements may enter as elements, and of which they may form legitimate members. Such cases are those in which the patented device is itself improved or made more effective by the combination, or in which a new whole is produced by the union, or in which the combination does not lie in the legitimate and ordinary use of the patented improvement, but is so far out of the track of it as not to be obviously suggested by it, or in which the additional element is itself new, and could not have been, in the contemplation of the patentee, among the modes of using or applying his improvement."

100. IN A SPECIFICATION FOR A COMPOSITION OF MATTER VARIABLE PROPORTIONS MAY BE STATED.—If in his specification the patentee gives a certain proportion as the

general rule applicable to the ordinary state of ingredients, he may, without risk of having his patent declared void by the court for vagueness and uncertainty, state other and variable proportions as exceptions to the rule, applicable to the varying states of the ingredients, although the precise proportions adapted to a given state of the ingredients, other than the usual state, can only be ascertained by computing it from the general rule, after the particular state of the ingredients is ascertained. *Curtis on Patents*, § 259; *Wood* v. *Underhill*, 5 *How.*, 1, 3, 4.)

101. THE CLAIM IS NOT INTENDED TO AID THE DESCRIPTION, BUT TO ASCERTAIN THE EXTENT OF WHAT IS CLAIMED AS NEW.—The claim is not intended to be any description of the means by which the invention is to be performed, but is introduced for the security of the patentee, that he may not be supposed to claim more than he can support as an invention. It is introduced lest, in describing and ascertaining the nature of his invention and by what means the same is to be performed, the patentee should have inadvertently described something which is not new, in order to render his description of the improvement intelligible. (*Curtis on Patents*, § 227.)

A proposition to limit the claim made by the patentee to the Commissioner does not bind the patentee. (*Pike* v. *Potter*, 3 *Fish.*, 55)

In the case of *Owen Dorsey ex parte*, (*Commissioners' Decisions*, *March*, 1870,) the Commissioner says: "It is yet more strenuously urged that the terms in which the invention is defined are such as to bring it clearly in conflict with pre-existing machines. This objection derives much of its force from a misapprehension of the proper office of what are usually called 'the claims' in a

patent. It is quite commonly supposed that they constitute, as it were, an instrument by itself, distinct from the descriptive part, and are to be construed irrespective of the rest, unless express reference is made to it; that one portion is intended to make known how the invention is to be practiced, the other by itself to define and limit the monopoly. It has been even held that the patent law expressly requires a distinct section for that purpose in the grant. Such is not the import of the statute. The clause in it which is relied on is nothing more than an embodiment of the rule of the English courts, requiring that the patentee should point out in his specification what is new, and distinguish it from what is old. But the statute prescribes no mode of doing this. It is not unusual for British patents to dispense with any such section. It would clearly be sufficient in this country if each new device is declared to be such in the text where it is described. It is more convenient to do this, no doubt, in one passage at the end. But in so doing the object is merely to designate those, among the things which have been described, which the inventor claims were originated by him; not to formally describe them anew or define them otherwise than sufficiently to indicate which, among the articles described, are novelties. Accordingly, in *Kay* v. *Marshall*, (2 *W. P. C.*,) a strong intimation was given that nothing should be embraced in a claim which had not been previously set forth. And the cases are numerous in which the claiming passages have been interpreted and controlled by the descriptive portion of the specification, even when not referred to." (*Wyeth* v. *Stone*, 1 *Story*, 273; *Stone* v. *Sprague*, *Ib.*, 270; *Ryan* v. *Goodwin*, 3 *Sumn.*, 514; *Davoll* v. *Brown*,

1 *Wood. & Min.*, 58; *Whitney* v. *Emmett*, *Bald.*, 303, 315; *Ames* v. *Howard*, 1 *Sumn*, 482.)

102. LANGUAGE EMPLOYED.—It is not necessary that the language employed should be technical or scientifically accurate, although the patentee is bound to describe, with reasonable certainty, in what his invention consists and what his particular claim is; but he is not bound to use any precise form of words; and if the terms made use of will enable the court to ascertain clearly, by fair interpretation, what the party intends to claim, an inaccuracy or imperfection in the language will not vitiate the specification. (*Wyeth* v. *Stone*, 1 *Story*, 271, 286.)

The nature of a process for which a patent is asked must be learned from the specification, and not from the explanations aside from it. (*Lowry ex parte*, *Commissioners' Decisions*, 1869, p. 85.)

103.. STRICTURES UPON THE WORDS "SUBSTANTIALLY AS DESCRIBED," "AS HEREIN SET FORTH," AND THE LIKE.—The practice of allowing claims for inventions which can only be distinguished from those previously invented or patented by the construction to be given to such words as "substantially as described," "as herein set forth," &c., cannot be too strongly condemned. The claim should state all the elements of the combination intended to be patented, and if the parts are the same in name and number as in some prior machine, and the improvement consists in some modification of one or more of those parts, the claim should distinctly state that modification. It should not be concealed in ambiguous phrases. The words "substantially as described," and the like, have no fixed legal meaning. They may serve to expand or contract the claim. In general they are employed for the

latter purpose, so that a claim may appear to be broad upon its face, which in truth, by virtue of this mysterious phraseology, is exceedingly narrow. Sometimes they are added by inventors as a matter of course, by way of rounding off the claim, and have no particular meaning; and again, they are intended to signify that the patentee claims that which he describes and everything substantially like it. They are, at the best, ambiguous and dangerous phrases, and, however else they may be used, they must not be employed in the granting of letters patent to make a claim good that without them would be bad and unpatentable. (*Charles Rubens ex parte*, *Commissioners' Decisions*, 1869, p. 107.)

In the case of *Sickles* v. *Falls Company* the court say: "The patentee, after describing the nature of his improvement and the machinery for effecting it, claims as follows: 'Imparting a co-existing movement to two reciprocating catch-pieces in the operation of trip cut-off valves.' The claim, in terms, is for an effect—for an effect or function—and, therefore, not patentable." (2 *Fish.*, 202.)

A claim for "constructing and arranging the spring catches, to cause the attachment of the lamp to the lantern, by the operation of pressing the lantern down upon the spring catches," is not the subject of a patent, but a mere result from the arrangement and combination of the parts. (*Sangster* v. *Miller*, 2 *Fish.*, 563.)

In the case of *Simonds ex parte*, (*Commissioners' Decisions*, *March* 14, 1870,) the Commissioner says: "Applicant claims, 'producing in cutting presses a successive change in the point of contact of the cutting-block with the cutting-die.' This claim is for a result or effect, and

is bad. It is in the precise form condemned in *Sickles* v. *Falls Company* (2 *Fish.*, 202) and *Sangster* v. *Miller*, (2 *Fish.*, 563.)

"The whole *genus* of claims for 'so constructing,' 'so combining,' 'producing,' 'determining,' and so on, *ad infinitum*, through the whole range of present participles, are of the same character, and obnoxious to the same objection. Some of them have been saved in the courts as by fire, by the construction given to the words 'substantially as described,' and the like, but not one of them should have been granted by the office. The patent is for the means of producing a result, not for the result as produced."

In the case of *Streeter* v. *Stodart*, (*Commissioners' Decisions, September* 7, 1870,) the Commisioner says: "It is a pernicious fallacy to say that every change in the 'arrangement' of the elements of a combination may form the foundation of a legitimate claim. This matter is fully discussed in the cases of *Nathan Martz* (*Commissioners' Decisions, January*, 1870, p. 18) and of *John Underwood*, (*Commissioners' Decisions, April*, 1870, p. 24.) In addition to what is there said, it may be remarked, that the word 'arrangement' has been construed by the courts to be synonymous with 'combination.' (See *Smith* v. *Higgins*, 1 *Fish.*, 540; *Bell* v. *Daniels*, *Ib.*, 372; *Howe* v. *Morton*, *Ib.*, 589.) To make a claim good for the arrangement of parts, it is necessary that all the elements should exist which are necessary to constitute a valid combination of the same parts, to wit: A novel union of the parts, a co-operation of the parts united, and the exercise of the inventive faculty as distinguished from the skill of the mechanic.

"Thus, A+B+C may constitute a legitimate combination when used in a certain relation. So, A+C+D may constitute another legitimate combination, provided D be not the mere equivalent of B, or a substitute, the employment of which involves no invention. Now, if one discovers that by employing B in the first combination in a new and modified form, by the use of which a new and useful result, or a better result, is obtained than by the original combination, how shall we state the formula of his invention? Obviously, it is a combination of A with C and with B, as modified. If, therefore, we designate the new form of B by B′, the formula of the combination will be A+B′+C But this same element may be further modified, not by change of form, but by change of location, by which the result is materially changed or a new result is attained. If we designate the element with the additional condition of the new location imposed upon it as B″, the combination will now be A+B″+C.

"But it must be obvious that to constitute a patentable subject-matter, the elements designated as B′ and B″ must differ from the original B in the same manner in kind as D differs from it in the second combination proposed; that is, they must not be mechanical equivalents for B, nor obvious substitutes for it, nor such modifications of it, either as to character or location, as belong to the skill of the mechanic rather than to the genius of the inventor.

"I do not mean to assert that a change of location may not enter as an element into a legitimate combination; but it is subject to the same conditions as any other element. It must be a new location, considered in the

light of the effect which it produces. It must require invention to adopt it, and when it has once been employed, no invention is involved in its use in any subsequent combination, except in those cases in which, to avail himself of it, the inventor is compelled to exercise further invention in the reorganization of his machine."

104. How Improvements should be Set Forth.—If a patent be for an improved machine, or an improvement on a machine, (the terms meaning substantially the same,) the patent must state in what the improvement specifically consists, in order, first, to enable the public to enjoy the full benefit of the discovery, when the monopoly has expired, by having it so described on record that it can be constructed; and, second, to put every citizen on his guard, that he may not, through ignorance, violate the law by infringing the rights of the patentee. (*Barrett* v. *Hall*, 1 *Mason*, 476; *Evans* v. *Hettick*, 3 *Wash.*, 425, 426.)

The object of the distinction between what is new and what is old is to show distinctly what the patentee claims as his invention. In order to make this distinction, the patentee is not confined to any precise form of words. The more usual form is to state affirmatively what the patentee claims as new; and if he makes use of anything old, to state negatively that he does not claim that thing. The former machine or other thing should be set forth sufficiently to make known what it is that the patentee engrafts his improvement upon; he should then disclaim the invention of the thing thus referred to or described, and state distinctly his improvement as the thing which he claims to have invented. (*Curtis on Patents*, §§ 232, 233; *Kneas* v. *The Schuylkill Bank*, 4 *Wash.*, 9, 14.)

105. Implication in regard to Parts not Claimed.

When a patentee specifies what he claims as new, every mechanical part, principle, or combination which he mentions in his specification, but which are not included in his invention as claimed and limited, must, by necessary implication, be considered as admitted to be old or in use before; and the patent is not invalid because the patentee has not in express words particularly stated them to be old, nor described the particular manner of their construction. (*Winans* v. *New York and Erie Railroad Company*, 1 *Fish.*, 213.)

106. THE INVENTION SHOULD NOT BE DESCRIBED OR CLAIMED AS A MODE, FUNCTION, OR ABSTRACT PRINCIPLE.—Although the invention may be a patentable subject, it may be claimed in such a way as to appear a mere function or abstract principle. In drawing the specification, therefore, care should be taken not to describe the invention as a mode for producing an effect (*vide supra*, p. 220) detached from the machinery by which the effect is produced. A patent must be granted for the machine, and not for a "mode" of operation, principle, idea, or other abstraction. (*Barrett* v. *Hall*, 1 *Mason*, 476; *Burr* v. *Duryea*, 1 *Wallace*, 531; *Curtis on Patents*, § 242.)

107. VAGUENESS AND AMBIGUITY OF DESCRIPTION.—The degree of clearness and freedom from ambiguity required in the specification is necessary to enable the Commissioner of Patents to judge whether the matter claimed is new or too broad, and to enable the courts, if the patent should be afterwards contested, to form like judgment, and also to enable the public to understand what the patent is. (*Hogg* v. *Emerson*, 6 *How.*, 484.) If the specification is wholly ambiguous and uncertain, so loosely defined, and so inaccurately expressed, that the

court cannot, upon a fair interpretation of the words and without vague conjecture of intention, gather what it is, the patent is void for such defect. (*Ames* v. *Howard*, 1 *Sumn.*, 485.) The inventor should not be permitted to couch his specification in such ambiguous terms that its claims may be expanded or contracted to suit the exigency. (*Parker* v. *Sears*, 1 *Fish.*, 93.)

A claim may be saved by construction that ought not to have passed the Patent Office in such a form as to make construction necessary to its salvation. The Commissioner ought not to send doubtful claims to the courts. The law makes him the judge in the first instance, and he has no right to turn out his work upon the country botched and blundering, in the hope that some court will patch it up. Many patents never go into the courts, and all patents ought to be so drawn that honest men of ordinary business capacity need not be afraid to deal with them. (*Joseph Thorne ex parte, Commissioners' Decisions*, 1869, p. 76.)

The act of 1836, § 6, provided that the applicant should "deliver a written description of his invention or discovery, * * * *avoiding unnecessary prolixity*," &c. The act of July 8, 1870, § 36, prescribed that the specification shall set forth, "in full, clear, *concise*, and exact terms," the nature of the invention or discovery. These provisions are necessarily to be enforced by the Commissioner, whose powers are ample, from the nature and necessities of the case, to determine what matter in a specification is or is not essential to a "full, clear, concise, and exact" description of the invention claimed. (*D. M. Smyth ex parte, Commissioners' Decisions, July* 23, 1870.)

It certainly is the duty of the Commissioner of Patents

to see to it that, so far as this result is possible of achievement, none but unambiguous claims are sent forth from the office. It is not sufficient that the claim be such as by a bare possibility may be saved through a liberal construction by the courts. (*N. J. Simonds, Commissioners' Decisions*, 1870, p. 25.) The ideal claim is one which admits of but a single interpretation, and that of the most literal character. The closer the Commissioner approximates to this standard in the exercise of his discretionary power in the revision of claims, the more nearly will one prolific source of misunderstanding and controversy be entirely avoided. (*Continental Wind Mill Company ex parte, Commissioners' Decisions, July* 27, 1870.)

108. FRAUDULENT CONCEALMENT, FALSE SUGGESTION.—The statute enacts it as one of the defenses to an action on a patent, "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." This defense will be made good where it appears that the patentee fraudulently concealed something that he knew to be material, or added something which he knew was not useful, material, or necessary at the time when he prepared his specification. If it was subsequently discovered not to be necessary, his patent will not be affected by it. (*Curtis on Patents*, § 250.)

109. DESCRIPTIVE TITLE.—While the specification is usually, and always ought to be, drawn with the assistance of learned and able counsel, the short descriptive title in the patent is usually suggested by the Commissioner

of Patents. (*Goodyear* v. *New Jersey Central Railroad*, 1 *Fish.*, 626.)

The title or description given to the invention in the grant is never expected to be specific, but only to indicate the nature and design of the invention. The specification, as its name indicates, must be searched for the exact description of what the patentee claims. (*Sickles* v. *Gloucester Manufacturing Company*, 1 *Fish.*, 222.)

110. ORDER OF SPECIFICATION.—The following order of the different portions of the specification should be observed: First, the statement of the object or purpose of the invention; secondly, the essence of the same; thirdly, the description of the detail; and, lastly, the claim. It is not absolutely indispensable to the order of the specification for the object and essence of the invention to form distinct sections therein, since they are both comprehended in the "nature" of the invention. (*Spence on the Specification*, 60.)

111. STATEMENT OF THE OBJECTS OF THE INVENTION.—It is usual in the specification, after reciting the title of the invention in the letters patent, to set out by stating its object or purpose. This is intended to show what desideratum the invention is designed to supply in the manufacture to which it refers. (*Ib.*, 61.)

The object or purpose of the invention being in this manner opened up, the natural course seems that it should be followed by a statement of the means which the invention supplies for carrying such object into effect; not a detailed description of such means, but the broad feature or principle involved therein. (*Ib.*, 64.)

This part of the specification forms a kind of epitome of the matter, which is afterwards treated more at length.

It states broadly in what the invention consists as to its practical character. It is here stated what particular construction and arrangement of machinery, or what combinations of materials or processes, are now organized and brought together for the first time in a useful manner. This, indeed, sets forth the essence of the invention, for the idea of a patented invention immediately suggests to the mind some mode of changing the existing machinery, or known materials, or processes by which a beneficial result is produced. (*Ib.*, 65.)

It is evident that great accuracy is here required, since the question, What is the invention? is answered by this part of the specification, taken in conjunction with the claim. While it is eminently desirable that the points here advanced should be strictly practical, it is at the same time highly important to guard against any undue narrowing of the object or purpose of the invention; but in endeavoring to guard against the evil of cramping the essence of the invention, care should be taken not to overstate its limits, which is an equally dangerous error. The right course lies between the two, and consists in a truthful disclosure of the exact nature, essence, or quality of the invention in its application to the object and purposes thereof. (*Ib.*)

112. DESCRIPTION OF DETAIL.—Next to a clear, broad statement of the invention comes a description of the detail, which exhibits the instrumental means of accomplishing the object or purpose of the invention. This description of detail should be adequate to meet the fullness of the expressions employed to characterize the essence of the invention, so that the latter may be clearly seen to have a real existence when carried into practice.

At the same time care should be taken not to cramp its extent as a principle, the object of the description of the detail being to show that the invention really contains an embodied, as distinguished from an abstract, principle. In this view, the machinery or apparatus described, as the instrumental means of carrying the invention into effect, ought to elucidate the structure of a body duly proportioned and adapted to perform its several functions in such a manner as to evince the vitality of the principle to which its action is (in the enunciation of the essence of the invention) alleged to be subservient: the main idea being that such detail presents to our view the organization of matter through which the principle or essence of the invention is realized or seen to act. All undue complexity of description should be avoided, since it may turn out to be more detrimental than mere surplusage, by its suggesting an interpretation, in reference to the subject-matter, foreign to or subversive of the real nature of the same. (*Ib.*, 72.)

113. THE CLAIM.—The claim may be said to be the most important part of the specification. It is here that the essence, principle, or spirit of the invention is stated in the most distinct terms. The whole of the foregoing matter is here summed up and resolved into its one idea. All the previous description of circumstances comes now to be seen only as affording a clue to the right interpretation of this final definition of the essential character of the invention. The claim, rightly understood, is in fact the specification; but, then, in order that it may be rightly understood, reference must be had to the antecedent matter, and it may indeed be said that the intelligibility of the whole specification greatly depends upon

the particular interpretation of the claim which is suggested by such reference. (*Ib.*, 91.)

It is well to calculate upon every objection being raised to the specification that human ingenuity can devise; and accordingly it may be foreseen that the true, distinct nature of the invention is left open to misconstruction by a mere statement of what it is, since it may appear to be not only that, but something more also, (probably of a prejudicial character,) unless guarded from such construction by a suitable negation. This course is particularly advisable when the patent is for a new combination of materials or processes which in their separate form are old or not open to be claimed. (*Ib.*)

114. Form of Specification for a Machine by a Sole Inventor.—

I, William Woodworth, of Poughkeepsie, in the county of Duchess, and State of New York, have invented certain improvements in planing machines, of which the following is a specification:

Nature and objects of the invention.

The first part of my invention relates to the combination of rotary cutters and feeding-rollers, in such a manner that the said feeding-rollers shall be capable of feeding the lumber to the cutters, and also of effectually resisting the tendency of the cutters to draw the lumber upward towards them; the object of this part of my invention being to reduce the lumber operated upon to a uniformity of thickness, and to give it a planed and even surface upon one side thereof.

The second part of my invention relates to the combination, with feeding-rollers and rotary cutters for planing one of the principal surfaces of the lumber, of rotary matching cutters, so as to form a tongue or groove, or both, upon the edge or edges of the lumber, at the same time that one of its principal surfaces is planed.

Description of the accompanying drawings.

Figure 1 is a side elevation of a machine embodying my invention.

Figure 2 is a plan of the same.

Figure 3 is an elevation, showing that end of the machine which is at the right hand in figure 1.

Figure 4 is a vertical transverse section, showing those parts of the machine which are at the right hand of the line *x x* drawn across figures 1 and 2.

General description.

A is the frame of the machine, which frame should be substantially constructed to resist the vibrations of the operating parts. B is the driving-pulley, which is hung on the main shaft C of the machine, from which latter motion is communicated to the operating parts. D is the shaft of the rotary cutters, by which the lumber is planed. This shaft is made flat upon two of its sides, between its bearings, for the reception of the cutters E E, which are firmly secured to it by bolts *a a*, the holes through these cutters for the reception of these bolts being elongated in the direction of the width of the cutters to allow the necessary adjustment of the cutters. The shaft D is hung in adjustable bearings, by which it may be elevated and depressed to regulate the thickness of the planed lumber. F is a pulley on the shaft D, which receives motion by a belt, G, from the band-wheel H, on the driving-shaft. I I and J J are the feeding-rollers, each pair of which is connected by finger-pinions *b b*, and the upper roller of each pair is hung in spring bearings, which allow it to yield slightly upward to pressure, to adapt it to any differences or inequalities in the thickness of the lumber. The lower roller of each pair is provided with a worm-wheel, *c*, which meshes into a worm or endless screw, *d*, on the shaft *k*, which is propelled by a bevel-wheel, *l*, on the main shaft, working into the bevel-wheel *f* on the shaft *k*.

L and M are cutters hung upon vertical shafts, N and O, one set of these cutters being adapted to form a groove, and the other to form a tongue, upon the edge of the board to be operated upon. These cutters are attached to the shafts in the manner already described with relation to the cutters E E.

The shafts N and O are provided with pulleys, *g g*, and rotation is communicated to them by belts, *h h*, from pulleys, *i i*, on the main shaft; rotation being given in the direction of the arrow to the driving-pulley.

The lumber to be planed is introduced from the end of the machine, which is shown at the right hand in figures 1 and 2, and being grasped by the rollers I I, is by them drawn forward to the cutters E E, which, being rapidly revolved towards the advancing lumber, plane it to the proper thickness; and as the lumber continues to advance, it is grasped by the rollers J J, which aid in the feeding motion and discharge the board after

it has passed the cutters. The upper rollers I and J, being hung in spring bearings, always exert a pressure on the top of the board, and thus prevent its being raised up by the action of the cutters E E.

When the lumber is designed for floors or ceilings, or other purpose for which it is required to be matched, a tongue is formed upon one edge of it and a groove in the other by the cutters L and M, which both revolve towards the advancing board; and these operations are performed at the same time that the upper surface of the board is planed, the whole being done at a single operation.

When the lumber is required to be matched, it should be first reduced to a uniform width, and guided in its introduction into the machine by a gauge, P, attached to the bed Q of the machine.

When the lumber is not to be matched, this gauge and the cutters L and M should be taken off and dispensed with.

Claims.

I claim as my invention:

First—The combination of the cutters E E and the feeding-rollers I I and J J, substantially as and for the purpose hereinbefore set forth.

Second—The combination with the cutters E E and feeding-rollers I I and J J of the cutters L and M, substantially as and for the purpose hereinbefore set forth.

WILLIAM WOODWORTH.

Witnesses: JETHRO WOOD.
OLIVER EVANS.

115. FORM OF SPECIFICATION FOR A PROCESS BY JOINT INVENTORS.—

We, Marion Ellsworth, of Chicago, county of Cook, and State of Illinois, and Joseph R. Shaw, of Indianapolis, county of Marion, and State of Indiana, have invented a certain process for separating smut and all impurities from wheat, of which the following is a specification:

Take of lime, newly slaked and while yet warm, one and a half pounds to each one hundred pounds of wheat. Mix the lime well with the wheat, let it stand one hour, then pass it through a smut-mill in the usual way, and it will be found that all the lime, smut, dirt, and other impurities attached to the wheat, of every kind, and which no smut-mill, without my liming process, will fully separate, will be entirely removed, and the flour will be as white and as sweet as though made from the best of wheat.

We do not claim the smut-mill, or any improvement thereon, or any new chemical quality of lime.

Claim.

We claim as our invention the process of applying lime, when newly slaked and warm, to wheat, before passing the latter through a smut-mill, so as to cleanse the wheat from all impurities, substantially as described.

MARION ELLSWORTH.
JOSEPH R. SHAW.

Witnesses: MAURICE JONES.
HENRY ELIAS.

116. FORM OF SPECIFICATION FOR A COMPOSITION OF MATTER BY AN ADMINISTRATOR.—

Benjamin Browning, deceased, late of Charleston, in the district of Charleston, and State of South Carolina, during his lifetime invented a certain compound called "wool oil," to be used instead of lard, rape-seed, or other oils, in the manufacture of wool.

The nature of the invention of the said Browning consists in mixing olive, lard, or rape-seed oil with a solution of oil of soap dissolved in hot water.

To prepare the wool oil, take a quantity of oil soap of any kind, provided the quality be good, and dissolve the same in hot water, say about thirty pounds of oil soap to thirty gallons of water, or a sufficient quantity of soap to saturate the water. Then take equal parts, by measure, of olive, lard, rape-seed, or any other kind of oil which can be used on wool in the process of its manufacture, and mix it with the preparation aforesaid, to wit, the soap solution, which, after such mixture, is ready to be used on the wool with as beneficial an effect as if pure oil only had been used. This wool oil will not decompose by age, because the oil of soap neutralizes the stearine in the oil; hence there is nothing to decompose. And for the same reason spontaneous combustion cannot be produced.

Claim.

I claim as the invention of the said Benjamin Browning the manufacture or preparation of a compound, which is denominated wool oil, of the ingredients, in the proportions, and for the purposes set forth.

EBENEZER WHITNEY,
Administrator.

Witnesses: JOHN M. THOMPSON.
ARTHUR BARTON.

VI. Drawings and Model.

SEC.
117. Drawings attached to the patent as part of specification.
118. Rules concerning drawings.
119. Copies furnished by the office.
120. Relation of drawings to the specification.
121. Description of drawings.
122. Letters.
123. Order of letters.
SEC.
124. Dotted lines.
125. Model.
126. Specimen of ingredients.
127. Commissioner may dispense with model.
128. Reqrisites of the model.
129. Model returned in rejected and abandoned cases.
130. Model as evidence.

117. DRAWINGS ATTACHED TO THE PATENT AS PART OF THE SPECIFICATION.—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 said drawings, to be furnished by the Patent Office, shall be attached to the patent as part of the specification. (*Act of July* 8, 1870, § 27.)

118. RULES OF THE PATENT OFFICE CONCERNING THE PREPARATION OF DRAWINGS.—Drawing must be on thick, smooth drawing paper, sufficiently stiff to support itself in the portfolios of the office. It must be neatly and artistically executed, with such detached sectional views as to clearly show what the invention is in construction and operation. Each part must be distinguished by the same number or letter whenever it appears in the several drawings. The name of the invention should be written at the top, the shortest side being considered as such. This drawing must be signed by the applicant or his attorney, and attested by two witnesses, and must be sent with the specification. Tracings upon cloth pasted on

thick paper will not be admitted. Thick drawings should never be folded for transmission, but should be rolled. (*Patent Office Rules, July*, 1870.)

The following rules must be observed in the preparation of the drawings, in order that they may be photo-lithographed:

The paper must be thin Bristol board or thick drawing paper, with a smooth or calendered surface. The outlines must be executed in deep black lines, to give distinctness to the print. Pale ashy tints must be dispensed with.

In shading, lines of black ink should be used, and such lines should be distinct and sharp and not crowded. Brush shadings or shadows will not be permitted.

All colors except black must be avoided in the drawings, lettering, and signatures; violet and purple inks must not be used.

No agent's, attorney's, or other stamp must be placed, in whole or in part, within the margin.

The sheet must not be larger than ten inches by fifteen, that being the size of the patent. If more illustrations are needed, several sheets must be used. (*Ib.*)

119. Copies Furnished by the Office.—Copies of drawings of patents issued after January 1, 1869, will be furnished to any one at the uniform rate of twenty-five cents per sheet of standard size. (*Ib.*)

Copies of drawings of patents issued prior to January 1, 1869, which can be photo-lithographed, will be furnished at twenty-five cents per sheet, when ten or more copies are ordered. Single tracings of such drawings, or less than ten, will be furnished at the cost of making them. One hundred copies or more will be furnished at $10 per hundred. (*Ib.*)

The duplicate drawing to be attached to the patent will be furnished by the office without charge, and will be a photo-lithographic copy of the thick drawing. (*Ib.*)

Written or printed copies of any records, books, papers, or drawings belonging to the Patent Office, and of letters patent under the signature of the Commissioner or Acting Commissioner, with the seal of office affixed, shall be competent 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. And copies of the specifications and drawings of foreign letters patent, certified in like manner, shall be *prima facie* evidence of the fact of the granting of such foreign letters patent, and of the date and contents thereof. (*Act of July* 8, 1870, § 57.)

The officer intrusted to give copies of papers or drawings in patent cases has no concern with the purpose for which asked. The policy of the law rather requires than forbids that copies should be given when applied for. (1 *Opinions Attorneys General*, 171.) And it is the duty of the Commissioner of Patents to give authenticated copies to any person demanding the same, on the payment of the legal fees; and for his refusal an action will lie against him. (*Boyden* v. *Burke*, 14 *How.*, 583.) But a demand accompanied by rudeness and insult is not a legal demand. (*Ib.*) A subsequent and proper demand cannot, however, be refused on account of prior misconduct or to enforce an apology. (*Ib.*) Copies cannot be taken by third parties; they must be taken by the proper officer and the fees paid therefor. (2 *Opinions of Attorneys General*, 456.)

120. OFFICE OF THE DRAWING AND ITS RELATION TO THE

SPECIFICATION.—The object of annexing drawings is to explain the mode of constructing the subject of the patent. It has been settled that the drawings constitute a part of the specification, when annexed thereto, and may be used to explain the otherwise imperfect description in the specification; so that the description may be partly in writing and partly in drawing; and if, by a comparison of words and drawings, the one will explain the other sufficiently to enable a skillful mechanic to perform the work, and to show that it is the invention claimed, the specification will be sufficient. (*Wilber* v. *Beecher*, 2 *Blatchf.*, 132.) The drawings need not be mentioned in the specification, but it is sufficient if the patentee puts them and written references on file with the specification. (*Emerson* v. *Hogg*, 2 *Blatchf.*, 1.) And a drawing, filed sometime after the recording anew of a patent, under § 1, act of March, 1837, is admissible in evidence, but is not to be deemed or taken as part of the specification, nor to be used for correcting any material defect therein. (*Winans* v. *Schenectady and Troy Railroad*, 2 *Blatchf.*, 299; *Curtis on Patents*, 262.)

If the drawings show an element of the invention which the patentee has not included specially in his claim, it is evidence, nevertheless, that it was a part of his invention, and he or his assignee has a right to incorporate that element in a reissued patent; and an ambiguity in the description may be removed by reference to the drawings, which may be examined to determine the dimensions of the parts, when dimensions become material. (*Swift* v. *Whissen.*)

The drawing may also be referred to for the purpose of adding something to the specification or claim not spe-

cifically contained or mentioned therein, *e. g.*, to describe or show the existence of rollers in a machine when they are not described in the specification. (*Washburn* v. *Gould*, 3 *Story*, 133.) But it need not delineate old machinery connected with the new invention when no change in such old machinery enters into the new invention. (*Emerson* v. *Hogg*, 2 *Blatchf.*, 9.)

121. DESCRIPTION OF DRAWINGS.—If drawings are used, they should be referred to in the commencement of the specification. When they are disposed in several sheets, it is often advisable to number the "figures" consecutively throughout, and thus to avoid, in references, the use of double numbers, such as "fig. 2, sheet 1," by enabling the reader to find the drawings from one reference. (*Macgregor*, *Language of Specifications*, 64.)

122. LETTERS.—The capitals, A, B, C, &c., are usually employed to mark the larger parts of the drawings, and the small letters, a, b, c, &c., are applied to more minute parts. (*Ib.*, 65.)

Parts which are similar in construction, and differ only in position, are frequently denoted by the same letter with an affix, as A^1, A^2, A^3, representing, for example, the spokes of a wheel or pillars of a frame. (*Ib.*, 65.)

123. ORDER OF LETTERS.—With regard to the order of letters, it is not easy to lay down comprehensive rules, without incumbering those who would observe them by confusing restrictions. In some cases, where the actions of each part of the portion of the machine or process under description result immediately from another, and where no particular or lengthy description is required of one or other part in the nature of a digression, the nature

and working of the invention may be described simultaneously. (*Ib.*)

Thus we may describe a portion of a steam engine and the action of its parts as follows: "In fig. 4, A^1, A^2, A^3, A^4, are the pillars supporting B, the frame. On B are fixed C^1 C^2, the bed-plates, carrying D^1 D^2, the bearings on which E, the cylinder, oscillates. F is the piston-rod, connected with G, the crank, which has a projection, *g*, that unlocks at each revolution of the catch *h*, and thus sets free the rod *i* and lever *k*, at the same time moving the eccentric H, so as to work the valve motion *l*." (*Ib.*, 66.)

In other cases it is more conducive to a clear understanding of the invention to describe the parts separately first, and to begin another description afterwards, in which their mutual relation is set forth. Thus a brewing apparatus may be described: "In fig. 5, B^1 is one of the two vats and its accompanying parts. The other is similar. The vat holds from one hundred to one hundred and fifty gallons, and the height and diameter are nearly equal. The upper part is hooped by rings k^1 k^2 k^3, made of fine-tempered iron, about four inches distant from each other. *l* is a ball-cock, regulating the supply of liquor from the pipe *m*, which is turned in a siphon form, and dips into the heating trough *n*, so as to be covered with four or five inches of water," &c. And after thus describing all the parts we may begin again, thus: "The operation of the machine was as follows: The liquor flows from the pipe *m* through the trough *n*, by the ball-cock *l*, into the vat B^1," &c.

The first portion of such an explanation of the drawings is something like a descriptive catalogue of the

parts represented and of the use of such in relation to those immediately adjoining it, while the second portion omits such minute description, on the supposition that it is understood, and proceeds to show the relation of all the parts in the operation of the machine.

When there are many figures, it affords relief to the mind to state at once, in the commencement, what each figure represents, thus: "Figure 1 represents an elevation of my improved loom; fig. 2 is a vertical section of the same, by a plane perpendicular to the axis of the breast-beam; fig. 3 represents the shed when open; and fig. 4 the same when closed; figs. 5, 6, 7, and 8 represent the machinery at each corner of the woof; and fig. 9 the apparatus for inserting the wire, (on a larger scale.") (*Ib.*, 67.)

124. DOTTED LINES.—Dotted lines are usually referred to when indicating parts represented as behind or covered by those nearer, as well as the paths of points when in motion. Great caution is required when it is endeavored to set forth particular parts of the machine as new parts, by distinguishing them in drawings. (*Ib.*, 68.)

It is to be recollected that the object of the specification *is not to describe the drawings*, but with the drawings *to describe the invention.* (*Ib.*, 68.)

125. MODEL.—In all cases which admit of representation by model, the applicant, if required by the Commissioner, shall furnish one of convenient size to exhibit advantageously the several parts of his invention or discovery. (*Act of July* 8, 1870, § 29.)

126. SPECIMENS OF INGREDIENTS.—When the invention or discovery is of a composition of matter, the applicant, if required by the Commissioner, shall furnish spec-

imens of ingredients and of the composition sufficient in quantity for the purpose of experiment. (*Ib.*, § 28.)

The Commissioner 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 said office; and said rooms and galleries shall be kept open during suitable hours for public inspection. (*Act of July* 8, 1870, § 13.)

127. COMMISSIONER MAY DISPENSE WITH MODEL.—An applicant, upon filing his specification and drawings, may submit to the Commissioner the question whether he shall deposit a model or specimen of his invention; otherwise a model will be required in every case, except for designs, where the nature of the invention admits of such illustration. (*Patent Office Rules, July*, 1870.)

128. REQUISITES OF MODEL.—The model must clearly exhibit every feature of the machine which forms the subject of a claim of invention. (*Ib.*)

It must be neatly and substantially made, of durable material. It should be made as small as possible, but not in any case more than one foot in length, width, or height. If made of pine or other soft wood, it should be painted, stained, or varnished. Glue must not be used, but the parts should be so connected as to resist the action of heat or moisture. (*Ib.*)

A working model is always desirable, in order to enable the office fully and readily to understand the precise operation of the machine. The name of the inventor, and of the assignee, (if assigned,) and also the title of the invention, must be affixed upon it in a permanent

manner. When the invention is a composition of matter, a specimen of each of the ingredients and of the composition must accompany the application, and the name of the inventor and of the assignee (if there be one) must be permanently affixed thereto. (*Ib.*)

129. MODEL WILL BE RETURNED IF THE APPLICATION IS REJECTED OR ABANDONED.—The model, unless otherwise disposed of, will be returned to the applicant upon demand and at the expense of the applicant, in all cases, when an application has been rejected more than two years; and, in any pending case of less than two years' standing, upon the filing of a formal abandonment of the application, signed by applicant. (*Ib.*)

Models filed as exhibits, in interference and other cases, may be returned to the applicant, at the discretion of the Commissioner. (*Ib.*)

The Commissioner 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. (*Act of July* 8, 1870, § 14.)

130. MODEL AS EVIDENCE.—Under the word patent, used in reference to the description of the thing patented, is included the patent, the specification attached to it, and the model and drawing, which are to be taken together, as making up the description. (*Whitney* v. *Emmett, Bald.*, 314.)

And the model may be resorted to for clearer information respecting the invention described in the specification. (*Hogg* v. *Emerson*, 6 *How.*, 485.)

Models of machines, about which there is a question, are a kind of evidence which is entitled to the highest credibility, and which, like figures, cannot lie. (*Morris* v. *Barrett*, 1 *Fish.*, 461.)

Evidence superior to and unaffected by the interest or prejudice of partisans, or by the opinions (the reveries they may often be called) of experts. (*McCormick* v. *Talcott*, 20 *How.*, 409.)

VII. Oath of Applicant.

SEC.
131. To what applicant is to make oath.
132. Oath when invention has been patented abroad.
133. Oath by administrator or executor.
134. Oath in cases of assignment.
135. Before whom oath may be taken.
136. Papers not to be sworn to in blank.
137. Oath not essential to the validity of the patent.
138. Oath extends to all described in the specification.
139. False suggestion.
140. Oath *prima facie* evidence.
141. Form of oath by sole inventor.

131. TO WHAT APPLICANT IS TO MAKE OATH.—The applicant shall make oath or affirmation 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. (*Act of July* 8, 1870, § 30.)

The applicant is not required to make oath or affirmation that he is the original and first inventor, but that he believes himself to be so. He cannot know absolutely whether he first invented or discovered the thing for

which he claims a patent, but he may believe that he did; and it is only when he is willing to make oath that he so believes that the law grants him a patent. (*Curtis on Patents*, § 273.)

132. OATH WHEN INVENTION HAS BEEN PATENTED ABROAD.—When application is made for a patent for an invention which has been already patented abroad, the inventor will be required to make oath that, according to the best of his knowledge and belief, the same has not been in public use in the United States for more than two years prior to the application in this country. (*Patent Office Rules, July*, 1870.)

133. OATH BY ADMINISTRATOR OR EXECUTOR APPLYING.—When the application shall be made by legal representatives, the oath or affirmation required to be made shall be so varied in form that it could be made by them. (*Act of July* 8, 1870, § 34.)

134. OATH IN CASES OF ASSIGNMENT BEFORE PATENT OR REISSUE OF A PATENT.—Patents may be granted and issued or reissued to the assignee of the inventor or discoverer, the assignment thereof being first entered of record in the Patent Office; but in such case the application for the patent shall be made and the specification sworn to by the inventor or discoverer; and also, if he be living, in case of an application for reissue. (*Ib.*, § 33.)

135. BEFORE WHOM OATH MAY BE TAKEN.—The oath or affirmation 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. (*Act of July* 8, 1870, § 30.) The oath being attested in all cases, in this and other countries, by the proper official seal of such notary. (*Patent Office Rules, July*, 1870.)

Where an act of Congress requires an oath to be administered, such oath, under the usage of a department, may be administered by a State officer having the power to administer oaths. (9 *Pet.*, 238; *United States* v. *Winchester*, 2 *McLean*, 135.)

In all cases in which, under the laws of the United States, oaths or affirmations may be made before a justice of the peace, they may be made before any notary public, and, when certified under his hand and seal, shall have the same effect as if made before such justice. (*Act of September* 16, 1850, § 1; 9 *Statutes at Large*, 458.)

A seal of a notary may be an impression made by the seal on paper, without wax or any other tenacious substance. (*Orr* v. *Lacy*, 4 *McLean*, 243.)

The seal of a notary is recognized in all countries where the law merchant prevails, and it is only necessary that it should conform to the law of the place where the notary acts. (*Ib.*)

Commissioners appointed by any circuit court of the United States may administer oaths in all cases in which, under the laws of the United States, oaths may be made before any justice of the peace or notary public. (*Act of September* 16, 1850, § 1; 9 *Statutes at Large*, 458.)

136. AN APPLICATION WILL BE REJECTED IN WHICH THE SPECIFICATION IS MADE OUT ON PAPERS WHICH HAVE BEEN SIGNED AND SWORN TO IN BLANK.—In the case of *Reed* v. *Roberts*, the Commissioner says: "There is reason to believe that the practice of forwarding to clients, to

be signed and witnessed, blank sheets, upon which specifications are afterwards to be written by the agent, and to which the previously prepared petition and oath of the applicant are to be attached, is not yet abandoned by attorneys practicing before this office. It is scarcely necessary to say, that the inventor or applicant who would sign and swear to a piece of blank paper, upon which some one else is, without his supervision, to write a description of an invention, is guilty of an act of moral perjury; and that the attorney or agent who knowingly presents papers so prepared to the Patent Office is guilty of a fraud on the office and the Government. I know of few offenses that may more properly be characterized as 'gross misconduct.' No power of attorney can justify any man in presenting to a public officer a paper purporting to be signed and sworn to by a man who never saw it, and who, at the moment it is presented in his name, is absolutely ignorant of its contents." (*Commissioners' Decisions*, 1869, p. 88.)

In the case of *De la Mar* v. *Surens et al.* the Commissioner says: "It appears that in December, 1865, they applied to solicitors to make application for letters patent. Blank papers were presented, which they signed and made oath to in blank. Subsequently, in fact not until nearly two years afterwards, these blanks were filled by the preparation of the specification which forms the subject of this application. I have already had occasion to call attention to this practice as mischievous and immoral. It is to be hoped that honorable men will frown upon it and avoid it.

"If the application had remained in this condition after the disclosure of these facts, I should have refused a patent upon it. But the applicants have filed a substitute

specification, properly signed and sworn to. The law requires this to be done before the issue of the patent. It does not declare the application to be a nullity until the oath is furnished. On the contrary, it has been decided that, if the patent issue without any oath, it is not void. (*Whittemore* v. *Cutter*, 1 *Gall.*, 433; *Crompton* v. *Bellnap Mills*, 3 *Fish.*, 536.)

"While such decisions do not authorize the Commissioner to dispense with the proper formalities, they clearly show that the defects may be cured at any time, and that the whole subject of amendment of applications is within his discretion." (*Commissioner's Decisions*, 1869, p. 94.)

137. OATH NOT ESSENTIAL TO THE VALIDITY OF THE PATENT.—The taking of the oath in due form in an application for a patent is not a condition precedent to the validity of the patent; it is but a pre-requisite to the granting thereof. The statute is directory to the officer superintending the issue of letters patent, and in no degree essential to its validity. (*Whittemore* v. *Cutter*, 1 *Gall.*, 433; *Dyer* v. *Rich.*, 1 *Metcalf*, 191.)

In the case of *Crompton* v. *Bellnap Mills* the court say: "The respondent finds among the papers on file in the case at the Patent Office a blank form of oath, with the jurat not signed by any magistrate; and hence he argues the oath was not taken. But the oath may have been taken for all that; and this negative testimony cannot overcome the direct recital of the letters patent that the oath was taken, or the presumption that the requirements of the law were complied with in issuing the patent.

"But, suppose it were so; suppose the oath was not taken; would the patent be void on that account? It was held otherwise by Justice Story in the case of *Whit-*

temore v. *Cutter*, (1 *Gall.*, 429.) The taking of the oath, though to be done prior to the granting of the patent, is not a *condition precedent*, failing which, the patent must fail. It is the evidence required to be furnished to the Patent Office, that the applicant really believes he is the original and first inventor of the art, &c. If he take this oath, and it turns out that he was not the first inventor or discoverer, his patent must fail and is void. So, if he do not take it, and still he is the first inventor or discoverer, the patent will be supported. It is *prima facie* evidence of the novelty and originality of the invention until the contrary appear. (*Parker* v. *Stiles*, 5 *McLean*, 60.)*

"So the act says, on payment of the duty, that is, fees, the Commissioner shall make an examination, and, if the invention shall be found useful and important, shall issue a patent. Suppose the fees should not be required or paid; would the patent therefore be void? Yet the one requirement appears to be as much a condition precedent as the other; both directory, not to be dispensed with, but neither involving the validity of the patent when granted." (3 *Fish.*, 536.)

138. OATH EXTENDS TO ALL IN SPECIFICATION.—The oath of inventor accompanying his application for a patent is to be considered as extending to all described in his specification, no less than the title of his invention. (*Hogg* v. *Emerson*, 6 *How.*, 482; *King* v. *Gedney*, *MS. Appeal Cases*, *D. C.*, 1856.)

139. FALSE SUGGESTION.—M, an alien, made oath that he was a citizen of the United States, and obtained a patent. Eight years afterward he surrendered his patent, made oath that he was a citizen of France, paid the

balance of the fee due the Patent Office, and obtained a reissue, which recited (among other things) that said original letters patent were "granted to him upon his belief that he was a citizen of the United States, which belief arose from an ignorance of the laws of the United States:" *Held*, That the original and reissued patents were both invalid: the first because of the false suggestion; the second from want of power in the Commissioner to grant it. (*Child* v. *Adams*, 1 *Fish.*, 189.)

140. OATH PRIMA FACIE EVIDENCE OF NOVELTY.—When the patent has issued, supported by the oath of the patentee, the burden of proof is cast upon the party who would object, to show that the grant has been improperly obtained by the patentee; because the law presumes, in the first instance, that the patent has been granted upon the proof which the statute requires to be laid before the officers of the Government, and that those proofs were satisfactory. (*Curtis on Patents*, § 472; *Philadelphia and Trenton Railroad Company* v. *Stimson*, 14 *Peters*, 458.)

The oath forming a part of the letters patent forms a legal ground for the presumption of the novelty and originality of the patentee's claim until the contrary is proved. (*Parker* v. *Stiles*, 5 *McLean*, 60.)

And a patent issued, grounded on the oath of the patentee, is *prima facie* evidence in an action of infringement. (*Fultz ex parte, MS. Appeal Cases, D. C.*, 1853.)

141. FORM OF OATH BY A SOLE INVENTOR.—

STATE OF NEW YORK, }
County of Albany. } *ss:*

Byron Rogers, the above-named petitioner, being duly sworn, (or affirmed,) deposes and says, that he verily believes himself to be the original and first inventor of the improvement in seed drills described in the foregoing specification; that he does not know and does not believe that the same

was ever before known or used; and that he is a citizen of the United States.

BYRON ROGERS.

Sworn to and subscribed before me this 13th day of March, 1869.

SIMON SHALLOW,

Justice of the Peace.

If the applicant be an alien, the sentence "and that he is a citizen of the United States" will be omitted, and in lieu thereof will be substituted "and that he is a citizen of the republic of Mexico," or "and that he is a subject of the King of Italy," or "of the Queen of Great Britain;" or as the case may be.

If the applicants claim to be *joint inventors*, the oath will read "that they verily believe themselves to be the original, first, and joint inventors," &c.

VIII. Classification of Subjects of Invention.

SEC.		SEC.	
142.	Classification and distribution.	160.	Illumination.
143.	Agriculture.	161.	Leather manufactures.
144.	Agricultural products, preparation of.	162.	Mechanical engineering.
145.	Builders' hardware.	163.	Metallurgy.
146.	Calorifics.	164.	Metal working.
147.	Carriages.	165.	Navigation.
148.	Chemical processes.	166.	Paper making.
149.	Civil engineering.	167.	Philosophical instruments.
150.	Clay manufactures.	168	Presses.
151.	Compositions.	169.	Printing and stationery.
152.	Felting and hat making.	170.	Railroads and railroad cars.
153.	Fine arts.	171.	Sewing machines.
154.	Fire-arms.	172.	Sports, games, and toys.
155.	Glass manufacture.	173.	Steam and air engines.
156.	Grinding mills.	174.	Stone working.
157.	Harvesters.	175.	Surgical apparatus.
158.	Household furniture.	176.	Textile manufactures.
159.	Hydraulics and Pneumatics.	177.	Wearing apparel.
		178.	Wood working.

142. CLASSIFICATION AND DISTRIBUTION.—The subjects of invention comprised in applications filed in the Patent Office are divided into thirty-six classes, some of which are subdivided into sections, and are distributed for examination among twenty-two principal examiners, each of whom has charge of a particular class or classes. The classification adopted January 1, 1868, is as follows:

143. CLASS I. AGRICULTURE.—Implements and machines for working the soil, including sowing, planting, fertilizing, digging, and gathering roots, &c., grafting, and pruning. (*For Harvesting, see Class XV.*)

144. CLASS II. AGRICULTURAL PRODUCTS, PREPARATION OF.—Implements and machines for preparing produce for market, including threshing, winnowing, protecting, and preserving crops and produce; fences and gates, cribs, granaries, stack-covers, and barns; incubation, culture of bees, care of domestic animals and dairy implements.

145. CLASS III. BUILDERS' HARDWARE.—Door-locks and fastenings, hinges, bell-hanging, and the metallic trimmings of houses, &c., including furniture hardware.

146. CLASS IV. CALORIFICS.—Apparatus for heating, ventilating, and cooking. (*For Blast and Ventilating Fans, Bellows, &c., see Class XVII.*)

147. CLASS V. CARRIAGES.—The construction of wheeled vehicles, including trucks, sleighs, &c. (*For Railroad Cars, see Class XXVIII.*)

148. CLASS VI. CHEMICAL PROCESSES.—Instruments and methods of evaporation, distillation, dyeing, tanning, water-proofing, vulcanizing india rubber, &c., and the manufacture of acids, salts, starch, sugar, alcohol, vinegar, dyes, paints, gas, glue, fats and oils, soaps, manures, &c.

149. CLASS VII. CIVIL ENGINEERING.—The construction of canals, roads, bridges, wharves, docks, sewers, wiers, dams, &c., and including military engineering, mining, architecture, masonry. (*For Blasting, &c., see Class XII.*)

150. CLASS VIII. CLAY MANUFACTURES.—The making of bricks, tiles, pottery, porcelain, and machines, tools, and kilns for manufacturing and enameling the same, including lime and cement kilns and peat machines.

151. CLASS IX. COMPOSITIONS.—Artificial substances formed by the mechanical or chemical combination of different ingredients.

152. CLASS X. FELTING AND HAT MAKING.—Methods and apparatus for felting wool, &c., and the making and finishing of hats, caps, &c., including implements and machines for the same.

153. CLASS XI. FINE ARTS.—Methods and applications of music, carving, sculpture, painting, graining, engraving, lithography, wood-cutting, &c., photography, bank-notes, &c., jewelry, including instruments and materials for the same.

154. CLASS XII. FIRE-ARMS.—Implements of war, offensive and defensive, including ammunition and its incidents, and blasting.

155. CLASS XIII. GLASS MANUFACTURE.—Glass furnaces; molding, blowing, cutting, grinding, and polishing glass, and implements and machines for the same.

156. CLASS XIV. GRINDING MILLS.—Machines for breaking, crushing, and grinding materials, including grain-cleaning, flour-bolting, &c. (*For Mill-gearing, see Class XX.*)

157. CLASS XV. HARVESTERS.—Implements and ma-

chines for harvesting and securing crops, &c. (*For Hand Hay-rakes and Pitchforks, see Class II.*)

158. CLASS XVI. HOUSEHOLD FURNITURE.—Articles, implements, and machines for domestic purposes. (*For Culinary Utensils, see Class IV.*)

159. CLASS XVII. HYDRAULICS AND PNEUMATICS.—Machines and apparatus for raising, conveying, and directing water and other fluids, including bottling, and apparatus for controlling and operating air, &c.

160. CLASS XVIII. ILLUMINATION.—Implements and devices for obtaining, preserving, and regulating artificial illumination.

161. CLASS XIX. LEATHER MANUFACTURES.—Machines and tools for working in leather, and the manufacture of boots and shoes, harness, trunks, belting, and including preparatory processes, cutting, splitting, &c.

162. CLASS XX. MECHANICAL ENGINEERING.—General mechanical movements, horse-powers, lifting jacks, hoisting apparatus, mill-gearing, &c. (*For Presses, see Class XXVI.*)

163. CLASS XXI. METALLURGY.—The preparation and treatment of ores, reduction and purification of metals, and processes for amalgamating, electroplating, and metallic coating.

164. CLASS XXII. METAL WORKING.—Methods, machines, and tools for shaping metals; construction of machines and articles of metal; manufactured articles of metal.

165. CLASS XXIII. NAVIGATION.—The construction of vessels, sails, rigging, propelling, and steering apparatus, life-boats, preservers, rafts, &c.

166. CLASS XXIV. PAPER MAKING.—The preparation

of vegetable pulp, and the manufacture of paper, papier maché, pasteboard, &c.

167. CLASS XXV. PHILOSOPHICAL INSTRUMENTS, including mathematical, optical, surveying, and nautical instruments; philosophical apparatus, scales, measures, and instruments of precision generally; registering, computing, signaling, telegraphing, and the application of electricity and magnetism.

168. CLASS XXVI. PRESSES.—Machines for compressing articles and materials. (*For Printing Presses, see Class XXVII.*)

169. CLASS XXVII. PRINTING AND STATIONERY.—Implements and machines for printing, type-setting, and distributing; type-founding and stereotyping, stamping, &c.; machines and tools for ruling, folding, and cutting paper, and for book-binding; labels, advertising cards, writing materials, &c.

170. CLASS XXVIII.—RAILROADS AND RAILROAD CARS. The construction of rails, chairs, switches, &c., and the rolling stock of railroads. (*For Engines of Locomotives, see Class XXXI.*)

171. CLASS XXIX. SEWING MACHINES.—Machines for sewing, stitching, embroidering, &c., and the incidents of such machines.

172. CLASS XXX. SPORTS, GAMES, AND TOYS.—Gymnastic apparatus, appliances for archery, fishing, skating, &c.; plays, games, diversions, and implements and devices for amusement.

173. CLASS XXXI. STEAM AND AIR ENGINES.—Machines for the application of vapor or gas as a motor; boilers and other apparatus for generating the same; governors, steam pumps, and feed apparatus, condensers, &c.

174. CLASS XXXII. STONE WORKING.—Machines and tools for hewing, cutting, and dressing stone, marble, granite, slate, &c.

175. CLASS XXXIII. SURGICAL APPARATUS.—Instruments and apparatus for the mechanical treatment of bodily infirmities, injuries, and diseases, and for assisting natural functions, including artificial limbs.

176. CLASS XXXIV. TEXTILE MANUFACTURES.—The treatment of cotton, flax, hemp, &c.; wool, hair, silk, &c.; and machinery for carding, spinning, cord and rope-making, weaving, knitting, lace-making, and braiding.

177. CLASS XXXV. WEARING APPAREL.—Articles of clothing and methods and machines for making the same, including articles for the toilet, &c. (*For Hats, see Class X; for Boots and Shoes, see Class XIX; for Sewing Machines, see Class XXIX.*)

178. CLASS XXXVI. WOOD WORKING.—Machines and tools for felling trees; hewing, sawing, planing, bending, turning, mortising, dove-tailing, and splitting wood; shingle and stave-cutting; comb-sawing; and the making of blinds, broom-handles, tree-nails, pegs, match-splints, &c.

IX. Examination and Amendment.

SEC.		SEC.	
179.	Examination of the application.	185.	Information, copies, and drawings furnished.
180.	Time to complete application.	186.	Applicant may demand specific references.
181.	Order of examination.	187.	Number of amendments allowed.
182.	Cases which have precedence.	188.	Amendment after appeal to examiners-in-chief.
183.	Cases not taken up out of turn.		
184.	Reference given upon rejection.		

SEC.
189. Amendment after appeal to the Commissioner.
190. Special amendments.
191. Requirements of amendment.
192. Division of the application may be required.
193. Correction of specification may be required.
SEC.
194. Specification will not be returned for amendment.
195. Attendance of applicant.
196. Examiner cannot decline to take jurisdiction, &c.
197. Executive, ministerial, and judicial functions of examiners.
198. Form of amendment.

179. EXAMINATION OF THE APPLICATION.—On the filing of an application and the payment of the duty required by law, the Commissioner 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. (*Act of July* 8, 1870, § 31.)

180. TIME TO COMPLETE AND PREPARE APPLICATIONS FOR EXAMINATION.—All applications for patents shall be completed and prepared for examination within two years after the filing of the petition, 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 that such delay was unavoidable. (*Ib.*, § 32.)

181. APPLICATIONS IN GENERAL EXAMINED IN REGULAR ORDER.—All cases in the Patent Office are classified and taken up for examination in regular order; those in the same class being examined and disposed of, as far as practicable, in the order in which the respective ap-

plications are completed. (*Patent Office Rules, July*, 1870.)

182. CASES WHICH HAVE PRECEDENCE.—When the invention is deemed of peculiar importance to some branch of the public service, and when for that reason the head of some department of the Government specially requests immediate action, the case will be taken up out of its order. These, with applications for reissues and for letters patent for inventions for which a foreign patent has already been obtained, which cases have precedence over original applications, are the only exceptions to the rule above stated in relation to the order of examination. (*Ib.*)

183. NO ORDER WILL BE GRANTED TO TAKE CASES UP OUT OF TURN.—In the case of *Hewins* v. *Spooner* the Commissioner says:

"In the course of the testimony a letter from a solicitor of patents, and one of the parties named above, was put in evidence. I do not see that this letter is relevant to any of the issues of this case, and I have given no weight to it as testimony. I refer to it now, as the publication of this opinion affords me a convenient opportunity of expressing the view which I entertain of its contents.

"The letter was written in February, 1869, in relation to obtaining the second patent upon the Baldwin meter. In this letter the writer says: 'I have a way now of obtaining the allowance of a patent in six hours after it reaches the Patent Office, by payment of $75; and I intend to have large fees paid me in excess of this for accomplishing this sort of a thing.'

"The first remark which this statement demands is, that it is false in fact. No solicitor or any other person

has 'a way of obtaining the allowance of a patent in six hours after it reaches the Patent Office.' Cases are received, recorded, and examined in their regular order. They do not reach the examiner until a day or two after they are filed, since they must pass through other rooms, where the fees are received, the cases classified, the application completed, the files made up, and other formal matters attended to. The examiners, under the great pressure of the numerous applications submitted to them, cannot reach a new case under a week or two after it comes into their rooms; so that, under the most favorable circumstances, the thing asserted in this letter is simply impossible. No order is ever granted under the present administration of the office to take cases up out of turn, except as provided in the printed rules, even when inventors have come to Washington to attend to their own applications; and this because it is simply just that those who send their cases to the office, and trust to the operation of its rules, shall not be set aside at the demand of the clamorous few who choose to attend in person, or to demand special privileges by friends or attorneys. This rule is imperative, and it has been faithfully and rigidly adhered to.

"But the writer of this letter intimates that this just rule may be set aside by the payment of money. 'Cases may go through in six hours,' he says, 'by the payment of $75;' and the advantage of knowing this secret he deems to be so great, that he intends 'to have large fees' paid to him 'for accomplishing this sort of thing.' This insinuation is also false. It is simply a libel upon the Patent Office—a libel which has not the slightest foundation in fact. The writer never had a patent allowed in

six hours after the application reached the Patent Office, and he never paid to the Patent Office or any officer thereof $75 or any other sum to secure the allowance of cases out of their regular order. Inventors ought to know that if they are foolish and wicked enough to pay their money upon such pretenses, it will never reach the pockets of the Government officials for whom they suppose it to be designed. It goes no further than the unscrupulous attorney or agent, who, assuming to trade upon the supposed corruption of sworn officers, is willing to slander honest men, and destroy public confidence in the administration of public affairs, in order that he may enrich himself at the expense of his credulous client. Instances have come to my knowledge where money has been extorted from clients by agents after patents had actually been allowed, but not yet issued, upon the pretense that it was necessary to bribe the examiner. I know of no case where the money went beyond the solicitor. No practitioner can assert, with truth, that he possesses any facilities by which he is enabled to procure patents in advance of any of his competitors, beyond his knowledge of the forms and routine of the office and his skill and care in the preparation of his cases. To take money from his clients, under the pretense that it is to be used to procure such facilities, is to add theft to falsehood." (*Commissioners' Decisions, September* 13, 1870.)

184. REFERENCE GIVEN UPON REJECTION.—Whenever, on examination, any claim for a patent is rejected, for any reason whatever, 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 renew-

ing his application or of altering his specification; and if, after receiving such notice, the applicant shall persist in his claim for a patent, with or without altering his specifications, the Commissioner shall order a re-examination of the case. (*Act of July* 8, 1870, § 41.)

185. INFORMATION, COPIES, AND DRAWINGS FURNISHED. Upon the rejection of an application for want of novelty, the applicant will be furnished with a specific reference (by name, date, and class) to the article or articles by which it is anticipated. If he desires a copy of the cases so referred to, or of the plates or drawings connected with them, they will be forwarded to him, if in possession of the office, on payment of the cost of making such copies.

When the rejection of an application is founded upon another case previously rejected, but not withdrawn or abandoned, the applicant will be furnished with all information in relation to the previously rejected case which is necessary for the proper understanding and management of his own. (*Patent Office Rules, July*, 1870.)

186. APPLICANT MAY DEMAND SPECIFIC REFERENCES.—In the case of *Ellis and Albertson ex parte*, the Commissioner says: "The applicants state that they have invented a new and useful improvement 'in hoes, rakes, and *similar implements*,' consisting of a mode of attaching hoes, rakes, and *similar implements* to their shanks, &c., 'whereby a very firm and secure attachment is obtained, and one which will admit of the hoe, rake, *or other tool* being set at any desired angle with the shank or handle,' &c. The examiner replies that the devices 'are old and well-known mechanical expedients, such as are employed by artisans in various branches of mechanical pursuits.

Carpenters and others use it for attaching center and other bits to braces; also for adjusting gauges *and other implements*.' This reference was general, and might, upon request of the applicant, have been made more specific. Unchallenged, however, it fully answers the claim." (*Commissioners' Decisions*, 1869, p. 8.)

In the case of *Schneider ex parte*, the Commissioner says: "Applicant claims 'a gilt beading or molding, either around the inner edge of a wooden frame or paper mat, or around the outside of the frame, when spun thereon from a flat metal band, for the purpose substantially as described.' This claim is somewhat awkwardly worded, but it sufficiently appears that the invention claimed is in substance a picture frame, with a metal bead spun upon the inner or outer edge from a flat band. The examiner does not assume to anticipate the invention precisely as claimed, but states the mode of spinning metal beads to be old in other branches of art, and affirms that a frame with a gilt bead is old. I do not understand the declaration of the examiner to go to the extent of declaring that the gilt metal bead is old as applied to picture frames. This construction of his language is expressly denied by the applicant, and if the examiner had taken exception to this denial, he should have furnished a specific reference.

"As the case is presented, I am of the opinion that a picture frame made in the manner described possesses patentable novelty as a new article of manufacture." (*Commissioners' Decisions*, 1869, p. 24.)

187. NUMBER OF AMENDMENTS ALLOWED.—The applicant has a right to amend, of course, after the first rejection; and he may amend as often as the examiner pre-

sents any new references. There must be two rejections upon the claim as originally filed, or, if amended, (in a matter of substance,) *upon the amended claim*, in order to close the case before the primary examiner, and render, in case further action is required, an appeal to the board of examiners-in-chief necessary. (*Patent Office Rules, July*, 1870.)

In the case of *Alice Appleton ex parte*, the Commissioner says: "The applicant complains that after her appeal to the board of examiners-in-chief the case was examined a third time, without her knowledge, and new references were given, which were considered by the examiners-in-chief in forming their judgment of the case. This complaint is sustained by the record, which shows that an appeal was taken to the board of examiners-in-chief January 24, 1868, on which day her counsel filed his brief; that on February 28, 1868, the examiner notified the applicant that the case had been re-examined, and gave new references, one to common household practices and another to the patent of C. E. Kilbourne, August 27, 1867, and that on March 9, 1868, the examiners-in-chief proceeded to judgment in the case.

"This course was undoubtedly irregular. After a first rejection, the applicant may insist upon his claim as presented. If the examiner reaffirms 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 by reason of them, if he desires to do so. When he has appealed, the case is closed before the primary examiner, unless it be regularly remanded, with leave to amend or with di-

rections for further examination. If it be so remanded, the case is re-opened below, and cannot return to the appellate tribunal until the applicant has responded to the new examination, either by amendment or fresh appeal.

"The applicant in this case has therefore a clear right of amendment, in view of the references contained in the third letter of the examiner.

"As the case now stands, I understand the examiner to affirm that the mode already in use of connecting knit goods in common household practice is by a crochet stitch, substantially the same as that of applicant. This applicant does not deny upon the record, and as no means of comparison are furnished, the statement of the examiner must be accepted as true.

"The decision of the board of examiners-in-chief is affirmed, with leave to the applicant to move to remand the case to afford opportunity for amendment." (*Commissioners' Decisions*, 1869, p. 8.)

188. AMENDMENTS AFTER APPEAL TO EXAMINERS-IN-CHIEF.—When the applicant has appealed the case is closed before the primary examiner, unless it be regularly remanded, with leave to amend, or with directions for further examination. If it be so remanded, the case is reopened below, and cannot return to the appellate tribunal until the applicant has responded to the new examination, either by amendment or fresh appeal; and after the *decision* of the board the primary examiner cannot reconsider the case without an order from the Commissioner. (*Duthie* v. *Casilear*, *Commissioners' Decisions*, *September* 15, 1870.)

189. AMENDMENTS AFTER APPEAL TO THE COMMIS-

SIONER.—When amendments are admitted while an appeal to the Commissioner is pending, the case should be again submitted to the examiner for investigation. (*Perry* v. *Lay*, *Commissioners' Decisions*, 1869, p. 3.)

In the case of *Cree ex parte*, the Acting Commissioner says: "So far, then, as the references go, it must be judged that applicant is entitled to a patent upon his peculiar bale. The present claim, however, is objectionable. There is no relation between this special construction of bale and the adjustable clasp around the neck of the bottle. The function of the two are entirely distinct, and they cannot properly be claimed in combination. For this reason the decision of the examiners-in-chief is affirmed, but with leave to applicant to amend his claim and specification before the primary examiner." (*Commissioners' Decisions*, *August* 3, 1870.)

190. SPECIAL AMENDMENTS.—After a second rejection, and at any time before the issue of the patent, the applicant may draw up special amendments and present the same to the Assistant Commissioner, who may, in his discretion, grant leave to make such special amendments, and allow a reconsideration by the examiner in charge. But such amendments shall first be submitted to the examiner, in order that he may indorse thereon his recommendation or objections. (*Patent Office Rules*, *July*, 1870.)

191. REQUIREMENTS OF THE AMENDMENT.—All amendments of the model, drawings, or specification, in the case of original applications, must conform to at least one of them as they were at the time of the filing of the application; and all amendments of specifications or claims must be made on separate sheets of paper from the original, and must be filed in the manner above di-

rected. Even when the amendment consists in striking out a portion of the specification or other paper, the same course should be observed. No erasure must be made by the applicant. The papers must remain forever as they were when filed, so that a true history of all that has been done in the case may be gathered from them. In every case of amendment the exact word or words to be stricken out or inserted should be clearly specified, and the precise point indicated where any insertion is to be made. (*Ib.*)

192. THE APPLICANT MAY BE REQUIRED TO DIVIDE HIS APPLICATION, (*vide supra*, p. 255.)—In the case of *Lehman ex parte* (*Commissioners' Decisions, July* 23, 1870) the Commissioner says: "Applicant files a specification of twenty-four pages, with nineteen claims, accompanied by four sheets of drawings, constituting an application for a combined agricultural implement, which consists of a combined sower, cultivator, hay-rake, and corn-planter. Some of the claims relate to the combination of these machines, and others to improvements in the individual machines, which have no reference to the combination, and which are capable of use upon any machines of their respective classes.

"Combined implements which use certain parts in common, and so save the expense of duplicating such parts, are becoming more and more common. They are useful, and, if new, are undoubtedly patentable. The combinations themselves, and all the parts which necessarily relate to such combinations, may, no doubt, be included in one patent, so that the subject-matter of the patent, and of all its claims, shall have reference to the *combined* machine.

"When, however, the applicant seeks to include in the same grant independent improvements in the individual machines composing the combination, which improvements have nothing to do with the combination, but are of general application, it is manifest that he is entitled to no more favor than if he attempted to patent improvements upon two independent and uncombined machines under one grant. To permit this would be a fraud upon the Government, and would utterly destroy all attempts at classification. This matter is fully discussed in *Linus Yale's Case.* (*Commissioners' Decisions*, 1869, p. 110.)"

193. EXAMINER MAY REQUIRE CORRECTION AND REVISION OF SPECIFICATION.—The specification, especially if the claim be amended, must be amended and revised, if required by the examiner, for the purpose of correcting inaccuracies of language or unnecessary prolixity, and of securing correspondence between the description of the invention and the claim. (*Patent Office Rules, July*, 1870.)

But the decision of the examiner upon such preliminary or intermediate questions, or refusals to act, twice repeated, or the determination of the questions of title, the number of amendments, the structure of the specification, the correspondence of the drawing with the model or the written description, and the accuracy and completeness of the description, will be re-examined, upon application, by the Commissioner in person, under the rule of the Patent Office which provides that "decisions of examiners upon preliminary or intermediate questions, or refusals to act, twice repeated, will be re-examined, upon application, by the Commissioner in person." (*Patent Office Rules, July*, 1870; *Krake ex parte*,

Commissioners' Decisions, 1869, p. 100; *Smyth ex parte*, *Commissioners' Decisions, July* 23, 1870; *Lehman ex parte*, *Ib., July* 23, 1870; *Nichols ex parte, Ib.*)

194. SPECIFICATIONS WILL NOT BE RETURNED FOR AMENDMENT.—The office will not return specifications for amendment; and in no case will any person be allowed to take any papers, drawings, models, or samples from the office. If applicants have not preserved copies of such papers as they wish to amend, the office will furnish them on the usual terms. (*Patent Office Rules, July*, 1870.)

195. ATTENDANCE OF APPLICANT NOT REQUIRED.—The personal attendance of the applicant at the Patent Office is unnecessary. The business can be done by correspondence or by attorney. (*Ib.*)

196. EXAMINER CANNOT DECLINE TO TAKE JURISDICTION ON THE GROUND THAT A CASE IS RES ADJUDICATA.—In the case of *D. M. Nichols ex parte*, the Commissioner says: "If the claims in the new application had differed from those previously considered by the board, there would be no doubt of the jurisdiction of the examiner. They were properly before him for some consideration. In the course of his examination he found them to be substantially the same as claims previously rejected by the appellate tribunal. They were not the same claims, but claims in effect the same. The examiner was, therefore, right in saying that the question of their patentability was *res adjudicata*. He should, therefore, have rejected the claims for lack of patentability on the authority of the former decision of the board. The question would then have been appealable to the board, to determine whether, in fact, their objections to the former claims

applied equally to these. I do not think the examiner could properly decline to take jurisdiction." (*Commissioners' Decisions, July* 23, 1870.)

197. EXECUTIVE, MINISTERIAL, AND JUDICIAL FUNCTIONS OF PRIMARY EXAMINERS.—The examiners and the Commissioner act continually in a double capacity. They are executive officers, having certain duties to perform, in relation to every application, of a purely executive character. Some of these duties are purely ministerial, and others, while strictly executive, require the exercise of discretion. Thus, the reception of the application and of the fee, the act of examination, the record of the patent, and the signing and the sealing, are ministerial; while the determination of the question of title, the number of amendments, the structure of the specification, the correspondence of the drawings with the model or the written description, and the accuracy or completeness of the description, are executive acts, although discretion is exercised in their performance. The judgments of the examiner, or of the Commissioner, upon what may be called the merits, the questions of patentability, of novelty, and utility, are judicial acts; and it is when sitting to determine these and questions of like character that these officers become *quasi* judges. The board of examiners-in-chief, on the other hand, act only in an appellate and judicial capacity. They are not, by law, vested with any executive duties, except as they may be included in "such other duties as may be assigned to them by the Commissioner." From the judicial acts of the examiner an appeal lies to the board; from his executive acts the appeal is to the Commissioner. An appeal from his decision upon the merits does not

carry with it his action upon executive matters. (*John A. Krake ex parte, Commissioners' Decisions*, 1869, p. 100.)

198. FORM OF AMENDMENT.—

WASHINGTON, D. C., *July* 20, 1869.

To the Commissioner of Patents:

In the matter of my application for letters patent for an improvement in wagon brakes, I hereby amend my specification, by striking out all between the ninth and twentieth lines, inclusive, on page 3, by inserting the words "*connected with*" after the word "*and*," in the first line of the second claim, and by striking out the third claim and substituting therefor the following:

3. The combination of the self-acting brake C, pin A, and slotted flanges D, substantially as described and for the purposes set forth.

HENRY RICHARDS,
By MILTON MEADOWS,
His attorney in fact.

X. Renewal of an Application upon which the Final Fee has not been Paid.

SEC.
199. Consequence of neglecting to pay the final fee.
200. Who may petition for renewal.
201. Renewed application to be made within two years.
202. New specification, &c., not required.
203. When an interference will be declared.
204. Form of petition for renewal.

199. CONSEQUENCE OF NEGLECTING TO PAY THE FINAL FEE WITHIN SIX MONTHS FROM NOTIFICATION OF ALLOWANCE.—Every patent shall 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 shall not be paid within that time the patent shall be withheld. (*Act of July* 8, 1870, § 23.)

The final fee on issuing a patent must be paid within

six months after the time at which the patent was allowed and notice thereof sent to the applicant or his agent. And if the final fee for such patent be not paid within that time, the patent will be forfeited, and the invention therein described become public property, as against the applicant therefor, unless he shall make a new application therefor within two years from the date of the original allowance. (*Patent Office Rules, July*, 1870.)

200. WHO MAY PETITION FOR RENEWAL OF THE APPLICATION.—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 has failed 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. (*Act of July* 8, 1870, § 35:)

201. RENEWED APPLICATION TO BE MADE WITHIN TWO YEARS FROM NOTIFICATION OF ALLOWANCE.—The 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, as aforesaid, was ordered to issue prior to the issue thereof. (*Ib.*)

202. NEW SPECIFICATION, &C., NOT REQUIRED.—It is not necessary for the applicant to file a new specification, oath, model, or drawing, on petitioning for the renewal of an application upon which the final fee has not been paid. The proper course will be to file a petition, stating

the date of the filing of the original application, and the date of the notification of allowance, and praying that the original specification, oath, drawings, and model be used as a part of the renewed application.

203. WHEN AN INTERFERENCE WILL BE DECLARED.—Upon considering the renewed application, if it be found that applications have been made, or unexpired patents have been granted, in which the device in controversy has been described or claimed, an interference will be declared between such applications or patents and such renewed application, in order that an opportunity may be given for the production of proof of abandonment or two years' public use, if either exist. (*Patent Office Rules, July*, 1870.)

