THE LAW OF PATENTS.

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THE LAW OF PATENTS

FOR

USEFUL INVENTIONS.

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BOOK III.

OF LETTERS-PATENT.

TREATISE

ON

THE LAW OF PATENTS.

BOOK III.

OF LETTERS-PATENT.

PRELIMINARY ANALYSIS.

§ 415. The Patent Privilege Created and Defined by the Grant of Letters-Patent.

THAT act of the government by which it confers on an inventor the right to the exclusive public use of his invention is the grant of letters-patent. Prior to this act, whatever right he has in his discovery is vested in him only by the law of nature, and is limited to the free use of his invention by himself, subject to its equally free imitation or re-invention by others. But by the grant of letters-patent his right to use becomes an exclusive one. While his own privileges in reference to the discovery are not enlarged, the privileges which the law of nature confers on other persons are suspended, and pending the term of his patent the whole control over the invention resides in him alone. The issue of a patent is therefore, to all intents and purposes, the creation of a new right in favor of the inventor, — the right to exclude all other persons from the use of the invention, — and bestows on him a true monopoly, whose character and extent, as well as duration, the government must specifically define. Of this exclusive privilege the letters-patent are at once the measure and the evidence. By them

the scope of the invention patented is conclusively determined, and the line drawn between those objects which lie open to unrestricted use and those which none but the inventor can lawfully employ. On them depend, on the one hand, the entire commercial value of the invention, with the consequent reward of the inventor, and on the other hand, the privileges still remaining in the public. Hence it becomes most important that in them the invention should be accurately pointed out, and that by them the rights of the inventor should be permanently established within the precise limits which the nature of his discovery and its position in the arts require.

§ 416. Patent Office Established to Secure the Issue of Legal and Correct Letters-Patent.

It is to secure this accuracy in the description of the invention in the letters-patent, and to fix this precise limit between the rights of the inventor and the public, that the Patent Office of the United States has been created. To this department of the government have been committed the interests of individual inventors as well as those of the whole community, so far as they depend upon the progress of the industrial arts. To it the inventor has recourse if he wishes for protection while completing his discovery and reducing it to practice. To it he applies, when his inventive act is finished, for the patent by which his monopoly is to be conferred. By it his application is examined, the novelty and utility of his alleged invention are determined, the language he has used in its description, or in the statement of his claims, is corrected and made to correspond with the real character of his invention, and the controversies between himself and rival inventors are decided. The proceedings necessary to the performance of these various functions and to the securing of these different results have developed, under successive acts of Congress and the decisions of the courts and the Commissioner, into an elaborate system of laws and regulations, in accordance with which all applications for letters-patent must be prepared, submitted, scrutinized, and granted or denied.

§ 417. Authority of Patent Office to Amend Defective Letters-Patent.

Notwithstanding all available diligence and skill on the part of inventors in describing their inventions, and all the care of the Patent Office in examining them, errors often occur in letters-patent, which, if allowed to remain and govern the reciprocal rights of the inventor and the public, would be productive of serious injustice. The law has therefore authorized the correction of these errors, even after the patent is issued by the government, and although it has controlled the relations of the inventor and the public for a long period of time. These errors result mainly from an excess in the description of the invention in the letters-patent, whereby the inventor has received a grant of the exclusive use of more than he has himself invented; or, on the contrary, from some omission or inaccuracy in the description, whereby the right secured by the patent is more limited than that to which the nature of his invention has entitled him. In either case, an application to the Patent Office for the amendment of his letters-patent becomes necessary,—an application which is always granted where the error has occurred without his own misconduct or neglect.[1]

§ 418. Illegal Letters-Patent Repealed, not by Patent Office but by Courts.

The same power which can create a patent privilege can also, when it becomes necessary, destroy it. The authority to grant letters-patent when the required conditions are performed implies an authority to repeal them whenever it is ascertained that the grant had been improperly conferred. Thus, although the Constitution authorizes Congress only to secure to inventors their exclusive rights, yet it has always claimed and exercised the power to provide methods for invalidating its own grants upon discovering that the patentee had no right to retain them. This power, however, has not been confided to the Patent Office; for a patent, when once issued, passes beyond the control of that department, except for the purpose of amendment on the application of the

§ 417. [1] See §§ 633–715 and notes, *post*.

patentee. All questions as to the repeal of patents fall within the jurisdiction of the courts of the United States, and the proceedings instituted for that object are regulated by the statutes or the general provisions of the law.[1]

§ 419. Letters-Patent Interpreted by the Courts.

The grant of an exclusive privilege to an inventor creates a contract relation between himself and the public, the obligations of which, on both sides, are expressed in the letters-patent. A patent is thus a written agreement by which the rights and duties of the inventor on the one hand, and of the people at large upon the other, are defined. Like every other contract, the character and scope of these rights and duties depend upon the terms of the patent as interpreted by the courts, and this interpretation is governed by the same general rules which are applied in construing any written obligation between one party and another. Whatever may have been the real nature of the invention, or the true intention of the inventor in describing it, or even the limits which the Patent Office has attempted to establish for his exclusive rights, the monopoly actually secured by the patent is ascertained and determined by the judicial construction given to its various provisions. In the last resort the patent privilege is, therefore, measured by the judgment of the courts; and hence the legal doctrines applied in construing contracts are always to be borne in mind when the letters-patent, or the documents preliminary to them, are to be prepared.[1]

§ 420. Rights Created by Letters-Patent Transferrible.

The right conferred by the grant of letters-patent is the right to the exclusive use of the invention during a specific period of time. This right differs, in some respects, from the right to the invention itself. The right to the invention vests in the inventor by virtue of his own creative act, and under existing laws includes the right not only to use it without a patent, but to obtain a patent for it, and under certain circumstances to procure an extension of that patent for an ad-

§ 418. [1] See §§ 716–730 and notes, *post.*

§ 419. [1] See §§ 731–751 and notes, *post.*

ditional term of years. The right created by the letters-patent is collateral to the right to the invention, and consists in the authority to prohibit other persons from making, using, or selling the patented art or instrument during the time named for the continuance of the monopoly. Like the right to the invention, however, this right may be transferred to others, either as an entirety or in subdivisions, and for such periods and upon such conditions as the inventor may desire. All these conveyances are limited in their effect by the interpretation given to the patent by the courts, and the titles of all who claim an interest in the patent relate back to the original letters-patent as the source from which they spring.[1]

§ 421. Extension of Letters-Patent: General Divisions of the Law Relating to Letters-Patent.

From an early period the law has taken notice of the fact that during the original term for which the monopoly was granted the inventor may, from circumstances not within his own control, fail to obtain the entire recompense which he deserves; and it therefore has provided, sometimes in one method, sometimes in another, for the extension of the letters-patent after the first term has expired. This duty is also confided, wholly or in part, to the Patent Office; and when exercised completes the series of invaluable services which that department of the government has been empowered to render to the meritorious inventor.[1] Thus it appears that the provisions of Patent Law concerning those letters-patent by which the rights of the inventor and the public are defined, and the titles of the patentee and his transferees to the exclusive use of the invention are established, relate to six principal subjects: —

I. The Grant of Letters-Patent.
II. The Amendment of Letters-Patent.
III. The Repeal of Letters-Patent.
IV. The Construction of Letters-Patent.
V. The Transfer of Letters-Patent.
VI. The Extension of Letters-Patent.

§ 420. [1] See §§ 752–834 and notes, *post*.

§ 421. [1] See §§ 835–845 and notes, *post*.

CHAPTER I.

OF THE GRANT OF LETTERS-PATENT.

§ 422. Grant of Letters-Patent Governed by Statute and by Rules of Patent Office: Authority of such Rules.

The proceedings relating to the grant of letters-patent are regulated in part by the acts of Congress, and in part by rules established by the Patent Office itself. While the general features of these proceedings may properly be made the subject of permanent provisions in the statutes, their numerous and ever varying details can be controlled only by the vigilant and flexible authority of the department in which they arise. For this reason power has been conferred upon the Commissioner of Patents to adopt such regulations as he may deem expedient for the conduct of the business committed to his charge. These rules are subordinate to the statutes, and if inconsistent with them are invalid, but otherwise are of the same obligation as the acts of Congress.[1] Officers of the department, as well as parties and attorneys, are bound to recognize and follow them until duly repealed, and no departure from them, except in some case of necessity, is permitted.[2]

§ 422. [1] That the Patent Office has power to make its own rules, and if these are consistent with the statutes, they are as binding as an act of Congress, see United States *v.* Marble (1882), 22 O. G. 1365.

That the rules of the Office as to the forms of papers, etc., must be complied with, see *Ex parte* Mason (1888), 43 O. G. 627.

That the Executive Department will not interfere with the regulations of the Patent Office, see Opinion Atty. Gen. (1869), 13 Op. At. Gen. 28.

That if inconsistent with the statute, the rule yields and the statute prevails, see Stone *v.* Greaves (1879), 17 O. G. 260.

[2] That the rules are binding until repealed, see Smith *v.* Cowles (1885), 30 O. G. 343; *Ex parte* Smoot (1877), 11 O. G. 1010.

That the rules are binding on the officers of the department as well as on the public, see Brown *v.* La Dow (1880), 18 O. G. 1049; *Ex parte* Smoot (1877), 11 O. G. 1010.

That the rules must not be departed from without necessity, see *Ex parte* Skinner (1881), 19 O. G. 662.

Changes in these regulations can be made at any time by the same authority which originally enacted them; and after such a change the new rule is to be obeyed even in pending cases, unless injustice will thereby be done to the contestants.[3] In the absence both of a statute and a rule of the department, the Patent Office is governed by the principles which the courts apply to cases of a similar character.[4] .

§ 423. Grant of Letters-Patent Illegal unless Statutory Prerequisites Fulfilled.

According to the acts of Congress and the rules of the Patent Office, certain preliminary steps on the part of the inventor are made essential to the granting of a patent. The bestowal of the patent privilege depends entirely upon the provisions of the statutes, and the conditions named therein must be fulfilled or the letters-patent will be null and void.[1] With these prerequisites the Patent Office has no power to dispense, though of their existence and sufficiency the Commissioner is in many cases the final judge; and that they did exist and were sufficient the issue of the letters-patent is always *prima facie* evidence.[2]

[3] That there is no excuse for an officer who adheres to a practice after it has been overruled on appeal, see *Ex parte* Kitson (1881), 20 O. G. 1750.

That where new rules do not injure parties in pending cases they will be followed, see Fowler *v.* Benton (1880), 17 O. G. 266.

That the decisions of courts operate on all cases alike from the time they are rendered, while the rules of practice apply only to cases filed after their adoption, if they would prejudice the parties, see *Ex parte* Pfaudler (1882), 23 O. G. 269.

[4] That where the same questions arise in the Patent Office as in the courts, they are governed by the same rules, see Dana *v.* Greenleaf (1875), 9 O. G. 198.

That the same rules as to the evidence establishing the fact of invention are followed in the Patent Office and the courts, see Chambers *v.* Duncan (1876), 10 O. G. 787.

§ 423. [1] That the right to letters-patent rests on the statutes, and the conditions authorizing their issue must be strictly fulfilled, see *Ex parte* Benton (1882), 23 O. G. 341; Moffitt *v.* Gaar (1860), 1 Bond, 315; 1 Fisher, 610; Latta *v.* Shawk (1859), 1 Bond, 259; 1 Fisher, 465.

[2] That the Patent Office cannot dispense with the legal prerequisites to a patent, see Eagleton Mfg. Co. *v.* West, Bradley, & Cary Mfg. Co. (1883), 111 U. S. 490.

That the patent is *prima facie* evidence that all prerequisites existed, see Dorsey Harvester Rake Co. *v.* Marsh (1873), 6 Fisher, 387.

That as to some prerequisites the decision of the Patent Office is final,

§ 424. Authority of the Commissioner, Acting Commissioner, and Examiners.

The principal officers of the government concerned in the granting of letters-patent are the Commissioner of Patents, the Acting Commissioner, and the various grades of examiners. As the Patent Office is a branch of the Department of the Interior, its general operations are under the supervision of the Secretary of that department, and he may require the Commissioner to perform the functions imposed upon him by the law.[1] The Commissioner is, however, practically at the head of the Patent Office. His powers are partly judicial, partly ministerial. As a judicial officer, he sits as a court of appeal in certain classes of contested cases.[2]

see Hoe *v.* Cottrell (1880), 1 Fed. Rep. 507.

See also §§ 451, 967, 1016, 1032, and notes, *post*.

§ 424. [1] That the Commissioner acts under the supervision of the Secretary of the Interior, and may be required by him to perform his official duties, see Dec. Sec. Int. (1877), 12 O. G. 475.

That the duties of the Commissioner are of two classes: (1) those imposed on him by law; and (2) those imposed by rule of the department, see Houston *v.* Barker (1888), 44 O. G. 697.

That the Commissioner is subject to the control of the Secretary of the Interior only where he is not controlled by the statutes, see U. S. *v.* Butterworth (1884), 3 Mackay, 229; 27 O. G. 519.

That no appeal lies from the judicial acts of the Commissioner to the Secretary of the Interior, see Houston *v.* Barker (1888), 44 O. G. 697; Butterworth *v.* Hoe (1884), 112 U. S. 50; 29 O. G. 615; U. S. *v.* Butterworth (1884), 3 Mackay, 229; 27 O. G. 519.

That the Secretary has no appellate jurisdiction over the Commissioner as to the quasi-judicial duties imposed on him by law, and though he has authority to direct him to perform his duties, he cannot control the mode of their performance unless they are merely ministerial, see Houston *v.* Barker (1888), 44 O. G. 697.

That the appellate jurisdiction of the Secretary is limited to cases arising under the rules prescribed by him for the government of his department, see Houston *v.* Barker (1888), 44 O. G. 697.

That where the Commissioner acquiesces in the decision of the Secretary he cannot treat it as a nullity when the Supreme Court afterwards decides that the Secretary had no power to act, see Drawbaugh *v.* Blake (1885), 30 O. G. 259.

That the Secretary will not interfere where the Commissioner has made every endeavor to be correct, unless there has been fraud or palpable error, see Dec. Sec. Int. (1883), 23 O. G. 629.

[2] That the Commissioner acts judicially in granting or refusing a patent, but is nevertheless bound by established rules and principles, see Butterworth *v.* Hoe (1884), 112 U. S. 50; 29 O. G. 615.

That the judicial powers of the Commissioner are chiefly as a court of appeal, see Stone *v.* Greaves (1880), 17 O. G. 397.

That the Commissioner is not to follow the decisions of lower tribunals

As a ministerial officer, he has jurisdiction over the whole matter of the examination of applications and the grant and issue of patents, but in the discharge of these ministerial duties he is subject to the statutes and the rules of the Office; and his powers cannot be extended beyond these, either by his own authority or by the construction of the courts.[3] The Acting Commissioner is, for all legal purposes, the Commissioner himself; his jurisdiction cannot be collaterally attacked, and patents certified and allowed by him are of the same validity as those issued by the Commissioner in person.[4] The examiners, with the exception of the Examiners-in-Chief, are appointed by the Commissioner, and are charged with various duties, especially those of correcting errors in the descriptions of alleged inventions contained in applications for letters-patent, of examining the novelty and utility of such inventions, and of hearing and deciding upon the claims of rival inventors. The functions of the other officers of this department are mainly clerical, and require no particular enumeration.[5]

if he thinks them erroneous, see Sellers *v.* Walter (1886), 37 O. G. 1001.

[3] That the Patent Office in granting patents before 1836 acted ministerially rather than judicially, see Opinion Atty. Gen. (1831), 2 Op. At. Gen. 454.

That the ministerial jurisdiction of the Commissioner extends to the whole matter of examining applications and granting patents, see Stone *v.* Greaves (1880), 17 O. G. 397.

That the ministerial powers of the Commissioner cannot be extended by the courts, see Child *v.* Adams (1854), 1 Fisher, 189; 3 Wall. Jr. 20.

[4] That the Acting Commissioner is, for all legal purposes, the Commissioner, see Dorsey Harvester Rake Co. *v.* Marsh (1873), 6 Fisher, 387.

That the clerk is Acting Commissioner when the Commissioner is sick or absent, see Woodworth *v.* Hall (1846), 1 W. & M. 389; 2 Robb, 517.

That the jurisdiction of the Acting Commissioner cannot be collaterally attacked, and that his certificate is good between the parties, see Woodworth *v.* Hall (1846), 1 W. & M. 248; 2 Robb, 495.

[5] That the duties of examiners are fixed by the Commissioner, see Hull *v.* Com. (1875), 7 O. G. 559; 2 MacArthur, 90.

See also § 51 and notes, *ante*.

For a discussion of the powers of the Board of Examiners, see *Ex parte* Hull (1875), 9 O. G. 1.

That an examiner cannot pass on any matter expressly decided by a superior tribunal, see *Ex parte* Reynolds (1883), 24 O. G. 993.

That the jurisdiction of an examiner does not change with the person of the incumbent, but remains unaffected until the case passes to a different tribunal or is ended, see *Ex parte* Fredericks (1887), 40 O. G. 691.

That the proceedings in the Patent Office are always presumed to be regular, see Eagleton Mfg. Co. *v.* West,

§ 425. Patent Solicitors and Attorneys.

The business between inventors and the Patent Office is usually transacted through attorneys. An inventor has the right to prepare his own application, and to appear and prosecute his claims in person; but in most cases by doing this he necessarily encounters great difficulties, arising partly from his ignorance of the requirements of the law, and partly from his inability to comply with them if they were known. A due regard for their own interests has led inventors to intrust such affairs to men trained for that purpose, and the practice has been encouraged by the Patent Office as tending to facilitate its own labors, as well as to render more secure the rights of patentees. All such attorneys act under the supervision of the Commissioner, and are subject to a withdrawal of their privileges for misconduct toward the Office or their clients. Their obligations to their employers and their authority and methods of transacting business are governed partly by the regulations of the Office, and partly by the ordinary rules of law.[1]

§ 426. Applications: Caveats: Interferences.

The object of an inventor in endeavoring to procure a patent is twofold: (1) To secure for himself the grant of an exclusive privilege; (2) To prevent a similar grant to any rival applicant. To accomplish the first object he must file in the Patent Office an application in which he describes and claims a patentable invention resulting from his own creative act, and must support his application by an oath that he believes himself the first and true inventor of the art or instrument therein described. If the allegations of this application are, upon the customary examination in the Patent Office, found correct, his petition for a patent is formally allowed and in due course of proceedings the letters-patent will be issued, creating in him the desired monopoly.[1] The latter object, though a secondary one, is still of great import-

Bradley, & Cary Mfg. Co. (1880), 17 O. G. 1504; 18 Blatch. 218; 2 Fed. Rep. 774.

§ 425. [1] See §§ 431–437 and notes, *post.*

§ 426. [1] See §§ 449–585 and notes, *post.*

ance. As every patent is *prima facie* valid, it clothes the patentee with a presumptive right to the exclusive use of the invention, and although issued to another than the real inventor, and therefore liable to be avoided by the courts, while it exists it constitutes a cloud upon the title of the true inventor, rendering his own letters-patent of doubtful validity even where it forms no obstacle to his procuring them. Methods have consequently been provided for the attainment of this as well as the first object. An inventor who is engaged in developing his conceptions or reducing them to practice, and is not yet prepared to make a formal application for a patent, may protect himself against the issue of a patent to his rival by filing in the Patent Office a notice called a Caveat, and maintaining it on file until his invention is completed and his own application is prepared.[2] Where his rival first appears after his own application has been presented to the Office, he can secure the adjustment of their conflicting claims, and, if he be the true and first inventor, the issue of the patent to himself and its refusal to his rival, by a proceeding known as an Interference.[3] These three proceedings constitute the principal business of the Office in relation to the grant of patents.

§ 427. Patent Office Practice and Procedure.

In the conduct of these proceedings the Patent Office is guided not only by the acts of Congress and the written rules of the Office, but by its own established practice. In this tribunal, as in every other, statutes and rules receive a practical interpretation by their application to particular states of fact, and methods of procedure are extended or defined by usages subordinate to, but still beyond, the provisions of the written law. With the facility for reducing all such usages to formal rules which is afforded by the powers of the Commissioner, there is, however, less room for these judicial and traditionary regulations in the Patent Office than in most other bodies where conflicting claims are decided.

[2] See §§ 438–448 and notes, *post*.

[3] See §§ 586–616 and notes, *post*.

§ 428. Patent Privilege Created at the Date of the Issue of the Letters-Patent: Mode and Conditions of Issue.

The final action of the Patent Office in the granting of a patent is the issue of the letters-patent to the inventor. Then, and then alone, does his title to the patent privilege become complete.[1] Neither the application, nor the admission of the novelty and utility of his invention by the examiners, nor the decision in his favor of any contest with rival claimants, establishes his rights as against the public. This can be done only by the actual issue of the letters-patent. The mode in which this issue shall take place, the form and contents of the instrument itself, the term which it shall specify as the duration of the monopoly, and the acts to be performed by the inventor on receiving notice of the grant, are all specifically prescribed by law.[2]

§ 429. Letters-Patent Grantable by Special Act of Congress.

In certain cases letters-patent may be granted without the intervention of the Patent Office. Instances arise where the merits of an inventor justly entitle him to the privileges of a patentee, although from peculiar circumstances his case is not within the jurisdiction conferred upon the Patent Office by the statutes. In such instances an application may be made directly to Congress itself, whose general powers under the Constitution enable it to secure to the inventor the exclusive use of his invention, in any manner and for any time which it may deem expedient. Patents thus granted fall under the general provisions of the law, except when otherwise specified in the act conferring them.[1]

§ 428. [1] That no legal title to the patent exists until the patent issues, see Pontiac Knit Boot Co. *v.* Merino Shoe Co. (1887), 31 Fed. Rep. 286.

[2] See §§ 617–632 and notes, *post*.

§ 429. [1] The power of the Federal legislature, under the Constitution, to grant a monopoly to an inventor by special act has been repeatedly affirmed by the courts, and frequently exercised by Congress itself. The fact that the invention has already gone into extensive public use, or that a long period has elapsed since it was ready for bestowal on the public, or that an application to the Patent Office for a patent has been refused, may furnish a reason why Congress should decline to show this favor to the inventor, but in no wise restricts its authority to do so, should the measure seem expedient. Existing monopolies cannot in this manner be abrogated or curtailed; but with this limitation the action of Con-

§ 430. Grant of Letters-Patent: Subordinate Topics: Order of Discussion.

In considering the various rules relating to the grant of letters-patent, and the many subordinate and collateral topics which the general subject embraces, the following arrangement will be pursued: —

I. Of Patent Attorneys, their Rights and Duties.
II. Of Caveats and the Procedure thereon.
III. Of the Form of the Application.
IV. Of the Subject-Matter of the Application.
V. Of the Description of the Invention.
VI. Of the Claim.
VII. Of the Drawings and Model.
VIII. Of the Filing of the Application and Payment of Fees.
IX. Of Procedure in Uncontested Cases.
X. Of Procedure in Interference Cases.
XI. Of the Form and Effect of Letters-Patent.

SECTION I.

OF ATTORNEYS.

§ 431. Relation of Patent Attorneys to the Patent Office.

An inventor may choose any person of intelligence and good moral character to act as his attorney in the prosecution of his application for a patent.[1] Over all such attorneys the Commissioner of Patents has a certain authority and he may pass upon their appointments and dismissals;[2] but the Patent Office is not responsible for their conduct toward their clients,

gress may be retrospective or prospective only, and may bestow on the monopoly such characteristics of duration and extent as the wisdom of the legislature may determine. See further on this subject §§46, 47, and notes, *ante*.

§ 431. [1] That patent attorneys are not required to be learned lawyers, see Osgood *v.* Badger (1888), 44 O. G. 1065.

That no qualifications of age, sex, or capacity are requisite to patent attorneys, see Hoosier Drill Co. *v.* Ingels (1879), 15 O. G. 1013.

[2] That the Commissioner may pass on powers and revocations of attorneys, see *Ex parte* Morley (1886), 37 O. G. 337; *Ex parte* Pitney (1880), 17 O. G. 447.

That patent attorneys are not agents of the Patent Office, see Hoosier Drill Co. *v.* Ingels (1879), 15 O. G. 1013.

nor will it aid inventors in selecting them. Nor are special privileges permitted by the Office to any one attorney over another; nor has one any more facilities for procuring patents than another, except such as arise out of his own superior diligence and skill.

§ 432. Patent Attorneys Appointed only by a Written Power.

An inventor can appoint an attorney only by a written power of attorney, and the Patent Office cannot recognize the attorney as such until the power of attorney has been duly filed in the department. This written power must be signed by the inventor or other proper applicant, and must name each and every person upon whom the attorneyship is to be conferred. A power of attorney given to a firm must thus specifically mention each member of the firm or it cannot be regarded as bestowing the required authority either upon the firm as a whole or upon any of the copartners. Any power of attorney may contain a written authorization, by virtue of which the original attorney may substitute another for himself, or may associate another with him; but such authorization will not empower the substitute or associate to delegate his authority to others.[1] The rules requiring and governing the power of attorney are stringent and universal, not even a member of Congress being allowed to examine patent cases, nor act in them, without first filing such written power.

§ 433. Authority of Attorney Revocable or Irrevocable: How Revoked.

A power of attorney may be either irrevocable or revocable. Where it constitutes part of a contract, in the fulfilment of which the attorney has a beneficial interest, it is irrevocable; although even in such cases the attorney is still, so far as the

§ 432. [1] That an associate attorney cannot be appointed by the applicant without the consent of the regular attorney, see *Ex parte* Ranks (1887), 38 O. G. 329.

That an associate attorney should be appointed by the regular attorney upon the written authority of his client, see *Ex parte* Ranks (1887), 38 O. G. 329.

That where an applicant appoints two or more attorneys he must designate with which the Office shall hold correspondence, otherwise it will recognize only the resident attorney, see *Ex parte* Jewett (1887), 38 O. G. 781.

application for a patent is concerned, the mere agent of his principal.[1] Unless the authority is thus irrevocable, it may be terminated by the client at his pleasure. In order to do this, he should give written notice of such revocation to the Patent Office; whereupon the Office will immediately notify the attorney, and thenceforth deal personally with the client, or with such other attorney as he may lawfully appoint. This notice puts an end to the authority of the attorney; and neither the Patent Office nor any contesting party to whom the notice of the revocation may be given is at liberty thereafter to recognize him as representing his former principal.[2] The death of the principal also terminates a revocable power of attorney; and where an applicant dies pending his application, his personal representatives must re-appoint the attorney, or ratify his former appointment, before he can be allowed to act for them.[3] But the assignment, by an applicant, of an undivided interest in the invention will not revoke a previous power of attorney nor authorize the assignee to revoke it; though where a power of attorney is conferred before the application, and subsequently, but still before the application, the entire interest in the invention is assigned, the authority of the attorney of the assignor expires, and a new appoint-

§ 433. [1] That when a power of attorney is part of a contract which creates a beneficial interest in the attorney, it is irrevocable, see *Ex parte* Harrison (1878), 13 O. G. 547.

That an attorney holding an irrevocable power is still the mere agent of his principal, see *Ex parte* Cox (1872), 2 O. G. 491.

That a power of attorney not coupled with an interest is revocable at will, see *Ex parte* Morley (1886), 37 O. G. 337.

[2] That an applicant can discharge his attorney on giving notice to the Patent Office without leave of the Commissioner, see Hoosier Drill Co. *v.* Ingels (1879), 15 O. G. 1013.

That notice to the Patent Office of revocation terminates the authority of the attorney and the right of the Office to deal with him as such, see *Ex parte* Morley (1886), 37 O. G. 337; Hoosier Drill Co. *v.* Ingels (1879), 15 O. G. 1013.

That notice to the adverse parties of such revocation deprives them of the right to recognize him as attorney, see Hoosier Drill Co. *v.* Ingels (1879), 15 O. G. 1013.

[3] That the death of an applicant revokes his power of attorney, see Eagleton Mfg. Co. *v.* West, Bradley, & Cary Mfg. Co. (1880), 18 Blatch. 218; 2 Fed. Rep. 774; 17 O. G. 1504.

That the former attorney of a deceased applicant has no power to amend the application after his death without the oath of the representative, see Eagleton Mfg. Co. *v.* West, Bradley, & Cary Mfg. Co. (1880), 18 Blatch. 218; 2 Fed. Rep. 774; 17 O. G. 1504. Affirmed s. c. (1883) 111 U. S. 490.

ment, or the ratification of the previous one, by the assignee is necessary.[4]

§ 434. Authority of Attorney Limited to the Application Accompanying the Power.

The relation created between the inventor and his attorney by the filing of the written power of attorney is neither permanent nor universal, but has reference only to the particular proceedings of which the power of attorney forms a part, and ends when that proceeding is concluded.[1] If several applications are instituted concurrently by the same inventor, a separate power of attorney must be filed in each, although in all the person of the attorney may be the same. For purposes of notice in certain cases, however, the Patent Office continues to recognize an attorney as a medium of communication with his client after the business for which he was appointed is completed.

§ 435. Authorized Attorney the Sole Medium of Communication between Patent Office and Inventor: his Rights and Duties.

After the filing of the written power of attorney in the Patent Office, all its correspondence with the inventor takes place through his attorney. The attorney has a right to inspect the papers in his case while in the custody of the Office, and is allowed to consult with the examiners and their assistants in regard to questions which arise concerning it in their departments. In all his dealings with the Patent Office he is required to conduct himself with courtesy and decorum; and written applications, arguments or other documents, containing anything in violation of this requirement, will ordinarily be returned to him without action. In his dealings with his client he is subject to the general rules of

[4] That when an entire invention is assigned before application, and the attorney has received his power from the inventor alone, the power must be ratified by the assignee or a new attorney appointed, see *Ex parte* Ackerman (1880), 17 O. G. 1036.

§ 434. [1] That the authority of an attorney is not continuous, but ends when the application ends, see Hoosier Drill Co. *v.* Ingels (1879), 15 O. G. 1013.

agency, and is obliged to use such skill and diligence as the nature of the business he has undertaken may demand.[1] But neither his culpable neglect nor his fraudulent conduct are allowed to prejudice his principal, unless they have been instigated or accepted by the principal himself, or unless vested rights or public interests would be unjustly violated were the acts of the attorney held invalid.[2]

§ 436. Compensation of Patent Attorneys: Lien on Letters-Patent.

The attorney of an inventor, like any other attorney, has a lien upon the papers of his client for his fees.[1] The letters-patent, when issued by the Office, are delivered to him if he so desires, and may be retained by him until his reasonable charges against the patentee for services and disbursements have been paid. The same privilege belongs to an associate or substitute attorney in reference to all papers properly coming into his possession, although the patent itself is not delivered to him by the Office without a special order from the primary attorney.

§ 437. Attorneys Disbarred by Commissioner for Cause.

The power of the Commissioner over the attorneys of inventors extends to their suspension or dismissal for gross misconduct, either toward the Patent Office or their clients. This power is conferred on the Commissioner by statute, and

§ 435. [1] That a party is bound by the acts of his attorney, acting in good faith and within the scope of his authority, see *Ex parte* Hatchman (1884), 3 Mackay, 288; 26 O. G. 738; *Ex parte* Hatchman (1883), 25 O. G. 979.

[2] That delays fraudulently caused by his attorney do not prejudice the inventor, see Case *v.* Hastings (1875), 7 O. G. 557.

For some purposes the acts of the attorney bind his principal, even though involving a breach of duty or a want of professional skill. Where the interests of rival claimants are to be affected by a disavowal of the measures adopted by the attorney, or where the public have availed themselves of the apparent abandonment of rights which greater vigilance or knowledge on the part of his attorney might have secured to the inventor, the principal is bound by the acts of his agent and must seek his remedy for the ignorance or neglect in the usual mode. Examples of the application of this rule will be observed in many cases hereafter cited, especially in reference to the subject of Re-issues.

§ 436. [1] That an attorney, or a substitute attorney, has a lien on the papers of his client, see *Ex parte* Bowers (1879), 16 O. G. 1004.

its necessity is manifested by the frequency of the occasions which demand its exercise. The suspension or dismissal may be general, covering all present and future proceedings in which the attorney is or might be employed, or it may be particular, merely preventing him from acting in the special cases named. This power, however, is not arbitrary nor conclusive. A hearing upon formal charges, in pursuance of the usual judicial methods, is accorded to the attorney; and the order for his dismissal, with the reasons for it, must be submitted to and receive the approval of the Secretary of the Interior before it goes into effect.

SECTION II.

OF CAVEATS.

§ 438. Purpose of Caveat.

The purpose of a caveat is to secure to an inventor the opportunity to have the question of priority between himself and a rival inventor determined before the issue of letters-patent to either.[1] In the absence of such an opportunity the first applicant for a patent would receive the grant, although as a matter of fact he was not the earliest inventor. If subsequently to the issue of his patent the earlier inventor made his application, and successfully maintained his claim of priority, he would become entitled to, and would obtain, a patent also. Thus two outstanding patents for the same invention would exist, each vesting the exclusive right in a different patentee, — a condition of affairs endangering the value of the invention not only to the rival patentees but to the public, since the use of the invention under either patent is a *prima facie* infringement of the other. To prevent this difficulty as far as possible Congress in 1836 provided the present method of securing to inventors who may not be ready to present their own applications such timely notice of the pendency of

§ 438. [1] That the object of a caveat is to protect the first conceiver, and secure him a proper notice of subsequent applications, see Phelps *v.* Brown (1859), 18 How. Pr. 7; 4 Blatch 362; 1 Fisher, 479; Allen *v.* Hunter (1855), 6 McLean, 303.

other applications covering the same invention as will enable them to make their claims and have them investigated by the Patent Office before any one receives the patent.

§ 439. Nature and Effect of Caveat.

A caveat is a written notice to the Patent Office that the caveator claims to be the first and true inventor of the art or instrument therein described. Its effect is to prevent the grant of a patent for the same alleged invention, without notice to the caveator, in case an application should be filed by another inventor during the life of the caveat. Thus it simply entitles the caveator to a certain notice. It does not afford him any protection against public use, nor supply the place of due diligence in perfecting his invention and reducing it to practice.[1] It gives him no advantage over any rival claimant, who may subsequently file a caveat or an application for a patent; nor does it impose upon him any obligation, either to present an application on his own behalf, or to oppose the issue of the patent to his rival.

§ 440. Who may File a Caveat.

No person is permitted to enjoy this privilege unless he is a citizen of the United States, or, if an alien, unless he has resided in this country for one year next preceding the filing of his caveat, and has formally declared his intention to become a citizen. He must also be the actual inventor of the art or instrument described in his caveat, and must believe himself to be its first inventor; and for reasons known to himself, but into which neither the Patent Office nor the law inquires, he must desire further time to mature his invention before filing his own application for a patent.[1]

§ 439. [1] In Bell *v.* Daniels (1858), 1 Bond, 212, Leavitt, J.: (218) "The effect of the 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." 1 Fisher, 372 (377).

§ 440. [1] That a caveat cannot be filed for a design as a design cannot exist at all until it is complete enough to be patented, see *Ex parte* Carty (1888), 44 O. G. 570.

§ 441. Contents of Caveat.

The caveat itself consists of a petition on oath, a specification, and in some cases a drawing. The petition alleges the citizenship or resident alienage of the caveator, his inventive act, and his desire to perfect his invention before applying for a patent, and prays that his accompanying specification may be placed on file in the Patent Office. The oath affirms the allegations of citizenship or residence, and the belief of the caveator that he is the first inventor. The specification embraces a description of the object of invention, and of its distinguishing characteristics. In this description the same particularity is not required as in that annexed to a petition for a patent; but it must be as complete and exact as the inventor is able to give, and must be precise enough to enable the examiners in the Office to determine whether an invention described in a subsequent application is probably the same. Any defect in this respect must be amended before the caveat can be accepted by the Office. The specification must also be limited to one invention, according to the rules established for the application for a patent; and if amendments offered describe a different or an additional invention they cannot be received, except as new and separate caveats. When practicable, a full and accurate drawing of the invention, executed upon some substance capable of being folded for convenient filing, should accompany the specification. The caveat must be signed by the inventor, although in caveats for joint inventions the signature of one inventor only is sufficient.[1] The established fee must also be forwarded with the caveat. A failure to comply with any of these requirements renders the caveat of no validity, and the caveator is not entitled to the notice which it is intended to secure.

§ 442. Filing of Caveat: its Secrecy.

On the receipt of the caveat by the Patent Office, in proper form, it is filed in the secret archives of the Office and there

§ 441. [1] That a caveat for a joint invention may be signed by one of the inventors only, see *Ex parte* Gray (1877), 12 O. G. 396.

That a caveat and oath by one inventor is no bar to an application by him and another as joint inventors if the mistake were *bona fide*, see Hoe *v.* Kahler (1882), 12 Fed. Rep. 111; 20 Blatch. 430.

remains during its life, inaccessible to all persons except the inventor, or his duly authorized agent, and the officers of the department. No information is permitted to be given to any others, either concerning its contents or the fact of its existence, unless by the direction of the caveator.[1]

§ 443. Duration of Caveat.

A caveat, once filed, remains in force for one year from the date of its acceptance by the Patent Office. At the expiration of this term it may be renewed for another year by the payment of an additional fee; and so on from year to year during the pleasure of the caveator. If not renewed it still remains in the secret archives of the Office, although it ceases to secure any rights to the inventor.

§ 444. Notice of Subsequent Applications to Caveator: Proceedings Thereon.

Whenever an application for a patent for the same invention is filed by a rival inventor, either simultaneously with the caveat or during its life, and the invention described is found by the Office to be patentable and to correspond apparently with that specified in the caveat, proceedings on the application are suspended, the application with its specification, drawings, and model is deposited within the secret archives of the Office, and the caveator is notified to file his application for a patent in order that the rival claims may be determined. The caveator must thereupon present his application within three months from the expiration of the time regularly required for the transmission of such notice to him by mail from Washington; and if it then appears that the two applications claim the same invention an interference will be declared and the controversy heard and decided in the mode provided for that purpose.[1] This notice to the caveator

§ 442. [1] That the rule requiring caveats to be kept secret is lawful, see Dec. Sec. Int. (1883), 23 O. G. 629.

That the fraudulent disclosure of a caveat to a rival applicant does not bar the right of the latter to a patent for the invention described and claimed in an application filed before the disclosure was made, see American Bell Telephone Co. *v.* National Improved Telephone Co. (1886), 27 Fed. Rep. 663.

§ 444. [1] In American Nicholson Pavement Co. *v.* Elizabeth (1873), 3 O. G. 522, Nixon, J.: (525) "The 12th section of the act of July 4, 1836, under which the foregoing caveat was filed,

it is the duty of the Commissioner to give; and if, through any fault or inadvertence in the Office, it should be omitted, or if the caveator should fail to receive it, and a patent for the invention issue to the applicant, the latter can take no advantage from his patent in any subsequent interference proceeding between himself and the caveator.[2] Although his

authorizes any person who shall have invented any new art, machine, or improvement thereof, and shall desire further time to mature the same, upon payment of twenty dollars, to file in the Patent Office a caveat, setting forth the design and purpose thereof, and its principal and distinguishing characteristics, and praying protection of his right till he shall have matured his invention. Such caveat is filed in the confidential archives of the Office and preserved in secrecy. The obvious design of this section is to afford to inventors the opportunity of perfecting their discoveries and inventions. To prevent an abuse of the privilege, it is further provided that if an application is made by any other person, within one year from the time of filing the caveat, for a patent of any invention with which it may in any respect interfere, it shall be the duty of the Commissioner to deposit the descriptions, specifications, drawings, and model, in the confidential archives of the Office, and to give notice by mail to the person filing the caveat of such application, who shall, within three months after receiving the notice, if he would avail himself of the benefits of his caveat, file his description, specifications, drawings, and model. If no such application is made, the caveator has a reasonable time in which to mature his invention or discovery; and when his letters-patent are issued, if he have used due diligence, he has the right to have his matured invention incorporated into his patent, and to supersede those that have intervened between the date of his first discovery and his subsequent

taking out of the patent." 6 Fisher, 424 (431).

[2] In Frevert v. Gahr (1873), 3 O. G. 660, Thacher, Act. Com.: (660) "The law, however, not only contemplates that notice shall be duly sent, but that it shall be received by the caveator; that he shall have the benefit of his caveat for which he has paid, which he cannot have if he does not receive notice of an interfering application. I do not mean to assert that the Office is bound to insure him notice, further than it does in ordinary cases, by duly mailing the notice and suspending the interfering application, as was done in this instance. But when it appears in proof as a matter of fact that the notice, through no fault of his, did not reach the caveator, then it follows that the patentee has obtained his patent without the proceedings in interference which the law contemplates shall be had in all cases of this nature. Whereas, if the notice had not failed to reach its destination, the parties would, in all probability, have come before the Office as applicants upon equal footing, as the law intends in such cases; now, by the fault of neither party nor the Office, the patentee, as such, has, upon the record, acquired an advantage. It cannot be ignored that his apparent advantage in this instance comes through a mere accident, and that if allowed its ordinary value the spirit of the law would obviously be subverted. Therefore I am not disposed to consider Gahr in any better position than he would have been had the interference been declared pending his application."

That it is the duty of the Commis-

patent cannot be recalled it will be regarded as surreptitiously obtained, and both the caveator and himself will be treated as standing on equal ground as rival applicants.[3] But this rule in reference to notice applies exclusively to applications filed pending the caveat; of those which are already in the Office when the caveat is filed, and those which are presented after the life of the caveat expires, the caveator has no right to be informed, but must take the same chances concerning them as any other inventor.[4]

§ 445. Caveat not to be Withdrawn: Copies: Amendments.

A caveat, having been once filed in the Office, cannot be withdrawn by the caveator, either for the purpose of amendment or for any other purpose. Copies of it, or of its accompanying papers, may be obtained by him or his authorized agent in the usual manner; and any correction or addition which he may desire to make, if proper to be made at all, must be separately prepared and filed.

§ 446. Caveat as Evidence: as Estoppel.

A caveat is evidence of the date of the invention described therein, and may be used in certain cases as proof that the inventive act had been performed before the time when it was filed.[1] But unless necessarily inferred from the description given, it does not show that the invention was then completed; nor, on the other hand, does the statement in it that the caveator desires further time to mature his invention

sioner to give to the caveator the proper notice, and its accidental omission cannot prejudice his rights, see Phelps *v.* Brown (1859), 4 Blatch. 362; 18 How. Pr. 7; 1 Fisher, 479.

[3] That a patent issuing on a subsequent application, without notice to the caveator, gives no advantage to the patentee, but as against the caveator he will still be treated as a rival applicant, see Ware *v.* Bullock (1874), 7 O. G. 39; Phelps *v.* Brown (1859), 4 Blatch. 362; 18 How. Pr. 7; 1 Fisher, 479.

That a patent issued on a subsequent application without notice to the caveator is "surreptitiously obtained," see Phelps *v.* Brown (1859), 4 Blatch. 362; 18 How. Pr. 7; 1 Fisher, 479.

[4] That an application and a caveat being filed simultaneously by two different inventors, the caveator is entitled to notice, see *Ex parte* Essex (1876), 9 O. G. 497.

§ 446. [1] See MS. cases cited in Law's Digest: title, Caveat. Also § 1015 and notes, *post*.

conclude him from averring that the art or instrument was at that time perfect and ready for a patent.[2]

§ 447. Caveat not Assignable.

The law makes no provision for the assignment of a caveat, or of the right to notice which it is intended to secure. The invention described therein may be transferred under such terms of contract as shall protect the assignee by obliging the inventor to proceed with his application, upon receiving notice, on behalf of the real owner of the invention; and the caveat may serve as a means for identifying the invention applied for with the invention so transferred.

§ 448. Caveator not Concluded by his Description of the Invention.

The description of the invention as given in a caveat is not conclusive upon the inventor or his assignee. It does not purport to be an account of a result accomplished, but of a result expected and desired; and, when attained, this result may vary in many particulars from the one foreseen by the inventor. While, therefore, as entitling him to a notice of subsequent applications, the caveat is taken according to the terms of the description, he is not estopped by it, when his invention is completed, from connecting with his perfect art or instrument the inventive act imperfectly delineated by him in the caveat. Having filed this as a matter of precaution, he may proceed with his experiments; and if he uses due diligence he may secure his matured invention by a patent, although other inventors have conceived the same ideas or successfully prosecuted the same experiments since the date of his original discovery.[1] In all such cases the question between him and his rivals is simply that of priority of invention, to be determined according to the principles already stated.

[2] That a caveat does not show whether or not the invention is perfected, see Johnson *v.* Root (1858), 1 Fisher, 351.

§ 448. [1] That if the first conceiver, having filed his caveat, uses reasonable diligence in reducing to practice, he may protect his matured invention in his patent, see American Nicholson Pavement Co. *v.* Elizabeth (1873), 3 O. G. 522; 6 Fisher, 424; Phelps *v.* Brown (1859), 4 Blatch. 362; 18 How. Pr. 7; 1 Fisher, 479.

SECTION III.

OF THE APPLICATION: ITS FORM.

§ 449. Application for Letters-Patent Made by Whom.

An application for a patent must in all cases be made by the inventor, if living, whoever may by law be actually entitled to the ownership of the exclusive privilege when granted. A patent may be issued, as shown at length in the preceding Book, either to the inventor himself, his personal representatives, or his assigns; but the measures to obtain it must be originated by the inventor, unless this has been rendered impossible by his death. If he has died after completing the invention and without applying for a patent, the application must be made by his executor or administrator in the interest of his heirs or devisees or assignees, in whom, by law or by the act of the inventor, the right to the patent may be vested. An application for a patent for a joint invention must be made by all the joint inventors.

§ 450. Proper Applicant Determined from the Record Title in the Patent Office.

In receiving and examining applications the Patent Office deals only with those who appear, by the records of the Office, to be the proper applicants.[1] It has no jurisdiction over questions of title between rival claimants, and cannot undertake to make or alter or enforce the agreements of contending parties. It therefore recognizes the inventor as the only

§ 450. [1] In *Ex parte* Edison (1875), 7 O. G. 423, Thacher, Com.: (424) "The issue before the Commissioner is, to whom shall the patents be granted? In determining this question, the Commissioner must be guided entirely by the record. He has not the authority of a court to consider evidence, outside the record, as to outstanding equities. The only question that he can decide is, who on the record possesses the *legal* title to these inventions? He must issue the patents accordingly, if the requirements of the Office in such cases provided have been complied with."

That an application is evidence of the applicant's title, see Com. Dec. (1884), 26 O. G. 637.

That in issuing patents the Patent Office has no power to reform or cancel assignments or decide the equitable rights of parties on extraneous proof, but must follow the record title, see *Ex parte* Paine (1878), 13 O. G. 408.

party in interest, until by proof of his death and the presentation of the proper letters by his personal representative, the latter is substituted in his place, or until, by the filing and recording of an assignment, the assignee is made either the sole owner of the invention, or a joint owner with the inventor. Thus, although the application be originally made by the inventor, the person of the applicant, as known to the Patent Office, may be subsequently changed, either wholly or in part. By the death of the inventor, or by his assignment of the entire interest in the invention or in the future patent, he ceases to be known to the Office as an applicant, and his executor or administrator or the assignee is alone entitled to hold correspondence with the department concerning the invention; while if the assignment has transferred only an undivided interest in the invention or the patent, both the inventor and the assignee now constitute the applicant, and both are so regarded by the Office and must act jointly in the prosecution of their claims. Changes of this character may take place up to the date of the issue of the patent, and the patent will then be granted to whosoever may appear of record to be its proper owner.[2]

§ 451. Applications must Conform to Legal Requirements: if Granted, such Conformity Presumed.

Every application for a patent must conform in all respects to the requirements of the law.[1] The Patent Office has no power to dispense with any of them, however unessential they may seem to be.[2] Its own authority, as well as the rights of

[2] That an assignment filed of record after the final fee is paid will be considered in the Patent Office, see *Ex parte* Paine (1878), 13 O. G. 408.

That assignees of two joint inventors become thereby the owners of a sole patent afterward granted to one of the joint inventors and may control the application, see Kohler *v.* Kohler (1888), 43 O. G. 247.

§ 451. [1] That all essential statutory prerequisites must be fulfilled or the patent will be void, see Eagleton Mfg. Co. *v.* West, Bradley, & Cary Mfg. Co. (1884), 111 U. S. 490; 27 O. G. 1237; Eagleton Mfg. Co. *v.* West, Bradley, & Cary Mfg. Co. (1880), 18 Blatch. 218; 2 Fed. Rep. 774; 17 O. G. 1504; Latta *v.* Shawk (1859), 1 Fisher, 465; 1 Bond, 259; Ransom *v.* Mayor of N. Y. (1856), 1 Fisher, 252; Child *v.* Adams (1854), 1 Fisher, 189; 3 Wall. Jr. 20.

See also § 423 and notes, *ante*.

[2] That the Patent Office has no power to dispense with such prerequisites though the courts may have sustained patents not possessing them, see Eagleton Mfg. Co. *v.* West, Bradley, &

applicants, rests upon the provisions of the statutes, and is validly exercised only when such provisions are obeyed.[3] But this rule is not pressed to an extreme against the interests of applicants. Where the applicant has in good faith complied with his own obligations under the direction of the Office, no error or neglect on its part can prejudice his rights.[4] Moreover, from the granting of the patent the courts presume that all formal requirements have been fulfilled, and do not suffer this presumption to be disputed, except in some proceeding directly instituted to repeal the patent.[5]

Cary Mfg. Co. (1883), 111 U. S. 490; 27 O. G. 1237; *Ex parte* Heginbotham (1875), 8 O. G. 237.

[3] In Moffitt *v.* Garr (1860), 1 Bond, 315, Leavitt, J.: (317) "It is an undoubted truth that an inventor has no legal rights or immunities under a patent, except such as are conferred by the statute. With whatever solemnity or observance of legal form it may have issued, if wanting in any substantial statutory requisite, it is a nullity. And such defect is always available as a defence in a suit for an infringement." 1 Fisher, 610 (612).

That a patent is invalid unless the substantial legal requirements are complied with, though the patentee is innocent of bad intent, see *Ex parte* Benton (1882), 23 O. G. 341.

[4] In Commissioner *v.* Whitely (1866), 4 Wall. 522, Swayne, J.: (532) "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."

That errors in the Patent Office, without the fault of the inventor, cannot affect his rights, see Bignall *v.* Harvey (1880), 18 O. G. 1275; 4 Fed. Rep. 334; 18 Blatch. 353; Sayles *v.* Chicago & Northwestern R. R. Co. (1865), 2 Fisher, 523; 1 Bissell, 468; Phelps *v.* Brown (1850), 1 Fisher, 479; 4 Blatch. 362; 18 How. Pr. 7; Sparkman *v.* Higgins (1846), 1 Blatch. 205.

That delays in the Patent Office, if not attributable to the negligence of the applicant, cannot affect his rights, see Jones *v.* Sewall (1873), 6 Fisher, 343; 3 Clifford, 563; 3 O. G. 630; Johnsen *v.* Fassman (1871), 1 Woods, 138; 5 Fisher, 471; 2 O. G. 94; Dental Vulcanite Co. *v.* Wetherbee (1866), 2 Clifford, 555; 3 Fisher, 87; Sayles *v.* Chicago & Northwestern R. R. Co. (1865), 1 Bissell, 468; 2 Fisher, 523; Adams *v.* Jones (1859), 1 Fisher, 527; Rich *v.* Lippincott (1853), 2 Fisher, 1.

That delays in the Patent Office, if acquiesced in by the applicant, may bar his rights, see Bevin *v.* East Hampton Bell Co. (1871), 5 Fisher, 23; 9 Blatch. 50.

[5] In Philadelphia & Trenton R. R. Co. *v.* Stimpson (1840), 14 Peters, 448, Story, J.: (458) "It is a presumption of law that all public officers, and especially such high functionaries, 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

§ 452. **Legal Requisites of Application.**

An application for a patent, as well as all communications with the Patent Office concerning it, must be in writing; and if not correctly, legibly, and clearly written the Commissioner may require them to be printed at the cost of the party filing them. The application must be in the English language and be addressed to the Commissioner, and must include a petition, an oath, and a specification or Description and Claim

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 re-examine 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." 2 Robb, 46 (63).

That the decision of the Commissioner on the sufficiency of the applicant's fulfilment of the formal prerequisites to a patent is final, see Hancock Inspirator Co. *v.* Jenks (1884), 21 Fed. Rep. 911; Hoe *v.* Cottrell (1880), 1 Fed. Rep. 597; 18 O. G. 59; 17 Blatch. 546; 5 Bann. & A. 256; De Florez *v.* Raynolds (1878), 14 Blatch. 505; 3 Bann. & A. 292; United States Rifle & Cartridge Co. *v.* Whitney Arms Co. (1877), 14 Blatch. 94; 11 O. G. 373; 2 Bann. & A. 493; Tarr *v.* Folsom (1874), 5 O. G. 92; Holmes, 312; 1 Bann. & A. 24; McMillin *v.* Barclay (1871), 5 Fisher, 189; 4 Brews. (Pa.) 275; Seymour *v.* Osborne (1870), 11 Wall. 516.

That the issue of a patent is *prima facie* evidence that all prerequisites are complied with, see Konold *v.* Klein (1878), 3 Bann. & A. 226; Gear *v.* Grosvenor (1873), 3 O. G. 380; 6 Fisher, 314; Holmes, 215; Dorsey Harvester Rake Co. *v.* Marsh (1873), 6 Fisher, 387; Crompton *v.* Belknap Mills (1860), 3 Fisher, 536.

That a patent need not recite that all its prerequisites have been fulfilled, see Gear *v.* Grosvenor (1873), Holmes, 215; 6 Fisher, 314; 3 O. G. 380.

That a patent can be attacked on the ground of formal defects in the application or its prerequisites only by a *scire facias*, a bill in equity, or an information to set aside the patent, see Hoe *v.* Cottrell (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256.

That judgments by the Patent Office are *prima facie* only, not conclusive, see Wilson *v.* Barnum (1849), 2 Fisher, 635; 1 Wall. Jr. 347; 2 Robb, 749.

That the Patent Office is not estopped to deny the validity of its own grant, see McKnight *v.* Van Wagenen (1876), 9 O. G. 1161.

of the art or instrument for which a patent is desired. In certain cases it must be accompanied by drawings and a model or specimen of the invention. No application can be accepted by the Office for examination until it is complete in all its parts;[1] and where it has been signed or sworn to in blank or without actual inspection of the petition and specification, or has been altered or partly filled up after being signed or sworn to, it will be stricken from the files if such irregularity is discovered before the patent is delivered.[2]

§ 453. The Application-Petition: its Requisites.

The petition is a communication addressed to the Commissioner and duly signed by the applicant, requesting the grant of letters-patent for the invention described in the application. It must state the name and residence of the petitioner, and in its designation of the invention must contain words of reference to the specification for a fuller disclosure thereof.[1] It should also set forth the person on whose behalf the application is made and to whom the patent is desired to issue; declaring whether it be to the applicant himself, or whether, in case of a previous assignment, it be to the assignee of an entire interest alone, or jointly to the assignee of a part interest and the applicant.

§ 454. The Application-Oath: By and Before Whom Made.

The oath of the applicant is one of the most important portions of his application.[1] Being in many cases conclusive as

§ 452. [1] That there can be no patent without an application, see Railway Register Mfg. Co. *v.* Broadway & Seventh Ave. R. R. Co. (1886), 26 Fed. Rep. 522; 34 O. G. 921; Eagleton Mfg. Co. *v.* West, Bradley, & Cary Mfg. Co. (1884), 111 U. S. 490; 27 O. G. 1237.

That an examiner should refuse to act unless there is a proper application before him on which to act, see *Ex parte* Benton (1882), 23 O. G. 341.

[2] That a blank application and oath signed and forwarded to Washington to be filled up does not comply with the law, and a patent granted thereon is invalid, see *Ex parte* Benton (1882), 23 O. G. 341.

That the applicant must sign his first name in full, see *Ex parte* Gentry (1888), 44 O. G. 822.

§ 453. [1] That the petition for a patent must so refer to the specification that the patent prayed for may be identified, see *Ex parte* Mason (1888), 43 O. G. 627.

§ 454. [1] In *Ex parte* Heginbotham (1875), 8 O. G. 237, Spear, Act. Com.: (237) "The oath is a prerequisite to the granting of a patent. It was so held by Judge Story in the very case

to the facts therein alleged, it must conform strictly to the requirements of the law.[2] It must be made by the inventor, if alive, or if he be dead, by his personal representative.[3] It can be taken before any person in 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 United States, or before any notary public, — the oath being in all cases attested by the official seal of the officer administering it.[4]

§ 455. The Application-Oath: its Averments.

This oath may be in the usual form of an oath, or in that of an affirmation. The applicant must swear that he does verily believe himself to be the original and first inventor of the art or instrument for which he desires a patent; that he does not know and does not believe that the same was ever before known or used; and that the invention has not been in public use nor on sale in the United States for more than two years preceding the date of the present application.[1] He must

in which he held the patent valid, notwithstanding the informality of the oath (Whittemore *v.* Cutter, 1 Gall.), and other courts have found the same; but, because the courts have sustained patents where some of the prerequisites to their granting have been ignored or dispensed with by the Office, it by no means follows, as contended by the present applicant, that it is a matter discretionary with the Commissioner."

That the oath is not a mere formality, but is necessary and gives *prima facie* validity to the patent, see *Ex parte* Eaton (1873), 4 O. G. 525.

That no patent can issue without the application-oath, see Opinion Atty. Gen. (1820), 1 Op. At. Gen. 332.

[2] That the oath, being often conclusive, must be made strictly according to law and before the proper officer, see Warnant *v.* Warnant (1880), 17 O. G. 265.

That the oath need not be dated, see French *v.* Rogers (1851), 1 Fisher, 133.

That the oath need not be in writing, see Hancock Inspirator Co. *v.* Jenks (1884), 21 Fed. Rep. 911.

[3] That the application-oath must be made by the applicant, not by his agent or attorney, see Opinion Atty. Gen. (1861), 10 Op. At. Gen. 137.

[4] That an oath in a foreign country to an application can be taken only before an officer designated under section 4892, there being no authority to take an oath except by statute, and the laws of a foreign country having no force as against the statute, see *Ex parte* Gruson (1884), 26 O. G. 274.

§ 455. [1] That the oath must aver that the invention has not been in public use or on sale in this country for more than two years before the application, see *Ex parte* Rowan (1882), 22 O. G. 1037; *Ex parte* Livingston (1881), 20 O. G. 1747.

Whether the phrase "with the consent and allowance" of the inventor

also aver his citizenship and place of residence, and disclose the names, numbers, and dates of any foreign patents he may have obtained for the same invention.[2] This oath relates to the entire specification, and must be true concerning each and every portion of it, but does not include the model, in the construction of which parts may become necessary of which he is not the first and original inventor.[3] It is also limited in its effect to the invention thus described, and with each amendment of the specification by which new matter is introduced as part of the original invention a new oath must be filed.[4]

§ 456. The Application-Oath: its Truth or Falsehood.

The averments of this oath concerning the originality of the invention relate only to the belief of the inventor, and the oath is not, therefore, a false one, nor the patent based thereon illegally obtained, though it be subsequently discovered that the invention has been previously known. But an oath wilfully false concerning the citizenship of the applicant, or any other matter made essential by the statutes, is a fraud

can properly be inserted in this averment must depend on the interpretation of the law of Abandonment as discussed in §§ 357, 358, and notes, *ante*.

That the oath must aver that the inventor does not believe that the invention was ever known or used before his inventive act, see *Ex parte* Rowan (1882), 22 O. G. 1037.

[2] That the applicant must disclose under oath all his foreign patents for the same invention, see *Ex parte* Mason (1888), 43 O. G. 627; Opinion Sec. Int. (1882), 21 O. G. 1197; *Ex parte* Bland (1879), 15 O. G. 828.

That the rule requiring disclosure of the date of foreign patents is reasonable, see U. S. *v.* Marble (1882), 22 O. G. 1365; and is authorized by Sec. 4887, Rev. Stat., see *Ex parte* Toufflin (1879), 15 O. G. 657.

That the disclosure of foreign patents must be definite and in the usual form, see *Ex parte* Mason (1888), 43 O. G. 627.

[3] That the oath applies to and covers the entire specification, see *Ex parte* Eaton (1873), 4 O. G. 525; Hogg *v.* Emerson (1848), 6 How. 437; 2 Robb, 655.

That the oath must cover every feature claimed, see *Ex parte* Clark (1886), 36 O. G. 120; *Ex parte* Foster (1885), 33 O. G. 113.

That the oath does not relate to the model, see *Ex parte* Eaton (1873), 4 O. G. 525.

That an oath on a joint application relates to the whole, not to separate parts of the invention, see Tieman, Simpson, & Collins (1877), 11 O. G. 1.

That an application-oath relates only to the claimed inventions, for which a patent is solicited, see *Ex parte* Crandall (1886), 35 O. G. 625; Drawbaugh *v.* Blake (1883), 23 O. G. 1221.

[4] For the form and other requisites of the amendment-oath, see § 561 and notes, *post*.

upon the government, and renders the patent void.[1] After the patent issues, however, the Patent Office has no jurisdiction over it, and cannot entertain the question whether the oath were true or false.[2]

§ 457. The Application-Oath: how far Conclusive.

The oath is in all cases *prima facie* evidence that the applicant is the first and true inventor, and in uncontested cases in the Patent Office is conclusive upon all the matters to which it relates. Where rival applications are filed, each containing the same oath made by its own applicant, the contradictory affidavits nullify each other, and the question is open to further proof without bias toward either party.[1] The averments of the oath concerning the grant of foreign patents for the same invention to the applicant add nothing to the force of the oath as evidence of the originality of his invention.[2]

§ 456. [1] That a false oath of citizenship is an irremediable defect and avoids the patent, see Child *v.* Adams (1854), 3 Wall. Jr. 20; 1 Fisher, 189.

[2] That after a patent has once issued the Patent Office cannot inquire whether the application-oath were true or false, see *Ex parte* Gillon (1877), 11 O. G. 419.

§ 457. [1] In Little *v.* Lillie (1876), 10 O. G. 543, Duell, Com.: (544) "When an application is made the party is required to make oath that he verily believes himself to be the first and original inventor; and this is received as evidence of the fact, and renders the patent, when granted, *prima facie* evidence that the patentee is the first and original inventor. (Philadelphia & Trenton Railroad *v.* Stimpson, 14 Pet. 456; Corning *v.* Burden, 15 How. 270; Parker *v.* Stiles, 5 McLean, 60.) When, however, a party claims an invention which is described and may be claimed by another applicant or patentee, the oath of one nullifies that of the other, and it becomes a matter for further proof as to which one is, in contemplation of law, the first and original *inventor*. It is for this purpose that an interference is declared, not to determine the patentability of the invention, but whether the party claiming it is the person designated by the statute as the originator of the invention. This distinction is observed throughout all the statutes on this subject."

See also Bartholomew *v.* Sawyer (1859), 1 Fisher, 516; 4 Blatch. 347.

[2] That the affidavit of an applicant concerning his foreign patents is only presumptive evidence that he is the real inventor, see *Ex parte* Nagel (1880), 17 O. G. 198.

That the oath of an applicant that another had obtained a patent in England for the *same* invention, as one communicated to him, is conclusive evidence that the applicant is the sole inventor until the contrary appears, see Von Alteneck *v.* Thomson (1880), 17 O. G. 571.

§ 458. The Application-Oath: Letters-Patent not Invalidated by its Omission.

Although the oath is one of the essential portions of the application, and cannot be dispensed with by the Patent Office, yet a patent granted without an oath is not on that account invalid.[1] The presumption that all things were rightly done in the department is sufficient to sustain it in all suits, except those which are instituted directly for its repeal.[2]

SECTION IV.

OF THE APPLICATION: ITS SUBJECT-MATTER.

§ 459. Subject-Matter of Application must be a Patentable Invention.

The subject-matter of the application for a patent must be a patentable invention. It must be a concrete art or instru-

§ 458. [1] In Crompton *v.* Belknap Mills (1869), 3 Fisher, 536, Clark, J.: (541) "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 Whittemore *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 verily believes he is the original and first inventor of the art, etc. If he takes 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 fee 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."

See also Hartshorn *v.* Eagle Shade Roller Co. (1883), 18 Fed. Rep. 90; 25 O. G. 1191; Dyer *v.* Rich (1840), 1 Met. 180; Whittemore *v.* Cutter (1813), 1 Gallison, 429; 1 Robb, 28.

[2] That an oath will be presumed from the grant of a patent, see Hoe *v.* Kahler (1885), 25 Fed. Rep. 271; 34 O. G. 127; affirming s. c. in 20 Blatch. 430; 12 Fed. Rep. 111.

That there is no presumption that the records of the Patent Office show all that was done, see Hoe *v.* Kahler (1885), 25 Fed. Rep. 271; 34 O. G.

ment, embodying an idea of means conceived by the creative faculties of the inventor, belonging to one of the six classes enumerated in the statutes, and being new, useful, and not already abandoned by the inventor to the public.[1] For nothing less than this can any valid patent be granted; and, of course, for nothing less can any application for a patent be entertained. These characteristics of a patentable invention have been sufficiently discussed, and therefore here demand only this passing reference. There are, however, a few additional provisions of the law, particularly relating to the scope of an application for a patent, which require our present notice. These may be grouped into: (1) Rules which compel an applicant to limit his application by the Claims of patents and he is further required to illustrate it by drawings. Patents are constantly issued for inventions the utility and completion of which are not shown otherwise than by the specifications and drawings, the cases being exceptional in which the applicant is required to present an operative model to demonstrate his discovery. Where an original discoverer has made a formal application for a patent in conformity with the requirements of the law, has furnished a description of the invention, which with the drawings and the model, if required by the Commissioner, is a sufficient disclosure to a person skilled in the art of the practical utility of an invention which in other respects is patentable, and has evinced by diligent prosecution of his application a faith in its importance, it is not necessary, to entitle him to be considered an inventor, that he shall prove actual reduction to practice. It is enough, if he has shown, in the manner prescribed in the law, that the invention is perfect and capable of useful operation."

That where the invention is obviously impracticable the application must be rejected, see *Ex parte* De Bausset (1888), 43 O. G. 1583.

127; affirming s. c. in 20 Blatch. 430; 12 Fed. Rep. 111.

That the recital in a patent that the oath was taken is conclusive until fraud is shown, though the patent issues on an amended application, see Hancock Inspirator Co. *v.* Jenks (1884), 21 Fed. Rep. 911; Seymour *v.* Osborne (1870), 11 Wall. 516.

§ 459. [1] In Starr *v.* Farmer (1883), 23 O. G. 2325, Teller, Sec.: (2327) "The question whether an invention has been perfected and is capable of useful operation has to be determined in the consideration of every application for a patent; for until a conception has been shown to be complete and capable of useful adaptation, requiring no further invention to make it practically operative, a patent therefor cannot be legally issued. To provide the means from which the Commissioner of Patents may decide upon the patentability in this respect of a discovery, the law prescribes that an applicant for a patent shall file a written description of the invention, and of the manner and process of making, constructing, 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 to construct and use the same;

that he has previously obtained; and (2) Rules which govern the joinder of separate inventions in a single application.

§ 460. Subject-Matter must not be an Invention already Patented in the United States by the same Inventor.

Two patents cannot be granted by the United States to the same inventor for the same invention. Its power to create a monopoly is exhausted by the first grant, and hence the later patent must be absolutely void.[1] That the application on which the later patent is based was of earlier date than that in pursuance of which the first patent issued is immaterial.[2] The government, having once conferred upon the inventor all it had to bestow in reference to that invention, cannot add to his exclusive privilege by a repetition of its granting act; and therefore, where the scope of both the earlier and the later patents is the same, the former is the only one by which the rights of the inventor are secured. And since no application for a patent can be proper where the patent, if allowed, would be invalid, an application for a patent for any invention covered by a previous patent to the same inventor is prohibited.

§ 461. Subject-Matter may be an Invention already Patented in the United States by a Rival Inventor, or in a Foreign Country by the same Inventor.

This rule applies, however, only where the same inventor seeks an additional patent from the United States. The later

§ 460. [1] That there cannot be two concurrent American patents to the same inventor for the same invention, and that where two such patents are issued the last is void, see McMillin *v.* Rees (1880), 1 Fed. Rep. 722; 17 O. G. 1222; 5 Bann. & A. 269; *Ex parte* Locke (1879), 16 O. G. 1140; *Ex parte* Langlois (1878), 14 O. G. 84; *Ex parte* Cottrell (1876), 9 O. G. 495; Jones *v.* Sewall (1873), 3 O. G. 630; 3 Clifford, 563; 6 Fisher, 343; Suffolk Co. *v.* Hayden (1865), 3 Wall. 315; Treadwell *v.* Bladen (1827), 4 Wash. 703; 1 Robb, 531; Morris *v.* Huntington (1824), 1 Paine, 348; 1 Robb, 448; Odiorne *v.* Amesbury Nail Factory (1819), 2 Mason, 28; 1 Robb, 300; Barrett *v.* Hall (1818), 1 Mason, 447; 1 Robb, 207.

[2] That a later patent to the same inventor is void, though its application were earliest, see McMillin *v.* Rees (1880), 1 Fed. Rep. 722; 17 O. G. 1222; 5 Bann. & A. 269.

application of a rival inventor assumes that no monopoly has been created in favor of his adversary by the former patent, that patent being invalid because granted to one who was not, as the law requires, the original and first inventor.[1] The application of the same inventor for a re-issue of his former patent, so amended as to protect his actual invention, is merely an endeavor to secure in express terms the privilege which the government has already ambiguously bestowed.[2] And where the same inventor who has obtained a patent from a foreign state subsequently makes an application for a patent in the United States, the monopoly he seeks is one essentially distinct in territorial limits from that which he has previously received, and therefore one which may yet be conferred upon him by the government within whose gift it still resides.[3] It is when the granting of a patent on the present application would be the mere empty repetition of the granting act, as distinguished from the clearer definition of a monopoly already in existence, and from the creation of a new monopoly either in favor of the same inventor or his rival, that the application is improper and must on that account be refused.

§ 461. [1] That a patent issued to a rival inventor is no bar to a later one to the true inventor, see Hibbard *v.* Richmond (1880), 17 O. G. 1155.

That where two patents to different inventors cover the same general invention the later will, if possible, be construed to claim only the new matter appearing therein, see Richardson *v.* Noyes (1876), 10 O. G. 507.

[2] That upon the surrender of a former defective patent a later one may be granted and be valid, see Jones *v.* Sewall (1873), 3 O. G. 630 ; 3 Clifford, 563 ; 6 Fisher, 343.

[3] That a prior foreign patent does not invalidate though it limits the term of a subsequent American patent, see Dolbear *v.* American Bell Telephone Co. (1888), 126 U. S. 1 ; 43 O. G. 377.

That a prior foreign patent does not prevent the issue of a broader American patent, see Faure *v.* Bradley (1888), 44 O. G. 945.

That the grant of surreptitious foreign patents to others cannot affect the rights of the real inventor in the United States, see Kendrick *v.* Emmons (1875), 2 Bann. & A. 208 ; 9 O. G. 201.

That under section 8, act of 1836, no American patent could be granted if the foreign patent issued more than six months before, see Cornely *v.* Marckwald (1883), 17 Fed. Rep. 83.

That a foreign patentee seeking an American patent is not compelled to adhere to the precise subject-matter of his foreign patent, see *Ex parte* Siemens (1877), 11 O. G. 969.

§ 462. Subject-Matter must not Include Inventions already Patented in the United States by the same Inventor.

An application which, together with new matter, includes matter already patented in the United States by the same inventor is within this rule, as well as one whose scope corresponds exactly with that of the preceding patent.[1] An inventor who devises an improvement to his own patented invention cannot apply for and obtain a patent for the whole invention as improved, but only for the *new* development of his original idea.[2] The inventor of a combination, the elements of which are already protected by his previous patents, cannot obtain additional protection for those elements by claiming them in his application for a patent for the combination. In both these instances, as in all similar ones, it may be necessary to the comprehension by the public of his last invention that the former should be fully described in the new application, but the application itself must so distinguish the earlier invention from the later that it shall clearly appear to be an application for a patent only for the last invention.

§ 463. Subject-Matter may be a New Use of an Invention already Patented in the United States by the same Inventor.

An application for a patent for a previously patented invention by the same inventor, on the ground that new uses for it have been discovered since the issue of the former patent, is also forbidden by this rule.[1] All uses to which an invention can be put, whether by its inventor or by others, without an additional exercise of inventive skill, are covered by the original patent for that invention, even although such uses were unknown when the patent issued; and hence another patent, based upon such uses, would be a simple duplication

§ 462. [1] That no patent with generic Claims can be granted after one with a Claim for the species, see *Ex parte* Upton (1884), 27 O. G. 99; *Ex parte* Holt (1884), 29 O. G. 171.

[2] That an inventor may patent an improvement on his own invention, see O'Reilly *v.* Morse (1853), 15 How. 62.

§ 463. [1] That a second patent cannot issue for the same invention though used for separate purposes, see McComb *v.* Brodie (1872), 5 Fisher, 384; 2 O. G. 117; 1 Woods, 153.

See also §§ 259–271 and notes, *ante*.

of the grant. Where a new use for the invention is discovered by the exercise of the inventive faculties of the same or other inventors, the new use is itself a new invention, and if possessing all the other statutory requisites, it may be patented as a new art or combination in which the old invention is employed as an instrument, or as an elemental means; but it adds nothing to the patentable character of the original invention, nor does it constitute any ground for the protection of that invention in another patent. Here, also, the application for a patent for the new art or combination may have occasion to describe the former invention in order to convey an adequate idea of the new use which is to be the subject of the future patent; but the distinction between the old invention and the new must be apparent on the face of the application, and a patent for the latter only must be claimed.

§ 464. Subject-Matter must not be an Invention already Patented in the United States by the same Inventor, although his Former Patent is Inoperative and Invalid.

An application for a new patent by the same inventor where his previous patent, although not covering his entire invention, is capable of being re-issued so as to afford it a complete protection, is within this rule. An important difference must be here remembered between an invention as it appears upon the face of a patent and as it exists practically in the arts. Some concrete inventions are simple units, the result of a single inventive act, not separable into distinct patentable parts, and any patent for such an invention must either protect the whole product of the inventor's skill or fail to protect anything whatever. Other concrete inventions consist of parts, each of which is an independent invention and separately patentable; and a patent for the entire invention may be valid and sufficient although its inventor makes no attempt to protect therein the individual inventions of which it is composed. Only a patent for an invention of the former class can properly be brought within this rule. A patent for a simple unitary invention, if properly expressed, protects everything that the inventor has invented, and any failure to secure to

him the entire monopoly to which he is entitled can be cured by a correction of its verbal ambiguities. It is an act of the government bestowing a particular exclusive privilege, and although the limits of that privilege may be uncertain on account of some defect in the language by which it is described, the grant is an effectual one, and cannot be repeated however it may need to be defined.[1] Hence an amendment of the patent by re-issue is not only a sufficient remedy for the inventor, but it is all the remedy to which, in accordance with the theories that underlie the Patent Law, he is entitled.

§ 465. Subject-Matter may be an Integral Part, or a Combination, of other Inventions already Patented in the United States by the same Inventor.

On the other hand, where a concrete invention is composed of parts each of which is the result of a separate inventive act, it is optional with the inventor either to protect all these inventions by a single patent or to apply for and obtain different patents for the several subordinate inventions. If in his first application for a patent he endeavors to secure protection for all, and if in his first patent the government evidently confers upon him a monopoly as to all, however imperfectly the grant of the monopoly may be expressed, no new application for a patent for any of them can be entertained; and the inventor must avail himself of his right to a re-issue, or remain without remedy.[1] But if the inventor has attempted in his former application only to procure a patent for the concrete invention as a whole, or for some one or more of its several

§ 464. [1] In *Ex parte* Roberts (1887), 40 O. G. 573, Hall, Com.: (574) "Where the invention is one, integral, and indivisible, whether it relates to different parts of a single organization or combination, or process and product, or genus and species, a prior patent which claims or covers part of the whole invention, in legal contemplation takes the whole invention out of the field of patentability, whether the subsequent applicant be the original patentee or some other person."

Further, that a new patent cannot cover matter inseparably involved in the matter claimed in a former patent, see Railway Register Mfg. Co. *v.* Broadway & Seventh Ave. R. R. Co. (1886), 26 Fed. Rep. 522; 34 O. G. 921; *Ex parte* Holt (1884), 29 O. G. 171; *Ex parte* Ransom (1884), 39 O. G. 119.

§ 465. [1] That a patent for parts of a previously patented invention is void if the prior patent attempted to claim such parts, see Stow *v.* Chicago (1877), 3 Bann. & A. 83; 8 Bissell, 47.

parts, the monopoly which he has received is limited to those results of his inventive skill, and all other results are still proper subjects for new applications and new patents, unless he has meanwhile abandoned them to the public.[2] That in his former patent he described those other inventions as elements of the one then patented, or as associated with it in that concrete invention in which all unite, cannot affect his right to base on them new applications and new patents.[3]

[2] That a combination and its elements are distinct inventions, and a patent for the former does not cover the latter, see Rowell v. Lindsay (1885), 113 U. S. 97; 31 O. G. 120; Corn Planter Patent (1874), 23 Wall. 181; 6 O. G. 302.

That unless abandoned by two years' public use and sale a sub-combination may be covered by a later patent, see Cahn v. Wong Town On (1884), 9 Sawyer, 630; 19 Fed. Rep. 424; 27 O. G. 299.

That separate parts of the same invention may be separately patented, see Jones v. Sewall (1873), 3 Clifford, 568; 6 Fisher, 343; 3 O. G. 630.

[3] It has been sometimes held that no new patent could be granted for an invention described but not claimed in a former patent, and that the only mode of bringing such unclaimed inventions within the protection of the law is by a re-issue of the former patent. Thus in Mathews v. Flower (1885), 25 Fed. Rep. 830, Brown, J.: (830) "If it were true that complainants had previously obtained a patent for the same invention secured to them by the patent in suit, and that this prior patent had expired, it would doubtless be a complete answer to this bill, since a man cannot have two patents for the same invention. James v. Campbell, 104 U. S. 356; Suffolk Co. v. Hayden, 3 Wall. 315; Morris v. Huntington, 1 Paine, 348. And this disability extends, not only to what is *claimed* in the first patent, but to that which is *described* therein as the patentee's invention. If a man cannot have a patent for what another has claimed or described in a prior patent, much less can he have one for what he himself has claimed or described; for he thus shows that he has anticipated himself. James v. Campbell, 104 U. S. 356, 382." 33 O. G. 887 (887).

In *Ex parte* Long (1883), 25 O. G. 1189, Marble, Com.: (1190) "An applicant is entitled to fully describe, show, and claim his invention; but having shown and described it in a patent he has no right to thereafter file an application and obtain a patent for subject-matter shown and described in such patent. If he have any remedy in such case it is by re-issuing his patent. In *Ex parte* Atwood (C. D., 1869, p. 98), Mr. Commissioner Fisher said: 'When an application is filed every invention contained in that application must be patented under it or under such division of it as the wishes of the applicant and the rules of the Office may permit.' Since said decision the practice of the Office has been uniform in requiring an applicant, if he desires to obtain a patent for subject-matter shown and described in his application, but not properly patentable therein, to file another application for such matter during the pendency of the former application. This practice has been sustained by the courts, and none other seems to have been adopted or insisted

Being entitled under the law to a monopoly for each invention, he cannot be precluded from receiving it by anything

upon until the present time. An applicant has the right to file his appliation and claim so much of his invention as he wishes or sees fit; but he has no right to reserve a portion of it, and thereafter claim such reserved portion, and thus, in fact, extend the life of his patent. If this could be done, the actual term of a patent would not be seventeen years, but a longer term. A party cannot prevent abandonment by simply stating that he does not abandon a certain invention. Abandonment is always a question of fact. Parties are presumed to intend what they do, and if they expressly reserve, or by oversight or negligence fail to claim, subject-matter shown and described in a patent, the presumption is that they intend to abandon it, especially if they do not file an application therefor prior to the issuance of the patent wherein it is shown and described."

See also Swift *v.* Jenks (1887), 29 Fed Rep. 642; 38 O. G. 1017; Hill *v.* Commissioner (1885), 4 Mackay, 266; 33 O. G. 757; *Ex parte* Derby (1884), 26 O. G. 1208; *Ex parte* Hill (1883), 24 O. G. 1176; Marvin *v.* Lillie (1867), 27 O. G. 299.

These cases, except the last, base their assertions upon a hasty and mistaken interpretation of Campbell *v.* James (1882), 104 U. S. 356; 21 O. G. 337. The passage usually quoted in support of this position does at first blush, perhaps, appear to sustain it. But more careful scrutiny would have shown that the learned Justice employed the words "embraced or described" as synonymous with "patented" and "claimed;" and would further have disclosed the following statement on page 370 (104 U, S.), which places the whole doctrine in its proper light: "If he was the author of any other invention than that which he specifically describes and claims, though he might have asked to have it patented at the same time and in the same patent, yet if he has not done so, and afterward desires to secure it, he is bound to make a new and distinct application for that purpose and make it the subject of a new and different patent." That this is the true construction of this entire decision, see Vermont Farm Machine Co. *v.* Marble (1884), 27 O. G. 621; 22 Blatch. 32; 19 Fed. Rep. 307.

But apart from authority this doctrine is manifestly incorrect in principle, as well as inapplicable in practice. For were it true, every intentional omission to claim any invention which the application had described would operate as an abandonment of the invention to the public, since no intentional omission can be cured by a re-issue; and thus an applicant would be compelled to claim every invention which a proper delineation of his principal invention required him to disclose, whatever violations of the rules of joinder he might thus commit, or however premature the submission of the invention to the public as a practically operative means might be. To avoid this dilemma, a qualification has been introduced into the doctrine, permitting a subsequent patent for inventions described but not claimed in the former patent, provided a reservation of the right to apply for and obtain the subsequent patent were inserted in the former, and the later application were filed within a reasonable time after the issue of the prior patent. This modification of the doctrine is discussed and sustained in *Ex parte* Roberts (1887), 40 O. G. 573, by Hall, Com.: (573) "It is undoubtedly true that when a patent issues for an invention, all of which is shown but only part of which is claimed,

short of its bestowal on him by the government, or by his abandonment of the invention to the public; and until one or

there is a dedication to the public of that part which is unclaimed. In such case the law conclusively infers an intention to make the dedication, and the inference cannot be overcome by evidence; the applicant, however, always has it in his power, in a certain class of cases, to prevent this inference from arising if he acts in time. In cases which are divisional, — that is, when, as in the present case, the features not claimed in the first application are independent of those claimed, — an applicant may expressly assert in his application a reservation of his right to claim them in another or subsequent application, and he should present and prosecute such application without delay. He may also file his second application so as to have it pending concurrently with the first. Such course anticipates and prevents the inference of dedication. This proposition is fully sustained by many authorities."

See also Adams *v.* Bellaire Stamping Co. (1886), 28 Fed. Rep. 360; 36 O. G. 567; *Ex parte* Derby (1884), 26 O. G. 1208; *Ex parte* Rohn (1883), 25 O. G. 1190.

But even with this qualification the doctrine is not in harmony with the general spirit and theory of the Patent Law, nor with the requirements of inventors and the public. The general theory of the Patent Law contemplates every invention as a separate entity, wholly independent of every other invention, and entitled to a distinct monopoly if it possesses the necessary attributes of a patentable invention. That in the application for a patent for a different invention it may become expedient to describe this also cannot affect its patentable character, nor does it raise a conclusive presumption of abandonment. If such description is followed by a two years' public use or sale, or is coupled with any other circumstances indicating a dedication of the invention to the public, the right to a monopoly will be lost; but this loss is not occasioned by the previous description of the invention in the former patent, nor by the failure to reserve the invention for a future patent, these being but single links in the chain of facts from which an intention to abandon is inferred. Moreover it is to the advantage both of the inventor and the public that he should be entirely free to patent his inventions separately and in such order as his inventive prudence may suggest, since on the whole it is far more probable that he will bestow the invention on the public as soon as it is ripe for beneficial use, than that after disclosing it in the description of a former patent he should withhold it after it becomes available for their employment and his own profit. Thus as no evil can result to the community by the application to his described but not claimed inventions of the same rule of reasonable diligence which governs cases of re-issue and other cases arising under the common doctrine of abandonment, the consistency of the law would seem to require that matter described but not claimed in a former patent may be the subject of a later patent unless it has been in some manner already dedicated to the public. This is the position maintained in Vulcanite Paving Co. *v.* American Artificial Stone Paving Co. (1887), 42 O. G. 828; Wilson *v.* Cubley (1886), 26 Fed. Rep. 156; 35 O. G. 257; *Ex parte* Holt (1884), 29 O. G. 171; Vermont Farm Machine Co. *v.* Marble (1884), 19 Fed. Rep. 307; 27 O. G. 621; 22 Blatch. 32; Graham *v.* McCormick (1880), 11 Fed. Rep. 859; 21 O. G. 1533; 10 Bissell, 39; 5 Bann.

the other of these events has taken place his application must be entertained and his claim for an exclusive privilege be

& A. 214; Graham *v.* Geneva Lake Crawford Mfg. Co. (1880), 11 Fed. Rep. 138; 21 O. G. 1536.

In *Ex parte* Holt (1884), 29 O. G. 171, are discussed three classes of cases: —

1. Those holding that no patent can issue for an invention actually covered by a former patent though the terms of their Claims may differ, viz., Sickels *v.* Falls Co., 4 Blatch. 508; O'Reilly *v.* Morse, 15 How. 62; Odiorne *v.* Amesbury Nail Factory, 1 Robb, 300; Smith *v.* Ely, 5 McLean, 76.

2. Those where the second patent contained a broad or generic Claim covering the more specific matter protected by the former patent, viz.: Jones *v.* Sewall, 3 Clifford, 575; James *v.* Campbell, 104 U. S. 356; 21 O. G. 337; McKay *v.* Jackman, 22 O. G. 85, overruling McKay *v.* Dibert, 19 O. G. 1351; *Ex parte* Atwood, C. D. 1869, 98; *Ex parte* Lowe, C. D. 1870, 89; *Ex parte* Hyde, C. D. 1871, 109.

3. Those where the new patent covers matter described in the prior patent but essentially distinct and separable from anything claimed therein. Concerning the latter cases, Dyrenforth, Act. Com., says: (177) "It has, it is true, been held that a person can independently patent that which has been shown and described but not claimed in a previous patent upon a concurrent application. Authorities upon this subject are, The Suffolk Co. *v.* Hayden (3 Wall. 315); Singer & Clark *v.* Braunsdorf and Weil (7 Blatch. 521); McMillen *et al. v.* Reese *et al.* (17 O. G. 1222); Graham *v.* McCormick *et al.* (11 Fed. Rep. 859); Hatch *v.* Moffit (15 Fed. Rep. 252); *Ex parte* Emerson (17 O. G. 1451); *Ex parte* Derby (26 O. G. 1208). These cases, however, are easily distinguishable from the case of James *v.* Campbell and that here involved. In all of them that which was independently patented was either a distinct and separate part of the invention or a distinct improvement thereon. It was not substantially the same thing comprehended in the first patent. There was not a mere distinction of breadth or scope of Claim. The remedy where a broad Claim is omitted is pointed out in the Derby case, *supra.*"

In the first and second of these classes the later patent, so far as it covers the matter protected by the former patent, must be absolutely void; and if the new matter is inseparable from that already patented, the whole grant must fail. In such cases no reservation in the former patent can aid the inventor, but as Dyrenforth, Act. Com., in the same decision remarks: (177) "It is clear that if the law prohibits a separate patent for anything but a distinct and separate part of the thing invented, the applicant may not evade the prohibition by reserving the broad claims by a statement in his specific patent; he cannot reserve that which the law forbids him to reserve."

That reservation clauses tend to mislead the public and should not be allowed in applications, see *Ex parte* Blair (1888), 43 O. G. 113.

That where the subject-matter is properly divisible the inventor may file his separate applications at any time without any reservation clause, and each will be judged on its own merits, see *Ex parte* Blair (1888), 43 O. G. 113.

That where the subject-matter is not divisible the second application must be filed while the first is pending, that both may be adjudged together, see *Ex parte* Blair (1888), 43 O. G. 113.

That where one application fully dis-

recognized. To compel him in such cases to have recourse to a re-issue would not only be contrary to the fundamental ideas on which the doctrine of re-issue rests, but would deprive him of a greater or less portion of that term for which the law provides that his monopoly shall endure.

§ 466. Subject-Matter may be an Invention Dependent on or Collateral to an Invention already Patented in the United States by the same Inventor.

Again, this rule does not apply to cases where the same inventive act produces two concrete results, each of which is a separate patentable invention. A single exercise of the inventive faculties may produce both a process and its product, a machine and the manufacture it creates, a composition of matter and the art by which it is applied to its intended use. In all such cases, if the inventions are truly separable, the inventor is entitled to a monopoly for each, although neither could have been discovered and been made available without the other.[1] A patent for but one, though it may necessarily

closes the invention claimed in the other, cross-references should be inserted in each to distinguish one from the other, see *Ex parte* Blair (1888), 43 O. G. 113.

That a description in a prior patent without a Claim of the invention is not a bar to a subsequent patent, if the second application is made within two years, see Eastern Paper Bag Co. *v.* Standard Paper Bag Co. (1887), 41 O. G. 231; 30 Fed. Rep. 63.

See also § 352 and notes, *ante*, and § 506 and notes, *post*. The doctrine stated in §§ 687–692 and notes, *post*, in reference to re-issues is equally applicable to the present subject, since any patentable matter which could be inserted in a re-issue may, if constituting a complete invention in itself, be protected by a separate patent.

§ 466. [1] That a process and its product may be separately patented, see *Ex parte* Lupton (1874), 5 O. G. 489; Jones *v.* Sewall (1873), 3 Clifford, 563; 3 O. G. 630; 6 Fisher, 343; Brass Co. *v.* Miller (1871), 5 Fisher, 48; 9 Blatch. 77; Goodyear *v.* Providence Rubber Co. (1864), 2 Clifford, 351; 2 Fisher, 499.

That no patent can be granted for the product after one for the process from which that product necessarily results, the second patent being in effect a duplication of the first, see *Ex parte* Holt (1884), 29 O. G. 171.

That a patent having issued for a product as made by a certain process, a later patent cannot be granted for the process which results in the product, see Mosler Safe & Lock Co. *v.* Mosler (1888), 127 U. S. 354; 43 O. G. 1115.

That a machine and its product may be separately patented, see *Ex parte* Lupton (1874), 5 O. G. 489; Brass Co. *v.* Miller (1871), 5 Fisher, 48; 9 Blatch. 77.

That where a patent has been granted

describe the other, is thus no hindrance to an application for a patent for the unsecured invention; but the new application must be judged according to its own intrinsic merits, as if no previous patent had been granted.[2]

§ 467. Subject-Matter must not be an Invention already Claimed in a Pending Application by the same Inventor.

The rules which in this manner limit the scope of applications by the monopolies previously granted to the same inventor define the relations which two or more applications by the same person must sustain toward each other. As two patents cannot be granted to the same inventor for the same invention, so two applications attempting to secure patents for the same patentable subject-matter are equally objectionable. An inventor, having prepared and filed an application for a patent, cannot file another application for the same concrete invention, except as an amendment to the former, unless he first withdraws from the earlier the matter which he wishes to incorporate into the later.[1] This, for some purposes to be

for a machine which produces a certain article, a subsequent patent cannot be granted for the article, though it might have been covered by the machine-patent, see Excelsior Needle Co. *v.* Union Needle Co. (1885), 32 Fed. Rep. 221.

That a second patent for a special application of the force to the object named in a rejected Claim of the former application is valid, see *O'Reilly v.* Morse (1853), 15 How. 62.

[2] That the description of a process in an application for a patent for the apparatus does not prevent a patent for the process, if applied for within two years, see Eastern Paper Bag Co. *v.* Standard Paper Bag Co. (1887), 41 O. G. 231; 30 Fed. Rep. 63.

§ 467. [1] That an inventor cannot file a second application, after the patent is ready to issue on the first, for a device rejected on the prior application, but must re-issue the first patent and claim it there, see *Ex parte* Arkell (1877), 11 O. G. 1111.

That where two applications describe the same invention and the later one does not claim it, a patent not covering it may issue on the later application, and a patent covering it on the earlier application, see *Ex parte* Emerson (1879), 16 O. G. 1232.

That an applicant cannot claim matter covered by the Claim of a previous application, see *Ex parte* Holt (1884), 29 O. G. 171.

That after an application has passed to issue no other one covering the same matter should be passed, see *Ex parte* Gaboury (1886), 37 O. G. 217.

That a second application will not be rejected merely because a prior one by the same applicant is still pending, see *Ex parte* Gaboury (1886), 37 O. G. 217.

That matter described and not claimed in one application can be claimed in a second application filed pending the prior one, but not if the whole patentable matter is indivisible, see *Ex parte* Holt (1884), 29 O. G. 171.

hereafter stated, he is allowed to do; but in such cases each of his applications must clearly show, by proper allegations of disclaimer, that the limits of the monopoly for which it prays do not include any part of the subject-matter of the others.[2]

§ 468. Joinder of Inventions not Consistent with the Nature of the Patent Privilege: but nevertheless Permitted.

The joinder of several inventions in a single application is not altogether consistent with the principles or the policy of Patent Law, however nearly related to each other such inventions may be. A right to the exclusive use of one invention is entirely distinct from a right to the exclusive use of any other, and the monopolies created in favor of an inventor must therefore always be as numerous as the inventions upon which they are based. That several monopolies can be created by one granting act, and can be witnessed by one instrument of grant, is undeniable; but the symmetry of the law and the avoidance of unnecessary confusion would require that each invention be protected by a separate patent, in which the limits of the single monopoly conferred thereby might be clearly and perpetually defined. A contrary practice, however, has arisen, and out of consideration for its convenience and its economy to applicants has been sanctioned by the Patent Office and the courts.

§ 469. Joinder of Inventions Differently Viewed in the Courts and in the Patent Office.

The rules by which the limitations of this practice are declared, and the evils naturally flowing from it are as far as possible avoided, are not in all respects the same in the

[2] That where two applications describe, and one of them claims an invention, the one not claiming must disclaim it, and refer to the other by its date and number, see *Ex parte* Blair (1888), 43 O. G. 113; *Ex parte* Finch (1883), 26 O. G. 273.

That the rules requiring cross-disclaimers in two pending applications for the same general invention are strictly enforced, see Drawbaugh *v.* Blake (1883), 23 O. G. 1221.

That the rule requiring disclaimers where two pending applications describe but only one claims an invention is merely directory, and the issue of the first patent is no bar to the second, unless the subject-matter is one, integral, and indivisible, see *Ex parte* Roberts (1887), 40 O. G. 572.

Patent Office as in the courts.[1] The practice was adopted before the re-organization of the patent system in 1836, and when the only questions involved in it, of importance to the public, related to the intelligibility of the specification and the amount of fees received for patents by the government. In their disposition to encourage inventors by every means that the language of the statutes would permit, the courts sustained patents covering several different inventions, and laid down rules for their own guidance in the matter which there has been no later judicial occasion to disturb. But when the present method of examining the novelty and utility of an invention before the issue of a patent was inaugurated, the liberality shown by the courts toward this practice was found to be irreconcilable with the proper fulfilment of its duties by the Patent Office; and as these duties have increased, and a greater subdivision of its operations has from time to time become essential, the introduction of more rigid rules has been inevitable, in order that the work of examining an application might not have to be repeated in several different divisions of the department, and that after the patent issued the specifications and drawings might be placed for future reference in some specific group of inventions, without unnecessary reduplication.[2] To present a complete view of this subject a

§ 469. [1] In *Ex parte* Bancroft (1881), 20 O. G. 1893, Marble, Com. : (1894) "I am aware that the courts have sustained patents where two inventions embraced therein were made to accomplish the same end and purpose. See Wyeth *et al. v.* Stone *et al.*, 1 Story, 273. Also, patents containing an invention which might be applied in different ways. See Hogg *et al. v.* Emerson, and cases cited, 6 How. 437. It is also true that the courts have sometimes sustained patents which ought never to have been granted, in order to protect the rights of parties. My attention has been called to the fact that patents have been issued for a process and product, a machine, process, and product, and a machine and product; and, as I think, in many cases improperly. The fact that the courts will sustain patents in order to protect the rights of parties, or that patents have been improperly issued, furnishes no rule of action for this Office."

[2] That joinder does not follow the same rules in the courts as in the Patent Office, and the former will rarely declare a patent void for misjoinder, though the necessities of the Patent Office may often require separation, see *Ex parte* Herr (1887), 41 O. G. 463.

That it is for the Patent Office to determine whether a joinder shall be allowed, see *Ex parte* Sartell (1888), 42 O. G. 295; Sessions *v.* Romadka (1884), 21 Fed. Rep. 124; 28 O. G. 721; McKay *v.* Dibert (1881), 19 O. G. 1351;

statement of the rules as they appear in the judgments of the courts and in the decisions of the Patent Office must be made, both generally and in their application to particular classes of inventions.

§ 470. Joinder of Inventions: Rule in the Courts.

The general rule adopted by the courts and sanctioned by the uniform current of decisions permits the joinder of several inventions in one patent where the inventions are kindred and auxiliary, — that is, where they are capable of being used in connection with each other to serve a common end.[1] It is

5 Fed. Rep. 587; *Ex parte* Möller (1879), 16 O. G. 358; Bennet *v.* Fowler (1869), 8 Wall. 445.

That doubt as to joinder is resolved in favor of the applicant, see *Ex parte* Herr (1887), 41 O. G. 463.

That the question of joinder must be determined to some extent by the Office classification, but not by the matter of fees, see *Ex parte* Mefford (1883), 25 O. G. 881.

That the arts are necessarily classified as the statute recites them and subordinate classes are constantly arising as the arts advance, which the Patent Office must distinguish, see *Ex parte* Herr (1887), 41 O. G. 463.

That the classification referred to in *Ex parte* Herr was not based on mere Office divisions but on the distinctions recognized in the arts as actually subsisting between inventions, see *Ex parte* Sartell (1888), 42 O. G. 205.

That inventions of different statutory classes cannot be joined, unless inseparable, see *Ex parte* Herr (1887), 41 O. G. 463; *Ex parte* Blythe (1884), 30 O. G. 1321.

That dependent inventions may be joined though the Office classification must give way, see *Ex parte* Mefford (1883), 25 O. G. 881.

That no inflexible rule of joinder is possible, see *Ex parte* Young (1885), 33 O. G. 1390.

§ 470. [1] In Densmore *v.* Schofield (1868), 4 Fisher, 148, Swayne, J.: (154) "Now, undoubtedly, independent things, separable and separate things, where any combination arises, provided they be cognate, relate to the same invention, and have relation to the same subject, the same object to be accomplished, — undoubtedly these separate claims can be made in the same patent. If they have no such tie of connection as I have mentioned, if they are for separate and entirely different things, then the patent would be void, because it attempted to unite what cannot be united; but if they be connected by a common tie, a common object or purpose, then undoubtedly these different claims can be united in one and the same patent."

In Hogg *v.* Emerson (1850), 11 How. 587, Woodbury, J.: (606) "It is well settled . . . that a patent for more than one invention is not void if they are connected in their design and operation."

In Wyeth *v.* Stone (1840), 1 Story, 273, Story, J.: (287) "But it has been said that if each of the machines patented is independent of the other, then separate patents should have been taken out for each; and that they cannot both be joined in one and the same patent; and so there is a fatal defect in the plaintiff's title. And for this position

not necessary that this common and connected use should be the sole use to which any of these inventions can be applied,

the doctrine stated in Barrett *v.* Hall (1 Mason R. 473), and Evans *v.* Eaton (3 Wheat. R. 454, 506), is relied on. I agree that, under the general patent acts, if two machines are patented which are wholly independent of each other, and distinct inventions for unconnected objects, then the objection will lie in its full force, and be fatal. The same rule would apply to a patent for several distinct improvements upon different machines, having no common object or connected operation. For, if different inventions might be joined in the same patent for entirely different purposes and objects, the patentee would be at liberty to join as many as he might choose, at his own mere pleasure, in one patent, which seems to be inconsistent with the language of the patent acts, which speak of the thing patented, and not of the things patented, and of a patent for an invention, and not of a patent for inventions; and they direct a specific sum to be paid for each patent. Besides, there would arise great difficulty in applying the doctrines of the common law to such cases. Suppose one or more of the supposed inventions was not new, would the patent at the common law be void *in toto*, or only as to that invention, and good for the rest? Take the case of a patent for ten different machines, each applicable to an entirely different object, — one to saw wood, another to spin cotton, another to print goods, another to make paper, and so on; if any one of these machines were not the invention of the patentee, or were in public use, or were dedicated to the public before the patent was granted, upon the doctrines of the common law the patent would be broader than the invention, and then the consideration therefor would fail, and the patent be void for the whole. But if such distinct inventions could be lawfully united in one patent, the doctrine would lead to consequences most perilous and injurious to the patentee; for, if any one of them were known before, or the patent as to one was void, by innocent mistake or by priority of invention, that would take away from him the title to all the others, which were unquestionably his own exclusive inventions. On the other hand, if the doctrine were relaxed, great inconvenience and even confusion might arise to the public, not only from the difficulty of distinguishing between the different inventions stated in the patent and specification, but also of guarding themselves against fraud and imposition by the patentee, in including doubtful claims under cover of others which were entirely well founded. In construing statutes upon such a subject, these considerations are entitled to no small weight. At least, they show that there is no ground, founded in public policy or in private right, which calls for any expanded meaning of the very words of the statute; and that to construe them literally is to construe them wisely. It is plain, also, that the act of 1837, ch. 45, in the ninth section, contemplated the rule of the common law as being then in full force; and, therefore, it seeks to mitigate it, and provides, 'that whenever, by mistake, accident, or inadvertence, and without any intent to defraud or mislead the public, any 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 invented' (not of different things invented) 'of which he was not the first and original inventor, and shall have no legal or just right to claim the same, in every such case the patent shall be good and valid for so much of the invention or dis-

nor that it be their ordinary use, nor even that they should ever have been thus employed. Their capacity for such use is

covery' (not inventions or discoveries) 'as shall be truly and *bona fide* his own; provided it shall be a *material* and substantial part of the thing patented, and be definitely distinguishable from the other parts so claimed without right as aforesaid.' This language manifestly points throughout to a definite and single invention, as the 'thing patented,' and does not even suppose that one patent could lawfully include divers distinct and independent inventions, having no common connection with each other, nor any common purpose. It may, therefore, fairly be deemed a legislative recognition and adoption of the general rule of law in cases not within the exceptive provision of the act of 1837. And this is what I understand to have been intended by the court in the language used in Barrett *v.* Hall (1 Mason, 447, 475, 478). It was there said (p. 475) that 'a patent under the general patent act cannot embrace various distinct improvements and inventions; but in such a case the party must take out separate patents. If the patentee has invented certain improved machines, which are capable of a distinct operation, and has also invented a combination of these machines to produce a connected result, the same patent cannot at once be for the combination, and for each of the improved machines; for the inventions are as distinct as if the subjects were entirely different.' And again (p. 478), 'If the patent could be construed as a patent for each of the machines severally, as well as for the combination, then it would be void, because two separate inventions cannot be patented in one patent.' It is obvious, construing this language with reference to the case actually before the court, that the court were treating of a case where each of the patented machines might singly have a distinct and appropriate use and purpose, unconnected with any common purpose, and therefore each was a different invention. In Moody *v.* Fiske (2 Mason, 112, 119), the judge alluded still more closely to the distinction, and said: 'I wish it to be understood in this opinion that though several distinct improvements in one machine may be united in one patent, [yet] it does not follow that several improvements in two different machines, *having distinct* and independent operations, can be so included; much less that the same patent may be for a combination of different machines and for distinct improvements in each.' It is perhaps impossible to use any general language in cases of this sort, standing almost upon the metaphysics of the law, without some danger of its being found susceptible of an interpretation beyond that which was then in the mind of the court. The case intended to be put in each of these cases was of two different machines, each applicable to a distinct object and purpose, and not connected together for any common object or purpose. And, understood in this way, it seems to me that no reasonable objection lies against the doctrine. Construing, then, the present patent to be a patent for each machine, as a distinct and independent invention, but for the same common purpose and auxiliary to the same common end, I do not perceive any just foundation for the objection made to it. If one patent may be taken for different and distinct improvements made in a single machine, which cannot well be doubted or denied, how is that case distinguishable in principle from the present? Here there are two machines, each of which is or may be justly auxiliary to produce the same general result, and each is applied to the same

sufficient to entitle their inventor to embrace them in a single patent, since when contemplated as co-operating toward this common end they may be properly regarded as parts of one invention. But separate and distinct inventions, not capable of such connected use, cannot be joined in the same patent.[2] Their design and operation being independent of each other there is no point of view from which they can be considered as one invention; and patents embracing two or more such inventions will not be sustained.

common purpose. Why then may not each be deemed *a part or improvement* of the same invention? Suppose the patentee had invented two distinct and different machines, each of which would accomplish the same end, why may he not unite both in one patent, and say, I deem each equally useful and equally new; but, under certain circumstances, the one may, in a given case, be preferable to the other? There is a clause in the Patent Acts which requires that the inventor, in his specification or description of his invention, should 'fully explain the principle and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions.' Now this would seem clearly to show that he might lawfully unite in one patent all the modes in which he contemplated the application of his invention, and all the different sorts of machinery or modifications of machinery by which or to which it might be applied; and if each were new there would seem to be no just ground of objection to his patent reaching them all. *A fortiori*, this rule would seem to be applicable where each of the machines is but an improvement or invention conducing to the accomplishment of one and the same general end." 2 Robb, 23 (37).

That two related and auxiliary inventions may be joined in the same patent, see McComb *v.* Brodie (1872), 1 Woods, 153; 2 O. G. 117; 5 Fisher, 384; Lee *v.* Blandy (1860), 2 Fisher, 89; 1 Bond, 361; Hogg *v.* Emerson (1848), 6 How. 437; 2 Robb, 655.

That several inventions which may be, though they are not, used together may be joined, see Emerson *v.* Hogg (1845), 2 Blatch. 1.

That inventions appropriate for use in the same article for a common purpose of making the article may be joined, see Maxheimer *v.* Meyer (1881), 20 O. G. 1162; 20 Blatch. 17; 9 Fed. Rep. 460.

That related inventions, if invented by different inventors, cannot be joined, see Potter *v.* Wilson (1860), 2 Fisher, 102.

[2] That separate and independent inventions cannot be joined in one patent either under the law or the rules of the Patent Office, see *Ex parte* Heginbotham (1875), 8 O. G. 237.

That distinct and separate inventions, not connected in design and operation, cannot be joined, see Sessions *v.* Romadka (1884), 21 Fed. Rep. 124; 28 O. G. 721.

That a joinder of separate and distinct but not independent inventions is proper, see Mosler Safe & Lock Co. *v.* Mosler (1885), 31 O. G. 1689; 22 Fed. Rep. 901.

§ 471. Joinder of Inventions: Rule in the Patent Office.

The general rule established in the Patent Office by the regulations and decisions of successive Commissioners permits the joinder of distinct inventions in an application where one of such inventions is dependent on the other and where they thus mutually contribute to produce a single result.[1]

§ 471. [1] In *Ex parte* Young (1885), 33 O. G. 1390, Montgomery, Com.: (1391) "All will agree that an application should not ordinarily embrace matters which belong to absolutely distinct, independent, and unconnected official classes or sub-classes where the inventions involved are separate, independent, and not connected together in their nature, design, or operation, but that in such cases a division should undoubtedly be insisted upon. The first inquiry, therefore, should be as to whether or not the inventions, if there be more than one included in the application, can reasonably and properly be said to be independent inventions — *separate* inventions. If they are so independent and separate, they should not be joined, and a division should be called for. If they are not so independent and separate, but are only distinct, but still 'kindred and auxiliary,' or connected in their design and operation, or in their nature or operation connected together, then ordinarily a division should not be required."

That distinct inventions can be joined if one is dependent on the other, see *Ex parte* Hogan (1879), 16 O. G. 907.

That distinct inventions are not necessarily independent, see *Ex parte* Young (1885), 33 O. G. 1390.

That devices subserving a common end and contributing to a unitary result may be joined, see *Ex parte* Sol Kuh (1876), 10 O. G. 587; *Ex parte* Clinton & Knowlton (1876), 9 O. G. 249; *Ex parte* Jopling (1875), 8 O. G. 1032.

That devices adapted to each other, if belonging to the same class and used to serve a common end, may be joined, see *Ex parte* Noyes (1875), 8 O. G. 818.

That where the parts of an invention are intimately connected, and co-operate in the result, they may be joined, see *Ex parte* Freese (1880), 17 O. G. 1095.

That when devices, in their nature distinct, form a complete set which operate together, they may be joined, see *Ex parte* Gokey (1878), 15 O. G. 295.

That connected inventions may be joined, though a separate foreign patent has been granted for each, see *Ex parte* Unsworth (1879), 15 O. G. 882.

That no joinder is permitted in the Patent Office unless the inventions directly act in producing a resultant operation due to all the inventions, see *Ex parte* Herr (1887), 41 O. G. 463.

That it is for the Patent Office to judge whether inventions are separate and distinct, see *Ex parte* Bancroft (1881), 20 O. G. 1893.

That separate and independent inventions cannot be joined, see *Ex parte* Young (1885), 33 O. G. 1390; *Ex parte* Van Matteson (1883), 24 O. G. 389; *Ex parte* Bancroft (1881), 20 O. G. 1893; *Ex parte* Hogan (1879), 16 O. G. 907; *Ex parte* Law (1877), 12 O. G. 940; *Ex parte* Howland (1877), 12 O. G. 889; *Ex parte* Sol Kuh (1876), 10 O. G. 587; *Ex parte* Elbers (1875), 12 O. G. 2.

That inventions which do not co-operate, or depend on each other for their operation, cannot be joined, see

Since in these cases the dependent invention cannot be contemplated by the mind as complete and practically operative unless in connection with the other, and cannot be examined and passed upon by the Patent Office without inquiring into and determining its limits with respect to the other, their joinder is not inconsistent with the division of duties in the Office, though the spirit of its regulations, as well as of the law itself, still demands a separate patent and a separate application for each invention. In judging of inventions with reference to this general rule, their dependency or independency is determined by the scope and relation of the concrete inventions, not by the unity or diversity of the ideas of means as they were developed in the mind of the inventor.[2] That the inventions pertain to the same subject, or belong to the same genus, or are by nature adapted to a common use should

Ex parte Dieterich (1877), 11 O. G. 195.

That inventions which co-operate neither in function nor result cannot be joined, see *Ex parte* Westcott (1876), 10 O. G. 546.

That independent inventions, whether arts or instruments, cannot be joined, see *Ex parte* McDougall (1880), 18 O. G. 130.

In examining the foregoing cases, or any others upon this subject, it should be borne in mind that inventions are here regarded as "inseparable" whenever either one of them is necessarily dependent on the other. A product which can be created only by a specific process is "inseparable" from that process, although the process, being capable of an application which does not result in that product, is not "inseparable" therefrom. An apparatus which has no other use than in performing a certain art may also be "inseparable" from that art, while the art itself may be entirely separable from the apparatus and as easily performed by many others. "Inseparability" or "dependence," as a ground of joinder, may thus be predicable of either or both of the conjoined inventions, — the invention being single for the purposes of an application or a patent whenever any of its component or subordinate or resultant arts or instruments could not exist as operative means without the others. This limitation of "inseparability" serves to reconcile with each other all the discordant positions which, by their too comprehensive language, the decisions appear to have maintained.

[2] In *Ex parte* Murray (1873), 3 O. G. 659, Leggett, Com. : (660) "It might be supposed, because the inception and perfection of a process and the product to be treated and improved by it, or of a machine and its product, are often conjoined in the mind of the inventor, that in this is to be found a reason why the two ought to be regarded as constituting one subject of invention to be embraced in a single patent. But this is not the proper criterion by which to judge of them. The inventions are to be contemplated when completed, and if they are then distinct, it is immaterial how intimately they may have been blended in their production."

any one desire so to employ them, does not constitute such dependence as to justify their joinder.[3] But where the ultimate end for which one was created cannot be reached without the employment of the other, or where the operation of the one results in the production of the other, or where the use of one involves the concurrent or co-operating use of all the rest, or where one is generic and the other a particular species of that genus,[4] this dependence exists and the inventions may be joined.

[3] That distinct inventions cannot be joined though they pertain to the same things, see *Ex parte* Van Matteson (1883), 24 O. G. 389; *Ex parte* Hamilton (1877), 13 O. G. 122.

That distinct inventions cannot be joined, though they belong to the same genus, see *Ex parte* Stow (1873), 3 O. G. 322.

That the capability of use by application to some outside article does not warrant a joinder where there is no mutual dependence and intercommunication, see *Ex parte* Law (1877), 12 O. G. 940.

[4] In *Ex parte* Kent (1880), 17 O. G. 686, Doolittle, Act. Com.: (686) "It is true that a discoverer of a genus in mechanics is entitled to a Claim in a patent co-extensive with the genus, and to which all subsequent Claims for species of that genus must be subordinate. As each genus, however, constitutes a separate invention, but one can be claimed in the same application. A genus is defined as 'a precisely defined and exactly divided class,' and as 'an assemblage of species possessing certain characteristics in common,' but not as including different classes of objects having simply general resemblances and functions; and in a Claim for a genus these common characteristics must be distinctly pointed out. . . . In addition to a generic Claim, one who has invented the genus may, under the established practice of the Office, claim a particular species illustrative or typical of the genus."

In *Ex parte* Kook (1879), 16 O. G. 543, Paine, Com.: (544) "While it is easy to distinguish theoretically between those cases in which several different forms constitute different species of one genus and those in which they constitute only a single species, the practical discrimination between the two classes of cases is not always easy. The principle is this: When the different forms are such that the substitution of one for another involves invention, the differences are patentable, and the several forms constitute different species of the genus, all subject to one generic patent, but each legally patentable in a distinct and specific patent. On the other hand, when the substitution of one for the other involves no invention, but only mechanical skill, the differences are not patentable, and the forms do not constitute several species of the genus, but are all modifications of a single species."

In *Ex parte* Howland (1877), 12 O. G. 889, Doolittle, Act. Com.: (889) "It may be stated, in brief, that whenever a generic Claim can be predicated which is good in view of the state of the art, and which will include the modifications or specific devices described or exhibited in the drawings, then these may all be retained in a single application; for it is manifest, from the fact that the Claim applies with equal apti-

§ 472. Joinder of Inventions: Combinations: Sub-combinations: Elements.

Out of the application of these general rules to the various classes of inventions have grown certain special rules by which the joinder of two or more inventions of the same class or of different classes is also governed. Before discussing those special rules, however, a peculiar doctrine relating to combinations, which are found in all these classes, may properly be stated. A combination, its sub-combinations, and the elements of which each sub-combination is composed are dependent inventions whenever such elements and sub-combinations are considered in reference to the principal combination in which all unite. Although this principal combination is a true invention, distinct in law as well as in fact from all the subordinate inventions which enter into it, no idea of it can be formed in the mind, no embodiment of that idea can be made practically operative in the arts, and no examination as to its novelty or utility can take place in the Patent Office, without embracing in this idea, in its embodiment, and in this examination each of the elements and sub-combinations of which it consists. Hence, whenever any of these sub-combinations or their elements have been invented by the inventor of the principal combination and have not been previously patented in this country, they may be joined in one application

tude to each, that there are generic features of identity which indicate the same basis of invention. On the other hand, where no Claim of the character indicated can be maintained, it is equally true that there is such diversity as will require a division of the application; this restriction being pursued until the matter retained in any single case can be safely said to relate to but one invention, or, in other words, can be contained in the broadest patentable Claim that is capable of being drawn to it."

Further, that a generic invention and one species under the genus may be joined, see *Ex parte* Heaton (1879), 15 O. G. 1054; *Ex parte* Smith (1879), 16 O. G. 630; *Ex parte* Cowper (1879), 16 O. G. 499.

That two or more distinct species under the same genus cannot be joined, see *Ex parte* Ewart (1880), 17 O. G. 448; *Ex parte* Heaton (1879), 15 O. G. 1054; *Ex parte* Dinkelbilher (1879), 16 O. G. 810; *Ex parte* Cowper (1879), 16 O. G. 499; *Ex parte* Morrison (1879), 16 O. G. 359.

That two distinct species under the same genus, if requiring different inventive acts, cannot be joined, though all will be covered by a patent for the genus, see *Ex parte* Kook (1879), 16 O. G. 543.

For an excellent discussion of joinder and kindred subjects, see *Ex parte* Herr, (1887), 41 O. G. 463.

with the principal combination.[1] And this is equally true whether these elements and sub-combinations are, in their own nature as separately considered, similar or dissimilar to each other either in name, in class, or in mode of operation. This doctrine applies, however, only to cases where the principal combination is itself the subject-matter of the application. It is this combination which constitutes the link between the different sub-combinations and their elements, and thus forms the ground of their dependence on each other. Apart from this combination these subordinate members may or may not be wholly independent of one another, and may be joined or not joined according to the rules which govern simple inventions of their peculiar class.[2] Different combinations of the same group of elements, combinations of one or more

§ 472. [1] In Stevens *v.* Pritchard (1876), 2 Bann. & A. 390, Clifford, J.: (390) "Cases arise where a patentee, having invented a new and useful combination, consisting of several elements, which in combination compose an organized machine, also claims to have invented new and useful inventions, consisting of fewer members of the same elements; and in such cases the law is well settled that, if the several combinations are new and useful, and will severally produce new and useful results, the inventor is entitled to a patent for the several combinations, provided he complies with the requirements of the patent act, and files in the Patent Office a written description of each of the alleged new and useful combinations, and of the manner of making, constructing, and using the several inventions. He may, if he sees fit, give the description of the several combinations in one specification, and in that event he can secure the full benefit of the exclusive right to each of the several inventions by separate Claims, referring to the specification for the description of the inventions, without the necessity of filing separate applications for each of the inventions. Separate descriptions of the respective inventions in one application are as good as if made in several applications; but the Claims must be separate, and it would follow that if the patentee, by inadvertence, accident, or mistake, should fail to claim any one of the described combinations, he might surrender the original patent, and have a re-issue not only for the combinations claimed in the original specification, but for any which were so omitted in the Claims of the original patent." 4 Clifford, 417 (418); 10 O. G. 505 (505).

See also Banks *v.* Snediker (1880), 17 O. G. 508; Gill *v.* Wells (1874), 22 Wall. 1; 6 O. G. 881.

That the elements of a combination may be joined with it unless they have become known in the arts as separate inventions and possess utility in other relations, see *Ex parte* Sartell (1888), 42 O. G. 295.

That elements already in general use in other connections cannot be joined with the combination, see *Ex parte* La Borde (1888), 44 O. G. 700.

[2] That aggregated devices cannot be joined unless the joinder would be proper when they are considered as distinct inventions, see *Ex parte* Cardwell (1878), 15 O. G. 293.

elements with several different groups of additional elements,[3] a single element and several different combinations into which it enters, a combination and distinct improvements in its different elements not affecting the operation of the combination as a whole, one improvement in one element and another improvement in a different element,[4] — all these are also, for the same reason, outside this peculiar doctrine. An application in which such a joinder should be made would embrace no separate subject-matter which could bring them into relations of dependence. Whenever, therefore, they are capable of being joined in any application which does not embrace the principal combination, it must be on the ground that they are in their own nature dependent on each other and mutually contribute to produce a single result, — a state of facts which allows their joinder under the general rule.

§ 473. Joinder of Inventions: Arts: Apparatus: Product.

The special rules which govern the joinder of arts or processes with each other or with related inventions of a different class, are more stringent in the Patent Office than in the courts. The decisions of the courts permit two processes to be covered by one patent when they are so related to each other that they are capable of being used for the attainment of a common end. They also allow a process to be embraced in the same patent with the apparatus by which it is performed and the product in which it results, where all originate in the inventive genius of the same inventor, although the process, the apparatus, and the product are so far separable from each other that the process might be otherwise performed, the apparatus otherwise employed, and the product otherwise produced.[1] But in the Patent Office arts cannot be

[3] That different combinations of the same elements cannot be joined, nor combinations of the same invention with different elements, see *Ex parte* Shepard (1872), 3 O. G. 522.

[4] See § 478 and notes, *post*.

§ 473. [1] That the statute allows the joinder of Claims for an art and its apparatus, see *Ex parte* Young (1885), 33 O. G. 1390. That a Claim for a process cannot be joined with a Claim for a machine where the process consists in the operation of the machine, there being in such case but one invention, viz: the machine, see Gage *v.* Kellogg (1885), 23 Fed. Rep. 891; 32 O. G. 381.

In United States *v.* Butterworth (1884) 27 O. G. 717, it is doubted whether the process performed by apparatus can be

joined merely because they relate to the same subject, or can be used for the promotion of a single ultimate result. Either, one must be in its own nature dependent on the other, or taken together they must constitute a combination-process which is also made the subject-matter of the application.[2] Nor can a process be joined with the apparatus that performs it,[3] nor

patented as a separate invention from the apparatus. This doubt must be solved in the affirmative, if the process can be performed by other apparatus or the apparatus can be used for other purposes; in the negative, if they are so related that the process is the function of this apparatus and of this apparatus only.

That one patent may cover the process and another the apparatus, see Philips *v.* Kochert (1887), 40 O. G. 1341; 31 Fed. Rep. 39; Tilghman *v.* Proctor (1880), 102 U. S. 707; 19 O. G. 859; Cochrane *v.* Deener (1876) 94 U. S. 780; 11 O. G. 687; Corning *v.* Burden (1853), 15 How. 252.

That a process and its product may be joined, see Sewall *v.* Jones (1875), 91 U. S. 171; 9 O. G. 47; Merrill *v.* Yeomans (1874), 5 O. G. 267; Holmes, 331; 1 Bann. & A. 47; Goodyear *v.* Providence Rubber Co. (1864), 2 Fisher, 499; 2 Clifford, 351.

That a process and its product may be joined if the specification shows that the inventor had both results in his mind, see Welling *v.* Rubber Coated Harness Trimming Co. (1875), 2 Bann. & A. 1; 7 O. G. 608.

That if a process and product are joined each must be fully described, see Kelleher *v.* Darling (1878), 4 Clifford, 424; 14 O. G. 673; 3 Bann. & A. 438.

That processes and their products are to be joined or not as the Patent Office may decide, see Goodyear *v.* Wait (1867), 3 Fisher, 242; 5 Blatch. 468.

[2] In *Ex parte* McDougall (1880), 18 O. G. 130, Marble, Com.: (131) "The rule that several distinct inventions cannot be included in a single application is a well-settled one, and is alike applicable whether such inventions be improvements in processes or in machinery. . . . Each of the several 'acts' of 'the series of acts' constituting the process may be capable of performing separately its own peculiar function, and may be used independently of the others; but if together they co-act in producing the final result they may be joined in a single application. In such a case a Claim can be made to the process as an entirety, and separate Claims can also be made to the sub-processes which go to make up the same. So, also, where one has discovered that a desired result can be attained by a process consisting of a series of steps or acts, and that certain of the steps in such process may be replaced by others which will operate in an equivalent manner in attaining the same end, these several modifications can be embraced in one application, for they cannot be regarded as distinct inventions. In such case the applicant would be entitled to a broad or generic Claim, which would include all the modifications, and would also be allowed to claim separately any one of these modifications or species."

That several processes cannot be joined merely because they relate to the same subject, see *Ex parte* McDougall (1880), 18 O. G. 130.

[3] That a process and its apparatus cannot be joined, see *Ex parte* Herr (1887), 41 O. G. 463.

That the process and the apparatus that performs it may be joined, though other apparatus will perform it, if the apparatus is inseparable from the process

either of these with the product in which they result, unless they are to such an extent inseparable that the existence of some one of them is dependent upon that of the others.[4]

and cannot be used except in performing the process, see *Ex parte* Tyne (1880), 17 O. G. 56.

That a process, the apparatus, and the product can be joined if inseparable, not otherwise, see *Ex parte* Dailey (1877), 13 O. G. 228.

In *Ex parte* Simonds (1888) 44 O. G. 445, it is held that where the process and the apparatus are inseparable the former must be the mere function of the latter. This is true where the process can be performed only by the apparatus in question, not where other apparatus can be employed in the process, although the apparatus in question, being capable of no other use than in this process, may be truly inseparable therefrom.

That an art and its apparatus cannot be joined in one patent, being separable inventions wherever the art is not the mere function of the apparatus, see *Ex parte* Blythe (1884), 30 O. G. 1321. But see preceding case and remarks.

Where a process can be performed by different apparatus it is a separate patentable entity from the apparatus which performs it, and therefore must be separately patentable. But it does not follow from this that if any one apparatus can be used for no other purpose than the performance of this process, the process is the mere function of such apparatus, and consequently not a patentable art. Every process may be regarded as a function in its relation to the apparatus which performs it, though it be a means in its relation to the object acted on, and where it is capable of existence apart from one specific apparatus, *i. e.* where it can be performed by various apparatus, it is a separately patentable invention. But an apparatus which can do nothing except perform a specific process is inseparable from that process, though the process may not be inseparable from the apparatus; and if the process and apparatus are both new inventions they may be joined in one application, not on the ground that the process is the function of the apparatus, but because the apparatus cannot be invented, examined, nor adjudged apart from the single process it performs.

[4] In *Ex parte* Tyne (1880), 17 O. G. 56, Doolittle, Com.: (56) "It is a settled practice of the Office that a process and its product or a machine and its product may be united in the same application and patent when the product is the necessary result of the process or machine, and can only be produced in that way, or where distinct machines are associated and are necessary to produce a single result. The connection, in all cases, between the means and result must be inseparable. *Ex parte* Cobb, 16 O. G. 175; Wintherlich, 16 O. G. 404; 16 O. G. 808. Now a mechanical process, which is only another name for an art, is inseparable from the means by which it is operated. These means may vary, but if the same improvement in the art is produced in substantially the same way the different means are necessarily equivalents, just as two machines producing the same product in substantially the same way are equivalents. And it is no objection to joinder in the same application of inseparably connected distinct inventions that some other equivalent invention may be substituted in place of one of the former."

In *Ex parte* Murray (1873), 3 O. G. 659, Leggett, Com.: (660) "A machine is a distinct subject of invention, and

Thus a process may be joined with its inevitable product or with the apparatus by which alone it can be performed, or a product may be joined with the process on which it depends for its production, or an apparatus with the process whose performance constitutes the sole method in which it can be used; and when either the process or the apparatus or the product are so connected with the other two that its existence as a concrete invention is derived from, or results in, theirs an application for a patent for the former may include the others also.

§ 474. Joinder of Inventions: Machines: Processes: Products.

A similar difference between the Patent Office and the courts obtains in reference to the rules relating to the joinder of machines. Under the decisions of the courts, two machines can be covered by one patent whenever they are kindred in their nature and capable of a connected use toward a common

its product, or the article which it is employed to make, is another distinct subject of invention, if new in itself. They are classified separately in the portfolios of the Office, and require separate examinations, and to grant both in the same patent complicates and increases the work of examiners and greatly augments the danger of making mistakes and improperly duplicating patents. . . . The same is true of a process and the article produced by it. The two are entirely independent. The process may be new and the product old, or both may be new, and yet the product be capable of being produced by other processes. . . . Notwithstanding the precedents which exist, and admitting that such a practice as they indicate, if not strictly correct, is not fatal to the validity of patents, I think the time has come when, leaving out of consideration the perspicuity of the patents themselves, and the revenue to be derived under the law for examinations, a proper classification in the Office, so as to facilitate examinations and prevent mistakes in the issue of patents, requires that processes, machines, and their products be presented for patent in separate applications."

That a product and process may be joined, see *Ex parte* Stow (1873), 3 O. G. 322.

That where a process and its product are inseparable, and the sub-process and its product are also inseparable, all may be joined, and if these constitute a generic invention, one species under the genus may be added, see *Ex parte* Du Motay (1879), 16 O. G. 1002.

That a process and product cannot be joined unless inseparable, see *Ex parte* O'Neill (1879), 16 O. G. 1049.

That where a process and product are inseparable they should be joined, see *Ex parte* Young (1885), 33 O. G. 1390; *Ex parte* O'Neill (1879), 16 O. G. 1049.

That a process and a product which requires another process to complete it cannot be joined, see *Ex parte* Chamberlin (1874), 6 O. G. 544.

end.[1] Machines and their integral parts, or a machine and the product in which its use results, or a machine and the process it performs, are also proper subjects-matter for a single patent.[2] The Patent Office rules, however, require a separate application for each machine unless one cannot be contemplated as an operative instrument without the other, or unless they constitute the elements or sub-combinations of a principal machine which is also the subject-matter of the application.[3] A machine and its product, a machine and its process, or a machine with both its process and its product, may be joined when either one cannot exist as a concrete and practical invention without the others.[4]

§ 474. [1] That two distinct machines cannot be joined, see Root *v.* Ball (1846), 4 McLean, 177 ; 2 Robb, 513.

That machines capable of a common use may be joined, see Wyeth *v.* Stone (1840), 1 Story, 273 ; 2 Robb, 23.

[2] That a machine and its integral parts may be joined, see Wheeler *v.* McCormick (1873), 4 O. G. 692 ; 11 Blatch. 334 ; 6 Fisher, 551 ; Foss *v.* Herbert (1856), 1 Bissell, 121 ; 2 Fisher, 31.

That the parts may be separately patented, see Jones *v.* Sewall (1873), 3 O. G. 630 ; 6 Fisher, 343 ; 3 Clifford, 563 ; Wheeler *v.* McCormick (1873), 4 O. G. 692 ; 11 Blatch. 334 ; 6 Fisher, 551.

That if the parts are separately patented, each patent may describe the whole, see McMillin *v.* Rees (1880), 1 Fed. Rep. 722 ; 17 O. G. 1222 ; 5 Bann. & A. 269.

That where the product of a machine is new it may be claimed in a patent for the machine, see Excelsior Needle Co. *v.* Union Needle Co. (1885), 32 Fed. Rep. 221.

That a machine, its process, and product are separately patentable, see McKay *v.* Dibert (1881), 19 O. G. 1351 ; 5 Fed. Rep. 587.

That a machine having been patented, its process and product may be separately patented at any subsequent period unless barred by two years' public use, see McKay *v.* Dibert (1881), 19 O. G. 1351 ; 5 Fed. Rep. 587. But see McKay *v.* Jackman (1882), 12 Fed. Rep. 615 ; 20 Blatch. 466 ; 22 O. G. 85.

[3] That subordinate devices may be joined with the principal device, see *Ex parte* Bigelow (1878), 13 O. G. 913.

That all parts of a machine which co-operate to produce a single result may be joined, see *Ex parte* Canhape (1880), 17 O. G. 327.

That where two machines together produce a result which they could not separately produce they may be joined, see Burke *v.* Partridge (1878), 58 N. H. 349 ; *Ex parte* Lones (1873), 4 O. G. 582.

That machines used as elements of a combination may be joined, see *Ex parte* Holub (1880), 17 O. G. 854 ; *Ex parte* Shippen (1875), 8 O. G. 727.

[4] In *Ex parte* Bancroft (1881), 20 O. G. 1893, Marble, Com. : (1894) "Various opinions have been expressed by my predecessors as to what constitutes a single invention or discovery. It has been held, and as I think properly, that a die and its product, a pro-

§ 475. Joinder of Inventions: Manufactures: Processes: Apparatus.

The courts permit two manufactures to be joined whenever they are appropriate for use in the same article to serve a common purpose, or when they stand to each other in the relation of a combination and its elements, or when they are the elements of a combination which is itself embraced in the same patent. When any new manufacture is the result of a new process, or is made by a new machine, these also may be joined, although the manufacture might be otherwise produced. The Patent Office, however, applies here the same restrictions as in the cases of a process or machine. One of the two manufactures must be intrinsically dependent upon the other and co-operate with it to some unitary result, or one must represent the genus of which the other is a species, or

cess and its product, the different parts of the same machine co-operating to produce a unitary result, and a machine and its product are respectively sometimes one and the same invention, and therefore may be included in the same patent. The true rule in the latter case, I think, was properly stated by my predecessor, Mr. Commissioner Paine, in the case of *Ex parte* Wintherlich (16 O. G. 404), as follows: 'If the machine and the manufacture are so related that the former cannot operate without producing the latter, and the latter can only be produced by the former, both may be united in one patent; but this is an exception to the general rule, which forbids the joinder of the machine and its product in one application.' The rule above stated also applies in the case of a die and its product or a process and its product. It is *only* when the product can be produced by the die or the process that the die and its product or the process and its product can be considered one and the same invention. In a case where different parts of a machine may be embraced in the same patent they may be so embraced only because they help to make up one entire whole. In all the cases decided by my predecessors which I have been able to find, the idea of a single invention was always kept in view. Different opinions have been expressed as to what constitutes a single invention; but I have been unable to find that it has been held that two distinct and independent inventions can be embraced in one patent."

That a machine and its product cannot be joined, see *Ex parte* Murray (1873), 3 O. G. 659.

That a machine and its product cannot be joined unless they are inseparable, see *Ex parte* Wintherlich (1879), 16 O. G. 404, 808.

That when the machine and its product are so related that the former cannot operate without producing the latter, and the latter can only be produced by the former, they can be joined, see *Ex parte* Wintherlich (1879), 16 O. G. 404, 808.

That if the product can be made only by the machine they may be joined, see *Ex parte* Cobb (1879), 16 O. G. 175.

they must be members of a combination which is covered by the same application.[1] The manufacture and the process or the machine which produces it must be inseparable as concrete inventions; so that either, on one hand, the manufacture implies the process or machine, or, on the other hand, the process or machine implies the manufacture, and the investigation of the one thus necessarily involves that of the other.[2]

§ 476. Joinder of Inventions: Compositions: Ingredients: Processes: Apparatus.

Compositions of matter are subject to the same rules as manufactures, both in the Patent Office and before the courts. When wholly independent they cannot be joined; when capable of co-operating to a common end the courts sanction their joinder, although the rules of the Patent Office forbid it unless one is dependent on the other and their co-operation is inevitable.[1] As every composition is a true combination, its elements and sub-combinations may be joined with it in an application for a patent;[2] and where it stands toward a process or machine in the relation of a product, the courts permit it to be joined with them as in the case of any other product, while the Office limits such a joinder to instances in which the composition and machine or process are inseparable.[3]

§ 477. Joinder of Inventions: Designs.

Owing to the peculiar character and functions of a design, it is scarcely conceivable that any two designs could be de-

§ 475. [1] That a manufacture may be joined with a combination into which it enters, see *Ex parte* Adams (1873), 3 O. G. 150.

[2] See notes in §§ 473, 474, *ante*, as to joinder of product with processes or machines.

§ 476. [1] That two compositions cannot be joined where one contains all the ingredients of the other with additional ingredients, see *Ex parte* Lippincott (1879), 16 O. G. 632. This is not true where one composition is a sub-combination of the other.

[2] That the joinder of Claims for the associations of ingredients in a composition is proper, if they contribute to the single result and are not in different classes, see *Ex parte* Hentz (1884), 26 O. G. 437.

[3] See §§ 473, 474, and notes, *ante*, covering joinder of product.

pendent on each other or capable of acting toward a common end except as elements in a combination; and therefore but one separate design can be included in a patent, although where several subordinate designs unite to form a new one the application for a patent for the new design may embrace all the elements and sub-combinations of which it consists.[1] It is equally foreign to the idea of a design that it should be dependent on, or inseparably connected with, those qualities in its object which make that object a new manufacture; and hence although the object be the same it cannot be protected by one patent both as a manufacture and as a design.

§ 478. Joinder of Inventions: Improvements.

The joinder of improvements is also regarded by the Patent Office and the courts from different points of view. Two improvements may be related either directly through the dependence of one upon the other or indirectly through their individual dependence upon the same original invention. Where neither of these relations exists, the improvements cannot be joined. Distinct improvements in distinct arts or machines are as independent of each other as any two inventions of the same class can ever be, and all the rules, both of the Office and the courts, require for each of these a separate

§ 477. [1] That the joinder of designs is governed by the usual rules, see *Ex parte* Patitz (1883), 25 O. G. 980.

That two independent designs cannot be joined, see *Ex parte* Beattie (1879), 16 O. G. 266.

That the capability of being associated does not make two designs dependent, see *Ex parte* Patitz (1883), 25 O.G. 980.

That a design patent can cover but one design and such modifications of it as do not affect its identity, see *Ex parte* Gerard (1888), 43 O. G. 1240.

That several aggregated designs cannot be joined, see *Ex parte* Gerard (1888), 43 O. G. 1235.

That a joinder of a combination design and its elemental designs is proper in the courts if the Patent Office will permit it, see Dobson *v.* Hartford Carpet Co. (1885), 114 U. S. 439; 31 O. G. 787; *Ex parte* Pope (1883), 25 O. G. 290; *Ex parte* Beattie (1879), 16 O. G. 267; *Ex parte* Rogers (1878), 13 O. G. 596.

That in the Patent Office the elements of a design cannot be joined with the design, see *Ex parte* Gerard (1888), 43 O. G. 1235.

That in an application for a design a Claim for a separable part of it, which is not a complete design, cannot be inserted, see *Ex parte* Pope (1883), 25 O. G. 290.

That the relation of genus and species does not exist in designs, see *Ex parte* Gerard (1888), 43 O. G. 1240.

application.[1] But two improvements in the same art or machine, though as improvements merely they may be wholly independent of each other, are so connected through the original invention that they are capable of serving a common end, and hence, according to the doctrine of the courts, may be covered by the same patent and joined in the same application.[2] An improvement in a given art or machine may not,

§ 478. [1] In Emerson *v.* Hogg (1845), 2 Blatch. 1, Betts, J. : (7) "In Evans *v.* Eaton (3 Wheat. 454, 506), and in Barrett *v.* Hall (1 Mason, 447, 475), doubts are started whether, under the general Patent Law, improvements on different machines can regularly be comprehended in the same patent, so as to give a right to the exclusive use of the several machines separately, as well as a right to the exclusive use of them in combination. But the special statute (6 U. S. Stat. at Large, 70) applicable to the first case furnished a rule in itself, and the doctrine intimated by the court must accordingly be accepted as put hypothetically, and not laid down as a settled principle to govern the construction of specifications. The case of Barrett *v.* Hall attempts a generalization of the doctrines of the Patent Law, and, in the particular now under inquiry, the definition there adopted has no necessary connection with the case decided. Judge Story, in Moody *v.* Fiske (2 Mason, 112, 119), enters a caveat against his reasoning in that case being held to authorize the including in one specification several improvements in separate machines, having distinct and independent operations ; much less the claiming in the same patent a combination of different machines; and distinct improvements in each. The suggestions advanced in all these cases were by way of caution, and were probably designed to avoid the conclusion that the court had prejudged or was committed upon that particular form of the question. No one of the cases demanded a judgment upon the specific point. In Wyeth *v.* Stone (1 Story, 273, 292) the court reviews those cases, and restricts their application to such inventions as are necessarily distinct from each other, and not contemplated to be used in connection, and holds that a patent for several machines, each being a distinct and independent invention, is valid where they have a common purpose and are auxiliary to the same common end. (Phillips on Pat. 216, 217 ; Pitts *v.* Whitman, 2 Story, 609, 620, 621.) The principle seems to be, that the inventions should be capable of being used in connection, and to subserve a common end (Wyeth *v.* Stone, 1 Story, 273, 289, 290), though their actual employment together does not seem to be required to sustain the validity of the patent in which they may be united."

See also Evans *v.* Eaton (1818), 3 Wheat. 454 ; 1 Robb, 243.

That Claims covering several and distinct improvements relating to one article are not allowed, and all but one may be ordered disclaimed by the court as a condition of granting relief as to the others, see Sessions *v.* Romadka (1884), 28 O. G. 721 ; 21 Fed. Rep. 124.

[2] That several improvements on the same original machine may be joined, see Burke *v.* Partridge (1878), 58 N. H. 349 ; Lee *v.* Blandy (1860), 1 Bond, 361 ; 2 Fisher, 89 ; Adams *v.* Jones (1859), 1 Fisher, 527 ; Morris *v.* Barrett (1859), 1 Fisher, 461 ; 1 Bond, 254 ;

however, always be applicable to that original alone, or be useful only in connection with the other improvements which may be made by the same inventor on the same original invention, but may be equally operative for different purposes apart from them. Under the general rules of the Office, such improvements cannot be joined in the same application; a joinder of improvements being forbidden unless one so depends upon the other that they mutually co-operate to produce a given result.[3] Distinct and independent improvements in separate parts of the same original invention therefore cannot be joined;[4] but several improvements in the different elements of a combination affecting the action of the combination as a whole, or improvements which so operate upon each other as to increase their joint efficiency, may be united in one application and be protected by the same patent.[5]

§ 479. Joinder of Inventions: Application of these Rules often Difficult.

Although these various rules are reasonable in theory and clear in statement, their application to practical inventions is often difficult, from the obscurity which may exist in regard to the actual relations of the inventions to each other. Differences of opinion frequently arise between inventors and the Patent Office on this subject; and as the authority of the Office is supreme and finally determines what is a single in-

Pitts *v.* Whitman (1843), 2 Story, 609; 2 Robb, 189; Wyeth *v.* Stone (1840), 1 Story, 273; 2 Robb, 23; Moody *v.* Fiske (1820), 2 Mason, 112; 1 Robb, 312.

[3] That devices, improving a machine as a whole, may be joined, see *Ex parte* Clinton (1876), 9 O. G. 249.

That two or more improvements on a machine, each contributing to the common result, may be joined, see *Ex parte* Sergeant (1876), 9 O. G. 963.

That improvements in the separate parts of a machine cannot be joined unless they co-operate in the new invention, see *Ex parte* Gillies (1876), 10 O. G. 415.

That several improvements in the parts of a device may be joined if they co-operate to improve it as a whole, and the improvements are not distinct subjects of invention or manufacture, see *Ex parte* Herr (1887), 41 O. G. 463.

[4] That independent improvements on the different parts of a machine cannot be joined, see *Ex parte* Van Matteson (1883), 24 O. G. 389.

[5] That improvements in the elements of a combination may be joined if the elements co-operate in the original combination, though there are other elements, see *Ex parte* Möller (1879), 16 O. G. 358.

vention and whether or not an attempted joinder is permissible, an application may be found defective on account of an improper joinder, and a patent upon it may be refused. In such cases the inventor may amend his application by striking out such of the inventions as it has been decided cannot be joined with the others, and may then make them the subjects-matter of separate applications, inserting into each, where the inventions all relate to a common object, specific disclaimers of the inventions severally covered by the others.[1] When this amendment appears necessary on the face of the original application, it may be ordered before any action on the merits; otherwise, at any time before the final issue of the patent.

SECTION V.

OF THE APPLICATION: THE DESCRIPTION OF THE INVENTION.

§ 480. The Specification: its Importance.

The specification is the most important portion of the application. Not only does it serve as the basis of all the proceedings in the Patent Office and thus determine the right of the inventor to a patent, it also becomes a portion of the patent when granted, and as such fixes and defines the rights of the inventor and the public as against each other. In view of its importance, and in order to secure to it such characteristics as shall enable it to perform its proper functions both before and after the issue of the patent, numerous rules have been established concerning its form and contents which must be strictly observed.[1]

§ 479. [1] That where distinct inventions are embraced in the same application the application must be divided, see *Ex parte* Preston (1880), 17 O. G. 853; *Ex parte* Siemens (1877), 11 O. G. 969.

That on a division of the application disclaimers must be filed with each division, excluding the matter not claimed therein, see *Ex parte* Finch (1883), 26 O. G. 273. See also § 467, note 2, *ante*.

That a division being once made the excluded matter cannot be reinstated, see *Ex parte* Preston (1880), 17 O. G. 853.

§ 480. [1] That the rules of the Patent Office assume that all parts of the specification will conform to the statutes and rules, see *Ex parte* Crandall (1886), 35 O. G. 625.

§ 481. The Specification Sets Forth the Contract between the Public and the Patentee: its Twofold Object.

The functions of a specification and the propriety of the rules which govern it are evident from the nature of a patent. A patent is a contract between the inventor and the public, by which the inventor, in consideration that the exclusive use of his invention is secured to him for a limited period of time, confers upon the public the knowledge of the invention during that period and an unrestricted right to use it after that period has expired.[1] The public, on the other hand, acting through the government, agree with the inventor that, in consideration of his immediate bestowal upon them of a full knowledge of the invention and of the entire right to use it after the term named in his patent is at an end, they will protect him in its exclusive use during the life of his patent. In this contract resides the whole force and benefit of the patent to both parties. The specification is the instrument in which the terms of these mutual considerations and promises are declared, and on its completeness and accuracy depends the validity and the value of the contract itself. Its object is thus twofold: (1) To place the invention fully within the knowledge of the public; (2) To define the exact limits of that exclusive use which the public has undertaken to protect. All the rules into whose discussion we are now about to enter are intended to secure the accomplishment of these two objects.[2]

§ 481. [1] In Page *v.* Ferry (1857), 1 Fisher, 298, Wilkins, J.: (306) "The patent may be considered in the light of a deed from the government, the consideration of which is the invention specified; and the patentee is bound to communicate it, by so full, clear, and exact a description, with drawings and models, that it shall be within the comprehension of the public at the expiration of the patent; for at that period his invention becomes public property. The exclusive privilege is not conferred merely as a reward of genius, and for the encouragement of useful inventions and improvements in arts and manufactures, but also embraces the public benefit." See also Wintermute *v.* Redington (1856), 1 Fisher, 239; Gibson *v.* Brand (1842), 1 Web. 627; Walton *v.* Potter (1841), 1 Web. 585.

[2] In Tucker *v.* Tucker Mfg. Co. (1876), 4 Clifford, 397, Clifford, J.: (400) "Exactitude in the description of an invention is required for three reasons: 1. That the government may know what they have granted, and what will become public property when the term of the monopoly expires; 2. That licensed persons desiring to practise the invention may know during the term how to make, construct, and

§ 482. The Specification: its Two Divisions the Description and the Claim.

Having these two objects to fulfil, a specification is naturally divided into two parts, not wholly independent of each other, but sufficiently distinct to be capable of, and to require, a separate consideration. These two parts are known as the Description, and the Claim.[1] It is the office of the Description to communicate to the public the knowledge of the invention. It is the office of the Claim to define the limits beyond which the public cannot pass without invading the exclusive rights of the inventor. These two parts are not simple repetitions of each other.[2] While the Description necessarily

use the invention; 3. That other and subsequent inventors may know what part of the field of invention is unoccupied." 10 O. G. 464 (464); 2 Bann. & A. 401 (403).

See also Mabie *v.* Haskell (1865), 2 Clifford, 507; Forbes *v.* Barstow Stove Co. (1864), 2 Clifford, 379; Judson *v.* Moore (1860), 1 Bond, 285; 1 Fisher, 544; Wayne *v.* Holmes (1856), 2 Fisher, 20; 1 Bond, 27; Morton *v.* Middleton (1863), 1 Cr. S. 3d Series, 725; Hills *v.* London Gas Light Co. (1860), 5 H. & N. 312; Holmes *v.* London & N. W. R. R. Co. (1852), Macrory, P. C. 13; Neilson *v.* Thompson (1841), 1 Web. 278; Hornblower *v.* Boulton (1799), 8 T. R. 95; 1 Abb. P. C. 98; Arkwright *v.* Nightingale (1785), 1 Web. 60; 1 Abb. P. C. 24.

§ 482. [1] That the applicant for a patent must fully describe and exactly claim his actual invention; and when he has done this the requirements of the law are satisfied, see *Ex parte* Skinner (1881), 19 O. G. 662; Wyeth *v.* Stone (1840), 1 Story, 273; 2 Robb, 23.

That the primary object of a specification is to describe the invention, see Aultman *v.* Holley (1873), 11 Blatch. 317; 6 Fisher, 534; 5 O. G. 3.

That both Description and Claims are required in a specification, see *Ex parte* Crandall (1886), 35 O. G. 625.

That whether a Claim can also answer the purpose of a Description is doubtful, see Smith *v.* Murray (1886), 27 Fed. Rep. 69; 36 O. G. 1045.

[2] In *Ex parte* Holt (1884), 29 O. G. 171, Dyrenforth, Act. Com.: (178) "The description of an invention by a specification alone is not now, as formerly, all-sufficient; but the Description must be supplemented by a specific and well-defined Claim to the part, improvement, or combination which the inventor regards as his property. The aim, end, and purpose of *the specification*, under the present statute, is to *describe* the invention sought to be covered by the patent, and the manner of making, constructing and using the same. The aim, the end, the purpose of *the Claim* is to *point out particularly* and *distinctly define* the invention to be secured to the individual. The *Claim* is the measure of the patent, and the day has passed when the courts will search through the specification for information which it is the very office of the *Claim* to impart."

The words "description" and "claim" being used in Patent Law not only to denote the two parts of the specification but also in their common acceptation, and the rules applied to them in these different uses being in many respects dissimilar, an endeavor is made in this work to avoid the con-

contains allusions to and delineations of many other arts or instruments besides the real invention, in order to enable the latter to be clearly understood, the Claim states the invention only, enumerating its essential characteristics and excluding everything for which the protection of the patent is not desired, with an implied or express reference to the Description for a fuller explanation of such features of the invention as the brevity of the Claim may leave obscure. The purposes of the two parts being thus distinct, their form and nature will be found to differ in a corresponding manner.

§ 483. The Description: its Object and General Requisites.

The Description is intended to render the invention accessible to the public. By this is meant that the knowledge of the invention communicated through the Description must be so complete and accurate that during the life of the patent the scope of the protected invention shall be clearly discernible, and that after the patent has expired the public can make it available for immediate practical use without the further exercise of inventive skill.[1] A Description failing in any respect to accomplish this purpose is defective, and if the defect is incurable the patent based on the specification which embraces it is void.[2] The rules which have been established by the statutes, the courts, and the Patent Office for securing this completeness and accuracy in the Descrip-

fusion which would otherwise result by beginning the words with a capital letter whenever they are employed in their technical sense, as signifying parts of the specification.

§ 483. [1] In Parks *v.* Booth (1880), 102 U. S. 96, Clifford, J.: (101) "Inventors . . . are required, before they secure a patent, to deliver a written Description of the improvement, and of the manner and process of making, constructing, and using the same, in such full, clear, and exact terms as to enable one skilled in the art or science to make, construct, and use the invention. . . . Requirements of the kind may be regarded as conditions precedent to the right of the Commissioner to grant such an application." 17 O. G. 1080 (1090).

See also Sullivan *v.* Redfield (1825), 1 Paine, 441; 1 Robb, 477.

That the patent, by its very terms, must confer a useful invention on the public, see Carr *v.* Rice (1856), 1 Fisher, 198; Opinion Atty. Gen. (1796), 1 Op. At. Gen. 64.

That the entire invention must be specified in the most unequivocal and unambiguous language, see *Ex parte* Williams (1876), 10 O. G. 748.

[2] That an imperfect Description makes a patent void, see Wayne *v.* Holmes (1856), 1 Bond, 27; 2 Fisher, 20.

tion relate to its substance, or what it must contain, and to its form, or the mode in which what it contains must be expressed. These are now to be examined in detail in their order, — first, in reference to inventions in general; and second, in reference to each of the particular classes of inventions.

§ 484. The Description must Disclose the Attributes of the Invention.

According to the statutes, the Description must contain full explanations of three different subjects: the invention itself; the manner of making it; and the mode of putting it to practical use, — a complete knowledge upon all these points being necessary to render the invention available to the public without further experiment or exercise of inventive skill.[1] In describing the invention itself, each of its essential parts must be clearly and exactly delineated, and the relation of each to the others definitely portrayed.[2] That some are to be found

§ 484. [1] That the Description must explain the principle of the invention and state the best known mode of constructing and operating it, see Grier *v.* Castle (1883), 17 Fed. Rep. 523; 24 O. G. 1176; Union Sugar Refinery *v.* Matthiesson (1865), 2 Fisher, 600; 3 Clifford, 639; Page *v.* Ferry (1857), 1 Fisher, 298; Teese *v.* Phelps (1855), 1 McAllister, 48; Thomas *v.* Welch (1866), L. R. 1 C. P. 192; Morgan *v.* Seaward (1836), 1 Web. 170; 2 Abb. P. C. 262; Brunton *v.* Hawkes (1821), 4 B. & Ald. 541; 1 Abb. P. C. 336.

That the invention described and claimed must correspond in principle, if not in form, with the actual invention, see Weir *v.* North Chicago Rolling Mill Co. (1883), 23 O. G. 191; 9 Bissell, 508; 14 Fed. Rep. 42.

[2] That the exact new invention must be described, see *Ex parte* Cornell (1872), 1 O. G. 573.

That the description of the invention varies in definiteness according to its nature, but must be sufficient to inform those skilled in the art, see Mowry *v.* Whitney (1872), 14 Wall. 620; 1 O. G. 492; 5 Fisher, 494.

That a description of the mode of using an invention is not a description of the invention itself, see *Ex parte* Doten (1877), 12 O. G. 841.

That the description of a result does not describe the means by which it is attained, see Burrall *v.* Rumsey (1877), 13 O. G. 123.

That the Description of an invention, whose utility is dependent on some property of matter, must describe that property, see Andrews *v.* Hovey (1883), 5 McCrary, 181; 16 Fed. Rep. 387; O. G. 1011.

That the patentee is not bound by the qualities of the article described as the result of his process, but by those which actually exist in it when produced, see Goodyear *v.* New York Gutta Percha & India Rubber Vulcanite Co. (1862), 2 Fisher, 312.

That the principle to be explained is the idea of means, not the scientific principle of the invention, see Eames *v.* Andrews (1887), 122 U. S. 40; 39 O. G. 1319; Andrews *v.* Cross (1881), 8 Fed.

in the Description, and others in the drawings or models referred to in the Description, does not satisfy the requirements of this rule. The written Description must be complete in itself, although its language may be illustrated and applied by means of a model or the drawings which accompany it.[3] Whatever features of the invention are indispensable to its performance of the functions which it was intended to discharge are to be described in words as accurately as the nature of the case admits; while features not thus indispensable, although in the inventor's mind inextricably connected with the others, may safely be omitted.[4] Hence details of shape, size, quality, proportion, arrangement, and materials require delineation when essential to the operation of the art or instrument described, but otherwise are superfluous except so far as their mention may become necessary in order to set forth its essential characteristics. Besides this delineation of the parts of the invention and their mutual relations, the state of the art to which it belongs must be sufficiently de-

Rep. 269; 19 Blatch. 294; 19 O. G. 1705; St. Louis Stamping Co. v. Quinby (1879), 4 Bann. & A. 192; 16 O. G. 135.

That the theory on which the invention operates need not be explained, see Eames v. Andrews (1887), 122 U. S. 40; 39 O. G. 1319.

[3] That it is not enough that the invention appears in the drawings, — it must also appear in the written Description and Claim, — see Gunn v. Savage (1887), 30 Fed. Rep. 366; Roemer v. Neumann (1885), 26 Fed. Rep. 102; Tinker v. Wilber Eureka Mower & Reaper Mfg. Co. (1880), 1 Fed. Rep. 138; 5 Bann. & A. 92; *Ex parte* Fox (1812), 1 Web. 431; 1 Abb. P. C. 185. *Contra*, Poupard v. Fardell (1869), 18 W. R. 127; Brunton v. Hawkes (1820), 1 Carp. P. C. 410; 1 Abb. P. C. 336.

That drawings may show the form and position of parts of the invention where the Description fails to do so, see Baker v. Bostwick (1880), 18 O. G. 61; 3 Fed. Rep. 517; 5 Bann. & A. 463.

That drawings cannot supply the place of a written Description to such an extent that a Claim can be construed to cover matter indicated only by the drawings, see Gunn v. Savage (1887), 30 Fed. Rep. 366.

That a model showing the invention cannot supply the place of a written Description, see Barry v. Gugenheim (1872), 1 O. G. 382; 5 Fisher, 452.

[4] That the failure to describe an essential element renders the patent useless to the public and void, see Carr v. Rice (1856), 1 Fisher, 198.

That the means described must be the essential necessary means, not mere accidental adjuncts, see Russell v. Dodge (1876), 93 U. S. 460; 11 O. G. 151.

That a failure to describe an element embraced in the inventor's conception of his invention, but still without which the new machine will work, is not fatal to the patent, see Carr v. Rice (1856), 1 Fisher, 198.

scribed to show its real place in the art, and to disclose the precise points in which it differs from all inventions previously known, — thus distinguishing the new matter, to be covered by the patent, from the old which is already in the possession of the public.[5] When several inventions are joined in one application, the same particularity of description is necessary in regard to each; and where the invention is generic, at least one species of the genus must be delineated in the manner here prescribed.

§ 485. The Description must Disclose the Manner of Making the Invention.

The manner of making the invention is the method by which the idea of means conceived by the inventor is reduced to practice. While this idea, which is the principle of the invention, is a unit and invariable, the modes of its embodiment in the concrete invention may be numerous and, in appearance, very different from each other. The applicant is not required to describe all possible forms in which this principle may be reduced to practice, or even all such forms as he may have himself adopted. These belong to the skill of the mechanic, not the inventor; and having one embodiment before them, the public are presumed to be able to construct such others as they may desire. But one mode of reducing the idea to practical utility must be described, and this must be the best one known to the inventor, since to withhold, for his own use or that of his licensees, a better form than that which he bestows upon the public would be a fraud upon them and render the patent void.[1] This description of the manner of

[5] That the Description must distinguish the new from the old, see Grier *v.* Castle (1883), 17 Fed. Rep. 523; 24 O. G. 1176; Sawyer *v.* Miller (1882), 12 Fed. Rep. 725; 4 Woods, 472; Phillips *v.* Page (1860), 24 How. 164; Teese *v.* Phelps (1855), 1 McAllister, 48; Dangerfield *v.* Jones (1865), 13 L. T. Rep. N. S. 142; Newall *v.* Elliott (1864), 10 Jur. N. S. 954; Holmes *v.* London & N. W. R. R. Co. (1852), Macrory, P. C. 13; Crane *v.* Price (1842), 4 M. & G. 580; 1 Web. 393; Carpenter *v.* Smith (1841), 1 Web. 530; Manton *v.* Manton (1815), Dav. P. C. 333; 1 Abb. P. C. 189.

§ 485. [1] That the specification must describe some practicable method of *carrying the invention into effect*, see *Ex parte* Schoonmaker (1878), 13 O. G. 595; Union Sugar Refinery *v.* Matthiesson (1865), 2 Fisher, 600; 3 Clifford, 639.

That the specification must describe

making must embrace such a statement of the idea or principle of the invention, and of its application to the materials employed in the practice of the concrete art or the construction of the concrete instrument, that the public, following its directions, may produce from it alone a practically operative invention, performing in the best method known to the inventor the functions which it was intended to discharge.[2] Abstract or theoretical principles, however, being mere truths of science or speculative methods of accounting for results, need not be mentioned.[3] The inventor himself is not required to understand them, nor is an acquaintance with them necessary to enable the public to reap the entire benefits of his invention.

§ 486. The Description must Disclose the Mode of Use of the Invention.

The modes of putting an invention to practical use are also often numerous and varied. They belong to the mechanical rather than the inventive side of the invention, although some mode of use must inevitably be contemplated by the inventor while employed in the development of his idea of means, and must, for the same reasons, be stated to the public in order that their knowledge of the invention, as a practically operative art or instrument, may be complete.[1] But having ex-

the best mode of applying the principle of the invention, see Grier *v.* Castle (1883), 17 Fed. Rep. 523; 24 O. G. 1176.

That to conceal the best mode for the benefit of the inventor and his licensees avoids the patent, see Dyson *v.* Danforth (1865), 4 Fisher, 133.

[2] That the Description is sufficient if, from it alone, a competent mechanic can construct the invention, see Wayne *v.* Holmes (1856), 2 Fisher, 20; 1 Bond, 27.

That the statement in the Description of each different method of doing a thing must be so clear that it can be done in each way by those skilled in the art, and if any such way is vaguely stated it must be erased, see *Ex parte* Howe (1883), 24 O. G. 1090.

[3] That the scientific principle need not be stated, see Eames *v.* Andrews (1887), 122 U. S. 40; 39 O. G. 1319; Andrews *v.* Cross (1881), 19 O. G. 1705; 8 Fed. Rep. 269; 19 Blatch. 294; St. Louis Stamping Co. *v.* Quinby (1879), 4 Bann. & A. 192; 16 O. G. 135; Woodward *v.* Dinsmore (1870), 4 Fisher, 163.

That the reason given by the inventor for the operation of his invention is not conclusive, see Stow *v.* Chicago (1877), 3 Bann. & A. 83; 3 Bissell, 47.

§ 486. [1] That the Description must disclose a method of putting the invention to practical use, see American Hide & Leather Splitting & Dressing Mach. Co. *v.* American Tool & Mach. Co. (1870), 4 Fisher, 284; Holmes, 503;

plained one mode, all other possible modes are assumed to be suggested by it, unless they depend upon the further exercise of inventive skill, in which case they become new and separate inventions.[2] The mode explained must be the best within the knowledge of the applicant;[3] and must be described, not by asserting that a given result can be obtained by using the invention, but by prescribing certain fixed and definite rules of action by following which the given result will be accomplished.[4]

§ 487. The Description to be Confined to these Three Points.

To these three subjects the Description ought to be confined. Whatever matters of narration or assertion pass beyond these limits are surplusage, and if they do not render the delineation fatally ambiguous, are at least unnecessary and objectionable. Especially is this true of all expressions praising the art or instrument described, and disparaging competing inventions. The sole object of the Description is to confer knowledge upon the public concerning the intrinsic character of the new device or process and the mode of making it available in practice; and no argument as to its merits, either actual or comparative, can be appropriate in such an instrument.[1]

Pitts *v.* Wemple (1855), 2 Fisher, 10; 1 Bissell, 87; Felton *v.* Graves (1820), 3 C. & P. 611; 1 Abb. P. C. 416; R. *v.* Wheeler (1819), 2 B. & Ald. 345; 1 Abb. P. C. 317.

[2] That *having described one mode* others need not be mentioned, see Pike *v.* Potter (1859), 3 Fisher, 55; Derosne *v.* Fairie (1835), 1 Web. 154; 2 Abb. P. C. 78.

[3] That the mode described must be the best mode known to the inventor, see Lorillard *v.* McDowell (1877), 11 O. G. 640; 2 Bann. & A. 531; 13 Phila. 461.

That the patent is valid if the invention serves any use, though it will not fulfil all the uses claimed for it in the patent, see Phillips *v.* Risser (1885), 26 Fed. Rep. 308.

[4] That the Description must not state merely a result but a mode of attaining it, see Burrall *v.* Rumsey (1877), 13 O. G. 123.

§ 487. [1] In Aultman *v.* Holley (1873), 11 Blatch. 317, Woodruff, J.: (325) "The object of a specification is to describe *the thing invented, so as to* enable a mechanic of ordinary skill to construct it and apply it to practical use; and the Claim declares what the patentee claims as his invention. Beyond this, all essays eulogistic of its utility, and assertions of its capacity, are immaterial and useless." 6 Fisher, 534 (543); 5 O. G. 3 (7).

In *Ex parte* Williams (1872), 1 O. G. 225, Leggett, Com.: (226) "It is proper and desirable that an applicant should briefly, and in a well-condensed form, set forth clearly the present state of the art to which his invention relates; but in doing so he should not ask the

§ 488. The Description is Sufficient if Sufficient for Persons Skilled in the Art.

The language and the methods of statement employed in the description of these three subjects must be such as to place the invention fully in the possession of the public. To render an invention accessible to the public, it is not necessary that it should be so described as to be understood by all the individuals of whom the public is composed. Probably no implement, however simple and however long in use, can be comprehended and applied in practice without some previous knowledge, on the part of him who uses it, as to the end which it is designed to accomplish and the general modes in which such ends must be attained. Every invention is a single step forward in the progress of the industrial arts, and cannot be intelligible except to those who are familiar with the steps already taken and with the object which this new advance is intended to subserve. It would be impossible as well as useless for the inventor, in his application for a patent, to furnish to the general public such a complete knowledge of all past achievements in the arts as would enable them to understand the precise place occupied by his invention, and thus perceive its character, its method of construction, and its mode of use. Each of these arts has its especial votaries, men whose lives are spent in acquiring information concerning the appliances which relate to their own industry, and in putting them in practical operation both for their personal and the public good. The possession of an invention by these artisans is its possession by the public for all beneficial purposes, and the inventor who renders it accessible to them makes it as available to the community at large as, in the nature of things, it could ever be. It is to these persons, skilled in the art to which the invention appertains, that the Description of it in the specification is addressed.[1] The inventor has a right to

Office to indorse his claim to superiority over other inventions by name, nor to disparage patents granted to others. A discussion of the merits or demerits of other patents or inventions in the body of a specification is improper, and should not be indulged by the Office. While such a discussion may be proper in an argument, it is out of place in a specification. A specification should be descriptive, not argumentative."

§ 488. [1] In Plimpton *v.* Malcolmson (1876), L. R. 3 Ch. 531, Jessel, M. R.: (568) "Now what is the meaning of it

assume that all those who have recourse to his patent for their knowledge of his invention bring with them such an acquaintance with the state of the art as the ordinary prac-

being a sufficient specification? Upon that there has been a very great deal of authority. Judges have stated it in different ways, no doubt, but I do not think there is much difference in substance. In the first place, it is plain that the specification of a patent is not addressed to people who are ignorant of the subject-matter. It is addressed to people who know something about it. But then there are various kinds of people who know something about it. If it is a mechanical invention, as this is, you have, first of all, scientific mechanicians of the first class, — eminent engineers; then you have scientific mechanicians of the second class, — managers of great manufactories, great employers of labor, persons who have studied mechanics — not to the same extent as the first class, the scientific engineers, but still to a great extent — for the purpose of conducting *manufactories* of complicated and unusual machines, and who therefore must have made the subject a matter of very considerable study; and in this class I should include foremen, being men of superior intelligence, who like their masters would be capable of invention, and like the scientific engineers would be able to find out what was meant even from slight hints, and still more from imperfect descriptions, and would be able to supplement, so as to succeed even from a defective description, and even more than that, would be able to correct an erroneous description. That is what I would say of the two first classes, which I will call the scientific classes. The other class consists of the ordinary workman, using that amount of skill and intelligence which is fairly to be expected from him, — not a careless man, but a careful man, though not possessing that great scientific knowledge or power of invention which would enable him by himself, unaided, to supplement a defective description or correct an erroneous description. Now, as I understand, to be a good specification it must be intelligible to the third class I have mentioned, and that is the result of the law. It will be a bad specification if the first two classes only understand it, and if the third class do not. I do not think, when the cases come to be examined, there is really any difference between the judges on this point. Their language differs, but I do not think the cases differ."

In Mowry *v.* Whitney (1871), 14 Wall. 620, Strong, J.: (644) "The specification, then, is to be addressed to those skilled in the art, and is to be comprehensible by them. It may be sufficient, though the unskilled may not be able to gather from it how to use the invention." 5 Fisher, 494 (502); 1 O. G. 492 (495).

That the Description of the invention is addressed to persons skilled in the art, see Roberts *v.* Schreiber (1880), 5 Bann. & A. 491; 18 O. G. 125; 2 Fed. Rep. 855; Klein *v.* Russell (1873), 19 Wall. 433; Woodward *v.* Morrison (1872), 5 Fisher, 357; 2 O. G. 120; Holmes, 124; Tilghman *v.* Mitchell (1871), 4 Fisher, 599; 9 Blatch. 1; Whitney *v.* Mowry (1867), 3 Fisher, 157; 2 Bond, 45; Forbes *v.* Barstow Stove Co. (1864), 2 Clifford, 379.

That if the Description is sufficient to enable those skilled in the art to make and use the invention the requirement of the law is satisfied, see Loom Co. *v.* Higgins (1882), 105 U. S. 580; 21 O. G. 2031; Roberts *v.* Schreiber (1880), 5 Bann. & A. 491; 18 O. G. 125; 2 Fed. Rep. 855; St. Louis Stamping Co. *v.* Quinby (1879), 16 O. G. 135; 4

tical workmen in that art possess;[3] and if he affords to them such information as enables them to practise his invention, he satisfies all the requirements of the law, although to the unskilled his statements may be wholly unintelligible.

Bann. & A. 192; Calkins *v.* Bertraud (1875), 6 Bissell, 494; 9 O. G. 795; 2 Bann. & A. 215; Ives *v.* Hamilton (1875), 92 U. S. 426; 10 O. G. 336; Dorsey Harvester Rake Co. *v.* Marsh (1873), 6 Fisher, 387; Singer *v.* Walmsley (1860), 1 Fisher, 558; Judson *v.* Moore (1859), 1 Bond, 285; 1 Fisher, 544; Wayne *v.* Holmes (1856), 1 Bond, 27; 2 Fisher, 20; Allen *v.* Hunter (1855), 6 McLean, 303; Hogg *v.* Emerson (1850), 11 How. 587; Brooks *v.* Jenkins (1843), 3 McLean, 250; 2 Robb, 118; Whitney *v.* Emmett (1831), Baldwin, 303; 1 Robb, 567; Heath *v.* Unwin (1852), 2 Web. 230; Neilson *v.* Harford (1841), 1 Web. 295; Bickford *v.* Skewes (1841), 1 Web. 214; Elliott *v.* Aston (1840), 1 Web. 222; Galloway *v.* Bleriden (1839), 1 Web. 521; Morgan *v.* Seaward (1833), 1 Web. 170; 2 Abb. P. C. 262; Crossley *v.* Beverly (1829), 1 Web. 106; 1 Abb. P. C. 409; Sturtz *v.* De La Rue (1828), 5 Russ. 322; 1 Web. 83; 1 Abb. P. C. 399; Manton *v.* Manton (1815), Dav. P. C. 333; 1 Abb. P. C. 189; Harmar *v.* Playne (1809), Dav. P. C. 311; 11 East, 101; 1 Abb. P. C. 171; Hornblower *v.* Boulton (1799), 8 T. R. 95; 1 Abb. P. C. 98; Boulton *v.* Bull (1795), 2 H. Bl. 463; 1 Abb. P. C. 59; R. *v.* Arkwright (1785), 1 Web. 64; 1 Abb. P. C. 29; Arkwright *v.* Nightingale (1785), 1 Web. 60; 1 Abb. P. C. 24.

That the Description must be sufficient to enable persons skilled in the art to construct and use the invention from it alone, see Downton *v.* Yaeger Milling Co. (1879), 17 O. G. 906; 1 Fed. Rep. 199; 1 McCrary, 26; 5 Bann. & A. 112; Keith *v.* Hobbs (1878), 69 Mo. 84; Jenkins *v.* Walker (1872), 1 O. G. 359; 5 Fisher, 347; Holmes, 120; 2 Robb, 588; Brooks *v.* Jenkins (1843), 3 McLean, 250; 2 Robb, 118.

That persons "skilled in the art" are those of ordinary and fair information, not of special excellence, see *Ex parte* Kerr (1884), 28 O. G. 95; Foxwell *v.* Bostock (1864), 10 L. T. Rep. N. S. 144; Household Co. *v.* Neilson (1842), 1 Web. 673; Neilson *v.* Harford (1841), 1 Web. 295; Morgan *v.* Seaward (1836), 1 Web. 170; 2 Abb. P. C. 262; Sturtz *v.* De La Rue (1828), 5 Russ. 322; 1 Web. 83; 1 Abb. P. C. 399; Manton *v.* Manton (1815), Dav. P. C. 333; 1 Abb. P. C. 189.

[3] That the inventor has a right to assume that those who read his Description have a knowledge of the art, see Royer *v.* Coupe (1886), 29 Fed. Rep. 358; 39 O. G. 239; Tompkins *v.* Gage (1865), 2 Fisher, 577; 5 Blatch. 268.

That though the Description is to be read by persons skilled in the art, yet only known equivalents are covered by it, see Woodward *v.* Morrison (1872), 2 O. G. 120; Holmes, 124; 5 Fisher, 357; Heath *v.* Unwin, (1855), 25 L. T. C. P. 19.

That if, on the assumption that certain matters are known to those skilled in the art, the specification is intelligible, it is sufficient, see Hancock Inspirator Co. *v.* Lally (1886), 27 Fed. Rep. 88; 35 O. G. 1001.

That the specification of a pioneer invention is addressed to persons skilled in the art as the art existed at the date of the invention, and it cannot be supplemented by a knowledge of subsequent events or of another's invention of the same thing, see Voelker *v.* Gray (1885), 30 O. G. 1091.

That if a Description is sufficient at

§ 489. The Description Sufficient if Sufficient when Construed with the other Parts of the Application.

The inventor also has a right to assume that those who seek for information in his patent will examine it in the manner usually employed in reference to other legal documents. Every instrument, whether it be a statute, a grant, or a contract, is construed as a whole, not by detached passages; and the imperfections and obscurities of one part are thus removed or interpreted by the others. The same method must be followed in reading the specification of a patent.[1] Lan-

the date of the patent subsequent discoveries cannot make it less so, see Celluloid Mfg. Co. *v.* American Zylonite Co. (1887), 40 O. G. 1453; 30 Fed. Rep. 437.

§ 489. [1] In Howes *v.* Nute (1870), 4 Clifford, 173, Clifford, J.: (174) "Evidently the question as to the sufficiency of the Description and specification must be determined, like a question of construction, from what is written, aided by the drawings, and, if need be, by the Patent Office model. Particular passages in the Description must not be separated from what precedes or follows them in the same connection, but one part of the instrument must be compared with another, and the whole considered together, in order to determine whether it is incomplete and ambiguous, or sufficient to uphold the Claim of the patent." 4 Fisher, 263 (265).

In Singer *v.* Walmsley (1860), 1 Fisher, 558, Giles, J.: (582) "In examining the question the jury are to look at the drawings as well as the specifications, for they are a part of the description of the thing patented; also to the state of the art at the time of the invention, and the knowledge of previous improvements in sewing-machines which were then in general use. But if, from the specifications and drawings taken as a whole, any person skilled as aforesaid could construct and use the sewing machine or device therein described without invention of his own, which would attain the result claimed for it in the said patent, then the said patent is good although there may be a mistake in describing the action of some part of the machinery, but which mistake could be easily discovered by the mechanic when he came to examine the same."

In Whitney *v.* Emmett (1831), Baldwin, 303, Baldwin, J.: (314) "In deciding on its sufficiency, the court inspect the whole description as one paper, which they assume to be true in fact, and if found to be in conformity with the requisitions of the law, so that it appears with reasonable certainty, either from the words used or by necessary implication, in what the invention or improvement consists, as claimed by the patentee, they will adjudge it sufficient. 1 Mason's Rep. 188, 189. A description, though in some respects obscure, imperfect, or not so intelligible as to fully answer all the objects of the law, is good if it enables the court to specify the improvement or invention patented, from the face of the patent and accompanying papers. It is enough if there is a substantial description of the thing patented, though defective in form or mode of explanation. In this respect the papers will be viewed in the same light as a declaration in a suit at law; the court, looking on them as a statement of the patentee's right and title, will overlook all defects in the mode of

guage is to be considered in connection with its context; one clause of description with others relating to the same subject; delineations of the parts of the invention with directions for its construction, or its use; the written Description with the drawings and the model; the entire specification and its adjuncts with the petition, oath, and other portions of the application; and if from them, all together, the necessary knowledge can be gained by those to whom the specification is addressed, the Description is sufficient.[2]

§ 490. The Description must be Correct: Correctness Defined.

Having regard to the persons to whom the specification is addressed, and the interpretation which it may receive from accompanying documents, the description of each one of its three subjects-matter must be correct, complete, and intelligible.[1] A description is correct when the idea expressed by

setting it out, if it contains a substantial averment of such matter as suffices in law to make out a cause of action. This is a question of law which the court decides; it is a question for the jury to decide, whether the statements are true in fact; the court does not look beyond the patent and the other papers, but the jury decide from the papers, the evidence of the witnesses, an inspection of the old and new machine and the model, to ascertain whether in point of fact the specification, as made out at the trial, is sufficient." 1 Robb, 567 (583).

That the Description is sufficient if from it, aided by the drawings, model, and other parts of the application, the invention can be fully ascertained, see Judson *v.* Moore (1860), 1 Fisher, 544; 1 Bond, 285; Goodyear *v.* Railroad (1853), 2 Wall. Jr. 356; 1 Fisher, 626; Kneass *v.* Schuylkill Bank (1820), 4 Wash. 9; 1 Robb, 303.

That the drawings may aid the Description, see Banker *v.* Bostwick (1880), 18 O. G. 61; 3 Fed. Rep. 517; 5 Bann. & A. 463; Swift *v.* Whisen (1867), 2 Bond, 115; 3 Fisher, 343; Judson *v.* Moore (1860), 1 Fisher, 544; 1 Bond, 285; Foss *v.* Herbert (1856), 2 Fisher, 31; 1 Bissell, 121; Earle *v.* Sawyer (1825), 4 Mason, 1; 1 Robb, 490; Daw *v.* Eley (1867), 13 L. T. Rep. N. S. 399; Hastings *v.* Brown (1853), 1 E. & B. 450; Morgan *v.* Seaward (1838), 1 Web. 170; 2 Abb. P. C. 262; Bloxam *v.* Elsee (1825), 1 C. & P. 558; 1 Abb. P. C. 373.

That an imperfect Description coupled with incomplete drawings does not disclose the invention, see New Process Fermentation Co. *v.* Koch (1884), 29 O. G. 535; 21 Fed. Rep. 580.

That a mistake in copying the specification in a re-issue which is corrected by the other parts of the description is of no consequence, see Kendrick *v.* Emmons (1875), 2 Bann. & A. 208; 9 O. G. 201.

That a caveat not recited in the specification belongs to the history of the invention, not to its description, see *Ex parte* Chubb (1872), 2 O. G. 519.

[2] See further as to the interpretation of the Description, etc., §§ 735-745 and notes, *post*.

§ 490. [1] In O'Reilly *v.* Morse (1853), 15 How. 62, Taney, C. J.: (119) "Who-

the words of which it consists corresponds exactly with the real nature of the thing described. The law requires this correspondence between the actual invention, or the acts by which it is constructed or put into practical use, and the language in which these several matters are portrayed.[2] The

ever discovers that a certain useful result will be produced, in any art, machine, manufacture, or composition of matter, by the use of certain means, is entitled to a patent for it; provided he specifies the means he uses in a manner so full and exact that any one skilled in the science to which it appertains can, by using the means he specifies, without any addition to or subtraction from them, produce precisely the result he describes. And if this cannot be done by the means he describes, the patent is void. . . . And it makes no difference, in this respect, whether the effect is produced by chemical agency or combination, or by the application of discoveries or principles in natural philosophy known or unknown before his invention, or by machinery acting altogether upon mechanical principles. In either case he must describe the manner and process as above mentioned, and the end it accomplishes.

The present statute declares that the Description must be in terms that are "full, clear, concise, and exact." The act of 1836 prescribed that the language shall be "full, clear, and exact, without unnecessary prolixity." The act of 1793 simply required terms "full, clear, and exact." The qualities intended to be secured in the Description by these provisions were evidently the three mentioned in the text, viz.: correctness, completeness, and intelligibility.

That the Description must be correct, complete, and intelligible, see Parks *v.* Booth (1880), 102 U. S. 96; 17 O. G. 1089; Schneider *v.* Thill (1880), 5 Bann. & A. 565; Judson *v.* Moore (1860), 1 Fisher, 544; 1 Bond, 285; Brooks *v.* Jenkins (1844), 3 McLean, 432; Park *v.* Little (1813), 3 Wash. 196; 1 Robb, 17.

[2] In Lowell *v.* Lewis (1817), 1 Mason, 182, Story, J.: (188) "A patent is grantable only for a new and useful invention; and, unless it be distinctly stated in what that invention specifically consists, it is impossible to say whether it ought to be patented or not; and it is equally difficult to know whether the public infringe upon or violate the exclusive right secured by the patent. The patentee is clearly not entitled to include in his patent the exclusive use of any machinery already known, and if he does, his patent will be broader than his invention, and consequently void. If, therefore, the description in the patent mixes up the old and the new, and does not distinctly ascertain for which, in particular, the patent is claimed, it must be void; since if it covers the whole it covers too much, and if not intended to cover the whole, it is impossible for the court to say what, in particular, is covered as the new invention. The language of the patent act itself is decisive on this point. . . . It is, however, sufficient if what is claimed as new appear with reasonable certainty on the face of the patent, either expressly or by necessary implication. But it ought to appear with reasonable certainty, for it is not to be left to minute inferences and conjectures from what was previously known or unknown; since the question is not, what was before known, but what the patentee claims *as new;* and he may, in fact, claim as new and patentable what has been long used by the public. Whether the invention itself be thus

difficulty of framing such a Description does not dispense with its production. As no inventive act is performed until the inventor so fully comprehends his own invention that he is able to communicate its essential characteristics to other men, so nothing can be said to be invented unless it can also be described.[3] This rule is, however, satisfied when the Description corresponds substantially with the necessary attributes of the subject delineated. Absolute precision, even in essentials, is not possible, owing in part to the various senses in which the same words may be employed, and in part to the different impressions made by the same object upon different minds.[4] Slight errors in essential points and grave mistakes on immaterial points are therefore overlooked unless they would mislead a cautious reader of the whole Description. Wrong names applied to subjects or their qualities; erroneous theories as to the causes which produce a given effect;

specifically described with reasonable certainty is a question of law upon the construction of the terms of the patent, of which the specification is a part." 1 Robb, 131 (136). See also Tucker *v.* Tucker Mfg. Co. (1876), 4 Clifford, 397; 10 O. G. 464; 2 Bann. & A. 401; Langdon *v.* De Groot (1822), 1 Paine, 203; 1 Robb, 433.

That failure to describe an essential element avoids the patent, see Schneider *v.* Thill (1880), 5 Bann. & A. 565; Carr *v.* Rice (1856), 1 Fisher, 198; Liardet *v.* Johnson (1778), 1 Web. 53; 1 Abb. P. C. 22.

[3] That nothing can be patented unless it can be described, and that a patentee cannot have invented what he cannot describe, see Smith *v.* Downing (1850), 1 Fisher, 64.

[4] In Goodyear *v.* Railroad (1853), 1 Fisher, 626, Grier, J.: (634) "On account of the great vagueness and indefiniteness of the language used in describing the various arts, machines, manufactures, and compositions of matter, it is almost impossible to describe the real nature of many discoveries or processes in language free from ambiguity or misconstruction. Different persons, looking at it from different points of view, would describe it in different terms. In the present case, one would describe it as 'the art of curing India rubber;' another, 'the art of rendering caoutchouc, and manufactures in which it is used, insensible to heat or cold, or the action of most of its known solvents;' another, as a 'fabric, manufacture, or new composition of matter, having qualities never before combined in any other known substance, being elastic, water-proof, insensible to acids, to heat, or to cold.'" 2 Wall. Jr. 356 (363).

That the description of the subject-matter must vary in definiteness according to its nature, see Mowry *v.* Whitney (1872), 14 Wall. 620; 5 Fisher, 494; 1 O. G. 492.

That absolute precision is not required, see Dorsey Harvester Rake Co. *v.* Marsh (1873), 6 Fisher, 387.

That immaterial errors are not regarded, see McKesson *v.* Carnrick (1881), 19 Blatch. 158; 21 O. G. 137; 9 Fed. Rep. 44.

unfounded statements in regard to the results which the invention will accomplish; defects which are apparent to those skilled in the art and which their ordinary mechanical information would enable them to remedy, — all these inaccuracies, and others of a similar character, are consistent with that substantial correctness in essentials without which a knowledge of the invention cannot be communicated to the public.[5]

§ 491. The Description must be Complete: Completeness Defined.

A description is complete when it embraces every essential part and attribute of the thing described. The Description in a specification is complete, within the meaning of the law, when by following it precisely as it reads, without addition or subtraction, a person skilled in the art could make and use the invention. But here, also, a perfect agreement between the language employed by the inventor and the facts and acts which it endeavors to express is not always attainable. Immaterial parts are often so connected with the material that the description of the latter inevitably draws after it the delineation of the former; and on the other hand, many material objects and operations are so familiar to the inventor

[5] That the Description is sufficient, sufficient, see Blanchard Gun Stock Turning Factory *v.* Warner (1848), 1 Blatch. 258.

That the omission to state that a certain function is the leading feature of the invention is not fatal, see Burden *v.* Corning (1864), 2 Fisher, 477.

That defects which those skilled in the art would remedy from their own knowledge are not fatal, see Whitney *v.* Mowry (1867), 3 Fisher, 157; 2 Bond, 45; Swift *v.* Whisen (1867), 3 Fisher, 343; 2 Bond, 115; Singer *v.* Walmsley (1860), 1 Fisher, 558.

That the Description is sufficient if it corresponds in principle, though not in form, with the actual invention, see Weir *v.* North Chicago Rolling Mill Co. (1883), 23 O. G. 191; 9 Bissell, 508; 14 Fed. Rep. 42.

in spite of technical defects, if the invention clearly appears, see Adams *v.* Joliet Mfg. Co. (1877), 12 O. G. 93; 3 Bann. & A. 1.

That mistakes in naming the invention, or in assigning it to its proper class, as by calling it a product when it is a process, do not render the Description insufficient, see Foye *v.* Nichols (1882), 8 Sawyer, 201; 22 O. G. 2243; 13 Fed. Rep. 125; Goodyear *v.* Railroad (1853), 2 Wall. Jr. 356; 1 Fisher, 626; Neilson *v.* Harford (1841), 1 Web. 331; Minter *v.* Mower (1835), 1 Web. 138; 2 Abb. P. C. 178; Derosne *v.* Fairie (1835), 1 Web. 154; 2 Abb. P. C. 73.

That though the Description states that the invention will do some trifling thing which it will not do, it is still

and his readers that their specific description, or even an allusion to them, would be superfluous. The law recognizes these difficulties in the way of an absolutely complete Description, and overlooks the defects which they occasion. Though the Description is excessive it is still sufficient, unless the redundancy is fraudulent or renders the essential parts of the Description uncertain and obscure. Though it omits appliances, modifications, or processes which persons skilled in the art would know were necessary and would themselves supply; though it fails to describe implements and materials that are in common use, or methods of construction generally practised in the arts, — it may still be complete enough to put before the already trained and informed intelligence of the reader an accurate and entire picture of the invention, from which he can understand it, construct it, and use it as easily as if all these familiar acts and objects were particularly described.[1]

§ 491. [1] That the Description need not describe what is in common use, see Thompson *v.* Gildersleeve (1888), 43 O. G. 886; Burrall *v.* Jewett (1830), 2 Paige (N. Y.) 134; Kneass *v.* Schuylkill Bank (1820), 4 Wash. 9; 1 Robb, 303.

That modifications and appliances which would suggest themselves to ordinary mechanics need not be mentioned, see Union Paper Bag Co. *v.* Nixon (1873), 4 O. G. 31; 6 Fisher, 402; Wayne *v.* Holmes (1856), 2 Fisher, 20; 1 Bond, 27.

That if a process can be performed by those skilled in the art by following the directions given in the Description, using their own knowledge of the art, it is sufficient, see Lawther *v.* Hamilton (1888), 42 O. G. 487.

That well-known processes and devices need not be described, see Mulford *v.* Pearce (1875), 9 O. G. 204; 13 Blatch. 173.

That it is not necessary to describe all the uses of the invention, see Pike *v.* Potter (1859), 3 Fisher, 55.

That the Description need not mention all that is necessary to secure the best effect if a good effect can be secured by what is described, see Sewall *v.* Jones (1875), 91 U. S. 171; 9 O. G. 47.

That unless a good effect can be obtained by using what is described, the patent is void, see Sewall *v.* Jones (1875), 91 U. S. 171; 9 O. G. 47.

That if persons skilled in the art can practise the invention from the description given the omission of minor details is not important, see Burrall *v.* Jewett (1830), 2 Paige (N. Y.), 134.

That the Description must show a new invention in fact, see Head *v.* Stevens (1838), 19 Wend. 411.

That the Description must be so complete that one skilled in the art can practise the invention from it alone, see Webster Loom Co. *v.* Higgins (1879), 16 O. G. 675; 15 Blatch. 446; 4 Bann. & A. 88.

That the Description need not mention all things that may be used if those which are named will answer the purpose, see Bickford *v.* Skewes (1841), 1 Web. 214; 2 Abb. P. C. 528.

§ 492. The Description must be Intelligible: Intelligibility Defined.

A description is intelligible when the language and the methods of statement which it employs convey to the mind of the reader the exact ideas embodied in the subject or the act described. A Description may be correct and complete and yet not be intelligible, either because of its undue brevity, or its excessive prolixity, or the strangeness of its words, or the confused arrangement of its sentences. Such a Description in a specification is not permissible.[1] It must not only be correct in what it states, and state completely the entire invention, but its phraseology and the collocation of its sentences must make these statements clear and plain to those skilled artisans to whom it is addressed.[2] The inventor may assume that they will understand the technical terms peculiar to their art, and that they will be able to follow such direc-

§ 492. [1] That if the Description is unintelligible the patent is void, see Sawyer *v.* Miller (1882), 4 Woods, 472; 12 Fed. Rep. 725; Hovey *v.* Stevens (1846), 3 W. & M. 17; 2 Robb, 567; Hovey *v.* Stevens (1846), 1 W. & M. 290; 2 Robb, 479; Kneass *v.* Schuylkill Bank (1820), 4 Wash. 9; 1 Robb, 303; Newberry *v.* James (1817), 1 Carp. P. C. 368; 1 Abb. P. C. 282.

That vagueness of language in the Description does not defeat the patent, if the real invention can be known by it, see Goodyear *v.* Railroad (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

[2] In Lowell *v.* Lewis (1817), 1 Mason, 182, Story, J.: (189) "A question nearly allied to the foregoing is whether (supposing the invention itself be truly and definitely described in the patent) the specification is in such full, clear, and exact terms, as not only to distinguish the same from all things before known, but 'to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same.' This is another requisite of the statute (§ 3), and it is founded upon the best reasons. The law confers an exclusive patent-right on the inventor of anything new and useful, as an encouragement and reward for his ingenuity, and for the expense and labor attending the invention. But this monopoly is granted for a limited term only, at the expiration of which the invention becomes the property of the public. Unless, therefore, such a specification was made as would at all events enable other persons of competent skill to construct similar machines, the advantage to the public which the act contemplates would be entirely lost, and its principal object would be defeated. It is not necessary, however, that the specification should contain an explanation, level with the capacities of every person (which would, perhaps, be impossible); but, in the language of the act, it should be expressed in such full, clear, and exact terms, that a person skilled in the art or science of which it is a branch would be enabled to construct the patented invention." 1 Robb, 131 (137).

tions as a master-workman would give to his subordinates;[8] but he must, in any event, bring the terms of his Description down to the level of their understanding, and in it give to

[8] In Mowry *v.* Whitney (1871), 14 Wall. 620, Strong, J.: (644) "And it is evident that the definiteness of a specification must vary with the nature of its subject. Addressed as it is to those skilled in the art, it may leave something to their skill in applying the invention, but it should not mislead them. The objection here is that in describing the degree of heat to be applied after the wheels have been deposited in the heated chamber the patentee states it to be such that the temperature of all parts of the wheels 'may be raised to the same point, say a little below that at which fusion commences,' and the defendant insists that this amounts to a direction to raise the heat to a degree that must destroy the chill of the tread, and thus render the casting valueless as a railroad car-wheel. But it is obvious that only vague and uncertain directions could have been given respecting the extent to which the heat is necessary to be raised. It must differ with the difference in the progress of cooling which has taken place before the wheels are removed from the moulds. The process requires this removal before they have become so much cooled as to produce such inherent strain on any part as to impair its ultimate strength. Precisely when such a strain begins cannot be known. Cooling commences the instant the casting is made, and with cooling commences contraction, and strain must soon follow. Plainly it is impossible to describe the point of time when the strain has proceeded so far as to impair the ultimate strength of any part of the wheel. That, in the nature of things, must be left to the judgment of the operator." 5 Fisher, 494 (503); 1 O. G. 492 (495).

In Judson *v.* Moore (1860), 1 Fisher, must have a fair and reasonable construction; and if the jury believe, from the evidence before them, that this invention can be constructed by the exercise of skill and judgment on the part of a mechanic, they will come to the conclusion that these specifications are sufficient in the aspect of the case to which I now refer. It may be remarked that in carrying out any invention the exercise of some skill and judgment on the part of the mechanic called to construct it will always be required. Something must necessarily be left to him. If with the exercise, therefore, of ordinary intelligence and skill, the jury believe that the invention could be constructed from the information given by the patent, there would be no doubt that the specifications answered the requisites of the statute." 1 Bond, 285 (290).

That if the Description uses terms intelligible to persons skilled in the art it is sufficient, see Loom Co. *v.* Higgins (1881), 105 U. S. 580; 21 O. G. 2031; Anilin *v.* Higgin (1878), 15 Blatch. 290; 14 O. G. 414; 3 Bann. & A. 462; Monce *v.* Adams (1874), 12 Blatch. 1; 7 O. G. 177; 1 Bann. & A. 126; Singer *v.* Walmsley (1860), 1 Fisher, 558.

That a Description is to be read as if the invention were present and the reader skilled in the art, see Loom Co. *v.* Higgins (1881), 105 U. S. 580; 21 O. G. 2031.

That the Description, being addressed to persons skilled in the art, is to be modified as they would modify it, see Klein *v.* Russell (1873), 19 Wall. 433.

That the ability of the inventor or his attorney to understand the Description is no proof of its intelligibility, see *Ex parte* Kerr (1884), 28 O. G. 95.

them a practical, intelligible, and reliable guide to the character of his invention, and the best method of constructing it and employing it in the arts.

§ 493. The Description: Ambiguity, when Fatal.

When a Description fails in either of these requisites of correctness, completeness, and intelligibility, it is said to be ambiguous; and where this ambiguity exists to any considerable degree it is fatal to the patent.[1] The courts are properly inclined to protect the inventor in spite of any errors into which he may have fallen through his own unskilfulness in the use of language, or through a too great dependence on the supposed knowledge of others. Early decisions in this country, indeed, went so far as to declare his patent valid even where his Description was so imperfect as to be practically useless as a guide to the public, unless its imperfection was intentional and fraudulent;[2] and though this doctrine has

§ 493. [1] That no ambiguous or equivocal Description can be permitted, see *Ex parte* Gould (1876), 10 O. G. 203.

That when the Description is ambiguous and calculated to mislead, the patent is void, see Carlton *v.* Bokee (1872), 17 Wall. 463; 2 O. G. 520; 6 Fisher, 40; Walton *v.* Potter (1841), 1 Web. 585; 1 Abb. P. C. 345; Campion *v.* Benyon (1821), 6 Moore, 71; 1 Abb. P. C. 345.

That the consequences of uncertainty in the Description must fall on the plaintiff, see Poppenhusen *v.* Falke (1861), 2 Fisher, 181; 4 Blatch. 493.

[2] In Whitney *v.* Emmett (1831), Baldwin, 303, Baldwin, J.: (321) "Here the patent contains no proviso declaring it void, if the specification is not in conformity with the law; this is provided for in the sixth section as a substitute for the proviso, and defines the causes for which a circuit court can adjudge a patent void, in a civil suit, for defects in the specification. These are concealment or addition, fully appearing to have been made for the purpose of misleading the public, which is wilful fraud clearly proved; but the court cannot bring within this definition a patent with a specification defective on other grounds, still less act upon the English principle, that the specification is for the purpose of giving the public the benefit of the invention *after* the expiration of the patent, as that would be in contradiction to the act of Congress expressly assigning other reasons. Such has been the uniform construction of the law in the circuit courts, that a patent can be declared void for no other defect in the specification than fraudulent concealment or addition. 1 Peters C. C. Rep. 401; 1 Wash. 171; 3 Wash. 198; 1 Mason, 189, 190; 1 Gall. 434; 7 Wheat. 429, 430. No discretion is left to the circuit courts to annul a patent for any reason not contained in the acts of Congress; they have not left us free to infer motives, objects, and grounds of supposed policy for requiring specifications; the third section of the act of 1793 defines them without any declaration that the

been overruled by sounder judgments, indulgence is still shown to the mistakes of inventors so far as a due regard

patent shall be void if the specification is defective. English decisions, therefore, founded on the assumed reason for the grant of a patent, are not of authority here where the Constitution and laws give other reasons, and omit the one founded on the public benefit to result from the disclosure after the expiration of the privilege. You will therefore not make that a subject of deliberation, for it is not material whether the public can profit by the invention during or after the term of the patent. The true inquiry is whether, in the spirit of the law, the plaintiffs have made such a description of the thing patented as to distinguish it from all others before known, and to enable others skilled in the matter to make, compound, or use it, and to explain the principle and mode of application by which it can be so distinguished from other inventions. If from the patent, specification, drawings, model, and old machine, 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 act of Congress." 1 Robb, 567 (591).

In Gray *v.* James (1817), Peters, C. C. 394, Washington, J. : (401) "But if the jury should be of opinion that the specification is materially defective, the objection will not be sufficient to invalidate the plaintiff's patent, unless they should also be satisfied that the concealment of the circumstances not described was intended to deceive the public. What degree of evidence ought to be required to prove such fraudulent intention must rest with the jury to decide. Positive evidence can seldom be expected, nor is it necessary. The law, it is true, requires that such intention should fully appear ; but still it may be presumed from circumstances entirely to the satisfaction of the jury, which would be sufficient to authorize them to find the fact. As if the parts concealed are so essential and so obviously necessary to be disclosed that no mechanic skilled in the art could reasonably be expected to understand the subject, so as from the description given to make the machine, it would be difficult to impute the omission of the patentee to a fair motive. But this presumption would seem to be much weakened in a case like the present, where so many practical mechanics have testified that they could not hesitate in supplying the omissions in this specification." 1 Robb, 120 (128).

In Whittemore *v.* Cutter (1813), 1 Gallison, 429, Story, J. : (435) "It is therefore argued that if the specification be materially defective, or obscurely or so loosely worded that a skilful workman in that particular art could not construct the machine, it is a good defence against the action, although no intentional deception has been practised. And this is beyond all question the doctrine of the common law ; and it is founded in good reason ; for the monopoly is granted upon the express condition that the party shall make a full and explicit disclosure, so as to enable the public, at the expiration of his patent, to make and use the invention or improvement in as ample and beneficial a manner as the patentee himself. If, therefore, it be so obscure, loose, and imperfect that this cannot be done, it is defrauding the public of all the consideration upon which the monopoly is granted. And the motive of the party, whether innocent or otherwise, becomes immaterial, because the public mischief remains the same. It is said that the

to the rights of the public will permit.[3] However vague may be the representation of his invention given by the Description, if from it, taken in connection with its accompanying drawings and model, a person skilled in the art to which it belongs can by the exercise of his mechanical powers and information alone construct and use the invention, the ambiguity is not fatal.[4] But if experiment or inventive skill on

law is the same in the United States, notwithstanding the wording of the sixth section, for there is a great distinction between a concealment of material parts, and a defective and ambiguous description of all the parts; and that in the latter case, although there may be no intentional concealment, yet the patent may be avoided for uncertainty as to the subject-matter of it. There is considerable force in the distinction at first view; and yet, upon more close examination, it will be difficult to support it. What is a defective description but a concealment of some parts necessary to be known in order to present a complete view of the mechanism? In the present case the material defects were stated, among other things, to consist in a want of a specific description of the dimensions of the component parts, and of the shapes and position of the various knobs. Were these a concealment of material parts, or a defective and ambiguous disclosure of them? Could the Legislature have intended to pronounce that the concealment of a material spring should not, unless made with design to deceive the public, avoid the patent, and yet that an obscure description of the same spring should at all events avoid it? It would be somewhat hazardous to attempt to sustain such a proposition. It was probably with a view to guard the public against the injury arising from defective specifications that the statute requires the letters-patent to be examined by the attorney general, and certified to be in conformity to the law, before the great seal is affixed to them. In point of practice, this must unavoidably be a very insufficient security, and the policy of the provision that has changed the common law may be very doubtful. This, however, is a consideration proper before another tribunal. We must administer the law as we find it. And, without going more at large into this point, 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. There is no ground, therefore, on which we can support this objection." 1 Robb, 28 (34).

In Park *v.* Little (1813), 3 Wash. 196, Washington, J.: (198) "It is true that the thing for which the patent is granted should be truly and fully described in the specification; but if this is done, so as clearly to distinguish it from all other things before known, and so as to enable any person skilled in the art of which it is a branch, or with which it is most nearly connected, to make and use the same, it is sufficient, — the matters not disclosed must appear to have been concealed for the purpose of deceiving the public, to invalidate the patent." 1 Robb, 17 (19).

[3] That ambiguity in the Description is fatal irrespective of the intent of the inventor, see Blake *v.* Stafford (1868), 3 Fisher, 294; 6 Blatch. 195; also §§ 969, 970, 972, 1035, 1037 and notes, *post*.

[4] In Ames *v.* Howard (1833), 1 Sumner, 482, Story, J.: (485) "The

the part of the constructor or the user is necessary to render the invention available in practice, the Description is fatally ambiguous, and the patent granted on the specification which contains it is invalid.[5]

Constitution of the United States, in giving authority to Congress to grant such patents for a limited period, declares the object to be to promote the progress of science and useful arts, an object as truly national, and meritorious, and well-founded in public policy as any which can possibly be within the scope of national protection. Hence it has always been the course of the American Courts (and it has latterly become that of the English courts also) to construe these patents fairly and liberally, and not to subject them to any over-nice and critical refinements. The object is to ascertain what, from the fair sense of the words of the specification, is the nature and extent of the invention claimed by the party; and when the nature and extent of that claim are apparent, not to fritter away his rights upon formal or subtile objections of a purely technical character. Now let us see what is the invention, as claimed by the plaintiff in the specification in this case. I agree that if he has left it wholly ambiguous and uncertain, so loosely defined, and so inaccurately expressed that the court cannot, upon a fair interpretation of the words and without resorting to mere vague conjecture of intention, gather what it is, then the patent is void for this defect. But if the court can clearly see what is the nature and extent of the claim, by a reasonable use of the means of interpretation of the language used, then the plaintiff is entitled to the benefit of it, however imperfectly and inartificially he may have expressed himself. And for this purpose we are not to single out particular phrases standing alone, but to take the whole in connection." 1 Robb, 680 (392).

That ambiguity is not fatal unless the Description is rendered unintelligible, see Swift *v.* Whilson (1867), 2 Bond, 115; 3 Fisher, 343; Judson *v.* Moore (1860), 1 Fisher, 544; 1 Bond, 285.

That ambiguity may be removed by the oath or other parts of the application, see Pettibone *v.* Derringer (1818), 4 Wash. 215; 1 Robb, 152.

That if the Description has no apparent meaning when construed by the court, the patent is void, see Emerson *v.* Hogg (1845), 2 Blatch. 1.

That any ambiguity, which is sufficient to perplex persons skilled in the art, is fatal, see Page *v.* Ferry (1857), 1 Fisher, 298.

See also §§ 969, 970, 1034, 1035 and notes, *post*.

[5] That the Description must so disclose the invention that no further exercise of inventive skill is necessary in order to practise it, see Neilson *v.* Harford (1841), 1 Web. 331; Morgan *v.* Seaward (1836), 1 Web. 170; 2 Abb. P. C. 262; R. *v.* Arkwright (1785), 1 Web. 64; 1 Abb. P. C. 29.

That no further experiment must be needed to practise the invention, see Lockwood *v.* Faber (1886), 27 Fed. Rep. 63; Simpson *v.* Holliday (1865), 12 L. T. Rep. N. S. 99; Muntz *v.* Foster (1844), 2 Web. 96; McNamara *v.* Hulse (1842), 2 Web. 128; 1 Coll. 477; Neilson *v.* Harford (1841), 1 Web. 331; R. *v.* Wheeler (1819), 2 B. & Ald. 345; 1 Abb. P. C. 317; R. *v.* Arkwright (1785), 1 Web. 64; 1 Abb. P. C. 29.

§ 494. The Description: False Suggestion Fatal.

A wilful false suggestion or concealment, in any point material to the invention or to the mode of making or using it, is also fatal to the interests of the inventor. He is obliged to keep faith with the public; and as he seeks to obtain the widest protection which it is in their power to bestow, he is, in his turn, bound to confer on them his entire secret in its most available and beneficial form. If for the purpose of misleading them and securing some advantage to himself, he states in his Description less than the whole truth, or asserts that things are necessary to produce the desired effect when he knows that they are not so, the fact that some degree of benefit may be derived from what he has described will not prevent the forfeiture of all right to any patent for the invention.[1] Such wilful fraud is never presumed from any defect in the Description which can be otherwise accounted for, but is to be established by direct or circumstantial evidence.[2]

§ 495. The Description: its Form.

Subject to the foregoing rules, the Description is left to the judgment and choice of the inventor. No particular form of words is prescribed to him, though where two or more phrases

§ 494. [1] That a false suggestion in a material part of the specification avoids the patent, see Delano *v.* Scott (1834), Gilpin, 489; 1 Robb, 700; Simpson *v.* Holliday (1864), 20 Newt. L. J. N. S. 108; Galloway *v.* Bleaden (1839), 1 Web. 521; Bloxam *v.* Elsee (1825), 1 C. & P. 558; 1 Abb. P. C. 373.

That if the patent describes a false principle while the true one is disclosed to licensees, the patent is fraudulent and void, see Dyson *v.* Danforth (1865), 4 Fisher, 133.

That a concealment by which the patentee obtains an advantage over the public, if wilful, avoids the patent, see Heath *v.* Unwin (1852), 2 Web. 236; Tetley *v.* Easton (1852), Macrory, P. C. 48; Walton *v.* Bateman (1842), 1 Web. 613; Neilson *v.* Harford (1841), 1 Web. 295; Morgan *v.* Seaward (1836), 1 Web. 170; 2 Abb. P. C. 262; Lewis *v.* Marling (1829), 1 Web. 493; 1 Abb. P. C. 421; Crompton *v.* Ibbotson (1828), 1 Web. 83; 1 Abb. 394; Bovill *v.* Moore (1816), Dav. P. C. 361; 1 Abb. P. C. 231; Wood *v.* Zimmer (1815), 1 Web. 82; 1 Abb. P. C. 202; Turner *v.* Winter (1787), 1 Web. 77; 1 Abb. P. C. 43; R. *v.* Arkwright (1785), 1 Web. 64; 1 Abb. P. C. 29.

That if the Description asserts that things are necessary when they are known to the patentee to be useless, the patent is void, see Lewis *v.* Marling (1829), 1 Web. 493; 1 Abb. P. C. 421; Huddart *v.* Grimshaw (1803), 1 Web. 85; 1 Abb. P. C. 128; R. *v.* Arkwright (1785), 1 Web. 64; 1 Abb. P. C. 29.

See also § 969 and notes, *post.*

[2] See § 1034 and notes, *post.*

are open to his use the clearest and most easily understood is to be selected.[1] His modes of definition may vary according to the nature of the subject to which they relate, stating the characteristics and qualities of his invention in express language, or causing them to appear by necessary implication.[2] At the outset he should specify the particular art to which the invention appertains, and may then describe it either by concrete illustrations or the enumeration of its peculiar properties.[3] The old and the new may be distinguished from each other by separate delineations, or both may be embraced in one general Description and the line be subsequently drawn between them by the Claim; and in describing the old, if patented, the prior patent may be referred to and be incorporated by such reference into the new specification.[4] Words of recommendation may be used instead of words of direction, and will be regarded as essential parts of

§ 495. [1] In Wyeth *v.* Stone (1840), 1 Story, 273, Story, J.: (286) "I agree that the patentee is bound to describe, with reasonable certainty, in what his invention consists, and what his particular claim is. But it does not seem to me that he is to be bound down to any precise form of words; and that it is sufficient, if the court can clearly ascertain, by fair interpretation, what he intends to claim, and what his language truly imports, even though the expressions are inaccurately or imperfectly drawn." 2 Robb, 23 (36).

That where there is a choice of expressions the inventor must select the clearest, see *Ex parte* Gould (1876), 10 O. G. 203.

[2] That the language and definitions of a Description vary with the subject-matter, see Mowry *v.* Whitney (1872), 14 Wall. 620; 5 Fisher, 494; 1 O. G. 492.

That the ordinary meaning of words, such as "tempering," is governed by the general language of the specification, see Cary *v.* Lowell Mfg. Co. (1887), 40 O. G. 1239; 31 Fed. Rep. 344.

[3] That the Description ought to point out, at the beginning, the particular art, machine, article, or composition to which the invention relates, in order that the whole specification may be read as applicable thereto, see *Ex parte* Thompson (1879), 16 O. G. 588.

That concrete and illustrative descriptions are as proper as abstract ones, see Goodyear *v.* Railroad (1853), 2 Wall. Jr. 356; 1 Fisher, 626.

[4] That old parts may be distinguished from new by describing all and claiming the whole when so constructed as to produce the given effect, see Gottfried *v.* Phillip Best Brewing Co. (1879), 17 O. G. 675; 5 Bann. & A. 4.

That it is proper to describe the whole invention and point out what is new and what old, see Wintermute *v.* Redington (1856), 1 Fisher, 239.

That in distinguishing the new from the old the patentee is bound by the description as he gives it, see Goodyear *v.* Railroad (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

That a prior patent may be referred to in the Description to show differences between it and the present invention, see *Ex parte* Chubb (1872), 2 O. G. 519.

the Description or not, as the actual nature of the invention may require.[5] The application of a new natural force may be described either by describing the result with the mode of obtaining it, or by describing the means employed to produce it.[6] But indirect methods of description should not be re-

[5] In Sewall *v.* Jones (1875), 91 U. S. 171, Hunt, J.: (185) "Farther on, the patentee, Winslow, says, 'I recommend the following method.' This is not of the substance of the patent. A recommendation is quite different from a requirement. The latter is a demand, an essential, a necessity. The former is a choice or preference between different modes or subjects, and is left to the pleasure or the judgment of the operator. He may adopt it. He will do well if he does. But he may reject it, and still accomplish his object by means of the patent. The principle is this: The omission to mention in the specification something which contributes only to the degree of benefit, providing the apparatus would work beneficially and be worth adopting without it, is not fatal, while the omission of what is known to be necessary to the enjoyment of the invention is fatal. Curtis, sect. 248. An excess of description does not injure the patent, unless the addition be fraudulent. Id. sect. 250. Accordingly, when the inventor says, 'I recommend the following method,' he does not thereby constitute such method a portion of his patent. His patent may be infringed although the party does not follow his recommendation, but accomplishes the same end by another method." 9 O. G. 47 (49).

That the phrase "it is desirable, etc.," may make the thing referred to a part of the invention, see Klein *v.* Russell (1873), 19 Wall. 433.

[6] In Andrews *v.* Hovey (1883), 5 McCrary, 181, Shiras, J.: (193) "It is not necessary to extend these quotations to show that the principle which it is claimed constitutes the discovery or invention of Colonel Green, as described in the re-issued patent, is that the production of a vacuum in the earth by means of an air-tight tube driven into the earth, to which is attached a suction pump, will greatly increase the supply of water. To produce this vacuum it is necessary that the tube forming the lining of the well should be in such close contact with the surrounding earth as to be air-tight; and it is claimed that driving the tube into the ground, whether with or without originally perforating the earth with a rod, constitutes a mode of constructing a well which practically results in producing a well whose lining, — to wit, the tube — is in air-tight connection with the earth. In other words, in order to successfully apply the principle, it is absolutely essential that the tube forming the lining of the well should be in such close contact with the earth that the air cannot pass down around the outside of the tube, and the pump used in drawing up the water must also be attached to the end of the tube by an air-tight connection. Unless both of these conditions are fulfilled it is impossible to create a vacuum in the tube, and about the portion of it inserted in the water-bearing stratum; and as the creation of this vacuum is the essential and only means of applying the principle which it is claimed constitutes the chief merit of Colonel Green's invention or discovery, it follows that in order to protect such a discovery by a patent it must be included within the specifications. This may be done by either a proper description of the result to be obtained, with the mode

sorted to where the same degree of correctness and completeness is not attainable by them as might be reached by the direct.[7] General words describing an effect do not describe the cause, unless the cause and the effect are indissolubly connected and are commensurate with each other.[8] The description of a class of substances as an element in the invention is not correct except when each substance in the class will serve the purpose.[9] A device is not portrayed by the delineation of its mode of use, nor is the use itself described unless a practical rule is given by following which the desired result can be obtained.[10] In describing a generic

or means to be employed in producing the same, or by simply describing the means employed to accomplish the result; that is to say, it would be sufficient if it was stated that, by the use of certain prescribed means, a vacuum in and about the tube would be created, and thereby the supply of water would be increased, or if it was stated that the tubing of the well was so driven as to be made air-tight by contact with the surrounding earth, and the pump to be used was affixed to the tube by an air-tight connection. In the latter case the result reached or the principle put into operation would not be described; but as the means described must necessarily produce the result, or apply the principle, it is held sufficient to describe the means employed, without specifying the principle which is thereby brought into play. Indeed, it is not necessary that the inventor, to be entitled to a patent, should himself understand the abstract principle which his invention brings into use. It is sufficient if he is the inventor of a means whereby a new and useful application of the abstract principle is brought about. Still, as already remarked, it is necessary that in the patent and specifications the new and useful application of the principle must be described, either by setting forth the result obtained, with the means of its accomplishment, or else by such a description of the means employed as will, if followed, necessarily produce a result which embodies the practical application of the principle involved." 16 Fed. Rep. 387 (395); 26 O. G. 1011 (1014).

That it is not enough to describe a result, — its mode of attainment must be shown, — see Burrall *v.* Rumsey (1877), 13 O. G. 123.

That a product may be described by describing its mode of production if no clearer way exists, see Anilin *v.* Higgin (1878), 15 Blatch. 290; 14 O. G. 414; 3 Bann. & A. 462.

[7] That a Description is sufficient if it contains a proper designation of the invention, a clear statement of its parts, its operation, and its relation to surrounding matters, a distinct separation of the new from the old, and is followed by well-defined Claims, see *Ex parte* Thompson (1879), 16 O. G. 588.

[8] That general words indicating an effect become descriptive of the cause only when the cause invariably produces the effect, see *Ex parte* Carlock (1875), 8 O. G. 191.

[9] That if a class of substances be described as forming an element in the invention, the patent is void if any substance of the class will not answer the purpose, see Schneider *v.* Thill (1880), 5 Bann. & A. 565.

[10] That to describe a mode of use is

invention, one species of the genus must be also described, and more may be, though but one species can be claimed and covered by the patent.[11]

§ 496. The Description when the Invention is a Combination.

The general rules already stated are appropriate to the Description of all classes of inventions. Their application to particular classes has resulted in the establishment of subordinate rules in reference to each class, with the view of securing in its Description the necessary correctness, completeness, and intelligibility. These we shall now consider, commencing with those which relate to combinations. The essential features of a combination are its several elements and their co-operative law. Each of these must, therefore, be specifically described, and the drawings as well as the written matter must represent the elements in combination. This is no less imperative where the elements which enter into the combination are old and well known than where they are original with the inventor of the combination and have never been communicated to the public.[1] But beyond these essential features the Description need not go. The mechanism by which the elements of the combination are connected

not a description of the thing used, mans (1877), 94 U. S. 568; 11 O. G. 970.

That a vague description of a combination element or its total omission are vital defects of form, see *Ex parte* Mill (1887), 40 O. G. 918.

That a class of objects cannot be described as an element unless every object of that class will answer the purpose, see Schneider *v.* Thill (1880), 5 Bann. & A. 565; Turner *v.* Winter (1787), 1 Web. 77; 1 Abb. P. C. 43.

That where a specification confines the invention to one article as an element in a combination and says or implies that no other article will answer, no other article can be its equivalent, see Schillinger *v.* Cranford (1885), 4 Mackay, 450; 37 O. G. 1349.

see *Ex parte* Doten (1877), 12 O. G. 841.

That the Description must give a fixed rule which can be successfully followed, though variations from it may be possible in practice, see Tilghman *v.* Werk (1862), 1 Bond, 511; 2 Fisher, 229.

[11] That a specification for a generic invention need describe but one species, though it may describe more, see *Ex parte* Ewart (1880), 17 O. G. 448.

That constructions illustrating generic Claims, but not themselves the basis of any Claim, may be described, see *Ex parte* Howe (1883), 25 O. G. 1189.

§ 496. [1] That the specification of a combination of old elements must describe the old elements and the mode of combining them, see Merrill *v.* Yeo-

with each other, those parts of the entire device which are either useless or serve incidental purposes not within the scope of the co-operative law, and the general invention of which the present combination might be a subordinate factor, may be omitted, except when its description is required in order to render that of the new invention sufficiently intelligible.[2]

§ 497. The Description when the Invention is an Art.

The essential characteristics of an art reside in the acts of which it is composed. These acts must, therefore, be correctly, completely, and intelligibly described. Physical means of some kind being required for the performance of these acts, such means and the mode of using them must also be particularly delineated, unless from the nature of the acts described they are sufficiently obvious to those to whom the specification is addressed.[1] But the Description need not include all the different physical means by which the art may be exercised, nor declare all the modes in which such means may be employed, provided the art can be successfully practised by using the apparatus actually described according to the rule laid down by the inventor.[2]

[2] That useless parts of a combination are not elements, see *Ex parte* West (1872), 2 O. G. 30. See also § 278 and notes, *ante*.

That a Description is good though it includes useless parts, if it does not state that they are essential, see Lewis *v.* Marling (1829), 1 Web. 493; 4 C. & P. 56; 1 Abb. P. C. 421.

That where the elements of a combination are clearly pointed out, other particulars of construction do not belong in it as an invention, see Temple Pump Co. *v.* Goss Pump & Rubber Bucket Mfg. Co. (1887), 39 O. G. 467; 30 Fed. Rep. 440; 31 Fed. Rep. 292.

§ 497. [1] That the Description of an art must disclose the means, by which it can be successfully practised, with sufficient clearness to enable those skilled in the art to carry it into effect, unless such means are obvious, see The Telephone Cases (1888), 126 U. S. 1; 43 O. G. 377; Tilghman *v.* Proctor (1881), 102 U. S. 707; 19 O. G. 859; Downton *v.* Yaeger Milling Co. (1880), 5 Bann. & A. 112; 1 McCrary, 26; 1 Fed. Rep. 199; 17 O. G. 906; *Ex parte* Elbers (1877), 12 O. G. 2; Booth *v.* Kennard (1837), 2 H. & N. 84; Rex *v.* Wheeler (1819), 2 B. & Ald. 345; 1 Abb. P. C. 317; Boulton *v.* Bull (1795), 2 H. Bl. 463; 1 Abb. P. C. 59.

That the Description of a chemical process is not addressed to persons ignorant of chemistry, see Allen *v.* Hunter (1855), 6 McLean, 303; Heath *v.* Unwin (1852), 2 Web. 230.

[2] That where the Description of a process gives a fixed rule which can be successfully followed it is sufficient, though variations from it are possible,

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§ 498. The Description when the Invention is a Machine.

A machine is a mode of operation embodied in tangible materials. Its essence or principle is its structural law, and this must, therefore, be correctly and intelligibly explained. As this principle can be made available for use only by its expression in some actual mechanism, the best mode of constructing and employing such a mechanism must also be described. Every integral part of the machine, with its position and relation to the other parts, and with all those details of shape, proportion, and materials which are essential to the operation of the mechanism as a whole, should be delineated in such a manner as to distinguish the principle of this machine from those which underlie and govern all previous machines.[1] Other matters serve only the purposes of illustration, and may be omitted if the machine and its principle can be fully understood without them.[2]

see Tilghman *v.* Werk (1862), 1 Bond, 511 ; 2 Fisher, 229.

That a rule requiring heat "not less than 310°" does not limit the invention to that degree if the process is the same, see Buchanan *v.* Howland (1863), 2 Fisher, 341.

That where the Description of a chemical process uses terms applicable to several substances only one of which will answer, it is insufficient, see Anilin *v.* Levinstein (1884), L. R. 29 Ch. 366.

That where some heat is needed and no exact degree can be given because dependent on the condition of the substance treated, if a *maximum* and *minimum* are stated, the rest may be left to the judgment of the operator, see Mowry *v.* Whitney (1871), 14 Wall. 620 ; 5 Fisher, 494 ; 1 O. G. 492.

That a process may be described by describing either the result with the mode of obtaining it, or the means employed to produce it, see Andrews *v.* Hovey (1883), 16 Fed. Rep. 387 ; 5 McCrary, 181 ; 26 O. G. 1011.

That a process cannot be inferred by the court or the public from a description of its product, see Western Electric Co. *v.* Ansonia Co. (1885), 114 U. S. 447 ; 31 O. G. 1305.

§ 498. [1] That the Description of a machine is sufficient when it contains a proper designation of the invention, a clear description of its parts, its operation, and its relation to surrounding matters, a distinct separation of the new and old, and is followed by well-defined Claims, see *Ex parte* Thompson (1879), 16 O. G. 588.

That a Description of the mode of using a machine is not a Description of the machine itself, see *Ex parte* Doten (1877), 12 O. G. 841.

That the failure to describe an essential element renders the whole Description defective, see Carr *v.* Rice (1856), 1 Fisher, 198 ; Felton *v.* Greaves (1829), 3 C. & P. 611 ; 1 Abb. P. C. 416.

That a failure to describe an element embraced in the idea of the inventor, but without which the new machine will work, is not a fatal defect, see Carr *v.* Rice (1856), 1 Fisher, 198.

[2] In Page *v.* Ferry (1857), 1 Fisher, 298, Wilkins, J. : (307) "Where the

§ 499. **The Description when the Invention is a Manufacture.**

A manufacture is the most indefinite of all the different classes of inventions. Its essential qualities are, of course, those without which it would cease to be the particular invention that it now is; but what these qualities are it is often difficult to ascertain and to declare. Various methods of describing manufactures have therefore been adopted, to suit the varying character of these inventions. Where its essential qualities are discernible these may be enumerated, and if this can be so clearly and precisely done as not only to give a complete knowledge of the new manufacture, but also to distinguish it from all others, it is the best mode of describing it. Where this is impossible, the process by which the manufacture is produced may be particularly delineated and the manufacture described as the result of that peculiar process. If the manufacture is obtained by using chemicals, the substances employed and their mode of use may be stated and the nature of their product thus defined.[1] But in all cases

object of the patent may be obtained by a competent mechanic of ordinary skill, one acquainted with the structure of similar machines, or structures involving the same principle, by fairly following out the specifications and drawings, without other inventions or additions or experiment, the patent is valid and unimpeached, and the rule of law is sufficiently met."

In Brooks *v.* Jenkins (1844), 3 McLean, 432, the court say: (447) "The utmost precision in the Description of the machine is not to be expected, nor is it essential. Parts of machinery and processes generally known need not be described. A wedge, pulleys, rollers, rack and pinion, and other things, known to all mechanics, will be supplied by the mechanist without stating their size or structure. Nor is it essential to state the proportionate parts of a machine, nor the velocity of its operations. These are matters of adjustment for the eye and judgment of the constructor. Whether a machine be large in its parts or small, its motion slow or quick, makes no difference in the principle of it." See also Temple Pump Co. *v.* Goss Pump & Rubber Bucket Mfg. Co. (1887), 39 O. G. 467; 30 Fed. Rep. 440; Singer *v.* Walmsley (1860), 1 Fisher, 558; Crossley *v.* Beverly (1827), 1 Web. 106; 1 Abb. P. C. 409.

That the Description of a machine need not include modifications and appliances which practical use or their general knowledge would suggest to mechanics, see Union Paper Bag Co. *v.* Nixon (1873), 4 O. G. 31; 6 Fisher, 402.

That the phrase "vertical or nearly so" is certain enough for skilled mechanics, see Swift *v.* Whisen (1867), 2 Bond, 115; 3 Fisher, 343.

§ 499. [1] That a manufacture may be described by describing its mode of production, if no better way exists, see Anilin *v.* Higgin (1878), 15 Blatch. 290; 14 O. G. 414; 3 Bann. & A. 462.

That a product may be described and claimed as the result of a described pro-

the manufacture must, in some way, be fully explained and be distinguished from all other inventions, and this being done, other assertions regarding it are immaterial. Thus when the manufacture can be understood without it, the process or machine by which it is produced need not be mentioned;[2] and if their description is attempted, a defect therein will not impair the validity of that by which the manufacture is explained.[3]

§ 500. The Description when the Invention is a Composition of Matter.

A composition of matter is a group of ingredients intermingled in a specific manner and producing a specific result which has new properties of its own. Thus it presents three essential subjects for description: the ingredients, their mode of intermixture, and the resulting composition. Each of the ingredients must be completely and exactly described, either by the name given to it in the arts or by an enumeration of its qualities, or in some other way intelligible to those who are to use it. Nothing must be left to experiment either as to their nature or their number, and no substance should be specified as an ingredient unless it is essential to the composition, since the inventor will be so far concluded by it that he cannot claim that any composition is identical with his un-

cess or "any process which will produce a like result," see Pickhardt *v.* Packard (1884), 23 Blatch. 23; 30 O. G. 179; Anilin *v.* Higgin (1878), 15 Blatch. 200; 14 O. G. 414; 3 Bann. & A. 462.

That unless a product is so described that it can be recognized apart from the description of the process of making it the patent will cover it only when made by that process, see Cochrane *v.* Anilin (1884), 111 U. S. 293; 27 O. G. 813.

That if the manufacture as disclosed by the Description is useful it is sufficient, though if better described it could be made to be more useful, see McNamara *v.* Hulse (1842), Car. & M. 471; 2 Web. 129.

[2] That a Description of a manufacture need not describe the mode of producing it, see McCloskey's Application (1879), 3 MacArthur, 14; Cohn *v.* United States Corset Co. (1876), 93 U. S. 366; 11 O G. 457; Cohn *v.* United States Corset Co. (1874), 12 Blatch. 225; 1 Bann. & A. 340; 6 O. G. 259.

[3] That a specification may be sufficient for a product when it would not suffice if the invention were a machine, see Brass Co. *v.* Miller (1871), 5 Fisher, 48; 9 Blatch. 77.

That if the product be fully described and also the machine for making it, the description of the product will be sufficient though the machine prove useless, see Magic Ruffle Co. *v.* Douglass (1863), 2 Fisher, 330.

less it employs such substance or its equivalent.[1] In describing the mode of intermixture, the quantity and proportions of the several ingredients, and the process of compounding them, must be correctly and precisely stated. Here, also, nothing must be left open to be determined by experiment.[2] Where quantities and proportions must be exact in order to produce the composition, the Description must furnish this exact rule.[3] Where variations in proportions or quantity are

§ 500. [1] That ingredients must be so described that no further experiment to discover them will be needed, see Tyler *v.* Boston (1868), 7 Wall. 327; Wood *v.* Underhill (1847), 5 How. 1; 2 Robb, 588.

That the general description of a class of objects as ingredients is insufficient if one member of the class will not answer, see Bickford *v.* Skowes (1839), 1 Web. 214; Turner *v.* Winter (1787), 1 Web. 77; 1 Abb. P. C. 43.

That where "water" is mentioned as an ingredient any water must answer the purpose, see Keith *v.* Hobbs (1878), 69 Mo. 84.

That ingredients must be called by their usual names so as not to mislead, see Strutz *v.* De La Rue (1828), 1 Web. 83; 5 Russ. 323; 1 Abb. P. C. 399; Savory *v.* Price (1823), 1 Ry. & Mo. 1; 1 Web. 83; 1 Abb. P. C. 366.

[2] In Jenkins *v.* Walker (1872), Holmes, 120, Shepley, J.: (123) "When the specification of a new composition of matter gives only the names of the substances which are to be mixed together, without stating any relative proportion, undoubtedly it would be the duty of the court to declare the patent to be void; and the same rule would prevail when it was apparent that the proportions were stated ambiguously or vaguely; for in such cases it would be evident on the face of the specification that no one could use the invention without first ascertaining by experiment the exact proportions of the different ingredients required to produce the result intended to be obtained. The specification must be in such full, clear, and exact terms as to enable any one skilled in the art to which it appertains to compound and use the invention; that is to say, to compound and use it without making any experiments of his own." 1 O. G. 359 (361); 5 Fisher, 347 (351).

In Tyler *v.* Boston (1868), 7 Wall. 327, Grier, J.: (330) "Now a machine which consists of a combination of devices is the subject of invention, and its effects may be calculated *a priori*, while a discovery of a new substance by means of chemical combinations of known materials is empirical and discovered by experiment. Where a patent is claimed for such a discovery, 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.' The law requires the applicant for a patent right to deliver a written Description of the manner and process of making and compounding his new-discovered compound. The art is new; and therefore persons cannot be presumed to be skilled in it, or to anticipate the result of chemical combinations of elements not in daily use."

That the proportions of ingredients must be so described that no further experiment will be needed to discover them, see Wood *v.* Underhill (1847), 5 How. 1; 2 Robb, 588.

[3] That the phrase "about" in a

consistent with the attainment of the desired result, the limits of such variations must be definitely given.[4] If differences in the quality or strength of the ingredients as commonly found existing in the arts require differences of proportion, this must be disclosed and a rule given which can be practically followed. The intermixture of ingredients is an art or process, and must be described in the same manner as any other art, each act with the physical means for performing it being specified unless already obvious to those skilled in the art.[5] The composition itself may be described in the same method as a manufacture, either by enumerating its essential qualities, or where it is inseparably connected with the mode of production, by stating it as the result of the particular intermingling of the ingredients before described.[6] In these descriptions

Description is uncertain, and the quantity or degree named will be taken as exact, the word "about" being disregarded, see Davis *v.* Palmer (1827), 2 Brock. 298 ; 1 Robb, 518.

[4] That it is sufficient to describe the proportions of ingredients as lying within certain limits (e. g., "from ¼ lb. to 1 lb.") if any quantity within these limits will answer, see Goodyear *v.* Wait (1867), 5 Blatch. 468 ; 3 Fisher, 242.

That where the Description says that the proportions of ingredients may be varied, it does not cover all proportions, but only those within proximate limits, see Francis *v.* Mellor (1871), 5 Fisher, 153 ; 1 O. G. 48.

That the Description need not prescribe exact and unvarying proportions of ingredients, nor state that all the substances employed for collateral purposes (as coloring matter, etc.), if not true ingredients, must invariably be used, see Klein *v.* Russell (1873), 19 Wall. 433.

That if the Description states what the inventor considers the best proportions it is sufficient though others will answer, see Patent Type Founding Co. *v.* Richard (1859), 6 Jur. N. S. 39.

[5] That the Description must enable one skilled in the art to mix the ingredients, and produce the composition, without further experiment, see Jenkins *v.* Walker (1872), 5 Fisher, 347 ; 1 O. G. 359 ; Holmes, 120.

[6] In Goodyear *v.* Railroad (1853), 1 Fisher, 626, Grier, J. : (635) "If the patentee has set forth fully the materials, their various proportions, and the processes necessary to the production of this composition of matter, he has done all that the law requires, and should be entitled to its protection. The patent should be carefully examined to find the thing discovered, and if it be clearly set forth, the patentee should not suffer for the imperfection or vagueness of the language used in describing its true extent and nature." 2 Wall. Jr. 356 (364).

That a composition may be described by enumerating its qualities, see *Ex parte* Tweddle (1876), 10 O. G. 747.

That a composition may be described as the result of a described process when there is no clearer way of delineating it, see Anilin *v.* Higgin (1878), 15 Blatch. 290 ; 14 O. G. 414 ; 3 Bann. & A. 462 ; *Ex parte* Tweddle (1876), 10 O. G. 747 ; Goodyear *v.* Railroad (1853) 1 Fisher, 626 ; 2 Wall. Jr. 356.

That the patentee is not bound by

and directions the inventor may employ such technical terms as are customary in the art to which the composition belongs, however narrow may be the circle of persons familiar with that art;[7] a general rule, indeed, but one especially applicable to this class of inventions.

§ 501. The Description when the Invention is a Design.

A design is an appearance imposed upon some physical substance for the purpose of making a given impression on the eye. Being addressed particularly to the sense of sight, it would hardly be expected that a correct and complete idea of this invention could be conveyed to the mind through words, which, though perhaps read by the eye, are really addressed to the ear. Still, so far as practicable, the written Description of a design must point out its characteristic qualities and accurately distinguish between what is claimed as new and what is conceded to be old.[1] Taken in connection with the drawings, it must impart to the public a knowledge of the design and of the method of producing it, as complete and available as is required respecting other classes of inventions. Where the design embraces two configurations, as in the obverse and the reverse of the same article, both may and ought to be described.[2] But if the shape impressed upon the substance endows it with new mechanical properties, as well as with a new appearance, only the latter should be embraced in the Description;[3] the former, when constituting a new inven-

the qualities of his composition as given in the Description, but as they actually exist in the composition when produced according to his method, see Goodyear *v.* N. Y. Gutta Percha & India Rubber Vulcanite Co. (1862), 2 Fisher, 312.

[7] That the Description of a chemical composition is not addressed to persons ignorant of chemistry, see Allen *v.* Hunter (1855), 6 McLean, 303.

§ 501. [1] That a design can be delineated on paper, and known forms can be expressed in words, see *Ex parte* Traitel (1883), 25 O. G. 783.

That the Description of a design must be clear, exact, and particular, see *Ex parte* Niedringhaus (1874), 7 O. G. 171.

[2] That both the obverse and reverse of a design may be described, see *Ex parte* Diffenderfer (1872), 2 O. G. 57.

[3] That the Description of a design ought not to set forth the mechanical functions of the invention, see *Ex parte* Norton (1882), 22 O. G. 1205; *Ex parte* Diffenderfer (1872), 2 O. G. 57.

That a design application must confine itself to the characteristics of a design, not inserting those of a useful article, see *Ex parte* Traitel (1883), 25 O. G. 783.

tion, as it sometimes may, belonging to the class of manufactures, not designs.

§ 502. The Description when the Invention is an Improvement.

An improvement, although a complete invention in itself, is always dependent upon some original invention, without a knowledge of which, and of its relation to the improvement, the latter cannot be understood. The improvement in itself must, therefore, be described in all its essential characteristics like any other invention of its class; and in addition to this, the original invention, of whose idea of means this is a new development, must be delineated sufficiently to show the nature of the whole invention as improved.[1] With what

§ 502. [1] In Merrill *v.* Yeomans (1876), 94 U. S. 568, Miller, J.: (570) "When a man supposes he has made an invention or discovery useful in the arts, and therefore the proper subject of a patent, it is, nine times out of ten, an improvement on some existing article, process, or machine, and is only useful in connection with it. It is necessary, therefore, for him, in his application to the Patent Office, to describe that upon which he engrafts his invention, as well as the invention itself; and, in cases where the invention is a new combination of old devices, he is bound to describe with particularity all these old devices, and then the new mode of combining them, for which he desires a patent. It thus occurs that, in every application for a patent, the descriptive part is necessarily largely occupied with what is not new, in order to an understanding of what is new." 11 O. G. 970 (971).

In Isaacs *v.* Cooper (1821), 4 Wash. 259, Washington, J.: (261) "The last, and by no means the least fatal, objection is to the patent and specification, which are so manifestly defective that the court ought not to interpose until the plaintiff shall have established his right at law, if he can do so. The patent is for an improvement on the horizontal wheel invented by the plaintiff. But what the nature of the invention was, upon which this is alleged to be an improvement, is not stated. Was it patented; and if not, is there any other source of information to which others can resort in order to find it out, so as to enable them to distinguish the improvement from the original invention, and in that way to discover in what the improvement consists? Neither the patent or specification affords the slightest information upon those points. The invention alluded to may, for aught that appears, be known to no other person than the plaintiff. How, then, can any human being, however skilful in the art, find out with certainty or even conjecture in what the improvement consists from the patent itself, or from the records in the Patent Office? If the original invention had been patented, the specification should at least have referred to and plainly described it. If it was not, it should have stated what that invention was, and in what the improvement consists. As the matter stands, the nature of the improvement is altogether unintelligible." 1 Robb, 332 (335).

Further, that a specification for an

particularity the old invention is to be portrayed depends upon the knowledge which those skilled in the art already have concerning it, and the obviousness of the relation which subsists between it and the new improvement. To put the entire invention, old and new, before the public, and at the same time to distinguish clearly between the old and the new, in order that it may appear that the claims of the inventor to an exclusive right are limited to the improvement, is the object to be accomplished.[2] This must be done by the Descrip-

improvement must describe the original sufficiently to distinguish the improvement from it, see Wintermute *v.* Redington (1856), 1 Fisher, 239; Hovey *v.* Stevens (1846), 3 W. & M. 17; 2 Robb, 567; Brooks *v.* Jenkins (1844), 3 McLean, 432; Peterson *v.* Wooden (1843), 3 McLean, 248; 2 Robb, 110; Sullivan *v.* Redfield (1825), 1 Paine, 441; 1 Robb, 477; Dixon *v.* Moyer (1821), 4 Wash. 68; 1 Robb, 324; Knoass *v.* Schuylkill Bank (1820), 4 Wash. 9; 1 Robb, 303; Evans *v.* Hettick (1818), 3 Wash. 408; 1 Robb, 166; Evans *v.* Eaton (1818), 3 Wash. 443; 1 Robb, 193; Barrett *v.* Hall (1818), 1 Mason, 447; 1 Robb, 207; Lowell *v.* Lewis (1817), 1 Mason, 182; 1 Robb, 131.

That the exact new feature must be described, see Dangerfield *v.* Jones (1865), 13 L. T. Rep. N. S. 142.

That the Description must show wherein the improvement consists and not merely the device as improved, see Head *v.* Stevens (1838), 19 Wend. 411; Bovill *v.* Moore (1816), Dav. P. C. 361; 1 Abb. P. C. 231; McFarlane *v.* Price (1816), 1 Web. 74; 1 Abb. P. C. 227; Hornblower *v.* Boulton (1799), 8 T. R. 95; 1 Abb. P. C. 98; Williams *v.* Brodie (1785), Dav. P. C. 96; 1 Web. 75.

[2] In Evans *v.* Hettick (1818), 3 Wash. 408, Washington, J.: (425) "What then is the plaintiff's invention, as asserted by the plaintiff, conceded by the defendant, and sanctioned by the Supreme Court, in the case of Evans *v.* Eaton? The answer is, an improvement on the hopperboy, or an improved hopperboy, which that court have declared to be substantially the same. If this be so, then the section of the law before mentioned has declared that he must specify this improvement in full, clear, and exact terms. If he has not done so he has no valid patent on which he can recover. The English decisions correspond with the injunctions of our law. The American decisions, so far as we have any report of them, maintain the same doctrine. Mr. Justice Story, in the case of Lowell *v.* Lewis, lays it down that, 'if the patent be for an *improvement* in an existing machine, the patentee must in his specification distinguish the new from the old, and confine his patent to such parts only as are new; for, if both are mixed together, and a patent is taken for the whole, it is void.' What is the reason for all this? In the first place, it is to enable the public to enjoy the full benefit of the discovery, when the patentee's monopoly is expired, by having it so described upon record, that any person skilled in the art of which the invention is a branch may be able to construct it. The next reason is to put every citizen upon his guard, that he may not through ignorance violate the law, by infringing the rights of the patentee, and subjecting himself to the consequences of litigation.

tion and Claim in connection with the drawings and model, for it is not sufficient that by comparing the old and the im-

The inventor of the original machine, if he has obtained a patent for it, and all persons claiming under him, may lawfully enjoy the full benefit of that discovery, notwithstanding the improvement made upon it by a subsequent discoverer. If he has not chosen to ask for a monopoly, but abandons it to the public, then it becomes public property, and any person has a right to use it. The inventor of the improvement may also obtain a patent for his discovery, which cannot legally be invaded by the inventor of the original machine, or by any other person. The rights of each are secured by law, and there is no incompatibility between them. But if a man, wishing to use the original invention, and honestly disposed to avoid an infraction of the improver's right, is unable to ascertain from any certain and known standard where the original invention ends and where the improvement commences, how is it possible for him to exercise his own acknowledged right, freed from the danger of invading that of another? — and to what acts of oppression might not this lead? Might not the patentee of this mysterious improvement obtain from the ignorant, the timid, and even the prudent members of society, who wish to use the original discovery, the price he chooses to ask for a license to use his improvement, and in this way compel them to purchase it rather than incur expenses and inconveniences far greater than the sum demanded would pay for or compensate? If this may happen, then the improver enjoys in a degree the benefit of a discoverer both of the original machine and also of the improvement. In short, the patentee of the improvement may, to a certain extent, keep all others at arm's length as to the original invention, or make them pay him for it in derogation of the rights of the inventor of the original machine." 1 Robb, 100 (184).

In Evans *v.* Eaton (1818), 3 Wash. 443, *Washington, J.*: (452) "3. An improvement on a former machine. This is a fair subject for a patent, and the plaintiff has laid before you strong evidence to prove that his hopperboy is a more useful machine than the one which is alleged to have been previously discovered and in use. If, then, you are satisfied of this fact, the point of law which has been raised by the defendant's counsel remains to be considered; which is, that the plaintiff's patent for an improvement is void, because the nature and extent of his improvement are not stated in his specification. The patent is for an improved hopperboy, as described in the specification which is referred to and made part of the patent. Now, does the specification express in what his improvement consists? It states all and each of the parts of the entire machine, — its use and mode of operating; and claims as his invention the machine, the peculiar properties or principles of it, viz. the spreading, turning, and gathering the meal, and the raising and lowering of its arm by its motion to accommodate itself to the meal under it. But does this description designate the improvement, or in what it consists? Where shall we find the original hopperboy described, either as to its construction, operation, or use, or by reference to anything by which a knowledge of it may be obtained? Where are the improvements on such original stated? The undoubted truth is that the specification communicates no information whatever upon any of these points. This being so, the law as to ordinary cases is clear that the plaintiff cannot recover for an improvement.

proved inventions, as they exist practically in the arts, the

The first section of the general Patent Law speaks of an improvement as an invention, and directs the patent to issue for his said invention. The third section requires the applicant to swear, or affirm, that he believes himself to be the true inventor of the art, machine, or improvement for which he asks a patent; and further, that he shall deliver a written Description of his invention, in such full, clear, and exact terms that any person acquainted with the art may know how to construct and use the same, etc. That it is necessary to the validity of a patent that the specification should describe in what the improvement consists is decided by Mr. Justice Story, in the cases referred to in the appendix to 3 Wheaton, and in the English cases of Boulton *v.* Bull, Boville *v.* Moore, McFarlane *v.* Price, Harmar *v.* Playne, and perhaps some others. What are the reasons upon which this doctrine is founded? They are to guard the public against unintentional infringements of the patent during its continuance, and to enable an artist to make the improvement by a reference to some known and certain authority, to be found among the records in the office of the Secretary of State, after the patent has run out. But it is contended by the plaintiff's counsel, that the law would be unreasonable to require, and therefore that it does not require, this to be done, unless the improvement is upon a *patented* machine, a description of which can be obtained by a reference to the records of the office of the Secretary of State, — that it might often be impossible for the patentee to discover, and consequently to describe, the parts of a machine in use, perhaps, only in some obscure part of the world. The answer to this is that an improvement necessarily implies an original, and unless the patentee is acquainted with the original which he supposes he has improved, he must talk idly when he calls his invention an improvement. If he knows nothing of an original, then his invention is an original, or nothing; and the subsequent appearance of an original, to defeat his patent, is one of the risks which every patentee is exposed to under our law. As to the supposed distinction between an improvement on a machine patented and one not so, there is nothing in it. In both cases the improvement must be described, but with this difference, — that in the former case it may be sufficient to refer to the patent and specification for a description of the original machine, and then to state in what the improvements on such original machine consist — whereas in the latter case it would be necessary to describe the original machine and also the improvement. The reason for this distinction is too obvious to require explanation." 1 Robb, 193 (203).

That the specification of an improvement need not describe the original further than is necessary to understand the new matter, see Many *v.* Jagger (1848), 1 Blatch. 372; Emerson *v.* Hogg (1845), 2 Blatch. 1; Harmar *v.* Playne (1809), 11 East, 101; 1 Abb. P. C. 171.

That if the original is well known it need not be particularly described, nor even the mode of attaching the improvement to it if this is apparent without description, see Loom Co. *v.* Higgins (1882), 105 U. S. 580; 21 O. G. 2031.

That the Description must distinguish the old from the new, and binds the patentee as he makes it, see Goodyear *v.* Railroad (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

That in order to distinguish old parts from new the specification may describe each and all the parts and then claim the whole when so constructed as to

nature of the latter and its characteristic differences from the former could be ascertained.[3]

§ 503. The Description: its Sufficiency a Question of Fact.

The sufficiency of the Description is a question of fact, to be investigated by experience, elucidated by evidence, and decided by a jury.[1] Only persons skilled in the art are usually capable of judging whether its delineations are correct, complete, and intelligible, and whether from it alone they could construct and use the invention. The inventor, having adopted it as his method of communicating his discovery to the public as represented by such persons, is bound by it and must abide the result of their endeavors to make the art or instrument available for practical use by following the directions he has given. But where a Description is, upon

produce the given effect, see Gottfried *v.* Phillip Best Brewing Co. (1879), 17 O. G. 675; 5 Bann. & A. 4.

That an application for an improvement must distinguish it from the original but need not disclaim the original, see *Ex parte* Firm (1887), 39 O. G. 1199.

[3] That the specification for an improvement must describe its nature and extent, and it is not sufficient that by comparing the old and the improved machines the difference might be detected, see Evans *v.* Eaton (1822), 7 Wheat. 356; 1 Robb, 336; Foxwell *v.* Bostock (1864), 10 L. T. Rep. N. S. 144.

§ 503. [1] In Forbes *v.* Barstow Stove Co. (1864), 2 Clifford, 379, Clifford, J.: (392) "The specifications are required for two principal purposes: first to inform the public what the thing is of which the patentee claims to be the inventor; and, secondly, to enable the public, after the expiration of the patent, to practise the invention from the specification, as therein described. Whether the patentee has described the subject-matter, or what he claims to have invented, so as to enable the public to know what his claim is, is in general a question of law for the court on the construction of the patent. Cur. on P. § 130, p. 130. But whether he has described the invention in such full, clear, and exact terms as to enable the public to practise it from the specification *is in general a question of fact* to be determined, in common-law cases, by a jury. The act of Congress does not require the patentee to address himself to the uninformed upon the particular subject, but allows him to speak to persons of competent skill in the art; and it only 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 given in the specification."

See also Page *v.* Ferry (1857), 1 Fisher, 298; Reutgen *v.* Kanowrs (1804), 1 Wash. 168; 1 Robb, 1; Morton *v.* Middleton (1863), 1 Cr. S. 3d Series, 721; Wallington *v.* Dale (1852), 7 Exch. 888; Beard *v.* Egerton (1848), 19 L. J. C. P. 38; Walton *v.* Bateman (1842), 1 Web. 613; Neilson *v.* Harford (1841), 1 Web. 295; Bickford *v.* Skewes (1839), 1 Web. 214; Hill *v.* Thompson (1817), 1 Web. 235; 1 Abb. P. C. 299.

its face, so incomplete or unintelligible as to be evidently useless for purposes of public information, the court may decline to hear the testimony of witnesses and on its own judgment declare the patent void.[2]

SECTION VI.

OF THE APPLICATION: THE CLAIM.

§ 504. The Claim: its Objects and General Requisites.

It is the office of the Claim to define the limits of that exclusive use which is secured to the inventor by the patent, and thus to draw the line between those arts or instruments that are open to the public, and those whose employment by it is forbidden until the patent has expired. The Claim is, therefore, an essential part of the specification; and without it one of the two great purposes of that instrument would remain unfulfilled.[1] Hence the statutes require not only that the inventor shall fully *describe* his invention in the specification, so that any person skilled in the art can practise it, but also that he shall "particularly point out and distinctly *claim* the part, improvement, or combination which he claims as his invention or discovery." And the rules of the Patent Office prescribe that the specification shall conclude with a specific and distinct Claim or Claims of every separate sub-

[2] In Wood *v.* Underhill (1847), 5 How. 1, Taney, C. J.: (4) "In patents for machines the sufficiency of the Description must, in general, be a question of fact to be determined by the jury. And this must also be the case in compositions of matter where any of the ingredients mentioned in the specification do not always possess exactly the same properties in the same degree. But when the specification of a new composition of matter gives only the names of the substances which are to be mixed together, without stating any relative proportion, undoubtedly it would be the duty of the court to declare the patent to be void. And the same rule would prevail where it was apparent that the proportions were stated ambiguously and vaguely." 2 Robb, 588 (593).

See also Brooks *v.* Jenkins (1844), 3 McLean, 432.

§ 504. [1] That where there is no Claim there is no application, see *Ex parte* Lasscell (1884), 28 O. G. 1274; 29 O. G. 861; *Ex parte* Holt (1884), 29 O. G. 171.

That a thing is not claimed when shown only in the drawings and not in the Description or Claim, see Couse *v.* Johnson (1879), 16 O. G. 719.

ject-matter that the applicant desires to protect by the patent for which he has applied.[2]

§ 505. The Claim the Life of the Patent and the Measure of the Patent Privilege.

The Claim is thus the life of the patent so far as the rights of the inventor are concerned, and by it the letters-patent, as a grant of an exclusive privilege, must stand or fall.[1] The

[2] That each Claim is an independent patent, see Celluloid Mfg. Co. *v.* Zylonite Brush & Comb Co. (1880), 27 Fed. Rep. 201; 35 O. G. 1228; United Nickel Co. *v.* California Electrical Works (1885), 25 Fed. Rep. 475; 11 Sawyer, 250.

§ 505. [1] In Railroad Co. *v.* Mellon (1881), 104 U. S. 112, Woods, J.: (117) "The act of July 4, 1836, c. 357 (5 Stat. 117), under which this patent was issued, requires that an applicant for a patent shall not only 'deliver a *written description of his invention or* discovery,' but 'shall also particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery.' This provision is substantially re-enacted in the act of July 8, 1870, c. 230 (16 Stat. 198), Rev. Stat. sect. 4888, and remains in force. As a rule, therefore, the specification filed with the application for letters-patent contains a general Description of the invention sought to be patented, which is followed by what is technically called the 'Claim.' In reference to this latter part of the specification this court, speaking by Mr. Justice Bradley, has said: 'It is well known that the terms of the Claim in letters-patent are carefully scrutinized in the Patent Office. Over this part of the specification the chief contest generally arises. It defines what the Office, after a full examination of previous inventions and the state of the art, determines the applicant is entitled to.' Burns *v.* Meyer, 100 U. S. 671. See also Keystone Bridge Co. *v.* Phœnix Iron Co., 95 id. 274, 278. In view, therefore, of the statute, the practice of the Patent Office, and the decisions of this court, we think that the scope of letters-patent should be limited to the invention covered by the Claim, and that though the Claim may be illustrated, it cannot be enlarged by the language used in other parts of the specification." 20 O. G. 1891 (1892).

In Masury *v.* Anderson (1873), 11 Blatch. 162, Blatchford, J.: (165) "The rights of the plaintiff depend upon the Claim in his patent, according to its proper construction, and not upon what he may erroneously suppose it covers. If at one time he insists on too much, and at another on too little, he does not thereby work any prejudice to the rights actually secured to him." 6 Fisher, 457 (460); 4 O. G. 55 (56).

In Pitts *v.* Wemple (1855), 1 Bissell, 87, Drummond, J.: (90) "The Patent Law requires the inventor to set forth the nature and extent of his discovery, so that, by referring to his letters-patent, a mechanic of competent skill may be able, in the state of the art as then understood, to construct the machine or improvement, if the invention relate to a machine. And he must particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery. He is restricted to this Claim. It is true that the whole patent, including specifications and drawings, is to be taken into considera-

thing patented is the thing claimed, whatever the patentee may suppose or assert that he has invented; and though the statement of the Claim comes short of the true limits of the invention, the inventor must abide by them, as he has described and published them in this written definition of its character and scope.[2] The courts will not go into the history of the art

tion, but we look at them only for the purpose of placing a proper construction upon the Claim." 2 Fisher, 10 (13).

That a patent must stand or fall by its Claims, see Meissner *v.* Devoe Mfg. Co. (1872), 2 O. G. 545; 5 Fisher, 285; 9 Blatch. 383; Parker *v.* Sears (1850), 1 Fisher, 93.

That where the only patentable feature in the invention is dormant and unclaimed the patent is invalid, see Ingham *v.* Pierce (1887), 31 Fed. Rep. 822; 42 O. G. 1062.

That the scope of a patent is governed by the Claim, see Yale Lock Co. *v.* Greenleaf (1880), 117 U. S. 555; 35 O. G. 386; *Ex parte* Holt (1884), 29 O. G. 171.

That if the Claim does not define the invention the courts can give no relief, see Delaware Coal & Ice Co. *v.* Packer (1880), 24 O. G. 1273; 1 Fed. Rep. 851; 5 Bann. & A. 296.

That the identity of patents is determined by their Claims, see Adams *v.* Bellaire Stamping Co. (1886), 28 Fed. Rep. 360; 36 O. G. 567; McMillin *v.* Rees (1880), 17 O. G. 1222; 1 Fed. Rep. 722; 5 Bann. & A. 269.

That where a Claim sets forth a certain arrangement as essential, no other arrangement is the same invention, see Tate *v.* Thomas (1885), 30 O. G. 345.

[2] That the invention patented is the invention set forth in the Claim, and that only, see Toohey *v.* Harding (1880), 4 Hughes, 253; 1 Fed. Rep. 174; McMillin *v.* Rees (1880), 5 Bann. & A. 269; 17 O. G. 1222; 1 Fed. Rep. 722; Delaware Coal & Ice Co. *v.* Packer (1880), 5 Bann. & A. 296; 24 O. G. 1273; 1 Fed. Rep. 851; *Ex parte* Emerson (1880), 17 O. G. 1451; Couse *v.* Johnson (1879), 4 Bann. & A. 501; 16 O. G. 719; *Ex parte* Locke (1879), 16 O. G. 1140; Keystone Bridge Co. *v.* Phœnix Iron Co. (1877), 95 U. S. 274; 12 O. G. 980; Welling *v.* Rubber Coated Harness Trimming Co. (1875), 2 Bann. & A. 1; 7 O. G. 608; Fuller *v.* Yentzer (1874), 6 Bissell, 203; 1 Bann. & A. 520; Wheeler *v.* McCormick (1873), 4 O. G. 602; 6 Fisher, 551; 11 Blatch. 334; Brown *v.* Hinkley (1873), 3 O. G. 384; 6 Fisher, 370; Rich *v.* Close (1870), 4 Fisher, 270; 8 Blatch. 41; Haselden *v.* Ogden (1868), 3 Fisher, 378; Blake *v.* Stafford (1868), 3 Fisher, 294; 6 Blatch. 195; Hayden *v.* Suffolk Mfg. Co. (1862), 4 Fisher, 80; Morris *v.* Barrett (1859, 1 Bond, 254; 1 Fisher, 461; Johnson *v.* Root (1858), 1 Fisher, 351; Sickels *v.* Gloucester Mfg. Co. (1856), 1 Fisher, 222; Rich *v.* Lippincott (1853), 2 Fisher, 1; O'Reilly *v.* Morse (1853), 15 How. 62; Kneass *v.* Schuylkill Bank (1820), 4 Wash. 9; 1 Robb, 303.

That the claimed invention alone is covered by the patent, though it be less than the real invention, see Brass Co. *v.* Miller (1871), 5 Fisher, 48; 9 Blatch. 77; Kidd *v.* Spence (1859), 4 Fisher, 37; Detmold *v.* Reeves (1851), 1 Fisher, 127.

That parts which are indispensable to the invention are not covered by the patent unless mentioned in the Claim, see McMillin *v.* Rees (1880), 5 Bann. & A. 269; 17 O. G. 1222; 1 Fed. Rep. 722.

That if a patentee inserts an unes-

to ascertain what he has really discovered and what he might have patented if he had chosen, but will take him at his word and protect him according to the terms in which he has himself demanded such protection.[3] Even where he confines the language of his Claim to a mere reference to the letters affixed to the drawings, the rigidity of the rule is not relaxed, and only the devices shown in the drawings thus referred to are regarded as constituting his invention.[4]

sential feature in his Claim he cannot afterwards deny its materiality, see Le Fever *v.* Remington (1882), 21 Blatch. 80; 22 O. G. 1537; 13 Fed. Rep. 86.

[3] In Keystone Bridge Co. *v.* Phœnix Iron Co. (1877), 95 U. S. 274, Bradley, J.: (278) "*When a Claim is so* explicit, the courts cannot alter or enlarge it. If the patentees have not claimed the whole of their invention, and the omission has been the result of inadvertence, they should have sought to correct the error by a surrender of their patent and an application for a re-issue. They cannot expect the courts to wade through the history of the art, and spell out what they might have claimed, but have not claimed. Since the act of 1836, the patent laws require that an applicant for a patent shall not only, by a specification in writing, fully explain his invention, but that he 'shall particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery.' This provision was inserted in the law for the purpose of relieving the courts from the duty of ascertaining the exact invention of the patentee by inference and conjecture, derived from a laborious examination of previous inventions, and a comparison thereof with that claimed by him. This duty is now cast upon the Patent Office. There his Claim is, or is supposed to be, examined, scrutinized, limited, and made to conform to what he is entitled to. If the Office refuses to allow him all that he asks, he has an appeal. But the courts have no right to enlarge a patent beyond the scope of its Claim as allowed by the Patent Office, or the appellate tribunal to which contested applications are referred. When the terms of a Claim in a patent are clear and distinct (as they always should be), the patentee, in a suit brought upon the patent, is bound by it. Merrill *v.* Yeomans, 94 U. S. 568. He can claim nothing beyond it. . . . (279) As patents are procured *ex parte*, the public is not bound by them, but the patentees are. And the latter cannot show that their invention is broader than the terms of their Claim; or, if broader, they must be held to have surrendered the surplus to the public." 12 O. G. 980 (981).

That the court will not go into the history of the art, but will abide by the Claims, see James *v.* Campbell (1882), 104 U. S. 356; 21 O. G. 337.

That the court will not enlarge the Claim by the Description, see Yale Lock Co. *v.* Greenleaf (1886), 117 U. S. 554; 35 O. G. 386; Lehigh Valley R. R. Co. *v.* Mellon (1881), 104 U. S. 112; 20 O. G. 1891.

[4] That if a Claim is a mere reference to the drawings, only the device shown in the drawings is protected, see *Ex parte* Marsh (1872), 2 O. G. 197.

§ 506. The Claim: its Effect, as an Abandonment or otherwise, upon the Matter not Claimed.

As a consequence of this limitation of the patent to the matter claimed, all matters not claimed are considered as excluded from the particular invention which forms the subject of the application. It has been sometimes stated that a failure to claim an art or device admits it to be old;[1] or, if it is really new, that the omission to protect it abandons it to the public.[2] These statements need qualification. From the nature of the invention itself all that is essential to it must be new, and it can properly be claimed only by excluding all that is old. But it does not follow that other features, described in the specification and omitted from the Claim, are already known to the public; for it may often happen that each one of several new inventions can be understood only by describing it in connection with the others. Nor is it true that by thus describing and not claiming any one of them, the inventor, *ipso facto*, dedicates it to the public use. He is at liberty to patent each of them, if he desires to do so, either in separate patents, or in the same patent when their joinder would be consistent with the rules relating to that subject; and the patenting of one before he makes an application for the others cannot be regarded as abandoning the rest unless this be his intention, as shown by all the circumstances of

§ 506. [1] That to describe and not claim admits the unclaimed matter to be old, see Rowell *v.* Lindsay (1881), 19 O. G. 1565; 10 Bissell, 217; 6 Fed. Rep. 290; Corn Planter Patent (1874), 23 Wall. 181; 6 O. G. 392; Kirby *v.* Dodge & Stevenson Mfg. Co. (1872), 10 Blatch. 307; 6 Fisher, 156; 3 O. G. 181; Conover *v.* Roach (1857), 4 Fisher, 12; Winans *v.* N. Y. & Erie R. R. Co. (1856), 1 Fisher, 213.

[2] That failure to claim described matter dedicates it to the public, see Swift *v.* Jenks (1884), 19 Fed. Rep. 641; 27 O. G. 621; Miller *v.* Brass Co. (1881), 104 U. S. 350; 21 O. G. 201; Giant Powder Co. *v.* California Vigorit Powder Co. (1880), 18 O. G. 1339; 6 Sawyer, 508; 4 Fed. Rep. 720; Batten *v.* Taggert (1851), 2 Wall. Jr. 101.

That the claiming of one specific device, and the omission to claim others which are apparent on the face of the specification, is an abandonment of the latter, see Hill *v.* Commissioner (1885), 33 O. G. 757; 4 Mackay, 266.

That the claiming of a specific device, and an omission to claim other devices apparent on the face of the Description, is a dedication of the latter, unless the patentee surrenders, proves inadvertence, etc., and re-issues with due diligence, see Combined Patents Can Co. *v.* Lloyd (1882), 15 Phila. 481; 21 O. G. 713; 11 Fed. Rep. 149; Miller *v.* Brass Co. (1881), 104 U. S. 350; 21 O. G. 201.

the case or by that public use or sale from which the law presumes such an abandonment. To describe and not to claim is a proper method of admitting that to be old which really is old. It is also a proper method of abandoning new inventions to the public, when such is the evident intention of the inventor. It is also a proper method of distinguishing the new invention, which forms the subject-matter of the present application, from other new inventions which are to be the subjects-matter of future applications.[3] The sole inevitable conclusion from the omission is that the omitted features do not enter into the essence of the present invention, and are not claimed as protected by the present patent.[4] What further conclusions may be drawn from it depends on other considerations, relating either to the novelty of the omitted feature in itself, or to its actual or presumed abandonment by its inventor.

§ 507. The Claim: its Form and Contents Governed by Strict Rules.

The paramount importance of the Claim, and the necessity for such exactness and completeness in its statements as will precisely define the invention to be protected by the patent, have led to the establishment of numerous rules for framing it, some of which are common to all classes of inventions, while others have reference to particular classes. These

[3] That to describe and not claim is a method of postponing the unclaimed matter for a future patent, see *Ex parte* Emerson (1880), 17 O. G. 1451; Giant Powder Co. *v.* California Vigorit Powder Co. (1880), 18 O. G. 1339; 6 Sawyer, 508; 4 Fed. Rep. 720; Corn Planter Patent (1874), 23 Wall. 181; 6 O. G. 392.

That the description of a process in an application for a machine patent does not abandon the process to the public if the process patent be applied for within two years, see Eastern Paper Bag Co. *v.* Standard Paper Bag Co. (1887), 30 Fed. Rep. 63; 41 O. G. 231.

That where an applicant intends to obtain a future patent for the matter described but not claimed in the present application, he must expressly reserve in this one the right to do so, and apply for the other within a reasonable time, see *Ex parte* Roberts (1887), 40 O. G. 573; Adams *v.* Bellaire Stamping Co. (1886), 28 Fed. Rep. 360; 36 O. G. 567; *Ex parte* Derby (1884), 26 O. G. 1208; James *v.* Campbell (1882), 104 U. S. 353; 21 O. G. 337.

[4] That a failure to claim described matter simply excludes it from the patent, leaving it to be covered by a subsequent patent or not, at the option of the inventor without any previous reservation, see Corn Planter Patent (1874), 23 Wall. 181; 6 O. G. 392; and cases cited in the notes to §§ 465, 466, *ante*.

general rules relate to the contents, the form, the joinder, and the construction of Claims. Those which govern the contents of a Claim, prescribing what it must include, what it must omit, and what may be included or omitted at the option of the inventor, will be first discussed.

§ 508. The Claim must Claim a Practically Operative Means.

Every Claim must set forth and claim a practically operative means.[1] An inventor is not obliged to claim all that he may have invented.[2] His idea of means may be susceptible of different stages of development, the more advanced of which it may not yet seem proper to him to disclose. Or his invention may embrace subordinate inventions, which he may determine either to surrender to the public or to reserve for the protection of future patents. But he must, at least, so far describe and claim what he has invented as to place before the public, and to ask protection for, some art or instrument capable of practical use.[3] Nothing less than this is a patentable invention, and no Claim can be sustained unless

§ 508. [1] That a Claim must be for an operative means, see *Ex parte* Cornell (1872), 1 O. G. 573; American Pin Co. *v.* Oakville Co. (1854), 3 Blatch. 190.

That a Claim for certain devices as the means for producing a certain result is proper, though under some circumstances they will not so operate, see Wheeler *v.* Clipper Mower & Reaper Co. (1872), 10 Blatch. 181; 6 Fisher, 1; 2 O. G. 442.

[2] That the Claim may be as narrow as the patentee chooses, if it covers an operative means, see *Ex parte* Emerson (1880), 17 O. G. 1451; Russell & Erwin Mfg. Co. *v.* Mallory (1872), 2 O. G. 495; 5 Fisher, 632; 10 Blatch. 140.

That the inventor need not claim all he describes, though new, provided that which he claims will operate apart from the rest, though thereby he may secure the whole, see *Ex parte* Sturges (1872), 1 O. G. 204.

That a Claim for an entire invention will be taken as covering all that is described as entering into the invention unless the Claim itself shows the contrary, see Evans *v.* Kelly (1880), 5 Bann. & A. 71; 9 Bissell, 251; 23 O. G. 192; 13 Fed. Rep. 903; Tetley *v.* Easton (1883), Macrory's P. C. 82.

[3] That the Claim must be for matter so described that any one skilled in the art can use it, see Vogler *v.* Semple (1877), 11 O. G. 923; 7 Bissell, 382; 2 Bann. & A. 556.

That an article patentable only when used in certain connections must be claimed only as to such connections, see Stewart *v.* Mahoney (1876), 5 Fed. Rep. 302; 4 Bann. & A. 84.

That the occasional accidental operation of a device, varying from its usual operation, and inconsistent with its principle, is not a basis for a Claim for a device uniformly producing similar effects, see Voelker *v.* Gray (1885), 30 O. G. 1091.

the exclusive privilege which it endeavors to define is one which can lawfully be granted.

§ 509. The Claim must Claim a Concrete Art or Instrument.

Again, every Claim must be for a concrete invention. Patents are not granted for the protection of abstract ideas or scientific theories, but for practical arts to be performed, or for physical instruments available for use on physical objects.[1] Underlying every invention is the idea of means of which the operative art or instrument is the tangible embodiment; and ultimately this idea of means receives complete protection from the patent. But the thing patented is the concrete expression of this idea, the art or mechanism or product in which the idea is reduced to practice; and it is this which must be set forth in the Claim, in distinction from the discovery or conception which it embodies.

§ 510. The Claim must Claim a Single and Distinct Invention.

Again, every Claim must be confined to some single and distinct invention. Two arts or instruments cannot be embraced in one Claim.[1] Where a general invention is capable of modifications which differ substantially from each other, embodying different ideas of means or the same idea in different stages of development, each one of these is a distinct invention, and if claimed at all must be claimed separately

§ 509. [1] That the Claim must state a concrete invention, not an abstraction, see *Ex parte* Designolle (1877), 13 O. G. 227; Burr *v.* Duryee (1863), 1 Wall. 531.

That the Claim must not cover a principle, see *Ex parte* Fairbanks (1873), 3 O. G. 65; Burr *v.* Duryee (1863), 1 Wall. 531; Walton *v.* Bateman (1842), 1 Web. 613.

That a Claim for the use of a natural force for a special purpose is improper, — the special method of using it for such purpose must alone be claimed, — see O'Reilly *v.* Morse (1853), 15 How. 62.

That general truths and forces belong to all men, and cannot be claimed, see Opinion Atty. Gen. (1856), 8 Op. At. Gen. 269; Detmold *v.* Reeves (1851), 1 Fisher, 127.

See §§ 133–143 and notes, *ante*.

§ 510. [1] That but one invention can be embraced in a single Claim, see *Ex parte* Bland (1879), 15 O. G. 775.

That a process and its product cannot be embraced in a single Claim, see *Ex parte* Bates (1879), 16 O. G. 266; Merrill *v.* Yeomans (1874), 1 Bann. & A. 47; 5 O. G. 267; Holmes, 331.

That a machine and its product, an art and its apparatus, etc., cannot be covered by one Claim, see *Ex parte* Bates (1879), 16 O. G. 266.

from the rest. When the parts of a device, as well as the device itself, are new inventions, the device as a whole and each subordinate part of it must be made the subject of as many separate Claims. Thus every Claim becomes complete within itself; exactly commensurate with the single invention it purports to cover, and capable of being allowed or disallowed in the Patent Office, and sustained or defeated in the courts, without prejudice to any other invention than the one therein specifically described.

§ 511. The Claim must Indicate the Class of Patentable Inventions to which the Claimed Invention Belongs.

Again, every Claim must define the invention it includes in such a manner as to indicate the class of inventions to which it belongs. While the Claim need not state in terms whether the invention claimed is an art, a machine, a manufacture, a composition of matter, a design, or an improvement, it must be apparent to which of these great classes the invention does pertain.[1] Thus, if the real invention is an art or process, it must be claimed as such and not as the means by which the art is practised, nor as the product in which it results.[2] If it is a machine, the mechanism, not the mode of operating it, is the true subject-matter of the Claim.[3]

§ 512. The Claim must Precisely Define the Invention Claimed.

Again, every Claim must precisely define the exact limits of the invention claimed.[1] This may be done by the enumeration

§ 511. [1] That the Claims of a patent must clearly show whether the claimed invention is an art, machine, manufacture, composition, design, or improvement, see *Ex parte* Mayall (1873), 4 O. G. 210.

[2] That an apparatus must be claimed as such, not as a means for practising the art, see *Ex parte* Bates (1879), 16 O. G. 266.

That the exact invention, not the art of using it, must be claimed, see *Ex parte* Cornell (1872), 1 O. G. 573.

[3] That a machine must be claimed as such, not as a "mode of operation," see Hatch *v.* Moffitt (1883), 15 Fed. Rep. 252; Burr *v.* Duryee (1863), 1 Wall. 531.

That where an effect is produced by mechanical means, the means should ordinarily be claimed as a machine or manufacture, not as a process, see Piper *v.* Brown (1870), 4 Fisher, 175; Holmes, 20. See also § 529 and notes, *post.*

§ 512. [1] That the claimed invention must be precisely and completely covered by the Claim, see *Ex parte* Thompson (1879), 16 O. G. 588; *Ex parte*

of its essential characteristics, or, when these are fully stated in the Description, by such a delineation of the invention *claimed as identifies it with the one described.*[2] When the invention is a complete art or instrument, new and patentable in itself without relation to other things, it must be claimed as such without any reference to the objects or the purposes for which it may be employed.[3] On the other hand, where

Funck (1878), 14 O. G. 158; Scott *v.* Ford (1878), 14 O. G. 413; Merrill *v.* Yeomans (1877), 94 U. S. 568; 11 O. G. 970; *Ex parte* Hopper (1872), 2 O. G. 4; Davis *v.* Bell (1837), 8 N. H. 500; Whittemore *v.* Cutter (1813), 1 Gallison, 478; 1 Robb, 40; Rushton *v.* Crawley (1870), L. R. 10 Eq. 522; Gibson *v.* Brand (1842), 1 Web. 613; Carpenter *v.* Smith (1841), 1 Web. 530.

That each substantially different modification of the invention which the inventor intends to protect must be definitely described, see Sargent *v.* Carter (1857), 1 Fisher, 277.

That if the patentee intends to claim only a part of what he has described as entering into the invention the Claim must show it, or all will be considered as claimed, see Evans *v.* Kelly (1880), 5 Bann. & A. 71; 9 Bissell, 251; 23 O. G. 192; 13 Fed. Rep. 903; Totley *v.* Easton (1857) 2 C. B. N. S. 706.

That where the invention is described as consisting in the peculiar construction of one or more parts only such construction can be claimed, see Phœnix Caster Co. *v.* Spiegel (1886), 26 Fed. Rep. 272.

That the adjunctive devices referred to in all the Claims for an invention must be the same in themselves and in their relation to the invention, see *Ex parte* Stanbridge (1888), 43 O. G. 1345.

[2] That the enumeration of such elements as constitute the operative invention is a proper mode of claiming it, see *Ex parte* Farrow (1872), 2 O. G. 57.

That elements not essential to the invention should not be stated in the Claim, see *Ex parte* Kitson (1881), 20 O. G. 1750; *Ex parte* Farrow (1872), 2 O. G. 57; Furbush *v.* Cook (1857), 2 Fisher, 668.

That when the new invention does not embrace the entire concrete art or instrument only the new parts invented must be stated by the Claim, see Seymour *v.* Osborne (1870), 11 Wall. 516.

That when a device as claimed is useful only as part of a whole, the other parts will be understood as implied in the Claim, see *Ex parte* West (1872), 2 O. G. 30.

That elements which are described as essential to the invention are not covered by the patent unless stated or implied in the Claim, see McMillin *v.* Rees (1880), 5 Bann. & A. 269; 17 O. G. 1222; 1 Fed. Rep. 722.

[3] That a Claim must not include any parts, features, or other matters not embraced in the invention intended to be claimed, see *Ex parte* Skinner (1881), 19 O. G. 662; *Ex parte* Wheat (1879), 16 O. G. 360; *Ex parte* Wilber (1872), 1 O. G. 379.

That if new devices are claimed as specifically arranged, the Claim covers them only when thus arranged, see Tate *v.* Thomas (1885), 30 O. G. 345; Carlton *v.* Bokee (1873), 17 Wall. 463; 6 Fisher, 40; 2 O. G. 520.

That what is described as merely auxiliary must not be claimed, see *Ex parte* Wheat (1879), 16 O. G. 360.

That a Claim covering useless things is not void unless they are claimed as essential to the invention, see Lewis *v.*

the invention is new and patentable only when considered with reference to certain purposes or objects, it must be claimed only in connection with such purposes or objects, and a Claim for it without this limitation would be void.[4] The importance of this rule becomes especially evident in cases where the real invention consists in the new use of some art or instrument already known. A Claim for the art or instrument itself would be improper, since the new use does not change its character as a patentable invention. The use itself must be set forth and claimed, this being the only new product of inventive skill; and in the Claim for this new use, the objects upon which the art or instrument is now to be employed, or the mode of operation in which it is now to be applied, must be particularly described.

§ 513. The Claim must Distinguish the Invention Claimed from all Known Inventions.

Again, every Claim must distinguish the art or instrument which it embraces from every art or instrument already known.[1]

Marling (1829), 1 Web. 493; 1 Abb. P. C. 421.

That a Claim for certain devices as a means to produce certain results is good, though under peculiar circumstances the results would not follow, see Wheeler *v.* Clipper Mower & Reaper Co. (1872), 10 Blatch. 181; 6 Fisher, 1; 2 O. G. 442.

[4] That if the invention is patentable only when used in certain connections, it must be claimed only in such connections, see Stewart *v.* Mahoney (1879), 5 Fed. Rep. 302; 4 Bann. & A. 84.

§ 513. [1] In *Ex parte* Funck (1878), 14 O. G. 158, Spear, Com.: (159) "The office of the Claim is to clearly and distinctly set forth what an applicant regards to be peculiarly his own invention. If the improvement consists in some addition to or alteration of an existing structure, whether it be by the introduction of new features having no conjoint function with the old parts, or by substantial re-organization in which new elements may or may not enter as co-operative factors, in either event the Claim should express no more and no less than is necessary to convey an accurate understanding of the actual invention which had been made. If, for example, an additional feature, valuable in its way, and yet entirely independent of the old elements, so far as co-acting with them, is incorporated in a device, it must be manifest that the Claim should cease when it had specified the single feature. To continue beyond this, and enumerate other parts belonging to the old structure improved upon, is as much an offence against clearness and precision as to state, as elements of a combination Claim, parts which have no office whatever to perform in accomplishing the specific result. The retention of the old elements in the Claim, when there is nothing in common be-

A Claim including any matter before patented, or in possession of the public, is fatally defective. Such matter should not be mentioned in the Claim if the invention claimed can be sufficiently defined without it, and if mentioned must be expressly disclaimed.[2] Though the invention is worthless

tween them and the one newly added to the machine, is a misstatement of the invention, giving a fictitious importance to the improvement, and defeating any accurate judgment of its merit because of the obscurity resulting from the erroneous association."

In the Corn Planter Patent (1874), 23 Wall. 181, Bradley, J.: (223) "It is objected to several of the patents under consideration that they do not state what parts of the machine patented are new and what parts are old, and that they are therefore void. There is nothing in the Patent Law which, in terms, requires the patentee to do this. The language of the act of 1836, under which these patents were drawn, is that before any inventor shall receive a patent for his invention or discovery he shall deliver a description thereof, and of the manner and process of making, constructing, using, and compounding the same, in such full, clear, and exact terms as to enable a person skilled in the art to reproduce it; and the act directs that the inventor shall 'particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery.' This, of course, involves an elimination of what he claims as new from what he admits to be old. But what can be a more explicit declaration of what is new and what is old than the summary of the patentee's claim at the close of the specification, if that is made in clear and distinct terms, or in terms so clear and distinct as to be fairly understood. It implies that all the rest is old, or, if not old, that the applicant does not claim it so far as that patent is concerned. If the patentee by his specification, including the summary Claim at its close, points out and distinguishes what he claims as his own invention, it is all that is required. That, if we can find it without difficulty or embarrassment, is what he claims as new; the rest he impliedly, if he does not expressly, disclaims as old. No particular form of words is necessary if the meaning is clear." 6 O. G. 392 (400).

That the Claim must clearly distinguish between the new matter and the old, see Terry Clock Co. *v.* New Haven Clock Co. (1878), 17 O. G. 908; 3 Bann. & A. 332; *Ex parte* Hobson (1872), 1 O. G. 141; Brown *v.* Selby (1871), 2 Bissell, 457; 4 Fisher, 363; Bray *v.* Hartshorn (1860), 1 Clifford, 538; Hovey *v.* Stevens (1846), 3 W. & M. 17; 2 Robb, 567; Dangerfield *v* Jones (1865), 13 L. T. Rep. N. S. 142; Newall *v.* Elliott (1864), 10 Jur. N. S. 954; Booth *v.* Kennard (1857), 2 H. & N. 84; Holmes *v.* London & N. W. R. R. Co. (1852), Macrory's P. C. 13; Crane *v.* Price (1842), 4 M. & G. 580; Carpenter *v.* Smith (1841), 1 Web. 530; McFarlane *v.* Price (1816), 1 Web. 74; 1 Abb. P. C. 227; Manton *v.* Manton (1815), Dav. P. C. 333; 1 Abb. P. C. 189.

That the new and old may be distinguished by describing both and claiming only the former, see Rowell *v.* Lindsay (1881), 19 O. G. 1565; 10 Bissell, 217; 6 Fed. Rep. 290; Gottfried *v.* Phillip Best Brewing Co. (1879), 17 O. G. 675; 5 Bann. & A. 4; Corn Planter Patent (1874), 23 Wall. 181; 6 O. G. 392; Winans *v.* N. Y. & Erie R. R. Co. (1856), 1 Fisher, 213; and other cases cited in § 506, note 1, *ante*.

[2] That a Claim including old matter

apart from certain other arts or instruments before communicated to the public the Claim should not describe them, for to whatever extent its utility may be dependent upon its connection with them they form no portion of its essence as a patentable invention.

§ 514. The Claim must Set Forth the Invention Claimed in its Most Perfect Concrete Form.

Again, every Claim must set forth the invention it purports to describe in that form which, according to the judgment of the inventor, the most perfectly embodies it. An inventor who seeks protection for his invention from the public is obliged to place it before the public in the form best fitted for practical use, and both in his Description and his Claim it is his duty to disclose his conception through that concrete

is void, see Milligan *v.* Lalance & Grosjean Mfg. Co. (1884), 29 O. G. 367 ; 21 Fed. Rep. 570 ; Maguire *v.* Eames (1880), 18 Blatch. 321 ; 8 Fed. Rep. 761; Scott *v.* Ford (1878), 14 O. G. 413; *Ex parte* Funck (1878), 14 O. G. 158 ; Corn Planter Patent (1874), 23 Wall. 181 ; 6 O. G. 302 ; Blake *v.* Stafford (1868), 3 Fisher, 294 ; 6 Blatch. 195 ; Phillips *v.* Page (1860), 24 How. 164 ; Holliday *v.* Rheem (1852), 18 Pa. St. 465 ; Hovey *v.* Stevens (1846), 3 W. & M. 17 ; 2 Robb, 567 ; Davis *v.* Bell (1837), 8 N. H. 500 ; Whitney *v.* Emmett (1831), Baldwin, 303 ; 1 Robb, 567 ; Watson *v.* Bladen (1826), 4 Wash. 580 ; 1 Robb, 510 ; Sullivan *v.* Redfield (1825), 1 Paine, 441; 1 Robb, 477 ; Kneass *v.* Schuylkill Bank (1820), 4 Wash. 9 ; 1 Robb, 303 ; Thomas *v.* Foxwell (1858), 5 Jur. N. S. 37 ; Gamble *v.* Kurtz (1846), 3 C. B. 425 ; Minter *v.* Mower (1837), 1 Web. 138 ; 2 Abb. P. C. 178 ; Campion *v.* Benyon (1821), 6 Moore, 71 ; 1 Abb. P. C. 345 ; Brunton *v.* Hawkes (1821), 4 B. & Ald. 541 ; 1 Abb. P. C. 336 ; Hill *v.* Thompson (1817), 1 Web. 235 ; 1 Abb. P. C. 299 ; Bovill *v.* Moore (1816), Dav. P. C. 361 ; 1 Abb. P. C. 231 ; Huddart *v.* Grimshaw (1803), 1 Web. 85 ; 1 Abb. P. C. 128 ; R. *v.* Else (1785), 1 Web. 76 ; 1 Abb. 40.

That a Claim covering old matter is void, though the applicant has invented a new part which is useless without the old, see Winans *v.* N. Y. & Erie R. R. Co. (1856), 1 Fisher, 213.

That a Claim for the whole device, where the invention is merely an improvement, claims old matter and is void, see Maguire *v.* Eames (1880), 18 Blatch. 321 ; 8 Fed. Rep. 761 ; Sullivan *v.* Redfield (1825), 1 Paine, 441 ; 1 Robb, 477.

That a Claim covering three things, one being old, is void, see Heinrich *v.* Luther (1855), 6 McLean, 345.

That a Claim covering old matter is curable by disclaimer, see Hovey *v.* Stevens (1846), 3 W. & M. 17 ; 2 Robb, 567. See also §§ 537, 642–646, and notes, *post.*

That a disclaimer in a pending application must explain, not contradict, the Claim, and distinguish the new from the old, see *Ex parte* Hobson (1872), 1 O. G. 141.

art or instrument which most accurately expresses his idea. Having done this, all other forms are presumed to be embraced in the one claimed, unless they are disclaimed.[1] Thus a Claim for the making of an instrument or the doing of an act, describing the best mode of making the one or doing the other, covers all modes in which the former can be made or the

§ 514. [1] In Murphy *v.* Eastham (1872), 2 O. G. 61, Shepley, J.: (62) "The patentee does not, as is sometimes done, claim in terms the thing patented, however its form and proportions may be varied; but the law so interprets his Claim without the addition of these words. In contemplation of law, after he has fully described his invention and shown its principles, and claimed it in a form which perfectly embodies it, unless he disclaims other forms he is deemed to claim every form in which his invention may be copied." 5 Fisher, 306 (309); Holmes, 113 (116).

In Winans *v.* Denmead (1853), 15 How. 330, Curtis, J.: (343) "Patentees sometimes add to their Claims an express declaration, to the effect that the Claim extends to the thing patented, however its form or proportions may be varied. But this is unnecessary. The law so interprets the Claim without the addition of these words. The exclusive right to the thing patented is not secured if the public are at liberty to make substantial copies of it, varying its form or proportions. And, therefore, the patentee, having described his invention, and shown its principles, and claimed it in that form which most perfectly embodies it, is, in contemplation of law, deemed to claim every form in which his invention may be copied, unless he manifests an intention to disclaim some of those forms."

That a Claim to the invention in one form covers it in all forms, see Grier *v.* Castle (1883), 17 Fed. Rep. 523; 24 O. G. 1176; McComb *v.* Brodie (1872), 2 O. G. 117; 5 Fisher, 384; 1 Woods, 153. See also §§ 130, 237–244, and notes, *ante*.

That all qualities of the invention are covered by the Claim, though they are not specially stated, see *Ex parte* Tweddle (1876), 10 O. G. 747.

That a Claim for a device as an "attachment" to something else is a Claim for the device however used, see McClain *v.* Ortmayer (1888), 42 O. G. 724.

That additional Claims for different forms of the invention are unnecessary and improper, see *Ex parte* McDougall (1880), 18 O. G. 130; Carver *v.* Braintree Mfg. Co. (1843), 2 Story, 432; 2 Robb, 141.

That a Claim for a material having certain qualities does not cover subsequently discovered material having the same qualities, see Goodyear *v.* Berry (1868), 2 Bond, 189; 3 Fisher, 439; Tetley *v.* Easton (1852), Macrory's P. C. 48.

That a Claim for a chemical composition covers only the same use of the same or equivalent ingredients, see Goodyear *v.* Berry (1868), 2 Bond, 189; 3 Fisher, 439.

That the Claim of an invention in one form does not cover other forms when these are disclaimed, see Union Paper Bag Mach. Co. *v.* Pultz & Walkley Co. (1878), 15 O. G. 423; 15 Blatch. 160; 3 Bann. & A. 403; Murphy *v.* Eastham (1872), 5 Fisher, 306; 2 O. G. 61; Holmes, 113; Winans *v.* Denmead (1853), 15 How. 330.

That colorable variations may be covered by the Claim by using language sufficiently broad, see *Ex parte* Demming (1884), 26 O. G. 1207.

latter can be done.[2] Or where the invention consists in the new shape given to an object, such shape expressing an idea of means, all other shapes embodying the same idea are protected by the Claim for that alone.[3] In this manner the protection of the patent, though not granted directly to the idea of means conceived by the inventor, as fully embraces it as if it were distinctly and expressly stated in the Claim.

§ 515. The Claim must Correspond with the Description.

Finally, as the Claim is the request of the inventor for the protection of the invention communicated to the public in the Description, it must entirely correspond with the Description and be based upon the matter therein contained.[1] No invention can be claimed in any specification unless it has

[2] That a Claim for the making of a thing or the doing of an act covers all modes of making or doing it, although only one mode is described, see Union Paper Bag Mach. Co. *v.* Nixon (1876), 1 Flippin, 491; 9 O. G. 691; 2 Bann. & A. 244.

[3] That a Claim for a new shape of an object covers all other shapes expressing the same idea of means, see Winans *v.* Denmead (1853), 15 How. 330.

See also § 238 and notes, *ante*.

§ 515. [1] That the invention claimed must be identical with the invention described, see Knox *v.* Quicksilver Mining Co. (1880), 4 Fed. Rep. 809; *Ex parte* Designolle (1877), 13 O. G. 227; *Ex parte* Gould (1876), 10 O. G. 203; *Ex parte* Fairbanks (1873), 3 O. G. 65; Page *v.* Ferry (1857), 1 Fisher, 298; Corning *v.* Burden (1853), 15 How. 252; Seed *v.* Higgins (1860), 8 E. & B. 755.

That the Claim and Description are distinct, and each must be complete and exact, and the Claim must be more than a mere reference to the Description, see *Ex parte* Rice (1874), 5 O. G. 522.

That the Claim is distinct from the Description, and represents such parts of the described matter as constitute the invention to be patented, see Merrill *v.* Yeomans (1877), 94 U. S. 568; 11 O. G. 970.

That the Claim may be illustrated but not enlarged by the Description, see Yale Lock Co. *v.* Greenleaf (1886), 117 U. S. 555; 35 O. G. 386; Railroad Co. *v.* Mellon (1881), 104 U. S. 112; 20 O. G. 1891.

That the Claim can neither save a bad Description nor invalidate a good one, see Kay *v.* Marshall (1836), 2 Web. 39.

That a Claim cannot cover means substantially different from those described, though they produce substantially the same results, see *Ex parte* Demming (1884), 26 O. G. 1207.

That when the Description and Claim disagree, the Claim controls, see McKesson *v.* Carndick (1881), 21 O. G. 137; 19 Blatch. 158; 9 Fed. Rep. 44.

That when the Claim and Description are repugnant the whole invention must be found in one or the other, and the two may so contradict each other as to make the whole void, see Smith *v.* Murray (1886), 27 Fed. Rep. 69; 36 O. G. 1045.

been previously described in such a manner that any person skilled in the art could practise it from such Description, without experiment or the exercise of his own inventive skill.[2] Features of the invention not delineated in the Description cannot be inserted in the Claim, even though a mechanic in endeavoring to construct or employ the invention would inevitably discover them.[3] Matter described as auxiliary, but not essential to the invention, cannot be stated in the Claim.[4] A Claim for what has been described as a new part of an existing invention should not mention any other parts of such invention, unless they are necessarily connected with or related to the new, and when thus mentioned it must be apparent from the Claim itself that it does not attempt to cover them.[5] A Claim for all modes of effecting a result when the invention has been previously described as a single mode of effecting it,[6] or which embraces the natural

[2] That the invention claimed must have been so described that any one skilled in the art could practise it, see Vogler *v.* Semple (1877), 7 Bissell, 382; 11 O. G. 923; 2 Bann. & A. 556.

That a Claim based on an insufficient Description is void, see Simpson *v.* Holliday (1865), 12 L. T. Rep. N. S. 99.

[3] That a Claim for a method not shown in the Description is void, see Needham *v.* Washburn (1874), 4 Clifford, 254; 7 O. G. 649; 1 Bann. & A. 537.

That a Claim for features not described, but which a maker of the article might discover by using it, is invalid, see Kelleher *v.* Darling (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

[4] That the Claim must not contain matter described as auxiliary, see *Ex parte* Wheat (1879), 16 O. G. 360.

[5] That where the described invention is a new part of an existing invention, the other parts should be omitted from the Claim if the *new* can be intelligibly stated without them, see *Ex parte* Skinner (1881), 19 O. G. 662; *Ex parte* Kitson (1881), 20 O. G. 1750; *Ex parte* Wilber (1872), 1 O. G. 379; Furbush *v.* Cook (1857), 2 Fisher, 668.

[6] In O'Reilly *v.* Morse (1853), 15 How. 62, Taney, C. J.: (112) "We perceive no well-founded objection to the description which is given of the whole invention and its separate parts, nor to his right to a patent for the first seven inventions set forth in the specification of his claims. The difficulty arises on the eighth. It is in the following words: 'Eighth, I do not propose to limit myself to the specific machinery or parts of machinery described in the foregoing specification and Claims; the essence of my invention being the use of the motive power of the electric or galvanic current, which I call electro-magnetism, however developed, for marking or printing intelligible characters, signs, or letters, at any distances, being a new application of that power of which I claim to be the first inventor or discoverer.' It is *impossible to misunderstand* the extent of this Claim. He claims the exclusive

force applied when the invention is a method of applying it, or which claims a principle of operation apart from the mechanism through which the operation is performed or the process in which it is employed, also violates this rule, since in each case the invention claimed is broader than the one described.[7] The Claim may, however, be narrower than the invention set forth in the Description, provided the subject-matter of the Claim is a practically operative art or instrument.[8] Thus, if

right to every improvement where the motive power is the electric or galvanic current, and the result is the marking or printing intelligible characters, signs, or letters at a distance. If this Claim can be maintained, it matters not by what process or machinery the result is accomplished. For aught that we now know, some future inventor, in the onward march of science, may discover a mode of writing or printing at a distance by means of the electric or galvanic current without using any part of the process or combination set forth in the plaintiff's specification. His invention may be less complicated, less liable to get out of order, less expensive in construction and in its operation. But yet if it is covered by this patent the inventor could not use it nor the public have the benefit of it without the permission of this patentee. Nor is this all; while he shuts the door against inventions of other persons, the patentee would be able to avail himself of new discoveries in the properties and powers of electro-magnetism which scientific men might bring to light. For he says he does not confine his claim to the machinery or parts of machinery which he specifies; but claims for himself a monopoly in its use, however developed, for the purpose of printing at a distance. New discoveries in physical science may enable him to combine it with new agents and new elements, and by that means attain the object in a manner superior to the present process and altogether different from it. And if he can secure the exclusive use by his present patent he may vary it with every new discovery and development of the science, and need place no description of the new manner, process, or machinery, upon the records of the Patent Office. And when his patent expires the public must apply to him to learn what it is. In fine, he claims an exclusive right to use a manner and process which he has not described, and indeed had not invented, and therefore could not describe when he obtained his patent. The court is of opinion that the Claim is too broad, and not warranted by law."

That all modes of effecting an end cannot be claimed, see Lawther *v.* Hamilton (1884), 29 O. G. 449; 21 Fed. Rep. 811; *Ex parte* Demming (1884), 26 O. G. 1207; Marsh *v.* Dodge & Stevenson Mfg. Co. (1873), 5 O. G. 398; 6 Fisher, 562; Stone *v.* Sprague (1840), 1 Story, 270; 2 Robb, 10; Wyeth *v.* Stone (1840), 1 Story, 273; 2 Robb, 23.

[7] That the Claim must not cover a force of nature, see Detmold *v.* Reeves (1851), 1 Fisher, 127.

That the Claim must not cover a principle, see *Ex parte* Fairbanks (1873), 3 O. G. 65; Burr *v.* Duryee (1863), 1 Wall. 531; Walton *v.* Bateman (1842), 1 Web. 613.

See §§ 133–143 and notes, *ante*.

[8] That the invention claimed may be narrower than that described if it be

a single new element in the described invention be a complete operative means it may be claimed alone, and if it is essential to the operation of the invention as a whole, the entire invention may be indirectly protected by this restricted Claim.[9] When the different parts of a device, as well as the device itself, have been described as new, the inventor may claim one part alone, or all parts separately, or the device alone, or both the parts and the device, as he deems best;[10] and where he has described certain features of his invention as capable of being omitted without impairing its practical efficiency, these may be either inserted in the Claim or omitted from it without affecting its validity.

§ 516. The Claim: no Particular Form Required.

No particular form of words is required for the statement of the Claim.[1] The language used must be sufficiently clear and accurate to define the invention to the mind of the reader and convey to him a precise idea of its essential character,

an operative means, see *Ex parte* Emerson (1880), 17 O. G. 1451; Russell & Erwin Mfg. Co. *v.* Mallory (1872), 2 O. G. 495; 10 Blatch. 140; 5 Fisher 632.

[9] That where a part of the described invention is practically operative alone, it may be claimed alone; and if essential to the operation of the rest, a Claim for it alone will protect the whole invention, see *Ex parte* Sturges (1872), 1 O. G. 204.

[10] That where the Description shows several ways of applying a substance to new uses the Claim may cover all, see *Ex parte* Floyd (1874), 6 O. G. 541.

That where the parts of an invention are separately operative, a Claim for each may be inserted with that for the invention as a whole, see *Ex parte* Smith (1872), 2 O. G. 117.

That a Claim for each subordinate part is proper in connection with a Claim for the whole, though the parts are inoperative except in connection with each other, see Wells *v.* Jacques (1874), 5 O. G. 364; 1 Bann. & A. 60.

See also § 472 and notes, *ante*.

That where the Description restricts the invention to a certain arrangement of parts, the Claim for the union of such parts must be correspondingly limited, see *Ex parte* Marsh (1872), 2 O. G. 197.

§ 516. [1] That no particular form of Claim is required, see *Ex parte* Designolle (1877), 13 O. G. 227; *Ex parte* Dahne (1875), 7 O. G. 1095; Wyeth *v.* Stone (1840), 1 Story, 273; 2 Robb, 23.

That the Claim is a whole and must stand or fall as such, being incapable of partial acceptance or rejection, see *Ex parte* Smith (1872), 1 O. G. 403.

That differences in the language of Claims do not necessarily show a difference in the inventions, see Sharp *v.* Tifft (1880), 18 Blatch. 132; 17 O. G. 1282; 2 Fed. Rep. 697; 5 Bann. & A. 399.

neither exceeding the limits of the invention actually made, nor falling short of that operative means which the inventor intends to secure. A general and ambiguous Claim, leaving it uncertain what the inventor really wishes to protect, is void, but inartificial and ungrammatical expressions, not producing such uncertainty, do not render it invalid.[2] Useless words should not be inserted nor synonymous words be multiplied; since the former tend to create unnecessary ambiguity, while the latter are calculated to mislead the reader by suggesting to him that each word may be used by the inventor to express a different idea from that denoted by the others.[3] Equivocal words are, of course, never permitted; for by their employment the meaning of the Claim is at once rendered doubtful.[4]

[2] That any terms properly qualified may be used in a Claim, see *Ex parte* Holt (1884), 29 O. G. 171.

That every element claimed must be clearly stated, not merely inferred, see *Ex parte* Holt (1884), 29 O. G. 171.

That a Claim must assert, not rest in doubtful implications, see Fricke *v.* Hum (1877), 22 Fed. Rep. 302.

That vague Claims are not allowable, see *Ex parte* Paige (1887), 40 O. G. 807.

That an ambiguous Claim is void, see Edgarton *v.* Furst & Bradley Mfg. Co. (1881), 9 Fed. Rep. 450; 21 O. G. 261; 10 Bissell, 402; Merrill *v.* Yeomans (1877), 94 U. S. 568; 11 O. G. 970; Sargent *v.* Burge (1877), 11 O. G. 1055; Blake *v.* Stafford (1868), 3 Fisher, 294; 6 Blatch. 195; Rich *v.* Lippincott (1853), 2 Fisher, 1.

That a Claim cannot use such indefinite expressions as "means," "mechanism," etc., see *Ex parte* Holt (1884), 29 O. G. 171; *Ex parte* Wilkin (1884), 29 O. G. 950; *Ex parte* Demming (1884), 26 O. G. 1207.

That a Claim must set out the invention, not merely refer to the Description, see *Ex parte* Demming (1884), 26 O. G. 1207.

That a Claim to what is described in the specification is too vague, see Albany Steam Trap Co. *v.* Felthousen (1884), 22 Blatch. 169; 20 Fed. Rep. 633.

That where an invention consists in the peculiar arrangement of certain parts, a Claim stating the parts in a general manner and referring to the Description as showing the arrangement, is not sufficient, see *Ex parte* Kerr (1884), 28 O. G. 95.

That the casual misuse of words does not make a Claim defective, if it can be cured by examining the Description, see Reed *v.* Street (1885), 34 O. G. 339.

That a Claim will be sustained, though inaccurately expressed, if the court can see what the invention really is, see Stover *v.* Halsted 1875), 8 O. G. 558; 13 Blatch. 95; Ames *v.* Howard (1833), 1 Sumner, 482; 1 Robb, 689.

[3] That the repetition of synonymous words is improper in a Claim, see *Ex parte* Smith (1872), 2 O. G. 117.

[4] That equivocal words must not be used, see *Ex parte* Designolle (1877), 13 O. G. 227.

That the words "means," "mechanism," "connections," are proper when used to denote appliances which are not part of the invention, but are not to be used with reference to essential elements of the patentable subject-mat-

Of this character is the word "equivalent;" for as a true "equivalent," in the sense of the Patent Law, is always covered by the Claim, though not mentioned, the insertion of the word in the Claim implies matter outside its ordinary meaning and appears to widen the scope of the invention, while leaving its actual limits undefined.[5]

§ 517. The Claim: Technical Phrases.

In stating Claims certain phrases are frequently employed to which a special importance seems to be attached by applicants. Among these are the phrase "substantially as de-

ter, see *Ex parte* Stoughton (1888), 43 O. G. 1345; *Ex parte* Stanbridge (1888), 43 O. G. 1345.

[6] In *Ex parte* Haasz (1873), 4 O. G. 610, Leggett, Com.: (611) "I know of no rule or reason for prescribing or proscribing the use of any particular word or phrase in connection with a specification or Claim. Anything of the sort would necessarily be arbitrary and unreasonable. All the words of our language are, of course, as free to the intelligent and appropriate use of inventors in their specifications and Claims as to anybody else; but there are some words and phrases which are capable of being used equivocally, and perhaps the words *equivalent* and *equivalents* are the most conspicuous examples. Whenever they occur in such a connection as to have an equivocal signification, their employment in that connection must be inhibited. This is as far as a rule of practice in the matter can go. Under this rule judicious care must be exercised in the consideration of each particular case, where these words recur, to the end that the Claims shall clearly, definitely, and correctly comprehend the alleged subject-matter of invention and nothing more. No ambiguous or useless word or phrase ought ever to be allowed in a Claim. It is well known to those versed in Patent Law, that equivalents are comprehended in every Claim, whether specified or not, and that the use of the word in a Claim cannot enlarge its legal scope. Wherever its use would merely serve to convey a magnified idea of the scope of the patent to the uninformed, it surely ought not to be allowed."

That a Claim covers all equivalents, see Burden *v.* Corning (1864), 2 Fisher, 477, and notes to § 257, *ante*.

That equivalents are covered though the inventor never thought of them, see McNamara *v.* Hulse (1842), 2 Web. 128.

That a Claim cannot cover matters subsequently discovered, see Tetley *v.* Easton (1852), Macrory's P. C. 48.

That equivalents should not be expressly claimed, see *Ex parte* Reid (1879), 15 O. G. 882; *Ex parte* Bogart (1876), 10 O. G. 113.

That the words "or equivalent devices." must not be used in a Claim unless the equivalents are described in the specification, or unless a patent for one would be a complete bar to a patent for the other, see *Ex parte* Dolph (1887), 39 O. G. 239.

That the examiner may require the words "or equivalents" to be erased, and the applicant cannot then amend by inserting a particular Claim for the alleged equivalent, see *Ex parte* Johnson (1888), 43 O. G. 507.

scribed," and others of the same meaning. These phrases import the same thing when used in a Claim as when elsewhere employed. They are neither necessary nor technical. The reference they make to the Description is always implied, and relates only to the essential features of the invention as therein delineated. They add nothing, therefore, to the certainty of the Claim, nor do they detract from it unless the claimant carelessly inserts them as a substitute for a more clear and definite statement of his invention.[1] When used, the word "described" refers to the Claim as well as the Description, and either may thus aid in the interpretation of the other.[2] Whether expressed or implied, they limit the general

§ 517. [1] In Mitchell *v.* Tilghman (1873), 19 Wall. 287, Clifford, J.: (391) "Usually the Claim contains the words 'as described' or 'substantially as described,' or words of like import, which are everywhere understood as referring back to the descriptive parts of the specification. Words of such import, if not expressed in the Claim, must be implied, else the patent in many cases would be invalid as covering a mere function, principle, or result, which is obviously forbidden by the Patent Law, as it would close the door to all subsequent improvements." 5 O. G. 299 (303).

In *Ex parte* Collins Co. (1872), 2 O. G. 617, Leggett, Com.: (617) "These words should be regarded precisely as other words should be, — that is, as having their ordinary meaning, — when used in a Claim, as elsewhere, and nothing more. There is no artificial significance to be set up for them by which they are to be considered either as desirable or dangerous. There is no objection whatever to their use where they make sense; but they have no legal effect either to enlarge or limit a Claim properly drawn, and, so far as the grant of a patent is concerned, they should have no influence one way or the other. The Claim should be sufficient in its terms either with or without them, because either with or without them its meaning and effect are to be determined in the courts by the light of the specification."

That Claims always refer to the Description, whether so expressed or not, see Westinghouse *v.* Gardner & Ranson Air Brake Co. (1875), 9 O. G. 538; 2 Bann. & A. 55.

That the phrase "substantially as described" has no efficacy unless the Description is clear, see *Ex parte* Skinner (1881), 19 O. G. 662.

That a Claim depending on the phrase "mechanism substantially as described" is too vague, see *Ex parte* Wilkin (1884), 29 O. G. 950.

That where the Description is specific the words "substantially as described," render the Claim specific, see *Ex parte* Ewart (1880), 17 O. G. 448.

That the phrase "substantially as described and shown" relates only to the material features of the invention, see Waterbury Brass Co. *v.* Miller (1871), 9 Blatch. 77; 5 Fisher, 48.

[2] That the word "described" refers to the Claim as well as the Description, see Pearl *v.* Ocean Mills (1877), 2 Bann. & A. 469; 11 O. G. 2.

terms of the Claim to the specific features set out in the Description, though neither these phrases, nor the one "as specified," confines the Claim to that mode of using the invention which has been previously described.[3] The phrase "substantially as and for the purposes set forth" is of a different character. These are words of limitation, and should not be used unless they are intended to have their special signification. They refer to the Description for a qualification of the general statements of the Claim, and confine the invention within the purposes and operations there specifically named.[4]

§ 518. The Claim must not Claim a Mere Function.

One of the most objectionable forms in which a Claim can be stated is that of a Claim for the function of the invention. A functional Claim is one which claims the producing of an effect as distinguished from the means by which it is produced.[1] Such a Claim is void, since it neither covers a patentable invention nor corresponds with the Description previously given.[2] The language of a functional Claim is usually parti-

[3] That a Claim for a combination "substantially as described" is limited to the elements described as composing it, see Hailes *v.* Van Wormer (1873), 20 Wall. 353; 5 O. G. 89.

That the phrase "in the manner . . . mentioned," limits the process to the manner described, see Barker *v.* Grace (1847), 1 Exch. 339.

That in a Claim the words "as specified" do not limit the Claim to the described mode of using the invention, see Lorillard *v.* McDowell (1877), 2 Bann. & A. 531; 11 O. G. 640; 13 Phila. 461; Betts *v.* Menzies (1861), 10 H. L. Cas. 117.

[4] That the words "substantially as and for the purposes set forth" refer to the Description for a limitation of the general words employed, see Corn Planter Patent (1874), 23 Wall. 181; 6 O. G. 392; *Ex parte* Sperry (1872), 2 O. G. 387.

§ 518. [1] In *Ex parte* Hahn (1875), 8 O. G. 597, Spear, Act. Com.: (597) "It is clear from the numerous decisions of the courts and Office on that point that what is known as a functional Claim is one that has for its subject the performance of an act merely, and not the means by which that act is executed. It is not for a substantive thing, but for the *result* which that thing accomplishes. Its language is usually in the participial form, as 'producing,' 'operating,' 'determining,' so combining,' 'so constructing,' etc."

[2] That a Claim for a function is void, see Matthews *v.* Schoneberger (1880), 4 Fed. Rep. 635; 18 Blatch. 357; 18 O. G. 1464; *Ex parte* Ives (1878), 15 O. G. 385; *Ex parte* Arnold (1874), 5 O. G. 553; Wheeler *v.* Simpson (1874), 1 Bann. & A. 420; 6 O. G. 435; Sickels *v.* Falls Co. (1861), 4 Blatch. 508; 2 Fisher, 202; Opin-

cipial; and if construed according to its terms the matter claimed would be the operation of the invention on its object, not the invention itself. In order to sustain the patent the courts construe such Claims, if possible, as Claims for the means by which the act is performed, and not for the performance of the act itself.[3] Thus a Claim for the "so forming" a thing is treated as a Claim for the thing formed; a Claim for the application of means by which a certain thing is done is held to be a Claim for the means applied; a Claim for producing a given effect, by means of a peculiar arrangement of the instruments employed, is considered as a Claim for the instruments as so arranged; and a Claim for the "doing" of an act is interpreted to be a Claim for the means or apparatus by which the act is done.[4] But where the Claim is unequivocally functional,—as, for example, where it claims the "operating of" a machine, or the "imparting motion" to an object,—it is fatally defective.[5] It must not be forgotten,

ion Atty. Gen. (1856), 8 Op. At. Gen. 269.

See also §§ 144–146 and notes, *ante*.

That participial Claims are improper, see *Ex parte* Cox (1873), 3 O. G. 2.

That an apparatus must not be claimed as a "means of doing," but as a specific device, see *Ex parte* Bates (1879), 16 O. G. 266.

That a Claim for a design must not cover a mere function, see *Ex parte* Diffenderfer (1872), 2 O. G. 57.

[3] That a Claim, when functional in form, is treated, if possible, as a Claim for the means performing the function, see Royer *v.* Schultz Belting Co. (1886), 28 Fed. Rep. 850; 38 O. G. 898; Coffin *v.* Ogden (1869), 3 Fisher, 640; 7 Blatch. 61; Minter *v.* Wells (1834), 1 Web. 134; 2 Abb. P. C. 47.

That the courts do not sanction functional Claims by relieving patentees from their consequences, see *Ex parte* Ives (1878), 15 O. G. 385.

That functional Claims may often be cured by inserting a reference to the mechanism described, see *Ex parte* Holmes (1874), 6 O. G. 360.

[4] That a Claim for the "so forming," etc., is not functional, but claims the thing formed, see Parham *v.* American Buttonhole, Overseaming, & Sewing Mach. Co. (1871), 4 Fisher, 468.

That a Claim for the application of means by which an effect is accomplished is a Claim for the means applied, see Hitchcock *v.* Tremaine (1871), 4 Fisher, 508; 8 Blatch. 440.

That a Claim for such an arrangement of elements as will produce a certain effect is a Claim for the elements as so arranged, not for the function, see Renwick *v.* Pond (1872), 2 O. G. 392; 5 Fisher, 569; 10 Blatch. 39.

That a Claim for "doing" an act or thing is treated as a Claim for the means of doing it, see Fuller *v.* Yentzer (1876), 94 U. S. 288; 11 O. G. 551; Seymour *v.* Osborne (1869), 3 Fisher, 555.

[5] That a Claim for the "operating of," etc., is void, see *Ex parte* Ives (1878), 15 O. G. 385.

That a Claim for "imparting mo-

however, that the function of one invention may be itself a different invention, as an art may stand in the relation of function to the apparatus by which it is performed. Where such an invention is the one described, it may be claimed in any language suitable for its definition, although the same Claim, if based on a Description of the instruments employed, would be clearly functional and void. In a Claim properly defining the real invention, its functions may be referred to and its operation set forth without impairing the validity of the Claim.[3]

§ 519. The Claim must not Claim a Mere Effect.

Another objectionable form of Claim is that which claims the result accomplished by the use of the invention, instead of the invention by whose use the result is attained. Where a result is a new product and constitutes the real invention, it is, of course, the proper subject of the Claim.[1] But where it is a mere effect of the means devised by the inventor, it cannot be claimed in his patent. It is not in its nature a patentable invention, nor, if it were, could it be monopolized by an inventor who had simply discovered one means of producing it.[2] Such Claims are, therefore, void, although, as in

tion," etc., is void, see Sickels *v.* Falls Co. (1861), 2 Fisher, 202; 4 Blatch. 508.

That in a machine patent a Claim for the "mode of operation" is void, see Hatch *v.* Moffitt (1883), 15 Fed. Rep. 252.

That a Claim for a mechanical process, which is a mere function of the described devices, is void, see Case *v.* Hastings (1875), 7 O. G. 557.

[3] That a Claim for the means does not become a functional Claim by stating the operation of the means, if it is otherwise sufficient, see *Ex parte* Gray (1877), 11 O. G. 329; *Ex parte* Kieth (1876), 9 O. G. 744.

§ 519. [1] That a Claim for a result as a product is valid, see Anilin *v.* Higgin (1878), 15 Blatch. 290; 14 O. G. 414; 3 Bann. & A. 462.

[2] That a Claim for a result as an effect is void, see *Ex parte* Beavis (1879), 16 O. G. 1233; Marsh *v.* Dodge & Stevenson Mfg. Co. (1874), 5 O. G. 398; 6 Fisher, 562; Wheeler *v.* Simpson (1874), 6 O. G. 435; 1 Bann. & A. 420; Bailey Washing & Wringing Mach. Co. *v.* Lincoln (1871), 4 Fisher, 379; Sickels *v.* Falls Co. (1861), 4 Blatch. 508; 2 Fisher, 202.

See also §§ 147–149 and notes, *ante*.

That a Claim for all means of accomplishing a result is a Claim for the result itself and therefore void, see Lawther *v.* Hamilton (1884), 29 O. G. 449; 21 Fed. Rep. 811; *Ex parte* Demming (1884), 26 O. G. 1207; Marsh *v.* Dodge & Stevenson Mfg. Co. (1874), 5 O. G. 398; 6 Fisher, 562; O'Reilly *v.* Morse (1853), 15 How. 62; Stone *v.* Sprague (1840), 1 Story, 270; 2 Robb, 10;

the case of functional Claims, the courts construe them, if possible, as Claims for the art or instrument by which the effect is accomplished.[3] Thus a Claim for so forming an object that a certain result is attained, or for the production of an effect by arranging certain devices in the manner described, is regarded as a Claim for the object so formed, or the devices so arranged.[4]

§ 520. The Claim must not be Alternative.

A Claim stated in the alternative is invalid when the language of the Claim either covers nothing positively, or leaves it uncertain which of several things the inventor intends to claim.[1] The use of the disjunctive conjunction does not, of itself, render a Claim uncertain. Where the essential characteristics of the invention are properly set forth, and some of its connections or modes of use are described in the alternative, the Claim is good, since the matters described in the alternative form no part of the invention, and may be eliminated from the Claim without impairing the completeness of its statement of the real invention. Or where in setting forth the invention itself the disjunctive conjunction is employed in its enumerative sense, and the Claim thus becomes the equiva-

Wyeth *v.* Stone (1840), 1 Story, 273; 2 Robb, 23.

That a Claim for the use of a natural force for a special purpose is too broad, being equivalent to a Claim for the purpose thereby effected, see O'Reilly *v.* Morse (1853), 15 How. 62.

That where a structure produces results the Claim must be for the structure, not the result, see *Ex parte* Roloson (1879), 15 O. G. 471.

[3] That where a Claim in terms is for a result it will be construed, if possible, to cover the means by which the result is effected, see Coes *v.* Collins Co. (1882), 22 O. G. 417; 20 Blatch. 221; 9 Fed. Rep. 905; Palmer *v.* Gatling Gun Co (1881), 19 Blatch. 392; 20 O. G. 815; 8 Fed. Rep. 513; Henderson *v.* Cleveland Co-operative Stove Co. (1877), 12 O. G. 4; 2 Bann. & A. 604; Fuller *v.* Yentzer (1876), 94 U. S. 299; 11 O. G. 597; Corn Planter Patent (1874), 23 Wall. 181; 6 O. G. 392; Evarts *v.* Ford (1873), 5 O. G. 58; 6 Fisher, 587.

[4] That a Claim for the "so forming . . . that" a given result is attained is a Claim for the means, not the result, see Lull *v.* Clark (1882), 22 O. G. 1535; 13 Fed. Rep. 456; 21 Blatch. 95.

§ 520. [1] That alternative Claims are not allowable, see *Ex parte* Holt (1884), 29 O. G. 171; *Ex parte* McDougall (1880), 18 O. G. 130; *Ex parte* Reid (1879), 15 O. G. 882; Union Paper Bag Mach. Co. *v.* Nixon (1873), 4 O. G. 31; 6 Fisher, 402; Carr *v.* Rice (1858), 1 Fisher, 325.

lent for as many separate Claims as it contains enumerative clauses, the Claim, although irregular in form, is still allowable. Thus to claim both of two alternatives, or to claim different arrangements of the same elements in a combination where each arrangement is an operative means, has been permitted.[2] But the danger of ambiguity in all uses of the disjunctive, and the ease and security with which each of several devices or arrangements may be stated in separate Claims, causes alternative Claims to be disfavored by the Patent Office, although the courts may manifest a disposition to sustain them where the language is capable of an intelligible construction.

§ 521. The Claims must not be Unnecessarily Multiplied.

The law prescribes no limit to the number of Claims which may be inserted in a single specification. But a repetition of the same Claim, or the multiplication of Claims for the same invention, is not allowed except in cases where the nature of the invention renders it necessary to describe it in different methods, *in order to make it clear or to state all that can* rightfully be claimed. Claims are not like counts in a declaration, varied in terms to meet the possible phases of evidence or legal interpretation; they are conclusions from the specification, and must neither be fictitious, nor redundant, nor appear to cover more than fairly can be claimed.[1] The needset up in other Claims, see *Ex parte* Holt (1884), 29 O. G. 171.

§ 521. [1] In *Ex parte* Woodruff (1880), 17 O. G. 453, Doolittle, Act. Com.: (453) "The general doctrine heretofore in vogue in the Office that it is admissible, under proper restrictions, for parties to put their Claims in different forms to prevent misconstruction of them by the public or the courts must be construed, as the Examiner contends, to have reference, not to unnecessary repetition of Claims for the same thing, but to those cases which are difficult of definition, and where one set or form of words would be inadequate to clearly cover the invention

[2] That a Claim to both of two alternatives is valid, see Union Paper Bag Mach. Co. *v.* Nixon (1873), 4 O. G. 31; 6 Fisher, 402.

That an alternative Claim is good only when it is the equivalent of two Claims, one for each alternative, see Tuck *v.* Bramhill (1868), 3 Fisher, 400; 6 Blatch. 95.

That a patent cannot claim alternative forms of a combination unless each is an operative machine, see Brown *v.* Whittemore (1872), 5 Fisher, 524; 2 O. G. 248.

That Claims cannot be for independent alternative constructions or for mere modifications of the construction

less repetition of the same matter in different Claims tends to mislead by conveying the idea that some substantial difference exists between the subjects of the several Claims; and if this is carried to such an extent as to create ambiguity, or cover more than is really invented, the entire patent may be rendered void.[2] Where one Claim will be sufficient no others should be made; and where two or more are inserted, without necessity, the one which best protects the invention will be retained and the others will be rejected.[3] But several

and prevent misconstruction. Another difficulty arises from the inability of an applicant to set forth in a single Claim the device broadly, so that it will cover all other devices which are the same in principle of operation, and therefore equivalents, and, at the same time, the specific device he has invented and described to carry out the improvement in the art of manufacture. But where the invention is simple in nature and can be clearly stated in simple language and in one Claim, there is no justification for setting out the invention in a series of Claims which all mean the same thing. Claims are not like counts in pleadings, which are often repetitions of the same cause of action in different forms of language to provide against the hazard of the proofs varying materially from the statement of the cause of action, but they are the conclusion of the specification, and their object is to set forth distinctly and concisely just what the invention is which the applicant asks to be secured to him by his patent, and they should not consist of fictitious, redundant, or amplified allegations of matters by which it is hoped to secure protection for something more than the applicant has actually invented or contemplated. Where the terms of a Claim in a patent are clear and distinct, as they always should be, no necessity arises for repeating such Claim in different forms of language, and subjecting the Office and the courts to great labor in scrutinizing them, and to doubt and annoyance as to their limitations and construction."

That the duplication of Claims does not necessarily avoid a patent, see Tompkins *v.* Gage (1865), 5 Blatch. 268; 2 Fisher, 577.

That divided and multiplied Claims are disapproved, see Bostock *v.* Goodrich (1884), 21 Fed. Rep. 316; 29 O. G. 278.

That Claims for the same thing may be repeated in different language in order to prevent misunderstanding, see *Ex parte* Hahn (1875), 8 O. G. 597; *Ex parte* Shippen (1875), 8 O. G. 727.

[2] In Carlton *v.* Bokee (1873), 17 Wall. 463, Bradley, J.: (471) "We think it proper to reiterate our disapprobation of these ingenious attempts to expand a simple invention of a distinct device into an all-embracing Claim, calculated by its wide generalizations and ambiguous language to discourage further invention in the same department of industry and to cover antecedent inventions. Without deciding that a repetition of substantially the same Claim in different words will vitiate a patent, we hold that where a specification by ambiguity and a needless multiplication of nebulous Claims is calculated to deceive and mislead the public, the patent is void." 2 O. G. 520 (523); 6 Fisher, 40 (48).

[3] That two Claims for the same thing are improper, and that which

Claims for the same art or instrument as serving different purposes, or as employed in different modes, or as accomplishing different results, may be properly made, since such a separation tends to prevent confusion and to preserve the essential characteristics of the invention distinct from those of its objects and its uses.[4]

§ 522. The Claim: Joinder of Claims for Different Inventions.

The joinder of several Claims for different inventions in the same specification is governed by the rules heretofore considered in reference to the joinder of inventions.[1] The Claims, being the life of the patent, the central point to which all the other parts converge and from which they derive their value to the inventor, may embrace every invention for whose protection he may lawfully apply; and must embrace all those which his patent is destined to secure. A Claim may, therefore, be inserted in the specification for each of the described inventions whose nature and dependence on the principal invention is such as to permit its joinder in the same application. The Claims for each of these inventions must possess all the characteristics, and fulfil all the requirements which would be necessary to their validity were it the sole invention claimed.

§ 523. The Claim Interpreted by other Parts of the Application.

While the rules governing the scope and language of the Claim are thus numerous and rigid, the attitude of the courts toward the inventor, in its interpretation, is just and liberal.

best protects the invention will be retained, the other rejected, see Dederick *v.* Cassell (1881), 20 O. G. 1233; 9 Fed. Rep. 306; 14 Phila. 503.

That a Claim embracing only a feature or quality which is covered by another Claim, as inseparable from its particular subject-matter, is void, see Combined Patents Can Co. *v.* Lloyd (1882), 15 Phila. 485; 11 Fed. Rep. 153.

That a Claim cannot be so changed by construction as to make it the same as another Claim of the same patent, see Filley *v.* Littlefield Stove Co. (1887), 39 O. G. 1203; 30 Fed. Rep. 434.

[4] That several Claims for the same device as accomplishing several results may be inserted, see *Ex parte* Smith (1880), 17 O. G. 271.

§ 522. [1] That Claims for separate but dependent inventions may be joined, see *Ex parte* Smith (1872), 2 O. G. 117.

That a second Claim for an inseparable feature of the invention previously claimed is not proper, see Combined Patents Can Co. *v.* Lloyd (1882), 11 Fed. Rep. 153; 15 Phila. 485.

See also §§ 468–479 and notes, *ante*.

In construing the Claim the whole specification is taken together, and if the terms in which the Claim is stated are consistent with those of the Description, the latter with its accompanying drawings is treated as an amplification and explanation of the former, illustrating and applying its more concise and definite expressions. Thus, though the Claim is distinct from the Description and as such must be complete in itself and not merely refer to the Description for a statement of the invention claimed, yet every feature of the invention which the Description has declared to be essential, and all the modes of using it therein prescribed, are covered by the Claim, whether or not they are particularly mentioned.[1] Without departing from the rule that the Claim must clearly limit and define the exact invention for which a patent is desired, or assuming the power to alter or enlarge a Claim, the courts sustain it whenever in connection with its proper exponent, the Description, and in view of the state of the art, it renders the nature of the claimed invention evident to those to whom the specification is addressed.[2]

§ 523. [1] That the Claims are interpreted and limited by the Description, see Snow *v.* Lake Shore & Mich. Southern R. R. Co. (1887), 121 U. S. 617; 39 O. G. 1081; *Ex parte* Holt (1884), 29 O. G. 171; Fuller *v.* Yentzer (1874), 6 Bissell, 203; *Ex parte* Marsh (1872), 2 O. G. 197.

That parts shown in the Description to be essential to the invention must be understood, though not mentioned in the Claim, see *Ex parte* Richardson (1875), 7 O. G. 1053.

That a Claim may be limited by the drawings, where it describes the device only by letters referring to them, see *Ex parte* Marsh (1872), 2 O. G. 197.

That drawings cannot so far supply the place of a written Description that a Claim can be construed to cover matter shown only in the drawings, see Gunn *v.* Savage (1887), 30 Fed. Rep. 366.

That the Claim cannot be enlarged by the Description, see Yale Lock Co. *v.* Greenleaf (1886), 117 U. S. 554; 35 O. G. 386; Lehigh Valley R. R. Co. *v.* Mellon (1881), 104 U. S. 112; 20 O. G. 1891.

That where the Description and Claims disagree, the Claims control, see McKesson *v.* Carndick (1881), 21 O. G. 137; 19 Blatch. 158; 9 Fed. Rep. 44.

[2] That whenever the nature of the invention can be ascertained by construing the specification in view of the state of the art, the Claim will be construed to cover it, if its language will permit, see Andrews *v.* Carman (1876), 9 O. G. 1011; 13 Blatch. 307; 2 Bann. & A. 277; Turrill *v.* R. R. Co. (1863), 1 Wall. 491; Whipple *v.* Middlesex Co. (1859), 4 Fisher, 41; Le Roy *v.* Tatham (1852), 14 How. 156; Haworth *v.* Hardcastle (1854), 1 Web. 480; 2 Abb. P. C. 19.

That a Claim for a device which is useless in itself, but is useful in connection with other things mentioned in

§ 524. The Claim for a Combination: Combinations not Covered by Claims for their Elements.

By the application of these general rules to Claims for different classes of inventions many special rules have been developed, to which from time to time new rules are added as new cases are presented for determination. In examining these attention must be first directed to the rules concerning combinations. A combination is the union of several elements under one co-operative law. It is an invention distinct both from the elements of which it is composed and from the law by which their co-operation is controlled. It must, therefore, be claimed as an invention by itself, not being covered by a Claim for each of the elements separately, nor by a Claim for all of them collectively, nor by a Claim for all of them co-operatively under a different co-operative law.[1]

§ 525. The Claim for a Combination: its General Requisites.

A Claim for a combination must include all its essential characteristics, and embrace enough to produce a distinct and useful result, but must, at the same time, be confined to that union of one element with another which the inventor has created and described.[1] It must distinguish clearly between

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the Description, is good, see Wells *v.* Jacques (1874), 1 Bann. & A. 60; 5 O. G. 364.

That where the specification describes several ways of applying a substance to new uses, the Claim will be so construed as to cover all, see *Ex parte* Floyd (1874), 6 O. G. 541.

§ 524. [1] That a Claim for the elements alone does not cover the combination, see Delaware Coal & Ice Co. *v.* Packer (1880), 5 Bann. & A. 296; 1 Fed. Rep. 851; 24 O. G. 1273. See also § 527 and notes, *post*.

§ 525. [1] That a Claim including an element not co-acting as part of the combination is invalid, see Van Camp *v.* Maryland Pavement Co. (1888), 43 O. G. 884; Kerosene Lamp Heater Co. *v.* Littell (1878), 13 O. G. 1009; 3 Bann. & A. 312.

That a patent for a combination of old elements cannot claim any other union of the elements than the one invented and described, see Larabee *v.* Cortlan (1851), 3 Fisher, 5; Taney, 180.

That a patent cannot claim alternative combinations unless both are operative means, see Brown *v.* Whittemore (1872), 5 Fisher, 524; 2 O. G. 248.

That where a Claim for a combination attributes to it a certain motion, it is the means by which the motion is produced and not the motion that forms the subject of the patent, see Royer *v.* Schultz Belting Co. (1886), 28 Fed. Rep. 850; 38 O. G. 898.

the new and the old, either by expressly disclaiming the latter or by totally omitting it;[2] and if the real invention consists only in the new arrangement of an existing combination, improving its operation or effect, the Claim must point out the new arrangement as the limit of its request for protection, or the Claim will be too broad.[3] Features not essential to the combination should not be introduced into the Claim.[4] If the new combination forms merely a part of some art or instrument of wider scope, the other portions of the art or instrument should not be mentioned, where the new combination can be adequately set forth without them; and when their statement becomes necessary they should be disclaimed. Nor should the Claim embrace the connecting mechanism by which the new combination is united to the principal invention, except under the same necessity and coupled with a similar disclaimer.[5]

[2] In The Corn Planter Patent (1874), 23 Wall. 181, Bradley, J.: (224) "Where a patentee, after describing a machine, claims as his invention a certain combination of elements, or a certain device, or part of the machine, this is an implied declaration, as conclusive, so far as that patent is concerned, as if it were expressed, that the specific combination or thing claimed is the only part which the patentee regards as new. True, he or some other person may have a distinct patent for the portions not covered by this; but that will speak for itself. So far as the patent in question is concerned, the remaining parts are old, or common and public." 6 O. G. 392 (400).

That all unclaimed elements of the described combination are thereby conceded to be old, see Rowell *v.* Lindsay (1881), 10 Bissell, 217; 19 O. G. 1565; 6 Fed. Rep. 290; Conover *v.* Roach (1857), 4 Fisher, 12; Batten *v.* Taggert (1851), 2 Wall. Jr. 101. This concession relates only to the patent in question; the unclaimed matter in itself may really be new and reserved for a future patent. See § 506 and notes, *ante*.

[3] That where the Claim covers a combination which in its general character is old, the special construction in which the novelty consists must be pointed out or it will be too broad, see Terry Clock Co. *v.* New Haven Clock Co. (1878), 17 O. G. 908; 3 Bann. & A. 332.

[4] That a Claim for a combination should not cover non-essential elements, see Rapid Service Store R. R. Co. *v.* Taylor (1887), 42 O. G. 721; Royer *v.* Schultz Belting Co. (1886), 28 Fed. Rep. 850; 38 O. G. 898; Hancock Inspirator Co. *v.* Jenks (1884), 21 Fed. Rep. 911; *Ex parte* Kitson (1881), 20 O. G. 1750; Furbush *v.* Cook (1857), 2 Fisher, 668.

That an unessential part is not an element unless claimed as such, see Bradley *v.* Dull (1884), 27 O. G. 625; 19 Fed. Rep. 913. See also § 278 and notes, *ante*.

[5] That a Claim for a combination should not include the connecting mechanism unless it is an element in the combination or is essential to the comprehension of what is claimed, see *Ex parte* Skinner (1881), 19 O. G. 662.

§ 526. The Claim for a Combination may be Stated in any Intelligible Form.

Any form of words may be employed in a Claim for a combination provided it accurately describes the real invention. To enumerate the elements, and to state explicitly the method of their combination and the law of their co-operation, constitutes a perfect Claim; but such a statement is not always possible. The inventor is not obliged to understand, sufficiently to formulate in words, the mode in which these elements unite and act upon each other or upon their common object. It is enough that he has actually combined them and thereby produced a new and useful operative means; and any language in which he can make his invention so far intelligible to the public that they can practise it themselves, and can perceive the limits of the exclusive privilege he claims, answers the requirements of the law.[1] Thus a Claim for the described elements in such a combination as will achieve a certain result, or a Claim for such an arrangement of the elements as will produce a given effect, or a Claim for so much of the mechanism described as accomplishes a particular purpose, — have been allowed, where the Description indicated to those skilled in the art such combinations, arrangements, or portions of the mechanism as gave clearness and precision to the Claim.[2] No such Claim can be con-

§ 526. [1] That a Claim for a combination must embrace enough to produce a distinct, definable, and unitary result, though not necessarily enough to produce the entire result aimed at, see *Ex parte* Rheutan (1874), 5 O. G. 521; *Ex parte* Farrow (1872), 2 O. G. 57.

That a Claim for an inoperative combination is void, see Torrant *v.* Duluth Lumber Co. (1887), 39 O. G. 1425; 30 Fed. Rep. 830.

[2] In Renwick *v.* Pond (1872), 10 Blatch. 39, Blatchford, J.: (49) "Claiming the arrangement of a combination, when the arrangement is such as to produce a given mechanical result of the combination, is not a Claim to a function. The result is not claimed irrespective of the means producing it. The means alone are claimed, and claimed only when specially arranged to produce a given result. This is very far from claiming a function." 2 O. G. 392 (395); 5 Fisher, 569 (579).

In Silsby *v.* Foote (1852), 14 How. 218, Curtis, J.: (226) "When a Claim does not point out and designate the particular elements which compose a combination, but only declares, as it properly may, that the combination is made up of so much of the described machinery as effects a particular result, it is a question of fact which of the described parts are essential to produce that result; and to this extent, not the construction of the Claim, strictly speak-

strued to extend beyond the matter previously described. Whether it contains the phrase "substantially as described" or not, it must be limited to the elements and mode of union already set forth at length in the Description.[3]

§ 527. The Claim for a Combination Covers only the Precise Combination Claimed.

A Claim for a combination covers the exact combination claimed and nothing more. It does not protect the elements of the combination, nor their mode of union, nor their co-operative law, separately considered.[1] It does not embrace any other union of the same elements with each other, or with additional elements, nor a combination of a portion of these elements among themselves.[2] Where it omits certain

ing, but the application of the Claim sufficiently certain, see Babcock & Wilcox Co. *v.* Pioneer Iron Works (1888), 43 O. G. 756.

§ 527. [1] That a Claim for a combination does not cover its elements, see Evans *v.* Kelly (1880), 13 Fed. Rep. 903; 23 O. G. 192; 9 Bissell, 251; 5 Bann. & A. 71; Mowry *v.* Whitney (1871), 14 Wall. 620; 5 Fisher, 494; 1 O. G. 492; Lister *v.* Leather (1858), 8 E. & B. 1031.

[2] That a Claim for a combination of old elements does not cover any combination in which one element is new and essentially different, see Babcock *v.* Judd (1880), 17 O. G. 1351; 1 Fed. Rep. 408; 5 Bann. & A. 127.

That a Claim for such a combination of the described elements as will produce a given result covers only the combination actually stated in the Description, see Case *v.* Brown (1864), 2 Wall. 320.

That a patent for a combination of old elements cannot claim any union of one element with another except the union invented and described, see Larabee *v.* Cortlan (1851), 3 Fisher, 5; Taney, 180.

That the Claim must be limited to the arrangement described in the Claim, should be left to the jury."

That the Claim may state that the combination consists of the described elements when so constructed as to produce the given effect, see Gottfried *v.* Phillip Best Brewing Co. (1879), 17 O. G. 675; 5 Bann. & A. 4.

That a Claim for the combination as a whole may be stated as covering the described elements in combination, see Wicke *v.* Ostrum (1881), 103 U. S. 461; 19 O. G. 867.

That "means," "mechanism," and similar comprehensive terms are not proper in Claims for combinations for the purpose of pointing out the invention, see *Ex parte* Paige (1887), 40 O. G. 807; *Ex parte* Wilkin (1884), 29 O. G. 950; *Ex parte* Holt (1884), 29 O. G. 171; *Ex parte* Kerr (1884), 28 O. G. 95; *Ex parte* Domming (1884), 26 O. G. 1207.

[3] That a Claim for a combination "substantially as described" will be limited to the elements described as composing it, see Hailes *v.* Van Wormer (1873), 20 Wall. 353; 5 O. G. 89.

That the words "or other part" in a Claim for a combination of elements means other equivalent part and is

elements it excludes them from the combination, though they are in fact essential to it as an operative means; and where it treats certain elements as necessary they cannot afterwards be declared by the inventor to be unnecessary, although his real invention was complete without them.[3]

§ 528. The Claim for a Combination may be Joined with Claims for its Elements and Sub-combinations.

The specification of a combination may contain several different Claims. Besides the Claim for the combination as a whole, each of its elements and sub-combinations, if new and patentable inventions, may be also claimed, even where they are useless except as portions of the principal invention.[1] But Claims for the same element or sub-combination, as performing functions not relating to the combination as a whole, and Claims for different combinations though composed of the same elements, cannot be inserted, unless they come within the general rules concerning the joinder of inventions.[2]

see Tate *v.* Thomas (1885), 30 O. G. 345; *Ex parte* Marsh (1872), 2 O. G. 107.

[3] That elements omitted from the Claim are thereby excluded from the combination, see § 156, note 2, and §§ 278, 282 and notes, *ante*.

That when devices are described as useful only in combination with other devices a Claim for the former as a combination includes the latter also, see *Ex parte* West (1872), 2 O. G. 30.

That a Claim including non-essential elements makes them essential, and the patentee cannot afterwards assert that they are unnecessary, see Van Camp *v.* Maryland Pavement Co. (1888), 43 O. G. 884; Royer *v.* Schultz Belting Co. (1886), 28 Fed. Rep. 850; 38 O. G. 898; Fay *v.* Cordesman (1883), 109 U. S. 408; 25 O. G. 1277; Le Fever *v.* Remington (1882), 22 O. G. 1537; 13 Fed. Rep. 86; 21 Blatch. 80; Coolidge *v.* McCone (1874), 2 Sawyer, 571; 5 O. G. 458.

That a Claim for a combination makes essential all parts which are named as, or must be necessarily inferred to be, elements, but not parts used as connecting or moving factors alone, see Thompson *v.* Gildersleeve (1888), 43 O. G. 886.

§ 528. [1] That the elements, if new, may be separately claimed, see Stevens *v.* Pritchard (1876), 2 Bann. & A. 390; 4 Clifford, 417; 10 O. G. 505. See also § 472 and notes, *ante*.

That the elements may be claimed, though useless out of the combination, see Henderson *v.* Cleveland Co-operative Stove Co. (1877), 12 O. G. 4; 2 Bann. & A. 604.

[2] That different combinations of the same elements cannot be covered by one patent, see *Ex parte* Shepard (1872), 3 O. G. 522.

That different combinations of the same elements as performing different functions, cannot be claimed in one patent, see Pattee *v.* Moline Plow Co.

§ 529. The Claim for an Art: its General Requisites.

A Claim for an art should enumerate the acts in which its essential character resides, and set them forth in such a manner as to identify them with the acts delineated in the Description. The mode of doing this is left to the discretion of the inventor, and to the peculiar nature of the process he attempts to claim. But in claiming this class of inventions there is especial danger of a departure from the terms of the Description. A Description relating to the production of an effect by the use of mechanism should conclude with a Claim for the machine only, not for the art of using it, unless its use for the purpose named is a distinct invention and has been so described.[1] On the other hand, a Description setting forth a new process, and referring to the apparatus employed in practising it merely as illustrating and explaining the new art, should be followed by a Claim for the art only, not for the apparatus so employed.[2] Where an effect is produced by new chemical forces, or by the new application of some natural force, the effect though new is not the proper subject of a Claim; the use of the new forces and the new use of the natural force are arts and must be so claimed.[3] A Claim for

(1881), 22 O. G. 173; 9 Fed. Rep. 821; 10 Bissell, 377.

That each Claim must cover a complete and operative combination in the general direction of the invention, see *Ex parte* Holt (1884), 29 O. G. 171.

§ 529. [1] That a Claim for a mechanical process, which is a mere function of the described machine, is not proper, see *Ex parte* Simonds (1888), 44 O. G. 445; Case *v.* Hastings (1875), 7 O. G. 557; Piper *v.* Brown (1870), 4 Fisher, 175; Holmes, 20.

That a Claim for a combination of mechanical elements cannot be construed to cover a process, but must be limited to the mechanical parts and equivalents, see Grier *v.* Wilt (1887), 120 U. S. 412; 38 O. G. 1365.

That when the functions of a machine constitute a new process, the process may be claimed though no other machines will perform it, see *Ex parte* Wintherlich (1879), 17 O. G. 55. See also § 172 and notes, *ante*.

That a Claim for a process, consisting in the operation of a machine, is only a Claim for the machine, see Dederick *v.* Cassell (1881), 20 O. G. 1233; 9 Fed. Rep. 306; 14 Phila. 503.

See also §§ 466, 473, 474, and notes, *ante*.

[2] That where a new process is described but the Claim is limited to the apparatus which performs it, the patent is void unless the apparatus is also new and patentable, see Boston Elastic Fabrics Co. *v.* East Hampton Rubber Thread Co. (1874), 5 O. G. 696; Holmes, 372; 1 Bann. & A. 222.

[3] That where the effect is obtained by the new use of natural forces, the new use should be claimed as an art, see Piper *v.* Brown (1870), 4 Fisher,

an art covers all ways of practising it, and if its elements possess equivalents, a general Claim may cover it under every form; and a specific Claim, following the particular method of performing it laid down in the Description, will cover it under the method thus described.[4] But the Claim for a process does not embrace the product, although no other mode of producing it is yet discovered; nor does a Claim for several arts in combination protect these arts except as thus co-operating to a common end.[5] A Claim for each step of an art may be joined with the Claim for the art itself whenever such steps are true sub-processes and are complete inventions in themselves, but not where they are incapable of use as operative means when severed from each other.[6]

§ 530. The Claim for a Machine: its General Requisites.

A machine must be claimed as a specific piece of mechanism, not as a mode of operation, a principle, an idea, a means of producing an effect, or an effect produced.[1] If the inven-

175; Holmes, 20; O'Reilly *v.* Morse (1853), 15 How. 62.

That where an effect is produced by chemical action the Claim should be for a process, see Piper *v.* Brown (1870), 4 Fisher, 175; Holmes, 20.

That a Claim for the "process of constructing" by doing certain acts is a Claim for a process, see Andrews *v.* Cross (1881), 8 Fed. Rep. 269; 19 Blatch. 294; 19 O. G. 1705.

[4] That a general Claim for a process covers all ways of performing it, see Tilghman *v.* Proctor (1880), 102 U. S. 707; 19 O. G. 859; Bridge *v.* Brown (1871), Holmes, 53.

That a Claim for a process to whatever substance, known or unknown, it may be applied is too broad, see Bailey Washing & Wringing Mach. Co. *v.* Lincoln (1871), 4 Fisher, 379.

[5] That a Claim for the process does not necessarily cover the product, see Goodyear *v.* Wait (1867), 5 Blatch. 468; 3 Fisher, 242.

That a Claim for a process does not protect the product if the product can be made in any other way, see Goodyear *v.* Railroad (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

That the product and process cannot be expressly embraced in one Claim, see *Ex parte* Bates (1879), 16 O. G. 266; Merrill *v.* Yeomans (1874), 1 Bann. & A. 47; 5 O. G. 267; Holmes, 331.

[6] That each stage of a process, if a true sub-process, may be also covered by a separate Claim, see *Ex parte* Wilson (1879), 16 O. G. 95; *Ex parte* Smith (1879), 16 O. G. 630.

That different steps of an entirety process cannot be covered by separate Claims, see *Ex parte* Wheat (1879), 16 O. G. 360.

That a Claim for a process does not cover either the separate steps or the materials used unless they are clearly pointed out and described in the specification, see Western Electric Co. *v.* Ansonia Co. (1885), 114 U. S. 447; 31 O. G. 1305.

§ 530. [1] That a machine must be

tion does not embrace an entire machine, the parts invented must be clearly pointed out and claimed, and the parts not invented must not be mentioned, or if mentioned must be disclaimed.[2] The function of the machine must not be claimed, nor its mode of operation; though if this function constitutes a new process it is patentable as an art, and a Claim for it may be joined with those for the machine unless the general rules regarding the joinder of inventions would be thereby infringed.[3] Claims for each subordinate piece of mechanism may be joined with those for the principal machine, though not capable of use in any other known connection.[4]

§ 531. The Claim for a Manufacture: its General Requisites.

A *manufacture* must be claimed as a new product, apart from any Claim for the process of making it or for the pur-

claimed as such, and not as a principle, a mode of operation, or an idea, see Burr *v.* Duryee (1863), 1 Wall. 531.

That an apparatus should not be claimed as a "means of doing," but as a distinct instrument, see *Ex parte* Bates (1879), 16 O. G. 266.

[2] That if the invention does not embrace an entire machine, the parts invented must be distinctly claimed, see Seymour *v.* Osborne (1870), 11 Wall. 516.

That the new parts must be distinctly claimed, and if claimed only in connection with other parts they are protected only in such connection, see Graham *v.* Mason (1869), 5 Fisher, 1; 4 Clifford, 88.

That a Claim for a device having certain capabilities covers only the instrumentalities by which the effect is produced, see Anders *v.* Gilliland (1880), 19 O. G. 177.

[3] That in a machine patent a Claim for the "mode of operation" is void, see Hatch *v.* Moffitt (1883), 15 Fed. Rep. 252.

That when an effect, not in itself a new invention, is produced by the operation of a machine, the Claim must be for the machine, not the process, see Dederick *v.* Cassell (1881), 20 O. G. 1233; 9 Fed. Rep. 306; 14 Phila. 503; Piper *v.* Brown (1870), 4 Fisher, 175; Holmes, 20.

That where the Description covers a process and the Claim covers only a machine, unless the machine is new the patent is void, see Boston Elastic Fabrics Co. *v.* East Hampton Rubber Thread Co. (1874), 5 O. G. 696; Holmes, 372; 1 Bann. & A. 222.

That when the functions of a machine are a new process the latter may be claimed as a process, though no other machine will perform it, see *Ex parte* Wintherlich (1879), 17 O. G. 55. See also §§ 473, 474, and notes, *ante*.

[4] That several Claims for the same device, as accomplishing several results, may be made in the same patent, see *Ex parte* Smith (1880), 17 O. G. 271.

That each subordinate mechanism may be separately claimed, though not useful by itself, see Wells *v.* Jacques (1874), 5 O. G. 364; 1 Bann. & A. 60.

pose for which it is employed.[1] If the product is new in itself, it should be set forth in the Claim by a simple enumeration of its essential qualities, without reference to the mode in which it is produced; but where such a statement is impossible it may be defined as the product resulting from a described process, or in any other sufficient manner.[2] When the character of the product depends upon its method of production, it must be claimed only as produced by that specific process, and the same form of Claim must be employed when the process and the product are inseparable.[3] The words "article of manufacture" have no particular significance in a Claim, and do not aid nor impair its validity.[4] The name of the product claimed refers to it as it is delineated in the Description, not as it is in itself or may become known in the arts.[5] A Claim for a new product resulting from the use of substances having certain described qualities does not cover a product resulting from the use of subsequently discovered substances having the

§ 531. [1] That a new product may be claimed by itself, see Glue Co. *v.* Upton (1874), 4 Clifford, 237; 6 O. G. 837; 1 Bann. & A. 497.

That the manufacture must be claimed independently of the process, see *Ex parte* Mayall (1873), 4 O. G. 210.

That a Claim for the manufacture should not explain nor set forth the process by which it is made, see *Ex parte* Shalters (1879), 15 O. G. 970; *Ex parte* Cobb (1874), 5 O. G. 751; *Ex parte* Mayall (1873), 4 O. G. 210.

[2] That a product may be claimed by enumerating its qualities, and setting forth the mode of its production, in the Description and referring to these in the Claim, see *Ex parte* Tweddle (1876), 10 O. G. 747.

That a product may be claimed by describing it, and the mode of making it, and stating it to be new, see United Nickel Co. *v.* Pendleton (1883), 15 Fed. Rep. 739; 24 O. G. 704; 21 Blatch. 226.

[3] That where product and process are inseparable the product may be claimed as the result of employing the process, see Glue Co. *v.* Upton (1874), 4 Clifford, 237; 6 O. G. 837; 1 Bann. & A. 497.

That the Claim may be for the product however made, or as the result of a given process, see Merrill *v.* Yeomans (1874), 1 Bann. & A. 47; Holmes, 331; 5 O. G. 267.

That a Claim for a product as produced by any process which will produce a like result covers it only when made by equivalent processes, see Pickhardt *v.* Packard (1884), 22 Fed. Rep. 530; 23 Blatch. 23; 30 O. G. 179.

[4] That the phrase "article of manufacture" has no special significance in a Claim, see *Ex parte* Adams (1873), 3 O. G. 150; *Ex parte* Wattles (1873), 3 O. G. 291.

[5] That the name of the product claimed refers to it as described, not as it actually exists, see Anilin *v.* Cummins (1879), 4 Bann. & A. 489; Anilin *v.* Hamilton Mfg. Co. (1878), 3 Bann. & A. 235; 13 O. G. 273.

same qualities;[6] nor is any product so embraced in the process which produces it that a Claim for the process will protect the product when produced in any other manner.[7] Claims for a new manufacture and the means of making it, whether the means be an art or a machine, may be joined subject to the limitations of the general rules already stated.[8]

§ 532. The Claim for a Composition of Matter: its General Requisites.

A single composition of matter requires only a single Claim, in which the invention is set forth, like any other combination, by enumerating its elements, and stating the mode of their union, and the essential qualities of the resulting composition.[1] If such a Claim cannot be framed, whatever defines and distinguishes the composition from all others will suffice, — as where it describes the compound as the result of mixing certain ingredients in a certain manner. A Claim for a composition formed of specific known ingredients should mention each of them, and if it states no definite proportions, or mode of intermixture, those named in the Description are presumed to be referred to in the Claim.[2] A Claim for a chemical composition covers only the same use of the same or equivalent chemical ingredients.[3] A Claim for any union of less than the whole group of ingredients employed in the production of

[6] That a Claim for a product formed of certain described substances having certain qualities does not cover products formed of subsequently discovered substances having the same qualities, see Goodyear *v.* Berry (1868), 2 Bond, 189; 3 Fisher, 439.

[7] That a Claim for the process does not cover the product, if it can be made in any other manner, see Goodyear *v.* Wait (1867), 5 Blatch. 468; 3 Fisher, 242; Goodyear *v.* Railroad (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

[8] That the article and the means of producing it may be separately claimed, see Merrill *v.* Yeomans (1877), 94 U. S. 568; 11 O. G. 970.

See also § 475 and notes, *ante*.

§ 532. [1] That a composition of matter requires but a single Claim, see *Ex parte* Wheat (1879), 16 O. G. 360; *Ex parte* Loeser, (1876), 9 O. G. 837.

[2] That if the composition consists of well-known ingredients the Claim must enumerate them, see *Ex parte* Williams (1876), 10 O. G. 748.

That a general Claim for a composition of certain ingredients is a Claim for them in the proportions previously described, see Loutrel *v.* Mellor (1871), 1 O. G. 48; 5 Fisher, 153.

[3] That a Claim for a chemical composition covers only the same use of the same or equivalent ingredients, see Goodyear *v.* Berry (1868), 2 Bond, 189; 3 Fisher, 439.

the principal composition is a Claim for a different invention, and can be inserted in the same application only when so related to the former that a joinder is permitted.[4]

§ 533. The Claim for a Design: its General Requisites.

A Claim for a design must be as distinct and specific as a Claim for any other invention, if the nature of the design will permit. Nothing beyond the configuration or ornamentation, which constitutes the invention, must be mentioned in the Claim; neither the qualities of the substance upon which the design is imposed, nor the mechanical functions which the substance may thus be enabled to perform, being any part of the design itself.[1] The Claim may consist either of a verbal description of the essential features of the design, or of such references to the drawings as indicate the lines and figures characterizing the invention.[2] Different designs cannot be embraced in a single Claim; and Claims for distinct designs cannot be joined unless so dependent on each other as to come within the usual rules.[3]

§ 534. The Claim for an Improvement: its General Requisites.

An improvement is an invention essentially distinct from the original art or instrument to which it pertains; and a Claim for an improvement must, therefore, not only define the improvement, like any other new invention, but also fully and accurately distinguish between it and the old invention.[1] In order

[4] That a second Claim for a composition of fewer or different ingredients is a Claim for a different invention, and is improper unless the two inventions may be joined in one patent, see *Ex parte* Loeser (1876), 9 O. G. 837.

See also § 476 and notes, *ante*.

§ 533. [1] That the Claims of a design patent should contain the phrase "as shown and described" so as to limit the patent to the exact design, see *Ex parte* Gerard (1888), 43 O. G. 1234.

That a Claim for a design must not cover a mere function, see *Ex parte* Diffenderfer (1872), 2 O. G. 57.

[2] That a Claim for "the configuration of the design hereunto annexed when applied to carpeting" is proper, see Dobson *v.* Dornan (1886), 118 U. S. 10; 35 O. G. 750.

[3] That there can be no joinder of separate designs, see *Ex parte* Gerard (1888), 43 O. G. 1240.

See also § 477 and notes, *ante*.

§ 534. [1] That a Claim for an improvement must clearly state the exact improvement made, see *Ex parte* Murray (1875), 8 O. G. 943; Whittemore *v.* Cutter (1813), 1 Gallison, 478; 1 Robb, 40; Hill *v.* Thompson (1818), 1 Web. 239; 1 Abb. P. C. 304.

That the Claim for an improvement

to accomplish this, such a Claim should confine itself entirely to the characteristics of the improvement made, embracing nothing which is not necessarily connected with or related to it, although the part or group of parts of which the improvement consists will not operate except in union with the original invention.[2] If it is requisite to the precise definition of the improvement that mention should be made of any features of the original invention, it must be apparent from the language used that these features of the original are not claimed.[3] Two or more distinct improvements cannot be joined in the same Claim, though Claims for distinct improve-

must distinguish the new from the old, see Brown *v.* Selby (1871), 2 Bissell, 457 ; 4 Fisher, 363 ; Bray *v.* Hartshorn (1860), 1 Clifford, 538.