204. FORM OF PETITION FOR THE RENEWAL OF AN APPLICATION.—

To the Commissioner of Patents:

Your petitioner represents that on May 8, 1868, he filed an application for letters patent for an improvement in churns, which application was allowed July 7, 1868, but that he failed to make payment of the final fee. He now makes renewed application for letters patent for said invention, and prays that the original specification, oath, drawings, and model may be used as a part of this application. SIMON SLOTHFUL.

XI. Renewal of Withdrawn and Rejected Applications filed prior to July 8, 1870.

SEC.
205. Consequences of neglect to renew application.
206. New application, formal renewal.
207. Applications in interference.
208. Intent of the act.
209. Petition to be accompanied by a demand for action.

205. CONSEQUENCES OF NEGLECT TO RENEW APPLICATION.

When an application for a patent has been rejected or

withdrawn prior to the passage of the act of July 8, 1870, the applicant shall have six months from the date of such passage to renew his application or to file a new one; and if he omit to do either, his application shall be held to have been abandoned. Upon the hearing of such renewed applications abandonment shall be considered as *a question of fact.* (*Act of July 8, 1870, § 35.*)

206. NEW APPLICATION, FORMAL RENEWAL.—The proper course will be, where the application has been withdrawn, to file a new application; and where it has been rejected but not withdrawn, to file a formal renewal, with or without amendment, as the status of the application with reference to previous action may require. (*Patent Office Rules, July, 1870.*)

207. WHEN RENEWED APPLICATIONS WILL BE PLACED IN INTERFERENCE.—Upon considering such renewed applications of either class, if it be found that applications have been made or unexpired patents have been granted in which the device in controversy has been described or claimed, an interference will be declared between such applications or patents and such renewed application, in order that an opportunity may be given for the production of proof of abandonment or two years' public use, if either exist. (*Ib.*)

208. INTENT OF THE ACT.—In the case of *Millspaugh ex parte* the Commissioner says: "In this case the attorneys for applicant file the following paper:

"In the matter of," &c., "filed September 20, 1869, and rejected by the board of examiners June 25, 1870, we beg leave to renew the same, in accordance with act of Congress relating to patents approved July 8, 1870, and to retain model, drawing, and papers heretofore filed, to

constitute the renewed application. The case is respectfully submitted to the board of appeal for their further action."

This paper is similar to a large number filed by various attorneys, except that the last paragraph is usually omitted. Some seem to suppose that the effect of such a request is to begin the case *de novo*, while others imagine that by filing such a paper they "keep the case alive" for two years, during which time they may or may not take or request further action. Both opinions are errors. The act of July 8, 1870, § 35, was intended for no such purposes. The sole intent of the second proviso of that section is, 1. To permit withdrawn cases to be refiled, in which case, of course, they begin *de novo;* and, 2. To permit rejected cases to be renewed, that is, to be revived and continued under the new law. (*Commissioners' Decisions, September* 21, 1870.)

209. PETITION TO BE ACCOMPANIED BY A DEMAND FOR ACTION.—"The prayer for renewal is a prayer for further action, and the effect of it is simply to demand such action as shall set the case in motion. Section 32 provides 'that all applications for patents shall be completed and prepared for examination within two years after the filing of the petition, 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,' &c. It will be observed that the two years run, not from action by the applicant, but action 'of which notice shall have been given to the applicant,' *i. e.*, action by the office.

"The petition for renewal is but a part of the action nec-

essary on behalf of the applicant to revive his case. To complete that action and make it effectual his petition must be accompanied with a specific demand for such proposed action as the status of the case may require. Thus, if the case has been but once rejected, the petition for renewal must be accompanied by a demand for a second examination, or by an amendment. If it has been twice rejected, the petition will accompany the appeal or the prayer to the Commissioner for further leave to amend. If it has been rejected by the board, the petition must be filed with the appeal to the Commissioner. If it has been rejected by the Commissioner, there can be no renewal, unless an appeal to the supreme court of the District of Columbia has been taken.

"Petitions for renewal do not differ, in this respect, from the petition for an original or reissued patent, or for the renewal of an application upon which the final fee has not been made for an extension or for an appeal. In all of these cases action is proposed or requested, which it is expected the office will proceed to make with reasonable diligence.

"I hold, therefore, that the filing of a naked petition for the removal of a rejected application does not of itself renew the case; and that if such petition is not accompanied or followed up by a demand for the action appropriate to the next stage beyond that at which the renewal finds it, the case will, after January 8, 1871, be treated as abandoned." (*Ib.*)

XII. Appeal to Examiners-in-Chief.

SEC.
210. Duties of examiners-in-chief.
211. Résumé of the laws constituting the board.
212. Examiners to be governed by decisions of the Commissioner.
213. When applicant may appeal.
214. Judicial and executive acts.
215. Adverse decisions only revised.
216. No rehearing allowed except upon order of Commissioner.
217. Primary examiner cannot reconsider without Commissioner's order.
SEC.
218. Case may be remanded for further examination.
219. Delegated discretion.
220. Commissioner may withhold patent after favorable decision.
221. Petition to set forth reasons of appeal.
222. Form of appeal from examiner.
223. Form of appeal from examiner in charge of interferences.

210. DUTIES OF EXAMINERS-IN-CHIEF.—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 reissues 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. (*Act of July* 8, 1870, § 10.)

211. RÉSUMÉ OF THE LAWS CONSTITUTING THE BOARD OF EXAMINERS-IN-CHIEF.—Examiners are first named in the act of 1836, in which provision is made for the appointment of one who is called "an examining clerk." Their duties are nowhere mentioned in the law, except as they may be supposed to be alluded to in the seventh section of the same act, where it is said that "the Commissioner shall make, or cause to be made, an examina-

tion of the alleged new invention or discovery, and if, on any such examination, it shall not appear to the Commissioner, &c., if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor."

Prior to the passage of the act of 1861, a board of appeal, consisting of three principal examiners, had been appointed by the Commissioner for the purpose of relieving him from the labor of hearing appeals, whose decisions, when affirmed or reversed by the Commissioner, became the action of the office. It was to make permanent provision for this board that the act of 1861 was passed.

That act provides: "That for the purpose of securing greater uniformity of action in the grant and refusal of letters patent, there shall be appointed by the President, by and with the advice and consent of the Senate, three examiners-in-chief, at an annual salary of $3,000 each, to be composed of persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters patent; and also to revise and determine in like manner upon the validity of the decisions of examiners in interference cases and when required by the Commissioner in applications for the extension of patents, and to perform such other duties as may be assigned to them by the Commissioner; that from their decisions appeals may be taken to the Commissioner of Patents in person, upon payment of the fee hereinafter prescribed; that the said examiners-in-chief shall be governed in their action by

the rules to be prescribed by the Commissioner of Patents."

Except as to the manner of their appointment, this is substantially the old appeal board. These new officers are made, by express provision of law, subordinate to the Commissioner; are required "to perform such other duties as may be assigned to them" by him, and are required to be governed in "their action," upon all the subjects committed to them, both by the law and the Commissioner, "by the rules to be prescribed" by him. (*Hull ex parte, Commissioners' Decisions*, 1869, p. 68.)

212. EXAMINERS-IN-CHIEF TO BE GOVERNED BY THE RULES AND DECISIONS OF THE COMMISSIONER.—It follows, therefore, that the board of examiners, like all other examiners, are controlled in their action by the rules of the office, or any rules of practice announced by the Commissioner, or any construction of such rules or of the law, made by him, as may be of general application.

Indeed, in no other way can "uniformity of action" be secured. If the board are to affirm to-day and reverse to-morrow under the same state of *facts*—if they are to follow the Commissioner in this decision, and to differ from him in that—it is manifest that, so far from securing uniformity, they would soon plunge the office into inextricable confusion. Their true office is, while relieving the Commissioner of the mass of appeals which come from the primary examiners, so to deal with those appeals as to enforce upon the examiners his decisions and his administration of the office, and thus secure uniformity. They are not to make law for the Commissioner; but, both by the appeal allowed to him from

them, and by the express provisions of the act, he is to make law for them.

It will be noticed that appeals may be taken from the primary examiner to the board of examiners-in-chief from decisions "when adverse to the grant of letters patent." No such provision is made as to appeals to the Commissioner from the board. Such appeal is "from their decisions." In both instances the law is silent as to decisions either by the primary examiners or the examiners-in-chief, when such decisions are not adverse to the grant of letters patent.

Such decisions undoubtedly remain unaffected by the act of 1861. They remain, as they always were, under the control of the Commissioner, as the executive head of the office. He prescribes the duties of the examiners. He is himself an examiner, under the act of 1836, and by the terms of that act it is made his duty to "superintend, execute, and perform all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, &c., as are herein provided for, or shall hereafter by law be directed to be done and performed." He countersigns the patent, and after the indorsement of the examiner upon it touching his examination, the Commissioner, or his agent, must authorize its issue, and cause the seal of the office to be affixed to it. (*Ib.*)

213. WHEN APPLICANT MAY APPEAL.—Every applicant for a patent or the reissue 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 interference, in such case, to the board of examiners-in-chief, having

once paid the fee for such appeal provided by law. (*Act of July* 8, 1870, § 46.) But there must be two rejections upon the claim as originally filed, or, if amended, (in a matter of substance,) upon the amended claim. (*Patent Office Rules, July*, 1870.)

214. FROM THE JUDICIAL ACTS OF THE EXAMINER AN APPEAL LIES TO THE BOARD; FROM HIS EXECUTIVE ACTS THE APPEAL IS TO THE COMMISSIONER.—The examiners and the Commissioner act continually in a double capacity. They are executive officers, having certain duties to perform, in relation to every application, of a purely executive character. Some of these duties are purely ministerial, and others, while strictly executive, require the exercise of discretion. Thus, the reception of the application and of the fee, the act of examination, the record of the patent, and the signing and the sealing, are ministerial; while the determination of the question of title, the number of amendments, the structure of the specification, the correspondence of the drawings with the model or the written description, and the accuracy or completeness of the description, are executive acts, although discretion is exercised in their performance. The judgments of the examiner, or of the Commissioner, upon what may be called the merits; the questions of patentability, of novelty, and utility, are judicial acts; and it is when sitting to determine these and questions of like character that these officers become *quasi* judges. The board of examiners-in-chief, on the other hand, act only in an appellate and judicial capacity. They are not by law vested with any executive duties, except as they may be included in "such other duties as may be assigned to them by the Commissioner."

From the judicial acts of the examiner an appeal lies to the board; from his executive acts the appeal is to the Commissioner. An appeal from his decision upon the merits does not carry with it his action upon executive matters. (*Krake ex parte, Commissioners' Decisions*, 1869, p. 100.)

Decisions of examiners upon preliminary or intermediate questions, or refusals to act, twice repeated, will be re-examined, upon application, by the Commissioner in person. (*Patent Office Rules, July*, 1870.)

In the case of *Wilkinson ex parte* the Commissioner says:

"This application was rejected by the examiner because, in his opinion, the device was 'essentially deficient in patentable invention.' Thereupon the applicant demanded a reference or a patent. The examiner gave no reference and refused a patent. Applicant reiterates his demand for a reference under rule 37, and appeals to the Commissioner in person under rule 45.

"He has mistaken both his rights and his remedy.

"Rule 37 provides, that 'upon the rejection of an application for want of novelty, the applicant will be furnished with a specific reference,' &c. The present application is not rejected 'for want of novelty,' but for want of 'patentable invention.' This objection may concede that the thing is new, but denies that invention was involved in its production. No reference is required either by rule or by law to establish this ground of rejection.

"But, if it were so, the remedy is by appeal to the board of examiners-in-chief, and not to the Commissioner in person. This is not a decision upon an intermediate question, nor is it a refusal to act. The examiner's decision

goes to the merits of the application and is adverse to the applicant. If the examiner gives a general reference, and the applicant is entitled to a specific reference, and demands it, the remedy is by appeal to the board, who would then hold the general reference to be no reference, or an insufficient one, and reverse the decision of the examiner in rejecting the application. The case does not differ in principle from one in which a specific reference is given, which the applicant claims to be insufficient to form the basis of a judgment of rejection.

"The appeal is dismissed." (*Commissioners' Decisions, March*, 1870.)

215. ADVERSE DECISIONS ONLY REVISED.—The examiners-in-chief will consider the case as it was when last passed upon by the primary examiner, merely revising his decisions so far as they were adverse to the applicant. (*Patent Office Rules, July*, 1870.)

In the case of *Rockwell ex parte* (motion) the Commissioner says:

"In this case, which has been rejected by the board of examiners-in-chief, on appeal from the primary examiner, the applicant asks that the case may be remanded to the board, with instructions to reconsider their action.

"The grounds upon which this motion is based, as stated by the attorneys for applicant, are, 1. 'That the action was not made according to law; and, 2. That an entire misapprehension existed in respect to the two articles. The examiner gave a reference which he considered to be an equivalent for our client's invention, thereby affirming its patentability, but denying its novelty. The board, on the other hand, refuse the patent on the ground that the improvement lacked "inventive genius," thereby

denying its patentability, which was not in controversy. It by this means reversed the affirmative, and not the adverse decision of the primary examiner, while it thus, of course, contravened the law entirely. (See case *Stephen Hull, Commissioners' Decisions*, 1869, p. 69.) Again, there is evidently a total misunderstanding with regard to the correspondencies which exist between the two devices.'

"The applicant mistakes the meaning of the words 'adverse decision,' as applied to the action of the primary examiner. He seems to suppose that these words are equivalent to 'reason for adverse decision' or 'adverse reason' of the examiner; whereas, in truth, they refer to the conclusion or action of the examiner, and not the reason which he gives for it. The decision of the examiner is, that one or all of the claims of the application are rejected. This is adverse to the applicant, as it denies his right to a patent. He appeals from the fact of rejection, not from the theory upon which it is based. That may be wrong, but the action itself may be right, and the board, seeing that what the examiner has done or decided is right, must necessarily affirm his decision, although they may be of the opinion that he could have given a much better reason for it.

"The appeal in this respect is analogous to the ordinary appeals in equity cases. Nothing is more common than for the court above to affirm the judgment of the court below, upon grounds quite different from those taken by the tribunal of original jurisdiction; sometimes, indeed, the appellate tribunal expressly repudiates the reasons for the decision rendered below, and yet affirms the decision or judgment itself.

"If, therefore, an appeal be taken to the board, it is from the decision, action, judgment, or order of the examiner, and not from his reasoning. The board will look into the case to see if upon the record the decision or action be right, although the reason assigned for it be utterly untenable. If, as in the present case, the application be rejected for want of novelty, and the examiners-in-chief find that the alleged invention does not involve a patentable subject-matter, they may properly affirm the decision of the primary examiuer, which decision was, that a patent could not be granted.

"This rule, however, applies only to questions presented by the record which are appealable to the board, by which I refer to questions arising upon the merits of the application. The examiners-in-chief are not to make examinations for the purpose of procuring new testimony upon which to found new reasons, nor are they to reverse or affirm the decision of the primary examiner upon matters of executive detail. If, for example, the claims be rejected for want of novelty, and the board discover upon examination that no oath has been made, or that the specificatiou is not witnessed, they are not to affirm the decision rejecting the application, especially if they find the merits of the case with applicant. The proper course, in such case, is to refer the case to the examiner, suggesting the informality, in order that it may be corrected before any decision is made upon the merits.

"As to the second ground upon which a reconsideration is asked, to wit, that the examiners-in-chief misapprehended the character of the application, or of the reference; that can only be reached by appeal to the Commissioner. That mode of review is expressly pro-

vided for the correction of any errors, either as to the law or facts, which the examiners-in-chief may make. In order to pass upon this branch of the motion, I must examine the case upon its merits. This I can only do upon an appeal regularly initiated by the payment of the fee prescribed by law.

"The motion is therefore overruled." (*Commissioners' Decisions, September* 21, 1870.)

216. No Rehearing Allowed except upon Order of Commissioner.—Cases which have been heard and decided by the examiners-in-chief will not be reheard by them except upon the order of the Commissioner. (*Patent Office Rules, July*, 1870.)

In the case of *Strain ex parte*, (motion,) Acting Commissioner Duncan says: "This application was rejected a second time by the primary examiner February 25, 1870, and upon appeal duly taken his decision was affirmed by the board of examiners-in-chief March 30.

"Since this decision by the board the case seems to have been reconsidered by both the primary examiner and the examiners-in-chief, numerous affidavits having been filed by applicant bearing upon the alleged novelty and utility of the invention. In these subsequent proceedings the examiner adheres to his former position, reiterating the references before cited, which in his judgment should defeat the application on the score of novelty; while the board in their second decision, rendered July 20, overrule the adverse decision of the examiner, basing their judgment upon 'the affidavits filed since the case was last before them.'

"All the proceedings in this case since the first decision rendered by the board have been irregular and with-

out authority. While it was competent for the applicant to support his argument by affidavits, there was no authority for the examiner to reopen the case for further action, and the subsequent action of the board is in contravention of the rule that 'cases which have been heard and decided by the examiners-in-chief will not be reheard by them, except upon the order of the Commissioner.'

"The later proceedings in this case, therefore, are set aside, and the application remanded to the status which it properly held immediately upon the first rejection by the board." (*Commissioners' Decisions, July* 27, 1870.)

217. AFTER THE DECISION OF THE BOARD, A PRIMARY EXAMINER CANNOT RECONSIDER THE CASE WITHOUT AN ORDER FROM THE COMMISSIONER.—In the case of *Duthie* v. *Casilear* (interference) the Commissioner says: "This is a motion to dissolve an interference. Several reasons are urged by the attorney for the motion, of which only one will be considered.

"It appears that Duthie's patent was twice rejected by the examiner and once by the examiners-in-chief. Subsequently, through oversight or change of opinion, the examiner allowed a patent to Casilear. He afterward took up the application of Duthie, and, without amendment or order from the Commissioner, reconsidered it, and placed it in interference with the patent of Casilear. This course was irregular. After the decision of the board the case was removed from the jurisdiction of the examiner, and he could not reconsider the case without an order from the Commissioner. It is somewhat difficult to see, also, if the inventions interfere, how a patent was granted to Casilear, a subsequent applicant. At all events, the irregularity in the reconsideration of Duthie's

case and in the declaration of interference are such, that the motion to dissolve the interference must prevail. The interference is dissolved." (*Commissioners' Decisions, September* 15, 1870.)

218. CASE MAY BE REMANDED FOR FURTHER EXAMINATION.—When the applicant has appealed, the case is closed before the primary examiner, unless it be regularly remanded, with leave to amend or with directions for further examination. If it be so remanded, the case is reopened below, and cannot return to the appellate tribunal until the applicant has responded to the new examination, either by amendment or fresh appeal.

In the case of *Krake ex parte* the Commissioner says:

"These statements were interpolations of the most dangerous character. The examiner excuses himself for permitting them to remain in the specification, by stating that the board of examiners-in-chief did not order them to be stricken out. But this is no excuse. It was not the duty of the board to strike them out. It is the duty of the examiner to purge the specification, drawings, or model of new matter before examining the claims. His action upon such questions is not 'adverse' to the grant of letters patent, because it is not a final adjudication upon the merits. No appeal, therefore, lies from such action to the board of examiners-in-chief." (See *Decision of Commissioner Holloway, William Cleveland Hicks ex parte*, 9 *Decisions*, p. 323.) * * * "It was the duty of the examiner, therefore, at any stage of the case, to purge this application of the new matter interpolated into the amended specification. It was not the duty of the examiners-in-chief to do this, although it is undoubtedly within their power, at their discretion, to decline to entertain an ap-

peal while the application is imperfect, and to remand it to the examiner, that such imperfections might be cured." (*Commissioners' Decisions*, 1869, p. 100.)

219. DELEGATED DISCRETION EXERCISED BY A PRIMARY EXAMINER CANNOT BE REVIEWED.—In the case of *Mody and Hudson ex parte* the Commissioner says:

"The examiner rejected the claims of appellant upon references. I agree with the board of examiners-in-chief, that the references are not pertinent, and that the combinations claimed are novel.

"The board, however, go on to say: 'But the emergency does not warrant the expense incurred and the inconveniences resulting from its being embodied in the instrument. Even when the tool requires such a correction as is supposed, which will very rarely occur, it would be cheaper to make a new face upon the indicator than to resort to the applicant's apparatus. This is clearly one of those cases in which it is left to the discretion of the Commissioner to determine whether an invention is sufficiently useful and important 'to justify the issue of a patent.' (See § 7, *Act July* 4, 1836.)

"The examiner made no objection to the application because of lack of utility in the invention, but the board, while overruling him upon the issue of novelty, affirms his rejection of the patent upon the ground set up by themselves as above.

"This involved a two-fold error: First, If the question of utility be one of discretion vested in the Commissioner in person, the board of examiners-in-chief cannot exercise discretion for him; but if it be delegated discretion, to be exercised by the primary examiner as the agent of the Commissioner, then the exercise of it cannot be re-

viewed upon appeal. It is familiar law, that no appeal or writ of error will lie to set aside an act or reverse a decision, the making of which the law has confided to the discretion of the lower court. Second, The objection to the application, that the invention, though new and useful, is costly, and likely to be more costly than useful, is not one which the Patent Office should raise or maintain. It may well be left to the public, who buy the best and cheapest. This subject was fully discussed in *Cheeseborough ex parte*, (*Commissioners' Decisions*, *May* 1869, p. 11,) and the reasoning of that decision covers the present case.

"The decision of the board of examiners-in-chief is reversed." (*Commissioners' Decisions*, 1869, p. 108.)

220. THE COMMISSIONER MAY WITHHOLD A PATENT, ALTHOUGH THE EXAMINERS-IN-CHIEF HAVE DECIDED THAT IT OUGHT TO ISSUE.—In the case of *Stephen Hull ex parte* the Commissioner says:

"The examiner refused to grant a patent upon the ground that the application had been abandoned and the invention had gone into public use.

"Applicant appealed to the board of examiners-in-chief June 1, 1869, and on August 28, 1869, the board, by two of its members, rendered a decision reversing that of the primary examiner.

"On June 9, 1869, two months and a half before the decision of the board was made, the Commissioner decided, in the case of *John W. Cochran*, involving facts almost identical with those in applicant's case, that a patent ought not to issue. This decision *affirmed* a previous decision of the board of examiners-in-chief.

"It does not appear, from the decision of the board in

the present case, that the opinion of the Commissioner in Cochran's case was considered or was before them; but it does appear that, whether with or without examining that decision, they have in effect decided that a patent ought to issue in a class of cases in which the Commissioner and themselves had already decided that it ought not to issue.

"If the decision, while departing from the rule laid down by the Commissioner, had been adverse to applicant, he would, no doubt, have sought the Commissioner by appeal, to demand that the action of the board, in neglecting to conform to that of the Commissioner, be reversed. As, however, the decision is in his favor, he demands his patent, and insists that the board of examiners-in-chief 'are to settle for the examiners what is the law in patent cases,' even to the extent of ignoring the decisions of the Commissioner. * * * As the head of the office, responsible for its management and for the acts of his subordinates, charged by law with the execution of all acts and things touching the granting and issuing of letters patent, it is his right, it is his duty, when he has reason to believe that, by the action of any of his subordinates, a patent is about to issue which ought not to be granted, to arrest such issue, and to take such steps as in his judgment may be necessary to correct the error and secure the public from imposition. To say that any examiner, or board of examiners, refusing to be guided by his decisions or to obey his rules, might issue patents broadcast to those who were not entitled to them, and that, because there is no appeal as against the lucky applicant, the Commissioner is by law made powerless to avert the evil—nay, more, must himself sign the patents

which he knows ought not to issue—is to force upon this act a construction which is, in my opinion, the very reverse of that intended by the legislature.

"I have examined the remarks of Judge Dunlop in *Snowden* v. *Pierce*. Although expressing some views adverse to the opinion I have here maintained, this point was not, as it could not be, before him. What he says is simply *obiter dictum*, provoked apparently by the argument of counsel. The question, if there be one, is of an executive rather than a judicial character, and is for the Attorney General rather than for the courts.

"In the absence of other light upon this subject than that afforded me by the statute and the practice of the office, I have no hesitation in holding, that I have the power to withhold a patent at any stage of its progress, whenever facts arise which in my judgment constitute a bar to its issue. This is the view taken by Commissioner Foote, my immediate predecessor. In his annual report for 1868 he says: 'I have endeavored to provide some means for reviewing, briefly, favorable decisions before patents were issued upon them, but found that the force of the office was inadequate to such work in addition to the performance of other indispensable duties.'

"In this case I have suspended the issue of a patent to Stephen Hull, and have remanded the case to the board of examiners-in-chief for re-examination, in the light of the decision of the Commissioner in the cases of John W. Cochran and John W. Orr." (*Commissioners' Decisions*, 1869, p. 68.)

221. PETITION TO SET FORTH REASONS OF APPEAL.—A petition in writing must be filed, signed by the party or

his authorized agent or attorney, praying an appeal and setting forth briefly and distinctly the reasons upon which the appeal is taken. (*Patent Office Rules, July*, 1870.)

222. FORM OF APPEAL FROM THE EXAMINER TO THE EXAMINERS-IN-CHIEF.—

To the Commissioner of Patents.

SIR: I hereby appeal to the examiners-in-chief from the decision of the principal examiner, in the matter of my application for letters patent for an improvement in wagon brakes, which, on the 20th day of July, 1869, was rejected the second time. The following are assigned for reasons of appeal: [*Here follow reasons.*] LEMUEL LOOKUP.

223. FORM OF APPEAL FROM THE EXAMINER IN CHARGE OF INTERFERENCES TO THE EXAMINERS-IN-CHIEF.—

To the Commissioner of Patents.

SIR: I hereby appeal to the examiners-in-chief from the decision of the principal examiner in charge, in the matter of the interference between my application for letters patent for improvement in sewing machines and the letters patent of Elias Coleman, in which priority of invention was awarded to said Coleman. The following are assigned for reasons for appeal: [*Here follow reasons.*] WILLIAM SYPHAX.

XIII. Appeal to the Commissioner in Person.

SEC.		SEC.	
224.	Appeal from examiners-in-chief.	230.	Decisions upon questions of fact.
225.	Commissioner will not review the action of his predecessor.	231.	Case may be remanded to examiner.
226.	Time of hearing.	232.	Appeal from primary examiner.
227.	Motions.	233.	Form of appeal.
228.	Limit of oral arguments.		
229.	New assignment.		

224. APPEAL FROM THE EXAMINERS-IN-CHIEF.—If the applicant is dissatisfied with the decisions of the examiners-in-chief he may, on payment of the duty required

by law, appeal to the Commissioner in person. (*Act of July* 8, 1870, § 46.) All cases which have been acted on by the board of examiners-in-chief may be brought before the Commissioner in person, upon a written request to that effect, and upon the payment of the fee of twenty dollars required by law. (*Patent Office Rules, July*, 1870.)

225. A CASE DELIBERATELY DECIDED BY ONE COMMISSIONER WILL NOT BE DISTURBED BY HIS SUCCESSOR.—The only remaining remedy will be by appeal, in those cases allowed by law, to the supreme court of the District of Columbia sitting in banc. (*Ib.*) The Commissioner will not review the action of his predecessor, or of the appellate judge in the same case. (*J. W. Orr ex parte, Commissioners' Decisions*, 1869, p. 33.)

226. TIME OF HEARING.—All cases pending before the Commissioner will stand for argument at one o'clock on the day of hearing. If either party in a contested case, or the appellant in an *ex parte* case, appear at that time, he will be heard. (*Patent Office Rules, July*, 1870.)

227. MOTIONS.—Reasonable notice of all motions, and copies of the motion papers and affidavits, must be served upon the opposite party or his attorney; and in contested cases no motions will be heard in the absence of the other party, except upon default after due notice; nor will a case be taken up for oral argument after the day of hearing, except by consent of both parties. (*Ib.*)

228. LIMITATION OF ORAL ARGUMENTS.—Unless otherwise ordered before the hearing begins, oral arguments will be limited to one hour for each counsel. (*Ib.*)

229. NEW ASSIGNMENT.—If the engagements of the tribunal before whom the case is pending are such as to prevent it from being taken up on the day of hearing, a

new assignment will be made, or the case will be continued from day to day until heard. (*Ib.*)

230. DECISIONS TURNING UPON QUESTIONS OF FACT WILL NOT BE REVERSED UNLESS RENDERED WITHOUT OR AGAINST EVIDENCE.—The appeal to the board of examiners, and to the Commissioner and judge, was given to determine disputed points of law, rather than to review mere questions of fact. Upon such questions the examiner is as likely to be right as the Commissioner. It is familiar law, that the verdict of a jury, or the finding of a judge upon submission, upon facts, will not be disturbed by the appellate tribunal, except in cases where the verdict or judgment is manifestly without evidence, or beyond a reasonable doubt against evidence. The mere fact that the appellate judge feels that if the question had been originally tried before him he would have come to a different conclusion from the lower tribunal, (no question of law being involved,) will not justify him in disturbing the judgment of that tribunal, where there was any evidence to sustain it. (*Fawcett* v. *Graham*, *Commissioners' Decisions*, 1869, p. 113.)

In the case of *Blanchard* v. *Strain*, the Commissioner says:

"The testimony is very voluminous, covering some three hundred and seventy-five pages of manuscript. The examiner in charge of interferences and the examiners-in-chief have both decided in favor of Strain. The question involved is purely one of fact, depending upon the credibility of contradicting witnesses.

"I cannot believe it was ever intended that in a case like this, where no legal question is involved, the parties should be able, by appeal, to compel four tribunals to

read over a great mass of testimony, with a view of pronouncing independent judgments upon the evidence, without reference to the opinions of those who had already considered it. If this is not true the examiner and examiners-in-chief have both found the weight of evidence with Strain is to have no weight with me—if I am to throw it aside and examine the case as if they had never looked at it—it is obvious that the two trials before them might as well have been dispensed with, and that all such cases might as well be tried before the Commissioner or appellate judge in the first instance.

"The duty of the Commissioner in this class of cases is, in my opinion, fully discharged when he has so far examined the case as to find that the question involved is purely one of fact, and that the decision of the board upon the facts is not without evidence, or against the manifest weight of evidence. (See *Fawcett* v. *Graham*, *Commissioners' Decisions* 1869, p. 118.) The verdict upon the facts of four persons skilled in such examinations ought to be as persuasive with the Commissioner as the verdict of a jury with the judge upon a motion for a new trial." (*Commissioners' Decisions*, *June* 6, 1870.)

In the case of *White* v. *Purdy*, the Commissioner says:

"Upon a state of facts substantially similar, I held, in *Fawcett* v. *Graham*, (*Commissioners' Decisions*, 1869, p. 118,) *Blanchard* v. *Strain*, (*ib.*, *June*, 1870, p. 26,) and *Jeffers* v. *Duchamin*, (*ib.*, *September*, 1870,) that where a case in interference turns wholly upon a question of fact, and the evidence is conflicting, and both of the tribunals below have decided the same way, the Commissioner will not reverse the former decisions, unless they have

been rendered without evidence, or against the manifest weight of the evidence.

"As the correctness of this ruling has been challenged by the appellant in the present case, it may be well to state more fully the reason and authority by which it is supported.

"The appellant seems to suppose that the fact that an appeal is allowed to the Commissioner necessarily requires that officer to disregard the findings below; that he should treat them as if they had never been made, and should take up the case and examine it as a case of first impression, giving precisely the same decision as he would have done if he had heard it originally, instead of the examiner of interferences.

"This view cannot be admitted to be sound. The appeal is from the decision of the examiner or examiners-in-chief, and it can hardly have been intended that the Commissioner should ignore the fact that there had been any decision whatever. On the contrary, it would seem manifest that the fact that a decision had been rendered, from which an appeal had been taken, must exercise such an influence in a case of doubt, or where testimony was nicely balanced, as to determine the appellate tribunal to follow and sustain the decision rather than to overturn it. For, in such a case, a mind in doubt might well suffer those doubts to be resolved in the direction in which another mind, competent to judge, had already reached and announced a decision.

"Any other view would render the trials before the examiner and examiners-in-chief worse than useless. Cases might as well be tried in the first instance by the Commissioner, and the delay and expense of the former:

hearings be saved, if the decisions upon such hearings are to be treated precisely as though they had never been rendered.

"The position of the party before the Commissioner on appeal is not different from that of one who seeks to set aside the verdict of a jury or the finding of a judge upon a question of fact, or who appeals in admiralty or equity cases from the court below to a circuit or supreme court. In cases like these we are not without the light of authority. This will appear from the following cases:

"'A mere difference of opinion between the court and jury does not warrant the former in setting aside the finding of the latter; that would be, in effect, to abolish the institution of juries, and substitute the court to try all questions of fact. It must be clear that the jury has erred before a new trial will be granted, on the ground that the verdict is against the weight of evidence or unsupported by it; and if this is the rule, as it undoubtedly is, even in the court where a cause is tried, and before whom the witnesses appeared and testified, *a fortiori* ought it to be the rule when another court decides the motion for a new trial, with no other knowledge of the facts than is derived through the imperfect medium of a written statement.' (*McGatrick* v. *Wason*, 4 *Ohio St. R.*, 556.)

"'The findings of a court, when substituted for a jury, are entitled to the same consideration as the verdict of the latter; and it is well settled that a verdict will not be set aside upon the ground of an erroneous finding, unless it is clear that such is the case.' (*Merrick* v. *Boury*, 4 *Ohio St. R.*, 60.)

"'A decree, like a verdict, will not be set aside on the ground of an erroneous finding, unless it is clearly against

the weight of the evidence or clearly unsupported by it. Where there is no evidence at all to support a decree, it will be reversed for that reason.' (*Medina County Mutual Fire Insurance Company* v. *Bollmeyer*, 4 *Ohio St. R.*, 107.)

"In the case of *The Grafton*, (1 *Blatchf.*, 177,) Nelson, J., said: 'The case involves two questions of fact.' * * * 'Both questions strike me as being exceedingly close upon the evidence, and are so nearly balanced that it would be wrong for an appellate court to interfere. According to the impression which the examination of the proofs has left upon my mind, I should not feel justified in disturbing the conclusions of the court below, whether for or against the appellant in respect to either question, as I think different minds might very well arrive at different conclusions. To warrant a reversal upon a mere question of fact, the preponderance of the evidence should be of a somewhat decided character, such as would justify the granting of a new trial in a court of common law, on the ground that the verdict was against the weight of evidence. It seems to me that this principle should govern this court in reviewing a question of fact determined by the district court.'

"In the case of *The Ship Marcellus* (1 *Black*, 414) the Supreme Court say: 'The only question proposed by these pleadings is one of fact. In this, as in all other cases of the kind, there is great discrepancy and conflict in the testimony of the witnesses as to every averment in the pleadings. We have had occasion to remark more than once, that when both courts below have concurred in the decision of questions of fact, under such circumstances parties ought not to expect this court to reverse such a decree, merely by raising a doubt founded on the

number or credibility of witnesses. The appellant in such case has all presumptions against him, and the burden of proof cast on him to prove affirmatively some mistake made by the judge below in the law or in the evidence. It will not do to show that on one theory, supported by some witnesses, a different decree might have been rendered, provided there be sufficient evidence to be found on the record to establish the one that was rendered.' (See also *Walsh* v. *Rogers*, 13 *How.*, 284; *The Water Witch*, *ib.*, 494; *The Narragansett*, 1 *Blatchf.*, 211; *Cushman* v. *Ryan*, 1 *Story*, 95; and *The Grace Girdler*, 7 *Wall.*, 204.)

"These cases cover the findings of judges and the verdicts of juries upon questions of fact in cases at law, as well as the findings of fact in causes in equity and admiralty jurisdiction. They fully establish the principle announced in *Fawcett* v. *Graham* and *Blanchard* v. *Strain*." (*Commissioners' Decisions*, 1869, p. 52.)

231. CASE MAY BE REMANDED FOR FURTHER INVESTIGATION OR AMENDMENT TO EXAMINER.—Where amendments are admitted while an appeal to the Commissioner is pending, the case should be again submitted to the examiner for investigation. (*Perry* v. *Lay*, *ib.*, 1869, p. 3.)

In the case of *Townsend ex parte* the Commissioner says: "This case is remanded to the primary examiner, at his request, for the purpose of giving further references to the applicant." (*Ib.*, *September* 14, 1870.) And in the case of *Cree ex parte* the Acting Commissioner says: "So far, then, as the references go, it must be judged that applicant is entitled to a patent upon his peculiar bale. The present claim, however, is objectionable. There is no relation between this special construction of bale and the adjustable clasp around the neck of

the bottle. The function of the two are entirely distinct, and they cannot properly be claimed in combination. For this reason the decision of the examiners-in-chief is affirmed, but with leave to applicant to amend his claim and specification before the primary examiner. (*Ib.*, *August* 3, 1870.) In the case of *Alice Appleton ex parte* the Commissioner says: "As the case now stands, I understand the examiner to affirm that the mode already in use of connecting knit-goods in common household practice is by a crochet-stitch, substantially the same as that of the applicant. This applicant does not deny upon the record; and as no means of comparison are furnished, the statement of the examiner must be accepted as true. The decision of the board of examiners-in-chief is affirmed, with leave to the applicant to move to remand the case to offer opportunity for amendment." (*Ib.*, 1869, p. 8.)

232. APPEAL FROM PRIMARY EXAMINERS TO THE COMMISSIONER.—Decisions of examiners upon preliminary or intermediate questions, or refusals to act, twice repeated, will be re-examined, upon application, by the Commissioner in person. (*Patent Office Rules*, *July*, 1870.)

In the case of *Wilkinson ex parte* the Commissioner says: "This application was rejected by the examiner, because, in his opinion, the device was 'essentially deficient in patentable invention.' Thereupon the applicant demanded a reference or a patent. The examiner gave no reference, and refused a patent. Applicant reiterates his demand for a reference, and appeals to the Commissioner in person.

"He has mistaken both his rights and his remedy. Rule 37 provides, that 'upon a rejection of an application

for want of novelty, the applicant will be furnished with a specific reference,' &c. The present application is not rejected 'for want of novelty,' but for want of 'patentable invention.' This objection may concede that the thing is new, but deny that invention was involved in its production. No reference is required, either by rule or by law, to establish this ground of rejection. But if it were so, the remedy is by appeal to the board of examiners-in-chief, and not the Commissioner in person. This is not a decision upon an intermediate question, or upon a refusal to act. The examiner's decision goes to the merits of the application, and is adverse to the applicant. If the examiner gives a general reference, and the applicant is entitled to a specific reference, and demands it, the remedy is by appeal to the board, who would then hold the general reference to be no reference, or an insufficient one, and reverse the decision of the examiner in rejecting the application. The case does not differ in principle from one in which a specific reference is given, which the applicant claims to be insufficient to form the basis of a judgment of rejection. (*Commissioners' Decisions, March* 8, 1870.)

"The determination of the question of title, the number of amendments, the structure of the specification, the correspondence of the drawings with the model or the written description, and the accuracy and completeness of the description, are executive acts, although discretion is exercised in their performance; but the judgment of the examiner upon what may be called the merits, the questions of patentability and of novelty, are judicial acts. From the judicial acts of the examiner, an appeal lies to the board; from his executive acts, the

appeal is to the Commissioner." (*Krake ex parte*, *Commissioners' Decisions*, 1869, p. 100.)

Thus, in the case of *Collins ex parte*, the Commissioner says:

"This is an appeal from the primary examiner. Applicant claims an 'improvement in screens or beds for receiving and securing the spawn of fish, in the art of pisciculture, whereby the process is greatly simplified and the labor diminished, and it consists in the use of a revolving screen, arranged and operating as described.'

"He describes the apparatus in detail. It consists of a box placed in the race-way of a fish-pond, provided with an upper screen of wire-cloth covered with gravel, on which the fish lay their spawn. Below this is a second screen of finer material, forming an endless apron, which receives the spawn from the upper screen and conveys it to a box below, where it is secured for use.

"This is all very plain and intelligible. The apparatus is well described by reference to the drawings and by well-chosen terms, and no one could have the slightest difficulty in constructing it and putting it in position for operation.

"The examiner, however, declines to examine the case upon its merits, but requires the applicant 'to be more specific in his description as to the manner of the deposition of the spawn, and how it passes through the gravel-bed, and what is its condition when it enters the chamber below, where and how the water enters the tank, when and where impregnation takes place, and where the embryo is developed.

"The examiner misconceives the nature of the invention. It is not an improvement in the process of pisci-

culture, but in spawning-screens. It is a mechanical device, performing mechanical functions. It is a mere instrument, to be employed by those skilled in the art, and its nature and functions are described in terms addressed to them. It cannot be necessary to accompany such description with a treatise on fish culture; and if the applicant had embodied such a dissertation in his specification, he would be justly obnoxious to the charge of 'unnecessary prolixity,' which is condemned in terms by the statute.

"The decision of the examiner is reversed, and the case will be examined on its merits." (*Ib.*, *June* 8, 1870.)

And in the case of *Blanchard ex parte* the Commissioner says:

"This is an appeal from the decision of the primary examiner.

"The applicant claims, 'as an improved article of manufacture, a mold-board for ridging plows, having the concavity G, for turning a furrow, a circular recess, g', and an adjustable circular plate, H, attached thereto, all as and for the purpose described.'

"This claim was rejected by the examiner, because the claim was for an 'article of manufacture,' while the invention was, according to the description, only 'a portion of a machine.'

"The applicant seems to suppose the examiner to have denied that a part of a machine was patentable. If this were so, it would unquestionably be an error. But the examiner means to affirm no more than that a fraction of a machine cannot be claimed as 'an article of manufacture.'

"By the true construction of the word 'manu[illegible]'

as used in the patent act, it fairly covers only such manufactured articles or products as are complete in themselves, or, if parts of a whole, are so far complete as to be the subject of separate manufacture and sale. Thus a lamp chimney is intended to be used with a lamp and not otherwise, nevertheless it may properly be made, sold, and patented as a new manufacture.

"In this case applicant admits that 'this mold-board is adapted and applicable only to this single kind of plow. It is, in other words, a mere fraction of a machine. If a material part, it may be claimed as such, but it is not in any proper sense an article of manufacture.

"The decision of the primary examiner is affirmed." (*Ib., June* 13, 1870.)

233. Form of Appeal from the Examiners-in-Chief to the Commissioner.—

To the Commissioner of Patents.

Sir: We hereby appeal to the Commissioner in person from the decision of the examiners-in-chief in the matter of our application for the reissue of letters patent for an improvement in cotton presses granted to Anthony Bowen, May 18, 1865. The following are assigned for reasons of appeal:

[*Here follow reasons.*]

William Martin.
Claudius Jenkins.

XIV. Appeal to the Supreme Court of the District of Columbia.

Sec.		Sec.	
234.	Appeal to court sitting in banc.	239.	Forms furnished by the office.
235.	Appellant to notify Commissioner.	240.	Appellant to furnish certified copies.
236.	Papers accompanying notice.	241.	Duties of Commissioner.
237.	Time of filing reasons of appeal.	242.	Insufficiency of Commissioner's reasons.
238.	Reasons of appeal should not be vague and unsatisfactory.		

SEC.
243. Commissioner and examiners may be examined.
244. Duty of the court.
245. Revision confined to reasons of appeal.
246. Appeal tried upon evidence before Commissioner.
247. Decision to govern further proceedings.
248. Validity of patent may be contested.
249. Rules of the court.
250. Cases in which an appeal does not lie.
SEC.
251. Court cannot order patent to issue or consider amendments which have not been examined.
252. Decision binding only upon questions submitted.
253. Decisions followed as precedents.
254. Form of petition to the court.
255. Form of certificate of Commissioner.
256. Form of notice and reasons of appeal.

234. APPEAL TO THE COURT SITTING IN BANC.—If a 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. (*Act of July* 8, 1870, § 48.)

235. APPELLANT TO NOTIFY COMMISSIONER.—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. (*Ib.*, § 49.)

236. PAPERS ACCOMPANYING NOTICE.—The mode of appeal from the decision of the office to the supreme court of the District of Columbia is by giving written notice thereof to the Commissioner; said notice being accompanied by the petition, addressed to the supreme court of the District of Columbia, by the reasons of appeal, and by a certified copy of all the original papers and evidence in the case. (*Patent Office Rules, July*, 1870.)

237. TIME OF FILING REASONS OF APPEAL.—The reasons of appeal must be filed within thirty days after notice of the decision appealed from. (*Ib.*)

The filing of the "reasons of appeal" is essentially the appeal itself. (*Greenough* v. *Clark, MS. Appeal Cases, D. C.*, 1858.) And where the reasons of appeal are not filed within the time prescribed by the Commissioner of Patents, the right of appeal is lost. (*Ib.*) For an appeal cannot be made after the time limited in the notice of appeal. (*Linton ex parte, ib.*, § 1850.) The Commissioner may, however, enlarge the time to file such reasons. (*Greenough* v. *Clark, ib.*, 1858.) He may extend the time of appeal; it is a matter within his discretion. (*Justice* v. *Jones, ib.*, 1859.)

238. REASONS OF APPEAL SHOULD NOT BE VAGUE AND UNSATISFACTORY.—The reasons of appeal should be so expressed that the court may gather from their language what is meant by them, but they need not be according to any technical formula. (*Laidly* v. *James, MS. Appeal Cases, D. C.*, 1860.) They should not be vague and unsatisfactory, but should involve some point affecting the decision of the Commissioner. (*Winslow ex parte, ib.*, 1850.) And no assignment is sufficiently specific which does not with reasonable certainty point out the precise matter of alleged error. (*Douglass* v. *Blackington, ib.*, 1859.) Thus, the following alleged reasons of appeal have been held to be insufficient: "That the decision of the Commissioner was inconsistent, as opposed to precedents which have governed before;" (*Winslow ex parte, ib.*, 1850;) "that the decision of the Commissioner was in opposition to a clear apprehension of the merits of the case," (*ib.*;) or, "is against evidence or the weight

of evidence;" (*Douglass* v. *Blackington*, *ib.*, 1859;) "that the reasons assigned by the Commissioner for rejecting an application are irrelevant, and do not apply to the subject-matter." (*Aiken ex parte*, *ib.*, 1850.)

A reason of appeal, "that there was no evidence of any device or arrangement like that of the applicant," was held by Cranch, C. J., to be no ground for reversing the decision of the Commissioner, as he might have had other grounds than the evidence offered for the rejection. (*Crooker ex parte*, *ib.*, 1850.) And when the reason of appeal was "that the decision of the Commissioner was adverse to the opinions of skillful and competent practical and scientific men, who were peculiarly qualified to judge as to the merits of the particular invention," it was held that this reason did not involve the question of novelty, and the opinion of such experts could not affect the question of novelty. (*Winslow ex parte*, *ib.*)

An objection to the *opinion* of the Commissioner, as to the intention of an invention, cited as a cause of rejection, is not a good "reason of appeal." Whatever may have been his opinion, his decision may be correct. (*Crooker ex parte*, *ib.*, 1850.)

239. FORMS FURNISHED BY THE OFFICE.—Printed forms of notice of appeal, of the reasons of appeal, and of the petition will be forwarded on request. (*Patent Office Rules*, *July*, 1870.)

240. APPELLANT TO FURNISH CERTIFIED COPIES.—The party appealing shall lay before the court certified copies of all the original papers and evidence in the case. (*Act of July* 8, 1870, § 51.) The original files in the case cannot be taken from the office to the court, but certified

copies of the record and references, to be used as evidence, will be furnished at the usual rates. (*Patent Office Rules, July*, 1870.)

241. DUTIES OF COMMISSIONER.—On receiving notice of the time and place of hearing such appeal, the Commissioner shall notify all parties who appear to be interested therein, in such manner as the court may prescribe. (*Act of July* 8, 1870, § 51.) And the Commissioner shall furnish it with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal.

242. REASONS OF COMMISSIONER MAY BE INSUFFICIENT, YET HIS DECISION CORRECT.—And the insufficiency of the Commissioner's reasons for rejecting an application is not in itself evidence that his decision is wrong, and is no cause for reversing it. (*Aiken ex parte, Commissioners' Decisions*, 1858.)

And it is immaterial what reasons the Commissioner assigns for his decision; his reasons may be insufficient, and yet his decision be correct. (*Ib.*)

The court is only required to examine the *conclusions* which the Commissioner may have arrived at in any given case, and not the process or reasons by which such conclusions may have been attained. (*Spencer ex parte, Ib.*)

243. COMMISSIONER AND EXAMINERS MAY BE EXAMINED.—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 machine or other thing for which a patent is demanded. (*Ib.*)

An examiner may be inquired of as to the nature and

features of the invention under consideration and essential to the right claimed, and which may not be sufficiently set forth in the report of the Commissioner. (*Seely ex parte, ib.*, 1853.)

The officer of the Patent Office who may attend before the judge on an appeal is not considered as counsel for the Patent Office, or as an advocate of either of the parties litigant. He only attends for the purpose of explaining the decision of the Commissioner. (*Perry* v. *Cornell, ib.*, 1847.)

The language of the statute means, that the explanation authorized to be required of the Commissioner and examiners may be so full and clear an explanation of the principles of the thing, as to enable the judge duly to apply and weigh the evidence offered to support the issue in the case, and is not to be limited to a mere exposition of the terms used; and such explanations so given the judge is bound to respect as a part of the case. (*Richardson* v. *Hicks, ib.*, 1854.)

244. DUTY OF THE COURT.—It shall be the duty of said court, on petition, to hear and determine such appeal, and to 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, notifying the Commissioner of the time and place of hearing; and the revision shall be confined to the points set forth in the reasons of appeal. (*Act of July* 8, 1870, § 50.)

245. REVISION CONFINED TO POINTS SET FORTH IN REASONS OF APPEAL.—The jurisdiction of the court on appeal is confined to the reasons of appeal. (*Arnold* v. *Bishop, MS. Appeal Cases, D. C.*, 1841, *ib.*, § 50; *Smith* v. *Flick-*

inger, ib., 1843; *Cochrane* v. *Waterman, ib.*, 1844; *Aiken ex parte, ib.*, 1850.) And however worthy of consideration a proposition or argument may be, if not within such reasons, it must be disregarded. (*Burlew* v. *O'Neil, ib.*, 1853.) The court can revise the decision of the Commissioner only in respect to points involved in the reasons of appeal; and if the Commissioner did not err in those points, his decision must be affirmed, even though the judge should be of the opinion, upon the evidence and merits of the whole case, that such decision was wrong. *Arnold* v. *Bishop, ib.*, 1841.) The powers and jurisdiction given to it on appeal are special and limited, and must be construed and exercised strictly. (*Pomeroy* v. *Connison, ib.*, 1842.) The court can only decide such questions and render such judgment as it is expressly authorized by the statutes to decide and render. (*Ib.*) It is not at liberty to look into every error of fact or law which may have been committed in the case, but only to such as have been specifically pointed out by the reasons of appeal. (*Laidly* v. *James, ib.*, 1860.)

246. APPEAL TRIED UPON EVIDENCE BEFORE COMMISSIONER.—The appeal will be tried upon evidence which was in the case and produced before the Commissioner. (*Act of July* 8, 1870, § 50; *Rules of Supreme Court, D. C.*, p. 94.) And the question must be decided according to such evidence. (*Warner* v. *Goodyear, MS. Appeal Cases, D. C.*, 1846; *Perry* v. *Cornell, ib.*, 1847.) The court is limited by law to the papers and evidence which were before the Commissioner. (*Saunders ex parte, ib.*, 1861.) And whether his decision is correct or erroneous must depend upon the evidence and proofs before him. (*Ruggles* v. *Young, ib.*, 1853.)

The court on appeal has no power to send the case back to the Patent Office, to take proofs by competent experts as to the alleged utility of the invention, or to hear such proofs on appeal. (*Saunders ex parte, ib.*, 1861.) But where a party has been prevented from producing before the Commissioner proofs to support his claim, it is the duty of the court to pursue such a course as will afford the party an opportunity to produce such proofs, and the court will make an order authorizing the party to take and file with his appeal evidence as to the originality and utility of his invention. (*Fultz ex parte, ib.*, 1853.)

Affidavits cannot be considered on appeal which were not acted on by the Commissioner in forming his decision nor taken by his authority. (*Jackson ex parte, ib.*, 1856.) And an objection not taken at the hearing before the Commissioner cannot be made on appeal to the court. (*Smith* v. *Flickenger, ib.*, 1843.) But if new references are made at the trial of an appeal before the court, as grounds for the rejection of an application for a patent, and are such as are material, they will be considered as having deprived the applicant of his right of amendment, and in such case the decision of the Commissioner will be reversed, and he will be directed to proceed with the case anew. (*Root ex parte, ib.*, 1853.)

247. DECISION TO GOVERN FURTHER PROCEEDINGS 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 govern the further proceedings in the case. (*Act of July 8, 1870, § 50.*)

248. VALIDITY OF PATENT MAY BE AFTERWARDS CONTESTED.—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. (*Ib.*)

249. RULES OF THE SUPREME COURT IN APPEALS FROM THE COMMISSIONER OF PATENTS.—First. All appeals taken from the decisions of the Commissioner of Patents to the supreme court of the District of Columbia shall be entered in a docket to be kept for that purpose by the clerk of the court; and every rule, motion, or order made in every pending appeal, and the final decision made in each case, shall be recorded in the minutes of the court, to be kept by the clerk for the purpose.

Second. The party desiring to appeal from the decision of the Commissioner of Patents must give written notice thereof to the Commissioner, accompanied with his petition to the supreme court of the District of Columbia to grant him a hearing, and file the reasons of appeal.

Third. The appellant, previous to any action on and preparatory to the hearing of any appeal, must comply with the requisites of the law in the Patent Office, and his petition must state concisely, 1. The application for the patent; 2. Its nature; 3. The Commissioner's refusal; 4. The prayer of appeal; 5. Notice thereof to the Commissioner; 6. The filing of the reasons of appeal in the Patent Office.

To every petition must be annexed a certificate of the proper officer that the requisitions of the law have been complied with, or an affidavit of the truth of the facts stated in the petition.

No notice to the Commissioner will be issued until such certificate or affidavit be made or produced.

The appeal will be tried upon the evidence which was in the case and produced before the Commissioner.

Fourth. The appellant must file his argument in writing, within five days after the Commissioner shall send in his report, and the papers, models, and drawings or specimens, or within five days after the day of hearing, which argument must state the facts and law relied on, together with the authorities in support of the same.

Fifth. At the hearing oral arguments may be made, not to occupy more than one hour for each counsel engaged, and not more than two counsel in each case will in any case be heard.

Sixth. In no case will arguments before the court be heard, except made by the party in interest in person, a member of the bar of this court, the superior or supreme court of a State, Territory, or District of the United States, or a duly licensed solicitor of patents, in good standing before the Patent Office, and admitted to practice before this court as the appellate tribunal from the decisions of the Commissioner of Patents.

Seventh. The court, having fully heard the appeal, shall return to the Commissioner a certificate of its proceedings and decisions, which shall be entered of record in the Patent Office, and such decisions, so certified, shall govern the further proceedings of the Commissioner in such case.

250. CASES IN WHICH AN APPEAL DOES NOT LIE.—Nothing preliminary to the issuing of a patent, unless made so by the law authorizing appeals, is a valid ground of appeal. (*Wade* v. *Mathews, MS. Appeal Cases, D. C.*, 1850.) No appeal lies from matter within the discretion of the Commissioner, as extending time to take testimony, &c.,

(*Hopkins* v. *Lewis*, *ib.*, 1859,) or the refusal of the Commissioner to grant a rehearing. (*Rouse ex parte*, *ib.*, 1854.) And questions as to the practicability or usefulness of an invention and the reducing of it to practice are matters within the discretion of the Commissioner, and are not made the subjects of appeal. (*Wade* v. *Mathews*, *ib.*, 1850.) And where the decision of the Commissioner neither affirms nor denies the right of an applicant to the patent, (which he claims,) upon the merits of the supposed invention, it is not such a decision as is the subject of appeal. The refusal, therefore, of the Commissioner to revise and revoke a decision of one of his predecessors in office rejecting an application for a patent, is not a ground of appeal. (*Janney ex parte*, *ib.*, 1847.)

The law requires the Commissioner to aid the inventor, by information and suitable references, to remedy a defective specification or claim, and to assist his judgment in determining whether he should withdraw or persist in a rejected application. (*Vide supra*, p. 17.) But the manner of doing so, how often, and to what extent, is left to the discretion of the Commissioner; and it is not the subject of review whether this duty is well and sufficiently performed in a certain instance. (*Chambers ex parte*, *MS. Appeal Cases*, 1859.) And it is not proper matter for the appellate tribunal that the Commissioner has not given a party such reasons for his decision, and made such suggestions as to enable him to judge of the expediency of abandoning or modifying his application. (*Spencer ex parte*, *ib.*, 1859.)

251. THE SUPREME COURT HAS NO AUTHORITY TO ORDER A PATENT TO ISSUE, OR TO DECLARE AN AMENDED SPECIFICATION ENTITLED TO A PATENT, WHICH HAS NEVER BEEN

RECEIVED OR EXAMINED AT THE OFFICE.—In the case of *Whiteley and Gage ex parte, motion,* (*Commissioners' Decisions,* 1869, p. 53,) the Commissioner says: "William Gage obtained letters patent September 16, 1856, for improvement in harvesters, which were assigned to himself and Andrew Whiteley, who on February 18, 1865, applied for permission to surrender the same, and for a reissue thereof in four divisions, designated as A, B, C, and D, respectively.

"The applications, after much correspondence and varibus amendments, were finally rejected by the examiner, from whose decision an appeal was taken to the board of examiners-in-chief. The board affirmed the decision of the primary examiner, and their decision, in turn, was affirmed, on appeal, by the Commissioner.

"An appeal was taken from the decision of the Commissioner to Justice Wylie, one of the judges of the supreme court of the District of Columbia, who at first reversed the decision of the Commissioner, but subsequently reopened the case, reheard it, and affirmed the Commissioner's decision. The opinion of Justice Wylie was delivered May 22, 1866.

"On May 30, 1866, applicants presented another amendment, which the office refused to receive, upon the ground that the decision of the judge was final, and that the case was no longer open for amendment.

"From this decision applicants again appealed, August 5, 1867; but no steps were taken under the appeal until August 25, 1868, more than two years after the last action of the office, when applicants appealed 'from the final action of the department refusing to grant reissued patents upon divisions A, B, C, and D.'

"The office replied to the notification of appeal, that

the alleged appeal was too indefinite in its terms to be entertained; and, further, that there had been no decision of the department (not already appealed from) from which an appeal would then lie. The office further declined to send the papers to the judge.

"On the same day that the appeal was taken, to wit, August 25, applicants presented to the office four entire new specifications, which they asked leave to substitute for the original and amended specifications, for the purpose of having the new specifications considered upon the appeal before Justice Fisher.

"On December 8, 1868, Justice Fisher rendered a decision in the matter of the appeal upon the four divisions, in the following terms: 'I hereby reverse the decision of the Commissioner of Patents of the 30th day of May, 1866, refusing to allow the applicants to amend their specifications so as to eliminate therefrom the objectionable language which prevented their obtaining the reissue prior to that date, and order that the reissues, in divisions A, B, C, and D, be *forthwith issued, in accordance with the amended specifications filed August* 25, 1868.'

"At the time of the hearing, if hearing there were, before the learned justice, none of the original papers were before him, no amended specifications had ever been filed in the office, and there is no evidence to show upon what amended specifications he proposed 'forthwith' to issue the reissues. Certain papers are in the files, bearing date August 25, 1868, without office mark, and which are not identified as those which were presented to the judge. If, however, these were the specifications upon which the learned judge directed the patent to issue, it is to be remarked concerning them, that they have never yet been

before an examiner in the office, that the novelty of the improvements claimed has never been examined in any way, and that if the patents were now to issue upon these specifications, they would issue without having been subjected to the scrutiny provided by law for protection against mistake and fraud, and without applying to them any of the tests which the law has provided for ascertaining the novelty or utility of any of the improvements claimed therein. How grave an error this would be will appear when it is further stated, that the original patent granted to William Gage contained but two claims. As in contemplation of law each claim embodies a separate invention, these two claims stood, in effect, for two patents. They were very modest in their scope, and the machine which they describe was of limited value. In fact, so far as is known to the office, it has never been manufactured. Yet from this small beginning the four specifications, dated August 25, 1868, and which the learned judge orders the office to patent without examination 'forthwith,' present no less than twenty-one claims each, or eighty-four claims in all; eighty-four claims, representing eighty-four different inventions, and equivalent to eighty-four different patents, springing from two. This is expansion of the most formidable character; and yet, upon the simple presentation of this batch of inventions to the judge, the office is required to patent them forthwith, without inquiring into novelty, utility, form, or structure of claims, or any other matters which the law requires to be ascertained by the office before any patent shall issue. Nay, more than this; the learned justice, six days later, made a further order, directing these eighty-four claims, when issued, to be antedated to February 18,

1865, so that the effect would have been to make them retroactive for nearly *four years;* thus seeking to sweep within their grasp, as infringers, all manufacturers who for four years had built machines in utter ignorance of such claims, of claims which, in fact, had no existence prior to August 25, 1868.

"Each of these orders was issued in contravention of law. The learned judge had no jurisdiction to make them. They are absolutely null and void, and I am compelled to decline to execute them. The whole purpose of the establishment of the Patent Office would be destroyed. Its corps of examiners, its collection of mechanical and scientific books, its record of patents heretofore granted, its vast collection of models and drawings and of foreign patents, and, in short, all its appliances for the examination into the novelty of alleged inventions, would be useless if applicants can appeal, upon any pretext, to a judge of the supreme court of this District, and, upon such appeal, present him with a new specification and new claims, which have never been examined, and which may embody the inventions of other men, and procure from him an order to this office to issue a patent upon such specifications 'forthwith.'

"No such power is vested in the appellate judge by law.

"The jurisdiction of the judge upon appeal from the Commissioner of Patents is limited. It extends only to a review of the reasons of the Commissioner for refusing an application for an original or reissued patent in the first instance, and to a review of the judgment of the Commissioner in interference cases. No power is given to the judges of the supreme court of the District to re-

view the executive or ministerial acts of the Commissioner, or acts the doing or not doing of which rests in his sound discretion. Until a very recent period the judges of that court have uniformly declined to take such jurisdiction or to usurp the purely executive functions of the Commissioner.

"In the present case the Commissioner refused a patent to applicants upon the claims as presented; they appealed from his decision, and their appeal was not sustained. The jurisdiction of the judge over the case ended with the decision of the appeal. Subsequently the applicants asked leave to amend. They had amended four times already, had insisted upon their application, had chosen to take a final rejection, which, upon appeal, was affirmed.

"Whether the Commissioner would allow further amendment or not was a matter entirely within his discretion. It was not a matter of right with the applicants. It is a motion for an amendment and rehearing; for a new trial. Such motions are always regarded as within the discretion of the officer to whom they are addressed. The granting or refusal to grant them is never a proper subject of appeal.

"In *Wylie* v. *Coxe*, (14 *How.*, 2,) the supreme court say: 'In relation to the order, it is plain no appeal will lie from the refusal of a motion to open the decree and grant a rehearing. The decision of such a motion rests in the sound discretion of the court below, and no appeal will lie from it.'

"In *Rouse ex parte* (*Book of Appeals*, *vol.* 2, p. 313) Judge Dunlop says: 'One full, fair, and impartial trial between the same parties, and for the same matter of controversy,

is all that any citizen can claim under this statute or any other law known or practiced by the courts of this country. If, from surprise, accident, or fraud, or new-discovered proof, or any other legal cause, a fair and full trial has not been had, the remedy is by rehearing or a new trial, or some equivalent proceeding in the tribunal where the first trial took place. The sound discretion of that tribunal must be invoked, and from its refusal to interfere there is no appeal.'

"The case of Rouse, as stated by the learned judge, was as follows: 'In the present case the Commissioner, in the exercise of his discretionary power, refused to Rouse the withdrawal of the first and the filing of his second application, and refused to declare a new interference between him and Dodge; and in effect refused to give him another hearing.'

"In the case of *Raymond ex parte* (*Book of Appeals, vol.* 3, p. 443) Judge Dunlop says: 'An appeal lies by law from the decision of the Commissioner to either of the judges of the circuit court of the District of Columbia. Whichever of the judges of that court is applied to *decides it finally, and no other judge of that court can entertain another appeal in the same case* and review the former decision; that former decision is final and conclusive upon either of the other judges sitting at chambers.'

"And yet, in the present case, Justice Fisher not only reviewed the decision of Justice Wylie, his brother justice, but remarked upon that decision as follows: 'The appellants thereupon, I think, might well have treated the action of Justice Wylie in rehearing the case and reversing his own decision *as a mere nullity*, and have rightfully demanded their reissues in their several divisions,

A, B, C, and D, without offering to amend their claims in any respect whatever.'

"In the case of *Janney ex parte* (*Book of Appeals, vol.* 1, p. 221) Chief Justice Cranch says: 'The act of 1839 gives the right of appeal to the judge only in cases where an appeal was by the previous act allowed from the decision of the Commissioner to a board of examiners, and then only when a patent was refused. In the present case he has not refused a patent. He decides only that he will not examine the merits of the claim which has been twice rejected after a full examination of his predecessors in office. This refusal was not a ground for appeal to examiners under the seventh section of the act of 1836, and therefore is not a ground of appeal to the judge.'

"It is obvious, therefore, that the refusal of the Commissioner to allow further amendment, after the case had been decided upon appeal by Justice Wylie, was not upon any ground the proper subject of an appeal, and that Justice Fisher was without jurisdiction in the premises.

"But even if the appeal had been properly entertained, he was equally without jurisdiction to make the order which he entered December 8, 1868. By the terms of that order he directed 'that the reissues, in divisions A, B, C, and D, *be forthwith issued*, in accordance with the amended specifications filed August 25, 1868.'

"No power is conferred upon the appellate judge to order a patent to issue. His power, at most, extends to a reversal of the decision of the Commissioner from which an appeal is taken. The act of March 3, 1839, substituting the chief justice of the district court of the District of Columbia for the board of examiners, expressly declares that 'the Commissioner shall also lay before said

judge all the original papers and evidence in the case, together with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal, *to which the revision shall be confined.*' * * * 'And it shall be the duty of the said judge, after a hearing of any such case, to return, all the papers to the Commissioner, with a certificate of his proceedings and decision, which shall be entered of record in the Patent Office; and such decision, so certified, *shall govern the further proceedings* of the Commissioner in such case.'

"The act of July 4, 1836, § 7, provided, with reference to the board of examiners, as follows: 'And, on an examination and consideration of the matter by such board, it shall be in their power, or of a majority of them, to reverse the decision of the Commissioner, either in whole or in part; and, their opinion being certified to the Commissioner, he shall be governed thereby *in the further proceedings to be had on such application.*'

"It is obvious that nothing like an order from the judge directing the patent to issue was contemplated by these provisions. In fact, they give no power to the judge to make any order whatsoever. He may decide the question before him and may certify his decision, but he is not authorized to *order* the Commissioner to do anything whatsoever.

"This view of the statute is sustained by the decisions. In *Arnold* v. *Bishop* (*Book of Appeals, vol.* 1, p. 80) Chief Justice Cranch says: 'The words of the act are that the judge's decision '*shall govern the further proceedings of the Commissioner in such case.*' This must apply only to so much of the case as is involved in the reasons of appeal; and the appeal itself can be considered only as an appeal to so

much of the decision of the Commissioner as is affected by such reasons. If, therefore, after the judge shall have decided in favor of the applicant upon the points involved upon his reasons of appeal, other sufficient reasons remain for rejecting the claim for a patent, untouched by the decision of the judge, it would seem that the Commissioner might properly still reject it.'

"In *Potter* v. *Dixon* (2 *Fish.*, 381) it appeared that in an interference between Singer and Wilson an appeal had been taken to Judge Dunlop, who, upon hearing, decided in favor of Wilson, *and ordered a patent to issue to him.* After the return of the papers to the Patent Office the Commissioner discovered that the application interfered with the patent of a third party, and a new interference was declared. Upon appeal to Judge Dunlop he refused to look into the case upon its merits, but peremptorily ordered the Commissioner to execute his first order. Upon this Mr. Justice Nelson says: 'Section eleven of the act of 1839 *does not provide that the Commissioner shall issue a patent* to the applicant if the decision of the chief justice is in his favor, but simply declares that it shall 'govern the further proceedings of the Commissioner in such case;' and so it should, as it respects parties concerned, but not as to other parties who may come in and claim the benefit of the provision.

"We are quite clear, therefore, that the learned chief justice erred in refusing to entertain the appeal in the case of the interference declared with the A. B. Wilson patent, and that his order to the Commissioner, dissolving the interference and directing his order in the case of the interference with the I. M. Singer patent to be executed, *was a nullity.*'

"But the learned justice not only directed the patents to be issued forthwith, but he directed them to be antedated to February, 1865.

"Without discussing at this time the question of antedating reissues, or stopping to expose the enormity of such a practice, it is sufficient to say that this part of the order of the learned justice was equally without authority. Upon this point the supreme court, of which the learned justice is a member, sitting *in banc*, upon an application for a mandamus to compel the Commissioner, in this very case, to issue these very reissues antedated as ordered, expressly declared, Chief Justice Cartter delivering the opinion of the court: 'In the case of *Gage and Whiteley* v. *The Commissioner of Patents*, the court has come to the conclusion to deny the application for the mandamus, for the want of jurisdiction in the appellate judge to make the order the violation of which is complained of.' * * * 'It is very clear to the mind of the court that Judge Fisher had no jurisdiction in the premises. The jurisdiction is limited. It is limited to an appeal circumscribed to the rights of the reissue of the patent.'

"It is believed, if the application for the mandamus had covered the first decision of the learned justice as well as the second, that it would have received the same condemnation from the full bench. My predecessor declined to obey these orders; and entertaining these views, and sitting here not only as the guardian of the rights of inventors, but of those of the public, and especially of the manufacturing public, I cannot, under the circumstances, consent to the issue of these reissued patents.

"As regards the division of this batch of applications which is designated as Division G, the facts are as follows:

During the pendency of the application for divisions A, B, C, and D, and before the decision of Justice Wylie, applicants amended Division A by taking therefrom the fourteenth claim and framing a new division, called Division E, with five claims of invention. On October 29, 1866, applicants filed a fresh division, called Division F, with five more claims. These divisions were both rejected by the office, on the ground that the claims presented involved no patentable subject-matter. They were appealed to the board of examiners, to the Commissioner, and finally to Justice Fisher, who overruled the action of the office, and ordered the patents to issue, with antedate to February 18, 1865, more than a year before either of the applications were filed in the office. The office declined to antedate, but finally obeyed the order so far as to issue the patents in the fall of 1868, although the novelty of the claims had never been examined. Since the last decision of Justice Fisher, upon divisions A, B, C, and D, the applicants have again proposed to amend Division A by taking therefrom the twenty-first claim, framing a new division, to be called Division G, and expanding the single claim extracted from Division A into twenty-two claims.

"It will thus be seen that the original patent of William Gage, with its two claims, has now reached, in the hands of applicants, the formidable proportions of *seven* patents, with no less than *one hundred and sixteen claims.*

"Division G, so-called, cannot be allowed. The original patent is surrendered, and has been reissued in divisions E and F.

"It has no vitality to support another division. Chief Justice Cartter, in *Whiteley, assignee of Weeks, ex parte,*

said: 'This motion raises the question simply as to the effect of the surrender of a patent. Can such patent, after its surrender, be received and treated by the office or the judge as having legal vitality in such wise as to give authority for reissue? If I correctly comprehend the subject, it cannot. The surrender of a patent, and letters patent granted in reissue for the same subject upon such surrender, is the death of the first patent in the life of the second. Whatever of title to the subject of the patent survives is to be found in the letters of reissue, and not in the patent out of which such letters grow, and any application thereafter made for reissue should be based upon the reissued letters patent. Inasmuch as this application is made upon an expired title, there is no authority in the office to comply with it.'

"It is true that this opinion of the chief justice was overruled by his associate, Justice Fisher, in the same case, and that a patent was ordered to issue 'forthwith;' but, though there be a conflict of opinion between the two justices, I still think myself justified in quoting so respectable an authority as Chief Justice Cartter.

"If it be said that Division G derives its vitality from Division A, and not from the surrendered original, the obvious answer is that Division A was no longer open for amendment. Whether the decision of Judge Wylie against it was final, or whether Justice Fisher was authorized to order it to issue 'forthwith,' it was equally removed from the power of applicant to alter or amend it in any way.

"The statute which permits a division of reissues is section 5 of the act of 1837, which provides, 'That whenever a patent shall be returned for correction and reissue

under the thirteenth section of the act to which this is additional, and the patentee shall desire several patents to be issued for distinct and separate parts of the thing patented, he shall first pay,' &c.

"This provision evidently contemplates nothing more than that, when his rights are determined and the Commissioner is willing to allow him a patent, he may receive distinct improvements in several patents. The whole transaction is single. The divisions make up but one patent, and should be treated as one application until finally disposed of. No provision is made for issuing a patent for some undisputed part of the invention, and carrying on a contest subsequently for another patent for some other part.

"Accordingly, in *Selden ex parte*, *Book of Appeals*, vol. 3, p. 459, Judge Morsell said: 'The case is that application which embraces the *whole* matter, however it may become afterward divided into parts, unless the law declares it to be otherwise.' And again: 'The case is that which is set forth as the ground of the application in the incipient stages of it, and includes or embraces the whole, and not a part only, each part of which is only a part of one whole; and so it must be here considered, notwithstanding the after effect produced by reissuing separate patents for each part; and such has been the invariable contemporaneous practice by the office and the judges ever since the passage of the law.'

"Since, therefore, the patent of William Gage has been reissued in the divisions known as E and F, I am of opinion that no other division of reissue for the same patent can be entertained by the office.

"The fee paid by applicant is subject to his order, but

the application filed by him and marked Division G cannot be examined.

252. THE DECISION OF THE APPELLATE TRIBUNAL IS BINDING ONLY UPON THOSE QUESTIONS WHICH WERE SUBMITTED TO ITS CONSIDERATION.—In the case of Andrew Whiteley, *ex parte*, Mr. Justice Fisher says: "On the 21st day of May, 1863, Whiteley applied for a reissue in three divisions, having surrendered the reissued patent. The Commissioner of Patents refused this second reissue, on the ground that as Ball, Aultman & Co. possessed an exclusive right to the invention, under the original patent, within the limits of the State of Ohio, and as the Hawleys also had the exclusive right to said invention within the limits of the northern counties of Illinois, under the reissue of 1858, Whiteley was only the grantee of an exclusive sectional interest, and not of the entire patent.

"From this decision Whiteley prayed an appeal to a justice of the supreme court of the District of Columbia, but the Commissioner refused to grant the appeal also, which was continued to be withheld from him until the early part of the year 1867, when the Supreme Court of the United States, in a case of mandamus, to which Whiteley and the late Commissioner, D. P. Holloway, were the parties, declared that Whiteley was entitled to have his appeal as a matter of right under the patent laws, and that if the mandamus issued by the supreme court of the District of Columbia, then under consideration of the Supreme Court of the United States, had directed the Commissioner to allow the appeal, such an order would have been held correct.

"On the 9th day of April, 1867, soon after the Supreme Court of the United States had made this declar-

ation, Whiteley filed his reasons of appeal, and brought the case to hearing before Chief Justice Cartter, who, on motion of J. J. Coombs, esq., on behalf of the Commissioner of Patents, dismissed the appeal, upon the ground that on the 11th day of February, 1867, Whiteley 'had assigned all his right, title, and interest in said patent to Whiteley, Fissler & Kelly, who, on the 18th day of March, 1867, assigned all their right, title, and interest therein to Jonathan Haines,' the first patentee, and that this transfer divested him (Whiteley) of all interest or control over the title to the invention, 'and that the effect of issuing letters patent for the residue of the term—that is, of granting a reissue to Whiteley'—would be to force a title in defiance of the act of the party and in fraud of his assignee.