That an applicant for an improvement may be required to explicitly distinguish the old and the new, but not to acknowledge the old to be old or make any other admission, see *Ex parte* Massicks (1887), 38 O. G. 1489.

[2] In *Ex parte* McMurray (1875), 8 O. G. 943, Spear, Act. Com.: (943) "It is always a very difficult and delicate question to determine how subordinate Claims for an improvement in a mechanism of any considerable number of parts, or in any respect complicated, should be limited, and no exact rule can be laid down for such cases. Unquestionably, an applicant having made an improvement upon a previously existing machine may lay claim to the specific part which he has improved, or to any reasonably well-defined group of parts thus improved, even although that part or that group of parts do not alone operate to produce any beneficial result. No one is misled by any such Claim, but understands readily, even if it be not specifically stated, that the improvement is upon a specified part of the machine to which it relates. To require the applicant to specify all the parts necessary to the complete operation would be to defeat the very object for which he seeks a patent, and would be plainly against reason. But to how small a number of elements he shall reduce his Claim is not so easy to determine ; but each case must be judged in a great measure by itself, care only being taken that the Claim do not mislead."

[3] That a Claim to improvements must be limited to them by express terms or fair construction, see Troy Laundry Mach. Co. *v.* Bunnell (1886), 27 Fed. Rep. 810 ; 23 Blatch. 558.

That it is not sufficient that persons skilled in the art can distinguish the improvement from the original invention, but the Claim itself must show it, see Foxwell *v.* Bostock (1864), 10 L. T. Rep. N. S. 144.

That a Claim for an improvement must be limited to the new arrangement, and cannot embrace substitutes different in character and form, merely because they perform the same functions and effect the same results, see Dyer *v.* National Hod Elevating Co. (1885), 24 Fed. Rep. 182.

That a Claim for one of a series of improvements must be restricted to the precise form and arrangement described, see Bragg *v.* Fitch (1887), 121 U. S. 478 ; 39 O. G. 829.

ments may be joined in the same application.[4] Where several parts of the original have been improved, and such improvements can be so far treated as but one invention as to be properly included in a single Claim, the entire Claim is void if either of the alleged improvements happens to be old.[5] A Claim for the whole invention, when the advance is only an improvement, is invalid, though limited to the invention "as improved.[6]" In construing a Claim for an improvement the original is always kept in view, and such an interpretation given to the Claim, if possible, as will protect the actual improvement made.[7]

§ 535. The Claim for a Generic Invention: its Scope.

Several distinct inventions often occupy toward some other invention the relation of species to a genus. A generic invention is one in which are represented the essential characteristics of a group of arts or instruments, each of which, in addition to the characteristics common to the group, possesses other specific characteristics which distinguish it from all the rest. The same invention may be generic to the individuals of its own genus, and specific in its relations to some wider invention representing the group to which itself belongs. Thus an invention consisting in the use of a class of substances for a certain purpose is generic as to an invention consisting in the use for the same purpose of some particular substance of that class; and the latter is, in its turn, generic toward an invention consisting in the use for the same purpose of some specific quality of that particular substance.[1] A patent for

[4] See § 478 and notes, *ante*.

[5] That when the Claim covers several associated improvements it is void if either be old, see Heinrich *v.* Luther (1855), 6 McLean, 345; Moody *v.* Fiske (1820), 2 Mason, 112; 1 Robb, 312.

[6] That where the invention is an improvement it alone can be patented, and a Claim for the whole art or instrument is void, see Johnston Ruffler Co. *v.* Avery Mach. Co. (1886), 28 Fed. Rep. 193; Phillips *v.* Page (1860), 24 How. 164; Woodcock *v.* Parker (1813), 1 Gallison, 438; 1 Robb, 37; *contra*, Goodyear *v.* Matthews (1814), 1 Paine, 300; 1 Robb, 50. See also §§ 513 and notes, *ante*, and 537 and notes, *post*.

[7] That if a fair interpretation shows that only the improvement is claimed the patent is valid, see McAlpine *v.* Mangnall (1846), 3 C. B. 496.

§ 535. [1] That a patent for the use of a substance in a process is generic in relation to a patent for the use of that substance when of a certain quality, see Slade *v.* Blair (1880), 17 O. G. 261.

the genus always covers the species, and hence every subsequent inventor of a specific invention, though entitled to protection for what he has himself conceived, holds his exclusive privilege subject to the general rights of the inventor of the generic invention.[2] As the creation of each one of the specific inventions includes the creation of all the characteristics common to the group, the inventor of any of the species may obtain a patent covering the genus, unless some other inventor has previously conceived the same fundamental idea, and is using due diligence in reducing it to practice.[3] These relations between inventions and the rights which grow out of them require attention when the Claims of patents are to be stated or construed.

§ 536. The Claim for a Generic Invention may be Joined with a Claim for One Species.

Where an invention possesses only the characteristics common to the group, it represents the genus as distinguished from the species, and its description will support only a generic Claim.[1] If in addition to these common characteristics it has special qualities of its own, it represents one species as well as the genus, and its description will support a specific as well as a generic Claim. In this case a generic Claim alone would leave the peculiar characteristics of the species unprotected; while a specific Claim alone would limit the patent to an invention having both the common qualities of

[2] That a patent claiming the genus covers all subsequent patents claiming only the species, see *Ex parte* Ewart (1880), 17 O. G. 448.

That a specific Claim is always subject to the generic, see Walsh *v.* Shinn (1879), 16 O. G. 1006.

That generic Claims do not cover functions and results, see *Ex parte* Beavis (1879), 16 O. G. 1233.

[3] That an inventor of a species before any one else invents the genus, or any other species, may claim the genus also, see *Ex parte* Gardner (1880), 17 O. G. 626; *Ex parte* Ewart (1880), 17 O. G. 448.

That no patent with generic Claims can be granted after one with a Claim for the species, see *Ex parte* Upton (1884), 27 O. G. 99.

That a generic patent must describe one or more species, see *Ex parte* Wilson (1879), 16 O. G. 95.

§ 536. [1] That a generic Description will support only a generic Claim, see *Ex parte* McClintock (1880), 17 O. G. 267.

That generic Claims do not cover effects, see *Ex parte* Beavis (1879), 16 O. G. 1233.

the genus and the particular qualities of the species, the genus being thus left open to the public.[2] The description of both genus and species will not prevent this result in the absence of a proper Claim for each; and where the description is either generic alone or specific alone the phrase "substantially as described" in the Claim confines the Claim to the generic or specific invention thus described.[3] Where the common characteristics of the genus constitute an operative means the genus and each one of its species are distinct inventions, and every member of the group is also an invention by itself, apart from and independent of the others.[4] The joinder of Claims for two or more of these must depend on their connection with each other under the usual rules upon that subject; though where the same invention represents the genus and one species, both a generic and a specific Claim may be inserted. That several species are described as embraced under the genus does not extend this power of joinder, nor does the statement in the Description that one of two described species is the best deprive the inventor of the right to claim the other and leave that unclaimed.[5]

[2] That no specific Claim can be made unless the species is described, see *Ex parte* McClintock (1880), 17 O. G. 267.

That a Claim for a species limits the patent to that species, though the Description covers a generic invention, see Hawes *v.* Gage (1871), 5 O. G. 494.

[3] That when the Description is specific the Claim for the invention "substantially as described" covers the species only, see *Ex parte* Ewart (1880), 17 O. G. 448.

[4] That a genus and each of its species are distinct inventions, see *Ex parte* McClintock (1880), 17 O. G. 267.

[5] In *Ex parte* Ewart (1880), 17 O. G. 448, Paine, Com.: (449) "While two species can be set forth by way of illustration in one Description, they cannot both be set forth either in separate specific Claims in one patent or in one specific Claim; nor can both or either of them be set forth in a generic Claim. Both cannot appear in separate specific Claims in one patent, for that would admit two distinct and independent inventions into one patent. Both cannot not appear in one Claim, for that would make the Claim as well as the patent double. One cannot be so shown in a generic Claim, for that would transform it into a specific Claim. Both cannot appear in a generic Claim, for they would make the Claim double as well as specific. A Claim cannot be framed to cover generically several specific inventions by merely aggregating specific Claims for those inventions. Its terms must be broad enough to cover both without specifically claiming either, and yet not broad enough to trench upon any distinct genus."

See also *Ex parte* McClintock (1880), 17 O. G. 267; *Ex parte* Morrison 1879), 16 O. G. 359.

That when the steps of an entirety

§ 537. The Claim, when Defective.

A Claim is defective when it fails to define the real invention with sufficient completeness and precision, or when it claims more than belongs to the invention. In the former case the discovery of the inventor is not properly protected.[1] In the latter case the Claim is absolutely void.[2] Both these defects may be, however, remedied by a re-issue, and the latter one is also curable by a disclaimer.[3] When several Claims are inserted in the specification, the presence of a void Claim does not affect those which are good, unless there is an evident intention to mislead the public or an unreasonable delay in filing a disclaimer.[4]

process have equivalents, a generic Claim may cover it under any form, and a specific Claim may cover the specific form, see *Ex parte* McDougall (1880), 18 O. G. 130.

That several devices constructed on the same principle may be described in one application and covered by one generic Claim, but only one device can be specifically claimed, see *Ex parte* Howland (1877), 12 O. G. 889.

That the designation of one of two species as the best does not debar the patentee from claiming the other, see *Ex parte* McClintock (1880), 17 O. G. 267. See also § 471, note 4, *ante*.

§ 537. [1] That the Claim may be valid for what it claims, though it does not claim the full invention, see Wilson *v.* Coon (1880), 19 O. G. 482; 6 Fed. Rep. 611; 18 Blatch. 532; and § 508, note 2, *ante*.

[2] That a Claim exceeding the limits of the actual invention is void, see Milligan *v.* Lalanco & Grosjean Mfg. Co. (1884), 29 O. G. 367; 21 Fed. Rep. 570; Scott *v.* Ford (1878), 14 O. G. 413; Winans *v.* N. Y. & Erie R. R. Co. (1856), 1 Fisher, 213; Heinrich *v.* Luther (1855), 6 McLean, 345; Holliday *v.* Rheem (1852), 18 Pa. St. 465; Davis *v.* Bell (1837), 8 N. H. 500; Whitney *v.* Emmett (1831), Baldwin, 303; 1 Robb, 567; Watson *v.* Bladen (1826), 4 Wash. 580; 1 Robb, 510; Knowss *v.* Schuylkill Bank (1820), 4 Wash. 9; 1 Robb, 303.

[3] That an excessive Claim is curable by re-issue or disclaimer, see Silsby *v.* Foote (1857), 20 How. 378; Hovey *v.* Stevens (1846), 3 W. & M. 17; 2 Robb, 567; Peterson *v.* Wooden (1843), 3 McLean, 248; 2 Robb, 116; Stanley *v.* Whipple (1839), 2 McLean, 35; 2 Robb, 1. See also §§ 642–646 and notes, *post*.

That an incomplete or inexact Claim may be cured by re-issue, see §§ 656, note 3, 668, notes 5 and 6, and 693 and notes, *post*.

That a disclaimer in a pending application must not contradict but explain and limit the Claim, see *Ex parte* Hobson (1872), 1 O. G. 141.

[4] That the presence of void Claims in a patent does not impair the effect of good Claims, see Tyler *v.* Galloway (1882), 22 O. G. 2072; 12 Fed. Rep. 567; 20 Blatch. 445; Christman *v.* Rumsey (1879), 58 How. Pr. 114; 17 Blatch. 148; 17 O. G. 903; 4 Bann. & A. 506; Burdett *v.* Estey (1878), 15 O. G. 877; 15 Blatch. 349; Russell *v.* Place (1876), 94 U. S. 606; 12 O. G. 53; Carlton *v.* Bokee (1873), 17 Wall. 463; 2 O. G. 520; 6 Fisher, 40; Cahart *v.* Austin (1865), 2 Fisher, 543;

§ 538. The Claim, as Corrected or Allowed in the Patent Office, Determines the Validity and Scope of the Patent.

It is the duty of the Patent Office to secure the correct statement of the Claims before it allows the issue of a patent.[1] That the courts might sustain a defective Claim, in order to prevent the defeat of a granted patent, is no reason for permitting such a Claim to pass the scrutiny of the department.[2] The Claim is to define what the Patent Office, after due examination, has ascertained to be the real discovery of the inventor, and it must be amended or withdrawn according to the judgment of the officers to whom this duty is committed. Once settled in its terms by their decision, the courts will not disturb it, either by interfering with its language or by narrowing or enlarging it by construction.[3]

§ 539. The Specification: its Signature: Erasures and Corrections.

The specification must be signed by the inventor, or by his executor or administrator, and the signature must be attested

2 Clifford, 528; Singer *v.* Walmsley (1860), 1 Fisher, 558.

That void Claims may be disclaimed, see Tyler *v.* Galloway (1882), 22 O. G. 2072; 12 Fed. Rep. 567; 20 Blatch. 445.

That where of two Claims one is too broad under one interpretation, and under another is a mere repetition of a former Claim, it is void and must be disclaimed, see Tyler *v.* Galloway (1882), 22 O. G. 2072; 12 Fed. Rep. 567; 20 Blatch. 445.

That unreasonable delay in disclaiming void Claims will vitiate the entire patent, see McCormick *v.* Seymour (1854), 3 Blatch. 209; Hall *v.* Wiles (1851), 2 Blatch. 194; and notes to § 646, *post.*

§ 538. [1] That it is the duty of the Patent Office to see that Claims are correct, see Keystone Bridge Co. *v.* Phœnix Iron Co. (1877), 95 U. S. 274; 12 O. G. 980.

[2] That the courts may sustain Claims which the Patent Office ought not to allow, see *Ex parte* Cornell (1872), 1 O. G. 573.

That though the courts may sustain defective Claims the Patent Office has no right to permit them, see *Ex parte* McDougall (1880), 18 O. G. 130.

[3] In Burns *v.* Meyer (1879), 100 U. S. 671, Bradley J.: (672) "It is well known that the terms of the Claim in letters-patent are carefully scrutinized in the Patent Office. Over this part of the specification the chief contest generally arises. It defines what the Office, after a full examination of previous inventions and the state of the art, determines the applicant is entitled to. The courts, therefore, should be careful not to enlarge, by construction, the Claim which the Patent Office has admitted, and which the patentee has acquiesced in, beyond the fair interpretation of its terms."

See also §§ 738–743 and notes, *post.*

That a Claim cannot be dissected and accepted or rejected piecemeal, but must stand or fall together, see *Ex parte* Smith (1872), 1 O G. 403.

by two witnesses, each signing his full name, legibly written.[1] The Description and Claims, and all amendments thereof, must be written in a clear and readable hand on one side of the paper only; and all interlineations and erasures must be marked in marginal or foot notes written on the same sheet of paper, for which purpose a wide margin should be reserved on the left-hand side of the page. Legal-cap paper, with the lines numbered, is recommended by the Office.

SECTION VII.

OF THE APPLICATION: THE DRAWINGS AND MODEL.

§ 540. Drawings, Model, and Specimens: when Required.

In order to secure still greater accuracy and completeness in the description of that art or instrument for which the inventor claims the protection of a patent, the law requires him to furnish drawings, and a model or specimens, illustrating its distinctive characteristics, whenever in the judgment of the Patent Office the case demands them. The requirement of the statute in reference to drawings is positive, and the applicant must file them if the nature of the invention permits.[1] Those in reference to the model and specimens are conditional upon the order of the Commissioner, and the applicant is not obliged to furnish them unless especially directed. But as the question whether the nature of the case admits of drawings is finally determined by the Commissioner, and his decision as to their sufficiency, as well as that of the specimens or model, is conclusive,[2] the practical difference in this respect between these several requirements is insignificant, affecting merely the order of proceedings in the Office.

§ 539. [1] That the applicant must sign his first name in full, see *Ex parte* Gentry (1888), 44 O. G. 822.

§ 540. [1] That a drawing must be filed whenever the nature of the invention permits, see *Ex parte* Chase (1879), 16 O. G. 809.

[2] That the decision of the Commissioner that drawings were duly presented is final except on proceedings to avoid the patent, see Hoe *v.* Cottrell (1880), 17 Blatch. 546; 18 O. G. 59; 1 Fed. Rep. 597; 5 Bann. & A. 256.

See also § 423 and notes, *ante*.

§ 541. Drawings must Correspond with Specification.

The drawings filed must correspond with the specification in all the essential characteristics of the invention.[1] They are but another method of portraying the same art or instrument therein described in words, and a discrepancy between the two delineations may give rise to such an ambiguity in the entire description as renders the patent void.[2] They are connected with the specification by means of figures affixed to each drawing, and letters or figures affixed to each of its several parts, and so referred to in the language of the Description and the Claim that the verbal and pictorial representations will serve to illustrate and explain each other.[3]

§ 542. Drawings to be so Clear and Full as to Supply the Place of a Model.

The drawings filed must be so full and clear that, if the invention is a simple one, no model will be needed.[1] The model, being retained in the Patent Office after the patent issues, is inaccessible to the public without recourse to the place of its deposit. The drawings, on the contrary, through the copies annexed to the patent, and published in the "Gazette," or supplied on application by the Office, circulate in every direction and are open to inspection by all persons interested in the art to which the invention may belong. In pursuance of its duty to disseminate in the widest degree immediate information concerning all inventions, the Patent

§ 541. [1] That the drawings must correspond in all essential points with the specification, see *Ex parte* Witty (1884), 29 O. G. 862; *Ex parte* Schoonmaker (1878), 13 O. G. 595.

That the drawings must show every feature claimed, see *Ex parte* Crandall (1886), 35 O. G. 625.

[2] That the drawings may show the invention where the specification fails to do so, see Banker *v.* Bostwick (1880), 18 O. G. 61.

That all patentable matter shown in the specification, drawings, or model is covered by the application, see Singer *v.* Braunsdorf (1870), 7 Blatch. 521.

That an imperfect description coupled with incomplete drawings make the patent void, see New Process Fermentation Co. *v.* Koch (1884), 29 O. G. 535; 21 Fed. Rep. 580.

[3] That under the act of 1793, the drawings need not have been referred to in the specification, see Emerson *v.* Hogg (1845), 2 Blatch. 1.

§ 542. [1] That in simple inventions the drawings must be sufficient to supply the place of a model, see *Ex parte* Jovè (1880), 17 O. G. 801.

Office properly requires that the drawings shall, as far as possible, supply the place of a model; and this in simple inventions, with the present facilities for pictorial representation, they are fully competent to do. In complicated structures, incapable of complete perspective reproduction on a plane surface, a model becomes necessary.

§ 543. Drawings: General Requisites in each Class of Inventions.

The drawings must exhibit every feature of the invention covered by the Claims; otherwise the language of the specification would set forth a different art or instrument from that depicted in the drawings, resulting in an ambiguity which might be fatal to the patent. In the drawings which accompany the specification for an art, every stage or sub-process capable of illustration by a drawing must be shown; but the different steps of a sub-process do not require such delineation.[1] In a machine or manufacture, the drawing must disclose all the essential parts in their proper places, as they would appear in the practically operative instrument.[2] The drawings of an improvement must exhibit, in one or more views, the improvement itself disconnected from the old structure, and also in another view so much only of the old structure as will suffice to show the connection of the improvement therewith.[3] A design must be shown by a drawing or a photograph, in which all the distinctive characteristics of the new configuration or ornamentation are depicted. But while the drawings must thus present every feature of the claimed invention to the eye, they need not be working-drawings nor on an operative scale.[4] They are not intended as a guide to the

§ 543. [1] That in an application covering an art every claimed stage or sub-process must, if possible, be illustrated by drawings, but not the several steps of each sub-process, see *Ex parte* Carter (1879), 16 O. G. 809.

[2] That a drawing must accompany an application covering an article of manufacture, see *Ex parte* Chase (1879), 16 O. G. 809.

[3] That in a patent covering an improvement in machinery, drawings of the improvement are necessary, see Burrall *v.* Jewett (1830), 2 Paige (N. Y.), 134.

That in an application covering an improvement, the improvement must be shown by a model and drawings, but not the original when it is well known to the public or its description is accessible, see *Ex parte* Tracy (1875), 8 O. G. 144.

[4] That the drawings need not be working-drawings nor on an operative scale, see American Hide & Leather

mechanic in constructing the invention further than that, in connection with the written specification, they put him in possession of such knowledge of the essential attributes of the invention that through his own skill in the art he can practically create it and employ it.

§ 544. Drawings: Special Rules Governing their Artistic Perfection.

To render the drawings suitable for the various uses of the Patent Office they are required to attain, in their execution, to a uniform standard of excellence; and for this purpose they must conform to certain rules from time to time prescribed by the department. These rules relate chiefly to the size, materials, arrangement, and lettering of the several views given of the invention, and may be found stated at length in the published regulations of the Office. These rules are rigorously enforced, since unless it conforms to them a drawing is practically worthless; and until complied with by the applicant his case will not receive consideration. The drawing must be signed, like the specification, by the inventor or his attorney in fact, and attested by two witnesses;[1] their full names being given and legibly written.

§ 545. *Model not Filed until Ordered by the Patent Office.*

A model is not required until an examination of the application in the Patent Office shows it to be necessary to the full disclosure of the essential characteristics of the invention. When thus required, notice to that effect is sent to the applicant and proceedings on his application are suspended until it is furnished. A model filed, when not required, is returned to the inventor. No model of a design is requisite where it can be sufficiently represented by photographs or drawings.

§ 546. Model: its General Requisites.

A model must clearly exhibit every feature of the invention which forms the subject of a Claim, but should not include

Splitting & Dressing Mach. Co. *v.* American Tool & Mach. Co. (1870), 4 Fisher, 284; Holmes, 503.

§ 544. [1] That the drawings, under the act of 1836, could be signed either by the inventor or his authorized agent, see Opinion Atty. Gen. (1859), 9 Op. At. Gen. 378.

any other matter than that covered by the actual invention, unless it be necessary to the representation of the invention in a working model.[1] A working model is often desirable in order to enable the examiner to understand the precise operation of the new invention. The model must be neatly and substantially made of durable material, metal being preferred, unless the material is an essential feature of the invention, in which case the model must, of course, conform to this as well as to the other characteristic attributes of the idea of means. The size and finish of the model, with various other minor requisites, must correspond with the regulations from time to time established by the Patent Office, by whose decision the sufficiency of the model is conclusively determined.[2]

§ 547. Model: its Final Disposition.

When an application is rejected in the Patent Office, and more than two years have elapsed since such rejection, the model will be returned to the applicant upon demand, at his expense, unless it is deemed necessary to preserve it in the Office. When an applicant formally abandons a pending application and files a certificate to that effect, duly signed by him, the model will be restored. Where a patent is granted, the model remains permanently in the Patent Office, and cannot be removed therefrom except in the custody of some sworn employee of the Office, authorized for that purpose by the Commissioner.

§ 548. Model: its Relation to other Parts of the Application.

The filing of a model does not constitute the filing of an application, nor is it any evidence that the application is complete.[1] Each portion of the application must be judged by

§ 546. [1] That the model must correspond with the specification and drawings in all essential particulars, see *Ex parte* Schoonmaker (1878), 13 O. G. 595.

That the model must clearly show every feature claimed, see *Ex parte* Crandall (1886), 35 O. G. 625.

[2] That the decision of the Commissioner that the model was duly presented is conclusive except on proceedings to set the patent aside, see Hoe *v.* Cottrell (1880), 17 Blatch. 546; 18 O. G. 59; 1 Fed. Rep. 597; 5 Bann. & A. 256.

§ 548. [1] That the filing of a model is not the filing of an application, see Henry *v.* Francestown Soapstone Stove Co. (1880), 17 O. G. 569; 5 Bann. & A. 108; 2 Fed. Rep. 78; Draper *v.* Wat-

itself so far as regards its correspondence with established rules, although on questions of interpretation the entire application is considered. A sufficient model does not validate an imperfect Description nor an improper Claim, nor supply the place of an accurate drawing. Only when the complete application is presented to the Patent Office, with every part perfect in itself, has the applicant any standing before the department or any right to have his application duly examined and adjudged.

§ 549. Specimens, instead of Drawings or Model, Required in Applications Covering Compositions of Matter.

A composition of matter not being capable of representation by drawings or model, the law requires the applicant to forward to the Patent Office, on the request of the Commissioner, such specimens of the ingredients and of the composition as will be sufficient for the purpose of experimentally showing the essential features of the invention.[1] In all cases where the article is not perishable, a specimen of the composition claimed, put up in proper form to be preserved by the Office, must be furnished.

SECTION VIII.

OF THE APPLICATION: FILING AND FEES.

§ 550. Filing of Application the Commencement of Proceedings to Obtain a Patent.

The act by which the attention of the Patent Office is directed to the claims of the inventor, and his right to an examination of those claims is secured, is the filing of the application with the Commissioner of Patents. This may be

tles (1878), 16 O. G. 629; 3 Bann. & A. 618.

That the filing of a model does not show that the application is complete, see Draper *v.* Wattles (1878), 16 O. G. 629; 3 Bann. & A. 618.

§ 549. [1] That whether specimens of ingredients shall be filed with an application is for the Patent Office to decide, see Anilin *v.* Cochrane (1879), 16 Blatch. 155; 4 Bann. & A. 215; Tarr *v.* Folsom (1874), Holmes, 312; 5 O. G. 92; 1 Bann. & A. 24.

done at any time after the invention is completed, provided no abandonment has taken place;[1] but until it is done the Office can take no notice of the invention further than to allow the inventor access to its library, records, and models, and to supply him with such copies of them as he may desire.

§ 551. Filing of Application: in What it Consists.

An application is filed when the petition, oath, and specification are presented in writing to the Commissioner, accompanied by such drawings as the nature of the case admits, and by such model or specimens as the Commissioner may himself require.[1] Neither the filing of a model, nor the writing of an application, nor the placing of the case in the hands of an attorney with instructions to apply for a patent, constitutes the filing of an application.[2] Nor is an application filed until all its parts have been received. It is desirable that these should be presented at the same time, and that all the papers embraced in the application should be attached together. If this is not done, each part must be accompanied by a letter accurately and clearly connecting it with the parts previously forwarded. An application not completed by the presentation of all its parts within two years from the lodgment

§ 550. [1] That the application may be filed at any time after the invention is completed, unless it has been abandoned, see Shaw *v.* Cooper (1833), 7 Peters, 292; 1 Robb, 643.

See also § 351 and notes, *ante*.

§ 551. [1] That the application is filed when presented to the Commissioner, see Henry *v.* Francestown Soapstone Stove Co. (1880), 5 Bann. & A. 108; 17 O. G. 569; 2 Fed. Rep. 78; Graham *v.* McCormick (1880), 5 Bann & A. 244; 10 Bissell, 39; 21 O. G. 1533; 11 Fed. Rep. 859.

[2] That filing a model is not filing an application, see Henry *v.* Francestown Soapstone Stove Co. (1880), 5 Bann. & A. 108; 17 O. G. 569; 2 Fed. Rep. 78; Draper *v.* Wattles (1878), 16 O. G. G. 629; 3 Bann. & A. 618.

That writing an application is not filing it, see Henry *v.* Francestown Soapstone Stove Co. (1880), 5 Bann. & A. 108; 17 O. G. 569; 2 Fed. Rep. 78.

That placing the invention in the hands of solicitors to have an application filed is not filing it, see Graham *v.* McCormick (1880), 10 Bissell, 39; 11 Fed. Rep. 859; 21 O. G. 1533; 5 Bann. & A. 244.

That to sign a blank application and forward it to solicitors to be filled out and filed, and their filing it is not such filing as the law requires, see *Ex parte* Benton (1882), 23 O. G. 341.

That the decision of the Commissioner that the application is properly filed cannot be collaterally attacked, see Hoe *v.* Cottrell (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256.

See also § 423 and notes, *ante*.

of the petition in the Patent Office is regarded as abandoned, unless the delay is shown to have been unavoidable.[3]

§ 552. Application, once Filed, thereafter Known by Date and Number.

When all the required parts of an application have been thus presented, it is placed on file for examination and a serial number given it, notice of which is sent to the applicant. Thenceforth the application is known both to the Office and to the inventor by its number, as well as by the title of the invention, and in all his correspondence with the Office concerning it, the inventor or his attorney must define the subject-matter of his communication by stating the name of the applicant, the title of the invention, the serial number of the application, and the date when it was filed.

§ 553. Application, once Filed, not Withdrawn: Preserved in Secrecy.

After an application is completed, the specification cannot be withdrawn from the Patent Office for any purpose whatever, though the model or the drawing may be returned to the applicant for such corrections as are deemed necessary. A copy of the specification may, however, be obtained by the inventor or his attorney. From all other persons outside of the department every part of the application is preserved in secrecy,[1] and no information is given concerning it to any one without due authority from the inventor, except in interference cases, or when the application has been rejected or

[3] That under the act of 1861 (Sec. 4894, Rev. Stat.), providing that all applications must be completed within two years unless the Commissioner is satisfied that the delay is unavoidable, if the application is delayed longer than two years and is then allowed, the decision of the Commissioner in allowing it is conclusive on the question of the reasonableness of the delay, see McMillin *v.* Barclay (1872), 5 Fisher, 189; 4 Brews. (Pa.) 275. See also § 578 and notes, *post.*

That an invention is not abandoned while the application lies unfiled in the hands of the attorney, unless the inventor knows of the neglect, see Birdsall *v.* McDonald (1874), 1 Bann. & A. 165; 6 O. G. 682.

§ 553. [1] That pending applications must be kept secret, see *Ex parte* Neale (1879), 15 O. G. 511.

That the rule requiring secrecy is reasonable and should be enforced, see Dec. Sec. Int. (1883), 23 O. G. 629.

abandoned, and in the judgment of the Commissioner its disclosure may be necessary.

§ 554. Payment of Fees.

The payment of the fees required by law is made by statute a condition of the issue of the patent, and the rules of the Patent Office prescribe their payment in advance, though when a patent issues before compliance with this requisite, it is not on that account invalid.[1] The fees may be paid to the Commissioner, or to the Treasurer or an Assistant Treasurer of the United States, or to any of the depositaries, national banks, or receivers of public money designated by the Secretary of the Treasury for that purpose, whose receipt, transmitted to the Patent Office, will be accepted as sufficient evidence of payment. Payment may also be made by postal order, or by money mailed to the Department. Money paid by mistake, or in excess of the required amount, will be refunded.

SECTION IX.

OF THE APPLICATION: PROCEDURE IN THE PATENT OFFICE IN UNCONTESTED CASES.

§ 555. Examination of Application: Objections to its Form.

All cases in the Patent Office are divided into certain classes for the purpose of examination and decision; those in the same class being examined and disposed of as far as practicable in the order in which the respective applications are completed, unless the invention is deemed of peculiar importance to some branch of the public service, and the head of a department of the government requests immediate attention to it upon that account. On the receipt of any application in the Office, and the payment of the fee, it is assigned to its proper class, and when its turn arrives is first subjected to an examination to determine whether it is in all respects in proper

§ 554. [1] That a patent issued without payment of the fees is valid, see Crompton *v.* Belknap Mills (1869), 3 Fisher, 536.

form.[1] If found to be formally sufficient, an examination into the merits of the application, and the patentability of the invention therein claimed, is instituted. But if decided to be insufficient the applicant is notified of the defect, and such information is given to him as will enable him to judge of the propriety of the decision, and if possible to correct his error.[2] Upon this notice he may either supply the alleged defect, or he may insist upon the sufficiency of the application and file a written request for a reconsideration, distinctly and specifically pointing out the errors in the finding of the examiner. From an adverse decision of the examiner, after such reconsideration, the applicant may appeal to the Commissioner in person. Where the faults in the form of the application are not vital the examiner may, if he chooses, withhold the announcement of his decision upon those points, and proceed to consider the application on its merits;[3] but must then, in

§ 555. [1] That the examiner may insist on having the specification correspond with the forms given in the rules, if he does so when the application is first filed, see *Ex parte* Bate (1879), 15 O. G. 1012.

That an examiner ought not to allow cases when the papers are defective, whether the defect is mentioned in the rules or not, see *Ex parte* Benton (1882), 23 O. G. 341.

That where there is a vital defect of form, such as the omission of an element, etc., the application cannot be examined on its merits, see *Ex parte* Mill (1887), 40 O. G. 918; *Ex parte* Silliman (1886), 34 O. G. 1389.

[2] That the Patent Office must act as the friend, not the adversary, of an applicant, and its examiners must aid him to secure his actual invention, see *Ex parte* Donovan (1888), 44 O. G. 698.

That the objections of examiners must be definitely stated to the applicant and the mode of avoiding them be pointed out, see *Ex parte* Wilkins (1883), 24 O. G. 1270.

That for an examiner to say that the defects are shown by "pencil notes" in the specification is not sufficient, see *Ex parte* Wilkins (1883), 24 O. G. 1270; *Ex parte* Evarts (1874), 5 O. G. 429.

That an applicant may insist on an examination of his application on its merits, in spite of defects in its form, unless the examiner gives him such information as will enable him to remove the defects, see *Ex parte* Templeton (1880), 17 O. G. 910.

[3] That the examination of an application on its merits is not conclusive on the Patent Office as to its correctness of form, see *Ex parte* Farquharson (1876), 10 O. G. 702.

That where a design patent is applied for when a mechanical patent alone is proper, the examiner, if the case is clear, should hold the application and notify the applicant; but if the case, being doubtful, is examined and rejected, a new application must be filed and a new fee paid, see *Ex parte* Bailey (1886), 37 O. G. 781.

That an application for a design patent should be rejected if the examiner

his first letter to the applicant, state all his formal objections with their reasons, and until these are disposed of no judgment can be passed upon the merits, without an order of the Commissioner.[4]

§ 556. Objections on the Ground of Misjoinder: Division of the Application.

When a single application embraces several independent inventions in violation of the rules regarding the joinder of inventions, the applicant will be required to limit his present application to some one of them, and may then file separate applications for the others.[1] If the independence of the inventions is clear on the face of the application, this division must be ordered before any examination on the merits; if not clear, the division may be required at any time when its necessity becomes evident before final action.[2] Whether a division shall be made rests entirely within the judgment of the Patent Office,[3] but none should be ordered unless each of the alleged

considers that the subject-matter is not a design, and from such rejection an appeal lies to the Board of Examiners, see *Ex parte* Harris (1886), 38 O. G. 104.

[4] That the first letter of the examiner must advise the applicant of all formal requirements, cite all references, and instruct him that action on the merits is postponed until the objections are removed, see *Ex parte* Mill (1887), 40 O. G. 918; *Ex parte* Silliman (1886), 34 O. G. 1389.

That all formal matters must be settled before any Claim is rejected on the merits, and no rejection on the merits should be made in terms until all formal questions are determined, see *Ex parte* Mill (1887), 40 O. G. 918; *Ex parte* Silliman (1886), 34 O. G. 1389.

§ 556. [1] That where separate and independent inventions are embraced in one application, it must be divided, see *Ex parte* Mill (1887), 40 O. G. 918; *Ex parte* Young (1885), 33 O. G. 1390; *Ex parte* Martin (1883), 25 O. G. 502; *Ex parte* Preston (1880), 17 O. G. 853; *Ex parte* Siemens (1877), 11 O. G. 969.

See also §§ 468–479 and notes, *ante*.

That if a combination does not cooperate a division between the elements is necessary, see *Ex parte* Herr (1887), 41 O. G. 463.

That a division must be ordered when two independent inventions are covered, whether the divided inventions would come under any Office class or not, see *Ex parte* Martin (1883), 25 O. G. 502.

[2] That if an application is to be divided, it should be done before an examination on the merits, see *Ex parte* Silliman (1886), 34 O. G. 1389; *Ex parte* Young (1885), 33 O. G. 1390; *Ex parte* Rice (1874), 5 O. G. 522.

That division should not be ordered without sufficient examination to show its necessity, see *Ex parte* Sanders (1878), 13 O. G. 818.

[3] That whether a division is necessary is a question for the Patent Office alone, see *Ex parte* Herr (1887), 41

independent inventions would be a proper subject-matter for a separate patent;[4] and the examiner, in communicating the order to the applicant, must clearly point out to him the nature and extent of the required division, to enable him to file such separate applications if he so desires.[5] The division is effected by an amendment of the original application, confining its Claims, and so far as practicable its Description, to a single invention, and the filing of such additional applications for the other inventions as may be deemed advisable.[6] These additional applications are so far independent of the original that each must be attested by a new oath, and possess all the other prerequisites of a complete application;[7] but

O. G. 463; McKay *v.* Dibert (1881), 5 Fed. Rep. 587; 19 O. G. 1351; *Ex parte* Murray (1873), 3 O. G. 659.

See also § 469 and note 2, *ante*.

That the Patent Office requires a division not merely for its own sake but in order that the patent may be valid, see *Ex parte* Van Matteson (1883), 24 O. G. 389.

[4] That no division can be required unless each invention would be separately patentable, see *Ex parte* Pintsch (1877), 11 O. G. 597.

That in dividing applications the distinction between separable inventions must be regarded, not the mere distinctions between words, see *Ex parte* Holt (1884), 29 O. G. 171.

That where the Claims of two divisions must overlap each other the division is improper, see *Ex parte* Holt (1884), 29 O. G. 171.

That no division can be ordered where the process and product are inseparable, see *Ex parte* Holt (1884), 29 O. G. 171. See also § 473 and note 3, *ante*.

That divisions between parts of the same machine must not cover the same ground, see *Ex parte* Holt (1884), 29 O. G. 171.

That a divisional application cannot be based on new matter added to the original after filing, see *Ex parte* Buell (1884), 26 O. G. 437.

[5] That in notifying the applicant to divide his application, the examiner must point out clearly the nature and extent of such division, see *Ex parte* Knott (1875), 8 O. G. 238.

That in ordering a division between a process and a product on the ground that the product can be produced by other processes, such other processes must be pointed out by the examiner, see *Ex parte* Pastor (1887), 42 O. G. 95.

[6] That where a division is ordered and matter is eliminated from the specification it must be removed from the drawings also unless necessary to the comprehension of what remains, see *Ex parte* Simonds (1888), 44 O. G. 449.

That where a division is required an amendment which simply reduces the number of the inventions, without removing the objections raised, should not be received, and if admitted only limits the right of the applicant to elect what inventions shall be covered by the application, see *Ex parte* Maxim (1888), 43 O. G. 506.

[7] That each additional application for the divided inventions must be supported by a new oath and possess the

when the patents are allowed, the date of the original application is regarded as the date of all the others, in reference to the questions of priority and public use, in order that the rights of the inventor to his entire invention, as first applied for, may be fully preserved.[8] Where all the inventions so divided relate to the same general subject-matter, and each of the applications thus describes the whole though claiming but a single part, each should disclaim all other portions, with proper references to the applications in which they are claimed.[9]

§ 557. Model and Specimens Ordered when Found Necessary.

No preliminary examination of the application is made in the Patent Office to ascertain whether or not a model will be necessary. The application, if complete in other respects, is subjected to an examination on its merits, and if in the course of this examination it appears to the examiner that a model will be useful, an order to furnish one is sent to the applicant, and proceedings are suspended until the order is obeyed. The same rule applies to specimens of a composition and of its ingredients.

other requisites of an independent application, see *Ex parte* Tieman (1877), 11 O. G. 1; *Ex parte* Hoginbotham (1875), 8 O. G. 237.

That where an application is filed as a division of a former application, the first duty of the examiner is to see whether it is a legal continuation of the other, see *Ex parte* Buell (1884), 26 O. G. 437.

[8] That where several divisions represent different parts of the same whole, to which all the parts are necessary, all the divisions should be pending at one and the same time, see *Ex parte* Holt (1884), 29 O. G. 171.

That all the divided applications bear the date of the original, see Graham *v.* Geneva Lake Crawford Mfg. Co. (1880), 11 Fed. Rep. 138; 21 O. G. 1536; Graham *v.* McCormick (1880), 11 Fed. Rep. 859; 10 Bissell, 39; 21 O. G. 1533; 5 Bann. & A. 244.

[9] That all divisional applications must disclaim what they do not claim, see *Ex parte* Clarke (1884), 26 O. G. 824.

That the rules requiring cross-disclaimers in two pending applications for the same general invention re strictly enforced, see Drawbaugh *v.* Blake (1883), 23 O. G. 1221.

That the rules requiring disclaimers in pending applications are directory only, and the issue of one patent is no bar to a second unless the matter is inseparable, see *Ex parte* Roberts (1887), 40 O. G. 573.

That where an application is once divided, the separated matter can never be re-instated, see *Ex parte* Preston (1880), 17 O. G. 853.

That no election binding on the applicant is made until he has complied with the order for a division and his action has been accepted by the Office, see *Ex parte* Maxim (1888), 43 O. G. 506.

§ 558. Examination of Application on its Merits: Two Questions Involved: their Decision.

When an application is complete in form it is entitled to an examination on its merits. This examination consists in an inquiry into the legal right of the applicant to a patent for the invention described and claimed in the application. It involves two questions: (1) Whether the subject-matter of the application is, in itself, a patentable invention; (2) Whether the applicant or his decedent was its true and first inventor. In uncontested cases the latter question is answered affirmatively by the oath of the applicant, and requires no further investigation unless the examiner has some knowledge to the contrary.[1] The former question is divisible into five subordinate ones: (1) Whether the subject-matter of the application is the result of a true and complete inventive act; (2) Whether it is embraced in either one of the six classes of inventions which are made patentable by the act of Congress; (3) Whether it is now, or, on the contrary, has been known or used in this country, or patented or published at home or abroad, before the date of the present application; (4) Whether it is useful; (5) Whether it has been abandoned to the public. In making this investigation the examiner is not compelled to observe the strict rules of evidence, but must ascertain, as best he can, from the publications, patents, and general knowledge at his command, whether the application should be rejected or allowed.[2] He is not bound by any conclusions of his predecessors, though he must follow the deci-

§ 558. [1] That the application-oath is *prima facie* proof of the applicant's priority, see *Ex parte* Hill (1879), 16 O. G. 765.

See also § 457 and notes, *ante*.

[2] That the rules of evidence do not apply to uncontested cases, see Hedges *v.* Daniels (1880), 17 O. G. 394.

That the examiner must ascertain, as best he can, whether the invention is patentable, see Hedges *v.* Daniels (1880), 17 O. G. 394.

That the identity of two designs must be decided from inspection by the experts in the Office, see *Ex parte* Gerard (1888), 43 O. G. 1235.

That matters public notoriety, affecting the right of the applicant to a patent will be taken notice of, see Anson *v.* Woodbury (1877), 12 O. G. 1.

That if the examiner sees that the invention is impracticable he should reject the application for want of utility, see *Ex parte* De Bausset (1888), 43 O. G. 1583.

That a patent should not be allowed merely because it can do no harm, see *Ex parte* Mixer (1872), 1 O. G. 48.

sions of the Commissioner both on matters of law and fact, whatever may be his own judgment concerning their propriety.[3] He is also required to conform to the rules laid down by the courts for determining the patentability of inventions. If it appears to him, as the result of his investigation, that the subject-matter of the application is patentable and that the applicant or his decedent was its true and first inventor, it is his duty to allow the application; if the contrary appears, it is his duty to reject it.[4] Where the investigation leaves him in doubt, it is still incumbent on him to decide either for or against the applicant, in order that the patent may be granted, or else an opportunity be given for further inquiry on a reconsideration or an appeal.

§ 559. Rejection of Application: Notice and References.

When an application, or one of the Claims in an application, is rejected upon any ground whatever the examiner is required to notify the applicant of such rejection, stating all his reasons therefor fully and precisely, and giving him such information and references as may assist him in judging of the advisability of prosecuting his application or of altering his specification.[1] If the ground of the rejection be that the applicant is not the true and first inventor of the art or instrument described, the examiner must cite references establishing his assertion, or himself make oath to it, to overcome the presumption arising from the oath of the alleged inventor.[2]

[3] That the conclusions of an examiner do not bind his successor, unless embodied in a formal judgment, see *Ex parte* Buell (1884), 26 O. G. 437; *Ex parte* Starr (1879), 15 O. G. 1053.

That the former erroneous decision of an examiner is to be departed from, see *Ex parte* Traitel (1883), 25 O. G. 783.

[4] That the primary examiner when considering the merits of the application must look to the language of the application alone, see Faure *v.* Bradley (1888), 44 O. G. 945.

§ 559. [1] That an examiner, in rejecting an application, should cite references, not give his own *dictum*, see *Ex parte* Fairbanks (1873), 3 O. G. 65.

That all the examiner's reasons for rejecting the application must be given at once, see *Ex parte* Proudfit (1876), 10 O. G. 585.

That all references and objections are to be cited and urged by the examiner on or before final rejection, though if he overlooks a reference he may urge it as soon after final rejection as he discovers it, as *e. g.* in his appeal-statement, see *Ex parte* Parker (1886), 36 O. G. 119.

[2] That if the examiner denies the

If the ground of the rejection be the absence of novelty in the subject-matter of the application, the examiner must disclose to the applicant all his own information on the subject, citing the best references at his command. When these references are prior patents, each must be designated by its date and number, and by the name of the patentee and the class of the invention. When the reference is a prior publication, its title, date, page or plate, and place of publication or place where a copy may be procured, must be given. When the reference is a fact within the knowledge of the examiner or the Patent Office, the data mentioned must be as precise as the nature of the case admits, and the reference must be supported by the affidavit of the person to whom the fact is known. The pertinence of the reference cited, if not obvious on inspection, must be clearly explained and the anticipated Claim particularly specified; and where a reference shows or describes inventions other than that claimed by the applicant, the part relied on to defeat his Claim must be as accurately designated as possible. Devices cited as references need not have commercial value, nor be identical in form, material, or mode of use with that described in the application; substantial correspondence constituting them the same invention.[3] An abandoned or rejected application is not a public document, and cannot be referred to as disclosing prior knowledge of the invention.[4] In all cases, pertinent references only should be

priority of the applicant and cannot cite a reference, he must support his denial by an affidavit, see *Ex parte* Hill (1879), 16 O. G. 765.

[3] That devices, cited as references, need not have commercial value, see Sargent *v.* Burge (1877), 11 O. G. 1055.

That the device, cited as a reference, need not be identical with the one claimed in the application, either in material, shape, or mode of use, see *Ex parte* Chatillon (1872), 2 O. G. 115.

That a drawing without printing may be cited as a reference, see *Ex parte* Borden (1884), 26 O. G. 439.

[4] That an abandoned application cannot be cited as a reference, see Webster *v.* Sanford (1888), 44 O. G. 567; *Ex parte* Borden (1884), 26 O. G. 439; Corn Planter Patent (1874), 23 Wall. 181; 6 O. G. 392.

That a rejected application cannot be cited as a reference, see Webster *v.* Sanford (1888), 44 O. G. 567; Blades *v.* Rand, McNally, & Co. (1886), 27 Fed. Rep. 93; 37 O. G. 99; Northwestern Fire Extinguisher Co. *v.* Philadelphia Fire Extinguisher Co. (1874), 6 O. G. 34.

That an abandoned or rejected application can be cited as a reference, see *Ex parte* Gordon (1874), 6 O. G. 543.

mentioned, and the best references should be cited first.[5] The examiner is under no obligation to embody in his notice any suggestions as to the proper Claims to be inserted in the application, — this being a matter for the applicant upon the information afforded to him by the Patent Office.[6]

§ 560. Action of Applicant after Rejection: Insistence and Second Rejection.

On the receipt of this notice of rejection, the applicant may either insist on the allowance of his application as it stands, or he may amend it, or he may withdraw it altogether. If he insists, he may controvert by argument the position taken by the examiner upon matters of law or upon the identity of his invention with the references cited, or he may deny the existence of the facts contained in the reference itself. To facts stated and sworn to by the examiner as within his personal knowledge, he may oppose his own affidavit or those of other persons, and these may be met by counter-proofs on the part of the examiner. If the reference is a domestic patent, or if it is a foreign patent or a publication, the applicant may avoid the reference by an affidavit showing his completion of the invention before the filing of the application for the domestic patent, or before the date of the foreign patent or the publication, and averring that he does not know or believe that the invention has been in public use or on sale in this country for more than two years prior to his application, and that he has never abandoned the invention.[1] A rejection upon such references

[5] That pertinent references only should be cited, see *Ex parte* Brownlie (1873), 3 O. G. 212.

That the best references must be cited first, see *Ex parte* Sanders (1878), 13 O. G. 818.

[6] That the examiner need not suggest proper Claims, this being the duty of the applicant, see *Ex parte* Evarts (1874), 5 O. G. 429.

§ 560. [1] That the applicant need show only such facts as will carry the date of his invention back of the references cited, see *Ex parte* Lanfrey (1881), 20 O. G. 892; *Ex parte* Gasser (1880), 17 O. G. 507.

That in order to overcome a prior patent or publication the applicant must show by competent legal proof that he had disclosed the invention to others, as fully as the patent or publication does, before the patent was granted or the publication made, see *Ex parte* Saunders (1883), 23 O. G. 1224.

That an affidavit, under the rule requiring an affidavit of prior invention after rejection on a patent or publication, must set out the facts on which

to domestic patents showing but not claiming the invention, or to foreign patents, or to publications, or on the ground of public use or sale, or that the device referred to is capable of performing the same operation in the same manner, or that the invention is inoperative or frivolous or injurious to public health or morals, opens the whole question of fact to investigation upon affidavits or depositions, denying or supporting these objections.[2] Upon the statement of the applicant that he insists on the allowance of his application in its original

the applicant bases his claim and if he asserts that he had made drawings or models, such drawings and models, or copies of them, must be produced, see *Ex parte* Saunders (1883), 23 O. G. 1224.

That the applicant, in his proof, must set forth the facts which show that his inventive act preceded the filing of the application named in the reference, though they need not be particularly stated nor need he allege that he made the invention before the inventor whose patent has been cited against him, see *Ex parte* Gasser (1880), 17 O. G. 507.

That the applicant's proof must show a reduction to practice or reasonable diligence in reducing, before the filing of the application for the patent cited against him, see *Ex parte* Gasser (1880), 17 O. G. 507.

That foreign inventors may show that their inventions were known in this country before the dates of their applications, but cannot show use abroad prior to the dates of their patents, see *Ex parte* Lanfrey (1881), 20 O. G. 892.

That affidavits claiming priority against an existing patent are secret, see *Ex parte* Gasser (1880), 17 O. G. 507.

In cases where the patent cited as a reference claims the invention covered by the rejected application, and is an unexpired domestic patent, an interference arises upon the filing of the affidavit described in the text, and the proceedings thenceforth follow the rules discussed in §§ 586–616, *post*.

[2] That the Patent Office may receive the affidavits of third persons in uncontested cases, but care must be taken to guard against fraud, and the applicant must have an opportunity to examine them and offer counter-proof, see Hedges *v.* Daniels (1880), 17 O. G. 394.

That the Commissioner may act on his personal knowledge of public use, see Alteneck's Appeal (1882), 23 O. G. 269.

That the inquiry of the Commissioner into the knowledge of others as to an alleged public use is a judicial inquiry, and there must be due notice and legal evidence, see *Ex parte* Barricklo (1886), 38 O. G. 417; Alteneck's Appeal (1882), 23 O. G. 269.

That the right and opportunity to offer rebutting evidence on the question of public use is no substitute for cross-examination of adverse witnesses, see Alteneck's Appeal (1882), 23 O. G. 269.

That a rejection on the ground of public use or sale on mere *ex parte* affidavits, without notice or examination, is improper, see *Ex parte* Barricklo (1886), 38 O. G. 417; Alteneck's Appeal (1882), 23 O. G. 269.

That affidavits, averring that the invention was in public use two years before the application was filed, authorize the Commissioner to call on the applicant to show cause why he should not prove the contrary, see *Ex parte* Barricklo (1886), 37 O. G. 672; 38 O. G. 417.

form, and the completion of the proofs and counter-proofs upon the disputed questions of fact, when such exist, the examiner is required to re-examine the case and communicate the result of this examination to the applicant. If he again rejects the application, his notice of such second rejection must, like that of the first, specifically and exhaustively allege the grounds of his adverse decision.

§ 561. Amendment of Application.

Amendments to the application may be offered at any time after it is taken up for examination and before final disposition of it has been made.[1] Amendments in form are optional with the applicant to any extent, and may be required by the Patent Office when necessary to correct inaccuracies of statement or undue prolixity, or to secure correspondence between the Claim and the Description. Amendments in substance can be made only within certain limits, and under certain prescribed conditions.[2] No new matter can under any circumstances be introduced by amendment.[3] New matter is that which is not found in the specification, drawings, or model, as first filed, and which involves a departure from the original invention.[4] Such matter must necessarily be a distinct art or

§ 561. [1] That an inventor may amend or enlarge his Claims at any time pending his application, in order to embrace everything which was specified at the outset, see Railway Register Mfg. Co. *v.* North Hudson Co. R. Co. (1885), 24 Fed. Rep. 793 ; 33 O. G. 355.

That an amendment may be made at any time within two years from the date of the "last action," see *Ex parte* Reynolds (1883), 24 O. G. 993.

[2] That an amendment cannot be made unless a good reason for allowing it appears, see *Ex parte* Winchester (1830), 17 O. G. 453.

[3] That new matter, changing the character of the invention, cannot be introduced by amendment, see *Ex parte* Wharton (1887), 40 O. G. 917 ; *Ex parte* Dunn (1879), 16 O. G. 1004 ; *Ex parte* Lamb (1879), 16 O. G. 405 ; *Ex parte* Temple (1877), 12 O. G. 795.

That the phrase "new matter" applies to re-issues rather than amendments, see *Ex parte* Holt (1884), 29 O. G. 171.

[4] That any amendment containing features not found in either the specification, the drawings, or the model, when the invention is capable of illustration by model or drawings, introduces new matter and must be made as a separate application, see *Ex parte* Crandall (1886), 35 O. G. 625 ; *Ex parte* Temple (1877), 12 O. G.

That no material amendment can be allowed, see Chicago & Northwestern R. R. Co. *v.* Sayles (1878), 97 U. S. 554 ; 15 O. G. 243.

That amendments enlarging the in-

instrument, or a new and separately patentable improvement on the old, and can be now presented only in a separate application.[5] Amendments changing the construction or mode of operation of the invention, or describing a different embodiment of the idea, or re-instating Claims which have been eliminated to avoid certain references cited or to comply with an order for a division of the application, are all open to this objection and cannot be permitted.[6] Amendments not intro-

vention are suspicious, see Chicago & Northwestern R. R. Co. *v.* Sayles (1878), 97 U. S. 554; 15 O. G. 243.

That an amendment cannot insert into the application matter which has been in public use more than two years, see Kittle *v.* Hall (1887), 39 O. G. 707; 29 Fed. Rep. 508; 24 Blatch. 184.

That amendments enlarging the scope of the application are not allowable, see Eagleton Mfg. Co. *v.* West, Bradley, & Cary Mfg. Co. (1880), 18 Blatch. 218; 17 O. G. 1504; 2 Fed. Rep. 774.

That an amendment cannot introduce a different invention but only set forth more fully the one already applied for, see *Ex parte* Snyder (1882), 22 O. G. 1975.

That amendments may illustrate but cannot alter the invention applied for, see *Ex parte* Howe, (1883), 25 O. G. 1189.

That an applicant cannot change his ground and secure successive examinations for a single fee, see *Ex parte* Holt (1884), 29 O. G. 171.

[5] That where an amendment is not permitted a new application may be filed, see *Ex parte* Thurmond (1886), 37 O. G. 217.

[6] That the essential character of the invention, as originally set forth, cannot be changed by amendment, see *Ex parte* Dodge (1872), 3 O. G. 179.

That Claims rejected to meet objections of the examiner cannot be re-inserted by amendment, either in the same or a different mode of statement, see *Ex parte* Andrews (1879), 15 O. G. 1056.

That Claims struck out because inconsistent with other Claims cannot be re-inserted by amendment, after such other Claims have been defeated in an interference, see *Ex parte* Cobb (1879), 16 O. G. 175.

That a Claim once voluntarily erased cannot be restored, but may be made the subject of a new application, see *Ex parte* Johnston (1887), 40 O. G. 574.

That matter eliminated by a division of the application cannot be re-instated by amendment, see *Ex parte* Preston (1880), 17 O. G. 853.

That an applicant having elected to claim one species cannot change though he finds it unpatentable, see *Ex parte* Wharton (1887), 40 O. G. 917.

That when an application contains a generic Claim and several specific Claims, of which one is imperfect, the applicant may amend his imperfect Claim and then elect which specific Claim he will retain, see *Ex parte* Johnston (1887), 40 O. G. 574.

That when an examiner is in doubt as to want of identity in the amended application he should examine it on the merits, and if he rejects it cite his references, see *Ex parte* Bennett (1886), 35 O. G. 1003.

That where an amended application shows want of identity, it should be rejected by the examiner and an appeal taken if desired, see *Ex parte* Bennett (1886), 35 O. G. 1003.

ducing new matter may be made without a new oath when the features of the invention therein described or claimed are already apparent in the application as originally filed, and the effect of the amendment is merely to supply suitable connections, add subordinate devices, remedy manifest defects, correct clerical errors, or declare further uses for which the art or instrument may be employed.[7] Where drawings and a model accompanied the original specification, such amendments must conform to at least one of them as they were first filed; but if the invention does not admit of model or drawing the specification may be amended on proof satisfactory to the Commissioner that the proposed matter was part of the origi-

[7] In *Ex parte* Snyder (1882), 22 O. G. 1975, Marble, Com.: (1975) "The applicant will not be permitted, under the guise of an amendment, to introduce into his application a wholly different invention, nor to change the construction and operation of an invention which has been fully described and shown, nor to present a different or preferable form of his invention. He may be permitted, upon proper occasion, to supply suitable connections, to add a spring to a pawl, a handle to a crank, a belt to a pulley, teeth to a wheel, an outlet to a closed receptacle, or other manifest defects or omissions in features essential to the operation of the invention or to the completeness of the disclosure, and which were caused by a clerical error of the draftsman or the unfamiliarity of the inventor with official forms. These amendments, supplemental in their nature, may be made as completing the invention imperfectly shown and described. They add to the invention disclosed some part or feature which agrees with the construction and operation already presented. An applicant cannot be permitted, however, to erase the lines of his drawing and delineate anew the construction and operation of a part fully shown and described, or replace a well-described but inferior arrangement by a preferable form of his invention."

That any amendment, within the original sworn statement, may be made without a new oath, etc., see Railway Register Mfg. Co. *v.* North Hudson Co. R. Co. (1885), 24 Fed. Rep. 793; 33 O. G. 355; *Ex parte* Eaton (1873), 4 O. G. 525.

That an amendment may introduce a part of a Claim covering an element additional to the combination in which the invention was said to consist, if this element is shown in the specification or drawings, see Hoe *v.* Cottrell (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256.

That an amendment may claim the process as composed of certain sub-processes if the specification describes them, see *Ex parte* Wohltmann (1879), 16 O. G. 723.

That where the specification describes the old elements of a combination as new, an amendment distinguishing the new elements from the old must be filed, see *Ex parte* Gilbert (1879), 16 O. G. 763.

That an amendment may be made showing that the invention is applicable to additional uses, see *Ex parte* Slotterbeck (1875), 8 O. G. 1073.

nal invention.[8] Amendments not introducing new matter, but containing features which are not substantially represented in the application as originally filed, and yet which might have been, and are claimed to be, a part of the original invention, must be accompanied by a new oath, averring that the subject of the amendment was a portion of the invention and was invented before the original application was presented;[9] and the

[8] That if the matter of an amendment can be found either in the specification, drawing, or model it suffices, see *Ex parte* Huck (1879), 16 O. G. 1052; *Ex parte* Dorman (1876), 9 O. G. 1061.

That amendments to the specification must be based on the drawing or model if any; and if none, then they must be shown by proper proof to have been embraced in the original invention, see *Ex parte* McDougall (1882), 21 O. G. 1783; *Ex parte* Shalters (1879), 15 O. G. 970.

That an invention not shown in the drawing or model, when capable thereof, cannot be inserted in an amendment, and an amendment embracing such matter should not be received, see *Ex parte* Vailo (1886), 37 O. G. 563; *Ex parte* Bennett (1886), 35 O. G. 1003.

That drawings must not be changed or erased in the Patent Office, being records of an important character, see *Ex parte* Wharton (1887), 40 O. G. 917.

That where there are neither drawings nor model the amendment must still be confined to the original invention, see *Ex parte* Crandall (1886), 35 O. G. 625.

That in cases not admitting of model or drawing an amendment must be accompanied by proof that the new matter is part of the original invention, and in the absence of such proof the amendment will not be considered, see *Ex parte* Bennett (1886), 35 O. G. 1003.

[9] That Claims amended in matters of substance are to be treated as new Claims just presented, — matters of substance being such as change the character of the invention, not merely the modes of describing it, — see *Ex parte* Winchester (1880), 17 O. G. 453.

That an amendment not fairly covered by the original oath must be duly verified, see *Ex parte* Foster (1885), 33 O. G. 113.

That where Claims are enlarged in subject-matter by an amendment a supplemental oath is necessary, see *Ex parte* Crandall (1886), 35 O. G. 625; *Ex parte* Clarke (1886), 36 O. G. 120.

See also § 455 and note 3, *ante*.

That an amendment introducing a part of the invention as originally made, but not appearing in the specification as first filed, must be supported by an oath that it belonged to the original invention, see *Ex parte* McDougall (1882), 21 O. G. 1783.

That an amendment introducing what was before shown only in the model requires a new oath, see *Ex parte* Eaton (1873), 4 O. G. 525.

That an amendment filed by an administrator after the death of the original applicant requires a new oath when the matter introduced covers more than the original application, and a patent issued on such amendment without a new oath is void, see Eagleton Mfg. Co. *v.* West, Bradley, & Cary Mfg. Co. (1883), 111 U. S. 490; 27 O. G. 1237; Eagleton Mfg. Co. *v.* West, Bradley, & Cary Mfg. Co. (1880), 18 Blatch. 218; 17 O. G. 1504; 2 Fed. Rep. 774.

That the decision of the Patent Office

date of this oath is then entered on the papers and is thereafter regarded as the true date of the amended application.[10] By this mode of amendment a specific Claim may be inserted in an application for the generic invention, or the description of a mode of making a certain manufacture may be introduced into an application for the manufacture itself; or features essential to the invention, but not embraced within the original sworn statement, may be added to the Description and Claim already filed.[11] No amendment can be permitted to enlarge a specification to the prejudice of intermediate inventors;[12] and long delay in filing such amendments raises a strong presumption that the original application correctly limited the scope of the invention then made, and that the additions or variations disclosed by the amendment are of late discovery.[13]

that an attorney has been appointed an amendment showing such a mode with authority to amend is final, see Hoe *v.* Cottrell (1880), 17 Blatch. 546; 18 O. G. 59; 1 Fed. Rep. 597; 5 Bann. & A. 256.

[10] That when an amendment which requires a new oath is filed, the date of the application is changed to that of the new oath, see *Ex parte* McDougall (1882), 21 O. G. 1783.

That when an amendment introduces matter evidently just thought of by the inventor, the date of his amendment is taken as the date of the invention, see Hull *v.* Lowden (1881), 20 O. G. 741.

That applications amended by order of the Patent Office are continuous, see International Tooth Crown Co. *v.* Richmond (1887), 39 O. G. 1550; 30 Fed. Rep. 775.

[11] That when an application contains generic Claims only, and the oath avers that the applicant invented the things claimed, a new specific Claim cannot be inserted by amendment, see *Ex parte* Heaton (1879), 15 O. G. 1054.

That where a Claim for a manufacture is rejected because no mode in which it could be made is described, can be made with a new oath, see *Ex parte* Benson (1879), 15 O. G. 512.

[12] In Railway Co. *v.* Sayles (1878), 97 U. S. 554, Bradley, J.: (563) "The law does not permit such enlargements of an original specification, which would interfere with other inventors who have entered the field in the mean time, any more than it does in the case of re-issues of patents previously granted. Courts should regard with jealousy and disfavor any attempts to enlarge the scope of an application once filed, or of a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alteration, or to appropriate that which has, in the mean time, gone into public use." 15 O. G. 243 (246).

[13] That the insertion of an amendment broadening the Claims of the applicant after long delay tends to show that the real invention was properly presented in the original application, see Chicago & Northwestern R. R. Co. *v.* Sayles (1878), 97 U. S. 554; 15 O. G. 243.

§ 562. Amendments: when Made.

Though amendments may be made at any time when their necessity becomes apparent, they should be completed as far as possible before the Claims are passed upon by the examiner.[1] Amendments in substance cannot be filed, as of course, on or after an appeal from the examiner to the examiners-in-chief,[2] nor after a notice of the allowance of the patent has been given to the applicant;[3] since in the first case the amend-

§ 562. [1] That amendments should be completed before the Claims are passed on by the examiner, but may be made at any later time if necessary, see *Ex parte* Dodge (1872), 3 O. G. 179.

That the application is open to amendment and addition, within the limits fixed by the drawings and model, until it is finally disposed of, see *Ex parte* Dodge (1872), 3 O. G. 179; Singer *v.* Braunsdorf (1870), 7 Blatch. 521.

That after a rejection the applicant cannot amend by claiming a different invention, see *Ex parte* Zabel (1888), 43 O. G. 627.

That after a second rejection an applicant cannot amend as a matter of course, but must satisfactorily explain why he did not earlier offer the correction, see *Ex parte* Donovan (1888), 44 O. G. 698.

That the filing of another application, claiming the same invention, does not prevent the prior applicant or patentee from amending his application or patent or doing any other rightful act, see *Ex parte* Zay (1881), 19 O. G. 1496.

That the object of limiting amendments is to determine when the application is complete, see *Ex parte* Temple (1877), 12 O. G. 795.

That when the examiner refuses to receive an amendment, the applicant may petition the Commissioner, and then unless it is clearly improper, the examiner may be ordered to receive it, see *Ex parte* Vaile (1886), 37 O. G. 563; *Ex parte* Bennett (1886), 35 O. G. 1003.

That where an amendment, received by the examiner under order of the Commissioner, contains matter which he regards as not embraced in the original invention, he must reject it, see *Ex parte* Vaile (1886), 37 O. G. 563; *Ex parte* Bennett (1886), 35 O. G. 1003.

[2] That Claims filed after an appeal to the examiners-in-chief cannot be considered unless sanctioned by the Commissioner, see *Ex parte* Dodge (1872), 3 O. G. 179.

That an amendment cannot be made in taking an appeal to the examiners-in-chief, see *Ex parte* Hammond (1872), 2 O. G. 57.

That a primary examiner cannot open a case for amendment after appeal and affirmance by the examiners-in-chief, on a mere suggestion of such examiners, but only on a clear recommendation, see *Ex parte* Peterson (1887), 40 O. G. 692.

That jurisdiction over such amendments is in the examiner with right of appeal, see *Ex parte* Peterson (1887), 40 O. G. 692; *Ex parte* Pearson (1887), 40 O. G. 244.

That an amendment of the specification, after the decision of the appellate tribunal, should be forwarded to the examiner, who will pass on its admissibility and merits, see *Ex parte* Reynolds (1883), 24 O. G. 993; *Ex parte* Hitt (1883), 25 O. G. 192.

[3] That an application which has passed to issue in the form selected by the applicant will not be withdrawn for amendment unless great damage would

ment would change the issue presented by the appeal, and in the second case would cause the patent to protect a subject-matter not allowed by the examiner. Amendments in form may be made after the patent is ordered to issue, and after payment of the final fee, on recommendation of the examiner, approved by the Commissioner.

§ 563. Amendments: their Form.

Every amendment must be written in a fair and legible hand, on one side of the paper, and on a separate sheet. No erasures can be made in the original application, but the exact word or words to be stricken out must be indicated in the amendment, and the substitutions, if any, with the place of their insertion, must be distinctly stated.[1] When an amendatory clause is amended it must be wholly rewritten so that no erasure or interlineation may appear when the amendments are completed. If amendments are numerous or difficult to arrange, the examiner or Commissioner may require the entire specification to be rewritten. The specification cannot be taken from the Patent Office for the purpose of alteration, nor can the drawing and model both be withdrawn at the same time.

§ 564. Amendments Dependent on Original Application: their Scope.

An amendment, however extensive in substance or complete in form, must always be subordinate to, and connected

otherwise result, see *Ex parte* Gaboury (1886), 37 O. G. 217.

That a petition to amend and have a new hearing, after the patent has passed to issue, will be denied, and the claimant left to file a new application, unless irreparable injury would result, see *Ex parte* Page (1888), 43 O. G. 1455.

§ 563. [1] That if a cancelled Claim is to be restored by amendment it must be done as a separate amendment, not by merely erasing the cancellation, see *Ex parte* Mumler (1883), 24 O. G. 1090.

That amended Claims may be inserted into an application by the attorney without the signature of the applicant, see Railway Register Mfg. Co. *v.* North Hudson Co. R. Co. (1885), 24 Fed. Rep. 793; 33 O. G. 355.

That an attorney has no right to substitute a clean draft of a specification for the one signed and sworn to by the applicant, and if he does so it must be erased, see Sheridan *v.* Latus (1883), 25 O. G. 501.

That where the examiner decides that the invention is a mere aggregation and the applicant acquiesces and erases his Claim, he should also cancel all reference thereto from his specification and drawings, and cannot afterward restore his Claim by an amendment, see *Ex parte* Gillette (1888), 44 O. G. 819.

with, the original application. Two distinct applications cannot qualify or support each other.[1] Where a later application by the same inventor describes the same invention as an earlier one, and either claims it more precisely or alone claims it, the later application is not regarded as an amendment to the earlier, but is allowed or rejected on its own merits.[2] The earlier application stands also unaffected by the filing of the later, and may be amended and allowed without reference thereto. An amendment of one portion of the application does not always change the rest, except so far as, by construing the whole together, the meaning of the unaltered portions may be modified by the interpretation given to that which is amended.[3] A Claim may thus be amended without affecting the Description, or the Description without influencing the Claims, or the drawings or model without revising the language of the specification.[4]

§ 565. Examination of Amended Application: its Rejection: Appeal.

In offering an amendment for the purpose of removing any of the grounds on which an application has been rejected by the examiner, the applicant must point out all the patentable novelty which he thinks the case presents in view of the state of the art, as disclosed by the references cited or objections made, and must show how his amendment avoids such references or objections.[1] As often as the examiner produces new

§ 564. [1] That each application, by whomsoever filed, is regarded as that of an independent inventor, and is in no manner affected by any other, see *Ex parte* Langlois (1878), 14 O. G. 84.

[2] That a later application for the same invention by the same inventor neither amends nor abandons the former, see *Ex parte* Langlois (1878), 14 O. G. 84.

That a later application by the same inventor, claiming an invention described but not claimed in a former and still pending application, cannot be received as an amendment of the former, see *Ex parte* Emerson (1880), 17 O. G. 1451.

[3] That Claims not affected by an improper amendment must be examined on their merits, see *Ex parte* Vaile (1886), 37 O. G. 563.

[4] That a Claim may be amended without altering the Description if the new Claim is warranted by the drawings and present Description, see Hoe *v.* Cottrell (1880), 1 Fed. Rep. 597; 18 O. G. 59; 17 Blatch. 546; 5 Bann. & A. 256.

That where two applications describe the invention, but only one claims it, the patent issues on the latter, see *Ex parte* Emerson (1880), 17 O. G. 1451.

§ 565. [1] That after a rejection on the merits a case cannot be reconsidered

references or arguments, the same process of amendment and explanation may be repeated. But after the final rejection of all the Claims no amendments are allowable, unless good cause is shown for permitting them, and satisfactory reasons are given for the delay in their presentation. From the refusal of the examiner to allow amendments an appeal lies to the Commissioner.[2] Upon the filing of any amendment to meet the references and objections of the examiner, it is his duty to examine the case presented by the amended application in the same manner as if it were an original application, and if he rejects it to communicate his rejection with its reasons to the applicant, to which reasons the applicant may reply by argument or amendment as before. After a second rejection of the Claims as originally filed, or, if amended in substance, of the amended Claims, the right of the applicant to a hearing before the examiner ceases, and any further action must be taken by an appeal from the decision of the examiner to the examiners-in-chief.[3]

§ 566. Appeal in Uncontested Cases: Matters of Form and of Substance.

Appeals in uncontested cases in the Patent Office are based either upon the decisions of the examiner as to some matter of form, or upon his decision as to some matter of substance. on mere formal amendments of the Claims and titles, but from the refusal of the examiner to consider such amendments an appeal lies to the Commissioner, see *Ex parte* Hitt (1883), 25 O. G. 192.

[2] That from the refusal of an examiner to consider an amendment appeal lies to the Commissioner, see *Ex parte* Bennett (1882), 35 O. G. 1003.

[3] That after a second rejection the examiner is not obliged to reconsider a Claim unless he thinks he has made a mistake, see *Ex parte* Starr (1879), 15 O. G. 1053.

That all the Claims of an application having been twice rejected on the same references, and no material intervening amendment being made, the applicant cannot amend again without showing good reason for it, and why he did not sooner amend, see *Ex parte* Thurmond (1886), 37 O. G. 217.

That the rejection of Claims may be appealed from, but the rejected matter cannot be made the subject of a new application, see *Ex parte* Ransom (1884), 39 O. G. 119.

That a rejected applicant must appeal within reasonable time or he will not be permitted to stand in the way of other applicants, see *Ex parte* Lombard (1888), 43 O. G. 1347.

That by taking an appeal from the rejection of one Claim the applicant forfeits no rights as to the others, see *Ex parte* Gillette (1888), 44 O. G. 819.

An appeal upon a question of form lies to the Commissioner in person. An appeal upon a question of substance lies to the board of examiners-in-chief.[1] A matter of form is one that relates to the fitness of the application for an examination on its merits, or involves merely some rule of Office practice.[2] A matter of substance is one that pertains to the patentability of the invention as described and claimed in the application, or to the right of the inventor to a patent upon the application as presented by him.[3] Thus, whether a combination is a true combination or a mere aggregation, whether the Claims cover operative constructions, whether the invention is practicable, whether it is new and useful, whether it has been abandoned to the public, whether an amendment is a departure from the original application or whether it affects the form or the substance of the application,[4] — all these and

§ 566. [1] That an interlocutory appeal to the Commissioner is not based on the merits of the application, — such appeals are taken to the examiners-in-chief, — see *Ex parte* Edward (1876), 9 O. G. 794.

That petitions and motions are addressed to the Commissioner, see *Ex parte* Baker (1886), 36 O. G. 1149.

That interlocutory appeals to the Commissioner are really petitions for orders, see *Ex parte* Baker (1886), 36 O. G. 1149.

[2] That matters of form are those which put the application into condition to be examined on its merits, see *Ex parte* Kitson (1881), 20 O. G. 1750.

That a question of joinder is a question of form, see *Ex parte* Gillette (1888), 44 O. G. 819; *Ex parte* Mill (1887), 40 O. G. 918.

That whether a Claim is intelligible is a question of form, see *Ex parte* Doten (1877), 12 O. G. 841; *Ex parte* Reynolds (1874), 6 O. G. 641.

That whether a Claim is functional is a question of form, see *Ex parte* Barrett (1888), 45 O. G. 125.

That matters of Office practice are appealable only to the Commissioner, see *Ex parte* Proudfit (1876), 10 O. G. 585.

That whether an appeal from an examiner ordering a division is to be made to the Commissioner or the examiners-in-chief is a matter for the Patent Office to decide, see U. S. *v.* Butterworth (1884), 27 O. G. 717.

[3] That the question of the patentability of the invention is one of substance, and from an adverse decision thereon appeal lies to the examiners-in-chief, see Barney *v.* Kellogg (1880), 17 O. G. 1096; *Ex parte* Pressprich (1877), 11 O. G. 195; *Ex parte* Ellis (1876), 9 O. G. 1110.

[4] That whether an invention is a true combination is a question of substance, see *Ex parte* Gillette (1888), 44 O. G. 819; *Ex parte* Barcellos (1880), 17 O. G. 110.

That whether an invention is operative is a question of substance, see *Ex parte* Kitson (1881), 20 O. G. 1750; *Ex parte* Muhl (1880), 17 O. G. 744; *Ex parte* Keith (1876), 9 O. G. 793.

That whether an invention is a design or a mechanical invention is a

others of the same character are questions involving the merits of the application, from an adverse decision upon which an appeal lies to the examiners-in-chief.

§ 567. Appeal, on Matters of Form, to Commissioner.

An appeal to the Commissioner from an adverse decision of an examiner upon a matter of form, once repeated, is taken by a written petition, setting up the decision complained of and the reasons for the appeal, and signed by the applicant or his attorney.[1] The examiner is then required to file a written statement disclosing the grounds of his decision;[2] and upon hearing had, either orally or by written argument, the Commissioner affirms or reverses or modifies the action of the examiner as his judgment may direct. This decision is final, and can be reviewed or reconsidered only by the Commissioner himself.[3]

question of substance, see *Ex parte* Schulze-Berge (1888), 42 O. G. 293.

That whether the invention is new is a question of substance, see *Ex parte* Nagel (1880), 17 O. G. 198; *Ex parte* Buchanan (1879), 16 O. G. 1049; *Ex parte* Proudfit (1876), 10 O. G. 585.

That whether a cited reference is pertinent is a question of substance, see *Ex parte* Kerr (1884), 28 O. G. 95; *Ex parte* Borden (1884), 26 O. G. 439.

That whether an invention is useful is a question of substance, see *Ex parte* Buchanan (1879), 16 O. G. 1049.

That whether the invention has been abandoned is a question of substance, see Jenkins *v.* Barney (1873), 3 O. G. 119.

That whether an amendment departs from the original by inserting new matter is a question of substance, see *Ex parte* Lanstrom (1880), 17 O. G. 744.

That where a feature is struck out of one Claim and inserted in another, the question whether the latter Claim now shows a true combination is one of substance, see *Ex parte* Wenzel (1880), 17 O. G. 512.

That the question whether the drawings are sufficient is one of substance, see *Ex parte* Kitson (1881), 20 O. G. 1750.

That whether a Claim distinguishes the new from the old is a question of substance, see *Ex parte* Reynolds (1874), 6 O. G. 641.

That objections to the insertion of distinct Claims for non-separable parts go to the merits and appeal lies to the examiners-in-chief, see *Ex parte* Gerard (1888), 43 O. G. 1235.

That whether a re-issue application covers new matter is a question of substance, see *Ex parte* Keith (1876), 9 O. G. 744.

§ 567. [1] That under the rule concerning interlocutory appeals, the principal examiner must act twice before review by the Commissioner, see *Ex parte* Bennett (1886), 35 O. G. 1003.

[2] That where the examiner requires a model and an appeal is taken, the examiner must show in his answer why a model is needed, see *Ex parte* Jové (1880), 17 O. G. 801.

[3] That examiners must abide by the decisions of the Commissioner, see *Ex parte* Kitson (1881), 20 O. G. 1750.

§ 568. Appeal, on Matter of Substance, to Examiners-in-Chief.

An appeal to the examiners-in-chief from an adverse decision of an examiner upon a matter of substance can be taken only after an original or amended Claim in the application has been twice rejected by the examiner, and after all the Claims have been passed upon and all questions of form conclusively settled in the manner before stated.[1] This appeal is instituted by a written petition, signed by the applicant or his authorized attorney, setting forth the points of the decision from which the appeal is taken and reciting the reasons for the appeal. The petition, having been duly filed, is submitted to the examiner, who, if he finds it to be regular in form, must thereupon furnish to the examiners-in-chief a written statement of the grounds of his decision on all the points involved in the appeal, with copies of the rejected Claims and the references applicable thereto. If he finds the petition irregular in form, the appellant may amend it, or may appeal from this finding to the Commissioner as upon any other question of form. The appellant, previous to the day of hearing before the examiners-in-chief, must file a brief of the authorities and arguments on which he will rely to maintain his appeal; and if he wishes to be heard orally, he must indicate it at the time of filing his petition, when a day of hearing will be fixed and proper notice given him; otherwise the case will be considered and decided by the examiners-in-chief upon the brief presented. The examiners-in-chief can affirm or reverse the decision of the examiner only upon the

§ 568. [1] That appeals on matters of substance must be taken to the examiners-in-chief, see *Ex parte* Baker (1886), 36 O. G. 1149.

That the right of appeal from a second rejection is absolute, whatever be the cause of rejection, see *Ex parte* Bennett (1886), 35 O. G. 1003.

That an applicant having an option of two or more modes of procedure, must elect one and abide by it, as where he can appeal or amend and chooses the latter, see *Ex parte* Williams (1887), 40 O. G. 1337.

That an application must be perfect in form before an appeal can be allowed on its merits, see *Ex parte* Mewes (1872), 2 O. G. 617.

That the jurisdiction of the examiner ceases on appeal, see *Ex parte* Brunner (1872), 1 O. G. 303.

That *ex parte* cases appealed to the examiners-in-chief are within the jurisdiction of the primary examiner as soon as the appeal is decided, see *Ex parte* Pearson (1887), 40 O. G. 244.

points on which the appeal is taken;[2] but if they discover any apparent grounds, not involved in the appeal, for granting or refusing letters-patent in the form claimed or in any other form, they must annex to their decision a written statement of these grounds, with such recommendations to the examiner in regard to his future action as they may deem proper.[3] These new grounds must then be considered by the examiner; and from his adverse decision, upon any question of substance therein presented, another appeal lies to the examiners-in-chief, or on questions of form to the Commissioner, as in other cases.[4]

§ 569. Appeal from Examiners-in-Chief to Commissioner.

From an adverse decision of the examiners-in-chief the applicant may appeal to the Commissioner in person. This

[2] That in *ex parte* cases the jurisdiction of the examiners-in-chief is limited to adverse decisions of the examiners, — all other objections they may discover must be referred to the Commissioner, — see *Ex parte* Smoot (1877), 11 O. G. 1010.

[3] That the examiners-in-chief must suggest anything they deem important either to the Office or the applicant, see *Ex parte* Dodge (1872), 3 O. G. 179.

That the examiners-in-chief can make no recommendation as to points not within their jurisdiction, see *Ex parte* Gillette (1888), 44 O. G. 819.

That if the examiners-in-chief are of opinion that a different form of Claim from that rejected should be allowed they should annex to their decision a statement to that effect, with such recommendation as they think best, but the examiner is not bound by such recommendation, see *Ex parte* Dysart (1886), 34 O. G. 1390.

That the examiners-in-chief are not required to absolutely determine any form of Claim to be passed on by the examiner, see *Ex parte* Dysart (1886), 34 O. G. 1390.

That a mere suggestion of the examiners-in-chief is not a recommendation, see *Ex parte* Holt (1886), 38 O. G. 229.

[4] That primary examiners may refuse to act on the recommendation of the examiners-in-chief, but an appeal lies from the refusal, see *Ex parte* Pearson (1887), 40 O. G. 244.

That where the examiners-in-chief make a "recommendation," the party may propose the recommended matter to the primary examiner, and if he refuses, the commissioner may order it or the party may, after acceptance of the matter and a new rejection of the application, appeal, see *Ex parte* Holt (1887), 38 O. G. 229.

That if new references are cited by an examiner after appeal to the examiners-in-chief, the applicant may again appeal without a new fee, unless the new references are based on his amendment, see *Ex parte* Dysart (1886), 34 O. G. 1390.

That a mandamus will not lie to compel the Commissioner to allow an appeal from a decision of the examiner to the examiners-in-chief on a question of abandonment, pending an interference, it being a matter of his discretion,

appeal, like the former, is taken by written petition, setting up the judgment complained of and the reasons of appeal. If the Commissioner, in revising the decision of the examiners-in-chief, discovers any apparent grounds for granting or withholding a patent which are not presented by the appeal, he may at any time, either before or after final judgment, when in his opinion substantial justice requires it, give reasonable notice to the applicant, and if any amendment or other action based thereon shall be proposed, he will remand the case to the examiner for his consideration.[1] He may also at any time return the case to the examiner for further inquiry when any amendment is filed, or other action taken, in pursuance of the recommendation of the examiners-in-chief. From the decision of the examiner in remanded cases appeal lies to the examiners-in-chief upon matters of substance and to the Commissioner upon matters of form, according to the usual rule.[2]

§ 570. Appeal from Commissioner to Supreme Court of the District of Columbia.

From an adverse decision of the Commissioner on an appeal from the examiners-in-chief in *ex parte* cases, a further appeal may be had to the Supreme Court of the District of Columbia.[1] This appeal is taken by a written petition, duly signed and filed with the clerk of the court, accompanied by certified copies from the Patent Office of all the original papers and evidence in the case. On taking this appeal the appellant

see *Ex rel.* Bigelow *v.* Thacher (1875), 2 MacArthur, 24; 7 O. G. 603.

§ 569. [1] That the Commissioner must take notice of an objection to patentability, however it may be brought to his notice, see *Ex parte* Smoot (1877), 11 O. G. 1010.

[2] That the primary examiner may refuse to act on the recommendation of the Commissioner and an appeal will lie from such refusal, see *Ex parte* Pearson (1887), 40 O. G. 244.

§ [illegible]. [1] That in *ex parte* cases an appeal lies from the Commissioner to the Supreme Court of the District, see Kirk *v.* Commissioner (1886), 37 O. G. 451; 5 Mackay, 229.

That the power to hear appeals, formerly vested in the Circuit Court of the District, now resides in the Supreme Court, see Opinion Atty. Gen. (1869), 13 Op. At. Gen. 79.

That an appeal lies from the Commissioner to the Supreme Court of the District of Columbia before suit brought in equity, except in interference cases, see Butler *v.* Shaw (1884), 21 Fed. Rep. 321.

must give immediate notice thereof to the Commissioner in writing, and file in the Patent Office a written statement of his reasons of appeal, which should be full and explicit and constitute a brief of the appellant's argument in support of his claims. The Commissioner must also furnish to the court the grounds of his decision, fully set forth in writing, touching all points embraced in the reasons of appeal. Notice of the time and place of hearing will be given by the court to the Commissioner and by him to the parties in interest, and upon the hearing the Commissioner or the examiner may be called upon to testify concerning the principles of the invention for which a patent is demanded. In reviewing the action of the Commissioner, the court must confine itself to the points set forth in the reasons of appeal,[2] and after judgment must return to the Commissioner a certificate of its proceedings and decision, which will be entered of record in the Patent Office, and will govern its further conduct of the case.[3] This decision does not, however, preclude any person from contesting the validity of the patent thus awarded, in any court wherein it may be called in question.

§ 571. Remedy of Applicant in Equity after Final Rejection of his Application in the Patent Office.

Where the Supreme Court of the District of Columbia decides against the applicant on this appeal, he may pursue his remedy by bill in equity in the Circuit Court of the District.[1] A copy of the bill must be served on the Commis-

[2] That in other cases than interference cases the Supreme Court of the District is a mere court of appeal, and is confined to the issues raised in the reasons of appeal and to the evidence produced before the Commissioner, see Butler *v.* Shaw (1884), 21 Fed. Rep. 321; *In re* Conklin (1874), 5 O. G. 235; 1 MacArthur, 375.

That an appeal to the Supreme Court of the District from a decision on a Claim for apparatus is not affected by the intermediate issue of a patent for the process in which the apparatus is used, see Butler *v.* Shaw (1884), 21 Fed. Rep. 321.

[3] That the certificate of the decision of the Supreme Court of the District of Columbia on an appeal should be made and certified during the term of the justice, but may be forwarded to the Commissioner after the justice retires from office, see Opinion Atty. Gen. (1870), 13 Op. At. Gen. 265.

§ 571. [1] Remedy by bill in equity to obtain a patent exists in *ex parte* cases after an appeal to the Supreme Court of the District has been adversely

sioner, and the court having cognizance thereof, after due hearing according to the usual course of equity proceedings, may adjudge that the applicant is entitled to a patent for the whole invention claimed, or for some separable part of it, as the facts may appear.[2] Such an adjudication will authorize

decided. It also exists where, on an appeal to the Commissioner in an interference proceeding, the applicant has been defeated. The doctrine and notes of this paragraph, (§ 571) apply chiefly to the former case. The latter is considered in § 604 and notes, *post*.

That under Sec. 4915 a bill in equity lies upon the refusal of a patent by the Commissioner or the Supreme Court of the District, see *In re* Squire (1877), 3 Bann. & A. 133.

That the remedy in equity to obtain a patent under Sec. 4915, applies only where the Commissioner or Court decides to reject an application on the ground that the applicant is not, on the merits, entitled to it, see Butterworth *v.* Hoe (1884), 112 U. S. 50; 29 O. G. 615.

That an applicant in an *ex parte* case is not entitled to a bill in equity until he has exhausted his remedies by appeal, see Kirk *v.* Commissioner (1886), 37 O. G. 451; 5 Mackay, 229.

That where the Patent Office rejects an application the remedy is by bill in equity, not mandamus, see Hull *v.* Commissioner (1875), 7 O. G. 559; 2 MacArthur, 90.

That where a patent is allowed by the Office, but the Commissioner, without denying the right of the applicant, refuses to issue it, mandamus will lie, see Butterworth *v.* Hoe (1884), 112 U. S. 50; 29 O. G. 615; and cases cited under § 583, note 3, *post*.

That the power of the Circuit Court to grant a patent upon a petition is independent of the powers of the Patent Office, see Whipple *v.* Miner (1883), 15 Fed. Rep. 117; 23 O. G. 2236.

It has been held that a bill in equity to obtain a patent could be brought in any circuit, and that the Commissioner might bind himself and his successors by appearing or accepting service. Vermont Farm Mach. Co. *v.* Marble 1884), 22 Blatch. 128; 27 O. G. 622; 20 Fed. Rep. 117. But the contrary has been decided by the Supreme Court of the United States in Butterworth *v.* Hill (1884), 114 U. S. 128; 31 O. G. 1043; where it is declared that the Commissioner's official residence is at Washington, that he can be sued only in the District of Columbia, and that he cannot waive the question of jurisdiction by appearance, consent, or default. Further, that a bill to obtain a patent must be brought in the Circuit Court for the District of Columbia, the courts of other districts having no power to enforce decrees against the Commissioner, see Prentiss *v.* Ellsworth (1846), 27 O. G. 623.

[2] For the form of a bill to obtain a patent after rejection by the Patent Office, and other proceedings, see *Ex parte* Greely (1873), 6 Fisher, 575.

That the Commissioner is not a necessary party to a bill in equity to obtain a patent, under Sec. 4915, where there is an opposing party, but a patentee who has transferred his interest must be made a party, see Graham *v.* Teter (1885), 25 Fed. Rep. 555.

That in a bill in equity against the Commissioner the Secretary is not a party, see Kirk *v.* Commissioner (1886), 37 O. G. 451; 5 Mackay, 229.

That a bill in equity to obtain a patent may be heard on any issues

the Commissioner to issue a patent to the applicant, upon his filing in the Patent Office a copy of the judgment, and otherwise complying with the requirements of the law.[3]

§ 572. Appeals in the Patent Office: their General Character and Effect.

An appeal in the Patent Office is not like a writ of error, or a motion for a new trial, but resembles an appeal in equity or admiralty, and does not require for its justification that the judgment appealed from should contradict the evidence.[1] Only questions that were properly within the jurisdiction of the inferior tribunal can be presented on appeal, and decisions affecting matters not within the cognizance of the Patent Office, such as matters of title, are not reviewable in any manner, but are simply void.[2] No appeal lies from a judgment wholly in favor of the appellant, nor from any judgment until it has been duly rendered in the required official form.[3] The decisions of all inferior tribunals must be so ex-

and with any evidence, see Butler *v.* Shaw (1884), 21 Fed. Rep. 321.

That equity will not aid the inventor in procuring a patent under Sec. 4915, in violation of his agreement with others, see Runstetler *v.* Atkinson (1883), 23 O. G. 940.

That delay in suing in equity for a patent is delay in prosecuting an application, and the court may inquire into its reasonableness, see Gandy *v.* Marble (1887), 122 U. S. 432; 39 O. G. 1423.

That a petitioner on a bill in equity to obtain a patent, after a delay of more than two years since the last action, must allege and prove that the delay was unavoidable, see Gandy *v.* Marble (1887), 122 U. S. 432; 39 O. G. 1423.

[3] That a judgment in equity in a suit to obtain a patent binds only the parties and those who derive title from them, see Butler *v.* Shaw (1884), 21 Fed. Rep. 321.

That where the Commissioner is the only defendant in a suit under Sec. 4915, the plaintiff pays the costs, but where there are contesting parties costs follow the usual rule, see Butler *v.* Shaw (1884), 21 Fed. Rep. 321.

§ 572. [1] That an appeal in the Patent Office is not like a writ of error, but like an appeal in equity or admiralty, see Dickson *v.* Kinsman (1880), 18 O. G. 1225; Packard *v.* Sandford (1879), 16 O. G. 1182.

That an appeal in the Patent Office is not like a motion for a new trial, and the judgment below need not contradict the evidence, see Dickson *v.* Kinsman (1880), 18 O. G. 1225.

That the court below did not give due weight to evidence is ground of appeal, see Slade *v.* Blair (1879), 15 O. G. 830.

[2] That no appeal lies from the refusal of the Commissioner to recognize an assignee as entitled to the patent, or on any other question of title, see Whitely *v.* Fisher (1870), 4 Fisher, 248.

[3] That no appeal lies from a judg-

plicit that the subject of the appeal can be clearly distinguished.[4] The appeal is limited to the issues apparent on the record, and brings up only the particular adjudications of which complaint is made.[5] An appeal raising no issue will be summarily dismissed.[6] If evidence is admitted during an appeal to support the claims of the applicant against the references and objections of the examiner, or to vary in any manner the issues of fact concerning the patentability of the invention, the whole case must be remanded to the examiner that he may pass upon it in its new condition. In an appeal from the examiners-in-chief to the Commissioner, he acts only in a judicial capacity and as a court of appellate jurisdiction.[7] Cases decided by him on appeal will not be re-opened except by himself, and those which have been determined by his predecessors will not be reviewed except in accordance with the rules governing the granting of new trials.[8] Cases decided by the examiners-in-chief cannot be reheard by them, when no longer pending before them, without the written authority of the Commissioner.[9]

§ 573. Interviews of Applicants with Examiners: Motions: Procedure.

The rules of the Patent Office generally direct that the communications between the Office and applicants or their

ment affirming patentability, see Barney *v.* Kellogg (1880), 17 O. G. 1096.

That a judgment is not effective until put into the proper official form, see *Ex parte* Starr (1879), 15 O. G. 1053.

[4] That the judgment below must be explicit, see Jenkins *v.* Barney (1873), 3 O. G. 119.

[5] That an appeal is limited to the issues apparent on the record, see *Ex parte* Jones (1874), 5 O. G. 585; Jenkins *v.* Barney (1873), 3 O. G. 119.

That on an appeal the presumption is in favor of the decision appealed from, see Packard *v.* Sandford (1879), 16 O. G. 1182.

[6] That an appeal raising no issue will be dismissed, see *Ex parte* Evarts (1874), 5 O. G. 429.

[7] That on an appeal from the examiners-in-chief, the Commissioner acts only in a judicial capacity, and as an appellate tribunal, see Stone *v.* Greaves (1880), 17 O. G. 397.

[8] That one Commissioner cannot rehear a case decided by his predecessor except on new facts, see Gill *v.* Scott (1884), 29 O. G. 949.

[9] That the Commissioner has power to revise the decisions of the examiners on motions for rehearings, but is less inclined to interfere when a rehearing is granted than when it is denied, see Loring *v.* Hall (1879), 15 O. G. 471.

That on a motion for rehearing the question is whether the former findings are unsupported by, or are in conflict with, the evidence, see Gardner *v.* Dudley (1880), 18 O. G. 683.

attorneys should take place in writing. Interviews with examiners concerning applications and other pending matters may, however, be had at the examiner's rooms, during office hours, or at any other time and place specially authorized by the Commissioner, although no personal discussion of a pending application is allowed until after the first official action thereon. Motions proper to be made at all must be made and determined by the tribunal before which the case is pending at the time;[1] cases being regarded as pending before a given tribunal until an appeal from its decision has been taken, or until the time for an appeal has expired. An appeal from an adverse decision on a motion must be taken to the Commissioner if the motion involves only matters of form, but to the examiners-in-chief if it relates to matters of substance. A motion once made and determined without appeal cannot be renewed on the same facts.[2] The conduct of each case is governed by the rules in force at its inception, unless new rules are adopted which can be followed without prejudice to the applicant, in which event the latter rules prevail.[3] Changes in the nature or jurisdiction of any of the tribunals in the Patent Office do not interrupt the progress of pending applications, though the mode of their procedure may, to some extent, be changed.[4]

§ 574. Abandonment of Application: not Abandonment of the Invention.

The law requires the applicant to prosecute his application with reasonable diligence. After completing the invention he may delay the filing of his application at his pleasure;

§ 573. [1] That a motion based on a statutory bar to the granting of a patent may be made to the tribunal having charge of the application, when no other mode for taking the objection has been provided, see Barney *v.* Kellogg (1880), 17 O. G. 1096.

[2] That a motion once decided without appeal cannot be renewed on the same facts, see Little *v.* Lillie (1876), 10 O. G. 543.

That a motion once absolutely denied cannot be repeated without leave, see Clemson *v.* Fowler (1886), 37 O. G. 671.

[3] That where a rule is changed pending an application, the proceedings will be governed by the new rule unless the applicant would be injured thereby, see Fowler *v.* Benton (1880), 17 O. G. 266.

[4] That a change in the jurisdiction of a tribunal does not necessitate a beginning *de novo*, see Colt *v.* Young (1852), 2 Blatch. 471.

but having filed it he cannot suffer it to lie indefinitely in the Patent Office, unacted on, without abandoning it. This abandonment of the application is not, however, an abandonment of the invention.[1] By an abandonment of the invention the inventor loses all right to apply for and obtain a patent to protect it. By the abandonment of the application the inventor is placed in the same situation as if he had never filed one; and while he may again apply, his later application may be subject to objections which could not have been urged against the former, and in this manner indirectly his right to a patent may be lost. Thus a public use or sale, which would not have defeated the prior application, because not preceding it at least two years, may on account of the greater lapse of time become a bar to the latter; or a claim of want of novelty or of inventive skill, which could not have been sustained by the state of the art when the first application was filed, may be made good by the advanced state of the art at the date of the new application.[2] The abandonment of an

§ 574. [1] That an abandonment of the application does not *ipso facto* abandon the invention, see Lindsay *v.* Stein (1882), 20 Blatch. 370; 10 Fed. Rep. 907; 21 O. G. 1613; *Ex parte* Livingston (1881), 20 O. G. 1747; Clark *v.* Scott (1872), 2 O. G. 4; 9 Blatch. 301; 5 Fisher, 245; Bevin *v.* East Hampton Bell Co. (1871), 9 Blatch. 50; 5 Fisher, 23; also § 353 and notes, *ante*.

That Sec. 4894 does not apply to the same cases as Sec. 4897, the former relating only to the abandonment of the application, see *Ex parte* Golding (1875), 8 O. G. 141; *Ex parte* McCully (1874), 6 O. G. 153.

That Congress can authorize the revival of an old application long after it is abandoned and a patent may then be granted thereon, the invention being examined in view of the state of the art when the application was originally filed, see Graham *v.* Johnston (1884), 21 Fed. Rep. 40.

That a delay in prosecuting an application, after it was erroneously rejected, was not abandonment of the invention before the act of 1870, see *Ex parte* Stewart (1873), 4 O. G. 665.

[2] That an application, filed after the abandonment of a prior one, is open to all objections arising since the prior application was filed, see *Ex parte* Livingston (1881), 20 O. G. 1747.

The effect of changes in the state of the art between the filing of the original and the renewed application is, of course, important only while the date of the application is regarded as the date of the applicant's inventive act. If publications, patents, or inventions, which have come into existence since his former application was filed, are cited against him, he may carry the date of his inventive act back of such advances in the art by extraneous proof, and thus maintain the patentability of his invention, so far as its novelty is concerned. The objection of an intermediate public use or sale cannot, however, be thus obviated, and may prove fatal to his claims.

application, therefore, can result in an abandonment of the invention only by the occurrence of circumstances, after it is filed and before the filing of a new one, which would have been fatal to any application had they transpired before it had been made; and the risk incurred by the inventor depends upon the fact that by the abandonment the date of the application on which his patent rests is transferred from the day on which the original application was filed to the day on which the new one was presented to the Patent Office. In the absence of such intervening circumstances, the trouble and expense of making the new application is the sole consequence of abandoning the former.[3]

§ 575. Application Abandoned by Unreasonable Delay: Delay of Two Years from "Last Action" Unreasonable.

Prior to the act of 1861 this question of the abandonment of the application by delay was determined upon general principles regarding diligence and good faith with the public. By that act, however, it was provided that all applications must be completed and prepared for examination within two years after the filing of the petition, and in default thereof should be considered as abandoned by the applicants, unless the Commissioner were satisfied that the delay was unavoidable. This provision was re-enacted in the act of 1870, and appears in the Revised Statutes, with the addition that a failure to prosecute the application within two years after any action thereon, of which notice has been given to the applicant, shall also work its abandonment.[1] It is thus made the

[3] If the doctrine of estoppel is to be applied to a negligent inventor, either in favor of the public or a rival inventor, under the circumstances discussed in §§ 346 note 1, 357 note 3, and 390 note 3, *ante*, any unreasonable delay in prosecuting a pending application, which can affect adverse interests, may properly be brought within the same rule, and forfeit his right to any further consideration of his claims.

§ 575. [1] In Goodyear *v.* Hills (1866), 3 Fisher, 134, Cartter, J.: (138) "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 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

duty of the applicant to complete his application by the presentation of all its parts to the Patent Office, and to prepare it for examination within two years after he files his petition, and also to take some active steps in prosecuting it within two years after the last action of the Office concerning it of which he has notice, under pain of having his application treated as abandoned, unless he can affirmatively satisfy the Commissioner that the delay could not have been avoided.[2] But this provision of the statutes does not confer upon the applicant a right to two years of inaction between each action of the Patent Office. Unreasonable delay for any period is still abandonment. These statutes merely declare that a delay of two years is *prima facie* unreasonable, and thus throw

country is advised, by the deliberation of the only tribunal provided by law for the ascertainment, at that stage of the invention, of his right, that he has none. More especially is he himself advised of that fact, for he is a party to the proceedings, and more immediately damnified by the rejection of the application. That 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."

That under Sec. 4894 a failure to prosecute an application for two years abandons it, see *Ex parte* Klenha (1884), 28 O. G. 1272.

That under the provision in Sec. 35, act of 1870, allowing six months after the date of that act for the renewal of withdrawn or rejected applications, an application filed in 1845, withdrawn in 1847, and not subsequently acted on, became dead, see *Ex parte* Cryer (1880), 17 O. G. 452.

That this saving clause of the act of 1870 could be made available to the rejected applicant only by filing a formal renewal of the old application, see *Ex parte* Gordon (1874), 6 O. G. 543.

That the omission of Sec. 35, act of 1870, from the Revised Statutes did not revive applications that were abandoned under it, see Davies *v.* Hartman (1876), 9 O. G. 351.

That an assignee is bound to the same diligence as an inventor, see Fire Extinguisher Mfg. Co. *v.* Graham (1883), 24 O. G. 793; 16 Fed. Rep. 543.

[2] That under Sec. 4894 (Sec. 32, Act 1870), a rejected application is abandoned if not prosecuted within two years, but a new one may be filed which will stand alone, unaided by the other on questions of abandonment, see Lindsay *v.* Stein (1882), 20 Blatch. 370; 21 O. G. 1613; 10 Fed. Rep. 907.

That eight years' delay after the rejection of an application without renewing it, other patents for substantially the same invention being granted meanwhile, operates as an abandonment, see United States Rifle & Cartridge Co. *v.* Whitney Arms Co. (1886), 118 U. S. 22; 35 O. G. 873.

That a rejected application leaves the applicant where he was when the application was made, but notifies him to proceed with due diligence, see Goodyear *v.* Hills (1866), 3 Fisher, 134.

That an abandoned application is not further noticed by the Patent Office, see *Ex parte* Casilear (1875), 8 O. G. 474.

upon the applicant the burden of proving that in his particular case the delay was justified.[3] In discussing them it will be sufficient to inquire what is meant by the "last action" of the Patent Office; what degree and duration of inactivity on the part of the applicant will abandon his application; and what reasons are sufficient to excuse delay. Whatever concerns the completion of the application and its preparation for examination has been already considered in its proper place.

§ 576. "Last Action" Defined.

The "last action," from which the period of two years dates, is the last interlocutory action of the Patent Office

[3] In Planing Machine Co. *v.* Keith (1879), 101 U. S. 479, Strong, J.: (485) "The Patent Law favors meritorious inventors by conditionally conferring upon them for a limited period exclusive rights to their inventions. But it requires them to be vigilant and active in complying with the statutory conditions. It is not unmindful of possibly intervening rights of the public. The invention must not have been in public use or on sale more than two years before the application for a patent is made, and all applications must be completed and prepared for examination within two years after the petition is filed, unless it be shown to the satisfaction of the Commissioner that the delay was unavoidable. All this shows the intention of Congress to require diligence in prosecuting the claims to an exclusive right. An inventor *cannot without cause* hold his application pending during a long period of years, leaving the public uncertain whether he intends ever to prosecute it, and keeping the field of his invention closed against other inventors. It is not unfair to him, after his application for a patent has been rejected, and after he has for many years taken no steps to re-instate it, to renew it, or to appeal, that it should be concluded that he has acquiesced in the rejection and abandoned any intention of prosecuting his claim further. Such a conclusion is in accordance with common observation. Especially is this so when, during those years of his inaction he saw his invention go into common use, and neither uttered a word of complaint or remonstrance, nor was stimulated by it to a fresh attempt to obtain a patent. When in reliance upon his supine inaction the public has made use of the result of his ingenuity, and has accommodated its business and its machinery to the improvement, it is not unjust to him to hold that he shall be regarded as having assented to the appropriation, or, in other words, as having abandoned the invention. There may be, it is true, circumstances which will excuse delay in prosecuting an application for a patent after it has been rejected, — such as extreme poverty of the applicant, or protracted sickness." 17 O. G. 1031 (1033).

That no unreasonable delay in prosecuting the application can be permitted, see Planing Mach. Co. *v.* Keith (1879), 101 U. S. 479; 17 O. G. 1031; Hanscom *v.* Latham (1876), 9 O. G. 1157; Marsh *v.* Sayles (1872), 2 O. G. 340; 5 Fisher, 610.

affecting the progress of the application, followed by the mailing of a notice of such action to the applicant.[1] Such mere ministerial acts as sending a letter in reply to a request for information, or for the return of papers or a model, do not constitute the action mentioned in the statute.[2] Every application pending in the Patent Office is presumed to be awaiting some act, either on the part of the Office or of the applicant, which will advance it to the next stage of the proceedings; and the action performed by the Office in its turn, and rendering it necessary for the applicant to act in order that further progress may be made, is the "last action" from which the period of his delay must be computed. A "suspension of action" by the Office implies further action, and does not constitute the "last action" here described.[3]

§ 577. "Inaction" of Applicant Defined.

The "inaction" of the applicant is, correspondingly, his failure to perform the act devolving upon him in order to advance his case. Whatever else he may do is of no consequence in reference to this question. Letters of general inquiry, the presentation of unimportant amendments, and other similar acts do not prevent the two years from running against his application.[1] His action must be one which renders it incumbent on the Office to take action in its turn, or

§ 576. [1] That in a rejected application the "last action" of the Patent Office is the mailing of the last letter of rejection to the applicant, and unless he takes further action, within two years from that date, the application is abandoned, see *Ex parte* Blake (1873), 3 O. G. 2.

[2] That "last action" is some action affecting the merits of the case, not mere ministerial action, see *Ex parte* Graham (1873), 3 O. G. 211.

That an answer to a request to return a model is not "last action," see *Ex parte* Lee (1874), 5 O. G. 58.

[3] That "suspension of action" implies further action, see *Ex parte* Hull (1875), 9 O. G. 1.

§ 577. [1] That after final rejection, without appeal, unimportant amendments will not keep the application alive in the Patent Office, see *Ex parte* Jenks (1878), 14 O. G. 747.

That irregular and illegal modes of procedure do not keep an application alive and prevent its abandonment, see Kirk *v.* Commissioner (1886), 37 O. G. 451; 5 Mackay, 229.

That the suspension of an application at the request of the applicant, and at his option to proceed with it, is "inaction," and unless taken up within two years it is abandoned, see *Ex parte* Norton (1888), 42 O. G. 296.

the delay is clearly imputable to him and he must bear the loss which it entails.[2] In computing the two years of his inactivity, the day on which the "last action" of the Patent Office was performed is excluded.[3]

§ 578. Unavoidable Delay not Unreasonable.

The inaction of the applicant, however protracted, cannot prejudice his application if the delay was unavoidable. Of this the Commissioner is made the final judge, though the question as to an abandonment of the invention itself by an unreasonable delay of the application in the Patent Office may always be raised and adjudicated in the courts.[1] No applicant can justly be regarded as responsible for a delay which he could not avoid. If he is urging his application as rapidly as under all the circumstances he is able to do, he cannot be considered as abandoning it.[2] Thus poverty or sickness, or

[2] That a bill in equity to obtain a patent, though not a technical appeal from the Patent Office but a true suit in equity, is still a part of the application for a patent, see Gandy *v.* Marble (1887), 122 U. S. 432; 39 O. G. 1423.

That delay in filing a bill in equity to obtain a patent for more than two years since the last action must be shown to be unavoidable, or it will work an abandonment, see Gandy *v.* Marble (1887), 122 U. S. 432; 39 O. G. 1423.

[3] That in computing the two years the day of "last action" is excluded, see *Ex parte* Musser (1879), 16 O. G. 858.

§ 578. [1] That the decision of the Commissioner, that delay in prosecuting an application was unavoidable, is final, see U. S. Rifle & Cartridge Co. *v.* Whitney Arms Co. (1877), 14 Blatch. 94; 11 O. G. 373; 2 Bann. & A. 493; McMillin *v.* Barclay (1871), 5 Fisher, 189; 4 Brews. (Pa.) 275.

That under Sec. 4894 the Commissioner's discretion is judicial, not a mere whim, and the evidence must show that the delay was unavoidable, see *Ex parte* Chapman (1884), 29 O. G. 950.

That "unavoidable delay" must be clearly proved, see *Ex parte* Klenha (1884), 28 O. G. 1272.

That under Sec. 4894 the evidence is to be heard by the Commissioner in person, see Smith *v.* Dimond (1881), 20 O. G. 742.

That too great leniency to delaying applicants, to the prejudice of the public, must not be allowed, see *Ex parte* Klenha (1884), 28 O. G. 1272.

That the decision of the Commissioner, that the invention has not been abandoned by delays in the application, is not conclusive on the courts, see Planing Mach. Co. *v.* Keith (1879), 101 U. S. 479; 17 O. G. 1031; U. S. Rifle & Cartridge Co. *v.* Whitney Arms Co. (1877), 14 Blatch. 94; 11 O. G. 373; 2 Bann. & A. 493.

[2] That if the applicant is prosecuting his case as rapidly as he is able, no delay will abandon it, see *Ex parte* Barnitz (1887), 41 O. G. 575; Goodyear Dental Vulcanite Co. *v.* Smith (1874), 5 O. G. 585; Holmes, 354;

inevitable absence from the United States, or legal inability to pursue his rights, have been held sufficient to relieve him from the consequence of his delay.[3] Where the inaction is not truly his own but is ultimately due to the errors or misconduct of other persons, either without his knowledge or beyond his control, he ought not, and is not compelled, to suffer its results. Hence delays in the Patent Office not attributable to him nor acquiesced in by him,[4] mistakes in the Patent Office which induce him not to act where a correct decision would have led him to exercise due diligence,[5] and the neglect of his attorney to obey his orders,[6] have been accepted as excuses

1 Bann. & A. 201; *Ex parte* Leavitt (1873), 3 O. G. 212.

That "unavoidable" delay in prosecuting an application is such delay as prudent and diligent men, using the ordinary agencies, would not have overcome, for the law does not compel parties to resort to unusual methods, see *Ex parte* Pratt (1887), 39 O. G. 1549.

That "unavoidable delay" means hindrance by circumstances over which the inventor had no control, see *Ex parte* Klenha (1884), 28 O. G. 1272.

That delay unaccompanied by any effort to avoid it is not unavoidable, see Smith *v.* Dimond (1881), 20 O. G. 742.

That "unavoidable" delay in prosecuting an application means unavoidable during the entire two years, see *Ex parte* Root (1887), 40 O. G. 811.

[3] That poverty, sickness, and other causes may excuse delay, and save the application, see Planing Mach. Co. *v.* Keith (1879), 101 U. S. 479; 17 O. G. 1031.

That poverty, etc., is an excuse only when it prevents action, see *Ex parte* Klenha (1884), 28 O. G. 1272.

That involuntary absence from the country excuses delay, see Weston *v.* White (1876), 13 Blatch. 447; 2 Bann. & A. 364.

See also § 353 and notes, *ante*.

[4] That delays in the Patent Office do not abandon the application, unless acquiesced in by the applicant, see Colgate *v.* Western Union Telegraph Co. (1878), 14 O. G. 943; 4 Bann. & A. 36; 15 Blatch. 365; Smith *v.* Goodyear Dental Vulcanite Co. (1876), 93 U. S. 486; 11 O. G. 246; Jones *v.* Sewall (1873), 6 Fisher, 343; 3 O. G. 630; 3 Clifford, 563; Johnsen *v.* Fussman (1872), 1 Woods, 138; 5 Fisher, 471; 2 O. G. 94; Singer *v.* Braunsdorf (1870), 7 Blatch. 521; Dental Vulcanite Co. *v.* Wetherbee (1866), 2 Clifford, 555; 3 Fisher, 87; Sayles *v.* Chicago & Northwestern R. R. Co. (1865), 1 Bissell, 468; 2 Fisher, 523; Adams *v.* Jones (1859), 1 Fisher, 527; Bell *v.* Daniels (1858), 1 Bond, 212; 1 Fisher, 372; Rich *v.* Lippincott (1853), 2 Fisher, 1.

That if the applicant acquiesces in a delay of the Patent Office, his application may thereby be abandoned, see Bevin *v.* East Hampton Bell Co. (1871), 5 Fisher, 23; 9 Blatch. 50.

That a delay while an interference is pending is not abandonment, see Taylor *v.* Shreffler (1883), 24 O. G. 1175.

[5] That a mistake in the Patent Office, inducing inaction, does not abandon the application, see Colgate *v.* Western Union Telegraph Co. (1878), 14 O. G. 943; 15 Blatch. 365; 4 Bann. & A. 36; Weitling *v.* Cabell (1872), 2 O. G. 223.

[6] That delay caused by the attor-

for an inaction which otherwise would have been fatal to his application. But where he has been led to his delay by motives of personal interest, or even by more indifference to the rights of others, he must be held strictly to its penalties.[7] He cannot be relieved upon the ground that his pecuniary interests would not have been advanced by his compliance with the law, nor that other voluntary occupations, however profitable to himself or others, have engrossed his capital or his time.[8]

§ 579. Abandonment of Application by Express Declaration of the Applicant.

An application may be abandoned not only by unreasonable delay in completing or prosecuting it, but by the express act of the applicant.[1] Such an abandonment must be in writing, describing the application by the title of the invention and the date of the filing, signed by the applicant in person, and filed in the Patent Office.[2] The presentation of a new application for the same invention does not withdraw or abandon the original, but each is accepted and treated by the Office as independent of the others, unless the later be offered as an amendment to, or a substitute for, the former.[3] An aban-

ney, and not acquiesced in by the applicant, does not abandon the application, see Howes *v.* McNeal (1878), 15 O. G. 608 ; 15 Blatch. 103 ; 3 Bann. & A. 376 ; Weston *v.* White (1876), 13 Blatch. 447 ; 2 Bann. & A. 364.

That a party may rely on trustworthy employees, and if they fail unexpectedly, it is "unavoidable," see *Ex parte* Pratt (1887), 39 O. G. 1349.

[7] That the present pecuniary worthlessness of an invention does not excuse delay in prosecuting the application, see *Ex parte* Woodbridge (1879), 15 O. G. 564.

[8] See § 387 and notes, *ante*.

§ 579. [1] That the cancellation of all the Claims is abandonment, see *Ex parte* Lasscell (1884), 29 O. G. 861 ; 28 O. G. 1274.

[2] That the Patent Office may require an abandonment to be stated in terms, and in default thereof an amendment cancelling all Claims may be rejected by the examiner, see *Ex parte* Lasscell (1884), 29 O. G. 861.

That a power of attorney, giving him full authority to amend, does not authorize him to withdraw all the Claims and so destroy the application, see *Ex parte* Lasscell (1884), 28 O. G. 1274.

[3] That a pending application is not affected by a subsequent application for the same invention by the same inventor, nor does the later abandon the earlier application, see *Ex parte* Langlois (1878), 14 O. G. 84.

That the filing of a second application, describing but not claiming the improvement claimed in the former application, does not abandon such improvement to the public nor affect the

doned application has no legal existence or validity for any purpose. It cannot aid a subsequent one by carrying back the date of application, nor is it further noticed by the Patent Office.[4]

§ 580. Withdrawal and Substitution of Applications.

At any time before the final rejection or allowance of an application it may be withdrawn by the applicant, and a new application may be filed containing a new specification, oath, and drawing, and accompanied by a new fee.[1] Also, after the final rejection of an application, a new one may be filed in the same manner, though the rejected application cannot be withdrawn. In both these cases, the relation of the new application to the old depends upon the question of abandonment. If the original application were abandoned it can never be revived;[2] and in that case, or when the filing of the

prior application, see Suffolk Co. *v.* Hayden (1865), 3 Wall. 315.

That after a rejected application has lain unnoticed for several years, and a new and independent application for the invention is filed, the later is regarded as a final abandonment of the former, see *Ex parte* Gordon (1874), 6 O. G. 543.

[4] That an abandoned application is no longer noticed by the Patent Office, see *Ex parte* Casilear (1875), 8 O. G. 474. See also § 559, note 4, *ante*.

§ 580. [1] That under the act of 1836 a request for the return of the fee was not of itself a withdrawal of the application, see Colgate *v.* Western Union Telegraph Co. (1878), 15 Blatch. 365; 14 O. G. 943; 4 Bann. & A. 36; *Ex parte* Sexton (1876), 9 O. G. 251.

That the filing of a second application is not necessarily a withdrawal of the first, see Colgate *v.* Western Union Telegraph Co. (1878), 15 Blatch. 365; 14 O..G. 943; 4 Bann. & A. 36.

For a review of the cases on the withdrawal of applications, see Colgate *v.* Western Union Telegraph Co. (1878), 15 Blatch. 365; 14 O. G. 943; 4 Bann. & A. 36.

[2] That an application once abandoned can never be revived, see *Ex parte* Mayor (1878), 13 O. G. 912; Marsh *v.* Sayles (1872), 5 Fisher, 610; 2 O. G. 340.

That an abandonment of the invention by a final withdrawal of the application is an abandonment to the public, not to rival inventors, see Consolidated Fruit Jar Co. *v.* Bellaire Stamping Co. (1886), 27 Fed. Rep. 377; 35 O. G. 627.

That on a question of abandonment of the invention by the withdrawal of the application the lapse of time is of great weight, if not conclusive, see Consolidated Fruit Jar Co. *v.* Bellaire Stamping Co. (1886), 27 Fed. Rep. 377; 35 O. G. 627.

That a delay of fifteen years after the withdrawal of an application is abandonment of the invention, see Consolidated Fruit Jar Co. *v.* Bellaire Stamping Co. (1886), 27 Fed. Rep. 377; 35 O. G. 627.

That where eight years have elapsed

new has been unreasonably delayed or delayed beyond the two years named in the statute without an excuse satisfactory to the Commissioner, the later application must stand wholly upon its own merits on all points, including those of the novelty and the abandonment of the invention.[3] If the original applications were not abandoned, and if the new ones have been filed without unreasonable delay and within the two years limited by law, they are regarded as substitutes for and as continuations of the former, and on all questions of novelty and abandonment their dates relate back to the dates of the originals.[4]

since the former application was withdrawn, and others have meanwhile patented the same thing and the applicant has patented other things, the application is abandoned, see U. S. Rifle & Cartridge Co. *v.* Whitney Arms Co. (1877), 14 Blatch. 94 ; 11 O. G. 373 ; 2 Bann. & A. 493.

That an application being abandoned, a new one may be filed, see *Ex parte* Crompton (1876), 9 O. G. 5 ; Davies *v.* Hartman (1876), 9 O. G. 351 ; *Ex parte* Golding (1875), 8 O. G. 141 ; *Ex parte* Casilear (1875), 8 O. G. 474.

That after one application has been rejected, a new one cannot be filed except as a renewal of the former, see *Ex parte* Sexton (1873), 3 O. G. 409 ; *contra*, *Ex parte* Sexton (1876), 9 O. G. 251.

That after the rejection of an application by the Supreme Court of the District it is not renewable, though a new one may be filed, see *Ex parte* Gordon (1874), 6 O. G. 543.

[3] In Lindsay *v.* Stein (1882), 20 Blatch. 370, Blatchford, J. : (376) "The defendant contends that the effect of the act of 1870 is, that when an application is, under § 32, to be regarded as abandoned, no new application for a patent for the same thing can be subsequently made. There is nothing to prevent a subsequent application. When made, it can derive no aid, as to time, from the prior abandoned application, and the applicant must stand, as to defences in suits on the patent, as if the new application were the first application." 10 Fed. Rep. 907 (913) ; 21 O. G. 1613 (1615).

That where a former application has been abandoned, and a new one is substituted for it, the later must be examined on its own merits by the state of the art at its date, see *Ex parte* Gordon (1874), 6 O. G. 543 ; *Ex parte* Le Van (1872), 1 O. G. 226.

That the intention of an applicant to sever his applications will be regarded, and notice taken of the last only, see *Ex parte* Golding (1875), 8 O. G. 141.

[4] In Godfrey *v.* Eames (1863), 1 Wall. 317, Swayne, J. : (325) "In our judgment, if a party choose to withdraw his application for a patent, and pay the forfeit, intending at the time of such withdrawal to file a new petition, and he accordingly do so, the two petitions are to be considered as parts of the same transaction, and both as constituting one continuous application, within the meaning of the law."

That an application filed within a reasonable time after a prior application has been withdrawn or rejected, but not abandoned, is regarded as the successor to and continuation of the original application, see *Ex parte* Livingston (1881), 20 O. G. 1747 ; Graham *v.* McCormick (1880), 5 Bann. & A.

Whether or not two applications are continuous is a question of fact, to be decided by the circumstances of the case.[5]

244 ; 10 Bissell, 39 ; 21 O. G. 1533 ; 11 Fed. Rep. 859 ; *Ex parte* Sexton (1876), 9 O. G. 251 ; Weston *v.* White (1876), 13 Blatch. 447 ; 2 Bann. & A. 364 ; Goodyear Dental Vulcanite Co. *v.* Willis (1874), 7 O. G. 41 ; 1 Bann. & A. 568 ; 1 Flippin, 388 ; Goodyear Dental Vulcanite Co. *v.* Root (1874), 1 Bann. & A. 384 ; 6 O. G. 154 ; Smith *v.* Prior (1873), 2 Sawyer, 461 ; 6 Fisher, 469 ; 4 O. G. 633 ; Blandy *v.* Griffeth (1869), 3 Fisher, 609 ; Howe *v.* Newton (1865), 2 Fisher, 531; Rich *v.* Lippincott (1853), 2 Fisher, 1 ; Adams *v.* Edwards (1848), 1 Fisher, 1.

That though twenty years elapse in making successive applications, and endeavoring to secure a patent, the applications may be continuations of the original, see Colgate *v.* Western Union Telegraph Co. (1878), 15 Blatch. 365 ; 14 O. G. 943 ; 4 Bann. & A. 36.

That where a second application is made for part of an invention disclosed in a former and still pending application, the later is a continuation of the former so far as the question of two years' public use is concerned, see Graham *v.* McCormick (1880), 21 O. G. 1533 ; 10 Bissell, 39 ; 11 Fed. Rep. 859 ; 5 Bann. & A. 244.

That where an application has been withdrawn and the attorney is directed to file a new one but fails to do so within reasonable time, and one is afterwards filed and accepted by the Patent Office, they are regarded as the same, and no intermediate public use will work abandonment of the invention, see Howes *v.* McNeal (1878), 15 Blatch. 103 ; 15 O. G. 608 ; 3 Bann. & A. 376.

That applications are not continuous if the interval of delay was avoidable, see Smith *v.* Dimond (1881), 20 O. G. 742.

That a delay of eighteen years without action, after rejection, is abandonment, see Marsh *v.* Commissioner (1872), 3 Bissell, 321.

That an application filed ten years after the withdrawal of its predecessor, no action being meanwhile taken, is not a continuation of the original, see Bovin *v.* East Hampton Bell Co. (1871), 9 Blatch. 50 ; 5 Fisher, 23.

That the continuity of two applications may be interrupted without a technical withdrawal, see Bovin *v.* East Hampton Bell Co. (1871), 9 Blatch. 50 ; 5 Fisher, 23.

That when applications are continuous they take the date of the original on questions of novelty and abandonment, see Henry *v.* Francestown Soap-Stone Stove Co. (1876), 2 Bann. & A. 221 ; 9 O. G. 408 ; Howard *v.* Christy (1876), 2 Bann. & A. 457 ; 10 O. G. 981 ; *Ex parte* Gordon (1874), 6 O. G. 543.

That where a substituted specification covers a different invention its date is the date of the application, as compared with that of a foreign patent, see Globe Nail Co. *v.* Superior Nail Co. (1886), 27 Fed. Rep. 450.

That an application, substituted for one already filed at the instance of the Patent Office, dates from the filing of the former as to the question of public use, see International Tooth Crown Co. *v.* Richmond (1887), 30 Fed. Rep. 775 ; 39 O. G. 1550.

[5] In Weston *v.* White (1876), 13 Blatch. 447, Shipman, J. : (452) "The continuity of the two applications is a question of fact, to be determined, in each case, upon an examination of its own circumstances. In order to ascertain this fact, the trier will find whether the inventor has abandoned his original application, either by his own will, or

§ 581. Substituted Applications are Continuations of the Original and Bear its Date.

It is immaterial how many of these substituted applications may be filed, or for how long a period such efforts to obtain a patent may be continued. The patent, when granted, will rest on the original application, as represented in its various successors, unaffected by the intermediate conduct of third parties or the current of events, unless some legislative act, embracing it in its provisions, has been passed.[1] New applications, after rejection or withdrawal, may be made by the original applicant, or if he has meanwhile deceased, by his personal representatives.[2]

§ 582. Allowance of Patent: Notice to Applicant.

Whenever by the decision of the examiner, or on appeal, it appears that the applicant is entitled to a patent, a notice of its allowance is sent to him, calling for the payment of the final fee within the period of six months as required by the statute, and if the fee is paid within this period the patent is prepared for issue. Until such notice to the applicant the patent is not "allowed" within the meaning of the law, nor does the case pass beyond the examiner's control, nor does the six months' period begin.[1] After notice is given of an allow-

by his acts, and whether the new application is substantially for the same invention which was originally claimed. If the two applications are found to be continuous, and it has been therefore proved that the delay in making the new application, after the rejection of the first, has not been unreasonable, under the circumstances of the case, and if the invention has not been abandoned to the public, the public use, in order to invalidate the patent, must be a use prior to the original and continuing application. Public or common use subsequent to the date of the original application, if that has been a continuing one, and the two petitions are 'parts of the same transaction,' will not avoid the patent." 2 Bann. & A. 364 (368).

See also Bevin *v.* East Hampton Bell Co. (1871), 5 Fisher, 23; 9 Blatch. 50.

§ 581. [1] That in a series of applications the first is the one on which the patent depends, see Pelton *v.* Waters (1874), 7 O. G. 425; 1 Bann. & A. 599.

[2] That when an inventor dies pending an application, his administrator or executor may file a new one, if such course does not affect the rights of third parties, see Rice *v.* Burt (1879), 16 O. G. 1050.

§ 582. [1] That a patent is not "passed and allowed" until the applicant or his agent is so notified under Sec. 4885, and up to that date the case is still controlled by the examiner, see *Ex parte* Starr (1879), 15 O. G. 1053.

That the formal judgment of the ex-

ance the case will not be withdrawn from issue except on the approval of the Commissioner, and if withdrawn for further action on the part of the Patent Office, and then allowed, a new notice of allowance must be given. After the final fee has been paid, and the case has received its date and number, it cannot be withdrawn for any purpose except on account of mistake on the part of the Office, or fraud or illegality in the application, or for interference proceedings. For these purposes the application is regarded as pending until the letters-patent are delivered.[2]

§ 583. Allowance of Patent not Binding on Commissioner until Letters-Patent are Issued: Mandamus.

The allowance of an application by the examiner, or by the examiners-in-chief upon appeal, does not oblige the Commissioner to grant the patent for which it prays. The law empowers him to withhold a patent whenever in his judgment the invention is not patentable, or the issue of the patent is forbidden by the statutes, or the patent if granted would probably be held invalid by the courts.[1] This power is not to be exercised except in extreme cases, where to attach it would be manifestly a violation of your duty as a public officer; but where, as in this case, it appears that the patent, erroneously allowed by one of your subordinates, contains Claims which are neither novel nor meritorious and are manifestly old, although no fraud has been practised, I am of the opinion that it is your duty, although the patent may have been signed, to withhold the seal of your Office."

In Hull *v.* Commissioner (1875), 7 O. G. 559, Wylie, J.: (559) "The first question for the court to determine in the present case is this: Whether, *in an ex parte application* for a patent, the Commissioner possesses any author-

aminer is expressed by signing the file-wrapper and sending it to the Issue Division, and until this is done the case is under his control, see *Ex parte* Buell (1884), 26 O. G. 437.

That until the file-wrapper is signed and the application forwarded to the Issue Division the case is not decided by the examiner, whatever opinion he may have expressed or whatever advice his predecessor may have given, see *Ex parte* Fredericks (1887), 40 O. G. 691.

[2] That an application is pending until the patent is actually delivered, see *Ex parte* Lawrence (1879), 16 O. G. 955.

§ 583. [1] In *Ex parte* Hunt (1878), 13 O. G. 771, Schurz, Sec.: (771) "Until the seal is affixed the patent is not complete, and whether it shall be affixed or not in a given case, or in any case, where the merits of the application are directly brought to your attention, is a question which you must judicially determine in the discharge of your official duty. After a patent is regularly allowed and signed, however, this right to refuse the attaching of the seal, so as to give the patent validity, should not be exercised except in extreme cases, where to attach it would be manifestly a violation of your duty as a public officer; but where, as in this case, it appears that the patent, erroneously allowed by one of your subordinates, contains Claims which are neither novel nor meritorious and are manifestly old, although no fraud has been practised, I am of the opinion that it is your duty, although the patent may have been signed, to withhold the seal of your Office."

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cised unnecessarily, nor to delay the patent in order that some collateral controversy may be judicially determined.[2] The remedy of the applicant against the Commissioner for an im-

ity, under the law, to withhold a patent he should withhold it even when the application has been allowed by the examiners if he considers its issue unlawful, see *Ex parte* Neale (1879), 15 O. G. 511; Smith *v.* Perry (1875), 9 O. G. 688.

That the knowledge of the Commissioner that the patent ought not to issue must be legal knowledge derived from sources recognized as evidence by the courts, see Smith *v.* Perry (1875), 9 O. G. 688.

That after the Commissioner has decided that an applicant is entitled to a patent he may reconsider his decision and withhold the patent for reasons satisfactory to himself, and no mandamus can then compel him to issue it, see United States *v.* Butterworth (1884), 3 Mackay, 229; 27 O. G. 519.

[2] That the Commissioner should not withhold a patent after the application has been allowed by the examiner, unless he deems it necessary, see Disston *v.* Frank (1872), 1 O. G. 305.

That an allowed application cannot be suspended by the Office unless some reference, publication, public use, or interference is alleged, see *Ex parte* Atwood (1888), 44 O. G. 341.

That the Commissioner should not withhold a patent merely to allow other proceedings in court to be determined, see *Ex parte* Sargent (1877), 12 O. G. 475.

That the relation between a process and its apparatus is not that of genus and species, and an application for the former cannot be suspended after allowance on the ground of an interference between an application for its apparatus and other apparatus, see *Ex parte* Atwood (1888), 44 O. G. 341.

That a patent cannot be withheld on moral grounds, see Opinion Atty. Gen. (1812), 1 Op. At. Gen. 170.

in opposition to the report of a primary examiner, or the report of the Board of Examiners-in-Chief in its favor; in other words, whether, in such a case, the decision of the primary examiner, if favorable to the patent, is conclusive upon the Office, and if unfavorable, and the applicant has carried his case by appeal before the Board of Examiners-in-Chief, and there obtained a favorable decision, this latter decision is conclusive, so that nothing is left to the Commissioner except the ministerial act of countersigning and affixing the seal of the Office to the parchment. The petitioner for this writ claims that, according to the organization of the Patent Office, the question of the patentability of an alleged invention is to be referred for examination first to one of the primary or assistant examiners. If his decision be unfavorable, the applicant has the right to appeal to the examiners-in-chief. If their decision should also be unfavorable, he has the right of appeal to the Commissioner; and should the Commissioner's decision be unfavorable, the right of still further appeal to this court. In all this the petitioner's views of the law are correct; but he also claims that because his application is *ex parte*, and no one can take the appeal but himself, and nobody will ever appeal from a decision in his own favor, that the first favorable decision he obtains at any stage of the proceedings must be conclusive on the Office, since the case can go no further except by appeal. This view of the law we think is not correct." 2 MacArthur, 90 (102).

See also Opinion Atty. Gen. (1849), 5 Op. At. Gen. 220.

That under Sec. 4885 the Commissioner alone is to award the patent, and

proper exercise of this power is by a writ of mandamus, directing the Commissioner to award the patent. A mandamus will not be granted to compel the Commissioner to perform acts which the law leaves to his discretion.[3] When granted it is conclusive only on the Patent Office and the public, not on other claimants of the invention.[4]

§ 584. Application Forfeited by Failure of Applicant to Pay Final Fee: Application after Forfeiture.

The failure of the applicant to pay the final fee within six months after the notice of allowance forfeits the application,

[3] That where the Commissioner refuses to issue a patent which he has once properly allowed, the remedy is by mandamus unless his refusal is based on a matter within his judicial discretion, see Butterworth *v.* Hoe (1884), 112 U. S. 50 ; 29 O. G. 615 ; Hull *v.* Commissioner, (1875), 7 O. G. 559 ; 2 MacArthur, 90.

That a mandamus will not lie against the Commissioner when the matter is within his discretion, see United States *v.* Marble (1882), 22 O. G. 1365 ; Bigelow *v.* Commissioner (1875), 7 O. G. 603 ; 2 MacArthur, 24.

That if the Commissioner having decided to issue a patent does not change his decision, and still unreasonably delays to issue the patent, a mandamus will lie, see United States *v.* Butterworth (1884), 3 Mackay, 229 ; 27 O. G. 519.

That the delay of the Commissioner to let the opinion of the Secretary of the Interior be taken is not an act of discretion but of deference, and a mandamus will lie, see United States *v.* Butterworth (1884), 3 Mackay, 229 ; 27 O. G. 519.

That a Commissioner, having made return to a mandamus that he withholds the patent merely to await the action of the Secretary of the Interior, cannot afterwards claim that he desires to rehear the case himself, see Gill *v.* Scott (1884), 29 O. G. 949.

That proceedings will not lie against the Commissioner unless he refuses to issue the patent after the Secretary of the Interior has signed it, see Whitely *v.* Fisher (1870), 4 Fisher, 248.

That a mandamus against the Commissioner pending in the Supreme Court of the District, to which the Commissioner has duly made his return, is not affected by the laches of the petitioner, see Withington *v.* Locke (1878), 15 O. G. 426.

That the resignation of the Commissioner, after a return made on the mandamus, will abate it, see Withington *v.* Locke (1878), 15 O. G. 426.

That the refusal of the Commissioner *to award a patent, on grounds within* his discretion, may be reviewed by a bill in equity, see Hull *v.* Commissioner (1875), 7 O. G. 559 ; 2 MacArthur, 90.

That on a bill in equity the courts may authorize but cannot compel the Commissioner to issue a patent, see Vermont Farm Machine Co. *v.* Marble (1884), 20 Fed. Rep. 117 ; 22 Blatch. 128 ; 27 O. G. 622.

That a bill in equity to obtain a patent is not a substitute for a mandamus, see United States *v.* Butterworth (1884), 3 Mackay, 229 ; 27 O. G. 519.

[4] That where the court orders the Commissioner to issue a patent the order is conclusive only against the public, not against other applicants, see Cruikshank *v.* Strong (1880), 17 O. G. 511.

and no patent can be issued thereon. At any time, however, within two years after the notice of allowance has been given, the applicant, or any other person interested in the invention as its inventor or assignee, may file a new application for the same invention, using the original oath, petition, specification, drawing and model, if he pleases, but paying a new fee.[1] This second application is not considered as a continuation of the former, but will bear date from the time of the renewal, and will be examined and passed upon like an original application.[2] In its examination the novelty of the invention will be determined by the state of the art when the original was filed, not by its present state as in the case of an application wholly new, and the question of abandonment will be investigated and de-

§ 584. [1] That where a patent has been forfeited for non-payment of the final fee, a renewal application may be filed within two years, but not afterward, see *Ex parte* Hardy (1877), 12 O. G. 1075; *Ex parte* McCully (1874), 6 O. G. 153.

That failure to pay the final fee is an incurable forfeiture, though unavoidable, see *Ex parte* Barnitz (1887), 41 O. G. 575.

That notwithstanding *Ex parte* Barnitz (41 O. G. 575), a new original application may be filed after two years, see *Ex parte* Barnitz (1888), 42 O. G. 1061. See also Thomson *v.* Waterhouse (1884), 30 O. G. 177.

That after two years' delay there can be no renewal application, see Thomson *v.* Waterhouse (1884), 30 O. G. 177.

That a renewal application is like a motion to revive a judgment, see Thomson *v.* Waterhouse (1884), 30 O. G. 177.

That an assignee of the invention before patent has a right to renew an application after a former one by the inventor has been forfeited, see *Ex parte* Eveleigh (1872), 1 O. G. 303.

That an assignee may make and swear to a renewal application, see Thomson *v.* Waterhouse (1884), 30 O. G. 177.

That the renewal of an application by a person not the attorney of record, without the knowledge of the applicant, is void, see Consolidated Fruit Jar Co. *v.* Bellaire Stamping Co. (1886), 27 Fed. Rep. 377; 35 O. G. 627.

That the ratification of an unauthorized act of an attorney in renewing an application cannot affect intervening rights, see Consolidated Fruit Jar Co. *v.* Bellaire Stamping Co. (1886), 27 Fed. Rep. 377; 35 O. G. 627.

That there is no rule or statute which authorizes an applicant to forfeit an allowed application, file a renewal within six months, and pay the application fee, as if a forfeiture had already occurred, see *Ex parte* Manny (1888), 44 O. G. 700.

[2] That a renewal application within two years in lieu of a forfeited one, under Sec. 4897, is for some purposes a continuation of the other and relates back to it, taking its date, see Thomson *v.* Waterhouse (1884), 30 O. G. 177.

That where an application was allowed Dec. 22, 1877, and forfeited for non-payment, but renewed Feb. 4, 1879, the renewal was regarded as a new application and stood on its own date, as to two years' public use, see Weir *v.* Morden (1884), 29 O. G. 83.

cided as a question of fact.[3] While an application remains forfeited no notice is given to the applicant of any subsequent applications, and neither forfeited nor abandoned applications are cited as references to defeat a later applicant.[4] Forfeited applications remain in the secret archives of the Patent Office, open to the inspection only of the applicants or their attorneys, but copies of them may be given to other persons when specifically ordered by the Commissioner.

§ 585. Final Fees: how Paid: Delivery of Patent.

The final fee may, like the entrance fee, be paid to the Commissioner, or to the Treasurer or any of the Assistant Treasurers of the United States, or to any of the depositaries, national banks, or receivers of public money designated by the Secretary of the Treasury for that purpose, whose receipt may be transmitted to the Patent Office. The patent will be delivered or mailed on the day of its date to the patentee, unless there be an attorney of record, in which case it will be delivered to him or to the patentee as the attorney may require, but without a special request to that effect it will not be given to an associate or substitute attorney.

[3] That a renewal application will be examined in the light of the state of the art at the time the original was filed, see *Ex parte* Livingston (1881), 20 O. G. 1747; *Ex parte* Gordon (1874), 6 O. G. 543.

That a new application, filed more than two years after forfeiture, is defeated by any matter in bar arising after the forfeiture, see *Ex parte* Livingston (1881), 20 O. G. 1747.

That a delay in renewing an application raises a suspicion of abandonment and the oath should negative it, see Thomson *v.* Waterhouse (1884), 30 O. G. 177.

That delay in renewing an application is not conclusive proof of abandonment of the invention, see U. S. Rifle & Cartridge Co. *v.* Whitney Arms Co. (1877), 11 O. G. 373; 14 Blatch. 94; 2 Bann. & A. 493.

[4] That a forfeited application is dead and is not in the way of other applications, see Opinion Acting-Com. (1877), 12 O. G. 979.

That a "withheld application" is one held in abeyance and revivable on paying a new fee, but is abandoned after two years, see *Ex parte* Livingston (1881), 20 O. G. 1747.

That Sec. 35, act 1870, does not refer to applications then pending, see *Ex parte* Mygatt (1877), 12 O. G. 51.

SECTION X.

OF THE APPLICATION: PROCEDURE IN INTERFERENCE CASES.

§ 586. Interference Proceeding Instituted to Determine Priority between Rival Inventors.

The procedure heretofore described is that which is pursued in uncontested or *ex parte* cases. Upon all questions relating to the patentability of an invention and the fact of its discovery by the alleged inventor, the only parties in interest are the public on one side and the inventor on the other; and the examination instituted in the Patent Office upon the filing of the application is regarded as sufficient both to protect the public rights and to secure the lawful privileges of the inventor. But when there are rival claimants for the same invention, to neither of whose applications, if each stood alone, could any effectual objection be urged in the interest of the public, the question as to which of these inventors is entitled to a patent still remains, and in the investigation of this question adverse individual interests appear. The law, which authorizes the grant of but a single patent for the invention, awards it to that one of the claimants who first conceived the idea of the art or instrument described, provided he has used due diligence in reducing it to practice. To determine this fact a judicial proceeding becomes necessary, in which the several rivals are parties adverse to each other, having a right to be heard by evidence and argument in vindication of their own claims and in opposition to the claims of their antagonists, and which results in a judgment in favor of some one of them as the lawful patentee.[1] This judicial

§ 586. [1] In Hibbard *v.* Richmond (1880), 17 O. G. 1155, Doolittle, Act. Com.: (1156) "The first and original inventor, whose invention has not been in public use or on sale more than two years prior to his application, and who has not abandoned the same to the public, is entitled to a patent for his invention upon making a proper application, and if on examination of such application it shall appear that the applicant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, it becomes the imperative duty of the Commissioner to grant him letters-patent. The whole

proceeding forms the only contested case now known in the Patent Office, and is called an Interference.[2]

§ 587. History of Interference Proceedings.

An interference is a proceeding instituted for the purpose of determining the priority of the inventive act between two or more parties who claim substantially the same patentable invention.[1] This proceeding first appeared in our law in the act of 1793, which provided that interfering applications should be submitted to the arbitration of three persons, — two chosen by the applicants and the third appointed by the Secretary of State, — whose award should be final.[2] The act

machinery of the Office under the law is framed for this purpose, and if the Commissioner at any time finds that he has granted a patent to one who is not the first and original inventor, but that the first and original inventor is another person whose application is pending before him, it is his duty to grant a second patent to such applicant. The manner of trying the fact as to whether an applicant in any given case is the first and original inventor when his application conflicts with another pending application or with an unexpired patent is prescribed by section 4904, Revised Statutes, and the proceeding is known as an 'interference.'"

[2] That an interference is now the only contested case in the Patent Office, see Little *v.* Lillie (1876), 10 O. G. 543.

§ 587. [1] That in an interference proceeding the sole question is that of the priority of the inventive act, see Hicks *v.* Keating (1887), 40 O. G. 343; Swift *v.* Rochow (1880), 17 O. G. 450; Laverty *v.* Flagg (1879), 16 O. G. 1141; *Ex parte* Knox (1879), 16 O. G. 1048; Miller *v.* Miles (1877), 11 O. G. 197; Lagowitz *v.* Topham (1875), 9 O. G. 742; Dana *v.* Greenleaf (1875), 9 O. G. 198; Smith *v.* Perry (1875), 9 O. G. 688; Bigelow *v.* Commissioner (1875), 7 O. G. 603; 2 MacArthur, 24.

That disputes between patentees and their assignees cannot be determined in an interference proceeding, see Swift *v.* Rochow (1880), 17 O. G. 450.

That an interference is declared between applications rather than applicants, and is intended to find out which invention was first produced, not who has the title, and want of title may appear without a statutory bar being proved, see Hicks *v.* Keating (1887), 40 O. G. 343.

[2] In Little *v.* Lillie (1876), 10 O. G. 543, Duell, Com., gives the following short history of interferences: (544) "The first laws relating to interfering applications were passed in 1793, when, under the system then in practice, patents were grantable as a matter of course, the only examination being to determine whether the invention was sufficiently useful and important and the papers in proper form. Even at that early date it was found necessary to provide a means whereby to determine which of two or more persons was the first and original inventor, and for this purpose it was provided that the matter should be submitted to arbitrators. The act of 1836, establishing the Patent Office, inaugurated a new system, which, with various modifications, has since been adopted. The office of Commissioner of Patents

of 1836 gave to the Commissioner the authority to hear and decide these controversies, subject to an appeal to the board of

was then created, and his powers and duties were defined to be 'under the direction of the Secretary of State to superintend, execute, and perform all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions, and improvements, as herein provided for, or shall hereafter, by law, be directed to be done and performed.' Section 6 of said act prescribed the conditions upon which a patent should be granted, and section 7 required the Commissioner to cause an examination of each application to be made, in order to determine whether, under the statute, the party was entitled to a patent, and, if found not, then he was to refuse the grant. As a matter separate and distinct from this examination, provision is made in section 8 for interferences, as follows: '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 any 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 from such decision on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had to determine which or whether either of the applicants is entitled to receive a patent as prayed for.' The appeal, like that in cases arising from a second rejection under sections 6 and 7, was to be taken to a Board of Examiners appointed for the purpose. By the act of 1839 this Board was abolished, and the Chief Justice of the District substituted as the appellate tribunal. The act of 1852 gave to the assistant judges the same authority to hear appeals as the Chief Justice. Section 2 of the act of 1861 created the Board of Examiners-in-Chief, whose duty it was made '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.' From the decision of this Board an appeal would lie to the Commissioner. The condition of the law at this time made it necessary that interferences be declared for determining the question of priority between two or more persons in order that the first and original inventor might be discovered. The primary examiners were intrusted with the decision of these cases, and, like *ex parte* cases, their action could be appealed from to the Board of Examiners-in-Chief, from them to the Commissioner, and thence to any of the justices of the District Court. On the 8th of July, 1870, the laws relating to patents were revised and the Patent Office reorganized, several marked and important changes being made in the practice. The provisions for interferences were contained in section 42 (R. S. 4904), as follows: 'Whenever an application is made for a patent, which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior in-

examiners. In 1839 the right of an appeal to the Chief Justice of the District Court of the United States for the District of Columbia, instead of to the board of examiners, was conferred on the defeated party, and the decision of the Chief Justice was made conclusive as to all further proceedings in the case. The act of 1861 intrusted the determination of this question to the primary examiners, subject to appeal to the examiners-in-chief, whose judgment in its turn could be revised by the Commissioner. The act of 1870 directed that a special examiner of interferences should be appointed in the Patent Office, before whom these contested cases should be heard, and from whose finding an appeal might be taken to the examiners-in-chief and from them to the Commissioner, whose decision should be final. The latter is the present system of procedure.

§ 588. Interference Proceedings Instituted only between Pending Applications or between a Pending Application and an Unexpired Patent.

An interference can be instituted only between two or more pending applications, or between a pending application

ventor, unless the adverse party appeals from the decision of the primary examiner, or of the Board of Examiners-in-Chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.' A special examiner was provided to attend to interference cases. Appeal to the Board and the Commissioner was allowed as in *ex parte* cases, but here the former practice and analogy ceased. While *ex parte* cases were appealable to the Supreme Court of the District of Columbia sitting in *banc*, instead of the justices, interferences could not be taken beyond the Commissioner, his decision being final. The work of the Office was then divided into *ex parte* and contested cases, the former to be considered by the primary examiners, from whose action an appeal might ultimately be taken to the Supreme Court of the District, and the latter to the examiner of interferences, whose action was limited to the decision of the question of priority of invention, of which the Commissioner was the last appellate tribunal. In order to facilitate the practice of the Office, the present rules were adopted. They require that the primary examiner shall settle all questions relating to the patentability of the invention before he declares the preliminary interference, for upon doing this the case is at once transferred to the examiner of interferences. The jurisdiction of the examiner of interferences extends only to the determination of the question of priority of invention and matters incidental thereto, in the manner prescribed by the rules."

and an unexpired patent. Where patents already granted conflict with one another, the Patent Office has no authority over them, and the rival patentees must seek the solution of their difficulties in the courts.[1] Where a patent has expired the patentee has no longer any right requiring protection or which he can be called upon to vindicate as against later applications.[2] Forfeited and abandoned applications have no standing in the Patent Office as the basis of any claim or the allegation of any right on the part of their applicants, and are not noticed in the examination of other applications.[3] The jurisdiction of the Patent Office extends to applications alone, and to those only while actually pending before it.[4] Its judgment upon an interference can affect only the applicant to whom it refuses or allows a patent, a rival claimant who has previously obtained a patent continuing to hold it until it is declared invalid by the courts although the later applicant has proved his own priority before the interference tribunal and received his patent.[5]

§ 588. [1] That an interference between two or more patents cannot be adjudicated in the Patent Office, see Nicholson *v.* Bennett (1879), 16 O. G. 631; Wilson *v.* Yakel (1876), 10 O. G. 944.

[2] That an interference cannot be declared against an expired patent, see *Ex parte* Mason (1876), 9 O. G. 1196.

[3] That no interference can be declared with forfeited or abandoned applications, see Starr *v.* Farmer (1883), 23 O. G. 2325; Opinion of Acting-Com. (1877), 12 O. G. 979; *Ex parte* Spear (1874), 5 O. G. 201.

[4] That an interference is declared whenever the Claims of a pending application conflict with those of another application or an unexpired patent, see Sawyer *v.* Edison (1883), 25 O. G. 597; Western Electric Light Co. *v.* Chicago Electric Light Mfg. Co. (1882), 11 Bissell, 427; 14 Fed. Rep. 691; Little *v.* Lillie (1876), 10 O. G. 543.

That an applicant is not entitled to an interference with an unexpired domestic patent till he has been rejected thereon, see *Ex parte* Massicks (1887), 38 O. G. 1489.

That an interference should be declared between an application and an unexpired patent, although the applicant's foreign patents are older than the conflicting patent, see *Ex parte* Bland (1879), 16 O. G. 47.

That in an interference it is no advantage to have a patent unless the patentee is the original inventor, see *Ex parte* Russell (1874), 5 O. G. 149.

That an interference becomes necessary because the dates of conflicting applications are not conclusive on the question of priority, see Thomas *v.* Reese (1880), 17 O. G. 195.

[5] That a judgment against a patent, in an interference case, does not annul the patent, but simply awards a patent to the rival, see C. A. Yale Cigar Mfg. Co. *v.* Yale (1884), 30 O. G. 1183.

§ 589. Interference Proceedings Instituted only between Conflicting Applications, or between an Application and a Conflicting Patent.

An application does not conflict with another application, or an unexpired patent, unless the invention covered by each specification is substantially the same.[1] Similarity or diversity in name and appearance are of no consequence.[2] Every invention occupies toward every other the relation either of identity or of equivalence or of specific difference or of generic difference. Applications for identical or equivalent inventions are applications for the same invention. Applications for

§ 589. [1] That patents or applications conflict only when they claim, in whole or in part, the same invention, see *Ex parte* Lassell (1884), 28 O. G. 1274; Sawyer *v.* Edison (1883), 25 O. G. 597; Drawbaugh *v.* Blake (1883), 23 O. G. 1221; Gold & Silver Ore Separating Co. *v.* U. S. Disintegrating Ore Co. (1869), 3 Fisher, 489; 6 Blatch. 307; Marvin *v.* Lillie (1867), 27 O. G. 299.

That on an interference the Claims actually made are considered, but the examiner must have regard to the whole specification and to the Claims which might be made, see *Ex parte* Wheeler (1883), 23 O. G. 1031.

That the rules governing interferences should be liberally construed, so that patents may be restricted to such inventions as the patentees can justly claim, see Drawbaugh *v.* Blake (1883), 23 O. G. 1221.

That if an applicant claims anything covered by a prior patent the patentee must be notified, and have a chance to contest it, see Marvin *v.* Lillie (1867), 27 O. G. 299.

Under former rules of the Patent Office, an interference was declared where applications might be amended so as to include conflicting Claims, though the conflicting matter were not claimed in the application at the time the interference was instituted. At present the rules forbid the declaration of an interference until after the conflict appears specifically in the Claims. The foregoing cases, and also the following, should be read in view of this change in the rule.

[2] That an interference should be declared when the inventions conflict though the Claims do not, see Drawbaugh *v.* Blake (1885), 30 O. G. 259.

That immaterial differences in the Claims of conflicting applications will be disregarded, and an interference declared, if the matter claimed is substantially the same, see Drawbaugh *v.* Blake (1883), 23 O. G. 1221.

That the subjects of an interference are things not words, see *Ex parte* Upton (1884), 27 O. G. 99; Greenough *v.* Drummond (1879), 16 O. G. 586; Nicholson *v.* Bennett (1879), 16 O. G. 631; Drummond *v.* Greenough (1879), 16 O. G. 959.

That an interference may exist though the inventions have different names, see Hoe *v.* Scott (1878), 14 O. G. 447.

That inventions interfere if they are equivalents for each other, though they differ in appearance, see Withington *v.* Locke (1877), 11 O. G. 417.

That an application for a design may interfere with one for a mechanical invention, if both claim the same subject-matter, see Collender *v.* Griffith (1873), 3 O. G. 91.

inventions generically different are wholly distinct and independent of each other. Applications for inventions specifically different are distinct and independent, unless the inventor of one species also claims the genus to which both belong and the inventor of the other species fails to disclaim it in his application.[3] An interference can, therefore, be properly declared only when the inventions, as described and claimed in the applications or the patent, are identical or equivalent, or where being specifically different they do involve, or may involve, a claim to the generic invention in which both are embraced.[4] It is not, however, necessary that the scope of the Description or the subject-matter of the Claims, as presented in each patent or each application, should be the same. If that which is described in one is contained within the Description of the other, or if the Claims of one could by amendment be lawfully incorporated in the other, the inventions are sufficiently identical to warrant this proceeding.[5]

[3] In Banks *v.* Snediker (1880), 17 O. G. 508, Paine, Com.: (510) "The relation of two interfering inventions to each other must, in contemplation of law, always be either that of (1) identity, or (2) equivalence, or (3) specific difference, or (4) generic difference. In the first two classes of cases the earlier is absolutely fatal to the later invention; in the fourth, it presents no obstacle to the patentability of the later invention; in the third, the prior invention is no bar to a specific patent for the later invention, subject to a generic patent covering both species."

[4] That no interference should be declared unless an applicant claims what has been granted to or applied for by another, see *Ex parte* Platts (1879), 15 O. G. 827.

That where one application claims the genus and another the species, they will interfere unless the latter disclaims the genus, see *Ex parte* Gardner (1880), 17 O. G. 626.

That a patent with a Claim for a species will not be granted while an application claiming the genus is pending, unless after an interference hearing, see *Ex parte* Upton (1884), 27 O. G. 99; *Ex parte* Holt (1884), 29 O. G. 171.

That where one Claim includes the other an interference should be declared, see *Ex parte* Upton (1884), 27 O. G. 99.

That if a narrow Claim be included in a broad Claim an interference is the proper method of determining who is entitled to the broad Claim, see *Ex parte* Upton (1884), 27 O. G. 99.

That Claims for inventions which are mere double uses interfere, see Drawbaugh *v.* Blake (1883), 23 O. G. 1221.

That a Claim for carrying an invention into use in a specific way does not interfere with a Claim for the invention itself, see Drawbaugh *v.* Blake (1883), 23 O. G. 1221.

That a single Claim in one application may interfere with several Claims collectively in another, see Drawbaugh *v.* Blake (1883), 23 O. G. 1221.

[5] That applications conflict with each

§ 590. Interference Proceedings Instituted only when the Later Applicant Claims Priority of Inventive Act.

An interference cannot be instituted between conflicting applications, or between an application and a conflicting patent, unless the later applicant claims that his own inventive act preceded that of the former applicant or patentee.[1] Where a conflicting patent has been issued before the filing of the rival application this claim to priority must be explicitly stated.[2] The grant of letters-patent raises a presumption of priority in favor of the patentee against all future applicants, and their applications are, therefore, rejected by the Patent Office on a reference to a prior patent, unless the applicant avers upon his oath that his inventive act anticipated the filing of the application upon which the patent was allowed. This presumption extends to every application for re-issue based

other when anything that is shown in one is claimed in the other, see Bell *v.* Gray (1879), 15 O. G. 776.

That an application conflicts with a patent when it claims anything shown by the patent, see Bell *v.* Gray (1879), 15 O. G. 776; Marvin *v.* Lillie (1867), 27 O. G. 299.

That two applications for combinations, one wanting an element of the other but otherwise identical in operation and effect, interfere, since the lesser anticipates the larger, and the interference can be prevented or dissolved only when the applicant for the lesser disclaims the larger, see Banks *v.* Snediker (1880), 17 O. G. 508.

That where a design can be produced only by a certain device, an application for the latter conflicts with a patent for the former and an interference should be declared, see Collender *v.* Griffith (1873), 3 O. G. 91.

That no interference will be declared with an improper divisional application, see *Ex parte* Holt (1884), 29 O. G. 171.

§ 590. [1] That an interference will not be declared between pending applications, or an application and an unexpired patent, unless the later applicant claims priority under oath, see Thomas *v.* Reese (1880), 17 O. G. 195; *Ex parte* Nagel (1880), 17 O. G. 198.

That where the record conclusively establishes priority no interference should be declared, see *Ex parte* Nagel (1880), 17 O. G. 198.

That the application-oath has nothing to do with priority, see Sellon *v.* Hochhausen (1885), 33 O. G. 995.

That in order to obtain an interference with a patent, an applicant must make oath that he completed his invention before the patentee's application was filed, and must state the facts which prove it, and not merely aver that he invented before the patent issued, see *Ex parte* Graydon (1883), 25 O. G. 192.

[2] That in a conflict between an application and a patent, the patent makes a *prima facie* case for the patentee, see Paul *v.* Dorland (1873), 4 O. G. 552.

That an applicant in conflict with a prior patent must show that he was the first to conceive and used reasonable diligence in reducing to practice, see Hammond *v.* Laird (1874), 7 O. G. 170.

upon such prior patent, which must prevail over all other applications, whether original or based on later patents, unless the later applicant alleges and proves his own priority. No such presumption, however, exists in favor of one pending original application against another,[3] or of a patent granted after the filing of its rival application,[4] or of a re-issue application based upon a patent issued after the antagonistic application had been filed. Each of such conflicting applications is regarded as hostile to the others, and so asserting a priority in favor of its own individual applicant against all the rest.

§ 591. Interference Proceedings Instituted in Nine Special Cases.

In accordance with these principles an interference can be instituted in the following cases: (1) Between two or more original conflicting applications; (2) Between an original application and an unexpired patent granted during the pendency of such original application; (3) Between an original application and an application for the re-issue of a patent granted during the pendency of such original application; (4) Between two or more applications for the re-issue of patents granted on applications pending at the same time; (5) Between an original application and an unexpired patent, granted before such application had been filed, provided the applicant, after the rejection of his application upon reference to the patent, avers on oath that he made the invention before the original application of the patentee was filed; (6) Between an original application and an application for the re-issue of a patent granted before such original application was filed, provided the applicant avers on oath that he made the invention

[3] That an interference is declared whenever the oath and application of one claimant is neutralized by the oath and application of another, see Little *v.* Lillie (1876), 10 O. G. 543.

That an "unexpired patent" means one granted before the conflicting application was filed, see *Ex parte* Marston (1882), 21 O. G. 633.

That conflicting applications are hostile, whenever filed, and the premature issue of a patent to one does not affect the rights of the other, see *Ex parte* Marston, (1882), 21 O. G. 633.

[4] That where one of two contesting applicants has obtained a patent an interference may be declared *nunc pro tunc*, see *Ex parte* Marston (1882), 21 O. G. 633.

before the original application for the patent sought to be re-issued had been filed; (7) Between two or more applications for the re-issue of patents whose original applications were not pending at the same time, provided the applicant for a re-issue of the later patent avers on oath that he made the invention before the original application on which the earlier patent issued had been filed; (8) Between an application for re-issue and an unexpired patent, provided the original applications for each patent were pending at the same time, and the re-issue applicant avers on oath that he made the invention before the original application of the other patentee was filed; (9) Between an application for the re-issue of a later unexpired patent and an earlier unexpired patent which was granted before the original application for the later patent had been filed, provided the re-issue applicant avers on oath that he made the invention before the filing of the original application for the earlier patent. In the first four cases it will be perceived that no such presumption of priority exists in favor of either party as requires an express averment on the part of the other to authorize an interference, while in the last five cases such a presumption does arise from the previous action of the Patent Office in favor of the earlier patentee, which can be rebutted only by a distinct claim under oath to a priority over the opposing applicant or patentee.[1]

§ 591. [1] In *Ex parte* Nagel (1880), 17 O. G. 198, Paine, Com.: (199) "An original application will be placed in interference with an unexpired patent if the applicant shall, by affidavit, show his ability to controvert the *prima facie* proof furnished by the date of the unexpired patent by showing that he made the invention before the patentee filed his application. So an original application may be placed in interference with a re-issue application, notwithstanding the *prima facie* evidence of priority afforded by the date of the patent of which a re-issue is sought, if the original application shall be fortified by an affidavit of the applicant showing that he made the invention before the patentee's original application was filed. Again, an interference will be declared between applications for the re-issue of patents granted on applications not pending at the same time, if the applicant for re-issue of the later patent shall support his application with an affidavit showing that he made the invention before the application on which the earlier patent issued was filed. The same principle obtains in all other cases provided for by the rules. . . . (200) It is provided in section 4904 of the Revised Statutes that, '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

§ 592. Interference Proceedings: Notice of Interference to the Rival Claimants.

The first step in an interference is to secure from the adverse parties an exact statement of their conflicting claims

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.' This obviously does not mean that the Commissioner is to declare an interference whenever an application is filed in which is claimed an invention which is also claimed in an unexpired patent. On the contrary, as a rule, an application is to be rejected if it contains a Claim embraced in an unexpired patent. It is only when the applicant makes oath that he made the invention before the filing of the patentee's application that an interference is declared between an original application and an unexpired patent. If, instead of the *prima facie* proof furnished by the date of the patentee's application and of his patent, on the one hand, and the contradictory proof furnished by the affidavit of the applicant, the record presented conclusive proof in favor of either party, an interference would be a frivolous proceeding, for which the Commissioner would be able to find no excuse."

That no *prima facie* showing of priority on the record can prevent a later applicant from claiming an interference, upon making the proper averments under oath, see *Ex parte* Nagel (1880), 17 O. G. 198.

That an interference should be declared between an application and an unexpired patent showing the same invention, although the applicant's foreign patents are older than the patent in question, see *Ex parte* Bland (1879), 16 O. G. 47.

That an applicant for re-issue is not allowed to establish his priority against an expired patent, see *Ex parte* Mason (1870), 9 O. G. 1196.

That an interference may be declared between a re-issue application and applications filed or patents granted since the date of the original patent, see Sargent *v.* Burge (1876), 10 O. G. 285; Mayall *v.* Murphy (1874), 5 O. G. 339; *contra*, Carroll *v.* Morse (1876), 9 O. G. 453; Becker *v.* Throop (1875), 8 O. G. 1; Paris *v.* Bussey (1875), 8 O. G. 859.

That one of two joint patentees may subsequently file a sole application and have an interference declared between it and the joint patent, whereupon if he be found to have been the sole inventor a patent will be granted to him notwithstanding his former oath as joint inventor, see Kohler *v.* Kohler (1888), 43 O. G. 247.

That when, between two successive applications by the same applicant, another application is filed by a different inventor, an interference will be declared, see *Ex parte* Golding (1875), 8 O. G. 141.

That where a patent issues on one of two pending applications without an interference, the patentee will have no advantage on that account over his rival, but an interference will be declared as if no patent had been granted, see Gordon *v.* Withrington (1876), 9 O. G. 1009; Smith *v.* Barter (1874), 7 O. G. 1; Brookfield *v.* Brooke (1873), 4 O. G. 81; Goodman *v.* Scribner (1872), 2 O. G. 673.

That when one application conflicts with two or more patents only one interference should be declared and all be made parties, see Wilson *v.* Yakel (1876), 10 O. G. 944.

That whether an interference shall

in such a form that the Patent Office can judicially act upon them. For this purpose, whenever the examiner in charge of any application discovers that its Claims conflict with those of any other application, or of any unexpired patent, or with any pending caveat, it is his duty to notify such applicants or patentees or caveators and, if necessary, to require them to state their Claims in such a manner that the nature and extent of their antagonism will become distinct and unmistakable.[1] Upon the receipt of this notice and within the time therein specified, all parties must put their Claims in such condition that no further change in them will be required to precisely cover their respective rights. By this method the jurisdiction of the Patent Office over all the parties and the subject-matter in controversy is rendered as complete as possible, and the issues between them are clearly and specifically defined. Any want of exactness in the statement of his Claim, on the part of either of the contestants, is a sufficient reason for requiring him to further amend it, no alteration being permitted after final judgment in the interference unless the testimony adduced upon the trial necessitates or justifies the change. Parties who fail to comply with the requirements of this notice will be excluded from the interference, but without prejudice to any other right than that of being heard therein.

§ 593. Interference Proceedings: Examination of Conflicting Applications on their Merits.

The next step in the interference is to ascertain the right of each claimant to a patent for the invention as against the

be declared is a matter for the Commissioner to decide and from his decision there is no appeal, see *Ex parte* Gower (1879), 15 O. G. 828.

§ 592. [1] Under former rules of the Office an interference could be instituted between claimants where patents or applications might be amended to claim the same patentable matter, see Rules prior to 1881, and *Ex parte* Bland (1879), 16 O. G. 47. Under present rules no interference is declared unless the rival application or patent claims the same subject-matter.

That the primary examiner must decide whether Claims interfere, see Faure *v.* Bradley (1888), 44 O. G. 945; *Ex parte* Saunders (1883), 23 O. G. 1224.

That adverse parties in interference will be allowed to see copies of interfering Claims and specifications, but no other persons can have access to the interference files, see *Ex parte* Fischer (1887), 38 O. G. 1237.

public and irrespective of the question of priority. No applicant is entitled to become a party to an interference unless his right against the public is complete. He must have performed an entire inventive act, not only conceiving an idea of means but also reducing it to successful practice, and must have produced an art or instrument belonging to one of the protected classes, possessing novelty and utility, and not abandoned to the public.[1] In this inquiry each applicant stands alone, neither aided nor obstructed by the acts or achievements of any other applicant; and if it becomes apparent that on his individual merits he could not lawfully receive a patent, he cannot be permitted to engage in any contest for priority with those whose applications might be properly allowed.[2] Upon all the questions thus arising the examiner must pass as in ordinary *ex parte* applications, with the same rights of appeal as heretofore described.[3]

§ 594. Interference Proceedings: Definition of Issues.

The third step in the interference is to define the issues upon which the judgment of the Patent Office is desired.

§ 593. [1] That all questions as to the patentability of the subject-matter must be disposed of before the interference is formally declared, and questions not then raised will be waived, see *Ex parte* Bland (1879), 16 O. G. 47; Anson *v.* Woodbury (1876), 11 O. G. 243.

That questions as to novelty must be settled before the interference is declared, see Bennage *v.* Phillippi (1876), 9 O. G. 1159; Wood *v.* Morris (1873), 3 O. G. 239.

That before an interference is declared it should appear that both inventions have been reduced to successful practice, see Sargent *v.* Burge (1877), 11 O. G. 1055.

That a declaration of interference rests upon the assumption that the applications or patents cover operative devices, but such presumption is not conclusive and the question of operativeness may be raised and determined at any time in settling that of priority, see Voelker *v.* Gray (1885), 30 O. G. 1091.

[2] That the reduction to practice of one of the conflicting inventions cannot be inferred from that of the other, see Sargent *v.* Burge (1877), 11 O. G. 1055.

That the existence of a patent is *prima facie* evidence of reduction to practice, though no practical use is shown, see Busha *v.* Phelps (1876), 9 O. G. 1010.

That abandonment by one inventor does not affect the other, see Harmet *v.* Reese (1882), 21 O. G. 1875.

[3] That the examiner of interferences has no jurisdiction over the question of patentability as such, though he may dispose of the question when collaterally raised in the trial of the interference, see Faure *v.* Bradley (1888), 44 O. G. 945.

This is also the duty of the examiner.[1] These issues must be based upon the applications and patents of those who have been found by him to be entitled to become parties to the interference, and must represent what they actually claim, not what they might claim.[2] They must contain a summary of the contested matter, and point out the conflicting Claims.[3] Hypothetical issues cannot be permitted.[4] They must have the same meaning as to all the claimants; and if susceptible of various meanings that one will be adopted which sustains the interference as declared, and best agrees with the specifications of the parties.[5] The construction placed upon an issue by the Patent Office is conclusive.[6] The issues must embrace only those applications and patents which conflict with all the others, and the various cross-interferences between these should be consolidated by presenting them in different counts in the same issue.[7] Notices of the interference are then prepared by the examiner for all the parties, disclosing the name and residence of each contestant and those of his attorney, the date of the filing of his application,

§ 594. [1] That there are no formal pleadings in interference proceedings, see Faure *v.* Bradley (1888), 44 O. G. 945.

That it is the duty of the examiner to see that the subject-matter put in issue by the interference is properly defined, see Dod *v.* Cobb (1876), 10 O. G. 826.

That the primary examiner must decide whether Claims interfere, see *Ex parte* Saunders (1883), 23 O. G. 1224.

[2] That in declaring an interference the examiner must look to the language of the application alone, see Faure *v.* Bradley (1888), 44 O. G. 945.

That the issue in an interference must set forth what the parties do claim, not what they might claim, see Nicholson *v.* Bennett (1879), 16 O. G. 631.

[3] That the issue must point out the conflicting Claims and contain a summary of the contested matter, see Stephen *v.* Bailey (1877), 13 O. G. 45.

[4] That hypothetical issues cannot be allowed, see Farnsworth *v.* Andrews (1875), 9 O. G. 195.

[5] That the issue must have the same meaning as to all the parties, see Nicholson *v.* Bennett (1879), 16 O. G. 631; Drummond *v.* Greenough (1879), 16 O. G. 959.

That when the issue is open to several constructions the one which sustains the interference as declared and best agrees with the specifications of the claimants will be adopted, see Locke *v.* Levalley (1881), 20 O. G. 671.

[6] That the construction placed by the Patent Office on the issue is conclusive, see Locke *v.* Levalley (1881), 20 O. G. 671.

[7] That a single interference can embrace only such applications and patents as conflict with all the others, and these may be consolidated into one by presenting them in different counts, see Bell *v.* Gray (1879), 15 O. G. 776.

or if he is a patentee the date and number of his patent and the date of his application therefor, the ordinals of conflicting Claims, and the invention claimed, — clearly and concisely defining them in as many counts as are necessary to exhibit all interfering Claims included in the issue. These notices are transmitted with the files to the examiner of interferences, whose duty it is to ascertain whether the issues are clearly stated and the notices sufficient, and if he finds them defective in any material point to return them with his objections to the examiner for amendment. Upon the refusal of the latter to amend them the matter is referred to the Commissioner. These notices being perfected, the interference is formally declared, and the notices are sent to the parties in interest, accompanied by an order to each to file a preliminary statement of the facts, on which his claim to priority is based, within a time mentioned in the notice. The interference then becomes a contested case, and passes under the exclusive jurisdiction of the examiner of interferences, unless some questions other than those relating to priority arise, and thus compel its temporary return to the consideration of the primary examiner.[8]

§ 595. Interference Proceedings: Preliminary Statements.

The preliminary statement ordered in the notices of interference is a concise written recital, under oath, of the date of the contestant's original conception of the invention, of his construction of a drawing or model, of the disclosure of his invention to others, of its reduction to practice, and of the extent of its use.[1] If the invention was made abroad, the statement must declare when and where, if ever, it was patented or described in a printed publication, and when it, or the knowledge of it, was introduced into this country.[2]

[8] That the examiner of interferences has exclusive jurisdiction of the issues when declared, see Faure *v.* Bradley (1888), 44 O. G. 945.

§ 595. [1] That the preliminary statement must declare the character and extent of the use of the invention from the time of its perfection until the application was filed, see Dermody *v.* Pennock (1878), 14 O. G. 202.

That the extent of the use of the invention need not be given if it is evident that it was completed within two years before the application, see *Ex parte* Wheat (1878), 14 O. G. 787.

[2] That an applicant for an invention

As the principal object of these statements is to fix the relative times of the inventive acts of the several contestants, the dates given therein are considered as conclusive, and the evidence afterwards offered must confirm, not contradict, them.[3] This statement must also embrace, in general, all the facts which the applicant intends to rely on to support his claim, whether they are to be proved by the records of the Patent Office or by extrinsic testimony.[4] It must be sealed up before filing, and cannot be opened for examination by the opposing parties until all are filed or the time for filing has expired, and until the examiner of interferences has inspected it and found it satisfactory. Either of the contestants may be required by the examiner to correct defects in his statement within a specified period, but neither the original nor the amended statement can be returned to him after it has once been filed. The time for filing or amending the statements may be extended upon motion made before the expiration of the interval first limited for that purpose, and after proper notice to the adverse parties. Claimants residing abroad may claim the date of the arrival of the inventor or his agent in the United States as that of his discovery, see Thomas *v.* Reese (1880), 17 O. G. 195.

[3] That the preliminary statement need not fix the exact date of the invention, nor must the proof necessarily correspond with the exact date fixed, see Connor *v.* Williams (1878), 15 O. G. 387.

That "on or about" such a date means that exact date, not an earlier one, see Bering *v.* Haworth (1878), 14 O. G. 117.

That the earliest dates given to the inventive act in the preliminary statement are conclusive on the claimant, as against his future claim for an earlier date, see Connor *v.* Williams (1878), 15 O. G. 386; Walpuski *v.* Jacobsen (1876), 9 O. G. 964.

That a statement fixing dates by belief only may be corrected by evidence, see White *v.* Farmer (1874), 5 O. G. 338.

That a claimant fraudulently misled is not bound by his statement, see Allen *v.* Gilman (1872), 2 O. G. 293.

That if the claimant were insane when he made his statement he may amend or disavow it, see *Ex parte* Brooks (1874), 6 O. G. 296.

That a preliminary statement works no estoppel in the courts, see Union Paper Bag Mach. Co. *v.* Crane (1874), 6 O. G. 801; Holmes, 429; 1 Bann. & A. 494.

[4] That where the later applicant had filed an application before the earliest of the contesting applicants, his later application must so refer to it as to connect the two, or it will not be noticed, see Huntley *v.* Smith (1880), 18 O. G. 795.