"The Commissioner's decision, adverse to Whiteley, had been made several years previous to the appeal being brought before Judge Cartter, and the reasons of appeal were filed also several years before, and all long before the assignment made by Whiteley to Whiteley, Fissler & Kelly, so that the ground upon which Judge Cartter dismissed the appeal was not involved at all in any of the questions raised by the assignment of errors in the appeal. The principal question raised by the errors assigned in the Commissioner's decision was whether, at the time of the surrender and application for a second reissue, on the 21st May, 1863, Andrew Whiteley was entitled, as the assignee of the original patentee, to have a reissue, or whether, as the Commissioner decided, he was only the grantee of an exclusive sectional interest, and not the assignee of the original patent, and therefore not entitled to the reissue.

"The appeal, being thus dismissed without any decision of the question raised by the appellant's reasons of appeal, and on matters arising long after the rendition of the Commissioner's decision, Whiteley again appealed on the 8th March, 1868, assigning in his reasons of appeal but one error, viz, that 'the Commissioner of Patents, then D. P. Holloway, erred by holding that the applicant was but the grantee of an exclusive sectional interest in the patent sought to be reissued, and therefore not entitled to the reissue, when the assignment showed that Haines had transferred to him the patent itself, when no interest in it was owned by any other person, and did this for enabling the assignee to procure its reissue, the same as he might have done in the absence of this assignment.'

"The first question for my decision is whether the appeal is now properly before me, an appeal having been brought in the same case and upon the same grounds substantially before Chief Justice Cartter, and dismissed by him, as before stated. If the former appeal were properly and lawfully determined or dismissed, the present appeal could not be entertained. Was the former appeal thus legally disposed of? I do not think it was. The jurisdiction of the supreme court of the District of Columbia in appeal from the decisions of the Commissioner of Patents is a special and limited jurisdiction. It is therefore the duty of the justice to whom an appeal is brought to confine himself strictly within the limits prescribed by the act conferring that jurisdiction. This jurisdiction was conferred first upon a board of examiners by act of July 4, 1836; afterwards, by act of March 3, 1839, it was transferred to the chief justice of

this District; afterwards, by act of August 30, 1852, it was extended to the assistant judges of the old court; and, by the act of March 3, 1863, it was transferred to the justices of the supreme court of the District of Columbia. Section 11 of the act of March 3, 1839, provides as follows: 'In all cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to a board of examiners, provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right of appeal to the chief justice of the district court of the United States for the District of Columbia, by giving notice thereof to the Commissioner, and filing in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing, and also paying into the Patent Office, to the credit of the patent fund, the sum of $25. And it shall be the duty of said chief justice, on petition, to hear and determine all such appeals, and to revise such decisions in a summary way on the evidence produced before the Commissioner, at such early and convenient time as he may appoint, first notifying the Commissioner of the time and place of hearing, whose duty it shall be to give notice thereof to all parties who appear to be interested therein, in such manner as said judge shall prescribe. The Commissioner shall also lay before the said judge all the original papers and evidence in the case, together with the grounds of his decision, fully set forth in writing, touching *all the points involved by the reasons of appeal, to which the revision shall be confined.*' From the words italicized it will be seen that the only duty which the judge to whom an appeal is taken in a patent case has to perform is to de-

termine the points involved by the reasons of appeal. To this law expressly confines him. The moment he enters upon the investigation or the determination of matters *de hors* these reasons of appeal, he has transcended the limits of the jurisdiction conferred, and acting thus, without power or jurisdiction, his act becomes a mere nullity. In the case of Whiteley's former appeal, the point on which the appeal was dismissed was in nowise involved by the reasons of appeal, and the dismissal is therefore, in my judgment, a mere nullity, and does not stand in the way of the present appeal." (*MS. Appeal Cases D. C.*, 1868.)

In the case of *Abraham* v. *Fletcher* the Commissioner says: "It seems as though the necessity would never cease to be felt of recalling the true nature and extent of the jurisdiction conferred upon the appellate judge in patent cases. Yet it is well known that he is the mere substitute for the board of examiners provided in the seventh section of the act of 1836. It seems to be thought by many that his judicial character invests him with further prerogatives. That is an entire mistake. His office serves merely as a *designatio personæ*, the means of ascertaining who shall constitute the tribunal of appeal. He derives no authority or jurisdiction from it, but has merely those which were conferred upon the former board of examiners. How limited those are has been often conceded by the judges when acting in their appellate capacity, as may be seen in repeated decisions referred to in *Law's Digest*, 138–141. (See more particularly *Arnold* v. *Bishop*, 138; *Richardson* v. *Hicks*, 140.)

"It is true that in a case somewhat resembling the one before us, *Potter* v. *Dixon*, (2 *Fish.*, 381,) Judge Nelson is

reported to have said, that 'the decision of the chief justice' (the appellate judge) 'was doubtless binding on the Commissioner as between those parties, but no further.' If he had said it was binding no further, at most, than as between those parties, he would have conveyed all he probably meant to say, certainly all he was called upon to decide.

"The question how far the former decision was binding, as between the parties to it, upon the Commissioner, was not discussed before him, and probably was not considered. On the other hand, the case plainly shows that the rescript of the appellate judge was held to be of no weight, except upon the precise points submitted to him. If, notwithstanding his order that a patent issue, the Commissioner may still suspend it when another party interposes a claim to the invention, it plainly follows that he has the same power when for other reasons it appears that there are valid objections to the issue.

"The truth is, the Commissioner is bound to follow the decision above upon those points only which were raised by the appeal, and upon no other. It is for the judge to say that a decision of the Commisstoner shall be affirmed or reversed; not to say that a patent shall or shall not issue. It belongs to the Commissioner alone to determine that question, and in determining it many other considerations may have to be taken into the account, besides those which have been passed upon by the judge. In *Wade* v. *Matthews*, (5 *Opinions Attorneys General*, 220,) it was held by Reverdy Johnson, Attorney General, that so long as the Commissioner had a patent within his control, which had been ordered to issue, he was bound to keep it back if fresh objections to it came

to his knowledge, so that he was not satisfied that it ought to issue.

"That is equally true, I apprehend, although his opinion upon other points touching the invention has been reversed on appeal. He is only precluded from raising anew an objection which has been overruled." (*Commissioners' Decisions*, 1869, p. 50.)

253. DECISIONS NOT MERELY ADVISORY, BUT TO BE FOLLOWED AS PRECEDENTS.—In the case of *Mason* v. *Doellbor and Houghton* the Commissioner says: "It is conceded by the counsel for the appellant, Mason, that this case presents the precise question as to abandonment which was lately decided by Mr. Justice Fisher, upon appeal from this office, in the case of *Rowley* v. *Mason*. I think that the decisions of the judges of the supreme court of the District of Columbia in cases which are properly before them on appeal from this office, are, in other cases to which they apply, something more than advisory, and that where, as in the present case, it is conceded that the facts are in substance the same as the case in which a decision has been rendered, it is the duty of the Commissioner to apply and enforce such decision without hesitation, whatever might be his individual opinion of the law. The decision of the board of examiners-in-chief is therefore affirmed, upon the authority of *Rowley* v. *Mason*." (*Commissioners' Decisions*, 1869. p. 26.)

254. FORM OF PETITION TO THE SUPREME COURT OF THE DISTRICT OF COLUMBIA.—

To the Supreme Court of the District of Columbia.

The petition of George Thompson, of Boston, in the county of Suffolk, and State of Massachusetts, respectfully showeth: That he has heretofore invented a new and useful improvement in velocipedes, and has applied to the Patent Office of the United States for a patent [*or for the reissue of a*

patent heretofore granted] for the same, and has complied with the requirements of the several acts of Congress and with the rules of the Patent Office prescribed in such cases; that his said application has been rejected by the Commissioner of Patents on appeal to him; and that he has filed in said office due notice to the Commissioner of Patents of this his appeal, accompanied with the reasons of appeal, and with certified copies of all the original papers and evidence in the case, all which will appear from the certificate of said Commissioner of Patents, hereto annexed.

And the said George Thompson prays that his said appeal may be heard and determined by your honorable court at such a time as may be appointed for that purpose; and that the Commissioner of Patents may be duly notified of the same, and directed in what manner to give notice thereof to the parties interested.

GEORGE THOMPSON.

255. FORM OF CERTIFICATE OF COMMISSIONER.—

PATENT OFFICE, WASHINGTON, D. C., *July* 17, 1869.

I hereby certify that the above-named George Thompson has complied with the requisites of the law necessary to perfect his aforesaid appeal.

SAM'L S. FISHER,
Commissioner of Patents.

256. FORM OF NOTICE AND REASONS OF APPEAL.—

To the Commissioner of Patents:

George Thompson, of Boston, in the county of Suffolk, and State of Massachusetts, hereby gives notice that he has appealed from your decision rejecting his application for a patent [*or for a reissue of a patent granted to him July* 7, 1865] for improvement in velocipedes, and of this you are respectfully requested to take notice.

Accompanying this notice are certified copies of all the original papers and evidence in the case, and a petition addressed to the supreme court of the District of Columbia.

And the said George Thompson assigns the following reasons for appealing from the said decision of the Commissioner of Patents, viz:

The Commissioner erred in deciding that the said improvement was not patentable.

The Commissioner erred in deciding that the said invention was not new.

GEORGE THOMPSON.

XV. Mandamus to the Commissioner.

SEC.
257. Mandamus a remedy against public officers.
258. To compel the performance of ministerial duties.
259. Distinction between ministerial acts and the ordinary discharge of official duties.
260. Principles applicable to heads of departments applied to the Commissioner of Patents.
261. Jurisdiction of the supreme court of the District of Columbia.
262. Mandamus to Commissioner of Patents.
263. Parties in mandamus.
264. Proceedings in mandamus.

257. MANDAMUS A REMEDY AGAINST PUBLIC OFFICERS.

—In order to maintain a system of government which will be able to secure to the citizen his rights, it is necessary to have persons appointed or chosen to administer the law. And when persons are thus clothed with the power, and have assumed the duties of a public officer, they have taken upon themselves the obligation to perform those duties; and if they neglect or refuse to do so, any person whose rights are thereby injuriously affected is entitled to demand relief. The remedy provided by our system of law, as well as that of England, is a process issuing from the judicial branch of the government, which seeks to compel the officer to go forward and do that which is enjoined upon him by the position he holds. (*Moses on Mandamus*, 14.)

And generally, in all cases of omission or mistake, where there is no other adequate specific remedy, resort may be had to this high judicial writ. It not only lies to ministerial, but to judicial officers. In the former case

it contains a mandate to do a specific act; but in the latter only to adjudicate, to exercise a judgment, or discretion, upon a particular subject. (*Ib.*)

It may be stated as a general principle, that this writ is only granted for public persons, and to compel the performance of public duties. (3 *Stephens's Nisi Prius*, 2291.) It can be resorted to only in those cases where the matter in dispute, in theory, concerns the public, and in which the public has an interest. The degree of its importance to the public is not, however, scrupulously weighed. (1 *Swift's Digest*, 564.) A mandamus gives no right, not even a right of possession, but simply puts a man in a position which will enable him to assert his right, which in some cases he could not do without it. And "in order to lay the foundation for issuing a writ of mandamus, there must have been a refusal to do that which it is the object of the mandamus to enforce, either in direct terms, or by circumstances distinctly showing an intention in the party not to do the act required." (3 *Stephens's Nisi Prius*, 2292; *Redfield on Railways*, 441, *note* 5; *Moses on Mandamus*, 18.)

258. To Compel the Performance of Ministerial Duties.—Where the heads of departments are the political or confidential agents of the executive, merely to execute the will of the President in cases where the executive possesses a constitutional or legal discretion, nothing can be more perfectly clear than that their acts are only politically examinable. But where a specific ministerial duty is assigned by law, and individual rights depend upon the performance of that duty, it seems equally clear that the individual who considers himself injured has a right to resort to the laws of his country

for remedy, and that mandamus is a proper remedy. (*Moses on Mandamus*, 63.)

It was held, in the case of *Marbury* v. *Madison*, that "It is not by the office of the person to whom the writ is directed, but the nature of the thing to be done, that the propriety or impropriety of issuing a mandamus is to be determined. Where the head of a department acts in a case in which executive discretion is to be exercised, in which he is the mere organ of executive will, it is again repeated that any application to a court to control, in any respect, his conduct, would be rejected without hesitation. But where he is directed by law to do a certain act, affecting the absolute rights of individuals, in the performance of which he is not placed under the particular direction of the President, and the performance of which the President cannot lawfully forbid, and therefore is never presumed to have forbidden, as, for example, to record a commission, or a patent for land, which has received all the legal solemnities; or to give a copy of such record; in such cases, it is not perceived on what ground the courts of the country are further excused from the duty of giving judgment, that right be done to an injured individual, than if the same services were to be performed by a person not the head of a department." (1 *Cranch*, 137.)

The doctrine that mandamus lies on the application of a private individual, and for his benefit, to compel the head of a department to perform a mere ministerial duty, where that duty is plain, seems to have been fully maintained in the case of *The Commissioners of the Land Office* v. *Smith*, 5 *Texas*, 471.

259. DISTINCTION BETWEEN MINISTERIAL ACTS AND THE

ORDINARY DISCHARGE OF OFFICIAL DUTIES.—A distinction is made between the ministerial acts of one of the heads of department, and those duties required in the ordinary discharge of official duties, over which the officer is required to exercise judgment and discretion. While the former can be compelled by mandamus, the latter cannot. (*Moses on Mandamus*, 65.)

In the case of *Decatur* v. *Paulding*, the Supreme Court of the United States, in reversing the decision of the circuit court of the District of Columbia, say: "In the case of *Kendall* v. *The United States*, 12 *Peters*, 524, it was decided in this court that the circuit court for Washington county, in the District of Columbia, has the power to issue a mandamus to an officer of the federal Government, commanding him to do a ministerial act." * * * "The head of an executive department of the government, in the administration of the various and important concerns of his office, is continually required to exercise judgment and discretion. He must exercise his judgment in expounding the laws and resolutions of Congress under which he is from time to time required to act. If he doubts, he has a right to call upon the Attorney General to assist him with his counsel; and it would be difficult to imagine why a legal adviser was provided by law for the heads of departments, as well as for the President, unless their duties were regarded as executive, in which judgment and discretion were to be exercised. If a suit should come before the court which involved the construction of any of these laws, the court certainly would not be bound to adopt the construction given by the head of a department. And if they supposed his decision to be wrong, they would, of course, so pronounce their judgment. But their judg-

ment upon the construction of a law must be given in a case in which they have jurisdiction and in which it is their duty to interpret the act of Congress, in order to ascertain the rights of the parties in the cause before them. The court could not entertain an appeal from the decision of one of the Secretaries nor revise his judgment in any case where the law authorized him to exercise discretion or judgment. Nor can it by mandamus act directly upon the officer, and guide and control his judgment or discretion in the matters committed to his care in the ordinary discharge of his official duties." * * * "The interference of the courts with the performance of the ordinary duties of the executive departments of the government would be productive of nothing but mischief; and we are quite satisfied that such a power was never intended to be given to them." (14 *Peters*, 497.)

In the case of *The United States* v. *Guthrie*, Mr. Justice Daniel, in delivering the opinion of the court, said: "It has been ruled, that the only acts to which the power of the courts, by mandamus, extends, are such as are purely ministerial, and with regard to which nothing like judgment or discretion, in the performance of his duties, is left to the officer; but that, wherever the right of judgment or decision exists in him, it is he, and not the courts, who can regulate its exercise.

"These are the doctrines expressly ruled by this court in the case of *Kendall* v. *Stockton*, 12 *Peters*, 524; in that of *Decatur* v. *Paulding*, 14 *Peters*, 497; and in the more recent case of *Brashear* v. *Mason*, 6 *How.*, 92; principles regarded as fundamental and essential, and apart from which the administration of the government would be impracticable." (17 *How.*, 284.)

Mr. Justice Clifford, delivering the opinion of the court in the case of *The Secretary* v. *McGarrahan*, said: "Since the decision of this court in the case of *McIntire* v. *Wood*, (7 *Cranch*, 504,) it has been regarded as the settled law of the court that the circuit courts of the United States in the several States do not possess the power to issue writs of mandamus except in cases in which it may be necessary to the exercise of their jurisdiction. (*Riggs* v. *Johnson Co.*, 6 *Wallace*, 198.)

"Authority to that effect might doubtless be given to those courts by an act of Congress; but the insuperable difficulty at present is, that neither the judiciary act nor any other act of Congress has conferred upon them any such power.

"Antecedent to the decision of this court in the case of *Kendall* v. *The United States*, grave doubts were entertained whether any court established by an act of Congress possessed any such jurisdiction; but the majority of this court came to the conclusion that the circuit court of this District might issue the writ of mandamus to an executive officer residing here, commanding him to perform a ministerial act required of him by law, and it is not denied that the court below possesses all the power in that behalf which the circuit court of the District possessed at that time." * * * "Though mandamus may sometimes lie against an executive officer to compel him to perform a mere ministerial act required of him by law, yet such an officer, to whom public duties are confided by law, is not subject to the control of the courts in the exercise of the judgment and discretion which the law reposes in him as a part of his official functions." (9 *Wallace*, 298.)

The rule to be gathered from all the cases decided in the Supreme Court of the United States, governing mandamus, to the officers of the government, seems to be this: It cannot issue in a case where discretion and judgment are to be exercised by the officer, nor to control him in the manner of conducting the general duties of his office. It can be granted only where the act required to be done is imposed by law—is merely ministerial—and the relator without any other adequate remedy. (*Moses on Mandamus*, 78.)

260. PRINCIPLES APPLICABLE TO HEADS OF DEPARTMENTS APPLIED TO THE COMMISSIONER OF PATENTS.—The principles applied by the Supreme Court of the United States, in cases of mandamus, to heads of departments of State, would seem to be applicable in cases of mandamus to the Commissioner of Patents. (See *Commissioner of Patents* v. *Whiteley*, 4 *Wallace*, 522.)

261. SOURCE OF POWER TO ISSUE THE WRIT IN THE SUPREME COURT OF THE DISTRICT OF COLUMBIA.—A writ of mandamus, at common law, was a command issuing in the King's name, from the court of King's Bench, and directed to any person, corporation, or inferior court of judicature within the King's dominions, requiring them to do some particular thing therein specified, which appertains to their office and duty, and which the court of King's Bench has previously determined, or at least supposes to be consonant to right and justice. (2 *Black. Com.*, 110.) But "in America the authority to issue the writ of mandamus does not exist as a prerogative power of the courts, but is derived by grant from the Government, through the Constitution or legislative enactments. And when the power has been granted in

general terms to a court, it is to be governed by the common law rules as to when it is proper to be issued. (*Kentucky* v. *Dennison*, 24 *How.*, 66; *In the matter of James Turner*, 5 *O. R.*, 543;" *Moses on Mandamus*, 17.)

The power to issue the writ of mandamus was, under the provincial government of Maryland, intrusted to the provincial court; which occupied under the government the place which belongs to the King's Bench in England. The Maryland constitution of 1777 transferred the right of issuing the mandamus, with the other powers of the provincial court, to the general court. (*Evans's Practice*, 18, 403.)

It has been held by the Supreme Court of the United States, in the case of *Kendall* v. *The United States*, 12 *Peters*, 526, that as the act of Congress of the 27th of February, 1801, concerning the District of Columbia, and by which the circuit court of the District is organized and its powers and jurisdiction pointed out, declared that the laws of the State of Maryland, as they now exist, shall be and continue in force in that part of the District which was ceded by that State to the United States, and as at the date of that act the common law of England was in force in Maryland, and that the power to issue a mandamus in a proper case is a branch of the common law fully recognized as in practical operation in that State at the time the circuit court for the District of Columbia was organized, it was thereby vested with broader powers and jurisdiction in this respect than is vested in the circuit courts of the United States in the several States, and that it does possess the power to issue the writ of mandamus, directed to United States ministerial officers, when it is a fit and proper remedy.

And in the case of *Decatur* v. *Paulding*, (14 *Dallas*, 515,) Taney, C. J., in delivering the opinion of the court, said: "In the case of *Kendall* v. *The United States* it was decided in the court that the circuit court for Washington county, in the District of Columbia, has the power to issue a mandamus to an officer of the federal government, commanding him to do a ministerial act."

The act of Congress of the 3d of March, 1863, which established the supreme court of the District of Columbia, provided that "the supreme court organized by this act shall possess the same powers and exercise the same jurisdiction as is now possessed and exercised by the circuit court of the District of Columbia," &c.

262. MANDAMUS COMMANDING THE COMMISSIONER TO PERFORM AN ACT ENJOINED BY LAW.—It follows, therefore, that the supreme court of the District of Columbia has the jurisdiction and power, in proper cases, to grant and enforce a "writ of mandamus," commanding the Commissioner of Patents to perform an act enjoined by law.

In the case of the *Commissioner of Patents* v. *Whitely*, (4 *Wallace*, 522,) the case is stated as follows: "Whiteley, the defendant in error, was the assignee of a sectional interest in a patent granted to Haines, on the 4th of September, 1855, for an improvement in mowing machines. He held, by virtue of several assignments, all the territory embraced in the patent, except the State of Ohio and the northern half of the State of Illinois; and in all the territory, except as just mentioned, was assignee of all the rights of the patentee.

"In 1863 he applied to the Commissioner of Patents for a reissue of the patent, according to the thirteenth section of the patent act of 1836.

"The assignees for the State of Ohio and of the northern half of Illinois did not join in the application.

"The Commissioner of Patents, after a laborious investigation of the law and comparison of various sections of the patent acts, decided that the applicant, not being the assignee of the whole interest in the patent, was not entitled to the reissue asked for.

"Whiteley took no appeal from the Commissioner's decision; but setting forth that his application for reissue was filed with the Acting Commissioner, and the refusal, petitioned the supreme court of the District of Columbia for a mandamus to send an application *to an examiner to be acted upon by him as though made by the patentee.*

"The Commissioner, in reply—premising that for the reason that the proposed applicant was not such an assignee as the law contemplates, and that the application, therefore, was not filed or entered upon the books of the office, and never had been, and that the fees required on such application, which had been paid by the relator to the chief clerk of the office, on the presentation of said application, had not been placed to the credit of the patent fund, but remain in the hands of the chief clerk, personally, and subject to the order of the relator—replied, among other reasons, against the mandamus:

"1. That the object of it was to carry by appeal a preliminary question solely cognizable by him to the supreme court of the District, and that such a mandamus would be nugatory.

"2. That he had decided rightly in rejecting the application, the relator not coming within the meaning of the term 'assignee,' as contemplated in the thirteenth section of the act of 1836. And in support of this view he sub-

mitted as part of his answer a full law argument, which now came up in the record.

"The supreme court of the District granted the mandamus, 'commanding the Commissioner of Patents *to refer said application to the proper examiner, or otherwise examine or cause the same to be examined according to law.*' The case was now here on writ of error, brought by the Commissioner of Patents, to remove the proceeding to this court. Two principal questions were raised:

"1. Supposing the decision of the Commissioner to have been erroneous, and that the assignee of a sectional interest in a patent was entitled to a reissue, did a mandamus such as that above mentioned lie to correct the decision?

"2. Did the Commissioner, in deciding as he did that the applicant as owner of but a sectional interest was not entitled to a reissue, decide correctly?"

Mr. Justice Swayne, delivering the opinion of the court, said:

"This case was brought here by a writ of error to the supreme court of the District of Columbia.

"On the 4th of September, 1855, a patent was issued to Jonathan Haines for an improvement in mowing machines.

"On the 22d of November, 1856, Haines sold and assigned to Ball, Aultman & Co. an exclusive right to the invention and patent, within the limits of the State of Ohio.

"On the 13th of April, 1858, upon the surrender of the original patent by Haines, and upon his application, without the assent of Ball, Aultman & Co., a reissue of the patent was granted to him.

"On the 15th of January, 1860, Jonathan Haines sold and assigned to his brother, Ansel Haines, one undivided third part of his interest in the patent.

"On the 25th of January, 1860, Jonathan and Ansel Haines sold and granted to Isaac and William C. Hawley the exclusive right to the invention and patent in certain counties in the State of Illinois.

"On the 10th of April, 1863, Ansel Haines resigned to Jonathan Haines all his interest in the patent.

"On the 17th of April, 1863, Jonathan Haines sold and assigned all his interest in the patent to Andrew Whiteley, the defendant in error. Haines, at the same time, delivered the patent to Whiteley, in order that he might surrender it and procure another reissue.

"Ball, Aultman & Co. were applied to, but declined to concur. It does not appear that the Hawleys were advised upon the subject.

"On the 25th of January, 1863, Whiteley filed his application in the Patent Office, in conformity with the provisions of the thirteenth section of the act of 1836.

"The Commissioner of Patents declined to entertain the application, upon the ground that the applicant was only the grantee of an exclusive sectional interest, and not of the entire patent. He also declined to allow an appeal to be taken from this decision. An application was thereupon made to the supreme court of the District of Columbia for a writ of mandamus. That court awarded a peremptory writ, commanding the Commissioner 'to refer said application to the proper examiner, or otherwise examine or cause the same to be examined according to law.' This writ of error is prosecuted to reverse that order. Did the court err in making it?

"The thirteenth section of the act of 1836 declares that, under the circumstances therein stated, 'it shall be lawful for the Commissioner, upon the surrender to him of such patent, * * * to cause a new patent to be issued to the inventor, for the same invention, for the residue of the period, then unexpired, for which the original patent was granted, in accordance with the patentee's corrected description and specifications; and, in case of his death or any assignment by him made of the original patent, a similar right shall vest in his executors, administrators, or assigns.'

"The seventh section of this act provides that, on the filing of any application for a patent and the payment of the duty required, 'the Commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery,' &c.

"The eighth section of the act of 1837 provides, in regard to applications for the reissue of patents and the decisions of the Commissioner, that 'in all such cases the applicant, if dissatisfied with such decision, shall have the same remedies and be entitled to the benefit of the same privileges and proceedings as are provided by law in case of original applications for patents.

"This renders it necessary to recur to the act of 1836, and to consider carefully its provisions touching the applications to which it relates.

"Both acts should be liberally construed to meet the wise and beneficent object of the legislature. Patentees are a meritorious class, and all the aid and protection which the law allows this court will cheerfully give them.

"If the Commissioner should hold that a party applying originally for a patent 'was not the original and first

inventor,' and should decide against him upon that ground, the applicant could undoubtedly take an appeal from his decision. The Commissioner having reached this conclusion, would be under no obligation to go further and examine any other question arising in the case, and it would not be necessary to the right of appeal that he should do so.

"Here an assignee applied for *the reissue* of a patent. It was clearly competent for the Commissioner, and it was his duty, to decide whether the applicant was an assignee at all; and, if so, whether he was assignee with such an interest as entitled him to a reissue within the meaning of the statutory provision upon the subject. The latter question is an important one. It is as yet unsettled, and awaits an authoritative determination.

"The Commissioner says, in his answer to the rule, that he could not examine the application, because none had been filed in the Patent Office.

"This position is untenable. It is averred in the petition, and not denied in the answer—and, therefore, as in other like cases of pleading, to be taken as conceded—that the application was filed with the Acting Commissioner. It is also admitted in the answer that the requisite amount of fees had been paid by the relator, but, it is added, that it had not been placed to the credit of the office, and was in the hands of the chief clerk, subject to the relator's order.

"The relator had done all in his power to make his application effectual, and had a right to consider it properly before the Commissioner.

"It was so. *If it was not, a mandamus would clearly lie to compel the Commissioner to receive it.* It was his first duty

to receive the application, whatever he might do subsequently. Without this initial step there could be no examination, and, indeed, no rightful knowledge of the subject on his part. Examination and the exercise of judgment, with proper fruit, were to follow, and they did follow.

"The Commissioner found the question, whether the assignee was such a one as the law entitled to a reissue, lying at the threshold of his duties. It required an answer before he could proceed further. His decision was against the appellant. His examination of the subject was thorough, and his conclusion is supported by an able and elaborate argument. It was made a part of his reply to the rule, and is found in the record.

"From this decision, whether right or wrong, the relator had a right, under the statute, to appeal.

"*If the mandamus had ordered the Commissioner to allow the appeal, we should have held the order under which it was issued to be correct.* But the order was that he should proceed to examine the application. That he had already done. The preliminary question which he decided was as much within the scope of his authority as any other which could arise. Having resolved it in the negative, there was no necessity for him to look further into the case. Entertaining such views, it would have been idle to do so. *The question* was vital to the application, and its resolution was fatal, so far as he was concerned. Only a reversal by the tribunal of appeal could revive it and cast upon him the duty of further examination.

"The principles of law relating to the remedy by mandamus are well settled.

"It lies where there is a refusal to perform a minis-

terial act involving no exercise of judgment or discretion.

"It lies, also, where the exercise of judgment and discretion are involved and the officer refuses to decide, provided that, if he decided, the aggrieved party could have his decision reviewed by another tribunal.

"It is applicable only in these two classes of cases. It cannot be made to perform the functions of a writ of error.

"In *Decatur* v. *Paulding*, (14 *Pet.*, 515,) referring to an act of Congress under which the relator in that case claimed a pension which had been refused her by the Secretary of the Navy, this court said: 'If a suit should come before this court which involved the construction of any of these laws, the court certainly would not be bound to adopt the construction given by any head of a department; and if they supposed his decision to be wrong, they would of course so pronounce their judgment. But their construction of a law must be given in a case in which they have jurisdiction, and in which it is their duty to interpret the act of Congress in order to ascertain the rights of the parties in the cause before them. The court could not entertain an appeal from the decision of one of the Secretaries, nor reverse his judgment in any case where the law authorizes him to exercise discretion or judgment; nor can it by mandamus act directly upon the officer, and guide or control his judgment or discretion in the matters committed to his care in the ordinary discharge of his official duties. * * * The interference of courts with the performance of the ordinary duties of the executive department of the government would be productive of nothing but mischief, and we are quite satisfied that such a power was never intended to be given to them.

'This case, as presented to the court below, was within neither of the categories above mentioned. The court, therefore, erred in making the order to which the Commissioner objected.

"The main question passed upon by the Commissioner, and which was supposed to underlie this case, is not before us for consideration. If it were, as at present advised, we are not prepared to say that the decision of the Commissioner was not correct.

"The order of the court below, awarding the mandamus, is reversed with costs, and it is ordered by this court that the application of the relator be by that court overruled and dismissed."

263. PARTIES IN MANDAMUS.—The writ of mandamus, from its very nature and definition, is "a command issuing in the name of the sovereign authority." (*Bouvier's Dict.*) And although it is substantially a civil remedy, (2 *Carter's Ind. R.*, 423,) yet in the United States it has always been issued in the name of the sovereignty by which it has been authorized. (*Moses on Mandamus*, 194.)

The suit, therefore, is properly prosecuted in the name of the United States against the Commissioner of Patents.

264. PROCEEDINGS IN MANDAMUS.—The writ can only be obtained after a rule to show cause has been laid by the court and a copy of it has been served on the Commissioner of Patents. (*Brosius v. Reuter*, 1 *Harr. and Johns.*, 481.) The rule is obtained by filing a petition, in which all the facts and circumstances entitling the party to the mandamus are stated, and which is verified by oath. (*Evans's Practice*, 404.) The petition should present to the court a *prima facie* case of duty on the part of the Commissioner to perform the act demanded,

and an obligation to perform it. (*Moses on Mandamus*, 234.) It should also appear that a demand has been made upon the Commissioner to do the thing he is sought to be compelled to do, and that he has refused or neglected to do it, (*Stephens's Nisi Prius*, 23; 9 *Mich. R.*, 328,) and that he has it in his power to perform the act. (*Ridding* v. *Bell*, 4 *Cal. R.*, 333.)

The Commissioner who appears to show cause why a mandamus should not be issued does so by what is sometimes called a return, sometimes an answer. (*Evans's Practice*, 404.) The return must either deny the facts on which the claim of the relator is founded or must state other facts sufficient in law to defeat the relator's claim. (10 *Wend.*, 20; 35 *Barb.*, 105; 37 *Penn. S. R.*, 237.)

When the return is made and filed, if insufficient, the relator may move to quash it, (*Evans's Practice*, 405; *People* v. *State*, 2 *Barb.*, 554; *Commonwealth* v. *Commissioners*, 32 *Penn. S. R.*, 218;) it may, however, be amended, or a supplementary return filed, should it prove defective, (*Evans's Practice*, 405,) and a return on leave of court may be amended in matters of substance even after exceptions have been made (*Doug. R.*, 135; 10 *Pick. R.*, 59.) The motion, however, for leave to amend should probably set forth specifically the points sought to be corrected. (*State* v. *County Judge*, 12 *Iowa*, 237.)

Motions or applications for mandamus against the Commissioner of Patents may be heard before the general term of the supreme court of the District of Columbia in the first instance, or by one of the justices at chambers, or in special term, but not until the petition, verified by affidavit and stating the grounds of the application, has been filed and docketed, and motion to quash

may be heard in the same manner. (*Rules of Supreme Court of D. C.*)

Upon argument of the law, arising upon the facts disclosed, the court decide that a mandamus shall or shall not go. (*Evans's Practice*, 404.)

The writ is served by delivering it to the person to whom it is directed. Courts enforce compliance with the peremptory writ by attachment of contempt. The application for an attachment is made by a motion, upon which the defendant may show cause, unless the contempt be gross, in which case the rule may be made absolute at first. (*Tidd's Practice*, 484.)

XVI. Designs.

SEC.
265. Subject-matter of design patents.
266. Models may be dispensed with.
267. Term for which granted.
268. Term may be extended.
269. Proceedings the same as in other cases.
270. Photographs.
271. Classification of designs.
272. Disputed questions.
273. Design may embrace a class of ornaments.
274. Designs patentable on account of utility.
275. Modes of operation not to be monopolized under a patent for design.
276. Applicant to elect the term of the patent on application.
277. No provision made for use and sale prior to application.
278. Design shown in a patent for mechanical invention lost.
279. Number of claims allowed.
280. Application for mechanical invention cannot be changed to application for design.
281. Form of petition.
282. Form of specification.
283. Form of oath.

265. SUBJECT-MATTER OF DESIGN PATENTS.—Any person who, by his own industry, genius, efforts, and expense, has invented or 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, 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 duty required by law and other due proceedings had, the same as in cases of inventions or discoveries, obtain a patent therefor. (*Act of July* 8, 1870, § 71; *vide supra*, p. 34, § 71.)

266. MODELS MAY BE DISPENSED WITH.—The Commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs. (*Ib.*, § 72.)

267. TERM FOR WHICH GRANTED.—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. (*Ib.*, § 73.)

268. PATENTS FOR DESIGNS MAY BE EXTENDED.—Patentees of designs issued prior to March 2, 1861, 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 2d day of March, 1861. (*Ib.*, § 74.) Upon extending a patent for a design its utility may be taken into account in estimating its value and importance to the public. (*B. L. Solomon ex parte, Commissioners' Decisions*, 1869, p. 49.)

269. PROCEEDINGS THE SAME AS IN OTHER CASES.—The petition, oath, specification, and other proceedings, are the same as for other patents. (*Patent Office Rules, July,* 1870.)

270. PHOTOGRAPHS.—Photographs are received for the illustration of works of design only. One must be pasted upon thick drawing-paper, but in every case where this mode of illustration is employed by an applicant he will be required to deposit in the office the glass or other "negative" from which the photograph is printed, so that exact official copies may be made therefrom when desirable. (*Ib.*)

271. CLASSIFICATION OF DESIGNS.—In the case of *Bartholomew ex parte* the Commissioner says: "Letters patent for designs have increased in importance within the last few years. Formerly, but few were granted; now, many are issued. To this day they have made so little figure in litigation that but three reported cases are known in which design patents have come into controversy. With their increase questions have arisen concerning their scope and character which have given rise to dispute and to inquiry as to the correctness of the current practice of the office in this branch of invention. While on the one hand it is insisted that the practice has always been uniform, and is therefore now fixed and definite, on the other it is asserted that there has never been, and is not now, any well defined or uniform practice either in the granting or refusal of design patents.

"The act of 1836 made no provision for the patenting of designs. The earliest legislation upon this subject is found in the act of August 29, 1842, section 3; and the

only legislation upon this subject is found in this section and in section 11 of the act of March 2, 1861.

"The definition of the subject-matter, or, in other words, of a 'design,' is the same in both acts. It is as follows: 'That any citizen, &c., who by his, her, or their own industry, genius, efforts, and expense, may have invented or produced any new and original design for a manufacture, whether of metal or other material or materials, and original designs for a bust, statue, bas-relief, or composition in alto or basso-relievo, or any new and original impression being formed in marble or other material, or any new and useful pattern, print, or picture, to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture, or any new and original shape or configuration of any article of manufacture not known or used by others,' &c.

"This definition embraces five particulars:

"1. A new and original design for a manufacture.

"2. An original design for a bust, statue, &c.

"3. A new and original impression or ornament to be placed on any article of manufacture.

"4. A new and useful pattern, print, or picture, to be worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture.

"5. A new and original shape or configuration of any article of manufacture.

"The first three of these classes would seem to refer to ornament only; the fourth, to ornament combined with utility, as in the case of trade-marks; and the fifth, to the shapes or forms of manufactured articles, which, for some reason, were preferable to those previously adopted."

272. DISPUTED QUESTIONS.—"The disputed questions which have thus far arisen under these definitions are: 1. What variations may be claimed or covered by the patent, consistent with unity of design? 2. Is a new shape of an article of manufacture, whereby utility is secured, a subject of protection under this act? and 3. Is mechanical function of any kind covered by it?

"As to the first of these questions, it seems to have been assumed that the design spoken of in all parts of the sections referred to covered a fixed, unchangeable figure; that the protection of the letters patent did not extend to any variation, however slight, but that such variation constituted a new design, might be covered by a new patent, and might safely be used without infringement of the first. This, it is said, is the correct theory of the law, and has been the uniform adjudication of the office."

273. A PATENT FOR A DESIGN MAY EMBRACE A GENUS OR CLASS OF ORNAMENTS, AS WELL AS ONE SPECIES.—"Neither of these statements is absolutely correct. The law by no means defines a design with such strictness. The language is, 'new and original design for a manufacture,' 'new and original impression or ornament,' 'new and original shape or configuration.' It would seem to be too plain for argument that the new design, or impression, or shape might be so generic in its character as to admit of many variations, which should embody its substantial characteristics and be entirely consistent with a substantial identity of form. Thus, if the invention were of a design for an ornamental button, the face of which was grooved with radial rays, it would seem that the first designer of such a button might properly

describe a button of five rays, and, having stated that a greater number of rays might be used, might claim a design consisting generally of radial rays, or of 'five or more' rays, and that it could not be necessary for him to take out a patent for each additional ray that could be cut upon his button. So, if the design were the ornamentation of long combs by a chain of pearls, it would seem that a claim for such a design might be maintained against one who arranged the pearls either in curved or straight lines, or who used half pearls only; and that such modifications, if they had occurred to the designer, might properly have been enumerated in his specification as possible and equivalent variations. In short, I can see no reason, under the law, why designs may not be generic, why what are called 'broad claims' may not be made to them, and why the doctrine of artistic or æsthetic equivalents may not be applied to them.

"This has been recognized to a greater or less extent in the adjudication of the courts and in the practice of the office. One of the reported cases is that of *Booth* v. *Garelly*, (1 *Blatchf.*, 247.) The design is described as consisting of 'radially formed ornaments on the face of the molds or blocks of which the button is formed, combined with the mode of winding the covering on the same, substantially as set forth, whether the covering be of one or more colors.' The specification, in 'substantially' setting forth the design, contained this language: 'It will be obvious from the foregoing that the figures can be changed at pleasure, by giving the desired form to the face of the mold by depressions and elevations which radiate from a point, whether in the center of the mold or eccentric thereto.' In the consideration of the case

by the court no objection was made to this statement or claim. In the case of *Root* v. *Ball*, (4 *McLean*, 180,) the learned judge instructed the jury that 'if they should find that the defendant had infringed the plaintiff's patent by using substantially the same device, as ornamental, on the same part of the stove, they would, of course, find the defendant guilty. To infringe a patent right, it is not necessary that the thing patented should be adopted in every particular; but if, as in the present case, the design and figures were *substantially* adopted by the defendants, they have infringed the plaintiff's right. If they adopt the same principle, the defendants are guilty.

"'The principle of a machine is that combination of mechanical powers which produces a certain result. And, in a case like the present, where ornaments are used for a stove, it is an infringement to adopt the design so as to produce substantially the same appearance.'

"It has been the constant practice to grant patents for designs for fonts of type, for sets of silver plate, for a series of printers' flourishes, and the like. This class of cases has always passed without objection. Two other cases which have arisen within the office deserve notice. The first was for a series of miniature shoulder-straps, with emblems denoting rank, provided with a pin, to be worn under an officer's coat, upon his vest, or as a lady's breastpin. The drawing shows eight of these pins, with emblems of rank, varying from that of second lieutenant to major general, and the specification, describing the brooch for a second lieutenant, goes on to say: 'I propose to introduce on some of them the different ornaments showing the respective ranks of the army

from a major generalship to a second lieutenancy. (See figures 2, 3, 4, 5, 6, 7, 8.')

"The second case was that of an application for a monogram visiting-card, on which the name was to be inscribed or printed in the form of a monogram. The applicant filed a drawing, showing a card upon which was a monogram of his own name. In his specification he gives certain rules for forming such monograms, and then says: 'It is manifest that the form of the letters, as well as the letters themselves, can be changed as required by circumstances or the taste of the individual for whom the monogram is designed, and that the general form and outline of the monogram may be varied, and indeed must vary, to be adapted to the particular name it is required to represent.' The claim was for 'a monogram visiting-card, or visiting-card upon which the name is inscribed or printed in the form of a monogram, substantially as herein specified.' This application was rejected by the examiner and board of examiners-in-chief, but was allowed by the Commissioner upon appeal.

"It is true that before and since this patent was issued many patents have been refused for what I have called generic designs. One man, having designed a tack-head ornamented with radial lines, was compelled to take out one patent for his tack with six radial lines, and another for the same tack with eight. There are other instances of like character, but they only serve to show that the practice of the office has not been uniform, and that the true practice is still to be adopted and followed.

"I have no hesitation in saying, in view of the premises, that a valid patent may be granted for a new genus

or class of ornaments, as well as for specific ornaments, though I do not doubt that, under the statute, every species, variety, and individual, having distinct characteristics, under such a genus, might also be patented, the patent being subordinate and tributary to that which covered the class.

"From the nature of this subject-matter there must always be more latitude in the issue of patents for trifling changes of form or outline, since it is only necessary that such changes should constitute a new design to entitle them to a patent of this class."

274. NEW SHAPES AND CONFIGURATIONS MAY BE PATENTED AS DESIGNS ON ACCOUNT OF THEIR UTILITY, WHEN THAT IS OWING TO THEIR FORM.—"The second question relates to the element of utility in patents for designs.

"Articles have been and are being constantly patented as designs which possess no element of the artistic or ornamental, but are valuable solely because, by a new shape or configuration, they possess more utility than the prior forms of like articles.

"Of this character are designs for ax-heads, for reflectors, for lamp-shades, for the soles of boots and shoes, which have been heretofore patented as designs; and to this class might be added with great propriety that class of so-called 'mechanical' patents granted for mere changes of form, such as plowshares, fan-blowers, propeller blades, and others of like character.

"When, therefore, my learned predecessor, in Crane's case, added to this number a box so designed as to hold with convenience a set of furs, he did but confirm, and not alter, the practice of the office, so far as it can be gleaned from the patented cases.

"I am of opinion that the class of cases named in the act as arising from 'new shape or configuration' includes within it all those new changes of form which involve increase of utility. This I take to be the spirit of the decision in *Wooster* v. *Crane*, (2 *Fish.*, 583.) The design was of a reel in the shape of a rhombus. The learned judge says: 'In this case the reel itself, as an article of manufacture, is conceded to be old, and not the subject of a patent. The shape applied to it by the complainant is also an old, well-known mathematical figure. Now, although it does not appear that any person ever before applied this particular shape to this particular article, I cannot think that the act quoted above was intended to secure to the complainant an exclusive right to use this well-known figure in the manufacture of reels. The act, although it does not require utility in order to secure the benefit of its provisions, does require that the shape produced shall be the result of industry, effort, genius, or expense, and must also, I think, be held to require that the shape or configuration sought to be secured shall at least be new and original as applied to articles of manufacture. But here the shape is a common one in many articles of manufacture, and its application to a reel cannot fairly be said to be the result of industry, genius, effort, and expense. No advantage whatever is pretended to be derived from the adoption of the form selected by the complainant, except the incidental one of using it as a trade-mark. Its selection can hardly be said to be the result of effort even; it was simply an arbitrary, chance selection of one of many well-known shapes, all equally well adapted to the purpose. To hold that such an application of a common

form can be secured by letters patent would be giving the act of 1861 a construction broader than I am willing to give it.'

"It would seem from this language that if there had been 'advantage,' *i. e.*, utility, in the adoption of the form of the rhombus, it would have found more favor in the eyes of the court."

275. NEW MODES OF OPERATION OR CONSTRUCTION CANNOT BE MONOPOLIZED UNDER A PATENT FOR A DESIGN.—"The third question may be readily disposed of. Modes of operation or construction, principles of action, combinations to secure novelty or utility of movement, or compositions of matter, can hardly be said to be 'shapes, configurations, or designs;' but where the sole utility of the new device arises from its new shape or configuration I think it may fairly be included among the subjects which the act of 1842 was designed to protect."

276. APPLICANT TO ELECT THE TERM OF THE PATENT ON APPLICATION.—In the case of *Mayo ex parte*, (*motion*,) the Commissioner says: "The applicant makes application for a patent for a design. He pays ten dollars into the treasury, and adds to his petition the following proviso: 'Should the Commissioner be willing to allow a patent on this application, the undersigned wishes to pay into the treasury the further sum of twenty dollars, and have such patent granted for fourteen years, instead of three and a half years.'

"Section 11 of the act of March 2, 1861, provides that upon application for a patent for a design, 'the Commissioner, on due proceedings had, may grant a patent therefor, as in the case now of application for a patent, for the term of three and one half years, or for the term of seven

years, or for the term of fourteen years, as the said applicant *may elect in his application:* provided that the fee to be paid *in such application* shall be for the term of three years and six months, ten dollars; for seven years, fifteen dollars; and for fourteen years, thirty dollars.'

"This language contemplates an election to be made by the applicant, at the time of his application, of the term for which he desires his patent to issue, and the payment of a fee corresponding to that election. It does not contemplate the contingency of an application for one term and the payment of one fee, and a subsequent election, at the time of issue, of another term and the payment of another fee. The words are, 'elect in his application.' The choice is to be made there and not elsewhere or otherwise, and, being made, must be final.

"I can see that the practice proposed might be desirable, and might result in the granting of design patents for a longer period and the receipt of a larger revenue; but I have no power to alter the plain language of the statute, or to extend the time of election beyond the time of making the application, for any purpose.

"In the present case the applicant has paid a fee of ten dollars. His patent, if granted, can issue only for three and a half years." (*Commissioners' Decisions, February* 23, 1870.)

277. No Provision Made for Use and Sale prior to Application.—In the case of *Stuart and Bridge ex parte,* (*Commissioners' Decisions, February* 23, 1870,) the Commissioner says: "The applicants, on November 3, 1868, patented the arrangement of ovens and flue in a cook stove having a peculiar external conformation. On February

5, 1870, they filed an application for a design identical with that shown in their patent of 1868.

"Upon this state of facts the examiner asks: 1. Should the application be rejected on the patent? 2. If so, can the patentees reissue in two divisions, one of which shall be for the design? 3. If so, what fees are required?

"Section 11 of the act of March 2, 1861, provides that the new design, &c., shall not be 'known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor,' &c.

"It will be observed that no provision is made for use or sale of the invention prior to the application, as in the case of other inventions; and the reason of the distinction is found in the fact, that as designs relate to form and shape only, no time is required for experiment before the application. At all events, the language of the statute is plain. The design must not have been known or used by others prior to the application of the inventor. It is obvious that if the design be described in a prior patent, granted either to himself or others, it is known to others within the meaning of the law. The present application must therefore be rejected upon the former patent."

278. A DESIGN SHOWN IN A PATENT FOR A MECHANICAL INVENTION IS LOST.—"The second question is, whether the original patent can be surrendered and reissued in two divisions, one of which shall be for the design?

"Patents for designs may be granted for three and one half, seven, and fourteen years, at the election of the applicant, made at the time of application. Patents for other inventions are granted for seventeen years.

"The patent granted to applicants in November, 1868,

was of the latter kind, and was granted for seventeen years.

"It is provided by section 13 of the act of 1836 that upon applications for reissue 'it shall be lawful for the Commissioner, &c., to cause a new patent to be issued to the said inventor for the same invention for the residue of the period, then unexpired, for which the original patent was granted.'

"This language is explicit, and it is obvious that under this section any reissue of this patent, or any division of such reissue, must be granted 'for the residue of the period then unexpired for which the original patent was granted;' that is, for the residue of seventeen years. But no patent for a design can be granted for seventeen years, or for the residue of an unexpired period of seventeen years; and this fact seems decisive of the question.

"The result is, that an invention of a design, if shown in a patent for a mechanical invention, is lost, and cannot be included in a subsequent application and patent for a design."

279. NUMBER OF CLAIMS ALLOWED.—In the case of *Sheppard ex parte*, (*motion*,) the Commissioner says: "This case is referred to me by the primary examiner, upon the following statement: 'In this application for patent for design of Isaac A. Sheppard, filed February 24, 1870, are found two claims: one for the central figure, (which constitutes the gist of the case,) when cast on and forming a part of a stove plate, and the other for the central figure and surrounding ornaments.

"'In dealing with this case, the examiner finds that it has not been the usual practice of the office to allow more than one claim in an application for a patent for a design.

The reasons generally given to sustain this course of action are, that a design is a complete and individual device or ornament, and as such must be exact and perfect in every form, line, or configuration, the slightest deviation from what is represented operating to make a new design.

"'The law evidently makes no such inflexible rule of official practice. In the Bartholomew case (*Commissioners' Decisions*, 1869, p. 111) it is observed that a certain reasonable and proper latitude is given in judging what does and what does not breathe the spirit of the invention in any given case, and that mere colorable variation is to receive no more countenance or favor in an application for a patent for a design than it would in an application for a mechanical device.

"'But while the examiner is impressed with these views, he is unwilling in his first decisions, in applications of the present character, to overrule, so far as falls within his jurisdiction, the generally settled custom and rule of the office in the above particular. He desires, therefore, to refer the whole matter to the personal consideration of the Commissioner, as a question of office practice, for his decision or direction.

"'L. DEANE, *Examiner.*'

"I agree with the examiner that there is no provision in, or fair construction of, the act relating to letters patent for designs, which forbids the union of two or more claims or clauses of claim in a single patent. I am at a loss to know upon what ground such a construction can be asserted or maintained. If the design contains features which are new, singly and in combination, no reason is known to me why they may not be so claimed.

"But the practice of the office has not been so uniformly adverse to the granting of double claims as seems to have been supposed. On the contrary, letters patent for designs containing more than one claim were granted in the years 1855, 1857, 1858, 1859, 1860, and 1862, and doubtless in the succeeding years, if time had permitted a further examination. Among these special reference is made to the patent granted to Apollos Richmond, in 1859, which contains one claim for the configuration of a stove plate, and another for the ornament upon the same plate; and to the patent granted to Isaac B. Woodruff, in 1862, for a design for a clock case, which contains one claim for the configuration of the whole case, and another for a gilt frame forming a subordinate part of the same whole.

"These cases fully justify the claims presented in the present application, which may, therefore, be allowed, both upon reason and precedent." (*Commissioners' Decisions, March* 8, 1870.)

280. AN APPLICATION FOR PATENT FOR MECHANICAL INVENTION CANNOT BE CHANGED INTO AN APPLICATION FOR A DESIGN.—Applicant filed, in September, 1868, an application for a patent for "a new and useful improvement in a rolled hollow hexagonal column." He claimed, in terms, "a hollow column of uniform thickness, hexagonal in both its interior and exterior, and rolled out from a solid or welded pile or billet of iron or steel, with a hexagonal opening through it, substantially as described and represented." Becoming satisfied that he could not succeed in obtaining a patent for his supposed invention in this shape, he now proposes to change his application into one for a patent for a design. He asks to be allowed

to deposit a further fee of $15, making $30 in all. He avers that it was by inadvertence and mistake that the fee of $30 was not paid originally, and the application made, in terms, for a patent for a design, under § 11 of the act of March 2, 1861. He presents an amended specification, in which the invention is described as a "new and original shape or configuration of steel or wrought iron rolled pipes, tubes, or hollow shafts or pillars;" and is claimed in the following terms: "As a new and original shape or configuration of tubes, pipes, hollow shafts, or hollow pillars or posts of steel, or wrought or malleable iron, a machine-rolled tube or pipe or hollow shaft or hollow post, of uniform and symmetrical hexagonal perimeter, area, and cross section, in every part of its length, and having no projections upon its surface or beyond its angles." In support of his prayer he urges that the question whether his patent be for an invention or design is merely one of classification, which is within the discretion of the Commissioner, and he insists that this is a case in which that discretion ought to be exercised in his favor.

Prior to the act of August 29, 1842, there was no law which permitted the granting of letters patent for "shapes," "configurations," "designs," "ornaments," "patterns," and the like, which did not involve some mechanical principle, or amount to a new machine or manufacture within the meaning of the patent law.

By that act and the act of March 2, 1861, these subjects were made patentable, not by enlarging the scope of the existing patent laws by the addition of new subjects of invention, but by independent legislation, providing for a new class of patents, granted to a different

class of persons, for a different class of subjects, for different periods of time, and upon the payment of different fees.

It is not a matter of discretion with the Commissioner whether the subject of an application be a machine, or a design for a manufacture; a manufacture, or a new and original shape or configuration of an article of manufacture; a composition of matter, or a composition in alto or basso-relievo; an art, or a pattern, print, or picture. It is a matter of law, in which a mistake is fatal. These subjects of invention or contrivance are in truth as distinct from each other as either is from a copyright.

The applicant treats this matter as if it were simply a matter of mistake as to the term for which he should have applied for letters patent; but in truth the error, if error there were, was in the character of the application itself. He applied for a patent for a new product, paying the fee for an examination, and paying for a patent for seventeen years. He described, not a design for a manufacture, but a manufacture. He claimed, not a new shape, but a new thing. I know of no discretion or authority vested in the Commissioner to turn this application into an application for a design, nor any process by which it can be accomplished short of a new application. A single illustration will make this sufficiently obvious. An alien may apply for letters patent for an invention, but not for a design, unless he has resided in this country for more than one year and made oath of his intention to become a citizen. It would be impossible, therefore, to turn the application of the alien for an invention into an application for a design, how-

ever clearly the subject-matter might place it in the latter class of subjects.

I regard the eleventh section of the act of 1861 as distinct from the remainder of the law as if it formed the subject of a separate statute, and the codifiers of the patent laws evidently so regarded it, for they collected all the matter relating to design patents in a separate chapter. (*Root* v. *Ball*, 4 *McLean*, 180.)

281. FORM OF PETITION FOR LETTERS PATENT FOR A DESIGN.—

To the Commissioner of Patents:

Your petitioner prays that letters patent may be granted to him for the new and original design set forth in the annexed specification.

THOMAS TASTY.

282. FORM OF SPECIFICATION FOR A DESIGN.—

I, Thomas Tasty, of New Haven, in the county of New Haven, and State of Connecticut, have invented and produced a new and original design for carpets, of which the following is a specification:

The nature of my design is fully represented in the accompanying photographic illustration, to which reference is made:

Claim.

I claim as my invention the design for a carpet, as shown.

THOMAS TASTY.

Witness: OLIVE OGLE,
SAMUEL MERRIWEATHER.

283. FORM OF OATH.—

STATE OF NEW YORK, }
County of Albany. } *ss.*

Thomas Tasty, the above-named petitioner, being duly sworn, (or affirmed,) deposes and says, that he verily believes himself to be the original and first inventor of the design for carpets described in the foregoing specification; and that he does not know and does not believe that the same was ever before known or used; and that he is a citizen of the United States.

THOMAS TASTY.

Sworn to and subscribed before me this 13th day of March, 1869.

SIMON SHALLOW,
Justice of the Peace.

XVII. Trade-Marks.

SEC.
284. Act of July 8, 1870.
285. Object and effect of the law.
286. Patent Office requirements.
287. Duplicate copies.
288. Record of assignment.
289. Form of petition and oath.
290. Form of transfer.
291. Form of certificate.

284. ACT OF JULY 8, 1870.—For the provisions of the act of July 8, 1870, concerning trade-marks, see Part I, p. 36.

285. OBJECT AND EFFECT OF THE LAW.—In the case of *King ex parte*, (*Commissioners' Decisions, September* 19, 1870,) the Commissioner says: "Applicant tenders $30 and asks for a patent for fourteen years for a 'design for a trade-mark.' He says: 'The distinctive features of my design consist of my portrait, placed in the center lengthwise, and surmounted by the British coat-of-arms, about which is arranged, in a semicircular form, the words "King's Sauce Royal." Upon the left of my portrait is a shield or tablet, containing the words "Shake well the bottle before using," and upon the opposite side a similar tablet, containing the words "None genuine without my portrait and signature, W. King," said signature being a fac simile of my handwriting. Although the above-named tablets are used, they are not considered as essential to the design, and may be omitted if desired.

"'Having thus fully set forth the nature and merits of my invention, what I claim as new, is: The hereinbefore described design, substantially as shown.'

"Prior to the act of July 8, 1870, no protection was afforded by statute for trade-marks *eo nomine*. They were left to the protection of the common law, except where the design was of such character as to fall properly within

the subjects patentable as designs. In such case they have been patented, usually with the addition of the words 'for a trade-mark.' These words were, however, merely descriptive, and carried with them no guaranty as to the use of the trade-mark. In other words, if goods had been sold with such a design affixed, the only penalty that could have been recovered, under the statute, would have been for the infringement of the design as an ornament, and no recovery could have been had of the damage resulting to the injury to the trade of the manufacturer by a violation of his trade-mark in the sale of the articles to which it was attached.

"It was to remedy this evil, and to give promptly, by statute, that protection to trade-marks which the common law tardily afforded, that Congress passed so much of the act of July 8, 1870, as relates to this subject. By the provisions of that act, a trade-mark, whether old or new, may be registered in the Patent Office by its owner, and by the payment of $25 protection is afforded for thirty years. As this protection is more ample, and covers more than double the time for less money, it is difficult to see why applicant, or any one else, should now seek a design patent for a trade-mark. The folly of the application does not, however, relieve me from the necessity of deciding upon its legality.

"The only clause of the designs act under which trade-marks can possibly fall is that which enumerates 'any new and original impression, ornament, pattern, print, or picture, to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture.' This manifestly refers to the external ornamentation of manufactured articles, and it requires, first, a specific article

of manufacture to be ornamented; and, second, an impression, ornament, pattern, print, or picture to be placed upon it. It was only by a forced construction of this clause that designs which were to be used only as trade-marks or selling labels could be included within it.

"But the subject is relieved of all difficulty by § 77 of the late statute. It is there enacted 'that any person, corporation, &c., who are entitled to the exclusive use of any lawful trade-mark, or who intended to adopt and use any trade-mark, for exclusive use within the United States, *may obtain protection for such lawful trade-mark* by complying with the following provisions.' This provision, by prescribing the statutory mode of obtaining protection for a trade-mark, excludes all other modes not expressly provided for, and operates as a construction of § 71, in excluding trade-marks from the list of subjects intended to be protected as designs.

"In accordance with this opinion, the present application, and all others which are intended to cover trade-marks, or 'designs for trade-marks,' must be presented under the provisions of §§ 77–84 of the act of July 8, 1870, and not otherwise."

286. PATENT OFFICE REQUIREMENTS.—As to who are entitled to trade-marks, requirements of the law, &c., see Part I, page 36, *et seq.*

Under the provisions of §§ 77 and 81 of the act authorizing the Commissioner to make rules, &c., the following requirements, in addition to those prescribed by law, have been established:

287. DUPLICATE COPIES.—Five duplicate copies of the proposed trade-mark, in addition to the one accompanying the statement and oath of applicant, must be depes-

ited with each application. Certified copies will be furnished at the usual rates. (*Patent Office Rules, July*, 1870.)

288. ASSIGNMENT OF TRADE-MARK TO BE RECORDED SIXTY DAYS AFTER ITS EXECUTION.—The right to the use of any trade-mark is assignable by any instrument of writing, and such assignment must be recorded in the Patent Office within sixty days after its execution. The fees will be the same as are prescribed for recording assignments of patents. (*Ib.*)

289. FORM OF PETITION AND OATH.—

To the Commissioner of Patents:

Your petitioners, Martin Scott and Henry Newman, partners under the firm name of Scott & Newman, residing in Peacedale, Washington county, Rhode Island, and engaged in the manufacture and sale of cotton sheetings at said Peacedale, represent that they have used for ten years last past, are now using, and have the right to use, a trade-mark for said sheetings, of which the design shown in the annexed drawing is a true copy; which trade-mark has been printed in blue ink upon the outside of each piece of sheetings. They further represent that no other person, firm, or corporation has a right to the use of said trade-mark, or of one substantially the same. They therefore pray that said trade-mark may be registered and recorded in the Patent Office according to law, they having paid into the treasury of the United States the sum of twenty-five dollars, and otherwise complied with the regulations in such case made and provided.

MARTIN SCOTT.
HENRY NEWMAN.

STATE OF RHODE ISLAND, } ss.
County of Washington, }

Martin Scott and Henry Newman, being sworn, make oath and say, that the foregoing statement by them subscribed is true in substance and in fact, as they verily believe.

MARTIN SCOTT.
HENRY NEWMAN.

Sworn to and subscribed before me this 15th day of July, 1870.

JOHN JUBAT,
Justice of the Peace.

290. FORM OF TRANSFER OF A TRADE-MARK.—

We, Jotham Mills and Abner Clark, of Keokuk, Iowa, partners under the firm name of Mills & Clark, in consideration of five hundred dollars, to us paid by Jarvis Case, of the same place, do hereby sell, assign, and transfer to the said Jarvis Case and his assigns the exclusive right to use, in the manufacture and sale of stoves, a certain trade-mark for stoves deposited by us in the United States Patent Office, and recorded therein July 15, 1870; the same to be held, enjoyed, and used by the said Jarvis Case as fully and entirely as the same would have been held and enjoyed by us if this grant had not been made.

Witness our hands this 20th day of July, 1870.

JOTHAM MILLS.
ABNER CLARK.

291. FORM OF CERTIFICATE.—

UNITED STATES PATENT OFFICE.

To all whom it may concern:

THIS IS TO CERTIFY, That ——— ——— did, on the —— day of ———, 187–, deposit in the United States Patent Office for registration a certain trade-mark for ———, whereof a copy is hereto annexed; that —— filed therewith the annexed statement; and, having paid into the Treasury of the United States the sum of twenty-five dollars, and otherwise complied with the acts of Congress in such case made and provided, the said trade-mark has been duly registered and recorded in the said Patent Office, and will remain in force for thirty years from the ——— day of ———, one thousand eight hundred and seventy.

In testimony whereof I have caused the seal of the Patent Office to be hereunto affixed this —— day of ———, 187–, and of the independence of the United States the ninety- ———.

[SEAL.]

———— ————,
Commissioner of Patents.

XVIII. Interference.

SEC.
292. Duty of Commissioner.
293. Patent to issue to prior inventor.
294. Definition of an interference.
295. When declared.
296. When one of the parties has obtained a patent.
297. Each party to file statement under oath.
298. Adjudication by default.
299. When case is closed and may be set for hearing.
300. Appeal in interference cases.

SEC.
301. Notice of declaration of interference.
302. Notice by publication.
303. First applicant presumed to be the prior inventor.
304. Assignment of time for taking testimony.
305. Postponement of hearing.
306. Affidavit required.
307. Examiner in charge of interferences.
308. When an interference will be dissolved.
309. Primary examiner cannot dissolve an interference.
SEC.
310. Two years' public use.
311. When a second interference will be declared.
312. Withdrawal of claims which do not interfere.
313. No amendments allowed.
314. Withdrawal after decision.
315. Interference may be opened to admit new parties.
316. Abandonment in interference cases.
317. Classes into which cases of interference may be divided.

292. DUTY OF COMMISSIONER.—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. (*Act of July* 8, 1870, § 42.)

293. PATENT TO ISSUE TO PRIOR INVENTOR UNLESS APPEAL IS TAKEN.—The Commissioner may issue a patent to the party who shall be adjudged the prior inventor, unless the adverse party shall appeal from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within some time, not less than twenty days, as the Commissioner shall prescribe. (*Ib.*)

294. DEFINITION OF AN "INTERFERENCE."—An "interference" is an interlocutory proceeding for the purpose

of determining which of two or more persons, each or either of whom claims to be the first inventor of a given device or combination, really made the invention first. (*Patent Office Rules, July*, 1870.)

295. WHEN AN INTERFERENCE WILL BE DECLARED.—An interference will be declared in the following cases:

First. When the parties have pending applications before the office at the same time, both or all the parties claiming to be the inventor of the same thing.

Second. When an applicant, having been rejected upon the prior unexpired patent or the prior application of another, claims to have made the invention before the prior applicant or patentee.

Third. When an invention is claimed in a renewed application which is shown or claimed in an application filed or unexpired patent granted prior to the filing of such renewed application.

Fourth. When an applicant for a reissue embraces in his amended specification any new or additional description of his invention, or enlarges his claim, or makes a new one, and thereby includes therein anything which has been claimed in any patent granted subsequent to the date of his original application, as the invention of another person, an interference will be declared between the application and any such unexpired patent or pending application. If the reissue application claims only what was granted in the original patent, it may be put into interference with any pending application in which the same thing is shown; provided the later applicant claims to be the prior inventor and is not barred a patent by public use or abandonment.

Fifth. When an application is found to conflict with

a caveat, the caveator is allowed a period of three months within which to present an application, when an interference may be declared.

Sixth. The office reserves to itself the right, when two applications are pending at the same time, in one of which a device may be described which is claimed in the other, to declare an interference to determine with whom is priority of invention, without reference to the order in which such applications may have been filed. (*Ib.*)

The interference must be in respect to patentable matters, (*Bain* v. *Morse, MS. Appeal Cases*, 1849,) and there can be no interference between applications unless there is a substantial identity of the things for which a patent is sought; if there are material and substantial differences between the two things, there can be no identity and no interference, (*Tyson* v. *Rankin*, *ib.*, 1853;) and where two separate applications for patents for improvements upon the same thing were generally similar in form, and in some respects nearly identical in construction, but the principle, object, and design of each was unlike that of the other, and the end to be attained or effect intended was wholly different, it was held, notwithstanding their general similarity, that the two inventions were not substantially the same, and that there was no interference between them. (*O'Reilly* v. *Smith*, *ib.*, 1853.) A patentable improvement is not an interference. (*Bain* v. *Morse*, *ib.*, 1849.)

An interference may be declared between two applications, if the same invention is substantially described in each of them, though the claim in one case may not be as broad as the specification. The oath as to invention

is to be construed as extending to all described in the schedule, (*King* v. *Gedney*, *ib.*, 1856;) and where a broad claim covers what is embraced in a special or restricted claim made by another party, a conflict exists which must be determined by an interference. (*Sherwood* v. *Searls*, *Commissioners' Decisions*, 1869, p. 112.)

A subsequent application which claims a device which is shown in a prior patent interferes with that patent whether the device be or be not claimed in the patent. In the first place, if the applicant succeeds, it follows, that the patentee can no longer use the whole of that which he has described in his patent; and, in the second, if the applicant makes claim to a device which is shown in an earlier patent, the office can grant no patent to him; for, *prima facie*, he is not the first, but the second inventor. He must prove priority, and the necessity for proof creates the necessity for the interference. (*Wright ex parte*, *Commissioners' Decisions*, *June* 13, 1870.)

An interference is properly declared where no claim can be made upon the device of the party first in the office which would not be embraced in that of the other party. (*Bachelor* v. *Porter*, *Commissioners' Decisions*, 1869, p. 64.)

296. WHERE ONE OF THE PARTIES HAS OBTAINED A PATENT.—The fact that one of the parties has already obtained a patent will not prevent an interference; for, although the Commissioner has no power to cancel a patent already issued, he may, if he finds that another person was the prior inventor, give him also a patent, and thus place them on an equal footing before the courts and the public. (*Patent Office Rules*, *July*, 1870.)

Thus, in the matter of the interference between the

application of J. C. Stoddard and the patent of H. A. Streeter for the same invention, the Commissioner says:

"If these two cases were before me in the form of applications, I should have no hesitation in refusing a patent to both. Unfortunately, Streeter has received a patent; and the question now before me is, whether one should now be granted to Stoddard.

"Aside from the substantial existence of the inventions claimed by Streeter in the prior patents of Stoddard, I find Stoddard to be the prior inventor of the precise 'arrangements' claimed by Streeter. He made a machine in 1866, which was seen by several persons, and the existence of which is fully proved. He swears to the making of another in 1868, at Dayton, Ohio, and this is not contradicted. He preferred, in his earlier patent, to locate the rake in front of the axle, because he thought that when the farmers fully understood it they would rather use it in that way, and he wished it to be fully tried. The other form was made, explained to others, and held in reserve. I have already held that it involved no invention to pass from the one to the other. Nevertheless, having issued a patent to Streeter, it is probably no more than just to issue a like grant to Stoddard, the real inventor of both forms, in order that he may be able to present to the public a grant as complete in the form of its claims as that which has inadvertently been made to his competitor. The decision of the board of examiners-in-chief, awarding priority of invention to Stoddard, is affirmed." (*Commissioners' Decisions, September* 7, 1870.)

The case of *Luther O. Crocker ex parte* presents interesting questions for consideration. Mr. Justice Fisher says: "In April, 1867, a patent was granted to said

Luther O. Crocker and one George T. Field, they having made an application therefor as *joint inventors*. After this patent had been issued, it appears that these patentees, upon consultation with their counsel, discovered that they were really not joint inventors of the device, but that Luther O. Crocker alone was the inventor. How this misapprehension occurred does not appear; but that Crocker was and is the sole inventor seems to be admitted by Field and also by the Patent Office. That the mistake honestly occurred does not seem to be doubted, as there is no suggestion from the office that there was any fraud practiced by either Field or Crocker. I therefore assume that the mistake, in supposing that they were joint inventors, was honestly made. Finding upon consultation with their counsel that they were laboring under this misapprehension, they set about correcting the error. To this end Crocker filed an application in his own name only for a patent for the same invention, making the oath of course that he was the sole inventor. Soon after filing this separate application he also filed an affidavit made by Field, setting forth the fact that the former patent had been erroneously issued to them as joint inventors, and that, since the explanation given them by their counselor, he was satisfied that Crocker alone was the sole inventor, and renouncing any claim as inventor himself, or as a joint inventor with Crocker.

"The question then arose in the office as to how the error could be cured, and Crocker receive a patent as sole inventor. All agreed that an error had been made, and it seems also to be conceded that it was made not through any fault in the office, but through the innocent ignorance of Crocker and Field. The applicant

demanded a new original patent to be issued to him solely, without any offer on his own behalf or of Crocker and Field to surrender the joint patent for cancellation. But the examiner in charge decided that the 'remedy is not the issue of a new patent, but that the party in amicable error should assign all his interest, real or apparent, to the applicant, who could then properly control a reissue;' and he postponed further action in the case, in order, I suppose, that such assignment might be made, and a reissue granted to Crocker only.

"To this Crocker, the applicant, objected, and insisted that he was entitled to be put in interference with the patent issued to Crocker and Field jointly, and himself declared the prior and sole inventor, on the sworn acknowledgments of himself and Field. The examiner, after a consideration of the matter, adhered to his original decision, and held that 'the applicant is the party in error, and cannot, through such error, force the office into the dilemma of either deliberately granting two patents for the same identical invention, or going through the form of a "*quasi interference.*"' The applicant still pressing for his new patent, the examiner finally rejected the application on the 3d of April, 1868, in order, as he says, 'to put the case in process to become subject to appeal upon the question at issue.' Accordingly Crocker made his appeal to the board of examiners-in-chief. This board decided that 'the patent issued to Crocker and Field is void *ab initio*, because it was issued to two parties as joint inventors, whereas Crocker was the sole inventor; and that thus, being void *ab initio*, an applicant for a patent cannot be put in interference with a patent which does not exist, and, for the same reason, there can be no party

to assign his interest, for he can have no interest to assign in a void patent.' From their reasoning it would seem that the applicant, Crocker, had no remedy either by a reissue or new original sole patent. Having pronounced the joint patent void, and treating it as no patent, we could hardly suppose it would support a reissue, any more than it would support an interference, which they pronounce impossible, because, as they say, the joint patent had actually no existence, and therefore there is no patent for Crocker's application to be put in interference with. They strangely enough, however, agree with the examiner that the application should be rejected, though they 'do not concur with him in the reasons which he has given for his decision or the remedy he suggests,' to wit, the assignment by Crocker and Field of the joint patent to Crocker, the surrender of the same by Crocker, and a reissue upon that surrender. They suggest, however, that the remedy of the applicant is in the surrender of the invalid patent, 'and in a reissue or granting of a new patent to the inventor (Crocker) for the residue of the period unexpired.' So that, although they say they do not concur in the remedy suggested by the examiner, they really do concur in it. The examiner suggests a reissue as the remedy; the board suggests the same remedy. They only, in fact, differ with him as to how the reissue is to be had. The examiner says it may be had by an assignment, made to Crocker alone from Crocker and Field, and then a surrender by Crocker. The board say no assignment can be made, because, the joint patent being void *ab initio*, there is nothing to assign. But it would seem that if there is nothing to assign, there can also be nothing to surrender; and, be-

sides, if, while the old patent is not assignable, it may still be surrenderable, it would seem that Crocker alone cannot surrender it. The surrender would have to be made by both Crocker and Field; and, then, what if Field were unwilling to surrender? How could Crocker compel him?

"The board suggests the remedy of reissue according to the provisions of section 18 of the act of 1836, which they quote in their opinion, and which I quote literally, except that, supposing it applies to cases of joint patentees or inventors, I substitute the plural for the singular number, in order to show that the provisions of that section could not possibly have been enacted to meet cases of the kind now under consideration. With such alterations the section would read thus: 'Whenever any patent which has been heretofore granted, or which shall hereafter be granted, shall be inoperative or invalid by reason of a defective or insufficient description or specification, or by reason of the patentee(s) claiming in his (their) specification as his (their) own invention more than he (they) had or should have a right *to claim as new*, if the error has or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the Commissioner, upon the surrender to him of such patent and the payment of a further duty of $30, to cause a new patent to be issued to the said inventor(s),' &c. Now, under this section, as I interpret it, if this old joint patent be surrendered, the reissued patent based upon it must issue to the same or 'said' patentees (or to the assignee of the same patentees) who took out the original patent upon which the reissue is based, so that a reissue

would be no more valid or operative than the original, the place of which it is to take. In my judgment, this thirteenth section was not intended to correct a mistake as to the parties who take out a patent under the honest but erroneous impression that they are joint inventors. It is simply intended to correct errors which might be made in the claims of the party taking out a patent by reason of the insufficient description of the machine or thing invented, and not to correct the errors of parties who have mistakenly supposed themselves to be joint inventors. It was intended to enable an inventor who had, on the one hand, claimed too much, by describing his claim too broadly, or, on the other, by failing to describe it broadly enough to cover all his invention, to cure these errors, and not to cure errors as to the identity of the inventor. I am, therefore, clear in my conviction that reissue is not the remedy which the patent laws provide for the error committed in this case.

"The question then recurs, can the mistake be cured by the mode suggested by the applicant? Can a new *original* patent be granted to him upon a declaration of interference between his application and the patent heretofore granted to Crocker and Field? I think this is the proper and only remedy, except, perhaps, by proceeding in equity under the sixteenth section of the act of July 4, 1836.