That a disclaimer of the invention in conflict is not a preliminary statement, see Laverty *v.* Flagg (1879), 16 O. G. 1141.

ing to amend their statements when required to do so, will be restricted to their record dates during the further proceedings in the case.

§ 596. Interference Proceedings: Effect of Failure to File Preliminary Statement.

The failure of any party to file his preliminary statement within the time prescribed forfeits his right to be further heard, by evidence or argument, in favor of an earlier date for his inventive act than that *prima facie* date fixed by the filing of his application.[1] Hence, if he is the later of two conflicting applicants, judgment goes against him at once upon the record. If he is the later of three or more conflicting applicants, he is no longer recognized as a party to the interference, which proceeds in its regular course as to the others.[2] If his antagonist is a patentee whose patent was granted on an application prior to his own, judgment is rendered forthwith for the patentee.[3] In applications for re-issue, as well as in patents put in interference, the date of the original application on which the first patent issued is the *prima facie* date of the inventive act of the patentee or re-issue applicant; and in the absence of his preliminary statement this date is taken as the true date of his conception of the idea of the invention, and his claim to priority is determined by its relation to the dates fixed by the adverse parties in their applications or by their preliminary statements and the proof that may be afterward adduced in their support. Thus if an applicant, by his preliminary statement, fixes the date of his inventive act at a time previous to the filing of the original application for a conflicting patent, and the patentee

§ 596. [1] That failure to file a preliminary statement leaves the party to the date of his application, see Booth *v.* Lyman (1880), 17 O. G. 393.

That the rule requiring a preliminary statement and prescribing its form and contents, is reasonable and must be obeyed, see Smith *v.* Cowles (1885), 30 O. G. 343.

[2] That if the later of three or more conflicting applicants fails to file his statement he is no longer a party to the interference, see *Ex parte* Evans (1873), 3 O. G. 180.

[3] That a prior patentee in interference is entitled to a judgment unless the contesting applicant files his statement and offers evidence, see Loring *v.* Hall (1879), 15 O. G. 471.

presents no preliminary statement, the applicant is entitled to a decision in his favor upon showing that he made the invention before the date on which such original application was filed. Or if an applicant for the re-issue of a later patent, based upon a later original application, by his preliminary statement carries the date of his invention beyond the date of the original application for the prior patent, and the prior patentee fails to file his statement as required, the former will be found to be the prior inventor if his inventive act is proved to have preceded the filing of the application for the earlier patent. Where no preliminary statement is filed by any of the parties, priority is awarded to the senior applicant.[4]

§ 597. Interference Proceedings: Amendment of Preliminary Statement.

The allegations of a preliminary statement are presumed to be correct, and are conclusive upon the party filing it, unless he has been fraudulently misled.[1] Evidence offered to support them must conform to these allegations in all material points or it will be disregarded.[2] Corrections in the preliminary statement, especially in regard to dates, thus become of vital importance, and if as first filed it contains substantial errors arising from inadvertence or mistake, amendments may be made on motion showing to the satisfaction of the Commissioner that they are essential to the ends of justice.[3]

[4] That the senior applicant will receive the patent in the absence of any preliminary statement from either party, even though the junior applicant's oath discloses that he received a British patent before the senior application was filed, see Sellon *v.* Hochhausen (1885), 33 O. G. 995.

That where no statement is filed, the junior applicant cannot have a patent even though the senior applicant for the present disclaims the invention, if his application covers it, see Sellon *v.* Hochhausen (1885), 33 O. G. 995.

§ 597. [1] That a preliminary statement procured by fraud is not binding, see Allen *v.* Gilman (1872), 2 O. G. 293.

That insanity of the maker avoids a preliminary statement, see *Ex parte* Brooks (1874), 6 O. G. 296.

[2] That the claimant cannot introduce evidence contradicting his statement, see Connor *v.* Williams (1878), 15 O. G. 387.

[3] That a preliminary statement may be amended by permission of the Commissioner in proper cases, see Clemson *v.* Fowler (1886), 37 O. G. 671; Moore *v.* Brown (1882), 22 O. G. 1882.

That an error in a preliminary statement in reference to a date may be

Clerical errors may be corrected at any time, but a motion to amend in material particulars must be made, if possible, before the taking of any testimony and as soon as practicable after the discovery of the error.[4] Upon this motion all parties are entitled to be heard, and reasonable notice of its pendency must be served upon them. No amendment can

amended on satisfactory proof that it was made in good faith and that the applicant was misled or acted without negligence, see Clemson *v.* Fowler (1886), 37 O. G. 671; Robinson *v.* Seymour (1885), 33 O. G. 113.

That an earlier date, if inconsistent with the proof, cannot be inserted by amendment, see Cutting *v.* Kaylor (1872), 2 O. G. 704.

That an amendment of the statement will not be allowed if the error arose through negligence, see Clemson *v.* Fowler (1886), 37 O. G. 671; Smith *v.* Cowles (1885), 30 O. G. 343.

That if a defect in a preliminary statement occurs through failure to obey orders, or neglect in finding out what the applicant ought to know, no amendment will be allowed, see Smith *v.* Cowles (1885), 30 O. G. 343.

That a party who protests against the adverse statement and obtains its amendment, and after the evidence in chief is taken moves to amend his own statement in order to carry his dates back of those of the adversary, cannot be allowed to do so, being guilty of laches, see Donnelan *v.* Berry (1887), 41 O. G. 1499.

That a party filing a preliminary statement, which he knows to be defective, cannot amend it after he has become familiar with his adversary's case, see Donnelan *v.* Berry (1887), 41 O. G. 1499.

That a preliminary statement may be amended before evidence is taken if the amendment is made as soon as possible after the error is discovered, see Smith *v.* Cowles (1885), 30 O. G. 343.

[4] In Hopkins *v.* Le Roy (1880), 18 O. G. 859; Marble, Com. (859): "When a party makes and files his preliminary statement it is to be presumed that he has fully canvassed all the facts in his case, and that the statement as filed, as far as is necessary, is a correct statement of such facts. Unless the party having made such statement asks to amend the same before any testimony is taken in the case, all parties have a right to proceed on the issue as made in the respective statements. It may be that a statement made contains an erroneous date as is claimed in this case; if so, the party making the statement should correct that date before his opponent has been put to the expense of taking testimony to sustain his own case. A party has no right to wait until his opponent has fully developed all the facts in his case and then for the first time make known the error that he has committed in his preliminary statement. Proper diligence on his part would have placed him in possession of the facts upon which he could have corrected his statement before such testimony was taken. If through carelessness or negligence he has failed to have such correction made, other parties should not be injured by such negligence."

That clerical errors may be corrected at any time, if no injustice will result, see Allen *v.* Gilman (1872), 2 O. G. 293.

That a preliminary statement ought not to be amended after the evidence is taken or published, see Hopkins *v.* Le Roy (1880), 18 O. G. 859; Oliver *v.* Zeller (1876), 10 O. G. 416.

be permitted after the reception of evidence on the ground of ignorance of law or of the neglect of an attorney, and when permitted on any ground, at this stage of the proceedings, ample time is allowed to the adverse parties to contradict the amended allegations by additional proof.[5] No defective preliminary statement ought to be received by the examiner; but if received, and not objected to by the other contestants, the right to insist on its exclusion will be waived.[6]

§ 598. Interference Proceedings: Examination of Preliminary Statements.

When the time for filing the preliminary statements has elapsed, such as have been filed are subjected to examination and are compared with the original applications on which the claims of the contestants rest. If it appears from this examination that the date of the filing of the earliest application is not anticipated by the dates fixed by the other parties for their own conception of the invention, priority is awarded to the earliest applicant.[1] Where the preliminary statement of a later applicant fails to carry the date of his inventive act behind the date when earlier applications were filed, judgment is entered against him.[2] Only in cases where the date claimed for his inventive act in the preliminary statement of one party anticipates the filing of an earlier application by some other party does the interference proceed further, since in these cases alone is the *prima facie* presumption of priority arising from the dates of filing the respective appli-

[5] That ignorance of the rules of the Patent Office or the carelessness of an attorney are no reasons for allowing an amendment after the evidence is in, see Guest *v.* Finch (1876), 10 O. G. 165.

That when the statement is amended after evidence taken the adverse party may be allowed, on motion, to take further evidence, see Moore *v.* Brown (1882), 22 O. G. 1882.

[6] That a defective statement ought not to be received, but if it is the defect is waived unless objected to, see White *v.* Farmer (1874), 5 O. G. 338.

§ 598. [1] That where an examination of the statements shows that no one is earlier than the first applicant judgment will be rendered in his favor on notice to the other parties; otherwise a hearing will be held, see Booth *v.* Lyman (1880), 17 O. G. 393.

[2] That unless the statement of a later applicant carries his date of conception beyond the date when the first application was filed, judgment will go against him, see Huntley *v.* Smith (1880), 18 O. G. 795.

cations rebutted, and additional evidence rendered necessary in order to determine between the antagonistic claimants.

§ 599. Interference Proceedings: Taking Testimony.

If the interference proceeds, the time is then fixed by the examiner for the taking of the testimony by the several parties.[1] A period is limited within which the latest applicant must complete his evidence in chief, followed by a period for the adverse party to finish his testimony in reply, and this by a third period for the rebutting evidence of the later applicant. Where there are more than two contestants their periods for taking testimony are so arranged that each shall have an opportunity to prove his own case against prior applicants, and to rebut their evidence when offered in reply, and also to answer that of later applicants. The time for taking evidence may be extended in favor of either party upon a motion disclosing under oath the reasons for his inability to obtain his evidence within the period prescribed, the names of the witnesses whose testimony he desires, the facts which he expects to prove by them, and the efforts he has made already to secure their earlier attendance.[2] A failure to complete his testimony within the period assigned to any party is not permitted to delay the final hearing. The hearing may be postponed for sufficient reasons by the examiner in charge, but unless thus postponed a later applicant, whose evidence has been completed within the time prescribed, may insist upon a hearing and judgment, after that time has elapsed, upon the evidence as it then appears.

§ 600. Interference Proceedings: Burden of Proof: Evidence Admissible.

The general rules of evidence apply in interference cases to the same extent and in the same manner as on similar issues

§ 599. [1] That in an interference with a patent the time for taking evidence will not be made coincident with the later dates fixed in another interference with the same patent, unless there is some reason for it other than that the facts are the same, see Keith *v.* Faure (1883), 25 O. G. 289.

[2] That the courts are liberal in extending the time for taking testimony if the party has been diligent, see Osgood *v.* Badger (1888), 44 O. G. 1065.

in the courts.[1] Priority of inventive act consists in the prior conception of the idea of means and the prior embodiment of this idea in some practically operative art or instrument, or reasonable diligence in perfecting such embodiment; and the successful claimant must establish this priority by a clear preponderance of evidence, though not necessarily beyond reasonable doubt.[2] In order to do this he must not only overcome the presumptions against him arising out of earlier applications and patents on behalf of other parties, but must affirmatively establish his right to priority as against such parties themselves, by proofs sufficient to defeat their patents in the courts.[3] Thus he must show that his conception of the in-

§ 600. [1] That the same rules of evidence apply in interference cases as in the courts, see Millward *v.* Barnes (1877), 11 O. G. 1060; Palm *v.* Behel (1876), 10 O. G. 701; Berry *v.* Stockwell (1876), 9 O. G. 404.

That the examiner of interferences has the exclusive right to decide as to the competency, construction, scope, and legal meaning of all foreign patents or other evidence, and to determine whether they cover the same invention as the one in interference, see Faure *v.* Bradley (1888), 44 O. G. 945.

[2] That on an interference the party having the burden of proof must show that he first completed the invention, see McKnight *v.* Wagenen (1876), 9 O. G. 1161.

That a claimant against a patent has the burden of proof, see Donoughe *v.* Hubbard (1886), 27 Fed. Rep. 742; 35 O. G. 1561; Cushman *v.* Parham (1876), 9 O. G. 1108.

That where the *prima facie* proof arising from the patent is outbalanced by evidence of prior invention, the burden of proof shifts to the patentee, see Hazelip *v.* Richardson (1876), 10 O. G. 747.

That on interference the averment that an applicant is not an original inventor must be conclusively proved by the party who alleges it, see Hockhausen *v.* Weston (1880), 18 O. G. 857.

That an applicant in interference with a patent need not prove priority beyond reasonable doubt, see Fulgham *v.* Westcott (1879), 16 O. G. 1005.

That the assertion of an applicant that he "invented" at a certain date is of little weight against facts showing the contrary, see Slade *v.* Blair (1880), 17 O. G. 261.

That where one of two joint patentees applies for a sole patent he must overcome by evidence the presumption arising from his oath as joint-inventor, as well as the *prima facie* case presented by the prior patent, or judgment on the interference will be against him, see Lovrien *v.* Banister (1880), 18 O. G. 299.

[3] That in an interference between an application and a patent, the applicant must offer such evidence of priority as would defeat the patent in the courts, see Gill *v.* Scott (1883), 23 O. G. 2511; Withington *v.* Locke (1877), 11 O. G. 417; Palm *v.* Behel (1876), 10 O. G. 701; Stoddard *v.* Perry (1874), 6 O. G. 33.

That if a junior inventor, using due diligence in reduction and application, obtains a patent and a senior inventor afterward applies, the latter must show entire freedom from laches or a patent

vention antedated that of every other claimant, and that at the date of their conceptions he had either reduced, or was using reasonable diligence in reducing, his own conception to successful practice.[4] In proving his conception of the invention the claimant may present any evidence which tends to show that the idea of means was fully developed in his own mind at the date alleged. Verbal descriptions, drawings or sketches, models, other devices equivalent in principle or embracing all the features on which conflict now arises, and any other manifestation or embodiment of his idea sufficient for its complete expression may be offered to support his claim.[5]

will be denied him and all doubts resolved in favor of the patentee, see Voelker *v.* Gray (1885), 30 O. G. 1091.

That the first applicant is regarded as the first inventor till the contrary appears, see Starr *v.* Farmer (1883), 23 O. G. 2325, 2327.

That where an application is complete and duly filed the subsequent applicant must show that he invented, or conceived the idea and was diligently reducing to practice, before the prior application was filed, see Starr *v.* Farmer (1883), 23 O. G. 2325, 2327.

That if one of the applications in interference is a division of one previously filed, the date of the original will be regarded in determining on whom is the burden of proof, see Henderson *v.* Reese (1883), 25 O. G. 191.

[4] That the successful claimant must show that he was the first to conceive and used reasonable diligence in reducing to practice, see Hammond *v.* Laird (1874), 7 O. G. 170.

That where two persons separately make the same invention the question is which is the first inventor, see Hall *v.* Johnson (1883), 23 O. G. 2411.

That where each one of two persons who united in reducing the invention to practice claims to be the inventor, the question is which conceived it, see Hall *v.* Johnson (1883), 23 O. G. 2411.

See also § 370–391 and notes, *ante*.

[5] That on an interference the *prima facie* date of a patented invention is the date of filing the application on which the patent issues, though other records of the Patent Office may be consulted, see Booth *v.* Lyman (1880), 18 O. G. 132.

That the uncontradicted oath of the applicant that he made drawings of the invention at a certain time, if supported by one other credible witness, is sufficient though the drawings have been destroyed, see Smith *v.* Edson (1875), 7 O. G. 827.

That the production of sketches prepared for the occasion profits little except as illustrating other evidence, see McCullough *v.* Watkins (1875), 8 O. G. 1074.

That mere descriptions and destroyed drawings are not of much weight to show priority, see Ware *v.* Bullock (1874), 7 O. G. 39.

That a machine embracing all the features over which the interference contest has arisen may serve to show the date of the invention, though it lacks certain improvements found in pending applications, see Hockhausen *v.* Weston (1880), 18 O. G. 857.

That devices produced by the applicant which are equivalent in principle may fix the date of the invention, see Bird *v.* Walsh (1878), 14 O. G. 234.

That an abandoned application is not

In proving reduction to practice he must establish the existence of an operative art or instrument, capable of practical employment.[6] Upon this point models, drawings, and descriptions have but little weight. Diligence in reducing to practice may be shown by any testimony applicable to the peculiar circumstances of the case. No claimant is allowed by evidence to carry the date of his conception of the invention behind the date assigned to it in the preliminary statement; and any substantial variation between such statement and the evidence on any point renders the evidence suspicious.[7] Where the statement fixes its dates by belief and information the testimony may render them more certain

considered in fixing the burden of proof, see Henderson *v.* Reese (1883), 25 O. G. 191.

That an abandoned experiment cannot be revived so as to secure priority on an interference, see Sheridan *v.* Latus (1883), 25 O. G. 501.

See also §§ 380, 381 and notes, *ante*.

[6] In Stover *v.* Clark (1877), 12 O. G. 188, Spear, Com.: (188) "The question in controversy is one capable of easy solution if the bearing of the Office in relation to interference proceedings, in which one of the parties is a patentee, is kept clearly in mind. In this class of cases the adverse applicant must show conclusively that prior to the time of the invention by the patentee he (the applicant) had fully reduced it to a form or condition capable of standing the test of actual practical use. An experimental reduction, the illustration of a theory by a model, will not suffice of itself to establish that completion which is alone regarded by the law as *sufficient to impeach the title of the patentee*. As was said in Coffin *v.* Ogden, 18 Wall. 124, 'If the thing were embryotic or inchoate; if it rested in speculation or experiment; if the process pursued for its development had failed to reach the point of consummation, — it cannot avail to defeat a patent founded upon a discovery or invention which *was completed, while in the other case* there was only progress, however near that progress may have approximated to the end in view."

See also Gardner *v.* Dudley (1880), 17 O. G. 801; Halladie *v.* Paine (1877), 12 O. G. 1077; Sargent *v.* Burge (1877), 11 O. G. 1055.

That a patent is *prima facie* proof that the patentee had completed his invention, though its practical use is not shown, see Bus[illegible] *v.* Phelps (1876), 9 O. G. 1010.

That the assertion of a party that he conceived the invention at a certain time amounts to very little unless he then completed it, see McCullough *v.* Watkins (1875), 8 O. G. 1074.

[7] That the evidence must conform to the statement or it will be rejected, see Hovey *v.* Hufeland (1872), 2 O. G. 493.

That any substantial variance between the statement and the evidence renders the evidence suspicious, see McCullough *v.* Watkins (1875), 8 O. G. 1074.

That the evidence as to the date of the invention need not agree with the statement, but must not show it to be earlier than the one therein alleged, see Connor *v.* Williams (1878), 15 O. G. 386; Walpuski *v.* Jacobsen (1876), 9 O. G. 964.

and correct.[8] A foreign patentee cannot prove an earlier date for his invention than the date of his foreign patent, and a foreign inventor who has not patented his invention abroad cannot anticipate by his evidence the date on which the knowledge of his invention was first brought to the United States, either by himself or by his confidential agent.[9] A preliminary statement is not admissible in evidence in favor of the party making it, although it may be used against him as rebutting or limiting the other evidence which he presents.[10]

§ 601. Interference Proceedings: Rules of Evidence.

The statute authorizes the Commissioner to make rules for taking testimony in cases pending in the Patent Office, and provides for the issue of *subpœnas* from the Federal courts in the districts where the witnesses reside, and for compelling the attendance of those witnesses who disregard the ordinary

[8] That a statement fixing dates by belief only may be corrected by the evidence, see White *v.* Farmer (1874), 5 O. G. 338.

[9] That an applicant for an invention conceived abroad may carry the date of his invention back to the arrival of the inventor or his agent in the United States, see Thomas *v.* Reese (1880), 17 O. G. 195.

That a foreign inventor cannot carry the date of his invention back by showing acts done in a foreign country, see Boulton *v.* Illingworth (1888), 43 O. G. 508.

That whether a foreign patentee can carry his date back to that of his foreign patent is doubtful, see Thomas *v.* Reese (1880), 17 O. G. 195.

That a foreign patentee cannot go behind the date of his patent to show the time of his invention, see Rumpff *v.* Köhler (1882), 23 O. G. 1831, 1832; Chambers *v.* Duncan (1876), 10 O. G. 787.

That evidence that one applicant published his invention abroad before the other made it here defeats the application of the other, and also possibly his own, see Thomas *v.* Reese (1880), 17 O. G. 195.

That Sec. 4887, limiting the term of the domestic by that of a foreign patent, cannot be invoked to carry the date of invention back to the date of a previously issued British patent, where the two patents are not alike, see Gandy *v.* Main Belting Co. (1886), 37 O. G. 1357.

For a discussion of the value of an English specification as evidence, see Lauder *v.* Crowell (1879), 16 O. G. 405.

On the whole matter of priority in reference to foreign inventors and patentees, see § 382 and notes, *ante*.

[10] That a preliminary statement is not affirmative evidence in favor of the party making it, see Lauder *v.* Crowell (1879), 16 O. G. 405.

That the original statement and the fact of its amendment will be considered on the merits as affecting the evidence concerning the actual date, see Robinson *v.* Seymour (1885), 33 O. G. 113.

summons.[1] In the exercise of the authority thus conferred upon him the Commissioner has established certain regulations, prescribing that all evidence offered in contested cases must be presented in depositions, taken upon due notice to the adverse parties in the form of interrogatories and replies, and sealed up, addressed, and forwarded to the Commissioner by the officer before whom they were given.[2] Where witnesses reside abroad, such depositions may be taken before an American consul, or other proper officer, by order of the Commissioner, based upon the motion of the claimant and his sworn averment that the motion is not made for purposes of delay or vexation to the adverse party and that the evidence cannot be otherwise conveniently obtained.[3] After these depositions are returned to the Commissioner and duly opened, they are subject to inspection by the parties, but cannot be withdrawn. Unless for satisfactory reasons to the contrary they must be printed by some person appointed by the Office for that purpose, and copies must be furnished to the Office and to each of the contestants. Caveats and other official records, and any special matter contained in printed publications, may be filed and used as evidence upon due notice to the adverse parties, when competent and pertinent to the issue. No evidence touching the matters in dispute can be considered at

§ 601. [1] That the rules of evidence in interference proceedings are those of the law in force in the District of Columbia, see Marsh *v.* Rein (1888), 43 O. G. 1453; Koen *v.* Quint (1883), 23 O. G. 1329.

That witnesses are under the control of the courts, not of the Commissioner, see Osgood *v.* Badger (1888), 44 O. G. 1065.

That husband and wife are not competent witnesses for or against each other in interference proceedings, see Marsh *v.* Rein (1888), 43 O. G. 1453; *contra*, Koen *v.* Quint (1883), 23 O. G. 1329.

That where one party to an interference attacks the patentability of the invention he must offer all his evidence on this point as well as that of priority before his opponent can be obliged to put in his proof, see Clark *v.* Le Dow (1888), 43 O. G. 248.

[2] That a notice to take testimony after so short an interval that the party must travel night and day to get there is not reasonable notice, see Hoag *v.* Abbott (1879), 15 O. G. 471.

That a failure to appear to take a deposition after reasonable notice is a waiver of all technical irregularities, see Hoosier Drill Co. *v.* Ingels (1879), 15 O. G. 1013.

[3] That the Commissioner may order depositions to be taken abroad before consuls, see Lauder *v.* Crowell (1879), 16 O. G. 405.

the hearing unless obtained in accordance with those rules. But merely technical objections, not working any substantial injury to the party raising them, will not be regarded, and where such injury is inflicted the injured party must make his objection as soon as he becomes aware of its existence, and notify the Office and the adverse party that unless the objection is removed it will be urged against him at the hearing.[4]

§ 602. Interference Proceedings: Arguments of Contestants.

The rules advise that arguments and briefs in all contested cases should also be printed and filed before the hearing, and parties neglecting to avail themselves of this advantage in due season have no right to an extension of time for that purpose. Upon the day named for the hearing, any party appearing will be heard, but no case will be taken up for oral argument after the day appointed, except by the consent of all parties. After the arguments have been completed, no further hearing will be accorded to either party unless at the request of the tribunal having jurisdiction of the case.

§ 603. Interference Proceedings: Judgment of Priority.

An interference having been once declared, it cannot be determined without a formal dissolution, or a judgment on the issue of priority.[1] This judgment may be rendered either

[4] That objections to the evidence must be urged at the hearing, under the rules, see *Hoag v. Abbott* (1879), 15 O. G. 471.

That a deposition improperly taken may be objected to at the interference *hearing*, though ordinary objections which may be cured by a new commission to take testimony, or formal objections merely, should be taken by motion to suppress, see Milligan *v.* Niedringhaus (1886), 38 O. G. 103.

That it is always better to move to suppress in advance of the hearing, see Milligan *v.* Niedringhaus (1886), 38 O. G. 103.

That a motion to suppress will be denied, except in extreme cases, if the party moving has neglected to take *proper* steps *for his protection*, see Osgood *v.* Badger (1888), 44 O. G. 1065.

That a motion to suppress must be made without unreasonable delay, see Milligan *v.* Niedringhaus (1886), 38 O. G. 103.

That if a witness in an interference refuses to answer a proper question on cross-examination his entire testimony will be excluded, see Milligan *v.* Niedringhaus (1886), 38 O. G. 103.

§ 603. [1] That where an interference exists the proceedings cannot terminate without a judgment on account of the

upon the testimony, or upon the written concession of the adverse parties, signed by the parties themselves and not merely by their attorneys, or upon the written declaration of either of the parties that he has abandoned his application.[2] Such written concession must be consistent with the facts, — no false or fraudulent admission of priority authorizing a judgment contrary to the truth.[3] In rendering a judgment on the testimony the examiner of interferences must follow the same rules concerning the performance and completeness of the inventive act which are recognized as binding in the courts. The several parties are presumed to have made the invention in the chronological order in which they filed their original applications, and the burden of proof rests on those who endeavor to establish any different order of invention.[4] Where all the parties are American inventors judgment must be awarded to the claimant who establishes the real priority of his inventive act. Where one of the parties is a foreign inventor and the others are American, the latter is entitled to priority unless the invention of the former was known or used in the United States, or patented or published, before the conception of the invention by the latter. If one of two foreign inventors has obtained a for-

abandonment of his application by one party, if the other party claims it, see Adler *v.* Van Wagener (1875), 8 O. G. 728.

That a judgment must be rendered except in cases where the rules otherwise provide, see Hicks *v.* Keating (1887), 40 O. G. 343.

[2] That an agreement conceding priority is not good unless signed by the adverse party himself, the attorney having no authority to sign it, see Tucker *v.* Kahler (1879), 15 O. G. 966.

That a concession of priority is not available except between the parties and in reference to pending proceedings, see Hammond *v.* Pratt (1879), 16 O. G. 1235.

[3] That a concession of priority contrary to the truth is void, see Hammond *v.* Pratt (1879), 16 O. G. 1235; Packard *v.* Sandford (1879), 16 O. G. 1132; Allen *v.* Gilman (1872), 2 O. G. 293.

See also § 363 and notes, *ante*.

[4] That unless a contrary right appears priority will be awarded to the party who first filed a complete application, including petition, specification, drawings, model, and fee, see Lapham *v.* Bettendorf (1879), 16 O. G. 137.

That priority cannot be awarded to the earliest applicant, who has merely conceived the idea and filed an application, against one who, before the filing of such application, had reduced the idea to practice, see Gardner *v.* Dudley (1880), 17 O. G. 801.

That priority will be awarded to the first perfecter of the invention though the other party were the first to practically use it, see Martin *v.* Bogle (1877), 12 O. G. 625.

eign patent, he must prevail over his adversary, although the other was in fact the first inventor; if both have obtained foreign patents the earliest patentee has the superior right; if neither has a foreign patent the earliest introducer into the United States prevails.[5] Where the decision in favor of one applicant against another is not appealed from, or is sustained upon appeal, it is equivalent to a rejection of the defeated applications, and a patent is awarded to the victorious applicant alone.[6] But when an applicant establishes his own priority against a patent, the patent cannot be affected by the judgment, and the sole result is the issue of another patent to the applicant. Where neither party proves priority judgment is rendered against both, in order that both may be enabled to appeal.[7] The wrongful issue of a patent to one applicant, pending an interference, does not warrant the issue of another to his rival where the priority of the latter is not proved.[8]

[5] That an invention made in the United States has priority over a foreign invention unless the foreign invention were used in the United States, or were published or patented, before the domestic invention was made, see Lauder *v.* Crowell (1879), 16 O. G. 405.

That as between two foreign inventions the first applicant in the United States has priority, if he is an original inventor, see Lauder *v.* Crowell (1879), 16 O. G. 405.

That as between two foreign inventors who are applicants in the United States, if one of them has a foreign patent he is entitled to priority, though the other was the first inventor, see Lauder *v.* Crowell (1879), 16 O. G. 405.

That when two foreign applicants are both foreign patentees, the earliest patentee is entitled to priority, see Lauder *v.* Crowell (1879), 16 O. G. 405.

That a foreign patentee stands like any other applicant until a contest begins, and must then prove his priority, see Lauder *v.* Crowell (1879), 16 O. G. 405.

[6] That the applicant for a specific invention, having been defeated in an interference with the applicant for the generic invention, cannot have a patent for the species subject to that for the genus unless he disclaims the genus or takes some other further action, see *Ex parte* Gardner (1880), 17 O. G. 626.

[7] That if neither party seems to be the original and first inventor judgment should run against both, see Wood *v.* Eames (1880), 17 O. G. 512.

[8] In *Ex parte* Frick (1872), 1 O. G. 574, Leggett, Com.: (574) "It is claimed by the applicant in this case that during the pendency of his application a patent has been issued to other parties for substantially the same thing, and he now asks that a patent be allowed him without being called upon to prove priority of invention in an interference with the existing patent. If it be true (which I now neither admit nor deny) that a patent has issued during the pending of this application with which this application at the time interfered, then the Office has committed

§ 604. Interference Proceedings: Appeal from Judgment of Priority.

Unless appealed from, the decision of the examiner of interferences is conclusive upon all the parties to the interference.[1] Such an appeal will lie only on some question involved in the issue of priority, and is taken in the first instance to the examiners-in-chief and from their adverse judgment to the Commissioner in person.[2] An appeal in

a grave error; but this error would not be corrected by granting the motion now made by the applicant. Two wrongs would not make one right. If the Office has committed a blunder by illegally issuing one patent, it cannot now correct that blunder by illegally issuing another. The action now must have reference to the present condition of the two cases. The existing patent, though prematurely issued, is beyond the control of the Office, and cannot be recalled. Another patent cannot be legally issued for the same invention, except upon interference trial it be shown that the applicant is the prior inventor. The motion of the applicant must, therefore, be refused."

§ 604. [1] That an interference must first be heard before the examiner of interferences, see Farnsworth *v.* Andrews (1875), 9 O. G. 195.

That the decision of the examiner of interferences is conclusive unless appealed from, see Whitely *v.* McCormick (1876), 10 O. G. 826; Jenkins *v.* Barney (1873), 3 O. G. 119.

[2] That the relation of the examiner of interferences and of the examiners-in-chief to the Commissioner is the same as that of one court to another, see Berry *v.* Stockwell (1876), 9 O. G. 404.

That the jurisdiction of an examiner terminates upon an appeal, see *Ex parte* Brunner (1872), 1 O. G. 303.

That no appeal lies from the refusal of an examiner to dissolve the interference on the ground that the adverse applicant had no right to make the Claims, no party having any other rights against his adversary than the whole public has, and it being presumed that the Patent Office will protect these, see Faure *v.* Bradley (1887), 40 O. G. 243.

That in an interference case a notice to the defeated party of the adverse decision, limiting the time for appeal to ten days, means ten days from the receipt of the notice, and is, therefore, uncertain, see Pearson *v.* Lister (1883), 24 O. G. 1175.

That on an appeal to the Commissioner in an interference the applicant is entitled to have his case considered on the law and the evidence, see Sellers *v.* Walter (1886), 37 O. G. 1001.

That if, pending an appeal to the Commissioner in an interference, he is notified that the applications should be rejected on the ground of public use, he should refer that question to the examiner, see Finch *v.* Bailey (1883), 25 O. G. 191.

That where the Commissioner is ordered by mandamus to hear an interference in person the patent cannot issue until the mandamus has been obeyed, see Withington *v.* Locke (1878), 15 O. G. 426.

That on an appeal the concurrent opinions of the examiner of interferences and the examiners-in-chief on a question of fact are of great weight, see Berry *v.* Stockwell (1876), 9 O. G. 404.

an interference case must be accompanied by a brief statement of the reasons therefor, and is governed by the same general rules that are applied to appeals in *ex parte* cases. From the decision of the Commissioner there is no appeal, and patents issue to successful applicants without further opposition on the part of rival claimants.[3] But a defeated claimant still has a remedy for the assertion of his own rights by a bill in equity upon which all adverse parties, whether applicants or claimants, may be heard; and if he then obtains a judgment another patent will be issued in his favor.[4]

§ 605. Interference Proceedings: Dissolution of the Interference.

If it becomes apparent during the course of an interference that its further prosecution would be useless, a motion to dissolve it may be made before the examiner of interferences, by whom the motion, with the files and papers, must be transmitted to the primary examiner for his decision on the points involved.[1] This motion may be offered whenever the testi-

[3] That no appeal will lie to the Supreme Court of the District of Columbia from a decision of the Commissioner in an interference case, the only remedy being by bill in equity under Sec. 4915, see Kirk *v.* Commissioner (1886), 37 O. G. 451; 5 Mackay, 229; Butler *v.* Shaw (1884), 21 Fed. Rep. 321.

That the Secretary of the Interior has no power to revise the decision of the Commissioner on the subject of priority, see Butterworth *v.* Hoe (1884), 112 U. S. 50; 29 O. G. 615; United States *v.* Butterworth (1884), 3 Mackay, 229; 27 O. G. 519.

[4] That a decision in interference is not final except in the Patent Office, and a bill in equity to annul the adverse patent will lie in favor of the defeated party, see Union Paper Bag Mach. Co. *v.* Crane (1874), 1 Bann. & A. 494; Holmes, 429; 6 O. G. 801.

That the remedy in equity provided by Sec. 4915 applies to decisions in interference cases as well as all other decisions on the merits of an application, see Butterworth *v.* Hoe (1884), 112 U. S. 50; 29 O. G. 615.

That the successful applicant cannot be enjoined from accepting his patent on the ground that the Commissioner was mistaken as to priority, see Whipple *v.* Miner (1883), 23 O. G. 2236; 15 Fed. Rep. 117.

That the power of the Circuit Court to grant a patent is independent of the Patent Office, but the defeated party cannot decide when the court shall act by injunction, see Whipple *v.* Miner (1883), 23 O. G. 2236; 15 Fed. Rep. 117.

That the filing of a bill in equity to obtain a patent by the defeated party to an interference does not stay proceedings in the Patent Office nor justify the Commissioner in withholding a patent from the successful party, see Wells *v.* Boyle (1888), 43 O. G. 753.

§ 605. [1] That an examiner of interferences cannot dissolve an interference

mony introduced or the arguments urged or the concession of either of the parties renders it evident that the interference cannot lawfully proceed.[2] The grounds on which it may be based are the non-patentability of the invention,[3] the absence

on *ex parte* affidavits alleging non-patentability, etc., though he may suspend and remand to the primary examiner, see Hedges *v.* Daniels (1880), 17 O. G. 152.

That if a motion to dissolve an interference is based on want of patentability, etc., it must be sent to the primary examiner, see Green *v.* Hall (1886), 37 O. G. 1475.

That when an interference is remanded to the primary examiner for want of patentability, etc., the interference is dissolved *pro hac vice*, the applications become *ex parte*, the original jurisdiction of the examiner attaches, and the right of appeal exists as in other *ex parte* cases, see Faure *v.* Bradley (1887), 40 O. G. 243.

[2] That a motion to dissolve may be made at any time, see Banks *v.* Snediker (1879), 16 O. G. 1096.

That if a motion to dissolve the interference is not filed within twenty days after the statement is approved the delay must be explained, or the examiner of interferences will not send the case to the primary examiner, though from his refusal to do so appeal lies to the Commissioner, see Green *v.* Hall (1886), 37 O. G. 1475.

That a motion to dissolve an interference must state the reasons, and recite the grounds, and show all the facts on which the motion is based, see Green *v.* Hall (1886), 37 O. G. 1475.

That adverse parties must be served with a notice of a motion to dissolve an interference and with the reasons therefor, and have an opportunity to be heard, see Green *v.* Hall (1886), 37 O. G. 1475.

That an irregular motion to dissolve an interference will be dismissed on motion of the adverse party, see Green *v.* Hall (1886), 37 O. G. 1475.

That if the later applicant disclaims the invention the interference will be dissolved, see Laverty *v.* Flagg (1879), 16 O. G. 1141.

[3] That a motion to dissolve an interference must be based on the application alone, not on the preliminary statement or other outside matter, see Faure *v.* Bradley (1888), 44 O. G. 945.

That an interference may be dissolved on the ground that the invention is not patentable, see Stone *v.* Greaves (1880), 17 O. G. 397; Hockhausen *v.* Weston (1880), 18 O. G. 857.

That on proof of facts showing a bar to the patent, as distinguished from a mere want of title, the interference may be dissolved, see Hicks *v.* Keating (1887), 40 O. G. 343.

That want of novelty is a ground for dissolution, see *Ex parte* Knox (1879), 16 O. G. 1048.

That if only one of the inventions is useful and operative a dissolution will be ordered, see Fuller *v.* Brush (1879), 16 O. G. 1188.

That where abandonment by public use is suspected the examiner of interferences may be ordered to investigate it, or the case may be remanded to the primary examiner, from whom an appeal lies, see *Ex parte* Finch (1887), 40 O. G. 1027.

That a motion to dissolve on the ground of non-patentability should be made at the outset, see Blinn *v.* Gale (1879), 16 O. G. 459.

For the practice in cases where a statutory bar appears, see Hicks *v.* Keating (1887), 40 O. G. 348.

of any real conflict between the Claims of the several contestants,[4] the failure of either party to show that he is a true inventor of the invention claimed,[5] or such irregularity in the institution of the interference as must render any judgment therein void.[6] From the decision of the primary examiner upon this motion an appeal lies in the usual manner to the examiners-in-chief;[7] but if no appeal is taken within the

[4] That unless both devices are embraced in the interference it should be dissolved, see Smith *v.* Winchell (1878), 13 O. G. 1127.

That if both parties do not claim the same subject-matter the interference will be dissolved, see Sawyer *v.* Edison (1883), 25 O. G. 597; Dod *v.* Cobb (1876), 10 O. G. 826.

That where two machines in interference are different, and only one is operative, the difference will be treated as essential, see Bradford *v.* Imlay (1879), 16 O. G. 314.

[5] That if the contestants appear to be joint inventors dissolution will be ordered, see Taylor *v.* Martin (1879), 16 O. G. 138.

That if a motion to dissolve is made on the ground that the adverse party is not an original inventor, the allegation must be conclusively proved, see Hockhausen *v.* Weston (1880), 18 O. G. 857.

That if it appears that the patentees in a joint conflicting patent were not joint inventors, the interference will be dissolved, see Walton *v.* Dennis (1879), 16 O. G. 959.

[6] That a motion to dissolve on account of non-interference or irregularity in the proceedings will be heard by the tribunal before which the case is pending, see Barney *v.* Kellogg (1880), 17 O. G. 1096.

That no motion to dissolve an interference should be sent to the primary examiner unless it alleges either that there is no interference in fact, or that the interference has been so irregularly declared that no judgment can be rendered, or that the invention is not patentable, or that the applicant has no right to claim it, see Edison *v.* Phelps (1887), 38 O. G. 539.

That on hearing a motion to dissolve an interference nothing will be considered but what appears on the face of the motion, and the papers filed, see Green *v.* Hall (1886), 37 O. G. 1475.

That on a motion to dissolve an interference counter affidavits may be filed at the time named for the hearing and without notice, and if the adverse party be taken by surprise, a continuance may be granted, see Green *v.* Hall (1886), 37 O. G. 1475.

That on a motion to dissolve an interference affidavits of the adverse party, filed without leave, will not be noticed, see Green *v.* Hall (1886), 37 O. G. 1475.

[7] That where a primary examiner overrules a motion to dissolve, and affirms his previous finding of patentability, the mover may make protest to the Commissioner against the issue of the patent, see Fowler *v.* Benton (1880), 17 O. G. 266.

That no appeal lies from a decision affirming "the right of the applicant to make the Claims," and so overruling a motion to dissolve, see Faure *v.* Bradley (1888), 44 O. G. 945.

That an appeal from the order to dissolve for want of patentability lies to the examiners-in-chief, see Fuller *v.* Brush (1879), 16 O. G. 1188.

That if an interference is dissolved, and both applications are rejected, and one party appeals to the Supreme Court of the District, the other by two years

time limited for that purpose, or if the right to an appeal is expressly waived by the party entitled to it, the examiner returns the files and papers, with his own judgment upon the matters embraced in the motion, to the examiner of interferences, who dissolves or continues the interference in accordance with the facts found by the primary examiner. Two motions to dissolve on the same ground are not permitted, the remedy of the party claiming it being exhausted by one motion with the privilege of an appeal.[8]

§ 606. Interference Proceedings: Suspension of the Interference.

Whenever the examiner of interferences or the examiners-in-chief upon appeal discover any fact not bearing on the question of priority, but showing that no conflict actually exists between the inventions of the several claimants, or that the invention is not patentable to either party, or that the interference was irregularly declared, it is their duty to suggest it to the Commissioner, in order that he may suspend the interference and remand the case to the primary examiner for his consideration of the matters thus discovered.[1]

failure to prosecute his application may abandon it, see Cruikshank *v.* Strong (1880), 17 O. G. 511.

[8] That two motions to dissolve cannot be entertained on the same ground; one motion only with an appeal or rehearing being allowed, see Banks *v.* Snediker (1880), 17 O. G. 508.

§ 606. [1] That the examiner of interferences has no jurisdiction over questions of patentability, see Little *v.* Lillie (1876), 10 O. G. 543.

That when, on an interference, the patentability of the invention seems doubtful, the interference should be suspended and the question referred to the examiner for decision, see Lynch *v.* Dryden (1873), 3 O. G. 407; Wood *v.* Morris (1873), 4 O. G. 131; *Ex parte* Neubecker (1873), 4 O. G. 319.

That if the invention is claimed to have been abandoned by public use, a suspension will be ordered and the case sent to the examiner, see Hedges *v.* Daniels (1880), 17 O. G. 152.

That an interference will not be arrested by the Commissioner before an appeal and referred to the examiner on a question of public use, unless the proof is clear, see Finch *v.* Bailey (1883), 25 O. G. 191.

That an examiner of interferences cannot consider affidavits as to public use, and on that ground reject an application and dissolve the interference, see Hedges *v.* Daniels (1880), 17 O. G. 152.

That an examiner of interferences may be directed to investigate a question of public use, see *Ex parte* Finch (1887), 40 O. G. 1027.

That the examiner of interferences, by order of the Commissioner, may fix times for taking evidence on the question of public use, see *In re* Alteneck (1883), 23 O. G. 2233.

An interference may also be suspended by the Commissioner, upon the request of the primary examiner, for the purpose of adding new parties or when the examiner has found new references which seem to him to cast a doubt upon the patentability of the invention.[2] After the decision of the primary examiner upon these matters, or that of the examiners-in-chief on an appeal, the interference will be dissolved or re-instated as the character of such decision may require.[3] Judgment in an interference case which is otherwise ready for decision will not be suspended in order that different questions, not affecting the defeated party may be first determined.[4] Hearings before the primary examiners upon these suspensions, as well as upon motions to dissolve, and appeals from their judgments to the examiners-in-chief or the Commissioner, are governed by the rules heretofore discussed in reference to *ex parte* cases.

§ 607. Interference Proceedings: Motions: Practice.

During the proceedings in an interference any other proper motions may be made by either party after reasonable notice

[2] That where the evidence on interference shows any other defects, suspension may be ordered and the case sent back to the examiner, see Bigelow *v.* Commissioner (1875), 7 O. G. 603; 2 MacArthur, 24.

That suspension may be ordered to add new parties, see Maloney *v.* Kidwell (1879), 16 O. G. 1139.

That if, pending an interference, an application is filed, which the examiner thinks should be included therein, he must report it to the examiner of interferences, who must ascertain whether any evidence has been taken; if not, he may suspend the interference and admit the new party, otherwise report to the Commissioner, see Reed *v.* Jordan (1887), 38 O. G. 661.

That an interference opened by the primary examiner to let in new parties stands as if it had just been originally declared, and neither party has a right, at this stage, to interfere in the framing of the issues or inspect the papers now admitted, see White *v.* Demarest (1887), 41 O. G. 1161.

[3] That if the decision of the examiner denies the patentability of the invention, the interference will be dissolved, unless appeal is taken, see Stone *v.* Greaves (1879), 17 O. G. 260.

[4] That the Commissioner will not suspend his judgment on an interference to await the decision of other questions not affecting the defeated party, see Smith *v.* Dimond (1881), 20 O. G. 742.

That an interference with a patent will not be suspended to await the decision of a suit as to its ownership, unless the interfering applicant is connected with the suit, or the parties to the suit are likely to be injured by the action of the Patent Office and are trying to protect their rights, see Keith *v.* Faure (1883), 25 O. G. 289.

to the adverse claimants.[1] Such motions are addressed to the tribunal having immediate jurisdiction of the interference, but an appeal from the decision thereby rendered may be taken to the examiners-in-chief on questions relating to the merits of the case and on other questions directly to the Commissioner, as provided in the general rules which govern all appeals. A motion does not necessarily operate as a stay of the proceedings. To effect this a special application must be made to the same tribunal, which may upon sufficient grounds order a suspension of the interference until the motion is decided.[2] The practice upon all motions in contested cases, where not particularly indicated by the rules of the Patent Office, follows the ordinary course of equity practice in the courts of the United States.

§ 608. Interference Proceedings: Amendment of Application by Disclaiming Contested Matter.

Amendments to an application while in interference can be made only for the purpose of delivering its subject-matter, wholly or in part, from the conflict in which it is apparently involved. An applicant who prefers to abandon any claim to the contested matter rather than incur the expense, delay, and risks of an interference, may file in the Patent Office, before the date fixed for the presentation of his preliminary statement, a disclaimer in writing over his own signature and attested by two witnesses, averring that he does not claim to be the inventor of the particular matter in issue. This disclaimer must be accompanied by such an amendment to his specification as removes the contested matter from his Claims as therein stated. Judgment will then be rendered against him in the interference, and his disclaimer and amendment will be embodied in his remaining application, which will

§ 607. [1] *That an interference is a* contested case, even in its preliminary stages, and motions cannot be made without notice to the other party, see Bell *v.* Gray (1879), 15 O. G. 776; Gray *v.* Bell (1878), 15 O. G. 385.

That notice must be given to all other parties, since every application or patent involved in the interference is hostile to all the rest, see Bell *v.* Gray (1879), 15 O. G. 776.

[2] That a motion does not stay proceedings in interference unless a petition to that effect is also offered and granted, see Dubois *v.* McCloskey (1880), 17 O. G. 1158.

thereafter be examined and determined as an *ex parte* case.[1] This disclaimer has no relation to the disclaimer of a patentee, filed for the purpose of amending an already granted patent.[2] Where there has been an assignment of the invention before or pending the application, such disclaimer must be accompanied by the written consent of the assignee.

§ 609. Interference Proceedings: Amendment of Application by Withdrawing Uncontested Matter for New Application.

Where an application covers several complete inventions, and an interference has been declared between it and another application or a patent embracing less than all the inventions therein claimed, the applicant may file an amendment withdrawing from his application the uncontested matters, in order to make these the subject of a new application, while the interference proceeds to judgment in reference to the matters in dispute.[1] In such new application no Claim can be inserted whose language includes anything still claimed in the original application, though the devices shown in the original may be described in the new, so far as may be necessary to render the subject-matter of the new intelligible to

§ 608. [1] That where the later applicant disclaims the conflicting invention the interference will be dissolved, see Laverty *v.* Flagg (1879), 16 O. G. 1141.

That the decision of the Commissioner, on appeal, that an amendment does not warrant a dissolution of an interference, is binding until duly reversed, *Ex parte* Gardner (1880), 17 O. G. 626.

[2] That an interference is not dissolved on account of a disclaimer made *pendente lite*, see Waring *v.* Wilkerson (1878), 15 O. G. 246.

That where a defeated party to an interference cancels the interfering Claims he cannot be required to disclaim such matter though his Claims may be made so specific as not to impose on the public, see *Ex parte* Firm (1887), 39 O. G. 1199.

§ 609. [1] That a party to an interference may remove from his application all his own peculiar separable inventions and not await the decision in the contest, see *Ex parte* Wheeler (1883), 23 O. G. 1031.

That a party to an interference cannot make in a separate application any Claim which the adverse party might also make, see *Ex parte* Wheeler (1883), 23 O. G. 1031.

That where in an interference the undisputed matter is withdrawn, and made the basis of a separate application, and a patent disclaiming all not claimed therein and reserving the right to apply for the disclaimed matter issues, and then a third application is filed claiming all in both the others, the latter is treated as a division of the first, see *Ex parte* Clarke (1884), 26 O. G. 824.

persons skilled in the art. The new application will be then examined and proceeded with as an *ex parte* case, unless some other interference is discovered.

§ 610. Interference Proceedings: Discovery of Non-Patentability of the Invention pending the Interference.

In rendering their decision on the question of priority, it is the duty of the examiner of interferences, or of the examiners-in-chief upon appeal, to call the attention of the Commissioner to any points they may discover relating to the general merits of the applications.[1] The Commissioner may then remand the case to the primary examiner for his consideration, the parties having the same rights of appeal from his determination of these questions as in other cases.[2] On an appeal from the examiners-in-chief to the Commissioner, upon the issue of priority, if he perceives that any matter relating to the patentability of the invention, or to the rights of either of the claimants as against the public, still remains undetermined, he may in the same manner provide for its examination and decision.[3]

§ 611. Interference Proceedings: Effect of Judgment.

A judgment in an interference, if not appealed from, is conclusive on the parties to the interference as far as the action of the Patent Office is concerned, and a second interference will not be declared between the same parties in reference to the same invention, either upon the same or upon

§ 610. [1] That all questions as to the patentability of the invention ought to be settled before the interference is declared, but if afterwards arising they must be considered, see Wood *v.* Morris (1873), 3 O. G. 239.

That if questions as to patentability first appear on the interference hearing they may be noted, and afterward passed upon by the primary examiner, see Anson *v.* Woodbury (1876), 11 O. G. 243.

That on an appeal to the examiners-in-chief in an interference, if the devices are found not to interfere, this question is not in issue but may be noted in a pos'script for further action, see Brown *v.* La Dow (1880), 18 O. G. 1049.

[2] That a hearing on an interference will be opened to let in newly discovered evidence as to the novelty of the invention, see Wood *v.* Morris (1873), 3 O. G. 239.

[3] That the Commissioner must take notice of an objection to patentability, however it may be brought to his attention, see *Ex parte* Smoot (1877), 11 O. G. 1010.

amended or new applications.[1] The former decision, if erroneous either in fact or in law, can, however, be reviewed, when substantial justice requires it, on a new trial granted according to the principles governing such proceedings in ordinary cases.

§ 612. Interference Proceedings: Number Unlimited: Consolidation of Interferences.

Any number of interferences may be instituted between a given application and conflicting patents or applications; and these may be concurrent or successive, as the circumstances may require.[1] When several applications interfere with one another upon the same subject-matter, presenting but a single issue, the various reciprocal interferences may be consolidated and disposed of upon one proceeding.[2] When a new application is filed pending an interference between others, every one of which conflicts with it on different points relating to the invention therein described, each of the former parties may so amend his application as to include all the points claimed in the later, and a new interference embracing all the applications will be then declared.[3] But if an application is in

§ 611. [1] That a second interference will not be declared between the successful party and his opponents, on other applications, although they show features described but not claimed in the successful application, unless the Commissioner so order, see Hovey *v.* Muller (1873), 3 O. G. 149.

§ 612. [1] In Potter *v.* Dixon (1863), 5 Blatch. 160, Nelson, J.: (163) "It is supposed by the learned Chief Justice that there can be but one interference declared by the Commissioner on an application for a patent, and that the decision of the Chief Justice is conclusive upon the Commissioner, though in the *meantime, and before the patent issues,* another case of interference should appear or be presented. There is certainly nothing in the statute limiting the power of the Commissioner in this respect, and the reason for the hearing in the second case is as strong as for that in the first. The object of the provision is one that pervades the whole of the statute, namely, to secure to the real inventor the exclusive privileges therein provided for. Besides, a hearing and decision between the applicant for a patent and A, whether in favor of the one or the other, forms no rule for a decision between the applicant and B, in case of an interference declared between them. The proceedings are independent and *inter alios.*" 2 Fisher, 381 (384).

That evidence as to priority must be received by the Patent Office if offered at any time before the patent issues, see Eccard *v.* Drawbaugh (1883), 24 O. G. 301.

[2] That interferences may be consolidated, see Bell *v.* Gray (1879), 15 O. G. 776.

[3] That when a new application is

conflict with another only upon one divisible member of the invention, and with still another only on a different member of the invention, the issues presented are entirely distinct, and the interference proceedings must be separate and independent of each other. A judgment in one interference does not prevent the successful contestant from being made a party to another interference with different opponents, and for this purpose his patent may be withheld from issue even after the allowance of his application and the payment of the final fee.[4]

§ 613. Interference Proceedings: Judgment how far Conclusive.

The doctrine of *res adjudicata* is recognized and applied in the Patent Office as well as in the courts.[1] But a judgment in one interference furnishes no guide in others, and is binding only on the parties to the record, and on them only in reference to further proceedings on the same questions in the Patent Office.[2] Before the courts the adverse parties still stand

filed, interfering with two or more applications already in interference, a new interference will be declared and the former parties may amend their Claims so as to meet the last application, see *Ex parte* Smith (1880), 17 O. G. 447.

[4] That an application is pending until the patent has been recorded, and up to that time it may be put in interference, whatever orders or payments may have been made, see *Ex parte* Osgood (1885), 33 O. G. 1265.

That the patent will not be withheld, after payment of the final fee, for the purpose of declaring an interference with a new conflicting application filed after a judgment for the patentee in a former interference, see Wright *v.* Reese (1877), 11 O. G. 329.

That no delay in interference proceedings against the consent of the applicant can abandon the application, see Taylor *v.* Shreffler (1883), 24 O. G. 1175; Weston *v.* White (1876), 13 Blatch. 447; 2 Bann. & A. 364.

§ 613. [1] That the doctrine of *res adjudicata* applies to proceedings in the Patent Office, see *Ex parte* Burge (1877), 13 O. G. 498; Whitely *v.* McCormick (1876), 10 O. G. 826.

That an interference-judgment is binding in interference cases in the Patent Office, though it may not be in the courts, see Nicholson *v.* Bennett (1879), 16 O. G. 631.

That an interference-judgment is conclusive in the Office upon all points which might by due diligence have been presented at the hearing, except in special cases, see Whitely *v.* McCormick (1876), 10 O. G. 826; Harlow *v.* Guernsey (1875), 7 O. G. 513.

[2] That a judgment in one interference can only indirectly affect others, see *Ex parte* Hedderwick (1879), 15 O. G. 472.

That the decision of the Chief Justice of the District of Columbia on an appeal under the act of 1839 did not prevent the declaration of an interference between the prevailing party and

upon equal ground, and the defeated claimants may be heard, like any other persons, in denial of the claims of the successful party, or in affirmation of their own.[3] The judgment of the Patent Office in an interference is, however, noticed by the courts as an indication that priority is justly claimed by the prevailing party till the contrary appears, and has been held to be a sufficient reason for granting him an injunction forbidding the infringement of his patent by the others until the controversy can be legally determined.[4]

other applications, see Potter *v.* Dixon (1863), 2 Fisher, 381 ; 5 Blatch. 160.

That a patent does not issue as of course upon a decision in interference for one party, see Potter *v.* Dixon (1863), 2 Fisher, 381 ; 5 Blatch. 160.

[3] In Union Paper Bag Machine Co. *v.* Crane (1874), 1 Bann. & A. 494, Lowell, J. : (495) "The decision of the Patent Office is never final upon the question of the novelty or priority of an invention. The rule may have been adopted at first from a consideration of the *ex parte* character of the proceedings at Washington, but it has never been confined, as is now maintained by the complainant, to cases in which no contest was had ; and it is obvious that it cannot be so limited, because, if one party to an interference is concluded as against the other party, the result may be that a patent is valid as against him, which is void as against all the rest of the world." 6 O. G. 801 (801), Holmes, 429 (430).

See also Minneapolis Harvester Works *v.* McCormick Harvester Mach. Co. (1886), 37 O. G. 506 ; 28 Fed. Rep. 565 ; Celluloid Mfg. Co. *v.* Chrolithion Collar & Cuff Co. (1885), 24 Fed. Rep. 275 ; 32 O. G. 883 ; Whipple *v.* Miner (1883), 15 Fed. Rep. 117 ; 23 O. G. 2236 ; Perry *v.* Starrett (1878), 14 O. G. 599 ; 3 Bann. & A. 485.

That an interference-judgment between a patent and a later application is never conclusive on the patentee, see Perry *v.* Starrett (1878), 3 Bann. & A. 485 ; 14 O. G. 599.

That a decision in an interference against a patentee does not bar him from suing to have the other's patent annulled, see Hubel *v.* Tucker (1885), 23 Blatch. 297 ; 27 Fed. Rep. 701.

That an interference-judgment is not conclusive except as to priority between the same parties, and on them only when they accept and act upon it, see Peck, Stow, & Wilcox Co. *v.* Lindsay (1879), 18 O. G. 68 ; 2 Fed. Rep. 688 ; 5 Bann. & A. 390.

That an interference-judgment is *res adjudicata* between the parties, see Shuter *v.* Davis (1883), 16 Fed. Rep. 564 ; 24 O. G. 303.

[4] That the decision of the Commissioner on priority, though not conclusive, is of great weight, see Gloucester Isinglass & Glue Co. *v.* Brooks (1884), 19 Fed. Rep. 426.

That an interference decision not appealed from is not conclusive on the parties but raises a strong presumption against the defeated party, see Kirk *v.* Du Bois (1887), 42 O. G. 297.

That an interference-judgment raises no presumption against any one but the defeated party and his privies, see Edward Barr Co. *v.* N. Y. & N. H. Automatic Sprinkler Co. (1887), 32 Fed. Rep. 79.

That an interference-judgment is ground for an injunction in favor of the successful against the defeated party,

§ 614. Interference Proceedings: Estoppel.

The doctrine of estoppel is also enforced in the Patent Office.[1] A party may be estopped either by his acts or admissions in relation to the matter in dispute, as against all other parties whose conduct in regard to the same matter has been based in good faith on his own.[2] A concession of priority binds him who makes it as to the pending proceedings and in favor of the other parties to the interference, and after such concession he cannot claim a new interference either upon the same grounds or on any other grounds which might have been taken advantage of in such proceedings.[3] A device once contended for in an interference as material and patentable in the form in which it is presented in the application cannot afterwards be claimed by the same party to have been insufficiently or erroneously described.[4] But the doctrine is confined within the narrow limits here specified, and is not applied in favor of third parties nor in reference to other controversies than the one to which the act or the admission specially relates.[5]

see Celluloid Mfg. Co. *v.* Chrolithion Collar and Cuff Co. (1885), 24 Fed. Rep. 275; 32 O. G. 383; Smith *v.* Halkyard (1883), 16 Fed. Rep. 414; 23 O. G. 1833. See also § 1183 and notes, *post.*

That the concurrent judgment of the examiner of interferences and the board of examiners is of great weight, but not conclusive, see Sellers *v.* Walter (1886), 37 O. G. 1001.

That the defeated party in an interference has the burden of proof in any future controversy as to priority, see Wire Book Sewing Mach. Co. *v.* Stevenson (1882), 15 Phila. 481; 11 Fed. Rep. 155.

§ 614. [1] That the doctrine of estoppel applies in interference cases, see Berry *v.* Stockwell (1876), 9 O. G. 404; *Ex parte* Roe (1874), 5 O. G. 397.

[2] That a party to an interference is not estopped by his conduct or admissions, unless the other party has been induced to act on them in relation to the invention in controversy, see Taylor *v.* Bourguignon (1879), 16 O. G. 958.

[3] That a concession of priority binds the parties to the interference, see Burgess *v.* Wetmore (1879), 16 O. G. 765.

That a party, having conceded priority to his rival, and the patent having issued on such concession, cannot claim a new interference on the same grounds or on any which might have been advanced at the former hearing, see Harlow *v.* Guernsey (1875), 7 O. G. 513.

[4] That a device, once contended for in an interference, cannot afterwards be declared by the contestants to have been erroneously or insufficiently described in the application, see *Ex parte* Kirby (1879), 16 O. G. 1095.

[5] That the defeated party in an interference is not estopped from objecting to the patent of his rival on the ground of want of novelty, see Smith *v.* Halkyard (1883), 16 Fed. Rep. 414; 23 O. G. 1833.

§ 615. Interference Proceedings: New Trials.

New trials are granted in the Patent Office for the same reasons and with the same restrictions as in other judicial tribunals.[1] The principal grounds for a new trial are the discovery of new evidence, fraud, or mistake of the tribunal on the former trial as to the real points at issue.[2] A new trial will be granted on the ground of newly discovered evidence only when the evidence is important, was not previously procurable by the use of due diligence, is not cumulative, proves a new and independent fact, and has become known to the party since the former trial.[3] If the petitioner failed to employ reasonable diligence in ascertaining the necessity for such evidence and in procuring it before the former trial, or if he were put on inquiry by evidence already given and failed to make the proper application for a continuance in order to secure it if he found it necessary to his case, or if the evidence in itself would manifestly not change the result, his prayer must be denied.[4] No new trial can be permitted

§ 615 [1] That new trials in the Patent Office are governed by the same rules as in the courts, see Stevens *v.* Putnam (1880), 18 O. G. 519; Wicks *v.* McAvoy (1880), 18 O. G. 859; *contra*, Eccard *v.* Drawbaugh (1883), 24 O. G. 301.

That the Commissioner cannot rehear matters adjudged by his predecessors, except on new facts or by way of new trial, see Lee *v.* Walsh (1879), 15 O. G. 563.

[2] That no rehearing in an interference will be allowed, except on such grounds as give the right to a new trial, see *Ex parte* Pattee (1872), 2 O. G. 618.

That a new trial may be granted on the ground of fraud or newly discovered evidence, though a patent has already been awarded to the former successful party, see Hibbard *v.* Richmond (1880), 17 O. G. 1155; Richmond *v.* Hibbard (1879), 16 O. G. 908.

[3] That a new trial for newly discovered evidence will be granted only when the evidence is (1) important; (2) not previously procurable by due diligence; (3) not cumulative; (4) *proves a new and independent fact*; and (5) became known to the party since the former trial, see Stevens *v.* Putnam (1880), 18 O. G. 519.

[4] That no new trial will be granted for new evidence unless due diligence had been used, see Rogers *v.* Bear (1879), 16 O. G. 908.

That no rehearing will be granted unless the new evidence will fix the date conclusively, see Eccard *v.* Drawbaugh (1883), 24 O. G. 301.

That where the new evidence will not change the result, or where the party was put on inquiry by the evidence already given, and might have procured that now offered as new evidence, a new trial will be denied, see Josselyn *v.* Swezey (1879), 15 O. G. 702.

That where the new evidence is really important its recent discovery

on the ground of ignorance, inadvertence, or mistake of the party or his counsel, or of surprise in matters of law, or of misstatements of attorneys, or of the omission of the former tribunal to give due weight to the evidence admitted or to conform its decision to evidence excluded as inadmissible.[5] A new trial for a judgment against evidence will not be allowed unless the judgment is either wholly unsupported by, or is in direct conflict with, the evidence received.[6] The right to a new trial may be forfeited by an unreasonable delay.[7] The decision of the examiner on an application for a new trial may be revised by the Commissioner; and where sufficient ground appears for granting it a new interference may be declared, and the question of priority again investigated, although the prevailing party on the former hearing has already received his patent.[8]

and former diligence of the applicant are not necessary, see Eccard *v.* Drawbaugh (1883), 24 O. G. 301.

That a new trial will not be granted on the ground that the former evidence was taken pending a motion to dissolve the interference, see Dubois *v.* McCloskey (1880), 17 O. G. 1158.

That *on a motion for a rehearing* evidence which might have been produced on the original hearing will not be regarded unless satisfactory reasons for not then producing it are given, see Burdsall *v.* Curran (1887), 42 O. G. 1167.

[5] That ignorance, inadvertence, or mistake of a party or his counsel, or surprise in matters of law, are not grounds for new trial, see Dod *v.* Cobb (1876), 10 O. G. 462.

That a misstatement by counsel in argument is not ground for new trial, see Wicks *v.* McAvoy (1880), 18 O. G. 859.

That the court below mistook the issue, and did not give due weight to certain evidence, is ground for appeal, not new trial, see Slade *v.* Blair (1879), 15 O. G. 830.

That a case decided in spite of evidence offered and excluded as inadmissible will not be re-opened to let in other evidence to establish the same fact, see Farcot *v.* Rice (1879), 15 O. G. 563.

[6] That a rehearing will be granted where there has been a manifest error as to the real question at issue, see Hull *v.* Lowden (1881), 20 O. G. 741.

That the *concurrent decisions of* lower tribunals on questions of fact will be set aside only for evident error, see Hazelip *v.* Richardson (1876), 10 O. G. 747.

That *on a motion* for new trial the question is whether the former findings are either wholly unsupported by, or clearly in conflict with, the evidence, see Gardner *v.* Dudley (1880), 18 O. G. 683.

[7] That the right to new trial may be lost by laches, see Jones *v.* Greenleaf (1879), 15 O. G. 560.

That the right to a rehearing or new trial is waived by an appeal, though the appellate court has no jurisdiction, see Gill *v.* Scott (1884), 29 O. G 949.

[8] That the declaration of a new interference is governed by the same rules as a new trial, see Marsh *v.* Dodge (1872), 2 O. G. 643.

§ 616. Interference Proceedings: Parties to: Assignees.

The parties to an interference are usually the rival inventors themselves, and from the nature of the case and the required proceedings no interference can be properly conducted without their participation. But when an inventor is unable or refuses to prosecute or defend his own claims to priority, or whenever the ends of justice would be otherwise defeated, an assignee may be permitted to protect his rights in the invention as a party to the interference, upon motion duly made to the Commissioner and satisfactory evidence that the necessity for such permission actually exists.

SECTION XI.

OF THE FORM AND EFFECT OF LETTERS-PATENT.

§ 617. Issue of Patent is a Judgment that all Prerequisites are Fulfilled.

The issue of letters-patent is a judgment that all prerequisites have been performed, and that all the conditions necessary to the granting of a patent privilege have been fulfilled.[1] Upon mere formal matters this judgment is final.[2] Upon questions relating to the merits of the invention and the title of the patentee it is *prima facie* correct, and casts the burden of proof upon any one who controverts the presumption raised by the patent.[3] Upon material points concerning the regu-

§ 617. [1] That the issue of a patent is a judgment that all the facts entitling the patentee to the patent do exist, see Konold *v.* Klein (1878), 3 Bann. & A. 226.

[2] That the decision of the Commissioner is final as to the sufficiency of all formal acts and proofs prerequisite to a patent, see Mahn *v.* Harwood (1884), 112 U. S. 354; 30 O. G. 657; U. S. Rifle & Cartridge Co. *v.* Whitney Arms Co. (1877), 14 Blatch. 94; 11 O. G. 373; 2 Bann. & A. 493.

That after the patent issues the Patent Office cannot inquire whether the patentee made a false oath, see *Ex parte* Gillen (1877), 11 O. G. 419.

[3] That the issue of the patent constitutes *prima facie* evidence of all facts entitling the patentee to the grant, see Eagleton Mfg. Co. *v.* West, Bradley, & Cary Mfg. Co. (1880), 17 O. G. 1504; 18 Blatch. 218; 2 Fed. Rep. 774; Konold *v.* Klein (1878), 3 Bann. & A. 226; Sands *v.* Wardwell (1869), 3 Clifford, 277; Philadelphia & Trenton R. R. Co. *v.* Stimpson (1840), 14 Peters, 448; 2 Robb, 46.

That the decision of the Commissioner is never conclusive on a question

larity of the proceedings in the Patent Office it is so far conclusive that the patent cannot be collaterally attacked upon such grounds, although they may present reasons for its repeal on a bill in equity, or an information.[4]

§ 618. Protest against the Issue of Letters-Patent.

A protest against the issue of a patent may be filed by any person, though not a party to the application nor otherwise connected with the proceedings, for the purpose of calling the attention of the Patent Office to objections urged against the application, or of asserting or saving his own rights as a claimant of the invention. In reference to the objections stated in such protest the Commissioner may take whatever action he deems necessary. As a notice to the Office of the claims of the protestant, it may furnish evidence in some future controversy to rebut presumptions of abandonment or acquiescence in the issue of the patent to another claimant. The protest must show that an application has been or will be filed, and that the protestant's knowledge of the existence of such application has been lawfully obtained through its voluntary communication to him by the applicant.[1]

§ 619. Letters-Patent, to whom Issued.

The grantee of a patent is usually the applicant himself. But when an inventor dies pending his application, the patent

of law, see Gardner *v.* Herz (1886), 118 U. S. 180; 35 O. G. 999; Mahn *v.* Harwood (1884), 112 U. S. 354; 30 O. G. 657.

That the decision of the Commissioner is not conclusive upon questions of abandonment or other matters relating to the merits, see Planing Mach. Co. *v.* Keith (1879), 101 U. S. 479; 17 O. G. 1031; Wilson *v.* Barnum (1849), 2 Fisher, 635; 1 Wall. Jr. 347; 2 Robb, 749. See also § 578 and notes, *ante*.

That the decision of the Commissioner is not conclusive on any question on which a defence in the courts may be based under the statutes, see Mahn *v.* Harwood (1884), 112 U. S. 354; 30 O. G. 657.

[4] That the regularity of a patent cannot be collaterally attacked, see Hoe *v.* Cottrell (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256; Doughty *v.* West (1869), 6 Blatch. 429; 3 Fisher, 580.

See also, as to all the matter of this paragraph, §§ 423, 451, and notes, *ante*, and §§ 967, 1016, 1032, and notes, *post*. As to whether and when a patent can be repealed, see §§ 716–730 and notes, *post*.

§ 618. [1] That a protest against the issue of a patent can be made only under the rules of the Patent Office, and must show that an application has been, or is about to be, filed and that the protestant's knowledge of it has been lawfully acquired, see *Ex parte* Neale (1879), 15 O. G. 511.

issues to his executor or administrator, in trust for his heirs at law or devisees. When an applicant assigns the whole interest in the expected patent or the entire invention, the patent will be granted to the assignee upon the request of the applicant; and when the assignment transfers only an undivided interest, the patent will, upon a similar request, be awarded jointly to the original applicant and the assignee. To secure the issue of the letters-patent to an assignee, either as the sole or part owner of the invention, however, the assignment must contain an express petition to that effect, and must be received at the Patent Office for record at a date not later than the day on which the final fee is paid.[1]

§ 620. Form and Contents of Letters-Patent.

The patent itself is exceedingly brief and simple. It consists of a short title or description of the invention, correctly indicating its nature and purpose, and a grant to the patentee, his heirs or assigns, of the exclusive right to make, use, and vend the invention described in the title and the annexed specification throughout the United States and its territories during the period prescribed by law. No recital of proceedings in the Patent Office is required, all presumptions being in favor of their correctness;[1] but a copy of the specification and drawings is appended to and is by law made part of the grant.[2] All patents issue in the name of the United States, under the seal of the Patent Office, and must be signed by the Secretary of the Interior and countersigned by the Commissioner. This signature of the Secretary is essential to the validity of the patent, and a patent accidentally issued without it cannot be amended after his term of office has expired.[3]

§ 619. [1] For the matter of this paragraph see also §§ 367, 368, 403–414, and notes, *ante*, and §§ 769–772, 800–802, 836, 844, and notes, *post*.

§ 620. [1] That a patent need not recite that the prerequisites have been fulfilled, see Gear *v.* Grosvenor (1873), Holmes, 215; 6 Fisher, 314; 3 O. G. 380; Philadelphia & Trenton R. R. Co. *v.* Stimpson (1840), 14 Peters, 448; 2 Robb, 46.

[2] That the specification might have been made part of the patent before 1836, at the request of the patentee, see Hogg *v.* Emerson (1850), 11 How. 587.

That under the act of 1790 the allegations of the petition were recited in the patent, see Evans *v.* Chambers (1807), 2 Wash. 125; 1 Robb, 7.

[3] That a patent is not valid unless signed by the Secretary, and if accidentally issued without his signature it

The patent is not complete until duly sealed; but when allowed and signed it is the duty of the Commissioner to affix the seal, unless it is evident to him that the issue of the patent would be contrary to law.

§ 621. Date and Delivery of Letters-Patent.

Every patent must bear date as of a day not later than six months from the allowance of the application and the mailing of the notice and request for the final fee. On payment of the fee the patent is prepared for issue, and receives its date and number, and is delivered to the patentee or his attorney, as the attorney may direct. In no case can a patent be antedated.[1] It takes effect as the grant of an exclusive privilege from the date of issue, although as evidence of an inventive act, and for many other purposes, it relates back to the date of the application upon which it is based.[2]

cannot be amended by his successor, see Marsh *v.* Nichols (1883), 15 Fed. Rep. 914; 24 O. G. 901.

That it is doubtful whether a patent issued without the signature of the Secretary becomes good from the date of his subsequently signing it, see Marsh *v.* Nichols (1883), 24 O. G. 901; 15 Fed. Rep. 914.

That the omission of the Secretary's signature cannot be aided by showing the *perfect patent on the record* (an imperfect grant not being saved by a perfect record), nor be amended by his successor though he were the Acting Secretary when the omission occurred, nor be cured by affixing the true signature after the Secretary's official term has expired, see Marsh *v.* Nichols (1883), 24 O. G. 901; 15 Fed. Rep. 914. See also McGarrahan *v.* Mining Co. (1877), 96 U. S. 316; Goodman *v.* Randall (1877), 44 Conn. 321.

§ 621. [1] That under the present law a patent cannot be antedated, see Gramme Electrical Co. *v.* Arnoux & Hochhausen Electric Co. (1882), 17 Fed. Rep. 838; 21 Blatch. 450; 25 O. G. 193.

That prior to 1836 a patent could not be antedated, see Opinion Atty. Gen. (1820), 5 Op. At. Gen. 722.

That under the acts of 1861 and 1836, a patent could be dated from the filing of the specification, if not preceding its issue more than six months, see Burdett *v.* Estey (1880), 3 Fed. Rep. 566; 19 Blatch. 1.

[2] That a patent takes effect from the date of the grant, see Gramme Electrical Co. *v.* Arnoux & Hochhausen Electric Co. (1883), 17 Fed. Rep. 838; 25 O. G. 193; 21 Blatch. 450.

That a patent may not always take its date from the day when it begins to run, as when it begins from the date of a foreign patent, see De Florez *v.* Raynolds (1880), 17 O. G. 503; 17 Blatch. 436; 8 Fed. Rep. 434; 5 Bann. & A. 140.

That a patent relates back to the date of the application, see Johnsen *v.* Fassman (1872), 5 Fisher, 471; 2 O. G. 94; 1 Woods, 138.

That in the absence of all other proof the date of the patent will be assumed to be the date of the application and of

§ 622. Term of Patent Privilege Limited by Express Statute or by Foreign Patents.

The term of a patent is measured by the statute, not by the language of the grant.[1] Where the invention has not been previously patented in a foreign country, the term is uniformly fixed at seventeen years from the date of the grant.[2] But where a foreign patent has already been obtained, a different rule has been adopted. It is the policy of our government not to impose upon our own public a greater restriction than has been or may be placed upon a foreign people in the use of the invention; and where the invention has been disclosed abroad by a patent, and will become the property of the foreign public after a given period of time, it is the purpose of our statutes to permit no more extended monopoly to the inventor in the United States. Various rules have been from time to time established to secure this result. Under the act of 1836 a foreign patent was a bar to a domestic application unless it had been granted and published within six months preceding the filing of the latter, thus making the terms of both substantially the same.[3] The act of

an assignment before patent, see Worley *v.* Loker Tobacco Co. (1882), 104 U. S. 340; 21 O. G. 559.

That a patent on a renewal application is to be dated six months after the renewal application is allowed, see Thomson *v.* Waterhouse (1884), 30 O. G. 177.

§ 622. [1] That the statute, not the language of the patent, limits its term, see De Florez *v.* Raynolds (1880), 17 O. G. 503; 8 Fed. Rep. 434; 17 Blatch. 436; 5 Bann. & A. 140.

That the patent ought to express its actual duration, see Opinion Sec. Int. (1882), 21 O. G. 1197.

That Sec. 4887 does not require that the term of a patent shall be correctly stated in the patent itself, but only limits the term, and the grant of a patent for seventeen years, therefore, does not prevent it from expiring with a prior foreign patent, see Canan *v.* Pound Mfg. Co. (1885), 31 O. G. 119; 23 Blatch. 173; 23 Fed. Rep. 185.

That a domestic patent is valid, though its term is not expressly limited to that of a foreign patent, see American Paper Barrel Co. *v.* Laraway (1886), 28 Fed. Rep. 141; 37 O. G. 674.

That in the absence of fraud the date of a patent may be altered to correspond with that of a foreign patent, see Opinion Atty. Gen. (1844), 4 Op. At. Gen. 335.

[2] That under the act of 1861 patents "remain in force" seventeen years, not run seventeen years from the date of the patent, see De Florez *v.* Raynolds (1880), 17 O. G. 503; 8 Fed. Rep. 434; 17 Blatch. 436; 5 Bann. & A. 140.

[3] That under the act of 1836 a foreign patentee applying for a domestic patent, within the time prescribed, could enjoy the full statutory term, see American Diamond Rock Boring Mach. Co. *v.* Sheldon (1879), 17 Blatch. 303.

1839 provided that the term of the American patent should be limited to fourteen years from the date or publication of the foreign patent, thereby delivering the invention from the protection of the patent at the time when it would have come into the possession of the public if the American and foreign patents had been simultaneously issued.[4] Under the act of 1861 the period of seventeen years was substituted for that of fourteen years in this as well as in those cases where no previous foreign patent had been granted.[5] In 1870 the present law was enacted, requiring the term of the American patent to be so limited as to expire at the same time with the foreign patent; or, if there be more than one, with that having the shortest term, but in no case to be more than seventeen years.[6]

[4] That under the act of 1839 the inventor might have a patent for the full term, though a prior foreign patent had been granted within six months, see Kendrick *v.* Emmons (1875), 2 Bann. & A. 208; 9 O. G. 201.

That before the act of 1861 patents were not limited by the term of a foreign patent, see Goff *v.* Stafford (1878), 14 O. G. 748; 3 Bann. & A. 610.

That the act of 1839 did not apply to cases where the foreign specification was filed less than six months before the application in the United States, see American Diamond Rock Boring Mach. Co *v.* Sheldon (1879), 17 Blatch. 303.

[5] That the act of 1861 does not repeal the provisions of the act of 1839 on this subject, but modifies them to make the term seventeen instead of fourteen years, see *Ex parte* Siemens (1877), 11 O. G. 1107.

That under the act of 1861 the American patent was limited to seventeen years from the date of the previous foreign patent, see Guarantee Insurance, Trust, & Safe Deposit Co. *v.* Sellers (1887), 41 O. G. 1165; Siemens *v.* Sellers (1883), 16 Fed. Rep. 856; 23 O. G. 2234; 16 Phila. 554; De Florez *v.* Raynolds (1880), 17 O. G. 503; 8 Fed. Rep. 434; 17 Blatch. 436; 5 Bann. & A. 140; Nathan *v.* N. Y. Elevated R. R. Co. (1880), 2 Fed. Rep. 225; 5 Bann. & A. 280.

That the act of 1861 caused the domestic patent to expire seventeen years from the date when the prior foreign patent took effect in favor of the patentee, see De Florez *v.* Raynolds (1880), 17 O. G. 503; 8 Fed. Rep. 434; 17 Blatch. 436; 5 Bann. & A. 140.

That the act of 1861 changes the date when the term ends, not the date of its beginning, see Guarantee Insurance, Trust, & Safe Deposit Co. *v.* Sellers (1887), 41 O. G. 1165.

[6] That the act of 1870 causes an American patent to expire at the same date with the shortest foreign patent that was granted before the grant of the American patent, see Gramme Electrical Co. *v.* Arnoux & Hochhausen Electric Co. (1883), 21 Blatch. 450; 17 Fed. Rep. 838; 25 O. G. 193; Koechlin *v.* Marble (1882), 2 Mackay, 12; 22 O. G. 1365; Henry *v.* Providence Tool Co. (1878), 14 O. G. 855; 3 Bann. & A. 501.

That the foreign patent limits the domestic, though the applicant here is the foreign patentee or some one to

§ 623. Term of Patent Privilege: When Limited by Foreign Patents.

In order that the term of the foreign patent may thus limit that of the domestic patent, it is essential that the inventions covered by the two patents should be identical,[1] and that the foreign patent should take effect before the issue of the domestic patent. The foreign patent takes effect when it is so issued as to create a monopoly in favor of the inventor, whether the patent is then disclosed to the general public or

whom the inventor caused the foreign patent to be granted, or is an American citizen, see Edison Electric Light Co. *v.* U. S. Electric Lighting Co. (1888), 43 O. G. 1456.

That the act of 1870 was not retroactive and did not apply to previous American patents or their re-issues, see Anilin *v.* Hamilton Mfg. Co. (1878), 3 Bann. & A. 235; 13 O. G. 273; Goff *v.* Stafford (1878), 3 Bann. & A. 610; 14 O. G. 748.

That an American patent cannot run over seventeen years, and will expire with any shorter prior foreign patent, see Weston *v.* White (1876), 9 O. G. 1196; 13 Blatch. 364; 2 Bann. & A. 321.

That to limit the term of a domestic by that of a foreign patent is to make both expire at the same time, see *Ex parte* Siemens (1877), 11 O. G. 969.

That the same rule applies when a single American patent covers several inventions separately patented abroad, see *Ex parte* Unsworth (1879), 15 O. G. 882.

§ 623. [1] That an American patent is not limited by the term of a foreign patent unless the inventions are identical, see Siemens *v.* Sellers (1883), 16 Phila. 554; 23 O. G. 2234; 16 Fed. Rep. 856; *Ex parte* Siemens (1877), 11 O. G. 969.

That the invention covered by a domestic patent will be the same as that covered by a foreign patent when the principle is the same though it may be improved, and in this case the term of the whole patent is that of the foreign patent, see Guarantee Insurance, Trust, & Safe Deposit Co. *v.* Sellers (1887), 41 O. G. 1165.

That a domestic patent is not limited by a foreign patent unless the latter claims as well as describes the same invention, see Holmes Electric Protective Co. *v.* Metropolitan Burglar Alarm Co. (1884), 22 Fed. Rep. 341; 32 O. G. 384.

That a patent which is a mere adaptation of a foreign patent expires at the same time, though some slight improvement be embraced in it, see Clark *v.* Wilson (1886), 28 Fed. Rep. 95; 36 O. G. 456.

That if the foreign invention would be enjoined as an infringement of the domestic patent it is the same, see Commercial Mfg. Co. *v.* Fairbank Canning Co. (1886), 27 Fed. Rep. 78; 36 O. G. 1473.

That if a representation in an application that the invention is identical with that covered by a foreign patent is made in good faith it does not estop the applicant from subsequently denying it, see Commercial Mfg. Co. *v.* Fairbank Canning Co. (1886), 27 Fed. Rep. 78; 36 O. G. 1473.

That the validity of a domestic patent cannot depend on that of a foreign patent, though its duration may, see Cornely *v.* Marckwald (1883), 21 Blatch. 367; 24 O. G. 498; 17 Fed. Rep. 83.

is by law confined to the knowledge of a certain class of persons.[2] It has been held in several cases that the foreign patent must have issued before the filing of the application in the United States;[3] but this doctrine was not consistent with the purpose of the rule, and later cases have therefore decided that it is sufficient if the foreign patent take effect before the actual grant of the domestic.[4] Where both are

[2] That the date of a foreign patent, a complete specification, having the effect of a patent, is filed, see Emerson *v.* Lippert (1887), 42 O. G. 964; 31 Fed. Rep. 911.

That under the act of 1861 when the domestic patent was applied for before the English provisional specification was filed, and was dated before the English patent was sealed (though the latter was dated earlier than the American patent), the term of the American patent was not limited by the English, see Gold & Stock Telegraph Co. *v.* Commercial Telegram Co. (1885), 23 Blatch. 199; 23 Fed. Rep. 340; 31 O. G. 1558.

That a Canadian patent takes effect when signed, sealed, and registered, not from its delivery, see Bate Refrigerating Co. *v.* Gillett (1882), 22 O. G. 1205; 13 Fed. Rep. 553.

That a Canadian patent takes effect from its date, though withheld from delivery on account of non-fulfilment of conditions, see Bate Refrigerating Co. *v.* Gillett (1887), 31 Fed. Rep. 809; 40 O. G. 1029.

[3] That the rule limiting the term of an American patent by that of a foreign patent does not apply to cases where the American patent was applied for before the issue of the foreign patent, see *Ex parte* Mann (1880), 17 O. G. 330; French *v.* Rogers (1851), 1 Fisher, 133.

That when a foreign patent is granted on the day the application is filed in the United States, it does not limit the American patent, see *Ex parte* Mann (1880), 17 O. G. 330.

[4] In Gramme Electrical Co. *v.* Arnoux & Hochhausen Electric Co. (1883), 17

when controlling the term of an American patent, is the date of its issue or publication as a patent, see De Florez *v.* Raynolds (1880), 17 O. G. 503; 17 Blatch. 436; 8 Fed. Rep. 434; 5 Bann. & A. 140; Weston *v.* White (1876), 13 Blatch. 364; 9 O. G. 1196; 2 Bann. & A. 321.

That an English "complete specification" gives the same protection as if the patent were already issued, see Emerson *v.* Lippert (1887), 31 Fed. Rep. 911; 42 O. G. 964.

That the foreign patent limits the domestic whether it be open or secret, see Gramme Electrical Co. *v.* Arnoux & Hochhausen Electric Co. (1883), 17 Fed. Rep. 838; 21 Blatch. 450; 25 O. G. 193.

That no English patent is complete until the final specification is enrolled, see Coburn *v.* Schroeder (1882), 22 O. G. 419; 20 Blatch. 392; 11 Fed. Rep. 425; Lorillard *v.* Dohan (1881), 20 O. G. 1587; 20 Blatch. 63; 9 Fed. Rep. 509; Bell *v.* Brooks (1881), 19 O. G. 290; *Ex parte* Mann (1880), 17 O. G. 330; American Diamond Rock Boring Mach. Co. *v.* Sheldon (1879), 17 Blatch. 303; Chambers *v.* Duncan (1876), 10 O. G. 787; Chambers *v.* Duncan (1876), 9 O. G. 741.

That an English provisional specification is not a patent, see Emerson *v.* Lippert (1887), 42 O. G. 964; 31 Fed. Rep. 911.

That a domestic patent is not limited by an English patent unless the latter is sealed before the former is issued, whatever date the latter may bear, or unless

granted on the same day, the domestic patent is regarded as the older, and its term is unaffected by that of the foreign patent.[5]

§ 624. Term of Patent Privilege: How Limited by Foreign Patents.

The term to which the American patent is thus restricted is the term of the original foreign patent.[1] Where the laws

Fed. Rep. 838, Blatchford, J.: (840) "The meaning of section 25 of the act of 1870 is that the United States patent shall expire at the same time with the foreign patent having the shortest time to run, which was granted before the United States patent was granted, and not that it shall expire at the same time with the foreign patent having the shortest time to run, which was granted before the time when the application for the United States patent was made." 21 Blatch. 450 (452); 25 O. G. 193 (194).

See also Bate Refrigerating Co. *v.* Gillett (1882), 13 Fed. Rep. 553; 22 O. G. 1205.

That the term of a domestic patent will be limited by that of a foreign patent granted pending the application for the domestic patent, see Bate Refrigerating Co. *v.* Gillett (1887), 31 Fed. Rep. 809; 40 O. G. 1029.

That where a foreign patent is applied for after the application for a domestic patent, but is granted before the issue of the domestic, it will still limit the duration of the latter, see Gramme Electrical Co. *v.* Arnoux & Hochhausen Electric Co. (1883), 21 Blatch. 450; 25 O. G. 193; 17 Fed. Rep. 838.

That the term of an American patent will be limited by that of a prior foreign patent, though the American application had been filed and the invention put in use in the United States before the foreign application was made, see Edison Electric Light Co. *v.* U. S. Electric Lighting Co. (1888), 43 O. G. 1456.

That where an application in the United States antedates an application in England, and the American patent issues before the English patent is sealed, or a complete specification is filed, the latter has no effect on the term of the former, see Emerson *v.* Lippert (1887), 42 O. G. 964; 31 Fed. Rep. 911.

[5] That where domestic and foreign patents are granted, or applications are filed, on the same day, the foreign are not prior to the domestic, see *Ex parte* Mann (1880), 17 O. G. 330.

§ 624. [1] That the term of the American patent should be fixed by ascertaining how long the foreign patent, as originally granted, was to run after the issue of the domestic, see Paillard *v.* Bruno (1886), 38 O. G. 900; 29 Fed. Rep. 864; *Ex parte* Siemens (1877), 11 O. G. 969.

That the term of a foreign patent, so far as it affects that of a domestic patent, is the term for which it is originally granted, whether it be extended or not, or forfeited for non-payment of periodical fees or not, or increased in statutory duration by subsequent legislative action, see Bate Refrigerating Co. *v.* Gillett (1887), 31 Fed. Rep. 809; 40 O. G. 1029.

That if a foreign patent, limiting the term of a domestic patent, is vacated *ab initio*, the domestic patent is not limited thereby, see Bate Refrigerating Co. *v.* Gillett (1887), 31 Fed. Rep. 809; 40 O. G. 1029.

of the country in which it was issued permit of its extension, this capability of extension forms no part of the grant. Its actual term as specified in the original letters-patent measures the life of the domestic patent, and its extension, if it be extended, does not prolong the monopoly in the United States.[2] The same rule prevails where an original patent may be enlarged by new grants as the inventor makes improvements to the original invention, thereby extending indirectly the term of the original. Each of these new grants or additions is considered as a different patent, having its own date of issue and its own term, and thus does not remove the limitation placed by the original patent on the term of the American.[3] Nor on the other hand does the premature expiration of the foreign patent, on account of the failure of the patentee *to* comply with the conditions essential to the completion of its granted term, extinguish the American patent, nor curtail the term fixed for it by the foreign patent at the date when it was issued.[4]

§ 625. Term of Patent Privilege: How Calculated when not Limited by Foreign Patents.

In calculating the term of a patent whose duration is not affected by that of a prior foreign patent, the day of its date

[2] That the capacity of extension is not part of a grant, and a foreign patent measures the domestic by its granted term, not by its possibilities of extension, see *Gramme Electrical Co. v.* Arnoux & Hochhausen Electric Co. (1883), 17 Fed. Rep. 838; 21 Blatch. 450; 25 O. G. 193.

That the extension of a foreign patent does not affect the American, see Paillard *v.* Bruno (1886), 38 O. G. 900; 29 Fed. Rep. 864; Baté Refrigerating Co. *v.* Gillett (1882), 13 Fed. Rep. 553; 22 O. G. 1205; Reissuer *v.* Sharp (1879), 16 O. G. 356; 16 Blatch. 383; 4 Bann. & A. 366; Henry *v.* Providence Tool Co. (1878), 14 O. G. 855; 3 Bann. & A. 501.

[3] That under the French law each "addition" stands by itself like a new patent, and by its own date fixes the term of a subsequent American patent, see De Florez *v.* Raynolds (1880), 17 Blatch. 436; 17 O. G. 503; 8 Fed. Rep. 434; 5 Bann. & A. 140.

[4] That *the forfeiture* of the *foreign* patent by the non-fulfilment of conditions does not affect the duration of the American patent, see Paillard *v.* Bruno (1886), 38 O. G. 900; 29 Fed. Rep. 864.

That under Sec. 4887 the term of a domestic patent is to be equal to the remainder of the term for which the foreign patent was granted, although the latter has been forfeited by not paying a tax or by other subsequent events, see Holmes Electric Protective Co. *v.* Metropolitan Burglar Alarm Co. (1884), 21 Fed. Rep. 458; 22 Blatch. 471; 28 O. G. 1189.

is excluded, and it will expire on the last hour of the same day and month, seventeen years after its issue.[1] Its term is unrestricted by that of any other patents, although the invention described in one patent may be so far dependent on those protected by others as to be incapable of use without them, and thus the public may be debarred from the free employment of any until all the patents have expired.[2] The term of a design patent has a different limitation, such patents being granted for three and a half, seven, or fourteen years, as the inventor may elect.

§ 626. Effect of Clerical Errors in Letters-Patent.

Mere clerical errors in the language of a patent do not affect its validity nor imperil the rights of the patentee. A mistake in his Christian name, or of a single letter in his surname, is of no consequence if he is otherwise sufficiently described; and the same liberal construction prevails in reference to other immaterial defects.[1] Where such mistakes occur through the fault of the Patent Office, they are corrected on the record at the request of the patentee. Errors upon material points must be cured by an amendment of the patent by a re-issue or disclaimer.

§ 625. [1] That a patent expires on the last hour of the same month and day, seventeen years after its issue, see Johnson *v.* McCullough (1870), 4 Fisher, 170.

[2] That separate patents for different inventions, having separate dates, will each expire at the end of its own term, though neither invention is capable of use without the others, see McKay *v.* Dibert (1881), 19 O. G. 1351; 5 Fed. Rep. 587.

But see McKay *v.* Jackman (1882), 20 Blatch. 466; 22 O. G. 85; 12 Fed. Rep. 615.

That where a patent having been issued with its term limited by that of a foreign patent is not accepted by the patentee, and a new patent is then granted for seventeen years, the new patent will run from the date of its issue, not from that of the former patent, see Railway Register Mfg. Co. *v.* North Hudson C. R. Co. (1885), 23 Fed. Rep. 593; 32 O. G. 519.

§ 626. [1] That a mistake in the Christian name of the patentee does not affect the patent, if he is otherwise sufficiently pointed out, see Northwestern Fire Extinguisher Co. *v.* Philadelphia Fire Extinguisher Co. (1874), 1 Bann. & A. 177; 6 O. G. 34; 10 Phila. 227.

That one erroneous letter in the name of the patentee may be of no consequence, see Bignall *v.* Harvey (1880), 18 O. G. 1275; 4 Fed. Rep. 334; 18 Blatch. 353.

§ 627. Recording of Letters-Patent: Copies of the Records.

All letters-patent are recorded, with their specifications, in books kept for that purpose in the Patent Office.[1] The record of a patent, like that of every other instrument which the law requires to be recorded, is constructive notice of its contents to all parties subsequently becoming interested in the invention, and is binding throughout the world.[2] After the patent is recorded, its record, with its specifications, drawings, model, and all other documents relating to the case, are open to general inspection in the Patent Office. No private individual is permitted to make copies or tracings from the files and records of the Office; but certified copies may be obtained by any one who civilly requests them, upon payment of the lawful fees.[3] These copies have the same weight, as evidence in any controversy in the courts or Patent Office, as would be given to the originals themselves.[4]

§ 628. Patented Articles to be Stamped.

The law requires that every patentee and his assigns and legal representatives, and all other persons making or vend-

§ 627. [1] That the grant of a patent is not complete, nor does any title pass, until it is recorded, see *Ex parte* Osgood (1885), 33 O. G. 1265.

That a title by the grant of letters-patent is a title of record, and no delivery is necessary to make it good, see *Ex parte* Osgood (1885), 33 O. G. 1265.

[2] That the record of a patent and its title is notice to all the world, see National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 19 Fed. Rep. 514; 28 O. G. 1007.

That the record of an instrument, which the law does not require to be recorded, is no notice of anything to any person, see Hamilton *v.* Kingsbury (1879), 17 Blatch. 264; 17 O. G. 147.

That where some papers not required to be recorded are recorded and others are not, a person who acts upon those recorded in ignorance of the others is bound by the latter as if they were known, see Hamilton *v.* Kingsbury (1879), 17 Blatch. 264; 17 O. G. 147.

See also § 785 and notes, *post*.

[3] In Boyden *v.* Burke (1352), 14 How. 575, Grier, J.: (583) "These records being in the care and custody of the Commissioner of Patents, it is his duty to give authenticated copies to any person who shall demand the same, as soon as he conveniently can, on payment of the legal fees. Where there is a right on the one side, and a corresponding duty imposed on the ..er, a refusal to perform such duty, on the reasonable request of the party entitled to demand it, will subject the officer to an action."

[4] That copies of the records in the Patent Office are evidence, see Brooks *v.* Jenkins (1844), 3 McLean, 432. See also §§ 1015–1017, and notes, *post*.

That an incorrect transcript from the Patent Office may be corrected by a new transcript, see Brooks *v.* Jenkins (1844), 3 McLean, 432.

ing any patented article for or under them, shall give sufficient notice to the public that such article is patented.[1] This notice may be given by marking the article itself with the word "patented," together with the date of the patent, or where this is impracticable by affixing to the article, or to the package in which it is enclosed for the market, a label containing the same word and date.[2] A failure to comply with this requirement prevents the owner of the patent, in any suit for its infringement, from recovering other than nominal damages against the defendant,[3] unless he can affirmatively prove that in some manner practically equivalent to this the defendant has received notice that his acts were an infringement of the patent, and after such notice has continued in his violation of the plaintiff's rights.[4]

§ 628. [1] That the duty of marking patented articles as "patented" devolves upon the manufacturer, see Wilson *v.* Singer Mfg. Co. (1879), 9 Bissell, 173; 4 Bann. & A. 637; 16 O. G. 1091.

That the object of the statute requiring patented articles to be stamped is to secure the public right to use unpatented articles, and prevent imposition under the claim that the articles have been patented, see Nichols *v.* Newell (1853), 1 Fisher, 647.

That this statute is to be strictly construed, see Wilson *v.* Singer Mfg. Co. (1879), 9 Bissell, 173; 4 Bann. & A. 637; 16 O. G. 1091; United States *v.* Morris (1866), 2 Bond, 23; 3 Fisher, 72.

[2] That where the mark cannot be put on the article itself it may be placed on the package, see Sessions *v.* Romadka (1884), 28 O. G. 721; 21 Fed. Rep. 124.

[3] That unless the evidence shows that the statute has been complied with only nominal damages can be recovered for infringements, see McComb *v.* Brodie (1871), 1 Woods, 153; 5 Fisher, 384; 2 O. G. 117.

That this statute applies to suits in equity as well as at law, see New York Pharmical Association *v.* Tilden (1883), 21 Blatch. 190; 23 O. G. 272; 14 Fed. Rep. 740.

That the failure to stamp prevents recovery of damages, but is no bar to an injunction either preliminary or perpetual, see Goodyear *v.* Allyn (1868), 3 Fisher, 374; 6 Blatch. 33.

That Sec. 13, act March 2, 1861, does not require that the plaintiff's bill in equity aver that his articles were stamped, see Goodyear *v.* Allyn (1868), 3 Fisher, 374; 6 Blatch. 33.

That to prevent a recovery of actual damages by reason of Sec. 13, act March 2, 1861, it must appear either from the bill or the proofs that the patentee has made or sold articles under the patent, see Goodyear *v.* Allyn (1868), 3 Fisher, 374; 6 Blatch. 33.

[4] In New York Pharmical Association *v.* Tilden (1882), 14 Fed. Rep. 740, Wallace, J.: (741) "Patentees are therefore required to give 'sufficient notice to the public' that the article is patented, . . . 'together with the day and year the patent was granted,' by stamping or labelling the article. It is a fair interpretation to hold that when any equivalent notice has been given, the defendant has been 'duly notified.' As

§ 629. Stamping Patented Articles by Infringers Prohibited.

As the complement of the foregoing rule, the law forbids any person, other than the patentee and those who claim or practise the invention under the protection of the patent, to mark on any article made, used, or sold by him the name or imitation of the name of its true patentee, without obtaining his consent or that of his assigns or legal representatives. It also prohibits every one, except with the consent of the true patentee or his assigns or legal representatives, from marking any patented article with the words "patented," "patentee," or "letters-patent," or any word of similar import, with intent to imitate or counterfeit the mark of the real owner of the patent.[1] The object of the first provision

the sufficient notice prescribed includes a specification of the time when the patent was granted, it is reasonable to conclude that any notice, verbal or written, that includes this information, will suffice." 23 O. G. 272 (272); 21 Blatch. 190 (191).

That notice otherwise given is equivalent to a mark on the articles themselves, in its effect on the right to substantial damages, see McComb v. Brodie (1871), 1 Woods, 153; 5 Fisher, 384; 2 O. G. 117.

That under Sec. 4900 no recovery of substantial damages can be had while articles were unstamped unless notice is given or knowledge is possessed by the infringer, and even then he is liable to pay substantial damages only for infringements committed with knowledge or after notice, see Allen *v.* Deacon (1884), 21 Fed. Rep. 122; 10 Sawyer, 210.

§ 629. [1] In Washburn & Moen Mfg. Co. *v.* Haish (1879), 9 Bissell, 141, Blodgett, J.: (142) "I am very clear that the defendant has no right, upon the admitted facts in the case, to mark his goods with any words or terms indicating that they are manufactured under complainant's patent. He has the right, and it is his duty, to mark his goods with his own patent-mark; but this does not give him the right to put upon the goods any *indicia* showing that they are made under another man's patent or a patent which he does not own and has no right to use. Several reasons occur to me why he should not be allowed to do this. In the first place, the owner of a patent has the right to regulate the quality of goods bearing the patent-mark. The value of a patent to its owner may largely depend upon the quality of goods manufactured under it. By manufacturing and selling a poor article purporting to be made under complainant's patent the value of the patent itself may be seriously impaired and the complainant damaged. In the second place, the public would be imposed upon and led to believe that they were purchasing a genuine article made by the patentee or under his patent. This reason applies the more forcibly because the law makes it the duty of a patentee, or those manufacturing goods under a patent, to mark his goods with the word 'patented,' with the date of the patent; and persons purchasing such goods with the belief that they were made and vended by the patentee, or those acting under his license, might be liable for an

of the statute is to protect the patentee and his assignees or licensees against the fraudulent and tortious imitation of his name upon an article apparently made under the monopoly created by his patent. The object of the second is to protect them against the intentional proximate representation of their patent-mark by an infringer. These wrongful acts tend to depreciate the value of the patent by casting doubts upon the scope of the invention, or by enabling the infringer to throw on the market inferior articles under the patent-mark, and thereby destroy the confidence of the public in the utility of the invention. The law cannot permit its own requirement of the patentee to be thus turned into a weapon against him, and hence attaches to these acts a penalty distinct from that which the wrong-doer would incur by a mere infringement.

§ 630. Stamping Unpatented Articles Prohibited.

A third provision of the statute forbids the marking or affixing to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public. The object of this provision is to prevent fraudulent impositions upon the community at large.[1] The fact that an article is patented is an indication to the public of its merit, and tends to promote its sale and use; and the unauthorized mark is thus a false pretence by which the purchaser is liable to be deceived. The marking of an article is also a notice to the public that its manufacture, use, and sale are under the protection of a patent, and cannot be engaged in without the license of the patentee; and if this notice be untrue, the public are fraudulently restricted in the enjoyment of their natural rights. Fraud being thus the gist of the offence forbidden, the penalty is not incurred unless the marking is performed with the intention to deceive.[2] To

action of infringement by the owner of ented" was intended to prevent fraud, the patent; and, thirdly, such an act is a direct violation of the property interest which the law vests in the owner of a patent." 4 Bann. & A. 571 (572); 18 O. G. 465 (465).

§ 630. [1] That the law forbidding the marking of unpatented articles as "pat- see Wilson *v.* Singer Mfg. Co. (1879), 9 Bissell, 173; 4 Bann. & A. 637; 16 O. G. 1091.

[2] In Walker *v.* Hawxhurst (1867), 5 Blatch. 494, Nelson, J.: (495) "The counsel for the plaintiff requested the Court to charge that if the jury be-

mark in joke, or in evident derision, or in the belief that the article comes within the scope of a patent, does not constitute the crime. But where the intent to deceive exists, it is immaterial whether the article is patentable or not, or whether a patent has been applied for and is expected to issue, or how the mark is made and attached to the article, or whether the article is ever sold or offered for sale in the market.[3] Where

lieved that the defendant intended the public to understand, by the words and figures he caused to be put on the article, that he had got a patent for it, he was liable for the penalty. The Court refused so to charge, but charged that if the defendant used the marks, knowing he had no right to, and with the intention of deceiving the public, then he was liable; but if he used them, supposing he had a right to, and with no intention to deceive the public, then he was not liable. I am of opinion that the Court did not err in refusing to charge as requested by the counsel. The request leaves out altogether the element of fraud and deceit, which is clearly, and even in terms, made essential to bring a party within the penalties of the statute. According to the interpretation of the counsel, the simple act of marking the article, indicating that it was patented when it was not, would be sufficient, because of necessity the party must mean and intend that the public should understand what he has thus explicitly expressed. But this is not the statute. The marking must not only give the public to understand the fact of a patent, but the act must be done *malo animo*, with an intent to deceive; and this ingredient of the offence, which is essential to make it complete, must be left to and be found by the jury. The Court, therefore, was right in submitting it to them."

See also Nichols *v.* Newell (1853), 1 Fisher, 647.

That an "intent to deceive" is an intent to make the public believe that the article is covered by a patent, and this intent exists where the party stamps an article without knowing or caring whether or not it is patented, and without an affirmative belief that it is patented, see Tompkins *v.* Butterfield (1885), 25 Fed. Rep. 556; 33 O. G. 758.

That a corporation may violate this act through its officers, see Tompkins *v.* Butterfield (1885), 25 Fed. Rep. 556; 33 O. G. 758.

That where a defendant is proved to have falsely stamped articles with intent to deceive the public, he is guilty of the offence, and no other matter is pertinent, see Kass *v.* Hawlowitz (1885), 33 O. G. 1135.

[3] In Oliphant *v.* Salem Flouring Mills Co. (1878), 5 Sawyer, 128, Deady, J.: (129) "The first two clauses of this section are evidently intended to protect the patentee of a patented article against the fraudulent use of his name or device upon a spurious article, and it is equally manifest that the third clause is intended to protect the public against the fraudulent use of the word 'patent.' What art, machine, composition, process, or result may be patented, is largely a question of fact, which in most cases lies beyond the knowledge or observation of the mass of mankind, the public. To say whether an article is both novel and useful, has 'a sufficiency of invention' to entitle it to be patented, is often a difficult question, and one which in most cases requires the skill and research of experts to determine. It may be useful but not new, or the re-

this intent is wanting, an article manufactured under an ex-

verse, and in neither case is it patentable. But the word 'patent' upon an article is *prima facie* an assertion that it has some peculiar value or merit sufficient to induce the government, upon a thorough examination of the subject, to give the inventor the exclusive right to make and vend the same. The impression which the fact ordinarily makes upon the mind is that the article marked 'patent' is in some respects more useful or desirable than articles of the same general kind or use which are not so marked. If, then, a person marks an unpatented article with the word 'patent,' the public are thereby liable to be deceived as to the character and value of the article. The act is a species of counterfeiting. This being so, the presumption is, until the contrary appears, that the mark was placed on the article with the intention to deceive. The falsehood is a badge of fraud. To my mind it is clear, both upon the reason of the thing and the plain words of the statute, that the penalty is incurred by marking an unpatented article with the word 'patent,' whether the same is patentable or not. The statute is made for the protection of the public, and is intended to prevent unscrupulous persons from *imposing* upon the community by the unauthorized and false use of the word 'patent.' But it must also appear that the article was so falsely marked with intent to deceive the public. Cases may arise in which it is apparent that the marking was done on unpatented articles in jest or ridicule, or as a mere fancy or caprice under such circumstances that it is not possible that any one could be misled or deceived by it. A person might mark his dog or horse with the word 'patent,' but hardly with the intention to make the public believe that either was of any more use or value than any other like animal. And in such an extreme case the Court might be able to say, on demurrer to the complaint, that there could not by any possibility have been any intention to deceive. But in all ordinary cases, or cases in which there can be any doubt about it, the question of fraudulent intent or purpose to deceive is one for the jury. In passing upon it, the probability or improbability of the public being deceived by the alleged false marking will be taken into consideration by them." 8 Bann. & A. 256 (257).

In Nichols *v.* Newell (1853), 1 Fisher, 647, Sprague, J. : (659) "If there was a purpose, at the time these words were affixed, to deceive the public, although the party may have expected a patent shortly, or within any time (if in the mean time they intended to put forth the articles and thereby deceive the public), then the offence would be committed. If they intended to deceive the public for a short time, and believed that they should then have their patent, still the offence is committed, because the statute forbids deceiving the public at any time."

That to mark "patented" on articles evidently not patentable and which cannot deceive the public is not an offence, see U. S. *v.* Morris (1866), 2 Bond, 23 ; 3 Fisher, 72.

That the marking is an offence, though no sales result, see Nichols *v.* Newell (1853), 1 Fisher, 647.

That the offence is committed by marking falsely, not by carrying the marked articles into another district with intent to sell, see Pentlarge *v.* Kirby (1884), 19 Fed. Rep. 501.

That the offence is committed however the mark may be put on, see Nichols *v.* Newell (1853), 1 Fisher, 647.

pected patent, or one formerly protected by a patent which has now expired, may lawfully bear this inscription.[4]

§ 631. Procedure and Penalty for Falsely Stamping Infringing or Unpatented Articles.

The statute embracing these provisions is penal in its nature, and must be strictly construed.[1] The punishment for its violation is a fine of one hundred dollars and costs,[2] to be recovered by any person in a *qui tam* action brought to the District Court of the United States within whose jurisdiction the offence may have been committed.[3] The person falsely

[4] That articles may be marked "patented" when a patent is expected, if there is no intent to deceive, see Nichols *v.* Newell (1853), 1 Fisher, 647.

That articles are patented and may be so marked, although the patent has expired, if the date of the patent is included in the mark, see Wilson *v.* Singer Mfg. Co. (1882), 11 Bissell, 298; 12 Fed. Rep. 57; Wilson *v.* Singer Mfg. Co. (1879), 9 Bissell, 173; 4 Bann. & A. 637; 16 O. G. 1091.

That a patentee has no right to mark his articles "patented," after the patent expires, under Sec. 4900, Rev. Stat., the act of marking showing an intent to deceive, see N. Y. Consolidated Card Co. *v.* Union Playing Card Co. (1886), 39 Hun, 611.

§ 631. [1] That the statute against false marking must be strictly construed, see Pentlarge *v.* Kirby (1884), 19 Fed. Rep. 501; United States *v.* Morris (1866), 2 Bond, 23; 3 Fisher, 72.

[2] That the penalty must be exactly one hundred dollars, see Stimpson *v.* Pond (1855), 2 Curtis, 502.

That the full penalty may be imposed for each article falsely stamped and sold, see Tompkins *v.* Butterfield (1885), 25 Fed. Rep. 556; 33 O. G. 758.

[3] That any person may maintain a *qui tam* action on this statute, see Kass *v.* Hawlowetz (1885), 33 O. G. 1135; Winne *v.* Snow (1884), 19 Fed. Rep. 507.

That the suit must be brought in the name of the informer, not of the United States, see United States *v.* Morris (1866), 3 Fisher, 72; 2 Bond, 23.

That a suit for false stamping under Sec. 4901 can be maintained only in the district where the stamping was done, and not where the stamped goods were sold, see Pentlarge *v.* Kirby (1884), 19 Fed. Rep. 501; Winne *v.* Snow (1884), 19 Fed. Rep. 507.

That a corporation is liable for the act of its superintendent in wrongfully stamping if he knew or should have known that the article was not patented, but not if he was ignorant and acted in good faith, see Tompkins *v.* Butterfield (1885), 25 Fed. Rep. 556; 33 O. G. 758.

That acts of employees in false stamping are acts of the principal, see Kass *v.* Hawlowetz (1885), 33 O. G. 1135.

That in a suit for false stamping in New York the plaintiff need not allege the tort as committed on a certain day, but "on or about the month of" is sufficient, see Fish *v.* Manning (1887), 31 Fed. Rep. 340.

That in a suit for falsely stamping

marking articles as protected by a given patent may be thereby estopped to deny its validity.[4]

§ 632. Failure of Alien Inventor to put his Invention into Market in the United States.

Under the act of 1886 it was the duty of an alien inventor and patentee to put his patented invention into the market in this country within eighteen months after the issue of the patent. To put his invention into the market consisted in offering it for sale at a reasonable price; and his failure to do

an article with the name or patent-mark of the true patentee in New York the declaration must point out the section of the statute sued on, and must allege that the defendant had no patent, that his device contained the patented improvement, and that it was stamped without consent of the patentee or his assigns or representatives, see Fish *v.* Manning (1887), 31 Fed. Rep. 340.

That in a suit for false stamping by a foreign corporation in New York, service upon the person who has general control of the business in which the stamping is done, is on the "managing agent" and is sufficient, see Hat-Sweat Mfg. Co. *v.* Davis Sewing Mach. Co. (1887), 31 Fed. Rep. 294.

That in a suit for false stamping the question of the identity of the stamped device with the patented invention is a question of law, where the want of identity is evident from the patent itself, see Tompkins *v.* Butterfield (1885), 33 O. G. 758; 25 Fed. Rep. 556; Hawlowetz *v.* Kass (1885), 33 O. G. 1499; 23 Blatch. 395; 25 Fed. Rep. 765.

That whether a stamped article, which is not covered by any patent before the court, is patented or not is a question for the jury, see Kass *v.* Hawlowetz (1885), 33 O. G. 1135.

That in a suit for a penalty for false stamping, under Sec. 4901, if the defendant has a patent which he claims covers the articles, the court should determine the scope and effect of the patent, see Hawlowetz *v.* Kass (1885), 23 Blatch. 395; 33 O. G. 1499; 25 Fed. Rep. 765.

That the charge of false stamping must be proved beyond reasonable doubt, see Tompkins *v.* Butterfield (1885), 25 Fed. Rep. 556; 33 O. G. 758.

That in a suit for false stamping the plaintiff is not bound to prove his case as fully as under an indictment, see Hawlowetz *v.* Kass (1885), 23 Blatch. 395; 33 O. G. 1499; 25 Fed. Rep. 765.

That in a suit for stamping with intent to deceive the plaintiff need not prove that the stamped articles are patentable, it being for the defence to show that they are not patentable and that the public could not be deceived, see Winne *v.* Snow (1884), 19 Fed. Rep. 507.

That in a suit for infringement the defendant cannot show that he has not stamped the infringing device as patented, especially if he does not set it up in his answer, see Herring *v.* Gage (1878), 15 Blatch. 124.

[4] That a person marking articles "patented," under a patent to which he has no right, cannot dispute the validity of such patent, on a motion to enjoin him from falsely stamping, see Washburn & Moen Mfg. Co. *v.* Haish (1879), 9 Bissell, 141; 4 Bann. & A. 571; 18 O. G. 465.

this within the time prescribed forfeited his right to recover for an infringement of the patent.[1] This requirement did not extend to the native assignees of an alien patentee, and was removed even from the latter by the act of 1870.[2] At present no obligation rests upon any patentee to develop his invention or to bring it into practical use.[3]

§ 632. [1] That "to put into market," under this statute, is to be willing to sell at reasonable prices, see Tatham *v.* Lowber (1847), 2 Blatch. 49.

[2] That this provision did not apply to native assignees of alien inventors, see Tatham *v.* Lowber (1847), 2 Blatch. 49.

[3] See § 31 and note, *ante*.

CHAPTER II.

OF THE AMENDMENT OF LETTERS-PATENT.

§ 633. Patentee Bound by the Language of his Patent as Construed by the Courts, whether or not his Actual Invention is thereby Adequately Protected.

AN inventor who has complied with all the provisions of the law on his part is entitled to the complete protection of his invention. The protection actually afforded by his patent, however, is limited and defined by the language it employs for describing and claiming the invention, as such language is interpreted by the courts. From many causes it may happen that the patent, thus construed, fails to cover the invention really made and intended to be patented; and the inventor, being concluded by his patent, is in this manner, therefore, liable to be defeated in the endeavor to secure his rights. In the early history of Patent Law no method existed by which this evil could be remedied. Whatever might be the character or merit of the invention, the patentee must take his letters-patent as they were granted to him; and if they were inaccurate or incomplete the consequences of these defects were inevitable and must be endured. He was regarded as responsible for all discrepancies between the language of the patent and the invention it pretended to describe. If it attempted, in the opinion of the courts, to cover more than the true invention, it was considered as a fraud upon the public, inasmuch as it deprived them of the right to use what was already known. If it departed from the essential characteristics of the invention, it was condemned as a fraudulent concealment from the public of such information as the patentee was bound to disclose. Thus, whether it described and claimed too much, or described and claimed too little, or

incorrectly stated what it did describe and claim, it was alike void and the patentee was left without redress.[1]

§ 634. Power to Amend the Defective Language of a Patent Necessary to the Protection of the Patentee.

With the amelioration of public sentiment toward inventors these burdens have been substantially removed. The custom of correcting defective patents by their surrender and the issue of amended patents was early established in this country, and received the sanction and approbation of the courts.[1] This practice has been formally adopted by the acts of Congress and made a permanent feature of our Patent Law.[2] Other statutes have provided simpler methods by which a mere redundancy of description or an excess of claim may be eliminated from the patent, while errors and mistakes which do not qualify the rights conferred by the patent are either wholly disregarded by the courts or may be amended by the Patent Office at the request of the inventor.

§ 635. The Power to Amend the Defective Language of a Patent does not Include the Power to Change the Nature of the Patented Invention or the Person of the Patentee.

The concession to the inventor of this power to amend his patent has not, however, in any degree obliterated the distinction between a new patent and an amended patent. By no process of emendation can the grant of an exclusive privilege to one person for one invention be transformed into the grant of an exclusive privilege to a different person or for a different invention. A patent is the bestowal of the right to a specific art or instrument upon a specific patentee, and through all the variations which its language may assume its identity as a patent must remain unchanged.[1] The scope of the

§ 633. [1] See §§ 14, 15, and notes, *ante*.

§ 634. [1] See Grant *v.* Raymond (1832), 6 Pet. 218; 1 Robb, 604.

[2] Act of 1832, § 3.

§ 635. [1] Nearly all the difficulties which have attended the subject of Reissue might have been avoided by a proper recognition of the principle here stated. A patent is the grant of a monopoly in an invention. This monopoly cannot be conferred except in an invention completely existing at the time of the grant, and upon an application for a patent for that invention by the inventor or his representatives; and

amending power is limited to such alterations of description and assertion as do not affect the essential character of the invention or the person of the patentee. For a mistake in these the only remedy is by the issue of a new original patent upon an independent application.

§ 636. *Defects and Modes of Amendment, each of Three Classes.*

Defects which fall within the scope of the amending power may be divided into three classes, as indicated by the methods now provided for their removal: (1) Clerical errors; (2) Errors consisting in an excess of claim; and (3) Errors of any kind, whether by excess or deficiency or misstatement, in any matter relating to the substance of the grant. The third

when conferred it is limited in scope to original patent. The second rule for-

the invention for which the patent has been sought. Here are three inexorable rules which cannot be affected by the concession of the amending power: (1) That the invention must have existed at the issue of the original patent, clearly *perceived* as well as *conceived* by the inventor, and fully reduced to practice; (2) That in his application for the original patent the inventor must have attempted to describe and claim every attribute of the invention which he desired to bring within the monopoly created by that patent; (3) That the monopoly created by that patent must thenceforth be regarded as commensurate with the invention which the inventor then endeavored to protect, and if the language of the patent, either through deficiency or excess of statement, fails to correspond with the monopoly as thus created, amendments for the purpose of curing this defect must be permitted until the language of the patent and the scope of the monopoly exactly correspond. The first rule precludes the introduction into the amended patent of any patentable matter which was not clearly in the mind of the inventor or had not been reduced to practice at the date of the

bids the insertion of any matter which the patentee did not endeavor to incorporate into the claims of his patent as originally granted, whether his purpose was to abandon the unclaimed matter to the public, or to reserve it for a future application. The third rule at once compels him and entitles him to change the terms in which his original patent describes and claims the invention it attempted to protect, whenever he discovers that its present language is inadequate. These rules are recognized in many cases, especially in Parker & Whipple Co. *v.* Yale Clock Co. (1887), 123 U. S. 87; 41 O. G. 811; Powder Co. *v.* Powder Works (1878), 98 U. S. 126; 15 O. G. 289; etc., where it is held that a re-issue is valid whenever it is confined to the invention which the inventor intended to describe and claim in the original patent, unless meanwhile he has abandoned it to the public. The application of these rules in the Patent Office and in the courts in a few of the earlier cases would have simplified the whole matter, and probably have saved numerous and expensive contests in which the subject of amending patents seems only to become more difficult and obscure.

class includes the second, so far as the nature of the defects are concerned; but the second has a peculiar remedy in addition to that by which the other errors of the third class are corrected. Defects of the first class are amended by the action of the Patent Office at the suggestion of the patentee. Defects of the second class may be cured by Disclaimer. Defects of the third class are removed by a Re-issue. Each of these remedies, with the method of applying them, will now be examined.

SECTION I.

OF THE AMENDMENT OF LETTERS-PATENT: CLERICAL ERRORS.

§ 637. Clerical Errors Defined: How Corrected.

Under the head of clerical errors may be embraced all the mistakes in the patent which do not affect the substance of the grant, and which occur through the fault of the employees of the Patent Office.[1] Upon his discovery of any such mistake after the delivery of the patent, the patentee or his assignee may make an application to the Commissioner for its correction, and if the error is clearly disclosed by the files or records of the Office, a certificate showing the fact and nature of the mistake will be signed by the Secretary of the Interior, countersigned by the Commissioner, sealed with the seal of the Patent Office, endorsed upon the patent, and duly recorded in the records of original patents as a part of that on which it is endorsed.[2] A printed copy of this certificate will also be

§ 637. [1] That an error in the number of a patent is a clerical error, see Reed *v.* Street (1884), 34 O. G. 339.

That a mistake in the Christian name of a patentee does not invalidate the patent, if he is otherwise so described as to be identified, see Northwestern Fire Extinguisher Co. *v.* Philadelphia Fire Extinguisher Co. (1874), 6 O. G. 34; 1 Bann. & A. 177; 10 Phila. 227.

That an error in one letter of the surname of a patentee may be of no consequence, see Bignall *v.* Harvey (1880), 18 O. G. 1275; 4 Fed. Rep. 334; 18 Blatch. 353.

That a mistake of the Patent Office in engrossing the specification is a clerical error, see *In re* Johnson's Patent (1877), L. R. 5 Ch. D. 503.

[2] That clerical errors may be corrected, without surrender and re-issue, by the action of the Patent Office, see Reed *v.* Street (1884), 34 O. G. 339.

That a clerical error in a patent could be corrected, under the act of 1836, only by the Secretary of State,

attached to each printed copy of the specifications and drawings issued from the Office.

§ 638. Errors of Substance not Corrected as Clerical Errors.

Errors affecting the substance of the grant cannot be corrected in this summary manner, although occurring through the fault of the employees of the Patent Office. Mistakes whose ordinary remedy is a re-issue can be removed only by that proceeding, from whatever cause they may arise; but when a re-issue becomes necessary through official negligence no fees are charged for its allowance, unless it operates as an amendment of other defects than those for which the Patent Office is responsible.

§ 639. Correction of Clerical Errors not to affect Intervening Rights.

The correction of a clerical error relates back to the date of the patent, and the amended instrument is thenceforth regarded as the original form of the grant. But such an amendment cannot affect intervening rights. While the patent remains uncorrected the public may safely act upon it as it stands, and the delay of the patentee in procuring its correction is regarded as an acquiescence in whatever rights or privileges others meanwhile may have lawfully acquired.[1]

SECTION II.

OF THE AMENDMENT OF LETTERS-PATENT: DISCLAIMER.

§ 640. Disclaimer: Its Twofold Purpose: To Amend Defective Patent: To Save an Otherwise Lost Suit.

Errors consisting in an excess of claim, whereby the protection of the patent is extended to matters not embraced

though his signature was not necessary, see Woodworth *v.* Hall (1846), 1 W. & M. 389; 2 Robb, 517.

That if the correction be material it can operate only on subsequent cases, see Woodworth *v.* Hall (1846), 1 W. & M. 248; 2 Robb, 495.

That the right to the correction of clerical errors may be lost by delay, see *In re* Blamoud's Patent (1860), 3 L. T. Rep. N. S. 800.

§ 639. [1] That the correction of a clerical error relates back to the date of the error unless intervening rights would be thereby affected, see Woodworth *v.* Hall (1846), 1 W. & M. 389; 2 Robb, 517.

within the actual invention, may be amended by disclaimer. Disclaimer forms the subject of two distinct provisions of the statutes, embraced in different sections and having no direct connection with each other. Section 4917 relates to disclaimer as a method of amending a defective patent. Section 4922 relates to it as a method by which the plaintiff, in a suit for infringement, may avoid the defence that his original patent claimed more than his invention, and in spite of this defect may recover proper damages for the injury he has sustained. Although these two provisions were incorporated into our Patent Law by the same act of Congress, this distinction between their purposes and scope is of great importance, and the failure to observe it has led, in some cases, to serious misunderstanding.[1]

§ 641. Origin and Nature of Disclaimer as a Method of Amending a Defective Patent.

A disclaimer, considered as a method of amending a defective patent, is a development of that amending power which formerly could be exercised only by a re-issue. As will hereafter appear, the re-issue of a patent necessitated the surrender of the original patent and the destruction of all rights arising therefrom. It was also a proceeding attended with expense and delay, and required the co-operation of all the owners of the patent in the surrender of the old patent and the application for the new. And yet in the absence of this proceeding, under the acts of 1832 and 1836, the rights of the patentee could not be vindicated against an infringer if his patent claimed more than his actual invention, although the actual invention were sufficiently described, and the portions properly claimed could be clearly distinguished from the excess. It was soon perceived, however, that for the purposes of this species of amendment, no such formidable and cautious procedure was demanded. The restriction of an ex-

§ 640. [1] That disclaimers under Secs. 4917 and 4922 rest on the same grounds though used for different purposes, see Hailes *v.* Albany Stove Co. (1887), 123 U. S. 582; 42 O. G. 95.

That a disclaimer does not admit that the patent is void, see Stocker *v.* Waller (1845), 9 Jur. 136; 1 C. B. 147.

cessive Claim is the simple abandonment of an apparent right. It prejudices no one except him who relinquishes what he has hitherto asserted, and may be made by any owner of a separate interest in a patent without affecting the privileges of his co-owners or the public. Hence in the act of 1837 it was provided that this particular amendment might be made by any owner of the whole patent, or of a sectional interest therein, by filing in the Patent Office a written disclaimer of the excess, and that, as modified by this disclaimer, the original patent should thereafter be construed in all cases where the rights of the disclaimant were involved. A disclaimer is thus an inexpensive and expeditious method of removing from a patent a defect which could at first be cured only by a re-issue, and which may still be remedied at the option of the owners of the entire patent by that more elaborate proceeding.[1]

§ 642. Disclaimer a Method of Amending only an Excessive Claim.

The defect which a disclaimer is intended to remove is one that, in its nature, is fatal to the patent.[1] An inventor has

§ 641. [1] That a disclaimer is allowed in reference to patents that were issued before the act was passed, see Hotchkiss *v.* Oliver (1848), 5 Denio (N. Y.), 314.

§ 642. [1] That a disclaimer is necessary when too much has been claimed, see Seymour *v.* McCormick (1856), 19 How. 96.

That superfluous Claims may be disclaimed, but cannot be rejected by the courts, see Parker *v.* Sears (1850), 1 Fisher, 98.

That a void Claim may be disclaimed, see Tyler *v.* Galloway (1882), 12 Fed. Rep. 567; 20 Blatch. 445: 22 O. G. 2072.

That a Claim, if too broad, may be narrowed by disclaimer, see Terry Clock Co. *v.* New Haven Clock Co. (1879), 17 O. G. 909; Rice *v.* Garnhart (1874), 34 Wis. 453.

That where the original patent claims two methods, the disclaimer may relinquish one, see Tuck *v.* Brimhill (1868), 6 Blatch. 95; 3 Fisher, 400.

That a patent covering distinct improvements may be amended by disclaiming all but one, see Sessions *v.* Romadka (1884), 28 O. G. 721; 21 Fed. Rep. 124.

That expanded and unlawful Claims inserted by re-issue may be abandoned by disclaimer, see Schillinger *v.* Cranford (1885), 4 Mackay, 450; 37 O. G. 1349; Atlantic Giant Powder Co. *v.* Hulings (1884), 21 Fed. Rep. 519; Schillinger *v.* Gunther (1879), 17 Blatch. 66; 16 O. G. 905.

That the original patent cannot be revived merely by disclaiming all changes made by the re-issue, but a new re-issue must be had, see McMurray *v.* Mallory (1884), 111 U. S. 97; 27 O. G. 915.

no more right under the modern law than he had under the ancient law to claim what he has not invented, and thus deprive the public of their vested privileges. Knowingly to insert such Claims in his original patent is a fraud which invalidates his grant, and knowingly to persevere in them, after he has discovered that they are without foundation, is a fraud which forfeits all his rights to the protection of any part of the invention covered by the patent. In cases of excessive Claim an amendment by disclaimer or re-issue is thus necessary to save any portion of the privilege conferred by the patent; and at whatever period, during the life of the patent, the patentee becomes aware of this defect he must remove it or the value of his patent is destroyed.

§ 643. Claim when Excessive: How Excess Ascertained.

A Claim is excessive when it claims any material and substantial act or thing beyond the scope of the real invention of the patentee, or beyond the scope of what he has described in his specification, drawings, or model, as his invention.[1] Immaterial and unessential features of the art or instrument protected by the patent are never regarded as covered by the Claim, nor does their mention in the Claim in any degree affect the character of the patented invention. Excess in these particulars is, therefore, not a fault which calls for any amendment, unless its presence in the Claims renders them obscure and thus requires their correction by re-issue.[2] Whether the Claim is broader than the Description may be discovered by comparing them with each other as they appear on the face of the patent. Whether it exceeds the real invention is determined by ascertaining the precise limits of the idea of means embodied in the invention, and inquiring if the

§ 643. [1] In O'Reilly *v.* Morse (1853), 15 How. 62, Taney, C. J.: (121) "Whether, therefore, the patent is illegal in part because he claims more than he has sufficiently described, or more than he invented, he must in either case disclaim, in order to save the portion to which he is entitled."

[2] In Hall *v.* Wiles (1851), 2 Blatch. 194, Nelson, J.: (199) "The provision in question applies only in the case where the part claimed by the patentee, of which he is not the inventor, is a material and substantial part of the thing patented. A disclaimer is necessary, therefore, only where the thing claimed without right is a material and substantial part of the machine invented."

allegations of the Claim cover any substantial instrument or operation not embraced in this idea. The former investigation is governed by the ordinary rules of interpretation. The latter may be pursued in any manner tending to disclose the actual nature of the invention made. Thus if the patentee has received a foreign patent in which his invention is described and claimed within narrower limits than in the domestic patent, or if in actual use certain features which the patent claims as material parts of the invention are discarded as non-essential, or if by any evidence it is established that the Claim includes features already known at the date of the invention, — in these and in all other proper ways the identity of the invention made with the invention claimed may be tested, and the extent and nature of the excess, if any, may be ascertained.[3] This excess, if separable from the other portions of the Claim, or if constituting one of several Claims in the patent, may form the subject-matter of a disclaimer. When not separable from the other portions of the Claim, the entire Claim is void and can be cured only by re-issue; and when the patent contains no other Claims than this indivisible, excessive Claim, the patent itself is inoperative and should be surrendered and re-issued.

§ 644. Excessive Claim Amendable by Disclaimer only when the Defect Arose through Mistake and without Fraud.

An excessive Claim can be amended by disclaimer only when the error arose through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention.[1] A

[3] That where a foreign patent (English) contains a disclaimer of certain features, the American patent must be limited in the same way, see Ashcroft *v.* Boston & Lowell R. R. Co. (1877), 97 U. S. 189; 13 O. G. 865.

That a device actually discarded in practice ought to be disclaimed, see *Ex parte* Marsh (1872), 2 O. G. 197.

That immaterial parts may be removed by disclaimer, see Lister *v.* Leather (1858), 8 El. & B. 1004; Reg. *v.* Mill (1851), 14 Beav. 312.

That a claimed element of a combination cannot be disclaimed, see Vance *v.* Campbell (1861), 1 Black, 427; Foxwell *v.* Bostock (1864), 4 De G. J. & S. 298.

That the correction of a mistake as to the effect produced must be made by re-issue, not by disclaimer, see Schillinger *v.* Gunther (1878), 14 O. G. 713; 15 Blatch. 303.

§ 644. [1] In Schillinger *v.* Gunther (1879), 17 Blatch. 66, Blatchford, J.: (69) "But no disclaimer can be allowed to be operative unless the unlawful claim was made through inadvertence, accident, or mistake, and without

patentee is not allowed to speculate on the chances of an attack upon his patent for its unwarranted assertions, nor on the submission of the public to his improper claims. The law requires of him the utmost good faith, with reasonable diligence and skill in the description of his invention and the statement of his claims, and does not hold him responsible for errors into which, in spite of honesty and caution, he is liable to fall. But to the patentee who wilfully endeavors to mislead the public, it lends no aid either in the correction of his errors or in avoiding their consequences, but leaves him to meet his merited fate in the rejection of his patent by the courts.

§ 645. Excessive Claim Amendable by Disclaimer only when the Amended Claim would cover a Patentable Invention.

An excessive Claim can be amended by disclaimer only when the Claim as amended would cover a patentable invention.[1] The patentee has no right to any patent whatever unless he has invented something which may lawfully become the subject-matter of a patent, and no mistake of his in coupling with his own production such instruments or operations as give to the described invention its entire patentable character can entitle him to retain the patent for what is truly his, after disclaiming that excess in which the attributes

any fraudulent or deceptive intention; nor can a plaintiff recover on a patent which claims anything not *bona fide* the patentee's, unless the claim to the thing not *bona fide* his was made through inadvertence, accident, or mistake, and without any wilful default or intent to defraud or mislead the public." 16 O. G. 905 (906).

That a disclaimer is proper where the mistakes were mistakes of fact, see Schilliuger *v.* Gunther (1879), 16 O. G. 905; 17 Blatch. 66.

That the burden of proof rests on those who allege that the excess was originally claimed through fraud, see Hotchkiss *v.* Oliver (1848), 5 Denio (N. Y.), 314.

For a discussion of inadvertence, etc., see §§ 658, *ante*, and 685–692, and notes, *post*.

§ 645. [1] That a disclaimer is of no avail unless the part rightfully claimed is a material and substantial part of the matter patented, and is distinguishable from the rest, see Hotchkiss *v.* Oliver (1848), 5 Denio (N. Y.), 314.

That an element of a combination is not a distinguishable part, see Vance *v.* Campbell (1861), 1 Black, 427.

That a part may be useful and yet neither material nor substantial nor distinguishable, see Hotchkiss *v.* Oliver (1848), 5 Denio (N. Y.), 314.

of a patentable invention alone reside. No one, therefore, can be permitted to disclaim, unless he or the alleged inventor from whom he derives his title has performed an inventive act, resulting in some material and substantial part of the thing patented which is so far separable from the excess that the patent can be valid for it, and protect it, after the excess has been disclaimed.

§ 646. Excessive Claim not Amendable by Disclaimer after Unreasonable Delay.

An excessive Claim can be amended by disclaimer only when the amendment is attempted without unreasonable delay. The same principle which forbids a patentee to assert a right to more than he has actually invented compels him to disavow the right as soon as he discovers that it has been unjustly claimed. Unreasonable delay in disclaiming is thus tantamount to an original fraudulent Claim, and through it the patentee loses the privilege of making the amendment by which alone his patent could be saved.[1] The question of unreasonable delay is a question for the court, upon the facts as found either by its own investigation or the verdict of a jury.[2] Delay begins whenever the patentee becomes aware that he has claimed more than he has invented or described. In cases where the excess is not apparent at once upon the inspection of the patent by the patentee, the allowance of his

§ 646. [1] That "unreasonable delay" avoids the good effect of a disclaimer, see Tuck *v.* Bramhill (1868), 6 Blatch. 95; 3 Fisher, 400; Singer *v.* Walmsley (1860), 1 Fisher, 558; Seymour *v.* McCormick (1856), 19 How. 96; Brooks *v.* Jenkins (1844), 3 McLean, 432.

That a delay in filing a disclaimer does not prejudice the patentee unless it is unreasonable, see Hotchkiss *v.* Oliver (1848), 5 Denio (N. Y.), 314.

That no disclaimer can be filed after the patent has expired, see Yale Lock Mfg. Co. *v.* Sargent (1886), 117 U. S. 536; 35 O. G. 497; Vacuum Oil Co. *v.* Buffalo Lubricating Oil Co. (1885), 23 Fed. Rep. 891.

[2] In Singer *v.* Walmsley (1860), 1 Fisher, 558, Giles, J.: (575) "What is 'unreasonable delay' is a question to be settled by the court and not for the jury. . . . The court will find that the time, in reference to the question of delay, commences when the knowledge was brought home to the party that he was not the first inventor, or when it is declared by a court, of competent jurisdiction to settle the question, that he was not the first inventor; then it is that the time commences to run, and not until then."

See also Seymour *v.* McCormick (1856), 19 How. 96; Brooks *v.* Jenkins (1844), 3 McLean, 432.

Claim by the Patent Office raises such a presumption in its favor that he may rely on its validity until a court of competent jurisdiction decides that it is broader than his real invention.[8]

§ 647. Disclaimer, by Whom Made.

Where an excessive Claim can be cured by disclaimer, the disclaimer must be filed by a party owning an interest in the patent and whose interest is distinct from that of his co-owners.[1] The original patentee cannot disclaim after he has parted with his entire title to the patent.[2] An owner of an undivided interest cannot disclaim, and thus change the form of the patent, without the co-operation of the other owners of the same interest in the patent. But an owner either of the entire patent, or of the entire interest within a specified territory, may file a disclaimer; and when the disclaimant is a territorial owner its effect upon the patent will be commen-

[8] In O'Reilly *v.* Morse (1853), 15 How. 62, Taney, C. J.: (121) "It appears that no disclaimer has yet been entered at the Patent Office. But the delay in entering it is not unreasonable. For the objectionable Claim was sanctioned by the head of the Office; it has been held to be valid by a circuit court, and differences of opinion in relation to it are found to exist among the justices of this court. Under such circumstances the patentee had a right to insist upon it, and not disclaim it until the highest court to which it could be carried had pronounced its judgment."

See also Seymour *v.* McCormick (1856), 19 How. 96.

That the allowance of Claims by the Patent Office is such evidence of their validity that the patentee may rely upon it until the courts have decided to the contrary, see Yale Lock Mfg. Co. *v.* Sargent (1886), 117 U. S. 536; 35 O. G. 497; Stutz *v.* Armstrong (1884), 28 O. G. 367; 20 Fed. Rep. 843; Burdett *v.* Estey (1878), 15 Blatch. 349; 15 O. G. 877.

That delay in disclaiming cannot exist until the need of a disclaimer is made known, see Kittle *v.* Hall (1887), 30 Fed. Rep. 239.

That a disclaimer may be filed after a patent has been adjudged invalid, see Morgan *v.* Seaward (1838), 2 Carp. P. C. 104; *In re* Derosne's Patent (1835), 1 Carp. P. C. 698.

§ 647. [1] That a disclaimer must be made by one who owns an entire right within a given territory, see Myers *v.* Frame (1871), 4 Fisher, 493; 8 Blatch. 446.

[2] That a disclaimer by a patentee is not valid unless he is still the owner of the patent, see Myers *v.* Frame (1871), 4 Fisher, 493; 8 Blatch. 446.

That under the English statute a disclaimer may be filed by a patentee who has parted with his interest, see Spilsbury *v.* Clough (1842), 1 Web. P. C. 255.

That a disclaimer by an attorney does not necessarily bind a patentee, see Mann *v.* Bayliss (1876), 10 O. G. 789.

surate only with his interest; and the patent as amended will thereafter limit and define his rights, while other parties hold under the patent in its original form.[3] Thus the same patent may be operative, in terms at least, to different extents in different sections of the United States, and may be valid as to diligent disclaimants, though void as to other owners who have unreasonably neglected to disclaim.

§ 648. Disclaimer, how Made.

A disclaimer must be made in writing, must be signed by the disclaimant and attested by one or more witnesses, and must be recorded in the Patent Office. It must state the exact interest of the disclaimant in the patent, and distinctly set out the excess which is to be disclaimed, averring that it was included in the patent through inadvertence, accident, or mistake.[1] Upon the receipt and recording of this disclaimer, it is considered as part of the original specification, to the extent of the interest possessed by the disclaimant and by those deriving title from him after the disclaimer is recorded.[2]

[3] In Potter *v.* Holland (1858), 1 Fisher, 327, Ingersoll, J.: (339) "The owner of a sectional interest, however, can make a disclaimer for his sectional interest, which is to be taken as a part of the original specification, for the section owned by him, and no greater extent. After such disclaimer a different claim of right is secured to the disclaimant, the owner of a sectional interest, from what is purported to be secured to the patentee, the owner of the remaining interest; different claims of right in the same invention are secured to different sectional owners; there are two specifications for the same invention, one making one claim of right to an invention for one section of country, and the other making another and different claim of right to the same invention, for another section of country. In effect it makes two patents out of one, one securing a claim of right to one person, and the other securing a different claim of right to another person. This is expressly authorized by the Patent Law." 4 Blatch. 206 (217).

That the word "claimant" in Sec. 4917 Rev. Stat. means disclaimant, see Union Metallic Cartridge Co. *v.* United States Cartridge Co. (1884), 112 U. S. 624; 30 O. G. 771.

§ 648. [1] That a disclaimer, under Sec. 7, act of 1837, must state the interest of the disclaimant, or it will be invalid, see Foote *v.* Silsby (1849), 1 Blatch. 445; Brooks *v.* Jenkins (1844), 3 McLean, 432.

[2] That a disclaimer becomes part of the specification and is considered in construing the patent, see Dunbar *v.* Myers (1877), 94 U. S. 187; 11 O. G. 35.

That a disclaimer may relate to one figure only in a drawing, see Brush *v.* Condit (1884), 28 O. G. 451; 22 Blatch. 246; 20 Fed. Rep. 826.

§ 649. Disclaimer not a Method of Amending a Defective Description.

From the nature of a disclaimer, and of the defect it is intended to remedy, it is evident that it cannot be employed for the alteration or reformation of the Description, but only for the elimination of superfluous matter from the Claims.[1] If the Description requires amendment in order to give effect to a Claim, or if the Claim itself demands restatement to avoid obscurity, or if new Claims are necessary to protect the actual invention, these objects must be sought by a re-issue, not by

§ 649. [1] In Hailes *v.* Albany Stove Co. (1887), 123 U. S. 582, Bradley, J.: (587) "A disclaimer is usually and properly employed for the surrender of a separate Claim in a patent, or some other distinct and separable matter, which can be excinded without mutilating or changing what is left standing. Perhaps it may be used to limit a Claim to a particular class of objects, or even to change the form of a Claim which is too broad in its terms; but certainly it cannot be used to change the character of the invention. And if it requires an amended specification or supplemental Description to make an altered Claim intelligible or relevant, while it may possibly present a case for a surrender and re-issue, it is clearly not adapted to a disclaimer. A man cannot by merely filing a paper drawn up by his solicitor make to himself a new patent, or one for a different invention from that which he has described in his specification." 42 O. G. 95 (97).

In Union Metallic Cartridge Co. *v.* United States Cartridge Co. (1884), 112 U. S. 624, Blatchford, J.: (642) "It is a patentee who 'has claimed more than that of which he was the original or first inventor or discoverer,' and only 'such patentee,' or his assigns, who can make a disclaimer, and the disclaimer can be a disclaimer only 'of such parts of the thing patented as he shall not choose to claim or hold by virtue of the patent or assignment.' A disclaimer can be made only when something has been claimed of which the patentee was not the original or first inventor, and when it is intended to limit a Claim in respect to the thing so not originally or first invented. It is true that, in so disclaiming or limiting a Claim, descriptive matter on which the disclaimed Claim is based may, as incidental, be erased, in aid of, or as ancillary to, the disclaimer. But the statute expressly limits a disclaimer to a rejection of something before claimed as new or as invented, when it was not new or invented, and which the patentee or his assignee no longer chooses to claim or hold. It is true that this same end may be reached by a re-issue, when the patentee has claimed as his own invention more than he had a right to claim as new; but if a Claim is not to be rejected or limited, but there is merely 'a defective or insufficient specification,' — that is, Description, as distinguished from a Claim, — the only mode of correcting it was and is by a re-issue." 30 O. G. 771 (775).

That a disclaimer cannot be used to make a patent cover what is not described or claimed as part of the invention, see White *v.* Gleason Mfg. Co. (1883), 24 O. G. 205; 21 Blatch. 364; 17 Fed. Rep. 159; Foxwell *v.* Bostock (1864), 4 De G. J. & S. 298.

a disclaimer. But where excessive Claims are to be remedied by a disclaimer, such parts of the Description as serve no other purpose than to support the excess disclaimed may also be withdrawn by the disclaimer, and the distinction between the actual invention and the excess be thus more clearly indicated.[2] In the same manner objectionable phrases in the

[2] In Hailes *v.* Albany Stove Co. (1883), 16 Fed. Rep. 240, Wallace, J. : (242) "If it is true that the patentees defectively or insufficiently described the invention, and claimed more than they had a right to claim as new, they were entitled to a re-issue of their patent upon surrender of the original. But it is not the office of a disclaimer to reform or alter the Description of the invention. If a patentee has claimed more than that of which he was the inventor, his patent may be valid for all that part which is justly and truly his own, and he may recover upon his patent if the part which is his own be definitely distinguished from the parts claimed without right; but in such case he cannot recover costs unless a disclaimer has been entered before suit commenced. When there are several Claims, some of which he is entitled to and others of which he is not entitled to, the part of the invention which is his own may be definitely distinguishable from that which is not his own, and a disclaimer before suit brought will put him right, and enable him to recover upon his patent as though it had originally been confined to the proper Claims; and there would seem to be no objection in such a case to eliminating by his disclaimer such parts of the Description as relate to the Claims to which he is not entitled and which he abandons. This, however, is a very different thing from converting a Claim from one thing into a Claim for something else, and amending the Description to effectuate the Claim. This might give the patentee a new patent; it certainly would enable him to grant himself a re-issue without the concurrence of the Commissioner of Patents. It would enable him, after others had occupied the field of invention, and by their intellect and experiments discovered what he had never pointed out or claimed, except, perhaps, so vaguely that his information was valueless, to deprive them of the fruit of their efforts. When there are distinct Claims in the patent, some of which are valid and others not; or, where there is a single Claim, but a specification by which the public can definitely distinguish what is new and belongs to the patentee, and what does not really belong to him, although he had claimed it, a disclaimer will right the patentee's mistake, and will work no injustice to others." 21 Blatch. 271 (273); 24 O. G. 391 (392).

In Schillinger *v.* Gunther (1879), 17 Blatch. 66, Blatchford, J. : (69) "It is true, that, strictly, Sec. 4917 contemplates only a disclaimer of some Claim, or part of a Claim; but, in connection with a disclaimer of a Claim, or of a part of a Claim, it is not improper to eliminate or withdraw, by the same writing, the parts of the body of the specification on which the disclaimed Claim, or part of a Claim, is founded. The disclaimer is none the less a disclaimer of a Claim or of a part of a Claim because, in addition, it disclaims such parts of the body of the specification. The disclaimer being a proper one, in form and substance, it is, by the statute, to be, after its filing, 'considered as part of the original specification.' The re-issued specification is to be

specification may be removed, and false statements of fact may be expunged, provided that no new construction is thereby given to what remains.[8] For the sole purpose of a disclaimer is to amend excessive Claims by eliminating from them the separable excess; and whatever else it may accomplish must be wholly subordinate and auxiliary to that end.

§ 650. Disclaimer Affects only the Excess which it Eliminates from the Claim.

The effect of a disclaimer is confined to the excess which it removes from the apparent protection of the patent. Except as to this the patent remains operative to the same extent as before the disclaimer was filed.[1] The disclaimer of a void Claim does not affect such other Claims of the patent as by themselves are valid, nor does the disclaimer of the excessive portion of a Claim impair the force of what is not disclaimed. Thus the disclaimer neither adds to the patent, nor makes it cover more than it formerly embraced.[2] The disclaimer of a species does not affect a Claim for the genus which includes it, nor does the disclaimer of an apparatus except when used for a particular purpose prevent the patentee from claiming it in connection with the purpose so described.[3] The patent stands

thereafter read as if the disclaimer were incorporated in it," 16 O. G. 905 (906).

That a disclaimer may eliminate all of the descriptive matter which relates to the parts disclaimed, see Tarrant *v.* Duluth Lumber Co. (1887), 39 O. G. 1425; 30 Fed. Rep. 830.

That a disclaimer may remove matter first set up in a re-issue, and may relate to the Description as well as to the Claim, see Schillinger *v.* Gunther (1879), 16 O. G. 905; 17 Blatch. 66.

[8] That objectionable phrases in the specification may be removed by disclaimer, see American Wood Paper Co. *v.* Heft (1867), 3 Fisher, 316.

That an *unintelligible specification* cannot be cured by disclaimer, see Ralston *v.* Smith (1865), 11 H. L. 223.

§ 650. [1] That the matter disclaimed ceases to be part of the invention, see Dunbar *v.* Myers (1877), 94 U. S. 187; 11 O. G. 35.

That a void Claim being disclaimed the rest are good, see O'Reilly *v.* Morse (1853), 15 How. 62.

[2] That a disclaimer adds nothing to the patent nor can it make the patent cover more than it did before, this being the province of a re-issue, see White *v.* Gleason Mfg. Co. (1883), 17 Fed. Rep. 159; 21 Blatch. 364; 24 O. G. 205; Foxwell *v.* Bostock (1864), 4 De G. J. & S. 298.

[3] That the disclaimer of one species does not affect the genus, see Walsh *v.* Shinn (1879), 16 O. G. 1006.

That a disclaimer of apparatus except when used for a special purpose does not admit it to be old, or bar the patentee from claiming it for that purpose, see

after the disclaimer as if it had been originally issued in the amended form, and both its Claims and its Descriptions are interpreted and applied without reference to the matter that has been withdrawn.[4]

§ 651. Origin and Nature of Disclaimer as a Method of Saving an Otherwise Lost Suit.

A disclaimer, considered as a method of avoiding a defence based on an excessive Claim, was also introduced into our Patent Law by the act of 1837. Prior to that act the patentee could not recover on a patent in which he claimed more than he had actually invented. It was his duty not only to describe his invention with exactness, neither withholding from the public the knowledge of any material part thereof nor misleading them by asserting the materiality of that which in itself was not essential, but to distinguish the invention to be covered by the patent from all other arts or instruments by a certain and specific Claim. Upon this Claim the fortunes of the patent turned. If it were narrower than the invention the scope of the protection afforded by the patent was nevertheless restricted to its terms. If it were broader than the actual invention it was false, at least in part, and as the court had no means of determining, as matter of law, how far the Claim was true nor of separating the true allegations from the false, the entire Claim was necessarily regarded as invalid. The act of 1836, while it made this defect curable by re-issue, also provided that when a defendant in an action for infringement prevailed over the

Black *v.* Thorne (1872), 10 Blatch. 66 ; 5 Fisher, 550 ; 2 O. G. 388.

[4] That an unfounded Claim being disclaimed the patent stands for the residue as if so originally issued, see McCormick *v.* Seymour (1854), 3 Blatch. 209 ; Clark *v.* Kenrick (1843), 12 M. & W. 221.

That after an amendment by disclaimer a patent cannot be so construed as to render the amendment nugatory, see Atlantic Giant Powder Co. *v.* Hulings (1884), 21 Fed. Rep. 519.

That where a disclaimer withdraws a new re-issue Claim, and leaves only what was covered by the original, if any new matter remains in the Description it must be discarded, see Schillinger *v.* Cranford (1885), 4 Mackay, 450 ; 37 O. G. 1349.

That a disclaimer cannot be used to explain that which remains in the patent, see Tetley *v.* Easton (1857), 2 C. B. N. S. 706.

plaintiff on this ground of defence, the court might award costs to either party in its discretion, if the defendant had used any part of the invention which was truly claimed as new. This provision enabled the court to shield the honest but mistaken patentee from some of the consequences of his error, leaving him, under other provisions of the same act, to amend his Claim and thus protect himself from further violations of his rights. The act of 1837 extended, and made more immediately applicable, these benign provisions. While conferring on the owner of the patent the power to amend at once by filing a disclaimer, it enacted that in all those cases where a disclaimer might properly be filed the patent should be good and valid for so much of the invention claimed as was truly and honestly the invention of the patentee, if it were in itself a patentable invention and separable from the matter falsely claimed. It further enacted that the plaintiff claiming under such a patent should be entitled to maintain his suit in spite of this defect, if the right to amend the patent by disclaimer had not been already forfeited by an unreasonable delay, but that he should recover no costs against the defendant unless he had filed such disclaimer in the Patent Office prior to the commencement of the suit.[1]

§ 651. [1] In Tuck *v.* Bramhill (1868), 3 Fisher, 400, Blatchford, J. : (406) "But the defendant contends that the disclaimer in this case, if properly made at all, cannot affect the issues in this suit, because it was not filed till after the commencement of the suit. In other words, the defendant contends that the plaintiff cannot recover in this suit because the Claim, as it stood when the suit was brought, embraced more than that of which the plaintiff was the first inventor. In urging this view, the defendant relies on the general principle of law to that effect, as recognized before the act of March 3, 1837, was passed, and on the provision of section 7 of that act, that '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 the same;' and he insists that the Claim of the patent must be construed, for the purposes of this suit, as if no disclaimer had been filed. . . . (408) This is not so. It is true that Judge Story, in Reed *v.* Cutter, 1 Story, 590, 600, says that if a disclaimer is filed during the pendency of a suit, the plaintiff will not be entitled to the benefit thereof in that suit, and that the same judge, in Wyeth *v.* Stone, 1 Story, 273, 294, says that the disclaimer mentioned in section 7 must be interpreted to apply solely to suits pending when the disclaimer is filed in the Patent Office, and the disclaimer mentioned in section 9 to apply solely to suits brought after the disclaimer is so filed, and that the proviso to section 7, as to the disclaimer's affecting a pending suit, prevents its affect-

Under these provisions the patent is no longer open to this defence except where the disclaimer was unreasonably de-

ing in any manner whatsoever a suit pending at the time it is filed. . . . (409) I cannot concur, however, in Judge Story's view of the provision in section 7 as to the disclaimer's affecting a pending suit. I understand that provision to mean that a suit pending when a disclaimer is filed is not to be affected by such filing, so as to prevent the plaintiff from recovering in it, unless it appears that the plaintiff unreasonably neglected or delayed to file the disclaimer. The 'unreasonable neglect or delay' mentioned in section 7 manifestly refers to the unreasonable neglect or delay mentioned in section 9, and the disclaimer mentioned in section 9 is clearly the disclaimer provided for in section 7. Moreover, the provision of section 9, that the plaintiff, where he is entitled to recover under that section, shall not recover costs unless he has entered a disclaimer, prior to the commencement of the suit, of what he claimed without right, is a strong implication that where he does not enter the disclaimer until after the commencement of the suit he may still recover in the suit, if otherwise entitled to do so, but without recovering costs. And such has been the view heretofore held by Mr. Justice Nelson, in this circuit. In Guyon *v.* Serrell, 1 Blatch. 244, he allowed a recovery, without costs, in a case where a disclaimer was filed after suit was brought; and in Hall *v.* Wiles, 2 Blatch. 194, 198, he says: 'If the disclaimer was entered in the Patent Office before the suit was instituted, the plaintiff recovers costs in the usual way, independently of any question of disclaimer. But if, in the progress of the trial, it turns out that the disclaimer ought to have been made as to part of what is claimed, the plaintiff may recover, but will not be entitled to costs.' Of course, it follows that if a disclaimer is made after suit brought, the plaintiff may still recover, but without costs." 6 Blatch. 95 (102).

That the plaintiff may recover for the infringement of his actual invention though he has filed no disclaimer, unless he has been guilty of unreasonable delay, see O'Reilly *v.* Morse (1853), 15 How. 62; Hall *v.* Wiles (1851), 2 Blatch. 194.

That an excessive Claim inserted by mistake may be disclaimed pending suit and the suit saved, though without costs, see Matthews *v.* Spangenberg (1882), 23 O. G. 92; 20 Blatch. 482; 19 Fed. Rep. 823.

That where a proper disclaimer has been filed the plaintiff may recover on the Claims not disclaimed, see Schillinger *v.* Gunther (1879), 17 Blatch. 66; 16 O. G. 905.

That a patentee may have his remedy though no disclaimer is filed, it not being a condition precedent, see Hotchkiss *v.* Oliver (1848), 5 Denio (N. Y.), 314.

That the court may increase the damages under Sec. 14, act of 1836, though no disclaimer was filed, see Guyon *v.* Serrell (1847), 1 Blatch. 244.

That under the act of 1837, when the patent claims too much, a suit can be saved only where the thing rightfully claimed can be distinguished from the excess, see Vance *v.* Campbell (1861), 1 Black, 427.

That in order to save the costs a disclaimer must be filed before suit, as well as with reasonable diligence, see Tuck *v.* Bramhill (1868), 6 Blatch. 95; 3 Fisher, 400; Reed *v.* Cutter (1841), 1 Story, 590; 2 Robb, 81.

That the filing of a disclaimer before suit affects only the costs, if there is no question of unreasonable delay, see Dunbar *v.* Myers (1877), 94 U. S. 487; 11

ferred, but the defendant is not liable for costs on any action brought while the patent still remains in its defective state.[2]

§ 652. Disclaimer a Nullity unless Original Claim Actually Excessive.

A disclaimer filed without sufficient cause is a nullity under this as well as the former section of the act.[1] If there is no real excess of Claim, according to the construction given to its language by the court, the filing of a disclaimer by the plaintiff, pending suit, does not admit his inability to recover costs.[2] A disclaimer leaving the patent to claim the entire invention, as the courts must have construed it had the disclaimer not been filed, is equally inoperative both as an amendment and upon the costs.[3] The same is true of a disclaimer of a part or act not claimed in the patent, and of such

O. G. 35; Tuck *v.* Bramhill (1868), 3 Fisher, 400; 6 Blatch. 95.

That a disclaimer being filed during suit, the plaintiff can recover no costs, see Hayes *v.* Bickelhoupt (1885), 32 O. G. 133; 23 Fed. Rep. 183; Burdett *v.* Estey (1878), 15 O. G. 877; 15 Blatch. 349.

That under the act of 1837 a disclaimer may be filed after the commencement of a suit, and the court will duly protect the interest of the defendants, see Smith *v.* Nichols (1874), 21 Wall. 112.

[2] That under Sec. 9, act of March 3, 1837, the plaintiff can recover for the infringement of such part of the device as is truly his, though his specification embraces more than he has a right to claim and no disclaimer is filed, see Tuck *v.* Bramhill (1868), 3 Fisher, 400; 6 Blatch. 95.

That Claims not sued on need not have been cured by disclaimer, in order to warrant a preliminary injunction, see Duff *v.* Calkins (1883), 25 O. G. 601.

That where the Claim of a patent is declared invalid too nearly to the expiration of the patent to allow of the filing of a disclaimer, the patentee can recover on the valid Claims, notwithstanding his failure to disclaim, see Kittle *v.* Hall (1887), 30 Fed. Rep. 239.

That where a disclaimer was made pending suit, and the defendant was not prejudiced thereby, the proceedings need not be recommenced, see Libbey *v.* Mt. Washington Glass Co. (1886), 36 O. G. 572; 26 Fed. Rep. 757.

§ 652. [1] That a disclaimer, filed without necessity, is a nullity, and does not affect the costs of the suit, see Sharp *v.* Tifft (1880), 17 O. G. 1282; 18 Blatch. 132; 2 Fed. Rep. 697; 5 Bann. & A. 399.

[2] That a disclaimer of something not claimed in the patent is a nullity, see Sharp *v.* Tifft (1880), 17 O. G. 1282; 18 Blatch. 132; 2 Fed. Rep. 697; 5 Bann. & A. 399.

[3] That where a disclaimer leaves the patent to claim the whole thing invented just as it must have been construed before, it has no effect on the costs, see Sharp *v.* Tifft (1880), 18 Blatch. 132; 17 O. G. 1282; 2 Fed. Rep. 697; 5 Bann. & A. 399.

features as the court finds merely formal and not essential to the idea of means embodied in the invention as originally claimed.

SECTION III.

OF THE AMENDMENT OF LETTERS-PATENT: RE-ISSUE.

§ 653. Origin of Re-issue as a Method of Amending a Defective Patent: Re-issues Prior to the Act of 1832.

Amendment by re-issue was introduced into our statute law by the act of 1832. Prior to this act, the right of the inventor to a patent, whose protection was commensurate with the invention he had made and had endeavored to describe in his specification, had been distinctly recognized by the courts as well as by the government itself. The practice of surrendering such patents as failed to afford this protection, and of issuing corrected patents by which the purposes of the law on behalf of the inventor were fulfilled, had been established, and had been repeatedly sanctioned by judicial decisions.[1] Such defective patents were regarded as invalid and inoperative whether the defect consisted in an insufficient or

§ 653. [1] In Grant *v.* Raymond (1832), 6 Peters, 218, Marshall, C. J.: (243) "It has been said that this permission to issue a new patent on a reformed specification, when the first was defective through the mistake of the patentee, would change the whole character of the act of Congress. We are not convinced of this. The great object and intention of the act is to secure to the public the advantages to be derived from the discoveries of individuals, and the means it employs are the compensation made to those individuals for the time and labor devoted to these discoveries, by the exclusive right to make, use, and sell the things discovered for a limited time. That which gives complete effect to this object and intention, by employing the same means for the correction of inadvertent error which are directed in the first instance, cannot, we think, be a departure from the spirit and character of the act." 1 Robb, 604 (635). This case was tried in the Circuit Court in 1828. The original patent was granted in 1821, and on account of its defective specification was surrendered and re-issued in 1825. Against an objection, at the trial, that such surrender and re-issue were not authorized by law, the patent was sustained, and the decision on this point was affirmed in the Supreme Court at the January Term, 1832. The act of 1832 was approved in the following July.

See also Shaw *v.* Cooper (1833), 7 Peters, 292; 1 Robb, 643; Opinion Atty. Gen. (1831), 2 Op. At. Gen. 454; Morris *v.* Huntington (1824), 1 Paine, 348; 1 Robb, 448.

obscure description of the invention or in an inaccurate statement of the true line of distinction by which the new matter described was separated from the old. The principle on which this practice rested is easily discernible. The inventor, having a right under the law to a patent for his actual invention, and not having succeeded in obtaining such a patent by his first attempt, was entitled to make another application and receive a more perfect patent. But in doing this he was liable to be met by the objection that his invention had already gone into public use and that his right to any protection had been thereby lost. To avoid this objection the method of securing the same object by amending the original patent was devised, to the mutual advantage both of the inventor and the public, — the inventor escaping the objection before mentioned, and the public becoming completely possessed of the invention at the expiration of the term of the original patent, instead of being compelled to await the passage of a new term dating from the issue of a later patent.[2] As this practice is the origin and foundation of the entire body of rules relating to re-issues, its purposes, spirit, and methods form the key by which the conflicts and problems arising under the later law are to be resolved.[3]

§ 654. Re-issues under the Act of 1832.

The act of 1832 recognized this mode of amendment and prescribed definite rules for its performance. It provided

[2] That a re-issue for the purpose of perfecting the patent is promotive of the public interest, see French *v.* Rogers (1851), 1 Fisher, 133.

That the privilege of a re-issue is invaluable to inventors, see Bluke *v.* Stafford (1868), 6 Blatch. 195; 3 Fisher, 294.

[3] The first act of Parliament which authorized the amendment of existing patents was passed in 1835. Prior to this date, however, the power had been exercised to a limited extent in cases where the error was merely verbal, was apparent on the face of the patent, and had arisen through accident or mistake. See *In re* Whitehouse's Patent (1830), 1 Web. 649, note; *In re* Redmund's Patent (1828), 1 Web. 649, note; and § 16 and notes, *ante*. Mr. Ogden's argument in Grant *v.* Raymond (1832), 6 Peters, 218, refers to *Ex parte* Beck (1784), 1 Bro. Ch. Rep. 575, as showing that the surrender of a defective patent and the issue of a new one in its stead was under the English practice "a matter of course." Other cases of amendment of letters-patents (not apparently relating to inventions, however), are cited in a note to 1 Web. 647.

that whenever any patent should be invalid or inoperative, through the non-compliance of the inventor with the terms and conditions mentioned in the third section of the act of 1793, the patent might be surrendered and re-issued if the error had arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention.[1] The invalidity and inoperativeness of the patent were thus made dependent on the failure of the patentee to fulfil the obligations imposed by the third section of the act of 1793, and his right to a re-issue was denied only when such failure had resulted from an intention to deceive, or from some other cause than inadvertence, accident, or mistake. The obligations imposed upon the patentee by the third section of the act of 1793 were threefold: (1) To make oath that he believed himself to be the true inventor of the art or instrument for which he sought a patent; (2) To deliver to the government a written description of his invention in such complete and exact language as would distinguish it from all other things before known and would enable any person skilled in the art to construct and use it; (3) To furnish with this description such drawings, model, or specimens, as the nature of the case might require.[2] Now it is obvious that a failure to comply with

§ 654. [1] Act of 1832, § 3: "Wherever any patent . . . granted to any inventor in pursuance of the act of Congress . . . passed . . . in the year of our Lord 1793, . . . shall be invalid or inoperative by reason that any of the terms or conditions prescribed in the third section of the said . . . act, have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, been complied with on the part of said inventor, it shall be lawful for the Secretary of State, upon the surrender to him of such patent, to cause a new patent to be granted," etc.

[2] Act of 1793, § 3: "That every inventor, before he can receive a patent, shall swear or affirm that he does verily believe that he is the true inventor or discoverer of the art, machine, or improvement, for which he solicits a patent, which oath or affirmation may be made before any person authorized to administer oaths, and shall deliver a written description of his invention and of the manner of using, or process of compounding the same, in such full, clear, and exact terms, as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same. And in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions; and he shall accompany the whole with drawings and written references, where the nature of the case

these conditions, through inadvertence, accident, or mistake, can rarely occur, except in reference to the second condition, or to so much of the third as is directly related to the second. A breach of the first condition must consist either in making no oath whatever, — a defect too glaring to escape attention, — or in making a false oath, which would be a wilful fraud. A breach of the third could take place only when no drawings, model, or specimens were furnished, — another open and apparent defect, — or when they failed to correspond with the invention, and thus rendered the description of which they were a part ambiguous and uncertain. Hence, in the vast majority of cases in which the patent was invalid or inoperative, its defects must have resided in the description given of the invention in the specification, drawings, model, or specimens, and it was chiefly to cure these defects that the remedy by re-issue was provided by the statute. The third section of the act of 1793 prescribed two rules concerning the description: (1) That its terms should be so full, clear, and exact as to enable any person skilled in the art to make and use the invention; (2) That its terms should be so full, clear, and exact as to distinguish the invention from all other things before known. Defects in this description, rendering the patent invalid and inoperative were, therefore, of two classes: (1) Defects in the disclosure of the invention to the public; (2) Defects in defining the precise limits of the invention by distinguishing it from things already known. At this early period of our Patent Law, the modern distinction between the Description and the Claim, as parts of the written specification, was unknown. The same statements and recitals served both purposes, — the scope of the protection afforded by the patent, and the explication of the invention for the information of the public, being gathered from the

admits of drawings, or with specimens of the ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention is of a composition of matter; which description, signed by himself and attested by two witnesses, shall be filed in the office of the Secretary of State, and certified copies thereof shall be competent evidence in all courts, where any matter or thing touching such patent right shall come in question. And such inventor shall, moreover, deliver a model of his machine, provided the Secretary shall deem such model to be necessary."

entire document without attaching particular significance to any special clause therein contained. But the act of 1793 was at least as stringent as any later statute has been in requiring the presence of such language in the written specification as should completely fulfil both these purposes. The right of the inventor to his patent was made contingent upon the fulness, clearness, and exactness with which the terms of his specification defined the invention which he claimed, and communicated to the public a knowledge of its construction and mode of use; and if in either of these respects the specification was deficient, the patent was invalid and inoperative, and became a proper subject for re-issue under the act of 1832. By virtue of this act the patentee might thus amend those portions of the specification which related to his claim for protection as readily as he could those portions which explained the method of making and using the invention. His right to what was actually his own was treated as commensurate with his duty of disclosure to the public, and the privilege of correcting a mistake, when the correction would redound to his advantage, was as fully recognized as was his obligation to correct it whenever the information afforded by his specification to the public was erroneous or incomplete.

§ 655. Re-issues under the Act of 1836.

The act of 1836 introduced into these provisions certain changes of phraseology, but no substantial variation either in the spirit or the meaning of the law. The requirements of the third section of the act of 1793 in reference to the description were preserved almost in the same language, except as to the method of distinguishing the new invention from all other things before known. The words relating to this matter in the act of 1793 were omitted in the act of 1836, and, instead thereof, it was prescribed that the inventor should particularly specify and point out that which he claimed to be his own invention or discovery.[1] This particular statement

§ 655. [1] Act of 1836, § 6: "But before any inventor shall receive a patent for any such new invention or discovery, he shall deliver a written description of his invention or discovery, and of the manner and process of mak-

of his claim is called throughout this act by the name of the "specification," — a name afterwards in use to denote sometimes the Description as distinguished from the Claim, sometimes the entire instrument embracing both, but in the act of 1836 evidently referring mainly to the clause or clauses in which the inventor attempted to specify and point out the exact limits of the invention which he claimed.[2] Thus the terms "description" and "specification," when coupled together in this act, indicate, not the same entire instrument or the same portions of the instrument, but two distinct portions, — the former being the detailed delineation of the invention given for the information of the public and as a basis for the Claim; the latter being the specific statement and definition of the invention claimed. Attention to this use of the word in this act is essential to the true interpretation of its provisions in relation to re-issues.

ing, constructing, using, and compounding the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, 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 shall particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery."

[2] Act of 1836, § 5: "Descriptions, specifications, and drawings;" "specifications . . . specifying what the patentee claims as his invention or discovery." Sec. 6: "Written description of his invention or discovery, . . . and specify and point out the part . . . which he claims as his own invention." Sec. 7: "Application, description, and specification;" "altering his specification to embrace only that part of the invention or discovery which is new." Sec. 12: "Description, specifications, drawings, and model;" "specifications of claim." Sec. 13: "Defective or insufficient description or specification;" "claiming in his specification as his own invention;" "corrected description and specification;" "original description and specification." Sec. 15: "Description and specification;" "specification of claim," etc. An examination of the context in which these phrases occur renders it perfectly apparent that "specification" signifies the Claim as distinguished from the Description.

In Wilson *v.* Coon (1880), 18 Blatch. 532, Blatchford, J.: (536) "The provision of Sec. 13 of the act of 1836 was that a patent might be re-issued when it was "inoperative or invalid by reason of a defective or insufficient description or specification," and the new patent was to be issued with a corrected "description and specification." This language was based on that of Sec. 6 of the act of 1836, which required the inventor to give in writing a description of his invention and of the manner of making and using it, and also to "particularly specify and point out" what he claimed as his invention. Under this language the "specification was the Claim, and the rest was the description." 6 Fed. Rep. 611 (616); 19 O. G. 482 (483).

§ 656. Re-issues under the Act of 1836: Variations from the Act of 1832.

The language of the act of 1836 in reference to re-issues limited their allowance to cases where a patent was "inoperative or invalid, by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification, as his own invention, more than he had, or shall have, a right to claim as new."[1] Of the import of this language two different views have been taken. It has been held, on the one hand, that the words "description" and "specification" are synonymous and are applied to the delineation of the invention given for the information of the public; that any mistake or insufficiency in this delineation is remediable by re-issue; that the only form of defective Claim which is recognized by the statute or is therein made curable by a re-issue is an excessive Claim; and consequently that a too restricted Claim, though it may wholly fail to afford the patentee that protection which the law endeavors to confer upon him, cannot be so corrected and enlarged as to secure to him the actual invention except by virtue of the general provisions of the law or under the doctrines applied to similar cases in courts of equity.[2] On the other hand, it

§ 656. [1] Act of 1836, Sec. 13.

[2] In Mahn *v.* Harwood (1884), 112 U. S. 354, Bradley, J.: (362) "The truth is (as was shown in Miller *v.* The Brass Company) that this class of cases, namely, re-issues for the purpose of enlarging and expanding the Claim of a patent, was not comprised within the literal terms of the law which created the power to re-issue patents." 30 O. G. 657 (659).

In Miller *v.* Brass Co. (1881), 104 U. S. 350, Bradley, J.: (352) "The power given by the law to issue a new patent upon the surrender of the original, for the correction of errors and mistakes, has been greatly misunderstood and abused. It was first contained in the act of July 3, 1832, c. 357; and the law was adopted in view of suggestions made in several judgments of this court. But it was carefully confined to cases where the patent was invalid or inoperative by reason of a failure to comply with any of the terms and conditions prescribed by the law for giving a clear and exact description of the invention, and where such failure was due to inadvertence, accident, or mistake, without any fraudulent or deceptive intention. This being shown, a new patent, with a correct specification, was authorized to be issued for the same invention. The act of July 4, 1836, c. 45, enlarged the power to grant re-issues by adding an additional ground for re-issue; namely, that the patentee had inadvertently claimed in his specification, as his own invention, more than he had a right to claim as new. And, with that addition, the law has continued substantially the same to the

has been declared that the words "description" and "specification" relate to two distinct portions of an entire instru-

present time. The fifty-third section of the act of 1870, c. 230, which was the law on this subject when the re-issue in the present case was granted, is in the following words: 'Whenever any patent is inoperative or invalid by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent, and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee.' It will be observed that while the law authorizes a re-issue when the patentee has claimed too much, so as to enable him to contract his Claim, it does not, in terms, authorize a re-issue to enable him to expand his Claim. The great object of the law of re-issues seems to have been to enable a patentee to make the description of his invention more clear, plain, and specific, so as to comply with the requirements of the law in that behalf, which were very comprehensive and exacting. The third section of the act of 1793, c. 11, required an applicant for a patent 'to deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same. And in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions; and he shall accompany the whole with drawings and written references, where the nature of the case admits of drawings.' This careful and elaborate requirement was substantially repeated in the sixth section of the act of 1836, with this addition: 'And shall particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery.' Although it had been customary to append a Claim to most specifications, this was the first statutory requirement on the subject. It was introduced into the law several years subsequently to the creation of re-issues; and it was in the thirteenth section of this act of 1836 that provision was made for a re-issue to correct a Claim which was too broad in the original. Now, in view of the fact that a re-issue was authorized for the correction of mistakes in the specification before a formal Claim was required to be made, and of the further fact that when such formal Claim was required express power was given to grant a re-issue for the purpose of making a Claim more narrow than it was in the original, without any mention of a re-issue for the purpose of making a Claim broader than it was in the original, it is natural to conclude that the re-issue of a patent for the latter purpose was not in the mind of Congress when it passed the laws in question. It was probably supposed that the patentee would never err in claiming too little. Those who have any experience in business at the Patent Office know the fact that the constant struggle between the Office and applicants for patents has reference to the Claim. The patentee seeks the

ment, — the former being the Description proper, the latter what is now known as "the Claim;" that a patent is in-

broadest Claim he can get. The Office, in behalf of the public, is obliged to resist this constant pressure. At all events, we think it clear that it was not the special purpose of the legislation on this subject to authorize the surrender of patents for the purpose of re-issuing them with broader and more comprehensive Claims, although, under the general terms of the law, such a re-issue may be made where it clearly appears that an actual mistake has inadvertently been made. But by a curious misapplication of the law it has come to be principally resorted to for the purpose of enlarging and expanding patent Claims. And the evils which have grown from the practice have assumed large proportions. Patents have been so expanded and idealized, years after their first issue, that hundreds and thousands of mechanics and manufacturers, who had just reason to suppose that the field of action was open, have been obliged to discontinue their employments, or to pay an enormous tax for continuing them. Now, while, as before stated, we do not deny that a Claim may be enlarged in a re-issued patent, we are of opinion that this can only be done when an actual mistake has occurred, not from a mere error of judgment (for that may be rectified by appeal), but a real *bona fide* mistake, inadvertently committed, such as a court of chancery, in cases within its ordinary jurisdiction, would correct. Re-issues for the enlargement of Claims should be the exception and not the rule; and when, if a Claim is too narrow, — that is, if it does not contain all that the patentee is entitled to, — the defect is apparent on the face of the patent and can be discovered as soon as that document is taken out of its envelope and opened, there can be no valid excuse for delay in asking to have it corrected. Every independent inventor, every mechanic, every citizen, is affected by such delay, and by the issue of a new patent with a broader and more comprehensive Claim. The granting of a re-issue for such a purpose after an unreasonable delay is clearly an abuse of the power to grant re-issues, and may justly be declared illegal and void. It will not do for the patentee to wait until other inventors have produced new forms of improvement, and then, with the new light thus acquired, under pretence of inadvertence and mistake, apply for such an enlargement of his Claim as to make it embrace these new forms. Such a process of expansion, carried on indefinitely, without regard to lapse of time, would operate most unjustly against the public, and is totally unauthorized by the law. In such a case, even he who has rights and sleeps upon them justly loses them." 21 O. G. 201 (202).