"It is true that Commissioner Foote, in his opinion affirming the decision of the board of examiners-in-chief, says that 'the Patent Office has no authority to issue two patents for the same invention—a joint patent to two parties and a separate one to one of them.' Let us see, first, whether such authority does not exist to issue two patents for the same invention. There can be no doubt

that such authority does exist. Let us suppose that John Doe applies for and receives a patent for an improved ticket-cutter, having invented it six months before he makes his application. Richard Roe, having invented the same thing precisely, six months before John Doe invented it, comes in with his application within two years from the time of the making his invention. The office would not hesitate at once to declare an interference between the patentee and the applicant; and if, upon the hearing, it should appear that Roe was the prior inventor, and was without laches, he also would receive his patent for the same invention, notwithstanding Doe had received one before.

"The whole law on this subject of interference looks to nothing other than granting two patents for the same invention. It is done every month almost, if not every week; and neither party is concluded by the action of the court in granting a patent to the other, but each is free to fight out his claim of priority before the courts. But the trouble of granting two patents in this case, a joint and separate one, seems to be two-fold: First, that Luther O. Crocker was one of the persons to whom the joint patent was issued, and therefore he cannot be put in interference with himself and another as joint patentees; and, second, that because Field had admitted away his joint inventorship before the declaration of interference, therefore the interference, if declared, would merely be a quasi interference. There are no difficulties at all. If another than Crocker had made an application for the patent he now seeks, a declaration of interference would have been made at once. Then why not make it between Crocker and Field and Crocker? One

of two parties may sue the firm of which he is a member, so he may be put in interference with his firm. Nor does the fact that Field swears away the claim of priority of Field and Crocker, in advance of the declaratiou of interference, present any reason why the interference should not be declared and tried. It simply saves time, expense, and trouble in the trial of cases, and that is all.

"But Commissioner Fisher, in his reply to the reasons of appeal in this case, after referring to the opiniou of Commissioner Foote, adds the following, viz:

"'1. This appellant, having heretofore made oath that the invention was joint, cannot now be permitted to allege that it was a sole invention. To permit this would offer a premium to perjury. (*See Child* v. *Adams*, 1 *Fish.*, 189.)

"'2. The remedy, if an honest error existed and any remedy could be afforded, should have been preceded by a surrender of the joint patent for cancellation. That this may be and has been done, see *Batten* v. *Taggart*, (17 *How.*, 84.')

"The very high respect which I entertain for the opinion of the present Commissioner on any question of patent law led me at first to suppose that if any remedy does exist at all for the error in this case, it could not be in the issuing of a new original patent; and, being clear in my conviction that it is not the case for a reissue, as provided for in section 13 of the act of 1836, I suppose the applicant was altogether remediless, except through a bill in equity; and yet it seemed to be hardly in consonance with the spirit of our patent system that a mistake thus honestly made, as this was admitted to be, must go entirely without relief from the office. But on look-

ing into the case of *Child* v. *Adams*, I find that it does not sustain the position which it is cited to sustain. The syllabus of that case, as made by the reporter, and very accurately made too, embraces the following seven propositions only, viz:

"1. Section 13 of the act of July 4, 1836, by defining the condition under which the power it confers shall be examined, necessarily excludes it in all others, except, perhaps, the correction of clerical errors.

"2. Where a statute defines the extent of power given to one who acts ministerially, the courts cannot extend it, or validate acts done without or beyond its authority.

"3. The Commissioner has no power to confirm a patent obtained by false suggestion, either by pardoning the offense or excusing it on the plea of innocent ignorance.

"4. If an alien, either through ignorance or intention, falsely represents himself as a citizen in order to obtain a patent, the patent so procured is inoperative and invalid to vest a title in the alleged invention.

"5. The oath of citizenship and other duties required by section 6 of the act of July 4, 1836, are conditions-precedent, without which the Commissioner has no authority to grant a patent; and a defendant may allege the neglect or fraudulent omission to fulfill these conditions, or any of these, as a sufficient defense.

"6. M, an alien, made oath that he was a citizen of the United States, and obtained a patent. Eight years afterwards he surrendered his patent, made oath that he was a citizen of France, paid the balance of the fee due the Patent Office, and obtained a reissue, which recited (among other things) that said original letters were granted to him upon his belief that he was a citizen of the

United States, which belief arose from ignorance of the laws of the United States: Held, that the original and reissued patents were both invalid, the first because of false suggestions; the second from want of power in the Commissioner to grant it.

"7. Held, also, that the Commissioner could not grant a new original patent eight years after the invention had been in public use.

"Now, the court did not decide in this case that the Frenchman, having once sworn himself to be a citizen of the United States, under an honest misapprehension could not be permitted to allege himself to be a French citizen. On the contrary, it may be fairly inferred, from the opinion delivered in the case, that he might have corrected his honest mistake if he had made timely application to do so in the right way. Judge Grier expressly declares that Mini, (the Frenchman,) with the consent of his assignees, had the right to surrender his original patent to be canceled, 'and when the invention or discovery had not been in public use more than two years the Commissioner might probably grant him a new original patent on an original application,' &c. The learned judge flatly decides that the Commissioner has no power under the 13th section of the act of July 4, 1836, to grant a new patent to one who has obtained it by false suggestion, which shall retroact by way of confirmation of the original or stand in its place; but says that he *probably* has the power to grant a new original patent in such a case, provided the invention or discovery had not been in public use more than two years before filing an original application, truly stating the citizenship of the inventor. So that, in fact, the case of *Child v.*

Adams, so far from militating against the right of the applicant in this case to have a new original patent on his new original sole application, actually favors it. The second proposition of Commissioner Fisher also fails of support from the case of *Batten* v. *Taggert*, viz, that the remedy, if any, could only be found in a surrender of the joint patent for cancellation. The case cited only shows that such a thing had been done, but it does not appear that it was ever decided to be properly and legally done, as it legally was never challenged. It certainly does not decide that a surrender must necessarily precede the granting of a new original patent.

"As Judge Grier, in the case of *Child* v. *Adams*, suggests that the court might *probably* in Mini's case have granted a new original patent on an original application, let us see if it is not more than probable that he had the power to do so. If we refer to the language of the 8th section of the act of 1836, and consider its provisions, we find that that probability rises to a certainty. That section declares that 'whenever an application shall be made for a patent which, in the opinion of the Commissioner, would interfere with any other patent for which an application may be pending, or with an unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to such applicants or patentees, as the case may be; and if either shall be dissatisfied with the decision of the Commissioner on the question of priority of right or invention, on a hearing thereof, he may appeal,' &c. In this case, it is conceded that Crocker has made an original application for a patent, which interferes and is identical with the patent issued to Crocker and Field. This being so, it was

the duty of the Commissioner at once to declare the interference, and to decide the question of priority of invention; and, upon the showing of both Field and Crocker, it appearing that Crocker was the sole inventor, it was his duty, in the absence of the testimony to the contrary, to decide priority in favor of Crocker, and to grant him a new original patent. Had Crocker neglected to make his original application for the sole patent for more than two years, his case would have been in that respect analogous to the case of the Frenchman, Mini, and he would not have been entitled to his new original patent, simply because the invention would have been too long in public use to entitle him to it, as was Mini's case. As I have before said, the fact that Crocker, individually and solely, would be a contesting party against himself and Field jointly would not in the least alter the case; nor would the fact that Field had, under oath, disclaimed all claim of inventorship be any reason for not declaring the interference. The joint patent and the sole application were conflicting claims, and required absolutely an interference to be declared. The duty of the Commissioner in such a case seems, by the terms of the 8th section of the act of 1836, to be made imperative, and, being so, it was error to have refused a declaration of interference and rejected the application for a new original patent to Crocker, as the sole inventor.

"For these reasons the decision of the Commissioner of Patents is reversed." (*MS. Appeal Cases*, 1869.)

297. EACH PARTY TO FILE STATEMENT UNDER OATH.—Upon the declaration of an interference each party will be required, before any time is set for the taking of testimony, to file a statement under oath, giving the date and

a detailed history of the invention, showing the successive experiments, steps of development, extent and character of use, and forms of embodiment. Such statement shall not be open to inspection by the other party until both are filed, or until the time for filing both has expired. (*Patent Office Rules, July*, 1870.)

298. ADJUDICATION BY DEFAULT.—In default of such filing by either party, or if the statement of either fails to overcome the *prima facie* case made by the respective dates of application, or if it shows that the invention has been abandoned, or that it has been in public use for more than two years prior to the application of affiant, the other party shall be entitled to an adjudication by default upon the case as it stands upon the record. (*Ib.*)

299. WHEN THE CASE IS CLOSED AND MAY BE SET FOR HEARING.—Where no testimony is taken by the applicant, upon whom rests the burden of proof, or where testimony has been taken by such applicant, but not by the other party, during the time assigned to the latter, the case will be considered closed, and may, at the expiration of the time assigned to such parties respectively, be set down for hearing at any time not less than ten days thereafter. (*Ib.*)

300. APPEAL IN INTERFERENCE CASES.—In cases of interference parties have the same remedies by appeal as other applicants to the examiners-in-chief and to the Commissioner, *but no appeal lies in such cases from the decision of the Commissioner.* Appeals in interference cases should be accompanied with a brief statement of the reasons thereof. (*Ib.*)

301. NOTICE OF DECLARATION OF INTERFERENCE.—When an interference is declared notice will be given to both

parties or to their attorneys. When one of the parties has filed a caveat, or already received a patent, duplicate notices will be sent to the patentee or caveator and to his attorney of record. (*Ib.*)

302. NOTICE BY PUBLICATION.—Where one of the parties resides abroad and has no known agent in the United States, in addition to the notice sent by mail, notice may be given by publication in a newspaper of general circulation in the city of Washington once in a week for three successive weeks. (*Ib.*)

303. FIRST APPLICANT PRESUMED TO BE THE PRIOR INVENTOR.—In cases of interference the party who first filed so much of his application for a patent as illustrates his invention will be deemed the first inventor in the absence of all proof to the contrary. (*Ib.*)

In the case of *Smith* v. *Burlew* the Commissioner says: "The opinion of the board of examiners-in-chief announces, as a rule of practice, the following extraordinary proposition: 'Heretofore, this board, in cases of interference between an applicant and a patentee, have leaned to the side of the applicant where there has been doubt as to who was the prior inventor, and have been disposed to grant the prayer of the applicant, on the ground that this is expedient in order that it may be determined in a court of law, if the parties so choose, to which of said parties is rightly issued letters-patent.'

"It is an old maxim of the law that *prior tempore, potior jure*, and when a party has made his application and obtained his patent, it would seem that his priority in point of time should entitle him to some consideration as against later and less diligent competitors. Accordingly, by the rules of this office, following the ordinary rules of

evidence, the burden of proof is put upon the last applicant to overcome by evidence the presumption of priority arising from the earlier application. The effect of this rule is to declare that, as the case stands at the declaration of interference, it must be decided in favor of the earlier applicant if no proof be offered; or, if the testimony is equally balanced, it must be decided in his favor; or, if it be simply doubtful, he is entitled to the benefit of the doubt. To give the benefit of the doubt to the last applicant is simply to presume that the first applicant is *not* the first inventor, which would neither be in accordance with law nor common sense. The logical result of such a doctrine would be, in every case where there are two applicants, neither of whom has a patent, but where the proofs raise a doubt, that a patent should issue to both, in order that the courts may decide between them.

"The truth is, that the Patent Office is made by law the tribunal where in the first instance the question of priority is to be determined, and where it is to be determined upon testimony taken and applied according to the ordinary rules of evidence. If there is error, a remedy is given by § 16, act 1836, (*vide supra*, p. 26,) by bill in equity, to either party, whether a patent be issued to him or not. This provision is ample, and takes away all necessity and excuse for foisting upon the country, in the face of the ordinary legal presumptions, two patents for the same invention, both of which may be used as means of speculations upon, or annoyance to, the innocent public.

"The decision of the board of examiners-in-chief is reversed, and the priority is awarded to Smith." (*Commissioners' Decisions, May* 16, 1870.)

As two patents ought not to be granted for the same thing, if it can be avoided, the benefit of a doubt should be given to the patentee on an interference with an applicant. (*Wheeler and Chenoweth, Commissioners' Decisions*, 1869, p. 3.)

304. ASSIGNMENT OF TIME FOR TAKING TESTIMONY.—A time will be assigned in which the other party shall complete his direct testimony; and a further time in which the adverse party shall complete the testimony on his side; and a still further time in which both parties may take rebutting testimony, but shall take no other. If there are more than two parties, the time for taking testimony shall be so arranged, if practicable, that each shall have a like opportunity in his turn, each being held to go forward and prove his case against those who filed their applications before him. (*Patent Office Rules, July*, 1870.)

305. POSTPONEMENT OF HEARING.—There is nothing in the laws relating to the Patent Office, or in the rules adopted by the Commissioner, to prevent him from postponing the hearing of an interference, if, in his opinion, the justice of the case should require it, and especially for the correcting of an irregularity in matters of form. (*Smith* v. *Flickenger, MS. Appeal Cases, D. C.*, 1843.)

Applications for postponement are within the discretion of the Commissioner, and it will be presumed that his discretion has been soundly exercised. (*O'Reilly* v. *Smith, ib.*, 1853.)

Where, therefore, depositions in an interference had been correctly taken, but had not been transmitted in the form required, so that they could be considered by the Commissioner, held that the Commissioner had

right to postpone the hearing, to allow the parties to cure the informality, if he should deem such action necessary to further the ends of justice. (*Ib.*)

306. AFFIDAVIT REQUIRED.—If either party wishes the time for taking his testimony, or for the hearing, postponed, he must make application for such postponement, and must show sufficient reason for it by affidavit filed before the time previously appointed has elapsed, if practicable; and must also furnish his opponent with copies of his affidavits and with reasonable notice of the time of hearing his application. (*Patent Office Rules, July*, 1870.)

Affidavits on which to move for an enlargement of the time to take testimony in an interference, on the ground that the moving party could not obtain the attendance of his witnesses at the time appointed to take their examination, should state the names, competency, and materiality of the witnesses to be examined. (*O'Reilly* v. *Smith, MS. Appeal Cases, D. C.*, 1853.)

307. EXAMINER IN CHARGE OF INTERFERENCES.—Cases of interference will, when the issue is made up and the testimony taken, be tried before the examiner in charge of interferences. (*Patent Office Rules, July*, 1870.)

308. WHEN AN INTERFERENCE WILL BE DISSOLVED.—If an interference has been properly declared, it will not be dissolved without judgment of priority, founded upon the testimony or the written concession of one of the parties, unless the invention is found not to be patentable, or to have been abandoned, or that it has been in public use for more than two years prior to the application of either party, or that no interference in fact exists. (*Ib.*)

In the case of *Duthie* v. *Casilear* the Commissioner says: "This is a motion to dissolve an interference. Several reasons are urged by the attorney for the motion, of which only one will be considered.

"It appears that Duthie's patent was twice rejected by the examiner and once by the examiners-in-chief. Subsequently, through oversight or change of opinion, the examiner allowed a patent to Casilear. He afterward took up the application of Duthie, and, without amendment or order from the Commissioner, reconsidered it, and placed it in interference with the patent of Casilear. This course was irregular. After the decision of the board the case was removed from the jurisdiction of the examiner, and he could not reconsider the case without an order from the Commissioner. It is somewhat difficult to see, also, if the inventions interfere, how a patent was granted to Casilear, a subsequent applicant. At all events, the irregularity in the reconsideration of Duthie's case, and in the declaration of interference, are such that the motion to dissolve the interference must prevail. The interference is dissolved." (*Commissioners' Decisions, September* 15, 1870.)

309. PRIMARY EXAMINER CANNOT DISSOLVE AN INTERFERENCE.—In the case of *Traut* v. *Diston* the Commissioner says: "In this case the primary examiner, upon the filing of an application of one of the Trauts as sole inventor, made an order dissolving the above interference. This order was irregular. After the declaration of an interference it cannot be dissolved except by the order of the examiner in charge of interferences, or the Commissioner, or by the board of examiners-in-chief or Commissioner on appeal. If facts come to the notice

of the primary examiner which render it proper that the interference should be dissolved, or if new cases are filed which he thinks should be included in the interference, he can only act through the examiner in charge of interferences, to whom application must be made.

"The order made by the primary examiner is set aside and the case remanded to the examiner of interferences." (*Commissioners' Decisions, September* 15, 1870.)

310. Two Years' Public Use, (*vide supra*, p. 264.)—In the case of *Young* v. *Hoard* the Commissioner says: "This is a motion to dissolve an interference, upon the ground that the invention is shown to have been in public use for more than two years prior to the application of Young, which was filed April 8, 1870.

"Affidavits have been filed on both sides, from which it appears that the patent with which Young claims an interference was, in fact, granted to John W. Hoard, R. A. Dennison, and Young himself, as assignees of Hoard; that, in company with his copatentees, he sold this patent to the Union Eyelet Company, who proceeded to manufacture under it in May, 1867, and have continued the manufacture until the present time. These facts are not denied by Young, but he asserts that, while the use of the invention by the Union Eyelet Company was begun and continued with his knowledge and consent in May, 1867, and for about six months thereafter, after that time he did not assent to such use, although he admits that it went on in spite of him.

"The admitted facts are fatal to Young's application. It is not necessary that the use should have been a continuing one, extending over a longer period than two years prior to the application, in order to render the

patent void. It is sufficient if it be a public use or sale, at any time and for any length of time, occurring more than two years before the filing of the application. (See *Hunt* v. *Howe*, *Book of Appeals*, vol. 2, p. 380; *Sanders* v. *Logan*, 2 *Fisher*, 167.)

"The motion is sustained, the interference will be dissolved, and the application of Young will be rejected, because the invention claimed by applicant was in public use for more than two years prior to his application." (*Commissioners' Decisions*, *June* 13, 1870.)

811. WHEN A SECOND INTERFERENCE WILL BE DECLARED. A second interference is only a rehearing of the same case. (*Eams* v. *Richards*, *MS. Appeal Cases*, *D. C.*, 1859.)

A second interference will not be declared upon a new application filed by either party during the pendency of an interference or after judgment, nor will a rehearing be granted, unless it be shown to the satisfaction of the Commissioner (in person) that the party desiring a new interference or rehearing has new and material testimony, which he could not have procured in time for the hearing, or unless other sufficient reasons be shown satisfactory to the Commissioner. (*Rules of the Patent Office*, *July*, 1870.)

In the case of *Abraham* v. *Fletcher*, the Acting Commissioner (Hodges) says: "The parties have heretofore been opposed to one another in a previous interference respecting the same invention, as well as two other parties, S. M. Clark and M. T. Gosnell. In the course of the controversy Abraham became satisfied that he was anticipated by Clark, and took no testimony, supposing he could not recover against him. The case was ultimately decided in favor of Fletcher, upon the ground that the device, which

Clark proved that he had originated before Fletcher had made the one in controversy, was not identical with it, but was a different invention. When Abraham learned this, he also ascertained, upon inquiry, that Fletcher's proof did not carry the discovery as far back as he claims that he himself had made it. He thereupon filed a second application. Upon his petition, and upon his showing the circumstances, it was ordered by the Acting Commissioner that the issue of Fletcher's patent should be suspended, and that the present interference should be declared between Abraham's second application and the previous one filed by Fletcher. Fletcher now moves, by his counsel, that this interference should be dissolved, and, secondly, that the order to suspend the issuing of Fletcher's patent should be rescinded.

"It is urged that the interference should be dissolved, in the first place, upon the ground that the decision in the former interference has settled the question as between these parties; that the question of priority has, in other words, become *res adjudicata*; and that Abraham is estopped by it from setting up any claims as a prior inventor against Fletcher. We apprehend that no such effect can be given to these decisions of the office. It is expressly provided in the 12th section of the act of 1836 that they shall not preclude the parties from contesting the validity of a patent in trials at law. There is still less reason for attributing such force to them in proceedings before the office, while the parties are yet before it. Even at law, the decision of a judicial tribunal is not regarded in that light until the term has elapsed and the case has become merged in a judgment beyond the control of the court. And so long as no patent has issued the whole matter is

still pending in the office, and there is nothing which can be regarded as *res adjudicata*, so far as to limit it in the exercise of its usual jurisdiction.

"It should be further remarked, that the doctrine contended for, if sustained, would render all second interferences between the same parties respecting the same invention utterly useless and vain. There would be no question left open between them, but their rights would be established by the result of the first interference beyond the power of the office to modify. Yet, from the earliest organization of the office, it has been the settled practice to declare such second interferences, and therein, when proper, to reverse the decision in the former one. And numerous patents have been granted to the successful parties upon such second interferences, notwithstanding patents had been granted to their adversaries upon the previous trials.

"The 8th section of the act of 1836 has, in fact, always been regarded as imperatively requiring that an interference should be declared whenever a pending application is found to be in conflict with another or with any unexpired patent. It has never been supposed that such an interference could be denied because the question to be raised had already been tried and settled by the office. When it was found that this was open to abuse, and that parties persisted in filing repeated conflicting applications, in order to delay the issuing of a patent to their successful opponents, the rule was adopted that upon the determination of an interference a patent should issue to the party recovering. If, then, the other filed a new application and demanded an interference, it should be granted between that application and the patent which had been issued.

"No more inducement usually remains, therefore, for filing such second application any more than for commencing causeless suits at law. This rule, however, is modified whenever the failing party shows cause why he should have a rehearing, just as courts grant new trials after a verdict. In such cases the issuing of the patent to the winning party is ordered to be suspended, and the interference is declared between his original application and the new application filed by the other party.

"Such were the circumstances of the present case. No question was made upon the hearing as to the reasonableness of the ground upon which the orders were made. The motion is refused." (*Commissioners' Decisions*, 1869, p. 50.)

In the case of *Diston* v. *Emerson*, Acting Commissioner Duncan says: "This is a motion for the reopening of the interference, which is now before the Commissioner on appeal from the decision of the examiners-in-chief in favor of the applicant.

"The patentee has taken no testimony, while the applicant appears to have carried his invention back to a date prior to the filing of the application upon which the patent was granted.

"Patentee now moves for a rehearing, on the ground that since the closing of testimony new evidence has been discovered which he deems material to the issue, said evidence being to the effect that applicant saw the invention going into public use, but neglected to assert his right thereto by warning the public to desist from the practice of that to which he himself was laying claim, and, further, that applicant denounced the invention as visionary, worthless, and impracticable; the apparent

object of this evidence being to show that at best applicant only regarded the invention as experimental and problematic in his hands until after it was reduced to practice and introduced into public use by another, or, if it is to be regarded as perfected by him, that the neglect on his part was such as to constitute a forfeiture of his right to a patent.

"Standing alone, these alleged facts would not establish either of the conclusions named; the authorities cited do not go to this extent; yet from an addendum to the opinion of the examiners-in-chief it appears that there is already in the case evidence of laches on the part of applicant. Said opinion is signed by but two members of the board, and one of these appended a postscript in these words: 'I subscribe this with hesitation, having doubts whether Diston can be said to have exercised reasonable diligence in adapting and perfecting the invention.'

"Under these circumstances it seems desirable to have the further evidence, now offered, bearing upon the question of laches. Taken in connection with the facts already proven, it may have a significance that would not attach to it if considered separately.

"It will be to the advantage of both parties doubtless that the question should be exhaustively investigated before the Patent Office, rather than slighted here, to become, of necessity, a bone of contention before the courts.

"Applicant can hardly complain of the delay that a reopening of the case will occasion, as the record shows that he rested nearly two years after his rejection, upon reference to the patent which he is now seeking to de-

stroy, before taking action to determine the question of priority; the parties owning the patent being allowed to go on, meanwhile, developing a large manufacturing enterprise by a liberal expenditure of capital, all unwarned and unconscious of impending danger.

"The motion is granted and the case will be reopened." (*Commissioners' Decisions, August* 25, 1870.)

In the case of *Covel* v. *Maxim* the Commissioner says: "This is a motion on the part of E. Hall Covel to reopen this case for another hearing and for further testimony.

"The facts are, in substance, as follows: The interference was declared February 2, 1869. Covel, having made oath to his invention sixteen days later than the other applicants, was ruled to take his testimony first, and to close it on the second Monday in March. The day of hearing was fixed for the fifth Monday of March, 1869.

"During the five weeks allotted to him Covel took no testimony whatever; but when it had elapsed he applied to the examiner and to the Commissioner for further time. Upon this application the time was extended to April 26, and the day of hearing was postponed to the second Monday of May. Covel still took no testimony, but allowed the case to go entirely by default. The examiner, therefore, on the day of hearing, had no choice but to decide against him, as his opponents had made the prior oath, and as he, upon whom the burden of proof lay, had taken no testimony whatever.

"As soon as he was notified of this decision, Mr. Covel appeared before the Commissioner, with an application for a rehearing and for further time. Upon hearing his statements, in the presence of the examiner, the Com-

missioner declined to grant him the three months for which he asked upon his unsupported demand, but suggested that he should present affidavits showing the necessity for such an extension. At his own request he was allowed a few days to visit New York upon that errand. This was about June 1.

"Nothing further having been heard from Mr. Covel, on July 9 the examiner addressed a letter to him, notifying him that his affidavits, if he intended to produce any, must be filed within twenty days, as further delay was unreasonable. This notice he alleges he did not receive until after the twenty days had expired; and upon this point, and it is the only one, he is sustained by the affidavits of others.

"Nevertheless he had the twenty days, and when he did hear of the notice he came again to Washington, and obtained from the Acting Commissioner an extension to August 21, thus giving him over twenty days more.

"This time passed like all the former allowances. Not an affidavit was or has been filed showing what testimony he proposed to take, why he needed so long a time to take it, or disclosing any of the facts required upon every motion to open a default or grant a rehearing.

"Finally, on the 7th of September, seventeen days after the last allowance of time, and *four months* after the decision, his motion was finally denied, and the patent was ordered to issue to Maxim and Radley.

"As usual, Mr. Covel now appears again with a motion for more time. Up to the present moment he has taken no proof, has offered no affidavit except his own to show what proof he desires to offer, or that he has proof to offer; and his own affidavits give no details, but are con-

fined to statements of the most general character. The only evidence of vitality that he has shown has been exhibited when the office—its patience outraged beyond limit, and mindful of the fact that the other applicants have some rights in the premises—has notified him that it could delay no longer. It is difficult to believe that such persistent waste of time was not intended simply to delay the issue of a patent to those whom applicant already believed to be the prior inventors. He declares by affidavit that he had no such intention, and he is entitled to the benefit of the doubt; but he by no means makes a case which ought to induce the Commissioner for a moment to delay or suspend the issue of a patent to those who have so long ago been adjudged entitled to receive it, and against whose claim not an iota of testimony has yet been offered after these months of delay.

"The notice of the decision of the examiner fixed a limit of appeal, which has long since passed. This might, in a proper case, have been enlarged, upon motion to the Commissioner. Failing to do this, the right of Maxim and Radley to a patent ought not now to be disturbed, especially as, in the absence of testimony, the correctness of the decision is beyond dispute." (*Commissioners' Decisions*, 1869, p. 78.)

312. WITHDRAWAL OF CLAIMS WHICH DO NOT INTERFERE.—When an application is adjudged to interfere with a part only of another pending application, the interfering parties will be permitted to see or obtain copies of so much only of the specifications as refers to the interfering claims. And either party may, if he so elect, withdraw from his application the claims adjudged not to interfere, and file a new application therefor: *Provided*,

That the claims so withdrawn cover inventions which do not involve the devices in interference: *And provided also*, That the devices in interference are eliminated from the new application. In such case the latter will be examined without reference to the interference from which it was withdrawn. (*Patent Office Rules, July*, 1870.)

313. No AMENDMENTS RECEIVED DURING INTERFERENCE.—No amendments will be received during the pendency of an interference, except as provided in the foregoing section. (*Ib.*)

314. WITHDRAWAL AND REFILING OF APPLICATION AFTER DECISION.—The Commissioner has authority to permit one of two competing applicants for a patent for a similar invention to withdraw his application, after decision upon an interference, and refile his application, and to declare a second interference between such last application and the competing one. (*Wade* v. *Matthews*, 5 *Opinions Attorneys General*, 224.)

But the permission to withdraw an application in such a case will be granted or not, as the Commissioner may be satisfied. The matter is in his discretion, to be exercised when in his opinion the spirit of the law demands it. (*Ib.*, 224.)

315. INTERFERENCE MAY BE OPENED TO ADMIT NEW PARTIES.—There is nothing in the statute limiting the power of the Commissioner to a single interference, and the reason for the declaration of a subsequent interference, if any should appear before the issue of the patent, is as strong as for the first one. When, therefore, an interference was declared between the application of J G W, assignee of A & F, and a patent previously issued to J M S, in which case, upon appeal to him, the chief justice

declared in favor of J G W, and ordered a patent to issue to him, and after the return of the order, but before the issue of the patent, another interference was declared between the same application and the patent issued to A B W, and the chief justice, upon appeal, held this last interference wrongfully declared, and peremptorily ordered the issue of the patent in pursuance of his first order, which was done, it was held, that the chief justice erred, and that the patent issued in accordance with his last order was without authority and void, and should be enjoined. (*Potter* v. *Dixon*, 2 *Fish.*, 381.)

After closing the time for taking testimony in an interference the Commissioner may admit another party to the interference and open the further taking of testimony. (*Laidley* v. *James*, *MS. Appeal Cases*, 1860.)

316. ABANDONMENT IN INTERFERENCE CASES.—In the case of *Rowley* v. *Mason*, (*MS. Appeal Cases*, *D. C.*, 1869,) Mr. Justice Fisher says: "In this case two issues are presented: one of fact, the other of law. The question of fact is whether Mason or Rowley was really the prior inventor of the device in controversy; and the question of law is whether, supposing Mason to have been the first discoverer in point of fact, he has not forfeited his right to a patent by reason of having slept for years on his invention.

"Upon a careful consideration of all the testimony in the case, I have come to the conclusion, though with much hesitation, that Mason invented the device claimed in this case in the year 1859, and reduced his invention to a fixed, positive, and practical form, and is therefore the first inventor.

"I now proceed to the inquiry whether he has or has

not forfeited his right to a patent as against a subsequent, independent inventor, for there is no question in my mind that Rowley is such.

"Mason perfected his invention in 1859, but failed to file his application until January, 1868, a period of about nine years thus intervening between the time of the perfection of his invention and the making of his application for letters patent.

"In the meantime, to wit, during the year 1866, Rowley, without any knowledge, so far as appears to us, of the invention having been made by Mason, perfects the identical device which Mason had perfected seven years previously, and files his application November 26, 1867. Rowley seems not to have lost any time unnecessarily in making his claim, and undoubtedly would have been entitled to his patent if the device had never been invented by Mason. So, if Mason had not perfected his invention, Rowley would undoubtedly have been entitled to a patent over him. No principle of patent law is better settled than that which was declared by Justice Story in the case of *Woodcock* v. *Parker*, (1 *Story*, 590,) wherein he says: 'In a race of diligence between two independent inventors, he who first reduces his invention to a fixed, positive, and practical form would seem to be entitled to a right to a patent therefor.' This principle is founded in sound policy. The great object of the patent law is the promotion of the arts and sciences as rapidly as possible, by means of holding out to inventors an exclusive monopoly in their inventions for a limited term, and the principle laid down by Justice Story conforms to the spirit of our patent system. Were it otherwise than he decided, inventors would sleep upon

their inchoate inventions, and put off their reduction to practical form to a more convenient season; the result of which would be, in many instances, the loss of useful inventions and improvements which they had begun and might well have perfected, whilst other inventors would be deterred from expending their money and brain-work in perfecting inventions by the apprehension that some more sluggish genius might step in and anticipate the fruits of their labors at the eleventh hour. The same sound policy seems to me to require that, as between two independent inventors, the one who has perfected his invention, but chooses to sleep upon it for nine years, or even a less period, and is only aroused from his slumbers by the application of a subsequent inventor for his patent, has no right to complain if that application should meet with success. It is also well settled that he who has abandoned an invention, even after it has been perfected, and dedicates it to the public, no matter for what reason, the dedication cannot be recalled. (See *Ransom* v. *Mayor of New York*, 1 *Fish.*, 252.)

"In the case of *Adams* v. *Jones*, (1 *Fish.*, 527,) it was decided that a man might justly be treated as having abandoned his application for a patent if, by reason of laches on his part, his application was not prosecuted with reasonable diligence. In *White* v. *Allen*, (2 *Fish.*, 440,) it was decided that when an invention is voluntarily broken up and laid aside, without any controlling impediment in the way of an application for a patent, and no other in the mean time invents the same thing, without any knowledge of that which is so suspended, and reduces the same to practice, applies for and takes out his patent, and introduces the patented invention to

public use, he must be regarded as the original and first inventor of the improvement.

"These decisions are all founded upon the same sound policy to which I have alluded. It is true that the law looks with indulgence upon delays which arise from the circumstances of parties who may make an invention, but it is equally true that when the invention, although perfected, has been intentionally abandoned or neglected, or the parties show by their acts that they have not done all that they can do, the law declares that they shall not be protected. (See *Sayles* v. *Chicago and Northwestern Railroad Company*, 2 *Fish.*, 523.)

"In this case I fail to see any reason why Mason could not have prosecuted his claim for a patent as well in 1860 or 1861 as after Rowley had filed his application. He has certainly been guilty of laches in so long sleeping upon his invention, and I can account for his neglect in no other way than upon the ground that he has abandoned it. It would certainly be bad policy if, after the space of nine years from the perfection of an invention, during all which time it was kept a secret in the brain of the inventor, he might come into the Patent Office and defeat the claim of a subsequent and independent inventor, who, honestly believing himself to have been the first discoverer of the improvement, had invested his whole estate in an honest effort to give to the public the benefit of his labors. If one might lie by quietly for nine years, he might do so for forty. Such a rule of law, we may readily see, so far from tending to encourage the promotion of the arts and sciences, would tend greatly to its discouragement, because no man would feel safe against the dishonest practices of the marauder

or pirate, who would not find it difficult to procure, for a reward, witnesses enough to swear up his priority, and fix a period of discovery which the honest inventor would find it hard enough to disprove.

"It is admitted by Mason that if the patent for the device in question had been obtained by Rowley, his (Mason's) claim for a patent could not properly have been allowed. But I can see no reason for the distinction between the case when the patent has been obtained by the subsequent and independent inventor, and a case of a pending application of the latter. What is the reason why the obtaining of a patent by a subsequent inventor should operate to prevent the issuing of a patent to the original inventor sleeping for years on his discovery? It certainly cannot be because of the obtaining of the patent *per se*, for a patent may issue to one, and if afterwards application is made by another, who can show himself to be the prior inventor, and not in fault in making his application after the first patent had been issued, the obtaining of the first patent would be no impediment to his obtaining a second. There must be therefore some other reason, and I find that reason sound in policy which dictates that inventors should not be allowed to play the part of the dog in the manger, by putting aside their inventions and keeping them a secret from the world for a long period of years, and only bringing them to light when they have learned that some other inventor has made the identical discovery, and is about to benefit himself and the world by making it public.

"To my mind there can be no stronger evidence of an intention to abandon an invention than breaking it

in pieces or throwing it aside, and thus neglecting it for a period of nine years.

"For these reasons the decision of the Commissioner of Patents is reversed, and it is ordered that a patent be issued to S. B. Rowley for the invention in controversy."

In the case of *Erbe* v. *Hill* the Commissioner says: "Hill applied for a patent in April, 1862, and obtained it in the following July. Erbe applied for a patent in October, 1864, more than two years after the issue of the patent to Hill. The issue of letters patent is a public act, of which Erbe was bound to take notice; and therefore, in contemplation of law, he knew of the issue of Hill's patent, and delayed his application for more than two years afterward. He now proves his own invention to have taken place in December, 1860, but offers no excuse for his protracted delay in applying for a patent.

"If there be such a thing as a race of diligence between two inventors, Erbe has long ago been distanced; if there be such a thing as laches, he has been guilty of it. If these reasons were not fatal to his claim, it is sufficient to say that his case is not distinguishable, on principle, from that of *Rowley* v. *Mason*, decided by Mr. Justice Fisher in May last, and, upon the authority of that case, his application must be denied.

"The decision of the board of examiners-in-chief is affirmed." (*Commissioners' Decisions*, 1869, p. 29.)

The decision of the Commissioner in the case of *Erbe* v. *Hill* was affirmed by Mr. Justice Fisher. The learned judge says: "Erbe seems to have completed his invention in December, 1860, and then to have slept upon it until 1864, nearly four years. Meanwhile Hill, independ-

ently, perfects the same invention in the early part of the year 1862, and immediately offers it to the public by applying for letters patent, which were granted. More than two years after Hill had taken out his patent Erbe awakes from his slumbers and claims priority of invention. It is too late. It is against the spirit of our patent system, and would be subversive of its policy, if men are allowed to wait for years after others—independent, though subsequent inventors—have taken out letters patent, and then, finding those letters patent to be valuable, to establish priority, after having slept so long with their inventions buried to the world. The cases of *Rowley* v. *Mason* and *Carlton and Merrill* v. *Atwood*, lately decided by me, are directly in point." (*Erbe* v. *Hill*, *MS. Appeal Cases*, *D. C.*, 1869.)

It would appear from the decisions of Mr. Justice Fisher, in the cases of *Rowley* v. *Mason* and *Erbe* v. *Hill*, above cited, that if an applicant, with no sufficient impediment in the way, delays to apply for two years after a patent for his invention has issued to another, he forfeits his title.

Where there has not been a public use, and there is no proof of abandonment in fact, it should not be presumed against the first applicant on account of mere delay in making an application. (*Woerd* v. *Bacon*, *Commissioners' Decisions*, 1869, p. 16.) Affirmed by Mr. Justice Fisher. (*MS. Appeal Cases*, *D. C.*, 1869.)

Three and a half years' delay in applying for a patent, after another person has obtained one for the same invention, cannot be excused by sickness, if the applicant has been attending meanwhile to other business. (*Wheeler* v. *Chenoweth & Merrill*, *Commissioners' Decisions*, 1869, p.

43.) Affirmed by Mr. Justice Fisher. (*MS. Appeal Cases, D. C.*, 1869.)

An inventor who made a drawing of his invention, but took no further steps for six years, when he filed his application, cannot prevail against his competitor, who had, in the mean time, devised it and obtained a patent. (*Wood* v. *Crowell, Commissioners' Decisions*, 1869, p. 107.)

In the case of *Merrill* v. *Atwood*, a lamp burner, embodying the device in controversy, was held to be an abandoned experiment, it having been prepared to test another invention, and after being used several evenings laid aside for years, until the interference was declared. (*Commissioners' Decisions*, 1869, p. 6, *affirmed*, *MS. Appeal Cases, D. C.*, 1869.)

In the case of *Mason ex parte, MS. Appeal Cases, D. C.*, 1870, the following question was submitted: "Whether the proposition in regard to laches of the applicant, John L. Mason, was intended to apply to the case of an *ex parte* application with the same effect as when the rights of an adverse claimant were likely to be affected by such laches?" In deciding this question, Mr. Justice Fisher says: "In reply to the second question, I have to say, that the case before me being that of adverse claimants, the proposition in regard to laches had reference and was intended to apply to such cases only, and not to the case of an *ex parte* application. The view which I entertain on the subject of laches is simply this: that the inventor who conceals his invention, or fails to take the steps necessary to secure his patent therefor, does so at the risk of being postponed in his claim by the coming in of a subsequent independent inventor, who is diligent in giving the world the benefit of his invention, just as he

takes the risks of losing the benefits of his invention by consenting to or allowing its public sale or use for the time fixed in the act of Congress as a bar against him. If he conceals his invention for any length of time, no matter how long, and it does not get into public use or on sale for more than two years by his consent or allowance, and it is not subsequently invented by another, who applies before him, and there is reasonable grounds to believe that he did not abandon it, I do not suppose that lapse of time *per se* would be cause for refusing his application for a patent."

317. CLASSES INTO WHICH CASES OF INTERFERENCE MAY BE DIVIDED.—Cases of interference may be naturally divided into two leading classes. The first comprises those in which the applicants are both original and independent inventors, and the only question left for decision is, which was the *first* inventor? The parties, in this class of cases, may be, and usually are, widely separated; they have no connection whatever with each other. The coincidence of invention is accidental, or rather results from the fact that the new improvement is one which is demanded by the state of arts, and one which many men are seeking, at the same time, to discover or develop.

The question of priority in such cases is usually one of easy solution. It is to be determined by ascertaining which of the parties first reduced the invention to a practicable form, either by a drawing, sufficient of itself to enable an artisan to make the thing invented, or by a sketch, accompanied by written description, or by model, or full-sized machine. In such cases, mere conversations, as proof of invention, however explicit in detail, should not be accepted, unless such conversations consisted of

directions to workmen to enable them to construct a machine which was actually built at the time and from such directions.

The second class of interference comprises those cases in which two men have been more or less connected in the work of invention; where the relation of partner, or employer and employee, or friend or fellow-workman, has, in some form, existed; where the invention, if it be the act of both, takes place at or about the same time; and where the real question is not so much one of priority, but of originality; where, in short, it is charged or inferred that one of the parties is claiming that which he has stolen from the other. This class may be again subdivided into three: First, where the parties are fellow-townsmen or workmen, or so situated that either might have known of the movements of the other; second, where one party is in the general employment of the other, and in the course of his work has hit upon some improvement in the tools or processes with which he works; third, where the one has been specially employed by the other to assist in developing or embodying the very invention in controversy. The cases which fall within the second class are by far the most difficult. The testimony is usually contradictory, and the parties, surrounded by a troop of partisans, clerks, or workmen, appear, and, like the seamen of opposing vessels in a collision case, swear directly in each other's faces. Each is at pains to deny every fact, material and immaterial, asserted by the other, until the judge is compelled to grope painfully through a mass of contradictory evidence to find some fact, as a basis for a decision, which has escaped the fury of the conflict. There may be some presumptions which

will render it possible to approximate to the truth. It may be said, in general, that in cases falling under the first subdivision, the evidence necessary to establish priority should be substantially the same as in cases of the first class, to wit, that he is the first inventor who has first reduced the invention to practice. As to the second and third subdivisions, it may be safely asserted that the presumption is that the workman is the inventor in the former case, and that the employer is in the latter.

When workmen are employed in large establishments, it is a natural and common mistake for employers to suppose that they are entitled to the brain-work as well as the hand-work of their employees; that if a valuable invention is made, as in some measure it is the product of their capital and of the mind of their servant, they have acquired such a title to it as to be able to consider themselves the inventors. This is especially the case when the employer has conversed with the workmen during the progress of the work, or has exhibited any interest in its successful completion. They confound the supply of material with the supply of ideas, and sometimes confidently claim to be the inventors of mechanism which they would find it difficult to describe and impossible to operate.

But where a man has conceived an idea and given to it more or less development, and employs a mere workman to put it into shape, it is obvious that much confusion is likely to follow, proportioned to the mechanical skill of the workman and the lack of it in the projector. So many suggestions and hints may be furnished by the workman, that at last he ceases to remember the parentage of the underlying idea, and fancies that the whole

machine is the product of his own invention. It must be rare, however, in such cases, that the labors of the mechanic or model-maker can raise him to a higher rank than that of joint inventor with him who has the original conception, while, in the great majority of cases, the safer rule is undoubtedly that adopted by the Supreme Court of the United States in the late case of *Agawam Woolen Company* v. *Jordan*, (7 Wall., 583,) where it is said: "When a person has discovered an improved principle in a machine, manufacture, or composition of matter, and employs other persons to assist him in carrying out that principle, and they, in the course of experiments arising from that employment, make valuable discoveries ancillary to the plan and preconceived design of the employer, such suggested improvements are, in general, to be regarded as the property of the party who discovered the original improved principle, and may be embodied in his patent as a part of his invention." (*Foster* v. *Fowle*, *Commissioners' Decisions*, 1869, p. 35.)

XIX. Affidavits and Depositions.

SEC.		SEC.	
318.	Commissioner may establish rules.	327.	Notice of objection.
319.	Before whom taken.	328.	Force and effect of rules.
320.	Clerk to issue subpena.	329.	Service of notice for taking testimony.
321.	Penalty for refusing to appear and testify.	330.	Object and requisites of notice.
322.	Rules of the Patent Office.	331.	How testimony is to be taken.
323.	Notice.	332.	Magistrate's certificate.
324.	Certified copy of caveat.	333.	Formal objections.
325.	Evidence to be sealed, &c.	334.	Access to testimony; copies.
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SEC.
338. Testimony received by agreement of parties.
337. Testimony taken on former interference.
338. Assignment of time.
339. Postponement.
340. Form of notice of taking testimony.
341. Form of deposition.
342. Form of certificate.

318. COMMISSIONER MAY ESTABLISH RULES FOR TAKING AFFIDAVITS AND DEPOSITIONS.—The Commissioner may establish rules for taking affidavits and depositions. (*Act of July* 8, 1870, § 43.)

319. BEFORE WHOM TAKEN.—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. (*Ib.*)

As to what officers are authorized to administer oaths *vide supra*, p. 318.

320. CLERK TO ISSUE SUBPŒNA.—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 his agent or attorney, issue subpena for any witness residing or being within said district or Territory, commanding him to appear and testify before any officer in said district or Territory, authorized to take depositions and affidavits, at any time and place in the subpena stated. (*Ib.*, § 44.)

321. PENALTY FOR REFUSING TO APPEAR AND TESTIFY. If any witness, after being duly served with such subpena, shall neglect or refuse to appear, or, after appearing, shall refuse to testify, the judge of the court whose clerk issued the subpena may, on proof of such neglect

or refusal, enforce obedience to the process, or punish the disobedience as in other like cases. (*Ib.*)

A person who, after being regularly served with a subpena, refuses or neglects to attend the trial, may be proceeded against by attachment. It is presumed also that an action on the case may be maintained against him; but before an attachment will be granted it must appear that the subpena was personally served upon him a reasonable time before the trial, and that the fees allowed by law were paid or tendered to him.

In the courts of the United States witnesses are entitled to the sum of one dollar and fifty cents for each day's attendance at the court, to the further sum of five cents per mile for traveling from their place of abode to the place where the court is holden, and to the like allowance for returning. (*Act of February* 26, 1853, c. 80.) The sum, therefore, which it is necessary to tender upon serving a subpena is one dollar and fifty cents for one day's attendance, and ten cents for each mile of distance between the residence of the witness and the place where the court is to be held. (*Conklin's Treatise*, 386.)

322. RULES OF THE PATENT OFFICE FOR TAKING AND TRANSMITTING EVIDENCE.—In interference, extension, and other contested cases the following rules have been established for taking and transmitting evidence:

323. NOTICE.—First. That, before the deposition of a witness or witnesses be taken by either party, due notice shall be given to the opposite party, as hereinafter provided, of the time and place when and where such deposition or depositions will be taken, with the names and residences of the witness or witnesses then and there to be examined, so that the opposite party, either in person

or by attorney, shall have full opportunity to cross-examine the witness or witnesses: *Provided*, That if the opposite party or his counsel be actually present at the taking of testimony, witnesses not named in the notice may be examined, but not otherwise. And such notice shall, *with proof of service of the same*, be attached to the deposition or depositions, whether the party cross-examine or not; and such notice shall be given in sufficient time for the appearance of the opposite party.

324. CERTIFIED COPY OF CAVEAT.—Second. That, whenever a party relies upon a caveat to establish the date of his invention, a certified copy thereof must be filed in evidence, with due notice to the opposite party, as no notice can be taken by the office of a caveat filed in its secret archives.

325. EVIDENCE TO BE SEALED, &c.—Third. That all evidence, &c., shall be sealed up, entitled upon the envelope with the name of the case in which it is taken, and addressed to the Commissioner of Patents by the person before whom it shall be taken, and so certified thereon, and forwarded, *immediately upon the close of the examination*, to the Patent Office.

326. EX PARTE TESTIMONY.—Fourth. In cases of extension, where no opposition is made, *ex parte* testimony will be received from the applicant; and such testimony as may have been taken by the applicant prior to notice of opposition shall be received, unless taken within thirty days after filing the petition for the extension; *Provided*, That immediately upon receiving notice of opposition the applicant shall give notice to the opposing party or parties of the names and residences of the witnesses whose testimony has thus been taken.

327. NOTICE OF OBJECTION.—Fifth. That no evidence touching the matter at issue will be *considered* upon the day of hearing which shall not have been taken and filed in compliance with these rules: *Provided*, Notice of the objection has been given, as hereinafter prescribed, (*vide infra*, § 314:) *Provided also*, That if either party shall be unable, for good and sufficient reasons, to procure the testimony of a witness or witnesses within the stipulated time, it shall be the duty of said party to give notice of the same to the Commissioner of Patents, accompanied by statements, *under oath*, of the cause of such inability, and of the names of such witnesses, and of the facts expected to be proved by them, and of the *steps* which have been taken to procure said testimony, and of *the time* or *times* when efforts have been made to procure it; which last-mentioned notice to the Commissioner shall be received by him previous to the day of hearing aforesaid. (*Patent Office Rules, July*, 1870.)

328. FORCE AND EFFECT OF PATENT OFFICE RULES. The rules and regulations of the Patent Office, as to taking testimony in cases of interference, are binding upon the parties, and each is entitled to the benefits of them, and, until abrogated, they are as binding upon the Commissioner himself as if enacted by the statute itself. (*O'Hara* v. *Haws*, *MS. Appeal Cases, D. C.*, 1859.)

The power granted to the Patent Office to make rules in respect to the taking of evidence gives no new right to make new rules of evidence, or to make new rules of law, or to divest vested rights by its rules of practice. (*Dyson ex parte*, *ib.*, 1860.)

Evidence taken under the rules established by the Commissioner of Patents, under the statute, must not

only be taken agreeably to these rules, but must be evidence competent in law. (*Arnold* v. *Bishop*, *ib.*, 1841.)

The rules referred to do not prohibit the Commissioner from looking into the deposition informally transmitted, or reading it and ascertaining its contents; but only prohibit him from considering it as evidence touching the matter in issue. (*Smith* v. *Flickenger*, *ib.*, 1843.)

The rules of the Patent Office as to the taking of testimony are to be just and reasonable, according to the established principles and precedents in like cases. (*Nichols* v. *Harris*, *ib.*, 1854.)

329. SERVICE OF NOTICE FOR TAKING TESTIMONY.—The notice for taking testimony must be served by delivering a copy to the adverse party, or his agent or attorney of record or counsel, or by leaving a copy at the party's usual place of residence, with some member of the family who has arrived at the years of discretion. The notice must be annexed to the deposition, with a certificate, duly sworn to, stating the manner and time in which the service was made. (*Patent Office Rules*, *July*, 1870.)

Service of notice to take testimony may be made upon applicant, upon the opponent, upon the attorney of record of either, or, if there be no attorney of record, upon any attorney or agent who takes part in the service of notice or the examination of the witnesses of either party. Where notice to take testimony has already been given to an opponent, and a new opponent subsequently gives notice of his intention to oppose, the examination need not be postponed, but notice thereof may be given to such subsequent opponent by mail or by telegraph. This rule, however, does not apply to *ex parte* examina-

tions, or those of which no notice has been given when notice of opposition is served. (*Ib.*)

330. OBJECT AND REQUISITES OF NOTICE.—The object of notice is to bring the adverse party before the examining officer. Where the party attends before such officer, such notice is mere form and technicality. (*Vide infra*, § 333; *Walker* v. *Forbes*, *MS. Appeal Cases*, *D. C.*, 1861.)

Where no notice of the taking of depositions has been given to the opposite party, but such opposite party or his counsel are present when they are taken, such depositions will not be excluded because of want of notice, and particularly if taken by consent of parties. (*Ib.*)

Depositions, to be used in a matter of interference before the Commissioner of Patents, taken without notice to the opposing party, cannot be used against him, unless he has waived his right to notice, and agreed to admit them to be read in evidence. (*Perry* v. *Cornell*, *ib.*, 1847.)

A notice of taking deposition at a place four hundred miles distant, served eleven days before the time for taking such depositions, is sufficient. (*Smith* v. *Flickenger*, *ib.*, 1843.)

331. HOW TESTIMONY IS TO BE TAKEN; SIGNATURE. The testimony must, if either party desires it, be taken in answer to interrogatories, having the questions and answers committed to writing in their regular order by the magistrate, or, under his direction, by some person not interested in the issue, nor an agent or attorney of one who is. The deposition, when complete, must be signed by the witness. (*Patent Office Rules*, *July*, 1870.)

332. MAGISTRATE'S CERTIFICATE.—The magistrate must append to the deposition his certificate, stating the time and place at which it was taken, the names of the wit-

nesses, (if any,) the administration of the oath, at whose request the testimony was taken, the occasion upon which it was intended to be used, the names of the adverse parties, and whether they were present. (*Ib.*) If the magistrate before whom a deposition is taken fails to certify thereon that it was sealed up by him, it is sufficient ground for excluding such deposition from the consideration of the Commissioner. (*Arnold* v. *Bishop, MS. Appeal Cases, D. C.*, 1841.)

333. FORMAL OR TECHNICAL OBJECTION.—No notice will be taken, at the hearing, of any merely formal or technical objection, unless it shall appear to have wrought a substantial injury to the party raising the objection; and even then, as soon as the party becomes aware of the objection, he must immediately give notice thereof to the office, and also to the opposite party, informing him at the same time that, unless corrected, he shall urge his objection at the hearing. (*Patent Office Rules, July*, 1870.)

334. ACCESS TO TESTIMONY; COPIES.—In contested cases, whether of interference or of extension, parties may have access to the testimony on file prior to the hearing, in presence of the officer in charge; and copies may be obtained by them at the usual rates. (*Ib.*)

335. DEPOSITION CANNOT BE TAKEN BEFORE INTERESTED PARTIES.—Deposition cannot be taken before a magistrate or person who is the attorney or of counsel for either party, or interested in the event of the action. (*Nichols* v. *Harris, MS. Appeal Cases, D. C.*, 1854.)

The officer before whom testimony is taken should stand indifferent between the parties, in no such relation to either of them as to bias him in favor of one more than

the other; more especially he should not be interested in the question at issue. (*Collins* v. *White*, *ib.*, 1860.)

336. TESTIMONY RECEIVED BY AGREEMENT OF PARTIES. By agreement of parties, the testimony of witnesses, otherwise incompetent, may be received and considered. (*Warner* v. *Goodyear*, *ib.*, 1846.)

337. TESTIMONY TAKEN ON A FORMER INTERFERENCE IS ADMISSIBLE ON A SECOND ONE, and may be used without being retaken, although the second interference is declared after an assignment to another party, (*Eams* v. *Richards*, *ib.*, *December*, 1859,) or after application is made by another party, and he is made a party to the interference. (*Carter* v. *Carter*, *ib.*, 1855.)

In the case of *Crowell* v. *Sim*, the Commissioner says: "A preliminary question is made as to an agreement between the parties relating to the introduction of testimony taken in a former interference. The agreement is, that the testimony may be read by the examiner in the present case. Counsel for Crowell claims that this meant nothing more than that the examiner might read the testimony, but that it was not to be treated as evidence; and they further assert that this was fully understood by the parties. Counsel for Sim deny this understanding, and claim that the agreement meant and means, that the examiner should read the former testimony as evidence in this case. As the parties cannot agree as to their verbal statements, I can only construe the paper according to its terms. My opinion is, that 'reading' the testimony can only mean reading it in evidence. Any other construction would render it practically without meaning, and Sim has so far relied upon his own understanding of it as to take no other testimony." (*Commissioners' Decisions*, *July* 26, 1870.)

338. ASSIGNMENT OF TIME IN INTERFERENCE CASES.—In cases of interference the party who first filed so much of his application for a patent as illustrates his invention will be deemed the first inventor in the absence of all proof to the contrary. A time will be assigned in which the other party shall complete his direct testimony; and a further time in which the adverse party shall complete the testimony on his side; and a still further time in which both parties may take rebutting testimony, but shall take no other. If there are more than two parties, the times for taking testimony shall be so arranged, if practicable, that each shall have a like opportunity in his turn, each being held to go forward and prove his case against those who filed their applications before him. (*Patent Office Rules, July*, 1870.)

339. POSTPONEMENT.—If either party wishes the time for taking his testimony, or for the hearing, postponed, he must make application for such postponement, and must show sufficient reason for it by affidavit filed before the time previously appointed has elapsed, if practicable, and must also furnish his opponent with copies of his affidavits and with reasonable notice of the time of hearing his application. (*Ib.*)

340. FORM OF NOTICE OF TAKING TESTIMONY.—

BOSTON, MASS., *March* 29, 1869.

In the matter of the interference between the application of Lyman Osgood for a paper collar machine and the patent No. 85,038, granted December 15, 1868, to Charles Comstock, now pending before the Commissioner of Patents.

SIR: You are hereby notified that on Wednesday, March 31, 1869, at the office of Sextus Tarquin, esq., No. 30 Court street, Boston, Massachusetts, at 9 o'clock in the forenoon, I shall proceed to take the testimony of Truman Truthful, Peter Pivot, and Welcome Story, all of Boston, as witnesses in my behalf.

The examination will continue from day to day until completed. You are invited to attend and cross-examine.

LYMAN OSGOOD,
By PETER PROCTOR, *his Attorney.*

CHARLES COMSTOCK,
Providence, R. I.

Proof of service.

Service of the above notice acknowledged.

CHARLES COMSTOCK,
By CHARLES CAVIL, *his Attorney.*

PROVIDENCE, *R. I., March* 30, 1869.

341. FORM OF DEPOSITION.—

Before the Commissioner of Patents, in the matter of the interference between the application of Lyman Osgood for a paper collar machine and the letters patent No. 85,038, granted December 15, 1868, to Charles Comstock.

Depositions of witnesses examined on behalf of Lyman Osgood, pursuant to the annexed notice, at the office of Sextus Tarquin, No. 30 Court street, Boston, Massachusetts, on Wednesday, March 31, 1869. Present, Peter Proctor, esq., on behalf of Lyman Osgood, and Charles Cavil, esq., on behalf of Charles Comstock.

Truman Truthful, being duly sworn, (or affirmed,) doth depose and say, in answer to interrogatories proposed to him by Peter Proctor, esq., counsel for Lyman Osgood, as follows, to wit:

Question 1. What is your name, age, residence, and occupation?

Answer 1. My name is Truman Truthful; I am forty-three years of age; I am a manufacturer of paper collars, and reside in Chelsea, Massachusetts.

Question 2, &c. * * *

And in answer to cross-interrogatories proposed to him by Charles Cavil, esq., counsel for Charles Comstock, he saith:

Cross-question 1. How long have you known Lyman Osgood?

Answer 1. * * * *

TRUMAN TRUTHFUL.

342. FORM OF CERTIFICATE OF OFFICER.—

COMMONWEALTH OF MASSACHUSETTS, *County of Suffolk.* } ss.

At Boston, in said county, on the 26th day of April, A. D. 1869, before me personally appeared the above-named Truman Truthful, and made

oath that the foregoing deposition by him subscribed contains the truth, the whole truth, and nothing but the truth. The said deposition is taken at the request of Lyman Osgood, to be used upon the hearing of an interference between the claims of the said Lyman Osgood and those of Charles Comstock, before the Commissioner of Patents, on the 3d day of May, A. D. 1869.

The said Charles Comstock was duly notified, as appears by the original notice hereto annexed, and attended by Charles Cavil, esq., his counsel.

SEXTUS TARQUIN,
Justice of the Peace.

The magistrate shall seal up the testimony, and write upon the envelope a short certificate, substantially in the following form, viz:

I hereby certify that the within depositions of Truman Truthful and Peter Pivot, relating to the matter of interference between Lyman Osgood and Charles Comstock, were taken, sealed up, and addressed to the Commissioner of Patents by me this 26th day of April, A. D. 1869.

SEXTUS TARQUIN,
Justice of the Peace.

XX. Evidence.

SEC.
343. Presumption.
344. Declaration and acts of parties.
345. Declaration &c., third parties.
346. Parol and secondary evidence.
347. Patent Office records.
348. Evidence of abandonment.
349. Evidence of priority.
350. Evidence of prior use.
351. Evidence of novelty and utility.
352. Examples of novelty and want of novelty.
353. Examination of parties.
354. Parties in interference cases may testify.
355. Competency of witnesses.
356. Experts.

343. PRESUMPTION.—The general head of presumptive evidence is usually divided into two branches, namely, presumptions of law and presumptions of fact. Presumptions of law consist of those rules which, in certain cases, either forbid or dispense with any ulterior inquiry. They are founded either upon the first princi-

ples of justice, or the laws of nature, or the experienced course of human conduct and affairs, and the connection usually found to exist between certain things. The general doctrines of presumptive evidence are not therefore peculiar to municipal law, but are shared by it in common with other departments of science. Thus, the presumption of a malicious attempt to kill from the deliberate use of a deadly weapon, and the presumption of aquatic habits in an animal found with webbed feet, belong to the same philosophy, differing only in the instance, and not in the principle, of its application. The one fact being proved or ascertained, the other, its uniform concomitant, is universally and safely presumed. It is this uniformly experienced connection which leads to its recognition by the law without other proof; the presumption, however, having more or less force in proportion to the universality of the experience. And this has led to the distribution of presumptions of law into two classes, namely, conclusive and disputable. (*Greenleaf on Evidence*, p. 21.)

Conclusive, or, as they are elsewhere termed, imperative or absolute, presumptions of law, are rules determining the quantity of evidence requisite for the support of any particular averment, which is not permitted to be overcome by any proof that the fact is otherwise. They consist chiefly of those cases in which the long-experienced connection before alluded to has been found so general and uniform, as to render it expedient for the common good that this connection should be taken to be inseparable and universal. They have been adopted by common consent, from motives of public policy, for the sake of greater certainty, and the promotion of peace

and quiet in the community; and therefore it is that all corroborating evidence is dispensed with, and all opposing evidence is forbidden. (*Ib.*)

The second class of presumptions of law, answering to the *præsumptiones juris* of the Roman law, which may always be overcome by opposing proof, consists of those termed disputable presumptions. These, as well as the former, are the result of the general experience of a connection between certain facts or things, the one being usually found to be the companion or the effect of the other. The connection, however, in this class, is not so intimate or so universal as to render it expedient that it should be absolutely and imperatively presumed to exist in every case, all evidence to the contrary being rejected; but yet it is so general, and so nearly universal, that the law itself, without the aid of a jury, infers the one fact from the proved existence of the other, in the absence of all opposing evidence. In this mode the law defines the nature and amount of the evidence which it deems sufficient to establish a *prima facie* case, and to throw the burden of proof on the other party; and if no opposing evidence is offered, the jury are bound to find in favor of the presumption. A contrary verdict would be liable to be set aside, as being against evidence. (*Ib.*, p. 38.)

Presumptions of fact, usually treated as composing the second general head of presumptive evidence, can hardly be said, with propriety, to belong to this branch of the law. They are, in truth, but mere arguments, of which the major premise is not a rule of law; they belong equally to any and every subject-matter; and are to be judged by the common and received tests of the truth

of propositions and the validity of arguments. They depend upon their own natural force and efficacy in generating belief or conviction in the mind, as derived from those connections which are shown by experience, irrespective of any legal relations. They differ from presumptions of law in this essential respect, that while those are reduced to fixed rules, and constitute a branch of the particular system of jurisprudence to which they belong, these merely natural presumptions are derived wholly and directly from the circumstances of the particular case, by means of the common experience of mankind, without the aid or control of any rules of law whatever. Such, for example, is the inference of guilt drawn from the discovery of a broken knife in the pocket of a prisoner, the other part of the blade being found sticking in the window of a house which, by means of such an instrument, had been burglariously entered. These presumptions remain the same in their nature and operation, under whatever code the legal effect or quality of the facts, when found, is to be decided. (*Ib.*, p. 49.)

It is a presumption of law, that when a patent has been obtained, and the specification and drawing recorded in the Patent Office, every man who subsequently takes out a patent for a similar machine has a knowledge of the preceding patent. As in chancery it is a maxim that every man is presumed to have notice of any fact upon which he is put upon inquiry by documents within his possession, if such facts could, by ordinary diligence, be discovered upon such inquiry. It is also a presumption of fact that every man, having within his power the exact means of information, and desirous of securing to himself the benefit of a patent, will ascertain, for his own

interest, whether any one on the public records has acquired a prior right. (*Odiorne* v. *Winkley*, 2 *Gall.*, 55.)

All persons are bound to take knowledge of the doings of the Patent Office in relation to inventions. (*Marcy* v. *Trotter*, *MS. Appeal Cases*, *D. C.*, 1860.)

In the case of the *Philadelphia and Trenton Railroad Company* v. *Stimson*, (14 *Peters*, 458,) Mr. Justice Story said: "It is a presumption of law that all public officers perform their proper official duties until the contrary is proved. And where, as in the present case, an act is to be done, or patent granted upon evidence and proofs to be laid before a public officer, upon which he is to decide, the fact that he has done the act or granted the patent is *prima facie* evidence that the proofs have been regularly made, and were satisfactory. No other tribunal is at liberty to reëxamine or controvert the sufficiency of such proofs, if laid before him, when the law has made such officer the proper judge of their sufficiency and competency. It is not, then, necessary for the patent to contain any recitals that the prerequisites to the grant of it have been duly complied with, for the law makes the presumption; and if, indeed, it were otherwise, the recitals would not help the case, without the auxiliary proof that these prerequisites had been, *de facto*, complied with. This has been the uniform construction, as far as we know, in all our courts of justice upon matters of this sort. Patents for lands, equally with patents for inventions, have been deemed *prima facie* evidence that they were regularly granted, whenever they have been produced under the great seal of the government, without any recitals or proofs that the prerequisites of the acts under which they have been issued have been duly

observed. In cases of patents, the courts of the United States have gone one step further, and as the patentee is required to make oath that he is the true inventor before he can obtain a patent, the patent has been deemed *prima facie* evidence that he has made the invention."

It is a presumption of law that the patentee is the first inventor of the thing patented by him, and the burden of proof is on the party denying it to disprove the fact. (*Pitts* v. *Hall*, 2 *Blatchf.*, 231,) and the burden of proof that a combination is not new is on the party denying that it is not new. (*Hovey* v. *Henry*, 3 *West. Law Jour.*, 154.)

The legal presumption is, from the action of the Patent Office, that a reissued patent is for the same invention as the original patent. (*Hussey* v. *McCormick*, 1 *Fish.*, 509.) The law requiring that an inventor should describe his invention with accuracy and fullness, and it being the duty of the Commissioner of Patents to see that this is done, the presumption is that the patent has been issued upon sufficient foundation. (*Judson* v. *Cope*, 1 *Fish.*, 615.)

A reissued patent is *prima facie* evidence that the original patent was lawfully surrendered and the new one was lawfully granted, (*Knight* v. *Baltimore and Ohio Railroad*, 3 *Fish.*, 1;) and, unless fraud upon the Patent Office is proved, (and it must be proved, never inferred,) it is *prima facie* evidence that there has been no abandonment of the invention to the public; and the burden of proof is on the defendant to show that any surrender to the public has taken place. (*Hoffheim* v. *Brandt*, 3 *Fish.*, 218.) The reissue furnishes *prima facie* evidence that everything necessary to justify the Commissioner in granting the reissue has been produced before the grant

was made, (*ib.*;) and, as the law now stands, the decision of the Commissioner is final and conclusive in cases of reissue, unless impeached for fraud in his or the patentee's acts, or for some irregularity on the face of the papers, or a clear repugnance between the original and reissued patents. (*Blake* v. *Stafford*, 3 *Fish.*, 294.)

However, it is in accordance with the late decisions of the courts, that the decision of the Commissioner is not conclusive upon the substantial identity of the invention claimed in the original." (3 *Fish.*, 439; *vide supra*, p. 570.)

The patent itself is *prima facie* evidence that it was lawfully issued, and that the party who claims it is the original inventor; and, if it be assailed, the proof must come from the party calling the validity in question, (*Hoffheim* v. *Brandt*, 3 *Fish*, 218,) and the original presumptions of novelty and utility arising from the grant of a patent are strengthened by the extension. (*Whitney* v. *Mowry*, 3 *Fish.*, 157.)

It is a presumption of law that what the patentee does not distinctly assert to be his invention was known before. (*Smith* v. *Higgins*, 1 *Fish.*, 587.) It is to be presumed that persons obtaining patents have acquainted themselves with the state of the art in which they are interested, as made known in books or by machines built and put in use, and evidence is not admissible to prove the contrary. (*Ib.*)

The recital in a reissue of a prior assignment, and the action of the Commissioner in granting the patent, make a *prima facie* case of title. (*Middletown Tool Company* v. *Judd*, 3 *Fish.*, 141.)

The constructor of a machine is presumed to be the

inventor, and the burden of proof is on him who denies the fact, and claims to be the inventor, (*Atkinson* v. *Boardman, MS. Appeal Cases, D. C.*, 1847;) but the claim of a draughtsman to an invention which he is employed to put in shape is to be viewed with suspicion, (*Doughty* v. *Clark, Commissioners' Decisions*, 1869, p. 14,) and where an invention is reduced to practice by an operative employed to labor upon it, the presumption is that his employer is the inventor; but, on the other hand, he is presumed to be the inventor if he is laboring under a general employment. (*Foster & Townsend* v. *Fowle*, 35.)

A patent is *prima facie* evidence that the grant of right in it is valid, that the things described in it are new and useful, that they required invention, and that they were the invention of the patentee; and such *prima facie* evidence must have full effect, unless rebutted by sufficient countervailing evidence, (*Potter* v. *Holland*, 1 *Fish.*, 327;) but the *prima facie* force of a patent, as to priority of invention on the part of the patentee, when once destroyed by evidence of prior invention on the part of another, cannot be restored by the patent itself, but only by specific testimony from witnesses. (*Barstow* v. *Swan*, *MS. Appeal Cases*, 1860.)

Under the act of 1790 a patent was made *prima facie* evidence. That act was repealed by the act of 1793, and that provision was not re-enacted in it; hence a patent was not received in courts of justice as even *prima facie* evidence that the invention patented was new or useful; but the plaintiff was bound to prove these facts to make out his case. But the act of 1836 introduced a new system, and under it—its inquisition and examination—a patent is received as *prima facie* evidence of the truth of

the facts asserted in it. (*Corning* v. *Burden*, 15 *How.*, 270.)

344. DECLARATION AND ACTS OF THE PARTIES.—The declarations of a party, at a given time, that he had invented a machine afterward patented, and which he then described, may be received in evidence; but they are not proof that he was the inventor, but only that he said he was, (*Evans* v. *Hetick*, 3 *Wash.*, 410;) and in cases of interfering applications, the declaration of the parties themselves in their own favor, in the absence of each other, are not competent evidence for any purpose, but to ascertain when and what they respectively claimed to have invented. (*Atkinson* v. *Boardman*, *MS. Appeal Cases*, *D. C.*, 1847.)

In the case of the *Philadelphia and Trenton Railroad Company* v. *Stimson*, (14 *Pet.*, 462,) Mr. Justice Story, in delivering the opinion of the court, said: "The objection is, that, upon general principles, the declarations and conversations of a plaintiff are not admissible evidence in favor of his own rights. As a general rule, this is undoubtedly true. It is, however, but a general rule, and admits and requires various exceptions. There are many cases in which a party may show his declarations conflict with acts in his own favor as a part of the *res gestæ*. There are other cases again in which his material declarations have been admitted. Thus, for example, in the case of an action for an assault and battery and wounding, it has been held, that the declarations of the plaintiff as to his internal pains, aches, injuries, and symptoms, to the physician called to prescribe for him, are admissible for the purpose of showing the nature and extent of the injuries done to him.

(See 1 *Phillips on Evidence*, c. 12, § 1, p. 200–202, 8th ed., 1838.) In many cases of inventions, it is hardly possible in any other manner to ascertain the precise time and exact origin of the particular invention. The invention itself is an intellectual process or operation; and, like all other expressions of thought, can in many cases scarcely be known except by speech. The invention may be consummated and perfect, and may be susceptible of complete description in words, a month or even a year before it can be embodied in any visible form, machine, or composition of matter. It might take a year to construct a steamboat, after the inventor had completely mastered all the details of his invention, and had fully explained them to all the various artisans whom he might employ to construct the different parts of the machinery. And yet from those very details and explanations another ingenious mechanic might be able to construct the whole apparatus, and assume to himself the priority of the invention. The conversations and declarations of a patentee, merely affirming that at some former period he invented that particular machine, might well be objected to. But his conversations and declarations, stating that he had made an invention, and describing its details and explaining its operations, are properly to be deemed an assertion of his right, at that time, as an inventor, to the extent of the facts and details which he then makes known, although not of their existence at an antecedent time. In short, such conversations and declarations, coupled with a description of the nature and objects of the invention, are to be deemed a part of the *res gestæ*, and legitimate evidence that the invention was then known to and claimed by him, and

thus its origin may be fixed at least as early as that period."

Although the mere declaration of an inventor, that at a certain time he made the invention, is not evidence. (*Cochrane* v. *Waterman*, *MS. Appeal Cases*, *D. C.*, 1844.) Yet the declarations of a party, describing, at a particular time, an alleged invention, are admissible to show what he knew or had invented at the time such declarations were made, provided they were made before a dispute or contest had arisen. (*Yearsly* v. *Brookfield*, *ib.*, 1853.) But the conversation and declaration of a party as to an invention are evidence of his right at the time only to the extent of the fact and details which he then describes and makes known. (*Garrett* v. *Davidson*, *ib.*, 1857.)

The correspondence between the office and a patentee is evidence, at least in a court of equity, for the purpose of showing the limitation placed by the patentee upon his claims. (*Pike* v. *Potter*, 3 *Fish.*, 55.) And the letters of a party to the Commissioner of Patents, applying for a patent for his invention, are admissible as evidence as to the fact of his being the inventor. (*Pettibone* v. *Derringer*, 4 *Wash.*, 219.)

Admissions or declarations as to an invention, made in a way of compromise and without the admission of any particular facts, are not admissible as evidence; but if made voluntarily, without any pending negotiation, it would seem they are admissible. (*Gibbs* v. *Johnson*, *MS. Appeal Cases*, *D. C.*, 1860.)

The fact that a party is a witness to the application of another for a patent for a particular invention does not estop such party from afterwards claiming to be the orig-

inal inventor of such invention, and he may show that he was deceived as to the character of the invention he was witnessing. (*Herring* v. *Leffingwell*, *ib.*, 1861.)

Where a party had disclaimed those parts of his invention which were found in another patent, it was held that this was an admission of the validity of such patent. (*Waterbury Brass Company* v. *New York and Brooklyn Brass Company*, 3 *Fish.*, 43.)

It seems that evidence as to the declaration of an inventor, which referred to a specimen or model of his invention, cannot be received without the production of such model or without its non-production being accounted for, (*Richardson* v. *Hicks*, *MS. Appeal Cases*, *D. C.*, 1854,) and an exhibit cannot be introduced in evidence for the purpose of showing that it is like the original model, unless the non-production of the original is accounted for. (*Ib.*)

345. DECLARATIONS AND ACTS OF THIRD PARTIES.—Where a witness was asked by counsel to state what third parties had said concerning an invention, the court decided that the question was improper. The person from whom the witness received the information on the subject ought to have been called on to give it in the usual way, and that the question was an attempt to introduce mere hearsay evidence of what others told the witness. (*Evans* v. *Hetlick*, 3 *Wash.*, 414.)

The declarations of a person as an agent, in relation to the business intrusted to him, and made at the time so intrusted, are competent concerning it, as a part of the *res gestæ*, if they relate to the act clearly. (*Aiken* v. *Bemis*, 3 *Wood. & Minot*, 350.)