The statements contained in the foregoing extract are responsible for the widely-spread impression that the case of Miller *v.* Brass Co. introduced radical changes into the law of re-issues. But the case itself, taken as a whole, warrants no such impression. In view of the facts apparent on the record, the judgment of the court was eminently just. The conclusions of the learned judge who delivered the opinion, — that a re-issue is proper only where the defect to be amended was "a *bona fide* mistake inadvertently committed;" that an unreasonable delay in applying for a re-issue indicates that the allegation of original "inadvertence or mistake is a mere pretence;" that when the defect is evident on an inspection of the patent, as is usually the case where it consists in an undue restriction of the

operative or invalid when either the Description or the Claim is defective or insufficient, or when the Claim ex-

Claim, any avoidable delay is unreasonable, — are supported not only by sound reason and the general analogies of the law, but by an almost unbroken current of judicial decisions. In reaching these conclusions, however, the court pursues the novel line of argument set forth in the passage above quoted, and seems to find the ground for its refusal to recognize the re-issued patent in the equitable doctrine that laches may forfeit an existing right, rather than in the rule of Patent Law that laches in re-issuing is inconsistent with the original existence of the right itself. An analysis of this argument results in the following propositions :—

(1) That prior to the act of 1836 the law did not require a formal Claim of the invention to be inserted in the specification.

(2) That prior to this act, therefore, the errors contemplated by the law governing re-issues, and curable by that mode of amendment, were errors in the Description, not the Claim.

(3) That when the Claim was made an essential part of the specification the law of re-issues was enlarged to embrace errors arising in the Claim.

(4) That as this extension of the law of re-issues expressly related only to errors consisting in an excess of Claim, it impliedly excluded from the operation of that law all errors which result from an undue restriction of the Claim.

(5) That, being thus excluded, the correction of an unduly restricted Claim is not within the special purpose of the legislation concerning re-issues; and, though permitted, must find its warrant in the general terms of the law and in the principles of equity.

(6) That the correction of restricted Claims is, therefore, lawful only where a court of chancery, if the case were within its jurisdiction, would order the amendment; and though otherwise proper, may be refused whenever the patentee has slept upon his rights or when the interests of others would be unjustly prejudiced by the re-issue.

In the case under consideration the final judgment must have been the same whether attained by this mode of reasoning or by that which, treating the correction of restricted Claims as within the ordinary amending powers conferred by the statutes, regards unreasonable delay, etc., as bearing only upon the question of original inadvertence or mistake. The same would probably be true in nearly every case where the lawfulness of a re-issue was to be determined by the Patent Office or the courts. But since the propositions above enumerated in effect transfer this class of re-issues from the statutory jurisdiction of the Patent Office to the chancery jurisdiction of the courts, and render their validity dependent not merely on the conditions named in the statute but on the equities arising after the issue of the patent, thus opening a wide and deep gulf of separation between these re-issues and all others; and since these several propositions, taken as the statement of special doctrines of Patent Law, have led to decisions in many later cases which are evidently erroneous in principle; — it is important that so far as they are incorrect they should be, if possible, refuted. The fundamental error seems to reside in the deduction drawn in the second proposition from the fact stated in the first. It is true that before the act of 1836 the law did not require a *formal* Claim to be inserted in the specification; but it does not follow from this that under the provisions of preceding statutes no claim

ceeds the limits of the actual invention; and consequently that whatever may be the nature of the error, or in whatever

was necessary, or that the modes therein prescribed for avoiding or correcting errors applied solely to the Description as distinguished from the Claim. On the contrary, a claim in some form has always been an essential feature of the specification. Whether couched in words of petition or in words of grant, whether incorporated in the general description or constituting an independent clause, this definition and assertion of the exclusive right of the inventor was never absent from the instrument creating his monopoly. Moreover, this statement of his claim has always been liable to the same defects, both of undue restriction and undue excess, resulting in the partial or entire destruction of his rights, and the amending power was thus as indispensable to him for the correction of imperfect claims as for the removal of obscurities from his description. Hence, as this power was granted professedly for his protection, it might safely be assumed that an amendment by enlarging restricted claims in order that they may include the whole invention, or by restricting claims to exclude what he had at first improperly embraced, should be as lawful and as readily permitted as the substitution of a clearer or a more complete description. Our courts proceeded upon this assumption before the act of 1832 was passed. In Morris *v.* Huntington (1824), 1 Paine, 348, Thompson, J. advances the opinion that where the patentee has claimed too much he may surrender, and take out an amended patent. In Grant *v.* Raymond (1832), 6 Peters, 218, the amendment which the court sustained was an enlargement of the Claim; and in the decision, Marshall, C. J., states that both the statutes which confer the patent, and the amending power which corrects its inadvertent errors, have for their chief object the protection of the inventor in the enjoyment of his actual invention; replying to the argument that by such amendments public interests are prejudiced by saying: "the communication of the discovery to the public has been made in pursuance of law with the intent to exercise a privilege which is the consideration paid by the public for the future use of the machine. If, by an innocent mistake, the instrument introduced to secure this privilege fails in its object, the public ought not to avail itself of this mistake, and to appropriate the discovery without paying the stipulated consideration. The attempt would be disreputable in an individual, and a court of equity might interpose to restrain him." The act of 1832 was enacted, as Baldwin, J., declares in McClurg *v.* Kingsland (1843), 1 How. 202, affirmance of the principles laid down in Grant *v.* Raymond and other cases. Among the re-issues while this statute was in force, was that involved in Stimpson *v.* Westchester R. R. Co. (1846), 4 How. 380, in which the claims of the patent had been enlarged by including an element referred to in the original Description but omitted from its Claim. The Supreme Court, through McLean, J., held that this enlargement of the Claim did not, as matter of law, invalidate the re-issue. These cases, as well as the reason of the law itself, sufficiently demonstrate that before the act of 1836, though no "formal Claim" was required by law, the existence of the claim, its susceptibility to error, and the power to amend it by restriction or extension as might be necessary to render the patent valid and operative in the interest of the inventor, were as clearly recognized as by any subsequent statute or decision. Indeed, this entire

part of the instrument it may occur, the statute provides for

portion of the argument appears to rest upon a misconception of the act of 1832 in its relation to the act of 1793, and of the true meaning of the term "specification" as it is employed in the act of 1836. See § 654, *ante*.

With the demolition of this fundamental error, the other portions of the argument also fall. If the Claim in some form had always been a feature of the specification, and if its faults of excess or deficiency were amendable by re-issue under and prior to the act of 1832, evidently no extension of the law of re-issues was intended or effected by the enumeration in the act of 1836 of the excessive Claim among the subjects of amendment. And if no such extension of the law occurred, there is no ground for the inference contained in the fourth proposition that a restricted Claim is not among the faults which a re-issue was expressly designed to cure, or for that in the fifth which bases the privilege of re-issuing in these cases upon general principles, and by the operation of the sixth imposes upon them conditions which are foreign to re-issues for the removal of other unintentional defects.

The extent to which these controverted opinions have been shared or adopted may be seen in the cases cited in the remaining portion of this note. It may fairly be questioned whether in most of them the position taken on this subject represents the deliberate judgment of the court. The ease with which sweeping statements, shorn of all qualifying phrases, are caught up and enunciated, especially in the reasonings as distinguished from the final decision of a judge, may account for what seems a striking departure from the general current of authority as exhibited in the succeeding note. In several of these cases, also, there are other statements which clearly show that the court had no intention to deny the right to correct an unduly restricted Claim in the same manner and upon the same conditions as any other defect occurring in the specification.

That a re-issue is not allowed except to give a more perfect description of the invention intended to be claimed in the original patent, or to narrow an excessive Claim, see Giant Powder Co. *v.* California Vigorit Powder Works (1880), 6 Sawyer, 508; 18 O. G. 1339; 4 Fed. Rep. 720; Knight *v.* Baltimore & Ohio R. R. Co. (1840), 3 Fisher, 1; Taney, 106.

That a re-issue cannot enlarge or expand the Claims of the original, see Dunbar *v.* White (1883), 15 Fed. Rep. 747; 23 O. G. 1446; Nye *v.* Allen (1883), 15 Fed. Rep. 114; 23 O. G. 2328; Fay *v.* Preble (1882), 14 Fed. Rep. 652; Moffitt *v.* Rogers (1882), 106 U. S. 423; 23 O. G. 270; New *v.* Warren (1882), 22 O. G. 587; James *v.* Campbell (1881), 104 U. S. 356; 21 O. G. 337.

That a re-issue cannot claim what is described but not claimed in the original, see Reed *v.* Chase (1885), 25 Fed. Rep. 94; 33 O. G. 996; *Ex parte* Pfaudler (1882), 22 O. G. 1881.

That it is the office of a re-issue to correct a Claim, not to enlarge it, see Russell *v.* Dodge (1876), 93 U. S. 460; 11 O. G. 151.

That the enlargement of the Claims of the original makes a re-issue void, as against the public as well as against intervening patentees, see Dunbar *v.* White (1883), 15 Fed. Rep. 747; 23 O. G. 1446.

The numerous cases, found in the notes to ensuing paragraphs, which assert that unreasonable delay, or the existence of intervening rights, or the

its amendment by re-issue.[3] That the latter view is the true one there are several indications in the body of the act itself.

appropriation of the unclaimed matter by the public, etc., work a forfeiture of the patentee's right to a re-issue, generally draw their erroneous doctrine from the same source, regardless of the principle that a privilege conferred by the statutes upon certain conditions cannot be abrogated by the courts if those conditions are fulfilled, whatever power the courts may have to determine by what kind and degree of evidence their fulfilment must be proved.

[3] In Odell *v.* Stout (1884), 22 Fed. Rep. 159, Sage, J.: (162) "It is to be kept in mind, however, that enlarging the Claim may be an entirely different thing from broadening the invention. He may, under proper circumstances, so enlarge his Claim as to make it extend to the limits of his invention, but he is bound by those limits. He may not enlarge the invention. . . . (164) Upon the authority of these cases it is clear that the Claim of a patent may be enlarged by a re-issue, if the patentee move promptly and no rights of others have intervened; and we are of opinion that in this case the delay was not unreasonable." 29 O. G. 862 (863).

In Combined Patents Can Co. *v.* Lloyd (1882), 21 O. G. 713, Butler, J.: (714) "That this statute authorizes the insertion of new Claims, founded on the original invention as exhibited by the specifications or drawings, in re-issues when the omission results from 'inadvertence, accident, or mistake,' and where the claimant has not by some act or omission estopped himself from exercising the right to amend, has been uniformly held, not only by the several circuit courts, but by the Supreme Court also. In Seymour *v.* Osborne (11 Wall. 516), the latter court said: 'Power is unquestionably conferred upon the Commissioner to allow the specifications to be amended if the patent is inoperative or invalid, and in that event to issue the patent in proper form; and he may under that authority allow the patentee to redescribe his invention and to include in the Description and Claims of the patent not only what was well described before, but whatever else was suggested or substantially indicated in the specifications or drawings which properly belonged to the invention as actually made and perfected.' The re-issue there involved, it is true, antedated the statute now in force, but as respects the question here involved this is unimportant, as before indicated. In the last cases in which this subject is discussed (Miller & Co. *v.* The Brass Company, and James *v.* Campbell *et al.*) . . . the right to insert new and enlarged Claims is clearly stated. In the first of these cases the court says: 'If a patentee who has no corrections to suggest in his specifications except to make his Claims broader and more comprehensive, uses due diligence in returning to the Patent Office, and says, "I omitted this," or "my solicitor omitted that," his application may be entertained, and on proper showing correction may be made.' And again, 'While, as before stated, we do not deny that a Claim may be enlarged in a re-issued patent, we are of opinion that this can only be done where an actual mistake has occurred, . . . a real *bona fide* mistake, inadvertently committed, such as a court of chancery in cases within its ordinary jurisdiction would correct. Re-issues for the enlargement of Claims should be the exception.' In the last of these cases it is said, 'Of course, if by actual inadvertence, accident, or mistake, innocently committed, the Claim does not fully assert or define the patentee's right in the invention specified in the patent, a speedy appli-

In the first place, this view gives full effect to the language of the act in reference to this subject. It preserves the distinc-

cation for its correction before adverse rights have accrued may be granted, as we have explained in the recent case of Miller *et al. v.* The Brass Company.'" 11 Fed. Rep. 149 (150); 15 Phila. 481 (482).

See also James *v.* Campbell (1881), 104 U. S. 356; 21 O. G. 337.

In Marsh *v.* Seymour (1877), 97 U. S. 348, Clifford, J.: (355) "Patents, in a proper case, may be surrendered and re-issued, but the re-issued patent must be for the same invention as the original patent, else the re-issue is invalid; but the patentee may redescribe his invention, and include in the Description and *Claims* of the *specification* not only what was well described before, but whatever else was suggested or substantially indicated in the old specification, drawings, or Patent-Office model, which properly belonged to the invention as actually made and perfected. Corrections may be made in the Description, specification, or Claims of the patent where the patentee has claimed as new more than he had a right to claim, or where the Description, specification, or Claim is defective or insufficient; but he cannot, under such an application, make material additions to the invention which were not described, suggested, nor substantially indicated in the original specifications, drawings, or Patent-Office model." 13 O. G. 723 (725).

In Welling *v.* Rubber-Coated Harness Trimming Co. (1875), 2 Bann. & A. 1, Nixon, J.: (4) "It is a well-settled principle that a patentee may so limit his Claim as to deprive himself of the full benefit of his invention or discovery. It was to remedy such a difficulty or omission that the privilege of surrender and re-issue was granted in the Patent Laws. Patentees often fail to realize any substantial advantage from some of the most useful inventions owing to their too narrow Claims, until such surrender, amendment, and re-issue have been made." 7 O. G. 608 (609).

In Calkins *v.* Bertraud (1875), 2 Bann. & A. 215, Blodgett, J.: (217) "This re-issue was made on the 26th of April, 1870, and while the Patent Office was acting under the law of 1836, as amended. . . . This law has been construed to authorize a patentee to claim on a re-issue whatever shall clearly appear to have been a part of his original invention as described or shown in his original specifications, drawings, or models. There are ample authorities upon that point construing the act of 1836 with amendments up to 1861, in that regard, and giving the inventor the right to a re-issue where the new Claim is clearly justified by his drawings, or specifications, or models, or either, and allowing him to amend his specifications, if necessary, so as to cover more fully what, upon experience, has proven to be a meritorious part of his invention. Battin *v.* Taggert, 17 How. 74; Gallahue *v.* Butterfield, 10 Blatchf. C. C. R. 232; Wheeler *v.* Clipper Co., 6 Fisher, 1; Seymour *v.* Osborne, 11 Wall. 544." 6 Bissell, 494 (496); 9 O. G. 795 (796).

In Wells *v.* Jacques (1874), 1 Bann. & A. 60, Nixon, J.: (68) "With regard to the first objection, it is undoubtedly true that it is not the province or the design of a re-issue to enlarge the original right of the inventor, but to cure some defect arising from inadvertency or mistake, and not from fraud, in drawing the specifications or Claims of the first patent. Every inventor is entitled to the benefit of all that he invents; and if he fails, for the reason above assigned, to acquire a right to his whole invention in his letters-patent,

tion which the act evidently makes between the Description and the specification, and recognizes a defect or insufficiency

he may surrender them and have a re-issue from time to time, until his specifications and Claims cover the whole ground." 5 O. G. 364 (366).

In Blake *v.* Stafford (1868), 6 Blatch. 195, Shipman, J.: (198) "Inventors are not usually sufficiently skilled in the art of nice composition to enable them to accurately draft their own specifications. They must, therefore, resort to others; and it not unfrequently happens that the draftsman employed to describe a particular invention, either through want of skill or from haste or ignorance of the state of the art, gives, in the specification, a very imperfect description of the thing invented. He sometimes narrows the scope of the inventor's ideas and combinations, and at other times expands them over instruments and devices which are not the product of his original thoughts. He may fail to set forth some feature of the invention which at the time is deemed unimportant, and which subsequently may be proved to be vital, or at least of great value. If the invention is of considerable pecuniary consideration, the public examine it with scrutinizing eyes, and if an inch of ground within the true scope of the discovery is unoccupied by the specification, it is at once seized upon by parties to whose business the new improvement has a near relation. If a fatal or damaging error has crept into the description, that fact is soon ascertained by those who desire to avail themselves of whatever improvement has been discovered. The privilege of surrender and re-issue is, therefore, invaluable to inventors, for without it they would often lose that protection for the offspring of their skill and labor which it is the immediate object of all patent laws to afford. It is, indeed, to be regretted that so great a proportion of the industry and intellectual acumen expended upon patents should be devoted to assailing, circumventing, or defeating them, rather than to their original construction. But the greatest skill and most untiring patience would not always be able to guard against all error. The privilege of surrender and re-issue is, therefore, necessary for the protection of inventors, and the act of Congress has explicitly stated the cases to which it shall extend, and conferred upon the Commissioner the power of determining when a patentee has brought himself within its provisions." 3 Fisher, 294 (299).

In Swift *v.* Whisen (1867), 3 Fisher, 343, Leavitt, J.: (352) "On this subject I may remark in deciding what a party may claim under a re-issued patent, there has been a tendency to great liberality in the action of the courts, and it has been held that whatever was the invention of the original patentee, whether expressly claimed in the original patent or not, when incorporated in the re-issued patent, will be held to be within the Claim of the original patent, and that it is the right of the assignee or holder of the patent to claim everything that was claimed, or everything which belonged rightfully, by fair construction, to the original patentee. I may not be understood. If there is evidence that the original patentee claimed, as a part of his invention, a certain feature, or that a certain feature was a part of his invention which he omitted to claim in his specification and Claim, upon the surrender of that patent by himself, or by an assignee, he has a right to incorporate in the re-issued patent that element, though not claimed specially in the first patent. And in determining this question, that

in either as a proper matter for amendment. It treats the adjectives "defective" and "insufficient" as covering two different classes of errors, the former consisting in want of exactness, the latter in want of completeness, instead of regarding the second as a substantial repetition of the first. It makes the field of amendment commensurate with the field of error,—all possible errors being comprised in inexactness and incompleteness of the Description, and in inexactness, incompleteness, and excessiveness of the Claim. In the second

is, the substantial identity of the invention covered by the original patent with that covered and described in the re-issued patent, it is competent for the jury to look into the drawings of the original patent to determine whether the inventions are the same. The drawings, as well as the specifications, are to be looked to in giving a construction to the Claims of a patent, in determining what was the invention of the original patentee. If, for instance, 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 the re-issued patent." 2 Bond, 115 (127).

Further, that the re-issue may so enlarge or otherwise modify the Claims of the original as to secure the actual invention, see Jenkins *v.* Stetson (1887), 32 Fed. Rep. 398; Becker *v.* Hastings (1884), 28 O. G. 98; 22 Fed. Rep. 827; *Ex parte* Long (1883), 25 O. G. 1189; Crandall *v.* Watters (1881), 9 Fed. Rep. 659; 20 Blatch. 97; 21 O. G. 945; Smith *v.* Merriam (1881), 6 Fed. Rep. 713; 19 O. G. 601; Waring *v.* Johnson (1881), 19 O. G. 1068; 19 Blatch. 38; 6 Fed. Rep. 500; Miller *v.* Brass Co. (1881), 104 U. S. 350; 21 O. G. 201; Anilin *v.* Higgin (1878), 15 Blatch. 290; 14 O. G. 414; 3 Bann. & A. 462; Lorillard *v.* McDowell (1877), 2 Bann. & A. 531; 11 O. G. 640; 13 Phila. 461; Westinghouse *v.* The Gardner & Ranson Air Brake Co. (1875), 9 O. G. 538; 2 Bann. & A. 55; Seymour *v.* Marsh (1872), 2 O. G. 675; 6 Fisher, 115; 9 Phila. 380.

That a Claim is part of the specification and therefore amendable, see Smith *v.* Merriam (1881), 19 O. G. 601; 6 Fed. Rep. 713.

That an enlarged Claim is allowable in a re-issue, if there are no adverse rights to be affected by it, see Stutz *v.* Armstrong (1884), 20 Fed. Rep. 843; 28 O. G. 367; McArthur *v.* Brooklyn Railway Supply Co. (1884), 19 Fed. Rep. 263; 21 Blatch. 558.

That a re-issue is the proper mode of securing what was described but not claimed in the original patent, see Asmus *v.* Alden (1886), 27 Fed. Rep. 684; 36 O. G. 231; Hill *v.* Commissioner (1885), 33 O. G. 757; 4 Mackay, 266; *Ex parte* Cottrell, (1876), 9 O. G. 495; Richardson *v.* Lockwood (1870), 4 Clifford, 128.

That a re-issue is the only mode of securing what was accidentally omitted from the original, see Keystone Bridge Co. *v.* Phœnix Iron Co. (1877), 95 U. S. 274; 12 O. G. 980.

That an element shown but not claimed in a prior patent, yet patentable thereby if it had been claimed, can be secured by re-issue or by a separate patent, see Loring *v.* Hall (1879), 15 O. G. 471.

place, this view is in harmony with the entire tenor of the act. The act is characterized by a spirit of great liberality toward inventors. The benefits which it confers upon them are inestimable. Even in the very section which provides for a re-issue the privilege of incorporating subsequent improvements and additions into an existing patent, with the same effect in law as if embraced in the patent as originally issued, was accorded, — a privilege far beyond the scope of any conceivable amendment in the Description or Claim of the original invention; and it can scarcely be supposed that the same legislature which conferred this privilege intended to deprive inventors of that remedy for insufficient Claims which had already been found necessary by the courts and had been granted by the act of 1832. In the third place, this view is the only one under which the remedy by re-issue is of any practical advantage to inventors. The value of a patent to the patentee depends upon the completeness with which it protects his actual invention, and as the limits of the protection are fixed by the Claim, a mistake by which the Claim is unduly restricted is, more than any other error, injurious to the inventor, and in his interest more imperatively demands correction. To permit him to amend by giving more specific information to the public, or by narrowing the Claims of his original patent, or by stating in more precise language the Claim that he has already made to the invention, affords him no adequate relief against the evils that inevitably arise out of the inherent difficulty which attends the endeavor to put into words a complete delineation of those essential characteristics in which the identity and individuality of the invention reside. If in any portion of the instrument error is likely to occur it is here; and if any error seriously prejudices his interests it is the one by which his patent is made narrower than his invention. And hence, if any error ought to be corrected, when occurring without wilful fault on his part, it is the one whereby he is deprived of that right to which he is entitled both by the spirit and the letter of the law. For these three reasons, and others which a careful study of the act itself suggests, it seems that of the two views of the rule above described the latter is correct; and that this act con-

fers the privilege of a re-issue whenever the Description or the Claim is inexact or incomplete, or when the Claim is broader than the actual invention, provided the error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention.[4]

§ 657. Re-issues under the Act of 1870 and the Revised Statutes of 1874.

Under the act of 1870 and the Revised Statutes, the law governing re-issues is the same as under the act of 1836. The phraseology of these later acts differs from that of the earlier in some unimportant respects, but it is evident that no intent to change the rules existed at the passage of these statutes, and that the language used was regarded as substantially identical with that of the former act.[1] This being the case, the law may now be considered as providing for

[4] That both the Description and the Claims may be corrected by re-issue, see Sewing Mach. Co. *v.* Frame (1884), 24 Fed. Rep. 596 ; 28 O. G. 96 ; Hailes *v.* Albany Stove Co. (1883), 16 Fed. Rep. 240 ; 24 O. G. 391 ; 21 Blatch. 271 ; Wilson *v.* Coon (1880), 6 Fed. Rep. 611 ; 19 O. G. 482 ; 18 Blatch. 532 ; Anilin *v.* Higgin (1878), 14 O. G. 414 ; 15 Blatch. 290 ; 3 Bann. & A. 462 ; Tucker *v.* Tucker Mfg. Co. (1876), 10 O. G. 464 ; 4 Clifford, 397 ; 2 Bann. & A. 401 ; Carew *v.* Boston Elastic Fabric Co. (1871), 3 Clifford, 356 ; 5 Fisher, 90 ; 1 O. G. 91 ; Batten *v.* Taggert (1854), 17 How. 74.

§ 657. [1] Act of 1870, Sec. 53 : "That 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," etc. Act of 1836, Sec. 13 : "That whenever any patent . . . shall be inoperative or invalid, by reason of a defective or insufficient [description or] specification, or by reason of the patentee claiming [in his specification] as his own invention more than he had or shall have a right to claim as new," etc. The difference between these two provisions consists simply in the omission from the act of 1870 of the words here included in brackets in the act of 1836. The change is evidently verbal, not substantial. The word specification is used in its modern sense as covering the Description as well as the Claim, and the patent is treated as a proper subject for re-issue when either is defective or insufficient. That this alteration in language was not intended to limit re-issues to cases where the Description as distinguished from the Claim is defective or insufficient appears from the final clause of Sec. 53, which permits the introduction into the re-issue specification of matter wholly omitted from the original, upon proof that it constituted part of the original invention, and was omitted by inadvertence, accident, or mistake. The Revised Statutes, Sec. 4916, follow the act of 1870, Sec. 53, so far as this point is involved. See Wilson *v.* Coon (1880), 6 Fed. Rep. 611; 19 O. G. 482; 18 Blatch. 532.

the re-issue of a patent whenever it becomes necessary to amend either the Description or the Claim in order to make the actual invention accessible to the public, or to afford it that complete and exact protection to which its inventor is entitled.[2]

§ 658. Conditions of Re-issue the Same under all the Foregoing Statutes.

The conditions upon which an amendment by re-issue might be made have remained the same under all these statutes. These are that the defect or insufficiency should have arisen through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. A defective or insufficient statement, purposely inserted with intent to deceive the public, is regarded as a fraud which vitiates the entire patent and justly forfeits all right of the inventor to any consideration from the government. Such a statement cannot be amended in any form. A defective or insufficient statement, occurring otherwise than through inadvertence, accident, or mistake, is also not amendable. "Inadvertence" signifies want of attention; "mistake," want of knowledge; "accident," circumstances against which the inventor cannot guard. A statement, made without inadvertence, accident, or mistake, is a statement made voluntarily and with sufficient knowledge and attention. If a statement thus made in the Description is defective or insufficient, the inventor is guilty of wanton negligence, if not of fraud, and certainly ought not to be permitted to amend. If a statement thus made in the Claim is incomplete, the inventor is precluded from correcting it on the ground that he has either abandoned the unclaimed matter to the public, or has excluded it from the present monopoly and reserved it for the protection of an independent patent. If the Claim is wilfully and with knowledge and attention made obscure or broader than his actual invention, it is evidently fraudulent and void. Of these questions of inadvertence, accident, mistake, and fraud, the Patent Office is to judge upon an application for re-issue; though where an

[2] See Sec. 656, note 3, *ante*, for cases on this subject decided since the passage of the act of 1870.

alleged incompleteness in the Claim is so apparent upon a comparison of the Description with the Claim that it could not have occurred involuntarily or through any want of knowledge or attention, or where unreasonable delay in obtaining a re-issue, or other circumstances in the history of the application or the patent, show that no inadvertence, accident, or mistake could have originally existed, the courts regard it as conclusive evidence that the inventor intended to exclude from his original patent all that was not duly claimed, and treat a re-issue which endeavors to reclaim it as to that extent invalid.

§ 659. The Fundamental Principles Governing Amendment by Re-issue Reducible to Four Propositions.

This review of the historical development of the subject of re-issues suggests the following propositions as representing the present doctrines of the law in reference thereto:[1] (1) That the sole object of a re-issue is to so amend an imperfect existing patent that it may disclose and protect the patentable subject-matter which it was the purpose of that patent to secure to its inventor; (2) That being the amendment of an existing patent, and not the grant of a new patent, it must be confined to the invention which the patentee attempted

§ 659. [1] The first three of these propositions express the fundamental conditions of amendment by re-issue, the absence of any one of which is a perfect bar to its allowance. The original patent must be an existing patent, otherwise there is nothing to amend; and it must be an imperfect patent, otherwise there can be no defect requiring an amendment. The subject-matter of the amendment must be the invention which the patentee endeavored to describe and claim in the original patent, otherwise the re-issue would be a new patent for a different invention, and not a mere amendment of the old. The defect must have occurred through inadvertence, accident, or mistake, and without fraud, or the pretended amendment would, in the first case, be a reclamation of matter already voluntarily excluded from the patent; or in the second, the original patent, and therefore the re-issue, would be wholly void. The absence of either one of these conditions is thus fatal to the re-issue. If two or all of them are wanting, the effect on the re-issue is the same. Hence it makes no stronger case against a re-issued patent to combine objections based upon the failure of these requisites than if one alone were proved. Caution to this effect would be unnecessary were not many decisions to be found in which the concurrence of these faults is given as the reason for rejecting the re-issue, — as if a partial one could be supported by the existence of the others, or as if one alone were not sufficient to render it invalid.

to describe and claim in his original patent; (3) That this amendment cannot be allowed unless the imperfections in the original patent arose without fraud, and from inadvertence, accident, or mistake; (4) That when the amendment is allowable it can be made in any form and to any extent that may be necessary to render the patent effective for the protection of the original invention. The discussion of these propositions, and of the proceedings in obtaining a re-issue, will occupy the remainder of this section.

§ 660. First Proposition: Sole Purpose of a Re-issue is to so Amend an Imperfect Patent that it may Protect the Patentable Subject-Matter which the Original Patent Attempted to Secure to its Inventor.

The truth of the first proposition,— that the sole purpose of a re-issue is to amend an imperfect patent in order that it may disclose and protect the proper subject-matter of the original patent — is self-evident. Being the method of amending a patent it pre-supposes a patent to amend. A patent void *ab initio* from any cause, as where it issues on a false oath of citizenship, or to alleged joint-inventors for a sole invention, is not an existing patent nor capable of becoming one by any process of amendment.[1] Whatever remedy there may be in such a case must be sought by an application for new letters-patent, not by a re-issue of the old. A perfect patent requires no re-issue. Changes in its language cannot

§ 660. [1] That a void patent cannot be re-issued, see Marsh *v.* Nichols (1883), 15 Fed. Rep. 914; 24 O. G. 901; *Ex parte* Benton (1882), 23 O. G. 341; Child *v.* Adams (1854), 1 Fisher, 189; 3 Wall. Jr. 20.

That where the defect in the original consists in a false oath of citizenship, it is void and cannot be re-issued to cure the defect, see Child *v.* Adams (1854), 1 Fisher, 189; 3 Wall. Jr. 20.

That a patent issued on an application signed and sworn to in blank, and afterwards filled out by the attorney, is void, and cannot be re-issued, see *Ex parte* Benton (1882), 23 O. G. 341.

That a joint patent for a sole invention being invalid no re-issue of it can be granted, see *Ex parte* Benton (1882), 23 O. G. 341; *Ex parte* Boursaloux (1878), 14 O. G. 233.

That if it appears on the face of the re-issue application that the original patent was void, the application will be dismissed, see *Ex parte* Benton (1882), 23 O. G. 341.

That an expired patent cannot be re-issued, see *Ex parte* Siemens (1877), 11 O. G. 1107; *Ex parte* Pulvermacher (1876), 10 O. G. 2.

be amendments unless the language were before defective, and though the former patent may have been surrendered and a new one has been granted by the Patent Office, yet if the former needed no amendment, the two are in all respects substantially the same, and the last is a mere duplication of the other.[2] An existing imperfect patent is thus the sole subject for a re-issue. The defects by which an existing patent can be rendered imperfect are specified by the statutes as any invalidity or inoperativeness arising from inexactness or incompleteness in the Description, or from inexactness, or

[2] By a "perfect patent," as the phrase is here employed, is meant a patent which completely covers and protects the *invention* which the patentee endeavored to secure. As appears hereafter in this paragraph, a patent may be perfect *in itself*; *i. e.*, it may cover patentable subject-matter and be free from all ambiguity, and thus be valid and operative when judged by the standard of such patentable subject-matter, and yet be wholly invalid and inoperative when measured by the actual invention which it was intended to include. That in this case the patentee is entitled to a re-issue cannot now be doubted. See notes 5 and 6, *post*. Certain decisions, however, are reported in which the power of the Commissioner to re-issue a patent that is valid and operative in itself seems to be denied, and in some of these the courts are said to have authority to review the judgment of the Commissioner on this point, and, on finding the original patent perfect *per se*, to declare the re-issue void. See § 714 and note, *post*.

Thus that no re-issue is proper unless the original is inoperative or invalid for a defective specification, or claims too much, and if the original shows on its face that this is not so, the re-issue will be void, see James *v.* Campbell (1881), 104 U. S. 356; 21 O. G. 337; Flower *v.* Rayner (1881), 19 O. G. 425; 5 Fed. Rep. 793; Giant Powder Co. *v.* California Powder Works (1875), 3 Sawyer, 448; 2 Bann. & A. 131; Burr *v.* Duryee (1863), 1 Wall. 531.

That where the original is valid and operative to the extent of its Claim, there is no reason for the re-issue and the re-issue is void, see Giant Powder Co. *v.* California Vigorit Powder Co. (1880), 18 O. G. 1339; 4 Fed. Rep. 720; 6 Sawyer, 508.

That where the only difference between the original and the re-issue is that the re-issue specification has the broader scope, the original would be valid if the re-issue is, and hence there was no reason for the re-issue and the re-issue will be void, see Giant Powder Co. *v.* California Vigorit Powder Co. (1880), 18 O. G. 1339; 4 Fed. Rep. 720; 6 Sawyer, 508.

As shown in § 714 and note, these positions are not correct. A re-issue cannot be held void even on the ground that it apparently reproduces the original patent, the decision of the Commissioner on the necessity for a re-issue being final. And that the validity and operativeness of the original patent, with reference to one invention, constitute no bar to its re-issue whenever the monopoly which it defines is not co-extensive with that which the patentee intended and attempted to secure, is evidenced by numerous decisions hereafter cited. See also Smith *v.* Merriam (1881), 6 Fed. Rep. 713; 19 O. G. 601.

incompleteness, or excess in the Claim. By enumerating these the statutes exclude all others, and confine the remedy to these alone.[3] "Invalidity" is any defect on account of which a patent might be declared invalid by the courts. It occurs whenever the Description is not sufficiently precise and complete to enable persons skilled in the art to practise the invention, or where the Claim is broader than the actual invention.[4] "Inoperativeness" is any defect, by reason of which the patent fails to give to the invention the protection which it was intended to afford. This occurs whenever the Claim is so obscure or so restricted that the exact limits of the invention entitled to protection are not clearly and correctly defined. In judging as to the existence of these defects, the nature of the invention which the patent was intended to protect must be kept constantly in view. A patent may be valid and operative as to one invention and not as to another. Thus where an invention is reached by several steps, or is composed of several parts, each of which is a separate invention, either of these may be sufficiently described and claimed, and yet the patent be invalid and inoperative as to the principal invention which it was chiefly intended to secure. That a patent is valid and operative to the extent that it discloses and protects some patentable invention does not, therefore, render it a perfect patent.[5] The object of the in-

[3] In Giant Powder Co. *v.* California Vigorit Powder Co. (1880), 6 Sawyer, 508, Field, J.: (520) "As thus seen, a re-issue can only be had when the original patent is inoperative or invalid from one of two causes, — either 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. And even then the patentee can only obtain a re-issue where the error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention." 4 Fed. Rep. 720 (723); 18 O. G. 1339 (1340).

That the provisions of the statute defining the conditions under which a patent may re-issue impliedly forbid it under any other conditions, see *Ex parte* Whitely (1886), 36 O. G. 1243; Child *v.* Adams (1854), 1 Fisher, 189; 3 Wall. Jr. 20.

[4] That where the Description is not full and clear a re-issue is needed, see Sewing Mach. Co. *v.* Frame (1884), 28 O. G. 96; 24 Fed. Rep. 596.

[5] In Giant Powder Co. *v.* Safety Nitro Powder Co. (1884), 10 Sawyer, 23, Sawyer, J.: (24) "A patent may be inoperative in my judgment, when it is inoperative in part. I do not think it must be absolutely inoperative in its entirety. If it is inoperative so far as not to cover all that the party is entitled

ventor in procuring it, and of the government in granting it, was to render accessible to the public, and for the time being to secure to the inventor, a specific invention or group of inventions, and if the patent, as it stands, does not accomplish this object it is invalid and inoperative within the meaning of the law, and may be amended by re-issue.[6]

§ 661. Failure to Describe or Claim Matter outside the Invention not a Defect in the Patent.

It is obvious that no patent can be invalid and inoperative by reason of its failure to describe and claim matter lying outside the limits of that invention which, having been conceived by the inventor and reduced to practice, the govern-

to claim, and what he is entitled to claim appears in the specifications, it being inoperative to that extent, I think it would be inoperative within the meaning of the provisions of the statute, and entitle the party to a re-issue covering his entire invention." 19 Fed. Rep. 509 (510); 27 O. G. 99 (100).

In Wilson *v.* Coon (1880), 18 Blatch. 532, Blatchford, J.: (536) "A patent may be inoperative from a defective or insufficient description, because it fails to claim as much as was really invented, and yet the Claim may be a valid Claim, sustainable in law, and there may be a description valid and sufficient to support such Claim. In one sense such patent is operative and is not inoperative; yet it is inoperative to extend to or claim the real invention, and the description may be defective or insufficient to support a Claim to the real invention, although the drawings and model show the things in respect to which the defect or insufficiency of description exists, and show enough to warrant a new Claim to the real invention. It can never be held, as it never has been held in a case where the point arose for decision, that a patent cannot be re-issued where a suit could be sustained on the specification and Claim as they were." 6 Fed. Rep. 611 (615); 19 O. G. 482 (483).

See also Hartshorn *v.* Eagle Shade Roller Co. (1883), 18 Fed. Rep. 90; 25 O. G. 1191.

That "not fully operative" is "inoperative," see Hartshorn *v.* Eagle Shade Roller Co. (1883), 25 O. G. 1191; 18 Fed. Rep. 90.

That a specification may be inoperative as to some parts of the invention and not as to others, and its inoperativeness as to the others may not have been discovered until long after its issue, see Thomson *v.* Wooster (1885), 114 U. S. 104; 31 O. G. 913.

That where the original patent is ambiguous and on that account inoperative, it may be explained by a re-issue if the Commissioner is satisfied that the inventions are the same, see *Ex parte* Gottstein (1877), 11 O. G. 1061.

[6] That where the Claims of the original patent were unnecessarily restricted, the re-issue may correct them and cover the whole invention, see Schuessler *v.* Davis (1878), 13 O. G. 1011.

That a re-issue is proper when the specification is imperfect, though the drawings and model are perfect, see Wilson *v.* Coon (1880), 6 Fed. Rep. 611; 18 Blatch. 532; 19 O. G. 482.

ment, by issuing that patent, originally endeavored to protect. If the idea of means had possibilities of further development or application, which the inventor did not then perceive, these did not enter into his actual invention. If his idea, as already conceived and apprehended, was divisible into other ideas of means, only a part of which had been reduced to practice, the latter alone could have constituted his invention. If his idea presented different aspects, capable of embodiment in essentially distinct inventions, each of which would have formed matter for an independent patent, the one selected by him as the subject of the patent whose amendment is in question is the sole invention which that patent could, if perfect, have secured. The limits of this invention thus exclude all new developments of the idea of means which have taken place since the original patent issued, all ideas which were not reduced to practice before the application for the original patent, and all distinct and independent parts or forms of the invention which were not embraced within the subject-matter of the patent already issued; and therefore no defect or insufficiency of statement concerning these can render the original patent inoperative or invalid, or furnish an occasion for its amendment. All that it can be made to cover, by any degree or species of correction is that completely *con*ceived, *per*ceived, and practically operative means for which the inventor then sought and the government then bestowed protection.[1] Intervening inventions, whether wholly distinct

§ 661. [1] In Manufacturing Co. *v.* Ladd (1880), 102 U. S. 408, Bradley, J.: (413) "A re-issue can only be granted for the same invention which was originally patented. If it were otherwise, a door would be opened to the admission of the greatest frauds. Claims and pretensions shown to be unfounded at the time might, after the lapse of a few years, a change of officers in the Patent Office, the death of witnesses, and the dispersion of documents, be set up anew, and a reversal of the first decision obtained without an appeal, and without any knowledge of the previous investigations on the subject. New light breaking in upon the patentee as the progress of improvement goes on, and as other inventors enter the field, and his monopoly becomes less and less necessary to the public, might easily generate in his mind an idea that his invention was really more broad and comprehensive than had been set forth in the specification of his patent. It is easy to see how such new light would naturally be reflected in a re-issue of the patent, and how unjust it might be to third parties who had kept pace with the march of improvement. Hence there is no safe or just rule but that which confines a re-issued patent to the

or consisting in substantial variations in or improvements on the old, subsequently discovered attributes of the invention

same invention which was described or indicated in the original." 19 O. G. 62 (64).

That a re-issue cannot cover more than the original invention as determined by the state of the art at the date of the first patent, see Carlton *v.* Bokee (1873), 17 Wall. 463 ; 6 Fisher, 40 ; 2 O. G. 520.

That a re-issue cannot embrace any invention other than that which the patentee had fully invented and the government had endeavored to protect by the original patent, see Cornell *v.* Weidner (1888), 127 U. S. 261 ; 43 O. G. 985 ; Haines *v.* Peck (1886), 26 Fed. Rep. 625 ; 35 O. G. 1227 ; Hubel *v.* Dick (1886), 24 Blatch. 139 ; 28 Fed. Rep. 656 ; 37 O. G. 1480 ; Schillinger *v.* Cranford (1885), 4 Mackay, 450 ; 37 O. G. 1349 ; Farmers' Friend Mfg. Co. *v.* Challenge Corn Planter Co. (1885), 23 Fed. Rep. 42 ; 30 O. G. 661 ; Reed *v.* Chase (1885), 25 Fed. Rep. 94 ; 33 O. G. 996 ; Flower *v.* Detroit (1884), 22 Fed. Rep. 292 ; Dryfoos *v.* Wiese (1884), 19 Fed. Rep. 315 ; 26 O. G. 639 ; 22 Blatch. 19 ; Parker & Whipple Co. *v.* Yale Clock Co. (1883), 18 Fed. Rep. 43 ; 25 O. G. 290 ; 21 Blatch. 485 ; McKay *v.* Stowe (1883), 17 Fed. Rep. 516 ; Hoffheins *v.* Russell (1883), 107 U. S. 132 ; 23 O. G. 2030 ; Andrews *v.* Hovey (1883), 26 O. G. 1011 ; 5 McCrary, 181 ; 16 Fed. Rep. 387 ; Lorillard *v.* McAlpin (1882), 14 Fed. Rep. 112 ; Newton *v.* Furst & Bradley Mfg. Co. (1882), 14 Fed. Rep. 465 ; 11 Bissell, 405 ; Neacy *v.* Allis (1882), 13 Fed. Rep. 874 ; 22 O. G. 1621 ; Hayes *v.* Seton (1882), 20 Blatch. 484 ; 12 Fed. Rep. 120 ; Streit *v.* Lauter (1882), 11 Fed. Rep. 309 ; Hart *v.* Thayer (1882), 10 Fed. Rep. 746 ; 20 Blatch. 315 ; 21 O. G. 701 ; 22 O. G. 1787 ; Meyer *v.* Maxheimer (1881), 9 Fed. Rep. 99 ; 20 Blatch. 15 ; 20 O. G. 1102 ; Averill Chemical Paint Co. *v.* National Mixed Paint Co. (1881), 9 Fed. Rep. 462 ; 20 Blatch. 42 ; 22 O. G. 585 ; Putnam *v.* Tinkham (1880), 4 Fed. Rep. 411 ; Giant Powder Co. *v.* California Vigorit Powder Co. (1880), 4 Fed. Rep. 720 ; 6 Sawyer, 508 ; 18 O. G. 1339 ; American Middlings Purifier Co. *v.* Atlantic Milling Co. (1879), 5 Dillon, 127 ; 4 Bann. & A. 148 ; 15 O. G. 467 ; Curtis *v.* Branch (1879), 4 Bann. & A. 189 ; 15 O. G. 919 ; Kerosene Lamp Heater Co. *v.* Littell (1878), 3 Bann. & A. 312 ; 13 O. G. 1009 ; Powder Co. *v.* Powder Works (1878), 98 U. S. 126 ; 15 O. G. 289 ; Vogler *v.* Semple (1877), 11 O. G. 923 ; 2 Bann. & A. 556 ; 7 Bissell, 382 ; Manufacturing Co. *v.* Ladd (1877), 2 Bann. & A. 488 ; 11 O. G. 153 ; Russell *v.* Dodge (1876), 93 U. S. 460 ; 11 O. G. 151 ; *Ex parte* Aldrich (1876), 9 O. G. 407 ; *Ex parte* Baldwin (1876), 9 O. G. 639 ; Putnam *v.* Yerrington (1876), 9 O. G. 689 ; 2 Bann. & A. 237 ; Tucker *v.* Tucker Mfg. Co. (1876), 10 O. G. 464 ; 2 Bann. & A. 401 ; 4 Clifford, 397 ; Stevens *v.* Pritchard (1876), 10 O. G. 505 ; 4 Clifford, 417 ; 2 Bann. & A. 390 ; Giant Powder Co. *v.* California Powder Works (1875), 3 Sawyer, 448 ; 2 Bann. & A. 131 ; La Baw *v.* Hawkins (1874), 1 Bann. & A. 428 ; 6 O. G. 724 ; Ball *v.* Withington (1874), 1 Bann. & A. 549 ; 6 O. G. 933 ; *Ex parte* Wheeler (1873), 4 O. G. 5 ; Dorsey Harvester Rake Co. *v.* Marsh (1873), 6 Fisher, 387 ; Aultman *v.* Holley (1873), 6 Fisher, 534 ; 11 Blatch. 317 ; 5 O. G. 3 ; Wells *v.* Gill (1873), 6 Fisher, 574 ; 4 O. G. 669 ; Carew *v.* Boston Elastic Fabric Co. (1871), 1 O. G. 91 ; 5 Fisher, 90 ; 3 Clifford, 356 ; Brown *v.* Selby (1871), 4 Fisher, 363 ; 2 Bissell, 457 ; Parham *v.* American But-

or of any of its parts, independent arts or instruments though tracing their origin to the same fundamental idea, and new matters of any kind, are equally beyond the scope of the original patent and of any correction or enlargement of its terms by a re-issue.[2]

tonhole, Overseaming, & Sewing Machine Co. (1871), 4 Fisher, 468; Hoffheins *v.* Brandt (1867), 3 Fisher, 218; Cahart *v.* Austin (1865), 2 Clifford, 528; 2 Fisher, 543; Whitely *v.* Swayne (1865), 4 Fisher, 117; Sickles *v.* Evans (1863), 2 Fisher, 417; 2 Clifford, 203; Poppenhusen *v.* Falke (1862), 5 Blatch. 46; 2 Fisher, 213; Popponhusen *v.* Falke (1861), 2 Fisher, 181; 4 Blatch. 493; French *v.* Rogers (1851), 1 Fisher, 133; Batten *v.* Taggert (1851), 2 Wall. Jr. 101; Knight *v.* Baltimore & Ohio R. R. Co. (1840), Taney, 106; 3 Fisher, 1.

That the re-issue cannot introduce a different principle though it were known to the patentee when he obtained the original patent, see Dyson *v.* Danforth (1865), 4 Fisher, 133.

That a re-issue cannot claim devices used with, but not part of, the original invention, see *Ex parte* Barker (1873), 4 O. G. 155.

That where the original patent accurately defines the invention, a re-issue cannot embrace antecedent improvements not within the limits of the original patent, see Funck *v.* Doty (1877), 13 O. G. 322.

That where the original patent covers but one form of an invention, it cannot re-issue to cover other forms, see Steam Gauge & Lantern Co. *v.* Miller (1882), 11 Fed. Rep. 718; N. Y. Bung & Bushing Co. *v.* Hoffman (1881), 9 Fed. Rep. 199; 20 Blatch. 3; 20 O. G. 1451; Washburn & Moen Mfg. Co. *v.* Haish (1880), 10 Bissell, 83; 7 Fed. Rep. 906; Manufacturing Co. *v.* Ladd (1877), 2 Bann. & A. 488; 11 O. G. 153; Wicks *v.* Stevens (1876), 2 Bann. & A. 318; 2 Woods, 310.

That a patentee is not entitled to a re-issue covering any matter which, according to the records of the Patent Office, he was not the first to disclose, see *Ex parte* Platts (1879), 15 O. G. 827.

That a re-issue will be sustained if the court can see that the patentee only seeks to cover his real invention, see Crandall *v.* Parker Carriage Goods Co. (1884), 28 O. G. 369; 20 Fed. Rep. 851.

[2] In *Ex parte* Seibert (1879), 16 O. G. 262, Paine, Com.: (265) "Where, however, he makes no discovery of the art of lubricating by hydrostatic pressure at all, but devises and patents a particular mechanism for lubricating by steam pressure, never suspecting the operativeness of that particular mechanism by hydrostatic pressure until after his patent has been granted, he is not entitled on a re-issue to a broad Claim for an art or method of hydrostatic lubrication, for he had not invented or discovered any such art or method when he took out his patent. But he is entitled, on a re-issue, to a Claim for just what he invented, — that is to say, for a machine in a particular form, involving the use of hydrostatic pressure. His monopoly of the method is limited to the method used in the precise construction invented."

In U. S. & Foreign Salamander Felting Co. *v.* Haven (1875), 9 O. G. 253, Treat, J.: (254) "The repeated decisions by the courts, and especially by the United States Supreme Court in the 1st, 17th, and 19th Wallace, indicate with sufficient distinctness that not only no new matter shall be introduced,

§ 662. Defects Amendable by Re-issue are Defects of Statement only, not of Subject-Matter.

It thus appears that the sole office of a re-issue is to correct faults of statement in the description and claim of the origi-

but that an enlargement of the original Claim growing out of the subsequent advance of the art is not to be tolerated. The reason of the rule is obvious. Every patent as to novelty or utility depends on the state of the art at the time of the claim made or patent issued; and, therefore, if a party, after learning from a subsequent advance of the art the worthlessness of his original invention, is to be permitted to claim a re-issue incorporating what was not originally in his mind, and what had been afterward suggested to him only by advances in the art made by others, then he could, it may be, even without any new invention, override all the elements which would serve to test the validity of the new application. In other words, having procured a worthless patent, and having subsequently learned from the advancing art how, by changing the terms of his patent, it could be made of value, he would, if a re-issue including the new matter were permitted, have the re-issue not only relate back to the date of the original patent, but absorb within its privileges all subsequent matters wholly unknown to and unthought of by him originally." 3 Dillon, 131 (134); 2 Bann. & A. 164 (166).

That a re-issue must be for the same invention as the original patent, and cannot be expanded to cover intervening inventions, see Meyer *v.* Maxheimer (1881), 20 Blatch. 15; 20 O. G. 1162; 9 Fed. Rep. 99.

That matter discovered by using the original invention cannot be embraced in the re-issue, see Andrews *v.* Hovey (1883), 5 McCrary, 181; 16 Fed. Rep. 387; 26 O. G. 1011.

That where the utility of an invention depends upon some property of matter which is not discovered until after the date of the original patent, no re-issue can claim and appropriate the property of matter as a feature in the invention, see Andrews *v.* Hovey (1883), 5 McCrary, 181; 16 Fed. Rep. 387; 26 O. G. 1011.

That a re-issue cannot embrace later inventions, no matter how meritorious the original may be, see Manufacturing Co. *v.* Ladd (1877), 2 Bann. & A. 488; 11 O. G. 153.

That to cover a new invention by suppressing certain features of the old is not allowable, see Matthews *v.* Iron Clad Mfg. Co. (1888). 124 U. S. 349; 42 O. G. 827; Matthews *v.* Boston Mach. Co. (1882), 105 U. S. 54; 21 O. G. 1349.

That a patentee cannot expand his Claims in a re-issue so as to cover the patentable invention of another, and if he does so he is liable to lose his own, see Adjustable Window Screen Co. *v.* Boughton (1874), 10 Phila. 251; 1 Bann. & A. 327.

That a re-issue cannot contain new matter, see Ives *v.* Sargent (1886), 119 U. S. 652; 38 O. G. 781; Hayes *v.* Seton (1882), 20 Blatch. 484; 12 Fed. Rep. 120; Kerosene Lamp Heater Co. *v.* Littell (1878), 3 Bann. & A. 312; 13 O. G. 1009; Gong Bell Mfg. Co. *v.* Clark (1878), 3 Bann. & A. 211; 13 O. G. 274; Thomas *v.* Shoe Mach. Mfg. Co. (1878), 3 Bann. & ... 557; 16 O. G. 541; Vogler *v.* Semple (1877), 11 O. G. 923; 2 Bann. & A. 556; 7 Bissell, 382; Union Paper Collar Co. *v.* Van Deusen (1874), 23 Wall. 530; 7 O. G. 919; La Baw *v.* Hawkins (1874), 1 Bann. & A.

nal patent.[1] It is a mere method of relieving the inventor from the disastrous consequences arising out of his want of skill in drawing his specification, and of preventing the public from taking an undue advantage of his errors. Mistakes in his choice or judgment as to what he shall attempt to cover by his patent, it does not undertake to remedy.[2] His present rights are adequately secured by the power conferred upon him to repeat his statements in varied forms by as many successive re-issues as he desires, until his language corresponds exactly with the actual invention which his patent was intended to protect. If he has other rights beyond the limits of this invention, he must ensure their preservation by an independent application and a separate patent.

428; 6 O. G. 724; Whitely *v.* Swayne (1865), 4 Fisher, 117.

See also § 668, note 10, *post*.

§ 662. [1] That a re-issue is intended to cure the inevitable defects of statement, see Blake *v.* Stafford (1868), 6 Blatch. 195; 3 Fisher, 294; Burr *v.* Duryee (1862), 2 Fisher, 275.

That it is the purpose of a re-issue to make the patent better, see Jordan *v.* Dobson (1870), 4 Fisher, 232; 2 Abbott, U. S. 398; 7 Phila. 533; Blake *v.* Stafford (1868), 6 Blatch. 195; 3 Fisher, 294.

That a re-issue may correct, but cannot alter, see Doane & Wellington Mfg. Co. *v.* Smith (1882), 24 O. G. 302; 15 Fed. Rep. 459.

[2] That an error in judgment as to what the patent shall cover, or in conclusions of fact, is no ground for a re-issue, see *Ex parte* Mahnken (1887), 40 O. G. 915; Yale Lock Mfg. Co. *v.* James (1884), 28 O. G. 917; 20 Fed. Rep. 903; 22 Blatch. 294.

That an error in judgment as to the nature of the invention cannot be corrected by re-issue, see Hubel *v.* Dick (1886), 28 Fed. Rep. 656; 37 O. G. 1480; 24 Blatch. 139.

That if the invention is really broader than the patentee supposes, but he describes and claims it in the original as he understands it, there is no inadvertence, accident, or mistake, and no room for a re-issue, see American Diamond Drill Co. *v.* Sullivan Mach. Co. (1884), 22 Blatch. 298; 21 Fed. Rep. 74; 28 O. G. 811.

That an error in fixing the term of a patent, so that it fails to conform to that of a foreign patent previously granted, may be corrected by re-issue, see Buerk *v.* Valentine (1872), 9 Blatch. 479; 2 O. G. 295; 5 Fisher, 366.

That where an American patent claimed several devices covered by separate foreign patents, of which some were expired, the devices covered by the expired patents can be excluded from the American patent by re-issue, and the patent be valid for the rest, see *Ex parte* Pulvermacher (1876), 10 O. G. 2.

That a re-issue cannot claim matters for which the original has expired by reason of its limitation by a foreign patent, see *Ex parte* Siemens (1877), 11 O. G. 1197.

§ 663. Second Proposition: Re-issued Patent must be Confined to the Invention which the Patentee Attempted to Describe and Claim in his Original Patent.

The second proposition, — that a re-issue, being the amendment of an existing patent as distinguished from the grant of a new patent for an amendment in the invention, must be confined to the invention which the patentee attempted to describe and claim in the original patent, — is equally indisputable. The fundamental theory of Patent Law that the complete and exact disclosure of the invention to the public is the consideration paid by the inventor for the monopoly created by the patent, as well as the express provisions of the statutes, require that the invention to be covered by the patent should be entirely and precisely described and claimed by the inventor in his specification; and as the patent could not lawfully have been issued, so it cannot be amended by re-issue, to embrace any subject-matter which the patentee did not endeavor at the outset to describe and claim.[1] Hence, before any amendment of the patent can be

§ 663. [1] As the principal difficulties which have arisen under the law of re-issues relate to this second proposition, it seems necessary, at the risk of some repetition, to examine more fully the foundation on which it rests, and the exact truth which it expresses. In order to obtain the grant of a monopoly the inventor must, in the first place, have conceived an idea of means and reduced it to practice in some operative art or instrument. In the second place, he must have perceived the essential character of his invention with such clearness and completeness as to be able to reproduce it, and to confer it on the public, in such a form as to make it available for practical use without the further exercise of inventive skill. In the third place, he must determine to patent either the entire invention or some separable part thereof, and must apply for a patent for that which he has thus concluded to secure. In the fourth place, he must incorporate in his application a specification in which he makes an honest effort to describe and to claim the invention, or separable part, which his expected patent is intended to protect. Until an inventor has taken these four steps he is not entitled to any patent whatever; and if they have been taken he is entitled to a patent only for the subject-matter which he has endeavored to describe and claim. Now if, in the first step, the idea of means which he has conceived has possibilities of development beyond the point to which he has carried it, these lie wholly outside of his invention, whether they are ever thereafter realized or not, and whether, if realized, their realization is due to his own or to another's inventive act. Obviously, therefore, none of these can enter into the subject-matter of his patent, although when the inventive act as to them becomes complete they may be covered by a subsequent and independent patent. Again

properly allowed, it must be made apparent to the Patent Office that every portion of the subject-matter of the pro-

if, in the second step, he apprehends but partially the attributes of his invention, perceiving only its narrower where it has a broader aspect, or seeing in it only a fraction of what it would present to more intelligent or experienced observers, that which he thus perceives and consequently can reproduce or communicate to others alone can be considered as entering into his invention or included in the subject-matter of his patent. If, in the third step, his invention is of such a nature as offers him the opportunity to choose whether he will obtain a monopoly for it as a whole, or for one or more of its separable parts, or for it in one aspect rather than another, he must assume the responsibility of this selection, and having made it, and acted on it in his application for a patent, he cannot reconsider his determination and substitute a different subject-matter in the same application. Finally, in the fourth step, if he does not in good faith endeavor to describe the invention for which he has determined to procure the patent, he is guilty of a fraudulent concealment which renders his patent, if he obtains one, wholly void; and if he does not attempt to claim it, he waives the right to its protection by that patent. These are principles which are not open to dispute and form an invariable guide to the Patent Office in granting patents, and to the courts in construing them and ascertaining their validity.

But if a re-issue is the amendment of an existing patent, as distinguished from the grant of a new patent, it is evident that, in its exercise of the amending power, the Patent Office can bestow on the inventor no other or greater privilege than it could have conferred upon him in the original patent; in other words, that only that invention which he had fully invented, which he clearly comprehended, which he selected as the subject-matter of the patent, and attempted to describe and to claim in his original application, can be embraced in the re-issue. And it is also evident that this exercise of the amending power cannot extend to any steps in the foregoing series anterior to the one in which the amendable defect may have arisen, to wit; the fourth and last. If the inventor has more fully developed his original idea of means, or if he has more deeply fathomed the character of that which he had then conceived, or if maturer judgment has led him to a different conclusion as to what he should have made the subject of his patent; these are matters entirely antecedent in the order of events to that in which alone, under our Patent Law, any amendable defect can have occurred. Whatever advantage can accrue to him from these later achievements, or more perfect knowledge, must be sought in new and original proceedings, not in a reformation of the old. For neither the language of the statutes, nor the general provisions of the law, permit the surrender and re-issue of a patent for any other purpose than that of curing some defect or insufficiency in the description of the patented invention or in the statement of the inventor's claims.

These considerations are so simple and so elementary that an apology for their frequent repetition would be necessary were not numerous expressions to be found in text-books and reported cases, *modern as well as ancient*, which misrepresent, or at least do not correctly state, this rule of law. Thus it is not true that an inventor may embrace in his re-issue his entire actual invention; or that it may include whatever the

posed re-issued patent was not only included in the original invention, but that the inventor attempted both to describe it

original patent suggested or described as belonging to the invention; or that it may cover anything which might have been claimed in the original, etc. It is true that whatever he had actually invented, had comprehended, had selected as the subject-matter of his patent, had attempted to describe and claim in his original specification, and through inadvertence, accident, or mistake, had there failed to properly describe and claim, he may now protect in his re-issue, — so much, and no more.

Of the multitude of cases which bear upon this point, a very few state it in its proper form and in intelligible language. Among these are the following: In Flower *v.* City of Detroit (1888), 127 U. S. 563, Blatchford, J.: (571) "It is sought to sustain the validity of the re-issue by attempting to show that the model filed in the Patent Office with the original application exhibited the invention covered by the first claim of the re-issue. It is doubtful whether that fact is satisfactorily established. But, irrespective of this, the case falls directly within the recent decision of this court in Parker & Whipple Co. *v.* Yale Clock Co. (123 U. S. 87; 25 O. G. 290). It was held in that case that what was suggested in the original specifications, drawings, or Patent Office model is not to be considered as a part of the invention intended to have been covered by the original patent, unless it can be seen from a comparison of the two patents that the invention which the original patent was intended to cover embraced the things suggested or indicated in the original specification, drawings, or Patent Office model, and unless the original specification indicated that those things were embraced in the invention intended to have been secured by the original patent. (See also Hoskin *v.* Fisher, 125 U. S. 217.) In the present case it cannot be seen from a comparison of the two patents that the original specification indicated that what is covered by the first claim of the re-issue was intended to have been secured by the original." 43 O. G. 1348 (1349).

In Parker & Whipple Co. *v.* Yale Clock Co. (1887), 123 U. S. 87, Blatchford, J.: (95) "The appellants contend that the first eight Claims of the re-issue do not specify any invention which is not contained in the clock described in the original patent and embodied in the model originally deposited in the Patent Office, and that the drawings of the original and of the re-issued patent are substantially the same. On these premises, it is argued for the appellants that it is lawful to include in the Claims of a re-issue whatever is suggested or substantially indicated in the specification, model, or drawings of the original patent, if the applicant was the original and first inventor thereof, and that such a re-issue will therefore be for the same invention as that of the original patent. Expressions in some opinions of this court, wrested from their context and interpreted in a different sense from that in which they were used, are cited to support these views; but the language of the court on the subject has steadily been to the contrary; and as the question arises so distinctly in this case and some misapprehension exists in regard to it, it seems proper to discuss it with some fulness." Here the court reviews the statutes, and several decisions, concluding with that of Seymour *v.* Osborne (1870), 11 Wall. 516, from which it quotes Judge Clifford's familiar statement, that a re-issue may contain whatever was "suggested or substantially indicated in the specifications or

and to claim it in the specification annexed to his original patent. And the courts, in construing the re-issued patent

drawings which properly belonged to the invention as actually made and perfected," and then continues: — (98) "In these extracts from the opinion it is seen that the court adheres strictly to the view that under the statute the Commissioner has no jurisdiction to grant a re-issued patent for an invention substantially different from that embodied in the original patent, and that a re-issue granted not in accordance with that rule is void. In what is there said about re-describing the invention, and about including in the new Description and new Claims what was suggested or indicated in the original specification, drawings, or Patent Office model, it is clearly to be understood, from the entire language, that the things so to be included are only the things which properly belonged to the invention as embodied in the original patent; that what that invention was is to be ascertained by consulting the original patent; and that while the new Description may properly contain things which are indicated in the original specification, drawings, or Patent Office model (though not sufficiently described in the original specification), it does not follow that what was indicated in the original specification, drawings, or Patent Office model is to be considered as a part of the invention, unless the court can see from a comparison of the two patents that the original patent embodied as the invention intended to be secured by it what the Claims of the re-issue are intended to cover. In what was thus said in Seymour *v.* Osborne there is no warrant for the view that, *ex vi termini*, what was suggested or indicated in the original specification, drawings, or Patent Office model is to be considered as a part of the invention intended to have been covered by the original patent, unless the court can see from a comparison of the two patents that the invention which the original patent was intended to cover fairly embraced the things thus suggested or indicated in the original specification, drawings, or Patent Office model, and unless the original specification indicated that those things were embraced in the invention intended to have been secured by the original patent. . . . (102) There is no evidence of any attempt to secure by the original patent the inventions covered by the first eight Claims of the re-issue, and those inventions must be regarded as having been abandoned or waived, so far as the re-issue in question is concerned, subject however to the right to have made a new application for a patent to cover them; in other words, those eight Claims are not for the same invention which was originally patented." 41 O. G. 811 (812).

In Yale Lock Mfg. Co. *v.* Scovill Mfg. Co. (1880), 18 Blatch. 248, Shipman, J.: (256) "I understand that the Supreme Court, in the case cited and in other cases, intend to declare that in a re-issue the same, and only the same, invention which was attempted to be secured in the original patent, but which was there imperfectly stated, and was not fully secured, through inadvertence, accident, or mistake, can be re-stated, so that the principles or details of the invention may be presented clearly and accurately, but that other inventions of the patentee, or modifications of the patented invention, which had not been attempted to be secured, or had not been applied for, cannot be embraced in a re-issue, but must be the subject of a new application, and that 'courts should regard with jealousy and disfavor any attempt to enlarge the scope of an application

are logically and legally compelled to presume that the Patent Office has performed this duty, and that the monopoly

once filed, or of a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alteration.' (Railway Co. *v.* Sayles, 97 U. S. 554.) But if the patentee has made a palpable mistake, and has limited his real invention by a misstatement of its principles, so that he is about to lose the fruit of his labor, he should be permitted to restate, and, if need be, enlarge his specification, so as to include the same invention which was plainly the subject of, but was not fully secured by, the original patent, although, literally, the enlarged invention is one which he did not apply for in his original specification, because that specification, by a misstatement of his actual invention, applied for a narrower patent than he was entitled to have." 3 Fed. Rep. 288 (296); 5 Bann. & A. 519 (526).

In Powder Co. *v.* Powder Works (1878), 98 U. S. 126, Bradley, J.: (138) "The specification may be amended so as to make it more clear and distinct; the Claim may be modified so as to make it more conformable to the exact rights of the patentee; but the invention must be the same. So particular is the law on this subject that it is declared that 'no new matter shall be introduced into the specification.' This prohibition is general, relating to all patents; and by 'new matter' we suppose to be meant new substantive matter, such as would have the effect of changing the invention, or of introducing what might be the subject of another application for a patent. The danger to be provided against was the temptation to amend a patent so as to cover improvements which might have come into use, or might have been invented by others, after its issue. The legislature was willing to concede to the patentee the right to amend his specification so as fully to describe and claim the very invention attempted to be secured by his original patent, and which was not fully secured thereby in consequence of inadvertence, accident, or mistake, but was not willing to give him the right to patch up his patent by the addition of other inventions, which, though they might be his, had not been applied for by him, or, if applied for, had been abandoned or waived. For such inventions he is required to make a new application, subject to such rights as the public and other inventors may have acquired in the meantime. This, we think, is what the present statute means, and what, indeed, was the law before its enactment, under the previous act of 1836. If decisions can be found which present it in any different aspect, we cannot admit them to be correct expositions of the law." 15 O. G. 289 (292).

In Brown *v.* Selby (1871), 4 Fisher, 363, Drummond, J.: (368) "A re-issue can only be for the invention originally made and intended to be described or claimed, and included in the original patent." 2 Bissell, 457 (462).

In Knight *v.* Baltimore & Ohio R. R. Co. (1840), 3 Fisher, 1, Taney, C. J.: (3) "The plaintiff was not entitled to the patent of 1834, except for the purpose of giving a more perfect description of the invention intended to be claimed by him in the patent of 1829. . . . The patent of 1829 having been cancelled when that of 1834 was granted, the subsequent patent of 1836, upon which this suit is brought, is not valid, unless the improvement described in it is, in its principles and mode of operation, the same with that intended to be described in the patent of 1834, and differing from it only in giving a more perfect description of the improvement intended to be

defined in the re-issued patent was not intended to extend beyond the invention which the patentee endeavored to dis-

secured by that patent. . . . The plaintiff was not entitled in the patent of 1836 to enlarge, change, or modify the improvement intended to be protected by the patent of 1834. . . . The plaintiff is not entitled to recover unless he is the original inventor of the improvement described in the patent of 1836, and unless that improvement is the same in principle and in its mode of operation with the one intended to be described in the patents of 1834 and 1829." Taney, 106 (107). It is worthy of remark that in this case, — the first in which the courts seem to have been called upon to decide what a re-issue might contain — the true rule is stated by Chief Justice Taney, viz. : that the patentee is entitled to claim in his re-issue only what he "intended to" describe and claim in his original patent.

That a re-issue is intended to cover the invention which the inventor actually made and attempted to protect by the original, see Eames *v.* Andrews (1887), 122 U. S. 40 ; 39 O. G. 1319 ; Parker & Whipple Co. *v.* Yale Clock Co. (1883), 21 Blatch. 485 ; 25 O. G. 290 ; 18 Fed. Rep. 43 ; Yale Lock Co. *v.* Scoville Mfg. Co. (1880), 18 Blatch. 248 ; 3 Fed. Rep. 288 ; 5 Bann. & A. 519 ; Powder Co. *v.* Powder Works (1878), 98 U. S. 126 ; 15 O. G. 289.

That if no attempt was made to secure the invention by the original patent, it cannot be embraced in a re-issue, see Hoskin *v.* Fisher (1888), 125 U. S. 217 ; 43 O. G. 509.

That a re-issue cannot claim either another invention or a broader invention than the one attempted to be described and claimed in the original patent, see Worden *v.* Searls (1887), 121 U. S. 14 ; 39 O. G. 359 ; *Ex parte* Herr (1887), 41 O. G. 463 ; Archer *v.* Arnd (1887), 31 Fed. Rep. 475; 40 O. G. 1032; Coon *v.* Wilson (1885), 113 U. S. 268 ; 30 O. G. 889 ; Dryfoos *v.* Wiese (1884), 22 Blatch. 10 ; 26 O. G. 630 ; 19 Fed. Rep. 315 ; Hart *v.* Thayer (1882), 20 Blatch. 315 ; 10 Fed. Rep. 746 ; 21 O. G. 701 ; 22 O. G. 1787 ; Combined Patents Can Co. *v.* Lloyd (1882), 21 O. G. 713 ; 11 Fed. Rep. 140 ; 15 Phila. 481 ; Miller *v.* Brass Co. (1882), 104 U. S. 350 ; 21 O. G. 201 ; Moffitt *v.* Rogers (1882), 106 U. S. 423 ; 23 O. G. 270 ; Wing *v.* Anthony (1882), 106 U. S. 142 ; Gosling *v.* Roberts (1882), 106 U. S. 39 ; 22 O. G. 1785 ; James *v.* Campbell (1881), 104 U. S. 356 ; 21 O. G. 337 ; Heald *v.* Rice (1881), 104 U. S. 737 ; 21 O. G. 1443 ; Smith *v.* Merriam (1881), 19 O. G. 601 ; 6 Fed. Rep. 713 ; Waring *v.* Johnson (1881), 19 O. G. 1068 ; 6 Fed. Rep. 500 ; 19 Blatch. 38 ; Kells *v.* McKenzie (1881), 20 O. G. 1663 ; 9 Fed. Rep. 284 ; Meyer *v.* Maxheimer (1881), 20 Blatch. 15 ; 20 O. G. 1162 ; 9 Fed. Rep. 99 ; Washburn & Moen Mfg. Co. *v.* Haish (1880), 10 Bissell, 65 ; 19 O. G. 173 ; 4 Fed. Rep. 900 ; Covell *v.* Pratt (1880), 18 Blatch. 126 ; 18 O. G. 301 ; 2 Fed. Rep. 359 ; 5 Bann. & A. 380 ; Manufacturing Co. *v.* Corbin (1880), 103 U. S. 786 ; 20 O. G. 297 ; Bell *v.* Langles (1880), 102 U. S. 128 ; 18 O. G. 1405 ; Garneau *v.* Dozier (1880), 102 U. S. 230 ; 19 O. G. 61 ; Manufacturing Co. *v.* Ladd (1880), 102 U. S. 408 ; 19 O. G. 62 ; American Middlings Purifier Co. *v.* Atlantic Milling Co. (1879), 15 O. G. 467 ; 5 Dillon, 127 ; 4 Bann. & A. 148 ; Cammeyer *v.* Newton (1879), 16 O. G. 720 ; 4 Bann. & A. 159 ; Campbell *v.* James (1879), 18 O. G. 979 ; 17 Blatch. 42 ; 4 Bann. & A. 456 ; Powder Co. *v.* Powder Works (1878), 98 U. S. 126 ; 15 O. G. 289 ; Jones *v.* McMurray (1877), 13 O. G. 6 ; 2 Hughes, 527 ; 3 Bann. & A. 130 ;

close and to appropriate in his original patent. Where the re-issued patent will bear no construction which confines its subject-matter to this invention, its Claims are necessarily invalid.

§ 664. Nature and Scope of the Invention which the Inventor Attempted to Describe and Claim in his Original Patent, how Determined.

By what method the Patent Office or the courts shall ascertain the limits of the invention which the patentee originally endeavored to describe and claim, the statutes do not particularly prescribe. The act of 1832 simply required that the re-issue should be for the same invention. The act of 1836 followed in this respect the act of 1832. The act of 1870 further provided that "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." The Revised Statutes reproduce these provisions of the act of 1870. Under these, it will be noticed that no limitation is placed to the amendment of the original specification except the prohibition of new matter, and no test is given by which the Office or the courts are to determine what it attempted to describe and

Marsh *v.* Seymour (1877), 97 U. S. 348; 13 O. G. 723; Vogler *v.* Semple (1877), 7 Bissell, 382; 11 O. G. 923; 2 Bann. & A. 556; Russell *v.* Dodge (1876), 93 U. S. 460; 11 O. G. 151; Tucker *v.* Tucker Mfg. Co. (1876), 4 Clifford, 397; 10 O. G. 464; 2 Bann. & A. 401; Collar Co. *v.* Van Deusen (1874), 23 Wall. 530; 7 O. G. 919; Gill *v.* Wells (1874), 22 Wall. 1; 6 O. G. 881; Carlton *v.* Bokee (1873), 17 Wall. 463; 6 Fisher, 40; 2 O. G. 520; Tarr *v.* Webb (1872), 10 Blatch. 96; 5 Fisher, 593; 2 O. G. 568; Sarven *v.* Hall (1872), 9 Blatch. 524; 1 O. G. 437; 5 Fisher, 415; Seymour *v.* Osborne (1870), 11 Wall. 516; Morey *v.* Lockwood (1868), 8 Wall. 230; Hoffheins *v.* Brandt (1867), 3 Fisher, 218; Cahart *v.* Austin (1865), 2 Clifford, 528; 2 Fisher, 543; Burr *v.* Duryee (1863), 1 Wall. 531.

That where the re-issue does not cover an invention distinct from that described and attempted to be claimed in the original, the re-issue is valid, unless the failure to claim amounted to abandonment, see Eames *v.* Andrews (1887), 122 U. S. 40; 39 O. G. 1319.

claim. In the case of a machine-patent it is assumed that every feature of the invention which the inventor intended to protect will be exhibited either in his drawing or his model, and by prescribing that these can be amended only by each other the statute fairly implies that no part of the actual invention which he made can be regarded as embraced in what he intended to describe and claim unless in one or both of these it is disclosed. Where no model or drawing exists, the Office and the courts are left to the guidance of such regulations concerning the kind and degree of evidence required for the solution of this question as they may, in general, or in reference to particular cases, see fit to establish.[1] The necessity for some permanent and definite rule upon the subject, however, and the manifest danger of fraud and imposition if the fact that by the original patent the inventor intended and attempted to cover the matter now claimed in the re-issue were to be determined in any case upon his mere assertions or other parol testimony alone, early led the courts to declare that the original specification, as illustrated by the model or drawings if any, and as interpreted by a proper explanation of its terms of art and by the examination in connection with it of the invention actually made, must bear upon its face sufficient evidence of the alleged endeavor to describe and claim.[2] This rule, as usually stated,

§ 664. [1] That the courts and the Patent Office obey the same rules in ascertaining the character of the invention which the patentee originally attempted to protect, see *Ex parte* Aldrich (1876), 9 O. G. 407.

[2] The cases in which this rule has been accepted and followed are almost without number, and yet in scarcely any of them has it been completely and accurately stated. The adoption of the incorrect forms mentioned in the text is largely responsible for this, but such has been the history of the rule itself that freedom from obscurity could scarcely be expected. The earliest case in which the courts seem to have established a test for determining the character of the invention which the original patent was intended to protect, and for ascertaining the identity with this of the invention claimed in the re-issue, was Knight *v.* Baltimore & Ohio R. R. Co. (1840), Taney, 106 ; 3 Fisher, 1. In this case Chief Justice Taney charged the jury that the plaintiff could not recover on his re-issued patent unless the invention which it described and claimed was "the same in principle and in its mode of operation with the one intended to be described in" the original patent, and then left this question of identity (which of course includes the question of the actual character of the invention intended to be covered by the original patent) to be decided by the jury, as a

appears in one of the two following forms: negatively, that a re-issue cannot include any subject-matter which the orig-

matter of fact. In the cases which immediately followed this, the same position was taken by the courts, and the jury were required to pass upon the identity of the inventions on any relevant evidence that might have been presented. See Carver *v.* Braintree Mfg. Co. (1843), 2 Story, 441; Stimpson *v.* Westchester R. R. Co. (1845), 4 How. 404; Allen *v.* Blunt (1846), 2 W. & M. 139; Batten *v.* Taggert (1854), 17 How. 83; Heilner *v.* Battin (1856), 27 Penn. 521; Poppenhusen *v.* Falke (1861), 4 Blatch. 496, etc. While the courts were pursuing this method of investigation a practice appears to have arisen in the Patent Office of confining the applicant for a re-issue to such evidence concerning the invention which he first endeavored to protect, and its identity with that claimed in the re-issue, as was furnished by the original patent and its specification, drawings, and model, when interpreted by the invention itself, — a practice more than once repudiated in the courts, but gradually making its impression upon their decisions. Concurrently with these events, the doctrines that the nature and scope of any patented invention is to be determined by the court as a matter of law upon an inspection of the patent; that consequently the identity of two patented inventions must be ascertained by a comparison of their respective patents with each other by the court; and that the action of the Commissioner in issuing or re-issuing a patent is *prima facie* lawful and valid; — were becoming firmly grounded and universally applied, culminating, at length, in the proposition announced by Clifford, J., in Sickles *v.* Evans (1863), 2 Clifford, 203, and affirmed by him in Stevens *v.* Pritchard, (1876), 4 Clifford, 417, that the action of the Commissioner in granting a re-issue is "final and conclusive, unless the court is of the opinion, upon comparing the two instruments, that the re-issued patent, as matter of legal construction, is not for the same invention as the original."

In the transition to this doctrine from that of Chief Justice Taney in 1840 decisions of various degrees of incorrectness and inconsistency were rendered, some affirming the right of the patentee to a re-issue in the broadest terms which his original invention would permit, others restricting him in the re-issue to what he had claimed in the original patent; some asserting that the identity of the inventions covered by the original and re-issued patents must be apparent to the court upon a mere inspection of the instruments themselves, others adopting the extreme position of Judge Clifford that this identity must be conclusively presumed unless the patents, when compared with one another, disclosed substantial differences between them; yet all finally agreeing in the rule primarily adopted by the Patent Office, that the original specifications, drawings, and model must afford the ultimate test by which the Office or the courts are to determine what portions and aspects of his actual invention the inventor had intended and attempted to describe and claim.

Having reached this point in the explication of the rule, most of the decisions treat it as sufficiently stated, and proceed to apply it in their own peculiar modes. But it is evident that this explication is not a finality. For though it be established that the subject-matter of a re-issue must be confined to the invention which the patentee originally attempted to secure, and that this attempt must be discoverable in the original specification, drawings, or model,

inal patent, as construed by the court, does not apparently endeavor to protect; affirmatively, that a re-issue may em-

the mode to be pursued in making that discovery is still to be determined. In reference to this mode of inquiry it must be remembered that the specification, in which the discovery is to be made, is confessedly defective, — so defective, indeed, that in consequence of its defects the patent is inoperative or invalid. Manifestly, then, no mere process of interpretation can avoid or cure its imperfections and ascertain what patentable matter it has undertaken to describe and claim, since where interpretation can have this effect the patent cannot be invalid or inoperative. Hence recourse must be had to some exterior source for information as to the true nature of the invention, that in the light afforded by its actual character, as the inventor conceived it and reduced it to practice before his original application for a patent, his defective claims and description may be read. This is evidently the only method in which the fact that the specificatiou is defective can be ascertained, or the nature and degree of the defect can be measured, or the scope of the invention which the defective delineation or assertion attempted to embrace can be explored; and not until the Patent Office or the court is thus informed of what the inventor might have made the subject-matter of his patent, if he had so desired, can it be in any situation to scrutinize the original specification, drawings, or model in order to discover what he did intend and endeavor to describe and claim.

Three sources of information concerning the actual character of the original invention may be accessible for the purpose of this inquiry: (1) The assertions of the inventor or other parol testimony; (2) The specification of the re-issued patent; (3) The invention itself as originally made and perfected. The first is excluded because unreliable and unnecessary, as well as on grounds of public policy, and demands no further consideration. The specification of the re-issued patent, on the contrary, is in the highest degree authoritative and available. It purports to give, and must be accepted as giving, a complete and exact description of the invention, and as stating fully and clearly the claims of the inventor. It is assumed to be sufficient to acquaint those skilled in the art with the mode of making and using the invention, and to inform the public of the precise line which separates the arts and instruments at their command from that which is embraced in the monopoly. The patentee cannot be permitted to deny that the court or Patent Office, by legally interpreting his re-issue specification, with its drawings and model, will obtain a perfect knowledge of his true invention, as he himself has made it and contemplated its introduction into public use. And hence the Patent Office and the courts have here a ready, permanent, and invariable standard with which to compare the original specification, and thus discover how much of the invention as it now appears in the perfected patent the inventor then attempted to describe and claim. Where no re-issue has as yet been granted, and no re-issue specification on which the patentee insists as the accurate presentation of his invention has been filed, this source of information is, of course, absent, and a resort to the actual invention becomes necessary.

This review of the subject makes it evident that the mode of discovery to be pursued in ascertaining what the original specification attempted to embrace must vary with the different

brace whatever was suggested or substantially indicated in the original specification or drawings as belonging to the invention

stages in the history of the re-issue. When the inventor or his attorney are endeavoring to decide what can be claimed in the proposed re-issue, or when the Patent Office is assisting the inventor to secure all that a re-issue may lawfully include, the actual invention itself must be examined, and by comparing this with the original specification, drawings, and model, they must determine how much of that invention the patentee then intended and attempted to describe and claim, and confine within those limits the invention claimed in the re-issue. This is evidently the proceeding contemplated by that clause of the statutes which authorizes the Commissioner, in certain cases, to consider any proper proof as to the real nature of the actual invention, and the extent to which the inventor failed in his original attempt to disclose and protect it; while in the case of a machine, the original model and drawings, in connection with the specification and the machine itself, are presumed to offer all the information upon these points that, for the purpose of preparing and allowing a re-issue, the inventor or the Office can require.

When the re-issue application is perfected in the Patent Office, according to the intention of the applicant, and he insists upon its correspondence with the actual invention as he originally attempted to secure it, the specification, drawings, and model embraced in this re-issue application become the test by which the intended scope of the original patent is to be judged; and it must therefore be assumed by the Office that whatever parts or features of the invention, as set forth in these amended and presumably correct delineations, are wholly absent from the original specifications were not included in the invention which the inventor there attempted to describe and claim. At this stage there is, therefore, no occasion for exterior evidence, or for an examination of the actual invention itself, except so far as may be necessary to understand the description and claims of the re-issue application.

When the courts are called upon to enter into this investigation (except in proceedings on appeal, or in equity, supplemental to the re-issue application, and which are consequently governed by the foregoing rules), the re-issued patent has been granted and its specification stands before the public, as well as the court itself, as the complete and accurate exposition of the invention originally made and intended to be patented by the inventor. When construed by the court, with such explanation of technical terms and such reference to the actual invention as may be deemed essential to its true interpretation, it furnishes all needed information concerning the character of the invention as originally made and perfected, and constitutes a standard with which the original specification, drawings, and model may be compared, and from which the court may satisfactorily and sufficiently discover what portions of the invention the patentee endeavored to communicate to the public and to bring within the monopoly created by his original patent. From this as well as the preceding stage of the investigation extrinsic testimony is thus excluded, save for the purpose of aiding the court in its interpretation of the original and re-issued patents with their respective specifications, drawings, and models.

As this inquiry in the courts is instituted after the re-issued patent has been granted, a further question arises which is not encountered in the previous

actually made and embodied in the original patent. These statements are not literally correct, since the rule itself relates

stages in the Patent Office. It has become a settled principle of law that the issue of a patent raises a presumption of its validity and of the existence of all the conditions which the statutes have imposed upon the patentee. Applied to the proceeding now under discussion, this principle would seem to justify the extreme doctrine heretofore referred to, and compel the courts to recognize the judgment of the Patent Office in allowing the re-issue, and thereby deciding that its subject-matter was attempted to be covered by the original patent, as final and conclusive unless the contrary is clearly evident on a comparison of the original and re-issue specification. This doctrine has been held in many cases, among which are Herring *v.* Nelson (1877), 14 Blatch. 293 ; 3 Bann. & A. 55 ; 12 O. G. 753 ; Tucker *v.* Tucker Mfg. Co (1876), 10 O. G. 464 ; 4 Clifford, 397 ; 2 Bann. & A. 401 ; Stevens *v.* Pritchard (1876), 10 O. G. 505 ; 4 Clifford, 417 ; 2 Bann. & A. 390 ; Chicago Fruit House Co. *v.* Busch (1871), 2 Bissell, 472 ; 4 Fisher, 395 ; Carew *v.* Boston Elastic Fabric Co. (1871), 3 Clifford, 365 ; 5 Fisher, 90 ; 1 O. G. 91. Later cases manifest a disposition to repudiate this position, and to assert that the presumption arising from the action of the Patent Office in allowing a re-issue does not prevent the courts from re-examining this question of correspondence between the original and re-issue specifications, and affirming the validity or invalidity of the re-issued patent according as this correspondence may or may not appear. In these cases, therefore, it is held that a comparison of the re-issue and original specifications must affirmatively show that the subject-matter of the former was attempted to be stated in the latter, and that the Claims of the re-issue can embrace no invention unless the court can see that the inventor intended to secure it under the original patent. See Flower *v.* Detroit (1888), 127 U. S. 563 ; 43 O. G. 1348 ; Fisher *v.* Hoskin (1888), 125 U. S. 217 ; 43 O. G. 509 ; Parker & Whipple Co. *v.* Yale Clock Co. (1887), 123 U. S. 87 ; 41 O. G. 811, etc. These cases probably represent the law as it will ultimately be established, though at present it is scarcely safe to prophesy whether their doctrine will prove as just and practically beneficial to inventors and the public as the former.

The rule, as stated and explained in the preceding portions of this note, is applicable whenever the descriptive matter of the original specification is imperfect, whether or not the Claims, as measured by such description, are defective or sufficient. But where the description is complete and accurate, and the fault resides in an obscure or too restricted or excessive Claim, the modes of inquiry above delineated are unnecessary. Here the description of the original patent becomes the standard by which the imperfections in its Claims, and the extent to which they can be corrected, must be judged, and neither in the Patent Office nor the courts can the Claims of the re-issue be permitted to embrace any subject-matter which was not adequately portrayed in the original description.

In concluding this prolix discussion the proposition announced in the previous paragraph may be reiterated, — that the object of discovery in the methods before mentioned is the attempt of the inventor not merely to describe the invention now embraced in the re-issue, but also to claim it, and thus bring it within the original monopoly. It is not indeed necessary that it appear expressly in his original Claims.

only to the mode by which the intended scope of the original patent is to be determined, while these forms of expressing it prescribe what a re-issue may or may not contain, — a matter already definitely fixed by the language of the statute, and which the courts have no power to extend or to curtail. From these erroneous forms of statement have arisen serious misapprehensions as to the nature and practical application of the rule itself. Certain decisions may be found which proceed on the assumption that it governs the allowance of re-issues, and which, adopting its affirmative form, therefore declare that anything which might have been claimed in the original patent, under the description therein given of the invention, may be claimed in the re-issue.[3] This position, as thus broadly stated, is not correct. That a Claim might have been made in the original does not, *ipso facto*, entitle the inventor to insert it in his re-issue.[4] Additional circumstances, such as abandonment, estoppel, and the like, are to be regarded; and in view of these, as well as its relation to the original description, is the validity of the amended Claim to be determined. Other decisions are reported which, assuming the rule to be of the same character and following its negative form, have held that nothing can be claimed in a re-issue which was not included in the Claim of the origi-

It may have been so connected with claimed matter in the Description that a Claim for either would impliedly cover both, as where Claims for a process embrace its inseparable product, or Claims for a combination incidentally include its indispensable elements and sub-combinations. But in this or some other manner the attempt to claim must have been so made in the original specification that the Patent Office and the courts, pursuing the appropriate method of inquiry just considered, may satisfy themselves that what the inventor clearly claims in his re-issue, he did endeavor to protect by his original patent.

[3] That whatever could have been claimed in the original patent may be claimed in the re-issue, see Washburn & Moen Mfg. Co. *v.* Haish (1880), 10 Bissell, 65; 19 O. G. 173; 4 Fed. Rep. 900; Draper *v.* Wattles (1878), 3 Bann. & A. 618; 16 O. G. 629; Union Paper Collar Co. *v.* Van Deusen (1872), 10 Blatch. 109; 5 Fisher, 597; 2 O. G. 361.

[4] That the mere fact that matter might have been claimed in the original is not alone enough to warrant its claim in the re-issue, see Electric Gas Lighting Co. *v.* Smith & Rhodes Electric Co. (1885), 31 O. G. 792; 23 Fed. Rep. 195; Yale Lock Mfg. Co. *v.* James (1884), 20 Fed. Rep. 903; 28 O. G. 917; 22 Blatch. 294; Newton *v.* Furst & Bradley Mfg. Co. (1882), 11 Bissell, 405; 14 Fed. Rep. 465; Kells *v.* McKenzie (1881), 9 Fed. Rep. 284; 20 O. G. 1663.

nal patent;[5] a rule which unwarrantably restricts the rights of the inventor, and is contrary alike to the uniform practice of the Patent Office and the general current of judicial opinion.[6] Both these errors might have been avoided had the true reason and purpose of this rule been clearly apprehended. It does not pretend to state when a re-issue may be granted or withheld, or what the re-issued patent may or may not contain. The acts of Congress have determined when it shall be granted, and that when granted it may contain whatever may be necessary to render it effectual to protect the invention which the inventor originally attempted to secure. In ascertaining what that invention was, the Patent Office and the courts have properly refused to look beyond the specification, drawings, and model of the original patent, interpreted when necessary by an examination of the invention itself, but have not held, nor had they any authority to hold, that everything which could have been claimed under the original patent, whether a part of the actual invention or not, and whether or not abandoned, might be claimed under the re-issue; nor, on the other hand, that nothing could be covered by the latter patent, although belonging to the actual invention, which was not embraced within the Claims of the former. Considered in its true intent, as a simple rule of evidence, it presents no special difficulty, but is reasonable, intelligible, and in most instances easy of application.

§ 665. The Attempt of the Inventor to Describe and Claim the Invention Embraced in the Re-issue must Appear in the Specification, Drawings, or Model of the Original Patent.

In order to determine what invention the inventor intended and endeavored to secure by the original patent, the specifi-

[5] That a re-issue cannot be expanded so as to claim matters which the patentee did not see fit to claim in the original, see Fay *v.* Fraser (1882), 11 Bissell, 422; 14 Fed. Rep. 652.

That a re-issue, whose only Claims are not in the original, is void, see Singer Mfg. Co. *v.* Goodrich (1883), 15 Fed. Rep. 455.

That Claims in a re-issue which expressly enlarge the invention claimed in the original are void, see Curtis *v.* Branch (1879), 15 O. G. 919; 4 Bann. & A. 199.

[6] See § 656 and note 3, *ante*.

cation, drawings, and model connected with that patent, explained when necessary by comparison with the actual invention or its correct description in the re-issue specifications, must, therefore, be adopted as the final guide.[1] These,

§ 605. [1] In Heald *v.* Rice (1882), 104 U. S. 737, Matthews, J.: (740) "The principles for determining the validity of re-issued patents have been discussed and formulated so repeatedly and so recently in this court that it is necessary at present only to refer to James *v.* Campbell, *supra*, 356; Miller *v.* Brass Company, *supra*, 350; Burr *v.* Duryee, 1 Wall. 531; and Powder Company *v.* Powder Works, 98 U. S. 126. In the present case the question of the identity of the invention in the original and re-issued patents is to be determined from their face by mere comparison, notwithstanding what was said in Battin *v.* Taggert (17 How. 74), and consistently with Bischoff *v.* Wethered (9 Wall. 812), according to the rule laid down in Seymour *v.* Osborne (11 Wall. 516), and Powder Company *v.* Powder Works, *supra*. That is, if it appears from the face of the instruments that extrinsic evidence is not needed to explain terms of art, or to apply the descriptions to the subject-matter, so that the court is able from mere comparison to say what is the invention described in each, and to affirm from such mere comparison that the inventions are not the same, but different, then the question of identity is one of pure construction, and not of evidence, and consequently is matter of law for the court, without any auxiliary matter of fact to be passed upon by a jury, if the action be at law." 21 O. G. 1443 (1446).

In Glue Co. *v.* Upton (1874), 6 O. G. 837, Clifford, J.: (838) "Power to surrender patents for the purposes suggested in the act of Congress implies that the specification may be corrected to cure the defect and to supply the deficiency, but interpolations in a re-issued patent of new features or ingredients or devices, which were neither described, suggested, nor substantially indicated in the original specification, drawings, or Patent Office model, are not allowed. (Battin *v.* Taggert, 17 How. 86; O'Reilly *v.* Morse, 15 How. 112; Sickles *v.* Evans, 2 Cliff. 222; Cahart *v.* Austin, 2 Cliff. 536.) Nor is parol testimony admissible in an application for a re-issue to enlarge the scope and nature of the invention beyond what was described, suggested, or substantially indicated in the original specification, drawings, or Patent Office model, as the purpose of a surrender and re-issue is not to introduce new features, ingredients, or devices into the patent, but to render effectual the actual invention for which the original patent should have been granted. Whether a re-issued patent is or is not for the same invention as the surrendered original cannot be satisfactorily determined without a comparison of the two, as the decision must necessarily depend very largely upon the question whether the specification and drawings of the re-issued patent are or are not substantially the same as those of the original, and if not, whether the changes or alterations are or are not greater than the act of Congress granting the power of surrender and re-issue allows." 4 Clifford, 237 (239); 1 Bann. & A. 497 (500).

That a re-issue cannot claim matters inconsistent with the specification, drawings, and model of the original, even though the same matters were claimed in the original patent, see *Ex parte* Warren (1876), 10 O. G. 1.

That where the original patent does

taken together and construed as mutually interpreting each other,[2] constitute the attempt of the inventor to disclose to others the idea of means which he has himself conceived and reduced to practice, and which he has selected as the subject-matter of his patent; and in the very nature of things this attempt must be so far successful as to afford some substantial indication or suggestion of the actual invention which is to be embraced in the proposed monopoly. An idea which the inventor is unable to express in words, or by pictorial representation, or in tangible materials, must either be so far abstract and indefinite as to lie outside the domain of the concrete industrial arts, or the inventor himself must have failed to apprehend it with that clearness and exactness which alone entitles him to claim the complete performance of an inventive act.[3] Cases in which an inventor, having *con*ceived the idea of means, having *per*ceived it, and having reduced it to practice in a new art or instrument, honestly attempts to describe and claim it, and yet succeeds in giving no substantial indication of its character and scope, must be so rare, if in-

not describe the real invention, the remedy is by a new application and patent, not by re-issue, see James *v.* Campbell (1881), 104 U. S. 356; 21 O. G. 337; Sarven *v.* Hall (1872), 1 O. G. 437; 9 Blatch. 524; 5 Fisher, 415.

The fact that a device is not mentioned in the original is evidence that a re-issue which claims it is for a different invention, see Campbell *v.* James (1879), 18 O. G. 979; 17 Blatch. 42; 4 Bann. & A. 456.

That the question is never how the original might have described the invention but how it did describe it, see Hammond *v.* Franklin (1885), 23 Blatch. 77; 22 Fed. Rep. 833; 30 O. G. 1324.

That the article, as made by the inventor before his application, was the same as that claimed in the re-issue is of no consequence, unless it was so described in the original patent, see Hammond *v.* Franklin (1885), 23 Blatch. 77; 22 Fed. Rep. 833; 30 O. G. 1324.

That a re-issue may claim whatever clearly appears, either by the specification, drawings, or model of the original patent, to have been part of the invention it intended to protect, see Calkins *v.* Bertraud (1875), 6 Bissell, 494; 9 O. G. 795; 2 Bann. & A. 215; Chicago Fruit House Co. *v.* Busch (1871), 2 Bissell, 472; 4 Fisher, 395.

[2] That a re-issue can cover nothing which is not found either in the specification, drawings, or model of the original, though either of these may be aided by the others, see Sarven *v.* Hall (1872), 9 Blatch. 524; 1 O. G. 437; 5 Fisher, 415.

[3] That what an alleged inventor cannot describe he cannot have invented, see Smith *v.* Downing (1850), 1 Fisher, 64; Boulton *v.* Bull (1795), 2 H. Bl. 463; 1 Abb. P. C. 59.

See also § 79 and notes, *ante*.

deed such a case is possible, that the rule is liberal enough toward *any* careful and diligent patentee, and *no* indulgence beyond this can be accorded to him without endangering the public interests and unjustly limiting the rights of subsequent inventors.[4]

§ 666. The Attempt of the Inventor to Describe and Claim the Invention may Appear either in the Original Specification, the Drawings, or the Model.

The attempt of the inventor to cover the invention by his original patent may appear either in the specification, the model, or the drawings.[1] If it were contained only in the

[4] Rev. Stat. Sec. 4916.

That an invention cannot be added to for re-issue purposes by proof that it really included matters not shown, see Averill Chemical Paint Co. *v.* National Mixed Paint Co. (1881), 20 Blatch. 42; 22 O. G. 585; 9 Fed. Rep. 462; Tarr *v.* Webb (1872), 10 Blatch. 96; 5 Fisher, 593; 2 O. G. 568.

That a re-issue cannot be granted on proof where there are no drawings, model, or specifications to show the invention, see Averill Chemical Paint Co. *v.* National Mixed Paint Co. (1881), 22 O. G. 585; 20 Blatch. 42; 9 Fed. Rep. 462.

That a re-issue cannot contain Claims which either the patent or contemporary records show could not have been embraced in the original, see Combined Patents Can Co. *v.* Lloyd (1882), 21 O. G. 713; 11 Fed. Rep. 149; 15 Phila. 481.

That no parol proof is admissible to show that the inventor intended to describe or claim matter not indicated to some extent in his original patent, see Tarr *v.* Webb (1872), 10 Blatch. 96; 5 Fisher, 593; 2 O. G. 568; Sarven *v.* Hall (1872), 9 Blatch. 524; 1 O. G. 437; 5 Fisher, 415; Cahart *v.* Austin, (1865), 2 Clifford, 528; 2 Fisher, 543.

§ 666. [1] That it is enough if the attempt of the inventor appears in the drawings, though it is not shown in the specification, see Smith *v.* Merriam (1881), 19 O. G. 601; 6 Fed. Rep. 713; Washburn & Moen Mfg. Co. *v.* Haish (1880), 10 Bissell, 83; 7 Fed. Rep. 906; Kerosene Lamp Heater Co. *v.* Littell (1878), 13 O. G. 1009; 3 Bann. & A. 312; Bantz *v.* Elsas (1874), 6 O. G. 117; 1 Bann. & A. 351; Booth *v.* Parks (1874), 1 Bann. & A. 225; 1 Flippin, 381; Swift *v.* Whisen (1867), 3 Fisher, 343; 2 Bond, 115.

That the attempt may be shown only in the model of the original patent, see Hendy *v.* Golden State & Miners' Iron Works (1883), 17 Fed. Rep. 515; 8 Sawyer, 468; Meyer *v.* Goodyear India Rubber Glove Mfg. Co. (1881), 11 Fed. Rep. 891; 22 O. G. 681; 20 Blatch. 91; Smith *v.* Merriam (1881), 19 O. G. 601; 6 Fed. Rep. 713; *Ex parte* Hunt (1879), 15 O. G. 831; Reissner *v.* Anness (1877), 13 O. G. 870; 3 Bann. & A. 176; *Ex parte* Baldwin (1876), 9 O. G. 639.

That the original patent may be amended by the model in the Patent Office or by the drawings, and the model may be inspected by the court, see Hendy *v.* Golden State & Miners' Iron Works (1883), 8 Sawyer, 468; 17 Fed. Rep. 515; Reissner *v.* Anness (1877), 3 Bann. & A. 176; 13 O. G. 870.

model, and the model has since been destroyed or lost, proper proof of its existence in the model may be offered, if consistent with the original drawings and Description.[2] And in examining the latter for this purpose, the application for the original patent, with its various amendments and substitutions, may be consulted, as throwing light upon the actual subject-matter which the inventor did endeavor to describe.[3]

§ 667. How the Attempt of the Inventor to Describe and Claim the Invention Embraced in the Re-issued Patent must Appear in the Original Specification, Drawings, or Model.

The attempt of the inventor to secure by his original patent the invention claimed in the re-issue is sufficiently indicated in his original specification, drawings, or model, whenever the Patent Office or the courts, by examining them in the light of the actual invention or the perfect re-issue specification, can perceive that if the original claims and descriptions had been free from substantive defects of statement the inventions covered by the original and re-issued patents would have been identical. The Patent Office, in endeavoring to afford the inventor the widest protection to which he is entitled, may,

[2] That it is sufficient if the attempt to cover alleged new matter were shown only in the model of the original, though the model is now lost, see Meyer *v.* Goodyear's India Rubber Glove Mfg. Co. (1881), 20 Blatch. 91 ; 22 O. G. 681 ; 11 Fed. Rep. 891.

That a re-issue cannot include an element not found either in the drawings or specifications, simply on the ground that the model is imperfect and that this may be the missing element, see Stockwell *v.* Haines (1877), 12 O. G. 137 ; *Ex parte* Seibert (1877), 12 O. G. 268.

That a re-issue cannot wholly change the character of the original invention, from what it appears in the specification and drawings, on the strength of a feature shown in the model, see Parker & Whipple Co. *v.* Yale Clock Co. (1883), 21 Blatch. 485 ; 25 O. G. 290 ; 18 Fed. Rep. 43.

That a re-issue will not be granted for what is shown in the model, if it contradicts the drawings and specifications, see *Ex parte* Hunt (1879), 15 O. G. 831.

That the Office model alone is not sufficient basis for a new Claim in the re-issue, unless it also appears that the inventor originally intended to claim the feature in question, see Flower *v.* Detroit (1888), 127 U. S. 563 ; 43 O. G. 1348.

[3] That where there have been successive applications for the original patent, these may be examined in order to ascertain what the inventor attempted to claim, see *Ex parte* Sexton (1876), 9 O. G. 251.

in certain cases, explore the history of the art to ascertain what the inventor might have claimed, and give effect to any phrases in the original description which can fairly be construed to cover it.[1] But in the courts the original specification, model, and drawings must speak for themselves, — not, of course, with perfect clearness and completeness, for then no amendment would be needed, but yet so as to render it apparent to the judicial mind, when comparing the original with the re-issue, that the inventions intended to be set forth in each patent are the same.[2] Thus matter mentioned in the Claims of the original but not consistent with the Description nor found either in the model or in the drawings, and matter merely alluded to as possible and useful but not suggested as a part of the invention to be patented, are alike outside the rule and cannot be embraced in the re-issue.[3] But matter stated to belong to the claimed invention, or appearing

§ 667. [1] See § 664, note 2, *ante*.

[2] In Thomas *v.* Shoe Mach. Mfg. Co. (1878), 16 O. G. 541, Clifford, J.: (542) "Inquiries in such a case are restricted to a comparison of the terms and import of the two patents in view of the drawings and Patent Office model. If from these it results that the invention claimed in the re-issue is not substantially different from the one described, suggested, or indicated in the specification or drawings of the original patent or Patent Office model, the re-issued patent must be held valid, as all other alterations and amendments plainly fall within the intent and purpose of the provision in the act of Congress which allows a surrender and re-issue; or, in other words, if the re-issued patent does not, upon the face of the instrument, embrace anything not substantially described, suggested, or indicated in the specifications, drawings, or model of the original, the defence that the re-issued patent is not for the same invention as the original must be overruled." 3 Bann. & A. 557 (561). See also Heald *v.* Rice (1882), 104 U. S. 737; 21 O. G. 1443; Glue Co. *v.* Upton (1874), 6 O. G. 837; 4 Clifford, 237; 1 Bann. & A. 497; and § 664, note 2, *ante*.

That the courts will not explore the history of the art to ascertain what the inventor might have claimed and may have attempted to patent, see James *v.* Campbell (1881), 104 U. S. 356; 21 O. G. 337; Keystone Bridge Co. *v.* Phœnix Iron Works (1877), 95 U. S. 274; 12 O. G. 980.

That the original and re-issued patents are construed according to the state of the art at the date of the application for the original, see Eachus *v.* Broomall (1885), 115 U. S. 429; 33 O. G. 1265; Garneau *v.* Dozier (1880), 102 U. S. 230; 19 O. G. 61.

[3] That matter appearing only in the Claim of the original patent, and not consistent with the description, cannot be regarded as belonging to the invention, see *Ex parte* Warren (1876), 10 O. G. 1.

That a re-issue cannot claim what is merely alluded to in the original as a possibility, but is not described therein as part of the invention, see *Ex parte* Evans (1873), 3 O. G. 180.

as a part thereof in the model or the drawings, although as thus described the invention is impracticable, and matter necessarily implied by what is actually described though not itself expressed in any form, are so contained in the original that an amendment by re-issue may include them.[4] When the original patent has already been before the courts, and it has been judicially determined that its description relates to but a single form of the invention, its model, drawings, and specification must be thenceforth regarded as attempting to describe only that form of the invention, and the re-issue must be limited in a corresponding manner.[5]

§ 668. Variations between the Descriptions and Claims of the Original and Re-issued Patents not Inconsistent with Identity of Subject-Matter.

The restriction of a re-issue to the subject-matter attempted to be covered by the original patent does not require an exact correspondence between the specifications, drawings, and models of the original and re-issued patents, except in machine-patents where the model and drawings can be amended only by each other.[1] The specification of the re-issue may

[4] That matter which as described is impracticable, may be redescribed and claimed in a practically operative form, see Wheeler *v.* McCormick (1873), 6 Fisher, 551 ; 11 Blatch. 334 ; 4 O. G. 692 ; Wheeler *v.* Clipper Mower & Reaper Co. (1872), 10 Blatch. 181 ; 6 Fisher, 1 ; 2 O. G. 442.

That a re-issue may include matters not described or claimed in the original patent if they were really parts of the original invention, and are necessarily implied by what was described, see Eames *v.* Andrews (1887), 122 U. S. 40 ; 39 O. G. 1319 ; *Ex parte* Siemens (1877), 12 O. G. 626.

[5] That a re-issue, after the specification of the patent has been construed by the courts, cannot claim a different form of the invention from that held to have been described in the original, see Cammeyer *v.* Newton (1879), 4 Bann. & A. 159 ; 16 O. G. 720.

That a re-issue may extend the patent beyond the judicial interpretation of the original Claims, see Poppenhusen *v.* Falke (1862), 5 Blatch. 46 ; 2 Fisher, 213.

§ 668. [1] In Stevens *v.* Pritchard (1876), 4 Clifford, 417, Clifford, J. : (422) "Corrections may be made in such cases by the specifications, drawings, or Patent Office model, and if the alterations do not exceed what was well described before, and what is substantially suggested or indicated in the surrendered specifications, drawings, and Patent Office model, the re-issued patent cannot be held invalid upon the ground that it embodies and secures a different invention from the original." 10 O. G. 505 (507) ; 2 Bann. & A. 390 (395).

In French *v.* Rogers (1851), 1 Fisher, 133, Kane, J. ; (138) "It is not the meaning of the law that the paten-

vary from that of the original in its language,[2] in its general

tee who applies for a re-issue must, at his peril, describe and claim in his new specification, either in words or idea, just what was described and claimed in his old one. His new specification must be of the same invention, and his Claim cannot embrace a different subject-matter from that which he sought to patent originally. But, unless we narrow down the correction which the statute contemplates till it becomes a mere disclaimer, it is not possible in any case to frame a correct specification which shall not be broader than the one originally filed. To supply a defect, to repair an insufficiency, is to add, — either directly, or by modifying or striking out a limitation; in either form, the effect is to amplify the proposition; in the case of a specification under the Patent Laws, it is to amplify the Description and enlarge the Claim."

That immaterial differences between the original and the re-issue, not affecting the construction or the mode of operation of the invention are permissible, see Crandall *v.* Watters (1881), 20 Blatch. 97; 21 O. G. 945; 9 Fed. Rep. 659; McCrary *v.* Penna. Canal Co. (1880), 5 Fed. Rep. 367; 14 Phila. 441; Herring *v.* Nelson (1877), 14 Blatch. 293; 12 O. G. 753; 3 Bann. & A. 55; Glue Co. *v.* Upton (1874), 4 Clifford, 237; 1 Bann. & A. 497; 6 O. G. 837; Parham *v.* American Buttonhole, Overseaming, & Sewing Mach. Co. (1871), 4 Fisher, 468.

That a re-issue may make definite what was before reached only by inference, see Hicks *v.* Otto (1884), 22 Blatch. 94; 29 O. G. 365; 19 Fed. Rep. 749.

That in the re-issue of other than machine-patents the specification may be made more certain or the Claim made to correspond with the specification, but nothing more, see Giant Powder Co. *v.* California Powder Works (1875), 3 Sawyer, 448; 2 Bann. & A. 131.

That models and drawings in machine-patents can be amended only by each other, see Stockwell *v.* Haines (1877), 12 O. G. 137.

[2] In Kerosene Lamp Heater Co. *v.* Littell (1878), 3 Bann. & A. 312, Nixon, J.: (316) "It must be for the same invention; but, subject to this limitation, such changes may be introduced in the Description, specifications, or Claims, as may be deemed necessary to give validity to the invention, and protect it against infringement. Whatever is fairly indicated, either in the schedules, drawing, or model of the original, may be comprehended in the specifications and Claims of a re-issue without subjecting the patentee to the imputation of claiming more than he is entitled to." 13 O. G. 1009 (1010).

In Herring *v.* Nelson (1877), 12 O. G. 753, Johnson, J.: (755) "That in re-describing his invention the patentee is not rigidly confined to what was described before, but that he may include in the new description whatever else was suggested or substantially indicated in the old, provided it was embraced in the invention as actually made and perfected. Differences in the Description and Claims of the old and new specifications are not the tests of substantial diversity, but the Description may be varied and the Claim restricted or enlarged, provided the identity of the subject-matter of the original patent is preserved. Within this range whatever change is required to protect and effectuate the invention is allowable." 14 Blatch. 293 (300); 3 Bann. & A. 55 (62).

In La Baw *v.* Hawkins (1874), 1 Bann. & A. 428, Nixon, J.: (430) "The patentee has a right to change his modes of expressing his specifications

description of the invention,[3] in its statement of the best mode

or Claims, — restricting or enlarging them, so as more fully to effectuate his intention. Variations in this respect do not make the two patents different. The precise object of the statute is to authorize such amendments. What he is not allowed to do is to interpolate into the re-issue new features and devices, which were not suggested or substantially indicated in the original specifications, drawings, models, or Claims." 6 O. G. 724 (725).

In Aultman *v.* Holley (1873), 11 Blatch. 317, Woodruff, J. : (319) "It is always to be borne in mind, in considering the validity of a re-issued patent, in the face of the objection before us, that the object of a re-issue, and the purpose of the law in permitting the surrender of a patent and a re-issue thereof, are to correct, or rather perfect, a defective or insufficient description or specification, including the Claim which the patentee makes to the devices described and which he alleges are his invention. The re-issue is, therefore, not to be tested by the mere language of the original specification, for the fact of re-issue proceeds upon the ground that such language is defective or insufficient." 6 Fisher, 534 (538) ; 5 O. G. 3 (5).

That the language of the re-issue specification may differ from that of the original, see Dunbar *v.* White (1883), 23 O. G. 1446 ; 15 Fed. Rep. 747 ; National Pump Cylinder Co. *v.* Gunnison (1883), 17 Fed. Rep. 812 ; Davis *v.* Brown (1881), 20 O. G. 1021 ; 9 Fed. Rep. 647 ; 19 Blatch. 263 ; Pearl *v.* Ocean Mills (1877), 2 Bann. & A. 469 ; 11 O. G. 2 ; Sprague *v.* Adriance (1877), 3 Bann. & A. 124 ; 14 O. G. 308 ; Putnam *v.* Yerrington (1876), 9 O. G. 689 ; 2 Bann. & A. 237 ; Tucker *v.* Tucker Mfg. Co. (1876), 2 Bann. & A. 401 ; 4 Clifford, 397 ; 10 O. G. 464 ; Carew *v.* Boston Elastic Fabric Co. (1871), 3 Clifford, 356 ; 5 Fisher, 90 ; 1 O. G. 91.

That variances in the title, Descriptions, and Claims of the original and re-issue will not affect the latter, if the inventions are the same, see Penna. Salt Mfg. Co. *v.* Thomas (1871), 5 Fisher, 148 ; 8 Phila. 144.

That general descriptions in the original may be made definite in the re-issue if the invention is unchanged, see St. Louis Stamping Co. *v.* Quinby (1879), 16 O. G. 135 ; 4 Bann. & A. 192.

That the omission in the re-issue of ambiguous words of the original does not enlarge the invention, see Atlantic Giant Powder Co. *v.* Goodyear (1877), 13 O. G. 45 ; 3 Bann. & A. 161.

That the re-issue may contain new words or phrases more accurately descriptive of the invention, see Draper *v.* Potomska Mills Co. (1878), 13 O. G. 276 ; 3 Bann. & A. 214.

That a re-issue may omit words used in the original, see Allen *v.* Blunt (1846), 2 W. & M. 121 ; 2 Robb, 530.

That a re-issue changing one letter in name of patentee, viz., Denchfield to Deuchfield, is good, see Bignall *v.* Harvey (1880), 18 Blatch. 353 ; 18 O. G. 1275 ; 4 Fed. Rep. 334.

[3] In Potter *v.* Stewart (1881), 18 Blatch. 561, Blatchford, J. : (562) "It is of no consequence that the re-issue states that certain combinations are found in the machine, which will act in a certain way and effect certain results, when the original did not state that such combinations were found there, or failed to state that said modes of operation and said results would follow, provided the said combinations in fact existed in a machine made according to the drawings and description in the original patent, or provided the

of using or constructing the invention,[4] or in the number and

said modes of operation and the said results in fact followed in a machine so made. To supply such defects is the very object and office of a re-issue." 19 O. G. 997 (997) ; 7 Fed. Rep. 215 (216).

That identity and diversity between the original and re-issue depends on the things described, not on the mere descriptions, see Herring *v.* Nelson (1877), 3 Bann. & A. 55 ; 12 O. G. 753 ; 14 Blatch. 293.

That the description of the re-issue may be more full and accurate than the original, see Washburn & Moen Mfg. Co. *v.* Haish (1880), 19 O. G. 173 ; 10 Bissell, 65 ; 4 Fed. Rep. 900 ; Robertson *v.* Secombe Mfg. Co. (1873), 6 Fisher, 268 ; 3 O. G. 412 ; 10 Blatch. 481 ; Crompton *v.* Belknap Mills (1869), 3 Fisher, 536 ; Poppenhusen *v.* Falke (1861), 4 Blatch. 493 ; 2 Fisher, 181.

That a re-issue may describe more fully and set forth distinct functions, or those not before stated, see Doane & Wellington Mfg. Co. *v.* Smith (1882), 24 O. G. 302 ; 15 Fed. Rep. 459.

That in a re-issue enlarging the Claims, the Claims alone are involved, and if the Description covers more than the Claims it is of no consequence, see Turner & Seymour Mfg. Co. *v.* Dover Stamping Co. (1884), 111 U. S. 319 ; 27 O. G. 1131.

That a re-issue may contain a fuller description of the state of the art, of the nature of the improvement, and of the advantages secured by its use, see Robertson *v.* Secombe Mfg. Co. (1873), 3 O. G. 412 ; 6 Fisher, 268 ; 10 Blatch. 481.

That a re-issue may describe a well-known thing differently from the original, see Tarr *v.* Folsom (1874), 1 Bann. & A. 24 ; 5 O. G. 92 ; Holmes 312.

That substances directly indicated in the original may be described in the re-issue, see Penna. Salt Mfg. Co. *v.* Thomas (1871), 5 Fisher, 148 ; 8 Phila. 144.

That the re-issue may more fully describe surrounding parts, remove false impressions, or show how difficulties may be avoided, see Kearney *v.* Lehigh Valley R. R. Co. (1887), 32 Fed. Rep. 320.

That where the original imperfectly describes what the state of the art shows to have been the real invention, the re-issue may cover it, see Yale Lock Mfg. Co. *v.* Scoville Mfg. Co. (1880), 18 Blatch. 248 ; 3 Fed. Rep. 288.

That the re-issue may describe and claim the invention either with or without the adjuncts described in the original, if the invention in both be really the same, see National Spring Co. *v.* Union Car Spring Mfg. Co. (1874), 6 O. G. 224 ; 12 Blatch. 80.

That a re-issue may redescribe the invention by the original model, drawings, or specification, but it is doubtful if it can go beyond these and include matter shown in the original application only, see Cahart *v.* Austin (1865), 2 Fisher, 543 ; 2 Clifford, 528.

[4] In Broadnax *v.* Central Stock-Yard & Transit Co. (1880), 4 Fed. Rep. 214, Nixon, J. : (216) "Because one mode only is indicated in the original, the patentee is not shut up to the one mode in the re-issue, as long as it is not of the essence of the invention. The law, indeed, requires him to disclose some mode by which it can be rendered practically useful, but it does not follow that he is confined to that, and may use no other." 5 Bann. & A. 609 (611).

That a re-issue may point out new uses or modes of using the original invention, see Potter *v.* Stewart (1881), 19 O. G. 997 ; 7 Fed. Rep. 215 ; 18 Blatch. 561 ; *Ex parte* Palmer (1880),

scope of its Claims.[5] The Claims, if previously too narrow,

17 O. G. 970; De Florez *v.* Raynolds (1878), 14 Blatch. 505; 3 Bann. & A. 292; *Ex parte* Donaldson (1873), 4 O. G. 4.

That a mistake in the original patent, as to the effect produced by the use of the invention, may be corrected by re-issue, not by disclaimer, see Schillinger *v.* Gunther (1878), 14 O. G. 713; 15 Blatch. 303; 3 Bann. & A. 491.

That the re-issue is good though it expresses different views from the original as to which one of two modes of construction is best, see American Nicholson Pavement Co. *v.* Elizabeth (1873), 3 O. G. 522; 6 Fisher, 424.

That a re-issue may depart from the original in *matters of mechanical adaptation*, see Decker *v.* Grote (1873), 10 Blatch. 331; 6 Fisher, 143; 3 O. G. 65.

[5] That a re-issue may explain and modify the Claims of the original, see Smith *v.* Merriam (1881), 19 O. G. 601; 6 Fed. Rep. 713; Woodward *v.* Dinsmore (1870), 4 Fisher, 163.

That the inventions may be the same though the Claims of the re-issue be entirely unlike those of the original, see Hussey *v.* Bradley (1863), 2 Fisher, 362; 5 Blatch. 134; Hussey *v.* McCormick (1859), 1 Fisher, 509; 1 Bissell, 300.

That the invention can be divided into distinct Claims in a re-issue, see Brown *v.* Deere (1881), 19 O. G. 361; 2 McCrary, 422; 6 Fed. Rep. 484.

That an improper multiplication of Claims in the re-issue does not affect the patent, the superfluous Claims being void, see Dederick *v.* Cassell (1881), 20 O. G. 1233; 9 Fed. Rep. 306; 14 Phila. 503.

That the re-issue may contain new Claims founded on the original Description, see Combined Patents Can Co. *v.* Lloyd (1882), 11 Fed. Rep. 149; 21 O. G. 713; 15 Phila. 481.

That a re-issue may claim matters found in the original Description though the inventor made no attempt to insert them in his Claims, see Eickemeyer Hat Blocking Mach. Co. *v.* Pearce (1873), 3 O. G. 150; 10 Blatch. 403; 6 Fisher, 219.

That a re-issue may restate the invention and claim such essential features as are not clearly stated in the original, see Woven Wire Mattress Co. *v.* Wire Web Bed Co. (1881), 8 Fed. Rep. 87.

That a re-issue may secure a different feature of the invention from the one claimed in the original patent, if it does not go beyond the invention described or suggested in the original, see Stevens *v.* Pritchard (1876), 4 Clifford, 417; 10 O. G. 505; 2 Bann. & A. 390.

That the patentee may in a re-issue claim a form of the invention described but not claimed in the original, when its importance has become apparent since the original was granted, see Atwood *v.* Portland Co. (1880), 5 Bann. & A. 533; 10 Fed. Rep. 283.

That where an original patent describes two forms of the invention and claims but one, the re-issue may claim the other, see American Nicholson Pavement Co. *v.* Elizabeth (1873), 6 Fisher, 424; 3 O. G. 522.

That the re-issue may cover the actual invention made, according to the original specification and drawings, though the specification may not have accurately described it, see Potter *v.* Stewart (1881), 7 Fed. Rep. 215; 18 Blatch. 561; 19 O. G. 997.

That a re-issue may contain new drawings based on the original specification, see Union Paper Bag Co. *v.* Nixon (1873), 6 Fisher, 402; 4 O. G. 31.

That the drawings of the re-issue may contain features not shown in the drawings of the original, see Union Paper

may be extended to embrace the entire patented invention, unless the additional features have been abandoned;[6] or, if excessive, may be so reformed as to exclude the matter hitherto improperly embraced within the patent.[7] But matter once described in the original specification as essential to the invention cannot be omitted;[8] and matter once disclaimed —

Bag Co. *v.* Nixon (1873), 4 O. G. 31; 6 Fisher, 402.

That the drawings may be amended in matters outside the model if it does not affect the Claims of the re-issue, see Pearl *v.* Appleton Co. (1880), 3 Fed. Rep. 153.

[6] That the Claims of a re-issue may be stated in language differing from those of the original, see Fay *v.* Fraser (1882), 11 Bissell, 422; 14 Fed. Rep. 652; La Baw *v.* Hawkins (1874), 6 O. G. 724; 1 Bann. & A. 428; Poppenhusen *v.* Falke (1862), 2 Fisher, 213; 5 Blatch. 46.

That the re-issue may cover the invention though it is broader than the patentee at first supposed, see Tuttle *v.* Loomis (1885), 24 Fed. Rep. 789; 30 O. G. 344.

That in a re-issue the Claims may be either enlarged or restricted as may be necessary to cover the actual invention, see Dorsey Harvester Rake Co. *v.* Marsh (1873), 6 Fisher, 387.

That enlarging Claims is not enlarging the invention, see Jenkins *v.* Stetson (1887), 32 Fed. Rep. 398; Odell *v.* Stout (1884), 22 Fed. Rep. 159; 29 O. G. 862.

That the re-issue may claim more than the original, see Robertson *v.* Seecombe Mfg. Co. (1873), 6 Fisher, 268; 3 O. G. 412; 10 Blatch. 481.

That an element described but not claimed in the original patent, may be claimed in the re-issue, see Loring *v.* Hall (1879), 15 O. G. 471.

That a re-issue cannot claim other and distinct things from those attempted to be claimed in the original, see Kells *v.* McKenzie (1881), 9 Fed. Rep. 284; 20 O. G. 1663. See also Am. Law Rev. vol. xv. p. 731.

That where the original patent fully and clearly describes and claims a specific invention so as not to be invalid by reason of an insufficient specification, the re-issue cannot expand and generalize the Claims so as to go beyond the original, see James *v.* Campbell (1882), 104 U. S. 356; 21 O. G. 337; Gill *v.* Wells (1874), 22 Wall. 1; 6 O. G. 881; Burr *v.* Duryee (1863), 1 Wall. 531.

That the omission of ambiguous words in the re-issue does not enlarge it, see Atlantic Giant Powder Co. *v.* Goodyear (1877), 3 Bann. & A. 161; 13 O. G. 45.

That the opinion of the inventor, stated in the re-issue, as to the character of his invention is not improper if it does not affect the Claims, see Reed *v.* Chase (1885), 25 Fed. Rep. 94; 33 O. G. 996.

[7] That the re-issue may be narrower than the original if the invention is unchanged, see Gould *v.* Ballard (1878), 3 Bann. & A. 324; 13 O. G. 1081.

That a re-issue need not claim all matters found in the original, see Gould *v.* Ballard (1878), 3 Bann. & A. 324; 13 O. G. 1081; Albright *v.* Celluloid Harness Trimming Co. (1877), 12 O. G. 227; 2 Bann. & A. 629; Chicago Fruit House Co. *v.* Busch (1871), 4 Fisher, 395; 2 Bissell, 472; Crompton *v.* Belknap Mills (1869), 3 Fisher, 536; Carver *v.* Braintree Mfg. Co. (1843), 2 Story, 432; 2 Robb, 141; Knight *v.* Baltimore & Ohio R. R. Co. (1840), 3 Fisher, 1; Taney, 106.

[8] That a re-issue cannot treat as non-essential what the original treated as es-

whether during the proceedings in the Patent Office in order to avoid an interference or to overcome the objections of an examiner, or in the body of the original patent, or by a subsequent disclaimer filed to save the patent or secure the costs of suit, — cannot be reclaimed, except in cases where the party applying for and obtaining the re-issue could not, according to the principles of equity, be regarded as estopped by the disclaimer.[9] The legal effect of such amendments, if allowed, would be an enlargement of the patented invention, and an insertion into the re-issue of features wholly distinct from or in addition to the subject of the original patent. Whatever variations may be made in the description or the Claims of the re-issue, neither directly nor indirectly can new matter be introduced into the patent,[10] by embracing parts of the

sential, see Russell *v.* Dodge (1876), 93 U. S. 460; 11 O. G. 151.

That an immaterial element may be dropped in the re-issue, see McWilliams Mfg. Co. *v.* Blundell (1882), 22 O. G. 177; 11 Fed. Rep. 419; Union Paper Collar Co. *v.* Van Deusen (1872), 5 Fisher, 597; 10 Blatch. 109; 2 O. G. 361; Woodward *v.* Dinsmore (1870), 4 Fisher, 163.

That where a difference in the number or quantity of the parts of an invention does not affect its substantial character or mode of operation, a re-issue for less than the original is good, see Coburn *v.* Schroeder (1881), 20 O. G. 1524; 8 Fed. Rep. 519; 19 Blatch. 377.

That an element apparently material may be omitted in the re-issue if the essence of the invention be unchanged, see McWilliams Mfg. Co. *v.* Blundell (1882), 22 O. G. 177; 11 Fed. Rep. 419.

That the re-issue may restrict the invention by omitting minor features described in the original, see Gould *v.* Ballard (1877), 13 O. G. 1081; 3 Bann. & A. 324.

[9] See §§ 680, 687–689, and notes, *post.*

That the re-issue is good where equity would decree the same correction of the mistake, see Jones *v.* Barker (1882), 11 Fed. Rep. 597; 22 O. G. 771; Miller *v.* Brass Co. (1881) 104 U. S. 350; 21 O. G. 201.

[10] In Thomas *v.* Shoe Mach. Mfg. Co. (1878), 16 O. G. 541, Clifford, J.: (542). "Patents may be surrendered to be corrected, and the power to surrender implies that the specification may be corrected to the extent necessary to cure the defects and to supply the deficiencies to render the patent operative and valid; but the patentee may not interpolate new features not described, suggested, or substantially indicated either in the specification, drawings, or Patent Office model. Interpolations of the kind, if material, show that the Commissioner exceeded his jurisdiction, and where that is done it clearly becomes *the duty of the court to declare the patent void.*" 3 Bann. & A. 557 (560).

In Russell *v.* Dodge (1876), 93 U. S. 460, Field, J.: (463) "And as a re-issue could only be granted for the same invention embraced by the original patent, the specification could not be substantially changed, either by the addition of new matter or the omission of important particulars, so as to enlarge

invention which the patentee did not attempt to cover by his former patent, or by reviving claims then made and since

the scope of the invention as originally claimed. A defective specification could be rendered more definite and certain so as to embrace the Claim made, or the Claim could be so modified as to correspond with the specification; but except under special circumstances, such as occurred in the case of Lockwood *v.* Morey, 8 Wall. 230, where the inventor was induced to limit his Claim by the mistake of the Commissioner of Patents, this was the extent to which the operation of the original patent could be changed by the re-issue. The object of the law was to enable patentees to remedy accidental mistakes, and the law was perverted when any other end was secured by the re-issue." 11 O. G. 151 (152).

In Stevens *v.* Pritchard (1876), 4 Clifford, 417, Clifford, J.: (421) "Surrenders are allowed in order that what was imperfect before may be made perfect, and in order that what was before ambiguous may be made clear and certain; and for that purpose the patentee may add whatever was substantially suggested or indicated in the original specifications, drawings, or Patent Office model. New features may not be introduced for the reason that every interpolation of the kind is forbidden by the act of Congress. Errors and defects may, however, be corrected under the conditions specified, and the prohibition that new features shall not be introduced must not be understood as taking away the right to include in the re-issue whatever was substantially suggested or indicated in the surrendered specifications, drawings, or Patent Office model." 10 O. G. 505 (506); 2 Bann. & A. 390 (393).

In Salamander Felting Co. *v.* Haven (1875), 3 Dillon, 131, Treat, J.: (134) "The repeated decisions by the courts, and especially by the United States Supreme Court, in the 1st, 17th, and 19th Wallace, indicate with sufficient distinctness, that not only no new matter shall be introduced, but that an enlargement of the original Claim, growing out of the subsequent advance of the art, is not to be tolerated. The reason of the rule is obvious. Every patent as to novelty or utility depends on the state of the art at the time of the claim made or patent issued, and, therefore, if a party, after learning from a subsequent advance of the art the worthlessness of his original invention, is to be permitted to claim a re-issue incorporating what was not originally in his mind, and what had been afterwards suggested to him only by advances in the art made by others, then he could, it may be, even without any new invention, override all the elements which would serve to test the validity of the new application. In other words, having procured a worthless patent, and having subsequently learned from the advancing art how, by changing the terms of his patent, it could be made of value, he would, if a re-issue, including the new matter, were permitted, have the re-issue not only relate back to the date of the original patent, but absorb within its privileges all subsequent matters, wholly unknown to, and unthought of by him, originally. This rule controls both the Patent Office and the courts. New matter must not be introduced. By new matter is not meant merely the introduction of a new ingredient in a patented composition, but any change in the original specification and Claim whereby a new and substantially different composition and results are secured." 9 O. G. 253 (254).

Further that "new matter" cannot be embraced in a re-issued patent, see

abandoned, or by extending his description to inventions created after the original patent had been granted.

Andrews *v.* Hovey (1883), 5 McCrary, 181; 16 Fed. Rep. 387; 26 O. G. 1011; Washburn & Moen Mfg. Co. *v.* Haish (1880), 10 Bissell, 65; 19 O. G. 173; 4 Fed. Rep. 900; Giant Powder Co. *v.* California Powder Works (1875), 3 Sawyer, 448; 2 Bann. & A. 131; Glue Co. *v.* Upton (1874), 1 Bann. & A. 497; 4 Clifford, 237; 6 O. G. 837; Carew *v.* Boston Elastic Fabric Co. (1871), 3 Clifford, 356; 5 Fisher, 90; 1 O. G. 91.

That a re-issue blending old matter and new matter in the same Claim is void, see Cahart *v.* Austin (1865), 2 Fisher, 543; 2 Clifford, 528.

That enlarged Claims are to be carefully scrutinized to see that they contain no new matter, see Tyler *v.* Welch (1880), 17 O. G. 1508; 3 Fed. Rep. 636; 18 Blatch. 209.

That new matter cannot be inserted in the re-issue though invented by the patentee and inadvertently omitted by him from the original, see Atwater Mfg. Co. *v.* Beecher Mfg. Co. (1881), 8 Fed. Rep. 608.

That where the original patent had no model or drawing, no new matter can be inserted in the re-issue on the ground that the inventor had it in his mind when the original application was filed, see *Ex parte* Dieckerhoff (1877), 12 O. G. 429.

That the rule as to the insertion of new matter is more strict in re-issues than in amendments to applications, — the former being governed by law, the latter by the discretion of the Commissioner, — see *Ex parte* Bragg (1875), 8 O. G. 985.

That new matter is anything not embraced in the original specifications, drawings, and model, see Dederick *v.* Cassell (1881), 14 Phila. 503; 20 O. G. 1233; 9 Fed. Rep. 306.

That where the same idea is found in the original specification and drawings, there is no new matter, see Christman *v.* Rumsey (1879), 58 How. Pr. 114; 17 Blatch. 148; 17 O. G. 903; 4 Bann. & A. 506.

That "new matter" in a re-issue is such an enlargement or alteration in the original specification and Claims as to include combinations or results which did not necessarily flow from the invention as originally described, see Putnam *v.* Yerrington (1876), 2 Bann. & A. 237; 9 O. G. 689.

That "new matter" in a re-issue is such as changes the invention or introduces what might be the subject of a new patent, see Seibert Cylinder Oil Cup Co. *v.* Harper Steam Lubricator Co. (1880), 4 Fed. Rep. 328; Powder Co. *v.* Powder Works (1878) 98 U. S. 126; 15 O. G. 289.

That nothing can be regarded as "new matter" unless it affects the substance of the invention, see Christman *v.* Rumsey (1879), 17 O. G. 903; 4 Bann. & A. 506; 58 How. Pr. 114; 17 Blatch. 148; *Ex parte* Carlock (1875), 8 O. G. 191.

That where the re-issue seeks to cover an infringing device it will be closely scrutinized, but will be valid if clearly for the same invention as the original patent, see Crompton *v.* Knowles (1881), 7 Fed. Rep. 199.

That unless it clearly appears that the re-issue contains new matters, substantially different from the original, it will be held valid, see Thomas *v.* Shoe Machinery Mfg. Co. (1878), 16 O. G. 541; 3 Bann. & A. 557.

That where the Claim in the re-issue states what the original Claim must have been construed to mean, there is no new matter, see Gold & Stock Telegraph Co. *v.* Commercial Telegram Co.

§ 669. The Re-issued Patent may Embrace all Inventions which the Original Patent Defectively or Insufficiently Described and Claimed, subject to the Rules Governing the Joinder of Inventions.

The application of this second proposition to individual cases of re-issue would be comparatively simple and easy were every patent limited to a single invention. Then having ascertained, in view of the state of the art at the date of the original patent, what were the essential attributes of the actual invention which the patentee endeavored to secure, as indicated in his specification, the amendments necessary to set forth and claim it with completeness and exactness could be readily perceived. But under the doctrines which permit the joinder of several distinct though dependent inventions in one patent, the subject becomes more complicated. The specification of a patent may describe and claim several distinct inventions, or it may describe several and claim only a certain number of those described, or it may describe and claim but one. In determining the scope of an original patent, as a basis for its amendment by re-issue, the question as to what invention the inventor has attempted to protect must then be variously answered. When the original specification describes but one invention, this of course is the only matter that can be embraced in the re-issue. But where it has described and claimed one art or instrument, and with that also has described subordinate parts which are distinct inventions, or has set forth additional inventions dependent on or independent of the one specifically claimed, the scope permissible to the re-issue must be subjected to a different test. It cannot be assumed that the original patent attempted to protect nothing except the one invention which it claimed. Nor, on the other hand, can it be supposed that the inventor intended to embrace therein distinct inventions, whose joinder with the principal invention is

(1885), 23 Blatch. 199; 23 Fed. Rep. 340; 31 O. G. 1559.

That a re-issue is too broad only where it embraces what was not described in the original as part of the invention or being described was abandoned, see Eames *v.* Andrews (1887), 122 U. S. 40; 39 O. G. 1319.

See further as to the subject of this paragraph, § 656, note 3, and § 661 and notes, *ante*, and § 693 and notes, *post*.

prohibited by law. In such cases, if the patent does not itself indicate the contrary, there seems to be no other practicable method of construing the original patent than to regard it as an attempt of the inventor to secure not only the invention claimed, but all the new results of his inventive skill whose nature and essential attributes he has substantially indicated in his description, and which were dependent on the invention covered by his original patent; and if these have not been abandoned or disclaimed they may all be included in the re-issue.[1] It is apparently upon this method that the courts and

§ 669. [1] Although no formal statement of this rule may be found in the reported cases, it has nevertheless been too often acted on by the courts to be disputed. The decisions cited in the subsequent paragraphs show that the test applied is not that of the presence of the subordinate or dependent inventions in the Claims of the original patent, but their capability of being claimed therein under the rules of joinder. It is taken for granted, where there are no indications to the contrary, that the patentee intended to secure by his original patent all those dependent and auxiliary inventions which he then described as resulting from his inventive act, and in the absence of any abandonment or estoppel, he is permitted to insert in his re-issue any such inventions which could lawfully have been claimed in the original. The few cases which depart from this rule are so manifestly unjust in their effect, and involve so wide a divergence from the settled principles of Patent Law, that they cannot be regarded as authority against the current practice of the Patent Office and the general position of the courts.

Within the limits of the doctrine thus declared there are, however, certain variations which deserve attention. Inventions capable of joinder may be either (1) mutually separable, or (2) mutually inseparable, or (3) one may be unable to subsist without the other though the other, on the contrary, could independently exist. Where the inventions are mutually inseparable a patent for one impliedly covers the other and is a bar to any subsequent patent therefor. The same is true where an invention, with which another is inseparably connected, has been patented. As in both these cases the unclaimed invention must either have been within the intended scope of the original patent, or have been abandoned to the public under circumstances which prevented the public from enjoying it by reason of its connection with the matter expressly patented, it is always a fair presumption that the patentee, by describing it in his original specification, endeavored to bring it within his monopoly and consequently has a right to claim it in his re-issue. But where the inventions are mutually separable or the invention sought to be introduced into the re-issue is not inseparable from the one claimed in the original patent, no such presumption can arise. Here it was optional for the inventor to have embraced the inventions in the same or different patents, and from the fact that he describes them in connection with the invention claimed in the original, no inference can be drawn that he did not intend to abandon them to the public or to procure for them a separate patent. In these cases the validity of the Claims by which they are appropriated in the re-issue must de-

the Patent Office have proceeded in affirming or denying the correspondence of re-issues with original patents in the different classes of cases which we now are to consider.

§ 670. Re-issued Combination-Patent cannot Embrace a Combination Essentially Distinct from that Described and Claimed in the Original Patent.

Where the subject-matter of the original patent is a combination, the re-issue may always cover the same combination; in some cases, it may be extended to protect sub-combinations, and in others to secure even the elements of which the combination is composed. The identity of the combination claimed in the re-issue with that which the inventor endeavored to describe and claim in the original specification depends upon the identity of their respective elements and of the co-operative law under which they are associated.[1] If the combination claimed in the re-issue contains less than all the elements of that described in the original, or if it substitutes for any former element an act or substance which is not its true equivalent,[2]

pend largely on the rules followed by the Office or the courts in comparing the original and re-issued patents. If the rule stated so often by Judge Clifford is adopted, — that the re-issue is valid unless the court can see that its subject-matter was not included in the attempt of the patentee to describe and claim his invention in the original specification, — such a relation between the inventions would, in the absence of any counter indications, relieve the original and re-issued patents from any appearance of repugnancy, and warrant a decision that the claims were valid. But if the rule is, as announced in more recent decisions, that a comparison of the two patents must affirmatively show that the invention claimed in the re-issue was evidently intended by the patentee to be embraced in his original Claims, a contrary conclusion might be reached, since the relation between the inventions is not incompatible with their intentional exclusion from the original patent. See also §§ 464–466 and notes, *ante*.

That a re-issue for separate parts of the invention where the original did not contemplate them as separate inventions, is void, see *Ex parte* Powell (1878), 13 O. G. 911.

§ 670. [1] That a combination-patent cannot be re-issued to cover a different combination or a combination embracing new elements, see Washburn & Moen Mfg. Co. *v.* Fuchs (1883), 5 McCrary, 236; 16 Fed. Rep. 661.

That a claim for a combination of parts, made in a peculiar way for a peculiar purpose, cannot be expanded by re-issue to include a combination of the same parts without limitation as to construction or uses, see McMurray *v.* Mallory (1884), 111 U. S. 97; 27 O. G. 915.

[2] In Gill *v.* Wells (1874), 22 Wall. 1, Clifford, J.: (24) "Very different rules, however, apply in a case where the only invention described in the original patent is the one which includes all the ingredients of the machine, provided there is no suggestion, indication, or intimation that any other invention of

or if it adds to the original elements another element per-

any kind has been made. Such a patentee as the one last mentioned may subsequently discover that he can accomplish a new and useful result by a combination embracing less than the whole number of the ingredients included in the prior patented combination, but he cannot secure the right and privilege of a patentee in the combination of the smaller number of the ingredients by a surrender of his first patent and a re-issue of the same which shall include the second combination as well as the first, because the re-issued patent in that event would not be for the same invention as the surrendered original. . . . (27) Equivalents are doubtless allowed to a patentee or owner of the patent to shut out infringements, but the Patent Act furnishes no support to the theory that the patentee may surrender a patent for an invention consisting of a combination of old ingredients, and amend the descriptive parts of the specification by striking out the entire description of one of the ingredients of the combination and inserting in lieu thereof a full description of several other devices, without any allegation that they are the equivalents of the one whose description is stricken out, or any explanation whatever, showing the reason why the change was made." 6 O. G. 881 (884, 885).

This portion of the above opinion is sometimes referred to as denying the right to cover sub-combinations in a re-issue. But it has no bearing on that question. A combination may be composed of simple elements united under a co-operative law. Or it may be composed of sub-combinations, i. e., of groups of elements, each group being itself a complete combination and entering into co-operative union with the other groups, not as an aggregation of collective elements, but as an organism governed by its own co-operative law. A combination composed of simple elements contains no sub-combinations, but each one of its elements co-operates with every other and performs its individual and distinctive function in the combination. In such a combination no patentable subject-matter exists except the combination as an entirety and its severable elements. Any union of the elements less than the whole number constitutes a distinct combination, utterly independent of the former and outside the scope of any patent by which the former may have been protected. It is to this class of combinations and this only that the doctrine of Gill *v.* Wells, here cited, and similar decisions, can apply. A combination composed of sub-combinations, on the other hand, contains three forms of patentable matter, — the principal combination, the sub-combinations, and the elements entering into each sub-combination ; and all of these are within the scope of the patent for the principal combination, and under proper circumstances may be claimed in its re-issue. But in these cases the line dividing the sub-combinations from each other must be strictly preserved. A combination of one sub-combination with a portion of another is not a part of the original invention but an entirely separate combination, introducing a new grouping of the elements and a new co-operative law. Where a combination is formed by adding a simple element to a complete sub-combination, the principal combination, the sub-combination, and the added element are the sole subjects-matter to which a patent for the principal combination can extend, and to those only while they retain their individual identity.

That a patent for a combination cannot re-issue to cover a less number of elements unless described in the original

forming a new material function in the combination,[3] or if it groups the same elements under a different method of co-

as a sub-combination, see Jenkins *v.* Stetson (1887), 32 Fed. Rep. 398.

That a re-issue is void when the original was for a combination only, if it covers a lesser combination of some of the original elements and is issued *within four months* of the expiration of the original, see Gage *v.* Herring (1882), 107 U. S. 640 ; 23 O. G. 2119.

That a re-issue of a combination-patent is void if it omits one of the essential elements of the original invention, see Jenkins *v.* Stetson (1887), 32 Fed. Rep. 398 ; Neacy *v.* Allis (1882), 22 O. G. 1621 ; 13 Fed. Rep. 874 ; Cammeyer *v.* Newton (1879), 16 O. G. 720 ; 4 Bann. & A. 159; Redmond *v.* Parham (1879), 16 O. G. 359.

That the re-issue of a combination-patent cannot omit one of the elements on the ground that experience has shown it to be unnecessary, see Hale *v.* Stimpson (1865), 2 Fisher, 565; Vance *v.* Campbell (1861), 1 Black, 427.

That an original, covering a combination of four elements, cannot re-issue as covering three only, or the combination of three with a different fourth element, see Gill *v.* Wells (1874), 22 Wall. 1 ; 6 O. G. 881.

That a re-issue is void when the original was for a combination and the re-issue is for another combination, containing only part of the elements of the former and operating in a different way, see Johnson *v.* Railroad Co. (1882), 105 U. S. 539 ; 22 O. G. 329 ; Johnson *v.* Railroad Co. (1878), 15 Blatch. 192; 3 Bann. & A. 428.

That when an element formerly claimed as essential is omitted, the Claim is expanded, see Phillips *v.* Risser (1885), 26 Fed. Rep. 308.

That if an inventor allows his solicitor to describe an element as essential and the patent so to issue, he is bound by it and cannot re-issue to exclude that element, see Holt *v.* Keeler (1882), 21 Blatch. 68 ; 22 O. G. 1291 ; 13 Fed. Rep. 464.

That a combination-patent cannot be re-issued, after fifteen years, so as to drop elements described as essential in the original, and so cover a different invention, see Johnson *v.* Railroad Co. (1882), 105 U. S. 539 ; 22 O. G. 329.

That the re-issue of a combination-patent cannot substitute another element for one of those contained in the original, unless the substituted element be a mere equivalent, see Blackman *v.* Hibbler (1879), 17 Blatch. 333; 4 Bann. & A. 641 ; 17 O. G. 107 ; Gill *v.* Wells (1874), 22 Wall. 1; 6 O. G. 881; National Spring Co. *v.* Union Car Spring Mfg. Co. (1874), 6 O. G. 224; 12 Blatch. 80 ; Decker *v.* Grote (1873), 3 O. G. 65 ; 10 Blatch. 331 ; 6 Fisher, 143 ; Gallahue *v.* Butterfield (1872), 10 Blatch. 232 ; 2 O. G. 645 ; 6 Fisher, 203.

[3] In Washburn & Moen Mfg. Co. *v.* Fuchs (1883), 16 Fed. Rep. 661, Treat, J. : (668) "The attempt to justify the re-issued patent of May 12, 1874, by invoking the prior application, October 27, 1873, for the patent of November, 1874, falls within the reasoning of the United States Supreme Court, 11 Wall. 516 ; the statement wherein is the *converse* of that now under review. That court said: ' Where the thing patented is an entirety, consisting of a single device or combination of old elements incapable of division or separate use, the respondent can not escape the charge of infringement by alleging or proving that a part of the entire thing is found in one prior patent or printed publication, or machine, and another part in another prior exhibit, and still another part in a third one, and from the three or any greater num-

operation, — the re-issue has departed from the original patent and cannot be sustained. But if the actual nature of the combination is unchanged, the re-issue may vary widely from the original in its statement of the invention as well as in its Claims.[4] Non-essential parts which the original specification erroneously described as entering into the combination may be omitted, or equivalents for any of the elements may be introduced, their equivalence being duly pointed out in the re-issue specification.[5] Though the original purports to describe the invention as a single article, yet if it be a true combination, as shown upon the face of that description, the re-issue may claim it according to its proper character.[6] But a suggestion, in a patent for an element or a sub-combination, that it is capable of use when combined with others also named, without substantially indicating the nature and essential feature of such exhibits draw the conclusion that the patentee is not the original and first inventor of the patented improvement.' If this be true as to the nature of a combination when an infringer seeks to defeat the same, why is it not equally true where a re-issue is sought to be upheld, under an original patent, by importing into the re-issue devices not suggested in the original, making thereby a new combination, distinct from the original? In other words, the re-issue must be confined to the original 'combination,' and cannot be expanded to make a new combination by introduction therein of devices, new or old, not included in or suggested by the original. Munson *v.* Gilbert & Barker Manuf'g. Co., 3 Bann. & A. 595. It must be borne in mind that the court is dealing with a 'combination' patent, and that under pretence of a re-issue a new combination cannot be upheld." 5 McCrary, 236 (245). See also Hayes *v.* Bickelhoupt (1885), 32 O. G. 133; 23 Fed. Rep. 183.

[4] That where the original patent describes and claims two elements, either of which is the equivalent of both, the re-issue may claim either alone, see Gallahue *v.* Butterfield (1872), 6 Fisher, 203; 10 Blatch. 232; 2 O. G. 645.

That where an original patent described and claimed a certain element having two specific properties, which properties constituted the value of that element in the combination, the re-issue may claim any other element then known which had the same properties, see Dunbar *v.* White (1881), 4 Woods, 116; 23 O. G. 1446; 15 Fed. Rep. 747.

[5] That a re-issue of a combination-patent may omit one or more of the non-essential features described in the original, see Parham *v.* American Buttonhole, Overseaming, & Sewing Mach. Co. (1871), 4 Fisher, 468.

That if such non-essential feature were, however, claimed as an essential element the mistake is irremediable, see §§ 278, 282, 527, and notes, *ante*.

That equivalents may be introduced by the re-issue, provided their equivalence is pointed out in the re-issued patent, see Gill *v.* Wells (1874), 22 Wall. 1; 6 O. G. 881.

[6] That where the original patent covers an "article" the re-issue may claim it as a combination, see Middletown Tool Co. *v.* Judd (1867), 3 Fisher, 141.

ures of the resulting combination, does not warrant a re-issue covering such combination.[7]

§ 671. Re-issued Combination-Patent may Embrace Sub-Combinations.

When the original patent describes and claims only the combination, but at the same time in its model, drawings, or specifications substantially sets forth any or all of the various sub-combinations which enter into the principal invention, these may be claimed in the re-issue, if not before abandoned or disclaimed, provided they originated from the inventive genius of the same inventor.[1] That the entire combination described

[7] That where the original merely suggests that the invention can be used with certain other devices, the re-issue cannot claim the combination of the invention with such devices, see *Ex parte* Wooten (1873), 3 O. G. 521.

§ 671. [1] In Christman *v.* Rumsey (1879), 17 Blatch. 148, Blatchford, J. : (155) "Under the decision in The Corn Planter Patent (23 Wallace, 181), which was subsequent to that in Gill *v.* Wells, the re-issue in the present case cannot be held to be void. The drawings of the original and the re-issue being the same, and the two specifications describing the same mechanical structure, with the same mode of operation, it must be held to be lawful to re-issue the patent with Claims to combinations of fewer elements than were contained in the combination claimed in the Claim of the original patent. The original claimed a general and larger combination, and the re-issue claims sub-combinations which enter into such general and larger combination. Such a re-issue was sustained in The Corn Planter Patent, on the ground that the re-issue was for things contained within the apparatus described in the original patent, and against the effort to control the case by the decision in Gill *v.* Wells." 17 O. G. 903 (905) ; 58 How. Pr. 114 (123) ; 4 Bann. & A. 506 (513).

In Herring *v.* Nelson (1877), 12 O. G. 753, Johnson, J. : (756) "But upon the doctrine of these cases in respect to actions for infringements, it is sought to establish a distinction between patents for combinations of old elements and all other patents in regard to re-issues, and to deny the power to re-issue such a patent for a combination of any fewer elements than were contained in the original combination. Now the Patent Act makes no such distinction. Its terms are general and relate alike to all patents. The position is set up and rests upon this argument, viz., the re-issue must be for the same invention. This consists in the combination, which disappears when one element is omitted. But this argument, true or unsound, does not apply to a case in which among the old elements some are single and some are sub-combinations entering into the general and larger combiuation." 14 Blatch. 293 (303) ; 3 Bann. & A. 55 (65).

In Pearl *v.* Ocean Mills (1877), 11 O. G. 2, Shepley, J. : (4) "When in the specification of the original patent the inventor describes a new and useful combination of a number of ingredients, performing in combination certain functions less than he has claimed, he may in the re-issue claim such combination of the less number which he has de-

and claimed in the original was impracticable does not prevent such a re-issue for the sub-combinations if, as suggested in the original patent, these are practically operative arts or instruments, and the re-issue indicates how each one may

scribed, suggested, or substantially indicated as his invention, but failed to include in his Claims; and the re-issue need not describe it in the exact language of the original, but may contain a more full and exact description of the same invention, imperfectly described in the original. There is nothing in the decision in Wells *v.* Gill in conflict with this statement of the principle of Patent Law." 2 Bann. & A. 469 (475).

In Gill *v.* Wells (1874), 22 Wall. 1, Clifford, J.: (24) "Cases arise where a patentee, having invented a new and useful combination consisting of several ingredients which in combination compose an organized machine, also claims to have invented new and useful combinations of fewer numbers of the ingredients; and in such cases the law is well settled that if the several combinations are new and useful, and will severally produce new and useful results, the inventor is entitled to a patent for the several combinations, provided that he complies with the requirement of the Patent Act and files in the Patent Office a written description of each of the alleged new and useful combinations, and of the manner of making, constructing, and using the same. He may give the description of the several combinations in one specification, and in that event he can secure the full benefit of the exclusive right to each of the several inventions by separate Claims referring back to the Description in the specification; and if by inadvertence, accident, or mistake, he should fail to claim any one of the described combinations, he may surrender the original patent and have a re-issue not only for the combination or combinations claimed in the original, but for any which were so omitted in the Claims of the original patent." 6 O. G. 881 (884).

Further, that sub-combinations, if shown in the original patent, and invented by the same inventor, may be claimed in the re-issue, see Jenkins *v.* Stetson (1887), 32 Fed. Rep. 398; Hubel *v.* Dick (1886), 24 Blatch. 59; 28 Fed. Rep. 132; 36 O. G. 939; Odell *v.* Stout (1884), 22 Fed. Rep. 159; 29 O. G. 862; Dederick *v.* Cassell (1881), 14 Phila. 503; 9 Fed. Rep. 306; 20 O. G. 1233; Kerosene Lamp Heater Co. *v.* Littell (1878), 13 O. G. 1009; 3 Bann. & A. 312; Turrell *v.* Spaeth (1878), 14 O. G. 377; Miller *v.* Bridgeport Brass Co. (1877), 12 O. G. 667; 14 Blatch. 282; 3 Bann. & A. 20; Stevens *v.* Pritchard (1876), 4 Clifford, 417; 10 O. G. 505; 2 Bann. & A. 390.

That where the sub-combinations claimed in the re-issue were shown in the original and the re-issue is applied for within six months after the grant of the original, inadvertence or mistake need not be specially proved, the speedy application being sufficient evidence thereof, see Jenkins *v.* Stetson (1887), 32 Fed. Rep. 398.

That where the original patent suggested only the combination it cannot re-issue to embrace sub-combinations, see Washburn & Moen Mfg. Co. *v.* Fuchs (1883), 5 McCrary, 236; 16 Fed. Rep. 661; Turrell *v.* Bradford (1883), 15 Fed. Rep. 808; 23 O. G. 1623; Miller *v.* Bridgeport Brass Co. (1877), 12 O. G. 667; 14 Blatch. 282; 3 Bann. & A. 20; Gill *v.* Wells (1874), 22 Wall. 1; 6 O. G. 881.

As to the joinder of a combination with its sub-combinations, see §§ 472, 528, and notes, *ante*.

be practically used;[2] for every sub-combination is a distinct invention which might have been protected under the original patent, and which does not forfeit its protection by having been joined with another invention, whose unpatentability has been demonstrated by experience. In its description of such

[2] In Wheeler *v.* Clipper Mower & Reaper Co. (1872), 10 Blatch. 181, Woodruff, J.: (186) "The claim that the original patent of 1854 was void because the invention therein described was not susceptible of being reduced to practical operation *gains* its importance to this controversy from the inference sought to be drawn therefrom, namely, that the several re-issues are therefore void. These suits are not founded on the original patent, but on the re-issues; and the claim is that, if the original patent was void because the machine therein described was not capable of reduction to practical use, therefore the re-issues are themselves void. If the premise were here conceded, I do not think that the inference necessarily follows. For example, suppose an inventor of several distinct new devices, or of several new combinations, each capable of being usefully employed in and towards a machine or various machines, and that their separate construction and mode of operation is fully apprehended, and the distinct office or function of each is appreciated, such inventor may, undoubtedly, have a patent for each. Suppose, now, he erroneously conceives that he has arranged a combination of all of them, or a combination of all of them with other known devices, so as to produce a new and useful machine, and for such a machine he applied for and obtains a patent, describing and illustrating all the several new devices or separate combinations of devices, their construction, and operation, but claiming only the aggregate machine. Such aggregate machine may be utterly useless; the patentee is wholly mistaken in regard to the practical operation of the whole; it will not produce the result for which it was intended, nor, in its aggregate form, any other useful result. Does the inventor, in such case, lose the benefit of his skill and ingenuity in producing devices, or combinations of devices, which are of practical value, because he first sought his patent in the form of a useless or impracticable combination? I apprehend not. He may surrender his original patent and have it re-issued in parts, which shall claim the respective new and useful devices or combinations of devices, pointing out, of course, in his specification, some mode or manner in which they may be reduced to practical use and value. He might have done this in his original patent, and claimed each separate new device as his invention. Not having done so, he may do so in his application for re-issues and his specifications therein; and the fact, if it be true, that his original patent was defective, because he claimed therein the aggregate combination, and that a useless or impracticable one, no more impairs the validity of the re-issues than any other defect or invalidity which makes a surrender and re-issue necessary to protect the device or devices which are useful, and which were in fact invented." 6 Fisher, 1 (18); 2 O. G. 442 (444).

See also Wheeler *v.* McCormick (1873), 6 Fisher, 551; 11 Blatch. 334; 4 O. G. 692.

So far as the decisions in the above cases assume that the re-issue may embrace sub-combinations or elements which the patentee did not intend and attempt to protect by the original, they are, of course, erroneous.

sub-combinations the re-issue may follow or depart from the language used in the original,— the identity of the sub-combination, both as to its elements and its co-operative law, being, however, always preserved.

§ 672. Re-issued Combination-Patent may Embrace the Elements of the Combination.

The re-issue of a patent for a combination may embrace such of its essential elements as are substantially indicated in the original specification, drawings, or model, and were the inventions of the same inventor.[1] As every element of a combination is in itself an operative means, and not a mere part of some patentable article or art, it is a distinct invention and could have been protected by a patent issued for itself alone. Its joinder with the combination in the original patent would have been legitimate, since the inventions are dependent; and hence it may be covered by the re-issue, even although the combination may not actually have been entitled to protection.[2] The re-issue cannot depart from the original as to the essential character therein given to the element, whatever variation in its language may be permitted; and if the original treats one form of the element as necessary to

§ 672. [1] In Wheeler *v.* Clipper Mower & Reaper Co. (1872), 10 Blatch. 181, Woodruff, J.: (186) "The original patent embraced, as an aggregate combination, several parts of the entire machine described in the specification, and claimed such aggregate as the invention of the complainant. These parts were all shown in the specification, drawings, and models. I know of no rule which forbids the inventor, who has omitted to claim separate new devices, or severable and distinct combinations, in the original patent, making a surrender, and taking re-issues for the distinct combinations or separate devices. From the fact of surrender and re-issue it is to be inferred that the original patent did not secure to the patentee all that he claims in the re-issue; but that alone does not render the re-issue void. If the devices covered by the re-issues were, in fact, new and useful, and if they are shown in the original specification, drawings, or model, then the patentee is entitled to secure the exclusive use of each separately, by a re-issue embracing each." 6 Fisher, 1 (18); 2 O. G. 442 (443).

That the re-issue of a combination-patent may cover its elements, see Smith *v.* Merriam (1881), 19 O. G. 601; 6 Fed. Rep. 713; Gallahue *v.* Butterfield (1872), 6 Fisher, 203; 10 Blatch. 232; 2 O. G. 645; Chicago Fruit House Co. *v.* Busch (1871), 4 Fisher, 395; 2 Bissell, 472; Batten *v.* Taggart (1854), 17 How. 74.

[2] That where the patented combination is impracticable, a re-issue for its elements, if described in the original, may be obtained, see Wheeler *v.* Clipper Mower & Reaper Co. (1872), 10 Blatch. 181; 6 Fisher, 1; 2 O. G. 442.

its performance of its elemental functions in the combination, the re-issue must adhere to that form, though other forms adapting it to other uses and positions are more valuable.[3] But when form is not made material by the original description, the re-issue may claim all forms of the element; or when the original describes an element as consisting in a class of acts or substances, the re-issue may confine the element to any single member of that class.[4] The right to thus bring individual elements within the operation of the patent by re-issue does not authorize the inventor to claim in it any grouping of elements which the original did not describe as a sub-combination.[5] If any individual element has been disclaimed, unless by mere mistake, the combination-patent cannot be re-issued to reclaim it.[6]

[3] That where the original patent is for a combination, one part of which is of peculiar shape so as to serve certain purposes, it cannot be re-issued to cover all shapes of this part whether they serve such purposes or not, see McMurray *v.* Mallory (1884), 111 U. S. 97; 27 O. G. 915.

[4] That where the original patent describes one form of an element in a combination, the re-issue may cover all forms of the element, unless form was material, see Gong Bell Mfg. Co. *v.* Clark (1878), 13 O. G. 274; 3 Bann. & A. 211.

That where the original patent claimed the use of an entire class of substances as a step in the process, the re-issue may confine the Claim to the use of any particular substance of that class, see St. Louis Stamping Co. *v.* Quinby (1879), 4 Bann. & A. 192; 16 O. G. 135.

[5] In Matthews *v.* Machine Co. (1882), 105 U. S. 54, Bradley, J.: (57) "But the complainants, in their re-issued patent, have split up and divided the elements of their invention, and claimed them separately, and not as a combination. Of course, this enlarges the scope of their patent. The separate Claims embrace fewer elements in combination than were embraced in the Claim of the original patent. No one could infringe the original patent unless he used all the elements of the combination. Any one will infringe the re-issue who uses any of those elements which are now separately claimed." 21 O. G. 1349 (1350). See also Bantz *v.* Frantz (1882), 105 U. S. 160; 21 O. G. 2037; Gill *v.* Wells (1874), 22 Wall. 1; 6 O. G. 881.

That a combination-patent cannot re-issue to cover the separate elements after unreasonable delay, see Archer *v.* Arnd (1887), 31 Fed. Rep. 475; 40 O. G. 1032; Bantz *v.* Frantz (1882), 105 U. S. 160; 21 O. G. 2037.

That elements shown in the original drawings only as a connected portion of the mechanism, and so described, cannot be claimed on the re-issue as an invention, see Ives *v.* Sargent (1887), 119 U. S. 652; 38 O. G. 781.

That a re-issue covering additional elements in a combination is improper, see Hubel *v.* Dick (1886), 28 Fed. Rep. 132; 36 O. G. 939; 24 Blatch. 59.

[6] That where an original patent claimed a series of dies and disclaimed them as separate devices, the re-issue cannot claim them separately, see At-

§ 673. Re-issued Generic Patent may Embrace One Species: When Re-issued, Species Patent may Embrace the Genus.

The relation subsisting between a generic invention and each of the species falling within that genus also leads to certain peculiar modifications of this rule. A generic invention is distinct from each of the specific inventions which it embraces, and each of these specific inventions is equally distinct from every other. Yet inasmuch as a generic invention cannot be fully described without delineating at least one of its included species, the joinder of a single specific invention with the generic is permitted in a patent for the latter. In the re-issue of a generic patent, therefore, the species which the original describes and which might have appropriately been claimed therein may be protected. But if the specification of the original generic patent describes two or more species, one only can be claimed in the re-issue, as only one could have been joined with the generic in the original. An unwise joinder of particular species with the genus in the prior patent cannot be remedied by a re-issue. Where the original describes two or more species with their genus, and claims the genus and one species, its re-issue cannot claim the genus and a different species. The abandonment of the former species, and the substitution for it of the latter, would be an entire departure from the specific invention which the inventor first attempted to secure, and thus would introduce into the re-issued patent such new matter as the rule peremptorily forbids.[1] A patent for a specific invention cannot re-

water Mfg. Co. *v.* Beecher Mfg. Co. (1881), 8 Fed. Rep. 608.

See also §§ 680, 687–689, and notes, *post.*

As to the joinder of a combination with its elements, see §§ 472, 528, and notes, *ante.*

§ 673. [1] In *Ex parte* McClintock (1880), 17 O. G. 267, Paine, Com.: (271) "An applicant who makes a generic invention, which he illustrates by describing two species, may, by inadvertence, accident, or mistake, join with his generic Claim the specific Claim which subsequently proves least desirable. But this is not the inadvertence, accident, or mistake for which the law provides a remedy by re-issue. That provision is not for the case in which the applicant, having the power to choose, selects the wrong invention, but for the case in which he imperfectly describes or claims the right invention. The inventions covered by a generic and specific Claim are distinct, although dependent, inventions. The only ground

issue to embrace the generic, for these are not only distinct inventions, but as the genus covers all possible species, the re-issue would indefinitely extend the scope of the original patent beyond the invention which it first attempted to protect.[2] An exception is allowed in favor of the inventor of the genus who described and claimed it in his application for the original patent, but was compelled without his fault to forego his claim and accept a patent for the specific invention alone. On the discovery of the error he is entitled to amend his patent by the insertion of the generic invention both in his Description and his Claims.[3]

§ 674. Re-issued Patent for an Art may Embrace the Same Art, and sometimes the Apparatus or the Product.

The re-issue of a patent for an art or process, whether composed of one or many different acts and operations, must be confined to the same acts and operations which constitute the essential features of the original invention. No new act can be added; no former operation, which has been described and claimed as necessary to the art, can be omitted.[1] Im-

on which one specific Claim can be joined in the same patent with a generic Claim is that the applicant, in order to support his generic Claim, must describe some one of the species, and may claim what he must describe. If he describes several species, as he is permitted but not required to do, and, by inadvertence, accident, or mistake, selects the wrong species, such inadvertence, accident, or mistake consists, not in an imperfect specification or Claim of either of the inventions, but merely in joining in the dual patent the wrong inventions. The remedy for such an error is not to be found in the substitution of another specific invention in the dual patent by a re-issue, but must be sought in an original patent granted on a new application."

That where the original patent describes only one species of a certain genus, it cannot re-issue to cover another species of the same genus, see *Ex parte* McClintock (1880), 17 O. G. 207.

That where two species were described and but one claimed, and the other species was then struck out of the Description, the specification was still sufficient and required no re-issue, see *Ex parte* Ewart (1880), 17 O. G. 448.

[2] That a patent for the species cannot re-issue to cover the genus, see *Ex parte* Waters (1875), 8 O. G. 399.

[3] That generic Claims may be inserted in the re-issue though they were struck out of the original application, see *Ex parte* Ewart (1880), 17 O. G. 448.

As to the joinder of generic and specific inventions, see §§ 535, 536, and notes, *ante*.

§ 674. [1] That a re-issue may contain a full description of processes only adverted to in the original, see Goodyear Dental Vulcanite Co. *v.* Smith (1874),

material steps may be abandoned, or equivalents introduced, and such variations in their order be directed as are not inconsistent with the original specification.[2] When the art as set forth in the original patent is a combination, its sub-processes and elements may be claimed in the re-issue, if they were first devised by the inventor of the art, were indicated in the original specification, and have not lost their patentable character by his disclaimer or abandonment. Besides the art itself, the re-issue may in certain cases cover the apparatus it employs or the product in which it results. Where these have been invented by the same inventor, have been sufficiently described in the original specification, and have neither been abandoned nor disclaimed, the right to cover them by the re-issue depends on their relation to the art, and the propriety of joining them therewith in the original patent. Thus where the process cannot be performed without the apparatus mentioned, or the product uniformly follows the employment of the process, the inventions are inseparably connected with each other, and the product or the apparatus may be covered by a re-issue of the patent for the art.[3]

5 O. G. 585; Holmes, 354; 1 Bann. & A. 201.

That a re-issue of a patent for a process cannot add a new step, see American Middlings Purifier Co. *v.* Atlantic Milling Co. (1879), 4 Bann. & A. 148; 15 O. G. 467; 5 Dillon, 127.

[2] That the re-issue of a patent for a process may omit some of the steps described in the original, if the process remains substantially the same, see *Ex parte* Wooten (1872), 3 O. G. 521.

That where an original, in describing a process, mentioned one material which does not answer the purpose, the re-issue may describe another material of the same class which will serve the same desired end, if it had been used by the inventor before his original application for a patent, see *Ex parte* Mayall (1873), 4 O. G. 582.

[3] That a process and its apparatus may be claimed in the same patent where the process is not the mere function of the apparatus, see § 473, and notes, *ante*.

That an original for a "method of doing" a thing may re-issue for the thing done, the inventions being the same, see Washburn & Moen Mfg. Co. *v.* Haish (1880), 19 O. G. 173; 4 Fed. Rep. 900; 10 Bissell, 65.

That where the original describes both process and product, but claims the process only, it may re-issue to cover the product also, see Tucker *v.* Dana (1881), 7 Fed. Rep. 213; Anilin *v.* Hamilton Mfg. Co. (1878), 13 O. G. 273; 3 Bann. & A. 235; Goodyear *v.* Wait (1867), 5 Blatch. 468; 3 Fisher, 242.

That a re-issue for a product is void, where the original was for the process, unless the use of the process always results in the product, and thus both are but one invention, see Powder Co. *v.*

§ 675. Re-issued Patent for a Machine may Embrace the Same Machine, and sometimes the Product, but not the Process.

The re-issue of a patent for a machine, if the machine be not a combination, must be limited to the same parts or their equivalents associated under the same structural law.[1] The re-issue may vary from the original in matters of mechanical adaptation, and may cover any mode of using the machine which has been properly indicated in the former specification.[2] When the machine is a combination, the re-issue may embrace such of its elements and sub-combinations as are suggested in the original description, if not abandoned or disclaimed, and if due to the inventive genius of the same inventor. A machine-patent cannot, however, be re-issued to include a process which consists in the mere use of the machine, nor a process in which the patented machine performs a necessary though subordinate part. The former is the function of the machine, and though protected by the patent for the machine is not itself a patentable subject-matter. The latter is an invention far broader than the mechanical devices it employs, and though not independent of them, lies outside the scope of any patent which has been originally confined to them. Thus while an original patent for an art

Powder Works (1878), 98 U. S. 126; 15 O. G. 289.

That a re-issue cannot cover a product and a process unless both have been substantially described in the original, see Penn. Salt Mfg. Co. *v.* Thomas (1871), 8 Phila. 144; 5 Fisher, 148.

That an original patent confined to a product produced by one process only cannot re-issue to cover the product, however produced, see Vacuum Oil Co. *v.* Buffalo Lubricating Oil Co. (1884), 20 Fed. Rep. 850; 22 Blatch. 266; 28 O. G. 1101.

That a patent for a process cannot re-issue after four years to cover the product also, see Union Tubing Co. *v.* Patterson Co. (1885), 23 Fed. Rep. 79.

As to the joinder of a process with its product or apparatus, see §§ 472, 529, and notes, *ante*.

§ 675. [1] That a re-issue can substitute a device for one employed in the original where they are equivalents, and not otherwise, see Tucker *v.* Tucker Mfg. Co. (1876), 10 O. G. 464; 2 Bann. & A. 401; 4 Clifford, 397; National Spring Co. *v.* Union Car Spring Mfg. Co. (1874), 6 O. G. 224; 12 Blatch. 80; Decker *v.* Grote (1873), 3 O. G. 65; 10 Blatch. 331; 6 Fisher, 143.

[2] That a re-issue may claim modes of constructing or operating a machine, where such modes were described, though not claimed, in the original, see Morris *v.* Royer (1867), 3 Fisher, 176; 2 Bond, 66.

might be re-issued to embrace any machine which it may use without enlarging the original invention, no patent for a machine could be re-issued to include the process without extending the protection of the patent to new matter which the original patent neither intended nor attempted to secure.[8]

[8] In Wing *v.* Anthony (1882), 106 U. S. 142, Woods, J.: (145) "It is quite clear that the original patent covers a mechanism to accomplish a specific result, and that the re-issued patent covers the process by which that result is attained, without regard to the mechanism used to accomplish it. The re-issue is, therefore, much broader than the original patent, and covers every mechanism which can be contrived to carry on the process. In the case of Powder Company *v.* Powder Works, 98 U. S. 126, it was held by this court that when original letters-patent were taken out for a process, the re-issued patent would not cover a composition unless it were the result of the process, and the invention of one involved the invention of the other. The converse of this proposition was decided by this court in James *v.* Campbell, 104 Id. 356. In that case the court said that a patent for a process and a patent for an implement or a machine are very different things, and decided, in substance, that letters-patent for a machine or implement cannot be re-issued for the purpose of claiming the process of operating that class of machines, because, if the claim for the process is anything more than for the use of the particular machine patented, it is for a different invention. To the same effect precisely is the case of Heald *v.* Rice, Id. 737. The present case falls within the rule laid down in the authorities cited."

In James *v.* Campbell (1881), 104 U. S. 356, Bradley, J.: (376) "A patent for a process and a patent for an implement or a machine are very different things. (Powder Company *v.* Powder Works, 98 U. S. 126.) Where a new process produces a new substance, the invention of the process is the same as the invention of the substance, and a patent for the one may be re-issued so as to include both, as was done in the case of Goodyear's vulcanized-rubber patent. But a process and a machine for applying the process are not necessarily one and the same invention. They are generally distinct and different. The process or act of making a postmark and cancelling a postage-stamp by a single blow or operation, as a subject of invention, is a totally different thing in the Patent Law from a stamp constructed for performing that process." 21 O. G. 337 (343).