The declarations of an assignor of a patent, after he has

parted with his interest, are inadmissible, either to show a want of title in him or to affect the quality of the article, or impair the rights of the purchaser. (*Many* v. *Jugger*, 1 *Blatchf.*, 376.) And the declarations of a patentee who had parted with all his interest is only hearsay evidence. (*Wilson* v. *Simpson*, 9 *How.*, 121, 122.)

The declarations of a third party in an interference, that he was a part inventor, are admissible to show that neither of the applicants is entitled to a patent. (*Yeersly* v. *Brookfield*, *MS. Appeal Cases*, *D. C.*, 1853.)

346. PAROL AND SECONDARY EVIDENCE.—Primary evidence is that kind of proof which, under any possible circumstances, affords the greatest certainty of the fact in question, and it is illustrated by the case of a written document; the instrument itself being always regarded as the primary or best possible evidence of its existence and contents. If the execution of an instrument is to be proved, the primary evidence is the testimony of the subscribing witness, if there be one. Until it is shown that the production of the primary evidence is out of the party's power, no other proof of the fact is in general admitted. All evidence falling short of this in its degree is termed secondary. The question whether evidence is primary or secondary has reference to the nature of the case in the abstract, and not to the peculiar circumstances under which the party in the particular cause on trial may be placed. It is a distinction of law, and not of fact; referring only to the quality, and not to the strength of the proof. Evidence which carries on its face no indication that better remains behind is not secondary, but primary. And though all information must be traced to its source, if possible, yet if there are several

distinct sources of information of the same fact, it is not ordinarily necessary to show that they have all been exhausted before secondary evidence can be resorted to. (*Greenleaf on Evidence*, p. 99.)

The cases which most frequently call for the application of the rule now under consideration are those which relate to the substitution of oral for written evidence, and they may be arranged into three classes: including in the first class those instruments which the law requires should be in writing; in the second, those contracts which the parties have put in writing; and in the third, all other writings the existence of which is disputed, and which are material to the issue. (*Ib.*, p. 100.)

By written evidence, is meant not every thing which is in writing, but that only which is of a documentary and more solemn nature, containing the terms of a contract between the parties, and designed to be the repository and evidence of their final intentions. When parties have deliberately put their engagements into writing in such terms as import a legal obligation, without any uncertainty as to the object or extent of such engagement, it is conclusively presumed that the whole engagement of the parties, and the extent and manner of their undertaking, was reduced to writing; and all oral testimony of a previous *colloquium* between the parties, or of conversation or declarations at the time when it was completed, or afterwards, as it would tend in many instances to substitute a new and different contract for the one which was really agreed upon, to the prejudice, possibly, of one of the parties, is rejected. In other words, as the rule is now more briefly expressed, "parol contemporaneous evidence is inadmissible to con-

tradict or vary the terms of a valid written instrument." (*Ib.*, p. 312.)

Parol evidence, bearing upon written contracts or papers concerning patent interests, ought not to be admitted without the production of such contracts or papers, to enable the court and jury to see whether the admission of parol evidence will trench upon the rule that parol evidence is not admissible to vary or contradict written contracts or papers. (*Philadelphia and Trenton Railroad Company* v. *Stimson*, 14 *Pet.*, 461.)

Certificates of manufacturers and others concerning an invention should be taken under oath, in order to be received and considered upon application for a patent. (*Jillson* v. *Winsor*, *MS. Appeal Cases*, *D. C.*, 1850.)

Although a letter from a third party is sent under cover of one from the inventor to the Commissioner of Patents, it is not evidence of priority of invention. (*Cochrane* v. *Waterman*, *ib.*, 1844.)

Copies of original memoranda and drawings are not admissible to confirm the testimony of the party who made them, but the originals might have been used to refresh the memory of the witness. (*Jones* v. *Wetherill*, *MS. Appeal Cases*, *D. C.*, 1855.)

Oral evidence of the meaning of parties in explanation of a written instrument respecting a patent right is inadmissible. The agreement, being in writing, must speak for itself. (*Troy Iron and Nail Factory* v. *Corning*, 1 *Blatchf.*, 472.)

347. PATENT OFFICE RECORDS, (*vide supra*, pp. 309, 310.) Written or printed copies of any records, books, papers, or drawings belonging to the Patent Office, and of letters patent under the signature of the Commissioner or Act-

ing Commissioner, with the seal of the office affixed, shall be competent 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. And copies of the specifications and drawings of foreign letters patent, certified in like manner, shall be *prima facie* evidence of the fact of the granting of such foreign letters patent, and of the date and contents thereof. (*Act of July* 8, 1870, § 57.)

Papers or drawings on file at the Patent Office are public records, and certified copies of them must be received in evidence when offered; if discordant, one may destroy the effect of the other, but they need not concur in every particular. (*Emerson* v. *Hogg*, 2 *Blatchf.*, 12.) If such copies are erroneous, the Commissioner of Patents has the power and ought to make them conform to the patent itself and to the record, (*Woodworth* v. *Hall*, 1 *Wood. & Minot*, 260;) and a former and defective certified copy of a patent may be corrected by another certified copy. (*Brooks* v. *Bicknell*, 3 *McLean*, 434.) Certified copies of papers in the Patent Office are to be received as *prima facie* evidence of the genuineness of the originals on file and absolute evidence of the correctness of the copies from the record. (*Parker* v. *Haworth*, 4 *McLean*, 371.) A certified copy of an assignment of a patent is *prima facie* evidence of the genuineness of the original, (*Lee* v. *Blandy*, 2 *Fish.*, 89,) and the production of the originals cannot be compelled. (*Brooks* v. *Bicknell*, 3 *McLean*, 434.)

348. EVIDENCE OF ABANDONMENT, (*vide supra*, pp. 264–267.)—Abandonment is in the nature of a forfeiture of right, which the law does not favor, and it should be made

out beyond all reasonable doubt, (*Pitts* v. *Hall*, 2 *Blatchf.*, 238;) and the law throws upon a party who seeks to obtain the benefit of a forfeiture the burden of proving it beyond all reasonable question. (*McCormick* v. *Seymour*, 2 *Blatchf.*, 256.) The natural presumption is, that a person who has invented a machine would not give it to the world, and there must be evidence of a distinct character as to abandonment, showing such intention. (*Hovey* v. *Henry*, 3 *West. Law Jour.*, 155.) Where experiments were unsatisfactory, and the inventor threw aside his temporary model, and wholly neglected for years to follow up his experiments, so as to produce a perfect machine, it was held, that such acts afforded strong and decisive evidence of an abandonment. (*Parkhurst* v. *Kinsman*, 1 *Blatchf.*, 494.)

In the case of *Goodyear & Bacon* v. *Hills*, Mr. Justice Cartter says: "The law-makers have admonished inventors and the public that if, before an application, they suffer more than two years to elapse in the use of the invention, they shall absolutely forfeit all right and title thereto. It is true that the legislative admonition relates to the period preceding the application. But it appears to me, so far as the court can be guided by its own judgment, that the inventor is left under the dominion of common-law principles in regard to any laches by which the application may be followed. Is it the law, that because an inventor files his application, which is refused by the office, he may sleep upon his rights indefinitely, and that at any period in his lifetime, or that of his representatives, the application may be revived as against the public? I think not. *Prima facie*, I think he would have to show a reason why he should be so permitted. The judgment of

condemnation by the office advertises to the country, at least, that he stands in no better position than before the application was made. The country is advised, by the deliberation of the only tribunal provided by law for the ascertainment at that stage of the invention, that he has no rights. More especially is he himself advised of that fact, for he is a party to the proceeding, and more immediately damnified by the rejection of the application. The rejection would at least be regarded, in the logic of equity, as a notice to him to proceed with diligence to traverse and reverse the judgment of the office." (3 *Fish.*, 139.)

349. EVIDENCE OF PRIORITY OF INVENTION.—When a man conceived a certain machine, no one knows except himself; when he described it, no one knew except himself and those to whom he described it. This is, from the nature of the case, the testimony upon which reliance must be placed. (*Sayles* v. *Hapgood*, 3 *Fish.*, 632.)

Priority of application for a patent does not decide priority of invention, (*Perry* v. *Cornell*, *MS. Appeal Cases*, *D. C.*, 1847;) but in cases of interference, the party who first filed so much of his application for a patent as illustrates his invention will be deemed the first inventor, in the absence of proof to the contrary. (*Patent Office Rules*, *July* 1870, *vide supra*, p. 451.) He is entitled to be placed in the condition of the defendant. His oath, being first made, gives him the benefit of the maxim, "*Potior est conditeo defendentis.*" (*Waters* v. *Taylor*, *MS. Appeal Cases*, 1869.)

A patent is *prima facie* evidence that the patentee was the first and original inventor, (*Winans* v. *New York and Harlem Railroad*, 31 *Jour. Frank. Inst.*, 3d series, 320;

Ransom v. *Mayor, &c., of New York*, 1 *Fish.*, 252; *Cahoon* v. *Ring*, 1 *Fish.*, 397,) and must prevail, unless there is other evidence to overcome such *prima facie* presumption. (*Ransom* v. *Mayor, &c., of New York*, 1 *Fish.*, 252.) The patentee has a right to rest upon his patent for his invention until its validity is overthrown, and if there is a reasonable doubt as to the priority of invention, the patentee is entitled to the benefit of it, (*Washburn* v. *Gould*, 3 *Story*, 142;) and where one party has a patent, the proof of want of originality must be specific and decisive in order to overthrow such patent. (*Troy Iron and Nail Factory* v. *Corning*, 1 *Blatchf.*, 472.) Upón interference with a patentee, not only is the burden of proof upon the applicant to establish priority of invention, but he must also explain why he was not as diligent as the patentee in making his application. (*Hunt* v. *Wood, Commissioners' Decisions*, 1869, p. 34.)

Priority of knowledge and use of an invention is a question of fact, which may be decided from one witness; the question is on the credibility and not the number of witnesses. (*Whitney* v. *Emmett, Bald.*, 310.)

Proof that a party had made a thing at a certain time is *prima facie* evidence that it had been invented by the patentee, until other evidence is given to show that it had been previously known. (*Pennock* v. *Dialogue*, 4 *Wash.*, 451.) But the silence of such party as to his claim of original invention at such time may be opposed to such evidence. (*Ib.*, 542)

In considering the question of originality, the oath of the inventor, made prior to the issue of letters patent, that he was the first inventor of the thing patented, may be opposed to the oath of a witness, offered to show

that the invention was not original. (*Alden* v. *Dewey*, 1 *Story*, 339.)

Where a dispute arises as to the priority of invention, a patentee is allowed to show the real date of it, and to have his rights as fully secured as if he had taken out his patent at that time. (*Parker* v. *Hulme*, 1 *Fish.*, 44.)

The measure of proof requisite to show the date of an invention depends upon the nature of the invention, whether complicated or not, the distance of time when the facts occurred, and the capacity of witnesses. (*Stephens* v. *Salisbury*, *MS. Appeal Cases*, *D. C.*, 1855.)

The time of the invention of an improvement must necessarily precede the time when the improvement is applied to a machine in operation. (*Cundell* v. *Parkhurst*, *ib.*, 1847.)

Dates in an account book, in which was made a drawing of an invention, are not conclusive evidence that the invention was made at the time of such dates. (*Jillson* v. *Winsor*, *ib.*, 1850.) And sketches in a diary deserve little consideration when there are indications that they have been interpolated. (*Purdy* v. *White*, *Commissioners' Decisions*, 1869, p. 22.) Proof that a drawing was shown by A at a certain time, before the well-established invention of the same thing by B, but without any model, and without proof that the articles were manufactured until long after the invention of B, is not sufficient to establish priority of invention in A. (*Jillson* v. *Winsor*, *MS. Appeal Cases*, *D. C.*, 1850.) Drawings prepared for the hearing of the interference are of but little weight, although accompanied with proof that they represent such as existed before. (*Purdy* v. *White*, *Commissioners' Decisions*, 1869, p. 22.)

But when original drawings were made of an invention, they are the best evidence of such invention, and on the non-production of them, unless legally accounted for as being lost, the legal presumption is that, if produced, they would show the facts to be unfavorable. *Beech* v. *Tucker*, *MS. Appeal Cases, D. C.*, 1860.) Verbal description may, however, be sufficient, without models or drawings, to show the date of an invention, (*Stephens* v. *Salisbury*, *ib.*, 1855;) but, to establish the date of an invention, it is not sufficient to show that the applicant was engaged upon one of the same character, without proof of its identity. (*Black* v. *Locke*, *Commissioners' Decisions*, 1869, p. 13.)

He is the real inventor, and is entitled to a patent, who first makes a machine capable of useful operation, though others may have previously conceived the idea and made experiments toward putting it in practice, (*vide supra*, pp. 247, 248, 249, 250, 251;) and where preliminary experiments have proved unsatisfactory to both parties, reliance should be placed on the first reduction to successful practice. (*Jennings* v. *Winter & Harris*, *Commissioners' Decisions*, 1869, p. 38.)

In the matter of interference between the applications of John C. Duckworth, George Crompton, and Horace Wyman, for letters patent for improvement in looms, the Commissioner says: "In a conversation between Crompton and Wyman, in 1861, the latter made some rough sketches, which he explained verbally to the former, of a plan which, as described, embodied in a rude form the invention in controversy. Crompton had a plan of his own, however, and, after discussion, concluded to adopt it in preference to Wyman's. Wyman's sketches were

not preserved, and nothing came of his description until September, 1866, when Crompton recurred to the idea, and, as Wyman testifies, having made 'modifications and improvements' upon it, built an experimental loom, which was tried for a few days during that month in Hamilton's tape works in Worcester.

"No sketches, models, or written description of what was alleged to have been invented by Wyman in 1861 having been preserved, we are left entirely to the recollections of Crompton and Wyman, both to some extent interested witnesses. Proof of invention consisting wholly of the memory of conversations occurring or of sketches made eight years before is of the most unreliable kind. (*Foster* v. *Hamilton*, *Commissioners' Decisions*, 1869, p. 30; *Townsend & Foster* v. *Fowle*, *ib.*, p. 35; *White* v. *Allen*, 2 *Fish.*, p. 445; *Winans* v. *New York and Harlem Railroad Company*, *Frank. Inst. Jour.*, 3d series, vol. 61, p. 322.) I should hesitate to accept such evidence as against a subsequent invention actually reduced to practice.

"But if Wyman invented anything in 1861, he did nothing with it for seven years. This, if the invention or application of others intervened, is fatal to his case. (See *Rowley* v. *Mason*, *supra*, p. 483, as well as a long list of cases since decided, in which the doctrine of that case has been followed and applied.)

"It is said that the war intervened; but the parties expressly testify that the manufacture of looms from that cause was interrupted but for a single year, and the war ceased in 1865. It is said that there was a verbal agreement between Crompton and Wyman, by virtue of which all inventions patented by the latter were to belong to the works; but as this agreement still exists, and the ap-

plication of Wyman is being pressed confessedly for the benefit of Crompton, who is the real party in interest, Wyman is to be charged with Crompton's laches as well as his own. The interest of Wyman in the invention has always been the same as now. Crompton, who is to own the patent, cannot be allowed to say that Wyman was prevented by him from obtaining a patent. Nor can Wyman, who has no pecuniary interest in it, be allowed to play the part of an inventor under duress. This is not the case of *White* v. *Allen*, (2 *Fish.*, 445,) nor anything like it. This is Wyman's application only in name. It is really made by Crompton for his own interest, and *a fortiori* he must be charged with his own laches.

"All that was done by Wyman, then, was to make a suggestion, subsequently abandoned. It was competent for any one to take up that suggestion, to modify, improve upon, or perfect it, and then to use or patent it." (*Whitely* v. *Swayne*, 7 *Wall.*, 685; *Duckworth* v. *Crompton*, *Commissioners' Decisions*, *May* 16, 1870.)

350. EVIDENCE OF PRIOR KNOWLEDGE OR USE IN A FOREIGN COUNTRY.—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, provided the same shall not have been introduced into public use in the United States for more than two years prior to the application, and that the patent shall 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; but in no case shall it be in force more than seventeen years. (*Act of July* 8, 1870, § 25.)

Whenever it shall appear that the 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. (*Ib.*, § 62.)

Evidence cannot be received of actual use and knowledge of an invention in a foreign country prior to the time of the invention here, unless it appears that the invention or improvement was patented in such foreign country or described in some public work, (*Judson* v. *Cope*, 1 *Fish.*, 615;) and it must appear that the improvement has been so clearly and intelligibly described that the invention could be made or constructed by a competent mechanic. (*Ib.*)

The language of the act (§ 6, act of 1839) under which this limitation was made is as follows: "That no person shall be debarred from receiving a patent for any invention or discovery, &c., by reason of the same having been patented in a foreign country more than six months prior to his application: *Provided, &c., and provided, also,* That in all cases every such patent shall be limited to the term of fourteen years from the date or publication of such foreign letters patent."

It will be seen that the language is "date or publication" of the foreign letters patent. As the patent cannot have a varying term, the "or" is to be read conjunctively, and the phrase is in effect "date *and* publication;" so that, if there be a difference between the day of date

and the day of publication, the limit should run from the latest day.

Under the English law, letters patent are dated when the provisional specification is filed. The applicant is allowed six months within which to complete his invention and to file a complete and extended specification. If he does this, the patent is formally issued to him; if not, he has "provisional protection" for six months, when all protection ceases. During the six months he may amend, alter, or improve upon his invention, and if his completed specification does not describe an invention inconsistent with his title and provisional specification, he may include his alterations, amendments, and improvements in his final paper. His provisional specification is in effect a caveat. It may not be followed up by a perfect invention; when, after six months, all protection ceases.

As the invention in its perfected, completed form is not "published" until the enrollment of the final specification; as, in fact, much of the invention may be *made* between the time of the filing of the provisional and completed descriptions, it would seem that the "date and publication" which are to determine the limit of a patent in this country should be the date of the filing of the complete specification.

This was the view of the law entertained by Commissioner Ewbank, when referring to this subject in the Rules of the Patent Office published in 1851. (*Patent Office Reports*, 1851, p. 509.) He says: "No invention will be considered as patented in a foreign country unless the specification has been enrolled and the patent in all respects complete."

There are but two reported cases bearing upon this

subject. The first is that of *Brooks* v. *Norcross* (2 *Fish.*, 661,) decided in 1851 by Mr. Justice Woodbury. Certain French machines were offered in evidence to defeat the Woodworth patent, which machines, it was insisted, had been patented in France. The language of the court is as follows: "But were these two French inventions ever 'patented,' within the meaning of that word in the act of Congress, (July 4, 1836?) The word there is first applied in connection with the original issue of a patent, prohibiting it to be done by the Commissioner, if it had been '*patented*' abroad. (§ 7.) It is next used in connection with the defense to a patent, declaring the defense good if the invention has before been 'patented' abroad. (§ 15.)

"The word 'patented,' as here used, must of course mean covered and made known to the world by a public patent, so as to bring home to the public generally, and probably, a knowledge of its existence, and deprive any one of the credit and protection of being original, if he afterward construct a like machine.

"But in the French system of patents at that time there existed private as well as public patents, and, for aught which appears, there may have been, till after 1828, patents of the former character, and consequently not coming within the spirit or ordinary meaning of the word *patented*, as used here in the act of 1836 to describe what is open and should be known to the community.

"This vital fact, whether private or public, ought to be made to appear by the defendant, as he sets up the patent as if coming within the word 'patented' as used in our own law, when nothing can be within the spirit of that law except what is public and thus known, open

and hence inimitable, and no other being in use here; such being the design and principle in all objections of this class and the analogous classes, the patents must have been used publicly, if used before; a description of them printed publicly, if printed before; an invention of them been made public, if made before; and 'patented' of course publicly, if any way before."

The second case is that of *Howe* v. *Morton*, (1 *Fish.*, 586,) decided by Judge Sprague in 1860. In this case the learned judge says: "But it is contended that this machine was patented abroad prior to the invention here, although the specification of Fisher & Gibbons was not enrolled until after the invention of Howe here. This raises another, and, so far as I am aware, a new question upon the construction of our own statute. The language of the statute is (§ 7, act of 1836) that it had before been 'patented or described in any printed publication'—'patented in any foreign country.' Was this invention of Fisher & Gibbons patented in England before the middle of May, 1845? That depends upon what is to be deemed patenting. What was the patent taken out in December? It was as follows: 'Invention of certain improvements in the manufacture of figured or ornamental lace or net, or other fabrics.' That was the patent and whole description; and there is no pretense that it even indicates any invention of a sewing machine.

"It is only by virtue of the specification enrolled in June, 1845, that we discover anything as to the stitching mechanism in the machine.

"But it is said that when the specification was enrolled it took effect from the date of the letters patent, and, therefore, what was specified and enrolled in June afterward

was in fact patented in December, 1844. That is the argument. What is the meaning of the word 'patented' in our statute? The English government may give such effect to certain acts of their own as they see fit; they may say letters patent may be granted in general terms, and that the fourteen years they grant may begin at the date of the letters patent, though no specification be enrolled till six months after. That is the law of England; but the question is, what did the Congress of the United States intend when they used the words 'patented in any foreign country?' Did they mean that the invention might be patented before it was made? Because, under the English law, the letters patent might be granted before the specification was made, and the specification might contain inventions made after the letters patent were granted. There would be some force in the argument if by the English law nothing could be put into the specification but what was invented or known before the letters patent were granted; but that was not so. The truth is, that the patentees had these six months by the terms of the letters patent to enroll their specification, and during all that time they may have made inventions and improvements; and the very thing that is relied upon here, as anticipating Howe, for all that we know, may have been invented after the middle of May, 1845, and put into the specification in June following.

"What is meant by Congress undoubtedly is, in the first place, that there shall have been an invention; and, in the second place, that it shall have been made patent to the world, *patented*. Now, we have no satisfactory evidence that the invention was made, and we have positive evidence that it was not made known to the world by

being patented until June, 1845; it was not made patent until after the invention by Howe. I am, therefore, of the opinion that Fisher & Gibbons' invention, whatever it may have been, was not patented until after Howe's invention, and can have no effect whatever."

It will be observed that these decisions refer to the date of the foreign patent when offered as a defense upon an action brought for the infringement of an American patent, and they refer to patents not granted to the American patentee. But *Mr. Justice Woodbury* says, in *Brooks v. Norcross:* "But 'patented abroad' means the same thing in the defense as in the issue of letters;" and it is difficult to see why any portion of the life of the American patent should be abridged by the filing abroad of an incomplete and unpublished specification. English letters patent, therefore, in so far as they affect the term of those granted in this country, are to be held to be "dated or published" at the time of the enrolling of the final specification. (*Commissioners' Decisions*, 1869, p. 60.)

In the case of *Maynard ex parte*, the Commissioner says: "Applicant presents a proper case for an extension, unless his invention is anticipated by the reference given by the examiner to the provisional specification of John Harcourt Brown, said to have been filed in England in August, 1855.

"I have already had occasion (*James Cochrane ex parte, Commissioners' Decisions*, 1869, p. 60) to consider the meaning of the word 'patented,' as used in our law with reference to inventions patented in foreign countries. In that case it was said: 'English letters patent, in so far as they affect the term of those granted in this country, are to

be held to be 'dated or published' at the time of the enrolling of the final specification.'

"A provisional specification is analogous to our caveat, and is filed for the purpose of permitting the inventor to complete or perfect his invention. Sometimes it contains no more than the title, and sometimes, as in the case of the present reference, is unaccompanied with drawings. Such a grant cannot be called a patent, nor can an invention described in it be said to have been 'patented' abroad.

"But the provisional specification is found in a printed publication, which bears date in 1856. This date must be construed most strongly in favor of the applicant. He has made oath that he is the original and first inventor. That oath can only be overcome by proof that the invention was made in this country, or patented or published abroad before the date of his invention. Proof that an invention was published in 1856 will not suffice. We cannot assume it to have been published before April 18, 1856, the date of his application; indeed, it must be assumed, in the absence of proof, to have been published at a later period.

"Nor is the recital in the publication, that the provisional specification bore date in 1855, of the slightest consequence. The printed publication can be evidence only to show that *at the date of publication* the thing described had an existence, and no recitals of former dates can be received as testimony. The contents of the book may be received as a description, but not as a history of the invention. This has been expressly held by the Supreme Court of the United States in *Seymour* v. *McCormick*, (19 *How.*, 107.) In that case the book offered in evidence

recited that the machine in question had worked successfully, but the court held that the publication could not be received as proof of any other fact, except that of the description of the improvement.

"It follows that the improvement patented to Maynard has not been patented abroad, nor has it been described in a printed publication of earlier date than his patent." (*Commissioners' Decisions, June* 4, 1870.)

As to the English laws and practice, *vide supra*, p. 85, *et seq.*

351. EVIDENCE OF NOVELTY AND UTILITY, (*vide supra*, p. .) Under the act of 1793 a patent was not even *prima facie* evidence that the invention patented was new or useful; but under the act of 1836 a patent issued after the examination required is received as *prima facie* evidence of the facts asserted in it. (*Corning* v. *Burden*, 15 *How.*, 270, 271.)

Whether there is novelty in an invention is a question to be determined upon a view of all the evidence in the case. (*Sickles* v. *Borden*, 3 *Blatchf.*, 540; *Batten* v. *Taggart*, 17 *How.*, 85; *Park* v. *Little*, 3 *Wash.*, 107.)

A combination of old parts to produce a new and useful result is an invention for which a patent may be granted. (*Evans* v. *Eaton*, *Pet. C. C.*, 322; *Barret* v. *Hall*, 1 *Mason.*, 447; *Pennock* v. *Dialogue*, 4 *Wash. C. C.*, 538; *Earle* v. *Sawyer*, 4 *Mason*, 1; *Le Roy* v. *Tatham*, 22 *How.*, 132.)

It is no objection to a patent for a combination that some or even all the parts have been known before. If the combination of them is new, and produces what is substantially a new and useful result, the combination is patentable. (*Pitts* v. *Whitman*, 2 *Story C. C.*, 609; *Hovey*

v. *Henry*, 3 *West. Law Jour.*, 153; *Hovey* v. *Stevens*, 1 *Wood. and Minot*, 290; *Blake* v. *Sperry*, 2 *N. Y. Leg. Obs.*, 251; *Buck* v. *Hermance*, 1 *Blatchf.*, 398; *Hall* v. *Wiles*, 2 *ib.*, 194.)

A patent for a combination of three distinct things is not infringed by combining two of them with a third, which is substantially different from the third element described in the specification, (*Prouty* v. *Ruggles*, 16 *Pet.*, 336; *Silsby* v. *Foote*, 14 *How.*, 219; *McCormick* v. *Talcott*, 20 *How.*, 402; *Vance* v. *Campbell*, 1 *Black.*, 427; *Eams* v. *Godfrey*, 1 *Wall.*, 78; *Brooks* v. *Jenkins*, 3 *McLean*, 432; *Brooks* v. *Bicknell*, 4 *McLean*, 80; *Parker* v. *Haworth*, 4 *McLean*, 370; *Latta* v. *Shank*, 1 *Fish.*, 465; *Lee* v. *Blandy*, 2 *Fish.*, 89;) and a patent for a combination of two things is not a patent for a combination of one of the two things with a third and different thing. (*Nicolson Pavement Company* v. *Hatch*, 3 *Fish.*, 432.)

A patentee who is not the inventor of a peculiar element of a combination cannot claim that element in combination with every form of another element with which he unites it, but may claim it when constructed and combined as described in his specification. (*Larabee* v. *Cortlan*, 3 *Fish.*, 5.)

A combination in mechanism must consist of distinct mechanical parts, having some relation to each other, and each having some function in the organism, (*Yale and Greenleaf Manufacturing Company* v. *North*, 3 *Fish.*, 279;) and in considering whether one element of a combination is substantially the same as an element of another combination, the fact that one works better than the other, coupled with the fact that the change is not within the ordinary knowledge and skill of all mechanics, is highly

important, and often decisive. (*Woodman* v. *Stimson*, 3 *Fish.*, 98.) Though the separate parts are all as old as the mechanic arts, if they are organized into a new machine, having a new mechanical operation, and the organization of this new machine involved the exercise of original thought, and is productive of useful results, then it is patentable, (*Blake* v. *Stafford*, 3 *Fish.*, 294;) and a modification of the parts of a combination, by which a new result is obtained, may be the subject of letters patent, (*Turrill* v. *Illinois Central Railroad Company*, 3 *Fish.*, 330;) but all the parts must coact in producing the result claimed for their combiuation. (*Swift* v. *Whissen*, 3 *Fish.*, 343.)

The patent raises the presumption of novelty and utility, and the degree of utility will not be very rigidly inquired into. (*Bell* v. *Daniels*, 1 *Fish.*, 372; *Teese* v. *Phelps*, 1 *McAllis.*, 49; *Potter* v. *Holland*, 1 *Fish.*, 327.) This presumption, however, is not conclusive, and it may be shown that the invention is useless and worthless, (*Lee* v. *Blandy*, 2 *Fish.*, 89,) or that the thing had been previously known. (*Coleman* v. *Leesor*, *MS.*, *Ohio*, 1850.)

According to the American cases the result alone, when the effects produced are more economical, useful, and beneficial, or a better article, is not conclusive evidence of novelty of an invention; but under the English cases the result alone, under like circumstances, is conclusive evidence of invention. (*Yearsly* v. *Brookfield*, *MS. Appeal Cases*, *D. C.*, 1853.)

As to the utility of an invention, upon application for a patent, the testimony of disinterested, practical men will be received, and it seems will overcome apparent resemblance to other inventions, (*Hoyt ex parte*, *ib.*, 1860;

Hayden ex parte, ib.;) so also as to the point whether an invention furnishes either a new article or a better or cheaper one. (*Arthur ex parte, MS., ib.*, 1861.) But it was held by Cranch, C. J., in the case of *Winslow ex parte*, that the opinion of experts or scientific and practical men, as to the comparative merits of two inventions, cannot affect the question of their novelty. (*Ib.*, 1850.)

The oath of the patentee, required upon his application for a patent, forms a legal ground for the presumption of the novelty of the claim until the contrary is proved. (*Parker* v. *Stiles*, 5 *McLean*, 60.)

The novelty of an invention can be defeated by a prior use only, by showing that such prior use accomplished the same result in the same manner. (*Foote* v. *Silsby*, 2 *Blatchf.*, 266.)

Upon application for a patent the applicant cannot be required to furnish evidence of the practical result of his invention. (*Seely ex parte, MS. Appeal Cases, D. C.*, 1853.)

352. EXAMPLES OF NOVELTY AND WANT OF NOVELTY.—If nothing is shown that will invalidate a patent already granted, another will not be allowed for the same thing, (*Grell* v. *Kunhert, Commissioners' Decisions*, 1869, p. 5.) A machine which is designed to accomplish a certain object is not anticipated by one which accomplishes the same object only occasionally, and without its having been intended, (*George W. Brown, ib.*, 10.) A patent furnishes no presumption that the invention was made before the filing of the application, (*John M. Heck, ib.*, 19.) A picture frame with a gilt-metal bead spun upon it from a flat band is a novelty, although such a frame with a gilt bead is old, as well as the mode of spinning metal beads, (*George Schneider, ib.*, 24.) Placing advertisements

on railway tickets having been practiced, it is no novelty to designate upon them places of business in the towns at the end of the route for which they issue, (*A. N. Towne, ib.*, 39.) An invention is not to be deemed old because a like effect has been produced by similar means, if it was only incidentally and occasionally, without being intended, (*Henry Waterman, ib.*, 51.) Escutcheons on stamps and the like, for inclosing distinctive marks, are old and not patentable, (*Lewis Abraham, ib.*, 59.) An English provisional specification, upon which no patent was issued, can be treated only as a published description in ascertaining the state of the art, (*R. O. Lowrey, ib.*, 85.) A die, whose surface is formed by electrotyping from an article of straw, is not to be patented, if dies have been before made with a like surface electrotyped from a cast or model of straw, (*H. Loewenberg, ib.*, 92.)

In the application: It being a mechanical expedient to insert metal into a hub in order to diminish friction, it requires no invention to insert soft metal in the eye of a wooden sash pulley for the same purpose, (*Thomas B. Stout, ib.*, 4.) To use an old article in a new situation is not of itself such a novelty as to be monopolized, (*Thomas Kerr, ib.*, 16.) The application of a known device may be deemed novel if it lies so far out of the beaten track as not to be suggested by the former use of it, (*Robert A. Chesebrough, ib.*, 18.) It is a mere double use to apply to several steam boilers what has been applied to one before, though of a different kind, (*James Murphy, ib.*, 24.) It is but a double use to apply to the casting of stove covers and centers the same process which had been previously employed in casting fire shovels and the like, (*E. C. Little, ib.*, 25.) There is no novelty in practicing

on a small scale what has been practiced on a large one before, or in practicing it for a different purpose, (*Woodward* v. *Reist*, *ib.*, 34.) There is no invention in employing upon a sheet-metal photographic frame a thumb-latch, which had been previously employed on other photographic frames, (*A. C. Platt*, *ib.*, 42.) The use of a friction driver in a type-setting machine may be the ground of a patent, though old in itself, if it has never been used in such a machine before, (*Joseph Thorne*, *ib.*, 76.) A claim for the combination of a pencil, rubber eraser, and sleeve to unite them, is not answered by the sleeve used in porte crayons, parasol handles, and the like, (*Vosburg & Ludden*, *ib.*, 80.) Land vehicles and water craft having been employed as advertising mediums, a vessel constructed and especially adapted for the purpose in an ordinary mechanical way is not to be regarded as an invention, (*A. M. Biedler*, *ib.*, 91.) The application of a device to a mower, which has been previously applied to a reaper in the same way, is a mere double use, (*H. M. Carter*, *ib.*, 96.) A jointed rod to operate a caster wheel in a harvester being old, there can be no invention in substituting it for a stiff rod in the place where the latter had been used, (*H. M. Carter*, *ib.*, 96.) Metallic springs having been used on eye-glasses to close them, and having been used on articles in the same way and for the same purpose as the applicant uses them on eye-glasses, his device is not entitled to favorable consideration, (*William Linden*, *ib.*, 108.)

In the material: The substitution of a cheaper material for the bed of a billiard table, as cement for glass and the like, may merit favorable consideration, (*W. E. Bond*, *ib.*, 17.) The substitution for an unelastic material

of one possessing elasticity is patentable, where that quality is made to subserve a useful purpose, as in railroad chairs, (*G. E. Deering, ib.*, 26.) A sheet-metal box or frame, with a wired flange, being known, there is no novelty in substituting it for a wooden or a cast-metal box in photographic frames, (*A. C. Platt, ib.*, 42.) A transparent cylinder surrounding the wick tube of a lamp, combined with a deflector above and an air distributor below, would not be patentable had an opaque cylinder been used in the same combination, (*Joseph Ridge, ib.*, 46.) Change of material is not patentable where the same material has already been used for the same general purpose, and is merely put in some new relation, (*Dimond & Doolittle, ib.*, 64.) To combine with a top rim flexible metallic lamp shades cannot be considered novel, as such shades are old, and shades not metallic have been combined with such a rim, (*Dimond & Doolittle, ib.*, 64.) Although a process was alleged to consist in the use of alum after soap, yet if the specification and claim represent it to consist in the use of soap and alum in the combination, it is anticipated by a published process in which aluminous soap was recommended for the same purpose, (*R. O. Lowrey, ib.*, 85.) Metallic springs for eye-glasses are anticipated by rubber springs, which have been used on them in a similar manner, (*William Linden, ib.*, 108.)

In the form: A change in the form of the aperture which it closes does not render a damper worthy of a patent, (*E. R. Femmo, ib.*, 9.) Introducing additional wheels into gearing does not alone render the combination legitimate, (*E. Z. Webster, ib.*, 9.) Piano stools having been made with iron legs, having recesses for tips, and chairs with wooden legs provided with dove-tailed

recesses for tips, and with rubber cushions inserted therein, to make piano stools with iron legs, constructed with such dove-tailed recesses and provided with such cushions, is not patentable, (*P. Y. Brown, ib.*, 18.) Tables vibrating in the arc of a circle having been used in sewing machines to carry the work, there is no merit in substituting a table for a horn which vibrated vertically in a straight line in another machine, (*Daniel Mills, ib.*, 25.) A change of form which renders an instrument more useful is patentable, although the change is simple, (*I. D. Warner, ib.*, 41.) Substituting a broad-faced stop for a pin to check the movement of the arm in a horse rake should not be patented, (*A. T. Barnes, ib.*, 81.)

In the structure: The sanction of the office will not be given to extending a railroad shoe lengthwise, so as to underlie the whole rail, (*Watts Cooke, ib.*, 6.) Merely reversing the operation of an apparatus is not a meritorious invention, (*George W. Blake, ib.*, 9.) A claim for hoppers within the furnace, with orifices between the boilers for feeding sawdust to the grate, so that the dust shall be dried, is not answered by such hoppers outside of the furnace, with orifices outside of the boilers, (*Samuel Sykes, ib.*, 9.) The mere reversal of two parts of a device in their position upon a structure is not to be regarded as a novelty, (*R. A. Leeds, ib.*, 13.) To add a shoulder for receiving a spring deserves no reward from the office, (*Sherrell & Warner, ib.*, 15.) To fit a tool with awls of different blades where one has been used before is not a novel conception in law, (*Wilcox* v. *Woodbury, ib.*, 17.) It is a mere limitation and not an expansion of an invention, to make the case of a centering awl whole which another has made with a split, so as to fit coun-

tersinks of different sizes, (*ib.*) To pack bales of compressed feed in paper, retained by slats and binders, instead of straw retained by slats as usual, is an improvement deserving recognition, (*S. W. Adwen*, *ib.*, 23.) To unite with steam boilers of different kinds a steam generator and superheater, such as has been united with one kind of boiler before, and claim the combination, is not to be allowed, (*James Murphy*, *ib.*, 24.) Adding a hinged lid to a vignette plate, and changing the mode of holding it in position, so that the whole frame is rendered less cumbersome, deserves a favorable consideration, (*A. C. Platt*, *ib.*, 42.) A band upon an open-grooved arrow gun, which holds the arrow in the groove while it is impelled by the spring, is not anticipated by a band which holds the arrow only before it is discharged, nor by such guns having close grooves or barrels, (*Charles Robinson*, *ib.*, 44.) A claim for a short stud, projecting downward from the head of a railroad spike, might possibly be understood to embrace a flexible barb in the same position; and that being old, the claim should not be allowed, (*P. J. Dwyer*, *ib.*, 57.) Mere omission of parts does not constitute patentable novelty; but, if followed by reorganization, it may, (*George McRoy*, *ib.*, 58.) Postage stamps with coupons, to be detached when the stamps are applied, in order to cancel them, anticipate revenue stamps with like coupons, although the coupons of the latter are made to correspond with the stamps, and are preserved in order to check frauds, (*Lewis Abraham*, *ib.*, 59.) There is no invention in changing a mill from a horizontal to a vertical position, nor in applying the driving power directly to the main roller instead of applying it through other mechanism, nor in incasing two bolts in

one casting, (*Stevens & Powers, ib.*, 63.) To spring an elastic body of a lamp shade over an inflexible rim cannot be regarded as novel, an elastic rim having been before sprung into an inflexible body, (*Dimond & Doolittle, ib.*, 64.) A ladies' safety belt, made with elastic pieces inserted, having been allowed a patent, it is an improvement upon it to make the belt in two pieces, connected by two buckles, so that the flaps which are attached are always opposite to each other, (*Bacheller* v. *Porter & Bancroft, ib.*, 64.) Pumps having been made in sections, there is no invention in making hydrants in sections, (*Charles & H. Ackerson, ib.*, 74.) A combination in a type-setting machine of an ejecting finger, a key to select the finger, and a carrier operated by a power separate from the key, is not answered by a combination in which the key both selects and operates the finger, (*Joseph Thorne, ib.*, 76.) A cover combined with a door latch sunk into the face of a door being old, as well as a projecting cover arranged on the face of a door, there is no novelty in a projecting cover with a latch so arranged, (*P. W. Dean, ib.*, 77.) A right and left screw having been used with a printer's side-stick, there is no invention in operating a quoin with one, although the side-stick can be used only in a press of a given size and a quoin can be used in any, (*F. H. Webb, ib.*, 78.) Whether a claim to a pencil, rubber eraser, and sleeve to unite them, can be extended to cover a complete cylinder for a sleeve without the ring by which the semi-cylinders composing the sleeve are connected, *quere?* (*Vosburg & Ludden, ib.*, 80.) To drive two rollers, one by the gear wheel on one end of a shaft and the other by another gear wheel on the other end of the same shaft, is an improvement on a similar

machine, in which one roller is driven by a gear wheel on the other, (*Powers & Stevens, ib.*, 81.) A broad-faced stop with a flange exteuding down the side of the bar on which it is placed, so as to bear the blow better, when substituted for a pin to check the movement of the arm in a horse rake, is patentable, (*A. T. Barnes, ib.*, 81.) To make a latch and weighted catch in one piece, which have before been made in two and soldered together, is not to be esteemed an invention, (*R. M. Thompson, ib.*, 81.) A metal shade in one piece, with flexible springs on its inner periphery, and intended to rest by the springs on the glass chimney of a lamp, is not anticipated by one which rests by three inflexible points on a metal cap over the chimney, (*M. H. Collins, ib.*, 82.) If a pinion has been secured upon the arbor of a wheel by means of a screw thread cut upon the arbor, there is no invention in securing the wheel upon the arbor of the pinion by the same means, although some slight advantages are incident to the latter construction, (*J. A. Smith, ib.*, 83.) There is no merit in forming blocks for a wooden pavement with a rebate on one side, so as to form a channel for holding concretes, after such blocks have been cut with a rebate on both sides for the same purpose, and the same effect has been produced by using long blocks alternating with short ones, (*L. S. Robbins, ib.*, 84.) A cork machine in which the cork was cut tapering by four cutters, which were made to approach each other during the process by means of a collar sliding upon the shaft to which they are hinged, does not anticipate one in which the cutter is in one piece, but with slits, and the edges approach each other in consequence of their form, (*M. F. Crocker, administratrix, ib.*, 85.) An instrument for

kindling fires by gas, which is supplied to it by a flexible pipe attached to a tubular handle, is not anticipated by a like instrument for kindling fires having no such handle, although it was suggested that it might be used with gas, if desired, (*Jeremiah Kenney, sr., ib.*, 95.) Where the distance between two points in an instrument is all that distinguished it from others, and that distance must be varied in different applications, it will not render the instrument patentable, (*I. D. Warner, ib.*, 109.) In a paper-folding machine the addition of a spring to one of the rollers, so that it will yield to the folding knife, is entitled to favor, (*S. C. Forsaith, assignee, &c., ib.*, 111.)

353. EXAMINATION OF PARTIES.—As a general rule, a party in a patent cause cannot be a witness in his own behalf. (*Buck* v. *Hermance*, 1 *Blatchf.*, 324; *Foote* v. *Silsby*, 3 *Blatchf.*, 508.) But the judiciary act of September, 1789, § 34, (1 Stats. at Large, p. 92,) in adopting the laws of the several States as rules of decisions in the courts of the United States, embraced laws relating to evidence; and where, therefore, under the laws of any State, parties may be examined as witnesses in their own behalf, a plaintiff in an action in the United States courts for infringement of his patent is a competent witness as to the issues raised therein. (*Hausknecht* v. *Claypool*, 1 *Black*, 431; *Vance* v. *Campbell*, 1 *Black*, 427.)

Formerly the testimony of an inventor or a party to the record was not admissible in an interference, (*Yearsly* v. *White*, *MS. Appeal Cases, D. C.*, 1853,) even though he had assigned all his interest in an invention to another. (*Eams* v. *Richards*, *ib.*, 1859; *Hill* v. *Dunklee*, *ib.*, 1857; *Gibbs* v. *Johnson*, *ib.*, 1860; *O'Rielly* v. *Smith*, *ib.*, 1853; *Barstow* v. *Swain*, *ib.*, 1860.) Upon this point Mr. Chief

Justice Cartter said, (*Irwin* v. *Merrill, MS. Appeal Cases, D. C.*, 1864:) "It is an elemental rule of evidence, as repeatedly declared by my predecessors and now affirmed, that a patentee and party to the record cannot become a witness by transfer of his right pending the proceeding. I do not possess the right, if I could see the reason, for removing this disability. It is urged by the Commissioner that the legislature and courts incline to listen to the testimony of parties. If the federal legislature, the law-making power of this jurisdiction, had made parties competent as witnesses, I should not hesitate to follow, but Congress has failed to do so. * * * * The prevailing rule of all good courts is to administer the law as they find it, without attempting to make it."

354. PARTIES IN INTERFERENCE CASES MAY TESTIFY.—Since the act of July 2, 1864, relating to the law of evidence in the District of Columbia, parties to the record in interference cases, and all parties interested in the same, have been deemed competent to give evidence. The provisions of the act are as follows:

"*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That on the trial of any issue joined, or of any matter or question, or on any inquiry arising in any suit, action, or other proceeding in any court of justice in the District of Columbia, or before any person having by law, or by consent of parties, authority to hear, receive, and examine evidence within said District, the parties thereto, and the persons in whose behalf any such action or other proceeding may be brought or defended, and any and all persons interested in the same, shall, except as hereinafter excepted, be competent and compellable to give evidence,

either *viva voce* or by deposition, according to the practice of the court, on behalf of either or any of the parties to the said action or other proceeding: *Provided*, That nothing herein contained shall render any person who is charged with any offense in any criminal proceeding competent or compellable to give evidence for or against himself or herself, or shall render any person compellable to answer any question tending to criminate himself or herself, or shall in any criminal proceeding render any husband competent or compellable to give evidence for or against his wife, or any wife competent or compellable to give evidence for or against her husband, or in any proceeding instituted in consequence of adultery; nor shall any husband be compellable to disclose any communication made to him by his wife during the marriage, nor shall any wife be compellable to disclose any communication made to her by her husband during the marriage. Approved July 2, 1864."

355. COMPETENCY OF WITNESSES.—It was also formerly held that the testimony of a witness directly or indirectly interested was not admissible in an interference, (*Marshall* v. *Mee*, *MS. Appeal Cases*, *D. C.*, 1853,) however small the amount of the interest might be, (*Arnold* v. *Bishop*, *MS. Appeal Cases*, *D. C.*, 1841;) but by the act of July 2, 1864, the disabilities of such witnesses were removed, and they are now competent and compellable to testify.

If no objection is made to the competency of a witness on his examination, and both parties examine him, it will be too late to take the objection afterward. (*Allen* v. *Alter*, *MS. Appeal Cases*, *D. C.*, 1860.)

In determining what credit is to be given to the testimony of witnesses, every circumstance affecting

their veracity should be taken into calculation, (*Evans* v. *Hettick*, 3 *Wash.*, 423,) and weight should be given to it in proportion to the competency of the witness to judge of the matter sworn to. (*Allen* v. *Hunter*, 6 *McLean*, 310.) The presumption of law is, that a witness on oath testifies honestly until the contrary is known. (*New England Screw Company* v. *Sloan*, *MS. Appeal Cases*, *D. C.*, 1853.) The testimony of witnesses otherwise incompetent may be received and considered by the agreement of the parties. (*Warner* v. *Goodyear*, *ib.*, 1846.)

356. EXPERTS.—To determine the question of the mechanical difference of machines, the law permits the opinions of men called experts to be given in evidence, and when such men are qualified, and free from bias, their testimony is entitled to great respect. (*Morris* v. *Barret*, 1 *Fish.*, 461.)

The patent act contemplates two classes of persons as peculiarly appropriate witnesses in patent cases, namely: 1st, practical mechanics, to determine the sufficiency of the specification as to the mode of constructing, compounding, or using the patent; 2d, scientific and theoretic mechanics, to determine whether the patented thing is substantially new in its structure and mode of operation, or a mere change of equivalents; and the second class is by far the higher and more important of the two. (*Allen* v. *Blunt*, 3 *Story*, 742.)

The opinions of professional men are evidence only as to matters which relate to their profession, (*Brooks* v. *Bicknell*, 3 *McLean*, 447;) thus, in medical science a physician is an expert; in navigation, a sailor. (*Page* v. *Ferry*, 1 *Fish.*, 298.) The statute defines the character of an expert as one "*skilled in the art or science*" to which

his opinion appertains, (*ib.*;) and one not so skilled is not a fit person to testify as to whether a specification contains a sufficient description. (*Poppenhausen* v. *New York G. P. C. Company*, 4 *Blatchf.*; *Allen* v. *Hunter*, 6 *McLean*, 307.)

The testimony of experts is useful to show the operation of devices; but when experts undertake to tell what a patent is for, they assume the duty of the court; and when they undertake to say what is or is not a violation of the patent, they not only assume the duty of the court, but the jury. (*Waterbury Brass Company* v. *New York and Brooklyn Brass Company*, 3 *Fish.*, 43.)

Experts may be examined to explain the meaning of terms of art on the principle, *Cuique in sua arte credendum*, (*Corning* v. *Burden*, 15 *How.*, 270; *Winans* v. *New York and Erie Railroad Company*, 21 *How.*, 100,) or as to whether a patent is void for uncertainty, (*Washburn* v. *Gould*, 3 *Story*, 138,) or to explain the difference between an original and reissued patent, (*Philadelphia and Trenton Railroad* v. *Stimson*, 14 *Pet.*, 462,) or as to the identity of different mechanical structures, (*Parker* v. *Stiles*, 5 *McLean*, 64,) or the state of the art at any given time, (*Winans* v. *New York and Erie Railroad*, 21 *How.*, 100,) or to explain machines, models, and drawings exhibited, (*ib.*;) but their opinion cannot be dignified with the mantle of authority, even on questions of science. (*French* v. *Rogers*, 1 *Fish.*, 133.)

XXI. Reissues.

SEC.
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380. Oath by applicant for reissue by assignee.

357. RÉSUMÉ OF THE LAW CONCERNING REISSUES.—Before the British act of 5 and 6 Wm. IV. c. 83, 1835, the consequence of a defect in the specification, in England, was an absolute loss of the privilege of the patent right. By the first section of that act the patentee or his assignee "may, with the leave of the attorney or solicitor general, enter a disclaimer of any part of either the title of the invention or of the specification, stating the reason for such disclaimer, or may, with such leave, enter *a memorandum of any alteration in the said title* or specification, not being such disclaimer, or such alteration as shall extend the exclusive right granted by the patent;" and such disclaimer or memorandum is thereafter to be considered a part of the title or specification.

In the early American cases, after the act of 1793, it

appears to have been supposed that the law had by that act been varied from the English; so that the patent right was forfeited and lost only in case of the defects specified in the sixth section being designed and fraudulent. It is provided by that section that, in a case for an infringement, the defendant may give in evidence, in his defense, "that the specification does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the described effect, which concealment or addition shall fully appear to have been made for the purpose of deceiving the public."

Mr. Justice Story, in giving an opinion in the circuit court, in 1813, on an examination of this section, remarked: "We think that the manifest intention of the legislature was not to allow any defect or concealment, in a specification to avoid the patent, unless it arose from an intention to deceive the public." (*Whittemore* v. *Cutter*, 1 *Gall.*, 429.)

In the same year, Mr. Justice Washington, instructing the jury in the circuit court of the United States for Pennsylvania, said on the subject of concealment, "the matters not disclosed must appear to have been concealed for the purpose of deceiving the public, in order to invalidate the patent." (*Park* v. *Little*, 3 *Wash.*, 196.)

In 1817, again, these judges appear still to have entertained the same opinion. (*Lowell* v. *Lewis*, 1 *Mass.*, 182; *Gray* v. *James*, 1 *Pet. C. C.*, 401.) But it was, at the same time, remarked by Mr. Justice Story, that the doctrine was liable to grave objections on the score of expediency. (*Whittemore* v. *Cutter*, 1 *Gall.*, 429.) And it was subsequently abandoned, and the English doctrine adopted, that a defect in the specification, from want of com-

pliance with the requisitions of the third section of the act of 1793, rendered the patent void; but that, if the defect arose from mistake, a new patent could be taken out for the unexpired part of the term. In this respect our law on this subject differed from the English.

This doctrine, as to the surrender and renewal of the patent, was suggested by Mr. Justice Thompson in a case that came before him in 1824, in which he remarked, "I see no insuperable objection to entering a *vacatur* of the patent of record in the Department of State, if taken out *inadvertently* and by *mistake*. All the proceedings in that department, on the subject of patents, are *ex parte*, except in the case of interfering applications. The department act rather ministerially than judicially, and upon the representation of the applicant, without entering into the question of right, and there seems to be no good reason why, on a like *ex parte* application, the patent may not be surrendered, and canceled of record, if no misconduct be imputable to the patentee in taking it out. And in such case, as the exclusive right is not to exceed fourteen years, the second patent may be limited according to circumstances, and thereby secure both to the patentee and the public their respective rights." (*Morris* v. *Huntington*, 1 *Paine*, 355.)

This doctrine was afterward distinctly adopted by the Supreme Court. (*Townsend* v. *Raymond*, 6 *Pet.*, 220; *Shaw* v. *Cooper*, 7 *Pet.*, 292.)

In confirmation of the construction thus given to the patent law of 1793 the fifth section of the additional law of 1832 was passed, by which it is enacted that "whenever any patent shall be invalid or inoperative, by reason that any of the terms and conditions prescribed

in the third section in the said act (of 1793) have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, been complied with on the part of the said inventor, it shall be lawful for the Secretary of State, upon the surrender to him of such patent, to cause a new one to be granted to the said inventor, for the same invention, for the residue of the period then unexpired, for which the original patent was granted, upon his compliance with the terms and conditions prescribed in the said third section of said act."

The law was thus put upon a liberal footing in respect to patentees, and the act of 1836, section thirteen, made a similar provision. (*Phillips on Patents*, 301.)

358. PROVISIONS OF THE ACT OF JULY 8, 1870.—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 specifications, to be issued to the patentee, or, in the case of his death or assignment of the whole or any undivided part of the original patent, to his executors, administrators, or assigns, for the unexpired part of the term of the original patent, the surrender of which shall take effect upon the issue of the amended patent; and 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 reissue of each of such reissued letters patent. And the specification and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. And the patent so reissued, together with the corrected specification, shall have the effect and operation in law, on the trial of all actions for causes thereafter arising, as though 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 a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid. (*Act of July* 8, 1870, § 53.)

359. To WHOM GRANTED.—A reissue is granted to the original patentee, his legal representatives, or the assignees of the entire interest, when, by reason of a defective or insufficient specification, the original patent is inoperative or invalid, provided the error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. (*Patent Office Rules, July*, 1870.)

The sole right to surrender is given, 1, to the patentee if he is alive and has made no assignment of the original patent; 2, to the executors and administrators of the patent after his decease, when there has been no such assignment; 3, to the assignee, after the death of the

inventor, when there has been an assignment of the original patent. Where, however, there has been an assignment of an undivided part of the whole patent the assignee of such part and the patentee become joint owners of the patent, and should join in the surrender; and if they do not, it will be invalid unless the part owner not joining shall ratify it. But a licensee or one who has had transferred to him a less or different interest than either the interest in the whole patent or an undivided part of such interest, or an exclusive sectional interest, has no legal right as assignee to surrender, and a surrender without his concurrence is valid. (*Potter* v. *Holland*, 1 *Fish.*, 327.)

360. APPLICATION MUST BE MADE BY INVENTOR, IF LIVING, IN CASE OF ASSIGNMENT.—Patents may be granted and issued or reissued to the assignee of the inventor or discoverer, the assignment thereof being first entered of record in the Patent Office; but in such case the application for the patent shall be made and the specification sworn to by the inventor or discoverer, and also, if he be living, in case of an application for reissue, (*Act of July* 8, 1870, § 33;) but if the inventor be dead, the application may be made and the specification sworn to by assignees.

361. CONCURRENCE OF PARTIES.—The petition must show that all parties owning an undivided interest in the patent concur in the surrender. (*Patent Office Rules, July*, 1870.)

362. RIGHTS OF ASSIGNEES.—It is not in the power of a patentee, by the surrender of his patent, to affect the rights of third persons to whom he has previously by assignment passed his interest in a whole or a part of

the patent, without the consent of such assignees. (*Potter* v. *Holland*, 1 *Fish.*, 327; *Woodworth* v. *Stone*, 3 *Story*, 750; *Smith* v. *Mercer*, 4 *West. Law Jour.*, 52; *McBurney* v. *Goodyear*, 11 *Cush.*, 571.) The reissued patent operates from the commencement of the original, and will inure to the benefit of assignees who became such before the reissue, although no assignment is made to them after the reissue. (*Woodworth* v. *Hall*, 1 *Wood. & Minot*, 248.)

A surrender of letters patent renders void all assignments so far as those are concerned who assent to the surrender. It is necessary that a prior assignee should have a new assignment before he can maintain an action for an invasion of the patent. (*Gibson* v. *Richards*, *Index Pat. Dec.*, No. 376.) Consent may be manifested by joining in the surrender, or previously authorizing it, or subsequently ratifying or approving it; and taking an advantage and benefit of it would be a ratification; and when so consented to the rights of the party consenting in and to the old patent are forever gone. (*Potter* v. *Holland* 1 *Fish.*, 327.) Assignees are not compelled to take under the reissued patent, and give up the right had under the old one. They may, if they prefer, rest their claims upon the specification as it stood when they purchased their right, (*Smith* v. *Mercer*, 4 *West. Law Jour.*, 52;) and there may be one claim of right under the old patent for one section of country and a different claim of right under the reissued patent for another section of country. (*Potter* v. *Holland*, 1 *Fish.*, 327.)

Where there has been an assignment of an undivided part of the whole original patent, in such case the assignee of such a part and the patentee become joint

owners of the patent, and should join in the surrender; and, if they do not, it will be invalid, unless the part owner not joining shall ratify it. (*Potter* v. *Holland*, 1 *Fish.*, 327.)

A person to whom the patentee has passed his interest in a part of the old patent, upon the surrender of the same by the patentee, and obtaining a reissued patent, is entitled to the same right, under the reissued patent, that he had to the old one. (*Ib.*) He may, however, elect to hold under the old patent, and it is not a valid objection, that in such case there would be different claims of right in the same invention secured to different sectional owners. (*Ib.*)

A reissue does not *inure* to the benefit of a prior assignee. He takes by ratification, not by inurement. (*Burdell* v. *Denig*, 2 *Fish.*, 589.)

363. STATEMENT OF TITLE.—A statement under oath of the title of the party proposing to surrender must be filed with the application. (*Ib.*)

364. APPLICATION FOR REISSUE ACTED ON AS SOON AS FILED.—Reissued patents expire at the end of the term for which the original patent was granted; for this reason applications for reissue will be acted on as soon as filed. (*Ib.*)

365. DEFECTS CURED BY REISSUE.—The act contemplates two classes of cases in which reissues may be granted: First, where the patent is *inoperative* and *invalid* by reason of a defective or insufficient specification; second, where the objection arises by reason of the patentee claiming as his own invention more than he had a right to claim as new, (*Goodyear* v. *Day*, *MS. New Jersey*, 1852;) but whether the defect be in the specification or claim, the

patentee may surrender his patent, and by an amended specification or claim cure the defect.

There is nothing in the act which requires the patentee to claim all things in a reissued patent which were claimed as his original invention in his original patent. A specification may be defective as well by an excess of claim as by a defect in the mode of stating it, and the inventor is always at liberty to omit part of his original invention if he deems it expedient, (*Carver* v. *Braintree Company*, 2 *Story*, 439;) and he is not bound to include in his reissued patent improvements to which he may have been actually entitled under the original patent, (*Knight* v. *Baltimore and Ohio Railroad Company*, 3 *Fish.*, 1;) and where the claim in the original was for a new article of manufacture, and in the reissue it was for a combination and arrangement of the parts, it was held that the former claim was unfortunate, as changes could be made to avoid the patent while retaining the principle of the invention, and that the defect was curable by reissue. (*Middletown Tool Company* v. *Judd*, 3 *Fish.*, 141.)

It is not necessary that there should have been any adjudication upon the patent in order to justify a reissue; the oath of the party as to the existence of the facts required for a reissue is enough, (*Bull ex parte*, *MS. Appeal Cases*, 1860;) and though the old specification had been adjudged good, yet if defective, so as to be open to litigation, and thus somewhat "inoperative," the Commissioner may reissue it. (*Woodworth* v. *Edwards*, 3 *Wood. & Minot*, 126.)

The disclaimer of a part of an invention in the original application, provided such disclaimer arose from inadvertency, accident, or mistake, will not prevent the pat-

antee from embracing the part so disclaimed in a reissue of his patent, (*Hayden ex parte*, *MS. Appeal Cases, D. C.*, 1860,) and a statement in an original patent that a part is old does not prevent such part being claimed in a reissued patent, though it seems it would have that effect if made advisedly. (*Laidly* v. *James*, *MS. Appeal Cases, D. C.*, 1860.)

866. THERE MAY BE MORE THAN ONE REISSUE.—There may be more than one reissue of the same patent. There is nothing in the patent acts that limits the correction of errors to such as may have been the first discovered. (*French* v. *Rogers*, 1 *Fish.*, 133.) The surrender and reissue, no matter how often they recur, are reciprocal, each in consideration of the other, and form together but a single act; and it is for the public interest that the surrender and reissue should be allowed to follow each other as often as the patentee is content to be more specific or modest in his claims. (*Ib.*)

But where the patentee surrendered his original patent and obtained a reissue, and afterwards surrendered the reissued patent and obtained a second reissue, it was held that the original patent having been canceled when the first reissue was granted, the second reissue was not valid unless the improvement described in it was in its principle and mode of operation the same with that intended to be described in the first reissue. (*Knight* v. *Baltimore and Ohio Railroad Company*, 3 *Fish.*, 1.)

When a patent has issued in one division of an application for a reissue the original patent is dead, and no new division can be entertained. (*Whitely and Gaye ex parte*, *Commissioners' Decisions*, 1869, p. 63.)

And after one patent has issued, upon an application

for a reissue the original patent is annulled, and no new division can be entertained.

In the case of *Whitely ex parte*, (*MS. Appeal Cases, D. C.*, 1869,) it was held by Chief Justice Cartter that the surrender of a patent and letters patent granted in reissue, for the same subject, upon such surrender is death to the first patent and life to the second. Whatever of title to the subject of the patent survives is to be found in the letters of reissue, and not in the patent out of which such letters grow; and any application made thereafter for reissue should be based upon the reissued letters patent.

367. USE UNDER THE DEFECTIVE PATENT.—No prior use of an invention under a defective patent can take away the right to surrender and reissue such patent, or authorize a use under the renewed patent, (*Stimson v. Western Railroad*, 4 *How.*, 402;) and the fact that the thing described in an original patent had been in public use in the interval between the issue of the original and reissue, does not exclude an inventor from the right to resume them in a reissue. (*Goodyear* v. *Day*, *MS.*, *N. J.*, 1852.)

368. REISSUE DURING EXTENDED TERM.—The Commissioner can lawfully reissue letters patent on an amended specification after the expiration of the original patent and during the existence of an extended term. (*Wilson* v. *Rosseau*, 4 *How.*, 688.) The extended patent of twenty-one years is, in such case, to be regarded as the "original patent," within the meaning of § 13 of the act of 1836, (*Gibson* v. *Harris.*, 1 *Blatchf.*, 169;) and the reissue of a patent extended by act of Congress to twenty-eight years, after it had been previously extended to twenty-one years, stands on the same footing. There is no

difference in principle. (*Ib.*; *Woodworth* v. *Edwards*, 3 *Wood. & Minot*, 126.)

369. A CLERICAL ERROR WILL BE CORRECTED WITHOUT FEES IF IT OCCURRED THROUGH THE FAULT OF THE OFFICE.—Before the passage of the act of 1836, the Supreme Court of the United States held, (*Grant* v. *Raymond*, 6 *Pet.*, 242; *Shaw* v. *Cooper*, 7 *Pet.*, 314,) that a defective patent might be surrendered, canceled, and reissued to correct an honest mistake on the part of the patentee, or an error committed by the office.

The 13th section of the act of 1836 provides for surrenders and reissues in two specified cases, but is silent as to all other grounds of surrender. It is believed that the right of the patentee to surrender his patent for the correction of errors committed by the office remains unaffected by the legislation contained in that section. It could never have been the intention of the legislature to restrict the correction of mistakes to those enumerated, or to declare that the errors of the office should not be reformed as promptly as those of the patentee.

Accordingly it has been the practice of the office to correct all errors in parties' names, titles, dates, and all omissions or insertions of words made by the fault of the office, upon the surrender of a patent, without fee, but to require the patentee, when seeking the correction of his own mistakes, to pay the fee and conform to the provisions made for cases of reissue.

In *Dental Vulcanite Company* v. *Wetherbee*, 3 *Fish.*, 87, a patent thus corrected came under the review of the full court in the district of Massachusetts. In that case, after an assignment of the entire interest of an inventor, the application for reissue was signed by the patentee,

and the reissue was granted to him instead of to his assignee. The court, by Mr. Justice Clifford, say: "Whether the mistake was first discovered by the Patent Office, or by the party named as patentee, does not appear, but it does appear that the letters patent were immediately returned to the Commissioner, and the mistake was corrected as a clerical error. Unless it could be corrected as a clerical error it could not be corrected at all, as it was clearly not a case falling within the provision authorizing a surrender and reissue." Again: "Second surrender was asked merely to correct an error of date in the first reissue, and it is obvious that the suggestion of error was well founded, and that the correction requested was one proper to be made."

In Betmold's case, (4 *Opinions*, 335,) Nelson, Attorney General, held that the date of a patent may be altered to correspond with that of a foreign patent, previously taken out by the inventor, where the mistake has not arisen from any fraudulent or deceptive intention. (See also *Smith* v. *Ely*, 5 *McLean*, 78–86; *James Cochran*, *Commissioners' Decisions*, 1867, p. 60.)

370. ERROR THROUGH THE FAULT OF THE PATENTEE WILL BE CORRECTED ONLY BY REISSUE ON THE USUAL TERMS.—A patentee when seeking the correction of his own mistakes is required to pay the fee required by law and conform to the provisions made for cases of reissue. (*Ib.*) In the case of *Havemeyer ex parte* the Commissioner says:, "This is a motion on the part of the American Papier Maché Company for the correction of an alleged clerical error. The facts are briefly as follows: Letters patent for an improvement in the manufacture of sugar molds, and other articles, were granted to Carl Kronig

in 1864. In 1868, this patent was returned with the following petition: 'The petition of Theodore A. Havemeyer, J. Lawrence Elder, and Charles F. Loosey, of New York city, respectfully represents: That your petitioners are the sole owners, by assignment, entered of record, of letters patent of the United States, granted to Carl Kronig, of Vienna, in the Empire of Austria. They therefore pray that they may be permitted to surrender the said letters patent, and that the same may be canceled and new letters patent issued *to your petitioners* on an amended specification,' &c.

"In the letter transmitting this application mention was made of an inclosed assignment from Havemeyer, Elder & Loosey to the American Papier Maché Company for record, but no request was made for the issue of letters patent to the last assignees.

"The patent was issued April 14, 1868, in accordance with the request of the petition, to Havemeyer, Elder & Loosey. The American Papier Maché Company now comes in, after a lapse of nearly two years, and asserts that the patent should have issued to it, and that the failure so to issue it was a clerical error on the part of the Commissioner, which ought to be corrected without further reissue or expense to the applicant.

"The act of March 3, 1837, § 6, provides 'That any patent hereafter to be issued may be made and issued to the assignee or assignees of the inventor or discoverer, the assignment thereof being first entered of record, and the application therefor being duly made, and the specification duly sworn to by the inventor.'

"The language is, '*may* be made and issued,' not 'shall be,' and it has been the constant practice of the

office to issue patents to the inventor unless otherwise specially requested by him. The mere facts of assignment and record do not impose upon the Commissioner the duty of issuing the letters patent to the assignee without further request, and the omission to do so is not therefore a mistake on his part. The rights of the assignee in the patent are precisely the same, whether the patent be issued to him or to the inventor, and whether it issue to the one or the other is a matter of form rather than of substance.

"In the case of *Dental Vulcanite Company* v. *Wetherbee*, (3 *Fish.*, 87,) where a similar correction is called the correction of a clerical error, the decision states that the error was corrected by reissue. The office records show that the patent was reissued to Cummings, January 10, 1865, after his sale to the Dental Vulcanite Company. On January 19, 1865, he addressed the office, stating the fact that all his rights were assigned to the Dental Vulcanite Company, and that the assignment was on record, and asking that the reissued patent 'be so amended as to recite the fact that the said reissue is granted to the said Dental Vulcanite Company.' This was refused, and on February 27, 1865, the reissue was surrendered, a fee of thirty dollars paid, and a new patent was reissued to the assignees, dated March 21, 1865.

"It is true that the learned judge speaks of this as the correction of a clerical error; but he adds, in effect, that it was an irregularity arising from an imperfection in the application. If the Commissioner was bound to issue to the assignee in all cases without request, upon the faith of the notice furnished by the record, the character of the application would have been immaterial.

"It must not be forgotten that applicants may make mistakes of a purely clerical character as well as the office. When the mistakes are those of the office, they will be corrected without expense to the applicant; but when he makes them, they can be cured only by a surrender of his old patent for correction, payment of the fee, and the issue of an amended patent.

"The error in the present case is one of the latter class, and can only be corrected by surrender and reissue." (*Commissioners' Decisions, February* 10, 1870.)

In the case of *Andrew ex parte*, (*motion*,) Acting Commissioner Duncan says: "This patent is for an improvement in door-knobs, and relates to a mode of adjusting the distance between the two knobs according to the thickness of the door upon which they are used, the adjusting mechanism consisting of a series of ratchet teeth upon the spindle, operating in connection with a spring detent located within the chamber or socket of the knob into which the spindle is to be inserted, the spring being made somewhat wider than the spindle, so that it can at any time be released by a proper instrument inserted by the side of the spindle through an orifice provided for that purpose. The claim is for 'the flat spring C, attached to the knob *spindle*, and adapted to engage with the ratchet teeth *a*, *a*,' &c.

"Unquestionably the word 'spindle' is erroneously used in the claim, and the patentee, by attorney, now moves that the specification be reprinted for the purpose of correcting the claim by erasing the interpolated word therefrom, on the ground that its insertion was a purely 'clerical error.'

"It is found upon examination of the papers that the

claim as it stands in the patent is in the precise language in which it was drawn by Andrew's attorney when his application was pending before the office. The error originated with applicant's duly authorized agent, and if in consequence the present owner of the patent is to any extent debarred his right to the full enjoyment of his invention, the appropriate remedy is as provided in § 53 of the patent act of July 8, 1870. It is an instance of a 'defective specification,' in which the error has arisen by 'inadvertence, accident, or mistake,' the word specification being employed in this connection in its generic sense, to include claim as well as mere description.

"As this case clearly comes within the category of those for which the remedy by reissue has been provided, it would be unwise, to say the least, if not, in fact, an act of questionable authority, to attempt to correct the error in the manner proposed.

"Of reissue patents, going out as they do with a new date and a distinctive number, the public are bound to take notice, the same as they are of original patents; but there is no official mode yet adopted of advertising to the world the fact and the character of changes made in the specification of a patent by the process sought to be applied in the present instance.

"The proposition is to issue a new patent, which is to retain the same date and number as the old one; and the public, not advised of any alteration in the original instrument, as they would be if a reissue had taken place, are to continue to use whatever certified or otherwise official copies have passed into circulation, in the full, though erroneous, belief that these copies are, in all particulars,

faithful transcripts of a public record which has, in point of fact, been changed, though without notice to the world.

"I am clearly of the opinion, therefore, for reasons of public policy as well as because of the express provision of the statute applicable to this case, that the patentee, if he finds himself hindered in his rights to any extent by reason of the error in the specification, should cure the defect by a reissue. The motion is denied." (*Commissioners' Decisions, July* 28, 1870.)

(See generally, as to the correction and effect of mistakes, *Kneass* v. *Schuylkill Bank*, 4 *Wash.*, 14; *Grant* v. *Raymond*, 6 *Pet.*, 241, 242; *Woodworth* v. *Hall*, 1 *Wood. & Minot*, 260, 398, 399; *Kittle* v. *Merriam*, 2 *Curt.*, 478.)

871. DIVISIONS OF A REISSUE, (*vide supra*, p. 255, *et seq.*) 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 reissue for each of such reissued letters patent. (*Act of July* 8, 1870, § 53.)

A patentee, in reissuing, may at his option have a separate patent for each distinct and separate part of the invention comprehended in his original patent, by paying the required fee in each case and complying with the other requirements of the law, as in original applications. Each division of a reissue constitutes the subject of a separate specification, descriptive of the part or parts of the invention claimed in such division; and the drawing may represent only such part or parts. All the divisions of a reissue will issue simultaneously. If there be controversy as to one, the other will be withheld from issue until the controversy is ended. (*Patent Office Rules, July*, 1870.)

If an original patent include two inventions, and its validity on that account is doubtful, a separate reissue is just and proper, (*Goodyear* v. *Day*, *MS. N. J.*, 1852;) and the patentee has a right to have a reissue of patents for each distinct part in order to effectually cure the defect. (*Ball ex parte MS. Appeal Cases, D. C.*, 1860.)

In the matter of the application of William Lowe, for the reissue of letters patent for an improved method of increasing combustion in steam boilers, granted June 4, 1867, the Commissioner says:

"Applicant devised an apparatus whereby the products of combustion arising from a furnace are conducted by tubes, which enter a combustion chamber at nearly opposite points. The currents are thus disturbed and caused to commingle, and while in this condition air or oxygen is introduced to them. It is claimed that combustion is much facilitated by this arrangement.

"For this apparatus he has applied and been allowed letters patent. He now seeks, in another division of his application, to obtain a second patent, with the following claim: 'The process above described of oxydizing the products of combustion, namely, by bringing air in contact with these gases while being mixed and in a state of disturbance.'

"The first answer to this claim is, that it cannot form the subject of a separate patent. It is not for a distinct and separate part of the thing patented in the original. The furthest point to which the division of inventions has been pushed has been to grant one patent for a process and another for the product of that process. Such patents have, with some hesitation, been sustained; (*Goodyear* v. *Honsinger*, 3 *Fish.*, 150; *Goodyear* v. *Wait*, 3 *Fish.*,

244; *Goodyear* v. *Providence Rubber Company*, 2 *Fish.*, 510;) but upon the express ground that this was a matter confided by law to the discretion of the Commissioner. But I have never known one patent to issue for a machine and another for the law or principle by which it operates. The mechanism of applicant is of no possible value except to carry out this process. Aside from this, it possesses no patentable utility. The process is of no avail, unless carried on through the medium of instrumentality. (*Morton* v. *New York Eye Infirmary*, 2 *Fish.*, 324.) It would be idle to sell the patent for the mechanism, and withhold that which covers its legitimate and only mode of operation.

Separate patents for processes and products have been justified upon the ground that the product might be imported, and a patent for the process would give no protection; but the machine and its mode of operation cannot be separated.

"Upon this ground alone the present application for a division cannot be sustained." (*Commissioners' Decisions, April* 30, 1870.)

872. ACTION OF THE COMMISSIONER.—In the case of *Allen* v. *Blunt*, 3 *Story*, 744, Story, J., says: "Whether the invention claimed in the original patent and that claimed in the new amended patent is substantially the same, is and must be in many cases a matter of great nicety and difficulty to decide. It may involve considerations of fact as well as of law. Who is to decide the question? The true answer is, the Commissioner of Patents, for the law intrusts him with the authority, not only to accept the surrender, but to grant the new amended patent. He is bound, therefore, by the very nature of his

duties, to inquire into and ascertain whether the specification is definite or insufficient, in point of law or fact, and whether the inventor has claimed more than he has invented, and in each case whether the error has arisen from inadvertency, accident, or mistake, or with a fraudulent or deceptive intention. No one can well doubt that, in the first instance, therefore, he is bound to decide the whole law and facts arising under the application for the new patent. *Prima facie*, therefore, it must be presumed that the new amended patent has been properly and rightfully granted by him. I very much doubt whether his decision is or can be re-examinable in any other place, or in any other tribunal, at least unless his decision is impeached on account of gross fraud or connivance between him and the patentee; or unless his excess of authority is manifest upon the very face of the papers; as, for example, if the original patent were for a chemical combination, and the new amended patent were for a machine. In other cases, it seems to me, that the law, having intrusted him with authority to ascertain the facts, and to grant the patent, his decision, *bona fide* made, is conclusive. It is like many other cases, where the law has referred the decision of a matter to the sound discretion of a public officer, whose adjudication becomes conclusive. Suppose the Secretary of the Treasury should remit a penalty or forfeiture incurred by a breach of the laws of the United States, would his decision be re-examinable in any court of law upon a suit for the penalty or forfeiture? The President of the United States is, by law, invested with authority to call forth the militia to suppress insurrections, to repel invasions, and to execute the laws of the Union; and it has been held by the

Supreme Court of the Uni.ed States that his decision as to the occurrence of the exigency is conclusive. In short, it may be laid down as a general rule, that where a particular authority is confided to a public officer, to be exercised by him in his discretion, upon an examination of facts, of which he is made the appropriate judge, his decision upon these facts is, in the absence of any controlling provisions, absolutely conclusive as to the existence of those facts. My opinion, therefore, is, that the grant of the present amended patent by the Commissioner of Patents is conclusive as to the existence of all the facts which were by law necessary to entitle him to issue it; at least, unless it was apparent on the very face of the patent itself, without any auxiliary evidence, that he was guilty of a clear excess of authority, or that the patent was procured by a fraud between him and the patentee, which is not patented in the present case." The Commissioner is presumed, in issuing new letters patent, to have discharged his duty faithfully and correctly, (*Allen* v. *Blunt*, 2 *Wood. & Minot*, 138,) and his action is not re-examinable elsewhere, unless a clear case of fraud is made out, (*Day* v. *Goodyear*, *MS. N. J.*, 1850, *Batten* v. *Taggart*, 17 *How.*, 84,) or unless it is apparent from the face of the patent that he has exceeded his authority, or unless there is a clear repugnancy between the old and new patent, or unless the new one has been obtained by collusion between the Commissioner and the patentee, (*Potter* v. *Holland*, 1 *Fish.*, 327.) The only mode of impeaching the reissue upon the ground that it is for a different invention from the original, where there is no allegation or proof of fraud, is by showing upon the face of the instrument that one is so different

from and repugnant to the other that the court can see that the invention described in the original is another and different one from that set forth in the reissue. (*Middletown Tool Company* v. *Judd*, 3 *Fish.*, 141; *Hussey* v. *Bradley*, 2 *Fish.*, 362.)

The Commissioner has power to decide, and in every acceptance of surrender does decide, that the original patent was inoperative and invalid by reason of a defective specification, or by claiming too much, and that the error arose by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention. (*Blake* v. *Stafford*, 3 *Fish.*, 294.)

He is authorized to grant a new patent for the same invention, and for no other; and when he grants the new one the presumption is that it embraces the same invention as the original, (*ib.*; *House* v. *Young*, 3 *Fish.*, 335;) but it is in accordance with the late decisions that the decision of the Commissioner is not conclusive upon the substantial identity of the inventions claimed in the original and reissued patents, (*Goodyear* v. *Berry*, 3 *Fish.*, 699;) and in the case of *Seymour* v. *Osborne*, 1869, (3 *Fish.*, 555,) Mr. Justice Nelson said: "It must be conceded that the action of the Commissioner, in receiving a surrender and granting a reissue, is very strong *prima facie* evidence that the case was one in which a reissue was proper and lawful, but the decision of the Commissioner upon this point is not conclusive; and the more recent decisions very clearly indicate the opinion that many reissues have been improperly granted, and that the abuses which have grown out of fraudulent or improper reissues have been such as to require a more rigid scrutiny in regard to the propriety and legality of the surrender and reissue of a

patent." (*Burr* v. *Duryee*, 1 *Wall.*, 531, 579; *Case* v. *Brown*, 2 *Wall.*, 320; *Sickles* v. *Evans*, 2 *Fish.*, 417; *Carhart* v. *Austen*, 2 *Fish.*, 543.

373. REISSUE MUST BE FOR THE SAME INVENTION AS THE ORIGINAL PATENT.—The general rule is, that whatever is really embraced in the original invention, and so described or shown that it might have been embraced in the original patent, may be the subject of a reissue, (*Patent Office Rules, July*, 1870.) 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 a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid. (*Act of July* 8, 1870, § 53.)

A reissue can be obtained only for that which was the original and true invention of the patentee, but which he failed to claim or describe in the original claim and specification, (*Hoffheim* v. *Brandt*, 3 *Fish.*, 218.) A new and different invention cannot be claimed. (*Batten* v. *Taggert*, 17 *How.*, 83.) The intent of the legislature was to enable patentees to cure *honest mistakes* and to get, *substantially*, *protection* for the *same invention* they had made and *intended* to be patented when the original patent was granted. (*Dyson ex parte*, *MS. Appeal Cases*, *D. C.*, 1860.) Only what was invented *before* or *at the time* of the grant of the original patent, and was *omitted* to be put in the original patent by accident or mistake, and without any fraudulent or deceptive intention, can be embraced in a reissue, (*Wilson* v. *Singer*, *MS. Appeal Cases*, *D. C.*,

1860,) and the invention must be shown in some part of the original patent, specifications, drawings, and model. (*Hoffheim* v. *Brandt*, 3 *Fish.*, 318.) The Commissioner is authorized to grant a new patent for the same invention, and none other, (*ib.*;) and where an invention was described in reissues of 1863, but not made in 1854, when the original patent was granted, the reissues were held to be void. (*American Wood Paper Company* v. *Hift*, 3 *Fish.*, 316.)

But differences of description or specification between the original and reissue are consistent with the identity of the thing patented. To correct a description or claim, or both, is one object of allowing a surrender, (*Crompton* v. *Belknap Mills*, 3 *Fish.*, 536;) and a patentee can legally take out a reissued patent for more than is described in the surrendered patent, if it does not exceed the actual invention when the first patent was taken out. (*Tatham* v. *Lowber*, *Mirror of Patent Office*, 146; *N. Y.*, 1847.) It may be that the ground covered by the reissue is enlarged beyond that embraced in the original, but the true question is, whether it is broader than the original invention. (*Blake* v. *Stafford*, 3 *Fish.*, 294.) The legal question is not what the patentee intended to patent, but what he had in fact invented. (*American Wood Company* v. *Hift*, 3 *Fish.*, 316.) The describing part of a machine in the first patent, but without making any claim to it, does not deprive the inventor of a right to a patent for such part. (*Batten* v. *Taggart*, 17 *How.*, 83.) If a certain feature of the original invention was the invention of the patentee, which he omitted to claim, he has a right, upon the surrender of the patent, to incorporate that element in a reissue. (*Swift* v. *Whissen*, 3 *Fish.*, 343.) If the drawings

show an element of the invention which the patentee has not included specifically in his claim, it is evidence nevertheless that it was a part of his invention, and he has a right to incorporate that element in a reissued patent. (*Ib.*) The patentee is entitled to every advantage within the full scope of his invention, and a new function developed by the combination of different elements of the invention will not be considered new matter. (*Bull ex parte, MS. Appeal Cases, D. C.*, 1860.)

In the case of an original application the applicant has no right, by law, to an amendment of his specification, except to conform his specification to the alterations suggested by the Commissioner, (*vide supra*, p. 333;) but an amendment in a case of a reissue is different: it is not of *grace*, but of right. (*Dyson ex parte, MS. Appeal Cases, D. C.*, 1860.)

In a reissued patent the patentee need not claim all that was claimed in the original patent. He may retain whatever he deems proper. (*Crompton* v. *Bellknap*, 3 *Fish.*, 536.) He is not bound to describe or claim all that he described or claimed in his original patent, but he cannot describe any new or other improvement. (*Goodyear* v. *Day, MS. N. J.*, 1852.)

Although, looking only to the claims of a reissue, it would be difficult to find any evidence that it was for the same invention as that specifically claimed in the original, and, indeed, a comparison of the language of these claims would seem, in the absence of all other proof, to repel such an allegation, yet this is not even conclusive. (*Hussey* v. *Bradley*, 2 *Fish.*, 326.) It is well settled, that in deciding upon applications for reissue, and the question whether the invention claimed on the

reissue is the same invention intended to be patented on the original application, the Commissioner of Patents is not confined to the claims, nor even to the examination of the evidence furnished by the specification, models, and drawings accompanying the original application, and that any legal proof to show it to be the same invention should be received. (*Ib.*)

Where the original and reissued specifications are consistent, or where there is *no* positive conflict or absolute inconsistency, the rule that, in the absence of fraud, the reissued patent is evidence of the identity of the inventions, may be applied; but, where it appears on the face of the respective specifications, as matter of law, that the specification and claim of the reissued patent are for a different invention from that secured in the original, the rule cannot be sustained. (*Sickler* v. *Evans*, 2 *Fish.*, 417.) And wherever it appears, upon a comparison of the two specifications and claims, as a matter of law arising on their construction, that the reissued patent is for a different invention from that secured in the original patent, then the original patent is void and of no effect. (*Ib.*)

The examiner has no authority for allowing new matter to be introduced in a reissue which was not shown in the original application, (*W. C. Dodge, Commissioners' Decisions*, 1869, p. 27.) Where the original application claims equivalents in general terms, such as are not shown in it cannot be enumerated specifically on a reissue, (*ib.*) Nothing but what was shown in the original specification, drawings, or model can be introduced into a reissue, (*ib.*) Nothing can be claimed in a reissue which was not shown in the original application, although

proof is offered that it is a necessary part of what was shown, (*ib.*) A patent that mentions in general terms that the invention may be used for other purposes not described, cannot therefore be reissued with a specification of any such purpose, (*Woodward* v. *Reist.*, *ib.*, 34.) The model or drawings may be amended by each other upon a reissue, but neither can be by the specification, (*Elizabeth Hawkes*, *ib.*, 37.) Devices not shown nor described in the original application, although alleged to be equivalents of what were, should not be introduced upon a reissue, (*Willis Humiston*, *ib.*, 47.) Although equivalents are claimed in general terms in an application, none but such as are shown in it should be specified in a reissue of the patent, (*J. A. Krake*, *ib.*, 100.) The construction of a machine which was evidently contemplated in the original specification may be described in explicit terms upon a reissue, (*George W. Brown*, *ib.*, 10.) The specification may be amended upon a reissue by the model originally filed, and the model or drawings may be amended by each other, but not by the specification, (*W. C. Dodge*, *ib.*, 27.

A reissue is prohibited, both by law and the rules of the Patent Office, for any thing save the same invention which was described or shown in the original patent, (*Dietz ex parte*, *MS. Appeal Cases*, *D. C.*, 1860.) But the legislature has not said by *what proof* the applicant shall show that his invention, claimed on reissue, is the same intended to be patented on his original application, and he is not limited by the statute to prove it by the original specifications, models, or drawing. Any legal proof, whether found in the record or *aliunde*, ought to be received and weighed. (*Dyson ex parte*, *MS. Appeal Cases*, *D. C.*, 1860.)

The law does not point to the model and drawiuge as the *sole* means of proof, and no authority is given to the Patent Office to limit the range of the applicant's proof, if it is such as, upon the law of evidence, is held sufficient to prove facts before other legal tribunals. (*Ib.*) The rules of the Patent Office as to reissues are general in their terms, and properly so. They do not profess to be without exception; they state what may be the subject of reissue, not what shall be, and do not prescribe that the mode mentioned therein shall be the only mode of proving identity of invention. (*Ib.*)

If there is a defect in the original patent and its specification, the applicant may resort to the next highest evidence, the model, to show the defects complained of, (*Bull ex parte, MS. Appeal Cases*, 1860,) and the model may be referred to as evidence of the extent of the invention. The applicant is not necessarily confined to the original record, *i. e.*, the patent and specification of his first patent. (*Ib.*)

It belongs to the province of the jury to decide whether the reissued patent is for the same invention as the original one. (*Carver* v. *Braintree Company*, 2 *Story*, 441, 442; *Batten* v. *Taggart*, 17 *How.*, 83; *Heilner* v. *Batten*, 27 *Penn.*, 521; *Stimson* v. *Westchester Railroad*, 4 *How.*, 404.) But the cases of *Batten* v. *Taggart* and *Carver* v. *Braintree Company* do not sustain the position that this question is one of fact, which *only* the jury can determine. The power of a court of equity to pass upon such fact is not touched by them. (*Poppenhausen* v. *Folke*, 2 *Fish.*, 181.)

374. SPECIFICATION AND CLAIM SUBJECT TO REVISION.—In all cases of applications for reissues the original claim, if reproduced in the amended specification, is subject to

re-examination, and may be revised and restricted in the same manner as in original applications; but if any reissue be refused, the original patent will, upon request, be returned to the applicant. (*Act of July* 8, 1870, § 53; *Patent Office Rules, July*, 1870.)

375. SURRENDER DOES NOT TAKE EFFECT UNTIL THE REISSUE IS GRANTED.—No surrender is made until the reissue is granted. Until the reissue is actually issued from the office the original patent remains uncanceled. It is usually deposited in the office with the application, as a guaranty that the application is made in good faith, and that, if the office is willing to grant the new patent, the old one shall be forthcoming. Besides this, as the demand for a reissue is declared to be based upon the invalidity of the original, an invalidity which the applicant is estopped to deny, (*Moffit* v. *Gaar*, 1 *Black*, 273,) the original patent is useless, and may well be committed to the custody of the office. Nevertheless, the uniform practice has been to return the original patent if a reissue be finally refused. There can be no doubt of the right of an applicant for a reissue to abandon his application at any time, and to demand and receive his original patent. Some have supposed the eighth section of the act of 1837 to be in conflict with this practice; but that section provides, not for an examination of the claims of the original patent, but for the examination of the new or corrected claims, in the same manner as upon an original application.

It is obvious that if the surrender does not take effect, and the patent remains uncanceled until the issue of the amended patent, the continuity is not broken. (*Whiteley ex parte, Commissioners' Decisions*, 1869, p. 72.)

If a reissue is not valid, the surrender which led to it will also be invalid, and the old letters patent will be considered in full force. (*Woodworth* v. *Edwards*, 3 *Wood. & Minot*, 137.)

376. RIGHTS CONFERRED BY REISSUE.—The new patent is issued to the patentee for the unexpired part of the term of the original patent, the surrender of which takes effect upon the issue of the amended patent, and the patent so reissued, together with the corrected specification, has the effect and operation in law, on the trial of all actions thereafter arising, as though the same had been originally filed in such corrected form. (See *Act of July* 8, 1870, § 53.) The reissued patent with corrected specifications has relation back to the emanation of the first patent as fully, for every legal purpose, as to causes subsequently accruing, as if the second patent had been issued at the date of the first one, (*Stanley* v. *Whipple*, 2 *McLean*, 37; *Smith* v. *Pearce*, 2 *McLean*, 176,) even though the original patent was invalid, (*Bloomer* v. *Stolley*, 5 *McLean*, 166,) and legalizes the rights of the patentee from the date of the first patent, (*Stanley* v. *Whipple*, 2 *McLean*, 37;) but it can cover only the same term that the original patent did. (*Woodworth* v. *Hall*, 1 *Wood. & Minot.*, 257.)

It operates, except to suits for violations commenced before the amendment, from the commencement of the original term. (*Ib.*) An action cannot be maintained for damages for an infringement occurring under the old patent before the surrender, (*Moffit* v. *Gaar*, 1 *Fish.*, 610;) but it is no defense to an action upon the reissued patent that the defendant's machine was made and put up during the original patent, under which he was not liable

to an action for infringement, (*Coe* v. *Rice*, 1 *Fish.*, 198,) nor will proof of the use of the thing patented during the interval between the original and reissued patents defeat the action, (*Batten* v. *Taggart*, 17 *How.*, 84.) No prior use of a defective patent can authorize the use of an invention after the emanation of a renewed patent, however long such use may have been after the date of the defective and surrendered patent. (*Stimson* v. *Westchester Railroad*, 4 *How.*, 402.)

There is a well-recognized difference between an extended and a reissued patent. The former grants a wholly new term, the latter only legalizes the right during the continuance of the original term. (*McBurney* v. *Goodyear*, 11 *Cush.*, 571.)

A contract concerning a patent made before its surrender applies to the reissued patent. (*Ib.*)

377. PETITION FOR A REISSUE, (BY THE INVENTOR.)—

To the Commissioner of Patents.

Your petitioner prays that he may be allowed to surrender the letters patent for an improvement in coal-scuttles, granted to him May 16, 1867, whereof he is now sole owner, [or, "whereof Henry Bates, on whose behalf and with whose assent this application is made, is now sole owner, by assignment,"] and that letters patent may be reissued to him for the same invention, upon the annexed amended specification.

RICHARD JONES.

378. PETITION FOR A REISSUE, (BY ASSIGNEES.)—

[To be used only when the inventor is dead.]

To the Commissioner of Patents:

Your petitioners pray that they may be allowed to surrender the letters patent for an improvement in coal-scuttles, granted May 16, 1867, to Richard Jones, now deceased, whereof they are now owners, by assignment, of the entire interest, and that letters patent may be reissued to them for the same invention, upon the annexed amended specification.

JOHN TOWERS.
ARCHIBALD SOMERS.

379. Oath by an Applicant for a Reissue, (Inventor.)

State of Pennsylvania, }
City and County of Philadelphia, } *ss.*

Thaddeus Tompkins, the above-named petitioner, being duly sworn, (or affirmed,) deposes and says that he verily believes that, by reason of an insufficient and defective specification, his aforesaid letters patent are inoperative and invalid; that the said error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, to the best of his knowledge or belief; that he is the sole owner of said letters patent, [or, "that Henry Bates is the sole owner of said letters patent, and that this application is made on the behalf and with the consent of said Bates;"] and that he verily believes himself to be the first and original inventor of the improvement set forth in this amended specification.

Thaddeus Tompkins.

Sworn to and subscribed before me this 26th day of July, 1869.

[Notarial Seal.]

Charles Candid,
Notary Public.

380. Oath by an Applicant for a Reissue, (Assignee.)

[To be used only when the inventor is dead.]

State of Virginia, }
City of Richmond. } *ss.*

Martin Halstead and Norris Brown, the above-named petitioners, being duly sworn, (or affirmed,) depose and say they verily believe that, by reason of an insufficient and defective specification, the aforesaid letters patent granted to Amos Mygatt are inoperative and invalid; that the said error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, to the best of their knowledge and belief; that the entire title to said letters patent is vested in them; and that they verily believe the said Amos Mygatt to be the first and original inventor of the invention set forth and claimed in the foregoing amended specification; and that the said Amos Mygatt is now deceased.

Martin Halstead.
Norris Brown.

Sworn to and subscribed before me this 14th day of November, 1869.

Morrison White,
Alderman and Justice of the Peace ex officio.

XXII. Extension.

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381. RÉSUMÉ OF THE LAW.—The Secretary of State, Commissioner of Patents, and Solicitor of the Treasury Department were, by the act of July 4, 1836, § 18, constituted a board of commissioners to hear evidence for and against the extension of patents, and to decide whether, having due regard for the public interest therein, it is just and proper that the term of the patent should be extended because the patentee has failed to obtain a reasonable remuneration. The commissioners being satisfied that the patent ought to be renewed, it was made the duty of the Commissioner of Patents to make a certificate on the original patent, showing that it extended

for a further term of seven years from the expiration of the first term. By the act of 1848, § 1, this power was vested solely in the Commissioner of Patents, who was thereby required to refer the application to the principal examiner having charge of the class of inventions to which the case belongs; and, upon his report, to grant or refuse the patent, upon the same principles and rules that had governed the board provided by the former act. The act of March 2, 1861, § 16, enacted that "all patents hereafter granted shall remain in force for the term of seventeen years from the date of issue, and all extension of such patents is hereby prohibited;" and the act of July 8, 1870, contains substantially the same provision; consequently, all patents granted after the passage of the act of 1861 are incapable of being extended, but patents granted before that date may still be extended on application. (*Curtis on Patents*, 285.)

382. DUTY OF APPLICANT.—Where the patentee of any invention or discovery, the patent for which was granted prior to the second day of March, 1861, shall desire an extension of his patent beyond the original term of its limitation, he shall make application therefor, in writing, to the Commissioner, 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 said invention or discovery. (*Act of July* 8, 1870, § 63.)

383. ASSIGNEE CANNOT APPLY.—Although the invention was sold and assigned before the patent was obtained,

and the extended term was sold to the same man, the application for extension should be made in the name of the patentee. (*Van Vliet ex parte, Commissioners' Decisions*, 1869, p. 93.)

384. WHEN APPLICATION MAY BE FILED BY ATTORNEY.—In the matter of the application of Henry Voelter for extension, Acting Commissioner Duncan says: "Question arises in this case as to the sufficiency of the proceedings under which the application was filed.

"The law requires that a patentee who is desirous of extending his patent beyond the term of its limitation shall make application in writing, &c., and that such application shall be filed at least ninety days before the expiration of the patent.

"Under this ninety days' limitation Voelter's application should have been in the Patent Office as early as June 1. In point of fact, the petition which bears his own signature was not received until July 2; but on the twenty-third day of May a duplicate of this petition was filed in the office by the inventor's retained counsel, the inventor's name being signed by such counsel in his character of attorney or agent.

"The requisite extension fee was paid on the same day, and the petition was accompanied with an affidavit by the party filing it, in which he set forth his relations to the case, and alleged that he had prepared and seasonably forwarded the original petition to the inventor's residence, in Germany, for his proper signature, but that, from recent telegraphic correspondence with him, it was feared that this would not be received back in time to meet the requirement of the statute if dependence were to be placed upon it alone.

"No serious question can be made as to the imperative character of the provision of law which fixes a limit of time for filing the petition. It is not an enactment addressed to the discretion of the Commissioner, but it is mandatory upon him; and he is as much required to insist upon a literal compliance with it as with those provisions of law which make it obligatory upon an applicant for a patent to take and subscribe the oath of invention, to complete the application within two years after filing the petition, or to pay the final fee within six months after notice of allowance.

"Passing this point, then, we come to the inquiry whether the filing an application for an extension is an act that must be done by the patentee *in propria persona*, or one that may also be performed by his duly authorized agent.

"For obvious reasons the law requires that the specification of a patent be signed by the inventor himself, if living. The oath, too, in original applications for patents, if not also in applications for extensions, is a personal matter, and must be made by the applicant himself.

"But the petition stands on a different basis. This is a matter of form merely. Its object in an extension case is simply to notify the office that the petitioner enters suit for an extension of the patent; and the object of the requirement that such notice be filed ninety days before the expiration of the original term is to enable the office to give the necessary publicity to the application by publishing it in the mode prescribed for sixty days prior to the day of hearing. Manifestly this can be done equally well whether the original notice comes from the hand of the party in interest or from his recognized agent. There

is nothing in the law that seems, directly or impliedly, to forbid the reception of the petition when signed by attorney; and in the absence of any such statutory prohibition, it is believed that a liberal policy in this regard is fully warranted by the analogies that obtain in the general law of principal and agent.

"If so, it is immaterial in the present case that the inventor's agent has not produced a written power of attorney for the performance of this specific act. His employment as counsel for the extension in the inventor's behalf, and the responsibility put upon him of preparing the papers relating thereto, are sufficient to establish the fact of agency; and no principle is better established than that an agent who is intrusted with general powers has all the implied powers within the scope of his employment.

"It would be unnecessary even that the agency be antecedently created, since an acquiescence by the principal in the assumed agency of another, when the acts of the volunteer agent are brought to his knowledge, is equivalent to an express authority.

"In the present instance, however, not only was there the pre-existing general agency, but the specific act of filing the duplicate petition was in effect ratified by the principal when he signed and filed the original. It is held, therefore, that the law in relation to the filing of applications for extensions has been complied with by the present applicant." (*Commissioners' Decisions; August* 26, 1870.)

The decision of Acting Commissioner Duncan, in the case of Voelter, was subsequently adopted by the Commissioner. In the case of *Garriques ex parte* the Com-

missioner says: "A petition for the extension signed by the administrator, per attorney, was filed June 9, 1870, and one by the administrator himself was filed on June 16. The first of these was filed more and the second less than ninety days prior to the expiration of the patent. It is insisted by the opponents of the extension, whose notice of opposition, it may be remarked, is liable to the same objection, that the law requires the petition to be signed by the applicant in *propria persona*, and that the petition signed by the attorney is a nullity.

"This precise point has just been decided by the Acting Commissioner in the case of Henry Voelter's extension. I agree with him in the opinion which he has expressed and adopt his conclusion as my own. Undoubtedly it is the better practice for the applicant himself to file the petition, and I should require some reason to be given in cases where the act is sought to be performed by attorney. Satisfactory reasons are given in Voelter's case and in the one under consideration. In the present case it appears that the estate had been fully administered and distributed, and the administrator, doubting his right to do so, was reluctant to appear. He did not, perhaps, realize that his relation to the patent was rather that of trustee for the benefit of the heirs, than of administrator of undistributed assets. When convinced of his right to prosecute the application, the time was so far spent that the rights of the heirs could only be saved by a petition filed by attorney.

"The statement, however, is duly made and sworn to by the administrator. The petition is a formal paper, bringing the case before the office preliminary to the substantial pleading, which is the statement, and no good reason

is perceived for refusing to receive it when executed by the applicant, through the medium of an agent, whose acts are duly authorized or ratified, when the circumstances are such as to justify the employment of such agency." (*Commissioners' Decisions, September* 5, 1870.)

385. WHEN APPLICATION MUST BE FILED.—The 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 said original term. (*Act of July* 8, 1870, § 63.)

In the case of J. T. & R. R. Smith the Commissioner says: "On August 8, 1870, applicants presented a petition for an extension of the patent granted to intestate, which they offered to file in the Patent Office. The patent will expire November 4, 1870. There would, therefore, be but eighty-nine days between the day of the filing of the application and the day of the expiration of the patent, if both of those days were included.

"Section 63, act of July 8, 1870, provides that the application for an extension 'shall be filed not more than six months or less than ninety days before the expiration of the original term of the patent.'

"The Commissioner has no power to waive this express provision of the law or to excuse the applicants for non-compliance. The language of the statute is positive, and has been universally treated as admitting of no exercise of discretion. Accordingly, in many cases in which the delay seemed unavoidable, Congress has interposed to grant relief by the passage of special acts, as well before as after the expiration of the patent.

"The petition in the present case cannot be received.

The fee of $50 deposited by applicants will be returned to them." (*Commissioners' Decisions, September* 22, 1870.)

386. ADMINISTRATOR MAY APPLY.—If a patentee is dead his administrator may apply for and obtain an extension of the patent. (*Nyman's cases*, 3 *Opinions of Attorneys General*, 446; *Brooks* v. *Bicknell*, 3 *McLean*, 258; *Washburn* v. *Gould*, 3 *Story*, 133; *Woodworth* v. *Wilson*, 4 *How.*, 716.) And this, although the original patentee had in his lifetime disposed of all his interest in bis patent. (*Wilson* v. *Rosseau*, 4 *How.*, 675.)

387. PUBLICATION OF NOTICE.—Upon the receipt of such application, and the payment of the duty 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. (*Act of July* 8, 1870, § 64.)

388. CASE TO BE REFERRED TO EXAMINER.—On the publication of such notice, the Commissioner shall refer the case to the principal examiner having charge of the class of inventions to which it belongs, who shall make to said Commissioner a full report of the case, and particularly whether the invention or discovery was new and patentable when the original patent was granted. (*Ib.*, § 65.)

389. OPPOSITION.—Any person may appear and show cause why the extension should not be granted. (*Ib.*, § 64.) Any person who intends to oppose an application for extension may, at any time after such application has

been made, give notice of such intention to the applicant. After this he will be regarded as a party in the case, and will be entitled to notice of the time and place of taking testimony; to a list of names and residences of the witnesses whose testimony may have been taken previous to his service of notice of opposition; to a copy of the application; and to any other papers on file, upon paying the cost of copying. (*Patent Office Rules, July*, 1870.) Any person opposing an extension must file his reasons of opposition in the Patent Office at least twenty days before the day of hearing. (*Ib.*)

390. TESTIMONY IN CONTESTED CASES.—In case of opposition to the extension of a patent by any person, both parties may take testimony, each giving reasonable notice to the other of the time and place of taking said testimony, which shall be taken according to the rules prescribed by the Commissioner in cases of interference. (*Ib.*) In contested cases no testimony will be received, unless by consent, which has been taken within thirty days next after the filing of the petition for the extension. (*Ib.*)

391. SERVICE OF NOTICE TO TAKE TESTIMONY.—Service of notice to take testimony may be made upon applicant, upon the opponent, upon the attorney of record of either, or, if there be no attorney of record, upon any attorney or agent who takes part in the service of notice or the examination of the witnesses of either party. Where notice to take testimony has already been given to an opponent, and a new opponent subsequently gives notice of his intention to oppose, the examination need not be postponed, but notice thereof may be given to such subsequent opponent by mail or by telegraph. This

rule, however, does not apply to *ex parte* examinations, or those of which no notice has been given when notice of opposition is served. (*Ib.*)

392. HEARING.—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. (*Act of July* 8, 1870, § 66.)

In the notice of the application for an extension a day will be fixed for the closing of the testimony, a day ten days later for the reception of arguments and for the filing of the examiner's report, and a day five days after this for a hearing; but no case will be set for a hearing more than three weeks prior to the expiration of the patent. Applications for a postponement of the hearing must be made and supported according to the same rules as are to be observed in cases of interference; but they will not be granted in such a manner as to cause a risk of preventing a decision in season. (*Patent Office Rules, July*, 1870.)

393. APPLICANT TO FURNISH STATEMENT UNDER OATH. The applicant for an extension must furnish to the office a statement in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures on account thereof, both in this and foreign countries. This statement must be made particular and in detail, unless sufficient reason is set forth why such a statement cannot be furnished. It must be filed within thirty days after filing the petition. (*Ib.*)

394. DIVISIONS OF A REISSUE.—When a patent has been reissued in two or more divisions, separate applications must be made for the extension of each division. (*Ib.*)

395. QUESTIONS CONSIDERED AND PROOF REQUIRED.—The questions which arise on each application for an extension are:

First. Was the invention *new* and *useful* when patented?

Second. Is it *valuable* and *important to the public*, and to what extent?

Third. Has the inventor been *reasonably remunerated* for the time, ingenuity, and expense bestowed upon it, and the introduction of it into use? If not, has his failure to be so remunerated arisen from neglect or fault on his part?

Fourth. What will be the effect of the proposed extension upon the public interests?

No proof will be required from the applicant upon the first question, unless the invention is assailed upon those points by opponents.

To enable the Commissioner to come to a correct conclusion in regard to the second point of inquiry, the applicant should, if possible, procure the testimony of persons disinterested in the invention, which testimony should be taken under oath. This testimony should have relation to nothing but what is actually covered by the claims of the patent.

In regard to the third point of inquiry, in addition to his own oath, showing his receipts and expenditures on account of his invention, the applicant should show, by testimony under oath, that he has taken all reasonable measures to introduce his invention into general use; and that, without neglect or fault on his part, he has failed to obtain from the use and sale of the invention a reasonable remuneration for the time, ingenuity, and

expense bestowed on the same, and the introduction of it into use. (*Ib.*)

396. As to Novelty.—A patent for a useless machine having been reissued with fourteen claims, of which but one embraced a device capable of advantageous use, and that an obvious device, and the patentee having sold the extended term for a limited sum, an extension of it, which would subject the trade to a heavy royalty, was denied, (*Lupton ex parte, Commissioners' Decisions*, 1869, p. 10.) The question whether an invention was sufficiently perfected when the patent was granted having been considered at the time, and discussed upon trials in which the patent was sustained, should not be agitated anew upon an application for an extension without cogent reasons, (*Burrows, ib.*, 48.) A patent will be extended upon the applicant's disclaiming a feature which had been anticipated, (*Crocker, ib.*, 85; *Woodbury, ib.*, 86; *Bailey, ib.*, 93.) Although a patent covering the principle on which a process depends has already been extended, yet a patent to another person, who first discovered the method of making the principle available, and reduced it to a successful practice, will also be extended, (*Wetherill, ib.*, 87.) A patent will not be extended unless it is restricted to the special use described of the device which is named, if the device is one which has been known before in other applications; *if the claim embraces it in general terms*, it is not enough to disclaim the former application of it, (*Stone, ib.*, 48.) A patent may be extended notwithstanding the claim was too broad, there not being sufficient time to correct it by a reissue, (*Crocker, ib.*, 85.) It is sufficient if, upon an extension, old devices are disclaimed, except when used in a certain combination

which is new, (*Woodbury, ib.*, 86.) Where matters have been improperly interpolated in a reissued patent, an extension of it will be refused, (*Krake, ib.*, 100.)

Upon an application for an extension of a patent the law requires a very rigid scrutiny into the original claim of the patentee as to the novelty and utility of the invention. (*Swift* v. *Whissen*, 3 *Fish.*, 343.)

397. As to Value and Importance.—Sales made under embarrassments are not a criterion of value upon a petition for an extension, (*Waterman ex parte, Commissioners' Decisions*, 51.) Although an invention was estimated at a high rate by witnesses, yet as no machine was ever made in accordance with the patent, and it had been sold back and forth at a nominal price, it was set down as of little value, (*Barrett, ib.*, 40.) An extension will be refused for the sole reason that the invention was of slight importance, (*Allender, ib.*, 46.) The extension of a patent will be refused when the only invention shown to be of any value was improperly interpolated upon a reissue, and did not appear in the original application, (*Goodale, ib.*, 82.) Where the invention as described in the original patent was never embodied in machines, the applicant will not be allowed to resort, in order to show its value, to machines manufactured under a reissue, in which old devices have been described and claimed, (*Taggart, ib.*, 102.) Upon applications for the extension of a patent the value of the invention will be estimated according to what it was as described in the original patent, irrespective of modifications improperly interpolated upon a reissue, (*Taggart, ib.*, 102.)

398. As to Remuneration.—In estimating the profits derived from a patented invention, only half of those

which have been made upon it in connection with another should, *prima facie*, be charged to it, (*Brown, ib.*, 10.) Where the invention could have cost but little time, ingenuity, or expense, was not of great public importance, and the patentee had reaped from it $64,594 86, his application for an extension was refused, (*Tucker, ib.*, 39.)

399. As to Policy.—A patent will not be extended when it would give the control of an important manufacture to assignees, who are to pay the inventor but one-fifth of the profits, (*Heck, ib.*, p. 19.) The patentee's want of diligence in originally applying for his patent is an objection to its being extended, (*Heck, ib.*, 19.) The extension of a patent should be refused when the patentee has done no more under it than to manufacture a few articles, has sold it at a low figure, and has disposed of most of his interest in the extension, if not the whole, (*Waters, ib.*, 42.) Devices not shown or described in the original application, having been introduced into a reissue, the patentee will be required to disclaim them as a condition of extending his patent, (*Humiston, ib.*, 47.) An extension will not be granted if it is for the benefit of an assignee, and not of the inventor, (*Van Vliet, ib.*, 93.)

400. Granting the Extension; Term.—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 said Commissioner shall make a certifi-

cate thereon, renewing and extending the said patent for the term of seven years from the expiration of the first term, which certificate shall be recorded in the Patent Office; and thereupon the said patent shall have the same effect in law as though it had been originally granted for twenty-one years. (*Act of July* 8, 1870, § 66.)

401. EFFECT OF EXTENSION.—A renewed patent has the same obligation and confers the same rights with an original patent. The inchoate property which vested by the discovery is prolonged by the renewed patent as well as by the original patent, (*Evans* v. *Jordan*, 1 *Brock.*, 254,) and the original patent becomes virtually a patent for twenty-one years. (*Gibson* v. *Harris*, 1 *Blatchf.*, 169; *Woodworth* v. *Edwards*, 2 *Wood. & Minot*, 125.) It is not essential to the validity of a renewed patent that all the proceedings should be set out at length; it is enough if it appears that the subject was before the proper officer, and that the decision was in favor of renewal. (*Brooks* v. *Bicknell*, 3 *McLean*, 435.)

402. ACTION OF THE COMMISSIONER.—The decision of the Commissioner of Patents upon an application for an extension, where he has jurisdiction, is conclusive as to the regularity of the proceedings, and cannot be the subject of examination and review elsewhere, except, perhaps, in case of fraud, which is an exception to the general rule. (*Colt* v. *Young*, 2 *Blatchf.*, 471; *Clum* v. *Brewer*, 2 *Curt.*, 506; *Brooks* v. *Bicknell*, 3 *McLean*, 435; compare *Wilson* v. *Rosseau*, 4 *How.*, 646.) But in the case of *Brooks* v. *Bicknell* it was held that the decision of the board of commissioners, (whose power is now vested in the Commissioner,) while conclusive as to matters of expense, the payment of the money required, and the

notice, was not conclusive as to the question of law, whether or not an administrator had a right, under the act of 1836, to apply for an extension. (3 *McLean*, 250.)

The decision of the Commissioner extending letters patent could not have been made without proof that the patentee had not derived a fair profit from his invention during the first part of his original term; and such decision, having been made after public notice and official investigation, shows that throughout the United States he was generally considered, as he was still considered at the Patent Office, the first inventor. (*Aiken* v. *Dolan*, 3 *Fish.*, 197.)

A notice of an application to extend the original patent is a sufficient notice of an application for the extension of a reissue; and as the functions of the Commissioner in extension cases are judicial, his judgment settles conclusively all questions of notice. (*Compton* v. *Belknap Mills*, 3 *Fish.*, 536.)

403. RIGHT OF ASSIGNEES.—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. (*Act of July* 8, 1870, § 67.)

Under the patent laws prior to 1836 a license or assignment expired with the limitation of the original patent, unless it was expressly in terms so granted as to be applicable to any renewal of the patent afterward. (*Washburn* v. *Gould*, 3 *Story*, 122, 135; *Woodworth* v. *Sherman*, 3 *Story*, 171.) The rule proceeded upon the ground that a man can pass by grant or assignment only that which he possesses and which is in existence at the time; and this doctrine is expressly applicable to licensees and assignees under the act of 1836, the whole design of

which is confined to the inventor and for his benefit, and not for the benefit of his licensee or assignee. (*Woodworth* v. *Sherman*, 3 *Story*, 171.) Therefore, the extension of a patent under § 67 of the act of 1870 does not inure to the benefit of assignees or grantees under the original patent, so as to vest in them any *exclusive* right; but the benefit of such renewal is limited to those who were in use of the patented article at the time of the renewal, and insures such persons the right to use the machine held by them at the time of such renewal. (*Wilson* v. *Rosseau*, 3 *How.*, 682.) The phrase "to the extent of their interest therein" means their interest in the patented machines, be that interest in one or more at the time of the extension, (*ib.*;) and the meaning of the word "thing patented," when construed in connection with the simple right to use, has reference to the thing patented. (*Ib.*)

The right of the assignee is limited to the right to *use*, although the person holding it may also have held, during the original term, an exclusive right to *make* and *vend*. (*Day* v. *Union Rubber Company*, 3 *Blatchf.*, 491.)

The object of the clause as to assignees is to preserve any previous contract or assignment in the sense in which both parties understood and intended it at the time it was made. (*Wilson* v. *Turner*, 7 *Law Reporter*, 530.)

A patentee cannot convey an extended patent before the extension. (*Day* v. *Candee*, 3 *Fish.*, 9.) He may, however, agree, upon a valuable consideration, to convey such right whenever it shall be vested in him. (*Ib.*)

The inchoate right of an inventor to an extension may be the subject of a contract of sale, (*Clum* v. *Brewer*, 2 *Curtis*, 506,) and an agreement made between a patentee, who is about to apply for a renewal of his patent, with

another, that in case of a renewal he will convey to him such renewed patent, in consideration of a certain sum, is valid, and, if the patent is renewed, such agreement conveys to the assignee an equitable interest or title, which can be converted into a legal title by offering to pay the agreed consideration, (*Hartshorn* v. *Day*, 19 *How.*, 220;) and where H agreed with A that, upon the fulfillment of certain considerations, he, H, would assign to A the extended term of certain letters patent, if the same should be extended, it was held that if the conditions had been fulfilled, H would have become the equitable owner of the extended term. (*Allen* v. *Dolen*, 3 *Fish.*, 197.)

Where J contracted to convey "to A a local interest in letters patent, to the utmost and fullest extent as to duration that he is or may be entitled to under the said letters patent," it was held that these words transferred an equitable title to the same local interest in an extension of said letters patent afterwards obtained, (*Chase* v. *Walker*, 3 *Fish.*, 120;) but a provision in a license, that a privilege is to continue during the term for which letters patent are or may be granted, is satisfied by holding it to apply exclusively to the reissue of the patent. There is nothing in the language which makes it exclusively or even necessarily applicable to an extension. (*Hodge* v. *Hudson River and Harlem Railroad*, 3 *Fish.*, 410.)

The established doctrine therefore is, that an assignee of a patent, holding, at the expiration of the first term, a right during that term to make and use the thing patented, may, during the term of its subsequent extension, continue to use it, and even repair it for use, but he cannot make it for use or for any other purpose, (*Wood* v. *Michigan and Southern Railroad*, 3 *Fish.*, 464;) but if the

patentee has agreed for a valuable consideration to convey the right in the extended term whenever it shall be vested in him, an equitable title in the extension of the letters patent afterwards obtained is transferred. (*Chase* v. *Walker*, 3 *Fish.*, 120; *Day* v. *Candee*, 3 *Fish.*, 9.)

Where a patent has been extended to a patentee, it is immaterial whether or not he was vested with the entire interest in the patent at the time of a surrender and reissue made prior to the extension. The extension vested an absolute and complete title in him, (*Potter* v. *Empire Sewing Machine Company*, 3 *Fish.*, 474;) and a reissue granted to an assignee may be extended to the patentee. In judgment of law, a reissue is only a continuation of the original patent. (*Crompton* v. *Belknap Mills*, *ib.*, 536.)

404. EXTENSION BY SPECIAL ACT OF CONGRESS.—Congress may, by special act, extend a patent even after the expiration of the original patent. (*Blanchard Gun-Stock Company* v. *Warner*, 1 *Blatchf.*, 274; *Blanchard* v. *Haynes*, 6 *West. Law Jour.*, 83.) Congress has the constitutional power to grant an extension of a patent after it has once been extended under § 18 of the act of 1836. (*Bloomer* v. *Stolley*, 5 *McLean*, 160.) There is no provision against such second extension. The policy of the law is to compensate the inventor, and if this object be not attained by a first extension, there would seem to be justice in a second. (*Ib.*) An act of Congress is not unconstitutional because it acts retrospectively to give a patent for an invention which was in public use. (*Blanchard* v. *Sprague*, 3 *Sumn.*, 541.) Such act of Congress is to be considered as ingrafted on the general laws relating to patents; they are statutes *in pari materia*, and such a patent is issued in pursuance of both. (*Evans* v. *Eaton*, 3

Wheat., 518; *Bloomer* v. *McQuewan*, 14 *How.*, 550.) A patent, when extended by act of Congress, after an extension under § 18 of the act of 1836, becomes a patent for twenty-one years. (*Gibson* v. *Harris*, 1 *Blatchf.*, 169.)

405. RIGHT OF ASSIGNEES UNDER EXTENSION BY ACT OF CONGRESS.—The right of an assignee to continue to use an invention, under his assignment during an extension of the patent, does not arise when the extension is by special act of Congress, and the assignment contains no provision to give such right. (*Bloomer* v. *Stolley*, 5 *McLean*, 158.) But in *Bloomer* v. *McQuewan*, (14 *How.*, 550,) in which case it was held that one in the lawful use of a machine, under a purchase, during the original term of a patent, is entitled to continue such use during an extension made by an act of Congress, unless there is something in the language of the act requiring a different construction. To enable an assignee to derive any benefit from an extension of a patent by act of Congress, an express provision should be inserted in the grant or assignment looking to such a renewal. Unless there be such a stipulation, showing that a renewal was contemplated, the court is bound to construe the instrument as relating to the existing right, in respect to which the parties are considered as contracting with each other. (*Gibson* v. *Cook*, 2 *Blatchf.*, 144.) If there is no reservation in an act of Congress extending a patent in favor of assignees, they have no right under the term thereby created, and they cannot even continue in the use of machines lawfully constructed before such term, and actually existing and in use when the former term expired. (*Gibson* v. *Gifford*, 1 *Blatchf.*, 529.)

406. PETITION FOR EXTENSION BY PATENTEE.—

To the Commissioner of Patents:

Your petitioner, now residing at Albion, Orleans county, New York, prays that the letters patent No. 12,841, for an improvement in steam-engines, granted to him August 17, 1853, may be extended for seven years from and after the expiration of the original term.

JAMES JOHNSON.

407. PETITION FOR EXTENSION BY AN ADMINISTRATOR.

To the Commissioner of Patents:

Your petitioner, Thomas Twitcher, administrator of the estate of Timothy Tweedle, deceased, (as by reference to the duly certified copy of letters of administration, hereto annexed, will more fully appear,) residing at Pittsburg, Allegheny county, Pennsylvania, prays that letters patent No. 12,842, for an improvement in stoves, granted to said Timothy Tweedle, August 24, 1853, may be extended for seven years from and after the expiration of the original term.

THOMAS TWITCHER,
Administrator.

408. FORM OF STATEMENT OF ACCOUNT.—

In the matter of the application of Fanny Forrester, of the city, county, and State of New York, executrix of the last will and testament of De Witt Forrester, deceased, for extension of letters patent No. 10,817, granted to him January 9, 1855, for improvement in mowing machines.

To the Commissioner of Patents:

The applicant respectfully represents that, prior to obtaining the letters patent now sought to be extended, the said De Witt Forrester was a farmer. That his attention was called to the subject of mowing machines by the difficulty of cutting grass by the machines then in use; that, after numerous patient and costly experiments, he succeeded in perfecting his invention and in obtaining his patent. He immediately made arrangements to manufacture the improvement, and for this purpose sold three fourths of his farm. He then, with others, built a factory and commenced operations; but, two years afterward, the establishment was destroyed by fire, without insurance. In the exposure at the fire Mr. Forrester contracted a disease which confined him to the house for three years, when he died, leaving applicant his executrix and widow, with a large family and small means. Nevertheless, applicant made every effort to induce manufacturers to use the improvement, and at last succeeded in inducing the firm of Weakly & Co., of Pemberton, New York, to recommence the manufacture of the machines. But after four years the firm failed, being largely in debt to appli-

cant for royalties. After this it became impossible for applicant to do anything with the invention. She wrote to various manufacturers and made personal application to others, but found them unwilling to make arrangement to pay royalties, or to use the invention in any way, unless she would sell the patent, including the extension, for a nominal sum. She states, however, that she has at length succeeded in perfecting an agreement with Merriam & Co., of Syracuse, New York, conditioned upon the extension, whereby the said firm agreed to manufacture the patented machines, and to pay her a royalty of three dollars upon each one made. Aside from the interest so vested in Merriam & Co., the entire interest in the extension remains vested in her, and she has made no assignment, contract, or agreement of any kind for the sale or assignment of the extended term to any person whatsoever.

Owing to the destruction of Mr. Forrester's books in the fire, it is impossible to prepare an accurate account of receipts and expenditures, but the following is believed to be as correct as it was possible to make it:

Receipts.

From profits from business, (for particulars of which see Schedule A).	$1,236 00
From royalties from Weakly & Co., (for details of which see Schedule B)	2,341 50
From sale of shop right to Brown & Jones, Penn Yan, N. Y.	250 00
Total receipts	$3,827 50

Expenditures.

Expense of procuring patent	$250 00
Net receipts	$3,577 50

The invention is exceedingly useful, as will be abundantly proved by the testimony. It is believed, if properly understood and appreciated, that it would now be incorporated in at least 50,000 mowing machines. Its value may be fairly fixed at the price which manufacturers have agreed to pay for it, which is three dollars per machine. If this estimate is even approximately correct, it is evident that the public have been greatly benefited; while the fact that Mr. Forrester invested his entire time and means, and finally lost his life in the prosecution of his invention, is respectfully offered as proof that he has not been adequately remunerated for his time, ingenuity, and expense bestowed upon this invention, and the introduction thereof into use.

Respectfully submitted,

FANNY FORRESTER,
Executrix.

409. OATH BY PATENTEE.—

STATE OF NEW YORK, }
County of Ontario, } ss.

Edward Monroe, the above-named applicant, being duly sworn, (or affirmed,) deposes and says that the foregoing statement and account by him signed is correct and true in all respects and particulars, to the best of his knowledge and belief.

EDWARD MONROE.

Sworn to and subscribed before me this 1st day of November, A. D. 1868.

PAUL PLACID,
Justice of the Peace.

410. OATH BY EXECUTOR.—

UNITED STATES OF AMERICA, }
Northern District of Ohio. } ss.

Roger Bacon, executor of the last will and testament of Simon Newcome, deceased, being duly sworn, (or affirmed,) deposes and says that the foregoing statement and account by him subscribed is correct and true in all respects and particulars, to the best of his information, knowledge, and belief.

ROGER BACON,
Executor, &c.

Sworn to and subscribed before me this 20th day of May, 1869.

WILLIAM BLACKSTONE,
U. S. Commissioner for the Northern District of Ohio.

411. REASONS OF OPPOSITION TO AN EXTENSION, (BY INDIVIDUALS.)—

In the matter of the application of Peter Prolong, for an extension of letters patent for improvements in sewing machines, No. 12,213, dated May 15, 1855.

To the Commissioner of Patents:

We wish to oppose the application above referred to, for the following reasons, viz:

First. Applicant was not the original and first inventor of the improvement claimed by him in said letters patent.

Second. If said alleged invention was ever made by applicant, which we deny, it is not *useful.*

Third. Said invention is not *valuable* and *important* to the public.

Fourth. Applicant has been *adequately remunerated* for his time, ingenuity, and expense in originating and perfecting his alleged invention.

Fifth. Applicant has not used due diligence in introducing his alleged invention into general use.

Sixth. Applicant has assigned to other parties all interest in the extension, and the extension, if granted, would not be for his benefit.

(See assignment to Veteran Grimes, dated April 1, 1864; recorded June 2, 1864, in liber J[10], p. 217.)

Seventh. The statement and account filed by applicant do not present a true statement of his receipts and expenditures.

DANIEL DRIVER.
SINCLAIR SCORCHEM.
JEREMIAH JOINING.

PAWTUCKET, RHODE ISLAND, *July* 19, 1869.

412. REASONS OF OPPOSITION TO AN EXTENSION, (BY A CORPORATION.)—

In the matter of the application of Timothy Twist, for an extension of letters patent for improvements in process for dressing thread, No. 13,119, dated May 19, 1855.

To the Commissioner of Patents:

The Growler Mills, a corporation established under the laws of Massachusetts, doing business at Fall River, Massachusetts, hereby gives notice of intention to oppose the application above referred to, for the following reasons, *viz:*

First. This company is extensively engaged in the manufacture and sale of sewing thread of the various kinds in general use, having large sums of money invested in business. It has been accustomed to dress thread by sizing and brushing, in substantially the same manner as warps and thread have been dressed and finished for many years, in the full belief that such process is neither new nor patentable. The said manufacture has been carried on for more than three years, with the knowledge and consent of said Timothy Twist, and without any claim to royalty or other compensation on his part, or pretense that he was the inventor of the said process. Within the past six months, however, he has threatened this corporation with an action for damages, unless an exorbitant sum of money were paid to him.

Second. Said letters patent are valid neither in law nor in fact; the alleged invention is not *valuable* and *important* to the public, and an extension would result in the prolongation of a vexatious and unfounded claim, which would compel a resort to litigation to prove the utter worthlessness of said patent.

This corporation is ready to substantiate by evidence these reasons of objection.

And said corporation hereby appoints Messrs. Morehead & Newton, of Fall River, Massachusetts, its attorneys and counsel, with full power to represent said corporation in all matters relating to said proposed extension.

Witness the seal of said corporation and the signature of its president, at Fall River, Massachusetts, this 3d day of April, A. D. 1869.

[SEAL.] THE GROWLER MILLS.
By RODERICK RITTENHOUSE, *President.*

[50-cent revenue stamp.]

The applicant for extension is required to forward to the Commissioner the original patent. If the patent has been lost or destroyed, the applicant should forward a statement, under oath, of the following form:

413. OATH TO THE LOSS OF LETTERS PATENT.-

STATE OF MASSACHUSETTS, } ss.
County of Suffolk. }

Charles Careful, of said county, being duly sworn, doth depose and say, that he is administrator of the estate of Henry Miner, deceased, late of Boston, in said county; that the letters patent No. 12,219, granted to said Henry Miner, and bearing date on the 9th day of January, A. D. 1855, have been lost or destroyed, as he verily believes; that he has made diligent search for the said letters patent in all places where the same would probably be found, if existing, and especially among the papers of the decedent; and that he has not been able to find said letters patent.

CHARLES CAREFUL,
Administrator, &c.

Subscribed and sworn to before me this 5th day of October, 1868.

PETER PLACID,
Justice of the Peace.

414. FORM OF CERTIFICATE OF EXTENSION.—

Whereas, upon the petition of A. W., of Auburn, in the State of New York, for the extension of the patent granted to him December 6, 1869, and reissued to him the fourth day of January, 1870, the undersigned, in accordance with the act of Congress approved the eighth day of July, 1870, entitled "An act to revise, consolidate, and amend the statutes relating to

patents and copyrights," did, on this twelfth day of October, 1870, decide that said patent ought to be extended:

Now, therefore, I, Samuel S. Fisher, Commissioner of Patents, by virtue of the power vested in me by said act of Congress, do renew and extend the said patent, and certify that the same is hereby extended for the term of seven years from and after the expiration of the first term, viz, from the fifth day of December, 1868, which certificate being duly entered of record in the Patent Office, the said patent has now the same effect in law as though the same had been originally granted for the term of twenty-one years.

In testimony whereof I have caused the seal of the Patent Office to be [SEAL.] hereunto affixed this fourth day of December, 1868, and of the independence of the United States the ninety-third.

SAM'L S. FISHER,
Commissioner

XXIII. Disclaimer.

SEC.	SEC.
415. When disclaimer may be filed; requisites.	418. Rights of grantees.
416. Action for infringement prior to disclaimer.	419. Owner of sectional interest may disclaim.
417. What should be set forth; when necessary.	420. Delay in filing.
	421. Effect of disclaimer.
	422. Form of disclaimer.

415. WHEN DISCLAIMER MAY BE FILED; REQUISITES. 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 duty 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: said 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. (*Act of July 8, 1870, § 54.*)

416. ACTIONS FOR INFRINGEMENT PRIOR TO DISCLAIMER. Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, a patentee shall have (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 as aforesaid, 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, provided it shall be a material and substantial part of the thing patented, and be definitely distinguishable from the parts so claimed, without right as aforesaid, notwithstanding the specification may embrace more than that of which the patentee was the original or 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; nor shall he be entitled to the benefits of this section if he shall have unreasonably neglected or delayed to enter said disclaimer, (*Ib.*, § 60.)

417. WHAT SHOULD BE SET FORTH; WHEN NECESSARY.—The interest of the party disclaiming should be set forth; but where an administrator, in whose name a patent had been extended, entered a disclaimer stating that he was the patentee, and referring to the patent as showing his interest, it was held to be sufficient, (*Brooks* v. *Bicknell*, 3 *McLean*, 439;) and where a patentee filed a disclaimer setting out that it was "to operate to the extent of the interest in said letters patent vested in the patentee," it was held that it fairly enough imported on its face that the patentee was the owner of the entire interest in the patent, and if so there was a substantial compliance with the statute as to the statement of interest, (*Foote* v. *Silsby*, 1 *Blatchf.*, 450;) and where the party disclaiming stated that he was the patentee, but said nothing in regard to a transfer of any part of the patent, the fair presumption is that he still owns the whole. (*Silsby* v. *Foote*, 14 *How.*, 221.) The law is not penal, but remedial; it is intended for the protection of the patentee as well as the public, and should not be restricted in its operation within narrower limits than the words of the law fairly import. (*O'Reilly* v. *Morse*, 15 *How.*, 121.)

A patentee may disclaim any thing which has been claimed through inadvertence or mistake, (*Parker* v. *Sears*, 1 *Fish.*, 93;) but a disclaimer is necessary only in cases where the thing claimed wrongfully is a material and substantial part of the thing invented. If it is not

essential to the machine, and was not introduced into the patent through wiilful default or intent to defraud or mislead the public, the want of a disclaimer affords no ground for invalidating the patent. (*Hall* v. *Wiles*, 2 *Blatchf.*, 199.) But when a patent is illegal in part, because of claiming more than the inventor has described, or more than he has invented, the patentee must disclaim in order to save the portion to which he is entitled. (*O'Reilly* v. *Morse*, 15 *How.*, 121.)

Inadvertence and error may occur as well in a disclaimer as a claim, (*Poppenhausen* v. *Fulke*, 2 *Fish.*, 181,) and a disclaimer in such a case will not prevent the patentee from embracing the part so disclaimed in a reissue of his patent. (*Hayden ex parte*, *MS. Appeal Cases*, *D. C.*, 1860.)

418. RIGHT OF ASSIGNEES.—If a disclaimer is filed by a patentee alone after an assignment of a part thereof, it will not operate in favor of the assignee in any suit, either at law or in equity, unless he has joined in it, (*Wythe* v. *Stone*, 1 *Story*, 294.) The disclaimer cannot affect a prior grantee unless he accept it, and he may refuse to be affected by it. (*Smith* v. *Mercer*, 5 *Penn. Law Jour.*, 531, *Kane*, *J.*, *Pa.*, 1846.)

419. OWNER OF SECTIONAL INTEREST MAY DISCLAIM.—The owner of a sectional interest may file a disclaimer, which will be considered as a part of the original patent to the extent of his interest, but the patentee is not compelled to join in such disclaimer, nor will it affect any one except him making it and those claiming under him. (*Potter* v. *Holland*, 1 *Fish.*, 327.)

420. EFFECT OF DELAY IN FILING.—In every suit brought upon a patent it is a good defense, both at law and in

equity, that there has been unreasonable delay or neglect to file a disclaimer where one is necessary. (*Wythe* v. *Stone*, 1 *Story*, 295; *Reed* v. *Cutler*, *ib.*, 600; *Brooks* v. *Bicknell*, 3 *McLean*, 449; *Hotchkiss* v. *Oliver*, 5 *Denio*, 318; *Parker* v. *Stiles*, 5 *McLean*, 56.)

What is "unreasonable delay" in filing a disclaimer is a mixed question of law and fact, to be decided under the direction of the court.) *Brooks* v. *Bicknell*, 3 *McLean*, 449.) It is a question of law for the court. (*Seymour* v. *McCormick*, 19 *How.*, 106; *Singer* v. *Walmsley* —.) The time in reference to the question of delay commences from when knowledge is brought home to the party that he is not the first inventor, or a court of competent jurisdiction has declared him not to be one. (*Singer* v. *Walmsley*, —.) Whether a disclaimer has been filed before or after the suit is brought, the plaintiff will not be entitled to the benefit thereof if he has unreasonably neglected or delayed to file it in the Patent Office. But such an unreasonable neglect or delay will constitute a good defense to the suit. (*Reed* v. *Cutler*, 1 *Story*, 600.) The question of delay in entering a disclaimer goes to the right of action, and if the jury are satisfied that there has been unreasonable negligence on the part of the patentee in making a disclaimer, then the whole patent is inoperative. (*Hall* v. *Wiles*, 2 *Blatchf.*, 198; *McCormick* v. *Seymour*, 3 *Blatchf.*, 222.)

421. Effect of Disclaimer.—The disclaimer mentioned in § 7 of the act of 1837 (*vide supra*, p. 23, § 54) applies solely to suits pending when the disclaimer is filed, and the disclaimer mentioned in § 9 of the same act (*vide supra*, p. 27, § 60) applies solely to suits brought after such disclaimer is filed. (*Wythe* v. *Stone*, 1 *Story*,

294.) If filed before the suit is brought, and the plaintiff establish on trial that a part of his invention not disclaimed has been infringed, he will be entitled to costs, (*Reed* v. *Cutler*, 1 *Story*, 600;) but if he omits to disclaim, and it appears on trial that he is entitled to be protected in a portion of his claims, but not in respect to another portion, he is still entitled to damages for the infringement of the valid portion, but is not entitled to costs, (*McCormick* v. *Seymour*, 3 *Blatchf.*, 222;) and a disclaimer will not affect any action pending at the time of filing it, except in respect to the question of unreasonable neglect or delay. (*Guyon* v. *Serrill*, 1 *Blatchf.*, 245.)

In the case of *Aiken* v. *Dolan* the complainant filed a bill in equity to restrain the defendant from infringing letters patent for "improvement in knitting needles."

Mr. Justice Cadwalader, delivering the opinion of the court, said: "By a proper disclaimer of the invention of latch needles without any such curvature the patent would, however, be sustainable for the actual improvement. The complainant proposes, through his counsel, to disclaim any construction of a latch needle which has not a swell, or its equivalent, substantially as shown in the drawings; and to repeat, in the words of the original specification, that what he claims as the invention of the patentee is the operation of the latch or tongue, &c., operated as therein described. The effect of such a disclaimer will be to deprive the complainant of all right to recover costs in the present suit. But a court of equity sometimes considers that which might and ought to be done as having already been done. There may, therefore, be a decree for a perpetual injunction, each party to pay his own costs, without any actual proof of record in the

Patent Office. According to the decision of the Supreme Court in *O'Reilly* v. *Morse*, (15 *How.*, 121,) it might perhaps be supposed that I should go further, and, before any actual disclaimer, decree an account or order an issue *quantum damnificatus*. But I do not think that a court whose decision is liable to reversion, on appeal, should in such case make any decree beyond the perpetual injunction without an actual disclaimer, previously recorded in the Patent Office. In the present stage of the case, therefore, I can do no more than award the injunction with leave to disclaim, and afterward to move for such further order for an account, &c., as may be deemed proper." (3 *Fish.*, 207.)

422. FORM OF DISCLAIMER.—

To the Commissioner of Patents:

Your petitioner, Ichabod Willis, of St. Louis, county of St. Louis, and State of Missouri, represents that he has, by grant duly recorded in the United States Patent Office, (liber —, p. —,) become the owner of an exclusive right within and for the several States of Maine, New Hampshire, and Vermont, to make, use, and vend to others to be used, a certain improved mechanical movement, for which letters patent of the United States were granted to Jeremiah Ingersoll, of Albany, in the county of Albany and State of New York, April 1, 1869; that he has reason to believe that, through inadvertence, accident, or mistake, the specification and claim of said letters patent are too broad, including that of which said 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:

"I also claim the sleeves A B, having each a friction cam C, and connected, respectively, by means of chains or cords, K L and M N, with an oscillatory lever, to operate substantially as herein shown and described."

ICHABOD WILLIS.

Witness: HENRY OAKLAND.

XXIV. The Patent.

Sec.	Sec.
423. Issuing, signing, and recording.	425. Date.
424. Contents and grant.	426. Form of patent.

423. Issuing, Signing, and Recording.—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, and they shall be recorded, together with the specification, in said office, in books to be kept for that purpose. (*Act of July* 8, 1870, § 21.)

424. Contents and Grant.—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 said invention or discovery throughout the United States and the Territories thereof, referring to the specification for the particulars thereof; and a copy of said specifications and of the drawings shall be annexed to the patent and be a part thereof. (*Ib.*, § 22.)

425. Date.—Every patent shall 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 shall not be paid within that period, the patent shall be withheld. (*Ib.*, § 23.)

426. Form of Patent.—

No. ——.

THE UNITED STATES OF AMERICA.

To all to whom these letters patent shall come:

Whereas, ——, of ——, ——, ha- alleged that —— ha- invented a new and useful ——, and ha- made —— that —— a citizen

of the United States; that —— verily believes —— the original and first inventor or discoverer of the said ——, and that the same hath not to —— knowledge and belief been previously known or used; —— ha- paid into the Treasury of the United States the sum of —— dollars, and presented a petition to the Commissioner of Patents praying that a patent may be issued therefor.

These are therefore to grant to the said ——, his ——, executors, administrators, or assigns, for the term of —— years from the —— day of ——, one thousand eight hundred and ——, the full and exclusive right and liberty of making, using, and vending to others to be used, the said ——, a description whereof is given in the annexed schedule, and made a part of these presents.

In testimony whereof I have caused these letters to be made patent and the seal of the Patent Office to be hereunto affixed. Given under [SEAL.] *my hand at the of city Washington, this —— day of ——*, in the year of our Lord one thousand eight hundred and ——, and of the independence of the United States of America the ——.

—— ——, *Secretary of the Interior.*

—— ——, *Commissioner of Patents.*

[Countersigned and sealed with the seal of the Patent Office.]

XXV. Patent Office Fees.

SEC.
427. All fees to be paid in advance.
428. Tariff of fees.
429. Final fee to be paid within six months.
430. How fees may be paid.
431. Money paid by mistake.
432. Revenue stamps.

427. ALL FEES TO BE PAID IN ADVANCE.—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. For the sake of uniformity and convenience, the remaining fees will be required to be paid in the same manner. (*Patent Office Rules, July*, 1870.)

428. TARIFF OF FEES.—The following is the tariff of fees established by law:

On filing every application for a design, for three years and six months	$10 00
On filing every application for a design, for seven years	15 00
On filing every application for a design, for fourteen years	30 00
On filing every caveat	10 00
On filing every application for a patent	15 00
On issuing each original patent	20 00
On filing a disclaimer	10 00
On filing every application for a reissue	30 00
On filing every application for a division of a reissue	30 00
On filing every application for an extension	50 00
On the grant of every extension	50 00
On filing the first appeal from a primary examiner to examiners-in-chief	10 00
On filing an appeal to the Commissioner from examiners-in-chief	20 00
On depositing a trade-mark for registration	25 00
For every copy of a patent or other instrument, for every 100 words	10
For every certified copy of drawing, the cost of having it made. (*Vide supra*, p. 309.)	
For copies of papers not certified, the cost of having them made.	
For recording every assignment of 300 words or under	1 00
For recording every assignment, if over 300 and not over 1,000 words	2 00

For recording every assignment, if over 1,000 words $3 00

429. FINAL FEE TO BE PAID WITHIN SIX MONTHS, (*vide supra*, p. 343.)—The final fee on issuing a patent must be paid within six months after the time at which the patent was allowed and notice thereof sent to the applicant or his agent. And if the final fee for such patent be not paid within that time the patent will be forfeited, and the invention therein described become public property, as against the applicant therefor, unless he shall make a new application therefor within two years from the date of the original allowance. (*Patent Office Rules, July*, 1870; *Act of July* 8, 1870, § 35.)

430. HOW FEES MAY BE PAID.—The money for the payment of fees may be paid to the Commissioner, 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, who shall give the depositor a receipt or certificate of deposit therefor, which shall be transmitted to this office. When this cannot be done without much inconvenience, the money may be remitted by mail, and in every case the letter should state the exact amount inclosed. Letters containing money may be registered. Post-office money-orders now afford a safe and convenient mode of transmitting fees. All such orders should be made payable to the Commissioner of Patents. (*Patent Office Rules, July*, 1870; *Act of July* 8, 1870, § 69.)

All money sent by mail, either to or from the Patent Office, will be at the risk of the owner. In no case should money be sent inclosed with models. All payments to

or by the office must be paid in specie, treasury notes, national bank notes, certificates of deposit, or post-office money-orders. (*Patent Office Rules, July*, 1870.)

431. MONEY PAID BY MISTAKE.—Money paid by actual mistake will be refunded; but a mere change of purpose after the payment of money will not entitle a party to demand such return. (*Patent Office Rules, July*, 1870; *Act of July* 8, 1870, § 70.)

432. REVENUE STAMPS must be attached as follows:

1st. A stamp of the value of fifty cents is required upon each power of attorney authorizing an attorney or agent to transact business with this office relative to an application for a patent, reissue, or extension.

2d. No assignment directing a patent to issue to an assignee will be recognized by this office, nor will any assignment be recorded, unless stamps shall be affixed, of the value of five cents, for every sheet or piece of paper upon which the same shall be written.

3d. The person using or affixing the stamp must cancel the same by writing thereupon the initials of his name and the date. (*Patent Office Rules, July*, 1870.)

PART IV.

CONTRACTS, ASSIGNMENTS, AND PRECEDENTS.

CONTRACTS, ASSIGNMENTS, AND PRECEDENTS.

I. Assignments.

SEC.

1. Patent may issue to assignees.
2. Assignments, &c.
3. Interests conveyed.
4. Recording.
5. Recording not essential as between the parties.
6. Object to protect bona fide purchasers.
7. Assignee.
8. Grantee.
9. Licensee.
10. Assignment before patent.
11. Effect and construction.
12. Sale on execution.
13. Assignees of alien inventors.
14. Form of assignment before patent.
15. Form of assignment of patent.
16. Form of assignment of undivided interest.
17. Form of exclusive territorial grant.

1. PATENT MAY ISSUE TO ASSIGNEES.—Patents may be granted and issued or reissued to the assignee of the inventor or discoverer, the assignment thereof being first entered of record in the Patent Office; but in such case the application for the patent shall be made and the specification sworn to by the inventor or discoverer; and also, if he be living, in case of an application for reissue. (*Act of July* 8, 1870, § 33.)

2. ASSIGNMENTS, GRANTS, AND CONVEYANCES.—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; and said 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. (*Act of July* 8, 1870, § 36.)

(As to right of assignee in cases of reissue, *vide supra*, p. 556. In cases of extension, p. 603.)

3. INTERESTS WHICH MAY BE CONVEYED.—A patent may be assigned, either as to the whole interest or any undivided part thereof, by any instrument in writing. No particular form of words is necessary to constitute a valid assignment, nor need the instrument be sealed, witnessed, or acknowledged; and a patent will, *upon request*, issue directly to the assignee or assignees of the entire interest in any invention, or to the inventor and the assignee jointly, when an undivided part only of the entire interest has been conveyed. When the patent is to issue in the name of the assignee, the entire correspondence should be in his name. The patentee may grant and convey an exclusive right under his patent to the whole or any specified portion of the United States, by an instrument in writing; or he may convey separate rights under his patent to make or to use or to sell his invention, or he may convey territorial or shop rights, which are not exclusive. Such conveyances are mere licenses, and need not be recorded. (*Patent Office Rules, July*, 1870.)

What if Congress provides for three kinds of assignments: first, as to the whole interest; second, as to an undivided part; and, third, an exclusive right in any district, (*Blanchard* v. *Eldridge*, 1 *Wall.*, 330;) but the stat-

ute renders the monopoly capable of subdivision as to locality, and in no other way. The patentee cannot carve out his monopoly, which is a unity, into a hundred or more, all acting in the same place and liable to come into conflict. (*Ib.*; *Whittemore* v. *Cutter*, 1 *Gall.*, 431; *Suydam* v. *Day*, 2 *Blatchf.*, 23.)

He cannot divide his right into parts and grant to one man the right to use it in its connection with or application to one thing, and to another in connection with a different thing, to such an extent as that *purchasers* from any of these persons may not use the fabric exactly as they like. (*The Washing-Machine Company* v. *Earle*, 3 *Wall.*, —.)

When the patentee sells the right to make, use, and *vend the invention in a particular place*, the purchaser buys a portion of the franchise which the patent confers; but the purchaser of a patented implement or machine for use in the ordinary pursuits of life stands on a different ground. By virtue of the contract of sale and the unconditional delivery of a patented article, it passes outside the monopoly, and is no longer under the peculiar protection granted to patent rights, (*Goodyear* v. *Beverly Rubber Company*, 1 *Clifford*, 348;) and when the patentee of certain processes and the products thereof, for a valuable consideration, sold the patented article, both the manufactured article and the materials of which it was composed passed to the purchaser, discharged of the peculiar privileges secured by the patent, and the purchaser may use the material in the manufacture of other articles not themselves protected by the patent, (*ib.*) and this although the patented article was bought of the patentee's licensee, who was restricted by the

license to a use of the patented product different from that to which it was devoted by the purchaser, (*ib.*;) but where a person had purchased of the owner of the invention certain knitting machines, with which the vendor was accustomed to send a package of needles used in the same, it was held, that the sale of the machines did not carry with it a right to the purchaser to manufacture new needles of the same construction as those sold, when those which he had bought were worn out, although the machines could not be operated without them, and the needles were the patented invention of the seller; the needles, however, being the subject-matter of a different patent from that covering the machine. (*Aiken* v. *Manchester Print Works*, 2 *Clifford*, 435.)

The grant of a machine, with the right to use it, does not import the same privileges under the patent as the sale of the right to make and vend the patented machine, (*ib.*) In the latter case the purchaser buys a portion of the franchise, and the right he acquires necessarily terminates at the time limited for the continuance of the patent; but in the former, the machine sold passes outside the monopoly, and is no longer under the protection of the patent act, (*ib.*,) and redress for injury in such case must be sought in the State courts, under State laws, and not under the special jurisdiction conferred on the Federal courts by the patent acts. (*Ibid.*)

4. RECORDING.—Every assignment or grant of an exclusive territorial right must be recorded in the Patent Office within three months from the execution thereof; otherwise, it will be void as against any subsequent purchaser or mortgagee for a valuable consideration without notice; but if recorded after that time, it will protect the

assignee or grantee against any such supsequent purchaser whose assignment or grant is not then on record. (*Patent Office Rules, July*, 1870.)

In every case where a patent issues or reissues to an assignee the assignment must be recorded at the Patent Office at least five days before the issue of the patent, and the specification must be sworn to by the inventor. (*Ib.*)

No assignment directing a patent to issue to an assignee will be recognized by the office, nor will any assignment be recorded, unless stamps shall be affixed of the value of five cents for every sheet or piece of paper upon which the same shall be written.

The person using or affixing the stamp must cancel the same by writing thereupon the initials of his name and the date. (*Ib.*)

The receipt of assignments is not generally acknowledged by the office. They will be recorded in their turn within a few days after their reception, and then transmitted to the persons entitled to them. (*Ib.*)

Three cases of the recording of assignments are provided for by the statute: first, an assignment of the whole patent; second, an assigument of an undivided part thereof; and, third, a grant or conveyance of an exclusive right under the patent within any specified part or portion of the United States. A grant of right, not being exclusive, need not be recorded. (*Brooks v. Byam*, 2 *Story*, 542.)

5. RECORDING NOT ESSENTIAL AS BETWEEN THE PARTIES.—To render an assignment valid under § 36 of the act of 1870, as *between the parties* and *against strangers*, it is not essential that it should be recorded. (*McKernan*

v. *Hite*, 6 *Ind.*, 430; *Case* v. *Redfield*, 4 *McLean*, 527.) The provision of the statute as to the recording of assignments within three months is merely directory, and, except as to intermediate *bona fide* purchasers without notice, any subsequent recording of an assignment will be sufficient to pass title to the assignee. (*Brooks* v. *Byam*, 2 *Story*, 524; *Boyd* v. *McAlpine*, 3 *McLean*, 424; *Peck* v. *Bacon*, 18 *Conn.*, 388; *Olcott* v. *Hawkins*, 2 *Amer. Law Jour.*, 319; *Hildreth* v. *Turner*, 17 *Ill.*, 185.) The recording is not a prerequisite indispensable to the validity of the assignment. (*Pitts* v. *Whitman*, 2 *Story*, 615, 618.) It is not necessary to make the transfer operative, but only essential to enable the assignee to sue in his own name, (*Blanchard's Gun-Stock Turning Company* v. *Warren*, 1 *Blatchf.*, 271;) and it is immaterial whether the assignment is recorded before or not till after suit brought. It is the common case of a deed required to be registered, where it is sufficient if it be registered before the trial, though after the suit is brought. (*Ib.*)

6. OBJECT OF RECORDING TO PROTECT BONA FIDE PURCHASERS.—The chief object of the requiring assignments to be recorded is manifestly the protection of *bona fide* purchasers, though not especially so declared. (*Gibson* v. *Cooke*, 2 *Blatchf.*, 148.) After the expiration of three months, if no record has been made of an assignment, and another assignment of the same right is made and recorded, the last assignment would be valid. (*Boyd* v. *McAlpine*, 3 *McLean*, 429.) To guard against an outstanding title of over three months' duration, the purchaser need only look to the records of the Patent Office; within that period he must protect himself as best he can, as an unrecorded assignment would prevail; but i‘

must be an assignment in writing, that may be recorded within the time limited. (*Gibson* v. *Cooke*, 2 *Blatchf.*, 148.)