That where the original is for a machine and the re-issue for a process, there is *prima facie* a departure, see Eachus *v.* Broomall (1885), 115 U. S. 429; 33 O. G. 1265.

That where the original patent is for a machine, it cannot re-issue to cover the process performed by the machine, though the process were described in the original, see *Ex parte* Pfaudler (1882), 22 O. G. 1881; Brainard *v.* Cramme (1882), 20 Blatch. 530; 22 O. G. 769; 12 Fed. Rep. 621; Heald *v.* Rice (1882), 104 U. S. 737; 21 O. G. 1443; New *v.* Warren (1882), 22 O. G. 587; *Ex parte* Hicks (1879), 16 O. G. 546.

That a re-issue is void where the original patent was for a machine which accomplishes two purposes, one intended, and the other neither intended nor expected, by the inventor, and the re-issue covers the process performed by the machine in effecting the latter purpose, see *Ex parte* Seibert (1879), 16 O. G. 262.

The product of a machine, if inseparably connected with it and otherwise within the rule of joinder so often stated, may also be claimed in the re-issue.[4]

§ 676. Re-issued Patent for a Manufacture may Embrace the Same Manufacture, and Sometimes the Process or the Apparatus.

An original patent for a manufacture can be re-issued only for the same concrete instrument, or for inventions upon which the production of such manufacture may depend. Whatever essential characteristics have been attributed to the manufacture in the original specification must be found in it as described and claimed in the re-issue; and through all variations of language, and all substitutions of equivalents, the identity of the invention must be distinctly traceable.[1] If it were first described as resulting from certain processes and possessing certain properties, the re-issue cannot depart from this delineation by ascribing it to different processes, or attributing to it other properties due to changes in the mode by which it is produced.[2] But new methods of applying it to practical use or new connections in which it may be employed can be disclosed, since these involve no alteration in the nature of the invention itself.[3] Where a manufacture

[4] That a re-issue cannot claim the occasional result of the device shown in the original, see *Ex parte* Seibert (1877), 12 O. G. 268.

As to the joinder of a machine with its process or product, see §§ 474, 530, and notes, *ante*.

§ 676. [1] That where an original patent was for an article in a particular form, a re-issue claiming it under whatever form is void, see Campbell *v.* Kavanaugh (1882), 20 Blatch. 256; 11 Fed. Rep. 83; N. Y. Bung & Bushing Co. *v.* Hoffman (1881), 20 Blatch. 3; 20 O. G. 1451; 9 Fed. Rep. 199.

[2] That a re-issue cannot claim a product however made, when the original claimed it only as made in a certain way, see Vacuum Oil Co. *v.* Buffalo Lubricating Oil Co. (1884), 22 Blatch. 266; 28 O. G. 1101; 20 Fed. Rep. 850.

That where the original patent is for a product as resulting from a certain process, it cannot be re-issued to cover the same product when resulting from different processes and containing not only some of the qualities of the old product but also new qualities not contained in the old product or producible by the old process, see Cochrane *v.* Anilin (1884), 111 U. S. 293; 27 O. G. 813.

[3] That a re-issue for a device is good though the machine to which the device is to be applied is differently described in the original, see Aultman *v.* Holley (1873), 5 O. G. 3; 6 Fisher, 534; 11 Blatch. 317.

That a patent for a new device, as

and a machine or process which produces it are inseparable, an original patent for the manufacture may re-issue to protect also the process or machine.[4]

§ 677. Re-issued Patent for a Composition may Embrace the Same Composition, and sometimes the Ingredients, the Process, or the Apparatus.

A composition of matter being always a true combination, the patent in which it is originally described can re-issue only for the same or equivalent ingredients, united by the same or equivalent modes of intermixture, and resulting in a compound possessing the same or equivalent properties.[1] Substances which are not ingredients, though described in the original as entering into the composition, may be omitted or others may be added without disturbing the identity of the invention, and variations in the mode of intermixture, which do not alter its substantial character, may be introduced.

adapted to one machine, cannot re-issue for the same device as adapted to other and non-analogous machines, but such device must be the subject of a new patent, see Holmes *v.* Plainville Mfg. Co. (1881), 20 Blatch. 123; 9 Fed. Rep. 757.

[4] That where the original invention was a new product resulting from a new process, the re-issue of a patent for the process or the product may cover both, either in the same or separate patents, see Tucker *v.* Burditt (1879), 4 Bann. & A. 569; Anilin *v.* Hamilton Mfg. Co. (1878), 3 Bann. & A. 235; 13 O. G. 273; Anilin *v.* Higgin (1878), 15 Blatch. 290; 14 O. G. 414; 3 Bann. & A. 462.

As to the joinder of a manufacture with its process or machine, see §§ 475, 531, and notes, *ante*.

§ 677. [1] In Dunbar *v.* White (1881), 4 Woods, 116, Billings, J.: (117) "Where a patentee in his original Claim and specifications describes his invention in part by specifying a material to be used, but declares that the sole utility or availability of that material in connection with his device is that it has two properties; and in his re-issued patent, in his Claim and specifications, in the description of his invention, substitutes for his former specification of a material to be used as a part of his device, a description of materials which may be used by specifying only those which have the two properties in which he had formerly declared the utility or availability of the material which he then named consisted, there is no enlargement of the thing patented, and the re-issued patent is, therefore, valid." 23 O. G. 1446 (1446); 15 Fed. Rep. 747 (748).

That a re-issue of a chemical patent is void unless the compound claimed is the same as that described in the original, see Tarr *v.* Webb (1872), 2 O. G. 568; 5 Fisher, 593; 10 Blatch. 96.

That where an original described and claimed a composition of matter as answering a specific purpose, it cannot re-issue to cover the compound as used for all other purposes, see Francis *v.* Mellor (1871), 5 Fisher, 153; 1 O.G. 48.

When the original has sufficiently indicated the nature of the several ingredients, or of their sub-combinations, these may be also claimed in the re-issue if they were discovered by the inventor of the composition and have not already passed from his control into the possession of the public. All arts or instruments invented by the same inventor and necessarily employed in manufacturing the composition, may be joined with it in the re-issue when their essential attributes were suggested in the original patent and they have neither been abandoned nor disclaimed. But no extrinsic matter, such as a mode of packing the compound when completed, or of using it for practical purposes when sold, can be inserted in the patent for the composition either originally or by amendment.[2] Though these are patentable inventions, the composition is not dependent upon them for its existence, and they are thus incapable of joinder with it in any patent where it forms the principal invention.

§ 678. Re-issued Patent for a Design may Embrace the same Design, and sometimes its Elements and Sub-combinations.

The re-issue of a design-patent must be confined to the design described or suggested in the original specification. The identity of the design is determined by the appearance which it presents to the eye, and the characteristic features of this appearance, as shown in the original, must be preserved in the re-issue. The elements and sub-combinations of the original design, if answering the requirements already mentioned, may be claimed in the re-issue;[1] but where the same article is both a new design and a new manufacture, the inventions are distinct and independent, and a re-issue of a patent for it as the one cannot embrace the article considered as the other.

[2] That where the original patent describes a composition of matter packed in a certain manner and claims only the compound, it cannot re-issue so as to claim the mode of packing, see Averill Chemical Paint Co. *v.* National Mixed Paint Co. (1881), 22 O. G. 585; 20 Blatch. 42; 9 Fed. Rep. 462.

As to the joinder of a composition with its process or ingredients, see §§ 476, 532, and notes, *ante*.

§ 678. [1] As to the joinder of designs, their elements and sub-combinations, see §§ 477, 532, and notes, *ante*.

§ 679. Re-issued Patent for an Improvement may Embrace the same Improvement, and sometimes the Apparatus or the Process.

An improvement is an invention subordinate to some existing art, machine, manufacture, composition of matter, or design, and in its essential character corresponds with the invention to which it belongs. The limitations which apply to the re-issue of a patent for an improvement are thus the same that govern a re-issue of the patent for the invention with which the improvement is connected. The re-issue must be confined to the exact improvement, suggested or described in the original patent.[1] It may include processes or implements by which the improvement is produced. It cannot embrace arts or instruments which occupy toward the improvement the relation of either functions or effects.

§ 680. Re-issued Patent cannot Embrace Matter Expressly or Impliedly Excluded from the Invention by the Original Patent.

The nature of the subject-matter which the inventor intended and attempted to describe and claim in his original specifications may be further indicated by the limitations which he has imposed upon it in his original patent; and in consequence of these his re-issue may be confined within narrower boundaries than the character of his invention would otherwise require. As by express disclaimer he may debar himself from covering by re-issue some essential feature of his actual invention, so by a faulty statement of its true scope and attributes in his original description, he may implicdly exclude from the invention matter which but for this he might have claimed in his re-issue.[1] Thus though all

§ 679. [1] As to the joinder of improvements, see §§ 478, 534, and notes, *ante*.

§ 680. [1] That matters disclaimed in the original cannot be claimed in the re-issue, see Beecher Mfg. Co. *v.* Atwater Mfg. Co. (1885), 114 U. S. 523; 31 O. G. 1306; Edgarton *v.* Furst & Bradley Mfg. Co. (1881), 21 O. G. 261; 9 Fed. Rep. 450; 10 Bissell, 402; Leggett *v.* Avery (1879), 101 U. S. 256; 17 O. G. 445; Funck *v.* Doty (1877), 13 O. G. 322; Wicks *v.* Stevens (1876), 2 Woods, 310; 2 Bann. & A. 318.

That the statements of an inventor in his original patent, as to the nature and scope of his invention, are binding upon him, see James *v.* Campbell (1881), 104 U. S. 356; 21 O. G. 337.

That the omission from the re-issue of the limitations inserted in the origi-

forms of the invention were really the result of his inventive act, and all the uses of which it is capable belong to him if he desires to hold them, he may so set forth the invention as identified with one form only, or as possessing qualities which fit it for a single definite use, that every other form and use become disclaimed by implication, and even though still patentable in another patent, he cannot introduce them into the existing patent by re-issue.[2] Again, where he mistakes the nature of his invention, and in the original specification attributes the effects which it produces to erroneous causes, upon whose operation he bases his original claims, his subsequent discovery of the true causes cannot be made available to him by a re-issue of his former patent.[3] A different application of the principle involved in these cases arises when the inventor has procured two separate patents, in both of which he has described the subject-matter whose incorporation into his re-issue he endeavors to secure. If he has claimed the matter in but one of these patents, this only

nal, renders the re-issue void, see Searls *v.* Bouton (1882), 12 Fed. Rep. 874; 20 Blatch. 528; 22 O. G. 946.

That the re-issue cannot claim what the patentee, in the original, professed to dispense with, see Miller *v.* Bridgeport Brass Co. (1882), 104 U. S. 350; 21 O. G. 201.

That a re-issue enlarging the invention by omitting words found in the original Claim is invalid, see Matthews *v.* Iron Clad Mfg. Co. (1888), 124 U. S. 347; 42 O. G. 827.

[2] That if the original identifies the invention with one form the re-issue cannot claim other forms, see Steam Gauge & Lantern Co. *v.* Miller (1882), 11 Fed. Rep. 718; and other cases cited in § 661, note 1, and § 676, note 1, *ante*.

That if the original limits the invention to matter possessing certain qualities or capabilities for certain uses, the re-issue can claim no other qualities or capabilities, see Francis *v.* Mellor (1871), 5 Fisher, 153; 1 O. G. 48.

That the statement, in the original, that certain things "are in quite common use" is such a disclaimer as prevents their being claimed in re-issue, see Edgarton *v.* Furst & Bradley Mfg. Co. (1881), 21 O. G. 261; 9 Fed. Rep. 450; 10 Bissell, 402.

That where the original restricts the invention to one use, it cannot re-issue to cover other uses, see Donne & Wellington Mfg. Co. *v.* Smith (1883), 15 Fed. Rep. 459; 24 O. G. 302; *Ex parte* Bragg (1875), 8 O. G. 985; *Ex parte* Allen (1872), 2 O. G. 89.

[3] That if the original describes and claims the invention as one cause producing the effect, the re-issue cannot claim subsequently discovered causes, see Eames *v.* Andrews (1887), 122 U. S. 40; 39 O. G. 1319; Andrews *v.* Hovey (1883), 5 McCrary, 181; 26 O. G. 1011; 16 Fed. Rep. 387.

can re-issue to embrace it.[4] If it is claimed in neither, it can be covered by a re-issue of the earliest alone.[5]

§ 681. Identity of the Invention Embraced in the Re-issued Patent with that Attempted to be Covered by the Original Patent Determined by Comparing the Respective Specifications.

The identity of the invention claimed in the re-issue with that which the inventor attempted to describe and claim in the original patent is ascertained, in most cases, by a simple comparison of their respective specifications with each other.[1] Where the invention is of a nature admitting of illustration by drawings or models, this is the only investigation which can be made.[2] Extrinsic evidence is not admissible except to explain

[4] That where a device is shown in two or more patents, only one of which claims it and this insufficiently, this patent alone can re-issue for it, see *Ex parte* Kirby (1879), 16 O. G. 1095; *Ex parte* Locke (1879), 16 O. G. 1140.

That where a device is described in two patents, and claimed only in one, the later must re-issue for it, even though the inventor is sole patentee in that patent, and he and his assignee are patentees under the other, see *Ex parte* Kirby (1879), 16 O. G. 1095.

That when a device is described in two patents and claimed only in one, and the earlier cannot re-issue for it, the later may, as where it was omitted on purpose from the earlier but by mistake in the later, see *Ex parte* Locke (1879), 16 O. G. 1140.

[5] That where a device is shown but not claimed in two or more patents, only the earliest can re-issue for it, see *Ex parte* Kirby (1879), 16 O. G. 1095; *Ex parte* Locke (1879), 16 O. G. 1140.

That an earlier patent cannot re-issue to cover an invention described only in a later one of the same general class, see Seibert Cylinder Oil Cup Co. *v.* Harper Steam Lubricator Co. (1880), 4 Fed. Rep. 328.

§ 681. [1] In Collar Co. *v.* Van D[illegible]en (1874), 23 Wall. 530, Clifford, J.: (558) "Whether a re-issued patent is for the same invention as the surrendered original or for a different one must very largely be determined by a comparison of the two instruments, as the decision must necessarily depend upon the question whether the specifications and drawings of the re-issued patent are not substantially the same as those of the original; and if not, whether the omissions or additions are or are not greater than the law allows to cure the defects of the original specification." 7 O. G. 919 (920).

See also Kerosene Lamp Heater Co. *v.* Littell (1878), 13 O. G. 1009; 3 Bann. & A. 312; Tucker *v.* Tucker Mfg. Co. (1876), 10 O. G. 464; 4 Clifford, 397; 2 Bann. & A. 401; Stevens *v.* Pritchard (1876), 10 O. G. 505; 4 Clifford, 417; 2 Bann. & A. 390: *Ex parte* Evans (1873), 3 O. G. 180; Metropolitan Washing Machine Co. *v.* Providence Tool Co. (1872), Holmes, 161; Parham *v.* American Buttonhole, Overseaming, & Sewing Mach. Co. (1871), 4 Fisher, 468; Seymour *v.* Osborne (1870), 11 Wall. 516.

[2] That a comparison of the specifica-

the meaning of technical terms, or to apply the language of the Description to its proper subject-matter.[3] If on the face of the two specifications, thus compared, it is apparent that the invention claimed in the re-issue is substantially distinct from that attempted to be covered by the original patent, the re-issue is void.[4] If the diversity is not apparent, the re-issue, so far as this requirement is concerned, will be sustained, it being

tions, drawings, and model alone can be resorted to in order to ascertain the identity of the re-issue with the original, under Sec. 4916 Rev. Stat., where the original patent has drawings or model, see *Ex parte* Seibert (1877), 12 O. G. 268; *Ex parte* Baldwin (1876), 9 O. G. 639.

[3] In Seymour *v.* Osborne (1870), 11 Wall. 516, Clifford, J.: (545) "Whether a re-issued patent is for the same invention as that embodied in the original patent or for a different one is a question for the court in an equity suit, to be determined as a matter of construction, on a comparison of the two instruments, aided or not by the testimony of expert witnesses, as it may or may not appear that one or both may contain technical terms or terms of art requiring such assistance in ascertaining the true meaning of the language employed. Where the specification and Claim, both in the original and re-issued patents, are expressed in ordinary language, without employing any technical terms or terms of art, the question whether the re-issued patent is for the same invention as that described in the original patent or for a different one is purely a question of construction; but where both or either contain technical terms or terms of art the court may hear the testimony of scientific witnesses to aid the court in coming to a correct conclusion. Cases doubtless arise where the language of the specification and Claim, both of the surrendered and re-issued patents, is so interspersed with technical terms and terms of art that the testimony of scientific witnesses is indispensable to a correct understanding of its meaning. Both parties in such a case would have a right to examine such witnesses, and it would undoubtedly be error in the court to reject the testimony; but the case before the court is not of a character to render it expedient to pursue the inquiry."

See also Heald *v.* Rice (1882), 104 U. S. 737; 21 O. G. 1443.

That the identity or diversity of the original and the re-issue are to be ascertained only by inspecting the two patents, not by outside evidence, see Johnsen *v.* Beard (1875), 2 Bann. & A. 50; 8 O. G. 435.

That parol evidence is not admissible to show that the subject-matter of the re-issue is within the scope of the original invention, where it does not appear in the original description, see Union Paper Collar Co. *v.* Van Deusen (1874), 23 Wall. 530; 7 O. G. 919; Glue Co. *v.* Upton (1874), 1 Bann. & A. 497; 4 Clifford, 237; 6 O. G. 837; Sarven *v.* Hall (1872), 1 O. G. 437; 5 Fisher, 415; 9 Blatch. 524; Seymour *v.* Osborne (1870), 11 Wall. 516.

That extrinsic evidence may be resorted to in order to apply the descriptions, etc., to their subject-matter, see Heald *v.* Rice (1882), 104 U. S. 737; 21 O. G. 1443.

[4] That if it appears on the face of the re-issued and original patents that the inventions are not identical, the re-issue is void, see cases cited in § 665, note 1, *ante*.

presumed that it is for the same invention as the original until the contrary appears.[5] In comparing the two specifications, the question is not what the inventor might have set forth in the original patent, but what he did set forth as his invention.[6] Differences in the Description and the Claims are not material, provided the inventions are the same.[7] That the invention claimed in the re-issue would not have been an infringement of the former patent affords no test, since such patent must have stood or fallen by its own Claims, and the re-issue is not limited to these. In construing the respective specifications, their Descriptions, drawings, and models are to be taken together, not separately, and the character of the invention gathered from them as a whole.[8] Drawings omitted

[5] That if the specifications of the re-issue are consistent with those of the original, the re-issue is valid, see Thomas *v.* Shoe Mach. Mfg. Co. (1878), 3 Bann. & A. 557; 16 O. G. 541; Herring *v.* Nelson (1877), 14 Blatch. 293; 12 O. G. 753; 3 Bann. & A. 55; Stevens *v.* Pritchard (1876), 10 O. G. 505; 4 Clifford, 417; 2 Bann. & A. 390; Tucker *v.* Tucker Mfg. Co. (1876), 10 O. G. 464; 4 Clifford, 397; 2 Bann. & A. 401; La Baw *v.* Hawkins (1874), 1 Bann. & A. 428; 6 O. G. 724; Chicago Fruit House Co. *v.* Busch (1871), 2 Bissell, 472; 4 Fisher, 495; Carew *v.* Boston Elastic Fabric Co. (1871), 3 Clifford, 365; 5 Fisher, 90; 1 O. G. 91; Sickels *v.* Evans (1863), 2 Fisher, 417; 2 Clifford, 203; and cases cited in § 684, note 2, *post*.

In this paragraph, and in the text generally, the doctrine that a re-issue is presumed to be for the same invention as the original until the contrary appears is adhered to, notwithstanding the apparent change of position in the later cases in the Supreme Court as indicated in § 664, note 2, *ante*. So many subordinate rules as to the construction of specifications, the burden of proof, etc., etc., have grown out of the former doctrine that it has not been considered prudent to disturb the present harmony of the law by the introduction into its authoritative statement of the new views which may safely be expounded and discussed in the notes.

[6] That in comparing the re-issue with the original patent, the question is not what the inventor originally intended to patent, but what did he in fact invent and try to patent, see American Wood Paper Co. *v.* Heft (1867), 3 Fisher, 316.

That the question is not how the original might have described the invention, but how it did describe it, see *Hammond v. Franklin* (1885), 23 Blatch. 77; 22 Fed. Rep. 833; 30 O. G. 1324.

[7] That if the inventions are the same, differences of description are immaterial, see cases cited in § 668, notes 1, 2, 3, *ante*.

That if the description, drawings, and model of the re-issue are identical with those of the original, the re-issue is valid though the Claims may differ, see Black *v.* Thorne (1872), 5 Fisher, 550; 10 Blatch. 66; 2 O. G. 388; and cases cited in § 668, notes 5, 6, 7, *ante*.

[8] That the identity of the re-issue with the original is ascertained by comparing their drawings and specifications as a whole, not separately, see Searls *v.*

from the original patent by mistake may be inspected, and the model, as first filed in the Patent Office, may be examined.[9] A dilapidated model may be aided by evidence disclosing its primitive condition, if not inconsistent with the drawings and Description;[10] and when a feature claimed in the re-issue is absent from the specification and drawings, the model will be presumed to contain it unless the model is produced.[11] Where the model is lost, and the drawings are said to be incorrect, no change can be permitted in the latter to cure the defect, except upon the most conclusive evidence that the invention, as presented in the model, would have justified the change.[12] In any doubt as to the scope of the re-issue specification the files of the re-issue application may be resorted to for its solution.[13]

Worden (1882), 21 O. G. 1955; 11 Fed. Rep. 501.

[9] That the drawings and model originally filed may be examined in reference to the identity of the re-issue with the original, see Johnsen *v.* Beard (1875), 2 Bann. & A. 50; 8 O. G. 435.

That the identity of the original and re-issue may be shown by the original drawing or model, or by some part of the drawings which, by mistake, was omitted from the one shown in the original patent, see *Ex parte* Baldwin (1876), 9 O. G. 639.

[10] That where a model is lost or destroyed it may be established by parol, see Meyer *v.* Goodyear's India Rubber Glove Mfg. Co. (1881), 22 O. G. 681; 11 Fed. Rep. 891; 20 Blatch. 91.

That a dilapidated model may be aided by evidence showing what it once was, if not inconsistent with the original specifications and drawings, in order to support a re-issue, see Aultman *v.* Holley (1873), 11 Blatch. 317; 6 Fisher, 534; 5 O. G. 3.

That the Office model alone is not sufficient basis for a new Claim in a re-issue, changing the character of the invention originally patented, see Flower *v.* Detroit (1888), 127 U. S. 563; 43 O. G. 1348.

[11] That where the specifications and drawings of the original do not show the feature claimed in the re-issue, only the inspection of the model can determine the matter, and if the model is not produced it will be presumed to contain the feature, see Hendy *v.* Golden State & Miners' Iron Works (1883), 17 Fed. Rep. 515; 8 Sawyer, 468.

[12] That where the original model is lost and the drawings are said to be incorrect, the court should not change the position of any part represented in the drawing, except upon the clearest proof, see Royer *v.* Russell (1881), 20 O. G. 1819; 9 Fed. Rep. 696.

[13] That the files of the re-issue application may be examined to show the scope of the re-issue, see Hopkins & Dickinson Mfg. Co. *v.* Corbin (1881), 103 U. S. 786; 20 O. G. 297.

See also §§ 665, 666 and notes, *ante*.

§ 682. Identity of Subject-Matter of a Re-issued Machine-Patent, how Determined.

In the case of a machine-patent, the identity of the re-issue with the original is determined by the application of a stricter and more conclusive test. A machine is an organism composed of physical parts so arranged as to operate in accordance with a pre-determined structural law. It is capable of exact representation in a drawing or series of drawings, and of equally exact reproduction in a model. Whatever may be the difficulties which attend its verbal description, the failure to indicate its essential parts and their method of arrangement by means either of the drawing or model cannot result from inadvertence, accident, or mistake. If not fraudulent, such failure would at least be evidence that the inventor did not comprehend the invention which he had undertaken to secure, and therefore could not be entitled to a patent. Hence the propriety of the rule that in a machine-patent the identity of the re-issue with the original is to be ascertained by comparing the models and drawings with each other, and that nothing can be embraced in the re-issue which is not found either in the models or the drawings annexed to the original patent. This rule works no hardship to the inventor, since his original patent protects all equivalent parts and arrangements of parts which can be organized under the same structural law, and at the same time it avoids the danger that through some alteration in the parts or their arrangement, as shown in the original drawings or model, a variation in the structural law might imperceptibly be made, and thus a new machine be claimed by the re-issue.

§ 683. Identity of Subject-Matter of the Re-issued Patent, how Determined when the Invention cannot be Represented by Drawings or Model.

In cases where the invention is incapable of representation by a model or by drawings, necessity requires that this question of identity should be settled by such methods as are most available. Language even at its best is ambiguous, and to compel the inventor to abide by the construction which might be put by others on his words alone, would often deprive him

of the most important fruits of his inventive skill. In determining the nature of the invention indicated in his original specification, and attempted to be covered in his original patent, the disadvantage under which he labors through the impossibility of interpreting his verbal description by pictorial or material representations is overcome, in the hearing on his application in the Patent Office, by permitting him to offer extrinsic evidence as to the true character and attributes of the invention which he has undertaken to describe.[1] The

§ 683. [1] In *Ex parte* Dieckerhoff (1877), 12 O. G. 429, Doolittle, Act. Com.: (430) "The first part of section 4916, requiring that no new matter shall be introduced into the specification, plainly refers to those cases accompanied by drawing and model; and, as was held in Seymour *v.* Osborne, this provision necessarily excluded the right in such cases to open the case to new parol testimony; but the express declaration, in the concluding clause of the section, that where there is neither model nor drawing amendments may be made upon proof satisfactory to the Commissioner that the proposed new matter or amendment was a part of the original invention, establishes a class of certain special cases, as the Supreme Court in the same case admitted. It gives to such applicants the privilege of submitting proof as to matter not embodied in the original patent, and permits the exercise of discretion on the part of the Commissioner in the consideration of such proof. Construing the whole of section 4916 together, as it should be, and keeping in mind the only real and lawful purpose of a re-issue application, to correct accidental mistakes in the original specification and drawing, there is nothing in the last clause, nor any previous one, to authorize a departure from the original invention, and the setting up in a re-issue of a substantially different invention. No amount of proof regarding an entirely different invention, however satisfactory it might be in showing that the same was within the knowledge of an applicant at the time of applying for his original patent, could justify the Office in allowing its introduction therein by re-issue. To the extent of correcting such errors and omissions as are sometimes supplied by consulting the model and drawing filed with an original application, the clause of the statute under consideration, I think, clearly obtains. It might permit, for instance, of the consideration of all original papers filed in the case, and such other evidence of official action from which the intentions of the parties could be discovered or their rights determined. This practice was illustrated in the case of Winslow, 9 Official Gazette, 795, where the patent had been passed upon by the United States Supreme Court, and certain matter was held not to be a part of the patent, but where the Office considered the decisions of inferior courts, a dissenting opinion in the court above, together with numerous affidavits, including one from an examiner in the Patent Office, as showing clearly the fact that the applicant had made the invention and had intended to incorporate the same in his patent and believed that he had done so. No doubt existed in that case as to what the applicant's original invention was, as shown by the records of the Office and the testimony of others relating thereto;

sources and the weight of this extrinsic evidence have not been definitely fixed by law. The statutes merely provide that in this class of cases the proof, upon which any matter omitted from the original specification may be regarded as a part of the original invention, must be satisfactory to the Commissioner, and under this provision papers filed in the Patent Office in connection with the case, and other evidence of official actions, have been received.[2] But, upon principle, no evidence should be admitted inconsistent with the original specification, drawings, and model. To allow a re-issue for an invention of which no suggestion appears in the original specification, upon parol evidence alone, sets the whole question at large, and opens the door to the perpetration of the gravest frauds upon the public.[3]

§ 684. Identity of Subject-Matter of the Re-issued Patent Presumed until the Contrary Appears: Re-issued Patent, how Construed.

The invention claimed in a re-issue is presumed to be identical with that attempted to be patented in the original,[1] and

and that it was not definitely set forth and claimed was clearly an inadvertence that could be supplied by the character of proof mentioned. But I am aware of no decision of the Office or the courts which would justify a radical departure from the invention originally indicated or described by means of entirely extraneous proof."

In Hussey *v.* Bradley (1863), 2 Fisher, 362, Hall, J.: (371) "But it is well settled that in deciding upon these applications for a re-issue and the question whether the invention claimed on the re-issue 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. *Ex parte* Ball; *Ex parte* Dyson; and Wilson *v.* Singer; Law's Digest, 620–622." 5 Blatch. 134 (141).

[2] That the original papers filed in the Patent Office, as well as other evidence, may serve to show whether the inventions are the same, see *Ex parte* Dieckerhoff (1877), 12 O. G. 429.

[3] As to the mode of investigating this question of identity in the courts, see § 664, note 2, *ante*.

§ 684. [1] In Spaeth *v.* Barney (1885), 22 Fed. Rep. 828; Colt, J.: (829) "The re-issue of letters-patent by the Commissioner is *prima facie* evidence that such re-issue is founded on sufficient cause, and is in accordance with law. It is also presumed that the Commissioner acted within his authority under the statute, until the contrary is proved." 30 O. G. 997 (997).

Further, that the allowance of a

this presumption is rebutted only when, from a comparison of the two specifications, it is evident that a substantial difference exists between them.[2] In aid of this presumption, the

re-issue raises a presumption of the identity of the subject-matter which can be overcome only by strong and controlling evidence, see Smith *v.* Goodyear Dental Vulcanite Co. (1877), 93 U. S. 486; 11 O. G. 246; Birdsell *v.* McDonald (1874), 6 O. G. 682; 1 Bann. & A. 165; Klein *v.* Russell (1873), 19 Wall. 433; Hussey *v.* Bradley (1863), 5 Blatch. 134; 2 Fisher, 362; Potter *v.* Holland (1858), 4 Blatch. 238; 1 Fisher, 382; O'Reilly *v.* Morse (1854), 15 How. 62; French *v.* Rogers (1851), 1 Fisher, 133.

That there is also a strong general presumption in favor of the validity of a re-issue and the consequent identity of the inventions, see Dederick *v.* Cassell (1881), 9 Fed. Rep. 306; 20 O. G. 1233; 14 Phila. 503; Thomas *v.* Shoe Mach. Mfg. Co. (1878), 3 Bann. & A. 557; 16 O. G. 541; American Middlings Purifier Co. *v.* Atlantic Milling Co. (1877), 3 Bann. & A. 168; 4 Dillon, 100; Reissner *v.* Anness (1877), 13 O. G. 870; 3 Bann. & A. 176; Smith *v.* Goodyear Dental Vulcanite Co. (1877), 93 U. S. 486; 11 O. G. 246; Miller & Peters Mfg. Co. *v.* Du Brul (1877), 12 O. G. 351; 2 Bann. & A. 618; Tucker *v.* Tucker Mfg. Co. (1876), 10 O. G. 464; 2 Bann. & A. 401; 4 Clifford, 397; Stevens *v.* Pritchard (1876), 10 O. G. 505; 4 Clifford, 417; 2 Bann. & A. 390; Salamander Felting Co. *v.* Haven (1875), 3 Dillon, 131; 9 O. G. 253; Doherty *v.* Haynes (1874), 4 Clifford, 291; 6 O. G. 118; 1 Bann. & A. 289; Bantz *v.* Elsas (1874), 6 O. G. 117; 1 Bann. & A. 351; La Baw *v.* Hawkins (1874), 6 O. G. 724; 1 Bann. & A. 428; Guidet *v.* Barber (1873), 5 O. G. 149; Jordan *v.* Dobson (1870), 2 Abbott, 398; 7 Phila. 533; 4 Fisher, 232; Blake *v.* Stafford (1868), 3 Fisher, 294; 6 Blatch. 195; Morris *v.* Royer (1867), 3 Fisher, 176; 2 Bond, 66; Forbes *v.* Barstow Stove Co. (1864), 2 Clifford, 379; Hussey *v.* Bradley (1863), 2 Fisher, 362; 5 Blatch. 134; Hussey *v.* McCormick (1859), 1 Fisher, 500; 1 Bissell, 300; Woodworth *v.* Edwards (1847), 3 W. & M. 120; 2 Robb, 610; Allen *v.* Blunt (1846), 2 W. & M. 121; 2 Robb, 530.

That the fact that a re-issue was granted after a severe contest raises a strong presumption in its favor, see Consolidated Bunging Apparatus Co. *v.* Peter Schoenhofen Brewing Co. (1886), 28 Fed. Rep. 428; 37 O. G. 786.

[2] In Thomas *v.* Shoe Machinery Mfg. Co. (1878), 3 Bann. & A. 557, Clifford, J.: (560) "Where the Commissioner accepts a surrender of an original patent and grants a new patent, his decision in the premises, *in a suit for infringement*, is final and decisive, and is not re-examinable in such a suit in the circuit court, unless it is apparent upon the face of the patent that he has exceeded his authority, and that there is such a repugnancy between the old and the new patents that it must be held as matter of legal construction that the new patent is not for the same invention as that embraced and secured in the original. Seymour *v.* Osborne, 11 Wall. 543. . . . Courts of justice will avoid such a conclusion, if they can reasonably do so, by a proper application of the maxim that patents are to receive a liberal construction, and, if practicable, be so interpreted as to uphold and not destroy the right of the inventor. Turrill *v.* Railroad, 1 Wall. 491; Ames *v.* Howard, 1 Sum. 482; Blanchard *v.* Sprague, 3 Sum. 279; Glue Co. *v.* Upton, 6 O. G. 837. Slight changes will not sustain such a defence,

Description, drawings, and model of the re-issue are always so construed, if possible, as to confine the re-issue to the original invention.[3] Claims apparently in excess of the original inven-

nor will the court in any case declare the patent void on that account, if, by the true construction of the two instruments, the invention secured by the two instruments is not substantially different from that embodied in the original patent. Inquiries in such a case are restricted to a comparison of the terms and import of the two patents in view of the drawings and Patent Office model. If from these it results that the invention claimed in the re-issue is not substantially different from the one described, suggested, or indicated in the specification or drawings of the original patent or Patent Office model, the re-issued patent must be held valid, as all other alterations and amendments plainly fall within the intent and purpose of the provision in the act of Congress which allows a surrender and re-issue; or in other words, if the re-issued patent does not, upon the face of the instrument, embrace anything not substantially described, suggested, or indicated in the specifications, drawings, or model of the original, the defence that the re-issued patent is not for the same invention as the original must be overruled." 16 O. G. 541 (542).

In La Baw *v.* Hawkins (1874), 1 Bann. & A. 428, Nixon, J.: (429) "The act of the Commissioner in accepting a surrender and granting a re-issue, is final and conclusive, and not re-examinable in a suit in the Circuit Court, unless it is apparent, upon the face of the patent, that he has exceeded his authority, or that there is such a a repugnancy between the old and the new patent that it must be held as matter of legal construction that the new patent is not for the same invention as that embraced and secured in the original patent." 6 O. G. 724 (725).

Further, that the re-issue is presumed to be for the same invention until by comparing it with the original patent the want of identity clearly appears, see Searles *v.* Bouton (1881), 21 O. G. 1784; 12 Fed. Rep. 140; 20 Blatch. 426; Smith *v.* Goodyear Dental Vulcanite Co. (1877), 93 U. S. 486; 11 O. G. 246; Doherty *v.* Haynes (1874), 4 Clifford, 201; 6 O. G. 118; 1 Bann. & A. 289; Seymour *v.* Marsh (1872), 6 Fisher, 115; 2 O. G. 675; 9 Phila. 380.

[3] That the question of identity between a re-issue and its original is a question of construction, not of evidence, if the court can understand the inventions from the patents, see Heald *v.* Rice (1881), 104 U. S. 737; 21 O. G. 1443; Seymour *v.* Osborne (1870), 11 Wall. 516.

That the Claims of the re-issue should be construed, if possible, so as to cover only the real invention described in the original, see Brainard *v.* Cramme (1882), 12 Fed. Rep. 621; 22 O. G. 769; 20 Blatch. 530; Swain Turbine & Mfg. Co. *v.* Ladd (1877), 11 O. G. 153; 2 Bann. & A. 488.

That a re-issue may be construed by the original, see Tyler *v.* Galloway (1882), 20 Blatch. 445; 22 O. G. 2072; 12 Fed. Rep. 567; Coburn *v.* Schroeder (1882), 22 O. G. 1538; Tyler *v.* Welch (1880), 3 Fed. Rep. 636; 18 Blatch. 209; 17 O. G. 1508; Manufacturing Co. *v.* Ladd (1880), 102 U. S. 408; 19 O. G. 62; Klein *v.* Russell (1873), 19 Wall. 433; Ely *v.* Monson & Brimfield Mfg. Co. (1860), 4 Fisher, 64.

That where one part of the re-issue seems void, it may be construed with the other parts and the whole together

tion are restricted by interpretation,[4] and void Claims are rejected without prejudice to such as have been properly allowed.[5] The entire re-issue specification is considered as an

may stand, see Carew *v.* Boston Elastic Fabric Co. (1871), 3 Clifford, 356 ; 5 Fisher, 90 ; 1 O. G. 91.

That where a re-issue broadening the Claims is granted after a delay of four and a half years it will be construed as covering the same matter as the original, see Albany Steam Trap Co. *v.* Felthousen (1885), 32 O. G. 1230.

That where a specific and complete invention is fully described, and all the papers including the application, etc., show that this was what the patentee intended to claim, there can have been no inadvertence, and the re-issue cannot be broadly construed even though the actual invention were wider than that described, see Yale Lock Mfg. Co. *v.* James (1884), 28 O. G. 917 ; 20 Fed. Rep. 903 ; 22 Blatch. 204.

That a re-issue as well as an original patent is to be so construed, if possible, as to cover the real invention according to the construction given to it by the patentee, see Klein *v.* Russell (1873), 19 Wall. 433.

[4] That the Claims of the re-issue will not be enlarged by construction, but will be confined to the original invention, if capable of that interpretation, see Tyler *v.* Welch (1880), 3 Fed. Rep. 636 ; 17 O. G. 1508 ; 18 Blatch. 209.

[5] In Gage *v.* Herring (1882), 107 U. S. 640, Gray, J. : (646) "The invalidity of the new Claim in the re-issue does not indeed impair the validity of the original Claim, which is repeated and separately stated in the re-issued patent. Under the provisions of the Patent Act, whenever through inadvertence, accident, or mistake, and without any wilful default or intent to defraud or mislead the public, a patentee in his specification has claimed more than that of which he was the original and first inventor or discoverer, his patent is valid for all that part which is truly and justly his own, provided the same is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right ; and the patentee, upon seasonably recording in the Patent Office a disclaimer in writing of the parts which he did not invent, or to which he has no valid claim, may maintain a suit upon that part which he is entitled to hold, although in a suit brought before the disclaimer he cannot recover costs. Rev. Stat. Sects. 4917, 4922 ; O'Reilly *v.* Morse, 15 How. 62, 120, 121 ; Vance *v.* Campbell, above cited. A re-issued patent is within the letter and the spirit of these provisions." 23 O. G. 2119 (2120).

Further, that void Claims in a re-issue do not affect the valid Claims, see Reed *v.* Chase (1885), 25 Fed. Rep. 94 ; 33 O. G. 996 ; American Diamond Rock Boring Co. *v.* Sheldon (1885), 25 Fed. Rep. 768 ; 33 O. G. 1598 ; Giant Powder Co. *v.* Safety Nitro Powder Co. (1884), 10 Sawyer, 23 ; 27 O. G. 99 ; 19 Fed. Rep. 509 ; Reay *v.* Raynor (1884), 22 Blatch. 13 ; 26 O. G. 1111 ; 19 Fed. Rep. 308 ; Dryfoos *v.* Wiese (1884), 22 Blatch. 19 ; 26 O. G. 639 ; 19 Fed. Rep. 315 ; Havemeyer *v.* Randall (1884), 21 Fed. Rep. 404 ; Hayes *v.* Bickelhoupt (1884), 21 Fed. Rep. 567 ; 29 O. G. 368 ; 22 Blatch. 463 ; Worden *v.* Searls (1884), 21 Fed. Rep. 406 ; Odell *v.* Stout (1884), 22 Fed. Rep. 159 ; 29 O. G. 862 ; Gold & Stock Telegraph Co. *v.* Wiley (1883), 17 Fed. Rep. 234 ; Wood *v.* Packer (1883), 17 Fed. Rep. 650 ; Cote *v.* Moffitt (1883), 15 Fed. Rep. 345 ; Starrett *v.* Athol Mach. Co. (1883), 23 O. G. 1729 ; 14 Fed. Rep. 910 ; Schillinger *v.* Green-

honest effort to amend the original specification in conformity with the essential character of the invention, as shown by the state of the art at the date of the original patent,[6] and only when it is incapable of any reasonable construction, without extending it beyond the limits of the actual invention, is it held to be a departure from the original patent, and on that account invalid.[7]

§ 685. Third Proposition: Amendment by Re-issue not Permitted unless the Imperfections in the Original Patent Arose without Fraud, and from Inadvertence, Accident, or Mistake.

The third proposition asserts that a re-issue cannot be allowed for the correction of an error unless it occurred through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention.[1] This proposition rests in part

way Brewing Co. (1883), 24 O. G. 495; 17 Fed. Rep. 244; Fetter *v.* Newhall (1883), 21 Blatch. 445; 25 O. G. 502; 17 Fed. Rep. 841; Tyler *v.* Galloway (1882), 12 Fed. Rep. 567; 20 Blatch. 445; 22 O. G. 2072.

That a void Claim in a re-issue may be disclaimed, see Tyler *v.* Galloway (1882), 12 Fed. Rep. 567; 20 Blatch. 445; 22 O. G. 2072.

[6] In Crandall *v.* Parker Carriage Goods Co. (1884), 20 Fed. Rep. 851, Coxe, J.; (852) "Where it can be seen that the patentee seeks, by apt words of description, to secure what he has honestly invented and nothing more, the court should hesitate to regard with favor the accusations now so freely made against re-issued patents." 28 O. G. 369 (370).

That a re-issue should be construed in view of the state of the art at the time the original was granted, see Garneau *v.* Dozier (1880), 102 U. S. 230; 19 O. G. 61.

That the state of the art when the original was filed may be shown on the question of identity between the original and re-issue to interpret the original as compared with the re-issue, see Eachus *v.* Broomall (1885), 115 U. S. 420; 33 O. G. 1265.

[7] See § 746 and notes, *post.*

§ 685. [1] In Coon *v.* Wilson (1885), 113 U. S. 268, Blatchford, J.: (277) "As the rule is expressed in the recent case of Mahn *v.* Harwood, 112 U. S. 354, a patent 'cannot be lawfully re-issued for the mere purpose of enlarging the Claim, unless there has been a clear mistake inadvertently committed in the wording of the Claim, and the application for a re-issue is made within a reasonably short period after the original patent was granted.' But a clear mistake, inadvertently committed in the wording of the Claim, is necessary without reference to the length of time." 30 O. G. 889 (891).

In *Ex parte* Conklin (1874), 1 MacArthur, 375, MacArthur, J.: (378) "It will be seen by the terms of the statute that in order to entitle a party to the re-issue of a patent it is incumbent on him to show that it is inoperative or invalid by reason of a defective or insufficient specification, or that the patentee had claimed more than he in-

upon the doctrine of fraud and in part upon the doctrines of estoppel and abandonment. A wilful attempt to deceive the public, whether by express misrepresentation or by obscurity and insufficiency of statement, is a fraud. It violates the fundamental principles of contract, upon which the right of an inventor to his patent privilege depends. If such an attempt be proved, the patent is void *ab initio;* its errors are incapable of remedy by any method of amendment; and the inventor forfeits, as a penalty for his wrong-doing, the entire protection he might otherwise have obtained.[2] An intentional misrepre-

vented, and that the error had arisen by inadvertence, accident, or mistake, and without any fraudulent intention. Unless these circumstances exist in an application of this character, I can find no authority by which the Commissioner can re-issue a patent; as he is an officer of special and limited power, his action must be restricted to the particular cases mentioned in the statute. I refer to these requirements of law because, if the original patent is neither inoperative nor invalid, and if no error has been occasioned by accident or mistake, there must be a presumption of law and fact that the patentee has abandoned to the use of the public everything which he may have invented, but which he did not include in his Claims and specifications. The law presumes that every one who applies for a patent will embody his invention in specifications sufficiently definite to preserve as much of his discovery as he desires to protect by a patent. If, from mistake, he has overlooked anything within the scope of his invention, he may surrender his patent on that ground, and claim a new one, in accordance with amended specifications. The party asking this relief must be denied it unless he brings himself within the statute. When he knows all the facts relating to his own case, but, through culpable negligence or misconduct, has failed to claim all of his discovery, the law will not extend its aid to him, but will leave him to enjoy only such limited advantages as he has actually secured. The law reserves its remedies for the careful and vigilant who may have been misled from any of the causes mentioned in the statute." 5 O. G. 235 (236).

In Jordan *v.* Dobson (1870), 4 Fisher, 232, Strong, J.: (237) "If the defect or insufficiency of the specifications of the surrendered patents had not arisen from inadvertence, accident, or mistake, and without fraudulent intention, the Commissioner had no right to re-issue the patent." 2 Abbot, 398 (404); 7 Phila. 533 (535).

See also *Ex parte* Whitely (1886), 36 O. G. 1243; Bate Refrigerating Co. *v.* Eastman (1885), 24 Fed. Rep. 645; 32 O. G. 517; Clements *v.* Odorless Excavating Apparatus Co. (1884), 109 U. S. 641; 26 O. G. 353; Flower *v.* Rayner (1881), 5 Fed. Rep. 793; 19 O. G. 425; Meyer *v.* Maxheimer (1881), 20 O. G. 1162; 20 Blatch. 15; 9 Fed. Rep. 99; Giant Powder Co. *v.* California Vigorit Powder Co. (1880), 18 O. G. 1339; 6 Sawyer, 508; 4 Fed. Rep. 720; Giant Powder Co. *v.* California Powder Works (1875), 3 Sawyer, 448; 2 Bann. & A. 131; Knight *v.* Baltimore & Ohio R. R. Co. (1840), Taney, 106; 3 Fisher, 1; Opinion Atty. Gen. (1836), 3 Op. At. Gen. 165.

[2] This doctrine rests not merely upon general principles of law, but upon the

sentation or concealment, without fraudulent design, concludes the party making it as to the character and scope of the invention attempted to be covered by the patent. What has been properly described and claimed is regarded as its true subject-matter; what has been voluntarily omitted or misstated is considered as abandoned to the public, or as permanently excluded from that particular patent;[3] and though it may sometimes be made the subject-matter of a future patent, it cannot be incorporated into the existing patent by re-issue. An error which occurs through inadvertence, accident, or mistake, is neither intentional nor fraudulent, but is consistent with an honest attempt to describe and claim the complete invention, as the inventor has himself conceived it and rendered it available for public use.[4] It is for the purpose of correcting this latter error only that an amendment by re-issue is permitted.

express provisions of the statute. An attempt to deceive the public by a suppression of the truth or the suggestion of a falsehood in the description and specification of the patent is therein made a valid defence in any action based upon the patent. The right to amend a defective patent either by disclaimer or re-issue is also conditioned upon the absence of any fraudulent or deceptive intention on the part of the patentee. Diligence and good faith are alike required of him as qualities of conduct and purpose without which no concession of exclusive privileges to him can be allowed. See Miller *v.* Brass Co. (1882), 104 U. S. 350; 21 O. G. 201.

[3] That a re-issue cannot claim matter intentionally omitted from the original, see *Ex parte* Mahnken (1887), 40 O. G. 915; Shirley *v.* Mayer (1885), 23 Blatch. 249; 25 Fed. Rep. 38; 34 O. G. 1391.

[4] That "mistake" as ground for re-issue is not the same thing as "misunderstanding," see *Ex parte* Wilkins (1883), 24 O. G. 1270.

That it is immaterial by what mistake or inadvertence a re-issue becomes necessary, see Stimpson *v.* Westchester R. R. Co. (1846), 4 How. 380; 2 Robb, 335.

That the re-issue affords *prima facie* evidence of inadvertence, but may be overcome by other proof, see Odell *v.* Stout (1884), 22 Fed. Rep. 159; 29 O. G. 862.

That "inadvertence, etc.," exists in reference to the application, not the invention, and occurs only where the former does not describe and claim what the inventor intended to protect, see *Ex parte* Mahnken (1887), 41 O. G. 1269.

That a Claim left out of the original because the applicant did not consider its subject-matter patentable cannot be inserted in the re-issue, see *Ex parte* Mahnken (1887), 40 O. G. 915.

That an error in opinion or judgment is not "mistake or inadvertence," see *Ex parte* Mahnken (1887), 40 O. G. 915.

That a re-issue which was evidently procured to cover other later devices and not to cure faults arising from inadvertence or mistake is invalid, see Newton *v.* Furst & Bradley Mfg. Co. (1886), 119 U. S. 373; 38 O. G. 104.

§ 686. Re-issue not Permitted where the Defects in the Original Patent Arose through Fraud.

With reference to this third proposition, defects and insufficiencies in the Description or Claims of a patent may thus be grouped in three classes: (1) Those which are intentional and fraudulent; (2) Those which are intentional but not fraudulent; (3) Those which are neither intentional nor fraudulent, but which arise from inadvertence, accident, or mistake. Concerning the first class, the law is plain and fully settled. The question as to the existence of a fraudulent and deceptive intention is a question of fact to be determined, upon direct or inferential evidence, by whatever tribunal may have jurisdiction of the controversy in which the question is raised. Thus on an application for a re-issue, the Commissioner may inquire into the original good faith of the patentee, and upon satisfactory proof of bad faith may deny the application. The courts, in ascertaining the validity of a re-issue already granted, may pursue the same investigation, and if a fraudulent intent appears to have been entertained by the original patentee, may treat the re-issue as invalid.[1]

§ 687. Re-issue not Permitted to Reject Matter Intentionally Inserted in the Original Patent, nor to Restore Matter Intentionally Excluded.

The line between the second and third classes, though sufficiently clear in statement, is not always easy to define in

§ 686. [1] The extent of the authority of the courts to inquire into the intention of the patentee in omitting or misstating any feature of the invention in his original patent cannot, at present, be precisely defined. That the decision of the Commissioner on the good faith of the patentee in applying for a re-issue, and on the absence of corruption in allowing it, is final, except upon proceedings brought to repeal the re-issued patent, is conceded; and that a patent may be collaterally attacked, on the ground that its Description and Claims are fraudulent and intended to deceive, is beyond question. A disposition to enlarge the sphere of judicial authority, and permit the courts to go behind the finding of the Commissioner upon the questions of inadvertence, etc., in ordinary actions on the re-issued patent has recently been manifested; and though indulged with great caution, and with perhaps too much regard for the supposed prerogatives of the Commissioner, is so clearly in the interests of a just administration of the law that its result in bringing all these issues into the jurisdiction of the courts in any suit, in which the validity of the patent is involved, may be considered as already certain. See §§ 714, 715, and notes, *post*.

practice. That matter which has once been deliberately embraced within or excluded from a patent can neither be disclaimed nor reclaimed by an amendment, and that matter unintentionally included or omitted may be afterward rejected or inserted, are rules distinct, precise, and exhaustive. The difficulty is found in ascertaining whether the original misstatement was deliberate or unintentional, and in devising and applying tests by which this question may be settled without relying on the evidence of the inventor as to the object which he had in view. The positions generally taken by the Patent Office and the courts in reference to this question are in harmony with those assumed in regard to other aspects of the doctrines of abandonment and estoppel.[1] Abandonment is always a question of intention, to be gathered in all cases from the conduct of the inventor toward his invention or the public. Estoppel rests upon an actual or presumed intention of the inventor, which is made effective by forbidding him to depart from the position he has once assumed. Errors occurring in the Description or Claims of the original patent are thus held to have been deliberate or unintentional according to the indications afforded by the circumstances causing, or connected with, or relating to the occurrence of these errors. Such circumstances may precede or be concurrent with or subsequent to the issue of the original patent. They may appear upon the face of the patent itself, or in the records of the Patent Office, or in the actions or omissions of the inventor; and whenever from these circumstances it is evident that the inventor deliberately made his attempt to describe and claim the invention in the form and with the limitations inserted in the original specification, any endeavor to correct the statement, by changing that form or discarding those limitations in the re-issue, is unlawful. What circumstances have been treated by the Patent Office or the courts as indicative of such intentional exclusion, will be now considered.

§ 687. [1] That whenever it may be necessary for the protection of either public or private rights, the doctrine of estoppel, as now applied in courts of law and equity to ordinary transactions, will be resorted to in the adjudication of patent causes, see §§ 346 and notes, 357, note 3, 390 and notes, *ante*, and §§ 981, 1021, 1046, 1195, and notes, *post*.

§ 688. Re-issue not Permitted to Enlarge the Claims of the Original Patent by Including Matter once Intentionally Excluded.

It may be premised that this question rarely arises except in cases where the alleged error in the original patent consists in an undue restriction of its Claims.[1] An amendment made in the Description, placing the invention more fully in the possession of the public and not enlarging the privileges of the inventor, is not subject to objection unless the original were fraudulent and the patent, therefore, void. An amendment merely limiting excessive Claims in the original patent is also rather for the public interest than that of the inventor, and when attempted without unreasonable delay seldom encounters opposition. But when the inventor endeavors by amendment to extend his Claims, and thus encroaches on a domain previously left open to the public or occupied by rival inventors, his efforts are naturally subjected to severe adverse criticism and his rights are properly confined within the narrowest limits. Hence it is in cases where the re-issue, though not materially altering the description of the original invention, claims for it essential features differing in number or in character from those claimed for it in the former patent, or where subordinate or dependent inventions, described but not claimed in the original patent, are claimed in the re-issue,

§ 688. [1] It is not, however, true that the right to a re-issue amending the Description or narrowing the Claims can be exercised without limitation. The patentee owes a duty to the public to present them with an accurate delineation of his invention, and to confine his Claims to the essential features which he has created; and he is open to the imputation of bad faith if he fails to amend his patent in these particulars when such amendment becomes evidently necessary. Thus even a disclaimer cannot save a patent unless made without unreasonable delay; and acquiescence in a faulty description may bar the allowance of a re-issue, if it does not furnish evidence of an original intention to deceive. Illustrations of these principles may be found in the following cases:

That while less delay is allowable in expanding Claims than in restricting them, no unreasonable delay as to either can be permitted, see *Ex parte* Matthews (1884), 26 O. G. 823.

That a defect in the Description may be cured by re-issue, even though the right to cure one in the Claim has been lost by delay, see Miller *v.* Brass Co. (1882), 104 U. S. 350; 21 O. G. 201.

That the original Claims may be reproduced in a re-issue without reference to delay, see Yale Lock Co. *v.* Sargent (1886), 117 U. S. 536; 35 O. G. 497; Steam Gauge Lantern Co. *v.* Miller (1882), 11 Fed. Rep. 718.

that the amendment is attacked, and that the question of deliberate or unintentional exclusion from the previous patent is involved.

§ 689. Intentional Exclusion Shown by Express Disclaimer in the Original Patent or during the Proceedings in the Patent Office.

A voluntary and intelligent disavowal of any matter which is embraced in the original description of the invention is conclusive evidence of its intentional exclusion from the patent.[1] This disavowal may consist in an express disclaimer embodied in the specification, or filed subsequently

§ 680. [1] That an intentional disclaimer of any matter in the original patent prevents its claim in a re-issue is apparent from the authorities cited in § 680, note 1, *ante*. But an unintentional or mistaken disclaimer, arising from an erroneous use of language, as distinguished from a misconception of the nature of the invention, has no such effect. On the contrary, it is one of the chief purposes of a re-issue to correct defects of this kind and to cause the patent to embrace what before it had, under the construction given to its terms, apparently excluded. Thus in Hussey *v.* Bradley (1863), 2 Fisher, 362, Hall, J.: (371) "Even a statement, in an original patent, that a part is old, or a disclaimer of a part, does not, it seems, necessarily prevent such part from being claimed in a re-issued patent, though it would have that effect if made advisedly, and not by inadvertence, accident, or mistake. *Ex parte* Hayden; Laidley *v.* James; Law's Digest, 616." 5 Blatch. 134 (141). See also Daniels *v.* Chesterman (1877), 13 O. G. 4; Poppenhusen *v.* Falke (1861), 2 Fisher, 181; 4 Blatch. 493.

That a re-issue may omit a disclaimer found in the original, if such disclaimer has no reference to the essence of the invention and does not limit its claim, see *Ex parte* Hermann (1876), 10 O. G. 865.

That a disclaimer in the original need not be inserted in the re-issue where it has been judicially determined that such disclaimer was unnecessary, see Eames *v.* Andrews (1887), 122 U. S. 40; 39 O. G. 1319.

That a re-issue, re-instating Claims omitted from a former re-issue in order to substitute wider ones, is valid, see Celluloid Mfg. Co. *v.* Zylonite Brush & Comb Co. (1886), 27 Fed. Rep. 291; 35 O. G. 1228.

That where a specification says that the invention consists in combining the elements, this does not abandon the elements themselves, see Henderson *v.* Cleveland Co-operative Stove Co. (1877), 12 O. G. 4; 2 Bann. & A. 604.

That the withdrawal of a Claim in the Patent Office as unnecessary is not an abandonment of the matter, see Eames *v.* Andrews (1887), 122 U. S. 40; 39 O. G. 1319.

That a re-issue upon the application of an assignee cannot cover matter once disclaimed by the original inventor, see Putnam *v.* Hutchinson (1882), 11 Bissell, 233; 12 Fed. Rep. 127; Ashcroft *v.* Railroad Co. (1877), 97 U. S. 189; 13 O. G. 865.

to the issue of the patent, or in the conduct of the inventor toward his application during the proceedings in the Patent Office.[2] A feature of the invention, whose rejection by the examiner is acquiesced in by the applicant without appeal, is thereby excluded as effectually as by express disclaimer.[3] A Claim withdrawn by amendment, either to save the application or escape an interference, is also finally repudiated by the patentee.[4] Even the acceptance of a patent, containing

[2] That a re-issue cannot include Claims abandoned in the first application, see Streit *v.* Lauter (1882), 11 Fed. Rep. 309.

That an admission by the patentee in his specification or application cannot be contradicted by him, see Moffitt *v.* Rogers (1881), 8 Fed. Rep. 147.

That matter abandoned in the Patent Office cannot be reclaimed by re-issue, see Yale Lock Mfg. Co. *v.* James (1884), 22 Blatch. 294 ; 28 O. G. 917 ; 20 Fed. Rep. 903.

[3] In *Ex parte* Hatchman (1884), 3 Mackey, 288, MacArthur, J. : (289) "We are of opinion that on an application for a patent, when one of the Claims presented is covered by previous inventions and the patents therefor are referred to, and the examiner upon such reference decides against such Claim, and the applicant thereupon, by his attorney, orders the same to be erased and withdrawn, and thus obtains and accepts a patent for the residue of his Claims, he is not entitled to a re-issued patent containing the identical Claim which he has so erased and withdrawn. We also hold that under such circumstances no error has arisen by inadvertence, accident, or mistake, within the meaning of the Patent Law, which would authorize the Commissioner to entertain the application for a re-issue." 26 O. G. 738 (738).

That a Claim rejected by the Patent Office and the rejection acquiesced in cannot be re-instated by re-issue, there being in such cases no accident or mistake, see *Ex parte* Page (1888), 43 O. G. 1455 ; Arnheim *v.* Finster (1886), 26 Fed. Rep. 277 ; 34 O. G. 700.

That if the Commissioner on an extension-hearing requires certain matters to be disclaimed and the patentee acquiesces, they cannot be inserted in a re-issue, there having been no inadvertence, see Union Metallic Cartridge Co. *v.* United States Cartridge Co. (1884), 112 U. S. 624 ; 30 O. G. 771.

That a Claim abandoned in the original application on an objection by the Patent Office, but afterward allowed to another applicant, may be inserted in the re-issue, see Yale Lock Mfg. Co. *v.* Norwich National Bank (1881), 19 Blatch. 123 ; 6 Fed. Rep. 377.

[4] That a re-issue cannot contain Claims which were withdrawn from the application for the original in order to secure its issue, see Shepard *v.* Carrigan (1886), 116 U. S. 593 ; 34 O. G. 1157 ; Leggett *v.* Avery (1879), 101 U. S. 256 ; 17 O. G. 445.

That if an applicant is obliged to include an element in order to procure a patent, he cannot afterwards broaden his Claim by dropping it, see Shepard *v.* Carrigan (1886), 116 U. S. 593 ; 34 O. G. 1157.

That a patentee is bound by the limitations imposed on his patent, whether they were voluntary or enforced by the Patent Office, and if he accepts a Claim not covering his entire invention he abandons the residue, see Toepfer *v.* Goetz (1887), 41 O. G. 933.

That where a Claim was withdrawn

limitations imposed by the Patent Office which narrow the scope of the invention as at first described and claimed in the application, is an irrevocable admission that such limitations are of the essence of the invention attempted to be covered by the patent.[5] In none of these cases can the undue restriction of the Claim be attributed to inadvertence, accident, or mistake.[6] The patentee, when he receives his

from the application of an original patent, in order to escape an interference, the re-issue cannot contain such Claim, see Lee *v.* Walsh (1870), 15 O. G. 563; *Ex parte* Gillen (1877), 11 O. G. 419.

That Claims cannot be restored after a judgment has been rendered in interference in the patentee's favor on his striking them out, see *Ex parte* Cobb (1870), 16 O. G. 175.

That a defeated contestant in an interference, after accepting a limited patent, cannot claim in his re-issue any matter awarded to his opponent, see *Ex parte* Burge (1877), 13 O. G. 498.

That where a device is adhered to in spite of an interference it cannot afterward be claimed that its retention in that application was a mistake, see *Ex parte* Kirby (1879), 16 O. G. 1095.

That it will not be assumed that contesting parties could have overcome objections raised by the Patent Office, see Puetz *v.* Bransford (1887), 39 O. G. 1427; 31 Fed. Rep. 458.

That where the original application was for a product and process both, and was amended to cover only the process, the patent cannot be re-issued to claim the product, see Giant Powder Co. *v.* California Powder Works (1875), 3 Sawyer, 448; 2 Bann. & A. 131.

That a proposal to limit the Claim, though made by the applicant to the Patent Office, does not bind the patentee unless it was accepted by the Commissioner, see Pike *v.* Potter (1859), 3 Fisher, 55.

[5] In N. Y. Belting & Packing Co. *v.* Sibley (1883), 15 Fed. Rep. 386, Lowell, J.: (389) "It has been several times decided by the Supreme Court that disclaimers, qualifications, and limitations, imposed upon a patentee by the Patent Office, are forever binding upon him if he chooses to accept a patent containing them. Not only are third persons likely to be misled to their injury by any subsequent enlargement by re-issue, or by a broad construction of Claims thus intended to be limited, but these qualifications are conditions precedent, without which there would have been no grant at all, and, of course, the grant must be taken as it is given." 23 O. G. 1444 (1445). See also Dodds *v.* Stoddard (1883), 24 O. G. 799; 17 Fed. Rep. 645; Putnam *v.* Hutchinson (1882), 12 Fed. Rep. 127; 11 Bissell, 233; Goodyear Dental Vulcanite Co. *v.* Davis (1880), 102 U. S. 222; 19 O. G. 543.

That a disclaimer, by direction of the Commissioner, in an application for a re-issue, of some modification of the original, does not concede that such modification is not covered by the patent, as it might do if in the original patent, see Union Metallic Cartridge Co. *v.* United States Cartridge Co. (1881), 7 Fed. Rep. 344.

That an applicant limiting his Claims upon a re-issue in view of the objections of the Patent Office is bound by the limitations in suits on the re-issue, see Crawford *v.* Heysinger (1887), 123 U. S. 589; 42 O. G. 197.

[6] Two exceptions have sometimes been recognized as existing under this rule: one, where the limitation in the

patent, knows that it does not cover all he had originally claimed. Instead of pressing his original application until

original patent was imposed through a mistake in the Patent Office; the other, where it resulted from the act of an attorney without special authority for that purpose from the applicant. The modern tendency seems to be to disregard these exceptions, and to compel the patentee to abide by the patent as he receives and accepts it. Thus that a re-issue may claim matters which, through a mistake in the Patent Office, were disclaimed in the original, was held in American Shoe Tip Co. *v.* National Shoe Toe Protector Co. (1877), 11 O. G. 740; 2 Bann. & A. 551; *Ex parte* Sexton (1876), 9 O. G. 251; Morey *v.* Lockwood (1868), 8 Wall. 230.

That where the Patent Office gives an erroneous interpretation to a Claim and thereupon rejects it with the assent of the patentee, the Claim bearing a different interpretation may be re-instated in a re-issue, see Yale Lock Mfg. Co. *v.* New Haven Savings Bank (1887), 32 Fed. Rep. 167; 43 O. G. 115.

The opposite doctrine is asserted in *Ex parte* Hatchman (1884), 3 Mackey, 288; 26 O. G. 738; Putnam *v.* Hutchinson (1882), 11 Bissell, 233; 12 Fed. Rep. 127; and cases cited under note 3, *ante*.

That a patentee having acquiesced in the rejection of broad Claims cannot afterward assert them, though the rejection was improper, see Blodes *v.* Rand, McNally, & Co. (1886), 27 Fed. Rep. 93; 37 O. G. 99.

The present state of the second exception is more doubtful, as the following authorities will show: —

That a disclaimer by an attorney without authority from the patentee is no bar to a re-issue covering the matter disclaimed, see Lee *v.* Walsh (1879), 15 O. G. 563; *Ex parte* Murdock (1879), 16 O. G. 957; Mann *v.* Bayliss (1876), 10 O. G. 789.

That a re-issue may embrace a Claim shown in the original application and erased by a misunderstanding of the attorney, see Stutz *v.* Armstrong (1884), 28 O. G. 367; 20 Fed. Rep. 843.

That material matters cannot be disclaimed by an attorney of his own motion, but only by the applicant himself, though immaterial matter may be disclaimed without the signature of the party, see *Ex parte* Murdock (1879), 16 O. G. 957.

But *per contra*, —

That an erasure of a rejected Claim by an attorney shows that there is no inadvertence, see *Ex parte* Hatchman (1884), 3 Mackay, 288; 26 O. G. 738; *Ex parte* Hatchman (1883), 25 O. G. 979.

That matter disclaimed in the Patent Office by the attorney to escape rejection cannot be reclaimed in a re-issue, though the patentee were ignorant of the disclaimer, see Arnheim *v.* Finster (1885), 24 Fed. Rep. 276; 32 O. G. 256.

That a mistake of a solicitor in procuring a patent with Claims narrower than he was instructed to make cannot be cured by re-issue after years of delay, see Ives *v.* Sargent (1887), 119 U. S. 652; 38 O. G. 781.

That where two rivals employ the same attorney who in good faith limits the application of one to allow priority in some matter to the other, and both acquiesce in the patents so granted for nine years and then discover that the other was its real inventor, no re-issue can be had by him to cover it and neither can hold it, see Hartshorn *v.* Saginaw Barrel Co. (1887), 119 U. S. 664; 38 O. G. 540.

That a Claim rejected in the Patent Office, and the rejection acquiesced in by the attorney for the inventor, cannot be inserted in a re-issue after two years'

his rights have been determined by the court of last resort, he has relinquished a portion of the fruits of his inventive skill, at least from the protection of that particular patent, in order to secure the rest, and whether his course in this respect were wise or unwise, he cannot afterward retrace it and by re-issuing his patent claim the matter once excluded.[7]

delay and after intervening rights have arisen, see Boland *v.* Thompson (1886), 23 Blatch. 440 ; 26 Fed. Rep. 633 ; 35 O. G. 1113.

That a claim stricken out of the original application because disallowed in the Patent Office, and whose subject-matter is not covered by the original patent as accepted by the patentee's solicitor, cannot be inserted in a re-issue, see Dobson *v.* Lees (1887), 30 Fed. Rep. 625.

That the inventor is a foreigner who does not understand English cannot save him if duly put upon his guard in reference to such rejection, see Boland *v.* Thompson (1886), 23 Blatch. 440 ; 26 Fed. Rep. 633 ; 35 O. G. 1113.

[7] In Leggett *v.* Avery (1879), 101 U. S. 256, Bradley, J. : (259) " If, in any case, where an applicant for letters-patent, in order to obtain the issue thereof, disclaims a particular invention, or acquiesces in the rejection of a Claim thereto, a re-issue containing such Claim is valid (which we greatly doubt), it certainly cannot be sustained in this case. The allowance of Claims once formally abandoned by the applicant, in order to get his letters-patent through, is the occasion of immense frauds against the public. It not unfrequently happens that, after an application has been carefully examined and compared with previous inventions, and after the Claims which such an *examination* renders admissible have been settled with the acquiescence of the applicant, he, or his assignee, when the investigation is forgotten and perhaps new officers have been appointed, comes back to the Patent Office, and, under the pretence of inadvertence and mistake in the first specification, gets inserted into re-issued letters all that had been previously rejected. In this manner, without an appeal, he gets the first decision of the Office reversed, steals a march on the public, and on those who before opposed his pretensions (if, indeed, the latter have not been silenced by purchase), and procures a valuable monopoly to which he has not the slightest title. We have more than once expressed our disapprobation of this practice. As before remarked, we consider it extremely doubtful whether re-issued letters can be sustained in any case where they contain Claims that have once been formally disclaimed by the patentee, or rejected with his acquiescence, and he has consented to such rejection in order to obtain his letters-patent. Under such circumstances, the rejection of the Claim can in no just sense be regarded as a matter of inadvertence or mistake. Even though it was such, the applicant should seem to be estopped from setting it up on an application for a re-issue." 17 O. G. 445 (446).

In Wicks *v.* Stevens (1876), 2 Woods, 310, Bradley, J. : (312) " The patent of 1866 was confined to portable revolving cotton-presses. I assume that the re-issued patent extends to all cotton-presses, *stationary as well as portable*, for, if confined to the latter, the defendant does not infringe it. Had this extension to stationary presses been omitted in the original patent by acci-

§ 690. Intentional Exclusion Shown by Failure to Claim Matter Clearly Described in the Original Patent unless the Claims are Amended by Re-issue without Unreasonable Delay.[1]

dent or mistake, it might be corrected in the re-issued patent. But its application to revolving presses generally was first claimed and then abandoned in the application for the original patent of 1866, and the Claim as finally made by the patentee, and to secure which alone his patent issued, was for a combination applicable to portable presses only. It cannot be said, therefore, that a neglect to claim the combination as applicable to revolving presses generally was an inadvertence, accident, or mistake. It was an exclusion designed and understood at the time. Attempts to grasp claims by means of re-issued patents, which, while the evidence is fresh at the time of the original application, the patentee would not have the hardihood to make, are getting too frequent, and are too often acquiesced in by the Patent Office. Perhaps this is not to be wondered at when we consider the persistency with which claims once abandoned are pressed upon the department after the evidence of their futility has been forgotten." 2 Bann. & A. 318 (319).

That where the Patent Office rejects a Claim, an appeal or bill in equity, not a re-issue, is the remedy, see Arnheim *v.* Finster (1886), 26 Fed. Rep. 277; 34 O. G. 700; Shepard *v.* Carrigan (1886), 116 U. S. 593; 34 O. G. 1157; Mahn *v.* Harwood (1884), 112 U. S. 354; 30 O. G. 657; New York Belting & Packing Co. *v.* Sibley (1883), 15 Fed. Rep. 386; 23 O. G. 1444; Putnam *v.* Hutchinson (1882), 12 Fed. Rep. 127; 11 Bissell, 233.

§ 690. [1] The doctrine discussed in this and the two succeeding paragraphs is one which all the decisions cited in the notes sustain, and which a few of them clearly and exclusively enunciate. In many of the opinions explaining these decisions, however, other theories are introduced and treated as the grounds on which the judgment of the court is based, thereby tending to obscure a proposition which in itself is sufficiently intelligible. These theories have been echoed by one court to another, sometimes in their entirety, sometimes shorn of their most important qualifications, and sometimes generalized into sweeping rules and applied to cases far beyond their legitimate scope, and thus have reduced the law on this topic to a condition of incoherence and uncertainty which is deplorable. To cite these cases without pointing out the chief errors of statement which are to be encountered, and explaining the relation of the most important of these theories to the true principles by which the subject must be governed, would be fruitless.

One of these theories is that a re-issue for the purpose of enlarging the Claims of a patent occupies a position different from that of a re-issue to restrict the Claims or more clearly describe the invention, both in reference to the time within which such re-issue must be sought, and to the mode in which it is affected by the intervening acts of others. Upon what interpretation of the statutes this position rests is explained at length in § 656, note 2, in a discussion of the case of Miller *v.* Brass Co. (1881), 104 U. S. 350. But if it be true that a re-issue for the purpose

invention, which has been clearly described in the specifica-

of enlarging Claims which were unduly restricted in the original is proper (and this is conceded by the theory under review), such re-issue is authorized by the statute whenever the original restriction arose from inadvertence, accident, or mistake, without any reference to *lapse of time*, or the acts of other parties. The inventor having actually invented more than his original patent has really secured, can lose the excess only by some form of abandonment, and this can never be inferred from mere delay alone, nor from the conduct of third parties. The intention to abandon (and without such intention no abandonment of any kind is possible) is conclusively disproved if the inventor attempted to cover the matter by his original patent, as it is, on the other hand, conclusively established if no such attempt were made. And as an omission or misstatement in a Claim, through inadvertence, accident, or mistake, presupposes an attempt to claim which has failed to accomplish the intention of the claimant, so it can never be true that matter originally misstated or omitted, through accident, mistake, or inadvertence, can have been then abandoned. But if the invention could not have been abandoned by the failure of an attempt to secure its protection, abandonment is certainly not effected by the mere continuance of the patent in its defective state. If the inventor does not relinquish his right to the invention by taking out his patent in its defective form, he surely cannot relinquish it by holding under the defective patent in the belief that it sufficiently protects his actual invention, whatever period may elapse. Not until he acquires such knowledge of the defects as would have made his original acceptance of the patent in that form incompatible with the idea of inadvertence, accident, or mistake in describing and claiming the invention, can any want of intention to monopolize the entire invention, as he originally attempted to describe it, be imputed to him. But when this knowledge is obtained, or by the exercise of ordinary vigilance could be obtained, his acquiescence in the defects of his original patent has a grave significance. Such acquiescence indicates an intention to abandon whatever the original patent, because of these defects, fails to secure. Were it not for the peculiar language of the statute and the dependence of the re-issued patent, so far as the patentability of the invention is concerned, upon the state of facts existing at the date of the original, it might indeed be held that this acquiescence is in itself an abandonment of the unprotected matter, and a bar to its reproduction in the re-issue. But the statute governing re-issues contains no provision for their refusal on account of the abandonment of the invention after the grant of the original patent. On the contrary, it makes the actions and attempts of the inventor at the date of the original application the sole criterion of his right to a re-issue, and until the case of Miller *v.* Brass Co. the courts had, with scarcely an exception, followed the same rule. See Battin *v.* Taggert (1854), 17 How. 74, overruling Battin *v.* Taggert, 2 Wall. Jr. 102, and asserting that matter described but not claimed does not become abandoned by lapse of time; also Hussey *v.* Bradley (1863), 5 Blatch. 134; 2 Fisher, 362; McWilliams Mfg. Co. *v.* Blundell (1882), 22 O. G. 177; 11 Fed. Rep. 419. Thus the acquiescence of a patentee in a defective patent can have no other weight, either in a subsequent application for a re-issue or in an action involving the validity of a re-issued patent, than as evidence of the real position of the patentee toward his invention at the date

tion, is always *prima facie* evidence of an intention, on the

of his original patent, and of the origin of his omissions and misstatements in intention rather than in accident, inadvertence, or mistake. His negligence in asserting his rights after he becomes aware that they are not sufficiently protected by his existing patent affords ample proof of his original intention to forego them, and it is only as an element in such negligence that the delay of the patentee in obtaining an amendment by re-issue is open to consideration.

The argument here urged is not intended as a denial that Congress could justly have withheld the privilege of a re-issue on the ground of unreasonable delay alone, without regard to the inference it affords as to the original intent of the inventor. But as neither the acts of 1832 or 1836 or 1870, nor the Revised Statutes, prescribe that diligence *per se* is essential to the right to a re-issue, while in reference to a disclaimer it was made an indispensable condition, and as in numerous instances re-issues have been granted after long periods of time, and have been unhesitatingly sustained by the courts, it is a fair conclusion that the legislature, in which the ultimate power to grant or withhold patents resides, never designed that the mere failure to apply for a re-issue, however prolonged, should operate as a forfeiture of the right to amend a patent whose defects originated in the modes described. Nor is it intended to deny that where legislative enactments are deficient, and inadequate to the protection of rights, the courts may act on general principles of justice and equity, and by a species of judicial legislation provide for cases not covered by the letter of the law. Thus if the removal and prevention of the abuses which had arisen in connection with re-issues could not have been accomplished by a true interpretation and enforcement of the provisions of the statutes, a resort to the doctrine that vested rights may be forfeited by laches or estoppel might have been excusable. But in the explication herein given of the positive law relating to re-issues, it seems evident that the legislative enactment is sufficient for itself, and that no occasion exists for the importation into this subject of those equitable theories which place the inventor entirely at the mercy of the court, although he may in all respects have fulfilled the express precepts of the law.

The effect of the conduct of third parties upon the right of a patentee to a re-issue amending his defective Claims is subject to still narrower limitations. Until he has knowledge, or is put upon such inquiry as would result in knowledge, that his invention is not fully secured by his patent, the actions and assertions of others cannot deprive him of the privilege of a re-issue when he does discover its necessity, either under the language of the statute or under the doctrines of abandonment or laches or estoppel. As was well said by Bradley, J., in White *v.* Dunbar (1886), 119 U. S. 47 (52): "The circumstance that other improvements and inventions, made after the issue of a patent, are often sought to be suppressed or appropriated by an unauthorized re-issue, has sometimes been referred to for the purpose of illustrating the evil consequences of granting such re-issues; but it adds nothing to their illegality." 37 O. G. 1002 (1003). For if, during his ignorance of the defects of his own patent, the patentee ascertains that others use, under a claim of right, that which is in reality the unprotected part of his invention, he must naturally regard them as infringers, whose tortious acts the law permits him to condone or punish at his pleasure. If a third party obtains a

part of the inventor, to exclude it from the operation of that

patent for what appears to be the same invention or one of its protected elements, without an interference with his patent, he may safely assume that the inventions are essentially distinct, and that no occasion for a vindication of his rights has been created. The conduct of other persons is thus without significance on this question except in connection with knowledge on the part of the patentee that his own patent needs amendment in order to protect his entire invention. But since when he attains this knowledge it is his duty to amend his patent without unreasonable delay if he would avoid the inference that the unprotected matter was at the outset intentionally excluded, whether or not third persons are using or have patented the unsecured invention, it is evident that their conduct can become important only when the reasonableness of his delay is to be determined. A period of inaction after the discovery of the defects in his patent, which might well be permitted were no antagonistic interests involved, would be wholly unwarrantable when other patentees or operators were claiming or enjoying the invention, and in proportion to the number and the value of such interests might greater degrees of diligence in applying for the re-issue be required.

If these views of the questions of delay and intervening rights are correct, the true doctrine in reference to both is this: that the Claims of a re-issue may be altered or enlarged to cover the entire invention which the patentee attempted to embrace in his original patent, provided he applies for a re-issue within such a period after he discovers or ought to have discovered the defect as is consistent with an original intention to protect the invention by his patent; and that upon the consistency of this period of delay with such original intention, the existence of antagonistic rights and interests in others is one important matter for consideration. That this is also the real doctrine of the cases in which the theory under discussion is set forth will be evident if the whole current of authority is examined, and the relation of each decision to those which it purports to follow as its guides is carefully traced.

Another theory, sometimes found in connection with the preceding is, that where the Claims of an original patent do not cover the entire invention, the defect is necessarily apparent to the patentee on an inspection of the patent, and hence that he is chargeable with notice of the error from the date of his reception of the patent. If this statement were to be regarded as a rule that no amendment by re-issue should be considered as an enlargement of the patent unless the error amended were apparent on the face of the original, the even balance of justice might not be thereby disturbed. But as the assertion of a fact it is not true. In the great majority of instances a failure to claim may be evident on inspection, but in many the nature of the invention may be so complicated, and its essential features so difficult of expression, that the patentee may fairly and honestly believe that he has embraced it in his Claims, while more mature experience or the subsequent decisions of the courts upon his patent may demonstrate his error. Upon the rule of law that when the discrepancy between the invention and the subject-matter of the Claims appears on an examination of the patent the patentee is chargeable with immediate knowledge and must pursue his remedy without delay, there can be no difference of opinion. But that in cases where the patentee does not discover, and with the employment of such vigi-

patent; and this evidence is regarded as conclusive upon him,

lance as the law requires of every asserter of a right could not discover, that his Claims were narrower than his invention, as he had attempted to secure it, it must be assumed either that he had notice at the issue of his patent, or that the correction of the Claims to make them correspond with the invention was not an enlargement, is alike unnecessary and inconsistent with the ordinary rules of law.

The two foregoing theories obtain especial prominence from their apparent recognition in the noted case of Miller *v.* Brass Co. (1881), 104 U. S. 350. Prior to the decision of this case the law of re-issue had been interpreted with great laxity in favor of patentees, and its application in many instances had been exceedingly abused. The Supreme Court availed itself of the opportunity afforded by this case to restore the administration of the law to its proper limits. It discovered and formulated no new principles, but simply reaffirmed the propositions that a re-issue cannot embrace new matter under any circumstances, nor any matter whose omission or misstatement in the original patent was intentional. But in its statement and explanation of these propositions the court labored under a peculiar embarrassment. The evil which it undertook to remedy was the enlargement of the Claims in a re-issue after individuals or the public had acted on the implied abandonment contained in the original. But as the law expressly conferred upon a patentee the right to claim in his re-issue any matter which he had attempted to describe and claim in the original patent, and which he had therein failed to claim through inadvertence, accident, or mistake, the Supreme Court could not repudiate or qualify this right. The question of identity was settled in favor of the patentee, if the original patent disclosed the subject-matter of the re-issue, and at the same time the decision of the Commissioner that the original defect arose from accident, mistake, or inadvertence was regarded as conclusive; and thus no method of avoiding the re-issue, however flagrant the abuse, appeared without a resort to theories which though familiar to equity jurisprudence were hitherto unknown to Patent Law, except as casual *dicta*, uttered in cases upon whose decision they had exercised no influence. Had the Supreme Court asserted its judicial power to re-examine the question of original inadvertence, etc., as it is now beginning to be recognized, and had it announced the doctrine that an original intention to abandon is indicated by a failure to correct the omission or misstatement as soon as it is brought home to the knowledge of the patentee, its decision would have reached the desired result without producing those evils which are engendered by uncertainties in legal rules and by supposed departures from settled principles of law.

Starting from these two theories, several propositions have been formulated by the courts, — some a direct application of the theories to the facts in controversy, and others evidently based on a misunderstanding of the theories themselves. Thus certain cases state that a re-issue to enlarge Claims after long delay is not permissible, making no mention of the further necessary condition that delay cannot begin until the patentee becomes aware of the defect or is put upon inquiry which would result in knowledge. Among these are Curran *v.* St. Louis Refrigerator & Wooden Gutter Co. (1886), 39 O. G. 590; Tubular Rivet Co. *v.* Copeland (1886), 26 Fed. Rep. 706; 34 O. G. 1277; White *v.* Dunbar (1886), 119 U. S. 47; 37 O. G. 1002; Asmus *v.* Alden (1886), 27

unless he has corrected the omission by a re-issue without un-

Fed. Rep. 684 ; 36 O. G. 231 ; Hubel v. Dick (1886), 28 Fed. Rep. 656 ; 24 Blatch. 139 ; 37 O. G. 1480 ; Phillips v. Risser (1885), 26 Fed. Rep. 308 ; Electric Gas Lighting Co. v. Smith & Rhodes Electric Co. (1885), 23 Fed. Rep. 195 ; 31 O. G. 702 ; Holt v. Kendall (1885), 26 Fed. Rep. 622 ; 35 O. G. 874 ; Arden v. Jewett (1885), 32 O. G. 1241 ; Mahn v. Harwood (1884), 112 U. S. 354 ; 30 O. G. 657 ; Simon v. Neumann (1884), 27 O. G. 918 ; 20 Fed. Rep. 196 ; Vacuum Oil Co. v. Buffalo Lubricating Oil Co. (1884), 22 Blatch. 266 ; 28 O. G. 1101 ; 20 Fed. Rep. 850 ; Flower v. Detroit (1884), 22 Fed. Rep. 292 ; Hayes v. Bickelhoupt (1884), 29 O. G. 368 ; 21 Fed. Rep. 566 ; Turner & Seymour Mfg. Co. v. Dover Stamping Co. (1884), 111 U. S. 319 ; 27 O. G. 1131 ; *Ex parte* Flynn (1883), 23 O. G. 2029 ; Combined Patents Can Co. v. Lloyd (1882), 21 O. G. 713 ; 11 Fed. Rep. 149 ; 15 Phila. 481 ; *Ex parte* Lee (1882), 23 O. G. 342 ; Jones v. Barker (1882), 22 O. G. 771 ; 11 Fed. Rep. 597 ; Sheriff v. Fulton (1882), 22 O. G. 87 ; 12 Fed. Rep. 136.

In some cases the existence of intervening rights, either alone or coupled with delay, is treated as a bar to a re-issue, still without mention of the state of the patentee's knowledge concerning the defect to be amended, as for example, Asmus v. Alden (1886), 27 Fed. Rep. 684 ; 36 O. G. 231 ; Hudnut v. Lafayette Hominy Mills (1886), 26 Fed. Rep. 636 ; 35 O. G. 1338 ; Newton v. Furst & Bradley Co. (1886), 119 U. S. 373 ; 38 O. G. 104 ; Baltimore Car Wheel Co. v. North Baltimore Passenger Ry. Co. (1884), 21 Fed. Rep. 47 ; Wooster v. Handy (1884), 22 Blatch. 307 ; 21 Fed. Rep. 51 ; 28 O. G. 629 ; Electric Gas Lighting Co. v. Tillotson (1884), 22 Blatch. 481 ; 21 Fed. Rep. 568 ; Flower v. Detroit (1884), 22 Fed. Rep. 292 ; Matthews v. Iron Clad Mfg. Co. (1884), 22 Blatch. 427 ; 21 Fed. Rep. 641 ; 29 O. G. 693 ; Turner & Seymour Mfg. Co. v. Dover Stamping Co. (1883), 111 U. S. 319 ; 27 O. G. 1131 ; Lansburgh v. Hasbrouck (1883), 21 Blatch. 325 ; 16 Fed. Rep. 566.

Another class of cases may be found in which the judgment of the court is based on the union of one or more of the foregoing propositions with others which would be alone decisive of the controversy. Thus while it is true that new matter can never be claimed in a re-issue, that a re-issue can never be allowed except to cure an unintentional error, that features not disclosed in the original can never be inserted in the re-issue, that an invention once intentionally excluded can never be reclaimed, that the delay of a re-issue for an unreasonable time after the defect was discovered is conclusive evidence of such intentional exclusion, and that any one of these conditions is a complete bar to the allowance or enforcement of a re-issued patent, these cases combine such conditions with each other as if their concurrence were necessary to deprive the patentee of his asserted rights. Among these are the following :

That a re-issue including new matter after unreasonable delay is void, see Clements v. Odorless Excavating Apparatus Co. (1884), 109 U. S. 641 ; 26 O. G. 353.

That a re-issue after unreasonable delay cannot claim a new use, thus covering a new mode of use, and a Claim whose novelty rests on such mode of use is invalid, see Gardner v. Herz (1886), 118 U. S. 180 ; 35 O. G. 999.

That a re-issue containing new matter is void after eight or nine years, unless the same matter is in some way claimed in the original, see Electric

reasonable delay.[2] The error in this case, if any, consists in a

Gas Lighting Co. *v.* Smith & Rhodes Electric Co. (1885), 31 O. G. 702 ; 23 Fed. Rep. 195.

That no re-issue can be granted in order to enlarge a Claim unless there is a clear mistake in the wording of the Claim through inadvertence, and no unreasonable delay in applying for a re-issue, see Western Union Tel. Co. *v.* Baltimore & Ohio Tel. Co. (1885), 25 Fed. Rep. 30 ; Mahn *v.* Harwood (1884), 112 U. S. 354 ; 30 O. G. 657.

That matter described and intentionally omitted from the Claim is abandoned and cannot be covered by a re-issue, as against the intervening rights of the public, see Railway Register Mfg. Co. *v.* Broadway & Seventh Ave. R. R. Co. (1886), 26 Fed. Rep. 522 ; 31 O. G. 921.

That a re-issue cannot claim, after fourteen years, an improvement not noticed in the original patent, though it was invented before the original, see Sickels *v.* Falls Co. (1861), 2 Fisher, 202 ; 4 Blatch. 508.

That a patent for mechanism cannot re-issue eleven years afterward to cover the process, as the inventions are different, see Scrivner *v.* Oakland Gas Co. (1884), 22 Fed. Rep. 98 ; 10 Sawyer, 390.

That where the original patent describes *inter alia* a part of a machine but states no use for it and makes no claim to it, a re-issue to cover it is invalid, at least after three years, see Reay *v.* Raynor (1884), 22 Blatch. 13 ; 26 O. G. 1111 ; 19 Fed. Rep. 308.

That where the original patent is limited to a specific device no enlargement of its Claims can be permitted by re-issue after nine years' delay, see Sheriff *v.* Fulton (1882), 22 O. G. 87 ; 12 Fed. Rep. 136.

Examples of a contrary character in which the independence of these conditions, and the sufficiency of each to prevent the allowance of a re-issue is asserted, may be found in the following : —

That diligence is of no consequence unless the re-issue is for the same invention as the original, see Ives *v.* Sargent (1887), 119 U. S. 652 ; 38 O. G. 781 ; Russell *v.* Laughlin (1886), 26 Fed. Rep. 699 ; 35 O. G. 1436 ; Coon *v.* Wilson (1885), 113 U. S. 268 ; 30 O. G. 889 ; Cowell *v.* Sessions (1883), 21 Blatch. 421 ; 17 Fed. Rep. 450.

That if the invention is not shown in the original patent there can be no re-issue at any time, see Hammond *v.* Franklin (1885), 23 Blatch. 77 ; 22 Fed. Rep. 833 ; 30 O. G. 1324.

In addition to the theories herein discussed there are several others which have from time to time found utterance from the bench in reference to this portion of the subject of re-issues. To notice each in detail would be needless. Most of them, if not all, are so far connected with those heretofore considered that it will require little acumen to detect their errors, and little deliberation to correct them. Understanding that no harmony is to be expected between unsound doctrines, and that the only true doctrine is that which fits all cases and distributes justice to all parties, the reader may compare the citations now to follow with each other and with the text, without danger of being misled by epigrammatic *dicta*, or by hastily conceived hypotheses.

[2] This proposition, be it remembered, is fully true only of cases in which clearly described matter is wholly omitted from the Claims. It is partially true in many cases where the matter has been misstated in the Claims. In those cases of misstatement where the Claim is open to several constructions, some of which would include and others

direct repugnance between the two parts of his specification,

exclude the matter in question, it is, however, false; for here only judicial interpretation can finally determine the real scope of the Claim. Hence the ordinary treatment of omissions and misstatements, as if all stood on equal ground and were to be governed by the *same rule*, is not correct. To enlarge a Claim by inserting matter which it never before contained or appeared to contain is one thing; to enlarge it by amending a misstatement is quite another. The extracts which follow do not, unfortunately, preserve this distinction, but the mere suggestion that it exists will be sufficient to guard the reader against extending the doctrine of these cases beyond its proper scope, whatever language the judges have seen fit to employ.

In Wollensak *v.* Reiher (1885), 115 U. S. 96, Matthews, J.: (99) "It follows from this that if at the date of the issue of the original patent, the patentee had been conscious of the nature and extent of his invention, an inspection of the patent, when issued, and an examination of its terms, made with that reasonable degree of care which is habitual to and expected of men in the management of their own interests in the ordinary affairs of life, would have immediately informed him that the patent had failed fully to cover the area of his invention. And this must be deemed to be notice to him of the fact, for the law imputes knowledge when opportunity and interest, combined with reasonable care, would necessarily impart it. Not to improve such opportunity under the stimulus of self-interest, with reasonable diligence, constitutes laches, which in equity disables the party who seeks to revive a right which he has allowed to lie unclaimed from enforcing it to the detriment of those who have, in consequence, been led to act as though it were abandoned. This general doctrine of equity was applied with great distinctness to the correction of alleged mistakes in patents by re-issues in the case of Miller *v.* Brass Company, 104 U. S. 350. It was there declared that where the mistake suggested was merely that the Claim was not as broad as it might have been, it was apparent upon the first inspection of the patent, and, if any correction was desired, it should have been applied for immediately; that the granting of a re-issue for such a purpose, after an unreasonable delay, is clearly an abuse of the power to grant re-issues, and may justly be declared illegal and void; that, in reference to re-issues made for the purpose of enlarging the scope of the patent, the rule of laches should be strictly applied, and no one should be relieved who has slept upon his rights, and has thus led the public to rely on the implied disclaimer involved in the terms of the original patent; and that when this is a matter apparent on the face of the instrument, upon a mere comparison of the original patent with the re-issue, it is competent for the courts to decide whether the delay was unreasonable and whether the re-issue was, therefore, contrary to law and void." 31 O. G. 1301 (1302). *Quere*, whether Miller *v.* Brass Co. *does* declare that "where the mistake suggested was merely that the Claim was not as broad as it might have been, it was apparent upon the first inspection of the patent?" The author does not so understand the language of Mr. Justice Bradley in that decision. In one part of the opinion he states that in the case at bar the defect was apparent on the first inspection of the patent; and in another portion lays down the general rule that "when, if a Claim is too narrow, — that is, if it does not contain all that the patentee is entitled

and though it might occur through inadvertence, accident, or

to — the defect is apparent on the face of the patent, . . . there can be no valid excuse for delay," etc. But this latter assertion is very far from a declaration that "when Claims are too narrow the *defect is* apparent on the face of the patent." The construction put by Wollensak *v.* Reiher on this language has sometimes been turned into the rule that when Claims are too narrow the patentee is chargeable with notice of that fact the moment the patent issues, — a rule pregnant with mischief and manifestly contrary to reason and justice. See also Hoskin *v.* Fisher (1888), 125 U. S. 217 ; 43 O. G. 509.

In Wollensak *v.* Reiher (1884), 22 Fed. Rep. 651, Gresham, J. : (652) "When an inventor receives his patent, it is his duty to examine it promptly, see that his invention is properly described, and that his Claims are broad enough to embrace it in all its scope. If, upon a more reading of his patent, it is obvious that he is entitled to a reissue with broader and more comprehensive Claims, he must make his application speedily. Failure to do this is a dedication to the public of so much of his invention as is not covered by his Claim. The rule of laches is strictly applied in such cases."

In Mahn *v.* Harwood (1884), 112 U. S. 354, Bradley, J. : (360) "The taking out of a patent which has (as the law requires it to have) a specific Claim, is notice to all the world, of the most public and solemn kind, that all those parts of the art, machine, or manufacture set out and described in the specification and not embraced in such specific Claim, are not claimed by the patentee, — at least not claimed in and by that patent. If he has a distinct patent for other parts, or has made application therefor, or has reserved the right to make such application, that is another matter, not affecting the patent in question. But so far as that patent is concerned, the Claim actually made operates in law as a disclaimer of what is not claimed ; and of all this the law charges the patentee with the fullest notice. Then, what is the situation ? The public is notified and and informed, by the most solemn act on the part of the patentee, that his Claim to invention is for such and such an element or combination, and for nothing more. Of course what is not claimed is public property. The presumption is, and such is generally the fact, that what is not claimed was not invented by the patentee, but was known and used before he made his invention. But, whether so or not, his own act has made it public property if it was not so before. The patent itself, as soon as it is issued, is the evidence of this. The public has the undoubted right to use, and it is to be presumed does use, what is not specifically claimed in the patent. Every day that passes after the issue of the patent adds to the strength of this right, and increases the barrier against subsequent expansion of the claim by re-issue under a pretence of inadvertence and mistake." 30 O. G. 657 (659).

In Miller *v.* Brass Co. (1881), 104 U. S. 350, Bradley, J. : (352) "But it must be remembered that the Claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent are, in law, a dedication to the public of that which is not claimed. It is a declaration that that which is not claimed is either not the patentee's invention, or, if his, he dedicates it to the public. This legal effect of the patent cannot be revoked unless the patentee surrenders it and proves that the specification was framed by real inadvertence, accident, or mistake,

mistake, it could not fail to become apparent on inspection

without any fraudulent or deceptive intention on his part; and this should be done with all due diligence and speed. Any unnecessary laches or delay in a matter thus apparent on the record affects the right to alter or re-issue the patent for such cause. If two years' public enjoyment of an invention with the consent and allowance of the inventor is evidence of abandonment, and a bar to an application for a patent, a public disclaimer in the patent itself should be construed equally favorable to the public. Nothing but a clear mistake or inadvertence, and a speedy application for its correction, is admissible when it is sought merely to enlarge the Claim." 21 O. G. 201 (202).

In Giant Powder Co. *v.* California Vigorit Powder Co. (1880), 18 O. G. 1339, Field, J.: (1340) "The statute authorizing a re-issue was intended to protect against accidents and mistakes, and it is only when thus restricted that it can be regarded as a beneficial statute. If a patentee does not embrace by his specifications and Claim all that he might have done, and there has been no clear mistake, inadvertence, or accident in their preparation, the presumption of law is that he has abandoned to the use of the public everything outside of them, or at least has postponed any additional Claim for further consideration." 6 Sawyer, 508 (522); 4 Fed. Rep. 720 (725).

Further, that no re-issue can be allowed to claim matter clearly described in the original patent but evidently omitted from its Claims, unless the re-issue is applied for within a reasonable time after the grant of the original, see Ives *v.* Sargent (1887), 119 U. S. 652; 38 O. G. 781; Gage *v.* Kellogg (1885), 23 Fed. Rep. 891; 32 O. G. 381; Reed *v.* Chase (1885), 25 Fed. Rep. 94; 33 O. G. 996; Wooster *v.* Handy (1884), 22 Blatch. 307; 21 Fed. Rep. 51; 28 O. G. 629; Scrivner *v.* Oakland Gas Co. (1884), 22 Fed. Rep. 98; 10 Sawyer, 300; Ives *v.* Sargent (1883), 17 Fed. Rep. 447; 21 Blatch. 417; Combined Patents Can Co. *v.* Lloyd (1882), 11 Fed. Rep. 140; 21 O. G. 713; 15 Phila. 481; Streit *v.* Lauter (1882), 11 Fed. Rep. 309; Holt *v.* Keeler (1882), 22 O. G. 1201; 13 Fed. Rep. 464; 21 Blatch. 68; Hayes *v.* Seton (1882), 20 Blatch. 484; 12 Fed. Rep. 120.

That an omission to claim matter evidently belonging to the invention is abandonment, unless the patent is amended by re-issue without delay, see Hill *v.* Commissioner (1885), 4 Mackey, 266; 33 O. G. 757; *Ex parte* Conklin (1874), 5 O. G. 235; 1 MacArthur, 375.

That unnecessary delay in re-issuing is acquiescence in the patent as allowed, and an abandonment of the rest of the invention, see *Ex parte* Flynn (1883), 23 O. G. 2029; Hayes *v.* Seton (1882), 20 Blatch. 484; 12 Fed. Rep. 120.

That delay in re-issuing shows original abandonment, see Tuttle *v.* Loomis (1885), 24 Fed. Rep. 789; 30 O. G. 344.

That any long delay in applying for a re-issue raises a presumption against "mistake and inadvertence," see Newton *v.* Furst & Bradley Mfg. Co. (1882), 14 Fed. Rep. 465; 11 Bissell, 405.

That the greater the discrepancy the shorter should be the time, see Mahn *v.* Harwood (1884), 112 U. S. 354; 30 O. G. 657.

That where a combination-patent fails to claim a sub-combination, the error is an evident one, and the right to the protection of the sub-combination will be abandoned by delay, see Gage *v.* Herring (1883), 107 U. S. 640; 23 O. G. 2119; Bantz *v.* Frantz (1882), 105 U. S. 160; 21 O. G. 2037.

That a re-issue cannot cover a process

of the patent, if examined by the patentee with ordinary care.[8]

after nine years' use of the devices claimed in the original, when the process consists in the use of such devices, see Brainard *v.* Cramme (1882), 22 O. G. 709; 12 Fed. Rep. 621; 20 Blatch. 530.

That the presumption of intentional exclusion from a failure to claim clearly described matter is *prima facie* only, until an unreasonable delay in amending the patent renders such presumption conclusive, appears from the following decisions: —

That a thing not claimed in the original patent is not thereby abandoned *ipso facto* to the public, and may be claimed in a re-issue, see Selden *v.* Stockwell Self-Lighting Gas Burner Co. (1881), 19 Blatch. 544; 20 O. G. 1377; 9 Fed. Rep. 390.

That there is no conclusive presumption, from the absence of Claims from the original covering the matters claimed in the re-issue, that the inventor did not intend to claim them in the original, see Eickmeyer Hat Blocking Mach. Co. *v.* Pearce (1873), 6 Fisher, 219; 3 O. G. 150; 10 Blatch. 403.

That things described but not claimed in the original patent are not thereby abandoned and may be claimed in the re-issue, though they have gone into use, see *Ex parte* Conklin (1872), 2 O. G. 541.

[8] In Miller *v.* Brass Co. (1881), 104 U. S. 350, Bradley, J.: (351) "It is manifest on the face of the patent, when compared with the original, that the suggestion of inadvertence and mistake in the specification was a mere pretence; or if not a pretence, the mistake was so obvious as to be instantly discernible on opening the letters-patent, and the right to have it corrected was abandoned and lost by unreasonable delay. The only mistake suggested is, that the Claim was not as broad as it might have been. This mistake, if it was a mistake, was apparent upon the first inspection of the patent, and if any correction was desired, it should have been applied for immediately." 21 O. G. 201 (201).

That if the inventor clearly perceives the nature of his invention he ought to be able to see whether his Claims protect it, see Wollensak *v.* Reiher (1885), 115 U. S. 96; 31 O. G. 1301. This seems to assume that if an idea is clearly perceived by the mind it can always be so expressed in words as to infallibly present to other minds precisely the same idea, — which is not true, especially in reference to conceptions in science and art. An inventor may believe that his Claims exactly cover his invention, but it does not follow that the judicial mind will arrive at the same conclusion.

That a delay in re-issuing to enlarge Claims is unreasonable if more time is taken than is needed to read the Claims and ascertain the necessity for their correction, see Hartshorn *v.* Eagle Shade Roller Co. (1883), 18 Fed. Rep. 90; 25 O. G. 1191.

That a patentee must examine his patent to see if it covers his invention, and three years' delay in so doing is unreasonable, and a re-issue then is invalid, if the defect is clear, see Ives *v.* Sargent (1886), 119 U. S. 652; 38 O. G. 781.

That where the omission to claim described matter is clear to intelligent persons, but the patentee and assignee were ignorant of it for want of using their means of knowledge, they are chargeable with laches, and if there is any delay in the re-issue, their right is forfeited, see Ives *v.* Sargent (1883), 21 Blatch. 417; 17 Fed. Rep. 447.

That a patentee is chargeable with notice of what the patent contains and is held to reasonable diligence, see Western Union Tel. Co. *v.* Baltimore & Ohio Tel. Co. (1885), 25 Fed. Rep. 30.

That ignorance of law is no excuse

The matter omitted from the Claims being so described in the specification as to place it fully before the public, they have a right to presume that the inventor intended to abandon it altogether, or to withhold it as the subject of a future patent. Under the law, as it existed before re-issues were allowed, such an omission would have operated as an irrevocable dedication of the unclaimed matter to the public, the original patent being unamendable, and the law permitting no new patent for an invention already publicly disclosed. Under the present law, however, these presumptions may be rebutted either by an application for a new patent for the omitted matter before two years of public use or sale have elapsed, or by a timely re-issue of the original patent. In the first case, the new application is independent of the former patent, and must be granted or denied on its own merits. In the second case, the re-issue is invalid when the duration of the period of delay is inconsistent with the idea of an original inadvertence, accident, or mistake.[4] Upon this question of

for delay in a re-issue, see Haines *v.* Peck (1886), 26 Fed. Rep. 625; 35 O. G. 1227.

That a want of knowledge of the language is considered on the question of delay, see Stutz *v.* Armstrong (1884), 28 O. G. 367; 20 Fed. Rep. 843; *contra*, Boland *v.* Thompson (1886), 23 Blatch. 440; 26 Fed. Rep. 633; 35 O. G. 1113.

[4] In Miller *v.* Brass Co. (1881), 104 U. S. 350, Bradley, J.: (355) "Now whilst, as before stated, we do not deny that a Claim may be enlarged in a re-issued patent, we are of opinion that this can only be done when an actual mistake has occurred; not from a mere error of judgment (for that may be rectified by appeal), but a real *bona fide* mistake, inadvertently committed; such as a court of chancery, in cases within its ordinary jurisdiction, would correct. Re-issues for the enlargement of Claims should be the exception and not the rule. And when, if a Claim is too narrow, — that is, if it does not contain all that the patentee is entitled to, — the defect is apparent on the face of the patent, and can be discovered as soon as that document is taken out of its envelope and opened, there can be no valid excuse for delay in asking to have it corrected. Every independent inventor, every mechanic, every citizen, is affected by such delay, and by the issue of a new patent with a broader and more comprehensive Claim. The granting of a re-issue for such a purpose, after an unreasonable delay, is clearly an abuse of the power to grant re-issues, and may justly be declared illegal and void. It will not do for the patentee to wait until other inventors have produced new forms of improvement, and then, with the new light thus acquired, under pretence of inadvertence and mistake, apply for such an enlargement of his Claim as to make it embrace these new forms. Such a process of expansion carried on indefinitely, without regard to lapse of time, would operate most unjustly against the public, and is totally unauthorized by

delay the courts or the Patent Office must decide in view of all the circumstances of the case itself. No unbending rule can be established limiting the time when such amendments must be made.[5] Analogy seems to require that no

the law. In such a case, even he who has rights, and sleeps upon them, justly loses them. The correction of a patent by means of a re-issue, where it is invalid or inoperative for want of a full and clear description of the invention, cannot be attended with such injurious results as follow from the enlargement of the Claim. And hence a re-issue may be proper in such cases, though a longer period has elapsed since the issue of the original patent. But in reference to re-issues made for the purpose of enlarging the scope of the patent, the rule of laches should be strictly applied; and no one should be relieved who has slept upon his rights, and has thus led the public to rely on the implied disclaimer involved in the terms of the original patent. And when this is a matter apparent on the face of the instrument, upon a mere comparison of the original patent with the re-issue, it is competent for the courts to decide whether the delay was unreasonable, and whether the re-issue was therefore contrary to law and void." 21 O. G. 201 (203).

See also Hartshorn *v.* Eagle Shade Roller Co. (1883), 25 O. G. 1191; 18 Fed. Rep. 90.

[5] In Mahn *v.* Harwood (1884), 112 U. S. 354, Bradley, J.: (363) "As we have already stated, no invariable rule can be laid down as to what is reasonable time within which the patentee should seek for the correction of a Claim which he considers too narrow. In Miller *v.* The Brass Company, by analogy to the law of public use before an application for a patent, we suggested that a delay of two years in applying for such correction should be construed equally favorable to the public. But this was a mere suggestion by the way, and was not intended to lay down any general rule. Nevertheless, the analogy is an apposite one, and we think that excuse for any longer delay than that should be made manifest by the special circumstances of the case." 30 O. G. 657 (659).

In Stutz *v.* Armstrong (1884), 20 Fed. Rep. 843, Acheson, J.: (845) "The Supreme Court has laid down no unbending rule by which to determine what is unreasonable delay in applying for the correction of such a mistake as existed here; and it seems to me that each case must be decided upon its special facts and merits. The application here was within two years after the grant of the original letters-patent; the exact lapse of time being one year, ten months, and eight days. Now, while this fact may not be conclusive, it would seem to be entitled to some consideration, in view of that provision of the Patent Laws by which nothing less than two full years' public use of an invention is a bar to an application for a patent. In Miller *v.* Brass Co., the fact that much more than two years had elapsed between the grant of the original letters-patent and the application for the re-issue was evidently in the mind of Mr. Justice Bradley, and suggested the illustration employed by him on page 352 of the reported case. And in all the like cases in which the Supreme Court has ruled against the validity of the re-issue (so far as I know), the lapse of time has been greatly in excess of two years." 28 O. G. 367 (368).

That no fixed rule determines reasonable time see Odell *v.* Stout (1884), 22 Fed. Rep. 159; 29 O. G. 862.

That reasonable time depends on cir-

longer period should be allowed than that within which a new patent might be issued, and that after two years of public use and sale of the omitted matter its abandonment should be conclusively presumed. But in many instances even this period cannot be properly allowed.[6] Where the practical importance and commercial value of the omitted matter is evident from the beginning, and where the inventor, therefore, must have known that in its original form the patent did not give him the complete protection which he needed to render all the fruits of his inventive skill available to him, any avoidable delay in the correction of the error is irreconcilable with the hypothesis that the omitted matter was unintentionally excluded. And on the other hand, where the unclaimed invention was not recognized as of material consequence until it had been tested by experience, or where no probability of adverse claims existed, or where the inventor might reasonably have supposed that his original patent would secure to him all that was really valuable in his invention, a delay of some duration is not incompatible with the idea of accident, inadvertence, or mistake in the original omission.[7] As in all

cumstances, see Western Union Tel. Co. *v.* Baltimore & Ohio Tel. Co. (1885), 25 Fed. Rep. 30.

[6] That two years is the usual limit for delay, see *Ex parte* Flynn (1883), 23 O. G. 2029.

That two years is in some cases a reasonable time, but not always, see Mahn *v.* Harwood (1884), 112 U. S. 354 ; 30 O. G. 657.

That an excuse for a delay longer than two years must be clearly shown, see Ives *v.* Sargent (1887), 119 U. S. 652 ; 38 O. G. 781.

That where the Claim of the original is clear and its scope plain, nine years' delay is unreasonable, see Shirley *v.* Mayer (1885), 23 Blatch. 249 ; 25 Fed. Rep. 38 ; 34 O. G. 1391.

That where the error, if any, is apparent and the articles claimed in the re-issue have gone into market, twenty-two months is too long a delay, see Arnheim *v.* Finster (1886), 26 Fed. Rep. 277 ; 34 O. G. 700.

That a delay of three months in applying for a re-issue is unreasonable when the defect is clear and other claimants intervene, if the only object is to enlarge the original Claims, see Coon *v.* Wilson (1885), 113 U. S. 268 ; 30 O. G. 889.

That a re-issue enlarging Claims within three months is in time, if no rights of others intervene, see Hammond *v.* Franklin (1885), 23 Blatch. 77 ; 22 Fed. Rep. 833 ; 30 O. G. 1324.

That a re-issue in two months is not laches, see Russell *v.* Laughlin (1886), 26 Fed. Rep. 699 ; 35 O. G. 1436.

That a few months' delay is of no consequence, see Dryfoos *v.* Wiese (1884), 22 Blatch. 19 ; 26 O. G. 639 ; 19 Fed. Rep. 315.

[7] That the question of adverse intervening rights is usually embraced in

other cases where the questions of due diligence or reasonable time are involved, the conduct of the inventor is subject to the interpretation of the courts, and he must abide by their decision whatever may have been his own views as to the reasonableness of his delay.[8] His delay having been judicially determined to be unreasonable, the inference that he originally intended to exclude the omitted matter from his patent becomes inevitable, and the re-issue cannot be sustained.

that of delay, see Stutz *v.* Armstrong (1884), 28 O. G. 367; 20 Fed. Rep. 843.

That the question whether adverse rights have arisen since the original patent was granted is always important on a re-issue, in reference to the claim of abandonment, see Stutz *v.* Armstrong (1884), 20 Fed. Rep. 843; 28 O. G. 367; Brainard *v.* Cramme (1882), 12 Fed. Rep. 621; 22 O. G. 769; 20 Blatch. 530.

That a patent for a combination issued in 1860, not claiming the sub-combinations, and re-issued in 1876 to cover them after the sub-combinations had been in use by others more than two years, is void for delay, see Turrell *v.* Bradford (1883), 21 Blatch. 284; 23 O. G. 1623; 15 Fed. Rep. 808.

That if sub-combinations are described in the original they may be claimed in the re-issue where there is no unnecessary delay and no injury to intervening rights, see Hubel *v.* Dick (1886), 28 Fed. Rep. 132; 36 O. G. 939; 24 Blatch. 59.

That where delays work an equitable estoppel it is in favor of the public, see Consolidated Fruit Jar Co. *v.* Bellaire Stamping Co. (1886), 27 Fed. Rep. 377; 35 O. G. 627.

That an unavoidable delay in applying for a re-issue does not work an abandonment, see Hartshorn *v.* Eagle Shade Roller Co. (1883), 18 Fed. Rep. 90; 25 O. G. 1191.

[8] In Mahn *v.* Harwood (1884), 112 U. S. 354, Bradley, J.: (360) "Conceding that it is for the Commissioner of Patents to determine whether the insertion of too narrow a Claim arose from inadvertence, accident, or mistake (unless where the matter is manifest from the record), the question whether the application for correction and re-issue is or is not made within reasonable time is, in most if not all of such cases, a question which the court can determine as a question of law, by comparing the patent itself with the original patent, and, if necessary, with the record of its inception. The reason for this was fully explained in the case of Miller *v.* The Brass Company." 30 O. G. 657 (659).

See also Western Union Tel. Co. *v.* Baltimore & Ohio Tel. Co. (1885), 25 Fed. Rep. 30; Wooster *v.* Handy (1884), 28 O. G. 629; 22 Blatch. 307; 21 Fed. Rep. 51; Miller *v.* Brass Co. (1882), 104 U. S. 350; 21 O. G. 201.

That an apparently unreasonable delay in applying for a re-issue renders it invalid, unless the patentee explains the delay by proper evidence, see Hoskin *v.* Fisher (1888), 125 U. S. 217; 43 O. G. 509.

§ 691. Intentional Exclusion not Shown by Failure to Claim Matter not Clearly Described in the Original Patent unless the Defects are Brought to the Knowledge of the Patentee, and he thereafter Unreasonably Delays their Amendment.

An omission from the Claims of the original patent of some feature of the invention, or of some subordinate or dependent invention, which is simply indicated or suggested but not clearly described in the original specification, or a defective statement in the Claims of the original which is consistent with an intention to protect the subject-matter claimed in the re-issue, raises no presumption of intentional exclusion. Such a misstatement or omission is not evident to the inventor upon a mere inspection of the patent, nor does the description so disclose the omitted matter to the public as to warrant any supposition that he has dedicated it to public use. Not until circumstances occur by which his attention is directed to the error, and he becomes aware that his entire invention is not covered by his patent, is he chargeable with negligence in the assertion of his rights.[1] But whenever and by whatever means this knowledge is communicated to him, his obligation to amend his Claims, and so far as necessary his description also, at once arises, and his failure to do this within a reasonable time is sufficient evidence that the original omission did

§ 691. [1] In Tuttle *v.* Loomis (1885), 24 Fed. Rep. 789, Wallace, J.: (789) "Whether he described in his original patent just the invention he supposed he had made, or whether his invention was really a broader one than he himself supposed it to be, when it became apparent that the real invention was unduly restricted and narrowed by the description, he was entitled to a re-issue if the error arose from inadvertence, accident, or mistake." 30 O. G. 344 (345).

That a mistake not discoverable till after several years may then be corrected, see Hartshorn *v.* Eagle Shade Roller Co. (1883), 18 Fed. Rep. 90; 25 O. G. 1191; Poppenhusen *v.* Falke (1862), 5 Blatch. 46; 2 Fisher, 213.

That a re-issue cannot expand a Claim after eight years except in very peculiar circumstances, see Tuttle *v.* Loomis (1885), 24 Fed. Rep. 789; 30 O. G. 344.

That a patentee is always presumed to know what, if vigilant, he could have known, see Arnheim *v.* Finster (1886), 26 Fed. Rep. 277; 34 O. G. 700; Ives *v.* Sargent (1883), 17 Fed. Rep. 447; 21 Blatch. 417.

That to move with alacrity after he discovers the defect does not satisfy the rule, if by due diligence it might have been known earlier, see Ives *v.* Sargent (1883), 21 Blatch. 417; 17 Fed. Rep. 447.

not result from any inadvertence, accident, or mistake.[2] Thus where the omitted matter has actually gone into public use,[3] or where another inventor has applied for and obtained a patent which distinctly claims it,[4] or where the courts interpreting his patent have decided that it does not embrace this feature or subordinate invention,[5] the inventor may be presumed to

[2] That upon the discovery of the defect the patentee must act with reasonable diligence or a re-issue cannot be allowed, see Pope Mfg. Co. *v.* Marqua (1883), 15 Fed. Rep. 400; Turrell *v.* Bradford (1883), 15 Fed. Rep. 808; 23 O. G. 1623; 21 Blatch. 284; Washburn & Moen Mfg. Co. *v.* Fuchs (1883), 5 McCrary, 236; 16 Fed. Rep. 661; Steam Gauge & Lantern Co. *v.* Miller (1882), 11 Fed. Rep. 718; Matthews *v.* Boston Mach. Co. (1882), 105 U. S. 54; 21 O. G. 1349; Sheriff *v.* Fulton (1882), 12 Fed. Rep. 136; 22 O. G. 87; Bantz *v.* Frantz (1881), 105 U. S. 160; 21 O. G. 2037; Johnson *v.* R. R. Co. (1881), 105 U. S. 539; 22 O. G. 329; Miller *v.* Brass Co. (1881), 104 U. S. 350; 21 O. G. 201; *In re* Conklin (1874), 5 O. G. 235; 1 MacArthur, 375; Knight *v.* Baltimore & Ohio R. R. Co. (1840), 3 Fisher, 1; Taney, 106.

[3] That where matters have been described but not claimed in the original patent, and have gone into use by others, they cannot be claimed in a re-issue after unreasonable delay, see Wooster *v.* Handy (1884), 28 O. G. 629; 22 Blatch. 307; 21 Fed. Rep. 51; Brainard *v.* Cramme (1882), 12 Fed. Rep. 621; 20 Blatch. 530; 22 O. G. 769.

That where an invention has been in use for fifteen years, an original patent cannot be re-issued to cover it, even in favor of the real inventor, but it must be regarded as abandoned, see Johnson *v.* R. R. Co. (1882), 105 U. S. 539; 22 O. G. 329.

That the use of the "new matter," before the original application was filed, shows that its omission from the application was intentional and was abandonment, see *In re* Conklin (1874), 1 MacArthur, 375; 5 O. G. 235.

That the mode in which the discovery of a mistake in the original was made does not affect the re-issue, see Poppenhusen *v.* Falke (1861), 4 Blatch. 493; 2 Fisher, 181.

[4] That a re-issue to enlarge Claims, and embrace a new invention which has been patented since the original patent, is not allowable after unreasonable delay, see Torrent Arms Lumber Co. *v.* Rodgers (1884), 112 U. S. 659; 30 O. G. 449.

[5] In Poppenhusen *v.* Falke (1862), 5 Blatch. 46, Shipman, J.: (53) "It not unfrequently happens that a judicial interpretation of the specification or Claim of a patent, or of both, discloses to the inventor and patentee, for the first time, the defects in the instrument, and shows him that he has unwittingly restricted his rights within narrower limits than his discovery, or has so inartificially described his invention that he has failed to secure any substantial advantage by it. Such a disclosure furnishes a proper occasion for a surrender and re-issue, when the error was inadvertent, and is clearly within the beneficent design of the statute. The judicial mind gives a legal construction to the language of the instrument, and this construction may reveal the fact that the terms used failed to cover the invention. To hold that the inventor should not be allowed to re-state his Claims by the use of new terms, would defeat the object of

have sufficient notice of the defect to make his continued acquiescence in it a conclusive admission that his patent, in its original condition, truly represented and covered the entire invention which he undertook to claim. Concerning the period within which the amendment must be made after such notice can be fairly imputed to the inventor, there is no other rule than that of reasonable time, to be determined by the courts from all the circumstances of the case. Any avoidable delay may prevent him from obtaining a re-issue, not by forfeiting a privilege once possessed, but by proving such an original intentional exclusion that the right to a re-issue could never have existed.[6]

§ 692. Intentional Exclusion not Shown by Mere Delay Alone in the Amendment.

An intention to exclude from the original patent the patentable matter suggested in its description but omitted from its Claims is never inferred from mere delay alone. The

the law, and abridge or strangle the inventor's rights, by reason of the imperfect language in which he had attempted to clothe his discovery." 2 Fisher, 213 (220).

[6] In Mahn *v.* Harwood (1884), 112 U. S. 354, Bradley, J. : (361) "If any such inadvertence or mistake has really occurred, it is generally easily discernible by an inspection of the patent itself ; and any unreasonable delay in applying to have it corrected by a surrender and re-issue is a just bar to such correction. If the specification is complicated and the Claim is ambiguous or involved, the patentee may be entitled to greater indulgence ; and of this the court can rightfully judge in each case. No precise limit of time can be fixed and laid down for all cases. The courts will always exercise a proper liberality in favor of the patentee. But in any case, by such delay as the court may deem unnecessary and unreasonable, the right to a re-issue will be regarded as having been abandoned and lost, and the Commissioner will be held to have exceeded his authority in granting it. Whenever it is manifest from the patent itself, compared with the original patent and cognate documents of record, or from the facts developed in the case, that the Commissioner must have disregarded the rules of law by which his authority to grant a re-issue in such cases is governed, the patent will be considered as void to the extent of such illegality. It is then a question of law, not a question of fact." 30 O. G. 657 (659).

That delay in a re-issue may be explained, see Wollensak *v.* Reiher (1885), 115 U. S. 96 ; 31 O. G. 1301 ; Singer Mfg. Co. *v.* Goodrich (1883), 15 Fed. Rep. 455.

That the courts will not assume, without proof, that a re-issue after fourteen years' delay enlarges the original or was sought for that purpose, see Clark *v.* Wooster (1886), 119 U. S. 322 ; 37 O. G. 1477.

lapse of time, unaccompanied by circumstances from which a purpose to omit what might have been claimed is presumed, cannot affect the right of the inventor to a re-issue of his patent, and to the correction of any error in the description or the Claim that may be necessary to secure the invention which he attempted to protect by his original patent.[1] The amendment of defects occurring through accident, mistake, or inadvertence, and without fraud, may therefore be made at any time when the error is discovered or the amendment may become desirable, provided the amendment does not introduce into the patent any invention not substantially indicated by the original specification.[2] A patent may thus be

§ 692. [1] In Hussey *v.* Bradley (1863), 2 Fisher, 362, Hall, J. : (378) "We cannot say, as matter of law, that these re-issues were too late, nor is there any proof of fraud or laches upon which we can, on that ground, declare these re-issued patents void. A re-issue has been upheld when the surrender was made more than sixteen years after the first patent was issued (Gibson *v.* Harris, 1 Blatch. 167), and it was there said that a patent which had been extended to twenty-one years under the general law, and afterward extended to twenty-eight years by special act of Congress, might be surrendered and re-issued after the term of twenty-one years had expired. And see Woodworth *v.* Edwards, 3 W. & M. 120 ; French *v.* Rogers, and Goodyear *v.* Day, Secs. 27–32, Law's Digest, 614, 615 (vol. i. p. 133). The fact that a portion of these inventions was not claimed in the original patent we have already shown does not defeat the present claims of the patentee, and that even a disclaimer in the original patent of an invention claimed in a re-issued one is not, without other proof, enough to avoid the re-issued patent. *Ex parte* Hayden, and Laidly *v.* James. It is true that in the case of Batten *v.* Taggert, 2 Wall. Jr. 102, Judge Kane decided that if a patentee neglects in his specification to assert his invention as to a certain part, omits to claim specifically such part, and suffers his patent so to stand for a number of years, he cannot afterward surrender his patent and take a re-issue claiming such part, as the use under the former patent, without any claim, will be a dedication to the public ; but this decision was overruled by the Supreme Court of the United States in the same case, 17 How. 85, and the cases to which we have already referred are, we think sufficient to show that we cannot, after the action of the Commissioner of Patents in respect to these patents, and without other proof, hold that there has been any abandonment or dedication to the public of the inventions claimed in these re-issued patents." 5 Blatch. 134 (148).

[2] That a re-issue after a delay of thirteen years is not too late, if the original was defective through a mistake and the re-issue was necessary to cure it, see Newton *v.* Furst & Bradley Mfg. Co. (1882), 11 Bissell, 405 ; 14 Fed. Rep. 465.

That no part of the invention originally described becomes dedicated to the public by lapse of time, but may be always claimed in a re-issue, see Battin *v.* Taggert (1854), 17 How. 74.

re-issued either during its original term, or during an extension regularly allowed by the Patent Office, or during an additional extension granted by a special act of Congress.[3]

§ 693. Fourth Proposition: Amendment by Re-issue, when Allowable, may be Made in Any Form and to Any Extent Necessary to Secure the Actual Invention.

The fourth proposition, -- that when an amendment by re-issue is allowable it can be made in any form and to any extent that may be necessary to render the patent effective for the original invention, — is evident from the nature and object of the amendment itself. The former patent being invalid and affording no protection, or being inoperative and affording less protection than the inventor had a right to claim, the re-issued patent is substituted for it in order that a patent, valid and operative for the entire invention attempted to be covered by the original patent, may exist in favor of the inventor.[1] Whatever is required for the attainment of this object may, therefore, be performed by the re-issue. Not only may the language of the specification be indefinitely varied, but new Claims may be added, or the old may be divided and restated, within any limits not embracing patentable matter which is absent from the original description.[2] If one re-

[3] That an extended patent can be re-issued, see *Ex parte* Sexton (1876), 9 O. G. 251 ; Wilson *v.* Rousseau (1846), 4 How. 646; 2 Robb, 372.

That a patent granted or extended under a special act may be re-issued like an ordinary patent, see Page *v.* Holmes Burglar Alarm Telegraph Co. (1880), 17 O. G. 737 ; 17 Blatch. 484 ; 1 Fed. Rep. 304 ; 5 Bann. & A. 165 ; Hussey *v.* Bradley (1863), 2 Fisher, 362 ; 5 Blatch. 134 ; Gibson *v.* Harris (1846), 1 Blatch. 167.

§ 693. [1] That if the first patent is defective a good one may be obtained, see Treadwell *v.* Bladen (1827), 4 Wash. 703 ; 1 Robb, 531.

[2] That it is the office of a re-issue to make a defective specification clear and a defective Claim sufficient, see Russell *v.* Dodge (1876), 93 U. S. 460 ; 11 O. G. 151 ; Aultman *v.* Holley (1873), 6 Fisher, 534 ; 11 Blatch. 317 ; 5 O. G. 3 ; Sarven *v.* Hall (1872), 5 Fisher, 415 ; 9 Blatch. 524 ; 1 O. G. 437.

That a re-issue may contain new Claims based on the old specification, if such Claims were omitted by mistake, and if the patentee has not been estopped to amend, see Combined Patents Can Co. *v.* Lloyd (1882), 21 O. G. 713 ; 11 Fed. Rep. 149 ; 15 Phila. 481 ; Swift *v.* Whisen (1867), 2 Bond, 115 ; 3 Fisher, 343.

That the Claims may be enlarged in a re-issue if the invention is the same, see Jones *v.* Barker (1882), 11 Fed. Rep. 597 : 22 O. G. 771 ; Sharp *v* Tifft (1880), 17 O. G. 1282 ; 2 Fed. Rep. 697 ; 18 Blatch. 132 ; 5 Bann. & A.

issue fails to accomplish the desired result another may be granted, and thus successive efforts at amendment may be made until the patent meets in all respects the purpose it was first intended to fulfil.[3] Each of these successive re-issues is

399 ; Rubber Co. *v.* Goodyear (1869), 9 Wall. 788.

That a re-issue cannot change the invention by narrowing a Claim in one part and expanding it in another, see Gage *v.* Kellogg (1886), 26 Fed. Rep. 242 ; 36 O. G. 234.

That a re-issue unwarrantably expanding the Claims is void, see Hoe *v.* Knap (1886), 36 O. G. 1244 ; 27 Fed. Rep. 204 ; Pattee Plow Co. *v.* Kingman (1885), 23 Fed. Rep. 801 ; Nye *v.* Allen (1883), 23 O. G. 2328 ; 15 Fed. Rep. 114 ; Donne & Wellington Mfg. Co. *v.* Smith (1882), 24 O. G. 302 ; 15 Fed. Rep. 459.

That the original patent cannot be broadened by re-issue so as to include matter anticipated by prior devices, see Ives & Miller *v.* Hartford Spring & Axle Co. (1882), 11 Fed. Rep. 510 ; 20 Blatch. 333 ; 22 O. G. 1037.

That an inexact Claim in the re-issue which if naturally construed would expand the invention is void, see Tyler *v.* Galloway (1882), 20 Blatch. 445 ; 22 O. G. 2072 ; 12 Fed. Rep. 567.

That if a re-issue does not narrow it must of course expand the Claims of the original, see French *v.* Rogers (1851), 1 Fisher, 133.

That where the specification and drawings are the same as those of the original the re-issue is not granted for making the description more full or for disclaiming old matter, see McMurray *v.* Mallory (1884), 111 U. S. 97 ; 27 O. G. 915.

That the case of Miller *v.* Brass Co., 104 U. S. 350, does not prohibit new Claims, — it applies the doctrine of equitable estoppel to the patentee after unreasonable delay when others may have acted on his non-claim, — see Asmus *v.* Alden (1886), 27 Fed. Rep. 684 ; 36 O. G. 231.

That the invention may be divided into distinct Claims in the re-issue, see Brown *v.* Deere (1881), 6 Fed. Rep. 484 ; 2 McCrary, 422 ; 19 O. G. 361 ; Dederick *v.* Cassell (1881), 20 O. G. 1233 ; 9 Fed. Rep. 306 ; 14 Phila. 503.

That the division and enlargement of Claims in a re-issue is not favored, though it is allowed if no new matter is introduced, see Dederick *v.* Cassell (1881), 14 Phila. 503 ; 20 O. G. 1233 ; 9 Fed. Rep. 306.

That if the several Claims of the re-issue cover the same invention as the original and no more, the re-issue is valid, see American Diamond Rock Boring Co. *v.* Sheldon (1885), 25 Fed. Rep. 768 ; 33 O. G. 1598.

That the re-issue is valid though its specification differs from that of the original, if they are consistent with each other, though if inconsistent the re-issue is void, see Sickles *v.* Evans (1863), 2 Clifford, 203 ; 2 Fisher, 417.

That the specification and Claims of the re-issue may differ from those of the original provided they claim nothing except what was present, both in fact and function, either in the original drawings or model, see Stephenson *v.* Second Avenue R. R. Co. (1880), 5 Bann. & A. 116 ; 1 Fed. Rep. 416.

That a re-issue cannot contain any change in the original specification or Claim whereby a new and substantially different invention results, or different effects are produced, see Salamander Felting Co. *v.* Haven (1875), 9 O. G. 253 ; 3 Dillon, 131.

[3] In French *v.* Rogers (1851), 1

independent of its predecessors, is unprejudiced by their imperfections, and is presumed to be an honest endeavor to effect the object for which the patent was originally issued.[4]

§ 694. Single Original Patents may Re-issue in Several Divisions.

In many cases, on account of the number or the intricate relations of the inventions described in the original patent, the object of the amendment cannot be accomplished by a

Fisher, 133, Kane, J. : (137) "There is nothing in the words of the act, or in the policy which it proclaims, that limits the correction of errors to such as may have been the first discovered. On the contrary . . . it is for the public interest that the surrender and re-issue should be allowed to follow each other just as often as the patentee is content to be more specific or more modest in his Claims."

That successive re-issues may be allowed, until the actual invention receives the desired protection, see Selden *v.* Stockwell Self-Lighting Gas Burner Co. (1881), 19 Blatch. 544 ; 20 O. G. 1377 ; 9 Fed. Rep. 390 ; Union Paper Collar Co. *v.* White (1875), 7 O. G. 698, 877 ; 2 Bann. & A. 60 ; 11 Phila. 479 ; Wells *v.* Jacques (1874), 1 Bann. & A. 60 ; 5 O. G. 364.

That a second re-issue must be for the same invention as the first re-issue, see Giant Powder Co. *v.* California Powder Works (1875), 3 Sawyer, 448 ; 2 Bann. & A. 131 ; Knight *v.* Baltimore & Ohio R. R. Co. (1840), 3 Fisher, 1 ; Taney, 106. This doctrine, unless broadly construed, improperly limits the right of the inventor by committing him irrevocably *to any mistake he may make* in the first re-issue.

That if a re-issue is void the original may be re-issued in its exact language and be valid, see Giant Powder Co. *v.* Safety Nitro-Powder Co. (1884), 19 Fed. Rep. 509 ; 10 Sawyer, 23 ; 27 O. G. 99.

That the original patent cannot be revived by merely disclaiming all changes made by the re-issue, but a new re-issue must be obtained, see Mc. Murray *v.* Mallory (1884), 111 U. S. 97 ; 27 O. G. 915.

That a first re-issue identical with the original is void, but a second re-issue repeating the original is good, see Celluloid Mfg. Co. *v.* Zylonite Brush & Comb Co. (1886), 27 Fed. Rep. 291; 35 O. G. 1228.

That the acceptance of a second re-issue with the original Claims restored admits that the original patent was not invalid or inoperative, see Celluloid Mfg. Co. *v.* Zylonite Brush & Comb Co. (1886), 27 Fed. Rep. 291 ; 35 O. G. 1228.

[4] That a second re-issue is not prejudiced by the faults of a former one, see American Diamond Rock Boring Co. *v.* Sheldon (1879), 17 Blatch. 209 ; 4 Bann. & A. 551.

That where there are several re-issues of the same patent the law always presumes that each was necessary to cure defects, see Union Paper Collar Co. *v.* White (1875), 2 Bann. & A. 60 ; 7 O. G. 698, 877 ; 11 Phila. 479.

That successive re-issues are not approved, see Union Paper Collar Co. *v.* White (1874), 7 O. G. 698, 877 ; 2 Bann. & A. 60 ; 11 Phila. 479.

That three re-issues of the same patent indicate fairness in each, see Swift *v.* Whisen (1867), 3 Fisher, 343 ; 2 Bond, 115.

more surrender of the original, and the substitution for it of a single re-issued patent. Where the original specification sets forth a new combination containing many new elements and sub-combinations, or where it contains a description not merely of the principal invention but of numerous subordinate or dependent inventions, the endeavor to describe and claim all these in one re-issue might often lead to hopeless confusion and uncertainty. To obviate this, the inventor is permitted to re-issue his original patent in divisions, covering in each so much of the patentable matter contained in the original description as he deems expedient, and thus receiving a separate patent for each separate part of his invention.[1] In this manner an original patent for a combination may re-issue in one patent for the entire combination, in others for its sub-combinations, and in still others for its elements.[2] A patent for a manufacture, which can be produced only by a given process, may re-issue in one patent for the process and another for the product.[3] The same rule applies in other cases of depend-

§ 694. [1] That a patent may re-issue in divisions for the distinct inventions embraced in the original, see Giant Powder Co. v. Safety Nitro-Powder Co. (1884), 19 Fed. Rep. 509; 10 Sawyer, 23; 27 O. G. 99; New v. Warren (1882), 22 O. G. 587; Dederick v. Cassell (1881), 9 Fed. Rep. 306; 20 O. G. 1233; 14 Phila. 503; Selden v. Stockwell Self-Lighting Gas Burner Co. (1881), 9 Fed. Rep. 390; 19 Blatch. 544; 20 O. G. 1377; *Ex parte* Lippincott (1879), 16 O. G. 632; Wheeler v. McCormick (1873), 11 Blatch. 334; 6 Fisher, 551; 4 O. G. 692; Penna. Salt Mfg. Co. v. Thomas (1871), 8 Phila. 144; 5 Fisher, 148; Bennet v. Fowler (1869), 8 Wall. 445; Goodyear v. Wait (1867), 5 Blatch. 468; 3 Fisher, 242.

That re-issue divisions are for separable inventions which can be separately patented, see *Ex parte* Herr (1887), 41 O. G. 463.

That a patent may be re-issued in several divisions, either concurrently or successively, and the original is good to protect each part until it is covered by a re-issue, see *Ex parte* Greaves (1880), 18 O. G. 623.

That a patent may re-issue in divisions, one division containing the original Claims, and another the new Claims, see Giant Powder Co. v. Safety Nitro-Powder Co. (1884), 10 Sawyer, 23; 27 O. G. 99; 19 Fed. Rep. 509.

[2] That where the original patent is for a combination it may re-issue in separate divisions for each sub-combination, and these are not separate patents for the same invention, see Wheeler v. McCormick (1873), 6 Fisher, 551; 11 Blatch. 334; 4 O. G. 692.

That sub-combinations, if operative by themselves, may be re-issued in separate patents, based on the same original, see *Ex parte* Wheeler (1873), 4 O. G. 5.

[3] That where the original patent was for a new product resulting from a new process the re-issue may cover both process and product, either in the same or separate patents, see Tucker v. Burditt

ent inventions, where the joinder, though allowable, would result disadvantageously to the inventor, and where his patent cannot, therefore, be conveniently re-issued in a single instrument to cover all he has described in the original.

§ 695. Relation of each Re-issue Division to the Original Patent, and to the Other Divisions.

As these divisions of the re-issue represent a single original patent, they must be granted to the same patentee, and be confined to the inventions indicated in the former specification.[1] The patentable matter claimed in each must be a complete invention in itself, and not merely a different application of the principal invention.[2] Each may describe the whole invention, if this be necessary to the explanation of the specific portion which it claims, and each may claim its own part in its separate condition and also as connected with the others.[3] One division is not affected by errors or excesses

(1879), 4 Bann. & A. 569; Anilin *v.* Hamilton Mfg. Co. (1878), 3 Bann. & A. 235; 13 O. G. 273.

Whether a patent for a process can re-issue in separate patents, one for the process and the other for the product, *quære*, see Goodyear *v.* Honsinger (1867), 3 Fisher, 147; 2 Bissell, 1.

§ 695. [1] That all the divisions of a re-issue must issue to the same patentees, see *Ex parte* Smith (1879), 16 O. G. 1233.

That a re-issue in divisions must be confined to the original inventions, see New *v.* Warren (1882), 22 O. G. 587.

[2] That where a patent is divided upon re-issue each division must be for a distinct part of the original invention, see Giant Powder Co. *v.* California Vigorit Powder Works (1875), 3 Sawyer, 448; 2 Bann. & A. 131.

That a patent cannot be divided upon its re-issue unless there are distinct inventions, not merely different applications to a specific invention under the same genus, see *Ex parte* Sexton (1873), 3 O. G. 409.

[3] In Wheeler *v.* McCormick (1873), 11 Blatch. 334, Woodruff, J.: (338) "Where a patentee, having patented an aggregate of several devices, is permitted to surrender his patent and receive new letters-patent for the several devices included in it, it does not follow that his new specifications may not be identical in their description of each and all of the devices included in the original aggregate patent. It is the patentee's selecting out of these devices some or one, being separable and capable of use as a distinct device or devices, and making that or those the subject of his specific Claim, that determines what is covered by each re-issue. The description of an entire machine may be convenient, and sometimes necessary, in order to show the adaptation of the separated device to a useful purpose, and illustrate, not its construction alone, but its application in one practical mode to the purpose for which it was designed. Such a description may be given, but that does not make the patent cover all that is included in the description. In this case,

in the others, but is judged on its individual merits as a separate patent for a separate invention.[4] All the divisions rest upon the original patent, however, as their common foundation, and an incurable defect in the original, such as a false oath or a fraudulent concealment, renders them altogether void.[5]

§ 696. Re-issued Patent Supersedes the Original and Requires its Surrender to the Government.

The amendment of a patent by re-issue is not, in legal effect, a simple addition to or variation of its description or its claims, — it is the grant of a different patent for the same invention;[1] and since during the life of one patent another

tion, it was competent for the patentee to amend his original specification, so as fully and minutely to describe all that was shown in the original or in its drawings or model, and receive patents for each separate device shown therein, or each separate and severable combination of devices, capable of distinct use, and while such specification might be annexed, *in totidem verbis*, to each re-issued patent, define and claim in each such separable and distinct part of his original aggregate invention, the specification in each case showing, as it should, the construction of each separate patented device or combination of devices, so as to give the required information to the public, and illustrating the application of each device or combination to actual use in the construction of an aggregate machine. This does not make one re-issue include all that is described in the specification. All that is included in a specification is not necessarily included in the patent. What is claimed in and secured by the patent is secured not only when used in the mode illustrated by the description of other devices with which it may be used in the specification, but it is secured against its use in connection with other devices of an entirely distinct character." 4 O. G. 692 (694); 6 Fisher, 551 (555).

That where a patent re-issues in divisions and each division claims its distinct part in combination with the rest, they will not be several patents for the same invention, see Wheeler *v.* McCormick (1873), 11 Blatch. 334; 4 O. G. 692; 6 Fisher, 551.

[4] That where an original patent is re-issued in divisions, the first division may be valid though the others are void, see Atwood *v.* Portland Co. (1880), 5 Bann. & A. 533; 10 Fed. Rep. 283.

That where a patent is divided upon re-issue, each division stands by itself as for a separate invention, see Brown *v.* Selby (1871), 4 Fisher, 363; 2 Bissell, 457.

[5] That where a patent re-issues in divisions, each division is treated as a separate Claim under one patent, see Penna. Salt Mfg. Co. *v.* Thomas (1871), 5 Fisher, 148; 8 Phila. 144.

That a re-issue must stand or fall by its own Clai , see Wisner *v.* Grant (1881), 7 Fed. Rep. 922; 18 O. G. 192.

§ 696. [1] That a re-issue is a new contract between the United States and the party who obtains it, see Goodyear *v.* Providence Rubber Co. (1864), 2 Clifford, 351; 2 Fisher, 499.

for the same invention cannot issue to the same patentee, the grant of the re-issue necessitates the previous surrender and cancellation of the original defective patent. The surrender is accomplished by the delivery of the original patent, or in case of its destruction or loss of a certified copy thereof, to the Patent Office, with a request for a re-issue;[2] and when this is accepted by the Commissioner, the original patent and all the claims accruing from it, in favor of the parties uniting in the surrender, are extinguished.[3] Their patent privileges are thenceforth derived from the re-issued patent only, upon which all their efforts to protect or vindicate their rights to the invention must be based.[4]

[2] That a surrender is not required by the statute to be in writing, see Dental Vulcanite Co. *v.* Wetherbee (1866), 2 Clifford, 555; 3 Fisher, 87.

[3] That all rights of action under the original patent expire with its surrender and re-issue, see Jones *v.* Barker (1882), 11 Fed. Rep. 597; 22 O. G. 771; U. S. Stamping Co. *v.* King (1879), 7 Fed. Rep. 860; 17 Blatch. 55; 17 O. G. 1399; 4 Bann. & A. 469; Mers *v.* Conover (1876), 11 O. G. 1111; Fry *v.* Quinlan (1875), 13 Blatch. 205; Reedy *v.* Scott (1874), 23 Wall. 352; 7 O. G. 463; Brown *v.* Hinkley (1873), 3 O. G. 384; 6 Fisher, 370.

That all rights of action are suspended by a surrender and re-issue application, see Burrell *v.* Hockley (1888), 44 O. G. 1400.

[4] In Peck *v.* Collins (1881), 103 U. S. 660, Bradley, J.: (664) "Since the decision of this case it has been uniformly held that if a re-issue is granted, the patentee has no rights except such as grow out of the re-issued patent. He has none under the original. That is extinguished. And although for the purpose of fixing a date to the title in a question of priority, and of limiting the period for which the patent is to run, the date of the original patent is important, no damages can be recovered for any acts of infringement committed prior to the re-issue." 19 O. G. 1137 (1138).

In Moffitt *v.* Gaar (1860), 1 Fisher, 610, Leavitt, J.: (613) "In the liberal and benignant spirit in which our patent system has been conceived and carried out, the thirteenth section of the act of 1836 gives to the patentee a right to correct his description or specification, when its imperfection has resulted from inadverteney, accident, or mistake. This is effected by a surrender of his patent, and obtaining a new patent upon an amended specification. By this means he is protected from some of the effects of his error, and secured in the enjoyment of all his rights as an inventor, after the emanation of the new or corrected patent. But the statute gives no right of action for an infringement occurring under the void patent, and before the re-issue of the new patent. In the present case the grounds on which the old patent was surrendered, and a re-issue authorized, are not before the court. But the court must presume that they were such as, by the language of the thirteenth section, authorized the surrender of the old patent, and the granting of a new one. The only condition on which this can be done is that the original patent is '*inoperative*

§ 697. Surrender of the Original Patent takes Effect upon the Grant of the Re-issued Patent.

Since the surrender, when accepted, abrogates all rights of the surrenderors under the original patent, the question as to the time of such acceptance is of great importance, and formerly was surrounded with considerable difficulty. Prior to the act of 1870 the statutes contained no specific answer to this question, and the decisions of the courts were not in harmony. Under the act of 1832, which first authorized this

or *invalid*' by reason of a failure to comply with the requirements of the statute. The proceeding is, therefore, equivalent to a distinct admission, made in the most solemn form, that the patent has no validity in the sense of entitling the patentee to an action for its infringement. The new patent can be operative only from its date, as affording the patentee a remedy for an infringement. The statute expressly negatives the idea that it was intended to give a retrospective operation to the new patent and entitle the patentee to an action for an infringement previously accruing. It was, doubtless, competent for the legislature to have declared that the new patent should have this effect, but the language used imports the opposite intention. The statute provides, in express terms, that the re-issued patent 'shall have the same effect and operation in law, on the trial of all actions hereafter commenced for causes subsequently accruing, as though the same had been originally filed in such corrected form, before the issuing of the original patent.' Now, the allegation of the plea in this case is that after the cause of action accrued, and after the commencement of this action the plaintiff surrendered his patent. The demurrer admits the truth of this averment. The claim of the plaintiff, then, is based on infringement occurring under the old patent, and not for a cause of action accruing after the date of the re-issued patent. Clearly the statute affords no remedy for such an infringement. Any other construction of the statute would result in the absurdity of conferring on the patentee, as the result of the surrender of what he admits to be an invalid patent, rights and immunities which he could not claim without such surrender. In other words, the legal effect of the re-issued patent would be to give force and vitality to the original patent, in the face of the admission of the patentee that it was inoperative and invalid. This may be illustrated by supposing that the patentee had made no surrender, but had chosen to rest his rights on the original patent. Is it not clear that there could have been no recovery in that case for an infringement? The patentee would have been met with the unanswerable objection that the patent was invalid, from a fatal omission to comply with the requisition of the statute. And there can be no pretence for claiming that by the surrender of the old patent, and the emanation of a second one, the patentee, as to infringements occurring under the original patent, is placed in a better situation than if there had been no surrender and re-issue." 1 Bond, 315 (317).

That a surrender and re-issue make the patent good as to all subsequent causes of action, though the original were invalid, see Bloomer *v.* Stolley (1850), 5 McLean, 158.

method of amendment, the re-issue was to be awarded upon the surrender of the former patent. As no examination of applications was then required, the surrender and re-issue were reciprocal and concurrent acts, and no interval could have elapsed during which neither patent was in force. The act of 1836, while introducing the system of examining applications and thus requiring greater or less delay between the surrender and the grant of the re-issue, did not change the language of the act of 1832 to meet this new circumstance, or by any other provision indicate the time when the surrender was to take effect. Hence the idea seems to have gained recognition that the surrender and re-issue were not dependent parts of the same transaction, but that the surrender was an absolute destruction of the original patent, and that unless the re-issue were granted the rights of the surrenderors were irretrievably lost. Under this doctrine the applicant for a re-issue occupied the same position as an applicant for an original patent. The patentability of his invention, and his relation to it as its first inventor were again open to investigation, as upon his original application, and a refusal of the re-issue operated as a complete repudiation of his claims.[1] The act of 1870 removed at once these difficulties and doubts by providing that the surrender should take effect only upon the issue of the amended patent.[2] At present, therefore, the rights of the surrenderors are protected by the original patent until the re-issue is awarded; and if the re-issue be refused, the original patent is returned to its owners, who are thus left to sustain it, so far as they are able, in the courts.[3]

§ 697. [1] That under the law, as it stood in 1860, a patent surrendered for re-issue was gone in any event, and the patentee must obtain the re-issue or have nothing, see Peck *v.* Collins (1881), 103 U. S. 660 · 19 O. G. 1137.

But *per contra*, —

That while the re-issue supersedes the original, the surrender and application for a re-issue do not, see Forbes *v.* Barstow Stove Co. (1864), 2 Clifford, 379.

That the surrender and re-issue constitute but one act, and are both alike valid or invalid, see French *v.* Rogers (1851), 1 Fisher, 133.

That if the re-issue is void the original patent still remains valid, see Woodworth *v.* Hall (1846), 1 W. & M. 389 ; 2 Robb, 517 ; Woodworth *v.* Hall (1846), 1 W. & M. 248 ; 2 Robb, 495.

[2] That before 1870 the surrender took effect from its date, after 1870 from the re-issue, see Peck *v.* Collins (1881), 103 U. S. 660 ; 19 O. G. 1137.

[3] An exception to this rule exists in

§ 698. **Surrender of the Original Patent: by Whom Made.**

No surrender can be valid and effective unless made with the concurrence of all the owners of the original patent.[1] The patentee, if living and still retaining any undivided interest in the patent, his representatives if he be dead and at his death had not assigned to others his entire patent privilege, and the assignees of any undivided interest in the whole patent, are parties whose consent to the extinguishment of the original patent is absolutely necessary.[2] The concur-

cases where an examination of the re-issue application on its merits discloses that the invention was originally unpatentable, for want of novelty, priority, or some other essential requisite. In such cases a decision adverse to the re-issue applicant is fatal to the entire patent. Thus in Peck *v.* Collins (1881), 103 U. S. 660, Bradley, J.: (664) "It seems to us equally clear that as the law stood when that decision was made, and as it continued to stand in 1866, when the surrender of Mudge's patent took place, a patent surrendered for re-issue was cancelled in law as well when the application was rejected as when it was granted. The patentee was in the same situation as he would have been if his original application for a patent had been rejected. The law declares in terms that 'the specifications and Claim in every such case shall be subject to revision and restriction in the same manner as original applications are.' Act of March 3, 1837, c. 45, Sec. 8, 5 Stat. 193; July 8, 1870, c. 230, Sec. 53, 16 Stat. 205; Rev. Stat. Sec. 4916. The question of his right to any patent at all was opened anew, the same as upon an original application for a patent. Surrender of the patent was an abandonment of it, and the applicant for re-issue took upon himself the risk of getting a re-issue or of losing all. A failure upon the merits, in a contest with other claimants, only gave additional force to the legal effect of the surrender. Since the surrender of the patent in this case the Patent Laws have undergone a general revision by the act of July 8, 1870, c. 230. In the fifty-third section of that act (being the section relating to the surrender and re-issue of patents), a new clause was introduced, declaring that the surrender 'shall take effect upon the issue of the amended patent;' and this clause is retained in Sec. 4916 of the Revised Statutes. What may be the effect of this provision in cases where a re-issue is refused, it is not necessary now to decide. Possibly it may be to enable the applicant to have a return of his original patent if a re-issue is refused on some formal or other ground which does not affect his original claim. But if his title to the invention is disputed and adjudged against him, it would still seem that the effect of such a decision should be as fatal to his original patent as to his right to a re-issue." 19 O. G. 1137 (1138).

§ 698. [1] That a surrender is invalid unless all owners of the patent concur, either by consent or ratification, see Meyer *v.* Bailey (1875), 8 O. G. 437; 2 Bann. & A. 73.

[2] That a surrender for re-issue must be made either by the patentee or by his representatives or assigns, see *Ex parte* Wright (1876), 10 O. G. 587; Potter *v.* Holland (1858), 1 Fisher, 327; 4 Blatch. 206.

That the patentee and the assignee

rence of such owners may be manifested either by joining in the surrender, or by subsequently ratifying it, though under the present practice in the Patent Office the written consent of all the owners must appear upon the face of the application for re-issue in which the surrender of the original patent is embodied.[3] Grantees and licensees are not so interested in the original patent as to make their concurrence necessary to the validity of its surrender and re-issue.[4] Local or individual rights acquired under the former patent remain unaffected by its surrender until the parties in whom such rights are vested voluntarily relinquish them and accept new rights under the re-issue.[5] The original patent may

of a part interest may join in surrender and application for a re-issue, see Potter *v.* Holland (1858), 1 Fisher, 327 ; 4 Blatch. 206.

That where the whole interest in a patent has been assigned the surrender should be made by the assignee, or with his consent, and the re-issue granted to him, see Dental Vulcanite Co. *v.* Wetherbee (1866), 3 Fisher, 87 ; 2 Clifford, 555.

That the assignment of part of a patent does not entitle the assignee to surrender and re-issue that part, see *Ex parte* Smith (1879), 16 O. G. 1233.

That the assignee of an undivided interest in the patent must join with the other owners in a surrender, see Potter *v.* Holland (1858), 4 Blatch. 206 ; 1 Fisher, 327.

That a surrender by, and a re-issue to, a person other than the owner would not affect the title of the owner, see Campbell *v.* James (1879), 18 O. G. 979 ; 17 Blatch. 42 ; 4 Bann. & A. 456.

That an assignee has the same rights under the re-issue as under the original, see Potter *v.* Holland (1858), 1 Fisher, 327 ; 4 Blatch. 206.

[3] That if an assignee ratifies a re-issue it becomes valid as to him, see Campbell *v.* James (1879), 18 O. G. 979 ; 17 Blatch. 42 ; 4 Bann. & A. 456 ; Meyer *v.* Bailey (1875), 8 O. G. 437 ; 2 Bann. & A. 73.

[4] That the grantee of a territorial interest is not an "assignee," as the word is used in the statute referring to re-issues, and that a surrender and re-issue is valid though a "grantee" does not consent, see Meyer *v.* Bailey (1875), 2 Bann. & A. 73 ; 8 O. G. 437 ; Commissioner *v.* Whitely (1866), 4 Wall. 522.

That neither a grantee nor a licensee can join in a surrender, see Potter *v.* Holland (1858), 4 Blatch. 206 ; 1 Fisher, 327.

That a re-issue is *prima facie* evidence that the surrender was proper, see Knight *v.* Baltimore & Ohio R. R. Co. (1840), Taney, 106 ; 3 Fisher, 1.

[5] In Potter *v.* Holland (1858), 4 Blatch. 206, Ingersoll, J. : (214) "It does not follow from this, however, that because a third person, to whom a patentee has passed his interest in a part of a patent, is entitled to the same right to a re-issued patent that he had to the old one, he is compelled to take under the re-issued one, and thereby compelled to give up the right which he had under the old one. If he were, his rights might be injuriously affected without his consent. If he were so compelled,

thus be in force as to grantees and licensees in some portions of the United States, although as to the owners of the patent, and in other sections of the country, the re-issued patent alone survives.[6] But the holders of these subordinate interests cannot claim under both patents. By authorizing or by taking the benefit of the surrender and re-issue, they abandon the privileges conferred upon them under the original patent and accept the amended patent as the source and measure of their rights.[7]

§ 699. Effect of Surrender and Re-issue upon Rights Accruing under the Original Patent.

The surrender of a patent for re-issue is an admission on the part of the surrenderors that the original patent is defective, and the acceptance of the surrender by the Commissioner is a judgment that its amendment by re-issue is required; but neither the surrender nor its acceptance indicates that the surrendered patent was entirely void.[1] The surrender is a vol-

a grantee under the old patent of an exclusive territorial right would be forced, without his consent, to give up damages which he might be entitled to under the old patent, for a violation of rights secured to him by that patent. And it might so happen that the old patent surrendered was a valid one, and that the re-issued one was invalid; or that the rights secured by the former were important, while the rights secured by the latter were of little consequence." 1 Fisher, 327 (336).

That the re-issue of a patent is for the purpose of curing defects and perfecting the patent, and cannot destroy vested rights of assignees, etc., see Harrison *v.* Ingersoll (1885), 56 Mich. 36.

[6] In Potter *v.* Holland (1858), 4 Blatch. 206, Ingersoll, J.: (216) "The object of a patent is to secure rights to an invention throughout the whole of the United States. We can discover no good reason why a portion or the whole of the invention, for a particular portion of the United States, may not be secured by one patent, and the remaining portion of the invention for the residue of the United States be secured by another patent. These two patents would, in effect, constitute together but one patent for the whole invention, for the whole United States. Two patents for separate parts, the separate parts together comprehending only the whole, would in effect be but one patent for the whole; as two separate deeds, for two separate sections of one whole lot of land, would not be, in effect, more than one deed for the whole lot. No more would be secured by the two patents than is authorized by law to be secured, or than could be secured by one. The two, in effect, would constitute but one." 1 Fisher, 327 (338).

[7] That by asserting rights under a re-issue parties in interest adopt it and to that extent forego their rights under the original, see Meyer *v.* Bailey (1875), 8 O. G. 437; 2 Bann. & A. 73.

§ 699. [1] That a surrender for re-issue admits that the original is inoperative,

untary extinguishment of former rights, not a concession that such rights never existed, and, therefore, while no suit can be maintained under the original patent nor any infringement of its privileges be made the ground of a recovery, all closed transactions under it remain undisturbed.[2] Judgments obtained upon it are not vacated.[3] Moneys paid under it cannot be reclaimed.[4] But an infringement which commenced under the original patent is not sanctioned by the surrender, and if it continues in the same or in another form after the grant of the re-issue, an action may be instituted on the latter patent, and damages accruing since the date of the re-issue be obtained.[5]

§ 700. Application for Re-issue: Concurrence of the Inventor therein Necessary, if Living.

An application for the re-issue of a patent granted and assigned before the 8th day of July, 1870, may be made by the owners of the patent with or without the concurrence of the original patentee.[1] Patents granted or assigned since July 8,

see Moffitt *v.* Gaar (1860), 1 Fisher, 610; 1 Bond, 315.

[2] That a surrender cannot affect rights previously acquired, see Potter *v.* Holland (1858), 4 Blatch. 206; 1 Fisher, 327.

That a contract concerning a patent applies to it after a surrender and re-issue, the re-issue not being a new patent, see McBurney *v.* Goodyear (1853), 11 Cush. 569.

[3] That the surrender of a patent for re-issue has no effect upon a right which has passed into a judgment, see Mers *v.* Conover (1876), 11 O. G. 1111.

[4] That although the surrender extinguishes the original patent, the moneys paid under it cannot be recovered, see Moffitt *v.* Gaar (1861), 1 Black, 273.

[5] That the acquiescence of the patentee in the use of his invention, under the original patent, does not authorize its use under a re-issue, see McWilliams Mfg. Co. *v.* Blundell (1882), 22 O. G. 177; 11 Fed. Rep. 419.

That a surrender and re-issue does not deprive the patentee of the right to sue for the unlawful use, after the re-issue, of a machine brought before the re-issue, see Bliss *v.* Brooklyn (1871), 4 Fisher, 596; 8 Blatch. 533; Carr *v.* Rice (1856), 1 Fisher, 198.

§ 700. [1] That under Sec. 13, act of July 4, 1836, the re-issue was to be granted to the patentee, if he was living and still the owner of the patent; if he was dead and there was no assignment, then to his executor or administrator; and if there was an assignment, to the assignee, see Potter *v.* Holland (1858), 4 Blatch. 206; 1 Fisher, 327.

That under the act of 1836 a re-issue might be granted to an assignee without the knowledge or consent of the patentee, see Swift *v.* Whisen (1867), 3 Fisher, 343; 2 Bond, 115.

1870, can be re-issued only upon the application and oath of the original inventor, if he be living.[2] Various reasons for this change in the law have been suggested. The oath accompanying the application must aver that the error whose amendment is desired arose through inadvertence, accident, or mistake, and must repeat the allegations of the original oath in reference to priority of invention and the absence of previous public use and knowledge. This oath, after the grant of the re-issue, is *prima facie* evidence upon all the points embraced therein. To permit it to be made by a mere assignee upon his information and belief, when the inventor is living and can, therefore, testify upon his positive knowledge, is an unnecessary relaxation of the ordinary rules of evidence and was properly corrected by the act of 1870. Moreover, the rights of the inventor in his invention are not exhausted by the conveyance of his entire interest in the original patent. Under former laws a re-issue might affect the value of his right to an extension after the expiration of the assigned patent,[3] and under present laws an alteration in the description or claims of the existing patent may prejudice his interests in subordinate or dependent inventions which may be indicated in the original specification, but which he did not intend to cover by the original patent or transfer to the assignee. His consent to the re-issue, if he is living and able to accord it, may be, therefore, properly required.

§ 701. Application for Re-issue: by Whom Made.

Under existing laws the application for re-issue must be made by the inventor, if living; on his own behalf if he is still the entire owner of the patent, and on behalf of its real owners if he has assigned the whole or any undivided interest. Where the inventor is dead the owners of the patent, whether his representatives or assignees or both, may make the application, as before the changes in the law.[1] A living inventor

[2] Rev. Stat. Sec. 4895.

[3] That where an assignee has re-issued a patent without the patentee's consent, the latter may apply for an extension of the original, see Potter *v.* Braunsdorf (1869), 7 Blatch. 97.

§ 701. [1] That an executor may obtain a re-issue, see Carew *v.* Boston Elastic Fabric Co. (1871), 3 Clifford, 356; 5 Fisher, 90; 1 O. G. 91.

That a re-issue to an administrator is presumed to be regular, see Northwest-

who refuses to apply for a re-issue on behalf of his assignees, when such an amendment of the patent is legitimate and necessary, may be compelled to do so by a court of equity,— since his assignment of the patent implies a contract on his part to do whatever may be requisite to render the patent effective for the actual invention, and this contract equity will enforce.[2] But an inventor has no authority to apply for the re-issue of an assigned patent without the consent of his assignees, and his wrongful act in this regard cannot impair their rights.[3] A re-issue thus obtained by him is valid or invalid at their election. They may ratify it and enjoy the advantages derived from it, though issued only in his name,[4]

ern Fire Extinguisher Co. *v.* Philadelphia Fire Extinguisher Co. (1874), 10 Phila. 227 ; 6 O. G. 34 ; 1 Bann. & A. 177.

[2] See §§ 1224, 1228–1230, and notes, *post.*

[3] That the surrender of an assigned patent is not valid unless made by the assignee or with his consent, see *Ex parte* Wright (1876), 10 O. G. 587 ; Meyer *v.* Bailey (1875), 8 O. G. 437 ; 2 Bann. & A. 73 ; Barnes *v.* Morgan (1875), 3 Hun, 703 ; Dental Vulcanite Co. *v.* Wetherbee (1866), 3 Fisher, 87 ; 2 Clifford, 555.

That a patentee cannot affect the interest of his assignee by any surrender for re-issue, see Barnes *v.* Morgan (1875), 3 Hun, 703.

That an assignment of a patent carries all re-issues if the assignee so elect, see Littlefield *v.* Perry (1874), 21 Wall. 205 ; 7 O. G. 964.

That a re-issue to the patentee is a bar to a re-issue to an unrecorded assignee, see Whitely *v.* Fisher (1870), 4 Fisher, 248.

[4] In Potter *v.* Holland (1858), 4 Blatch. 206, Ingersoll, J. : (214) "We adopt the rule laid down by Judge Story in the case of Woodworth *v.* Stone (3 Story, 749), that it is not in the power of the patentee, by a surrender of his patent, to affect, without their consent, the rights of third persons to whom he has previously passed his interest in the whole or a part of the patent. This consent may be manifested either by joining in the surrender with the patentee, or by previously authorizing it or by subsequently ratifying or approving it. To take advantage and benefit of it would be a ratification. When such consent is given the rights of the party so consenting in and to the old patent are forever gone. It may, too, be considered as a sound and settled principle that a person to whom the patentee has passed his interest in a part of the old patent, is entitled, upon the surrender of the same by the patentee, and the obtaining of a re-issued patent, to the same right under the re-issued patent that he had to the old one. The patentee cannot, by taking a re-issue, deprive him of the same right to it that he had to the old one, if he wishes to take the benefit of such right. Woodworth *v.* Hall, 1 Woodb. & Minot, 248. But when he does take advantage and benefit of the re-issued patent, he consents to give up, and does give up, the right which he had under the old one." 1 Fisher, 327 (335).

See also Littlefield *v.* Perry (1874), 21 Wall. 205 ; 7 O. G. 964 , Dental

or they may repudiate it and compel him to obtain another, or they may insist upon their privileges under the original patent. To guard against this unauthorized re-issue of an assigned patent, it is the practice of the Patent Office to require proof of the consent of all the owners of the patent, sufficient evidence of which is furnished by the filing of the abstract of their title with the application.[5]

§ 702. Re-issued Patent: to Whom Granted.

The re-issued patent may be granted to assignees of any degree, however remote from the original inventor.[1] The limits within which the original description and claims may be amended, and the consequences of a previous disclaimer or abandonment, are the same as if the application had been made by the inventor. The re-issue is void if any fraud is perpetrated or attempted by the applicant, as where he knows that the original assignor was not the true inventor or that the error whose amendment he desires did not occur in such a manner as alone warrants its correction.[2] The grant of a re-issue to an assignee is *prima facie* evidence of his title to the patent.[3] Parties claiming under the original patent, other

Vulcanite Co. *v.* Wetherbee (1866), 2 Clifford, 555; 3 Fisher, 87; Burdell *v.* Denig (1865), 2 Fisher, 588.

That third parties ratify the re-issue by using or selling rights under it, see Meyer *v.* Bailey (1875), 2 Bann. & A. 73; 8 O. G. 437.

That a re-issue does not *enure* to the benefit of the assignee when obtained by the patentee, the assignee taking by ratification, not by enurement, see Burdell *v.* Denig (1865), 2 Fisher, 588.

That when the patentee obtains a re-issue at the request of the owners of the patent after an assignment of the original it enures to the benefit of the assignees, see Wing *v.* Warren (1872), 5 Fisher, 548; 2 O. G. 342.

[5] That the Commissioner may require sufficient proof that the assignee consents to the re-issue, see *Ex parte* Wright (1876), 10 O. G. 587.

That a certified abstract of title is the proper evidence of the assignee's consent, see *Ex parte* Wright (1876), 10 O. G. 587.

§ 702. [1] That a re-issue may be granted to an assignee of any degree, see Selden *v.* Stockwell Self-Lighting Gas Burner Co. (1881), 19 Blatch. 544; 20 O. G. 1377; 9 Fed. Rep. 390; Swift *v.* Whisen (1867), 3 Fisher, 343; 2 Bond, 115.

That a re-issue may be obtained in his own name by the assignee of the executor of the patentee, see Carew *v.* Boston Elastic Fabric Co. (1871), Holmes, 45.

[2] That a re-issue is void if the applicant knew, at the date of the application for it, that he or his assignor was not the true inventor, see Singer *v.* Walmsley (1860), 1 Fisher, 558.

[3] That the grant of a re-issue to an

than its owners, may retain their existing rights or assert them as modified by the re-issue at their option.[4]

§ 703. Re-issued Patent a Continuation of the Original, and Governed by the Same Law.

A re-issued patent is a new statement of the contract between the public and the patentee, and binds each of its parties to the same extent as if it were an original patent. It is to be interpreted by the same rules, and is subject to amendment by re-issue or disclaimer in the same manner.[1] Being, however, a continuation in a new form of the original patent, the rights arising under it are governed by the law in force when the original was granted, and the patentability of the invention which it covers is determined by the state of the art as it existed at the date of the original.[2] The motive for obtaining a re-issue cannot change the rights which it creates, and is not regarded in deciding upon its validity or construing its provisions, except in cases where an actual fraud has been committed.[3]

assignee is *prima facie* evidence that he has a title to the patent, see Washburn & Moen Mfg. Co. *v.* Haish (1880), 10 Bissell, 65; 19 O. G. 173; 4 Fed. Rep. 900; American Diamond Rock Boring Co. *v.* Sheldon (1879), 17 Blatch. 208; 4 Bann. & A. 551.

[4] That no re-issue of a patent can affect the rights of non-consenting owners or other third parties, see Potter *v.* Braunsdorf (1869), 7 Blatch. 97; Potter *v.* Holland (1858), 4 Blatch. 206; 1 Fisher, 327.

That a portion or the whole of an invention for a particular part of the United States, and the rest for other parts, may be secured by a re-issue, see Potter *v.* Holland (1858), 4 Blatch. 206; 1 Fisher, 327.

That after an extension the re-issue is good for the extended term, see Gibson *v.* Harris (1846), 1 Blatch. 167.

§ 703. [1] That the Patent Office has the same power over a re-issue as over the original, see *Ex parte* Lippincott (1879), 16 O. G. 632.

[2] That the re-issue is a continuation of the original patent, see Shaw *v.* Colwell Lead Co. (1882), 20 Blatch. 417; 11 Fed. Rep. 711; Shaw *v.* Cooper (1833), 7 Peters, 292; 1 Robb, 643.

That a re-issue is governed by the law in force at the date of the original, see Shaw *v.* Cooper (1833), 7 Peters, 292; 1 Robb, 643.

That the patentability of the invention claimed in a re-issue is determined by the state of the art at the date of the original application, see Carroll *v.* Morse (1876), 9 O. G. 453; Carlton *v.* Bokee (1872), 17 Wall. 463; 2 O. G. 520; 6 Fisher, 40; and § 708, note 2, *post*.

[3] That the motive for a re-issue is unimportant, if the inventions are the same, see Buffum *v.* Oakland Mfg. Co. (1879), 4 Bann. & A. 599.

§ 704. Procedure on Applications for Re-issue: The Application.

An application for a re-issue, and the proceedings in the Patent Office thereon, are for the most part governed by the rules which regulate applications for original patents, and which have been already considered in detail. It will be sufficient, therefore, to discuss at this time only the particular points in reference to which the procedure on re-issue applications is exceptional. The application must be based upon a single original patent and must show the original to have been defective through mistake, and point out wherein the mistake consisted.[1] It need not follow the language of the statute.[2] It comprises a petition, an oath, an abstract of title, and the amended specification, accompanied by such drawings and model as the nature of the case may require. The petition prays for leave to surrender the original patent and for a re-issue upon the amended specification. It may be signed by the true owners of the patent, unless the patent has been granted or transferred since July 8, 1870, in which case the petition must be signed by the inventor if living, and contain the written assent of the present owners.[3] If the inventor has deceased, and the petition bears the signatures of the assignees, the fact of his decease must be duly stated. The abstract of title must disclose the names of all persons owning any undivided interest in the original patent;[4] and the orig-

§ 704. [1] That a re-issue can be based on but a single original patent, not on several, see Washburn & Moen Mfg. Co. *v.* Fuchs (1883), 16 Fed. Rep. 661; 5 McCrary, 236.

[2] That the application for a re-issue need not follow the language of the statute, see Gold & Stock Telegraph Co. *v.* Wiley (1883), 17 Fed. Rep. 234.

That a re-issue need not be applied for in writing under the statute, though the rules of the Patent Office may require it, see Dental Vulcanite Co. *v.* Wetherbee (1866), 3 Fisher, 87; 2 Clifford, 555.

[3] That if the original assignment by the patentee to the first assignee were made before July 8, 1870, the application for re-issue may be made by the assignee, see Selden *v.* Stockwell Self-Lighting Gas Burner Co. (1881), 19 Blatch. 554; 20 O. G. 1377; 9 Fed. Rep. 390.

That Sec. 3, act of 1870, proviso 2d, does not require applications for re-issue pending on July 8, 1870, to be made anew, with oath of inventor, etc., see National Spring Co. *v.* Union Car Spring Mfg. Co. (1874), 12 Blatch. 80; 6 O. G. 224.

[4] That an abstract of title must accompany an application for a re-issue, see *Ex parte* Fassett (1877), 11 O. G. 420; *Ex parte* Wright (1876), 10 O. G. 587.

inal patent, or, if it be lost, a certified copy and an affidavit of the loss, must at the same time be delivered to the Patent Office.

§ 705. Procedure on Applications for Re-issue: The Oath.

Where the petition must be signed by the inventor the oath must also be made by him; in other cases it should be made by the applicants, whoever they may be.[1] In addition to the matters embraced in the oath required in an original application, it must state particularly that the applicant believes the original patent to be inoperative or invalid, with his reasons for such belief, specifying the defects or insufficiencies in the description, or the excessive matter in the Claim, pointing out the errors which constitute the inadvertence, accident, or mistake, with the manner in which they arose, and alleging that such errors occurred without fraudulent or deceptive intention.[2] It must also disclose the existence of foreign

§ 705. [1] That under the act of March 3, 1871, the oath of the assignee was sufficient, if the original patent issued before July 20, 1870, but otherwise the oath of the inventor was required, see National Car Spring Co. *v.* Union Spring Mfg. Co. (1874), 6 O. G. 224; 12 Blatch. 80.

That where an assignee filed an application for a re-issue before July 20, 1870, his oath alone was sufficient, see National Spring Co. *v.* Union Car Spring Mfg. Co. (1874), 6 O. G. 224; 12 Blatch. 80.

That an applicant for a re-issue who has assigned his interest, and is still obliged to make oath that the mistake occurred "through inadvertence, etc.," is not merely a formal party and a perfunctory affiant, and his assignee is bound by his statements and declarations, see *Ex parte* Mahnken (1887), 41 O. G. 1269.

[2] That the oath to a re-issue application must aver that the applicant believes that he is the original and first inventor, and that the invention was never before known or used, and must allege his citizenship, see *Ex parte* Whitely (1886), 36 O. G. 1243.

That an affidavit, on an application for re-issue, that the original is "not fully valid and available" is not sufficient and the re-issue is void, see Poage *v.* McGowan (1883), 15 Fed. Rep. 398; Whitely *v.* Swayne (1865), 4 Fisher, 117.

That the rule requiring a detailed statement under oath is imperative, and unless observed the application will not be examined, see *Ex parte* Whitely (1886), 36 O. G. 1243; *Ex parte* Timken (1883), 24 O. G. 1088.

That the rule requiring a statement to be filed with a re-issue application, accounting for the defects in the original, is not retroactive, see *Ex parte* Pfaudler, (1882), 23 O. G. 269.

That the statement required to be filed with a re-issue application must set out the facts on which the application is based, not merely the opinions or conclusions of the person who prepares the paper, pointing out the defects which render the original invalid and showing

patents for the same invention, if any have been issued to the applicant or to others by his consent, with their dates and numbers and the extent to which the invention has been used in the United States, in the same manner as on an original application.[3]

§ 706. Procedure on Applications for Re-issue: The Specification, Drawings, and Model.

The language of the amended specification must correspond with that of the original unless some sufficient reason for a change appears. In an original Description the widest latitude in the use of terms may be permitted, but in the re-issue specification, where the identity of the invention must, at all hazards, be preserved, no unnecessary divergence from the words in which it was originally stated can safely be allowed. New names, new uses, new descriptive matter tend to create uncertainty in this respect, and may easily be made to cover some unwarrantable departure from the original invention. Except where the correction of the errors in the previous description requires the employment of additional or substituted phraseology, the rules followed by the Patent Office in passing upon the formal sufficiency of the amended specification, therefore, restrict it to the statements made in the original.[1] New drawings must accompany the specifica-

how they arose, see *Ex parte* Timken (1883), 24 O. G. 1088; *Ex parte* Wilkins (1883), 24 O. G. 1270; *Ex parte* Pfaudler (1882), 23 O. G. 269.

That a statement of reasons for re-issue, which merely alleges "misunderstanding," is not sufficient, see *Ex parte* Wilkins (1883), 24 O. G. 1270.

That, except for the Patent Office rules, the invalidity of the original need not be sworn to, and though an oath were required its omission would not invalidate the re-issue, see Hartshorn *v.* Eagle Shade Roller Co. (1883), 25 O. G. 1191; 18 Fed. Rep. 90; Burr *v.* Duryee (1862), 2 Fisher, 275.

That it is not imperative on the Patent Office that the fact that the original is inoperative, should have been judicially ascertained, see Burr *v.* Duryee (1862), 2 Fisher, 275.

[3] That under the rules re-issue as well as original applications require an oath disclosing foreign patents and the extent of use in the United States, see *Ex parte* Beck (1880), 17 O. G. 329.

§ 706. [1] In *Ex parte* Underwood (1872), 1 O. G. 549, Leggett, Com.: (549) "In applications for patents the examiner should interfere as little as possible with the language chosen by the applicant in describing his invention. The largest latitude should be allowed; but in applications for re-issues a different rule does and should prevail. The applicant should be held

tion when the invention is capable of such delineation, conforming in their style, number, and artistic perfection to the regulations governing original drawings. These new drawings are allowed to vary from the old only where the variation appears in the original model or relates to some unimportant matter not affecting the invention claimed. The amendment of the model is, in like manner, limited to features found in the original drawings.

§ 707. Procedure on Applications for Re-issue: Filing of the Application in the Patent Office.

The application, thus composed, is presented to the Patent Office by forwarding it in the usual mode to the Commissioner, accompanied by the statutory fees. This entitles the applicant to the consideration of his case, and if the Commissioner refuses to proceed with its examination, he may be compelled to do so by mandamus.[1] A hearing on an application for re-issue takes precedence over those on ordinary applications, and will be particularly expedited if the term of the original patent has almost expired.[2] The filing of the

rigidly to the language adopted in his patent, except that a good reason appears for departing from such language. In objecting to the use of new terms, new descriptive matter, etc., the examiner is not bound to give reasons. It is enough that such terms and descriptive matter are new; and it devolves upon the applicant to show good reason for their introduction, or they must be stricken out. A different rule would open a wide door to fraud. A patentee, if allowed to interpolate new uses, new descriptive matter, new names, etc., might, by frequent re-issues, keep full pace with the advancement in the art to which his patent pertains, and might thus appropriate to his own use the improvements and inventions made by others. The rule should be: *liberality with original applications; strict construction with applications for re-issue.*"

See also Hatch *v.* Moffitt (1883), 15 Fed. Rep. 252.

That the specification of the re-issue may be made more full and precise than the original, in order to cover the real invention, see Washburn & Moen Mfg. Co. *v.* Haish (1880), 4 Fed. Rep. 900; 10 Bissell, 65; 19 O. G. 173.

That a re-issue containing a broad Claim binds the patentee even though it does not secure his invention, see Wisner *v.* Grant (1880), 18 O. G. 192; 7 Fed. Rep. 922.

§ 707. [1] That where an applicant for a re-issue has filed his application and paid his fees and done all he can to make the application effectual, it is the duty of the Commissioner to hear it although he may not have accepted the fees, and if he refuses, a mandamus will lie to compel a hearing, see Commissioner *v.* Whitely (1866), 4 Wall. 522.

[2] That where a patent has nearly expired, its re-issue may be expedited in the Patent Office, see *Ex parte* Evarts (1874), 5 O. G. 429.

application does not preclude the applicant from resuming his rights under the former patent; but at any time before the re-issue has been granted he may withdraw his application, revoke his surrender, and be restored to his original position.[3]

§ 708. Procedure on Applications for Re-issue: Examination of the Application on the Merits of the Invention.

The specification annexed to a re-issue application is subject to revision, restriction, division, and other formal corrections in the Patent Office, to the same extent as an original specification.[1] An examination of the application on its merits involves an inquiry into the patentability of the invention therein described and claimed, into the identity of such invention with the invention attempted to be covered by the former patent, and into the cause from which

[3] In Forbes *v.* Barstow Stove Co. (1864), 2 Clifford, 379, Clifford, J.: (385) "The surrender is, undoubtedly, as is contended by the respondents, the act of the party making the application; but it is a mistake to suppose that the application may not be withdrawn, under leave of the Commissioner, for good cause shown, at any time before the proceedings are fully completed and duly recorded. The re-issued letters-patent, as a general rule, have the effect to supersede the original patent, but a pending application for that purpose cannot receive any such construction, no matter how nearly the proceedings may have approached to a consummation, so long as they are not finally completed. Prior to the issuing of the new patent, what is called a surrender in the case is in general nothing more than a preliminary offer to that effect, as the necessary means of obtaining a re-issue; and even when not so intended in the outset it may be subsequently so treated by the Commissioner, at the request of the party applying for the re-issue."

§ 708. [1] That the re-issue application will not be examined unless the statement is sufficient, see *Ex parte* Timken (1883), 24 O. G. 1089.

That the Claims of a re-issue application will not be examined on their merits in connection with the sufficiency of the statement, but in their proper order, see *Ex parte* Timken (1883), 24 O. G. 1089.

That in a re-issue application the examiner must first determine the sufficiency of the application itself; and if the applicant is not entitled to a re-issue the proceedings will terminate, but if the application and statement are sufficient an examination on the merits will be had, and if it then appears that the original was not inoperative, etc., or that its defects did not result from mistake, etc., or that the claim of the applicant is barred by the references cited, etc., the application will be rejected, the reasons for the rejection stated, and an opportunity given for an appeal, see *Ex parte* Ernst (1885), 33 O. G. 235.

the alleged error in the original arose. In examining the patentability of the invention the same questions as to its novelty, utility, abandonment, and the priority of the applicant's inventive act, are presented as on original applications, and the claim of the applicant as to any one of these questions is not aided by the fact that the invention has already once received the protection of a patent, and that the validity of the patent has been vindicated in the courts.[2] Even the repetition in the re-issue application of the exact Claims of the original patent does not exempt them from this examination or from the judgment which may be pronounced upon them by the Patent Office. The novelty of the invention is determined according to the state of the art at the date of the original application, not at that of the re-issue, since if the invention was then new to the public no subsequent advances in the arts can deprive it of the novelty which it possessed when the inventor first endeavored to protect it.[3] Its utility is measured by the usual standards. Abandonment is evidenced by more than two years' public use and sale before the original application, by an omission to claim it in the original patent after clearly describing it and an unreasonable delay in curing the omission by a re-issue, and by any other conduct of the inventor, either before or since the issue of the original patent, which proves an intention upon his part to dedicate the invention to the public.[4] That the invention

[2] That in an application for a re-issue, its Claims are subject to revision by the Patent Office though they have been sustained by the courts, see *Ex parte* Cox (1873), 3 O. G. 2.

[3] That on an application for a re-issue the patentability of the invention will be examined in view of the state of the art at the time when the original patent was applied for, see Carroll *v.* Morse (1876), 9 O. G. 453; Carlton *v.* Bokee (1872), 17 Wall. 463; 2 O. G. 520; 6 Fisher, 40.

That on an application for a re-issue the right of the re-issue applicant to the inventions claimed in his re-issue application will be examined in view of the state of the art as indicated by inventions made both before and since the original was granted, and by the claims of rival inventors, see Sargent *v.* Burge (1876), 10 O. G. 285.

That the re-issue is void for want of novelty if the original was, see Jones *v.* McMurray (1877), 3 Bann. & A. 130; 2 Hughes, 527; 13 O. G. 6.

[4] That on an application for a re-issue two years' public use of the invention before the original application may be shown, and will be fatal, see Funck *v.* Doty (1878), 14 O. G. 157.

That for all purposes of abandonment by public use and sale, the date of the re-issue is the date of the original,

was first conceived and reduced to practice by the alleged inventor is established *prima facie* by the oath accompanying the application, but may be contradicted by the records of the Patent Office or the personal knowledge of the examiner. The practice in regard to the objections and references of the examiner, as well as to amendments, arguments, rejections, and appeals, is similar to that in cases of original applications.

§ 709. Procedure on Applications for Re-issue: Examination of the Application as to the Identity of the Invention with that Described in the Original Patent.

In examining the identity of the invention claimed in the re-issue application with that attempted to be covered by the original patent, the examiner must be guided, not by his personal judgment or discretion, as in amendments to original applications, but by the rules specifically prescribed in the statutes and the decisions of the courts. The inventions are not identical unless all the essential characteristics of the one described and claimed in the re-issue application were described or attempted to be described in the original specification, drawings, or model as part of the patented invention.[1] In a machine-patent, for reasons hitherto recited, this identity must appear by a comparison of the drawings and models, which can be amended only by each other.[2] In other cases where drawings and models exist, the identity is determined

see Shaw *v.* Colwell Lead Co. (1882), 11 Fed. Rep. 711 ; 20 Blatch. 417.

That Sec. 32, act of 1870, making two years' delay in prosecuting an application an abandonment of it, does not relate to re-issue applications, see *Ex parte* Galusha (1873), 3 O. G. 321.

That things abandoned before the issue of the original patent cannot be claimed in the re-issue, see *Ex parte* Conklin (1872), 2 O. G. 543.

§ 709. [1] That on an application for a re-issue, parol evidence is not admissible to enlarge the scope of the invention beyond that shown in the original specification, drawings, and model, see Glue Co. *v.* Upton (1874), 6 O. G. 837 ; 4 Clifford, 237 ; 1 Bann. & A. 497 ; Collar Co. *v.* Van Deusen (1874), 23 Wall. 530 ; 7 O. G. 919 ; Cahart *v.* Austin (1865), 2 Clifford, 528 ; 2 Fisher, 543.

[2] That under the act of 1870 the Commissioner, in allowing a re-issue, cannot look outside the original specification, drawings, and model, except that in machine-patents, where the model is no longer in existence, extrinsic proof may be examined to determine what the machine really was, see Giant Powder Co. *v.* California Powder Works (1875), 3 Sawyer, 448 ; 2 Bann. & A. 131.

by comparing the entire descriptions, as contained in these and in the specifications to which they are annexed, with one another. Where there are no drawings or models, and the description in both the original and the re-issue applications, therefore, rests in words alone, extrinsic proof may be offered and received to establish this identity.[3]

§ 710. Procedure on Applications for Re-issue: Examination of the Application as to the Mode in which the Defects in the Original Arose.

The examination into the cause from which the alleged error in the original arose may be conducted according to the discretion of the Commissioner, provided it be done without prematurely disclosing the pendency of the re-issue application. The affidavit of the applicant is *prima facie* proof that the error occurred through inadvertence, accident, or mistake, and without fraudulent or deceptive intention; but this is open to contradiction or to confirmation by the records of the Patent Office, the affidavits of its officers, or any other evidence satisfactory to the Commissioner which can be obtained without a violation of the secrecy to which the applicant is entitled. The existence of this condition must be established before the re-issue can be legally allowed.[1] But

[3] That on an application for a re-issue the Commissioner may examine the original specifications, drawings, model, or any other legal proof, in order to ascertain the identity of the inventions, see Hussey *v.* Bradley (1863), 2 Fisher, 362; 5 Blatch. 134.

That where no model or drawing accompanies the original patent great care should be exercised to exclude new matter from the re-issue, see *Ex parte* Gottstein (1877), 11 O. G. 1061.

That extraneous evidence as to a model destroyed by fire, or other lost records, will not be received on a re-issue application, see *Ex parte* Williams (1878), 14 O. G. 202.

§ 710. [1] That no re-issue ought to be allowed by the Commissioner unless the applicant shows that the original was defective through mistake, and not through fraud, and points out in what the mistake consisted, see *Ex parte* Conklin (1874), 1 MacArthur, 375; 5 O. G. 235.

That an assignee cannot re-issue to cover additions unless he proves that the additions were made by the inventor, and were intended to be patented by him, and were omitted by mistake, see Opinion Atty. Gen. (1833), 2 Op. At. Gen. 572.

That the testimony of the patentee, who re-issued his patent after thirteen years, that "he thought" the original was defective and ought to cover the additional matter, does not prove original inadvertence or mistake, see Newton *v.* Furst & Bradley Mfg. Co. (1886), 119 U. S. 373; 38 O. G. 104.

the question relates to the intention of the inventor at the date of his original application, not to his conduct since that time, except so far as it throws light on his intention then; and if the error then was unintentional, his subsequent attitude toward individual third parties cannot estop him from asserting his right to amend his patent.[2]

§ 711. Procedure on Applications for Re-issue: Interferences.

An application for a re-issue is liable to be placed in interference with a pending original application, with another application for re-issue, or with an unexpired patent, whenever the inventions claimed in each are apparently identical. An interference will be declared, under the rules, between an application for a re-issue and a conflicting original application, if the original application was pending when the patent whose re-issue is desired was granted, or if the party presenting the original application makes oath that he performed his own inventive act before the filing of the application for the patent upon which the proceedings in re-issue have been based. An interference will be declared between two or more conflicting applications for re-issue when their respective patents were granted upon applications pending at the same time, or when the applicant for the re-issue of the later patent avers on oath that his inventive act preceded the filing of the application for the earlier patent. An interference will be declared between an application for a re-issue and a conflicting unexpired patent when the original applications for both patents were pending at the same time, and the re-issue applicant makes oath that his inventive act occurred before the original application of the other patentee

[2] That an applicant for a re-issue is not estopped from claiming it by his conduct toward outside parties, see *Ex parte* Roe (1874), 5 O. G. 397. This case rests upon the doctrine that an estoppel in favor of individual parties does not enure to the public benefit, and is consequently no bar to a re-issue of the patent as against the public. But if it be true, as many cases seem to indicate, that an inventor may estop himself to claim the invention as against the public, or that estoppel may constitute one step in that series of events which results in an abandonment of the invention to the public by the act of some rival inventor, there is no reason why a re-issue applicant should not be bound by his commissions or omissions to the same extent as any other claimant of an invention. See §§ 346, 357, 390, and notes, *ante*.

was filed, or when the original application for the patent whose re-issue is desired was filed after the other patent had been granted and the re-issue applicant presents an affidavit that his invention was completed before the filing of the application for the earlier patent. Where an interference has been declared between a patent and an application, and pending the interference an application is made for the re-issue of the patent, the re-issue application is examined on its individual merits, and if allowed, will take the place of the original patent in the interference.[1] A re-issue application, describing but not claiming an invention involved in interference, may be amended by the insertion of such Claim and be, thereupon, admitted to the contest. The proceedings upon an interference are the same whether the applications are for a re-issue or for an original patent.

§ 712. Procedure on Applications for Re-issue: Appeals.

From an adverse decision of the examiners upon any question relating to the merits of the application, an appeal lies to the examiners-in-chief, and thence successively to the Commissioner, the Supreme Court of the District of Columbia, and to the Supreme Court of the United States, except in interference cases, where the decision of the Commissioner is final. Although an application for re-issue has been duly allowed and passed by the examiners, the patent is still subject to the control of the Commissioner, and like an original patent may be withheld by him upon sufficient grounds.[1] If

§ 711. [1] That where the original patent is in interference, and not the re-issue-application, the re-issue-application will be examined, and on the surrender and cancellation of the original patent will be substituted for it, see *Ex parte* Zay (1881), 19 O. G. 1496.

That where the re-issue-application contains no Claim involved in the interference declared with the original, the application should not be placed in interference, see *Ex parte* Zay (1881), 19 O. G. 1496.

That where a patent has been surrendered for re-issue, an interference declared, an adverse decision rendered, and a re-issue refused, the patent is entirely avoided, see Peck *v.* Collins (1881), 103 U. S. 660; 19 O. G. 1137.

§ 712. [1] That a re-issue patent, though signed, may be withheld on account of a protest against its issue, see *Ex parte* Hunt (1879), 15 O. G. 831.

That after the Patent Office decides to re-issue a patent, a stranger cannot have access to the records of the proceedings in order to discover objections and contest it, see Dec. Sec. Int. (1883), 23 O. G. 629.

refused by one Commissioner his successor should not grant it without a careful re-examination of the case, and a clear conviction that the former judgment was erroneous.[2]

§ 713. Date and Term of Re-issued Patent.

A re-issued patent bears the date of the original for all purposes, except as the foundation of an action for infringement.[1] When the term of the re-issue is expressed in years, the term runs from the grant of the original.[2] When the original was limited by the duration of a foreign patent, the re-issue is subject to the same limitation.[3] The rights of all parties claiming under the re-issue, whether as against the public or against rival claimants, are held to have accrued when the original patent issued, and are interpreted and enforced according to the circumstances then existing.[4] All rights of action for the infringement of the original patent are, however, extinguished by its surrender, and suits pending at the date of the re-issue are abated.[5]

[2] That a re-issue withheld by one Commissioner will not be granted by his successor without a careful examination of the case, see *Ex parte* Hunt (1879), 15 O. G. 831.

§ 713. [1] That the re-issue bears the date of the original, except as to suits for infringement, see House *v.* Young (1867), 3 Fisher, 335; Hussey *v.* Bradley (1863), 2 Fisher, 362; 5 Blatch. 134; Bloomer *v.* Stolley (1850), 5 McLean, 158; Woodworth *v.* Hall (1846), 1 W. & M. 248; 2 Robb, 495; Stanley *v.* Whipple (1839), 2 McLean, 35; 2 Robb, 1; Shaw *v.* Cooper (1833), 7 Peters, 292; 1 Robb, 643; Grant *v.* Raymond (1832), 6 Peters, 218; 1 Robb, 604.

That the decision of the Commissioner that the date of the invention described in the re-issue was the date of the original patent is final, see House *v.* Young (1867), 3 Fisher, 335.

[2] That a re-issue granted for a specific term begins at the date of the original patent, see Whitely *v.* Fisher (1870), 4 Fisher, 248.

[3] That the law, not the language of the patent, decides when a re-issue becomes operative, see Whitely *v.* Fisher (1870), 4 Fisher, 248.

[4] That the rights of the patentee under the re-issue are governed by the law in force at the date of the original, see Shaw *v.* Cooper (1833), 7 Peters, 292; 1 Robb, 643.

[5] That the surrender extinguishes the original patent, and all rights of action under it fall with it, see Jones *v.* Barker (1882), 22 O. G. 771; 11 Fed. Rep. 597; Peck *v.* Collins (1880), 103 U. S. 660; 19 O. G. 1137; Moffitt *v.* Gaar (1861), 1 Black, 273.

That as all pending suits fail with a surrender of the patent for re-issue, there can be no continuance to obtain a re-issue, see Jones *v.* Barker (1882), 22 O. G. 771; 11 Fed. Rep. 597.

That a re-issue can affect only suits subsequently begun, see United States Stamping Co. *v.* King (1879), 17 O. G. 1399; 17 Blatch. 55; 7 Fed. Rep. 860; 4 Bann. & A. 469.

§ 714. Decision of Commissioner in Allowing a Re-issue, how far Conclusive.

The effect of a decision of the Commissioner in granting a re-issue, and the extent to which his decision is reviewable by the courts, are questions which have given rise to much discussion.[1] Upon principle, the problem seems to be a simple

§ 714. [1] Upon the effect of the award of a re-issue by the Commissioner the courts are to this day undecided, and the judgments of different tribunals are apparently irreconcilable. In several earlier cases it was held that the action of the Commissioner was conclusive unless fraud in obtaining and allowing the re-issue was alleged and proved. His power to determine the identity of the inventions covered by the re-issued and original patents was treated as final, and except in such palpable and unwarranted enlargements as implied a fraud, the re-issue could *not* on *this* ground be *im*peached. Thus in Whitely *v.* Swayne (1865), 4 Fisher, 117, Leavitt, J.: (123) "It is insisted by the counsel for the complainant, that the decision of the Commissioner of Patents in granting the re-issues is conclusive, and that the court cannot look into anything that transpired antecedently to the grant to impeach the validity of the re-issued patent. This is undoubtedly the settled law in this country, so far at least as to the identity of the original invention, and the invention as described and claimed in the application for the re-issue, unless fraud in the transaction is alleged. The Commissioner is supposed to have all the qualifications necessary to an intelligent decision of that question, and there are strong reasons why his action should be regarded as final. Such I understand to be doctrine of the Supreme Court of the United States, as announced in numerous reported cases. 4 How. 404; 15 How. 62; 17 How. 84; Law's Dig. 617. But I am not aware that the Supreme Court have decided in any case that it is not competent to inquire whether the Commissioner has exceeded his authority in granting a patent, without a compliance with the requirements of the statute. He has clearly no power to dispense with what the statute declares to be necessary prerequisites to the grant. And if it appears from the papers and records of the Office in evidence that the statutory requirements have not been complied with, it is within the power of a court, and its plain duty, to hold the patent to be void. Such was the doctrine announced by Judge Hall in the case of Ransom *v.* Mayor of New York, Law's Dig. App. 57. The learned judge says: 'Things specified in this section (6th section of the act of 1836) are prerequisites to the granting of a patent, and unless these prerequisites are complied with, a party sued for an infringement of the patent may show that they have not been complied with, and in that mode defeat the action of the supposed inventor.' The soundness of this doctrine cannot be successfully controverted. It would be straining the doctrine of presumptions in favor of the legality of the acts of a public officer to an unreasonable extent to hold that a patent is legal and valid where the records and papers of the Office show conclusively that essential statutory provisions had been disregarded."

Also in Swift *v.* Whisen (1867), 3 Fisher, 343, Leavitt, J.: (351) "But the statute makes it the special duty of the Commissioner of Patents to examine closely every application for a re-

one. The Commissioner is a judicial officer, empowered under

issue, and he is vested with no authority to grant a re-issue except under circumstances where the statute has been complied with. It is to be supposed, in support of the exercise of the authority of the Commissioner of Patents under the law, that all the requisites of the statute have been complied with, and hence it is the uniform doctrine of all the courts of the United States that they will presume that the law has been complied with, and they refuse, except under special circumstances referred to in the act, to go into any inquiry back of the grant by the Commissioner of Patents of these re-issues; in other words, to a certain extent they consider the action of the Commissioner upon the right of parties to a re-issue to be conclusive; presuming that all the requirements of the law have been enforced, have been complied with, in the case. The decisions upon the general doctrine to which I have referred, namely, to the effect that the action of the Commissioner is conclusive upon the question of the identity of the inventions embraced or described in the re-issue and in the original patent, would seem to be harmonious. There is no case, that I am aware of, in conflict with this general proposition; and these decisions rest upon the fact that in deciding whether the re-issue is for the same invention, the Commissioner of Patents, who acts, of course, under the obligation of an oath, acts in that particular in a judicial capacity. His decisions, therefore, on points of that kind, have the force and effect of judicial decisions, and courts are reluctant to go back of those decisions and to inquire whether the re-issue has been properly granted or not, except in cases where it is made apparent that the re-issue was obtained by fraud, or for the purposes of deception and imposition. But if any facts appear in the progress of a trial, which are sufficient to satisfy a jury that there has been fraud in the procurement of a re-issue, — either actual fraud, or circumstances which may be supposed to amount to constructive fraud, — the re-issued patent will be held invalid. There is a plain distinction between actual fraud and constructive fraud. The statute refers, specially, to cases of collusion, — fraudulent, corrupt collusion between the applicant for the patent and the Commissioner of Patents. If it is apparent that there has been any improper collusion between them, and that the patent has been granted corruptly, then, of course, that is an act of positive fraud that will invalidate any patent to which it applies. And there may be also constructive fraud, where it is made manifest that the re-issued patent is fraudulently extended beyond the claims of the original patent for a deceptive purpose, for the purpose of imposition upon the public, and where there is no just foundation for such a claim in the original patent; where, in fact, the re-issue goes altogether beyond the scope of the original invention and incorporated an element that was not contemplated or intended by the original patentee in his original patent. Cases of this kind have occurred in the progress of the execution of the patent laws of the country where re-issues have been fraudulent, — that is, where they have been tainted with this constructive fraud; where it appeared that, for a deceptive purpose, a party applying for a re-issue had sought to embrace an element in the re-issued patent that was not claimed and did not pertain to the original invention, for the purpose of taking advantage of other parties in the community who were using that element which he had fraudulently

certain circumstances to issue letters-patent, and while acting

made a part of his original invention." 2 Bond, 115 (125).

See also Jordan *v.* Dobson (1870), 2 Abbott, 398 ; 7 Phila. 533 ; 4 Fisher, 232.

It soon, however, became evident that the imputation of such comprehensive powers to the Commissioner on a more *ex parte* proceeding was at variance with the rights of individuals and with public policy. The position was then adopted by the courts that whenever it appeared on the face of the original and re-issued patents that the inventions embraced therein were not identical, the Commissioner had exceeded the authority conferred upon him by the statutes and that the award of the re-issue *might* be held *invalid* ; and, on the other hand, that where the want of identity was not apparent on comparing the two patents, the action of the Commissioner could not be impeached on any ground whatever, except for fraud in allowing the re-issue, and this only in a proceeding instituted for that purpose. This position has been maintained in numerous cases and is still adhered to by many of our courts. Thus in Seymour *v.* Osborne (1870), 11 Wall. 516, Clifford, J. : (543) "Where the Commissioner accepts a surrender of an original patent and grants a new patent, his decision in the premises, in a suit for infringement, is final and conclusive, and is not re-examinable in such a suit in the Circuit Court, unless it is apparent upon the face of the patent that he has exceeded his authority, that there is such a repugnancy between the old and the new patent that it must be held, as matter of legal construction, that the new patent is not for the same invention as that embraced and secured in the original patent."

In Jordan *v.* Dobson (1870), 4 Fisher, 232, Strong, J. : (237) "It must be assumed, therefore, he did determine there were defects in the former specifications arising from inadvertence, accident, or mistake, without any fraudulent intention. And having thus determined, his decisions are conclusive. They are not re-examinable, except so far as he decided there was no fraud. It is now settled that the granting of a renewed patent is so far conclusive upon the question of the existence of error in the original patent arising from inadvertency, accident, or mistake, that it leaves nothing open but the fairness of the transaction. Stimpson *v.* Westchester R. R. Co., 4 Howard, 380 ; Woodward *v.* Stone, 3 Story, C. C. R. 749 ; Allen *v.* Blunt, 3 Story, C. C. R. 742 ; Curtis on Patents, 280." 2 Abbott, 398 (404) ; 7 Phila. 533 (536).

In Collar Co. *v.* Van Dusen (1874), 23 Wall. 530, Clifford, J. : (558) "Unless, however, it is apparent upon the face of the new patent that the Commissioner has exceeded his authority, his decision is final and conclusive, as the jurisdiction to re-issue patents is vested in him subject to a single exception, that if there is such repugnancy between the old and the new patent that it must be held, as matter of legal construction, that the re-issued patent is not for the same invention as that embraced and secured in the original patent, then the re-issued patent is invalid." 7 O. G. 919 (920).

In Wells *v.* Jacques (1874), 1 Bann. & A. 60, Nixon, J. : (68) "His application is made to the Commissioner of Patents, and that officer, not this court, is the tribunal in which Congress has vested the power of determining whether sufficient reasons exist to grant the re-issue. His decision in the matter is final, in the sense that there is no appeal from it ; and it does not seem to

within his jurisdiction his judgments are conclusive and can-

be re-examinable here, unless it is evident upon the face of the re-issue that he has exceeded his authority, and that there is such a repugnancy between the old and the re-issued patent that it must be held, as a matter of legal construction, that they are not the same invention. Seymour *v.* Osborne, 11 Wall. 543." 5 O. G. 364 (366).

In Birdsall *v.* McDonald (1874), 6 O. G. 682, Swayne, J.: (683) "The Commissioner of Patents awarded the re-issue. The subject was placed by the law within his jurisdiction. His decision is to be held *prima facie* correct in all cases, and it is conclusive, unless impeached for fraud, or unless it is clear upon the face of the several specifications that the re-issue is not for the same thing as the original patent. Where a remedy is sought for fraud it must be in an independent proceeding had directly for that purpose by a bill in equity in the name and by the authority of the United States." 1 Bann. & A. 165 (170).

In Russell *v.* Dodge (1876), 93 U. S. 460, Field, J.: (464) "The decision of the Commissioner in granting the re-issue is, it is true, so far conclusive as to preclude in the present suit for infringement any inquiry into its correctness outside of the patents themselves. His action, in any case within the limits of his authority, is not open to collateral impeachment. But that authority being limited to a re-issue for the same invention as that embraced in the original patent, a re-issue for anything more is necessarily inoperative and void. To determine the identity of the invention the two patents may be compared. Thus compared, the re-issue here appears on its face to be for a different invention, and the Commissioner, therefore, exceeded his authority in issuing it." 11 O. G. 151 (152).

In Kells *v.* McKenzie (1881), 20 O. G. 1063, Brown, J.: (1063) "Under this section it is now settled that the decision of the Commissioner re-issuing the patent is final and conclusive, and is not subject to review in any court, except as to the identity of the invention. But if it be apparent upon the face of the patent that he has exceeded his authority, and has thus acted without jurisdiction, and that there is a manifest repugnancy between the old and new patent, then it must be held, as a matter of legal construction, that the new patent is not for the same invention as that embraced and secured in the original patent." 9 Fed. Rep. 284 (286).

In Spaeth *v.* Barney (1885), 22 Fed. Rep. 828, Colt, J.: (829) "The authorities are numerous and conclusive to the effect that where the Commissioner accepts the surrender of an original patent, and grants a new patent, his decision is final and conclusive in a suit for infringement, unless it is apparent on the face of the patent that he has exceeded his authority; that there is such a repugnancy between the old and the new patent that it must be held, as matter of legal construction, that the new patent is not for the same invention as that embraced in the original patent." 30 O. G. 997 (997).

To the same effect see American Diamond Rock Boring Co. *v.* Sheldon (1879), 17 Blatch. 208; Thomas *v.* Shoe Mach. Mfg. Co. (1878), 16 O. G. 541; 3 Bann. & A. 557; Russell *v.* Dodge (1876), 93 U. S. 460; 11 O. G. 151; Union Paper Collar Co. *v.* White (1875), 11 Phila. 479; 7 O. G. 698, 877; 2 Bann. & A. 60; La Baw *v.* Hawkins (1874), 1 Bann. & A. 428; 6 O. G. 724; Milligan & Higgins Glue Co. *v.* Upton (1874), 6 O. G. 837; 4 Clifford, 237; 1 Bann. & A. 497; Nicholson Pave-

not be collaterally attacked.[2] If he exceeds the limits of his jurisdiction, as fixed by law, his acts are void.[3] The courts

ment Co. *v.* Elizabeth (1873), 3 O. G. 522 ; 6 Fisher, 424 ; Parham *v.* American Buttonhole, Overseaming, & Sewing Machine Co. (1871), 4 Fisher, 468 ; Chicago Fruit House Co. *v.* Busch (1871), 2 Bissell, 472 ; 4 Fisher, 305 ; Blake *v.* Stafford (1868), 6 Blatch. 195 ; 3 Fisher, 294 ; Middletown Tool Co. *v.* Judd (1867), 3 Fisher, 141 ; Potter *v.* Holland (1858), 4 Blatch. 235 ; 1 Fisher, 382.

That a re-issue cannot be attacked by an infringer unless fraudulent or contrary to law or issued to the wrong party, see Dental Vulcanite Co. *v.* Wetherbee (1866), 3 Fisher, 87 ; 2 Clifford, 555.

The abuses which arose under this doctrine were its inevitable consequence. As any re-issue which the Patent Office could be prevailed upon to grant, whether it were for the original invention or not, and whether the defects which it corrected were intentional or otherwise, became impregnable in the courts unless the repugnancy between it and the original was manifest on the inspection of the two patents, patentees whose original patents covered all they had invented or at that time thought of claiming as their inventions, naturally took advantage of the general and indefinite language of their original specifications, and based upon them re-issue claims far beyond the limits of their own inventive acts, and under this doctrine vindicated their unwarranted assumptions even in the highest tribunal of the nation. In the effort to prevent or thwart these abuses the courts had recourse to various theories, in order, if possible, to remedy the evil without placing a further limitation on the powers of the Commissioner. By holding that the decision of the Patent Office on the origin of the amended defect, as well as on the identity of the inventions, was reviewable, they would at once have removed all difficulty ; since by permitting an inquiry into the character of the actual invention, and the intentional or unintentional omission or misstatement in the original specification, they would have limited every re-issued patent to the exact inventions which the patentee originally intended to secure. Reverence for the settled course of decisions forbade this heroic remedy and led to the introduction of other doctrines, intended to protect intervening public and private rights, which have in their turn created new difficulties and required perpetual explanation and modification in the courts. The current of legal and judicial opinion, however, seems to be moving steadily toward the only true solution of this question, as set forth in the remainder of this paragraph and in the cases cited in its notes.

[2] That the Commissioner's action in granting a re-issue is not open to review in cases where he has jurisdiction, see Ball *v.* Langles (1880), 102 U. S. 128 ; 18 O. G. 1405 ; Wells *v.* Gill (1872), 2 O. G. 590 ; 6 Fisher, 89.

[3] In *Odell v.* Stout (1884), 22 Fed. Rep. 159, Sage, J. : (161) "The action of the Commissioner of Patents is not *res adjudicata*. Cook *v.* Ernst, 2 O. G. 89. He is not an officer in whom, under the constitution, judicial power can be vested. Grant *v.* Raymond, 6 Pet. 242. If he were, the proceedings for procuring original letters and re-issues are *ex parte* and would not estop defendants, charged as infringers, upon questions affecting the validity of the patent. But the statutes, prescribing his powers and duties, vest in the Commissioner of Patents a discretion, which in some matters is final, and in others subject

have power to inquire whether a given act was within his jurisdiction or exceeded it, and according to the result of this inquiry they may treat his act as valid or invalid.[4] In refer-

to review. The authorities are not uniform; but the later cases, and some of not so recent date, are in harmony with the ruling made by Chief Justice Marshall in Grant *v.* Raymond, that the correct performance of all those preliminaries on which the validity of an original patent or of a re-issued patent depends, is always examinable in the court in which a suit for its violation is brought." 29 O. G. 862 (863).

In Giant Powder Co. *v.* California Vigorit Powder Co. (1880), 18 O. G. 1339, Field, J.: (1340) "The Commissioner is an officer of limited authority, and whenever it is apparent upon inspection of the patents that he has acted without authority or has exceeded it, his judgment must necessarily be regarded as invalid." 6 Sawyer, 508 (522); 4 Fed. Rep. 720 (725).

In Glue Co. *v.* Upton (1874), 6 O. G. 837, Clifford, J.: (838) "Jurisdiction to re-issue patents is vested in the Commissioner, and his decision in such an application is final and conclusive, and not re-examinable in a suit in the Circuit Court, unless it is apparent upon the face of the patent that the Commissioner has exceeded his authority, or that there is such a repugnancy between the old and the new patent that it must be held, as matter of legal construction, that the new patent is not for the same invention as that embraced and secured in the original patent." 4 Clifford, 237 (239); 1 Bann. & A. 497 (499).

That Sec. 4916, Rev. Stat., does not enlarge the powers of the Commissioner on a re-issue, see Powder Co. *v.* Powder Works (1878), 98 U. S. 126; 15 O. G. 289.

That the decision of the Commissioner on a re-issue is not final except within his jurisdiction, see Flower *v.* Rayner (1881), 19 O. G. 425; 5 Fed. Rep. 793; Metropolitan Washing Mach. Co. *v.* Providence Tool Co. (1872), Holmes, 161.

That no patent, whether re-issue or original, can be legal if the statutory prerequisites are not fulfilled, and where the non-fulfilment appears on the face of the patent or by the records of the Patent Office, the Commissioner has evidently exceeded his jurisdiction and the patent is void, see Whitely *v.* Swayne (1865), 4 Fisher, 117.

[4] In Giant Powder Co. *v.* California Vigorit Powder Co. (1880), 18 O. G. 1339, Field, J.: (1340) "As the power to accept a surrender and issue new letters is vested exclusively in the Commissioner of Patents, his decision in the matter is not open to collateral attack in a suit for the infringement of re-issued letters. His action, like that of all officers specially designated to perform a particular duty of a judicial character for the government, is presumed to be correct until impeached by regular proceedings to annul or modify it. He must judge, in the first instance, of the sufficiency of the original specification, whether the same is defective in any particular, whether such defect was the result of an unintentional error, and if so, to what extent a new or additional specification should be allowed to describe correctly the invention claimed; and it is to be assumed in every case that he has done his duty. The decisions of the Supreme Court to this effect are numerous, and the doctrine is among the settled rules of Patent Law. But it does not preclude the examination of the original and re-issued patents to see whether or not they disclose on their face a case in which the Commissioner had authority to act or whether

ence to re-issues the statutes confer on the Commissioner the power to amend a defective patent by re-issuing it in a corrected form. At the same time they prohibit the exercise of this power in such a manner as to introduce into the re-issue any new invention,[5] or to cure any defect which was originally intentional, or fraudulent.[6] In accepting a surrender and

he has exceeded his authority in issuing letters for an invention different from that described in the original patent. If they disclose a case in which the Commissioner has no jurisdiction to act, or a case in which, by his determination, he has exceeded his jurisdiction, the re-issued letters must fall. His determination can have no greater conclusiveness than that of the judgment of a regular judicial tribunal, and we all know that although such judgment cannot be collaterally attacked by showing that the evidence upon which the court acted was insufficient, that improper testimony was admitted, that the court erred in its rulings upon matters of law, or that the verdict of the jury was against the weight of evidence, yet the record of the judgment can in all cases be examined to see whether the court had jurisdiction of the subject-matter and of the person of the defendant, and if such jurisdiction be wanting the judgment is ineffectual for any purpose. So here upon all matters outside of the patents which the Commissioner was to hear, and upon the weight of which he was to determine, his judgment is conclusive in the present suit; but if the patents disclose a case in which he had no jurisdiction or in which he exceeded it, his determination carries with it no efficacy." 6 Sawyer, 508 (520); 4 Fed. Rep. 720 (723).

That where the Commissioner exceeds his authority in re-issuing a patent, under a mistake of law, the matter may be reviewed in actions for infringement, see Mahn *v.* Harwood (1884), 112 U. S. 354; 30 O. G. 657.

That the courts presume that in allowing a re-issue the Commissioner has done his duty, see Spaeth *v.* Barney (1885), 22 Fed. Rep. 828; 30 O. G. 997; Jordan *v.* Dobson (1870), 2 Abbott, 398; 7 Phila. 533; 4 Fisher, 232.

[5] That the Commissioner has exceeded his jurisdiction when the re-issue on its face covers a different invention from that described in the original, see Giant Powder Co. *v.* California Vigorit Powder Co. (1880), 6 Sawyer, 508; 4 Fed. Rep. 720; 18 O. G. 1339; Ball *v.* Langles (1880), 102 U. S. 128; 18 O. G. 1405; Russell *v.* Dodge (1876), 93 U. S. 460; 11 O. G. 151.

That Sec. 4916, Rev. Stat. governs the mode of proof but does not give the Commissioner power to grant a re-issue for a different invention, or to determine conclusively that inventions are the same, see Averill Chemical Paint Co. *v.* National Mixed Paint Co. (1881), 22 O. G. 585; 20 Blatch. 42; 9 Fed. Rep. 462; Powder Co. *v.* Powder Works (1878), 98 U. S. 126; 15 O. G. 289.

[6] In Flower *v.* Rayner (1881), 5 Fed. Rep. 793, Nixon, J.: (795) "A careful reading of the section shows that the Commissioner has power to grant a re-issue only in special cases and under particular circumstances. The original patent must be inoperative or invalid, either for defective or insufficient specifications, or from claiming as new more than the patentee has the right to claim; and, in addition to this, the error which is sought to be corrected must have arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. If the party in-

granting a re-issue, the Commissioner, who has entire control over the language of a patent, thus acts within his jurisdiction, provided that the defects in the original patent arose without fraud, through inadvertence, accident, or mistake, and that no new matter is embraced in the re-issue. The courts cannot so far review this action as to declare that the original patent was not defective, that the surrender and re-issue were on that account of no effect, and that the original patent is consequently still in force. Nor can they hold that the original operative and valid patent was extinguished by the surrender, but that being originally valid and operative it could not be the subject of re-issue, and, therefore, that no patent in favor of the patentee can now exist. Endless confusion would arise if the jurisdiction of the Commissioner upon these points were not final.[7] But on the other hand, where the Commissioner, in

terested can bring himself within these conditions and limitations, the Commissioner is authorized to issue a new patent for the same invention. When the original shows upon its face that the grounds and reasons for the re-issue do not exist, or where a comparison of the letters-patent disclose different inventions, the re-issue is void, as an act unauthorized by the law." 19 O. G. 425 (425).

See also Giant Powder Co. *v.* California Vigorit Powder Co. (1880), 4 Fed. Rep. 720; 6 Sawyer, 508; 18 O. G. 1339.

That although other courts declare that the decision of the Commissioner in allowing a re-issue is final, the Supreme Court of the District of Columbia, on appeal from the decision of the Commissioner in refusing a re-issue do not hold such decision conclusive, but require evidence of original inadvertence, accident, or mistake, see *In re* Conklin (1874), 1 MacArthur, 375; 5 O. G. 235.

carried the court so far that, in appearance at least, it has decided that the inoperativeness or invalidity of the original patent may be re-examined, and if the opinion of the court differs from that of the Commissioner on that question, the re-issue may be declared void. Thus in Giant Powder Co. *v.* California Vigorit Powder Co. (1880), 4 Fed. Rep. 720, Field, J.: (723) "As thus seen, a re-issue can only be had when the original patent is inoperative or invalid from one of two causes, — either 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; and even then the patentee can only obtain a re-issue where the error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. As the power to accept a surrender and issue new letters is vested exclusively in the Commissioner of Patents, his decision in the matter is not open to collateral attack, in a suit for the infringement of re-issued letters. His action, like that of all officers especially designated to per-

[7] The recent disposition to treat the action of the Commissioner in awarding a re-issue as reviewable has, in one case

accepting the surrender and granting the re-issue, has included in the re-issued patent any new matter, or any matter

form a particular duty of a judicial character for the government, is presumed to be correct until impeached by regular proceedings to annul or modify it. He must judge, in the first instance, of the sufficiency of the original specification, — whether the same is defective in any particular; whether such defect was the result of an unintentional error, and if so, to what extent a new or additional specification should be allowed to describe correctly the invention claimed; and it is to be assumed in every case that he has done his duty. The decisions of the Supreme Court to this effect are numerous, and the doctrine is among the settled rules of Patent Law. But it does not preclude the examination of the original and re-issued patents, to see whether or not they disclose on their face a case in which the Commissioner had authority to act, or whether he has exceeded his authority in issuing letters for an invention different from that described in the original patent. If they disclose a case in which the Commissioner had no jurisdiction to act, or a case in which by his determination he has exceeded his jurisdiction, the re-issued letters must fall. His determination can have no greater conclusiveness than that of the judgment of a regular judicial tribunal; and we all know that although such judgment cannot be collaterally attacked by showing that the evidence upon which the court acted was insufficient, that improper testimony was admitted, that the court erred in its rulings upon matters of law, or that the verdict of the jury was against the weight of evidence, yet the record of the judgment can in all cases be examined to see whether the court has jurisdiction of the subject-matter and of the person of the defendant; and if such jurisdiction be wanting, the judgment is ineffectual for any purpose. So here, upon all matters outside of the patents which the Commissioner was to hear, and upon the weight of which he was to determine, his judgment is conclusive in the present suit; but if the patents disclose a case in which he had no jurisdiction, or in which he exceeded it, his determination carries with it no efficacy. This is general and universal law, although we find expressions in opinions that the only question left over for the consideration of the court, in a suit for infringement of re-issued letters, is whether the new and the old patent are for the same invention, — the expressions would be more accurate if they were, — that seldom could any other question be raised, for seldom will it appear without the consideration of extrinsic evidence whether or not the original patent was invalid or inoperative from a defect of specifications. Suppose, for illustration, that the specifications in two patents, the original and the re-issued, were identical in their language, — or, differing in phraseology, were identical in meaning, — would it be pretended that, though their identity would be thus manifest on their face from a comparison of the two, and that the Commissioner in granting the re-issue had accordingly acted in a case not warranted by the statute, it must be assumed that the re-issue was properly granted, and that the action of the Commissioner could not therefore be questioned? The decisions support no such conclusion. The Commissioner is an officer of limited authority; and whenever it is apparent upon inspection of the patents that he has acted without authority, or has exceeded it, his judgment must necessarily be regarded

which was fraudulently or intentionally excluded from the

as invalid. His action must be restricted to the particular cases mentioned in the statute. That only authorizes a re-issue when, from an unintentional error in the Description of the invention, the patent is invalid or inoperative, or when the Claim of the patentee exceeds his invention. It is not sufficient that the patent does not cover all that the patentee could have claimed if his specifications had come up to his invention. If he has invented or discovered something beyond his original specifications and Claim, his course is not to endeavor to cover it by a re-issue, but to seek a separate patent for it. The statute authorizing a re-issue was intended to protect against accidents and mistakes, and it is only when thus restricted that it can be regarded as a beneficial statute. If a patentee does not embrace by his specifications and Claim all that he might have done, and there has been no clear mistake, inadvertence, or accident in their preparation, the presumption of law is that he has abandoned to the use of the public everything outside of them, or at least has postponed any additional claim for further consideration." 18 O. G. 1339 (1340); 6 Sawyer, 508 (520). See also Flower *v.* Rayner (1881), 19 O. G. 425; 5 Fed. Rep. 793.

This position has been since discussed and repudiated by Lowell, J., in Smith *v.* Merriam (1881), 6 Fed. Rep. 713, where he says: (715) "A case has been brought to my notice, decided by Mr. Justice Field, on his circuit, which is supposed by the patent lawyers to indicate a new departure in the law of re-issued patents. The high authority and great importance of that decision will be my apology for a discussion, which, a few weeks since, would have been unnecessary. The case is The Giant Powder Co. *v.* The California Vigorit Powder Co., 18 O. G. 1339; *s. c.* 4 Fed. Rep. 720. In it the learned judge is understood to declare that if the court can discover, upon a comparison of the two instruments, that there was no defective specification to be amended, and that the Claim was not broader than the invention, the action by the Commissioner in granting a re-issue was in excess of his jurisdiction, and void; and that if the patentee claims too little, instead of too much, his specification is not defective by reason of that mistake, but all which he did not claim was dedicated to the public. I do not mean to say that I consider the decision to be as extensive as this; but it is so understood by some members of the bar; and there are remarks in the opinion which lend a color to such a construction. The Revised Statutes simply re-enact the law upon this subject which has been in force since 1836: 'Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent, and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued.' Section 4916. The most natural construction of this law would perhaps be that if a patent should be inoperative by reason of a defective specification, or invalid for claiming too much, the defect might be supplied, or the excessive Claim be reduced, by re-issue. But the courts have given a very different inter-

original patent, he has exceeded his jurisdiction, and the Claims

pretation, — much wider in most respects, and narrower in only one. They do not permit a defective specification to be supplied, excepting from the drawings or model; but they do permit the Claim to be varied, provided the same invention is described in both patents, and hold that the decision of the Office that the occasion had arisen for granting a re-issue is final. The law is extremely liberal, perhaps too much so, and has been much abused; but if we change it suddenly we shall make a destruction of titles which it is impossible to contemplate without dismay. If the court is to decide, by inspection of the original patent, that it was not defective, the result is this: that after a patentee, upon the best advice which he can obtain, has been instructed that his specification needs amendment, and obtains a new patent, the court may say, 'We are unable to see any defect, and your re-issue, however honestly obtained, is bad, because your original patent was so good.' The mistake is one of law, and the Commissioner does not usually decide the law finally; but as to the mere question of the necessity for a re-issue, supposing the new patent itself to be unobjectionable, his decision has always been held to be final; and this for an unanswerable reason, that no patentee, however honest or careful, can be safe in obtaining a re-issue, if he is to be informed, when he gets into court, that the judge is unable to see why he should have surrendered his first patent. The slighter and more obviously unobjectionable the change, the stronger will be the argument that there was no occasion to make it; so that honest and careful patentees will be the most likely to suffer. It does not help the matter to call the action of the Commissioner an excess of jurisdiction. I know that the courts have called these mistakes jurisdictional. They did this to overrule, without positively saying so, the early cases which held the action of the Commissioner within his jurisdiction to be final. It is obvious that the Commissioner has the same jurisdiction to issue a bad patent as to issue a good one. As his action is *ex parte* it does not bind the world, excepting in certain matters which it is both unjust and inconvenient to review. A mistake by him as to the necessity of issuing a new patent is not an excess of jurisdiction, but a mistake in a matter clearly within his jurisdiction; and the real question is whether it is one which the courts will correct by destroying a new patent after the old one has been surrendered. Upon questions of the validity of a patent, or of a re-issue, in all great matters of novelty and construction and patentability, the decision of the Commissioner is not final, though his jurisdiction is undoubted; but I repeat that urgent reasons of justice require that upon the mere question whether the paper called a re-issue shall be given, his finding should be, as it has hitherto always been held to be, conclusive. Again, if it be found that the Claims of the original patent were valid, and that the re-issue for the same invention states the Claim or Claims in a different way, — though it may be a better way for the patentee, — the change does not of itself vitiate the new patent; but, on the contrary, the original Claims are conclusively presumed to have been made as they were through inadvertence, accident, or mistake. The law is so well settled that most of the reports do not contain the Claims of the two patents: but I suppose that no re-issue has ever contained the exact Claims of the original, and this can be discovered, incidentally, in many of

of the re-issued patent must be held invalid so far as such new

the cases, and positively in some, where the very point is passed upon. See Allen *v.* Blunt, 3 Story, 742 ; Stimpson *v.* Westchester R. Co., 4 How. 380 ; O'Reilly *v.* Morse, 15 How. 62 ; Batten *v.* Taggert, 2 Wall. Jr. 101 ; s. c. 17 How. 74 ; Bennet *v.* Fowler, 8 Wall. 444 ; The Goodyear Cases, 2 Wall. Jr. 283, 356 ; 2 Cliff. 351 ; 9 Wall. 798 ; Seymour *v.* Osborne, 11 Wall. 516 ; Roberts *v.* Ryer, 91 U. S. 150 ; Marsh *v.* Seymour, 97 U. S. 348 ; remarks of Bradley, J., in Powder Co. *v.* Powder Mills, 98 U. S. 136, and of the same learned judge in Carlton *v.* Bokee, 17 Wall. 463, where he intimates that a re-issue may be good as to those Claims which agree with the invention, and void as to others which exceed it ; Cochrane *v.* Deener, 94 U. S. 780 ; Conover *v.* Roach, 4 Fisher, 12 ; Stevens *v.* Pritchard, 10 O. G. 505 ; Herring *v.* Nelson, 14 Blatch. 298 ; Johnson *v.* Flushing R. Co., 15 Blatch. 192 ; Anilin Co. *v.* Higgins, id. 290 ; Pearl *v.* Ocean Mills, 11 O. G. 2. None of *these cases, unless it be Batten v. Taggert*, 17 How. 74, — which is perhaps inconsistent with Leggett *v.* Avery, 101 U. S. 256, — has been overruled ; and a great many similar cases could be cited. It has been brought out a little more decidedly by the later cases that the invention must be the same ; but it has never been held in the Supreme Court, or any circuit court, so far as I can discover, that the Commissioner's decision is not final as to the propriety of a re-issue, as distinguished from its validity upon what may be called its merits ; or that the Claims may not be varied to express the real invention. The Claim is part of the specification, and if defective may be amended. Russell *v.* Dodge, 93 U. S. 460, in which the decision is given by Mr. Justice Field, and which is cited by him in The Powder Co.'s Case, merely decides that a re-issue which claims a different invention is void. A similar decision has been made at this term of the Supreme Court, in giving which Mr. Justice Strong states the law in the old way, that the Commissioner's decision is final as to the mistake, but not as to the identity of invention. Ball *v.* Langles, 18 O. G. 1405. The only cases which he cites are Seymour *v.* Osborne, and Russell *v.* Dodge, which he evidently considers to be consistent with each other." 19 O. G. 601 (602).

Further, that the decision of the Commissioner as to the defectiveness of the original patent and the necessity for a re-issue is final, see Combined Patent Can Co. *v.* Lloyd (1882), 11 Fed. Rep. 149 ; 21 O. G. 713 ; 15 Phila. 481 ; Selden *v.* Stockwell Self-Lighting Gas Burner Co. (1881), 19 Blatch. 544 ; 20 O. G. 1377 ; 9 Fed. Rep. 390 ; Christman *v.* Rumsey (1879), 58 How. Pr. 114 ; 17 Blatch. 148 ; 17 O. G. 903 ; 4 Bann. & A. 506 ; Judson *v.* Bradford (1878), 16 O. G. 171 ; 3 Bann. & A. 539 ; Kerosene Lamp Heater Co. *v.* Littell (1878), 3 Bann. & A. 312 ; 13 O. G. 1009 ; Thomas *v.* Shoe Machinery Mfg. Co. (1878), 16 O. G. 541 ; 3 Bann. & A. 557 ; Lorillard *v.* McDowell (1877), 11 O. G. 640 ; 13 Phila. 461 ; 2 Bann. & A. 531 ; Miller & Peters Mfg. Co. *v.* Du Brul (1877), 12 O. G. 351 ; 2 Bann. & A. 618 ; *Ex parte* Conklin (1874), 5 O. G. 235 ; 1 MacArthur, 375 ; Wells *v.* Jacques (1874), 5 O. G. 364 ; 1 Bann. & A. 60 ; Jordan *v.* Dobson (1870), 4 Fisher, 232 ; 2 Abbott, 398 ; 7 Phila. 533 ; Blake *v.* Stafford (1868), 3 Fisher, 294 ; 6 Blatch. 195.

That the decision of the Commissioner that the re-issue is necessary is final, no matter how many times the

matter or intentionally excluded matter is concerned.[8] Upon

patent has already been re-issued, see Union Paper Collar Co. *v.* White (1875), 7 O. G. 698, 877; 11 Phila. 479; 2 Bann. & A. 60.

Furthermore, that the decision of the Commissioner is final on the collateral questions which must be settled, and the issues of fact which must be determined, before a surrender can be accepted and a re-issue allowed, unless the statute permits defences on these points, see Mahn *v.* Harwood (1884), 112 U. S. 354; 30 O. G. 657; Giant Powder Co. *v.* Safety Nitro-Powder Co. (1884), 19 Fed. Rep. 509; 10 Sawyer, 23; 27 O. G. 99: American Diamond Rock Boring Co. *v.* Sheldon (1879), 17 Blatch. 208; 4 Bann. & A. 551; Anilin *v.* Higgin (1878), 15 Blatch. 290; 14 O. G. 414; 3 Bann. & A. 462; Judson *v.* Bradford (1878), 3 Bann. & A. 539; 16 O. G. 171; Herring *v.* Nelson (1877), 14 Blatch. 393; 12 O. G. 753; 3 Bann. & A. 55; American Nicholson Pavement Co. *v.* Elizabeth (1873), 3 O. G. 522; 6 Fisher, 424; Hoffheins *v.* Brandt (1867), 3 Fisher, 218.

[8] Although the decision of the Commissioner in accepting a surrender and awarding a re-issue is final so far as the substitution of the re-issued for the original patent is concerned, the courts still have the power to declare the Claims of the re-issued patent invalid for any of those general reasons which apply to original patents, or for the special reason that such Claims contain matter which the Commissioner had no jurisdiction to allow. But, as in all other cases, the courts will so construe the re-issued patent, if possible, as to avoid this latter objection, and will confine it, if its language will reasonably permit, to such subject-matter as constituted the original invention, and was not intentionally omitted or misstated in the original patent. Where the re-issued patent repeats, as it usually does, one or more of the original Claims, these may be held valid, though all additional Claims are rejected as beyond the scope of the amending power; and thus, except in a few cases, the duty of the courts is limited to the construction of the re-issued patent. That in construing a re-issued patent it must be restricted to the subject-matter indicated in the original specifications as belonging to the actual invention is settled by an unbroken current of authority. See §§ 663–669 and notes, *ante*, and § 746 and notes, *post*.

See also Russell *v.* Dodge (1876), 93 U. S. 460; 11 O. G. 151; Collar Co. *v.* Van Deusen (1874), 23 Wall. 530; 7 O. G. 919; Bridge *v.* Brown (1871), Holmes, 53; Goodyear *v.* Berry (1868), 3 Fisher, 439; 2 Bond, 189; Calhart *v.* Austin (1865), 2 Fisher, 543; 2 Clifford, 528; Hussey *v.* Bradley (1863), 2 Fisher, 362; 5 Blatch. 134; Poppenhusen *v.* Falke (1861), 2 Fisher, 181; 4 Blatch. 493.

That the courts may inquire into the origin of the defect for whose amendment the re-issue was obtained, and confine the operation of the re-issued patent to matter not intentionally omitted or misstated in the original, has often been denied, see Asmus *v.* Alden (1886), 27 Rep. Fed. 684; 36 O. G. 231, Western Union Tel. Co. *v.* Baltimore & Ohio Tel. Co. (1885), 25 Fed. Rep. 30; Thomas *v.* Shoe Machinery Mfg. Co. (1878), 3 Bann. & A. 557; 16 O. G. 541; Blake *v.* Stafford (1868), 3 Fisher, 294; 6 Blatch. 195; Middletown Tool Co. *v.* Judd (1867), 3 Fisher, 141.

The contrary has, however, been asserted in recent decisions, and is undoubtedly the correct position. Thus in Mahn *v.* Harwood (1884), 112 U. S.

this latter question the whole field of inquiry should be open to the courts, and while the decision of the Commissioner is *prima facie* correct and the burden of proof rests on those who controvert it, the identity of the invention claimed in the re-issue with that described in the original patent, and the origin of the corrected error in inadvertence, accident, mistake, or fraud, should be exhaustively investigated.[9]

354, Bradley, J.: (359) "The same defence may be established by showing from the record that there was no inadvertence, accident, or mistake in drawing up the specification of the original patent; for the statute only gives a re-issue when the original is defective by inadvertence, accident, or mistake." 30 O. G. 657 (658).

In Odell *v.* Stout (1884), 22 Fed. Rep. 159, Sage, J.: (161) "The granting of a re-issue is *prima facie* evidence of inadvertence, accident, or mistake, as the granting of original letters is *prima facie* evidence of invention. This evidence may be overcome. It is not conclusive." 29 O. G. 862 (863).

The entire doctrine of abandonment by an unreasonable delay in applying for a re-issue is in reality only another mode of stating that the courts may inquire into the existence of original inadvertence, accident, or mistake; and every decision in favor of that doctrine is an indirect assertion that on this point the decision of the Commissioner is not conclusive. See §§ 690–692, and notes, *ante*, and also Western Union Tel. Co. *v.* Baltimore & Ohio Tel. Co. (1885), 25 Fed. Rep. 30; Wollensak *v.* Reiher (1885), 115 U. S. 96; 31 O. G. 1301.

[9] The method of investigation which may be pursued by the courts in reviewing the action of the Commissioner on the two questions here discussed is also as yet undetermined. It has been generally considered that the inquiry must be limited to the documentary evidence afforded by the original and re-issued patents, and by the records of the action of the Patent Office on the original and re-issue applications; and in some cases it has been held that unless in these the repugnancy of the inventions, or the intentional omission or misstatement in the original patent, were apparent the decision of the Commissioner was conclusive. Thus in Blake *v.* Stafford (1868), 6 Blatch. 195, Shipman, J.: (199) "As the law now stands, I regard the decision of the Commissioner as final and conclusive, unless impeached for fraud in his or the patentee's acts, or for some irregularity arising on the face of the papers, or for a clear repugnance between the original and re-issued patents. Under the Act, the Commissioner has the power to decide, and in every acceptance of a surrender and every re-issue 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. 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. The jurisdiction of the Commissioner is final and conclusive, unless, as already stated, fraud or collusion somewhere is proved, or some irregularity is apparent on the face of the papers, or there is a plain repugnance between the old and new specifications." 3 Fisher, 294 (300).

See also Malin *v.* Harwood (1884), 112 U. S. 354; 30 O. G. 657; Giant

§ 715. Re-issued Patent not Collaterally Attackable for Fraud in Procuring the Re-issue.

Neither a re-issued nor an original patent can be collaterally attacked on the ground that it was granted through the fraud either of the applicant or the Commissioner. This question can be raised only on a proceeding to repeal the patent.[1] Evidence of such fraud may be found in grossly

Powder Co. *v.* California Vigorit Powder Co. (1880), 4 Fed. Rep. 720; 6 Sawyer, 508; 18 O. G. 1339; Wells *v.* Gill (1872), 2 O. G. 590; 6 Fisher, 89.

In several particulars, however, this rule has been necessarily departed from, and there seems no sufficient reason why it should be at all regarded. Evidence outside the record must sometimes be admitted to ascertain the character of the actual original invention and its identity with that embraced in the re-issue; and in determining the question of original inadvertence, etc., by the reasonableness of the delay in obtaining a re-issue, all the circumstances attending the delay may be, as they constantly are, subjected to examination, and the validity or the scope of the Claims of the re-issue be thus indirectly decided by matters appearing only by parol. The reluctance of the courts to formally adopt this position, and throw the whole field of inquiry upon these two questions open for any and every ordinary method of investigation seems to arise from an exaggerated view of the authority of the Commissioner and the effect of his decision in allowing a re-issue. As this fundamental doctrine becomes clearer and more accurately stated it may be confidently expected that these resulting questions will be settled on a rational basis, and that the same latitude of inquiry will be permitted as to the cause of the alleged defect in the original patent, as is now enjoyed in reference to the patentability of the invention and the priority of the inventive act.

§ 715. [1] In reference to this question also the law has undergone marked alterations. It was formerly held that the question of fraud in obtaining the re-issue was open and might be submitted to the jury. See Stimpson *v.* Westchester R. R. Co. (1846), 4 How. 380; 2 Robb, 335; and § 714, note 1, *ante*. In Graham *v.* Mason (1869), 5 Fisher, 1; 4 Clifford, 88, it was suggested that a re-issue can be collaterally attacked either for fraud or want of identity. The current of authority is, however, to the contrary, and in spite of occasional apparent departures from the doctrine it may be regarded as the settled law that no objection to the re-issued patent on the ground of fraud in the patentee in procuring it, or corruption in the Commissioner in allowing it, can be raised except in a proceeding instituted by the United States for its repeal. Thus in Giant Powder Co. *v.* Safety Nitro-Powder Co. (1884), 10 Sawyer, 23, Sawyer, J.: (25) "The question whether there is a fraud in the surrender and application for a re-issue is one of fact, for the officers of the Patent Office alone to decide, and their determination is conclusive in a collateral proceeding." 27 O. G. 99 (100); 19 Fed. Rep. 509 (511).

In Thomas *v.* Shoe Mach. Mfg. Co. (1878), 3 Bann. & A. 557, Clifford, J.: (559) "Authority to accept the surrender of an original patent and to grant a re-issue is conferred upon the Commissioner, and, in a case arising under the Patent Law then in force, the Supreme Court, more than thirty years

and unwarrantably extended Claims, or in descriptive matter clearly intended to mislead the public, or in extrinsic facts which manifest bad faith on the part of the patentee or corruption on the part of the Commissioner.[2] This rule does

ago, decided that where an act was to be done or a patent granted upon proofs to be had before a public officer upon which he was to decide, the fact that such officer had done the act or granted the patent was *prima facie* evidence that the proofs had been regularly made and that they were satisfactory, even though the patent did not contain any recitals that the prerequisites to the grant had been fulfilled; and such continued to be the rule until the question came up under a later act, when the Supreme Court held that the granting of a re-issued patent closed all inquiry into the existence of inadvertence, accident, or mistake, and left open only the question of fraud for the jury. Railroad *v.* Stimpson, 14 Pet. 458; Stimpson *v.* Railroad, 4 How. 384. Since that time it has been definitely settled that neither re-issued nor extended patents can be abrogated by an infringer, in a suit against him for damages or profits, upon the ground that the letters-patent were procured by fraud in prosecuting the application for the same before the Commissioner. Rubber Co. *v.* Goodyear, 9 Wall. 797." 16 O. G. 541 (541).

In La Baw *v.* Hawkins (1874), 1 Bann. & A. 428, Nixon, J.: (429) "I take no notice of the denial in the defendant's answer, that the letters-patent were surrendered for good and lawful cause, or that they were inoperative or invalid, or deficient or insufficient in any respect, because that question is not open for examination here. Since the case of Seymour *v.* Osborne, 11 Wall. 516, it seems to be settled that neither re-issued nor extended patents can be abrogated by an infringer, in a suit against him for an infringement, upon the ground that the letters-patent were procured by fraud in prosecuting the application for the same before the Commissioner." 8 O. G. 724 (725).

In Johnsen *v.* Beard (1875), 2 Bann. & A. 50, Woodruff, J.: (51) "I understand the Supreme Court to have settled, distinctly and finally, that this court cannot enter into the examination of any question of fraud upon the Commissioner who granted the re-issue, or of any matter which is outside of the record; and that the only power which the courts have over re-issues, when their validity is sought to be impeached upon such grounds, is to look at the record of the original patent and of the re-issue, and to determine upon their face whether or not, as matter of law, the re-issue is a lawful one, without inquiring by what means it was procured, and without inquiring what matters of fact were involved *de hors* the record. The act of the Commissioner in granting the re-issue is final and conclusive." 8 O. G. 435 (436).

See to the same effect Schillinger *v.* Crawford (1886), 37 O. G. 1349; 4 Mackey, 450; Miller & Peters Mfg. Co. *v.* Du Brul (1877), 2 Bann. & A. 618; 12 O. G. 351; Birdsell *v.* McDonald (1874), 6 O. G. 682; 1 Bann. & A. 165; Milligan & Higgins Glue Co. *v.* Upton (1874), 6 O. G. 837; 4 Clifford, 237; 1 Bann. & A. 497; Corn Planter Patent (1874), 23 Wall. 181; 6 O. G. 392; Seymour *v.* Osborne (1870), 11 Wall. 516.

[2] In Goodyear *v.* Berry (1868), 2 Bond, 189, *per Curiam*: (202) "If the Claims of a re-issued patent clearly imply an

not forbid the admission, in a suit for the infringement of a re-issued patent, of testimony tending to establish that the alleged defects in the original patent arose from a fraudulent or deceptive intention on the part of the inventor, or prevent the courts from holding that the endeavor to correct such fraudulent defects by the re-issue cannot be sustained.[3]

expansion of the invention beyond the Claims of the original patent there is always ground for a presumption that there was a fraudulent intent to anticipate and cover subsequent inventions, and thus bar the door against patents for all subsequent discoveries. This is clearly against the policy of our patent-right system, and has been wisely condemned by the uniform decisions of the courts of the United States." 3 Fisher, 430 (440).

That where a re-issue fraudulently misleads the public it is void, see Aultman *v.* Holley (1873), 6 Fisher, 534; 11 Blatch. 317; 5 O. G. 3; Swift *v.* Whisen (1867), 3 Fisher, 343; 2 Bond, 115.

That a re-issue is not fraudulent merely because its object was to enlarge the scope of the original patent and was first suggested by judicial construction, see Poppenhusen *v.* Falke (1862), 2 Fisher, 213; 5 Blatch. 46.

That fraud, whether actual or constructive, renders a re-issue void, see Swift *v.* Whisen (1867), 3 Fisher, 343, 2 Bond, 115.

That if a re-issue is fraudulent all its Claims are void, see Odell *v.* Stout (1884), 22 Fed. Rep. 150; 29 O. G. 862.

[3] Fraud in obtaining a re-issue must not be confounded either with a fraudulent attempt to conceal the true nature of the invention from the public, which is a good defence under the statute against any patent, or with a fraudulent and deceptive intention in the omission or misstatement in the original patent now corrected in the re-issue, which according to the authorities cited in the notes to the last paragraph is a valid objection to a re-issue whenever its validity can be inquired into by the courts. The first is a matter between the government and the patentee, and is properly adjudicated only in a proceeding by the government to rescind its own grant. The other two concern the public generally, and the defendant in an infringement suit in particular, and may, therefore, be set up by him in his defence, and so far as the suit against him is concerned be conclusively determined by the courts.

CHAPTER III.

OF THE REPEAL OF LETTERS-PATENT.

§ 716. Three Classes of Persons Interested in the Repeal of Letters-Patent: Infringers: Prior Inventors: The Public.

THREE distinct rights are either limited or suspended by the grant of a patent, and three classes of persons are thus interested in its repeal. The first class embraces those persons who practise the invention in violation of the exclusive privilege conferred upon the patentee, and who thereby become liable to compensate him for the injury unless his patent can be shown to be invalid. The second class consists of prior inventors whose monopoly is denied or restricted in its enjoyment on account of the existence of an antagonistic patent, and whose rights never can be perfectly secured until the adverse patent is repealed. The third class are the general public whose free use of the invention is suspended while the patent is in force, and whose power to grant a later valid patent to a different and more meritorious inventor has been impaired by the mistaken issue of the first. For the protection of the rights of all these persons against unlawful patents the law properly provides measures commensurate with the requirements of the different classes, whereby the patents may either be declared inoperative in reference to certain individuals or may be universally and permanently repealed.

§ 717. Interests of Infringers Protected without Special Proceedings for a Repeal.

The rights of the first class are sufficiently preserved by the protection afforded to the third class, of which they are always members, and by allowing them to defend themselves in any suit for a violation of the patent by showing that, as to all

the points involved in such suit, the patent is invalid. Those who simply practise the invention require no other relief against an unlawful patent than that which frees them from a liability to pay for its infringement. It is not necessary that the validity of the patent in itself, or as a public grant, be called in question, nor that the judgment of the court pronounce it null and void. The statutes in permitting an infringer to attack the patent upon every matter relating to the patentability of the invention and the priority of the patentee's inventive act, and in conferring upon the court the power to declare the patent invalid so far as the pending controversy is concerned, have secured the practical employer of the art or instrument against an undue interference with his rights under color of an unlawful patent, except in cases where the invalidity of the patent arises from the fact that it was originally obtained by fraud. In these cases the infringer is left to the protection accorded to him as a member of the general public. It is true that it might often be to his advantage were he allowed in his defence to show that the patentee had secured his grant by fraud or by corruption, but for obvious reasons such defence cannot be made. The issue of a patent is the decree of a tribunal to whom the duty of awarding patents to the original inventors of patentable arts and instruments has been confided by the law, and its decrees within its jurisdiction, like those of other courts, cannot be collaterally impeached. Thus though an infringer may defeat the operation of the patent, as against himself, on the ground that if it covers the invention which he uses the Patent Office had no jurisdiction to award it, either because the invention was not patentable or because the patentee was not its first inventor, he cannot claim in his defence that a grant within the jurisdiction of the Patent Office is invalid because it was corruptly or fraudulently obtained.[1] This is a question which can be raised only by a proceeding instituted for that pur-

§ 717. [1] That a patent cannot be collaterally attacked for fraud in procuring it, but may be set aside and repealed on a direct proceeding for that purpose, see Eureka Co. *v.* Bailey Washing Mach. Co. (1870), 11 Wall. 488; Crompton *v.* Belknap Mills (1869), 3 Fisher, 536; Goodyear *v.* Providence Rubber Co. (1864), 2 Clifford, 351; 2 Fisher, 499.

pose on behalf of the authority from whom the grant has been improperly procured; and an infringer can, therefore, avail himself of this mode of relief only as a member of the general public, and through the measures which the law prescribes for their protection.

§ 718. Interests of Prior Inventors Require Special Proceedings for a Repeal.

The second class of persons require for their protection an additional proceeding. A prior inventor has not only the right to use his own invention, and when sued for the infringement of an earlier patent to defend upon the ground of his own previous inventive act, but he also has the right to that monopoly of the invention which the law confers upon him as a recompense for his inventive skill. An out-standing patent to a subsequent inventor cannot take away this right, nor prevent the issue of a later patent to the first inventor whenever his superior title is established; but the later lawful patent does not abrogate the former, nor relieve the true inventor from that cloud upon his title which arises from the existence of the earlier patent to his rival. To the complete enjoyment of his monopoly the extinguishment of the unlawful interfering patent becomes necessary, and as no power has been bestowed upon the Patent Office to recall it, the statutes have provided a specific method for securing its repeal.

§ 719. Interests of the Public Require Special Proceedings for a Repeal.

The third class of these persons, or the general public, possess collective rights beyond those which subsist in individuals, for whose protection against unlawful patents special measures are required. Such members of the public as infringe upon these patents may defend against them in the manner just described. Prior inventors, also members of the public, may remove interfering patents by the mode particularly provided for that purpose. But neither of these methods secures to the collective public the entire enjoyment of their natural and legal rights. The collective public are

entitled to all those benefits, direct or indirect, which flow from the free use of every industrial device that is not covered by a lawful patent; and the enjoyment of these benefits cannot be made conditional upon the willingness of individuals to infringe existing patents or their ability to successfully defend against them. An unlawful patent is practically as complete an obstacle to the public enjoyment of an invention as a lawful patent could be, until by some means the unlawful patent is virtually or actually destroyed; and the public interest thus demands the establishment of such forms of procedure as may lead to its immediate repeal. Moreover, by the issue of one patent for a given invention the public, acting through the government, exhaust their power to confer on any one this particular monopoly. Two conflicting monopolies in the same invention cannot exist, since the idea of a monopoly excludes all competition. Hence, whether the first patent be lawful or unlawful, while it remains in force no second patent can be granted, for the entire monopoly resides in him to whom the first was issued and nothing remains in the public to be bestowed upon another through the second. The practice of the Patent Office in allowing patents to prior inventors, notwithstanding earlier patents to later inventors, is not based on any theory that more than one monopoly can be created by the public, but is a mere device for putting both the claimants on equal ground before the courts, in order that their adverse claims to the monopoly may be determined. Whenever, therefore, an unlawful patent is obtained, the public are unlawfully deprived of their right to grant a lawful patent, and the recovery of this right by the repeal of the unlawful patent becomes a duty not only to themselves collectively but to that individual member of the public upon whom the monopoly ought legally to be conferred.

§ 720. Two Special Proceedings Provided for the Repeal of Unlawful Patents.

This description of the rights invaded by unlawful patents, and of the methods by which alone these rights can be protected, indicates that for two of these three classes of persons

special remedies must exist. Of the protection afforded to infringers by permitting them to avail themselves of any defence against the patent, except that of fraud in its procurement, nothing further need be stated here, — the subject being specially considered later in its proper place. Prior inventors and the general public, however, require each their own modes of redress, resulting in the repeal of the unlawful patent, in one case as to the contending claimant only, and in the other as to all mankind. These are to form the present subjects of examination.

SECTION I.

OF THE REPEAL OF PATENTS IN THE INTEREST OF PRIOR INVENTORS.

§ 721. Proceedings for a Repeal in the Interest of Prior Inventors under the Acts of 1790, 1793, and 1836.

The right of a prior inventor to institute proceedings for the repeal of a patent improperly granted to a subsequent inventor, or to one who simply pirated the invention, has been always expressly recognized by our Patent Law. The acts of 1790 and 1793 contained provisions by virtue of which actions could be instituted by any person, resulting, if successful, in the abrogation of the alleged unlawful patent.[1] The act of 1836, having secured by different methods the protection of the rights of all other individuals, restricted private actions for the repeal of patents to the prior inventor, conferring upon him the power thus to attack conflicting patents, whether the Patent Office had recognized his superior claims by granting him a patent or had refused his application on the ground of the outstanding earlier patent.[2] In

§ 721. [1] The act of 1790, Sec. 5, and the act of 1793, Sec. 10, were substantially identical. They provided for the issue of a rule against the owner of any patent, upon the application of any person averring under oath that the patent was obtained surreptitiously by or upon false suggestion, commanding the owner of the patent to show cause why the patent should not be repealed, and directed that unless such cause were shown a decree of repeal should be entered against the defendant.

[2] Act of 1836, Sec. 16, "*And be it*

this preceding the court not only had authority to repeal the unlawful patent, but where the prior inventor had been denied a patent in the Patent Office on account of the unlawful patent, it could adjudicate upon his title to the patent, and in pursuance of this judgment the Commissioner could award it to him as the lawful patentee.[8]

§ 722. Proceedings for a Repeal in the Interest of Prior Inventors under the Act of 1870.

The act of 1870 still further limited this privilege of instituting private actions for repeal, by requiring the prior inventor to satisfy the government of his superior title, and obtain a patent, before attacking the alleged unlawful patent of his adversary. The act of 1836, as has been seen, afforded the defeated applicant a double remedy, extinguishing the rival patent and reversing the unfavorable judgment of the Patent Office on his individual claims. The act of

further enacted, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, 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 and declare either the patents void in the whole or in part, or inoperative and invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this Act, to have and receive a patent for his invention, as specified in his Claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this Act. *Provided, however*, That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment." See also Sec. 10, act of 1839.

[8] That a patent can be declared void under Sec. 16, act of 1836, and Sec. 10, act of 1839, only when two patents interfere, or the Commissioner refuses a patent, or the Supreme Court of the district refuses it upon appeal, see Merserole *v.* Union Paper Collar Co. (1869), 3 Fisher, 483; 6 Blatch. 356.

That courts cannot declare a patent void under Sec. 17, act of July 4, 1836, see Merserole *v.* Union Paper Collar Co. (1869), 6 Blatch. 356; 3 Fisher, 483.

1870 separated these proceedings. In cases where the application of the prior inventor was denied on account of the existing patent, it gave him the same opportunity to vindicate his rights to a patent which he enjoyed under the act of 1836, but it did not permit him to join with this proceeding another, having for its object the repeal of the opposing patent.[1] This separation was correct in principle. The grant of a patent raises a strong *prima facie* presumption of its validity. The refusal of a patent by the Patent Office is also *prima facie* evidence that the applicant has no right to a monopoly. To permit a defeated applicant to attack an interfering patent in the face of these two presumptions is inconsistent with a due regard to the rights of the existing patentee. Not until he has overcome the presumption arising from his own defeat by obtaining a reversal of the adverse judgment, and by the allowance of a patent in his favor has put himself on equal ground with the earlier patentee, ought he to be permitted to bring his adversary into court in defence of the prior patent, or compel him to incur the risk of its repeal.[2] The present law thus adequately protects the

§ 722. [1] In the act of 1870, Secs. 52 and 58 represent and reproduce the matter contained in Sec. 16 of the act of 1836. Sec. 52 is substantially identical with Sec. 4915 of the Revised Statutes, which is as follows: "Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity, and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his Claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases where there is no opposing party, a copy of the bill shall be served on the Commissioner, and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not." Sec. 58 appears as Sec. 4918, Rev. Stat., and is quoted in § 723 and notes, *post*. By comparing these with Sec. 16, act of 1836, given in note 2, § 721, *ante*, the precise division in the law effected by the act of 1870 will be perceived.

[2] That no suit to annul a patent can be brought by a private party unless there are two outstanding interfering patents, see Mowry *v.* Whitney (1871), 14 Wall. 434; 1 O. G. 499; 5 Fisher, 513.

That a suit to defeat another's patent cannot be brought till the plaintiff receives his own, see Hoeltge *v.* Hoeller (1870), 2 Bond, 386.

interests of all parties, and far more accurately than the old preserves a proper order and sequence in its remedies.

§ 723. Proceedings for a Repeal in the Interest of Prior Inventors under the Revised Statutes of 1874.

The relief afforded to the defeated applicant is prescribed by Section 4915 of the Revised Statutes, and has already been discussed in its appropriate connection.[1] Proceedings for the repeal of interfering patents are governed by Section 4918.[2] According to this section any person interested in one of two or more interfering patents,[3] or in the practice of the invention which it claims, may bring a bill in equity against the owners of the adverse patent, praying for relief against the interfering patentee or any party holding under him.[4] Upon due notice

§ 723. [1] See §§ 571, 604, and notes, *ante*.

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

[3] That Sec. 4918, Rev. Stat., relates only to interfering patents for the same invention, when the plaintiff claims to be the original inventor, see Celluloid Mfg. Co. *v.* Goodyear Dental Vulcanite Co. (1876), 10 O. G. 41; 13 Blatch. 375.

That two patents for distinct articles do not interfere under Sec. 4918, though one is an improvement on the other, see Pentlarge *v.* N. Y. Bung & Bushing Co. (1884), 28 O. G. 370; 20 Fed. Rep. 314.

That two patents interfere under Sec. 16, act of 1836, only when they claim in whole or in part the same invention, as under Secs. 8 and 12, see Gold & Silver Ore Separating Co. *v.* United States Disintegrating Ore Co. (1869), 3 Fisher, 489; 6 Blatch. 307.

That no action lies by a junior patentee to obtain a decision that his patent does not conflict with a prior one, see Celluloid Mfg. Co. *v.* Goodyear Dental Vulcanite Co. (1876), 10 O. G. 41; 13 Blatch. 375.

That patents can be adjudged void only under Sec. 16, act of 1836, and Sec. 10, act of 1839, and then only when two patents interfere or when a patent is refused by the Commissioner or a justice of the Supreme Court of the District of Columbia on appeal, see Merserole *v.* Union Paper Collar Co. (1869), 3 Fisher, 483; 6 Blatch. 356.

[4] That an assignee before the patent, if his assignment was duly recorded, may sue one to whom the patent issued

to the adverse parties, and after such proceedings according to the usual course of equity as the nature of the controversy requires the court may declare either of the patents void in whole or in part, or inoperative or invalid in any particular portion of the United States, according to the interest of the parties in the patent or the invention patented.[5] This judgment binds only the parties to the suit and those deriving title under them after such judgment has been rendered.[6]

§ 724. Nature and Effect of the Proceedings for a Repeal in the Interest of Prior Inventors.

The power conferred by this section upon the prior inventor and those claiming under him is broad enough to meet all

after its denial to his assignor, and have so it may be dismissed without costs, see American Clay Bird Co. *v.* Ligowski Clay Pigeon Co. (1887), 31 Fed. Rep. 466; Lockwood *v.* Cleveland (1881), 6 Fed. Rep. 721.

That in a suit to annul an interfering patent the court may defeat the defendant's patent, although the plaintiff's patent is void, being anticipated by his own prior patents, see American Clay Bird Co. *v.* Ligowski Clay Pigeon Co. (1887), 31 Fed. Rep. 466.

That a delay of five years in instituting proceedings to annul a patent tends to show a want of good faith in the petitioner, see Sawyer *v.* Massey (1885), 25 Fed. Rep. 144.

That on a bill to repeal a patent in the Federal Courts, the preliminary statement as to the date of the invention on an interference in the Patent Office does not bind the assignees of the inventor, see Union Paper Bag Mach. Co. *v.* Crane (1874), Holmes, 429; 6 O. G. 801; 1 Bann. & A. 494.

[6] That the judgment on a bill to annul an interfering patent binds only the parties to the suit and their subsequent assignees, see Mowry *v.* Whitney (1871), 14 Wall. 434; 1 O. G. 499; 5 Fisher, 513.

That a proceeding under Sec. 4918, Rev. Stat., is a chancery proceeding and is regulated by chancery practice, as also under Sec. 739, see Liggett & Myers Tobacco Co. *v.* Miller (1880), 5 Bann. & A. 237; 1 McCrary, 31; 17 O. G. 798; 1 Fed. Rep. 203.

That a bill to annul a patent must be brought in the district where the defendant resides or is found, see Prentiss *v.* Ellsworth (1846), 27 O. G. 623.

That in a suit for repeal under Sec. 4918, Rev. Stat., no provision exists for notice to parties outside the district in which the suit is brought, see Liggett & Myers Tobacco Co. *v.* Miller (1880), 1 Fed. Rep. 203; 17 O. G. 798; 1 McCrary, 31; 5 Bann. & A. 237.

That in a suit for repeal under Sec. 4918, Rev. Stat., the defendant is not compelled to file a cross-bill in order to obtain affirmative relief, and if he does

conceivable emergencies.[1] Whenever the rights of one person are derived from the lawful patent of the first inventor, and are in any manner limited or violated by another person under cover of the unlawful patent of a subsequent inventor, redress commensurate with the injury may be obtained and the unlawful patent declared void so far as it affects the antagonistic interests of the contending parties.[2] The judgment of repeal may embrace the whole patent, as in cases where its entire patentable subject-matter was first produced by the inventive genius of the adverse claimant, or may include only the particular inventions which are covered by the rival patent and are found by the court to have been first invented by the rival patentee. Both patents are equally before the court for judgment and either may be repealed, so far as the contending parties are concerned, to any extent which may be necessary in order to secure to the party claiming under the prior inventor of each art or instrument the unqualified enjoyment of the monopoly to which he is entitled.[3] In this proceeding the

§ 724. [1] That in proceedings to annul under Sec. 4918, the courts are not bound by the decisions of the Patent Office, see Holliday *v.* Pickhardt (1887), 24 Blatch. 201; 29 Fed. Rep. 853; Minneapolis Harvester Works *v.* M'Cormick Harvesting Mach. Co. (1886), 28 Fed. Rep. 565; 37 O. G. 566; Hubel *v.* Tucker (1885), 23 Blatch. 297; 24 Fed. Rep. 701.

[2] That under Sec. 58, act of 1870, the court may order the defeated patent to be delivered to the clerk and cancelled by him, and sent to the Secretary of the Interior with a copy of the decree, see Sturges *v.* Van Hagen (1873), 6 Fisher, 572; 4 O. G. 579.

That where the court annuls a patent it may enjoin the patentee from instituting actions thereon, see Sawyer *v.* Massey (1885), 25 Fed. Rep. 144.

That a junior patentee cannot be enjoined from suing under his patent on the motion of the prior patentee, pending a suit by the prior patentee to cancel the junior patent, when the junior patent was granted after a full hearing in the Patent Office, on an interference with the prior patentee, see Asbestos Felting Co. *v.* Salamander Felting Co. (1876), 10 O. G. 828; 13 Blatch. 453.

[3] That Sec. 4918, Rev. Stat., allows the court to declare either or both patents void, in whole or in part, see Foster *v.* Lindsay (1875), 8 O. G. 1032; 3 Dillon, 126; 2 Bann. & A. 172; Foster *v.* Lindsay (1874), 7 O. G. 514; 1 Bann. & A. 605.

That on a bill to annul, the court can declare either patent void, but not both, see American Clay Bird Co. *v.* Ligowski Clay Pigeon Co. (1887), 31 Fed. Rep. 466.

That on a petition to annul, if it appears that one patentee abandoned his experiments, and after the issue of a patent to his rival renewed them and patented the invention, the rival patent will be sustained, see Hutchinson *v.* Everett (1885), 35 O. G. 1110; 26 Fed. Rep. 531.

patentability of the inventions described and claimed in the antagonistic patents is not in issue. Priority of invention is the only point in controversy, and judgment, therefore, is awarded to the party who derives his title from the first inventor.[4]

SECTION II.

OF THE REPEAL OF PATENTS IN THE INTEREST OF THE PUBLIC.

§ 725. Proceedings for a Repeal in the Interest of the Public Rest upon Fundamental Principles of Sovereignty, not on mere Legislative Acts.

Whether the public, as a collective body, can institute proceedings for the repeal of letters-patent, under the present provisions of our law, has been a matter of dispute. Adhering to the theory that such proceedings can be authorized only by express acts of legislation, some courts have held that in the absence of a statute conferring this power on the people it did not exist. In obedience to this doctrine it has been

[4] That the only issues on a petition to annul an interfering patent are interference and priority, see Sawyer *v.* Massey (1885), 25 Fed. Rep. 144; Pentlarge *v.* Pentlarge (1884), 22 Blatch. 10; 19 Fed. Rep. 817; *contra*, Foster *v.* Lindsay (1875), 8 O. G. 1032; 2 Bann. & A. 172; 3 Dillon, 126; Foster *v.* Lindsay (1874), 7 O. G. 514; 1 Bann. & A. 605.

That on a petition to annul an interfering patent, under Sec. 4918, the defendant cannot set up by plea as a defence, if holding under a later patent, that the invention was in use before the plaintiff's inventive act, see Pentlarge *v.* Pentlarge (1884), 22 Blatch. 10; 19 Fed. Rep. 817.

That on proceedings for repeal under Sec. 4918, Rev. Stat., a plea that the plaintiff's patent is void for want of novelty is improper, see Pentlarge *v.* Pentlarge (1884), 22 Fed. Rep. 412; 22 Blatch. 120.

That when on a suit to repeal under Sec. 4918, Rev. Stat., the defendant pleads that the plaintiff's patent is void for want of novelty, and this plea is overruled as improper, and the plea is amended, the defendant cannot set up the same matter in his answer, it being *res adjudicata* in that case, see Pentlarge *v.* Pentlarge (1884), 22 Blatch. 120; 22 Fed. Rep. 412.

That where, after an interference judgment, patents are granted to both parties, and the party to whom priority was adjudged institutes proceedings to annul the other patent, the latter patentee is not estopped to deny that the invention was new and patentable, see Holliday *v.* Piekhardt (1887), 29 Fed. Rep. 853; 24 Blatch. 201.

decided, in two cases of considerable prominence, that the acts of 1790 and 1793 bestowed this privilege upon the public; that the act of 1836, while enlarging the defences permitted to infringers, withdrew the public privilege of a repeal; and that as subsequent statutes have not revived it, no such privilege now exists.[1] But in the light of principle, as well

§ 725. [1] In Attorney-General *v.* Rumford Chemical Works (1876), 9 O. G. 1062, Shepley, J.: (1066), "This leads us to the consideration of the protection afforded by the provisions of the patent acts to the rights of the general public, and to the history of the legislation upon that branch of the subject. The fifth section of the act of 1790, the first act of Congress in relation to this subject (1 Stat. at Large, 111), provided a form and mode of proceeding to repeal a patent 'obtained surreptitiously, by or upon false suggestion,' upon complaint made under oath before the judge of the district court where the defendant resided, and motion within a year after the issuing of the patent, but not afterward. The patent issued under this act without any oath of the applicant and any previous examination, and want of novelty and originality are not included in the list of defences authorized by the sixth section. The act of 1793 extended the time of limitation for commencing proceedings to repeal the patent to three years, and enlarged the defences in actions for infringement, opening the defence for want of novelty and originality. These provisions clearly show that it was deemed necessary that authority for proceedings to repeal letters-patent should be conferred by statute. . . . (1067) These acts of 1790 and 1793, including these provisions conferring jurisdiction upon the Federal courts over proceedings for the repeal of letters-patent, were repealed by the act of 1836. That act was substantially re-enacted and codified by the act of 1870, and in the Revised Statutes of 1874. The act of 1836 contained no provision authorizing any proceeding to repeal letters-patent upon the ground that they were obtained 'surreptitiously, by or upon false suggestion,' but the sixteenth section provided a remedy in the case of conflicting patents, and for a repeal of the one which the court should adjudge had been improvidently issued. This takes the place of the remedy to which, in case of conflicting grants, the subject is entitled as matter of right in England. For the protection of the general public, in place of the provision for a proceeding in the nature of a *scire facias* to repeal the patent, to be instituted within three years, as provided in the act of 1793, it sought to provide safeguards against the issue of letters-patent upon false suggestion, and ample security against any injury to the citizen, to whom it opened every possible defence against injury resulting from any mistake or oversight of the Commissioner in issuing the patent. In fact, every defence against a patent that can well be imagined was left open to the citizen whose interests were affected by it, excepting only the one which, in Whitney *v.* Mowry, the Supreme Court decided was not open, — the question of fraud upon the government in obtaining the grant. To guard against such a fraud it provided for the examination by the Examiner and for a Commissioner and the subsequent proceedings hereinbefore stated, it being made the duty of the Examiner and the Commissioner to protect the rights of the public. The jurisdiction conferred by acts of 1790

as of the recent decisions of the Supreme Court, this position cannot be maintained. The right of the public to withdraw

and 1793 upon the Federal courts to repeal a patent, and which, without express grant, it is believed did not inhere in those courts, is nowhere conferred by the acts of 1836 or 1870, or in the Revised Statutes of 1874. It would seem to be a great stretch of power and assumption of jurisdiction for one circuit court, in the absence of any such express authority conferred by act of Congress, to repeal and vacate a patent which may have been originally granted upon the decree of another circuit court, upon appeal from the Commissioner, and *adjudged valid, perhaps, in litigation* respecting it in still another circuit court in another circuit. The better opinion upon this brief and imperfect review of the legislation of Congress upon this subject would seem to be that Congress had deliberately transferred the jurisdiction over the question of the protection of the rights of the general public to the *quasi* judicial decision of the Examiner and the Commissioner, or the actual judicial decision of the Federal courts upon appeal from the Commissioner, and fully protected the rights of the individuals against whom patents might be sought to be enforced, by opening to them every defence essential to the preservation of their rights and the protection of their interests. The decisions in the Federal courts sustaining proceedings in equity to vacate letters-patent granting lands obtained by fraud, furnish no precedent in case of letters-patent for inventions. The United States, as an owner of lands, has equal rights and is entitled to equal remedies with an individual owner. In granting lands the United States conveys that in which it has the fee. In issuing letters-patent for inventions, nothing is granted which belonged before to the United States. The issue of the letters-patent is in compliance with an act of Congress. The rights and remedies of the parties are dependent solely on the statute enactments, and do not grow out of any previous ownership of the supposed subject of the grant, as in the case of a conveyance of lands." 32 Fed. Rep. 608(621).

In United States *v.* American Bell Telephone Co. (1887), 41 O. G. 123; 32 Fed. Rep. 591, the same position is maintained. This case involved one of the most important patents ever issued in this country, and was exhaustively argued on both sides by several of the foremost members of the American Patent Law Bar. In rendering its judgment the court reviewed the history of legislation and judicial decision on this question, and arrived at conclusions which may be summed up as follows:

1. That all rights and remedies of patentees arise out of the Constitution and the acts of Congress, and where these are silent no right or remedy exists.

2. That the power to cancel a patent is not embraced among general equity powers, as in England, — the patent being there a royal grant, but here resting wholly on statute.

3. That a bill to cancel a patent cannot be maintained in the name of the United States in the absence of an express statute to that effect.

4. That the power to cancel a land patent does not extend to patents for inventions, since the government grants the land but not the invention.

5. That under the acts of 1790 and 1793 a patent could be cancelled on *scire facias* if surreptitiously obtained, but under later acts this is a ground of defence in infringement suits, and there only.

Of these conclusions the first and

from the grantee a grant improperly secured rests upon foundations deeper than the current enactments of the legislative

fourth seem to contain the fundamental propositions out of which the others are deduced, and the value of the decision as an authority thus depends on the truth of these premises and the soundness of the logical processes by which the others are inferred from them.

Firstly, then, is it true that all the rights and remedies of patentees arise out of the Constitution and the acts of Congress, and that where these are silent *no right or remedy exists?* The power to grant a monopoly in an invention was an attribute of sovereignty at common law, and was recognized as such by the courts of common law in the very heat of the contest against odious monopolies. (See § 9 and notes, *ante.*) It was claimed and exercised by the several States as an attribute of their common-law sovereignty, not only before but after the adoption of the Federal Constitution. (See § 45 and notes, *ante.*) The rights created by the grant of such a monopoly were defined and enforced, both in England and in our several States, according to the common principles and methods of law and equity, — in most cases without any statute to declare the right or to prescribe the remedy. When the Federal Constitution was framed it was optional with the people of the United States either to bestow this among other attributes of *sovereignty* upon the national government or to retain it within the sole possession of the individual States. They chose the former policy, and conferred upon the United States the same power to create monopolies in favor of inventors, throughout the entire country, that was already exercised by the several States within their respective areas, and that had been immemorially known to and sanctioned by the common law. In this provision of the Constitution they adopted the very words and phrases of the English law, defined the monopoly in terms of established meaning, and evidently contemplated the reproduction on this side the Atlantic of the system which had proved its value in the mother country. Under this clause of the Constitution Congress immediately passed the act of 1790, which is evidently little more than the formulation of the doctrines announced in previous decisions of the British common-law courts, and whose interpretation would have been impossible without constant recourse to the sources from which it was drawn. All later acts of Congress are mere developments and modifications of this earlier act, and bear a similar relation to the common law. Historically, therefore, the rights and remedies of patentees arise, not from the statutes, but from the common law, and though the common law has been to some extent declared and amplified by statutes, it cannot be assumed either that all the rights of patentees have been expressly named in these enactments, or that no remedies exist except those which are there particularly prescribed.

In practical jurisprudence the same fact appears. The earlier cases decided under our acts of Congress were adjudicated with constant reference to the decisions of the English courts. Equity asserted jurisdiction and applied its remedies unhesitatingly before the act of 1819, and when no chancery relief was given by statute. All questions as to the nature and scope of the monopoly, as to the forms of infringement, as to the course of pleading, mode of trial, and (except under the acts of 1790 and 1793) as to the measure of compensation in both tribunals, were settled by well-known law or equity

department of the government. It is a right inherent in the sovereign *jure regio*, and by the common law and in the his-

rules and independently of any express legislation. Whatever injury the patentee may sustain other than by the infringement of his patent, as by the slander of his title, the fraudulent discovery and appropriation of his secret pending his efforts to procure a patent, etc., must be redressed, if at all, according to the ordinary legal or equitable methods without the aid of statutes. The course of applied justice thus contradicts the proposition that all these rights and remedies rest on the Constitution and the acts of Congress, and that no right or remedy exists except as they bestow it.

It is doubtless true that if the Federal Constitution had not contained the clause referred to, or its equivalent, the United States would have received no power to create a monopoly in favor of the inventor. It is also true that if Congress had never passed an act to carry this clause into effect, no patents ever could have been granted by the Federal Government. But it does not thence follow that when Congress has legislated on the subject and established a patent-system clothed with the authority to issue patents for inventions, all rights under such patents and all remedies for their violation must be found declared and specified in the statutes by which this authority is conferred. As in every other instance where express legislation relates to subject-matter already known to the common law, the statute does not exclude what it does not mention or impliedly repeal, but both the written and unwritten law must be construed together and taken as the measure of the rights and remedies with which they deal.

But were it conceded that all the rights and remedies of patentees arise out of the Constitution and the acts of Congress, what inference can from this be drawn that the United States is without remedy against a fraudulent monopoly? Either the patentee has a right to retain a patent which he has procured by fraud, or the government which has been deceived, acting for the public which has been defrauded, has the right to cancel it. It will hardly be pretended that the written law confers such right upon the patentee, and thence according to the line of argument adopted by the court, the right to a repeal is vested in the United States. But neither the common law nor the principles of equity jurisprudence afford an apology for such a claim on behalf of the fraudulent patentee; on the contrary, in both tribunals the power of the government to interfere at once and restore to the public the privileges of which they have been unjustly deprived has constantly been recognized as a part of that same attribute of sovereignty by whose exercise the monopoly has been created. If the United States has not this power it is because the Federal Constitution, in conferring upon the national government the authority to create monopolies, divorced from this authority its necessary correlate, — the authority to rescind unlawful monopolies, — leaving the latter in the States as part of their reserved sovereignty, or extinguishing it altogether, — either of which positions is absurd, though scarcely more so than the claim that such a defect of sovereignty can be removed by any act of Congress.

Not to pursue this criticism further, can there be any serious doubt that the United States has power to repeal unlawful patents, irrespective of any special provision of the Constitution to that effect, or any act of Congress conferring that authority, but solely as a part of

tory of English jurisprudence has always been recognized as embraced in the prerogative by which the grant itself is au-

its sovereignty over the subject-matter of monopolies for inventions as delegated to it by the express language of the Constitution? And if this be not doubted what answer shall be given to the further question, — whether, possessing this power, the Federal government can exercise it for the protection of the public interests in the ordinary modes known to the law from which ours is derived or must await the designation by some act of Congress of a proceeding in which its repealing power could be applied?

It will divest this question of some of its obscurity if we remove from the discussion certain matters which have had great weight with the courts in the two cases now under review, but which have really no bearing whatever on the principle involved. In the acts of 1790 and 1793 provisions for the repeal, by *scire facias*, of patents issued upon false suggestion, were inserted which by later statutes were impliedly annulled, and now have no place in our written Patent Law. Assuming that these provisions were intended by Congress to afford the government a method for rescinding unlawful patents in the interest of the public, their repeal and the failure to provide such methods in the recent statutes has been accepted as a powerful argument in favor of the view that under present laws the government is left without a remedy. This is, in fact, the substance of the reasoning in the first case cited, which is closely followed in the second. But the slightest examination of these provisions will disclose that the remedy afforded by them was a private not a public remedy. The proceeding was to be instituted by a private person who was to be liable for the costs if his effort failed. It was to have been brought within a limited time after the patent issued, and was particularly designed to afford relief in cases where the patentee was not the first and true inventor of the matter covered by his patent. The awarding of the remedy was entirely at the discretion of the court. The United States could not be made a party to the suit, either originally or by substitution, and was held by the courts to be entirely without interest in the controversy, except as the public may always benefit by a decision that a patent is invalid. (See Wood *v.* Williams (1834), Gilpin, 517; 1 Robb, 717.) Now what possible connection can there be, either in law or logic, between this grant of a private remedy, or the substitution for it of other private remedies under later statutes, and the power of the United States, in its sovereign capacity, to interfere for the rescission of a monopoly unlawfully obtained? As it could not avail itself of this provision, the passage of the statute affords no indication that an act of Congress was necessary to enable it to exercise its power. As the repeal of this provision could not deprive it of any remedy, such repeal is no proof that its remedies do not exist. The arguments derived from these provisions are thus aside from the whole question at issue, leaving it to be determined upon independent grounds of fact and principle.

Stripped of this veil of fallacy the exact question may be stated thus: Either the United States has never had a remedy by means of which it might recall a patent fraudulently obtained; or it has always had and still retains the remedies known to equity and the common law. Each of these alternatives excludes the other, and one or the other of them must be true. Applying to this question the test of fundamental

thorized. Still more essential is it to our own patent system, where the issue of a patent creates a contract between the

principle we then inquire whether a sovereignty, in the exercise of sovereign authority, can ever confer upon an individual a privilege which curtails its own freedom of action and invades the common rights of all its subjects, beyond its own power to revoke the privilege when it discovers that the grant has been obtained by fraud. If so, the nation is more helpless than any private citizen. Through its ignorant or unfaithful servants it may commit itself to the most foolish or injurious measures without the ability to retrace its steps or to correct its errors. Such a condition of affairs is not contemplated by any theory of political society, or any system of civilized *jurisprudence*. The power to create necessarily embraces the power to destroy, and if modes are provided in which creative power may be exerted, and none for the administration of destructive energy, the latter must be exercised, when needed, in any manner which may have before been known to and sanctioned by the customary law. That this is true whenever the government has been defrauded into a grant of public property, has never been disputed. That it applies equally whenever public right has been unlawfully restrained, follows from the same principles of justice and the inherent nature of the sovereign power.

To avoid this conclusion, the court, in the case now considered, adopts the *dictum* of the earlier judge, that in the issue of letters-patent for an invention nothing is granted which before belonged to the United States, and therefore, although fraudulent, the patent cannot, like a land grant, be recalled. This is the fourth of our formulated propositions, and in it resides whatever real force the arguments on this side of the controversy possess.

That the government never owned and does not grant the *invention* to the patentee may be at once conceded, but this concession by no means disposes of the point in question. In a land grant the government transfers to private owners the property which it held, not as its own, but in trust for the whole people. By that transfer it decreases the entire amount of public property, and restricts its own power of dominion and conveyance over the land conferred. Thus when such a grant is obtained through fraud, the government and the public both sustain an injury, which known equitable and legal remedies are sufficient to redress. On the other hand, when the government grants a simple franchise it transfers no public property nor does it limit its own rights *in any manner or degree*. Other franchises of similar character may be indefinitely bestowed, and however numerous they may be, the privileges of the people at large are not affected. In such cases, as there is no injury, even where fraud is practised in procuring the grant, there is no occasion for a remedy, unless, in view of public policy, the government sees fit to inflict upon the fraudulent grantees the penalty of forfeiture. The positions taken by our courts in reference both to land grants and to franchises are, therefore, sound in principle and recognize the government as supplied with all the remedies it can require.

The judges, in the two cases now examined, repudiate all similarity between a patent for an invention and a land grant, and identify it with a franchise both in nature and effect. This is obviously an error. The issue of a patent does not confer a simple franchise; it creates a monopoly. Although the government and the public *do not own* the invention, they do possess rights in reference to it of the most important

inventor and the public which like all other contracts may

character, which are suspended or relinquished by the grant of letters-patent. The government has the right to bestow upon the first and true inventor of that invention an absolute and undisputed monopoly, free from all doubts as to his title, and this right is relinquished by the actual issue of a patent to any patentee. The public, whom the government represents, have an unquestioned natural right to use the invention freely upon its voluntary publication by the inventor, and to invent and use the art or article for themselves in case he does not see fit to disclose it. This right is immediately suspended by the issue of a patent, and cannot be regained until the patent has expired or been repealed. Both of these rights are of the highest value to the nation, and their invasion by fraudulently obtaining the issue of a patent is an injury equal in enormity and in disaster to the public to that which any fraudulent land grant could occasion. No better illustration of this statement can be needed than the patent whose repeal was sought in the case at bar, — a patent which if fraudulently procured has not only deprived the government of the power to confer a merited monopoly on an illustrious and successful inventor, but has been made an engine of oppression on the public from one end of the country to the other. If this question is to be determined by analogy it is thus evident that the doctrine applied to land grants, and not that to franchises, must furnish us with the desired solution. Though the correspondence in subject-matter is not exact, the rights involved are of the same general character and vest in the same persons, while the wrongs committed by the fraud affect interests of equal importance, and demand as summary relief.

In United States *v.* American Bell Telephone Co. (1888); 128 U. S. 315; 45 O. G. 1311, the principles asserted in this criticism of the two cases before mentioned have just been adopted, in substance, by the Supreme Court of the United States as the grounds of its reversal of the decision in United States *v.* American Bell Telephone Co., and its consequent rejection of Atty. Gen. *v.* Rumford Chemical Works as a reliable authority upon the point in question. Mr. Justice Miller there presents these considerations in a different arrangement from that here pursued, but reaches his results by the same general methods, unqualifiedly asserting the right of the United States to proceed in equity for the repeal of patents fraudulently obtained, although no statutory power or remedy to that effect has been conferred upon them.

In United States *v.* Gunning (1883), 21 Blatch. 516, Wallace, J.: (517) "Notwithstanding the expression of opinion by Judge Shepley, in Attorney General *v.* Rumford Chemical Works (2 Banning & Ardon, 298), in favor of the defendants' position, it is believed there is no sound reason why a bill will not lie in such a case, as well as where the subject of the grant is land or is a franchise or right of a different kind. The learned judge laid much stress upon the consideration that, in issuing letters-patent for inventions, nothing is granted which belonged before to the United States, and that the rights and remedies of the parties to such grants are dependent solely on the statute enactments, and do not grow out of any previous ownership of the subject of the grant; and it was his view that in such a case, express authority for proceedings to annul the grant must be conferred, in order to sanction them. The same reasoning would preclude a State from proceedings to annul the charter of a corporation created by its Legislature, if obtained through fraud. Yet it is a

be rescinded for non-performance of conditions precedent, or avoided when originally obtained by fraud.

§ 726. Patents Repealable at Common Law in the Interest of the Public in Three Classes of Cases.

At common law a grant by the sovereign was revocable in three classes of cases: (1) Where the same subject-matter had been previously granted; (2) Where the grant had been procured by fraud; (3) Where the subject-matter of the grant could not legally be granted.[1] Under our law the first

familiar principle that grants of corporate franchises, obtained through fraud practised upon the Legislature, are void when the State elects to set them aside by a judicial rescission. (Morawetz, Corp. § 148.) He also refers to the provisions of the Patent Acts of 1790 and 1793, which authorized proceedings for the repeal of patents obtained surreptitiously or by false suggestion, as indicating that Congress deemed it *necessary* that authority for proceedings to repeal letters-patent obtained through fraud should be conferred by statute. These provisions, however, permitted such proceedings to be taken by any person who chose to complain, — a right which did not and does not exist unless expressly conferred. A bill in equity lies to set aside letters-patent obtained by fraud, but only between the sovereignty making the grant and the grantee. (Field *v.* Seabury, 19 How. 323.) No inference can be justly drawn, therefore, from these provisions, that Congress deemed it requisite to confer express authority upon the United States to maintain such a suit, nor, from the absence of such provisions in the existing laws, that Congress intended to withhold such authority." 26 O. G. 356 (356), 18 Fed. Rep. 511 (512).

In Mowry *v.* Whitney (1871), 14 Wall. 434, Miller, J.: (440) "The 16th section of the Patent Act of 1836 seems to have in view the same distinction made by the common law in regard to annulling patents, for while it authorizes individuals claiming under conflicting patents, or one whose claim to a patent has been rejected because his invention was covered by a patent already issued, to try the conflicting claim in chancery, and authorizes the court to annul or set aside a patent so far as may be found necessary to protect the right, the suit by individuals is limited to that class of cases. And it is provided that the decree shall be of no validity except between the parties to the suit. The general public is left to the protection of the government and its officers." 1 O. G. 499 (500); 5 Fisher, 513 (515).

§ 726. [1] In Mowry *v.* Whitney (1871), 14 Wall. 434, Miller, J.: (439) "The ancient mode of doing this in the English courts was by *scire facias*, and three classes of cases are laid down in which this may be done: (1) When the king by his letters-patent has by different patents granted the same thing to several persons, the first patentee shall have a *scire facias* to repeal the second; (2) When the king has granted a thing by false suggestion, he may by *scire facias* repeal his own grant; (3) When he has granted that which by law he cannot grant, he, *jure regis*, and for the advancement of justice and right, may have a *scire facias* to repeal his own letters-patent. . . . It will be observed that in the case of a conflict

class has been modified in character and provided with a special remedy. The common law conclusively presumed the first patent to be valid as against all patents subsequently granted, and thus repealed only the later patent in favor of the former. Our law recognizes no conclusive presumption in the interest of either the prior or the later patent, but sustains the one granted to the first and true inventor and repeals all others. The method by which this is accomplished, without invoking the aid of the public, was discussed in the last section.

§ 727. Proceedings for a Repeal in the Interest of the Public Necessary when the Patent was Obtained by Fraud.

The second class of cases directly involves the interests of the whole people and can be remedied only by governmental interference. A patent procured by fraud not only confers no just rights on the patentee, but as long as it exists it constitutes an unwarrantable limitation on the sovereign power. So far as it affects the interests of individual citizens it is also an act of oppression, in aid of which the sanction of the government has been unlawfully obtained. But no ability to secure himself against its operation resides in any individual. It is a grant within the jurisdiction of the grantor, and therefore cannot be collaterally attacked. Nor is the injury sustained by individuals from the fraud and falsehood of the patentee so distinct from that inflicted on the general public that any private action can be instituted to redress it.[1]

under two patents granting the same rights, the *scire facias* may, according to the authorities cited, be brought in the name of one of the patentees; but in the other cases, when the patent was obtained by a fraud upon the king, by false suggestion, or where it was issued without authority, and for the good of the public and right and justice it should be repealed, the writ is to issue in the king's name or his attorney-general's. It is also said that when a patent is granted to the prejudice of the subject, the king of right is to permit him upon his petition to use his name for the repeal of it, in *scire facias* at the king's suit." 1 C. G. 499 (500); 5 Fisher, 513 (514).

§ 727. [1] In Mowry *v.* Whitney (1871), 14 Wall. 434, Miller, J.: (441) "The reasons for requiring official authority for such a proceeding are obvious: (1) The fraud, if one exists, has been practised on the government, and as the party injured, it is the appropriate party to assert the remedy or seek relief. (2) A suit by an individual could only be conclusive in result

Hence, as such frauds upon the Patent Office cannot be prevented, and as in the inevitable course of things patents from time to time are granted upon false suggestions or upon concealments which amount to fraud, the revocation of such patents is a duty which the public owes to itself both as a sovereign and as a community of individuals.

§ 728. Proceedings for a Repeal in the Interest of the Public sometimes Necessary where the Subject-matter of the Patent cannot Lawfully be Patented.

How far and when the government is called upon to interfere in cases of the third class is a question of more difficulty. The grant of a subject-matter which is by law incapable of being granted carries upon its face the evidence of its own invalidity. The power of the sovereign is not limited by it even in appearance, nor is the subject estopped from denying its efficiency in a collateral proceeding. Thus while the authority of the government to revoke the grant cannot be doubted, the cases in which this becomes necessary in the interest of the public or for individual protection are comparatively rare. Under our patent system the security af-

as between the patentee and the party suing, and it would remain a valid instrument as to all others. (3) The patentee would or might be subjected to innumerable vexatious suits to set aside his patent, since a decree in his favor in one suit would be no bar to a suit by another party. If, on the other hand, an individual finds himself injured, either specially or as a part of the general public, it is no hardship to require him to satisfy the attorney-general that the case is one in which the government ought to interfere, either directly by instituting the suit, or indirectly by authorizing the use of its name, by which the attorney-general would retain such control of the matter as would enable him to prevent oppression and abuse in the exercise of the right to prosecute such a suit. It would seriously impair the value of the title which the government grants after regular proceedings before officers appointed for the purpose, if the validity of the instrument by which the grant is made, can be impeached by any one whose interest may be affected by it, and would tend to discredit the authority of the government in such matters." 1 O. G. 499 (500); 5 Fisher, 513 (516). See also § 715 and notes, *ante*.

That the unintentional issue of a patent cannot be set up except in a direct proceeding to vacate the patent, see Doughty *v.* West (1869), 3 Fisher, 580; 6 Blatch. 429.

That the United States cannot sue to repeal a patent on grounds that have been urged against the patent in an infringement suit when the patent was sustained, see United States *v.* Colgate (1884), 32 Fed. Rep. 624.

forded against unlawful patents of this character by the proceedings in the Patent Office, and by the defences permitted to alleged infringers, is usually sufficient, and in such cases the government will not interfere. But where the invalidity of a patent has been established by repeated decisions of the courts, and it is being used as a mere instrument of oppression against citizens who, though aware of its true character, cannot avoid incurring trouble and expense in their defence against it, the public cannot justly refuse to withdraw the appearance of authority, under which the wrong is perpetrated, by the immediate and final revocation of the patent.

§ 729. Proceedings for a Repeal in the Interest of the Public are by Bill in Equity in the Name of the United States.

The proceeding for the repeal of an unlawful patent of the second or third classes is by a bill in chancery in the name of the government or its Attorney-General.[1] Such proceedings are instituted with great caution. The Attorney-General

§ 729. [1] In Mowry *v.* Whitney (1871), 14 Wall. 434, Miller, J.: (440) "The *scire facias* to repeal a patent was brought in chancery where the patent was of record. And though in this country the writ of *scire facias* is not in use as a chancery proceeding, the nature of the chancery jurisdiction and its mode of proceeding have established it as the appropriate tribunal for the annulling of a grant or patent from the government. This is settled so far as this court is concerned by the case of the United States *v.* Stone, in which it is said that the bill in chancery is found a more convenient remedy. A bill of this character was also sustained in the English chancery in the case of The Attorney-General *v.* Vernon, on the ground of the equitable jurisdiction in matters of fraud. And in the case of Jackson *v.* Lawton, Chancellor Kent says that in addition to the writ of *scire facias* which has ceased to be applicable with us, there is another remedy, by bill in the equity side of the court of chancery." 1 O. G. 499 (500); 5 Fisher, 513 (515).

That proceedings to repeal a patent under the act of 1793 were in the nature of a *scire facias*, see *Ex parte* Wood (1824), 9 Wheat. 603; 1 Robb, 438; Stearns *v.* Barrett (1816), 1 Mason, 153; 1 Robb, 97.

That only the attorney-general, in the name of the United States can sue to limit or repeal a patent, see Celluloid Mfg. Co. *v.* Goodyear Dental Vulcanite Co. (1876), 10 O. G. 41; 13 Blatch. 375; United States *v.* Doughty (1870), 7 Blatch. 424.

That the power of the attorney-general to sue for a repeal gives no power to a defendant in an *infringement* suit to bring the matter before the courts, see New York and Baltimore Coffee Polishing Co. *v.* New York Coffee Polishing Co. (1881), 20 Blatch. 174; 9 Fed. Rep. 578.

must be satisfied that sufficient grounds exist for submitting the question to the courts, and if he is in doubt he may be guided by the opinion of the Commissioner.[3] In cases where the patent is alleged to have been fraudulently obtained he may act at the instigation of a private party, but not in cases where the matter urged as the reason for refusal could be employed by the relator in his own defence against the patent.[3] In whosesoever interest and for whatever purpose the proceedings are commenced, they remain always under his control, and can be prosecuted or discontinued by him as his judgment of the merits of the controversy may require.[4]

§ 730. Procedure and Judgment upon a Bill for Repeal.

Upon this bill in equity the process, pleadings, hearing, and decrees follow the usual course of chancery proceedings.[1] All persons to be affected by the repeal of the patent must be made parties, and the grounds of the repeal must be established beyond reasonable doubt. The effect of a judgment in favor of the public is to extinguish the patent and all rights accruing under it, even in the hands of an innocent *bona fide* purchaser; and the owners of the patent must thereupon sur-

[3] That the name of the United States should be used in a bill for repeal only when the Commissioner is satisfied that the patent should be repealed, or the courts have doubted the validity of the patent, or the patent was fraudulently obtained, see Opinion Atty. Gen. (1874), 6 O. G. 723.

[3] That a bill to repeal a patent on the ground of a false oath will not lie in the name of the United States in the interest of private parties, though they file a bond indemnifying the United States, if the same matters could be set up in their defence when sued, see United States *v.* Frazer (1884), 22 Fed. Rep. 106.

[4] That suits to annul patents are wholly within the control of the United States attorney, and there is no obligation resting on him to institute or proceed with them, see New York and Baltimore Coffee Polishing Co. *v.* New York Coffee Polishing Co. (1881), 9 Fed. Rep. 578; 20 Blatch. 174.

§ 730. [1] That pending a suit on behalf of the United States for the repeal of a patent, an injunction to restrain or suspend actions for infringement will not be granted, the United States having no interest in such actions, see United States *v.* Colgate (1884), 22 Blatch. 412; 21 Fed. Rep. 318.

That the institution of a suit to repeal a patent raises no presumption of its invalidity, see American Bell Telephone Co. *v.* National Improved Telephone Co. (1886), 27 Fed. Rep. 663.

render it to the Patent Office that it may be duly cancelled.[2] Costs may be decreed against any owners of the patent whose false suggestions led to its original issue, but not against an owner who was not a party to the fraud.

[2] That a patent will be repealed on account of the fraud of the patentee, when he was not the true inventor, although his co-owner was not a party to the fraud, but was a *bona fide* assignee for valuable consideration, no costs, however, being decreed against him, see United States *v.* Gunning (1884), 23 Blatch. 31; 22 Fed. Rep. 653.

CHAPTER IV.

OF THE CONSTRUCTION OF LETTERS-PATENT.

§ 731. Nature and Scope of the Patent Monopoly Determined by the Legal Interpretation of the Letters-Patent.

THE character and scope of a patent privilege is determined by the construction given to the letters-patent.[1] The patented invention is not necessarily the art or instrument which has been actually discovered or produced by the inventor, nor that which he endeavored to protect or thinks he has protected by his patent;[2] it is the art or instrument which his patent really describes and claims, according to its true legal interpretation. Hence all his rights in reference to the exclusive use of his invention, and all the rights of the public to its free enjoyment, depend in the last resort upon the meaning which the law attaches to the language of his patent. The duty of interpreting letters-patent, therefore, imposes vast responsibilities upon the tribunal to which it is confided, and its proper discharge demands a high degree of industrial skill and knowledge.

§ 732. Interpretation of Letters-Patent a Matter of Law for the Court.

The duty of interpreting letters-patent has been committed to the courts.[1] A patent is a legal instrument, to be construed,

§ 731. [1] That a patent grants just to be, but on what the patent covers when properly construed, see Serrell *v.* Collins (1857), 1 Fisher, 289.

[2] That the opinions of patentees on legal questions connected with their patents are not binding on them, see Adams *v.* Edwards (1848), 1 Fisher, 1.

That the rights of a patentee do not rest on what he supposes the invention what the courts construe it to grant, see Masury *v.* Anderson (1873), 11 Blatch. 162; 6 Fisher, 457; 4 O. G. 55.

§ 732. [1] In Emerson *v.* Hogg (1845), 2 Blatch. 1, Betts, J.: (6) "It is the province and the duty of the court to settle the meaning of the patent, and, if that cannot be ascertained satisfac-

like other legal instruments, according to its tenor. Whether its Claims are valid or invalid, whether or not they embrace a given invention, and what may be the actual nature of the invention which they do embrace, are questions of law for the court, to be decided upon an inspection of the instrument itself.[2] No evidence of any kind, no opinions of other persons, can have any direct influence upon this decision. Where technical terms are used, or where the qualities of substances or operations mentioned or any similar data necessary to the comprehension of the language of the patent are unknown to the judge, the testimony of witnesses may be received upon these subjects, and any other means of information be employed.[3] But in the actual interpretation of the patent the

torily upon the face of the specification, the law declares it insufficient for ambiguity and uncertainty. (Godson on Pat. 109, and Supp. 29; Phillips on Pat. 249, 252.) The meaning of the terms employed, in view of the object the inventor had in contemplation, and to ascertain the extent of his claim, must be determined and declared by the court. The specification is laid before the jury as defined and settled by the exposition of the court, and the matters of fact presented by the respective parties to support or defeat the patent are then to be examined and applied as if the construction fixed by the court had been incorporated in the specification."

Further, that the interpretation of a patent is a matter of law for the courts, see National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 19 Fed. Rep. 514; 28 O. G. 1007; Jackson *v.* Allen (1876), 120 Mass. 64; Union Sugar Refinery *v.* Matthiesson (1865), 2 Fisher, 600; 3 Clifford, 639; Page *v.* Ferry (1857), 1 Fisher, 298; Parker *v.* Hulme (1849), 1 Fisher, 44; Davoll *v.* Brown (1845), 1 W. & M. 53; 2 Robb, 303.

That the construction of the patent is for the court, its application to the facts is for the jury, see Teese *v.* Phelps (1855), 1 McAllister, 48.

That it is for the court to say what the patent covers, and for the jury to say if the patent is sufficiently clear and full to enable the public to practise the invention, see Parker *v.* Stiles (1849), 5 McLean, 44; Davis *v.* Palmer (1827), 2 Brock. 298; 1 Robb, 518.

[2] That the construction of a specification is for the court as a matter of law, see Conover *v.* Roach (1857), 4 Fisher, 12; Emerson *v.* Hogg (1845), 2 Blatch. 1.

That the construction of the Claims of a patent is matter of law for the court, unless technical terms require evidence to explain them, see Ransom *v.* Mayor of N. Y. (1856), 1 Fisher, 252.

That whether a given element is claimed as essential or not is a question for the court, see Vance *v.* Campbell (1859), 1 Fisher, 483.

That the question as to the validity of the Claims is largely a question of law, see Burdett *v.* Estey (1878), 15 O. G. 877; 15 Blatch. 349.

That the court need not construe the patent for the jury in an action on a contract unless so requested, see Holliday *v.* Rheom (1852), 18 Pa. St. 465.

[3] In Day *v.* Stellman (1859), 1 Fisher, 487, Giles, J.: (491) "The court would remark that while the interpretation and construction of all written instru-

court proceeds upon its own responsibility, as an arbiter of the law, giving to the patent its true and final character and force.

§ 733. Advantages of Confiding the Interpretation of Letters-Patent to the Courts as Matter of Law.

Apart from the general principles upon which this duty of interpretation is entrusted to the court, there are advantages attending it which the inventor could not otherwise enjoy.[1] To treat the nature of the patented invention as a matter of fact, to be inquired of and determined by a jury, would at once deprive the inventor of the opportunity to obtain a permanent

ments is for the court, it nevertheless will bring to its aid the testimony of witnesses to explain terms of art, and make itself acquainted with the material with which the contracts deal, and with the circumstances under which they were made; but neither the testimony of witnesses in general, nor of professors, experts or mechanics, can be received, to prove to the court what is the proper or legal construction of any instrument of writing. Such evidence is inadmissible."

That extraneous matters may be considered to aid construction when it becomes necessary, see Day *v.* Cary (1859), 1 Fisher, 424.

That the court is not to be controlled by expert evidence in the construction of the patent nor as to the novelty of the invention, see Jackson *v.* Allen (1876), 120 Mass. 64.

portance for this distribution of the respective duties of the court and the jury. The import of the instrument is purely a question of law. The interpretation of complicated instruments of writing is a special occupation, requiring, like all others, special training and practice. The judge, from his training and discipline, is more likely to give a proper interpretation to such instruments than a jury; and he is, therefore, more likely to be right in performing such a duty than a jury can be expected to be. The action of a judge, in such a case as that of interpreting the specification, is moreover open to review and correction, by reconsideration on his part, or by the revisal of a superior or appellate court, where his reasoning can be tested. This is not so with a jury, who assign no reasons for their opinion, cannot be called on and are not permitted to review or reverse their action, and who, passing upon many questions in their private deliberations, do not declare by their verdict upon what particular elements they at last unite in a verdict; and it is impossible for a court to analyze them. The rule is, therefore, established, that on the judge is placed the responsibility, and he must declare the proper interpretation of written instruments." See also §§ 1017, 1174–1184 and notes, *post*.

§ 733. [1] In Parker *v.* Hulme (1849), 1 Fisher, 44, Kane, J.: (46) "The specification being an instrument of writing, and the words of which it is made up having a fixed and plain import, its interpretation is a matter exclusively for the court, who must explain it. This part of the case is not for the jury, who for the purposes of this cause will adopt and act upon the interpretation given to it by the court. There is great reason and im-

and universal definition of his rights under the patent, and in each case of infringement it would subject him to the danger of a false interpretation, from the consequences of which he could not escape. By confiding this duty to the court, however, its decision as to the nature of the patented invention becomes reviewable to the same extent as any other legal question, and when his patent has received the interpretation of the Supreme Court of the United States the inventor can maintain his privilege, as thus interpreted, against all opponents without further controversy in reference to its true limitations.[2]

§ 734. Interpretation of Letters-Patent Governed by both General and Special Rules.

In the construction of letters-patent the courts are guided by certain well-established rules which are intended to secure the reciprocal rights of the inventor and the public. Most of these rules are found in the decisions of the courts themselves, and are characterized by that liberal spirit which our law has always displayed toward the inventor. In discussing them in detail it will be convenient to consider, first, the general rules applicable to all letters-patent, and second, the special rules adopted in particular cases.

SECTION I.

OF THE CONSTRUCTION OF LETTERS-PATENT: GENERAL RULES.

§ 735. First General Rule: Patents are to be Liberally Construed in Favor of the Inventor.

The fundamental rule governing the construction of a patent, and of each of its individual parts, requires that it be liberally interpreted in favor of the patentee.[1] The patent privilege is

[2] That the construction given to a patent by the Supreme Court is final, see Goodyear Dental Vulcanite Co. *v.* Davis (1877), 3 Bann. & A. 115; 12 O. G. 1.

§ 735. [1] That a patent will be liberally construed, see Trader *v.* Messmore (1875), 1 Bann. & A. 639; 7 O. G. 385; Carew *v.* Boston Elastic Fabric Co. (1871), 1 O. G. 91; 5 Fisher, 90; 3 Clifford, 356; Francis *v.* Mellor (1871), 5 Fisher, 153; 8 Phila. 157;

property, and its extent and value are not to be limited, nor is its title to be disturbed, on any doubtful grounds.[2] It is created by a grant from the sovereign power, and for that reason every presumption of law is in support of its validity, and such construction must be given to the letter of the grant as will most perfectly secure the proposed benefit to the grantee.[3] It is the consideration of a contract made between the inventor and the public, and the instrument describing it must, therefore, be interpreted in the interest of the inventor to whom the consideration moves.[4] Thus in whatever aspect

1 O. G. 48; Rubber Co. *v.* Goodyear (1869), 9 Wall. 788; Union Sugar Refinery *v.* Matthiesson (1865), 2 Fisher, 600; 3 Clifford, 639; Imlay *v.* Norwich & Worcester R. R. Co. (1858), 1 Fisher, 340; 4 Blatch. 227; Potter *v.* Holland (1858), 1 Fisher, 382; 4 Blatch. 238; Goodyear *v.* Railroad (1853), 2 Wall. Jr. 356; 1 Fisher, 626; Parker *v.* Sears (1850), 1 Fisher, 93; Davoll *v.* Brown (1845), 1 W. & M. 53; 2 Robb, 303; Ryan *v.* Goodwin (1839), 3 Sumner, 514; 1 Robb, 725; Blanchard *v.* Sprague (1839), 3 Sumner, 535; 1 Robb, 734; Ames *v.* Howard (1833), 1 Sumner, 482; 1 Robb, 689; Whitney *v.* Emmett (1831), Baldwin, 303; 1 Robb, 567.

That the specification is to be read in a liberal spirit, see Hamilton *v.* Ives (1873), 6 Fisher, 244; 3 O. G. 30; Goodyear *v.* Railroad (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

That the specification of a patent should be so construed as to sustain it if possible, see Goodyear *v.* Berry (1868), 3 Fisher, 439; 2 Bond, 189; Johnson *v.* Willimantic Linen Co. (1866), 33 Conn. 436.

That a Claim is to be construed liberally by the specifications, drawings, and state of the art, see Smith *v.* Prior (1873), 2 Sawyer, 461; 6 Fisher, 469; 4 O. G. 633.

[2] In Blandy *v.* Griffith (1869), 3 Fisher, 609, Swayne, J.: (620) "The rights secured by a patent for an invention or discovery are as much property as anything else, real or incorporeal. The titles by which they are held, like other titles, should not be overthrown upon doubts or objections capable of a reasonable and just solution in favor of their validity. This principle should be steadily borne in mind by those to whom is intrusted the administration of civil justice." See also Francis *v.* Mellor (1871), 1 O. G. 48; 8 Phila. 157; 5 Fisher, 153; Goodyear Dental Vulcanite Co. *v.* Gardiner (1871), 3 Clifford, 408; 4 Fisher, 224.

[3] That the presumptions are in favor of a patent and it should be liberally construed, see Potter *v.* Holland (1858), 4 Blatch. 238; 1 Fisher, 382; Rex *v.* Mussary (1738), 1 Web. 41; 1 Abb. P. C. 8.

That Claims will be construed, if possible, to sustain the patentee's right to all he has invented, see Ransom *v.* Mayor of N. Y. (1856), 1 Fisher, 252.

[4] In C. A. Yale Cigar Mfg. Co. *v.* Yale (1884), 30 O. G. 1183, Dyrenforth, Act. Com.: (1188) "It is a contract between the public and the patentee, to be supported on the ground of mutual considerations, and, being essentially a bargain, is to be construed like other contracts to which there are two parties, each having rights and interests involved in its stipulation."

That the language of a patent must be

the patent privilege may be viewed, justice and legal principle both find expression in this rule, — that the presumption is in favor of the patentee, and that all doubtful points must be resolved in such a manner as to support his claims.

§ 736. Wherein a Liberal Construction of Letters-Patent Consists.

A liberal construction is given to the patent when its terms are so interpreted as to sustain the patent and cause it to protect the actual invention.[1] The law recognizes that Claims and Descriptions often are, and in the nature of things often must be, unskilfully drawn, and must, therefore, in many cases fail to represent unequivocally the invention which the patentee endeavored to secure.[2] To apply such Claims and Descriptions to the invention as it really exists, by giving to each word and phrase that one of its legitimate meanings which makes the whole Claim or Description correspond most accurately with the essential characteristics of the true invention, is to give the patent that liberal construction which the law requires.[3]

construed so as to effectuate the intention of the parties, and must be limited in scope if the inventor so intended, see Harris *v.* Allen (1883), 15 Fed. Rep. 106.

§ 736. [1] In Corning *v.* Burden (1853), 15 How. 252, Grier, J.: (269) "It is true that the patentee, after describing his machine, has set forth his Claim in rather ambiguous and equivocal terms, which might be construed to mean either a process or machine. In such case the construction should be that which is most favorable to the patentee, '*ut res magis valeat quam pereat.*' His patent having a title which claims a machine, and his specification describing a machine, to construe his Claim as for the function, effect, or result of his machine, would certainly endanger, if not destroy, its validity. His Claim cannot change or nullify his previous specification with safety to his patent."

That a patent should be liberally construed so as not to limit the invention beyond the facts, see Schillinger *v.* Gunther (1877), 11 O. G. 831; 14 Blatch. 152.

That a patent will be construed to sustain the Claim, though the specification must be broadly interpreted in order to do it, see Mallory Mfg. Co. *v.* Marks (1881), 20 O. G. 1521; 20 Blatch. 32; 11 Fed. Rep. 887.

That the court should interpret a patent as persons skilled in the art would, see Tondeur *v.* Stewart (1886), 37 O. G. 672; 28 Fed. Rep. 561.

[2] That in construing patents the court will remember that the specification and Claims are often unskilfully drawn, see Henderson *v.* Cleveland Co-operative Stove Co. (1877), 2 Bann. & A. 604; 12 O. G. 4.

[3] That a patent is to be construed by applying its words to its subject-matter, see Goodyear Dental Vulcanite Co. *v.* Gardiner (1870), 4 Fisher, 224; 3 Clifford, 408.

That the construction of patents is to

§ 737. Rule of Liberal Construction does not Authorize a Departure from the Language of the Letters-Patent.

This rule of liberal construction does not, however, confer upon the court the power to change the language of the patent, or to give to words or phrases a meaning wholly different from their own.[1] To interpret the terms of a patent is one act; to create new terms, either directly by substituting other terms or indirectly by adopting new significations for existing terms, is an entirely distinct act; and no authority to perform the latter act has ever been committed to the courts.[2] If the language of a patent is erroneous, if the inventor has discovered much and described little, if subsequent events have taught him that his patent is narrower than his actual invention, his remedy is by a new patent or by an amendment of his old patent, not by its forced construction.[3] The court, interpret-

be practical, not fanciful, see Davoll *v.* Brown (1845), 1 W. & M. 53; 2 Robb, 303.

That a patent for an art cannot be limited to the apparatus used for practising the art, see Hammerschlag Mfg. Co. *v.* Bancroft (1887), 32 Fed. Rep. 585.

§ 737. [1] That a patent will be interpreted by its own terms, see Goodyear Dental Vulcanite Co. *v.* Davis (1880), 102 U. S. 222; 19 O. G. 543.

That a patentee should be held strictly to the language of his Claim, see Delong *v.* Bickford (1882), 13 Fed. Rep. 32; 22 O. G. 2242.

That a patent is not to be enlarged by construction beyond what is explicitly described and claimed, see Keystone Bridge Co. *v.* Phœnix Iron Co. (1877), 95 U. S. 274; 12 O. G. 980.

[2] That while a patent is to be fairly construed, no new specification can be made by implication, see Sickels *v.* Gloucester Mfg. Co. (1856), 1 Fisher, 222.

That Claims must be construed by the language which is employed, not by what might have been employed, see Patent Clothing Co. *v.* Glover (1887), 40 O. G. 1135; 24 Blatch. 542.

[3] In Detmold *v.* Reeves (1851), 1 Fisher, 127, Kane, J.: (131) "If he has discovered much and discloses little; if there has been revealed to him one of the *arcana* of nature, and he communicates to the world only one or more of its derivatives and secondary truths, he patents no more than he has proclaimed. He will not be allowed afterward, when the extent of his right shall be the subject of controversy, either by expanding into a general expression what was limited before in a particular form, or by tracing out for us the line that leads back from consequences to remote causes, to initiate us, inferentially, into the radical mystery of his invention, and then argue that he had described it by implication from the first, and so claimed ownership of it in his patent."

That the court cannot consider that a Claim might have been broader if it is actually too narrow, see Becker *v.* Hastings (1884), 28 O. G. 98; 22 Fed. Rep. 827.

That if the patentee accepts a patent with narrow Claims they cannot be enlarged by construction, see Sutter *v.* Robinson (1886), 119 U. S. 530; 38

ing the patent, cannot depart from the letter of the instrument, either by excluding present terms or by interpolating others which do not appear. Its duty is discharged, and its authority exhausted, when it defines the character of the patented invention according to that significance of the words employed by the inventor in claiming and describing it which is most in harmony with its known essential attributes.

§ 738. Rule of Liberal Construction does not Authorize an Equivocal or Elastic Interpretation of the Claims.

Nor does the rule permit of such interpretations as render the inventor's Claims elastic or ambiguous.[1] The object of interpretation is to make the indefinite exact and the doubtful plain. An invention, whether it be an art or an instrument, has a concrete existence which is capable of precise definition and of clear description. It is only where the language of the patent fails to define with precision, or to describe with clearness, that any especial exercise of the interpretative power becomes necessary, and it must then be employed for the removal not the creation of ambiguities, and for the erection not the destruction of limitations to the in-

O. G. 230; Roemer *v.* Peddie (1886), 27 Fed. Rep. 702; 37 O. G. 338.

That a Claim cannot be enlarged by construction to cover what was intentionally omitted, see Bate Refrigerating Co. *v.* Eastman (1885), 24 Fed. Rep. 645; 32 O. G. 517.

That peculiarities of shape or arrangement will not be construed as distinctive features of the invention in order to save the Claim, unless the Description or Claim suggest it, see Bradley & Hubbard Mfg. Co. *v.* Charles Parker Co. (1885), 25 Fed. Rep. 907; 34 O. G. 249.

That details are not construed as essential features in order to save the Claim unless referred to in the Claim, especially where the Description merely recommends them, see Roemer *v.* Neumann (1885), 26 Fed. Rep. 102.

That a Claim is not to be construed to cover later inventions, see Root *v.* Lamb (1881), 19 O. G. 937; 7 Fed. Rep. 222.

That a patent will not be construed so liberally as to cover all that the patentee now thinks he might have covered, see Trader *v.* Messmore (1875), 7 O. G. 385; 1 Bann. & A. 639.

That if a patent does not cover all that the patentee intended to claim, he must amend it, the difficulty not being removable by construction, see Becker *v.* Hastings (1884), 22 Fed. Rep. 827; 28 O. G. 98.

§ 738. [1] That patents are not to be so liberally construed as to permit ambiguous or elastic Claims, see Parker *v.* Sears (1850), 1 Fisher, 93.

That intentionally loose and ambiguous Claims are not favored in the construction, see Taylor *v.* Garretson (1871), 5 Fisher, 116; 9 Blatch. 156.

ventor's Claim.[2] Every invention is a unit, distinct from every other invention, however similar in purpose or appearance, and except in cases where there is a joinder of inventions a patent covering one does not afford protection to the other. To construe a patent in such a manner that it may apply to either of these separate inventions at the pleasure of the inventor defeats the very object for which the power has been confided to the courts. While the patentee is entitled to the broadest definite interpretation which his language will legitimately bear, and is presumed to claim the invention to its full extent as so defined, the patent, when interpreted, must point out the invention whose protection it secures with a completeness and exactness which distinguish it from every other. Ambiguities and inaccuracies in essential portions of the patent, which cannot be removed by such interpretation, render the patent to that extent inoperative and void.

§ 739. Rule of Liberal Construction Permits an Interpretation in Accordance with the Real Nature of the Invention unless the Language of the Patent Clearly Forbids it.

Where the language of a patent is clear and capable of but one meaning, the duty of the court is fulfilled by interpreting its words and phrases in their proper sense, and defining the invention in accordance with this interpretation.[1] If,

[2] That a patent cannot be extended by construction to embrace any invention which it does not specifically claim, see Van Camp *v.* Maryland Pavement Co. (1888), 43 O. G. 884.

That Claims are not to be expanded by construction so as to cover more than the patentee first intended, see Couse *v.* Johnson (1879), 16 O. G. 719; 4 Bann. & A. 501.

That limited Claims are not to be expanded into general ones by implication or otherwise, see Detmold *v.* Reeves (1851), 1 Fisher, 127.

That the courts will not enlarge Claims by construction, see Burns *v.* Meyer (1879), 100 U. S. 671; Railway Co. *v.* Sayles (1878), 97 U. S. 554; 15 O. G. 243; Keystone Bridge Co. *v.* Phœnix Iron Co. (1877), 95 U. S. 274; 12 O. G. 980.

That a Claim for the special arrangement of parts must be construed to cover only the special parts and special arrangement, see Buzzell *v.* Andrews (1885), 25 Fed. Rep. 822; 34 O. G. 830.

§ 739. [1] That the specification and Claims ought to be construed to mean just what they seem to mean, see Anders *v.* Gilliland (1880), 19 O. G. 177.

That when Claims are clear and explicit they cannot be restricted or en-

as thus defined, the invention is not patentable either for want of novelty, utility, or inventive skill, or on account of previous dedication to the public, the inventor must abide the consequences, procuring an amendment of his patent when it does not correctly represent his actual invention, or relinquishing his claims entirely when what he has invented proves to be not entitled to protection. But when the language is not clear, or is capable of various constructions, recourse to extrinsic facts is often necessary to ascertain the sense in which in this particular case it must be understood.[2] The most important of these facts is the nature of the actual invention which the patent was intended to secure.[3] This

larged by reference to features not mentioned therein nor implied thereby, see Funck *v.* Doty (1878), 14 O. G. 157.

That the patentee is not limited to the literal import of his description, but may depart from it provided he does not change the principle nor make material alterations in its operation, see Grier *v.* Castle (1883), 17 Fed. Rep. 523; 24 O. G. 1176.

[2] That the construction of a patent depends on its words, or where these are ambiguous, on other circumstances, see Evans *v.* Eaton (1818), 3 Wheaton, 454; 1 Robb, 243.

[3] In Van Marter *v.* Miller (1879), 15 Blatch. 562, *Wallace, J.*: (563) "In construing a patent, it is first pertinent to ascertain what, in view of the prior state of the art, the inventor has actually accomplished; and this having been found, such a construction should be given as will secure the actual invention to the patentee, so far as this can be done consistently with giving due effect to the language of the specification and Claim." 4 Bann. & A. 124 (124).

In Page *v.* Ferry (1857), 1 Fisher 298, Wilkins, J.: (302) "The intention of the inventor, so as to effect the object designed, is to govern the construction of the language he employs. Inventors are not always educated or scientific men. Some most useful inventions have sprung from an illiterate source. Genius is not always blessed with the power of language. Courts look to the manifest design in order to remove any ambiguity arising from the terms employed. But this ambiguity must not be such as would perplex an ordinary mechanic in the art to which it applies."

In Winans *v.* Denmead (1853), 15 How. 330, Curtis, J.: (341) "Now, while it is undoubtedly true that the patentee may so restrict his Claim as to cover less than what he invented, or may limit it to one particular form of machine, excluding all other forms though they also embody his invention, yet such an interpretation should not be put upon his Claim if it can fairly be construed otherwise; and this for two reasons: (1) Because the reasonable presumption is that, having a just right to cover and protect his whole invention, he intended to do so, — Haworth *v.* Hardcastle, Web. P. C. 484; (2) Because specifications are to be construed liberally, in accordance with the design of the Constitution and the Patent Laws of the United States to promote the progress of the useful arts, and allow in-

being known the language of the patent must be construed to correspond with its essential attributes, unless such a construction would do violence to the terms employed. In that event a different interpretation must be given, although the eventual defeat of the patent may be thus ensured.

§ 740. Nature of the Invention Shown by State of Art at Date of Invention.

The nature of the invention attempted to be covered by the patent is sometimes evident upon its inspection or upon an examination of its practical operation. When this is not the case an investigation of the state of the art at the date of the invention may be instituted.[1] Every invention is a step

ventors to retain to their own use, not anything which is matter of common *right*, but what they themselves have created."

Further, that the patent is to be construed by the nature of the invention, see Steam Gauge and Lantern Co. *v.* Ham Mfg. Co. (1886), 28 Fed. Rep. 618; Hoff *v.* Iron Clad Mfg. Co. (1886), 35 O. G. 1230; Fitch *v.* Bragg (1881), 20 O. G. 1589; 8 Fed. Rep. 588; Washburn & Moen Mfg. Co. *v.* Haish (1881), 7 Fed. Rep. 906; 10 Bissell, 83; Robinson *v.* Sutter (1880), 10 Bissell, 100; 19 O. G. 127; 8 Fed. Rep. 828; Whitnum *v.* Seaman (1880), 5 Bann. & A. 95; 17 O. G. 626; 4 Fed. Rep. 436; Clark *v.* Kennedy Mfg. Co. (1877), 11 O. G. 67; 14 Blatch. 79; Morrill *v.* Yeomans (1877), 94 U. S. 568; 11 O. G. 970; Goodyear Dental Vulcanite Co. *v.* Davis (1877), 12 O. G. 1; 3 Bann. & A. 115; Bruff *v.* Ives (1877), 11 O. G. 924; 14 Blatch. 198; Mann *v.* Bayliss (1876), 10 O. G. 789; Bussey *v.* Wager (1875), 9 O. G. 800; Glue Co. *v.* Upton (1874), 4 Clifford, 237; 6 O. G. 837; 1 Bann. & A. 497; Barnes *v.* Straus (1872), 2 O. G. 62; 9 Blatch. 553; 5 Fisher, 531; McDougal *v.* Eames (1872), 2 O. G. 87; Taylor *v.* Garretson (1871), 5 Fisher, 116; 9 Blatch. 156; Coffin *v.* Ogden (1869), 7 Blatch. 61; 3 Fisher, 640; Woodman *v.* Stimpson (1866), 3 Fisher, 98.

That a patent will be so construed, if possible, as to protect the entire invention, see Henderson *v.* Cleveland Co-operative Stove Co. (1877), 2 Bann. & A. 604; 12 O. G. 4; Hamilton *v.* Ives (1873), 6 Fisher. 244; 3 O. G. 30.

That a specification should be construed with reference to the purpose of the invention, see Roberts *v.* Schreiber (1880), 2 Fed. Rep. 855; 18 O. G. 125; 5 Bann. & A. 491.

That a patentee is entitled to such a construction of his patent as will enable it to protect all forms of his invention, though he has described but one, unless he has restricted himself to certain forms in his Claims, see Grier *v.* Castle (1883), 24 O. G. 1176; 17 Fed. Rep. 523; Winans *v.* Denmead (1853), 15 How. 330.

That the construction given to the patent by the patentee will be sustained, if it is consistent with the language used, see Tondeur *v.* Stewart (1886), 28 Fed. Rep. 561; 37 O. G. 672; Bradley *v.* Dull (1884), 19 Fed. Rep. 913; 27 O. G. 625; Klein *v.* Russell (1873), 91 Wall. 433.

§ 740. [1] That patents are to be construed in view of the state of the art,

forward in the progress of the art to which it belongs, and the character of that step is often best determined by examining the condition of the art immediately before the step was taken and comparing it with the condition to which such step advanced the art. The difference between these must be the precise result of the inventor's act, and when it can be clearly ascertained it affords the safest guide to the exact scope of his invention. The state of the art at the date of the invention may be shown by previous patents, by the processes or instruments then known to the art, or by the testimony of persons acquainted with its general history and development.[2]

see Grier *v.* Wilt (1887), 120 U. S. 412; 38 O. G. 1365; Railway Register Mfg. Co. *v.* Broadway & Seventh Ave. R. R. Co. (1886), 26 Fed. Rep. 522; 34 O. G. 921; Reed *v.* Chase (1885), 25 Fed. Rep. 94; 33 O. G. 996; Buckingham *v.* Porter (1884), 10 Sawyer, 289; 36 O. G. 820; 26 Fed. Rep. 759; Jones *v.* Barker (1882), 22 O. G. 771; 11 Fed. Rep. 597; Sutro *v.* Moll (1881), 8 Fed. Rep. 909; 19 Blatch. 89; Root *v.* Lamb (1881), 7 Fed. Rep. 222; 19 O. G. 937; Washburn & Moen Mfg. Co. *v.* Haish (1880), 10 Bissell, 83; 7 Fed. Rep. 906; Webster Loom Co. *v.* Higgins (1879), 16 O. G. 675; 15 Blatch. 446; 4 Bann. & A. 83; Van Marter *v.* Miller (1879), 4 Bann. & A. 124; 15 Blatch. 562; Blaisdell *v.* Tuffts (1878), 15 O. G. 881; Bruff *v.* Ives (1877), 11 O. G. 924; 14 Blatch. 198; Clark *v.* Kennedy Mfg. Co. (1877), 14 Blatch. 79; 11 O. G. 67; Estabook *v.* Dunbar (1876), 10 O. G. 909; 2 Bann. & A. 427; Salamander Felting Co. *v.* Haven (1875), 9 O. G. 253; 2 Bann. & A. 164; 3 Dillon, 131; Burden *v.* Corning (1864), 2 Fisher, 477; Pitts *v.* Wemple (1855), 1 Bissell, 87; 2 Fisher, 10.

That a patent must be construed to claim only what the state of the art shows to be new, see Scott *v.* Evans (1882), 11 Fed. Rep. 726.

That where the scope of the art is limited the Claim must receive a narrow construction, see Adams *v.* Bellaire Stamping Co. (1886), 28 Fed. Rep. 360; 36 O. G. 567.

That the specification will be construed in view of the state of human knowledge and not as intending the impossible, see Tilghman *v.* Mitchell (1864), 2 Fisher, 518.

That a patent is construed by the state of the art at the date of the invention, and the description is limited to what thus appears to be new, see Neacy *v.* Allis (1882), 22 O. G. 1621; 13 Fed. Rep. 874; Jones *v.* Barker (1882), 11 Fed. Rep. 597; 22 O. G. 771; Giant Powder Co. *v.* California Vigorit Powder Co. (1880), 4 Fed. Rep. 720; 18 O. G. 1339; 6 Sawyer, 508.

That it is the state of the art at the date of the invention, not the application, which gives its meaning to the patent, see Sprague *v.* Adriance (1877), 14 O. G. 308; 3 Bann. & A. 124.

Contra, — That every patent is construed according to the state of the art at the date of the patent, see Salamander Felting Co. *v.* Haven (1875), 3 Dillon, 131; 9 O. G. 253; 2 Bann. & A. 164.

[2] That a specification will be construed by a history of the art and the

§ 741. Nature of the Invention Shown by Other Acts and Circumstances.

The character of the actual invention may also be evidenced by other statements of the inventor concerning its essential attributes. His allegations after the patent has been issued are of little weight, whether they tend to narrow or enlarge the scope of his invention.[1] But the position he assumed before the Patent Office while applying for a patent, the claims he then asserted, the concessions he there made, are all important indications as to the true nature of the idea of means which he embodied in his concrete invention and which he has endeavored to describe and claim in his patent.[2] Thus his correspondence with the Patent Office, the applications filed, the disclaimers offered, the objections raised and answered or avoided, are proper matters for examination by the court.[3] Besides these, any other

invention, see Giant Powder Co. *v.* California Vigorit Powder Co. (1880), 6 Sawyer, 508; 18 O. G. 1339; 4 Fed. Rep. 720.

That the description in a patent is to be construed in the light of prior patents, and its general terms are to be restricted by them, see Parsons *v.* Colgate (1882), 15 Fed. Rep. 600; 24 O. G. 203; 21 Blatch. 171.

That the patent will be construed in the light of the uncontradicted testimony as to prior devices, in order to ascertain its real scope, see Day *v.* Combination Rubber Co. (1880), 17 O. G. 1347; 2 Fed. Rep. 570; 5 Bann. & A. 385.

§ 741. [1] That the Claims may be construed in connection with the testimony of the patentee as to the actual invention, see Matthews *v.* Iron Clad Mfg. Co. (1888), 124 U. S. 347; 42 O. G. 827.

That a patent will not be narrowed from its evident meaning for the reason that the patentee and former owner says that his invention was not as broad as his specification, see Union Paper Bag Mach. Co. *v.* Pultz & Walkley Co. (1878), 15 Blatch. 160; 15 O. G. 423; 3 Bann. & A. 403.

[2] That the terms of the application and the proceedings in the Patent Office are to be considered in construing Claims, see Otis Bros. Mfg. Co. *v.* Crane Bros. Mfg. Co. (1886), 27 Fed. Rep. 550.

That a patentee cannot insist that his patent shall be construed to cover matter which he was compelled to abandon in the Patent Office in order to obtain a patent, and the records of the Office may be examined on this question, see Sutter *v.* Robinson (1886), 119 U. S. 530; 38 O. G. 230.

[3] That the meaning of a patent may be ascertained by examining the correspondence of the inventor with the Patent Office during the application, see Goodyear Dental Vulcanite Co. *v.* Davis (1880), 102 U. S. 222; 19 O. G. 543.

That a patent cannot be construed to cover articles which the Commissioner and the patentee agreed were outside it when the patent was issued, and this agreement may be shown by the corre-

facts may be considered which in the judgment of the court tend to disclose the object of the patent and thereby lead to a correct construction of its terms.[4]

§ 742. Second General Rule: Entire Patent Construed together as an Indivisible Instrument.

Subordinate to the fundamental rule that a patent must be liberally interpreted in order to accomplish, if possible, the purpose for which it was issued, is the rule that in ascertaining this purpose the entire patent must be construed together, and effect given to all its parts as members of a single indivisible instrument.[1] The vital force of a patent resides in

spondence between them, see Pike *v.* Potter (1859), 3 Fisher, 55.

That a patent is to be construed without reference to previous correspondence with the Office, or to rejected applications, see Piper *v.* Brown (1870), 4 Fisher, 175; Holmes, 20; Goodyear Dental Vulcanite Co. *v.* Gardiner (1870), 4 Fisher, 224; 3 Clifford, 408.

That a patent may be construed, if necessary, by the intention of the inventor in the use of words, and for ascertaining this the records of amendments in the specification, &c., in the Patent Office may be examined, see Trader *v.* Messmore (1875), 1 Bann. & A. 639; 7 O. G. 385.

That where an application, being rejected, is amended by adding new features and the patent is then allowed, it cannot be construed as covering the invention described in the rejected application, see Milligan *v.* Lalance & Grosjean Mfg. Co. (1884), 21 Fed. Rep. 570; 29 O. G. 367.

That where the patentee acquiesces in the limitation of his Claims by the Patent Office, the court cannot construe the patent to cover anything thus excluded, see Crawford *v.* Heysinger (1887), 123 U. S. 589; 42 O. G. 197; Phœnix Caster Co. *v.* Spiegel (1886), 26 Fed. Rep. 272; Otis Bros. Mfg. Co. *v.* Crane Bros. Mfg. Co. (1886), 27 Fed. Rep. 550.

That a patentee acquiescing in the rejection of broad Claims must be restricted to those allowed, though the rejection was improper, see Blades *v.* Rand, McNally, & Co. (1886), 27 Fed. Rep. 93; 37 O. G. 99.

That a patent in the hands of an assignee cannot be construed to cover matter excluded from the Claims by a wrongful rejection in the Patent Office, see Blades *v.* Rand, McNally, & Co. (1886), 27 Fed. Rep. 93; 37 O. G. 99.

[4] That no construction of a patent by acquiescence can arise in one year only, see Johnston Ruffler Co. *v.* Avery Mach. Co. (1886), 28 Fed. Rep. 193.

§ 742. [1] In Carver *v.* Braintree Mfg. Co. (1843), 2 Story, 432, Story, J.: (446) "There is no magic in words; and above all, in patents, the court looks through the whole patent and specification, in order to ascertain what the thing claimed and patented is; whether it is for an entirety or for various distinct improvements, capable of a distinct operation and independent use in the same machine, or for both, or whether it is for a combination of two or more things in a particular machine, to produce a given result, or for a simple or single improvement in a particular

its Claims. These measure the protection which the inventor seeks and the exclusive privilege which he obtains. Where they are clear, explicit, unmistakable, they need no aid, and are not aided, by reference to the other portions of the patent.[2] But when they are obscure or capable of different interpretations, the whole Description, drawings, model, oath, and title are to be considered as exponents of the Claims, and as determining the meaning and application of their words. No one of these descriptive portions of the patent can control the others.[3] The name given to the invention in the title or the

machine; or whether it is for any one or more of them. There is no artificial or universal rule of interpretation of such instrument beyond that which common-sense furnishes, which is to construe the instrument as a whole, and to extract from the descriptive words and the Claim what the invention is which is intended to be patented, and how far it is capable of exact ascertainment, and how far it is maintainable in point of law, supposing it clear from all ambiguity." 2 Robb, 141 (155).

See also American Wood-Paper Co. *v.* Heft (1867), 3 Fisher, 316; Morris *v.* Barrett (1859), 1 Bond, 254; 1 Fisher, 461; Day *v.* Cary (1859), 1 Fisher, 424; Pitts *v.* Wemple (1855), 2 Fisher, 10; 1 Bissell, 87; Pitts *v.* Whitman (1843), 2 Story, 609; 2 Robb, 189.

[2] That the specification and drawings are useful only to construe the Claim, see Pitts *v.* Wemple (1855), 1 Bissell, 87; 2 Fisher, 10.

That where a Claim is clear and explicit its language controls its meaning, without referring to the specification, see Rich *v.* Close (1870), 4 Fisher, 279; 8 Blatch. 41.

[3] In Francis *v.* Mellor (1871), 1 O. G. 48, McKennan, J.: (50) "Patents are to be construed liberally, so as to sustain and not destroy the right of the inventor. Hence the whole of the specification may and should be looked at, to learn from the description of the invention not only how to make it, but to ascertain what it really is. By the requirements of the statute the description must be in full, clear, and exact terms, and it is, therefore, an authorized guide to an accurate comprehension of what the patentee meant to claim as his invention. It is not only where the specification is expressly referred to that the Claim is to be construed in connection with it; but, as a general rule, the explanations contained in it are to be taken as the inventor's own interpreter of the meaning of his Claim, and of the essential qualities of the invention protected by his patent. Turrill *v.* R. R. Co., 1 Wall. 511; Curtis on Patents, Secs. 453 and 454." 5 Fisher, 153 (157); 8 Phila. 157 (158).

In Ransom *v.* Mayor of New York (1856), 1 Fisher, 252, Hall, J.: (260) "In order to determine what the plaintiffs claim as their invention, we are to look to the specification annexed to their patent, which specification is in the language of the alleged inventors themselves, is made by law a portion of the patent, and must be referred to for the purpose of determining what the patentees claimed as their invention, and what the Government have agreed to secure to them as their exclusive privilege. In determining the construction of these Claims (and their construction is a question of law exclusively for the court, and not for the determination of the

oath should be consistent with its character as set forth in the specification; the drawings and the model should in

jury, unless, indeed, there may be technical terms, or terms which need explanation by the evidence given before the jury), it is proper that the court should refer to the whole specification, and consider the whole of it in connection."

In Pettibone v. Derringer (1818), 4 Wash. 215, Washington, J.: (217) "But there can be no doubt that where the construction of the patent and specification, as to the subject of the grant, is doubtful, the affidavit, if more precise, may be resorted to to explain the ambiguity. It would seem to be particularly proper to do so for restraining general expressions in the specification; as the oath required to be taken by the act of Congress is, that the inventor does verily believe that he is the true inventor of the art, machine, or improvement for which he solicits a patent." 1 Robb, 152 (155).

Further, that the entire specification, with the drawings, model, oath, and title are to be considered as interpreting the Claims, see Matthews v. Iron Clad Mfg. Co. (1888), 124 U. S. 347; 42 O. G. 827; *Ex parte* Holt (1884), 29 O. G. 171; Bruce v. Marder (1882), 20 Blatch. 355; 22 O. G. 1039; 10 Fed. Rep. 750; Brainard v. Cramme (1882), 20 Blatch. 530; 22 O. G. 769; 12 Fed. Rep. 621; Holly v. Vergennes Mach. Co. (1880), 4 Fed. Rep. 74; 18 O. G. 1177; 18 Blatch. 327; Matthews v. Schoneberger (1880), 18 O. G. 1464; 4 Fed. Rep. 635; 18 Blatch. 357; Evans v. Kelly (1880), 9 Bissell, 251; 5 Bann. & A. 71; 23 O. G. 192; 13 Fed. Rep. 903; Robinson v. Sutter (1880), 10 Bissell, 100; 19 O. G. 127; 8 Fed. Rep. 828; Day v. Combination Rubber Co. (1880), 17 O. G. 1347; 5 Bann. & A. 385; 2 Fed. Rep. 570; National Car Brake Shoe Co. v. Lake Shore & Michigan Southern R. R. Co. (1880), 4 Fed. Rep. 219; 18 O. G. 1170; 9 Bissell, 503; Burke v. Partridge (1878), 58 N. H. 349; Bruff v. Ives (1877), 11 O. G. 924; 14 Blatch. 198; Fuller v. Yentzer (1876), 94 U. S. 288; 11 O. G. 551; Estabrook v. Dunbar (1876), 2 Bann. & A. 427; 10 O. G. 909; Metropolitan Wringing Mach. Co. v. Young (1876), 14 Blatch. 46; Westinghouse v. Gardner & Ranson Air Brake Co. (1875), 2 Bann. & A. 55; 9 O. G. 538; Wells v. Jacques (1874), 1 Bann. & A. 60; 5 O. G. 364; *Ex parte* Marsh (1872), 2 O. G. 197; Roberts v. Dickey (1872), 1 O. G. 4; 4 Fisher, 532; 4 Brews. (Pa.) 260; Carew v. Boston Elastic Fabric Co. (1871), 3 Clifford, 356; 5 Fisher, 90; 1 O. G. 91; Francis v. Mellor (1871), 5 Fisher, 153; 1 O. G. 48; 8 Phila. 157; Seymour v. Osborne (1870), 11 Wall. 516; Coffin v. Ogden (1869), 7 Blatch. 61; 3 Fisher, 640; Turrill v. Railroad Co. (1863), 1 Wall. 491; Hayden v. Suffolk Mfg. Co. (1862), 4 Fisher, 86; Whipple v. Middlesex Co. (1859), 4 Fisher, 41; Bell v. Daniels (1858), 1 Fisher, 372; 1 Bond, 212; Ransom v. Mayor of N. Y. (1856), 1 Fisher, 252; Kittle v. Merriam (1855), 2 Curtis, 475; Winans v. Denmead (1853), 15 How. 330; Corning v. Burden (1853), 15 How. 252; Hogg v. Emerson (1850), 11 How. 587; Hogg v. Emerson (1848), 6 How. 437; 2 Robb, 655; Davoll v. Brown (1845), 1 W. & M. 53; 2 Robb, 303; Ryan v. Goodwin (1839), 3 Sumner, 514; 1 Robb, 725.

That the Claims of a patent must be construed by the specification, and if the latter describes an entire article, the separable parts of the article are not regarded as inventions unless so claimed, see Evans v. Kelly (1880), 23 O. G. 192; 13 Fed. Rep. 903; 9 Bissell, 251; 5 Bann. & A. 71.

That an element limited to a peculiar

their respective modes disclose the precise features which are presented by the language of the Description; but variations between these are not to be regarded, provided their examination as a whole reveals the essential attributes of the invention claimed.[4] This rule applies equally to cases where the patent covers several inventions. As these must be mutually dependent and co-operative in order to be capable of joinder, the Claim for each may be, so far as necessary, elucidated and defined by the descriptions of the others.[5]

construction in one Claim will be limited in the same way in construing other Claims, see Railway Register Mfg. Co. *v.* Third Avenue R. R. Co. (1887), 42 O. G. 379.

That a doubtful specification may be aided by the drawing, see Tinker *v.* Wilbor Eureka Mower & Reaper Mfg. Co. (1880), 1 Fed. Rep. 138; 5 Bann. & A. 92; Banker *v.* Bostwick (1880), 18 O. G. 61; 3 Fed. Rep. 517; 5 Bann. & A. 463; Ingels *v.* Mast (1873), 6 Fisher, 415; Foss *v.* Herbert (1856), 1 Bissell, 121; 2 Fisher, 31; Hogg *v.* Emerson (1850), 11 How. 587; Burrall *v.* Jewett (1830), 2 Paige (N. Y.), 133.

That drawings are to be construed by the specifications, see Hamilton *v.* Ives (1873), 6 Fisher, 244; 3 O. G. 30.

That drawings cannot be so used as to change the character of the invention described in the specification, see Hailes *v.* Albany Stove Co. (1887), 123 U. S. 582; 42 O. G. 95.

That the drawing may show that the machine claimed under the patent is not the one for which it issued, see Burrall *v.* Jewett (1830), 2 Paige (N.Y.), 133.

That the drawings may be interpreted by the model, see Aiken *v.* Dolan (1867), 3 Fisher, 197.

That Claims will be construed by the drawings and model, see Hancock Inspirator Co. *v.* Jenks (1884), 21 Fed. Rep. 911.

That a clause in the application immediately connected with the Claim, and evidently stating what the inventor intended to secure, will be construed as part of the Claim, see La Rue *v.* Western Electric Co. (1886), 28 Fed. Rep. 85; 36 O. G. 453; 24 Blatch. 18.

[4] That the names and terms used by the patentee are to be construed in view of the entire specification and drawings, see Foye *v.* Nichols (1882), 8 Sawyer, 201; 13 Fed. Rep. 125; 22 O. G. 2243.

That the title of the invention should agree with the specification, see Goodyear *v.* Railroad (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

That the title of the invention in the patent does not control, but is to be taken in connection with the specification and drawings, and a liberal construction given to all, see Bell *v.* Daniels (1858), 1 Bond, 212; 1 Fisher, 372; Sickels *v.* Gloucester Mfg. Co. (1856), 1 Fisher, 222.

[5] That a construction making two Claims cover the same thing will be avoided if possible, see Tondeur *v.* Stewart (1886), 28 Fed. Rep. 561; 37 O. G. 672.

That one Claim cannot be so construed as to render another Claim of the same patent meaningless, see Cohansey Glass Mfg. Co. *v.* Wharton (1886), 28 Fed. Rep. 189; 36 O. G. 343.

§ 743. Second General Rule Authorizes the Restriction of the Claims by the Other Portions of the Patent, but not their Enlargement.

In thus construing the Claims of a patent by its descriptive portions, the scope of the Claims may often be restricted, but can never be enlarged.[1] The Claims are based on the description, the invention secured to the patentee being always identical with or contained in that communicated to the public; and therefore the interpretation given to the Claims must limit them to the invention previously described, however wide and comprehensive they might otherwise appear.[2] To meet extended Claims the rule of liberal construction requires all other members of the patent to be interpreted as broadly as the legitimate use of language, drawings, or models will permit, but when the Claims exceed such an interpretation of the descriptive matter they must be restricted by it or must wholly fail.[3] The converse of this proposition, however, is

§ 743. [1] That the Claim may be illustrated, not enlarged, by the other parts of the specification, see Yale Lock Co. *v.* Greenleaf (1886), 117 U. S. 554; 35 O. G. 386.

[2] That a general Claim will be limited to the invention described in the specification, see *Ex parte* Hahn (1875), 8 O. G. 597; U. S. Steam Gauge Co. *v.* American Steam Gauge Co. (1874), 5 O. G. 208; Holmes, 309; Cammeyer *v.* Newton (1874), 5 O. G. 753; 12 Blatch. 122; 1 Bann. & A. 294; Mitchell *v.* Tilghman (1873), 19 Wall. 287; 5 O. G. 299; Forsyth *v.* Clapp (1873), 4 O. G. 527; Holmes, 278; 6 Fisher, 528; Smith *v.* O'Connor (1873), 4 O. G. 633; 2 Sawyer, 461; 6 Fisher, 469; Roberts *v.* Dickey (1872), 4 Fisher, 532; 1 O. G. 4; 4 Brews. (Pa.) 260.

That general words in a Claim are limited by particular words in the specification, see Knox *v.* Murtha (1871), 9 Blatch. 205; 5 Fisher, 174.

That a Claim cannot receive a construction broader than the invention as shown in the specification, see Anders *v.* Gilliland (1880), 19 O. G. 177.

That general words in a Description or Claim are to be limited by the real nature of the invention, see Fischer *v.* Hayes (1881), 6 Fed. Rep. 76; 20 O. G. 239; 19 Blatch. 26.

That Claims are not limited by drawings when the specification shows that the real invention was broader, see Hamilton *v.* Ives (1873), 6 Fisher, 244; 3 O. G. 30.

[3] That a general description at the beginning of the specification will be construed by the subsequent specific directions for making the invention, and the description of its peculiar properties, see Holt *v.* Kendall (1885), 26 Fed. Rep. 622; 35 O. G. 874.

That a Claim is to be construed by the specification, and if the specification describes only the entire article the Claims do not cover each separate part of it, see Evans *v.* Kelly (1880), 13 Fed. Rep. 903; 9 Bissell, 251; 5 Bann. & A. 71; 23 O. G. 192.

That the Claims of a patent cannot be enlarged by the correspondence of the inventor with the Patent Office, nor by the proceedings pending the appli-

not true. Although the Claims must follow the description, it is not necessary that they cover all the patentable matter there described. The inventor may abandon portions of it to the public, or reserve them for the protection of a future patent. Whatever of such matter the legitimate meaning of his Claims, in their widest sense, embraces, they must be construed to hold, but beyond this meaning they cannot be enlarged by general terms in the description, or by its statement of other and distinct inventions.

§ 744. Third General Rule: Words and Phrases Interpreted, if possible, in their Ordinary Sense.

Subject to the preceding rules are those which govern the signification of the individual words and phrases employed by the inventor in his Description and Claims of the invention, and by the Patent Office in framing the letters-patent. Unless the contrary appears, a word has its ordinary meaning.[1] If commonly applied in different senses, it may be used in one part of the patent to denote a certain object, and in another to denote a different object,—its sense in each connection being determined by the object to which it relates.[2] If it has varied in its meaning since the date of the invention, it must be taken as including only the acts or things to which it then re-

cation, see Goodyear Dental Vulcanite Co. *v.* Gardiner (1871), 3 Clifford, 408; 4 Fisher, 224.

That clear and distinct Claims will govern where the specification is ambiguous, see McKesson *v.* Carnrick (1881), 9 Fed. Rep. 44; 21 O. G. 137; 19 Blatch. 158.

That a process cannot be inferred by the court from a description of its product, see Western Electric Co. *v.* Ansonia Co. (1885), 114 U. S. 447; 31 O. G. 1305.

§ 744. [1] That words used in a specification have their usual meaning unless the contrary appears, see Root *v.* Lamb (1881), 7 Fed. Rep. 222; 19 O. G. 937; Day *v.* Cary (1859), 1 Fisher, 424; Goodyear *v.* Cary (1859), 4 Blatch. 271.

That terms known in the art are construed as there used, see Day *v.* Stellman (1859), 1 Fisher, 487.

That under Sec. 4888, Rev. Stat., the specification must point out the exact invention, and the patent must be taken as it reads, in the light of common knowledge, until the contrary appears, see McCloskey *v.* Dubois (1881), 19 O. G. 1286; 20 O. G. 371; 8 Fed. Rep. 710; 19 Blatch. 205.

That where a specification misuses words, their ordinary meaning will still have weight, see Root *v.* Lamb (1881), 19 O. G. 937; 7 Fed. Rep. 222.

[2] That the meaning of words in a specification is dependent on the context, and the same words may mean different things in different connections, see Drummond *v.* Greenough (1879), 16 O. G. 959.

ferred and not those which it has more recently embraced.[3] Words also are interpreted according to the intent of the inventor, as indicated by their use in the specification, or in the art to which the invention appertains, or in his correspondence with the Patent Office.[4] Ambiguous words, if capable of no intelligible construction and the object of the patent can be made clearly known without them, may be rejected as surplusage.[5] General words may be limited in meaning, and special words extended, as the interpretation of the entire instrument requires. The arrangement of words in a sentence is of little moment, if its purport can be accurately discovered.[6]

§ 745. Practical Application of the Foregoing Rules.

In construing a patent in accordance with these rules the first object of attention is the Claim. If this requires no explanation, the court expounds it by the ordinary meaning of its words and defines the invention which it covers.[1] If

[3] That the language of a patent will be construed by its meaning at the date of the patent, not by that subsequently acquired, see McDougal *v.* Eames (1872), 2 O. G. 87.

That names are interpreted by evidence of their meaning at the time when they were used, not afterward, see Florence Sewing Mach. Co. *v.* Grover & Baker Sewing Mach. Co. (1872), 110 Mass. 70.

[4] That the language of a specification is to be interpreted according to the evident intention of the inventor, see Union Paper Bag Co. *v.* Nixon (1873), 6 Fisher, 402 ; 4 O. G. 31.

That general terms and special words are construed to cover the real invention if it can be done without violence to the language of the Claim, see Fitch *v.* Bragg (1881), 20 O. G. 1589 ; 8 Fed. Rep. 588 ; Estabrook *v.* Dunbar (1876), 10 O. G. 909 ; 2 Bann. & A. 427.

[5] That ambiguous words will be construed to suit the real nature of the invention, see White *v.* Allen (1863), 2 Clifford, 224 ; 2 Fisher, 440.

That ambiguous words in the specification will be controlled by the Claim or treated as superfluous, see McKesson *v.* Carnrick (1881), 9 Fed. Rep. 44 ; 19 Blatch. 158 ; 21 O. G. 137.

That phrases in a specification have no fixed meaning, but are to be interpreted by the courts, see Union Paper Bag Co. *v.* Nixon (1873), 6 Fisher, 402 ; 4 O. G. 31.

[6] That the specification is construed rather by the true import of the words used than by any arrangement of words, see Allen *v.* Hunter (1855), 6 McLean, 303.

§ 745. [1] In Rich *v.* Close (1870), 4 Fisher, 279, Woodruff, J. : (283) "It is quite true that in the construction of a Claim reference is to be had to the descriptive portion of the specification, or to any other portion of it, to ascertain the true interpretation of the Claim. But where the Claim is such as to leave no room for construction, where it is clear and explicit, and especially where there is nothing in the specification which shows that the patentee did not

explanation is required, the entire field of inquiry is open. The nature of the actual invention is sought in the history of the art, in the formal statements of the inventor before his patent issued, and in other facts which indicate its character. To this invention the entire description of the patent is applied, and whatever has been properly described and might, therefore, lawfully be claimed, is taken as the true interpretation of the Claim so far as the legitimate use of language will allow.[2] By this method of construction the rights of the inventor are secured to the fullest extent which is compatible with the preservation of the public right. Whenever he fails of complete protection it is through his own faults of statement, which he may correct by a re-issue.

SECTION II.

OF THE CONSTRUCTION OF LETTERS-PATENT: SPECIAL RULES.

§ 746. Special Rules: Pioneer Patents; Re-issued Patents; Patents Granted by Act of Congress.

In addition to the foregoing general rules, certain special rules of construction have arisen from the application of these

mean just what the plain language of Claim, which is the summing up, at the close of the patent, or specification preceding, the Claim being in the terms: 'What I claim to have invented, and wish to secure by letters-patent, is ——,' and then a condensed statement of what he wishes to have secured to him by his patent. But in construing that we take into view the whole of what precedes it in the specification, and also such extraneous facts presented by the evidence as may aid in giving the true construction to the patent, particularly the documents from the Patent Office which have preceded the granting of the patent itself." See also Woodman *v.* Stimpson (1866), 3 Fisher, 98; Whipple *v.* Baldwin Mfg. Co. (1858), 4 Fisher, 29; and § 739 and notes, *ante*.

the Claim imports, we are not aided by and have no need of aid from such specification." 8 Blatch. 41 (44).

That a Claim must be construed by its terms when they are clear, and cannot be enlarged by the context, see White *v.* Dunbar (1886), 119 U. S. 47; 37 O. G. 1002.

That where the import of a Claim is clear it cannot be enlarged by the Description, see Railway Register Mfg. Co. *v.* Third Avenue R. R. Co. (1887), 42 O. G. 379.