7. ASSIGNEE.—An assignee is one who has transferred to him in writing the whole interest of the original patent, or an undivided part of such whole interest, in every portion of the United States. And no one, unless he has such an interest transferred to him, is an assignee. (*Potter* v. *Holland*, 1 *Fish*, 327.)

8. GRANTEE.—A grantee is one who has transferred to him in writing the exclusive right, under the patent, to make and use, and to grant to others to make and use, the thing patented, within and throughout some specified part or portion of the United States. Such right must be an exclusive sectional right, excluding the patentee therefrom. (*Ib.*)

9. LICENSEE.—A licensee is one who has transferred to him in writing or orally a less or different interest than either the interest in the whole patent, or an undivided part of such whole interest, or an exclusive sectional interest. (*Ib.*)

10. ASSIGNMENT BEFORE PATENT, (*vide supra, p.* 274, *et seq.*)—An assignment of a patent may be made as well before the issuing of a patent as afterward. The thing to be assigned is not the mere parchment, but the monopoly conferred—the right of property which it creates; and when the party has acquired an inchoate right, an assignment of it is legal, (*Gayler* v. *Wilder*, 10 *How.*, 477, 493;) and an invention may as well be sold before as after the application for a patent. (*Rathbone* v. *Orr*, 5 *McLean*, 132.) After the patent has been issued no new assignment is necessary; the legal right to the monopoly and the property it created is vested by

operation of the assignment in the assignee. So held when the assignment had been recorded before the patent issued. (*Ib.*) An assignment of an invention is not void by being executed before the invention is patented. It is a good transfer of the right of the patentee immediately upon his obtaining the patent, and he would be estopped from setting up any adverse title. (*Herbert* v. *Adams*, 4 *Mason*, 15.) An inventor may sell his invention before he obtains a patent; and after the patent has been obtained, the contract will secure to the assignee the extent of his right. The provision of law which requires the application for a patent to be made in the name of the inventor becomes necessarily a part of the contract; the inventor sells his right, and obligates himself to obtain a patent. (*Rathbone* v. *Orr*, 5 *McLean*, 131; and see *Rich* v. *Lippincott*, 26 *Jour. Frank. Inst.*, 3d s., 13.) An inventor may sell future improvements as well as those already made, and a second as well as a first patent for them. (*Nesmith* v. *Calvert*, 1 *Wood. & Minot*, 34.) It is not proper to grant a patent on a joint invention to one of two inventors upon the assignment of the other; but all who are concerned in the invention should join in the petition. (2 *Opinions Attorneys General*, 571.) Patents for inventions cannot, under § 6 of the act of 1837, issue jointly to the inventor as such and to the assignee of a partial interest, but may issue to the assignee or assignees of the whole interest. (4 *Ib.*, 401.) When a transfer or assignment of an inventor's right is only partial, although the part excepted be very small, the assignee has no legal claim to have the patent issue in his name. It should issue in the name of the inventor. (9 *Ib.*, 403.)

11. EFFECT OF ASSIGNMENT.—An assignment of an exclusive right to make, use, and vend to others a patented machine, within a certain territory only, does not prohibit the assignee from selling elsewhere, out of the said territory, the products of such machines. The restriction in the assignment applies solely to the using of the machine, and is no restriction as to place of the sale of the product. (*Simpson* v. *Wilson*, 4 *How.*, 709.) An agreement between a patentee and a third person, as trustee, that the latter should hold the patent and have the control thereof for the benefit of those who had a right to use the same, under contracts with the patentee, transfers the entire interest and ownership, legal and equitable, of the patentee in the patent to such trustee, for the benefit of those interested. (*Hartshorn* v. *Day*, 19 *How.*, 211.) An assignment of the revenues of a railroad, by the company, to a preferred creditor, and the use of the rolling stock, is not a transfer of corporate entity or property; and the use, by the assignee, of cars to which patented brakes were attached, does not render him liable to account for infringement upon the patent right, the exclusive use of the brakes having previously been licensed to the company by the patentee. The assignee used the brakes as an agent and not as a purchaser; such use, in the name of the company, being exclusive, in the meaning of the license. (*Emigh* v. *Chamberlain*, 1 *Am. Law. Reg.*, *n. s.*, 207; *S. C.*, 2 *Fish.*, 192.) A particular agreement allowing the use of a patent right held a mere license, and not an assignment conveying an interest in the patent. (*Armstrong* v. *Hanlenbeck*, 3 *N. Y. Leg. Obs.*, 43.) An assignment of the whole or any part of an interest in a patent will be valid, although it is

at the time the subject of litigation, (*Gay* v. *Cornell*, 1 *Blatchf.*, 510,) but a paper purporting to be the assignment of an expired patent is void as an assignment. (*Bell* v. *McCullough*, 1 *Fish.*, 380.)

Mere circumstantial differences between a description of the patent in the specification and in an assignment will not render the assignment invalid, (*Holden* v. *Curtis*, 2 *N. Hamp.*, 63,) nor do they indicate fraud or prevent the right from passing. (*Case* v. *Mowry*, 1 *N. Hamp.*, 349.) An assignment may be exclusive, although limited to a certain number of machines, (*Washburn* v. *Gould*, 3 *Story*, 131;) such limitation is not inconsistent with the grant of an exclusive territorial right. (*Ib.*, 167.) The term exclusive comprehends not only an exclusive right to a whole patent, but the exclusive right to a patent in a particular section of country. (*Ib.*, 131.) If an assignment contains no warranty, the vendee cannot set up a parol warranty, for it is presumed that the writing contains the entire contract, (*Jolliffe* v. *Collins*, 21 *Mo.*, 341,) unless it is also alleged that the warranty was false and fraudulent, and then parol proof is only evidence of such representation. (*McClure* v. *Jeffrey*, 8 *Ind.*, 83.) The conveyance of a patent by A, with the written consent of B, in whom the title then was, is equally effective with a conveyance directly from B. (*Sherman* v. *Champlain Transportation Company*, 31 *Vt.*, 175.)

12. SALE ON EXECUTION.—A patented machine, and the right of use attached to it, may pass by sale, devise, or levy of execution, or assignment of any insolvent's effects. (*Woodworth* v. *Curtis*, 2 *Wood. & Minot*, 524.) The sale of a patented machine by a sheriff, under an execution, does not, in and of itself, convey to the purchaser

any right to use the machine in the manner pointed out in the patent right. The purchaser acts at his own peril. (*Sawin* v. *Guild*, 1 *Gall.*, 485.)

13. ASSIGNEES OF ALIEN INVENTORS take and hold the patent, which may be issued to them with all the privileges belonging to American patentees. The clause in § 15 of the act of 1836, (5 *Stats. at Large*, 123,) requiring the invention to be put on sale in a certain time, applies only to alien patentees. (*Tatham* v. *Lowber*, 2 *Blatchf.*, 49.) To the contrary, (*Tatham* v. *Loring*, 5 *N. Y. Leg. Obs.*, 207.)

14. FORM OF ASSIGNMENT OF THE ENTIRE INTEREST IN AN INVENTION BEFORE THE ISSUE OF LETTERS PATENT.—

In consideration of $1, to me paid by Ephraim G. Hall, of Cleveland, Ohio, I do hereby sell and assign to said Ephraim G. Hall all my right, title, and interest in and to a certain invention in plows, as fully set forth and described in the specification which I have prepared [if the application has been already made, say "and filed"] 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 to the said Ephraim G. Hall, as my assignee, for the sole use and behoof of the said Ephraim G. Hall and his legal representatives.

Witness my hand this sixteenth day of February, 1868.

[5-cent revenue stamp.] J. F. CROSSETTE.

15. FORM OF ASSIGNMENT OF THE ENTIRE INTEREST IN LETTERS PATENT.—

In consideration of $500, to me paid by Nathan Wilcox, of Keokuk, Iowa, I do hereby sell and assign to the said Nathan Wilcox all my right, title, and interest in and to the letters patent of the United States, No. 41,806, for an improvement in locomotive head-lights, granted to me July 30, 1864, the same to be held and enjoyed by the said Nathan Wilcox to the full end of the term for which said letters are granted, as fully and entirely as the same would have been held and enjoyed by me if this assignment and sale had not been made.

Witness my hand this tenth day of June, 1869.

[5-cent revenue stamp.] HORACE KIMBALL.

16. FORM OF ASSIGNMENT OF AN UNDIVIDED INTEREST IN THE LETTERS PATENT AND EXTENSION THEREOF.—

In consideration of $1,000, to me paid by Obadiah N. Bush, of Chicago, Illinois, I do hereby sell and assign to the said Obadiah N. Bush one undivided fourth part of all my right, title, and interest in and to the letters patent of the United States, No. 10,485, for an improvement in cooking-stoves, granted to me May 16, 1856; the same to be held and enjoyed by the said Obadiah N. Bush to the full end of the term for which said letters patent are granted, and for the term of any extension thereof, as fully and entirely as the same would have been held and enjoyed by me if this assignment and sale had not been made.

Witness my hand this seventh day of January, 1869.

JOHN C. MORRIS.

[5-cent revenue stamp.]

17. FORM OF ASSIGNMENT OF EXCLUSIVE TERRITORIAL GRANT BY AN ASSIGNEE.—

In consideration of $1,000, to me paid by William H. Dinsmore, of Concord, New Hampshire, I do hereby grant and convey to the said William H. Dinsmore the exclusive right to make, use, and vend within the State of Wisconsin and the counties of Cook and Lake, in the State of Illinois, and in no other place or places, the improvement in corn planters for which letters patent of the United States, dated August 15, 1867, were granted to Leverett R. Hull, and by said Hull assigned to me December 3, 1867, by an assignment duly recorded in liber X^{s}, p. 416, of the records of the Patent Office, the same to be held and enjoyed by the said William H. Dinsmore as fully and entirely as the same would have been held and enjoyed by me if this grant had not been made.

Witness my hand this nineteenth day of March, 1868.

ABRAHAM MOORE.

[5-cent revenue stamp.]

II. Licenses and Contracts.

SEC.
18. Licenses need not be recorded.
19. Construction and effect.
20. Assignee of license.
21. Licenses for single machines.
22. Other contracts.
23. Form of license, shop-right.
24. Form of license with a royalty.

18. LICENSES NEED NOT BE RECORDED.—The patentee

may convey separate rights under his patent to make or to use or to sell his invention, or he may convey territorial or shop rights which are not exclusive. Such conveyances are mere licenses, and need not be recorded. (*Patent Office Rules, July*, 1870.)

A conveyance transferring a less or different interest in the patent than either the interest in the whole patent, or an undivided part of such whole interest, or an *exclusive* sectional interest, is a mere license, and need not be recorded. (*Potter* v. *Holland*, 1 *Fish.*, 327; see also *Stevens* v. *Head*, 9 *Vt.*, 177; *Brooks* v. *Byam*, 2 *Story*, 541.)

19. CONSTRUCTION AND EFFECT OF LICENSE.—A contract of license is like every other contract, and depends upon a fair construction of the acts of the parties. (*Bell* v. *McCullough*, 1 *Fish.*, 380.) As to the principles upon which a license to manufacture under a patent should be construed, and their application to a license in particular cases, see *Washburn* v. *Gould*, 3 *Story C. C.*, 122; *S. C.*, 1 *West. Law Jour.*, 465; 7 *Law Rep.*, 276; *Day* v. *Cary*, 1 *Fish.*, 424; *Day* v. *Stellman*, *ib.*, 487. H assigned to M, A & Co. all his right and interest under his patent in twenty-three counties in Ohio, including that in which the defendants' manufactory was carried on. M, A & Co. were to pay ten dollars for each machine made and sold by them, while H reserved the right of sending machines of his own manufacture into the territory named in the contract. Held, that this paper was not an assignment of the interest of H in the patent within the territory named, but a mere license. (*Hussey* v. *Whitely*, 2 *Fish.*, 120; see also *Potts* v. *Jameson*, 15 *Barb.*, 315.) A license to use vulcanized iudia-rubber

for coating cloths, for the purpose of japanning, marbling, and variegated japanning, is limited to the particular kinds of goods mentioned, and conveys no right to use the rubber for coating cloths for any other purpose, (*Goodyear* v. *Providence Rubber Company*, 2 *Fish.*, 499;) but the public cannot be compelled to notice or regard agreements between the patentee and his licensee as to the limitation of the use of articles made by them. (*Metropolitan Washing-Machine Company* v. *Earle*, 2 *Fish.*, 203.) The purchase of a license forms no bond of allegiance to the patentee or an estoppel to the licensee from averring or proving any defense in an action for the infringement of the patent which any other person might use, (*Burr* v. *Duryee*, 2 *Fish.*, 275;) but when the defendants were licensees of the plaintiff, and stamped every article made with the name and date of the patent, the act was a public acknowledgment that the articles were made under the patent, notwithstanding their protest that it should not be so considered. (*Jones* v. *Vankirk*, 2 *Fish.*, 586.) A covenant between a patentee and his licensees that they will not manufacture certain articles may be valid as between the parties, but it does not run with the article manufactured like a covenant as to land. Such a contrivance to destroy competition may be valid, but the covenant binds only the parties to it. If a stranger purchase the product from one licensed to use the process, he need look no further, and may use it for his own purposes, without inquiring for or regarding any private agreement of licensees not to compete with one another. (*Metropolitan Washing-Machine Company* v. *Earle*, 2 *Fish.*, 203.) Where a railroad fifty-eight miles long, having a license to use a patented improvement, subsequently acquired by con-

solidation and change of name two hundred and ten miles more, held, that the license did not extend to or protect the newly acquired portion. (*Emigh* v. *Chicago, &c., Railroad Company*, 2 *Fish.*, 387.) Where a person agreed with a patentee to pay him a certain sum on every patented article manufactured by him, the patentee brought his action for money had and received, it was held that the jury might infer the receipt of money from the fact of the sale of the article, and that judgment should be rendered for the plaintiff as upon an executed contract. (*Stanley* v. *Whipple*, 2 *McLean*, 35.)

20. ASSIGNEE OF LICENSE.—A license to use a patented machine may be assigned, it not being a mere personal privilege, (*Woodworth* v. *Curtis*, 2 *Wood. & Minot*, 527; *Wilson* v. *Stolley*, 5 *McLean*, 2;) but a mere license to a party, without having his assigns, or equivalent words to them, showing that it was meant to be assignable, is only a grant of a personal power to the licensee, and is not transferable by him to another. (*Troy Iron and Nail Factory* v. *Corning*, 14 *How.*, 216.) Where D had an exclusive license to use the patent of G for a particular purpose, covenanting not to use it for other purposes, and to pay a specified tariff for such use, and C took an assignment of such license, it was held, that C took the license subject to the obligation to pay the specified tariff on what he should make under it. (*Goodyear* v. *Congress Rubber Company*, 3 *Blatchf.*, 449.)

21. LICENSE RELATIVE TO SINGLE MACHINES.—The limitation of the number of machines to be made or used under a patent is not inconsistent with the grant of an exclusive right in the patent within such territory. (*Washburn* v. *Gould*, 3 *Story*, 162.) Where one licensed

to run a patented machine sells such machine, the license to run does not necessarily pass with the machine. (*Wilson* v. *Stolley*, 4 *McLean*, 275.) The right of a licensee to use a patented machine may be assigned to a third person. A machine and the right to use it is personal property rather than a mere patent right, and has all the incidents of personal property, making it subject to pass by sale. (*Woodworth* v. *Curtis*, 2 *Wood. & Minot*, 524.) The right to *use* a machine, to be constructed according to a certain specification, involves the right to *make* or cause to be made the machine thus permitted to be used. (*Ib.*) A right or license to use *one* machine during the term of the patent does not mean any particular machine then sold, but has reference to what must be considered, therefore, one machine in number at one time. A second machine may be run if the first one wears out, or is destroyed by fire, or is constructed erroneously, or is disused entirely for want of repair. (*Ib.*; *Wilson* v. *Stolley*, 4 *McLean*, 275.) The right to construct a patented machine is distinct from the right to use it, the latter necessarily implying the right to repair, and also to purchase, when the one in use is worn out or destroyed. (*Bicknell* v. *Todd*, 5 *McLean*, 236.) Where the only right to use a patent was one which resulted from the purchase of a machine, such right is coextensive with the existence of the machine, and expires with it. (*Day* v. *Union Rubber Company*, 3 *Blatchf.*, 488.) A grant of a right by a patentee to make and use a patented machine within a term for which it has been granted will give the purchaser of machines from such grantee the right to use the *machine patented* as long as the machine itself lasts; nor will this right to

use a machine cease because an extension of the patent, not provided for when the patentee made his grant, has since been allowed, and the machine sold has lasted and is used by the purchaser within the term of time covered by this extension. (*Bloomer* v. *Millinger*, 1 *Wall.*, 340.)

22. OTHER CONTRACTS.—A party has no authority to grant licenses under a patent upon a mere agreement with the patentee to assign such patent. Before such a party can grant licenses, the patent must be actually assigned. (*Day* v. *Hartshorn, MS.*, 21, 1854.) While the exclusive rights of a patentee are specially guarded from intrusion, the contracts which he makes to share them with third persons are interpreted and enforced in the same manner as other legal engagements. (*Morse* v. *O'Reilly*, 6 *Penn. Law Jour.*, 501; 2 *Whart. Dig.*, 414.) Contracts in relation to a patented machine or implement are regulated by the laws of the several States, and are subject to State jurisdiction. (*Wilson* v. *Sandford*, 10 *How.*, 99.) An agreement made between B and C and others, providing for the settlement of various matters, the discontinuance of certain suits, and also as to the manufacture of a certain article, as follows: "That the said parties may each hereafter manufacture and vend spikes of such kind and character as they see fit, notwithstanding their conflicting claims to this time," must be construed with reference to the situations of the parties to it. As B claimed that he had the exclusive right, under his patent, to make such spikes, which right the defendant, C, was infringing, but defendant, C, claimed that he did not infringe such patent, but made such spikes by an entirely different method: held, that such an agreement did not give C a license to make such spikes after B's patent, but only a

right to make them by the same process or machinery he had been before using. (*Troy Iron and Nail Factory* v. *Corning*, 14 *How.*, 193; reversing, S. C., 1 *Blatchf.*, 467.) Where a patentee granted to V the exclusive right to construct and use and vend, within a certain territory, ten *planing, tongueing, and grooving* machines, and the grant declared that V was to enjoy an exclusive use of the patent within said territory, limited to said ten machines, and afterward the patentee granted to K the exclusive right under the patent of making, using, and vending within the same territory *molding planing machines:* held, that the grant first made to V conveyed the entire interest of the patentee, and that the subsequent grant to K was void. (*Ritter* v. *Serrell*, 2 *Blatchf.*, 379.) To an action of covenant upon an agreement, which granted a license to make and vend a patented article, the licensee agreeing to keep an account of the articles manufactured and to pay a fixed price per pound on those sold, it is no defense that the patent is invalid. (*Wilder* v. *Adams*, 2 *Wood. & Minot*, 329.)

23. LICENSE; SHOP-RIGHT.—

In consideration of $50, to be paid by the firm of Simpson, Jenks & Co., of Huntsville, Alabama, I do hereby license and empower the said Simpson, Jenks & Co. to manufacture, at a single foundery and machine shop in said Huntsville, and in no other place or places, the improvements in cotton-seed planters, for which letters patent of the United States, No. 71,846, were granted to me November 13, 1868, and to sell the machines so manufactured throughout the United States to the full end of the term for which said letters patent are granted.

Witness my hand this 22d day of April, 1869.

JOEL NORCROSS.

[5-cent revenue stamp.]

24. LICENSE, NOT EXCLUSIVE, WITH ROYALTY.—

This agreement, made this 12th day of September, 1868, between Morrison White, party of the first part, and the Uniontown Agricultural Works,

party of the second part, witnesseth: That whereas letters patent of the United States for an improvement in horse-rakes were granted to the party of the first part, dated October 4, 1867; and whereas the party of the second part is desirous of manufacturing horse-rakes containing said patented improvement; now, therefore, the parties have agreed as follows:

I. The party of the first part hereby licenses and empowers the party of the second part to manufacture, subject to the conditions hereinafter named, at their factory in Uniontown, Maryland, and in no other place or places, to the end of the term for which said letters patent were granted, horse-rakes containing the patented improvements, and to sell the same within the United States.

II. The party of the second part agrees to make full and true returns to the party of the first part, under oath, upon the first days of July and January in each year, of all horse-rakes containing the patented improvements manufactured by them.

III. The party of the second part agrees to pay to the party of the first part $5, as a license fee upon every horse-rake manufactured by said party of the second part containing the patented improvements; provided, that if the said fee be paid upon the days provided herein for semi-annual returns, or within ten days thereafter, a discount of fifty per cent. shall be made from said fee for prompt payment.

IV. Upon failure of the party of the second part to make returns, or to make payment of license fees, as herein provided, for thirty days after the days herein named, the party of the first part may terminate this license by serving a written notice upon the party of the second part; but the party of the second part shall not thereby be discharged from any liability to the party of the first part for any license fees due at the time of the service of said notice.

In witness whereof the parties above named (the said Uniontown Agricultural Works, by its president) have hereunto set their hands this day and year first above written.

MORRISON WHITE.
UNIONTOWN AGRICULTURAL WORKS,
By JABEZ REYNOLDS, *President.*

[5-cent revenue stamp.]

III. British Assignments.

SEC.
25. Assignments should be by deed.
26. Patentee may assign to himself and others.
27. Assignment before patent.
28. License.
29. Form of words required.
30. Estoppel.
31. Registry.
32. Stipulations and covenants.
33. Form of license.
34. Form of agreement to purchase share before patent.

25. ASSIGNMENTS OR TRANSFERS OF PATENTS SHOULD BE MADE BY DEED; that is, by a document or instrument in writing, on paper or parchment, and signed by the parties, sealed with their seals, and formally "delivered" as their "act and deed," like other deeds.

Assignments should contain such stipulations and provisos as the parties think desirable; they are in practice often restricted to the disposal of a share in the patent, such as a *half*, a *third*, a *twentieth* share, and so forth; but unless the deed stipulates how the patent is to be worked, it seems difficult to say what actual beneficial interest is thus conveyed, because coproprietorship in a patent does not seem to necessitate joint participation in profits. The proper course in such cases would appear to be to place the patent in trust, to be worked by the trustee or his agent for the benefit of all the creditors, in accordance with their respective shares.

26. PATENTEE MAY ASSIGN TO HIMSELF AND OTHERS.—As since the property-law amendment act, 22 and 23 Vict., cap. 35, sec. 21, the proprietor of personal property may assign to himself, or herself, and others, if such an arrangement be deemed suitable, the patentee can make an assignment in that manner, with stipulations

that he or she is to work the patent and pay over to the coproprietors their respective shares in the profits; or, under an assignment made in manner above stated, a receiver or manager may be appointed to work the patent and pay over the proceeds to the proprietors according to their respective shares. Sometimes assignments are clogged with a condition that the patentee shall be employed in carrying out the invention at a stipend to be paid by the assignees, and in such cases there are frequently stipulations that the patentee shall give his time to the carrying out of the invention; but according to the case of *Stocker* v. *Wedderburn*, 1857, (3 *Kay & Johnson Reports*, 393,) actual compliance with such a stipulation cannot be enforced by injunction, although it may entitle those interested to damages for default. An assignment of a patent may be made by way of mortgage. Further, such assignment will be good when there is a stipulation that upon the happening of a stated event the patent shall thereupon become and be transferred. (*Cartwright* v. *Amatt*, 2 *Davies's Patent Cases.*)

27. ASSIGNMENT BEFORE PATENT.—It not unfrequently happens that an inventor obtains pecuniary aid when applying for provisional protection, and in such case the party supplying the money wishes to have an assignment of the patent rights. The course then usually adopted is to have a memorandum of agreement prepared and signed by the parties, obliging the inventor to assign the patent as soon as it is obtained. For in such a case there seems to be a legal difficulty in the way of making a positive assignment to take effect upon the event of the grant of the patent being made, because the inventor has then no potential position with regard to the property therein,

for it does not depend on him whether it ever will be granted, but on the volition of the Crown. There are, however, several law cases which imply that, although in strict law no proper assignment can be made before the patent is granted, yet if the person assigning receive the consideration for the contract, and afterwards become possessed of the property, the court of chancery will compel him to perform the contract; and it appears that chancery will enforce the specific performance of an agreement by injunction, even where the payment of the purchase-money is all that is required. (*Cogent* v. *Gibson*, 33 *Beavan Reports*, 557, 1864; *Reeve* v. *Whitmore*, 12 *Weekly Reporter*, 113.) But the words must be clear in order to pass the property, per Lord Chancellor Westbury. (*Holroyd* v. *Marshall*, 9 *Jurist Reports*, 213, 1863.)

28. LICENSE.—A patentee may license others to make, use, exercise, and vend the said invention, still retaining the property in the patent to himself, even when such license may affect the whole term of the patent and the whole extent of territory for which it is granted. This is a *sole* and *exclusive* license; but licenses may be sole and exclusive with regard to a certain district or place, or they may be simple licenses to use, exercise, and vend, either limited as to place or district, or not, in which cases of simple licenses other licenses may be granted to other parties, the only effect of such simple licenses being to free the licenses from any action or proceeding for infringement.

29. FORM OF WORDS REQUIRED.—It is the proper and safe course to make the license by deed, especially in cases where sums of money as royalty payments may be stip-

ulated to be paid, or conditions may be imposed as to the manner of working under the patent.

There is no particular form of words required to be used in a deed of license or a deed of assignments, but as regards any stipulation or agreement which it is intended should have full legal force and effect given to it, that should be expressly stated as a "covenant" between the parties.

30. ESTOPPEL.—Moreover, the statements made in the document must be carefully considered, because they may work what is termed an "estoppel;" that is, they may hereafter stop the truth from being brought before the court, if the truth is at variance with what has been distinctly averred by the solemn act of executing the deed containing the former contrary statements.

This is apparent from the old cases of *Oldham* v. *Laymead*, (cited 3 *Term Reports*, 439,) and *Bowman* v. *Taylor*, (2 *Adolphus & Ellis Reports*, 278;) also the modern case of *Smith* v. *Scott*, (*Law Journal*, vol. xxviii, p. 325;) *Laws* v. *Purser*, (6 *Ellis & Blackburn Reports*, *p.* 930.)

And it is usually understood that without a special statement reserving the right of the licensee or assignee or purchaser of a patent to question its validity, he cannot, after executing the deed, question the validity of the patent, so as to recover back any part of the purchase-money, unless, indeed, he can show fraud in the transaction; for he is considered to have acknowledged its validity by the deed, and to be thereby estopped. (*Noton* v. *Brooks*, 1861, 7 *Hurlstone & Norman Reports*, 499.)

31. REGISTRY.—The patent law amendment act, 1852, requires licenses and assignments to be registered; and this is an important point to be attended to. And by the

same act, as before stated, the register may be altered in certain cases, as there stated.

In Morey's patent, 1858, (25 *Beavan Reports*, 581,) alterations were made in the register by adding the entry of a non-registered assignment made previously to another assignment which had been duly registered. In this case there was evident fraudulent dealing.

Re Green's patent, 1858, (24 *Beavan Reports*, 145,) the patentee assigned the patent, which was omitted to be registered, and afterwards he assigned to another party, who registered at once. The first assignee then registered, and moved the master of the rolls to expunge the first entry, which he ordered to be expunged with costs.

32. STIPULATIONS AND COVENANTS.—Licenses in practice, whether sole and exclusive or otherwise, are made under various circumstances, imposing various conditions on the licensee. Sometimes the payment of a fixed sum is the consideration for granting the license; more often a certain sum is paid by way of premium, and a percentage or royalty is to be paid on all articles made under the patent. This royalty is not unfrequently simply a payment of a fixed amount per machine or article, or given quantity of articles. Stipulations are introduced as to the keeping of accurate accounts or verification of accounts by statutory declaration; for inspection by patentee of the books of accounts and of the manufactory or workshops of the licensee; and even the power of distraint for non-payment of royalties is in some cases stipulated for.

It may be advisable that in no case shall a license be granted without either a premium at the time of grant or a minimum sum per annum being reserved as pay-

able, as otherwise the licensee, after having obtained the *license and led the patentee to believe that his patent has* been put in working train, may possibly, from various circumstances, be induced to refrain from any operations under it, and deprive him of the expected benefit.

However, the stipulations and conditions of licenses and assignments must be such as the law will give effect to.

It is not unusual to introduce into licenses a condition that the licensee shall not make any machines or articles of a similar kind without the patent improvements being applied *thereto; and it has been argued that this stipula*tion could not be supported in law, as being in restraint of trade.

In *Jones* v. *Lees*, 1868, (*Exchequer Reports*, *new series*, vol. i, p. 193,) such a covenant was upheld, it not being a covenant for an unreasonable time, but only for the term of the license.

The construction of the covenants in assignments and licenses follows the usual rules of law in construing deeds, as to which the case of *Webster* v. *Newsome*, (5 *Hurlstone & Norman*, 42,) may be referred to by those who wish to enter into details on that point.

In assignments, and perhaps in licenses, there may probably be covenants to pay the deferred stamp duties at the third and seventh years. In the case of *Hill* v. *Mount*, (18 *Common Bench Reports*, 72,) an agreement to assign and pay for letters patent was held not to compel the payment of the third year's stamp duty.

It is sometimes stipulated in licenses that the licensee shall use his best endeavors to detect infringers, and that the patentee shall prosecute them; and sometimes the licensee is left to prosecute them.

According to the case of *Renard* v. *Levenstein*, 1865, (Aniline dye patent,) an exclusive licensee has a right to use the name of the patentee to bring actions of infringement.

And in *Dunnicliff & Bagley* v. *Mallett*, *Dunnicliff & Bagley* v. *Berkin and another*, 1859, (7 *Common Bench Reports*, new series, p. 209,) an assignee of a part of a patent was adjudged to have a right to bring an action of infringement without joining the possessors of the other part or parts.

It may be remarked that both assignments and licenses, whether exclusive or otherwise, may have reference to *part* of any invention only. Thus they may refer to the use of the invention for a certain class of articles, or to some parts of a combination, and not to the whole, and so forth.

Both assignments and licenses usually contain covenants or clauses that all differences between the parties shall be submitted to arbitration; and a short way of doing this is to provide that the proceedings for arbitration shall be in accordance with the common-law-procedure act, 1854, (17 and 18 Vict., cap. 125,) as that act contains explicit directions on the subject. It is also desirable that all questions of the construction of the wording of the deeds should be required to be submitted to some particular conveyancing counsel or the conveyancing counsel of the court of chancery, either ultimately or primarily. In preliminary agreements it should always be provided that any further deed or document that may be deemed requisite shall be afterwards executed, in order to give legal effect to the transaction according to its true intent and meaning.

33. FORM OF LICENSE TO USE A PATENTED INVENTION.—This indenture, made the —— day of ——, between [*grantor*] of, &c., of the one part, and [*licensee*] of, &c., of the other part: Whereas by letters patent dated the —— day of ——, her majesty Queen Victoria granted unto [*grantor*,] his executors, administrators, or assigns, for the term of fourteen years, the exclusive privilege of using, exercising, and vending, within the united kingdom of Great Britain and Ireland, the Channel Islands and Isle of Man, the invention of a certain method of weaving: And whereas the said [*grantor*] hath become entitled to the patent and the benefit thereof: And whereas the said [*grantor*] hath agreed with the said [*licensee*] to grant to him a license to use the said invention to the intent and upon the terms herein expressed: Now this indenture witnesseth, that in pursuance of the said agreement, and in consideration of the covenants and agreements hereinafter entered into by the said [*licensee,*] he, the said [*grantor,*] doth grant unto the said [*licensee*] full license and authority, within the limits granted by the said letters patent, to use and exercise the said invention so far as the same relates to the weaving or manufacturing of ——, but not further or otherwise; and to vend all such —— as shall have been woven or manufactured by him during the continuance of this license or agreement, by means of or according to the principle of the said invention, for and during the unexpired residue of the term granted by the said letters patent, if the said [*licensee*] should so long live, subject nevertheless to the restrictions and provisions hereinafter contained, yielding and paying therefor unto the said [*grantor,*] his executors, administrators, and assigns, at the times and in the manner hereinafter expressed, the royalties or sums of money hereinafter by the said [*licensee*] covenanted to be paid: And the said [*licensee*] doth hereby, for himself, his heirs, executors, and administrators, covenant with the said [*grantor,*] his executors, administrators, and assigns, in manner following; that is to say:

1. That the said [*licensee*] shall pay to the said [*grantor,*] his executors, administrators, and assigns, the following rates and tributes: — for all —— woven or manufactured according to the principles of the said invention, in which no silk shall be used, either in warp or weft, for every shuttle used and employed in weaving the above-mentioned fabrics, for every week of such use, if the said fabric shall not exceed in width —— inches, the sum of ——; if above —— inches and not exceeding —— inches, the sum of ——; and for every additional inch in width above —— inches, the further sum of ——; and so in proportion for any less period of user than a week: And for all —— woven or manufactured according to the principles of the said invention, in which silk shall be used, for

every shuttle used and employed in weaving the above-mentioned fabrics, for every week of such user, if the fabric shall not exceed in width ——— inches, the sum of ———; if above ——— inches and not exceeding ——— inches, the sum of ———; and for every additional inch in width above ——— inches, the further sum of ———; and so in proportion for any less period of user than a week; such payments to be made on the first day of any calendar month during the continuance of the license, the first payment to be made on the first day of the month ensuing the date hereof, provided that the said [*licensee*] shall in no case, either in silk or cotton, manufacture any webs of a greater width than ——— inches.

2. That the said [*licensee*] shall not use or employ any shuttle in manufacturing according to the principles of the said invention during the night, but only in the usual and ordinary hours of day labor, and for not more than ——— hours in each twenty-four hours.

3. That on or before the last day of each calendar month during the continuance of this license the said [*licensee*] shall, by notice in writing, inform the said [*grantor*,] his executors, administrators, or assigns, or his or their agent in that behalf, of the number of shuttles intended to be used or employed in the ensuing month in the weaving of the said ———, distinguishing those to be used for the weaving of fabrics in which silk shall be used, and of the place or places where such shuttles respectively are intended to be employed.

4. That in case, at the expiration of any calendar month during the continuance of this license, the said [*licensee*] shall be desirous of increasing the number of shuttles employed by him for the purpose aforesaid, he shall, previously to such employment, give to the said [*grantor*,] his executors, administrators, or assigns, or his or their agent in this behalf, notice in writing of such intention and of the place or places where such increased number of shuttles are intended to be employed; and that the said [*licensee*] shall be deemed and taken to have used and employed for the purposes aforesaid, from the period of giving any such notice or notices as aforesaid until the expiration of the current calendar month for the time being, all the shuttles which in any such notice or notices as aforesaid he shall have signified his intention to use and employ, whether he shall in fact have so used or employed them or not.

5. That the said [*licensee*] shall, within the first three days of each calendar month during the continuance of this license, give unto the said [*grantor*,] his executors, administrators, or assigns, or his or their agent in that behalf, a statement in writing, signed by the said [*licensee*] or his agent, of the number of shuttles used and employed by the said [*licensee*] during the

preceding calendar month in the weaving of the said ——; distinguishing those used for the weaving fabrics in which silk shall be used, and also specifying and distinguishing the widths manufactured by the said shuttles respectively, and the respective times during which such shuttles shall have been employed.

6. That if at any time or times during the continuance of this license the said [*licensee*] shall use or employ any shuttles for weaving —— by means of or according to the principles of the said invention, without previously giving to the said [*grantor,*] his executors, administrators, or assigns, or his or their agent in that behalf, such notice in writing as is hereinbefore agreed to be given of his intention to use the same; or if the said [*licensee*] shall at any time during the continuance of this license neglect or refuse to give in such notice as is agreed to be given during the first three days of every calendar month of the shuttles used during the preceding month, then and in such case (and when and so often as the same shall happen) the said [*licensee*] shall, on the first day of the calendar month next after such use or employment or neglect as aforesaid, pay unto the said [*grantor,*] his executors, administrators, or assigns, the sum of £—— for each and every shuttle which shall have been so used or employed or of which no notice shall have been given as aforesaid, contrary to the covenant in that behalf hereinbefore contained.

7. That the said [*licensee*] shall not, at any time or times during the continuance of this license, use or employ, or knowingly permit or suffer to be used or employed, any shuttle whatever for weaving the said —— according to the principles of the said invention in any place or places other than such as shall have been specified in the notice in writing which shall have been given by the said [*licensee*] of his intention in that behalf.

8. That if at any time or times during the continuance of this license the said [*licensee*] shall use or employ, or knowingly permit or suffer to be used or employed, any shuttle for weaving the said —— according to the principles of the said invention in any place or places other than such as shall have been specified in such notice as aforesaid, or otherwise contrary to any of the stipulations herein contained; then and in every such case the said [*licensee*] shall, on the first day of the calendar month next after such use or employment, pay unto the said [*grantor,*] his executors, administrators, or assigns, the sum of £—— for each and every shuttle which shall have been so used or employed contrary to any of the stipulations herein contained.

9. That it shall be lawful for the said [*grantor,*] his executors, administrators, or assigns, and his or their agent or agents, at all seasonable times

in the daytime during the continuance of this license, to enter into and upon any factory, shop, house, or other place where the said [*licensee*] may be carrying on any manufacture or business, and then and there to inspect any shuttles and machinery which may be employed by the said [*licensee*] in the weaving of such —— as aforesaid, [or in any other weaving process,] and to ascertain the number of shuttles and the width of the fabrics woven therewith.

10. That the said [*licensee*] shall purchase of and from Messrs. —— ——, —— ——, or of such other persons as the said [*grantor*,] his executors, administrators, and assigns, shall nominate or appoint in that behalf, all the —— which the said [*licensee*] shall during the continuance of this license use or employ in the manufacture of the said —— fabrics as aforesaid, they, the said —— ——, —— ——, or such other person or persons as aforesaid, selling the same to the said [*licensee*] at the usual and accustomed price for the time being charged by them or him for such ——, and that the said [*licensee*] shall not, without the license and consent of the said [*grantor*,] his executors, administrators, and assigns, use or employ in their shuttles any other than the said —— so purchased.

11. That if the said [*licensee*] shall, at any time or times during the continuance of this license, use or employ in the manufacture of such —— as aforesaid any —— other than such as shall be purchased by him of and from the said —— ——, or such other person or persons as aforesaid, then and in every such case he the said [*licensee*] shall, provided the said —— ——, or such other person or persons as aforesaid, shall have been willing to sell the same to him at the usual and accustomed price, pay unto the said [*grantor*,] his executors, administrators, and assigns, the sum of —— for each and every pound weight of such —— which he, the said [*licensee*,] shall so use as last aforesaid.

12. That he, the said [*licensee*,] will not at any time hereafter assign or transfer or underlet the license hereby granted, or in any manner exercise or permit the same to be exercised, for the benefit, either wholly or in part, of any person or persons whomsoever, as manufacturer or manufacturers, other than the said [*licensee*,] and that this license shall absolutely cease and determine on the said [*licensee*] making any attempt so to assign or transfer or underlet the same, or becoming bankrupt, or suffering his estate and effects to be vested in assignees in insolvency or bankruptcy or in trustees for the benefit of creditors.

13. That all the sums of money hereinbefore agreed to be paid on breach of any stipulation herein contained shall be the stipulated damages for such breach, and not penalties.

In witness, &c.

34. Form of Agreement for Purchase of a Share of an Invention and of the Patent to be Obtained for the same.

Memorandum of an agreement indented, made, and entered into this 26th day of December, 1831, between —— ——, of ——, in the county of ——, of the one part, and —— ——, of ——, in the county of ——, of the other part:

Whereas the said —— —— hath recently invented and discovered certain improvements in ——, never before known or used in this kingdom;

And whereas the said —— —— intends forthwith to apply for her majesty's royal letters patent, for her special license and authority, for him, the said —— ——, his executors, administrators, and assigns, to make, use, exercise, and vend his said invention for his and their sole use and benefit during the term of fourteen years;

And whereas the said —— —— hath contracted with the said —— —— for the purchase of one-fifth share of and in the said invention, and the benefits thereof, and of the said letters patent, and all improvements thereof applicable thereto, and all future letters patent in respect thereof, and advantages arising therefrom, at the sum of ——, to be paid as hereinafter mentioned:

Now, these presents witness, that the said —— —— agrees to sell, and the said —— —— to purchase, one part or share of and in the said invention, of and in the said letters patent, and also of and in all improvements whatsoever which the said —— —— shall, or may hereafter, make or discover in the said invention, and of and in all future letters patent (if any) which he, the said —— ——, shall or may obtain for or in respect of such improvements, and of and in all rights, profits, or advantages whatsoever incident to the said letters patent, whether the same shall arise from making or manufacturing the said improved ——, or by the vending or sale thereof, or of any part thereof, or from the granting or sale of any license or licenses for the using or manufacturing thereof, or of any part thereof, or from the working thereof, or by any other means howsoever; the same to be held by the said —— ——, together with all powers and remedies for recovering the moneys to arise as aforesaid for all the term for which the said letters patent shall be granted, and for such renewed term or terms as may hereafter be granted therein:

And it is hereby agreed, that the said —— —— shall, and within —— days next after the date of these presents, apply and petition for the said letters patent, and shall and will follow up such petition by all proceedings

and means necessary and usual in such cases, so that the said letters patent may be obtained and the specification duly enrolled as soon as circumstances will permit; the same letters patent to be at the costs and expenses in all things of the said —— ——;

And that the said —— —— shall and will, within ——— days after the said letters patent, or any future letters patent, shall be granted, or at any time or times thereafter, if so required by the said —— ——, and at his expense, by such good and sufficient conveyances and assurances in the law as the said —— —— or his counsel shall advise and require, assign and make over the said ——— part or share, as aforesaid, unto the said —— ——, his executors, administrators, or assigns; and shall and will, in such assignment or assurance, enter into all usual covenants for the quiet possession or enjoyment and further assurance of the said share; and also into a covenant not to do, or assent to, or cause to be done, any act, deed, matter, or thing whatsoever, whereby or in consequence of which the said letters patent shall or may be forfeited or invalidated, or the right of the said —— —— to his share thereof be affected or incumbered; and also that the business of the said letters patent shall be managed and conducted by the said —— ——, and that he shall keep regular accounts of the same, and that such accounts shall be at all times open to the examination and inspection of the said —— ——, and that he shall have full power to make copies of or extracts from the same; and that the said —— —— shall pay the said sum of £ —— in manner hereinafter mentioned, viz, ———; and that the sum of £ —— shall be applied by the said —— —— in payment of the fees and expenses incident to obtaining the said letters patent;

And it is hereby further agreed, that in case the said —— —— shall hereafter obtain letters patent for ———, then that he will, if and when thereunto requested by the said —— ——, and in consideration of the further sum of £ ——, to be paid to him by the said —— ——, assign to the said —— —— one —— part or share of such last-mentioned letters patent, and of all benefit and advantage arising therefrom;

And it is lastly agreed, that if the said —— —— shall hereafter be inclined to sell and dispose of any further share or shares of the said letters patent, or either of them, that he will, in the first instance, offer the same to the said —— ——; and the said —— —— agrees that he will not in any instance whatever sell and dispose thereof, or offer to sell and dispose thereof, to a third person, before the said —— —— shall have refused to purchase the same.

IV. French Assignments and Powers of Attorney.

SEC.	SEC.
35. Legal formalities.	38. Transfers by attorney.
36. Object and effect of registry.	39. Number of assignees unlimited.
37. Formalities when the assignment is not drawn up in France.	40. Acte de cession.
	41. Acte unilateral de cession.
	42. Pouvoir

35. LEGAL FORMALITIES.—Patents may be assigned by the patentees themselves, or by persons acting in their names with regular powers; the assignment may be of the whole or only of part; it may be for the time remaining, or for a portion of it. All deeds of assignment must be made in a particular manner, and according to forms prescribed by the French law. A notary public is the only person in France qualified to draw up a deed of assignment, which must afterwards be recorded in the office of the prefect of the department in which the parties reside, if they reside in the same department, or in the office of the prefects of their respective departments, if they do not reside in the same. Should both the parties reside outside of France, the recording may take place in Paris, at the prefect's office.

Patentees forfeit all their rights unless they have paid in due time their annual patent fees, and no total or partial assignment can take place until the entire patent fees are paid.

No assignment is to be registered, except on the production and delivery, 1st, of the receipt of the payment made in due time of the last annual patent fee, distinct from the first annual patent fee; 2d, of a receipt to the receiver general in the department of the central receiver

at Paris for the entire payment of the complimentary patent fees; and, 3d, of an authentic abstract of the deed, executed before a notary of the department, and establishing the total or partial transfer of the patent, either gratuitously or for a consideration. The assignment, if regularly made, is registered in the same manner as the demand for the patent, and, provided the forms above stated have been regularly followed in the drawing up of the deed of assignment, the registering can never be refused.

36. OBJECT AND EFFECT OF REGISTRY.—The authenticity of the assignment, and the publicity given to it, have been required by law to preclude the possibility of fraud. Otherwise a patentee might have sold his patent to two or three different persons, and received the value of it twice or thrice over, if the public at large had not been officially informed that the rights of the patentee had passed into other hands.

The law declares null all assignments with reference to which the above forms have not been followed. But this nullity, merely introduced for the protection of the public, cannot be opposed by one of the parties against the other, their heirs, or assigns, who would be estopped by their own acts from making such a defense. An irregular assignment, however, confers no right to the patent, as far as relates to a third party. And notwithstanding the first assignment, if the patentee make a second and regular one, it would stand good; but the first assignment, though it would not confer any legal right to the patent itself, would nevertheless enable the purchaser to recover from the original patentee the moneys paid, the expenses incurred, and also damages.

A person holding an original patent, to which several other patents have been annexed for improvements, cannot transfer the original patent without the improvements, nor the improvements without the original patent; the whole being considered as only one patent.

37. FORMALITIES WHEN THE ASSIGNMENT IS NOT DRAWN UP IN FRANCE.—If the deed of assignment be drawn up in a foreign country, it still must be made by a notary public, whose signature must afterwards be certified by the French consul residing in the town where the transfer is executed. It may also be necessary to observe that the execution of the party assigning must be attested by the signature of two witnesses besides that of the notary. This deed must then be sent to France, and there, after being translated by a sworn interpreter, it must be deposited in a French notary's office, who will deliver a copy certified, which will be as legal and as binding as if made in France. This transfer must likewise be recorded and published in the same way above mentioned.

It would be more expeditious and less expensive to have the deed drawn up in French, before a foreign notary public, whose signature should be afterwards certified by a French consul; there would then be no necessity for having the deed translated and deposited in a French notary's office, and it would be sufficient to get it recorded.

38. PATENTEE MAY AUTHORIZE TRANSFER BY POWER OF ATTORNEY.—The transfer of a French patent may be made in France for the patentee by the bearer of a regular power from him to that effect. The forms prescribed for the validity of the transfer of patents must likewise be followed with respect to the power; it must be drawn

up by a notary public and not by an attorney, and the execution of the party must be witnessed, signed, and certified in the same manner as the deed of transfer.

As the assignment of a patent must be accepted by the transferree, his presence and signature are required to make the transfer definitive; nevertheless, he may empower a person to accept in his name the assignment, and then the transfer is completely effected. The same forms are required for this power as the preceding one.

39. NUMBER OF ASSIGNEES UNLIMITED.—Nothing in the French law limits the number of persons to whom a patent may be assigned; therefore, no authority from the legislature is required to make an assignment to more than five persons, as it was formerly by the English law. On the contrary, the number of persons who are able to take an interest in a patent is unlimited.

All that has been said respecting the forms to be followed in the assignment of a patent is applicable to licenses, with the exception of the recording, which is not necessary.

40. ACTE DE CESSION.—

Par-devant moi notarie royal et public en la ville de——, en présence des *témoins ci-après dénommés, domiciliés et qualifiés.*

Est comparu en personne M. N———, mécanicien, demeurant à——, lequel a par ces présentes, cédé et transporté, sans autre garantie que celle de ses faits et promesses personnelles, à M. N———, demeurant à——, à ci présént et ce acceptant, le brevet d'invention (d'importation ou de perfectionnement,) pris en France, par le comparant, le —— mil huit cent —— pour cinq, dix, ou quinze années, pour (*mettre ici le titre textuel du brevet.*)

Le présent transport est ainsi fait, moyennant la somme de mille francs que le sieur N——— reconnait avoir reçu, et dont il donne quittance. Et en outre à la charge par le cessionnaire, qui s'y oblige, de payer les frais du présent acte, et de remplir les conditions imposées aux cessionnaires par les lois spéciales.

Dont acte fait et passé en l'etude, le ——, en présence de M. R——, négociant, demeurant à ——, et M. S——, aussi negociant, demeurant à ——.

Et ont les parties signé avec les témoins, et ledit notaire après lecture faite.

41. Acte Unilateral de Cession.—

Par-devant moi notaire royal et public en la ville de——, en présence des témoins ci-après dénommés, domiciliés et qualifiés.

Est comparu en personne M. N——, mécanicien, demeurant à ——lequel a, par ces présentes, cédé et transporté, sans autre garantie que celle de ses faits et promesses personelles, à M. N——, demeurant à ——, le brevet d'invention (d'importation et de perfectionnement) pris en France par le comparant, le —— mil huit cent ——, pour cinq, dix, ou quinz années pour (*mettre le titre du brevet.*)

Le présent transport est fait moyennant la somme de mille francs, que le comparant reconnait avoir reçu des avant ce jour du sieur N——, et dont il donne quittance.

Et en outre à la charge par le cessionnaire de payer les frais des présentes et tous autres frais et honoraires auxquels la régularisation des présentes pourra donner lieu, et enfin d'accomplir les formalités imposées aux cessionnaires de brevets par les lois spéciales.

Le sieur N——, en acceptant la présente cession, devra s'obliger en même temps à accomplir toutes les conditions y stipulées.

Dont acte fait et payé en l'étude, le —— en présence de M. R. negociant, demeurant à ——, et de M. S. aussi negociant, demeurant a ——.

Et a, le dit comparant, signé avec les temoins, et le notaire apres lecture faite.

42. Pouvoir.—

Par-devant —— —— est comparu M. A. B —— ——.

Lequel a, par ces présentes, constitué pour son mandataire général et spécial ——, auquel il donne pouvoir de prendre, au nom du comparant, tous brevets d'invention pour découvertes qu'il peut avoir faites ou qu'il pourra faire; fixer la durée de ces brevets ainsi qu'il le jugera convenable; prendre pareillement tous certificats d'addition devant se rattacher, soit à des brevets obtenus par le comparant, soit à ceux qu'il pourra obtenir ultérieurement.

Aux fins que dessus, et dans les differents cas qui pourront se présenter, faire toutes déclarations, élire tous domiciles, signer et parapher toutes pièces, requérir tous procès-verbaux, signer et émarger tous registres, et en

general faire le nécessaire, promettant l'avoir pour agreable et le ratifiant par avance.

Dont acte fait en l'étude, le ——.

The following power, authorizing an attorney to prosecute an application for a patent, may be used for any European State:

Le soussigné —— —— constitue pour —— mandataire spécial aux effets ci-après:

M—— ——.

Auquel il donne pouvoir de pour—— et ^n —— nom, faire toutes les démarches nécessaires pour obtenir de S. M. l —— d —— un brevet d —— de —— ans, pour ——.

En conséquence, présenter à Sa dite Majesté l —— ou à toute autre autorité compétente, toutes Demandes, Petitions et Requêtes; se présenter à tous Ministéres, Bureaux, Greffes et Commissions que besoin sera; signer et approuver toutes pieces descriptives; requérir tous procés-verbaux, contracter tous engagements; verser ou retirer toutes tauxes; en prendre quittance ou en donner décharge; faire toutes demandes de brevet d'addition ou de perfectionnement; les échanger ou retirer s'il y a lieu; consentir la radiation de toutes inscriptions; retirer également les titres définitifs ainsi que toutes les pieces y afférentes; eigner tous actes ou proces-verbaux de désistemant des priviléges d'Etranger: Prendre la parole et répondre pour le constituant à toutes réclamations qui pourront surgir relativement au Brevet dont il s'agit, pendant toute la durée de celui-ci. Aux fins sus énoncées, passer et signer tous actes, élire domiciles; substituer dans tout ou partie des présents pouvoirs, et dans les différent cas qui pourront se présenter, faire généralement tout ce qui sera utile pour arriver à l'obtention du privilège sus relaté, promettant le constituant avoir le tout pour agréable, et le ratifier au besoin.

Mil huit cent ——.

V. Assignment of Copyright.

SEC.	SEC.
43. Copyright assignable.	45. Form of assignment.
44. Recording.	

43. COPYRIGHT ASSIGNABLE.—Copyrights shall be as-

signable in law by any instrument of writing. (*Act of July* 8, 1870, § 89.)

To be valid and operative, an assignment of an interest in a copyright must be in writing; but an agreement to assign may be by parol. (*Gould* v. *Banks*, 8 *Wend.*, 565.)

An assignment of a "copyright" in general terms is to be referred to what was then in existence, and not to any future contingency. It should not be extended by construction beyond the first term, unless it seems to be so actually meant by the author, and to include a future contingency. (*Pierpont* v. *Fowle*, 2 *Wood. & Minot*, 43–45.) But if it uses language looking beyond the existing copyright, the rule is otherwise. (*Ib.*)

44. RECORDING.—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. (*Act of July* 8, 1870, § 89.)

An assignment of a copyright, although not recorded, is still valid as between the parties and as to all parties not claiming under the assignors. (*Webb* v. *Powers*, 2 *Wood. & Minot*, 510.)

45. ASSIGNMENT OF COPYRIGHT FOR ORIGINAL AND RENEWED TERMS.—

Indenture made this 23d day of April, 1870, between Charles Russell, of Brooklyn, State of New York, of the one part, and George Arnold, of the city and State of New York.

Whereas the said Charles Russell has written and composed a book, entitled "The Law of the Farm:"

Now this indenture witnesseth, that the said Charles Russell, for and in consideration of the sum of $500, to him in hand paid by said George Arnold, the receipt of which is hereby acknowledged, has bargained, sold, and assigned, and by these presents does bargain, sell, and assign unto the said

George Arnold, his heirs, executors, administrators, and assigns, all the said book, and the manuscript thereof, and all his right, title, and interest, property, claim, and demand, of every kind and nature whatsoever, of, in, and to the same, and in any and all copyrights, and any and all renewals thereof, which may or can be had, or secured, or taken, in respect to said book or manuscript, under and by virtue of any acts of Congress, with any and all profit, benefit, and advantage that shall or may arise by or from printing, publishing, or vending the same, during the original or renewed terms of any such copyright. To have and to hold the same to the said George Arnold, his heirs, executors, administrators, and assigns forever.

And the said Charles Russell agrees to examine and correct the proof-sheets of said work as fast as they shall be furnished, and to make and complete a full and correct index therefor, as soon as may be after all the signatures of the text shall be furnished for that purpose.

And the said George Arnold, for himself, his heirs, executors, administrators, and assigns, covenants and agrees to furnish and deliver, free of cost, to said Charles Russell, twenty-five bound copies of said work, within three months after the said index shall or may be completed.

In witness whereof the said parties have hereunto set their hands and seals the day and year first above written.

CHARLES RUSSELL. [L. S.]
GEORGE ARNOLD. [L. S.]

Sealed and delivered
in presence of—
JOHN DOE,
RICHARD ROE.

VI. Forms of Procedure in Patent Causes.

SEC.
46. Bill in equity.
47. Equity subpœna to appear and answer.
48. Equity precept for appearance.
49. Equity motion for leave to file supplemental bill.
50. Equity answer.
51. Equity replication.
52. Equity notice for proofs under oral examination.
53. Declaration.
54. Plea and special notice.

46. BILL IN EQUITY.—

UNITED STATES CIRCUIT ——, } *In Equity.*
District of ——, }

To the honorable the judges of the circuit court of the United States

for the ——— circuit, within and for the ——— district of ———, ———, a citizen of the State of ———; (*or* a corporation duly established under the laws of the State of ———,) brings this his bill of complaint against ———, a citizen (or citizens) of ———, in said district.

And thereupon your orator complains and says, that ———, a citizen of the United States, was the true and original inventor of a new and useful improvement in ———, which said improvement was not known or used by others before the invention and discovery thereof by ———, who thereupon did apply to the Commissioner of Patents of the United States for letters patent for said improvement, and fully and in all respects complied with all the requirements of the law in that behalf, and especially made oath that he verily believed himself to be the true inventor or discoverer of the said improvement, and also paid into the Treasury of the United States the sum of thirty dollars, and presented to the Commissioner of Patents of the United States a petition, setting forth his desire to obtain an exclusive property in said improvement, and praying that letters patent might for that purpose be granted unto him; and also delivered and filed in said office of the Commissioner of Patents a written description of his said improvement, in such full, clear, and exact terms as to enable any person skilled in the art with which the said improvement is most nearly connected to make and use the same; which said description was duly signed by the said ——— and attested by two witnesses; and thereupon the said Commissioner of Patents caused letters patent to be made out and issued in the name of the United States of America, in due form of law in all respects, bearing date the —— day of ———, in the year one thousand eight hundred and ——, whereby was granted unto the said ———, his heirs, administrators, or assigns, for the term of ——— years from the date thereof, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, which is entitled in said letters patent, "A new and useful improvement in ———;" and the said letters patent having been signed by ———, Secretary of the Interior of the United States, and countersigned and sealed with the seal of the Patent Office by ———, Commissioner of Patents of the United States, and the same, having been duly recorded, were issued and delivered unto the said ———.

And your orator further shows unto your honors, that the defendant, ———, since the —— day of ———, has been engaged in making, using, and selling a large amount of ———, such as is described in said patents, and that the defendant refused to pay to your orator any of the profits which ——— made by such unlawful manufacture, use, and sales, or to

desist from making, using, and selling the same, in violation and infringement of your orator's rights, secured to him as aforesaid, and without his consent or allowance.

All which actings and doings are contrary to equity and good conscience, and tend to the manifest injury of your orator in the premises.

In consideration whereof, and forasmuch as your orator can only have adequate relief in this honorable court, where matters and things of this kind are made cognizable by statute: To the end, therefore, that the said defendant may, if —— can, show why your orator should not have the relief hereby prayed, and may, upon —— corporal oath and according to —— best and utmost knowledge, remembrance, information, and belief, full, true, direct, and perfect answer make to the matters and things hereinbefore stated and charged:

And that the said defendant may answer the premises, and that —— may be decreed to account with and pay over to your orator the profits which —— has or might have made by —— infringement of said letters patent in such unlawful manufacture, use, and sale of ——.

May it please your honors, the premises considered, to grant unto your orator a writ of injunction, issuing out of and under the seal of this honorable court, (*or* issued by one of your honors, according to the form of the statute in such case made and provided,) enjoining and restraining the said —— clerks, attorneys, agents, servants, and workmen from making any —— as is described in such —— letters patent,

And that your orators may have such further and other relief as the nature of the case may require and to your honors seems meet;

May it please your honors to grant unto your orator not only the writ of injunction conformable to the prayer of this bill, but also a writ of subpena, directed to the said ——, commanding ——, on a day certain, therein to be named, to be and appear in this honorable court, then and there to answer the premises, and to stand to, perform, and abide such further order, direction, and decree as may be made against ——:

And your orator, as in duty bound, will ever pray, &c.

—— ——,

Solicitor and of Counsel for Complainant.

UNITED STATES OF AMERICA, }
District of ——. } *ss.*

At ——, in the county of ——, and district aforesaid, on the —— day of ——, A. D. 18—, personally appeared the above-named ——, who, being duly sworn according to law, deposeth and saith that he is the

complainant in the foregoing bill, and has read the same, and knows the contents thereof;

That the said bill is true of his own knowledge, except as to those matters which are therein stated to be on information and belief of the complainant, and as to those matters he believes it to be true;

That this deponent verily believes ——— to have been the first and original inventor of the improvements claimed in said ——— letters patent.

47. EQUITY SUBPŒNA TO APPEAR AND ANSWER.—

The President of the United States of America to ——— ———, *greeting:*

You are hereby commanded that you personally appear before the judges of the circuit court of the United States for the ——— district of New York, in the second circuit, on the ———, to answer to a bill of complaint exhibited against you in the said court by [L. S.] ———, and to do further and receive whatever said court shall have considered in that behalf; and this you are not to omit under the penalty of two hundred and fifty dollars.

Witness the Hon. ——— ———, Chief Justice of the Supreme Court of the United States, at the city of ———, in said ——— district, the ——— day of ———, eighteen hundred and ———.

——— ———, *Clerk.*

——— ———,

Solicitor for Plaintiff.

Memorandum.—The defendant is to enter his appearance in the suit above mentioned in the clerk's office at ———, on or before the day at which the above subpœna is returnable, otherwise the bill may be taken *pro confesso.*

——— ———,

Solicitor for Plaintiff.

Marshal's Return.—I hereby certify that I served the within subpœna on ———, at ———, on the ——— day of ———, A. D. 18—, and on ———, at ———, on the ——— day of ———, A. D., 18—, by delivering to and leaving with them and each of them a copy of this subpœna, and at the same time showing them and each of them this original, with the seal of the court attached.

——— ———,

Deputy.

DISTRICT OF NEW YORK.

I hereby authorize and depute ——— to execute the annexed process and make due return according to law.

——— ———,

United States Marshal ——— *District of New York*

——— ———,

Deputy Marshal.

48. Equity Precept for Appearance.—

UNITED STATES CIRCUIT COURT —— DISTRICT OF NEW YORK.

——— } *In Equity.*
vs. }
——— }

The clerk of this court will please enter my appearance as solicitor for the defendant in the above-entitled cause.

Yours, &c.,

———— ————,
Solicitor for Defendant.

Dated ——, 18—.

49. Equity Motion for Leave to File Supplemental Bill.

UNITED STATES CIRCUIT COURT —— DISTRICT OF NEW YORK.

——— } *In Equity.*
vs. }
——— }

The complainants in the above-entitled cause move the court, upon the proposed supplemental bill of complaint herewith filed, for leave to file the same as a supplemental bill of complaint in said cause, and that the same stand filed therein as of the rule day for the first Monday of ——, A. D, 18—, (motion to be heard on said rule day before his honor ——, at —— o'clock.)

———— ————,
Solicitor for Complainant.

Dated ——.

50. Equity Answer.—

UNITED STATES CIRCUIT COURT —— DISTRICT OF NEW YORK.

——— } *In Equity*
vs. }
——— }

The answer of —— to the bill of complaint of ——, complainant.

The defendant, now and at all times hereafter saving and reserving to himself all and all manner of benefit and advantage of exception to the many errors and insufficiencies in the complainant's said bill of complaint contained, for answer thereunto, or unto so much or such parts thereof as this defendant is advised is material for him to make answer unto, answers and says:

All of which matters and things the said defendant is ready to aver, maintain, and prove, as this honorable court shall direct, and hereby prays to be hence dismissed with his reasonable costs and charges in that behalf sustained.

———— ————,
Solicitor and of Counsel.

DISTRICT OF NEW YORK, } ss.
County of ——.

——— ———, being duly sworn, says that he is the defendant in the above-entitled cause; that he has *read* the foregoing answer, and knows the contents thereof; and that the same is true of his own knowledge, except as to those matters therein stated on information and belief, and as to those matters he believes it to be true.

Sworn to before me this —— day of ———, A. D. 18—.

51. EQUITY REPLICATION.—

UNITED STATES CIRCUIT COURT ——— DISTRICT OF NEW YORK.

———
vs. } *In Equity.*
———

The replication of the above-named complainant to the answer of ———, defendant.

This repliant, saving and reserving to himself now and at all times hereafter all and all manner of benefit and advantage of exception which may be had or taken to the manifold insufficiencies of the said answer, for replication thereunto says that —— will aver, maintain, and prove —— bill of complaint to be true, certain, and sufficient in the law to be answered unto; and that the said answer of the said defendant is uncertain, untrue, and insufficient to be replied unto by repliant without this; that any other matter or thing whatsoever in the said answer contained material or effectual in the law to be replied unto, and not herein and hereby well and sufficiently replied unto, confessed and avoided, traversed or denied, is true; all which matters and things ———, repliant is and will be ready to aver, maintain, and prove, as this honorable court shall direct, and humbly prays as in and by —— said bill ——— has already prayed.

———,
Solicitor for Complainant.

52. EQUITY NOTICE FOR PROOFS UNDER ORAL EXAMINATION.—

UNITED STATES CIRCUIT COURT ——— DISTRICT OF NEW YORK.

———
vs. } *In Equity.*
———

SIR: You will please take notice that the complainants in said cause desire the evidence to be adduced therein to be taken orally, under the 67th rule of the Supreme Court, as amended; and you will further take

notice, that by an order made in said cause by —— ——, Esq., one of the examiners of said court, the examination of witnesses on the part of the said complainants will take place before said examiner at ——, in the city of ——, on —— the —— day ——, A. D. 18—, at — o'clock, —— and proceed as said examiner may direct.

Dated ——.

Yours., &c, —— ——,

Solicitor for Complainants.

To —— ——,

Solicitor for Defendants and —— ——, Defendants.

53. DECLARATION.—

UNITED STATES CIRCUIT COURT —— DISTRICT OF NEW YORK.

——
vs.
——

Of the —— day of ——, 186—. As yet of —— term, in the year of our Lord one thousand eight hundred and ——.

DISTRICT OF NEW YORK, *ss.*

—— ——, being a citizen of the United States of America, and a resident of ——, plaintiff in this suit, by —— ——, his attorney, complains of —— ——, defendant—, of the said —— district, of a plea of trespass on the case: For that whereas the said —— ——, of the town of ——, in the county of ——, and State of New York, and in said district, before and at the time of the making of the letters patent and of the committing of the grievances by the said —— ——, as heretofore mentioned, were the true, original, and first inventors of a certain new and useful improvement in ——, which was not known nor used before such invention or discovery as aforesaid, and were not at the time of the plaintiff's application for letters patent therefor, as hereinafter mentioned, in public use or on sale with the consent or allowance of said —— —— *or either of them;* and whereas said —— ——, being such original and first inventors, and being citizens of the United States, obtained for said invention letters patent of the United States in due form of law, under seal of the Patent Office, bearing date the ——, and whereas the said letters patent having been wholly assigned by the said —— —— to the said —— ——, and, having been surrendered by the said —— —— for being partially invalid on account of a defective specification, were canceled and new letters ordered to issue to said —— —— on the amended specification; and whereas the plaint-

iff did accordingly obtain new letters patent for such invention in due form of law upon such amended specification, under the seal of the Patent Office, and signed by the Secretary of the Interior, and countersigned by the Commissioner of Patents, and bearing date the ——, eighteen hundred and ——, which said reissued letters patent did grant according to law to the said —— ——, his heirs, administrators, and assigns, for the term of —— years from the said —— day of ——, eighteen hundred and ——, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof was given in the words of the said —— ——, in a certain schedule to said letters annexed and made part thereof, as by reference to said letters patent and the said specification thereto annexed, which the plaintiff now brings here into court, will fully appear.

And the plaintiff further says, that from the time of the granting to him of the said letters patent hitherto he has made, used, and vended to others to be used, the said improvement, to his great advantage and profit. Yet the said defendant–, well knowing the premises, but contriving to injure the plaintiff, did, on the —— day of ——, eighteen hundred ——, and at divers other times before and afterwards, during the said term of —— years mentioned in said letters patent and before the commencement of this suit at ——, in the county of ——, and State of New York, unlawfully and wrongfully, and without the consent or allowance, and against the will of the plaintiff, did use and cause to be used the said improvement, in violation and infringement of the exclusive right so secured to plaintiff by said letters patent as aforesaid, and contrary to the form of the statute of the United States in such case made and provided, whereby the plaintiff has been greatly injured and deprived of great profit and advantage, which he otherwise would have derived from said improvement, and has sustained actual damage to the amount of —— dollars; and by force of the statute aforesaid an action hath accrued to him to recover the said actual damages and such additional amount, not exceeding in the whole three times the amount of such actual damage, as the court may see fit to order and adjudge, besides costs. Yet the said defendant–, though requested, ha– never paid the same, or any part thereof, to the plaintiff, but ha– refused, and yet refuse– so to do, and therefore the plaintiff brings this suit.

—— ——,
Attorney and of Counsel for Plaintiff,
—— County, N. Y.

—— DISTRICT OF NEW YORK, ss.

——, being duly sworn, says, that on the —— day of ——,

186—, he personally served on the defendant ——— ———, within named, a copy of the within declaration and notice of rule to plead as herein indorsed.

Sworn before me this —— day of ———, 186 —.

SIR: Please to take notice that the within is a copy of a declaration filed with the clerk of the United States circuit court at ———; that you are required to plead thereto within twenty days from service hereof on you, or judgment by default, &c. Yours, &c., ———,

Plaintiff's Attorney, ——— *County, N. Y.*

To the above defendant.

54. PLEA AND SPECIAL NOTICE.—

UNITED STATES CIRCUIT COURT ——— DISTRICT OF NEW YORK.

———
vs. } *Plea.*
———

And the said defendant, ——— ———, by ——— ———, his attorney, comes and defends the wrong and injury, when, &c., and says that he is not guilty of the supposed grievances above laid to his charge, or any or either or any part thereof, in manner and form as the said plaintiff hath above thereof complained against ———, and of this the said defendant puts himself upon the country, and the said plaintiff doth the like, &c.

And it is suggested to the court, now here, that the defendant gives the following notices in writing of special matter to the plaintiff, thirty days before trial, under section 15 of the act of Congress passed July 4, 1836, entitled "An act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose:"

First, Notice of Special Matter.—Take notice that the above-named defendant will prove upon the trial of this cause, in bar of the said plaintiff's action, that the said ——— ———, the assignor of the said plaintiff, was not the original or first inventor of (here describe the patent.)

And the said defendant will further prove, upon such trial as aforesaid, that the same principle was known to and had been previously combined by and invented by ——— ———, who resides (or resided) at ———, in the State of ———, and that the same was known to and combined by said ——— ——— as early as ———, 18—.

And the said defendant will further prove, upon said trial as aforesaid, that what is claimed in said declaration and in said letters patent therein mentioned, and the specifications and drawings thereto attached, as the invention of said assignors of said plaintiff named in said declaration, was

substantially and in principle known to ——— ———, of ———, in the State of ———.

And the said defendant will further prove, upon said trial as aforesaid, that the thing patented in and by the letters patent was not first invented by *or known to* said ——— ———, *but the same was publicly known and* used prior to the time when it is alleged in this action the same was invented by him.

And the defendant will prove that ——— ———, who resides at ———, possessed such prior knowledge of the said thing mentioned as aforesaid in said declaration.

And that the said thing was in public use and on sale anterior to the said supposed discovery or invention thereof by said ——— ———.

Second. Please take notice that, on said trial of this cause, in addition to the notices already served upon you, the defendant will prove by ——— ———, of ———, and others, that they knew of the use of said thing, or substantially the same, as the alleged invention of said ——— ———, and the same, or substantially the same, was used by ——— ——— prior to the alleged invention thereof.

That the same, or substantially the same, was previously invented and patented ———, 18 —, by ——— ———.

*And the same was, previously to the time when it is claimed they in*vented or discovered the same, in public use with his consent and allowance, and upon sale with his consent and allowance, and subsequent to the time when it is claimed he invented or discovered the same.

SUPPLEMENT.

The following rules of practice in the supreme court of the District of Columbia, in appeals from the Commissioner of Patents, were adopted in general term, November 30, 1870, after this work had been stereotyped:

RULES OF PRACTICE.

1. The appellant's petition shall be addressed to the court, and shall be substantially as follows:

To the Supreme Court of the District of Columbia, in banc, ——, 187—.

The petition of —— ——, a citizen of ——, in the (*State, territory, district,*) of ——, respectfully shows as follows:

a. About the —— day of ——, 18—, I invented, (*describe the subject of the desired patent in the identical words of the application to the Patent Office.*)

b. On the —— day of ——, 18—, in the manner prescribed by law, I presented my application to the Patent Office, praying that a patent be issued to me for said invention.

c. Such proceedings were had in said office upon said application that, on the —— day of ——, 18—, it was rejected by the Commissioner of Patents.

d. I thereupon appealed to this court, and gave notice thereof to the Commissioner, and filed in his office the following reasons for said appeal:

e. The Commissioner of Patents has furnished me a complete copy of all the proceedings in his office upon my said application, which copy has been filed herewith, and is to be taken as part hereof.

f. And thereupon I pray that the court do revise and reverse said decision, to the end that justice may be done in the premises.

—— ——.

2. This petition shall be filed in the clerk's office of this court, and as soon as the petitioner has made the deposit required by law at the commencement of suits in this court, or said deposit has been dispensed with, the clerk shall enter the case in a docket to be provided by him for the

ings in the case shall be entered, as and when they successively occur, down to and including the final decision.

3. The clerk shall provide a minute book of his office, in which he shall record every order, rule, judgment, or decree of the court in each case, in the order of time in which said proceedings occur. And of this book there shall be two alphabetical indexes, one showing the name of the party applying for the patent, and the other designating the invention by its subject-matter or name.

4. The cases in the docket of causes shall be successively numbered from No. 1, onward, and each case shall also be designated by the number assigned to it on the records of the Patent Office.

5. This docket shall be called for the trial of the cases thereon on the first day of each session of this court in general term, provided the petition has been filed ten days before the commencement of the term.

6. The opinions of the court, when written, shall be kept by the clerk in the order of their delivery in a temporary book-file, indexed; and when so many have been delivered as will make a volume of convenient size, he shall cause them to be bound.

7. The clerk shall furnish to any applicant a copy of any paper in any of said appeals on payment of the lawful fees.

8. Hearing of said appeals shall be subject to the rules of the court provided for other causes therein.

9. When the testimony of the Commissioner or of any examiner, touching the principles of the invention in question, shall be deemed necessary, it shall be taken orally in open court, unless otherwise ordered by the court. And in such case the court may order it to be reduced to writing, and filed or entered on its minutes, if it think proper.

10. The final judgment or order of the court shall not recite any of the facts made to appear in the case, but shall be to the following effect:

"This appeal having been heard upon the record from the Patent Office, [and upon the testimony of the Commissioner of Patents,] [of one of the examiners,] touching the principles of the invention, and having been argued by [counsel for] the petitioner and [for] the Commissioner,

"It is thereupon ordered and adjudged that the [petition he dismissed] [Commissioner do issue to the petitioner a patent,] [as prayed,] [granting the petitioner (*so and so.*)]

"And that the clerk of this court transmit to the Commissioner of Patents a copy of this decree duly authenticated."

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APPENDIX.

APPENDIX.

I.

PUBLICATION OF THE SPECIFICATIONS AND DRAWINGS OF THE PATENT OFFICE.

JOINT RESOLUTION providing for publishing the specifications and drawings of the Patent Office.

Be it resolved by the Senate and House of Representatives of the United States of America in Congress assembled, That the publication of the abstracts of specifications and of the engravings heretofore accompanying the annual report of the Commissioner of Patents be discontinued after the publication of that portion of the report for eighteen hundred and sixty-nine, for which the plates have already been prepared; and that, in lieu thereof, the Commissioner be authorized to have printed, for gratuitous distribution, not to exceed one hundred and fifty copies of the complete specifications and drawings of each patent subsequently issued, together with suitable indexes to be issued from time to time, 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 taken and received in all courts as evidence of all matters therein contained, and shall be certified to under the hand of the Commissioner and seal of the Patent Office, and shall be taken and received in all courts as evidence, said copies not to be taken from said depositories for any other purpose than to be used as evidence; and the Commissioner of Patents is hereby authorized and directed to have printed such additional numbers of copies of specifications and drawings, certified as hereinbefore provided, 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 the Commissioner is also hereby authorized to furnish a complete set of such specifications and drawings to any public library which will pay for binding the same in volumes to correspond with those in the Patent Office, and for the transportation of the same, and which shall also provide proper custody for the same, with convenient access for the public thereto, under such regulations as the Commissioner shall deem reasonable: *And provided, also,* That all contracts for making copies of drawings shall be made under the provisions of chapter one hundred and fifty-five, section nine, of act of Congress approved June twenty-five, eighteen hundred and sixty-four, which reads as follows:

"SEC. 9. *And be it further enacted,* That all lithographing and engraving, where the probable total cost of the maps or plates illustrating or accompanying any one work exceeds two hundred and fifty dollars, shall be awarded to the lowest and best bidder for the interests of the Government, due regard being paid to the execution of the

work, after due advertisement by the Superintendent of Public Printing, under the direction of the Joint Committee on Printing: *Provided*, That the Joint Committee on Public Printing be authorized to empower the Superintendent of Public Printing to make immediate contracts for engraving, whenever, in their opinion, the exigencies of the public service will not justify waiting for advertisement and award."

Approved, January 11, 1871.

CHAP. V.—AN ACT to further regulate the publication of the specifications and drawings of the Patent Office.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That if, in the judgment of the Joint Committee on Printing, the provisions of the joint resolution providing for publishing specifications and drawings of the Patent Office, approved January eleventh, eighteen hundred and seventy-one, can be performed under the direction of the Commissioner of Patents more advantageously than in the manner provided in said joint resolution, it shall be so done, under such limitations and conditions as the Joint Committee on Printing may, from time to time, prescribe.

SEC. 2. That the price of the printed copies of specifications and drawings of patents, when uncertified, shall be determined by the Commissioner of Patents, ten cents being hereby fixed as the minimum, and fifty cents as the maximum price of the same; certified copies to be sold at the price fixed by the patent act of eighteen hundred and seventy.

Approved, March 24, 1871.

II.

Registration of Prints and Labels.

By the following act of Congress, approved June 18, 1874, (to take effect on and after the 1st day of August, 1874,) it is provided that certain prints and labels may be registered in the Patent Office.

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 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.

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.

Approved June 18, 1874.

By the word "print," as used in the said act, is meant any device, picture, word or words, figure or figures (not a trade-mark) impressed or stamped directly upon the articles of manufacture, to denote the name of the manufacturer, or place of manufacture, style of goods, or other matter.

By the word "label," as therein used, is meant 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, and bearing an inscription, (not a trade-mark,) as, for example, the name of the manufacturer or the place of manufacture, the quality of goods, directions for use, &c.

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

But no such print or label can be registered unless it properly belong to an article of commerce, and be as above defined; nor can the same be registered as such print or label when it amounts in law to a technical trade-mark.

To entitle the owner of any such print or label to register the same in this office, it is necessary that five copies of the same be filed, one of which copies shall be certified under the seal of the Commissioner of Patents, and returned to the registrant.

Form of Application for Registration.

[Making necessary changes to suit each case.]

[For an individual.]

To the Commissioner of Patents:

The undersigned, John Fisher, of the city of Brooklyn, county of Kings, and State of New York, and a citizen of the United States, [or resident

therein, as the case may be,] hereby furnishes five copies of a print, [*or "label," as the case may be,*] of which he is the sole proprietor.

The said print [or "label"] consists of the words and figures as follows, to wit: [Description.]

And he hereby requests that the said print be registered in the Patent Office, in accordance with the act of Congress to that effect, approved June 18, 1874.

——— ———,

BROOKLYN, N. Y., *August* 1, 1874. *Proprietor.*

[FOR A CORPORATION.]

The applicant, a corporation created by authority of the laws of the State of New York, [or other authority, as the case may be,] and doing business in said State, hereby furnishes five copies of a label [or "print," *as the case may be*] of which it is the sole proprietor.

The said label consists of the words and figures as follows, to wit: [Description.]

And it is hereby requested that the said label be registered in the Patent Office, in accordance with the act of Congress to that effect, approved June 18, 1874.

Witness the seal of said corporation at ———, 1874.

[SEAL.]

——— ———,

[*President or other officer.*]

The certificate of such registration will continue in force for twenty-eight years.

The fee for registration of a print or label is six dollars, to be paid in the same manner as fees for patents.

The benefits of this act seem to be confined to citizens or residents of the United States.

III.

CANADIAN PATENT LAW OF 1872.

CAP. XXVI. AN ACT respecting patents of invention.

[*Assented to 14th June*, 1872.]

Her Majesty, by and with the advice and consent of the Senate and House of Commons of Canada, enacts as follows:

I. Patent Office Constituted.

1. MINISTER OF AGRICULTURE TO BE COMMISSIONER OF PATENTS OF INVENTION.—There shall be attached to the Department of Agriculture, as a branch thereof, an office to be called the Patent Office; and the Minister of Agriculture for the time being shall be the Commissioner of Patents; and it shall be the duty of the said Commissioner to receive all applications, fees, papers, documents, and models for patents, and to perform all acts and things requisite to the granting and issuing of patents of invention; and he shall have the charge and custody of the books, records, papers, models, machines, and other things belonging to the said office.

2. SEAL.—The Commissioner shall cause a seal to be made for the purposes of this act, and may cause to be sealed therewith patents and other instruments and copies proceeding from the Patent Office; and all courts, judges, and other persons whomsoever, shall take notice of such seal, and receive impressions thereof in evidence, in like

manner as impressions of the Great Seal are received in evidence, and shall also take notice of and receive in evidence, without further proof and without production of the originals, copies or extracts certified under the seal of the said office to be copies of or extracts from documents deposited in such office.

3. COMMISSIONER TO MAKE RULES.—The Commissioner may, from time to time, subject to the approval of the Governor in Council, make such rules and regulations, and prescribe such forms as may appear to him necessary and expedient for the purposes of this act, and notice thereof shall be given in the *Canada Gazette;* and all documents, executed in conformity with the same and accepted by the Commissioner, shall be held valid so far as relating to the proceedings in the Patent Office.

4. DEPUTY COMMISSIONER AND CLERKS.—The Deputy of the Minister of Agriculture shall be the Deputy Commissioner of Patents of Invention; and the Governor in Council may, from time to time, appoint such clerks and officers under him as may be necessary for the purposes of this act, and such clerks and officers shall hold office during pleasure. No officer or employee of the Patent Office shall buy, sell, or acquire, or traffic in an invention or patent, or rights to patents therefor; and every such purchase and sale, and every assignment or transfer thereof, by or to any officer or employee as aforesaid, shall be utterly null and void. But this shall not apply to any original inventor, or to the acquisition by bequest.

5. ANNUAL REPORT AND LIST OF PATENTS.—The Commissioner shall cause a report to be prepared annually and laid before Parliament of the proceedings under this act, and shall, from time to time, and at least once in each

year, publish in the *Canada Gazette* a list of patents granted, and may, with the approval of the Governor in Council, cause such specifications and drawings as may be deemed of interest, or essential parts thereof, to be printed from time to time for distribution or sale.

II. Who may obtain Patents.

6. WHO MAY OBTAIN A PATENT.—Any person having invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not knowing or used by others before his invention thereof, and not being in public use or on sale, for more than one year previous to his application, in Canada, with the consent or allowance of the inventor thereof, may, on a petition to that effect presented to the Commissioner, and on compliance with the other requirements of this act, obtain a patent granting to such persons an exclusive property therein; and the said patent shall be under the seal of the Patent Office and the signature of the Commissioner, or the signature of another member of the Privy Council, and shall be good and avail to the grantee, his executors, administrators, or assigns, for the period mentioned in such patent; but no patent shall issue for an invention having an illicit object in view, nor for any mere scientific principle or abstract theorem.

7. INVENTIONS FOR WHICH FOREIGN PATENTS HAVE BEEN TAKEN OUT.—But an inventor shall not be entitled to a patent for his invention, if a patent therefor in any other country shall have been in existence in such country more than twelve months prior to the application for such patent in Canada; and if, during such twelve

months, any person shall have commenced to manufacture in Canada the article for which such patent is afterwards obtained, such person shall continue to have the right to manufacture and sell such article, notwithstanding such patent; and under any circumstances, where a foreign patent exists, the Canadian patent shall expire at the earliest date at which any foreign patent for the same invention expires.

8. REPRESENTATIVES OF INVENTOR MAY OBTAIN PATENT.—The patent may be granted to any person to whom the inventor entitled under the sixth section to obtain a patent has assigned or bequeathed the right of obtaining the same, or, in default of such assignment or bequest, to the executors or administrators or assigns of the deceased inventor.

9. PATENTS FOR IMPROVEMENTS ON PATENTED INVENTIONS.—Any person who has invented any improvement on any patented invention may obtain a patent for such improvement, but shall not thereby obtain the right of vending or using the original invention, nor shall the patent for the original invention confer the right of vending or using the patented improvement.

10. JOINT APPLICATION FOR A PATENT.—In cases of joint applications, the patent shall be granted in the names of all the applicants; and in such cases, any assignment from one of the said applicants or patentees to the other, or to any person, shall be registered in like manner as other assignments.

III. Conditions and Formalities.

11. DECLARATION TO BE MADE BY APPLICANT FOR A PATENT.—Every inventor, before a patent can be ob-

tained, shall make oath, or, when entitled by law to make an affirmation instead of an oath, shall make an affirmation, that he verily believes that he is, or, in the case of the inventor being deceased, the applicant shall make oath or affirm that the person whose assignee or representative he is, was the inventor of the invention for which the patent is solicited, and that the several allegations in the petition contained are respectively true and correct. Such oath or affirmation may be made before any Justice of the Peace in Canada; but if the inventor or the applicant is not at the time in Canada, the oath or affirmation may be made before any Minister Plenipotentiary, *chargé d'affaires*, consul, vice-consul, or consular agent, holding commission under the Government of the United Kingdom, or any Judge of the country in which the applicant happens at the time to be.

12. APPLICANT TO ELECT A DOMICILE IN CANADA.—The petitioner for a patent shall for all the purposes of this act elect his domicile at some known and specified place in Canada, and mention the same in his petition for a patent.

13. PARTICULARS REQUIRED IN APPLICATION.—The applicant shall, in his petition for a patent, insert the title or name of the invention, and shall, with the petition, send in a specification in duplicate.

14. SPECIFICATION AND DRAWING.—The specification shall correctly and fully describe the mode or modes of operating contemplated by the inventor; and shall state clearly and distinctly the contrivances and things which he claims as new, and for the use of which he claims an exclusive property and privilege; it shall bear the name of

the place where it is made, the date, and be signed by the inventor, if he be alive, (and if not, by the applicant,) and two witnesses; in the case of a machine, the specification shall fully explain the principle and the several modes in which it is intended to apply and work out the same; in the case of a machine, or in any other case where the invention admits of illustration by means of drawings, the applicant shall also, with his application, send in drawings in duplicate showing clearly all parts of the invention; and each drawing shall bear the signature of the applicant or of his attorney, and shall have written references corresponding with the specification, but the Commissioner may require further drawings or dispense with any of them, as he may see fit; one duplicate of the specification and of the drawings, if there are drawings, shall be annexed to the patent of which it forms an essential part, and the other duplicate shall remain deposited in the Patent Office.

15. WORKING MODEL, &c., TO BE DELIVERED TO THE COMMISSIONER.—The applicant shall also deliver to the Commissioner, unless specially dispensed from so doing for some good reason, a neat working model of his invention on a convenient scale, exhibiting its several parts in due proportion, whenever the invention admits of such model; and shall deliver to the Commissioner specimens of the ingredients, and of the composition of matter sufficient in quantity for the purpose of experiment, whenever the invention is a composition of matter; provided such ingredients and composition are not of an explosive character or otherwise dangerous, in which case they are to be furnished only when specially required by the Commissioner,

and then with such precautions as shall be prescribed in the said requisition.

II. Contents, Duration, Surrender, Reissue of Patents, and Disclaimers.

16. CONTENTS OF PATENTS.—Every patent granted under this act shall contain the title or name of the invention, with a reference to the specification,—and shall grant to the patentee, his executors, administrators, and assigns, for the period therein mentioned from the granting of the same, the exclusive right, privilege, and liberty of making, constructing, and using, and vending to others to be used, the said invention, subject nevertheless to adjudication before any court of competent jurisdiction.

17. DURATION OF PATENTS.—Patents of invention issued by the Patent Office shall be valid for a period of five, ten, or fifteen years at the option of the applicant; but at or before the expiration of the said five or ten years the holder thereof may obtain an extension of the patent for another period of five years, and after those second five years, may again obtain a further extension for another period of five years, not in any case to exceed a total period of fifteen years in all; and the instrument delivered by the Patent Office for such extension of time shall be in the form which may be from time to time adopted, to be attached, with reference to the patent, and under the signature of the Commissioner, or of any other Privy Councillor in case of absence of the Commissioner.

18. PATENT OR EXTENSION TO BE EXAMINED BY MINISTER OF JUSTICE BEFORE GRANTED.—Every patent and instrument for the extension of time as aforesaid shall, before it is signed by the Commissioner or any other member of the

Privy Council, and before the seal hereinbefore mentioned is affixed to it, be examined by the Minister of Justice, who, if he finds it conformable to law, shall certify accordingly, and such patent or instrument may then be signed and the seal affixed thereto, and being duly registered, shall avail to the grantee thereof.

19. In Cases of Error, Commissioner may cause new Patent to Issue.—Whenever any patent shall be deemed defective or inoperative by reason of insufficient description or specification, or by reason of the patentee claiming more than he had a right to claim as new, but at the same time it appears that the error arose from inadvertence, accident, or mistake, without any fraudulent or deceptive intention, the Commissioner may, upon the surrender of such patent and the payment of the further fee hereinbefore provided, cause a new patent, in accordance with an amended description and specification to be made by such patentee, to be issued to him for the same invention, for any part or the whole of the then unexpired residue of the period for which the original patent was or might have been, as hereinbefore directed, granted. In case of the death of the original patentee, or of his having assigned the patent, a like right shall vest in his assignee or legal representative. The new patent, and the amended description and specification, shall have the same effect in law, on the trial of any action thereafter commenced for any cause subsequently accruing, as if the same had been originally filed in such corrected form before the issue of the original patent.

20. Patentee may Disclaim anything included in the Patent by Mistake.—Similarly, whenever by any mistake, accident, or inadvertence, and without any willful intent to

defraud or mislead the public, a patentee has made his specification too broad, claiming more than that of which he or the party through whom he claims was the first inventor, or has in the specification claimed that he or the party through whom he claims was the first inventor of any material or substantial part of the invention patented, of which he was not the first inventor, and to which he had no legal right;—the patentee may, on payment of the fee hereinafter provided, make disclaimer of such parts as he does not claim to hold by virtue of the patent or the assignment thereof. Such disclaimer shall be in writing, and in duplicate, and attested in the manner hereinbefore prescribed for a patent, one copy to be filed and recorded in the office of the Commissioner, the other copy to be attached to the patent and made a part thereof by reference, and such disclaimer shall thereafter be taken and considered as part of the original specification. Such disclaimer shall not affect any action pending at the time of its being made, except in so far as may relate to the question of unreasonable neglect or delay in making it. In case of the death of the original patentee, or of his having assigned the patent, a like right shall vest in his assigns or legal representatives respectively, any of whom may make disclaimer. The patent shall thereafter be deemed good and valid for so much of the invention as is truly the disclaimant's own and not disclaimed, provided it be a material and substantial part of the invention, and definitely distinguished from other parts claimed without right; and the disclaimant shall be entitled to maintain a suit for such part accordingly.

V. Assignment and Infringement of Patents.

21. GOVERNMENT MAY USE PATENTED INVENTION.—The Government of Canada may always use any patented invention, paying to the patentee such sum as the Commissioner may report to be a reasonable compensation for the use thereof.

22. PATENTS TO BE ASSIGNABLE.—Every patent for an invention, whensoever issued, shall be assignable in law, either as to the whole interest or as to any part thereof, by any instrument in writing; but such assignment, and also every grant and conveyance of any exclusive right to make and use and to grant to others the right to make and use the invention patented, within and throughout Canada or any part thereof, shall be registered in the office of the Commissioner, in the manner from time to time adopted by the Commissioner of Patents for such registration; and every assignment affecting a patent for invention shall be deemed null and void against any subsequent assignee unless such instrument is registered as hereinbefore prescribed, before the registering of the instrument under which such subsequent assignee may claim.

23. REMEDY FOR INFRINGEMENT OF PATENT.—Every person who, without the consent in writing of the patentee, makes, constructs, or puts in practice any invention for which a patent has been obtained under this act or any previous act, or procures such invention from any person not authorized to make or use it by the patentee, and uses it, shall be liable to the patentee in an action of damages for so doing; and the judgment shall be enforced, and the damages and costs that may be ad-

judged shall be recovered in like manner as in other cases in the court in which the action is brought.

24. ACTION FOR INFRINGEMENT OF PATENT.—An action for the infringement of a patent may be brought before any court of record having jurisdiction to the amount of damages asked for, and having its sittings within the province in which the infringement is said to have taken place, and being, at the same time, of the courts of such jurisdiction within such province, the one of which the place of holding is nearest to the place of residence or of business of the defendant; and such court shall decide the case and determine as to costs. In any action for the infringement of a patent, the court, if sitting, or any judge thereof in chambers, if the court be not sitting, may, on the application of the plaintiff or defendant respectively, make such order for an injunction, restraining the opposite party from further use, manufacture, or sale of the subject matter of the patent, and for his punishment in the event of disobedience to such order, or for inspection or account, and respecting the same and the proceedings in the action, as the court or judge may see fit; but from such order an appeal shall lie under the same circumstances and to the same court as from other judgments or orders of the court in which the order was made.

25. COURT MAY DISCRIMINATE IN CERTAIN CASES.—Whenever the plaintiff fails to sustain his action, because his specificatien and claim embrace more than that of which he was the first inventor, and it appears that the defendant used or infringed any part of the invention justly and truly specified and claimed as new, the court

may discriminate, and the judgment may be rendered accordingly.

26. DEFENSE IN ACTIONS OF INFRINGEMENT.—The defendant, in any such action, may specially plead as matter of defense any fact or default which, by this act or by law, would render the patent void; and the court shall take cognizance of that special pleading and of the facts connected therewith, and shall decide the case accordingly.

VI. Nullity, Impeachment, and Avoidance of Patents.

27. PATENT MAY BE DECLARED VOID IN CERTAIN CASES, OR VALID ONLY FOR PART.—A patent shall be void, if any material allegation in the petition or declaration of the applicant be untrue, or if the specifications and drawings contain more or less than is necessary for obtaining the end for which they purport to be made, such omission or addition being willfully made for the purpose of misleading; but if it shall appear to the court that such omission or addition is simply an involuntary error, and it is proved that the patentee is entitled to the remainder of his patent *pro tanto*, the court shall render a judgment in accordance with the facts, and determine as to costs, and the patent shall be held valid for such part of the invention described; and two office copies of such judgment shall be furnished to the Patent Office by the patentee, one to be registered and to remain of record in the office, and the other to be attached to the patent, and made a part of it by a reference.

28. PATENTS TO BE CONDITIONAL FOR THE MANUFACTURE IN CANADA OF THE THING PATENTED.—Every patent granted under this act shall be subject and expressed to be subject to the condition that such patent and all the rights

and privileges thereby granted shall cease and determine and the patent shall be null and void at the end of two years from the date thereof, unless the patentee, or his assignee or assignees, shall within that period have commenced, and shall, after such commencement, continuously carry on in Canada the construction or manufacture of the invention or discovery patented, in such manner that any person desiring to use it may obtain it, or cause it to be made for him at a reasonable price, at some manufactory or establishment for making or constructing it in Canada, and that such patent shall be void if, after the expiration of twelve months from the granting thereof, the patentee, or his assignee or assignees, for the whole or a part of his interest in the patent, imports, or causes to be imported into Canada, the invention for which the patent is granted; and provided always, that in case disputes shall arise as to whether a patent has or has not become null and void under the provisions of this section, such disputes shall be settled by the Minister of Agriculture, or his deputy, whose decision shall be final.

2. COMMISSIONER MAY EXTEND THE TERM FOR MANUFACTURE IN CANADA.—Whenever a patentee has been unable to carry on the construction or manufacture of his invention within the two years hereinbefore mentioned, the Commissioner may grant to the patentee a further delay, on his adducing proof to the satisfaction of the Commissioner that he was for reasons beyond his control prevented from complying with the same, but no such further delay shall be thus granted in any case in advance of the time hereinbefore prescribed.

29. PROCEEDINGS FOR IMPEACHMENT OF PATENT.—Any person desiring to impeach any patent issued under this

act may obtain a sealed and certified copy of the patent, and of the petition, affidavit, specification, and drawings thereunto relating, and may have the same filed in the office of the Prothonotary or Clerk of the Superior Court for the Province of Quebec, or of the Court of Queen's Bench or Common Pleas for the Province of Ontario, or of the Supreme Court in the Province of Nova Scotia, or of the Court of Queen's Bench in the Province of New Brunswick, according to the domicile elected by the patentee as aforesaid, or in the court of highest jurisdiction in the Province of Manitoba or British Columbia, which Courts shall adjudicate on the matter and decide as to costs. The patent and documents aforesaid shall then be held as of record in such Court, so that a writ of *scire facias* under the seal of the Court grounded upon such record may issue for the repeal of the patent, for cause as aforesaid, if upon proceedings had upon the writ in accordance with the meaning of this act the patent be adjudged to be void.

30. JUDGMENT VOIDING PATENT TO BE FILED IN PATENT OFFICE.—A certificate of the judgment voiding any patent shall, at the request of any person or party filing it to be of record in the Patent Office, be entered on the margin of the enrollment of the patent in the office of the Commissioner, and the patent shall thereupon be, and be held to have been, void and of no effect, unless and until the judgment be reversed on appeal, as hereinafter provided.

31. TO BE SUBJECT TO APPEAL.—The judgment declaring any patent void shall be subject to appeal to any court of appeal having appellate jurisdiction in other cases over the court by which the same was rendered.

VII. Patents Issued under former Laws.

32. EXISTING PROVINCIAL AND DOMINION PATENTS TO REMAIN IN FORCE.—All patents issued under any act of the Legislature of the late Province of Canada, or of Nova Scotia, or of New Brunswick, or of British Columbia, and all patents issued for the Provinces of Ontario and Quebec, under any act of the late Province of Canada, and all patents issued under the "Patent act of 1869," to the date of the coming into operation of the present act, shall remain in force for the same term, and for the same extent of territory, as if the act under which they were issued had not been repealed, but subject to the provisions of this act in so far as applicable to them.

2. EXTENSION OF PROVINCIAL PATENTS TO OTHER PROVINCES.—And it shall be lawful for the Commissioner, upon the application of the patentee named in any such patent, being the inventor of the subject-matter of the patent, if the subject-matter of the patent has not been known or used, nor with the consent of the patentee on sale in any of the other Provinces of the Dominion, to issue, on payment of the proper fees in that behalf, a patent under this act, extending such provincial patent over the whole of the Dominion for the remainder of the term mentioned in the provincial patent.

33. RECORDS OF PROVINCIAL PATENT OFFICES TO BE HANDED OVER TO THE COMMISSIONER.—All the records of the Patent Offices of the late Province of Canada and of the Provinces of Ontario and Quebec, or Nova Scotia and New Brunswick, and British Columbia, shall be handed over by the officers in charge of them to the Commissioner of Patents of Invention, to form part of the records of the Patent Office for the purposes of this act.

VIII. Tariff of Fees.

34. TARIFF OF FEES.—The following fees shall be payable to the Commissioner, before an application for any of the purposes hereinafter mentioned shall be entertained, that is to say:

On petition for a patent for 5 years	$20 00
On petition for a patent for 10 years	40 00
On petition for a patent for 15 years	60 00
On petition for extension from 5 to 10 years	20 00
On petition for extension from 10 to 15 years	20 00
On petition for extension from 5 to 15 years	40 00
On lodging a caveat	5 00
On asking to register a judgment *pro tanto*	4 00
On asking to register an assignment	2 00
On asking to attach a disclaimer to a patent	2 00
On asking for a copy of patent with specification	4 00
On petition to reissue a patent after surrender, and on petition to extend a former patent to the Dominion, for every unexpired year of the duration of such patent, the fee shall be at the rate of	4 00

On office copies of documents, not above mentioned, the following charges shall be made:

For every single or first folio of certified copy	$0 50
For every subsequent hundred words (fractions from and under fifty being not counted, and over fifty being counted for one hundred)	0 25

35. COPIES OF DRAWINGS.—For every copy of drawings the party applying shall pay such sum as the Commissioner considers a fair remuneration for time and labor expended thereon by any officer of the department or person employed to perform such service.

36. FEES TO BE IN FULL OF ALL SERVICES.—The said fees shall be in full of all services performed under this act, in any such case, by the Commissioner or any person employed in the Patent Office.

37. FEES TO FORM PART OF THE CONSOLIDATED REVENUE FUND.—All fees received under this act shall be paid over to the Receiver General and form part of the Consolidated Revenue Fund of Canada, except such sums as may be paid for copies of drawings when made by persons not receiving salaries in the Patent Office.

38. RETURN OF FEES.—No fee shall be made the subject of exemption in favor of any person; and no fee, once paid, shall be returned to the person who paid it, except:

1. When the invention is not susceptible of being patented.

2. When the petition for a patent is withdrawn.

And in every such case the Commissioner may return one-half of the fee paid.

And in the case of withdrawal, a fresh application shall be necessary to revive the claim, as if no proceeding had taken place in the matter.

IX. Miscellaneous Provisions.

39. INTENDING APPLICANT FOR A PATENT MAY FILE A CAVEAT.—An intending applicant for a patent, who has not yet perfected his invention, and is in fear of being despoiled of his idea, may file in the Patent Office a description of his invention so far, with or without plans, at his own will; and the Commissioner, on reception of the fee hereinbefore prescribed, shall cause the said document to be preserved in secrecy, with the exception of delivering copies of the same whenever required by the said party or

by any judicial tribunal—the secrecy of the document to cease when he obtains a patent for his invention; and such document shall be called a *caveat*: *Provided, always*, That if application shall be made by any other person for a patent for any invention with which such *caveat* may in any respect interfere, it shall be the duty of the Commissioner forthwith to give notice by mail to the person who has filed such *caveat*, and such person shall, within three months after the date of mailing the notice, if he would avail himself of the *caveat*, file his petition, and take the other steps necessary on an application for patent; and if, in the opinion of the Commissioner, the applications are interfering, like proceedings may be had in all respects as are by this act provided in the case of interfering applications: *Provided further*, That unless the person filing any *caveat* shall, within one year from the filing thereof, have made application for a patent, the Commissioner of Patents shall be relieved from the obligation of giving notice, the *caveat* then remaining as a simple matter of proof as to novelty or priority of invention, if needed.

40. COMMISSIONER MAY OBJECT TO GRANT A PATENT.—The Commissioner may object to grant a patent in the following cases:

1. When he is of opinion that the alleged invention is not patentable in law.

2. When it appears to him that the invention is already in the possession of the public with the consent or allowance of the inventor.

3. When it appears to him that there is no novelty in the invention.

4. When it appears that the invention has been described in a book or other printed publication before the

date of the application, or is otherwise in the possession of the public.

5. When it appears that the invention has already been patented in Canada, (or elsewhere, when the case is one within the seventh section of this act,) except, however, when the case is one in which the Commissioner has doubts as to whether the patentee or the applicant is the first inventor.

41. COMMISSIONER TO NOTIFY GROUND OF OBJECTION TO APPLICANT.—Whenever the Commissioner objects to grant a patent as aforesaid, he shall notify the applicant to that effect, and shall state the ground or reason therefor with sufficient detail to enable the applicant to answer, if he can, the objection of the Commissioner.

42. APPEAL BY APPLICANT TO GOVERNOR IN COUNCIL.—Every applicant who has failed to obtain a patent by reason of the objection of the Commissioner as aforesaid may, at any time within six months after notice thereof has been addressed to him or his agent, appeal from the decision of the Commissioner to the Governor in Council.

43. ARBITRATION IN CASE OF INTERFERING APPLICATIONS.—In case of interfering applications for any patent, the same shall be submitted to the arbitration of three skilled persons, one of whom shall be chosen by each of the applicants, and the third person shall be chosen by the Commissioner or by his deputy or the person appointed to perform the duty of that office; and the decision or award of such arbitrators, or any two of them, delivered to the Commissioner in writing, and subscribed by them or any two of them, shall be final as far as respects the granting of the patent.

2. APPOINTMENT OF ARBITRATORS.—If either of the ap-

plicants refuses or fails to choose an arbitrator, when required so to do by the Commissioner, the patent shall issue to the opposite party; and when there are more than two interfering applicants, and the parties applying do not all unite in appointing three arbitrators, the Commissioner or his deputy or person appointed to perform the duty of that officer, may appoint the three arbitrators for the purposes aforesaid.

3. OATH OF OFFICE.—The arbitrators so named shall, before a judge of any court in any of the Provinces of Canada, subscribe to the following oath:

"I, the undersigned, (A. B.,) being duly appointed an arbitrator under the authority of the forty-third section of the Patent act of 1872, do hereby solemnly swear (*or* affirm, *as the case may be*,) that I will well and truly perform the duty of such arbitrator on the interfering applications of (C. D. and E. F.) submitted to me."

4. POWERS OF ARBITRATORS.—The arbitrators, or any one of them, after having been so sworn, shall have the power of summoning before them any party or witness, and of requiring him to give evidence on oath, orally or in writing, (or on solemn affirmation, if the person be entitled to affirm in civil matters,) and to produce such documents and things as such arbitrators deem requisite to the full investigation of the matters into which they are appointed to examine, and shall then have the same power to enforce the attendance of such witnesses, and to compel them to give evidence as is vested in any court of law in civil cases, in the Province in which the arbitration is to be had; and any willfully false statement made by any such witness on oath or solemn affirmation shall be deemed to be willful and

corrupt perjury; but no such party or witness shall be compelled to answer any question, by his answer to which he might render himself liable to a criminal prosecution.

5. FEES TO ARBITRATORS.—The fees for the services of arbitrators shall be a matter of agreement between the said arbitrators and the parties, and shall be paid by the parties naming them respectively, except those of the arbitrator or arbitrators when named by the Commissioner of Patents, which shall be paid by the applicants jointly.

44. DOCUMENTS TO BE OPEN TO INSPECTION.—All specifications, drawings, models, disclaimers, judgments, and other papers, except *caveats*, shall be open to the inspection of the public at the Patent Office, under such regulations as may be adopted in that behalf.

45. CLERICAL ERRORS.—Clerical errors happening in the framing or copying of any instrument of the Patent Office shall not be construed as invalidating the same, but when discovered they may be corrected under the authority of the Commissioner.

46. DESTROYED PATENT MAY BE REPLACED.—In case any patent be destroyed or lost, others of the like tenor, date, and effect may be issued in lieu thereof, on the party paying the fees hereinbefore prescribed for office copies of documents.

47. USE OF PATENTED INVENTION IN FOREIGN VESSELS.—No patent shall extend to prevent the use of any invention in any foreign ship or vessel, where such invention is not so used for the manufacture of any goods to be vended within or exported from Canada.

48. PATENT NOT TO AFFECT A PREVIOUS PURCHASER OF THE INVENTION.—Every person who before the issuing of

a patent has purchased, constructed, or acquired any invention for which a patent has been obtained under this act, shall have the right of using and vending to others the specific article, machine, manufacture, or composition of matter patented, so purchased, constructed, or acquired before the issue of the patent therefor, without being liable to the patentee or his representatives for so doing; but the patent shall not be held invalid as regards other persons by reason of such purchase, construction, or acquisition, or use of the invention by the person first aforesaid, or by those to whom he may have sold the same, unless the same was purchased, constructed, or acquired or used for a longer period than one year before the application for a patent therefor, which circumstance would then have the effect of making the invention one having become public and in public use.

49. PATENTED ARTICLES TO BE MARKED AS SUCH.—Every patentee under this act shall stamp or engrave on each patented article, sold or offered for sale by him, the year of the date of patent applying to such article, thus:—"Patented 1872,"—or as the case may be; and any such patentee selling or offering for sale any such patented article not so marked, shall be liable to the punishment of a fine not to exceed one hundred dollars, and, in default of the payment of such fine, to imprisonment not to exceed two months.

50. FALSELY MARKING ANYTHING AS PATENTED TO BE A MISDEMEANOR.—Whosoever writes, paints, prints, molds, casts, carves, engraves, stamps, or otherwise marks upon anything made or sold by him, and for the sole making or selling of which he is not the patentee, the name or any imitation of the name of any patentee for the sole mak-

ing or selling of such thing without the consent of such patentee—or without the consent of the patentee, writes, paints, prints, molds, casts, carves, engraves, stamps, or otherwise marks upon anything not purchased from the patentee, the words, "Patent," "Letters Patent," "Queen's Patent," "Patented," or any word or words of like import, with the intent of counterfeiting or imitating the stamp, mark, or device of the patentee, or of deceiving the public and inducing them to believe that the thing in question was made or sold by or with the consent of the patentee, or whosoever puts to sale as patented any article not patented in Canada, for the purpose of deceiving the public,—shall be deemed guilty of misdemeanor, and shall on conviction be punished therefor by fine, or by imprisonment, or both, in the discretion of the court, before which the conviction shall be had; but the fine shall not exceed two hundred dollars, nor shall the imprisonment exceed three months.

51. MAKING FALSE ENTRY OR COPY.—Any person willfully making or causing to be made any false entry in any register or book, or any false or altered copy of any document relating to the purposes of this act, or who shall produce or tender any such false or altered document, knowing the same to be such, shall be guilty of a misdemeanor, and shall be punished by fine and imprisonment accordingly.

52. INCONSISTENT ENACTMENTS REPEALED.—Chapter thirty-four of the Consolidated Statutes of the late Province of Canada, respecting Patents for Inventions, chapter one hundred and seventeen of the Revised Statutes of Nova Scotia, (third series,) chapter one hundred and eighteen of the Revised Statutes of New Brunswick, and

"The Patents Ordinance, 1867," of British Columbia, "The Patent act of 1869," and any act amending any of the said acts or laws, or any other act relating to patents, are hereby repealed, in so far as they or any of them may be inconsistent with this act, or make any provision in any matter provided for by this act, except only as respects all rights acquired and penalties or liabilities incurred under the said laws or any of them, before the coming into force of this act, as to which they shall remain in force, and nothing in this act contained shall affect any suit pending in any court of law or equity at the time of the coming into force of this act.

53. TITLE OF ACT.—In citing this act, it shall be sufficient to call it "The Patent act of 1872."

54. COMMENCEMENT OF ACT.—This act shall commence and take effect on the first day of September, 1872.

CHAP. 44.—AN ACT to amend "The Patent Act of 1872."

[*Assented to 23d May*, 1873.]

Whereas it is expedient to amend the several sections of "*The Patent Act of* 1872" hereinafter specified: Therefore Her Majesty, by and with the advice and consent of the Senate and House of Commons of Canada, enacts as follows:

1. The words "in the *Canada Gazette*" in the fourth line of section five of "*The Patent Act of* 1872," are hereby repealed.

2. The word "assigns" in the last line of section eight of the said act is hereby repealed, and the words "other legal representatives" substituted in lieu thereof.

3. The following words are hereby inserted after the

word "of" in the last line but one of section eleven of the said act: "a court of record or a public notary, or the mayor or other chief magistrate of any city, borough, or town corporate in."

4. The following words are hereby added and inserted at the end of section fourteen of the said act: "But the said Commissioner may, in his discretion, dispense with the said duplicate specification and drawing, and in lieu thereof cause copies of the specification and drawing, in print or otherwise, to be attached to the patent, of which they shall form an essential part."

5. The said act shall be amended by inserting the words "legal representatives" after the word "administrators," in the sixteenth section thereof.

6. This act shall be read and interpreted as forming one and the same act with the act hereby amended.

IV.

RULES, REGULATIONS, AND FORMS OF THE CANADA PATENT OFFICE, 1ST SEPTEMBER, 1872.

GENERAL RULES.

1. A personal appearance of the applicant or his representative at the Patent Office is not required, unless specially called for by the Commissioner or Deputy Commissioner, the business being transacted in writing.

2. In all cases the applicant or depositor of any paper is responsible for the merits of his allegations and the validity of the instruments furnished by him or his agent.

3. Correspondence will be carried on with the applicant or his agent, but only with one person.

4. All documents must be legibly and neatly written on foolscap paper, (say 13 inches long and 8 wide,) with an inner margin of one inch and a half wide.

5. All communications are to be addressed: "*To the Commissioner of Patents, Ottawa.*"

6. As regards proceedings not specially provided for in the forms, any form being conformable to the letter and spirit of the laws will be accepted, and if not conformable will be returned for correction.

7. Models must be neat and substantial working ones, not to exceed eighteen inches on the longest side, unless otherwise allowed by special permission; such models must be so constructed as to show exactly every part of

the invention and its mode of working. In cases where samples of ingredients are required by law, they must be contained in glass bottles properly arranged; but dangerous or explosive substances are not to be sent. Both models and bottles must bear the name of the inventor, the title of the invention, and the date of the application; and must be furnished to the Patent Office free of charge and in good order.

8. All fees required to be paid by law must be transmitted with the application, in current, bankable funds, inclosed in registered letters. Post Office orders are preferred. In no case should money be sent inclosed with models.

9. An application for a patent must be proceeded with and perfected within two years after the lodging of the petition, in default of which it will be regarded as abandoned; and all previous proceedings and payment of fees will be held at the expiration of that period as of no avail.

10. Two or more separate inventions cannot be claimed in one application, nor patented in one patent. But if *separate matters are represented to be so dependent on* and connected with each other as to be necessarily taken together to obtain the end sought for by the inventor, the Commissioner of Patents shall be the judge whether or not the pretensions of the applicant in such respect can be entertained.

11. *The filing of a protest against the issuing of a patent* shall not be taken in itself as sufficient reason to withhold the granting of such patent to an applicant.

12. A *caveat* shall be composed of a specification (*and drawings*) certified on oath, (see form No. 24,) and the filer thereof may lodge with it additional papers during

its currency, provided they are relevant exclusively to the same invention. The person filing *a caveat* will not be entitled to notice of any application pending at the time of filing his *caveat*.

13. All drawings must be made on one or more sheets of tracing linen (eight by thirteen inches) neatly executed, without colors.

14. In the matter of a reissue, under section 19 of the act, whatever is really embraced in the original application and so described or shown in the same that it might have been embraced in the original patent, may be the ground for a reissue. No new matters shall be introduced into the specification, nor shall the model and drawings be amended, except each by the other. In the absence of model or drawing, the reissue may contain amendments, upon satisfactory proof to the Commissioner that such amendments were a part of the invention, although omitted in the original application.

15. Information in relation to pending cases will be furnished only so far as it becomes necessary in conducting the business of the office.

16. The office cannot respond to inquiries as to the probability of an alleged invention being patented in advance of an application for a patent; nor to inquiries founded upon brief and imperfect descriptions, propounded with a view of ascertaining whether alleged improvements have been patented, and, if so, by whom; nor can it act as an expounder of the patent law, nor as counsellor for individuals, except as to questions arising within the office.

17. All business with this office should be transacted in writing. The action of the office will be based ex-

clusively on the written record. No attention will be paid to any alleged verbal promise or understanding in relation to which there is any disagreement or doubt.

18. Assignments of patents are to be accompanied by a copy thereof. Such copy will be kept in the Patent Office, and the original will be returned to the person sending it, with certificate of registration thereon. The copy to be neatly written on foolscap paper, (8 by 13 inches,) with an inner margin of one inch and a half wide.

19. All cases connected with the intricate and multifarious proceedings arising from the working of the Patent Office, which are not specially defined and provided for in these rules, will be decided in accordance with the merits of each case, under the authority of the Commissioner; and such decision shall be communicated to the interested parties, through the departmental correspondent of the Patent Office.

NOTICE.

I. Correspondence with the Department is carried through the Canadian mail free of postage.

II. Every paper forwarded to the office should be accompanied by a letter, and a separate letter should be written on every distinct subject.

III. In order to avoid unnecessary explanations and useless loss of time and labor, it is particularly recommended that reference be made to the law before writing on any subject to the Department; and it is also recommended, in every case, to have the papers and drawings prepared by competent persons, in the interest both of the applicant and of the public service.

IV. Although it is optional for the applicant to annex drawings to the specification of a *caveat* or not, still it is important, in the interest of the inventor, always to attach drawings to such specification.

V. It is in the interest of the applicant that the greatest possible care should be taken with the papers, as dispatch and regularity in the proceedings are thereby promoted.

VI. A copy of the rules with a particular section marked, sent to any person making an inquiry, is intended as a respectful answer by the office.

PETITIONS.

1. By a Sole Inventor.

To the Commissioner of Patents, Ottawa:

The petition of John Smith, of the city of Toronto, in the Province of Ontario, carpenter, showeth—

That he hath invented new and useful improvements on a machine for breaking stone, not known or used by others before his invention thereof, and not being in public use or on sale for more than one year previous to his application in Canada with his consent or allowance as such inventor, the title or name whereof is Smith's Stone-Breaking Machine.

Your petitioner therefore prays that a patent may be granted to him for the said invention, and, for the purposes of the Patent act of 1872, your petitioner elects his domicile in the city of Ottawa, Province of Ontario.

JOHN SMITH.

TORONTO, 1*st September*, 1872.

2. By Joint Inventors.

To the Commissioner of Patents, Ottawa:

The petition of James Thomas, blacksmith, and George Robert Major, tinsmith, both of the city of Ottawa, in the county of Carleton, in the Province of Ontario, showeth—

That they have jointly invented a new and useful improvement on the art or process of separating smut from wheat, not known or used by others before their invention thereof, and not being in public use or on sale for

more than one year previous to their application in Canada with their consent or allowance as such inventors, the title or name whereof is Smith and Major's Process for Separating Smut from Wheat.

Your petitioners therefore pray that a patent may be granted to them jointly for the said invention, and, for the purposes of the Patent act of 1872, your petitioners elect their domicile in the city of Ottawa, in the Province of Ontario.

JAMES THOMAS,
GEORGE ROBERT MAJOR.

OTTAWA, 1*st September*, 1872.

3. BY AN ASSIGNEE, OR LEGATEE "MUTATIS MUTANDIS."

To the Commissioner of Patents, Ottawa:

The petition of Solomon Lang, of the city of Montreal, Province of Quebec, laborer, showeth—

That Thomas Tardy, of the city of Ottawa, Province of Ontario, saloon keeper, hath invented new and useful improvements on planing machines not known or used by others before his invention thereof, and not being in public use or on sale for more than one year previous to this application in Canada with the consent or allowance of the said Thomas Tardy as such inventor.

That your petitioner by assignment, bearing date 1st September, 1872, acquired the right of obtaining a patent from Thomas Tardy aforesaid, for the said invention.

Your petitioner therefore prays that a patent may be granted to him, as assignee of the said Thomas Tardy, for the said invention, the title or name whereof is Tardy's Improved Planing Machine, and, for the purposes of the Patent act of 1872, your petitioner elects his domicile in the city of Ottawa, Province of Ontario.

SOLOMON LANG.

MONTREAL, 1*st September*, 1872.

4. BY AN INVENTOR AND AN ASSIGNEE.

To the Commissioner of Patents, Ottawa:

The petition of John Smith, of the city of Toronto, in the Province of Ontario, carpenter, and David Brown, of the city of New York, in the State of New York, one of the United States of America, painter, showeth—

That the said John Smith hath invented new and useful improvements on a machine for breaking stone, not known or used by others before his invention thereof, and not being in public use or on sale for more than

one year previous to this application in Canada with his consent or allowance as such inventor.

That by assignment, dated on the 1st September, 1872, the said John Smith transferred to the said David Brown an undivided one half interest in the said invention.

Your petitioners therefore pray that a patent may be granted to them jointly for the said invention, the title or name whereof is Smith's Stone-breaking Machine, and, for the purposes of the Patent act of 1872, your petitioners elect their domicile in the city of Ottawa, Province of Ontario.

JOHN SMITH,
DAVID BROWN.

TORONTO, 1st *September*, 1872.

5. BY AN ADMINISTRATOR OR EXECUTOR.

To the Commissioner of Patents, Ottawa:

The petition of James Clayton, of the city of Kingston, in the Province of Ontario, stone cutter, administrator of the estate (or executor of the last will and testament) of Thomas Clayton, in his lifetime of the said city of Kingston, deceased, millwright, (as reference to the duly certified copy of letters of administration (or letters testamentary) hereto annexed will more fully appear,) showeth—

That the said Thomas Clayton did invent a new and useful composition of matter for making artificial stone, not known or used by others before his invention thereof, and not being in public use or on sale for more than one year previous to this application in Canada with the consent or allowance of the said Thomas Clayton as such inventor.

Your petitioner therefore prays that a patent may be granted him as administrator (or executor) of the estate of the said Thomas Clayton for the said invention, the title or name whereof is Clayton's Composition for making Artificial Stone, and, for the purposes of the Patent act of 1872, your petitioner elects his domicile in the city of Ottawa, Province of Ontario.

JAMES CLAYTON.

KINGSTON, 1st *September*, 1872.

6. FOR A REISSUE, (BY THE INVENTOR.)

To the Commissioner of Patents, Ottawa:

The petition of Thomas Brown, of the city of Ottawa, in the Province of Canada, lumber manufacturer, showeth—

That your petitioner obtained a patent bearing date the twelfth day of August, A. D. 1870, for a new and useful improvement on churns.

That your petitioner is advised that the said patent is deemed defective or inoperative by reason of insufficient description or specification, and that the errors arose from inadvertence, accident, or mistake, without any fraudulent or deceptive intention.

Your petitioner being desirous of obtaining a new patent, in accordance with an amended description and specification in duplicate, transmitted herewith, therefore prays that he may be allowed to surrender the aforesaid patent, and a new patent be granted to him in accordance with the amended specification and description for the said invention for the unexpired period for which the original patent was granted.

THOMAS BROWN.

OTTAWA, 1*st September*, 1872.

7. FOR A REISSUE, (BY THE ASSIGNEE.)

To the Commissioner of Patents, Ottawa:

The petition of David Lane, of the town of Cobourg, in the county of Northumberland, Province of Ontario, tanner, showeth—

That your petitioner, by assignment bearing date the 24th day of June, 1872, obtained the exclusive right to a patent granted to Thomas Tardy, of the city of Ottawa, Province of Ontario, broom maker, on the 1st July, 1869, for new and useful improvements on planing machines.

That your petitioner is advised that the said patent is deemed defective or inoperative by reason of insufficient description or specification, and that the error arose from inadvertence, accident, or mistake, without any fraudulent or deceptive intention.

Your petitioner being desirous of obtaining a new patent, in accordance with an amended description and specification in duplicate, transmitted herewith, therefore prays that he may be allowed to surrender the aforesaid patent, and a new patent be granted to him as assignee of the said Thomas Tardy, in accordance with the amended specification and description for the said invention for the unexpired period for which the original patent was granted.

DAVID LANE.

COBOURG, 1*st September*, 1872.

The above form is to be altered to suit the case when the reissue is to the administrator or executor of a deceased inventor.

8. Form of Surrender, to be Written on the Original Patent.

To all to whom these presents shall come: Thomas Brown, of the city of Ottawa, in the Province of Ontario, lumber manufacturer, within named, sends greeting:

Whereas the within written patent for an improvement on churns is deemed defective or inoperative by reason of insufficient description or specification, and the error arose from inadvertence, accident, or mistake, without any fraudulent or deceptive intention, and the Commissioner of Patents accordingly, in pursuance of the statute in such respect, hath agreed to accept a surrender of the same:

Now know ye that the said Thomas Brown within named doth by these presents surrender and yield up the within written patent, granted to him for improvements on churns, and bearing date the 8th day June, 1872.

In witness whereof the said Thomas Brown hath set his hand and affixed his seal this first day of September, A. D. 1872.

Thomas Brown. [L. S.]

Signed, sealed, and delivered at the city of Ottawa, in the county of Carleton, in the Province of Ontario, in the presence of

Henry Cockburn.

9. For the Extension of the Period of a Patent, (Inventor.)

To the Commissioner of Patents, Ottawa:

The petition of Martin Scott, of the city of Montreal, in the Province of Quebec, cooper, showeth—

That on the 23d June, 1870, your petitioner obtained a patent for the period of five years from the said date, for new and useful improvements on churns.

That he is the holder of the said patent, and therefore prays that it may be extended for another period of five years.

Signed this first day of September, eighteen hundred and seventy-two.

Martin Scott.

10. For the Extension of the Period of a Patent, (Assignee.)

To the Commissioner of Patents, Ottawa:

The petition of Simon Smith, of the city of Halifax, in the Province of Nova Scotia, mariner, showeth—

That by assignment, dated 1st July, 1871, he obtained from John Brown of the village of Bridgetown, in the county of Annapolis, in the Province of Nova Scotia, stone-mason, the exclusive right to a patent granted on the 29th June, 1870, for a period of five years from the said date, to the said John Brown, for new and useful improvements in ploughs.

That your petitioner being the holder of the said patent, therefore prays that the said patent may be extended for another period of five years.

Signed this first day of September, eighteen hundred and seventy-two.

SIMON SMITH.

11. EXTENSION OF A PROVINCIAL PATENT TO THE WHOLE DOMINION.

To the Commissioner of Patents, Ottawa:

The petition of William Coe, of the town of Belleville, in the county of Hastings, in the Province of Ontario, railway agent, showeth—

That your petitioner is the inventor of the subject-matter of a patent granted to him on the 30th day of May, 1865, in the Province of New Brunswick, (Nova Scotia, &c.,) for a new and useful improvement on railway signals.

That the subject-matter of the said patent has not been known or used, nor with his consent on sale in any of the other Provinces of the Dominion.

Your petitioner therefore prays that a patent under the Patent act of 1872 be granted to him, extending the privileges of such provincial patent over the whole Dominion for the remainder of the term mentioned in the provincial patent.

WILLIAM COE.

BELLEVILLE, 1st *September*, 1872.

Duplicate copies of the original specifications and drawing, certified by inventor, to accompany the above petition, and to have certificate thereon, as follows:

Duplicate copy of the original specification (or drawing) relative to patent, *bearing date the thirtieth day of May*, one thousand eight hundred and sixty-five, and granted under the seal of the Province of New Brunswick to William Coe.

(Here insert copy of specification or drawing.)

I, William Coe, of the town of Belleville, in the county of Hastings, in the Province of Ontario, railway agent, do hereby certify that the forego-

ing is a true and correct copy of the original specification (or drawing) of patent granted to me. WILLIAM COE.

BELLEVILLE, 1st *September*, 1872.

Signed in the presence of PATRICK LYNCH.

12. POWER OF ATTORNEY.

To the Commissioner of Patents, Ottawa :

The undersigned, John Brown, of the town of Cornwall, in the county of Stormont, in the Province of Ontario, storekeeper, hereby appoints John Smith, of the city of Ottawa, Province of Ontario, his attorney, with full powers of substitution and revocation, to prosecute an application for a patent for new and useful improvements on sewing machines; to sign the drawings, to receive the patent, and to transact all business in the Patent Office connected therewith.

Signed at Cornwall this first day of September, one thousand eight hundred and seventy-two. JOHN BROWN.

In the presence of JOHN SMITH.

13. REVOCATION OF POWER OF ATTORNEY.

To the Commissioner of Patents, Ottawa:

The undersigned, John Brown, of the town of Cornwall, in the county of Stormont, in the Province of Ontario, storekeeper, having on or about the 1st September, 1872, appointed John Smith, of the city of Ottawa, Province of Ontario, his attorney, to prosecute an application for a patent for new and useful improvements on sewing machines, hereby revokes the power of attorney then given.

Signed at Cornwall this thirtieth day of September, one thousand eight hundred and seventy-two. JOHN BROWN.

In the presence of JOHN SMITH.

SPECIFICATIONS.

14. FOR A MACHINE.

To all whom it may concern:

Be it known that I, William Woodworth, of the town of Poughkeepsie, in the county of Dutchess, and State of New York, gentleman, have invented certain new and useful improvements on planing-machines, and I

do hereby declare that the following is a full, clear, and exact description of the same:

The first part of my invention relates to the combination of rotary cutters and feeding-rollers, in such a manner that the said feeding-rollers shall be capable of feeding the lumber to the cutters, and also of effectually resisting the tendency of the cutters to draw the lumber upward toward them; the object of this part of my invention being to reduce the lumber operated upon to an uniformity of thickness, and to give it a planed and even surface upon one side thereof.

The second part of my invention relates to the combination, with feeding-rollers and rotary cutters, for planing one of the principal surfaces of the lumber, of rotary machine cutters, so as to form a tongue or groove, or both, upon the edge or edges of the lumber, at the same time that one of its principal surfaces is planed.

Figure 1 is a side elevation of a machine embodying my invention.

Figure 2 is a plan of the same.

Figure 3 is an elevation showing that end of the machine which is at the right hand in figure 1.

Figure 4 is a vertical transverse section, showing those parts of the machine which are at the right hand of the line *x x*, drawn across figures 1 and 2.

A is the frame of the machine, which frame should be substantially constructed to resist the vibrations of the operating parts. B is the driving-pulley, which is hung on the main shaft, C, of the machine, from which latter, motion is communicated to the operating parts. D is the shaft of the rotary cutters by which the lumber is planed. This shaft is made flat upon two of its sides, between its bearings, for the reception of the cutters, E E, which are firmly secured to it by bolts *a a*, the holes through these cutters for the reception of these bolts being elongated in the direction of the width of the cutters to allow the necessary adjustment of the cutters. The shaft D is hung in adjustable bearings, by which it may be elevated and depressed to regulate the thickness of the planed lumber. F is a pulley on the shaft D, which receives motion by belt G, from the band-wheel H, on the driving-shaft. I I and J J are the feeding-rollers, each pair of which is connected by finger pinions *b b*, and the upper roller of each pair is hung in spring bearings which allow it to yield slightly upward to pressure, to adapt it to any differences or inequalities in the thickness of the lumber. The lower roller of each pair is provided with a worm-wheel *c*, which meshes into a worm or endless screw *d* on the shaft *k*, which is

propelled by a bevel-wheel *l* on the main shaft, working into the bevel-wheel *f* on the shank *k*.

L and M are cutters hung upon vertical shafts N and O, one set of these cutters being adapted to form a groove, and the other to form a tongue upon the edge of the board to be operated upon. These cutters are attached to the shafts in the manner already described with relation to the cutters E E.

The shafts N and O are provided with pulleys *g g*, and rotation is communicated to them by belts *h h*, from pulleys *i i*, on the main shaft: rotation being given in the direction of the arrow to the driving pulley.

The lumber to be planed is introduced from the end of the machine, which is shown at the right hand in figures 1 and 2, and being grasped by the rollers I I, is by them drawn forward to the cutters E E, which, being rapidly revolved towards the advancing lumber, plane it to the proper thickness; and as the lumber continues to advance, it is grasped by the rollers J J, which aid in the feeding motion and discharge the board after it has passed the cutters. The upper rollers I and J, being hung in spring bearings, always exert a pressure on the top of the board, and thus prevent its being raised up by the action of the cutters E E

When the lumber is designed for floors or ceilings, or other purposes for which it is required to be matched, a tongue is formed upon one edge of it and a groove on the other by the cutters L and M, which both revolve toward the advancing board; and these operations are performed at the same time that the upper surface of the board is planed, the whole being done at a single operation.

When the lumber is required to be matched, it should be first reduced to a uniform width, and guided in its introduction into the machine by a gauge P attached to the bed Q of the machine.

When the lumber is not to be matched, this gauge and the cutters L and M should be taken off and dispensed with.

I make no claim to the mode in which the cutters are secured upon their shaft, nor to the adjustable bearings which permit of the elevation or depression of the shaft, for I am aware that these are not new; but I claim as my invention—

1. The combination of the cutters E E and the feeding rollers I I and J J, substantially as and for the purpose hereinbefore set forth.

2. The combination with the cutters E E and the feeding rollers I I and J J of the cutters L and M, substantially as and for the purpose hereinbefore set forth.

WILLIAM WOODWORTH.

POUGHKEEPSIE, 1*st September*, 1872.

Signed in the presence of: JETHRO WOOD,
OLIVER EVANS.

15. Drawings.

Each sheet shall contain the following: The name of the invention, brief references, (A shaft, B valve,) place, date, signatures of two witnesses, the following certificate: "Certified to be the drawings referred to in the specification hereunto annexed," and the signature of the inventor or his attorney.

16. For an Art or Process.

To all whom it may concern:

Be it known that we, Marion Ellsworth, of Chicago, county of Cook, and State of Illinois, gentleman, and Joseph Richard Shaw, of Indianapolis, county of Marion, and State of Indiana, gentleman, have jointly invented—

A new and useful improvement on the art or process of separating smut and other impurities from wheat, and we do hereby declare that the following is a full, clear, and exact description of the same:

Take of lime, newly slacked, and while yet warm, one and a half pounds to each one hundred pounds of wheat. Mix the lime well with the wheat, let it stand one hour, then pass it through a smut-mill in the usual way, and it will be found that all the lime, smut, dirt, and other impurities attached to the wheat, of every kind, and which no smut-mill, without our liming process, will fully separate, will be entirely removed, and the flour will be as white and as sweet as though made from the best of wheat.

We are aware that lime has before been used for the purpose of cleaning wheat, being first mixed with the grain as above proposed, and the whole being then passed through a smut-mill; but in all previous processes, so far as we are aware, the lime has been used in a cold state; and for this reason such processes proved ineffectual. We propose to take lime *newly slacked, and while yet warm.*

We claim as our invention the process of cleaning wheat by mixing with it lime newly slacked and warm before passing it through a smut-mill, so as to cleanse the wheat from all impurities, substantially as described.

Marion Ellsworth,
Joseph R. Shaw.

Chicago, 1*st September*, 1872.

Signed in the presence of: Maurice Jones,
Henry Elias.

17. For a Composition of Matter.

To all whom it may concern:

Be it known that I, Ebenezer Whitney, of the city of Charleston, in the district of Charleston, and State of South Carolina, gentleman, am the administrator of the estate of Benjamin Browning, in his lifetime of the said city, gentleman, and that the said Benjamin Browning did invent a certain new and useful composition of matter to be used in the manufacture of wool; and I do hereby declare that the following is a full, clear, and exact description of the same:

The nature of the invention of the said Benjamin Browning consists in mixing olive, lard, or rape-seed oil with a solution of oil of soap dissolved in hot water.

To prepare the wool oil, take a quantity of oil soap of any kind, provided the quality be good, and dissolve the same in hot water, say about thirty pounds of oil soap to thirty gallons of water, or a sufficient quantity of soap to saturate the water. Then take equal parts, by measure, of olive, lard, rape-seed, or any other kind of oil which can be used on wool in the process of its manufacture, and mix it with the preparation aforesaid, to wit, the soap solution, which, after such mixture, is ready to be used on wool with as beneficial an effect as if pure oil only had been used. This wool oil will not decompose by age, because the oil of soap neutralizes the stearine in the oil; hence there is nothing to decompose. And for the same reason spontaneous combustion cannot be produced.

I claim as the invention of the said Benjamin Browning a compound composed of any of the oils ordinarily used on wool in its manufacture, and a solution of oil soap, substantially in the proportions and for the purposes set forth.

Ebenezer Whitney,
Administrator.

Charleston, 1st *September*, 1872.

Signed in the presence of: John James,
Henry Smith.

OATHS.

18. By Sole Inventor.

Canada, Province of Ontario,
County of York.

I, John Smith, of the city of Toronto, in the county of York, in the Province of Ontario, carpenter, make oath and swear that I verily believe

that I am the first inventor of new and useful improvements on a machine for breaking stone, described and claimed in the annexed specifications, and for which I solicit a patent by my petition, dated 1st September, 1872 And I further make oath that the several allegations contained in the said petition are respectively true and correct. JOHN SMITH.

Sworn before me at the city of Toronto this first day of September, one thousand eight hundred and seventy-two. THOMAS BROWN,
J. P. for the County of York.

19. JOINT INVENTORS.

CANADA, PROVINCE OF ONTARIO,
County of Carleton, to wit:

We, James Thomas, of the city of Ottawa, in the county of Carleton, in the Province of Ontario, in the Dominion of Canada, blacksmith, and George Robert Major, of the same place, tinsmith, do hereby severally make oath, and solemnly swear and say, and

1st. I, this deponent, James Thomas, for myself do hereby solemnly swear and say that I verily believe that I and the said George Robert Major are the true inventors of a new and useful improvement on the art or process of separating smut from wheat, described and claimed in the annexed specification, for which we solicit a patent by our petition to the Commissioner of Patents, dated 1st September, 1872. And I further make oath that the several allegations contained in the said petition are respectively true and correct.

And 2d. I, this deponent, George Robert Major, for myself do hereby make oath and solemnly swear that I verily believe that I and the above named James Thomas are the true inventors of a new and useful improvement on the art or process of separating smut from wheat, described and claimed in the annexed specification, for which we solicit a patent by our petition to the Commissioner of Patents, dated 1st September, 1872. And I further make oath that the several allegations contained in the said petition are respectively true and correct.

JAMES THOMAS,
GEORGE ROBERT MAJOR.

Sworn before me by the said James Thomas and George Robert Major this 1st day of September, 1872, at the city of Ottawa.

JOHN SMITH,
J. P. for the County of Carleton.

20. When the invention has been assigned before the issue of patent, the affidavit must be made by the "inventor," not by the "assignee."

21. If the inventor is dead, the administrator or executor will make the affidavit that the person named as inventor was the first inventor.

22. For a Reissue (Inventor.)

Canada, Province of Ontario,

County of Carleton.

I, Thomas Brown, of the city of Ottawa, in the Province of Ontario, lumber manufacturer,

Make oath and solemnly swear that the several allegations contained in my petition to the Commissioner of Patents, dated 1st September, 1872, for a reissue of the patent granted to me on the 4th September, 1871, for a new and useful improvement on churns, are respectively true and correct.

That I am the sole owner of the said patent.

And that I am the inventor of the improvements set forth and claimed in the amended specification. Thomas Brown.

Sworn before me at the city of Ottawa, in the county of Carleton, in the Province of Ontario, this first day of September, one thousand eight hundred and seventy-two. William Wills,

J. P. for the County of Carleton.

If the patent has not been exclusively assigned, the affidavit must state that the application for reissue is made with the consent of all the assignees.

23. For a Reissue—(Assignee of the entire interest.)

Canada, Province of Ontario,

County of Carleton.

I, David Lane, of the town of Cobourg, in the county of Northumberland, Province of Ontario, tanner, make oath and solemnly swear that the several allegations contained in my petition to the Commissioner of Patents, dated 1st September, 1872, for a reissue of the patent granted to Thomas Tardy, of the city of Ottawa, Province of Ontario, broom maker, for new

and useful improvements on planing machines, are respectively true and correct.

That I am the sole owner of the said patent.

And that Thomas Tardy was the inventor of the improvements set forth and claimed in the amended specification. DAVID LANE.

Sworn before me at the town of Cobourg, in the county of Northumberland, Province of Ontario, this first day of September, one thousand eight hundred and seventy-two. THOMAS PARSONS,
J. P. for the County of Carleton.

24. CAVEAT.

To the Commissioner of Patents, Ottawa:

The undersigned, James Thompson, of the village of New Edinburgh, in the county of Russell, in the Province of Ontario, school teacher, an intending applicant for a patent, who has made certain new and useful improvements on locomotive engines, and has not perfected his invention, prays that this specification may be filed as a caveat in the Patent Office, (here describe the invention as far as possible, and refer to letters in drawing, as in specification given before.) (Form No. 14.)

JAMES THOMPSON.

Signed in the presence of: CHARLES STEWART,
GEORGE HALL.

CANADA, PROVINCE OF ONTARIO,
County of Russell.

I, James Thompson, of the village of New Edinburgh, in the county of Russell, Province of Ontario, school teacher, make oath and solemnly swear that I am the first inventor of the invention described in the foregoing specification, and that the allegations contained in the above specification are respectively true and correct. JAMES THOMPSON.

Sworn before me at New Edinburgh, this first day of September, one thousand eight hundred and seventy-two.

ALEXANDER BUSH,
J. P. for County of Russell.

ASSIGNMENTS.

25. Of an Entire Interest (or an undivided one half interest) in an Invention before the Issue of Patent.

In consideration of the sum of ten dollars, to me paid by Solomon Lang, of the city of Montreal, I do hereby sell and assign to the said Solomon Lang all (or an undivided half of all) my right, title, and interest in and to my invention for new and useful improvements on planing machines, as fully set forth and described in the specification which I have signed preparatory to obtaining a patent. And I do hereby authorize and request the Commissioner of Patents to issue the said patent to the said Thomas Lang, (or jointly to myself and the said Thomas Lang,) in accordance with this assignment.

Witness my hand and seal this first day of September, one thousand eight hundred and seventy-two, at the city of Montreal.

Thomas Lord. [L. S.]

26. Of an Entire Interest in a Patent.

In consideration of five hundred dollars, to me paid by Nathan Wilcox, of Keokuk, Iowa, I do hereby sell and assign to the said Nathan Wilcox all my right, title, and interest in and to the patent of Canada, No. 1200, for an improvement in locomotive head lights, granted to me July 30, 1864, the same to be held and enjoyed by the said Nathan Wilcox to the full end of the term for which said patent is granted, as fully and entirely as the same would have been held and enjoyed by me if this assignment and sale had not been made.

Witness my hand and seal this first day of September, one thousand eight hundred and seventy-two, at Keokuk, Iowa.

Horace Kimball. [L. S.]

27. Disclaimer, to be in Duplicate.

I, William Look[illegible] village of Hull, in the county of Ottawa, Province of Quebe[illegible] the 1st September, 1872, obtained a patent for the Dominion of [illegible]r new and useful improvements on wagon brakes:

And through mistake, accident, or inadvertence, without any willful intent to defraud or mislead the public, I have made the claim in my specification too broad, (or as being the first inventor of a material or substantial part of the invention patented of which I was not the first inventor, and to which I had no legal right:)

I, therefore, hereby disclaim the part of the claim in the specification which is in the following words:

"I also claim the use of the lever A, in combination with crank D, as described."

WILLIAM LOOKUP.

HULL, 30*th September*, 1872.

Signed in duplicate in the presence of: DAVID BROWN,
FRANCIS LEMEUX.

Addition to the Rules and Regulations, (September, 1872,) of the Canada Patent Office, January 14th, 1873.

1. DRAWING.

In order to allow the Patent Office to have a Patent Office Record printed and published, containing the claims and drawings of all patents issued, it is further directed, in addition to the requirements of Rule 13 and Form 15, that—

One drawing on a sheet of card board, 8×13 inches, will be required of each invention, in addition to those ordered by Rule 13 and Form 15; the sheet is to be without writing on its face, merely the usual lettering required on the drawing; written title, references, certificate, signature, &c., not being necessary.

Where several sheets and figures are furnished in accordance with Rule 13, any one figure, which will best give a general idea of the invention, will be sufficient.

The card board to be used must have a smooth or calendered surface. A sheet of "double thick Bristol board" or "Whatman's drawing paper" is recommended.

All drawings must be clear, sharp, well defined, not too fine, and *perfectly black*.

NOTICE.

Lines that are pale, ashy, very fine, ragged, or rotten, give bad results when photo-lithographed.

Brush-shading, tinting, and imitation surface-graining should never be used; and in fine shading the result should be attained with as few lines as possible.

Section lines also should be as open in their spacing as the case will admit of, and these, as well as all right lines, in order to insure clearness, should be made with a ruling pen. The shading of convex and concave surfaces may be dispensed with when the invention is otherwise well illustrated.

Shade lines may sometimes be used with good effect, but heavy shadows, where they would obscure lines or letters of reference, should be avoided.

The card board drawing should be rolled on a roller for transmission to the office, as folding will prevent its usefulness for photo-lithography.

2. SPECIFICATIONS.

The duplicate specifications, in every application, must each be identified by the justice or judge, who takes the affidavit of the inventor, as "the specification referred to in the inventor's affidavit annexed." Such identification to be, by certificate, written at end of, and in each, such specification. Thus:

"This is the specification referred to in the affidavit of ——— ———, hereto annexed. Sworn before me this —— day of ———, A. D. 18—."

———— ————,

Judge or J. P.

3. AFFIDAVIT.

In all cases of applications for patents, where the affidavits are made out of Canada, and before a judge, the seal of the court, presided over by such judge, must be affixed to such affidavit.

V.

THE LAW OF COPYRIGHT IN THE UNITED STATES.

IN FORCE AUGUST 1, 1874.

From the Revised Statutes of the United States, in force December 1, 1873, as amended by act approved June, 18, 1874.

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.

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. Any citizen of the United States, or resident therein, who shall be the author, inventor, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, photograph or negative thereof, or of a painting, drawing, chromo, statue, 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 may reserve the right to dramatize or translate their own works.

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 and a citizen of the United States or resident therein, 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.

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.

SEC. 4956. No person shall be entitled to a copyright unless he shall, before publication, 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 printed copy of the title of the book or other article, or a description of the painting, drawing, chromo, statue, statuary, or model or design for a work of the fine arts, for which he desires a copyright; nor unless he shall also, within ten days from the publication thereof, 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, two copies of such copyright book or other article, or, in case of a painting, drawing, statue, statuary, model or design for a work of the fine arts, a photograph of the same.

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.

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.

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, within ten days after its publication, two complete printed copies thereof, of the best edition issued, or description or photograph of such article as hereinbefore required, and a copy of every subsequent edition wherein any substantial changes shall be made.

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."

SEC. 4963. Every person who shall insert or impress such notice, or words of the same purport, in or upon any book, map, chart, 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.

SEC. 4964. Every person who, after the recording of the title of any book as provided by this chapter, shall 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 witnessess, print, publish, or import, or, knowing the same to be so printed, published, 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.

SEC. 4965. If any person, after the recording of the title of any map, chart, musical composition, print, cut, engraving, 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 chapter, shall, 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, engrave, etch, work, copy, print, publish, 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, 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.

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.

SEC. 4967. Every person who shall print or publish any manuscript whatever, without the consent of the author or proprietor first obtained, (if such author or proprietor is a citizen of the United States, or resident therein,) shall be liable to the author or proprietor for all damages occasioned by such injury.

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.

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 district 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.

SEC. 4971. Nothing in this chapter shall be construed to prohibit the printing, publishing, importation, or sale of any book, map, chart, dramatic or musical composition, print, cut, engraving, or photograph, written, composed,

or made by any person not a citizen of the United States nor resident therein.

SEC.—. [Approved June 18, 1874, to take effect August 1, 1874.] 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 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.

VI.

DIRECTIONS FOR SECURING COPYRIGHTS

UNDER THE REVISED ACT OF CONGRESS WHICH TOOK EFFECT AUGUST 1, 1874.

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1. PRINTED TITLE FOR ENTRY BEFORE PUBLICATION.—A printed copy of the title of the book, map, chart, dramatic or musical composition, engraving, cut, print, photograph, or a description of the painting, drawing, chromo, statue, statuary, or model or design for a work of the fine arts, for which copyright is desired, must be sent by mail or otherwise, prepaid, addressed "Librarian of Congress, Washington, D. C." This must be done before publication of the book or other article.

2. COPYRIGHT FEES.—A fee of 50 cents, for recording the title of each book or other article, must be inclosed with the title as above, and 50 cents in addition (or $1 in all) for each certificate of copyright under seal of the Librarian of Congress, which will be transmitted by return mail.

3. WHAT IS REQUIRED TO PERFECT COPYRIGHT.—Within ten days after publication of each book or other article, two complete copies of the best edition issued must be sent, to perfect the copyright, with the address, "Librarian of Congress, Washington, D. C." It is optional with those sending books and other articles to perfect copyright, to send them by mail or express; but, in either case, the charges are to be prepaid by the senders. Without the

deposit of copies above required the copyright is void, and a penalty of $25 is incurred. No copy is required to be deposited elsewhere.

4. NOTICE OF COPYRIGHT TO BE GIVEN BY IMPRINT.—No copyright is valid unless notice is given by inserting in every copy published, on the title page or the page 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 as a work of the fine arts, by inscribing upon some portion thereof, or on the substance on which the same is mounted, the following words, viz: "*Entered according to act of Congress, in the year* ——, *by* ——, *in the office of the Librarian of Congress, at Washington;*" or, at the option of the person entering the copyright, the words: "*Copyright*, 18—, *by* ——.

The law imposes a penalty of $100 upon any person who has not obtained copyright who shall insert the notice "*Entered according to act of Congress,*" or, "*Copyright,*" etc., or words of the same import, in or upon any book or other article.

5. TRANSLATIONS, &c.—Any author may reserve the right to translate or to dramatize his own work. In this case, notice should be given by printing the words "*Right of translation reserved,*" or "*All rights reserved,*" below the notice of copyright entry, and notifying the Librarian of Congress of such reservation, to be entered upon the record.

6. DURATION OF COPYRIGHT.—Each copyright secures the exclusive right of publishing the book or article copyrighted for the term of twenty-eight years. At the end of that time, the author or designer, or his widow or

children, may secure a renewal for the further term of fourteen years, making forty-two years in all. Applications for renewal must be accompanied by explicit statement of ownership, in the case of the author, or of relationship, in the case of his heirs, and must state definitely the date and place of entry of the original copyright.

7. TIME OF PUBLICATION.—The time within which any work copyrighted may be issued from the press is not limited by any law or regulation, but depends upon the discretion of the proprietor. A copyright may be secured for a projected work as well as for a completed one.

8. ASSIGNMENTS.—Any copyright is assignable in law by any instrument of writing, but such assignment must be recorded in the office of the Librarian of Congress within sixty days from its date. The fee for this record and certificate is one dollar, and for a certified copy of any record of assignment, one dollar.

9. COPIES OR DUPLICATE CERTIFICATES.—A copy of the record (or duplicate certificate) of any copyright entry will be furnished under seal, at the rate of fifty cents each.

10. SERIALS OR SEPARATE PUBLICATIONS TO BE COPYRIGHTED SEPARATELY.—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 is to be taken out for each volume or part of a book, or number of a periodical, or variety, as to size, title, or inscription, of any other article.

11. COPYRIGHTS FOR WORKS OF ART.—To secure a copyright for a painting, statue, or model or design intended to be perfected as a work of the fine arts, so as to prevent infringement by copying, engraving, or vending such design, a definite description must accompany the appli-

cation for copyright, and a photograph of the same, at least as large as "cabinet size," must be mailed to the Librarian of Congress within ten days from the completion of the work.

12. NO LABELS COPYRIGHT.—Copyrights cannot be granted upon Trade-marks, or Labels intended to be used with any article of manufacture. If protection for such prints or labels is desired, application must be made to the Patent Office, where they are registered at a fee of SIX DOLLARS for labels, and TWENTY-FIVE for trade-marks.

13. FULL NAME OF PROPRIETOR REQUIRED.—Every applicant for a copyright must state distinctly the name and residence of the claimant, and whether the right is claimed as author, designer, or proprietor. No affidavit or formal application is required.

OFFICE OF THE LIBRARIAN OF CONGRESS,
Washington, 1874.