[2] In Johnson *v.* Root (1858), 1 Fisher, 351, Sprague, J.: (355) "In determining what it is that the plaintiff has secured to him by his patent from the Government, the court looks, in the first place, at what is called, technically, the

general rules to particular cases. A pioneer patent, introducing to the public some art or instrument entirely new, must be interpreted as liberally as its language will permit in order to protect the original conception in its widest form, notwithstanding any Description or Claim for specific details which the patent may contain.[1] A re-issued patent, if ambiguous and uncertain in itself, may be aided by referring to the specifications, drawings, and model of the original.[2] A patent granted by special act of Congress, upon representations made by the inventor as to the real nature of his invention, must be limited to the invention as thus represented, whatever else the terms of the patent might otherwise include.[3]

§ 746. [1] That the Claims of a pioneer patent are to be construed broadly, see Kirk *v.* DuBois (1887), 42 O. G. 297; Hammerschlag Mfg. Co. *v.* Bancroft (1887), 40 O. G. 1339; 32 Fed. Rep. 585; May *v.* County of Fond du Lac (1886), 27 Fed. Rep. 691; Thayer *v.* Spaulding (1886), 27 Fed. Rep. 66; 36 O. G. 1044; Worswick Mfg. Co. *v.* City of Buffalo (1884), 22 Blatch. 157; 27 O. G. 1239; 20 Fed. Rep. 126; Pickhardt *v.* Packard, (1884), 23 Blatch. 23; 30 O. G. 179; 22 Fed. Rep. 530.

That a pioneer patent is not to be limited to specific details if it is fairly open to a liberal construction, see Hammerschlag *v.* Scamoni (1881), 7 Fed. Rep. 584; 20 O. G. 75.

That when a new art is discovered and patented the Claims of the patent are broadly construed so as to cover all means of practising it, see Standard Measuring Machine Co. *v.* Teagle (1883), 15 Fed. Rep. 390; Kimball *v.* Hess (1883), 15 Fed. Rep. 393; 26 O. G. 107.

That on a question of joinder the rule of construction is most liberal, see *Ex parte* Herr (1887), 41 O. G. 463.

[2] That the Claims of a re-issue, if obscure, may be interpreted by the original specifications and drawings, see Bussey *v.* Wager (1875), 9 O. G. 300.

That an original patent can be referred to in order to construe the re-issue, see Reedy *v.* Scott (1874), 23 Wall. 352; 7 O. G. 463.

That in construing a re-issued patent the new matter claimed may be referred to as interpreting the good Claims, but only so far as it could properly have appeared in the original specification, see Schillinger *v.* Cranford (1885), 4 Mackey, 450; 37 O. G. 1349.

[3] That a patent granted by special act of Congress will be limited by representations made by the patentee to Congress in order to obtain the patent, see Union Mfg. Co. *v.* Lounsbury (1863), 2 Fisher, 389.

That a patent, having been irregularly granted and afterwards confirmed by special act of Congress, is to be governed and construed by the law in force when it was originally granted, see New American File Co. *v.* Nicholson File Co. (1881), 20 O. G. 524; 8 Fed. Rep. 816.

§ 747. Special Rules: Claims for Combinations: Improvements: Joint Inventions.

A Claim for a combination is to be construed liberally in order to support the combination, although another Claim is made for a special arrangement of the same elements.[1] Where a combination apparently claimed is shown to be old, the Claim may be interpreted to cover the particular elements employed, if the language of the Claim is capable of that construction.[2] The use of the word "combination" in some Claims, and not in others, indicates an intention to exclude the combination from the latter.[3] A patent for an improvement will be read in the light of the original invention and its own relations thereto.[4] A patent for a joint invention,

§ 747. [1] That a Claim for a combination will be construed broadly, though another Claim is made for a special arrangement of the same elements, see *Ex parte* Marsh (1872), 2 O. G. 197.

That in patents for combinations the limitations imposed by the inventor, especially after the rejection of a Claim, must be strictly construed in favor of the public as disclaimers, see Sargent *v.* Hall Safe & Lock Co. (1885), 114 U. S. 63; 31 O. G. 661.

That a patent for a combination cannot be construed to cover an element expressly disclaimed, see Shaver *v.* Skinner Mfg. Co. (1887), 41 O. G. 232.

That the courts cannot by construction eliminate a claimed element of a combination simply because it is practically useless, see Williams *v.* Stolzenbach (1885), 23 Fed. Rep. 39; 30 O. G. 891.

That all claimed elements are to be regarded as material in construing the patent, see Sargent *v.* Hall Safe & Lock Co. (1885), 114 U. S. 63; 31 O. G. 661; and §§ 156, 278, 282, 527, and notes, *ante*.

That a Claim for a combination includes everything which is either expressed or necessarily implied to be material, see Thompson *v.* Gildersleeve (1888), 43 O. G. 886.

That a Claim for an arrangement of all the parts constituting the article is construed as a Claim for the article itself, see Donoughe *v.* Hubbard (1886), 27 Fed. Rep. 742; 35 O. G. 1561.

That a Claim for a process consisting of several steps may be limited by the state of the art and the Description of the patent to the instrumentalities described, or their equivalents, which are essential to the performance of the process, see Lawther *v.* Hamilton (1888), 42 O. G. 487.

That a Claim for a combination may be construed as a Claim for a manufacture, see Duff *v.* Calkins (1883), 25 O. G. 601.

That a Claim for a combination covers all its effects though they are not named, see Thompson *v.* American Bank Note Co. (1888), 45 O. G. 347.

[2] That a Claim for a combination shown to be old may be construed as a Claim for the particular devices employed, see Clough *v.* The Gilbert & Barker Mfg. Co. (1878), 15 O. G. 1009.

[3] That the use of the word "combination" in some Claims but not in others excludes the idea of it from the latter, see Burden *v.* Corning (1864), 2 Fisher, 477.

[4] That a Claim for an improvement is

which is subsidiary to a prior sole invention, cannot be so construed as to embrace the sole invention.[5]

§ 748. Special Rules: Claims for Principles, Functions, or Effects.

A Claim for the principle or force employed in an invention will be interpreted, if possible, as a Claim for the instrument or operation by which the force is applied to its appropriate object.[1] A Claim for a function, where the specification describes the device or apparatus which performs it, will be construed as intended to cover such apparatus or device.[2] A Claim for a result or effect will be considered as a Claim for the means by which the effect is produced, if the specification, as a whole, is open to that interpretation.[3]

§ 749. Special Rules: Claims for an Entirety not Divisible: Claims for Separate Devices not Consolidated.

A Claim for an entire instrument or process, consisting of several steps or divisible parts, cannot usually be divided by construction in such a manner as to cover these independent members.[1] If the interpretation given to the invention by the specification, however, indicates that these steps or parts

to be construed in view of the original and its relations to it, see Brown *v.* Selby (1871), 2 Bissell, 457; 4 Fisher, 363.

That the court can determine whether two designs are the same by comparing them, see Jennings *v.* Kibbe (1882), 10 Fed. Rep. 669; 22 O. G. 331; 20 Blatch. 353; and §§ 201–207, 306, and notes, *ante*.

[5] That a joint invention, subsidiary to a prior invention of one of the joint inventors, cannot be so construed as to include it, see Hopkins & Dickinson Mfg. Co. *v.* Corbin (1878), 14 Blatch. 396; 14 O. G. 3.

§ 748. [1] That a Claim will not be construed to cover a principle if it can be so interpreted as to apply to a device, see Union Paper Bag Co. *v.* Nixon (1873), 4 O. G. 31; 6 Fisher, 402; and §§ 508, 509 and notes, *ante*.

[2] That functional Claims will be construed, if possible, as Claims for what performs the function, see Albany Steam Trap Co. *v.* Felthousen (1884), 22 Blatch. 169; 20 Fed. Rep. 633; Mfg. Co. *v.* Ladd (1877), 11 O. G. 153; 2 Bann. & A. 488; *Ex parte* Shippen (1875), 8 O. G. 727; and § 518 and notes, *ante*.

[3] That a Claim for a result will be construed, if possible, to be a Claim for a means of effecting a result, see Palmer *v.* Gatling Gun Co. (1881), 8 Fed. Rep. 513; 19 Blatch. 392; 20 O. G. 815; Henderson *v.* Cleveland Co-operative Stove Co. (1877), 2 Bann. & A. 604; 12 O. G. 4; and § 519 and notes, *ante*.

§ 749. [1] That a Claim for a whole cannot be divided by construction so as to cover the parts, see Evans *v.* Kelly (1880), 9 Bissell, 251; 13 Fed. Rep. 903; 23 O. G. 192; 5 Bann. & A. 71.

are the true means conceived by the inventor, the Claim may be extended to embrace them.[3] Two apparently separate Claims cannot be construed together as one Claim and be thus supported by each other.[3]

§ 750. Special Rules: Foreign Words: "Substantially as Described:" "Generic," etc.

Foreign words occurring in a patent are to be interpreted by the context and the real object of the inventor, and to receive such meaning as will effect his intention.[1] The phrase "substantially as described," in the Claim, signifies much or little, as the patentee evidently designed.[2] This phrase is always supposed to be incorporated in the Claim, whether or not it is actually inserted.[3] In any case it relates only to the material features of the invention, as shown by its purpose and by the elements which compose it and

[2] That effect is to be given to the whole description in the specification and drawings, and if it can be seen that the patentee intended to claim the parts separately, the patent must be so construed, see National Car Brake Shoe Co. *v.* Lake Shore & Michigan Southern R. R. Co. (1880), 9 Bissell, 503; 18 O. G. 1179; 4 Fed. Rep. 219.

[3] That two apparently separate Claims cannot be construed as one, and be supported by each other, see Seymour *v.* McCormick (1856) 19 How. 96.

That two patents cannot be construed to supplement each other, see Blades *v.* Rand, McNally, & Co. (1886), 27 Fed. Rep. 93; 37 O. G. 99.

That a Claim covering a class, where the invention is only one of the class, is confined to the invention, see Opinion Atty. Gen. (1856), 8 Op. Atty. Gen. 269.

§ 750. [1] That foreign words will be interpreted by the context, and the real nature of the invention, see White *v.* Allen (1863), 2 Fisher, 440; 2 Clifford, 224.

[2] That the phrase "substantially as described" means much or little, as the intention of the patentee requires, see Seymour *v.* Osborne (1869), 3 Fisher, 555.

[3] That the words "substantially as described" are always understood in the Claim, and refer to the specification, see Matthews *v.* Schoneberger (1880), 4 Fed. Rep. 635; 18 O. G. 1464; 18 Blatch. 357; Westinghouse *v.* Gardner & Ranson Air Brake Co. (1875), 2 Bann. & A. 55; 9 O. G. 538; Mitchell *v.* Tilghman (1873), 19 Wall. 287; 5 O. G. 299; and § 517 and notes, *ante*.

That Claims referring to the specification must be construed by it, see Gottfried *v.* Phillip Best Brewing Co. (1879), 5 Bann. & A. 4; 17 O. G. 675; Sickels *v.* Evans (1863), 2 Fisher, 417; 2 Clifford, 203.

That the Claim may be construed by the specification so as to be good, though on its face it covers only a function or a result, if it refers to the specification by the words "substantially as described," see Seymour *v.* Osborne (1870), 11 Wall. 516; Seymour *v.* Osborne (1869), 3 Fisher, 555.

enable it to accomplish its results.[4] The similar phrase "as herein described" likewise refers to the specification for a fuller and more exact statement of the subject-matter of the Claim.[5] The word "specification" is sometimes employed to denote both the Claim and the Description, and sometimes only the Description. In statutes and elsewhere, when it is used alone, it has the former meaning; when the word "Claim" is also used, it has the latter.[6] The term "generic" varies in its application. It is a relative term, the same invention being generic as to some inventions and specific as to others.[7] It is to be interpreted according to the nature of the operation or instrument to which it is applied, and the position of such instrument or operation in the art to which it belongs. The word "manufacture" may denote the article made, or the means by which it is produced.[8]

[4] In Waterbury Brass Co. *v.* Miller (1871), 9 Blatch. 77, Woodruff, J.: (97) "They relate only to material features of the combination specified, and these are to be ascertained by considering the object or purpose of the machine, and what are the elements of the combination which create its distinctive character, and are effective in producing the peculiar result for which the contrivance is made." 5 Fisher, 48 (68).

That in the Claim the words "in the manner and for the purposes herein specified" should not be construed to cover every part shown in the drawings and Description, nor to confine the invention to the precise form therein shown, see Reed *v.* Chase (1885), 25 Fed. Rep. 94; 33 O. G. 996.

[5] That the words "as herein described" or "set forth" refer to the specification, and may embrace elements not mentioned in the Claim, see Vance *v.* Campbell (1859), 1 Fisher, 483.

That the words in the Claim "all as shown and described" limits the Claim to the exact thing shown, see Osceola Mfg. Co. *v.* Pie (1886), 28 Fed. Rep. 83.

[6] In Wilson *v.* Coon (1880), 18 Blatch. 532, Blatchford, J.: (535) "The word 'specification,' when used separately from the word 'claim,' in § 4916, means the entire paper referred to in § 4888, namely, the written description of the invention, 'and of the manner and process of making, constructing, compounding, and using it,' and the Claims made. The word 'specification,' meaning Description and Claims, is used in that sense in §§ 4884, 4895, 4902, 4903, 4917, 4920, and 4922. In some cases, as in §§ 4888 and 4916, the words 'specification and claim' are used, and in § 4302 the word 'description' and the word 'specification' are used. But it is clear that the word 'specification,' when used without the word 'claim,' means Description and Claim." 19 O. G. 482 (482); 6 Fed. Rep. 611 (615). See also §§ 655-657 and notes, *ante*.

[7] That the term "generic" is relative, the same invention being "generic," as to some, and "specific" as to others, see *Ex parte* Ewart (1880), 17 O. G. 448; and §§ 535, 536, and notes, *ante*.

[8] That the word "manufacture" may

§ 751. Special Rules: Terms Admitting of Degrees: Other Terms.

Terms admitting of degrees — such as "tight," "hard," "hot," and the like — refer to that degree which is best suited to the purposes of the invention as indicated by its practical use.[1] The phrase "in any other convenient manner" includes every method which the invention can perform.[2] "Suitable materials" embrace all known materials proper for the purpose.[3] The "making" or "selling" of a substance is essentially distinct from its "use," and a patent for the latter does not confer upon the patentee any exclusive right to the former.[4] Other special words are interpreted in view of the practical character of the invention and as they would ordinarily be employed by persons skilled in the art.[5]

mean the article made, or the work of making it, see Shaw *v.* Colwell Lead Co. (1882), 20 Blatch. 417; 11 Fed. Rep. 711.

§ 751. [1] That terms admitting of degrees of meaning, such as "tight," "hard," etc., mean such degree as is suited to the purposes of the invention, see Robinson *v.* Sutter (1881), 8 Fed. Rep. 828; 19 O. G. 127; 10 Bissell, 100.

The words "to be hardened," in a Description, mean to be made as hard as possible, see Moncc *v.* Adams (1874), 7 O. G. 177; 1 Bann. & A. 126; 12 Blatch. 1.

[2] That in the specification the phrase "or in any other convenient manner," is construed to cover such manner as the device can perform, see Illinois Central R. R. Co. *v.* Turrill (1876), 94 U. S. 695; 12 O. G. 709.

[3] That the phrase "suitable materials" means "known materials," see Bailey Washing & Wringing Mach. Co. *v.* Lincoln (1871), 4 Fisher, 379.

[4] That a patent for the "use" of a thing does not cover the making and selling of it, see Keystone Bridge Co. *v.* Phœnix Iron Co. (1872), 5 Fisher, 468; 1 O. G. 471.

[5] That "jointly" in a Claim may mean "by united action," not necessarily "simultaneously;" see Gold & Stock Telegraph Co. *v.* Commercial Telegram Co. (1885), 23 Blatch. 199; 23 Fed. Rep. 340; 31 O. G. 1558.

That "perfect" means perfect according to the standard required in the art, see Adams *v.* Bridgewater Iron Co. (1886), 26 Fed. Rep. 324; 34 O. G. 1045.

That "free from defect" means sufficiently free for practical purposes, see Adams *v.* Bridgewater Iron Co. (1886), 26 Fed. Rep. 324; 34 O. G. 1045.

That "concavo-convex" means such a degree of each as mechanical judgment may show to be needed, see Temple Pump Co. *v.* Goss Pump & Rubber Bucket Mfg. Co. (1887), 39 O. G. 467; 30 Fed. Rep. 446.

That the words "or other part" mean "or other equivalent part," and do not render the Claim uncertain, see Babcock & Wilcox Co. *v.* Pioneer Iron Works (1888), 43 O. G. 756.

CHAPTER V.

OF THE TRANSFER OF LETTERS-PATENT.

§ 752. Patented Inventions are Property, and as Such Transferable.

A PATENTED invention, being capable of exclusive possession and dominion, is property, and occupies the same legal position and is governed by the same legal rules as any other object of human ownership. The patentee has the same rights in it, and the same authority over it, that are vested in him as to any class of property.[1] His title to it rests on the same ultimate basis of prior occupancy, receives the same sanction and vindication through the provisions of positive law, and is held and enjoyed upon the same general conditions of subservience to the rights of others and to the public good. And as, like most species of property, its value to its owner resides principally in his power to dispose of it for different property, its transfer by the patentee to other persons is restricted only by the nature of the property itself.[2] Of what forms of transfer a patented invention is capable is thus an inquiry preliminary to any discussion of the modes by which it may be practically conveyed.

§ 753. Property in a Patented Invention Twofold: the Invention, and the Monopoly.

The property in a patented invention is composed of two different elements, distinct in their origin, in their nature,

§ 752. [1] That an invention belongs to the inventor as fully as any other property, *see* Sloat *v.* Patton (1852), 1 Fisher, 154; and § 61 and notes, *ante*.

[2] That every patent and every interest in a patent is transferable, see Howe *v.* Chatham (1885), 64 Tex. 36; Campbell *v.* James (1880), 2 Fed. Rep. 338; 18 Blatch. 92; 18 O. G. 1111; Parker *v.* Haworth (1848), 4 *McLean*, 370; 2 Robb, 725.

That each Claim is separately transferable, see Pope Mfg. Co. *v.* Gormully & Jeffrey Mfg. Co. (1888), 34 Fed. Rep. 893.

and in the subordinate rights into which they may be divided. The first of these elements is the property in the invention itself. This element originates in the inventive act by which the invention was produced, consists of the right to practise the invention, and is divisible into the subordinate rights to make, use, and sell the art or instrument invented. The second element is the property in the patent privilege by which the invention is protected. This element originates in a grant of the sovereign power acting under the enactments of positive law, consists in the right to prevent all persons except the patentee from practising the invention, and is divisible into the subordinate rights to prohibit the making, use, or sale of the invention except upon such terms or by such persons as the patentee may deem expedient, and to obtain redress for its forbidden making, use, or sale. The first of these two elements is wholly independent of the second. It exists equally whether the invention is patented or not, and it may be transferred by the inventor either as a whole or as to any one or more of its subordinate rights. Nor does this element draw after it the second. While the invention remains a secret with the inventor or his transferees, their enjoyment of its benefits may be exclusive, but if it becomes known to others, their ownership of the invention confers upon them no power to prevent its general use. The necessity for the second element then first arises, and this being obtained bestows authority on the inventor to restrict the practice of the invention within such limits as he pleases, and to recover compensation from all persons who infringe on his exclusive rights. This second element is thus a mere prohibitory power.[1] While it confers a monopoly on

§ 753. [1] *In re* Brosnahan (1883), 4 McCrary, 1, Miller, J. : (5) "It is to be observed that no constitutional or statutory provision of the United States was, or ever has been, necessary to the right of any person to make an invention, discovery, or machine, or to use it when made, or to sell it to some one else. Such right has always existed and would exist now if all patent laws were repealed. It is a right which may be called a natural right, and which, so far as it may be regulated by law, belongs to ordinary municipal legislation ; and it is unaffected by anything in the Constitution or Patent Laws of the United States. The sole object and purpose of the laws which constitute the patent and copyright system is to give to the author and the inventor a monopoly of what he has written or discovered, — that no one else shall make

the inventor, it neither creates the invention nor any of the rights which accrue from the inventive act. On the contrary, it presupposes their existence, and if they do not exist the grant of the monopoly is void. Both its own nature and the purposes for which it is bestowed, however, render it so far dependent on the former element that it cannot subsist except in the inventor or in those to whom he has conveyed some interest in the invention; though any interest in the invention less than the exclusive right to make and use and sell may be transferred by the inventor without bestowing any part of his monopoly. Hence in every patented invention there are two objects capable of alienation, — the invention or the right to make, use, and sell the patented art or instrument, and the monopoly or the right to prohibit others from practising the invention, and to obtain redress for its forbidden making, use, or sale. The principles which govern the alienation of these objects are very different.

§ 754. Property in the Invention Transferable without Restriction.

The alienation of the invention, or the rights to make, use, or sell, is unrestricted by the nature of the property or the rules of law. The owner of the invention may confer these rights, either separately or together, upon one person or upon many different persons, and each may exercise the rights so conferred without reference to the others.[1] He may transfer them before or after the patent is granted, and may or may

or use or sell his writings or his invention without his permission; and what is granted to him is the exclusive right, not the abstract right, but the right in him to the exclusion of everybody else. . . . (6) the purpose of the Patent Law and of the constitutional provision are answered when the patentee is protected against competition in the use of his invention by others; and when the law prevents others from infringing on his exclusive right to make, use, or sell, its object is accomplished." 18 Fed. Rep. 62 (64).

Further, that a patent gives only a right to exclude others from practising the invention, see De Witt *v.* Elmira Nobles Mfg. Co. (1875), 5 Hun, 301; Hawks *v.* Swett (1875), 4 Hun, 146; 6 Thomp. & C. 529; Bloomer *v.* McQuewan (1852), 14 How. 539.

§ 754. [1] That the rights to make, to use, and to sell, are essentially distinct and may be separately granted, see Dorsey Revolving Harvester Rake Co. *v.* Bradley Mfg. Co. (1874), 12 Blatch. 202; Adams *v.* Burke (1873), 17 Wall. 453; 33 O. G. 114; Jenkins *v.* Greenwald (1857), 2 Fisher, 37; 1 Bond, 126.

not unite with this transfer a conveyance of the entire monopoly or any lawful interest therein.[2] Such transfer does not take effect by virtue of his patent, if he has procured one, nor does its validity as against him depend on the legality of the monopoly which he has received. Its sole relation to the patent arises from the fact that the patentee is not permitted to exercise the prohibitory powers of his monopoly against those to whom he has transferred a right to the invention, and is compelled in certain cases to employ these powers for their protection.

§ 755. Property in the Monopoly Transferable only within Certain Limits.

The alienation of the monopoly created by the patent is, on the other hand, restricted both by its own nature and the rules of law. Of its own nature it is indivisible, except as to the territorial area over which it may be exercised.[1] That each of two independent persons should possess the power to prohibit the practice of an invention in the same locality involves a contradiction of terms; for as this prohibitory power cannot exist apart from the property in the invention, each would at once have a right to make, use, and sell the patented invention and yet be subject to the prohibition of the other. An indivisible monopoly may reside in one person or in several. It may be vested in one owner as to one section of

[2] That a sale of the patented device and of the right to use it, conveys no part of the monopoly, see Goodyear *v.* Beverly Rubber Co. (1859), 1 Clifford, 348.

§ 755. [1] In Gayler *v.* Wilder (1850), 10 How. 477, Taney, C. J.: (494) "For it was obviously not the intention of the legislature to permit several monopolies to be made out of one, and divided among different persons within the same limits. Such a division would inevitably lead to fraudulent impositions upon persons who desired to purchase the use of the improvement, and would subject a party who, under a mistake as to his rights, used the invention without authority, to be harassed by a multiplicity of suits instead of one, and to successive recoveries of damages by different persons holding different portions of the patent right in the same place."

Further, that the monopoly is indivisible except as to locality, see Sanford *v.* Messer (1872), 2 O. G. 470; 5 Fisher, 411; Holmes, 149; Burr *v.* Duryee (1862), 2 Fisher, 275; Metropolitan Washing Machine Co. *v.* Earle (1861), 3 Wall. Jr. 320; 2 Fisher, 203; Goodyear *v.* Railroad (1853), 1 Fisher, 626; Suydam *v.* Day (1846), 2 Blatch. 20; and § 61 and notes, *ante*.

country and in a different owner as to another, but wherever it exists, it must exist as an entirety. It might indeed be possible, in theory, to sever the monopoly in correspondence to the rights embraced in the invention, conferring upon one person the power to prohibit all others from making the invention, upon another the power to forbid its use, and upon another the authority to prevent its sale; but the practical result of such divisions upon the rights of the respective monopolists, as well as upon those of the owners of these various interests in the invention, would be too disastrous to be long tolerated by an industrial community. The law, therefore, peremptorily forbids such multiplication of monopolies, and provides that the prohibitory powers bestowed upon the patentee shall be regarded as indivisible in subject-matter, and constitute but one monopoly in any given portion of the United States.[2]

§ 756. Transfers of Two Classes: First Class Transfers both the Invention and the Monopoly.

These differences between the alienability of an invention and that of the monopoly created by the patent indicate the differences between the two great classes of conveyances by which the transfer of an interest in a patented invention is effected. One of these classes operates directly both on the invention and on the monopoly. It not only conveys the entire or partial interest in the invention, conferring on the transferee the right to practise it, but it also bestows upon him the prohibitory power by virtue of which he can, within the area specified in his conveyance, prevent all other persons from enjoying it, and compel those who transgress to make him compensation for the injury. And as the power to prohibit includes the power to relieve from prohibition, this transferee, in alienating rights, in his turn, to practise the invention, emancipates his alienees from the restrictions of

[2] In Gayler *v.* Wilder (1850), 10 How. 477, Taney, C. J.: (495) "Unquestionably, a contract for the purchase of any portion of the patent right may be good as between the parties as a license, and enforced as such in the courts of justice. But the legal right in the monopoly remains in the patentee, and he alone can maintain an action against a third party who commits an infringement upon it."

See also Sanford *v.* Messer (1872), 5 Fisher, 411; Holmes, 149; 2 O. G. 470.

the monopoly to an extent commensurate with their respective interests in the invention.

§ 757. Second Class Transfers the Invention, but not the Monopoly.

The second class of conveyances operates directly only upon the invention. It transfers no interest in the monopoly, though it protects the transferee against the exercise of the prohibitory powers and enables him in certain cases to invoke them in his favor. It vests in him no authority either to forbid others to practise the invention, or to bestow upon them the right to its enjoyment; though when his interest in the invention is made alienable by the express terms of his conveyance, or by legal implication, his alienee receives the same rights, under the same restrictions and with the same degree of deliverance from the monopoly. Such a conveyance does not rest upon the patent nor affect the exclusive ownership of the monopoly by the patentee or those to whom, by the first class of conveyances, it has been transferred. Its sole operation upon the monopoly is that of an estoppel, — the transferor, and all persons who derive a title to the monopoly from him after the transfer of such interest in the invention, being estopped from enforcing their prohibitory powers against the transferee in such a manner as to impair the value of the interest transferred.

§ 758. No Transfer can be of the First Class unless it Conveys the Entire Interest, or an Undivided Portion of the Entire Interest, in the Invention for the Whole or for Some Definite Part of the United States.

The final test to which the conveyance of an interest in a patented invention is to be subjected, in order to determine whether it belongs to the former or the latter class, is found in the same difference between the alienability of an invention and of a monopoly. As the monopoly is created and subsists only to secure the benefits of the invention to its lawful owners, so the monopoly cannot exist except in one who owns the entire interest or a partial interest in the invention. It thus resides originally in the patentee, who

is the owner of the invention at the issue of the patent, and must remain in him until legally conveyed by him to others.[1] But the monopoly being indivisible in subject-matter cannot be transferred in connection with any one of the subordinate rights in the invention and still vest in the patentee in reference to the other rights which he retains. If he conveys the right to make the invention, or the right to use it or to sell it, or any two of these without the third, the monopoly is not affected, since it cannot follow these rights into the alience, and therefore must remain entirely in the patentee. Nor where these subordinate rights in the invention are themselves divided and conveyed can the monopoly be divided and transferred with them. The conveyance of a right to make and use and sell the invention, leaving in the patentee an independent right to make and use and sell, is proper as a transfer of the invention, but has no operation upon the monopoly; for the monopoly, being indivisible, must either follow the rights conferred upon the transferee and reside in its entirety in him, or continue undivided in the patentee; and the retention by the latter of his rights in the invention is inconsistent with an intention to confer the whole monopoly upon another. But the alienation of the entire interest in the invention or of an undivided portion of the entire interest, either for the whole or any sectional part of the United States, operates also as the transfer of a similar interest in the monopoly. When the patentee conveys the exclusive right to make, use, and sell the invention he has no longer any occasion for the exercise of the prohibitory powers created by the patent, while they become essential to his aliences for the assertion and vindication of their exclusive rights. If he transfers an undivided portion of the entire interest in the invention, he thereby confers upon his transferees rights equal to his own, in all respects, in the invention, and receives them into co-ownership with himself in the monopoly which is now as essential to their protection as it was to his.[2] And the monopoly being divisible as to locality,

§ 758. [1] That there are no owners of a patent except the patentee and his assignees or grantees, see Jordan *v.* Dobson (1870), 2 Abbott, 398; 4 Fisher, 232; 7 Phila. 533.

[2] That an assignment of an undivided

when he bestows on any person the exclusive rights in the invention or an undivided portion of the exclusive rights within a given area, the monopoly to the same territorial extent passes entirely, in the first case, to the alienee, and in the second, resides undivided in the joint-ownership of both.[3] From these principles it is evident that no conveyance can belong to the first class, and directly operate upon the monopoly, unless it transfers the entire interest in the invention or an undivided portion of such entire interest either for the whole or some defined part of the United States, and that every conveyance which leaves in the owner of the patented invention any distinct and independent right therein is of the second class, and can have no effect on the monopoly, except as it estops the owner of the patent from asserting his prohibitory powers in opposition to the rights conferred by him upon his alienee.

§ 759. First Class Divisible into Two Sub-Classes according to the Territorial Limits of the Monopoly Granted.

The first class of conveyances may evidently be subdivided into two inferior classes on the line fixed by the divisibility of the monopoly,—one subdivision embracing those conveyances which transfer the entire interest in the invention, or an undivided portion of the entire interest, for the whole United States; the other subdivision including those by which the entire interest, or an undivided part thereof, within some specified area is alienated.[1] The difference between these subdivisions

part of a patent makes the assignee and the patentee joint-owners, see Potter *v.* Holland (1858), 4 Blatch. 206; 1 Fisher, 327.

[3] That the sale of the exclusive right to make, use, and vend in a particular place confers a portion of the patent privilege, see Goodyear *v.* Beverly Rubber Co. (1859), 1 Clifford, 348.

§ 759. [1] In Gayler *v.* Wilder (1850), 10 How. 477, Taney, C. J.: (494) "By the eleventh section of the act of 1836, the patentee may assign his whole interest, or an undivided part of it. But if he assigns a part under this section, it must be an undivided portion of his entire interest under the patent, placing the assignee upon an equal footing with himself for the part assigned. Upon such an assignment, the patentee and his assignees become joint-owners of the whole interest secured by the patent, according to the respective proportions which the assignment creates. By the fourteenth section, the patentee may assign his exclusive right within and throughout a specified part of the United States, and upon such an assigument the

relates, not to the nature, but to the territorial limits of the rights and powers which they confer. A conveyance of the former species vests in the transferee, either alone or jointly with his transferor or others, the right to practise the invention, and to exercise prohibitory authority, anywhere within the United States. A conveyance of the latter species has the same effect within the boundaries which it describes.

§ 760. Forms of Transfer Corresponding to the Foregoing Classes: First Class, Assignment and Grant: Second Class, License.

The acts of Congress in providing for the transfer of interests in letters-patent, and the Federal courts in adjudicating upon the rights of parties to such transfer, have conformed to the essential nature of a patented invention, as thus described, and to the principles upon which its alienation must inevitably be based. The statutes recognize only two modes by which the monopoly may be transferred, — one by a conveyance of the entire interest in the invention, or of an undivided part thereof, for the whole country; the other by a conveyance of a similar interest, or part interest, within some portion of the United States.[1] To the former conveyance the courts have given the technical name of an Assignment; the latter they have called a Grant.[2] The conveyance of the subordinate rights in the invention, either separately or united, without affecting the monopoly otherwise than by estoppel, is also permitted; and the interests thus created are fully vindicated and sustained. To this conveyance custom and judicial sanction have attached the name of License.[3]

assignee may sue in his own name for an infringement of his rights. But in order to enable him to sue, the assignment must undoubtedly convey to him the entire and unqualified monopoly which the patentee held in the territory specified, — excluding the patentee himself, as well as others. And any assignment short of this is a mere license." See also Littlefield *v.* Perry (1874), 21 Wall. 205; 7 O. G. 964.

§ 760. [1] That there can be no assignment except of either an entire interest or an undivided interest in the whole United States, or of an entire interest, or an undivided interest, in a certain territory, see Littlefield *v.* Perry (1874), 21 Wall. 205; 7 O. G. 964.

[2] That the terms "assignee" and "grantee" are not synonymous, see Potter *v.* Holland (1858), 1 Fisher, 327; 4 Blatch. 206.

[3] That there are three forms of conveyance: Assignment, Grant, and Li-

§ 761. Transfer of Patented Inventions Unrestricted except by their own Nature.

Subject to the restrictions established by the nature of a monopoly, a patented invention is as freely alienable as any other personal property.[1] Every interest therein may reside in one owner or in several joint-owners, and may be enjoyed in any way which is compatible with the character of the interest itself.[2] The rights and obligations created between the parties by the transfer of these interests are governed by the ordinary rules which are applied to all contracts. The prohibitory powers, which vest in the owners of the monopoly by virtue of the patent, are controlled and exercised according to the special provisions of the Patent Law.[3] These will now be examined in detail, in reference to each of the forms of conveyance — Assignment, Grant, and License — in their order.

SECTION I.

OF THE TRANSFER OF LETTERS-PATENT: ASSIGNMENT: GRANT.

§ 762. Assignment Defined: Its Effect.

An assignment is a transfer of the entire interest in a patented invention, or of an undivided portion of such entire interest, as to every section of the United States.[1] It operates

cense, see Potter *v.* Holland (1858), 1 Fisher, 327 ; 4 Blatch. 206.

§ 761. [1] That all interests in patents are assignable, see Campbell *v.* James (1880), 2 Fed. Rep. 338 ; 18 Blatch. 92 ; 18 O. G. 1111.

That any contract may be made concerning patents provided it does not enlarge the right, see Star Salt Caster Co. *v.* Crossman (1878), 3 Bann. & A. 281 ; 4 Clifford, 568.

That under the laws of New York an assignment which suspends the power of alienation longer than the lives of the assignors does not create a perpetuity, since all may join in a transfer at any time, see Ladd *v.* Mills (1884), 22 Blatch. 242 ; 20 Fed. Rep. 792.

[2] That a patent may be assigned either in whole or in part, see Parker *v.* Haworth (1848), 4 McLean, 370 ; 2 Robb, 725 ; Boyd *v.* McAlpin (1844), 3 McLean, 427 ; 2 Robb, 277.

[3] That an assignment and all rights under it rest on the statute, see Gayler *v.* Wilder (1850), 10 How. 477 ; Suydam *v.* Day (1846), 2 Blatch. 20 ; and § 61 and notes, *ante*.

§ 762. [1] In Potter *v.* Holland (1858), 4 Blatch. 206, Ingersoll, J.: (211) "An assignee is one who has had transferred to him in writing the whole interest of the

both upon the invention and upon the monopoly, and conveys them, either wholly or in part, to the assignee. When the entire interest is assigned, it substitutes the assignee for the original patentee, conferring upon him, to their full extent, the rights embraced in the invention and the prohibitory powers bestowed by the patent.[2] Where an undivided interest is transferred, it places the assignee upon an equality, in all respects, with his assignor and the original patentee, vesting in him complete but not exclusive rights and powers as to the monopoly and the invention.[3]

§ 763. Assignments Distinguished from Grants: from Licenses.

To determine whether a given conveyance is an assignment or a grant involves little practical difficulty,—the essential difference between them consisting in the territorial area to which they relate.[1] An assignment and a license are, how-

original patent, or any undivided part of such whole interest, in every portion of the United States; and no one, unless he has had such an interest transferred to him, is an assignee." 1 Fisher, 327 (333).

[2] That the assignment of a patent is a sale of personal property, see Holden *v.* Curtis (1819), 2 N. H. 61.

That an assignee, as well as a patentee, is entitled to an injunction, see Jenkins *v.* Greenwald (1857), 1 Bond, 126; 2 Fisher, 37.

[3] That an assignment of an undivided interest makes the assignor and assignee joint-owners of the patent, see Potter *v.* Holland (1858), 4 Blatch. 206; 1 Fisher, 327.

§ 763. [1] In Meyer *v.* Bailey (1875), 2 Bann. & A. 73, McKennan, J.: (76) "What is meant by an assignee seems now to be settled by repeated adjudication, and by the explicit definition of the act of 1836. In Taylor *v.* Fuel, 6 Cranch, it was held, under the act of 1793, that one to whom was transferred all the rights secured by a patent, excepting certain counties in the State of Vermont, was not an assignee within the meaning of the law, but a mere grantee of a sectional interest in the patent; and in Whittemore *v.* Cutter, 1 Gallison, 429, it was held that the transferee of an undivided part of an entire patent was an assignee. From these decisions it results that only a person who is invested with the entire ownership of a patent or an undivided part of the whole is to be regarded as an assignee. Such, also, is the import of the act of 1836, in the eleventh section of which it is provided that 'every patent shall be assignable in law, either as to the whole interest or any undivided part thereof, by any instrument in writing,' and this assignment, 'and also every grant and conveyance of the exclusive right under any patent to make and use the thing patented within and throughout any specified portion of the United States, shall be recorded,' &c. The distinction established by previous judicial decisions between an assignee and the grantee of a sectional interest in a patent is evidently contemplated by this section, as it is also by the fourteenth sec-

ever, more easily confounded. They are alike in that each may apply to the entire United States, and each may operate upon all the rights embraced in the invention. They are unlike in that an assignment transfers also some interest in the monopoly, while a license leaves the monopoly unaffected in the hands of the licensor, except that it cannot be enforced against the rights conferred by him upon the licensee.[2] Now if the monopoly were separable from the invention, and were customarily transferred by a distinct conveyance, no question as to the character of any given instrument of transfer should arise. But inasmuch as certain transfers of the invention *ipso facto* convey the monopoly, and as every instrument transferring the monopoly must also pass some interest in the invention, and as a license as well as an assignment may operate upon all the rights included in the invention, it often becomes doubtful to which of these two classes a given instrument should be referred. The test is

tion, which authorizes the bringing of suits by 'patentee, assignee, or grantee of the exclusive right within and throughout some specified part of the United States.'" 8 O. G. 437 (438).

In Potter *v.* Holland (1858), 4 Blatch. 206, Ingersoll, J.: (211) "There are three classes of persons in whom the patentee can vest an interest of some kind in the patent. They are an assignee, a grantee of an exclusive sectional right, and a licensee. An assignee is one who has had transferred to him in writing the whole interest of the original patent, or any undivided part of such whole interest, in every portion of the United States; and no one, unless he has had such an interest transferred to him, is an assignee. A grantee is one who has had 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. A licensee is one who has had 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." 1 Fisher, 327 (333).

That the distinctions between patentees, assignees, grantees, and licensees are the same under the act of 1870 as under the act of 1836, see Nelson *v.* Mann (1879), 16 O. G. 761; 16 Blatch. 139.

[2] In Howe *v.* Wooldredge (1866), 12 Allen 18, Gray, J.: (22) "An assignment (and possibly a license to make, use, and sell) is a transfer of a part of the franchise granted by the government to the patentee; a mere license to use a single machine, or a sale of a single machine, transfers no part of the franchise, but *simply discharges* that machine from the operation of the franchise, and puts it upon the common ground of other property."

That an assignment and a license are entirely different, see Theberath *v.* Celluloid Mfg. Co. (1880), 5 Bann. & A. 577; 3 Fed. Rep. 143.

this: If the conveyance vests in the alience the entire interest in the invention, or if it makes him a joint-owner with the alienor in such entire interest, it transfers the monopoly to the same extent as the invention, and is an assignment. But if it leaves in the alienor any exclusive right whatever in the invention, or if the rights conferred upon the alience are not exclusive rights vesting in him alone or in him jointly with his alienor, the monopoly is not transferred and the conveyance is a license.[3] Thus the conveyance of an exclusive right

[3] In Gamewell Fire-Alarm Telegraph Co. *v.* Brooklyn (1882), 14 Fed. Rep. 255, Wallace, J.: (256) "The statutory power of assignment, as is said in Littlefield *v.* Perry, 21 Wall. 205, 219, 'has been so construed by the courts as to confine it to the transfer of an entire patent, an undivided part thereof, or the entire interest of the patentee or an undivided part thereof throughout a certain specified portion of the United States.' In that case there was in one instrument a conveyance of the entire patent, and there was also an instrument, executed concurrently, called a supplementary agreement, which contained a reservation of the right of the patentee to apply the invention himself to certain specified purposes. The two instruments were construed as a conveyance of the title to the patent, with a license back from the assignees to the patentee; and upon this construction the assignees were held as vested with the legal title. From the reasoning of the opinion it is evident, if there had never been a transfer of the patentee's right to the limited use of the invention, the interest transferred would not have been considered as vesting the statutory title in the assignees. In the present case the transfer was only of a right to use and vend the invention for limited purposes in specified places; the right to use and vend it for general purposes remaining intact until it was conveyed to the Western Union Telegraph Company. The right transferred was not an undivided part of an entire patent, or an undivided part of the entire interest of the patentee in specified territory, but was a segregated right for a particular employment of the invention. The complainant was, therefore, merely a licensee, within the rule established in Gayler *v.* Wilder, 10 How. 477; the right transferred to him being less than that of the entire and unqualified monopoly. The case of Ingalls *v.* Tice, 13 Reporter, 670, is directly in point. There the transfer to the complainant was of the sole and exclusive right to sell the patented article in certain specified territory; and as the right of the patentee to make and use the invention did not pass by the instrument, it was held that complainant did not acquire the legal estate, and, the patentee not having been made a party to the suit, a demurrer for that reason was sustained." 22 O. G. 1978 (1978). In this opinion the court, in speaking of the "entire patent," employs the usual language in reference to the subject of an assignment. As every Claim in a patent is, in effect, a separate patent, and may be the subject of a distinct assignment, the phraseology here and elsewhere found must be understood with that limitation. See Pope Mfg. Co. *v.* Gormully & Jeffrey Mfg. Co. (1888), 34 Fed. Rep. 893.

See further, on the difference between assignment and license, § 808 and notes, *post*.

to make, *or* use, *or* sell, for any special purpose, is a mere license, since the exclusive rights remaining in the alienor are his distinct and separate property, and require for their protection an ownership by him of the prohibitory powers which, being indivisible, cannot abide in him and at the same time pass to his alienee. For the same reason the transfer of a simple non-exclusive right to make *and* use *and* sell the invention is not an assignment. The alienor retains the same rights in himself, holding them as his own, and not in common with his alienee; his rights are still exclusive against all other persons except the alienee; and hence in order to preserve them the indivisible monopoly must still reside in him. On the other hand, the transfer of an exclusive right to make *and* use *and* sell, or, what is of the same effect as to all classes of inventions except arts or processes, of the exclusive right to make and sell the invention, or of an undivided interest in such exclusive right, vests the entire invention and consequently the monopoly also in the alienee, either alone or jointly with the alienor, and hence is an assignment.[4]

§ 764. Character of Assignment Determined by its Subject-Matter, not by its Terms or Conditions.

The character of a conveyance, as thus determined by its subject-matter, cannot be varied by the terms and conditions upon which the transfer has been made. These belong to the contract in pursuance of which the transfer was effected, not to the nature of the transfer itself. The parties may annex such qualifications to the conveyance, and impose such obligations upon themselves in reference to their respective rights, as they may deem expedient, — if the instrument transfers any interest in the invention which carries the monopoly, it is an assignment or a grant, but otherwise is a license. Thus, though they should provide that the consideration for the transfer shall be paid by the alienee to the alienor in the form of periodic royalties, or that the title of the alienee shall become forfeited by breach of certain specified conditions, — pro-

[4] That the assignment of the right to make and sell carries the right to use, and if exclusive, passes the entire monopoly, see Nellis *v.* Pennock Mfg. Co. (1882), 15 Phila. 493; 13 Fed. Rep. 451; 22 O. G. 1131.

visions which are generally annexed only to licenses, — the conveyance will be none the less an assignment or a grant, if in its subject-matter it embraces any interest in the monopoly.[1]

§ 765. Assignment, by whom Made.

An assignment of a patented invention can be made only by one in whom the ownership of both the invention and the monopoly resides. At the outset this double ownership vests in the patentee, — his right to the invention arising from his own inventive act; his right to the monopoly being conferred upon him by the patent.[1] Unless transferred by an assignment, or territorially divided by a grant, this ownership remains in him while living, and at his death passes to his executor or administrator as trustees for his heirs or devisees. Hence until the patentee has made either an assignment or a grant, the entire ownership resides in him, and he only can transfer it to another. If his first transfer is an assignment of the entire ownership, his own interest in the patented invention ceases, and no further transfer can be made except by his assignee. The same effect follows each succeeding assignment of the entire ownership, vesting the exclusive title to the invention in the successive assignees.[2] If any holder of the entire ownership assigns an undivided interest therein, the title and the power of assignment vest equally in all the owners of the patented invention, and each may now assign his interest, without restriction by the others.[3] But when the

§ 764. [1] That the fact that an assignee must account and pay a royalty does not make him a mere licensee, see Littlefield *v.* Perry (1874), 21 Wall. 205; 7 O. G. 964.

That a clause of forfeiture for nonperformance does not show that the assignee is a mere licensee, see Littlefield *v.* Perry (1874), 21 Wall. 205; 7 O. G. 964.

§ 765. [1] That the legal title to a patent vests in the patentee on its issue, see Consolidated Electric Light Co. *v.* Edison Electric Light Co. (1885), 25 Fed. Rep. 719; 33 O. G. 1597; 23 Blatch. 412.

[2] That the power to assign, grant, and license vests in the assignees of the patent, of whatever degree, see Selden *v.* Stockwell Self-Lighting Gas Burner Co. (1881), 19 Blatch. 544; 20 O. G. 1377; 9 Fed. Rep. 390.

[3] That the owner of a distinct interest in a patent may assign his own share, see May *v.* Chaffee (1871), 2 Dillon, 385; 5 Fisher, 160.

See also §§ 796, 798, and notes, *post*.

patentee or any subsequent assignee of the entire ownership divides it territorially by a grant, no further assignment of the patented invention is possible unless, perhaps, by a conveyance in which all the owners join.[4] The ownership of the grantor, like that of the grantee, is then a mere sectional ownership, subject to further grants either within the same or narrower territorial limits, but not to an assignment which must relate to the entire ownership within the United States. The transfer of a right to practise the invention, as distinguished from a right in the monopoly, does not, however, affect the title to the patented invention. A patentee or assignee or grantee may license others to make use or sell without thereby diminishing his power to alienate his interest, or change the nature of the rights of which that interest consists.[5] Upon the death of any owner of a patented invention, his ownership and power of alienation are transferred to his administrators or executors by the express provisions of the statutes, to be preserved and exercised by them in the same manner as by himself when living, though for the benefit of his heirs and devisees.[6] The power of infants and married women to assign their interests in patented inventions is governed by the local law.[7]

§ 766. Assignment, by whom Made when the Owner is Insolvent.

The rule that an assignment can be made only by the actual owner of the patented invention admits of no exception in the

[4] That co-owners may unite in one assignment though they own different territory, see Ladd *v.* Mills (1884), 22 Blatch. 242; 20 Fed. Rep. 792.

[5] See § 782 and notes, *post.*

[6] That an administrator may assign a patent when renewed in his own name, see Brooks *v.* Jenkins (1844), 3 McLean, 432.

That an assignment by one administrator gives a perfect title unless others can show a better, see Donoughe *v.* Hubbard (1886), 27 Fed. Rep. 742; 35 O. G. 1561; Bradley *v.* Dull (1884), 27 O. G. 625; 19 Fed. Rep. 913.

That the assignment of a patent by one of two administrators is good and will pass the entire interest in the patent, see Wintermute *v.* Redington (1856), 1 Fisher, 239.

See also § 406 and notes, *ante*, and §§ 800, 801, and notes, *post.*

[7] That an infant must assign by guardian, but the guardian is governed by the local law, see Fetter *v.* Newhall (1883), 21 Blatch. 445; 25 O. G. 502; 17 Fed. Rep. 841.

That the power of a married woman to assign a patent depends on the provisions of the local law, see Fetter *v.* Newhall (1883), 21 Blatch. 445; 25 O. G. 502; 17 Fed. Rep. 841.

interest of creditors. Valuable as his property therein may be, it cannot be subjected to the payment of his debts by any of the ordinary methods of involuntary alienation. This is not due to any peculiar sanctity which the law attaches to this class of property, but to the fact that the statutes which create the monopoly provide no other mode of transferring it than through the voluntary act of its real owner. The ownership of a patented invention cannot be seized and sold on execution by a sheriff like a personal chattel, nor like other incorporeal rights does it vest in a receiver or a trustee in insolvency by virtue of the judicial decree of the court by which these various officials are appointed.[1] Thus neither a bankrupt court, nor a court of equity, nor any person acting under their authority, can affect the ownership of a patented invention without the actual or presumed co-operation of the individual in whom such ownership is vested by the issue of

§ 766. [1] That a patent privilege cannot be seized and sold on execution, nor set off to a judgment creditor, see Carver *v.* Peck (1881), 131 Mass. 291; Pacific Bank *v.* Robinson (1881), 57 Cal. 520; Stevens *v.* Gladding (1854), 17 How. 447; Stephens *v.* Cady (1852), 14 How. 528.

That the patent privilege does not vest in a receiver merely by virtue of his appointment, see Dick *v.* Struthers (1885), 25 Fed. Rep. 103; 34 O. G. 131.

That a receiver, as such, has no power to convey the legal title to a patent, see Adams *v.* Howard (1884), 23 Blatch. 27; 22 Fed. Rep. 656; Gordon *v.* Anthony (1879), 16 O. G. 1135; 16 Blatch. 234; 4 Bann. & A. 248.

That a receiver, as such, may convey the equitable title, see Adams *v.* Howard (1884), 23 Blatch. 27; 22 Fed. Rep. 656.

That a trustee in insolvency does not acquire the patents of the insolvent by virtue of his appointment as trustee, see Campbell *v.* James (1880), 2 Fed. Rep. 338; 18 Blatch. 92; 18 O. G. 1111; Gordon *v.* Anthony (1879), 16 Blatch. 234; 16 O. G. 1135; 4 Bann. & A. 248; Ashcroft *v.* Walworth (1872), 5 Fisher, 528; 2 O. G. 546; Holmes, 152.

That a State has power to enact a statute by virtue of which an assignee in insolvency will become entitled to the patents of the insolvent, and a court of equity will be empowered to compel the insolvent to transfer them to the assignee, see Barton *v.* White (1887), 144 Mass. 281.

That under § 5046, Rev. Stat., a right to the patents of the bankrupt vested in the trustee by virtue of his appointment, see Carver *v.* Peck (1881), 131 Mass. 291; Prime *v.* Brandon Mfg. Co. (1879), 16 Blatch. 453; 4 Bann. & A. 379.

That under § 5046, Rev. Stat., the rights of the trustee were superior to those of an assignee of record whose assignment was made by the bankrupt after the bankruptcy, see Prime *v.* Brandon Mfg. Co. (1879), 16 Blatch. 453; 4 Bann. & A. 379.

the patent or by assignment from the patentee. Either of those courts may have the power to compel the owner to transfer the ownership by an assignment to the receiver or trustee, and a court of equity, on his refusal, may treat the equitable rights as vested in the creditors and appoint a trustee for the owner to convey the legal title, in his name and behalf, to the officer in charge of his bankrupt estate, but the title in all such cases is still derived from him on whom it was originally conferred.[2] That Congress has the power at any time to meet this difficulty, by creating methods of involuntary alienation, there can be no doubt, but in the absence of such statutes and judicial orders, the patented invention remains entirely and exclusively under the control of its owner, and may be retained or conveyed by him at his pleasure without reference to any existing condition of insolvency.[3]

§ 767. Assignment, to whom Made.

An assignment of a patented invention may be made to any person without regard to age, capacity, or citizenship.[1] A corporation may become the owner both of the invention and monopoly without receiving special charter-powers for that purpose, although such powers might be required in order to enable it to practise the invention.[2] Every assignee, of whatever degree of removal from the original patentee, occupies the same position and enjoys the same rights as any of his predecessors or co-owners, and is entitled to all the privileges

[2] That an insolvent court or court of equity may compel the insolvent to assign his patents to the trustee or receiver, see *In re* Keach (1884), 14 R. I. 571; Pacific Bank *v.* Robinson (1881), 57 Cal. 520; 20 O. G. 1314; Murray *v.* Ager 1881), 1 Mackey, 87; 20 O. G. 1311; Barnes *v.* Morgan (1875), 3 Hun, 703; 6 Thomp. & C. 105; Ashcroft *v.* Walworth (1872), 2 O. G. 546; 5 Fisher, 528; Holmes, 152.

That if the insolvent refuses to convey when ordered by the court, it may appoint a trustee to make the assignment, see Murray *v.* Ager (1881), 1 Mackey, 87; 20 O. G. 1311.

See further on this subject, §§ 803–805 and notes, *post*.

[3] That an assignment of all the assignor's property except such as is exempt by law does not carry a patent-right, see Campbell *v.* James (1880), 18 O. G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92.

§ 767. [1] That married women or infants may be made assignees, see Fetter *v.* Newhall (1883), 21 Blatch. 445; 25 O. G. 502; 17 Fed. Rep. 841.

[2] That a corporation may take the assignment of a patent without special charter powers for that purpose, see Dorsey Harvester Rake Co. *v.* Marsh (1873), 6 Fisher, 387.

and is subject to all the obligations conferred or imposed by the statutes upon the patentee and his assignees.[3]

§ 768. Form of Assignment: General Requisites.

No particular form for an assignment is prescribed.[1] It

[3] In Seldon *v.* Stockwell Self-Lighting Gas Burner Co. (1881), 10 Blatch. 544, Blatchford, J.: (552) "'The assignee' means the assignee in any degree and however remote. By § 4884 the grant is directed to be made to 'the patentee, his heirs, or assigns.' This is not limited to the first assignee. So § 4898, in declaring that 'every patent, or any interest therein, shall be assignable,' and that 'the patentee or his assigns' may convey an exclusive right under the patent, for the whole or any specified part of the United States, clearly means that an assignee in any degree is an assignee for all purposes. All parts of the statute are to be construed harmoniously in this respect, as there appears to be no good reason for a contrary construction. It is true that § 4 of the Patent Act of February 21st, 1793 (1 U. S. Stat. at Large, 322), used the words 'assignees of assigns, to any degree;' but the absence of the words 'to any degree' cannot, in view of all the provisions of the present statute, be regarded as restricting the meaning of the word 'assignee.'" 20 O. G. 1377 (1378); 9 Fed. Rep. 390 (396).

§ 768. [1] That assignments are governed wholly by statute, see Suydam *v.* Day (1846), 2 Blatch. 20.

That an assignment is not valid unless it complies with the laws of the United States, see Higgins *v.* Strong (1836), 4 Blackf. (Ind.) 182.

That an assignment requires no special form, see Siebert Cylinder Oil Cup Co. *v.* Beggs (1887), 32 Fed. Rep. 790; Campbell *v.* James (1880), 18 O. G. 1111; 18 Blatch. 92; 2 Fed. Rep. 838.

That an assignor, having only a residuary interest, may convey that by assigning "all his right, title, and interest," whether his prior assignment is recorded or not, see Turnbull *v.* Weir Plow Co. (1874), 7 O. G. 173, 1 Bann. & A. 544; 6 Bissell, 225.

That a certificate of the patentee that another person owns part of the patent is not an assignment, unless so intended, see Kearney *v.* Lehigh Valley R. R. Co. (1886), 27 Fed. Rep. 699.

That a certificate that the holder is the owner of $\frac{5}{6}$ of the patent and property of the M. T. Co., and "will receive shares of stock to that amount when the company is formed" is not an assignment, see Hope Iron Works *v.* Holden (1870), 58 Me. 146.

That if the description of the patent in the assignment be intelligible it is sufficient, see Myers *v.* Turner (1855), 17 Ill. 179.

That the deed need not set out the specification of the invention, if it is otherwise clearly shown, see Hill *v.* Thuermer (1859), 13 Ind. 351.

That the vendee of a patent must exercise ordinary care in inspecting the specification and Claims to see what the invention is, see Edmunds *v.* Myers (1854), 16 Ill. 207; Edmunds *v.* Hildreth (1854), 16 Ill. 214.

That circumstantial variance between the patent and its description in the assignment does not show fraud or prevent the title from passing, see Case *v.* Morey (1818), 1 N. H. 347; Holden *v.* Curtis (1819), 2 N. H. 61.

That the sale of an improvement is valid if the patent referred to in the conveyance so describes the improve-

must be made in writing and be signed by the assignors.[2] It must also contain operative words unequivocally indicating an intention to convey an interest both in the invention and in

ment that a person skilled in the art could make it, though it does not describe the original machine, see Harmon *v.* Bird (1839), 22 Wend. 113.

[2] That an assignment must be in writing, see Gottfried *v.* Miller (1882), 104 U. S. 521; 21 O. G. 711; Blakeney *v.* Goode (1876), 30 Ohio St. 350; Ashcroft *v.* Walworth (1872), 2 O. G. 546; Holmes, 152; 5 Fisher, 523; Jordan *v.* Dobson (1870), 4 Fisher, 232; 2 Abbott, 393; 7 Phila. 533; Davy *v.* Morgan (1868), 56 Barb. 218.

That an agreement based on a parol assignment is void for want of consideration, see Davy *v.* Morgan (1868), 56 Barb. 218.

That a patent is personal property, and but for the statute could be conveyed by parol, see Springfield *v.* Drake (1876), 58 N. H. 19.

That an oral agreement for the sale of an invention before patent, is not a contract for goods under the Statute of Frauds, see Somerby *v.* Buntin (1875), 118 Mass. 279.

That an agreement to hold a patent in trust for another may be by parol, see Blakeney *v.* Goode (1876), 30 Ohio St. 350.

That a parol contract to assign will pass an equitable title which a court of equity will enforce, see Burr *v.* De La Vergne (1886), 102 N. Y. 415; Whitney *v.* Burr (1885), 115 Ill. 289.

That equitable interests and rights to the proceeds of the sales of patents may be created by parol, see Blakeney *v.* Goode (1876), 30 Ohio St. 350.

That a verbal assignment vests in the assignee an equitable right to grant licenses, and notes given for such licenses are upon sufficient consideration, see Burke *v.* Partridge (1878), 58 N. H. 349.

That a parol agreement to assign and to allow the assignee to take out the patent in his own name, is valid, see Lockwood *v.* Lockwood (1871), 33 Iowa, 509.

That a parol agreement by the inventor to permit another to receive the patent in his own name for value, if carried out, can be shown and the value recovered, see Lockwood *v.* Lockwood (1871), 33 Iowa, 509.

That the legal title to a patent can be transferred only by a written instrument, signed by the owner of the patent, see Ashcroft *v.* Walworth (1872), 2 O. G. 546; Holmes, 152; 5 Fisher, 528.

That a contract binds the parties who participate in it, though signed only by one party representing the rest, see Bean *v.* Clark (1887), 40 O. G. 1454.

That an assignment executed by attorney must be signed with name of the principal and sealed with his seal, see Machesney *v.* Brown (1886), 38 O. G. 1130; 29 Fed. Rep. 145; 24 Blatch. 168.

That an assignment by an attorney in his own name is invalid, the signature of the owner being essential, see Pryor *v.* Coulter (1830), 1 Bailey (S. C.), 517.

That where the owner of a patent consents in writing to its transfer by another, it is as good as if the transfer were made directly by himself, see Sherman *v.* Champlain Transportation Co. (1858), 31 Vt. 162.

That a conveyance by a corporation with its seal, and by its president with his seal, is good as to both, see Campbell *v.* James (1879), 18 O. G. 979; 17 Blatch. 42; 4 Bann. & A. 456.

That a corporation may assign letters-patent although some shares of its

the monopoly.[3] A contract to sell the patented invention, therefore, is not an assignment, though it may be enforced in equity, and meanwhile operate by estoppel as a license.[4] But an irrevocable power of attorney, giving full control over the patented invention, may vest the entire ownership at once in the attorney named, and however widely differing in form from a conveyance may be a true assignment.[5] Whether a given instrument is or is not an assignment must be determined from its subject-matter, as described in the instrument itself. Parol evidence is not admissible to vary its terms except in cases of mutual mistake.[6] The motive for an assignment is immaterial.[7] A seal is not required.[8]

§ 769. Assignment before Patent: Its Form and Effect.

An assignment of a completed invention may be made either before or after the issue of the patent.[1] An inventor has, by

capital stock may be under attachment in a suit against a stockholder, see Gottfried *v.* Miller (1881), 104 U. S. 521; 21 O. G. 711.

That a forged assignment may be ratified *in pais*, see Campbell *v.* James (1879), 17 Blatch. 42; 18 O. G. 979; 4 Bann. & A. 456.

[3] In Campbell *v.* James (1880), 18 Blatch. 92, Wheeler, J.: (101) "All interests in patents are assignable by instrument in writing. No particular form is required; but still there must be some operative words expressing at least an intention to assign, in order to constitute an assignment." 18 O. G. 1111 (1114); 2 Fed. Rep. 338 (347).

[4] That a contract for the purchase of part of a patent-right may be good as a license, see Sanford *v.* Messer (1872), 5 Fisher, 411; 2 O. G. 470; Holmes, 149.

[5] That an irrevocable power of attorney may be an assignment, see Hartshorn *v.* Day (1856), 19 How. 211.

That an irrevocable and exclusive power to act as "sole agent" for making and selling an article, and to pay the proceeds to the principal less the commission is not an assignment, see Kempton *v.* Bray (1868), 99 Mass. 350.

That where the owners of a patent assign to a third party in trust to exercise certain powers on their behalf, the assignee possesses an authority coupled with an interest, see Ladd *v.* Mills (1884), 22 Blatch. 242; 20 Fed. Rep. 792.

[6] That parol evidence cannot vary the terms of an assignment, except in mutual mistake, see Knowlton Platform & Car Coupling Co. *v.* Cook (1879), 70 Me. 143; Hammond *v.* Pratt (1879), 16 O. G. 1235; Ruggles *v.* Eddy (1872), 5 Fisher, 581; 10 Blatch. 52.

[7] That the motive for an assignment is immaterial, see Siebert Cylinder Oil Cup Co. *v.* Phillips Lubricator Co. (1882), 10 Fed. Rep. 677.

That a conveyance made to deceive the Patent Office is inoperative, see Prime *v.* Brandon Mfg. Co. (1879), 16 Blatch. 453; 4 Bann. & A. 379.

[8] That it is not required that an assignment of a patent be under seal, see Gottfried *v.* Miller (1882), 104 U. S. 521; 21 O. G. 711; Van Ostrand *v.* Reed (1828), 1 Wend. 424.

§ 769. [1] That an assignment of an

virtue of his inventive act, not merely the ownership of his invention, but an inchoate right to the monopoly which is to become vested upon his application for and receipt of letters-patent. This ownership of the invention, and inchoate right to the monopoly, together with the right to perfect his title to the monopoly by obtaining letters-patent, is made assignable by law equally with the patented invention; and an assignment covering these rights and properly recorded secures to the assignee both the invention and monopoly immediately on the issue of the patent.[2] To authorize an issue of the patent directly to the assignee, however, the instrument of assignment must contain a written request to the Commissioner of Patents that the letters-patent may be granted to the assignee, or to the assignee and the inventor jointly if the conveyance operates upon an undivided interest, and must be filed for record in the Patent Office before the date fixed for the payment of the final fee.[3] Such a convey-

invention before patent is valid, see Cammeyer *v.* Newton (1876), 94 U. S. 225; 11 O. G. 287; Hammond *v.* Mason & Hamlin Organ Co. (1875), 92 U. S. 724; Continental Windmill Co. *v.* Empire Windmill Co. (1871), 8 Blatch. 295; 4 Fisher, 428; Appleton *v.* Bacon (1862), 2 Black, 699; Rathbone *v.* Orr (1850), 5 McLean, 131; Herbert *v.* Adams (1825), 4 Mason, 15; 1 Robb, 505.

That the right to an invention dates from its discovery, see Wintermute *v.* Redington (1856), 1 Fisher, 239.

That a mortgage of a future invention will cover it, though the invention be divided and patented in different patents under different names, see Hollins *v.* Mallard (1854), 10 How. Pr. 540.

See as to this whole subject §§ 409–411 and notes, *ante*.

[2] Sec. 4895, Rev. Stat.

That a sale by the inventor before the patent issues secures the invention to the vendee after the patent is granted, see Rathbone *v.* Orr (1850), 5 McLean, 131.

That an assignment of "one third of the full and exclusive right to the invention as set forth and described" in a specification about to be filed carries a one-third interest in all the patentable devices described and claimed in such specification and in all patents obtained therefor, see Puetz *v.* Bransford (1887), 31 Fed. Rep. 458; 39 O. G. 1083.

That alterations in one of such devices and the procuring a separate patent therefor do not take it out of such assignment, see Puetz *v.* Bransford (1887), 31 Fed. Rep. 458; 39 O. G. 1053.

That an assignee may accept a different patent in the room of the one agreed to be assigned, and if acting on such acceptance is estopped to claim the other, see Topliff *v.* Topliff (1887), 122 U. S. 121; 40 O. G. 115.

[3] That the patent cannot issue to the assignee unless the assignment contains a request to that effect, and is duly entered for record as prescribed by the rules, see Wright *v.* Randell (1881), 19 Blatch. 495; 21 O. G. 493; 8 Fed. Rep.

ance transfers to the assignee the legal as well as equitable title to the patented invention; and if by any fraud or accident the letters-patent should be issued in the name of the inventor only, the property in the invention and monopoly will, nevertheless, be vested in the assignee.[4] An instrument purport-

591; Hammond *v.* Pratt (1879), 16 O. G. 1235.

That the Patent Office cannot take notice of an equitable interest, whose existence is contingent on the issuing of a patent, see Martin *v.* Olney (1876), 9 O. G. 1107.

That the assignment of a future patent, not containing a request that the patent issue to the assignee, is not recordable, and if recorded is not notice, see Wright *v.* Randell (1881), 8 Fed. Rep. 591; 19 Blatch. 495; 21 O. G. 493; Gay *v.* Cornell (1849), 1 Blatch. 506.

[4] That no legal title exists till the patent issues, see Pontiac Knit Boot Co. *v.* Merino Shoe Co. (1887), 31 Fed. Rep. 286.

That the issue of a patent to an assignee gives him the legal title, see Perkins *v.* U. S. Electric Light Co. (1883), 24 O. G. 204; 21 Blatch. 308; 16 Fed. Rep. 513.

That a patent may issue to the assignee of an assignee, see Consolidated Electric Light Co. *v.* Edison Electric Light Co. (1885), 25 Fed. Rep. 719; 33 O. G. 1597; 23 Blatch. 412.

That the patent may issue to any assignee of record if the rights of paramount owners are not thereby affected, see Consolidated Electric Light Co. *v.* Edison Electric Light Co. (1885), 25 Fed. Rep. 719; 33 O. G. 1597; 23 Blatch. 412.

That where a patent issues to the first of several successive assignees, all whose assignments were on record pending the application, the title vests in the last, see Consolidated Electric Light Co. *v.* McKeesport Light Co. (1888), 34 Fed. Rep. 335; 44 O. G. 110; Consolidated Electric Light Co. *v.* Edison Electric Light Co. (1885), 25 Fed. Rep. 719; 33 O. G. 1597; 23 Blatch. 412.

That it is not necessary that the true owner of the patent be made the nominal patentee, see Consolidated Electric Light Co. *v.* Edison Electric Light Co. (1885), 25 Fed. Rep. 719; 33 O. G. 1597; 23 Blatch. 412.

That an assignment, made before the issue of the patent and recorded in the Patent Office, and conveying all the right of the inventor and the legal title which he expects to obtain, and requesting that the patent issue to the assignee, transfers the right to the assignee although the patent actually issues to the assignor, see Gayler *v.* Wilder (1850), 10 How. 477.

That an assignment made before the patent issues, requesting an issue to the assignee, will vest the legal title in the assignee on recording the assignment though the patent had been ordered to be issued to the assignor before the assignment was made, and was actually issued to him before the assignment was recorded, see United States Stamping Co. *v.* Jewett (1880), 7 Fed. Rep. 869; 18 O. G. 1529; 18 Blatch. 469.

That where an applicant assigns, requesting the patent to issue to the assignee, and the assignment is not recorded until after the patent issues, and subsequently to such record the patentee assigns to another, the title of the first assignee dates from the date of the record and prevails over the second assignee, see U. S. Stamping Co. *v.* Jewett (1880), 18 Blatch. 469; 7 Fed. Rep. 869; 18 O. G. 1529.

ing to be an assignment, but not containing this request or not recorded in due season, does not convey the legal title to the patented invention. It may create an equitable title which a court of chancery will enforce against the inventor and against all other parties who, having notice of the assignment, subsequently become interested in the invention; but it cannot prevail over a later assignment which confers a legal title upon a *bona fide* assignee who has no notice of the former.[5] In the absence of such intervening legal titles, the patent issues to the inventor, as if no equitable title had been previously created, and chancery compels him to receive and hold it as trustee for his equitable assignees, or to convey it to them by a regular assignment.[6]

[5] That an assignment before patent, patent can be specifically enforced in not requesting the issue to the assignee, is a contract to assign the patent after issue, and creates an equitable title in the assignee, see Hammond *v.* Pratt (1879), 16 O. G. 1235; Newell *v.* West (1875), 13 Blatch. 114; 9 O. G. 1110; 2 Bann. & A. 113; 8 O. G. 598; Troy Iron & Nail Co. *v.* Corning (1852), 14 How. 193.

That the equitable title of an assignee before patent without request, etc., cannot prevail over the legal title of subsequent *bona fide* purchasers without notice, see Davis Wagon Wheel Co. *v.* Davis Wagon Co. (1884), 22 Blatch. 221; 20 Fed. Rep. 699; Wright *v.* Randell (1881), 19 Blatch. 495; 21 O. G. 493; 8 Fed. Rep. 591.

[6] That an equitable prevails over the legal title in a court of equity, and the legal owner is treated as trustee for the equitable owner, see Whiting *v.* Graves (1878), 3 Bann. & A. 222; 13 O. G. 455. See also § 786 and notes, *post*.

That the interest in an invention cannot be assigned by parol so as to entitle the assignee to the patent as against the patentee, see Hammond *v.* Pratt (1879), 16 O. G. 1235.

That a contract to assign a future equity, see Hapgood *v.* Rosenstock (1885), 23 Blatch. 95; 23 Fed. Rep. 86; Hammond *v.* Pratt (1879), 16 O. G. 1235; *Ex parte* Edison (1875), 7 O. G. 423.

That a court of equity will not aid an inventor to obtain a patent in violation of his own agreements, see Runstetler *v.* Atkinson (1883), 23 O. G. 940.

That an assignee before patent, having notice of a prior unrecorded assignment, and with such notice procuring the patent to be issued to himself, takes the legal title in trust for the first assignee and may be compelled to convey to him, see Pontiac Knit Boot Co. *v.* Merino Shoe Co. (1887), 31 Fed. Rep. 286.

That specific performance will not be decreed in favor of one who has repeatedly broken the contract, though the defendant first transgressed it, see Ohio Steel Barb Fence Co. *v.* Washburn & Moen Mfg. Co. (1886), 26 Fed. Rep. 702; 35 O. G. 1337.

That no specific performance will be decreed where it would avail nothing, or where the petitioner has not acted equitably, see Werden *v.* Graham (1883), 24 O. G. 101; 107 Ill. 169.

That though a specific performance

§ 770. Assignment of Extension.

When the law provides for the grant of an extension to the patentee, he may assign his right to the extension in the same manner, even before the original patent has been issued.[1] Such an assignment creates an equitable title in the assignee, which becomes operative on the grant of the extension, and thereupon both the invention and monopoly vest in him according to the terms of his conveyance.[2] If the assignee is already an owner of the patented invention under the original patent, the effect of such extension is merely to prolong the period of his existing ownership. If his ownership is to commence with the extension, or to be enlarged thereby, and a

has been rendered impossible through the fraudulent act of the defendant, the court will not decree it, see Kennedy *v.* Hazelton (1888), 128 U. S. 667; Kennedy *v.* Hazelton (1888), 33 Fed. Rep. 293.

That an employer cannot compel his employee to assign a patent to him unless there was an agreement to that effect, see Hapgood *v.* Hewitt (1886), 119 U. S. 226; 37 O. G. 1247.

That where a workman is hired to invent, and agrees that his inventions shall belong to his employer, the employer is their real owner, see Joliet Mfg. Co. *v.* Dice (1883), 105 Ill. 649.

That a contract to sell the patent privilege is made good by securing a second patent when the first is void, see Stanley *v.* Whipple (1839), 2 McLean, 35; 2 Robb, 1.

That under a contract to assign several methods the assignee is not bound to accept an assignment of one, though the others are open to the public, see Serviss *v.* Stockstill (1876), 30 Ohio St. 418.

That an agreement to transfer property on the happening of a certain event gives an immediate right thereto upon the happening of the event, see McBurney *v.* Goodyear (1853), 11 Cush. 569.

See further §§ 408–414 and notes, *ante*, and §§ 786, 1228, 1229, and notes, *post*.

§ 770. [1] That an extension may be assigned before it is granted, see Consolidated Fruit Jar Co. *v.* Mason (1877), 7 Daly, 64; *Ex parte* Holmes (1873), 4 O. G. 581; Nicholson Pavement Co. *v.* Jenkins (1872), 14 Wall. 452; 1 O. G. 465; 5 Fisher, 491; Railroad Co. *v.* Trimble (1870), 10 Wall. 367; Clum *v.* Brewer (1855), 2 Curtis, 506.

That an extension may be contracted for, but not assigned, before it is granted, see Day *v.* Candee (1853), 3 Fisher, 9.

That an assignment of an extension, before even the original patent has issued, is valid, see *Ex parte* Holmes (1873), 4 O. G. 581.

[2] That an agreement to assign an extension is valid in equity, see Prime *v.* Brandon Mfg. Co. (1879), 16 Blatch. 453; 4 Bann. & A. 379; Newell *v.* West (1875), 8 O. G. 598; 2 Bann. & A. 113; 13 Blatch. 114; 9 O. G. 1110; Pitts *v.* Hall (1854), 3 Blatch. 201.

That an assignment of a future extension becomes operative on the grant of the extension, see Gear *v.* Grosvenor (1873), 3 O. G. 380; Holmes, 215; 6 Fisher, 314; Railroad Co. *v.* Trimble (1870), 10 Wall. 367.

That an agreement to sell an extension creates an equitable title, and becomes a legal title when the price is paid, see Hartshorn *v.* Day (1856), 19 How. 211.

now conveyance after the extension thus becomes necessary to perfect his legal title, chancery will enforce the preceding equitable assignment by compelling the patentee to execute such further transfer as may be required.[3] Though the extension be not granted until after the death of the patentee, his previous assignments bind it in the hands of his executors or administrators, who without the consent of his heirs or devisees, and without any order from the local court of Probate, may procure the extension and complete the title of the assignee.[4]

§ 771. Contract to Assign Future Inventions not an Assignment.

A contract for the transfer of inventions not yet in being is valid as a contract, but is not an assignment.[1] The subject-matter of an assignment is an existing invention, not only conceived as an idea of means but actually reduced to practice, and thus invested with the inchoate or perfected right to that monopoly which must always pass with the invention in this form of conveyance.[2] An intended or incomplete invention rests merely in purpose and expectation. It does not clothe the proposed inventor with any special privileges or entitle him to any rights in the monopoly which, if his purpose were accomplished, he might be able to secure. The transfer of such future inventions is a mere executory contract to assign them if they happen to be made.[3] It binds the

[3] That an inchoate right to an extension may be sold, and a contract for such sale specifically enforced in equity, see Newell *v.* West (1875), 8 O. G. 598; 13 Blatch. 114; 9 O. G. 1110; 2 Bann. & A. 113; Aiken *v.* Dolan (1867), 3 Fisher, 197.

[4] That an administrator may fulfil a contract to convey an extension, by procuring the extension and assigning it, no order of the Probate Court and no consent of the heirs being necessary, see Newell *v.* West (1875), 13 Blatch. 114; 8 O. G. 598; 9 O. G. 1110; 2 Bann. & A. 113.

See also as to the assignment of an extension, § 412 and notes, *ante*, and §§ 779, 844, and notes, *post*.

§ 771. [1] That the right to an invention can be transferred before it is completed and while its value is prospective and contingent, see Marshall *v.* Peck (1833), 1 Dana, 609; and §§ 368, 409, and notes, *ante*.

[2] That an assignment entitling the assignee to have a patent issued to him must be a formal assignment of a completed invention, not an agreement to assign future inventions, see Runstetler *v.* Atkinson (1883), 23 O. G. 940.

[3] That an instrument purporting to convey inventions not yet in being is a mere executory contract, not an assignment, see *Ex parte* Edison (1875), 7 O. G. 423.

inventor, and if the inventions are completed it gives the other party a contract right which equity can protect and make effectual when the interests of third parties without notice are not thereby prejudiced.[4]

§ 772. Assignment Before Patent Favored in Law.

An assignment of a patented invention before the grant of letters-patent is not regarded as the transfer of a lawsuit or a controverted right, and is consequently favored by the law.[1] Even where a patent has been once applied for and refused, a subsequent assignment of the inventor's interests is valid, and upon a new application a patent may be issued vesting the title in the assignee.[2] But when the application for a patent has been finally rejected and abandoned, the rights conferred by the inventor upon his assignees become extinguished, and if thereafter the heirs of the inventor obtain letters-patent by a special act of Congress, the interest in the invention and monopoly reside in them to the exclusion of the assignees.[3]

[4] That the assignment of an imperfect invention, with all its future improvements, is an assignment of the perfected result, and the assignee is the equitable owner of the patent when issued, see Littlefield *v.* Perry (1874), 21 Wall. 205 ; 7 O. G. 964.

That an assignment of a patent with future improvements is valid and vests an equitable interest in the improvements when made, which the court may follow with decree for legal title, see Aspinwall Mfg. Co. *v.* Gill (1887), 40 O. G. 1133 ; 32 Fed. Rep. 697.

That on an agreement to assign a future patent, the right to an assignment becomes absolute when the patent issues, see Satterthwait *v.* Marshall (1872), 4 Del. Ch. 337.

That a contract to assign will be specifically enforced, see Hapgood *v.* Rosenstock (1885), 23 Blatch. 95 ; 23 Fed. Rep. 86 ; *Ex parte* Edison (1875), 7 O. G. 423 ; and § 411 and notes, *ante*, and § 1228 and notes, *post*.

§ 772. [1] That an assignment pending an application is not an assignment of a lawsuit, see Gay *v.* Cornell (1849), 1 Blatch. 506.

[2] That an assignment of an invention before patent is valid, although a patent had been refused to the applicant before the assignment was made, see Gay *v.* Cornell (1849), 1 Blatch. 506.

That where an assignment had been made of an improvement pending an application for a patent, and the application being rejected a new application is filed and granted, the patent enures to the benefit of the assignee, see Littlefield *v.* Perry (1874), 21 Wall. 205 ; 7 O. G. 964.

[3] That when the inventor makes an assignment of his invention before a patent is granted, and the patent being refused on his application the application is abandoned, and his rights and all those derived from him are lapsed, and after his death his heirs obtain a patent by special act of Congress, their patent

§ 773. Effect of Assignment, how Determined: Its Construction.

The extent of the interest created in the assignee by an assignment depends in part upon the interest owned by the assignor, and in part upon the terms of the conveyance. An assignor cannot transfer what he does not himself possess. A sole patentee can assign the entire interest in the patented invention, but the owner of an undivided interest can convey only that undivided interest, and the owner of an interest which has been limited by previous grants or by irrevocable licenses, can give no title except to the residuary or reversionary rights that still remain in him.[1] Hence, however broad may be the words of the conveyance, they operate upon the patented invention only within the scope of the rights vested in the assignor at the date of the assignment. The assignee must take his interest subject to all previous lawful conveyances and to the restrictions originally imposed upon his assignor. Within these limits the interest transferred by the assignment is measured by the terms of the conveyance.[2] These are to be so construed as to effect the intention of the parties, but cannot be varied by parol evidence, except in cases of mutual mistake.[3] If more than one instrument enters into the transaction, as where the equitable title created by an

is not subject to the old assignment, see Fire Extinguisher Co. *v.* Graham (1883), 16 Fed. Rep. 543; 24 O. G. 793.

§ 773. [1] That an assignee's rights cannot be greater than those of his assignor, see Gottfried *v.* Miller (1881), 10 Fed. Rep. 471.

That it will never be presumed that a grantor intends to grant what he has no right to grant, or that the grantee expects to receive what is already his, see Day *v.* Cary (1859), 1 Fisher, 424.

That where an assignor has any right at all to convey, his grant of all his rights will not be intended as attempting to include rights previously transferred by him, see Turnbull *v.* Weir Plow Co. (1874), 6 Bissell, 225; 7 O. G. 173; 1 Bann. & A. 544.

[2] That the rights of the assignee are governed by the assignment, see Hendrie *v.* Sayles (1878), 98 U. S. 546.

[3] That a grant should be construed to cover whatever is necessary to render it effective, see Hamilton *v.* Kingsbury (1878), 15 Blatch. 64; 14 O. G. 448.

That an assignment of an interest in an invention is a contract, and is to be construed so as to effect the intention of the parties, see Nicholson Pavement Co. *v.* Jenkins (1872), 14 Wall. 452; 5 Fisher, 491; 1 O. G. 465.

That parol evidence cannot vary an assignment unless there has been a mutual mistake, see Knowlton Platform & Car Coupling Co. *v.* Cook (1879), 70 Me. 143; Hammond *v.* Pratt (1879), 16 O. G. 1235; Ruggles *v.* Eddy (1872), 5 Fisher, 581; 10 Blatch. 52.

assignment before patent is protected by the subsequent conveyance of the legal title, both are to be interpreted together in ascertaining the extent of the interest assigned.[4]

§ 774. Assignment, its Implied Warranty of Title.

The terms of the conveyance are important, not only as a measure of the interest assigned but as an indication of the liability of the assignor upon his implied warranty of title. As will be seen hereafter, the assignment imports a covenant that the assignor has a good right to convey the interest therein described; and whenever this interest exceeds the interest which he could actually convey the assignee has an appropriate remedy for the breach of warranty.[1] Hence the significance of the interpretation put by the courts upon the language of the instrument in two classes of cases; one where it purports to convey the entire interest in the patented invention; the other where it is construed to cover only such interest as the assignor may himself possess.

§ 775. Assignment of "All Rights" in the Patented Invention Warrants a Perfect Title.

An assignment of all rights to the patented invention, in whatever language such rights may be described, transfers or attempts to transfer the entire interest covered by the patent. By it the assignor asserts himself to be the sole owner of the patented invention, free from all incumbrances created by any prior transfer. From it, if this assertion of the assignor be true, the assignee derives an exclusive title to the invention and to the monopoly; if not true, such ownership as the assignor possessed is vested in him together with a right of action on the implied warranty, or at his option the transfer may be treated as inoperative and void. Thus an assignment

[4] That where an assignment has been duly recorded, and a supplementary assignment is not recorded, both are to be construed together, see Littlefield *v.* Perry (1874), 21 Wall. 205; 7 O. G. 964.

That titles to patents are not to be overthrown on soluble doubts, see Blandy *v.* Griffith (1869), 3 Fisher, 609.

That in case of doubt the practical construction given to the contract by the acts of the parties may control, see Topliff *v.* Topliff (1887), 122 U. S. 121; 40 O. G. 115.

§ 774. [1] See §§ 783, 1232, and notes, *post*.

of "all the right" to the patented invention, or of the "exclusive right to make and sell" throughout the United States for the whole term of the patent, or with any equivalent words of description, purports to convey the entire interest in the patented invention,[1] and is justified only when the assignor has the unqualified ownership of all the rights created or protected by the patent.

§ 776. Assignment of "All My Rights" in the Patented Invention Implies no Warranty of Title.

An assignment of all the rights of the assignor in the patented invention, on the other hand, contains no implied averment as to the nature or scope of the interest conveyed.[1] Such an assignment will operate upon any ownership which may be vested in the assignor, and will transfer it to the assignee subject to any previous conveyances or contracts which the assignor or his predecessors may have made, whether these have created legal or equitable rights, and whether or not they are recorded.[2] An assignee under this form of con-

§ 775. [1] In Turnbull *v.* Weir Plow Co. (1880), 9 Bissell, 334, Drummond, J.: (336) "Where a man assigns all the right which was conveyed to him by letters-patent, the meaning is that the assignment takes with it everything that the letters-patent conveyed. It is certainly different from an assignment which declares merely that he assigns all the interest which he, at the time he makes the assignment, has in the letters-patent, provided, as in this case, he had previously assigned a part of the interest which he had to another person." 23 O. G. 91 (91); 14 Fed. Rep. 108 (110); 5 Bann. & A. 288 (290).

That the grant of "an exclusive right to make and sell" the invention "in the United States for the whole term of the patent" carries the entire interest in the invention, see Pickhardt *v.* Packard (1884), 23 Blatch. 23; 30 O. G. 179; 22 Fed. Rep. 530; Nellis *v.* Pennock Mfg. Co. (1882), 13 Fed. Rep. 451; 22 O. G. 1131; 15 Phila. 493.

That whether the form of a conveyance is that of an assignment or a license, if it transfers all rights under the patent it is an assignment, and the transferee may sue in his own name, see Siebert Cylinder Oil Cup Co. *v.* Beggs (1887), 32 Fed. Rep. 790.

§ 776. [1] That a conveyance of all my right, title, and interest does not import a warranty, see Turnbull *v.* Weir Plow Co. (1874), 7 O. G. 173; 6 Bissell, 225; 1 Bann. & A. 544.

That an assignment of "all my right" purports to cover only the right he then has, see Turnbull *v.* Weir Plow Co. (1880), 23 O. G. 91; 9 Bissell, 334; 5 Bann. & A. 288; 14 Fed. Rep. 108.

That a conveyance of the right, title, and interest in a patent "as fully as the same would have been enjoyed by me but for this assignment," is a mere quitclaim without warranty, see Gilmore *v.* Aiken (1875), 118 Mass. 94.

[2] That a conveyance of "all my right, title, and interest in and to" a

veyance is put upon his guard and is chargeable with notice of all facts which he might have ascertained by inquiring of the prior owners of the patented invention, or of any person claiming a right under the patent.[3] Where an assignment of this character has once been made, every one who derives his title through it is presumed to have received his ownership with the same knowledge of existing interests in others which is imputed to the original assignee, and one transferring such rights to another is not bound by any suppression of the truth by future owners or by their failure to disclose the actual condition of the title.[4]

§ 777. Assignment Transfers only the Invention Specifically Assigned.

The assignment of a patented invention operates only upon the invention covered by the patent. Other inventions owned by the same assignor, though related to the one assigned as modifications or improvements, and though essential to the practical employment of the one assigned, are not transferred by the conveyance.[1] Even when the assignment confers in

patent, though properly recorded, does not affect a territorial right previously conveyed, even if the prior conveyance is not recorded, see Turnbull *v.* Weir Plow Co. (1880), 23 O. G. 91; 9 Bissell, 334; 5 Bann. & A. 288; 14 Fed. Rep. 108; Turnbull *v.* Weir Plow Co. (1874), 6 Bissell, 225; 7 O. G. 173; 1 Bann. & A. 544.

[3] That the expression "right, title, and interest," in an assignment from a person holding under the patentee, is enough to put the assignee on inquiry and to charge him with notice of what he could have found out from the first grantor, see Hamilton *v.* Kingsbury (1880), 17 O. G. 847; 4 Fed. Rep. 428; 17 Blatch. 460.

That where an assignment refers to an invention as in use, such reference is an express notice to the assignee of such use, and of the claim of the licensee of the right to use, see Prime *v.* Brandon Mfg. Co. (1879), 16 Blatch. 453; 4 Bann. & A. 379.

[4] That an assignor of his "right, title, and interest" only is not bound by any suppression of truth on the part of his assignees, nor by their failure to disclose the true state of the title, see Hamilton *v.* Kingsbury (1880), 4 Fed. Rep. 428; 17 O. G. 847; 17 Blatch. 460.

See further as to implied warranty, §§ 783, 794, 1232, and notes, *post*.

§ 777. [1] That an assignment of one invention does not carry an interest in a different one, see Puetz *v.* Bransford (1887), 39 O. G. 1427; 31 Fed. Rep. 458.

That the assignment of all right, title, and interest in and to an improvement, conveys no interest in the original invention, see Leach *v.* Dresser (1879), 69 Me. 129.

That a conveyance under a specific

express terms upon the assignee a right to future improvements on the invention, it cannot affect an independent invention; nor can a general conveyance of the interest of the assignor in all his patents previously obtained create a title in the assignee to a subsequent improvement upon any one of the assigned inventions.[2] The invention transferred by the assignment to the assignee also remains in him distinct from any other invention which he may acquire. The meeting in a single person of the ownership of several patented inventions does not unite the inventions, nor confer upon their owner any rights which could not have been asserted by the several owners of the different patents.[3] Thus where the elements

patent confers no right to use improvements which have been invented since the date of such patent, although they were in existence at the date of the conveyance, see American Hide & Leather Splitting & Dressing Machine Co. *v.* American Tool & Machine Co. (1870), 4 Fisher, 284; Holmes, 503.

That the word "invention," in a contract for the assignment of a patent therein recited includes only the invention described in the patent and its renewals, not any other improvements, though the invention would be worthless without them, see United Nickel Co. *v.* American Nickel Plating Works (1878), 4 Bann. & A. 74.

[2] That an assignment of a patent with the right to the improvements to be made does not cover distinct inventions, see Stebbins Hydraulic Elevator Mfg. Co. *v.* Stebbins (1880), 17 O. G. 1348; 4 Fed. Rep. 445.

That an assignment of the assignor's interest in all patents previously obtained does not carry a subsequent invention of an improvement in one of these, see Hammond *v.* Pratt (1879), 16 O. G. 1235.

That where an agreement was made to sell two inventions, one only of which was patented, and the conveyance was duly made of the patent, and afterwards the other was patented, the conveyance was held to cover only the first patent, see Warren *v.* Cole (1867), 15 Mich. 265.

[3] In Washburn & Moen Mfg. Co. *v.* Griesche (1883), 5 McCrary, 246, Treat, J.: (249) "When, through several assignments, an individual becomes the owner of several distinct patents he can have no greater rights than his assignors respectively. He cannot claim that as no one of the assigned patents is specifically infringed, yet, if they are all considered, and some element of one is imported into another, and thus by patchwork a really new combination, unpatented, can be formed, therefore the defendant, who uses none of these patents, must be held to infringe. To infringe what? No existing patent. To illustrate: If A has a patent and B has a patent, and C infringes neither; and if A assigns his patent to D, and B does likewise, does C, by force of those assignments, become an infringer, when he infringes neither? 3 Fisher, 536; 16 Pet. 336; 15 Wall. 187; 1 Black, 427; id. 73; 2 Fisher, 89. In these, as in some other cases recently argued, there seemed to be an unexpressed, yet implied thought, that the assignment of different patents to a common assignee gave to the latter greater

of a combination are separately patented the assignee of all these patents does not become thereby the owner of the combination, nor can he use the elements combined without a license under the patent for the combination. Nor can the assignee of several patents lap one upon the other, and in this manner cover features of the invention which the patents in the hands of separate owners would not protect.

§ 778. Assignment Transfers only the Monopoly Created by American Patents: Its Effect on Foreign Patents.

But while the operation of an assignment is thus uniformly limited to the invention covered by the patent, the scope of the monopoly conveyed is not invariable. An inventor may secure for his invention one monopoly under his original American patent, another dependent on the first under each re-issue, a third still dependent on the first, but more distinct from it than a re-issue, under an extension, and others under foreign patents. In connection with the invention, he may assign any one or several of these concurrent or successive monopolies, and which will pass under a given conveyance depends upon the terms of the assignment and the presumptions of law. That an assignment of the invention carries one of these monopolies is evident, since the possession of prohibitory powers is essential to the effective ownership of the entire interest or any undivided part of the entire interest in a patented invention. Hence an assignment before patent creates an equitable title in the assignee to the original term of the future American patent, and if in due form and properly recorded it vests in him the legal title also when the patent is actually granted. Re-issues, being dependent on and superseding the original patent, likewise pass by such assignment unless the assignee prefers to hold his monopoly as created by the original patent.[1] An assignment during

rights than the respective patents conferred on their patentees; so that the assignee claiming under both could, by lapping one over the other, or incorporating parts of one into the other, obtain a right, unpatented, which neither of the assignors could separately maintain. No such doctrine can be accepted. Each patent must rest on its own merits alone. Munson *v.* Gilbert & Barker Mfg. Co., 3 Bann. & A. 595." 16 Fed. Rep. 669 (671).

§ 778. [1] That as far as an assignment of a patent is concerned, the re-

the original term has the same effect on the monopoly arising from the original or re-issued patent, the legal title thereto always vesting in the assignee. The monopolies created by foreign patents, having no legal existence in the United States and being controlled entirely as to their operation and assignment by foreign laws, are not affected by any transfer of the patented invention, or of the invention before patent, which can be recognized and sustained in this country as the conveyance of a monopoly. For this reason an assignment of an invention, whether before or after the issue of an American patent, does not transfer the monopoly created by a foreign patent, nor does the existence of a foreign patent at the date of the assignment preclude the assignee from claiming title to the monopoly arising under the patent granted by the United States.[2] An express provision in such assignment transferring foreign patents would at best be but a contract which equity could enforce against the assignor by compelling him to execute such instruments as, under the foreign law, would operate as a conveyance of the monopoly within the country for which it was granted.

§ 779. Effect of Assignment upon an Extension.

It being certain that in every case an assignment operates upon the original term of the American patent and upon its reissues, and that it never operates upon a foreign patent except by virtue of the laws of the country where the patent is in force, the only doubt which can arise in reference to the effect of an assignment upon the monopoly relates to an extension. An extension, when allowed by law, is intended for the benefit of the inventor.[1] It is permitted to him only on the

issue is part of the original patent and is covered by the assignment, see Littlefield *v.* Perry (1874), 21 Wall. 205; 7 O. G. 964.

That an assignee may accept or reject a re-issue as he pleases, see Littlefield *v.* Perry (1874), 21 Wall. 205; 7 O. G. 964.

[2] That the sale of the "invention" and all patents, present or future, while it is patented only under a foreign patent, carries not only that patent but subsequent American patents, see Emmons *v.* Sladdin (1875), 2 Bann. & A. 199; 9 O. G. 352.

§ 779. [1] That an extension is for the benefit of the inventor, see *Ex parte* Baker (1872), 1 O. G. 632; Case *v.* Redfield (1849), 4 McLean, 526; 2 Robb, 741.

That no extension will be granted if the assignees are to reap the entire

ground that his inventive skill has not received a sufficient reward during the original term, and that this insufficiency is not due to his own fault or neglect.[2] It was not provided as a recompense to the assignees for the devotion of their capital or their business energies to the development of the invention and the distribution of its practical results among the public.[3] Thus an extension can be obtained by the inventor alone, if living, or by his administrator or executor after his death.[4] At the same time, the possibility of an extension adds to the value of the invention even before the original patent has been issued; and if he then is able to transfer it, and obtain a higher price on that account, he indirectly receives the recompense which the extension was intended to bestow. Hence the law recognizes his right to transfer this monopoly as well as any other,[5] only requiring that, as a simple assignment of the invention is satisfied by the passage of the original term, an instrument which is to operate upon the extension must expressly and unequivocally include it.[6] The presumption as to any given assignment is that it does not refer to the extension; and therefore, if its words can be construed to relate only to the original term and the re-issues, the assignment will be limited to these monopolies. Thus an assignment of all the assignor's right, title, and interest "during the term for which a patent may be granted;" or a conveyance of "all the patents which the grantor now has, or has in contemplation to obtain;" or a transfer of "all my right and title to the patent and the invention thereby secured;" or the assignment before patent of all the rights "I

benefit, see *Ex parte* Munger (1873), 3 O. G. 323; *Ex parte* Baker (1872), 1 O. G. 632.

See also § 836 and notes, *post*.

[2] See Sec. 18, act of 1836.

[3] That the extension of a patent does not enure to the benefit of an assignee of the original term, see Wilson *v.* Rousseau (1846), 4 How. 646; 2 Robb, 372.

[4] See Sec. 18, act of 1836; also Woodworth *v.* Wilson (1846), 4 How. 712; 2 Robb, 473; Woodworth *v.* Sherman (1844), 3 Story, 171; 2 Robb, 257.

[5] See § 770 and cases cited, *ante*.

[6] That the assignment of a patent during the original term, or before the patent issues, does not carry the extension unless there are express words to that effect, see Hendrie *v.* Sayles (1878), 98 U. S. 546; Gibson *v.* Cook (1850), 2 Blatch. 144; Case *v.* Redfield (1849), 4 McLean, 526; 2 Robb, 741; Phelps *v.* Comstock (1848), 4 McLean, 353; Brooks *v.* Bicknell (1845), 4 McLean, 64; Woodworth *v.* Sherman (1844), 3 Story, 171; 2 Robb, 257.

now have, or by letters-patent should be entitled to have," to the invention "to the full extent to which the same could be enjoyed by me but for this assignment," and providing for the issue of the patent to the assignee "as the owner of the whole right and title" to the invention; or a conveyance of "the patent" or of the "invention" after the patent has been granted,—have all alike been held to operate upon the original term and the re-issues only, for want of words which necessarily included the extension.[7] On the other hand it has been said that an assignment before patent of "the invention" without any restrictions, or an assignment of "the invention and of all rights that may from time to time be

[7] That a conveyance, during the original term, of all right, title, and interest during "the term for which letters-patent are or may be granted" does not carry an extension, see Gear *v.* Grosvenor (1873), 3 O. G. 380; Holmes, 215; 6 Fisher, 314.

That an assignment of the "right, title, and interest" in letters-patent about to be issued does not carry an extension, see Johnson *v.* Wilcox & Gibbs Sewing Mach. Co. (1886), 23 Blatch. 531; 27 Fed. Rep. 689.

That the grant of all patents which the grantor "now has or has in contemplation to obtain," does not carry an extension, see Wetherell *v.* Passaic Zinc Co. (1872), 2 O. G. 471; 6 Fisher, 50; 9 Phila. 385.

That an assignment by the patentee of all his right and title to the patent and to the invention thereby secured does not cover the extension, see Waterman *v.* Wallace (1875), 13 Blatch. 128; 2 Bann. & A. 126.

That an assignment, before a patent is granted, of all the right "I now have or by letters-patent would be entitled to have" in the invention, "to the full extent to which the same could be enjoyed by me but for this assignment," and providing for the issue of the patent to the assignee, "as the owner of the whole right and title" to the invention, does not cover an extension, for want of words showing an intention to convey a future interest, see Mowry *v.* Grand St. & Newtown R. R. Co. (1872), 10 Blatch. 89; 5 Fisher, 586.

That an assignment of the "patent" does not carry the extension, see *Ex parte* Holmes (1873), 4 O. G. 581.

That the assignment of an "invention" after a patent issues is the grant only of the current term, see Waterman *v.* Wallace (1875), 13 Blatch. 128; 2 Bann. & A. 126.

That an assignment of the "invention" does not carry the extension, unless expressly so stated, see *Ex parte* Holmes (1873), 4 O. G. 581.

That the "term for which letters-patent may be granted" in the *habendum* is to be construed by the rest of the deed, and usually includes nothing except re-issues, see Jenkins *v.* Nicholson Pavement Co. (1870), 4 Fisher, 201; 1 Abbott, 567.

That a contract by the patentee in 1829 that his assignee shall have the benefit of all renewals, covers only re-issues, and not extensions, in the hands of the administrator, extensions being unknown to the law at the date of the contract, see Wilson *v.* Rousseau (1846), 4 How. 646; 2 Robb, 372.

secured," or of "the invention to the full end of the term for which a patent may be granted," or of "all patents and renewals" or of "the invention as now secured by letters-patent," and "to the full end of the term for which letters-patent are or may be granted," or a conveyance by the owner of the right to an extension of "all my rights" in the invention, — transferred the patentee's rights to the monopoly under the extension, and imposed on him the obligation to obtain the extension, if possible, and by a proper instrument convey it to his assignee.[8] These illustrations show how comprehensive the language of an assignment may be, and yet not operate upon the extension; and also that no special form of words is necessary in order to convey it. In all cases the question is one of intention; and the interpretation put upon the instrument in this respect must be governed by its entire provisions, and by the circumstances of the contracting parties and the object they endeavored to effect. The assignee is presumed to know what rights to an extension may eventually vest in the assignor, and how such an extension would affect his own use and enjoyment of the invention; and he must either protect himself by the insertion of such provisions into the assignment as will secure to him the monopoly under the extension, as well as under the original patent, or abide by the presumption of the law that the right to the extension remains in the inventor.[9]

[8] That the assignment of an "invention" without any restrictions carries all future patents for it, see Emmons *v.* Sladdin (1875), 2 Bann. & A. 199; 9 O. G. 352.

That a conveyance of an "invention" and "of all rights that may from time to time be secured" carries an extension, see Railroad Co. *v.* Trimble (1870), 10 Wall. 367.

That an assignment of the "invention" "to the full end of the term for which a patent may be granted" covers an extension, see Nicholson Pavement Co. *v.* Jenkins (1872), 14 Wall. 452; 1 O. G. 465; 5 Fisher, 491.

That an assignment of patents and renewals carries extensions, see Union Mfg. Co. *v.* Lounsbury (1864), 42 Barb. 125; Goodyear *v.* Cary (1859), 4 Blatch. 271; Wilson *v.* Turner (1845), Taney, 278.

That an assignment of "the invention as secured by letters-patent" and "to the full end of the term for which letters-patent are or may be granted" carries the extension also, see Ruggles *v.* Eddy (1872), 5 Fisher, 581; 10 Blatch. 52.

That where an assignor owns a right to the extension, his conveyance of "all his right," etc., will carry the extension, see *Ex parte* Mason (1872), 1 O. G. 357.

[9] In Brooks *v.* Bicknell (1845), 4

§ 780. Single Assignment may Transfer Several Patented Inventions.

An assignment by the owner of several patents may include one or more or all of them, as the parties may desire; though, to avoid confusion on the records, a separate conveyance for each patent is desirable. When such an instrument describes each patent by its date and number, the subject-matter of the assignment is evident. A general assignment of all such patents as the assignor "has in his own right" is, however, valid, and will transfer all patents of which he is the apparent owner, or part-owner, though not those which he holds in trust for others.[1]

McLean, 64, *per Curiam:* (67) "The assignment transferred only the interest expressed on its face. No right, beyond the term named in the original patent, was conveyed by the assignment, unless so specified. But it is said that the assignee had ground to expect, when the patent expired, that he, in common with others, would have a right to use it; and that to deny him this right would be unjust. When he purchased the patent, in whole or part, he knew, or at least must be presumed to have known, that the patent could be renewed by Congress, and as a prudent man, he should have provided for such a contingency, in his contract of assignment, and what, under a renewal, would be a just provision in behalf of the assignee. For the time of the patent, he has not only had the right to use the machine, but to sell the invention to others. Now, no hardship results to the assignee from the renewal, unless he has a machine in operation which is necessarily suspended by the extension of the patent. The assignee could not claim, on any supposed ground of hardship, anything beyond the use of the machine or machines he may have in operation at the time of the renewal of the patent. But, under the construction claimed for the assignee, he not only takes the use of the machine, if the assignment was a general one, but the entire beneficial interest in the renewed patent. Such a construction is in direct opposition to the declared intention of the act."

That where a patentee agrees to sell a right under an extension, and the buyer pays part of the purchase-money, but refuses to pay the rest, this does not, *ipso facto*, cancel the contract, since it is part executed, though a court of equity would decree cancellation of it in terms, see Gibson *v.* Barnard (1848), 1 Blatch. 388.

See further as to the assignment of an extension, §§ 412, 770, and notes, *ante*, and § 844 and notes, *post*.

§ 780. [1] That the grant of such patents only as the grantor "has in his own right" does not include such as he holds for the benefit of others, but does include those in which he has only a part interest, see Wetherell *v.* Passaic Zinc Co. (1872), 2 O. G. 471; 6 Fisher, 50; 9 Phila. 385.

That a trade-mark used to designate patented articles is assignable with the patent, see Julian *v.* Hoosier Drill Co. (1881), 78 Ind. 408.

§ 781. Assignment of Patented Invention Does not Transfer Rights of Action for Past Infringements.

An assignment carries no right to sue for past infringements, unless so expressed.[1] These are injuries against the former owners of the patent, for which they have their remedy. Like other choses in action, the right to pursue this remedy can be transferred to the assignees of the invention, as well as to any other parties; but it is not embraced in the ownership either of the invention or the monopoly, and hence requires distinct words of conveyance. The assignment of an expired patent, however, being of no effect as an alienation of a patented invention for want of any existing subject-matter, may take effect upon those rights of action which alone remain, and be valid as a power of attorney to enforce them.[2] A conveyance *pendente lite* does not affect the litigation; but the judgment binds the parties to the assignment, according to the nature of the interests involved.[3]

§ 782. Effect of Assignment upon Existing Licenses and Powers of Attorney.

An assignment of the entire interest of the assignor in a patented invention revokes all his revocable licenses and terminates all his previous powers of attorney, unless the as-

§ 781. [1] That an assignment of a whatsoever which the estate has in, to, by, under, and through" letters-patent, carries rights of action for past infringements, see May *v.* County of Logan (1887), 30 Fed. Rep. 250; 41 O. G. 1387.

See further as to assignment of rights of action, §§ 790, 943, and notes, *post.*

[2] That the assignment of an expired patent may be good as a power of attorney to collect damages for past infringements, but not otherwise, see Bell *v.* McCullough (1858), 1 Bond, 194; 1 Fisher, 380.

[3] That a conveyance *pendente lite* does not affect the litigation, see Campbell *v.* James (1880), 18 O. G. 1111; 18 Blatch. 92; 2 Fed. Rep. 338.

patent does not cover claims for past infringements, unless so expressed, see Kaolatype Engraving Co. *v.* Hoke (1887), 30 Fed. Rep. 444; 39 O. G. 589; May *v.* Juneau Co. (1887), 30 Fed. Rep. 241; 41 O. G. 578; New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co. (1883), 21 Blatch. 519; 25 O. G. 1076; 18 Fed. Rep. 638; Merriam *v.* Smith (1882), 11 Fed. Rep. 588.

That an assignment of a patent by an administrator under order of court does not carry the right of action for past infringements, see May *v.* Juneau Co. (1887), 41 O. G. 578; 30 Fed. Rep. 241.

That the assignment of all "right, title, interest, claims, and demands

signee by continuing to recognize them as still in force estops himself from denying their validity.[1] The assignment of an undivided part of the entire interest creates a joint ownership in the invention and the monopoly, the proportion of each co-owner being determined by the provisions of the assignment. The relation sustained by these co-owners toward each other, and the rights of each as to the enjoyment of the patented invention, will be considered in a separate section.[2]

§ 783. Assignment for Valuable Consideration Implies a Warranty of Title, and a Right to Assign: Express Warranties.

From the assignment of a patented invention for a valuable consideration a warranty of title to it, and of a right to assign it according to the terms of the assignment, is implied by law.[1] This warranty grows out of the sale itself, not out

§ 782. [1] That the conveyance of a patent revokes all revocable licenses, see Shaw *v.* Colwell Lead Co. (1882), 20 Blatch. 417; 11 Fed. Rep. 711.

That where a patent and all future improvements are assigned to one person, and subsequently an agreement is made by the assignor with another not to interfere with his manufacture, and after this an improvement is made and patented and assigned to the first assignee, the latter may enforce this new patent against the promisee under the agreement, see Troy Iron & Nail Factory *v.* Corning (1852), 14 How. 193.

That where the patentee sells to a corporation, and having obtained a reassignment for the purpose of procuring an extension secures his extension and secretly licenses to others before he assigns back to the corporation, it is a fraud upon the corporation and the licensee acquires no rights, see Consolidated Fruit Jar Co. *v.* Mason (1877), 7 Daly, 64.

That an assignee of an interest in a patent, after a license is granted and while it is running, cannot compel the licensee to account to him separately for his share of the royalties, see Bergmann *v.* Macmillan (1881), L. R. 17 Ch. D. 423.

That the sale of a patent terminates all previous powers of attorney, see Labarce *v.* Peoria, Pekin, & Jacksonville R. R. Co. (1877), 3 Bann. & A. 180.

That assignees of a patent who allow a power of attorney to remain and permit others to act on it may be bound by it, see Labaree *v.* Peoria, Pekin, & Jacksonville R. R. Co. (1877), 3 Bann. & A. 180.

That where an entire invention is assigned before the application and the attorney has received his power from the inventor alone, the power must be ratified by the assignee, or a new attorney must be appointed, see *Ex parte* Ackerman (1880), 17 O. G. 1036.

[2] See §§ 795–799, and notes, *post*.

§ 783. [1] That in the sale of a patent there is always an implied warranty of title, see Faulks *v.* Kamp (1880), 3 Fed. Rep. 898; 17 O. G. 851; 17 Blatch. 432; 5 Bann. & A. 73; Sher-

of the instrument by which the conveyance is effected.[2] It draws after it any subsequently acquired title of the assignor which may be necessary to make his former transfer valid, and confers upon the assignee a right to damages wherever the interest actually vested in him by the assignment is less than that which it purports to convey.[3] Express covenants of warranty may also be inserted in the assignment. These bind the assignor according to their terms, and may wholly or in part supersede the implied warranty.[4] From a conveyance of all the assignor's right, title, and interest in the invention no warranty of title is implied. Such a conveyance passes the rights then vested in the alienor, whatever they may be, but imposes no obligation upon him, either on account

man *v.* Champlain Transportation Co. (1858), 31 Vt. 162.

That the sale of a patent right not only implies a warranty of title to it but a right to sell it, see Faulks *v.* Kamp (1880), 17 O. G. 851; 3 Fed. Rep. 898; 17 Blatch. 432; 5 Bann. & A. 73.

[2] That the warranty of title grows out of the sale itself, not out of the form of the conveyance, see Faulks *v.* Kamp (1880), 3 Fed. Rep. 898; 17 O. G. 851; 17 Blatch. 432; 5 Bann. & A. 73.

[3] That the warranty implied in the sale of a patent right draws after it any after acquired title of the vendor which may be necessary to make the sale effective, see Faulks *v.* Kamp (1880), 3 Fed. Rep. 898; 17 O. G. 851; 17 Blatch. 432; 5 Bann. & A. 73.

That the assignee may recover damages for the breach of warranty, see §§ 1229–1232, and notes, *post.*

[4] That there is no implied warranty in the sale of a patent that the patent is valid, see Hiatt *v.* Twomey (1836), 1 Dev. & Bat. Eq. (N. C.) 315.

That in the sale of a patent it is doubtful whether there is any implied warranty of validity where all is done in good faith, and both parties are assignees and are equally ignorant and limantic Linen Co. (1866), 33 Conn. 436.

That the conveyance of such inventions "as I have a patent right for" does not warrant that the vendor has a valid patent right, see Bull *v.* Pratt (1815), 1 Conn. 342.

That a subscriber for a share in a patent right, paying nothing and signing only as an inducement to lead others to subscribe, does not warrant to them the validity of the patent or the value of the invention, but they run their own risks, see Lane *v.* Smith (1878), 68 Me. 178.

That an agreement to protect the sales of the vendee from suits for infringements on other patents is a warranty that the article does not infringe other patents, see Croninger *v.* Paige (1880), 48 Wis. 229.

That a covenant of warranty is valueless when the property warranted does not exist, see Bliss *v.* Negus (1811), 8 Mass. 46.

That if the instrument conveying the patent contains no warranty, the vendee cannot set up a parol warranty, see Joliffe *v.* Collius (1855), 21 Mo. 338.

of a defect in his existing title or in respect to any title he may subsequently acquire.[5]

§ 784. Assignment to be Recorded: Record Constructive Notice.

For the protection of all persons subsequently becoming interested in the patented invention, the law requires that an assignment shall be recorded in the Patent Office within three months after the date of its execution.[1] During these three months the subsequent alienee must protect himself by such investigation as he is able to make, and runs his own risk of a defective title through the timely recording of a prior assignment.[2] But after three months without record the prior conveyance becomes invalid as against his later transfer, except in cases where he has actual notice of its existence.[3] The record of the title to a patented invention, as it appears in the Patent Office, is thus conclusive in favor of all *bona fide* purchasers of any interest in the invention who have no other knowledge of the state of the title than that which the record furnishes, and against all unrecorded assignees whose title dates more than three months before the subsequent title is acquired.[4] But such a record is not necessary to

[5] See § 776 and notes, *ante*.

§ 784. [1] Sec. 4898, Rev. Stat. "An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof."

See also Turnbull *v.* Weir Plow Co. (1874), 6 Bissell, 225; 1 Bann. & A. 544; 7 O. G. 173; Gibson *v.* Cook (1850), 2 Blatch. 144.

[2] In Gibson *v.* Cook (1850), 2 Blatch. 144, Nelson, J.: (148) "In order 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 in the best way he can, as an unrecorded prior assignment would prevail; but it must be an assignment in writing, that may be recorded within the time limited."

[3] That an assignment is not valid against innocent parties, unless recorded, see Boyd *v.* McAlpin (1844), 3 McLean, 427; 2 Robb, 277; Higgins *v.* Strong (1836), 4 Blackf. (Ind.) 182.

That the law requiring a record of assignments, etc., is for the protection of *bona fide* purchasers without actual notice, see Turnbull *v.* Weir Plow Co. (1874), 6 Bissell, 225; 7 O. G. 173; 1 Bann. & A. 544.

That an assignment duly recorded protects the assignee in all his rights as against a subsequent assignee, see Aspinwall Mfg. Co. *v.* Gill (1887), 32 Fed. Rep. 697.

That actual notice to a subsequent purchaser is equivalent to record, see Peck *v.* Bacon (1847), 18 Conn. 377; and cases cited in note 5, *post*.

[4] That the record of the patent and itsassignments in the Patent Office is notice to all the world, and every one

render an assignment valid as between the assignor and those claiming under him, or between the assignee and any person having actual notice.[6] The record, though made after

is chargeable with such knowledge as the search of the records would convey, see National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 28 O. G. 1007 ; 19 Fed. Rep. 514 ; Newell *v.* West (1875), 13 Blatch. 114 ; 8 O. G. 598 ; 9 O. G. 1110 ; 2 Bann. & A. 113.

That the assignee of a patent may rely on the record title, see Campbell *v.* James (1880), 18 Blatch. 92 ; 18 O. G. 1111 ; 2 Fed. Rep. 338 ; Secombe *v.* Campbell (1880), 2 Fed. Rep. 357 ; 18 Blatch. 108.

That the title of an assignee of record, derived from an assignor of more than six months ownership, cannot be attacked on the ground of fraud in the assignor, see Racine Seeder Co. *v.* Joliet Wire Check Rower Co. (1886), 27 Fed. Rep. 367 ; 37 O. G. 452.

That an assignment must be recorded before the assignee can sue on the patent, see Wyeth *v.* Stone (1840), 1 Story, 273 ; 2 Robb, 23.

That the Commissioner must be governed by the record title to the patent and cannot regard mere equitable claims, see *Ex parte* Edison (1875), 7 O. G. 423.

[6] In Perry *v.* Corning (1870), 7 Blatch. 195, Woodruff, J. : (201) "It is sufficient to say that as against a purchaser in good faith, for value, without notice of any prior assignment, an assignment not recorded within the time limited in the act is not valid, and will not affect his rights acquired from the patentee before such record is made ; and that, on the other hand, the instrument, though not recorded, is a perfectly valid instrument, and effectual according to its purport, as against the assignor and all others except third persons who, in good faith, for value, without notice, become purchasers or acquire rights or interests in or under the patent."

In Pitts *v.* Whitman (1843), 2 Story, 609, Story, J. : (615) "Now, it is observable that there are no words in this enactment which declare that the assignment, if not recorded, shall be utterly void ; and the question, therefore, is whether it is to be construed as indispensable to the validity of an assignment that it should be recorded within the three months, as a *sine qua non*, or whether the statute is merely directory for the protection of purchasers. Upon the best reflection which I have been able to bestow upon the subject, my opinion is that the latter is the true interpretation and object of the provision." 2 Robb, 189 (196).

Further, that an unrecorded assignment is valid between the parties, see Horne *v.* Chatham (1885), 64 Tex. 36 ; Maurice *v.* Devol (1883), 23 W. Va. 247 ; Turnbull *v.* Weir Plow Co. (1874), 7 O. G. 173 ; 6 Bissell, 225 ; 1 Bann. & A. 544 ; Moore *v.* Bare (1860), 11 Iowa, 198 ; Sone *v.* Palmer (1859), 28 Mo. 539 ; Black *v.* Stone (1858), 33 Ala. 327 ; Hildreth *v.* Turner (1855) 17 Ill. 184 ; McKernan *v.* Hite (1855), 6 Ind. 428 ; Louden *v.* Burt (1853), 4 Ind. 566 ; Case *v.* Redfield (1849), 4 McLean, 526 ; 2 Robb, 741 ; Peck *v.* Bacon (1847), 18 Conn. 377.

That an assignment though not recorded is good, except against creditors and subsequent *bona fide* purchasers, see Holden *v.* Curtis (1819), 2 N. H. 61.

That one who knows of a prior unrecorded assignment cannot be a *bona fide* purchaser, see Ashcroft *v.* Walworth (1872), 2 O. G. 546 ; Holmes, 152 ; 5 Fisher, 528.

That an assignment though unre-

three months have elapsed, affords constructive notice to all persons acquiring interests in the invention subsequently to the date of record.[6]

§ 785. Record of Unrecordable Instrument not Constructive Notice.

The law provides for the recording of three instruments only: an assignment before patent when the patent is to issue to the assignee, either alone or jointly with the inventor; an assignment after patent; and a grant.[1] The record of no other instrument than these affords constructive notice, although if thus brought to the knowledge of any person it may become as to him individually an actual notice of whatever rights the instrument purports to convey.[2] Thus an

corded is good against all who have est, could be recorded, see Sec. 11, 1836, actual notice, see Maurice *v.* Devol (1883), 23 W. Va. 247; Ashcroft *v.* Walworth (1872), 5 Fisher, 528; Holmes, 152; 2 O. G. 546; Continental Windmill Co. *v.* Empire Windmill Co. (1871), 4 Fisher, 428; 8 Blatch. 295.

That it has been doubted whether actual notice of an unrecorded grant would bind subsequent assignees, see Perry *v.* Corning (1870), 7 Blatch. 195, and cases there cited.

That a prior unrecorded assignment is good against subsequent assignees without value, see Saxton *v.* Aultman (1864), 15 Ohio St. 471.

[6] That the rule requiring an assignment to be recorded within three months is directory only, the record being good between the parties whenever it is made, see Brooks *v.* Byam (1843), 2 Story, 525; 2 Robb, 161.

That the record of an assignment is notice to subsequent purchasers, see Case *v.* Redfield (1849), 4 McLean, 526; 2 Robb, 741.

§ 785. [1] That under the act of 1836 only an assignment of the whole or a part of the entire interest in an existing patent, or a grant of a territorial interand Brooks *v.* Byam (1843), 2 Story, 525; 2 Robb, 161.

That under the act of 1870 and the Revised Statutes an assignment before patent may also be recorded, see Sec. 33, 1870, and Sec. 4895, Rev. Stat.

That Sec. 4895, Rev. Stat., does not provide for recording assignments of unpatented inventions, unless the patent is to issue to the assignee, and if recorded, such record is not notice to any one, see Wright *v.* Randel (1881), 21 O. G. 493; 19 Blatch. 495; 8 Fed. Rep. 591.

That the conveyance of a right to use within a limited territory need not be recorded, see Stevens *v.* Head (1837), 9 Vt. 174.

That under Sec. 5046, Rev. Stat. an assignment by the bankrupt court to the assignee need not be recorded in the Patent Office, see Prime *v.* Brandon Mfg. Co. (1879), 16 Blatch. 453; 4 Bann. & A. 379.

[2] That the record of an instrument which the law does not require to be recorded is not constructive notice of anything to any person, see Wright *v.* Randel (1881), 19 Blatch. 495; 8 Fed. Rep. 591; 21 O. G. 493; Hamilton *v.*

assignment before patent, unaccompanied by a request that the patent issue to the assignee, although recorded in due season, cannot prevail over a subsequent assignment with such request to a *bona fide* assignee for value, but the latter will receive the patent and can enforce it against the former.[3] The record of an assignment of a right of action under a patent, for the same reason, is not constructive notice to the party against whom such action lies.[4]

§ 786. Relation of Legal and Equitable Titles Arising from Assignments.

Through the operation of these rules concerning the record of assignments, as well as by the other methods before noticed, the legal and equitable titles to a patentable invention may become separated from each other and vest in different owners, or an equitable title as against certain individuals may be created in one party while both the legal and equitable titles, as against all the world, may reside in another. Where, for example, an inventor assigns his invention before the granting of a patent, and then procures the issue of a patent in his own name, the assignment not containing a request for it to issue to the assignee, the legal title

Kingsbury (1879), 17 Blatch. 264 ; 17 O. G. 147.

That an agreement to assign a patent is not a recordable instrument, and if recorded does not amount to notice, see N. Y. Paper Bag Mach. Co. *v.* Union Paper Bag Mach. Co. (1887), 32 Fed. Rep. 783.

The record of a recordable instrument is constructive notice to all persons, whether cognizant of the record or not. But a person, having actual knowledge that any instrument is on record is put on inquiry as to all facts which the instrument suggests and which a reasonable search might ascertain, whether or not the instrument is in itself properly recordable. Thus that where some papers which the law does not require to be recorded are recorded while others are not, a party who acts upon those recorded, in ignorance of the latter, is still bound by them as if also known, being put on inquiry by those recorded, see Hamilton *v.* Kingsbury (1879), 17 Blatch. 264 ; 17 O. G. 147.

[3] That an unrecorded assignment, or an assignment before patent not requesting the issue of the patent to the assignee though put on record, cannot avail against a subsequent *bona fide* legal title to the patent, and such subsequent assignee may have the patent issued to him and hold it against the former, see Wright *v.* Randel (1881), 19 Blatch. 495 ; 8 Fed. Rep. 591 ; 21 O. G. 493.

[4] That an assignment of a right of action need not be recorded, see Gear *v.* Fitch (1878), 16 O. G. 1231 ; 3 Bann. & A. 573.

vests in the inventor and the equitable title in the assignee.[1] Or where a party, having knowledge of the existence of a prior unrecorded assignment, after the time limited for recording it takes an assignment to himself and places it on record, he holds the legal title to the patented invention though the equitable title belongs to the former alienee.[2] In these cases, and in all others where the legal and equitable titles are severed from each other, chancery will regard the holder of the legal title as a trustee for the equitable owner, and compel him to execute such conveyances and perform such other acts as equity may require.[3] But where a legal and equitable title meet in the same person, these will prevail over all other merely equitable titles unless their equity is

§ 786. [1] That an assignment of the patent privilege, before the patent issues, is a contract to assign the patent when issued, and creates an equitable title to the patent in the assignee although the patent issues to the inventor, see Aspinwall Mfg. Co. *v.* Gill (1887), 40 O. G. 1133; United States Stamping Co. *v.* Jewett (1880), 7 Fed. Rep. 869; 18 Blatch. 469; 18 O. G. 1529; Hammond *v.* Pratt (1880), 16 O. G. 1235; Littlefield *v.* Perry (1875), 21 Wall. 205; 7 O. G. 964; Newell *v.* West (1875), 13 Blatch. 114; 8 O. G. 598; 9 O. G. 1110; 2 Bann. & A. 113; Troy Iron & Nail Co. *v.* Corning (1852), 14 How. 193; Gayler *v.* Wilder (1850), 10 How. 477.

That where a patent issues to an inventor after its assignment to another with a request that it issue to the assignee, the legal title vests in the assignee, upon his recording of the assignment, see United States Stamping Co. *v.* Jewett (1880), 7 Fed. Rep. 869; 18 Blatch. 469; 18 O. G. 1529; and other cases cited in § 769, notes 4 and 5, *ante*.

[2] That an assignee of record, taking his assignment with notice of prior unrecorded conveyances, acquires at most the legal title only, while the equitable title resides in the former assignees, see Maurice *v.* Devol (1883), 23 W. Va. 247; Ashcroft *v.* Walworth (1872), 5 Fisher, 528; 2 O. G. 546; Holmes, 152; Perry *v.* Corning (1870), 7 Blatch. 195; and other cases cited in § 784, notes 3 and 5, *ante*.

[3] That chancery will compel the holder of the legal title to do whatever may be required to protect the interests of the owner of the equitable title, see Hapgood *v.* Rosenstock (1885), 23 Blatch. 95; 23 Fed. Rep. 86; and cases cited in § 769, note 6, *ante*, and § 1228 and notes, *post*.

That where the absolute owner of a patent conveys it to joint trustees, with full discretionary powers, they cannot act otherwise than jointly, and their sole contracts are void, see Wescott *v.* Wayne Agricultural Works (1882), 11 Fed. Rep. 298.

That contract right may be protected in equity by enjoining the patentee from violating it, even though a specific performance cannot be decreed, see Goddard *v.* Wilde (1883), 17 Fed. Rep. 845.

That the sale of the invention, and the patent or extension to be thereafter obtained for it, with covenants of quiet enjoyment, gives an equitable interest in the patents so obtained, and the

superior to his.[4] Thus when an assignment before patent, unaccompanied by a request that the patent issue to the assignee, is followed by another assignment to a *bona fide* assignee for value containing such request, which being duly recorded secures the patent to the later assignee, the legal title vests in him by the issue of the patent, and the equities being equal he can hold the patented invention against the equitable title of the former assignee.[5] Or where, during the time limited for placing an assignment upon record, another *bona fide* purchaser obtains a title which he could enforce in chancery against his assignor, the due recording of the previous assignment enables the assignee in whom the legal and the equitable titles both inhere to vindicate them against any claim that may be set up by the later alienee.[6] The legal title is shown by the patent itself, as granted and assigned by proper instruments duly recorded.[7] Equitable titles may

patentee will be a trustee for the vendee, see Emmons *v.* Sladdin (1875), 9 O. G. 352; 2 Bann. & A. 109.

[4] That the legal title to a patent will prevail over the equitable, unless the legal owner had notice of the equities, see Davis Wagon Wheel Co. *v.* Davis Wagon Co. (1884), 20 Fed. Rep. 699; 22 Blatch. 221; and cases cited in § 769, note 5, *ante*.

That notice to individual stockholders of an outstanding equitable title is not notice to the corporation, see Davis Wagon Wheel Co. *v.* Davis Wagon Co. (1884), 22 Blatch. 221; 20 Fed. Rep. 699.

[5] That an assignment before patent with request that the patent issue to the assignee, if recorded, gives superior title to that of prior assignees of a prior patent, with contract to assign all future inventions of which this is one, provided the second assignment is *bona fide* and without notice, see Wright *v.* Randel (1881), 8 Fed. Rep. 591; 19 Blatch. 495; 21 O. G. 493.

That a subsequent *bona fide* purchase for value prevails over any mere contract to sell a future term, see Gibson *v.* Cooke (1850), 2 Blatch. 144; and cases cited in § 769, note 5, *ante*.

That where an inventor assigns a patent with the interest in a new invention made by him, and afterward assigns the new invention to others and requests the patent to issue to them, which latter assignment is recorded and the patent so issued, these latter assignees may hold the new invention against the former assignee, see Wright *v.* Randel (1881), 21 O. G. 493; 19 Blatch. 495; 8 Fed. Rep. 591.

[6] That an assignee, recording his assignment within the period prescribed by law, prevails over all intervening assignees, whether with or without notice of his assignment, see Gibson *v.* Cook (1850), 2 Blatch. 144.

[7] That the legal title to a patent is shown by the patent as granted and assigned, whatever equitable rights any mere contracts may create, see Graham *v.* McCormick (1880), 5 Bann. & A. 244; 10 Bissell, 39; 21 O. G. 1583; 11 Fed. Rep. 859.

That title by grant of letters-patent

rest upon contracts to convey, which are unrecordable, or upon recordable conveyances where record has been unlawfully delayed.[8] The parties having power in all cases to secure their rights by making proper conveyances and recording them in compliance with the law, the hardship which results from the extinguishment of merely equitable ownerships by those in which the legal and the equitable titles both unite must be attributed to their own negligence, rather than to the legal doctrine by which these respective rights are regulated and preserved.

§ 787. Assignor Estopped to Deny Validity of Patent or Title of Assignee.

The assignor of a patented invention is estopped from denying the validity of the patent or his own title to the interest transferred.[1] He cannot become the owner of an older patent

is title of record, see *Ex parte* Osgood (1885), 33 O. G. 1265.

That an assignment in trust gives the assignee a legal title, see Campbell *v.* James (1879), 17 Blatch. 42; 18 O. G. 979; 4 Bann. & A. 456.

[8] That a contract to assign creates only an equitable interest, see Gibson *v.* Cooke (1850), 2 Blatch. 144; Park *v.* Little (1813), 3 Wash. 196; 1 Robb, 17; and cases cited in § 769, note 5, and § 771, note 4, *ante*.

That an equitable title may rest on unrecorded conveyances, see note 2, *ante*.

§ 787. [1] That an assignor is estopped to deny the validity of the patent, see American Paper Barrel Co. *v.* Laraway (1886), 28 Fed. Rep. 141; 37 O. G. 674; Underwood *v.* Warren (1884), 21 Fed. Rep. 573; Time Telegraph Co. *v.* Carey (1884), 22 Blatch. 34; 26 O. G. 826; Consolidated Middlings Purifier Co. *v.* Guilder (1881), 9 Fed. Rep. 155; 3 McCrary, 186; Faulks *v.* Kamp (1880), 5 Bann. & A. 73; 17 O. G. 851; 17 Blatch. 432; 3 Fed. Rep. 898; Onderdonk *v.* Fanning (1880), 4 Fed. Rep. 148. See § 1021 and notes, *post*.

That parties subsequently becoming interested with the assignee are bound by the same estoppel, see Time Telegraph Co. *v.* Carey (1884), 22 Blatch. 34; 26 O. G. 826.

That an assignor is estopped to deny his own right to convey the patent, see Faulks *v.* Kamp (1880), 17 O. G. 851; 5 Bann. & A. 73; 17 Blatch. 432; 3 Fed. Rep. 898; *Ex parte* Edison (1875), 7 O. G. 423.

That a patentee is not estopped to deny the validity of his patent as against an assignee of his own trustee in bankruptcy, see Cropper *v.* Smith (1881), L. R. 26 Ch. D. 700; 10 App. Cas. 249.

That the estoppel operates against the assignor in favor of the assignee though the patent be invalid or the title void as against all the world beside, see Curran *v.* Birdsall (1883), 20 Fed. Rep. 835; 27 O. G. 1319.

That where a member of an infringing firm was formerly a part-owner of the patent, he is estopped from denying its validity unless he conveyed his interest to the plaintiff without considera-

for the same invention and hold it against his assignee, nor can he practise the invention contrary to the provisions of his assignment, and when sued for infringement set up in his defence the invalidity of the patent or his own inability to convey it.[2] On the contrary, if the patent be in fact invalid, and the assignor obtains a valid patent for the same invention, the valid patent enures to the benefit of the assignee, except where his assignment covered only the then existing rights of the assignor.[3] In the same manner the assignee is estopped

tion, see Parker *v.* McKee (1885), 32 O. G. 137.

That a plaintiff cannot deny the existence of a company through which he derived title, see Bogart *v.* Hinds (1885), 33 O. G. 1268.

That a patentee is estopped from denying the validity of the patent or its re-issues in a suit against him by his assignee, though the re-issues were granted after the assignment, and the assignee ought to have known that they were void, see Burdsall *v.* Curran (1887), 42 O. G. 1107; 31 Fed. Rep. 918.

That an applicant is estopped to deny his deed of assignment, see *Ex parte* Edison (1875), 7 O. G. 423.

[2] That a patentee having sold his patent cannot buy in an older patent and thus defeat his assignee's rights, even if the older patent be manifestly superior to his, see Rumsey *v.* Buck (1884), 20 Fed. Rep. 697; Curran *v.* Burdsall (1883), 27 O. G. 1319; 20 Fed. Rep. 835.

That where an assignor is co-owner of an older and superior patent, the assignee of the junior patent becomes the licensee of the other co-owners, and these must look to the assignor for their compensation, see Curran *v.* Burdsall (1883), 27 O. G. 1319; 20 Fed. Rep. 835.

That where an assignor agreed to stop making the invention and paid a license fee to the assignee for the privilege of selling what he had on hand, he cannot deny the validity of the patent in a suit against him by the assignee for infringement by making and selling after the assignment under new letters-patent, see Consolidated Middlings Purifier Co. *v.* Guilder (1881), 9 Fed. Rep. 155; 3 McCrary, 186.

That a party who clothes another with the legal title to a patent, and confers upon the assignee the power to determine who shall take its benefits, is estopped to complain of fraud on the ground that another is not allowed to share in it, see Racine Seeder Co. *v.* Joliet Wire Check Rower Co. (1886), 27 Fed. Rep. 367; 37 O. G. 452.

See as to infringements by assignors § 914 and notes, *post*.

[3] That where the grantor of a patent afterwards acquires a patent for the same invention, the latter enures to the benefit of his grantee, see Faulks *v.* Kamp (1880), 5 Bann. & A. 73; 17 Blatch. 432; 17 O. G. 851; 3 Fed. Rep. 898.

That if the title of the vendor is invalid at the time of the sale, a title afterwards acquired by him will enure to the benefit of the vendee, see Sherman *v.* Champlain Transportation Co. (1858), 31 Vt. 162.

That where one of two joint-patentees obtains a sole patent for the same invention, after the assignment of the joint patent, the sole patent vests in the assignees, see Kohler *v.* Kohler (1888), 43 O. G. 247.

That where an assignor grants to

from denying the validity of the patent, and of the title conferred upon him by the assignor, if he has taken and still enjoys the benefits of the assignment.[4] Where by the terms of the assignment he becomes liable to the assignor for royalties on sales or for a share in the profits made by him from the use of the invention he cannot, in an action of account brought by the assignor for their recovery, defend upon the ground that the invention was unpatentable, or the patent void, or the assignor without a title which he could convey.[5] Nor can he purchase an outstanding claim against the assignor and hold it as a set-off against the amount due according to the terms of his assignment.[6] But where an assignee, on discovering the defects in the patent or the title, repudiates the assignment and relinquishes its benefits, the estoppel is no longer operative upon him.[7]

one person, and afterwards to another without warranty, and then again becomes the owner of the rights of the first grantee, the second grant becomes effective by estoppel, see Littlefield *v.* Perry (1874), 21 Wall. 205 ; 7 O. G. 964.

That a title may be acquired by estoppel against an inventor who permits third parties to deal with his invention as if it were their own, see National Feather Duster Co. *v.* Hibbard (1881), 11 Bissell, 76 ; 21 O. G. 635 ; 9 Fed. Rep. 558.

That an estoppel *in pais* cannot turn into a first and original inventor one who is not so, but can merely divert the patent from the inventor to an equitable assignee or defeat it altogether, see Swift *v.* Rochow (1880), 17 O. G. 450.

See further as to the estoppel of the assignor §§ 981, 1046, and notes, *post.*

[4] That an assignee of a patent who has derived profits under it is estopped from denying its validity in an action for an account, see Swift *v.* Rochow (1880), 17 O. G. 450.

See also §§ 1238, 1239, and notes, *post.*

[5] That an assignee cannot defend against a claim for royalties on the ground of fraud in the assignor, if he has received all the benefits of the assignment, see Shaw *v.* Soule (1884), 20 Fed. Rep. 790.

That an assignee manufacturing on terms cannot deny the validity of the patent when called to an account, see Kinsman *v.* Parkhurst (1855), 18 How. 289.

[6] That an assignee cannot purchase of a third person a claim against the patentee and set it up against him on an account rendered in pursuance of an agreement to manufacture, see Kinsman *v.* Parkhurst (1855), 18 How. 289.

[7] That a recital in a conditional contract of assignment that "the vendor is the owner of the patent," is not an estoppel on the purchaser, if the contract is rescinded before it takes effect, see Swift *v.* Rochow (1880), 17 O. G. 450.

See further as to the general doctrine of estoppel upon assignees and licensees, §§ 820, 1238, 1239, 1251, 1252, and notes, *post.*

§ 788. Assignments upon Condition: Reversionary Interests of Assignor.

An assignment may be made upon condition, or for a term less than the entire duration of the patent, and thus reversionary interests may be created in the assignor.[1] These interests he can protect according to their nature, enforcing the conditions and maintaining actions, legal or equitable, as the case requires.[2] After the termination of his interest in the invention, whether by forfeiture for breach of condition or by lapse of time, the assignee can neither license others to practise it, nor in any other manner limit the rights now vested in the assignor.[3]

§ 788. [1] That unless an assignment is unconditional the assignor has rights which he can protect, see Cook *v.* Bidwell (1881), 20 O. G. 1083; 8 Fed. Rep. 452.

That as long as the conditions of a conditional assignment are not fulfilled, the assignor has a reversionary interest, see Otis Bros. Mfg. Co. *v.* Crane Bros. Mfg. Co. (1886), 27 Fed. Rep. 550.

That an assignment for a term of years leaves a reversionary interest in the assignor, which he can protect, see Still *v.* Reading (1881), 20 O. G. 1025; 9 Fed. Rep. 40; 4 Woods, 345; Cook *v.* Bidwell (1879), 20 O. G. 1083; 8 Fed. Rep. 452.

That whether an assignment on condition subsequent has been defeated is a question for the courts, not for the Patent Office, see Hammond *v.* Pratt (1880), 16 O. G. 1235.

[2] That where a patent is sold with a condition of reconveyance, the condition may be enforced, see Andrews *v.* Fielding (1884), 20 Fed. Rep. 123.

That where the assignee of a patent fails to carry out the purpose for which it has been assigned to him, and the contract provides for a reverting of the patent in such case to the assignor, it will so revert, see Buckley *v.* Sawyer Mfg. Co. (1881), 7 Fed. Rep. 358; 2 McCrary, 350.

That any person taking title from a conditional assignee with notice of the conditions is bound by them, see Werderman *v.* Société Générale d'Électricité (1881), L. R. 19 Ch. D. 246.

That where the inventor agrees with a capitalist to develop an invention, and each party is to use due diligence, and the patent is to revert to the inventor if the capitalist is in fault, no reverter will be decreed if both are in fault, and the inventor has been remunerated, see Buckley *v.* Sawyer Mfg. Co. (1881), 2 McCrary, 350; 7 Fed. Rep. 358.

That where the owner of a patent, having assigned the exclusive right to make and sell, excepting the right to sell in a certain place, and reserving to himself the personal right to make and sell anywhere, and having transferred to the assignee the right to sue infringers and take the proceeds of the suits, afterwards sells the patent to one who knows of this assignment and its terms, the assignee can enjoin the vendee from making and selling, except in the particular place excepted, see Haygood *v.* Rosenstock (1885), 23 Blatch. 95; 23 Fed. Rep. 86.

[3] That after an assignment has been forfeited by breach of condition, the assignee can grant nothing either by way of license or otherwise, see Abbett *v.* Zusi (1879), 5 Bann. & A. 38.

§ 789. Assignees: when Bound by Prior Acts of Assignors.

The privity which exists between the assignor of a patented invention and his assignees renders them subject to the legal consequences of all his prior acts of which they have actual or constructive notice or of which such notice is presumed.[1] They are concluded, equally with himself, by judgments rendered against him before the assignment, and receive their interests subject to all the equities of which they have knowledge.[2] If their title accrues pending an interference, they are bound by its results to the same extent that the assignor would have been had the assignment not been made.[3] But private conduct or admissions of the assignor, of which his assignees could have obtained no information or were not bound to make inquiry, do not thus affect them.[4] Acts subsequent to the assignment cannot prejudice their rights.

§ 789. [1] That an assignee takes the patent subject to all the legal consequences of the inventor's prior acts, see Worley *v.* Tobacco Co. (1881), 104 U. S. 340; 21 O. G. 559; McClurg *v.* Kingsland (1843), 1 How. 202; 2 Robb, 105.

That an assignee of the interest of another assignee takes no more than his grantor had, and is chargeable with notice of what he might have learned if he had inquired of the original grantor, as against a later assignee of the original grantor, see Hamilton *v.* Kingsbury (1880), 17 Blatch. 460; 17 O. G. 847; 4 Fed. Rep. 428.

[2] That the assignee of a patent is concluded by a decree against his assignor, see Pennington *v.* Hunt (1884), 20 Fed. Rep. 195; and §§ 983, 1017, 1048, and notes, *post.*

That an assignee takes subject to the assignor's disclaimers, and other acts working an estoppel, see Blades *v.* Rand, McNally, & Co. (1886), 27 Fed. Rep. 93; 37 O. G. 99.

That where an assignee assigns his rights, his assignee is bound by all the equities of which he has knowledge, see Kinsman *v.* Parkhurst (1855), 18 How. 289.

[3] That a purchaser who buys an interest in an invention during an interference is bound by the rule of *caveat emptor*, see *Ex parte* Mason (1872), 2 O. G. 274.

That under Sec. 58, act of 1870, an assignee is not estopped by the patentee's statement in an interference proceeding as to the date of his invention, see Union Paper Bag Mach. Co. *v.* Crane (1874), 1 Bann. & A. 494; 6 O. G. 801; Holmes, 429.

That a concession as to priority does not affect prior assignees, see Hammond *v.* Pratt (1880), 16 O. G. 1235.

That the rights of an assignee against a rival inventor are the same as those of his assignor, see Gay *v.* Cornell (1849), 1 Blatch. 506.

[4] That an assignee for valuable consideration is not bound by a prior unrecorded equitable claim of which he had no notice, see Campbell *v.* James (1880), 18 Blatch. 92; 18 O. G. 1111; 2 Fed. Rep. 338.

That whether assignees without notice are estopped by the conduct of the

§ 790. Assignment of Right of Action for Past Infringements.

The right to sue for past infringements may be assigned in connection with an assignment of the patent, like any other chose in action, and the remedy can be enforced in law or equity by the assignee.[1] Such an assignment may be made after a suit has been commenced, in which case the defendant must be notified thereof before proceeding further in the cause.[2] No especial form is required for such assignment. An irrevocable power of attorney to collect the claims, or an instrument purporting to assign the patented invention, but executed after the patent has expired, are regarded as sufficient for this purpose.[3] Such an assignment is not legally recordable.[4]

inventor, *quere*, see Sprague *v.* Adriance (1877), 3 Bann. & A. 124; 14 O. G. 308.

That a purchaser, pending a suit to which he is a party, takes subject to the equities of the other parties to the suit, see Kearney *v.* Lehigh Valley R. R. Co. (1886), 27 Fed. Rep. 699.

§ 790. [1] That the right to sue for the infringement of a patent is assignable, see Shaw *v.* Colwell Lead Co. (1882), 11 Fed. Rep. 711; 20 Blatch. 417; Hamilton *v.* Rollins (1877), 5 Dillon, 495; 3 Bann. & A. 157.

That the assignment of a share in the proceeds of suits for infringements creates no interest in the invention or the monopoly, see Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628.

That a right of action for infringement survives to personal representatives and may be sued on or assigned by them, and the assignee may sue thereon in his own name if the local law permits, see May *v.* County of Logan (1887), 30 Fed. Rep. 250; 41 O. G. 1387.

That an assignment by an administrator of all rights under or through an expired patent carries claims for past infringements, see May *v.* Saginaw Co. (1887), 32 Fed. Rep. 629.

That a sale of patents by an administrator under order of court for a nominal sum does not carry a right to sue for past infringements, see May *v.* Juneau Co. (1887), 30 Fed. Rep. 241; 41 O. G. 578.

That an assignment of a claim for the use of an invention is not an assignment of the patent, see Campbell *v.* James (1880), 18 Blatch. 92; 18 O. G. 1111; 2 Fed. Rep. 338.

That an assignee of claims for past infringements takes subject to all equities, see New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co. (1883), 21 Blatch. 519; 25 O. G. 1076; 18 Fed. Rep. 638.

[2] That when a right of action is assigned after a suit is brought, the defendant should be notified of it, see Gear *v.* Fitch (1878), 3 Bann. & A. 573; 16 O. G. 1231.

[3] That an assignment of an expired patent can take effect only as an assignment of claims for past infringements, see May *v.* Saginaw Co. (1887), 32 Fed. Rep. 629.

That the assignment of an expired patent may operate as a power of attorney to sue for and collect damages for past infringements, see Bell *v.* McCullough (1858), 1 Bond, 194; 1 Fisher, 350.

[4] That an assignment of the right

§ 791. Grant Defined: Distinguished from Assignment.

The grant of a patented invention differs from an assignment only as to the territorial limits within which it operates. It differs from a license as to the nature of the rights conveyed. The grantee has the exclusive interest both in the invention and in the monopoly, within the prescribed limits, and may maintain an action in his own name for an infringement of the patent within his territory. A licensee has either a non-exclusive interest or an interest in less than all the rights embraced in the invention, and no interest in the monopoly which he can make effective by a suit at law in his own name. To distinguish, therefore, an assignment from a grant it is only necessary to determine whether the conveyance is of force throughout the entire United States or is confined to a particular locality.[1] It matters not whether the restrictions are in positive or negative terms. An instrument transferring all the rights secured by the patent, except as to a certain town or county, is as true a grant as if the area lying outside of such town or county were specifically described.[2]

§ 792. Grant Distinguished from License.

To distinguish a grant from a license, regard must be paid to the nature of the interest conveyed. The interest must be

to maintain suits need not be recorded, see Gear *v.* Fitch (1878), 16 O. G. 1231; 3 Bann. & A. 573.

See further as to an assignment of a claim for past infringements, § 781 and notes, *ante*, and § 943 and notes, *post*.

§ 791. [1] See § 763, note 1, *ante*.

[2] That the transfer of the entire interest in the invention within specified territory is a grant, see Potter *v.* Holland (1858), 4 Blatch. 206; 1 Fisher, 327; Ritter *v.* Serrell (1852), 2 Blatch. 379.

That the transfer of all the patentee's interest in a given territory is a grant, see Perry *v.* Corning (1870), 7 Blatch. 195.

That an assignment of all rights "except certain counties already sold" is valid and certain, since evidence may show what counties have been sold, see Washburn & Moen Mfg. Co. *v.* Haish (1880), 19 O. G. 173; 10 Bissell, 65; 4 Fed. Rep. 900.

That the grant of a State-right "except 14 counties," with an agreement to furnish a list of such counties, leaves the grantee free to select them until the list is furnished, see Pryor *v.* Coulter (1830), 1 Bailey (S. C.), 517.

That when a territorial assignee sells his "right to use and sell" as mentioned in the patent, it carries his entire rights, see Burdell *v.* Denig (1865), 2 Fisher, 588.

entire within the prescribed area, and exclusive.[1] A transfer of the right to make or use or sell, or of the exclusive right to make or use or sell, does not convey the entire interest; the grant must operate on all three of these rights, and be exclusive as to all; and a transfer which does not thus operate is a mere license. But these rights need not be particularly described in the conveyance, if it manifests an evident intention of the grantor to transfer them. An alienation of all the rights mentioned in the patent is an assignment or a grant according to the territorial limits fixed by the conveyance.[2]

§ 793. Grants upon Condition.

A grant, like an assignment, may be conditional or temporary. It may also be limited as to the extent of its enjoyment. The grant of an exclusive right to make and use and sell a certain number of the patented devices within the prescribed territory, and of the exclusive use of the invention within such territory, is a valid grant, conferring upon the grantee the sole interest in the invention and monopoly in that area, and yet restricting him in its enjoyment to the number of the articles described.[1] Limits may also be placed to his mode

§ 792. [1] In Littlefield *v.* Perry (1874), 21 Wall. 205; 7 O. G. 964, the Supreme Court seem to recognize the grant of an undivided interest within a certain territory as valid and proper. The statute on which the power to transfer the monopoly depends, however, makes no provision for the conveyance of any rights within a specified area unless such rights are exclusive. Sec. 4898, Rev. Stat.: "The patentee . . . may in like manner grant and convey an exclusive right under his patent to . . . any specified part of the United States." See also Potter *v.* Holland (1858), 4 Blatch. 206; 1 Fisher, 327; Gayler *v.* Wilder (1850), 10 How. 477. A non-exclusive right must, therefore, be an interest in the invention as distinguished from the monopoly, — that is, a mere license, unless a grant of an undivided interest could be construed as making the grantee and grantor co-grantees, in whom the entire and exclusive sectional interest resided.

[2] That an assignment of all the patentee's right, title, and interest within certain territory is the grant of an exclusive right, see Perry *v.* Corning (1870), 7 Blatch. 195; Burdell *v.* Denig (1865), 2 Fisher, 588.

That an exclusive right for a term of years to use the invention in a given territory, and to use and sell the product of such use, is a mere license, not a grant, see Oliver, Finnie & Co. *v.* Rumford Chemical Works (1883), 109 U. S. 75; 25 O. G. 784.

§ 793. [1] That the grant of an exclusive right to make, use, and sell a cer-

of using the invention, or to the sale of it or of its products outside of his territory ; the conveyance is still a grant unless the enjoyment thus denied to the grantee is reserved to the grantor or vested in some other alience.[2] His right is no less exclusive for being limited in exercise, provided it resides in him alone. But in the absence of such restrictions the grantee may enjoy the rights to make and use and sell within his district as fully as the patentee could have done, and the products which arise out of his practice of the invention may be used by his vendees in any portion of the United States.[3]

tain number of the patented devices within a certain territory, and of the exclusive use of the patent in such territory, vests an exclusive territorial interest in the grantee, see Ritter *v.* Sorrell (1852), 2 Blatch. 379.

[2] That a grant of specific territory may be limited as to the mode of use and yet be valid, see Dorsey Revolving Harvester Rake Co. *v.* Bradley Mfg. Co. (1874), 12 Blatch. 202 ; 1 Bann. & A. 330.

[3] That an assignee of a territorial right, without restrictions, may sell the patented device to be used anywhere, see Hatch *v.* Hall (1884), 30 O. G. 1096 ; 22 Fed. Rep. 438 ; McKay *v.* Wooster (1873), 2 Sawyer, 373 ; 6 Fisher, 375 ; 3 O. G. 441.

That such an assignee cannot sell the device to have it sold again or used in the course of trade outside his territory, see Hatch *v.* Adams (1884), 22 Fed. Rep. 434 ; 29 O. G. 776.

See also §§ 824, 914, and notes, *post.*

That where the patentee grants a territorial right to make, use, and sell without limiting the use by the vendee, the vendee of the grantee may use the invention anywhere without reference to other grants of the patentee, see Adams *v.* Burke (1873), 17 Wall. 453 ; 33 O. G. 114.

That a grantee cannot make outside his own territory, for use outside it, see American Paper Barrel Co. *v.* Laraway (1880), 28 Fed. Rep. 141 ; 37 O. G. 674.

That an assignment, by the assignee of an exclusive right to make and use the invention within a given territory, exhausts his own interests within that territory, and he has no right to make up the invention and put it into the market, to be used after the patent expires, contrary to the rights of the patentee on the extension, see Union Paper Bag Mach. Co. *v.* Nixon (1876), 9 O. G. 691 ; 2 Bann. & A. 244 ; 1 Flippin, 491.

That the assignor of a territorial right cannot sell the device in that territory or to be used in that territory, see Union Paper Bag Mach. Co. *v.* Nixon (1876), 2 Bann. & A. 244 ; 9 O. G. 691 ; 1 Flippin, 491.

That the reservation by an assignor of the right to use the invention in one of several assigned States does not affect the assignee's rights in the other States, see Hobbie *v.* Smith (1886), 27 Fed. Rep. 656.

That an agreement that the grantee only should manufacture is not void as being in restraint of trade, see Kinsman *v.* Parkhurst (1855), 18 How. 289.

§ 794. Form of Grant: Implied Warrantios: Estoppels.

A grant, like an assignment, must be in writing and duly signed by the grantor.[1] It must also be recorded within the same period in order to avail against subsequent *bona fide* assignees and grantees for value.[2] It imports a warranty of title, and gives rise to the same estoppel and the same privities of interest and obligation as an assignment.[3] Having in view the essential difference between them, the rules which have been stated as regulating and applying to the one form of conveyance may be predicated, *mutatis mutandis*, of the other.

SECTION II.

OF THE TRANSFER OF LETTERS-PATENT: JOINT-OWNERS.

§ 795. Property of Joint-Owners in the Patented Invention.

By the assignment of an undivided interest in a patented invention, the alienor and alienee become joint-owners both of the invention and the monopoly. On account of the peculiar nature of this species of property, the relations of such joint-owners toward each other present questions of difficulty, not all of which can be considered as yet fully settled. Property in an invention, as well as property in a monopoly, is incorporeal. It is incapable alike of physical partition, and of united physical possession. The subordinate rights embraced in the invention may indeed be separated, and be

§ 794. [1] Sec. 4898, Rev. Stat.

[2] Sec. 4898, Rev. Stat. See also § 784 and notes, *ante*.

That a conveyance of "all my right, title, and interest in and to" a patent, though recorded, does not affect territorial rights previously conveyed by the grantor, but not recorded, see Turnbull *v.* Weir Plow Co. (1880), 14 Fed. Rep. 108; 9 Bissell, 334; 23 O. G. 91; 5 Bann. & A. 288.

[3] That an assignment of "all our right, title, and interest" in certain territory "to the full end of the term," etc., is not a mere release, but implies that a patent has been issued in due form, and if this is not true the price is not recoverable, see Shepherd *v.* Jenkins (1881), 73 Mo. 510.

That if a grantee avails himself of the grant, he cannot, in a suit for royalties on goods sold, deny that the patentee is the true inventor, unless he has been evicted, see Birdsall *v.* Perrigo (1865), 5 Blatch. 251.

hold by different owners, but the monopoly is indivisible, and whether it resides in many individuals, or in one alone, must be of the same character and limits. When, therefore, a patented invention, which includes both the invention and the monopoly, vests in two or more persons their relations to each other as co-owners must follow one of three rules: either (1) each owner must individually possess all the subordinate rights embraced in the invention together with the entire and indivisible monopoly; or (2) he must individually possess the rights embraced in the invention while the monopoly resides entire and indivisible in all the owners collectively; or (3) the rights embraced in the invention as well as the monopoly must vest indivisibly in all the owners as a single person. The first rule might be pronounced untenable upon its face had not the courts, ignoring the fact that the right to suspend prohibitory powers is as true a part of the monopoly as is the right to enforce them, already held with tolerable uniformity that each joint-owner may, at his pleasure, abrogate the monopoly both as against himself and his co-owners, — a position which assumes that the monopoly is indivisibly and entirely his to destroy, if not to exercise. The second rule, and probably the correct one, has as yet received no formal recognition except, perhaps, indirectly in cases where one joint-owner has been held liable to his co-owners for an infringement of their common patent. The third rule has been repeatedly discarded by the courts, and it may be accepted as an established doctrine that whatever may be their relation to the monopoly such joint-owners are not co-partners, nor collective owners of the invention, but that their interests therein are distinct, each being independent of the others, though subject to the limitations imposed upon its disposition and enjoyment by the monopoly conferred on his co-owners.[1]

§ 795. [1] In Pitts *v.* Hall (1854), 3 Blatch. 201, Hall, J.: (206) "In the case of joint-patentees, where no agreement of co-partnership exists, the relation of co-partners certainly 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

§ 796. Reciprocal Rights and Duties of Joint Owners in reference to the Enjoyment of the Patented Invention.

According to the second rule the monopoly resides in the co-owners collectively, and can neither be abrogated nor 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 right and interest; and at common law the one had no action of account against the other for his share of the profits derived from the common property. (Story on Partnership, § 89.) A personal chattel vested in several different proprietors cannot possibly be enjoyed advantageously by all, without a common consent and agreement among them. To regulate their enjoyment in case of disagreement is one of the hardest tasks of legislation, and it is not without wisdom that the law of England and of this country, in general, declines to interfere in their disputes, leaving it to themselves either to enjoy their common property by agreement or to suffer it to remain unenjoyed or to perish by their dissension, as the best method of forcing them to a common consent for their common benefit. (Abbott on Shipping, 98.) It is well settled that a destruction or sale of the joint property by one of the part owners, authorizes his co-proprietor to maintain trover for the conversion. (2 Kent's Comm., 8th ed., 351, note.) But on such a sale only the right of the party who makes the sale passes to the purchaser; and the purchaser becomes a tenant in common with the owner of the remaining interest, unless and until the latter confirms the sale, or recovers the value of his share from the wrong-doer. The principles of these doctrines are, it strikes me, applicable to the case of the joint-ownership of patent rights. The grant of the exclusive right to make, use, and vend to others to be used, is to the patentees jointly and not to either severally. The right, the property secured by the patent, may be granted to others by license or assignment, or by the sale of machines by the patentees jointly; and a license or assignment or sale of a machine by them is a transfer, *pro tanto*, of the property secured by the patent. One joint-owner can legally grant, assign, license, or sell only in respect to his own share or right. He cannot sell and give a good title to his co-owner's right, for the same reason that one joint-owner of a chattel cannot transfer the share of his co-proprietor. And if he appropriates any portion of the exclusive right or common property to his separate use or benefit, by either the use or the sale of the patented machine, he does what is, in principle, the same as the conversion, by destruction or sale, of the joint property by a tenant in common, which authorizes his co-tenant to maintain trover."

That joint-owners of a patented invention are tenants in common, see Dunham *v.* Indianapolis & St. Louis R. R. Co. (1876), 7 Bissell, 223; 2 Bann. & A. 327; De Witt *v.* Elmira Nobles Mfg. Co. (1875), 5 Hun, 301.

That there is no true analogy between patent rights and any other property, and co-owners are not like tenants in

suspended without the consent of all, while each joint-owner individually possesses the subordinate rights embraced in the invention. This rule at once preserves the harmony of the law in reference to the nature and ownership of a monopoly, protects the exclusive privilege conferred by the patent upon all the patentees, and permits to each owner as wide a latitude in the enjoyment of the invention as is consistent with the rights of his co-owners. Under it each may himself practise the invention without accountability to them, and may convey his entire interest in the patented invention to another individual; since the exercise of such powers does not interfere with the enjoyment of their equal privileges by the other owners, nor with that security from competition which the patent is intended to afford. But it forbids an assignment of the interest of one joint-owner to several assignees, or the grant of licenses to make, or use, or sell the patented invention, because by multiplying the number of those persons who can practise the invention without disturbance from the exercise of the monopoly, the value of the patented invention to the other owners may be sensibly diminished and perhaps destroyed. In the few cases hitherto decided the courts, by partially adopting the first rule, have indeed recognized this power as inherent in each owner of the patented invention. They have held that his right to alienate his own interest to others is unlimited in respect to the number of his transferees; that by such transfer the entire monopoly is abrogated or suspended so that his assignees and licensees cannot be interfered with by the other owners of the prohibitory powers; and that, at most, he is accountable to them for their proportion of the purchase-money or license-fees which he may have received.[1] It is obvious that under this rule the other own-

common of lands, or ways, or tolls, or personal property, see Vose *v.* Singer (1862), 4 Allen, 226.

That a joint interest in a patent does not make the owners partners, see Parkhurst *v.* Kinsman (1849), 1 Blatch. 488.

That there may be any number of joint-owners, and each will be independent of the others, and not a co-partner, see Vose *v.* Singer (1862), 4 Allen, 226.

That the issue of a patent to one of two joint-owners of an invention enures to the benefit of both, see Vetter *v.* Lentzinger (1871), 31 Iowa, 182.

§.796. [1] In Dunham *v.* Indianapolis & St. Louis R. R. Co. (1876), 7 Bissell, 223, Drummond, J.: (223) "The material point is, who is to answer, if any one, to the other patentees for the use of the part which does not belong to

ors do not obtain adequate protection. Those who desire to use their property by practising the invention are at the

them, when a joint-owner uses the improvement, or makes a contract with another person for its use. What is the position of patentees with reference to their right to use the thing patented? The patentees are tenants in common of the right. One of them has no superiority of right over the others. One of them can manufacture and use the article patented without the consent of the others; that is, each has the same right, although one may own a greater share of the thing patented than the others. The grant was, in this case, to the three to use and vend the improved car-brake shoes, and while it is clear that one of the patentees cannot grant what does not belong to him, and if he gives a license or makes a contract for the use of the thing patented, he can only grant that which he has himself, and not the rights of the other patentees, still he can clothe his grantee or his licensee with the same right that he has himself, namely, the right to sell or use the thing patented. And it seems to me the better rule is to hold, if there is a liability at all, that where a party owning less than the whole of a thing patented, makes a grant or a license, he shall be answerable to the others, rather than that the other patentees shall look to the grantee or licensee. There were three cases particularly referred to on the argument. One was the case of Pitts *v.* Hall, 3 Blatchford, 201, decided by Judge Hall, of the Northern District of New York. He seems to hold that if one joint-owner of a patent uses or sells his right without the authority of his co-owner, he is liable to an action by such co-owner for an infringement of the patent; and the conclusion, perhaps, to be drawn from his decision is that if the party to whom he sells uses the thing patented, an action could be maintained and an injunction issued against the grantee or licensee of the co-owner. Judge Curtis, in the case of Clum *v.* Brewer, 2 Curtis, Circuit Court, 506, seems to hold, and I think that is the true rule upon the subject, that where one of the joint-patentees uses or sells the thing patented, or any portion of it, the others cannot sue him as for an infringement of the patent. The most that can be claimed is that if one uses or sells it to the detriment of the others, he may be held responsible. For example, if he obtains more than his share of the profits from the use of the article, or in issuing licenses he obtains more than his share of the license money, he possibly may be held responsible by the other joint-patentees; but Judge Curtis, in that case, held that an injunction should not issue against the use, by one of the joint-patentees, of the thing patented, and the principle decided by him is that one tenant in common of letters-patent has the same right as the others to make, use, and sell the thing patented, and a licensee under one tenant in common cannot be enjoined on a bill by another tenant in common. A case has been decided in England bearing on this question, Mathers *v.* Green, 1 Law Reports, Chancery Appeals, 29, and the opinion is given by Lord Chancellor Cranworth. That was a case of letters-patent granted to three individuals. The Chancellor says: 'The right conferred is a right to exclude all the world other than the grantees from using the invention. But there is no exclusion in the letters-patent of any one of the patentees. The inability of any one of the patentees to use the invention, if any such inability exists, must be sought elsewhere than in the letters-patent. But there is

mercy of those whose profit is derived from selling rights or granting licenses to others; and as each owner may fix

no principle, in the absence of contract, which can prevent any persons not prohibited by statute from using any invention whatever. Is there any implied contract where two or more persons jointly obtain letters-patent, that no one of them shall use the invention without the consent of the others, or, if he does, that he shall use it for their joint benefit? I can discover no principle for such a doctrine. It would enable one of two patentees either to prevent the use of the invention altogether, or else to compel the other patentee to risk his skill and capital in the use of the invention on the terms of being accountable for half the profit, if profit should be made, without being able to call on his co-patentee for contribution if there should be loss.' Now while this is the principle announced by the Chancellor, it perhaps should be with this qualification, — that if one of the patentees obtains more than his share of the profits, he might be held liable under certain circumstances to the others. Certainly I do not wish to be understood as affirming that there is never such liability. Of course we must take into consideration any risk which he may run, any outlay of money which he may make in the manufacture or sale of the article; but if, looking at it upon equitable principles, he has obtained more than his share of the profits arising from the thing patented, either in the use or sale of it, or of licenses, it seems to me he might in certain cases be held accountable to the other joint patentees." 2 Bann. & A. 327 (328).

See also Clum *v.* Brewer (1855), 2 Curtis, 506.

That one co-owner cannot be obliged to account to the other for the mere use of the invention or for profits arising from its use, see Fraser *v.* Gates (1885), 118 Ill. 99; Gates *v.* Fraser (1881), 9 Bradwell (Ill.), 624.

That a surviving partner who uses a patent belonging to the late firm, against the objection of the representative of the deceased partner, is liable to account to such representative for one half the profits resulting from such use, see Freeman *v.* Freeman (1886), 142 Mass. 98.

That a part owner may be accountable to his co-owners for a share of the profits obtained by him from using the invention or selling rights, see Aspinwall Mfg. Co. *v.* Gill (1887), 40 O. G. 1133; 32 Fed. Rep. 697.

That whether one co-owner can compel another to account for one half the license fees, etc., received by him is doubtful, see Gates *v.* Fraser (1881), 9 Bradwell (Ill.), 624.

That each co-owner of a patent may use the right without the concurrence of the others and license at will, see Washburn & Moen Mfg. Co. *v.* Chicago Galvanized Wire Fence Co. (1884), 109 Ill. 71.

That a license by one co-owner is good against all, and their remedy is by account against him, see De Witt *v.* Elmira Nobles Mfg. Co. (1876), 66 N. Y. 459.

That one joint-owner cannot compel another to account for a share of his profits from a sale of the patented articles, see Vose *v.* Singer (1862), 4 Allen, 226.

That where one of several joint-patentees assigns to a third party, the estoppel against him operates as a license to the third party, and the other patentees must look to the assignor for an account, see Curran *v.* Burdsall (1883), 27 O. G. 1319; 20 Fed. Rep. 835.

his own price on the rights or licenses he grants, his liability to account to his co-owners for their share affords them no security of proper compensation. This rule seems to have been reached by treating property in a patented invention as analogous to property in a personal chattel, and endeavoring to apply to one the principles which govern the ownership of the other. If the sole property in a patented invention consisted in the right to practise it, some remote analogy to property in a personal chattel might exist. But the actual value of the property in a patented invention resides in the monopoly, by virtue of which its owners can not only prevent the use of a single personal chattel but of all others which are substantially identical with it in character. The right to practise the invention cannot be conferred without affecting these prohibitory powers, and no rule which ignores them, and permits the transfer of the invention without reference to its effect on them, can meet the requirements of the case. The second rule is far more just, and more in accordance with the nature of the subject, and in closer analogy to the rules applied to the joint-ownership of certain incorporeal rights to which those of the co-owners of a patented invention bear the nearest but by no means a perfect resemblance. It restricts the power of alienation on the part of a joint-owner within such limits as prevents an increase in the burden placed upon the common property of all, permitting him to enjoy his interest himself or to convey it to another single owner, whether an individual, a co-partnership, or a corporation, but not allowing him to multiply the number of those who are relieved from the monopoly without the consent of his co-owners. This rule also has its hardship, since it compels the joint-owner to practise the invention, or to sell his interest to a single purchaser or to such a group of purchasers as are acceptable to his co-owners, or to remain without the enjoyment of his property; but it is a rule conservative, not destructive, of the value of the patented invention as a whole, and entails on him no greater disadvantage than now rests upon the joint proprietors of a common, or a wharfing privilege, or any other incorporeal right, an increase in the number of whose occupants is forbidden by the law unless

it be with the express or implied permission of all the existing owners.[2]

§ 797. Joint-Owners cannot Practise Infringing Inventions.

Although the courts have recognized the right of one joint-owner to multiply indefinitely the number of those who can lawfully practise the patented invention without reference to

[2] Although no exact similitude exists between a patent privilege and any other property, yet the resemblance which it bears to a common of pasture is sufficient to suggest a possible solution of the present question. Both the patent privilege and the common of pasture are to be exercised within definite territory by specified means of enjoyment, and with a limited and determinable amount of profit. In both, the appropriation to himself, by one owner, of more than his just share of such profit is an unjust invasion of the rights of the others, whether, in the one case, by the introduction of an excessive number of commonable beasts, or, in the other, by distributing the patent privilege to an increased number of proprietors or licensees. Any assignment of either right which does not impose a greater burden on the common property, and any use of either by the owner which does not curtail its proper use by his co-owners, is fair and equitable although the ultimate result to him may far exceed any advantage which his co-owners may actually attain. Now the law finds no difficulty in regulating the rights and duties of commoners of pasture. It recognizes the fact that the profit is limited in amount and, therefore, prevents its distribution among a greater number of cattle than the owners have the right to introduce. But it does not measure the keenness of their appetites, nor the capacity of their stomachs, nor the benefit derived by one owner over another on account of his choicer breed of animals or the higher value to him of the food obtained. So far as analogy may be taken as a guide at all in such cases, does not this suggest that the joint-owners of a patent privilege enjoy all the rights to which they are entitled, as against each other, when each is allowed to practise the invention without accountability to his co-owners for any benefit which his superior skill or larger capital may enable him to realize, and to assign his interest to one other person, natural or artificial, for what price he pleases, with the same power to use and to assign; but that, as in the case of a commoner, he should not be allowed to introduce into the common property a greater number of those agencies by which its profits are to be absorbed, to the inevitable diminution of the advantage which his co-owners would otherwise have rightfully enjoyed? This suggestion, based on the nature of the property in the invention, takes no notice of the injury done to one owner of a patent by another when the latter prevents the former from exercising the prohibitory powers of the monopoly in his own defence, as under the present rules of law often occurs. But under this suggestion, that injury would also be avoided, since each owner could still enforce his rights against every person except the co-owner or the single individual to whom his interests had been assigned.

its effect on his co-owners, it has been held that neither a joint-owner nor his alienees can lawfully practise an infringing invention.[1] This limitation may appear inconsistent with

§ 707. [1] In Horring v. Gas Consumers' Association (1878), 3 McCrary, 206, Treat, J.: (206) "The direct question presented is whether an infringer of a patent can escape liability for his infringement because he is a joint-owner of the original patent upon which the infringement occurs. The cases cited do not reach the precise point raised by the bill. It is evident that if a stranger was guilty of the infringement he would be compelled to respond in damages. Can a part-owner infringe the common patent and escape all liability? If he can, it is obvious that, however small his aliquot part, he can make the enjoyment of the patent valueless to his joint-owner. He has, by virtue of the joint-ownership, a right to use the patent, but he has no right, more than a stranger, to infringe the same. If there is an infringement, the right of recovery is in the party wronged. All the joint-owners should ordinarily be parties plaintiff, but if the wrong-doer is one who is guilty to the damage of the other joint-owner, the other should not be left remediless. As to such infringement they are strangers. All the joint-owners are on the record, and the amount of the recovery determines their respective interests. The infringer cannot escape the consequences of his wrong to his joint-owner by averring that he was by his infringement injuring not his joint-owner alone, but himself also. In other words, he cannot, *under cover* of his interest in the common patent, shield every wrong-doer who may infringe that patent. He can, as to the other part owners, by infringing, become liable to them for the wrong done. The amount of recovery will be in proportion to their respective interests. Were this not so, the door would be open to the grossest frauds by one joint-owner against all other joint-owners. The case of Pitts v. Hall, 3 Blatchf. 204, and the comments thereon in Curtis, Pat. § 108 *et seq.*, do not cover this case. The question there discussed pertains to the use by one joint-owner of the common property. The difficulties in maintaining an action for an infringement against a joint-owner who merely uses the common patent may be insurmountable. As to that no opinion is expressed. In this case an entirely new and distinct proposition is presented, viz.: one of the several joint-owners is not using the common patent, but an infringing patent. His defence is that inasmuch as he had a right to use the original patent without question from his joint-owners, under the decision in Pitts *v.* Hall, *supra*, he has a right also to use any infringing patents, on the ground that his right to use the original being vested in him, his use of other and infringing patents did not cause any wrong or injury to himself as joint-owner. In other words, the defendant contends that as one joint-owner he could use the common patent without being liable to account to the other joint-owners; that he could not be sued as an infringer for using what he had a right to use by virtue of his proprietary interest; and, therefore, if he used an infringing device, he was only injuring himself in what he had a proprietary right to forbid. This would be correct if no interest except his own were involved, for a man may do what he pleases with his own, and "*volenti non fit injuria*" would be, *a fortiori*, applicable in such a case. If a stranger were using the infringing patent, this action would unquestionably lie against him; and the question before us is

the latitude allowed him under the preceding rule, but it is sound in principle. The powers included in his ownership of the invention are only such as can be exercised within the scope of the patent, by making, using, or selling the invention therein described and claimed; and his ownership of the monopoly, which exists only for the protection of his interest in the invention, does not entitle him to perform acts which would be an infringement in a stranger, unless they are the precise acts involved in the practice of the patented invention. The use by him of an infringing art or instrument is neither the practice of the patented invention nor the employment of prohibitory powers in its defence. It is an act entirely outside of the enjoyment of his rights as the owner either of the invention or of the monopoly. Acts of the same character on the part of licensees are equally beyond the privileges conferred upon them by their license, and are not affected by the estoppel which prevents the enforcement of the monopoly against their practice of the patented invention.[2] Joint-owners and their licensees are, therefore, as to such acts of infringement regarded as strangers to the patented invention, and are liable in damages to the other owners according to the proportion of their respective interests therein.

§ 793. Reciprocal Relations of Joint-Owners Variable by Contract: Their Relations to Third Parties.

While these general rules govern the relations of joint-owners in the absence of any special contract between them,

whether it will lie against a joint-owner, or, in the language of the bill, whether he, under cover of his joint ownership, can infringe and escape liability. So far as he acts outside of his interests or rights or powers as a joint-owner, there is no adequate reason for treating him, *quoad hoc*, otherwise than as a stranger. If this be not so, then one joint-owner may destroy, without remedy, the rights of the other joint-owners." 21 O. G. 203 (203); 3 Bann. & A. 253 (254); 9 Fed. Rep. 556 (556).

That one joint-owner can enjoin another in certain cases, see Duke *v.* Graham (1884), 19 Fed. Rep. 647.

That one co-owner is not estopped from denying the validity of the patent as against the others, see Marston *v.* Swett (1875), 4 Hun, 153; 6 Thomp. & C. 534.

[2] That a licensee is liable for infringement if he uses any other invention substantially identical with the one covered by his license, see Miller's Falls Co. *v.* Ives (1877), 14 O. G. 203; 14 Blatch. 169; 2 Bann. & A. 574.

they are nevertheless at liberty to regulate their reciprocal rights according to their own desires.[1] They may unite their interests more closely by additional agreements, or one may deprive himself of a portion of his rights in favor of the others. In reference to third parties, however, all the joint-owners of the patented invention are regarded as a single proprietor. Infringement by a stranger violates the right of all in whom the property in the patented invention vests, and all must join in actions to redress the wrong; the damages which they recover being apportioned among them according to their individual but undivided interests in the patented invention.[2]

§ 798. [1] That joint-owners of a patent may subdivide it at pleasure, see Vose *v.* Singer (1862), 4 Allen, 226.

That an agreement of co-owners to account, if observed by them for a time, is not within the Statute of Frauds where the contract has been fulfilled on one side by the transfer of the interest in the patent, and might have been fully executed on the other within the year, see Fraser *v.* Gates (1885), 118 Ill. 99.

That an agreement of co-owners to account to each other is a continuing agreement, and enures to the benefit of a bankrupt owner who purchases the interest from his assignee in bankruptcy, see Fraser *v.* Gates (1885), 118 Ill. 99.

That an agreement to account to each other does not make the co-owners partners, see Fraser *v.* Gates (1885), 118 Ill. 99.

That joint-owners of a patent who are also partners are bound to account to each other for the use of the invention, see Freeman *v.* Freeman (1884), 136 Mass. 260.

That co-owners, being also co-partners, may hold each other to account for royalties and prices received for the invention, see Burr *v.* De La Vergne (1886), 102 N. Y. 415.

That owners not named as licensors in the license are entitled to their share of the royalties, if they were partners with the nominal licensor when the license was granted, see Rogers *v.* Reisner (1887), 41 O. G. 351; 30 Fed. Rep. 525.

That an agreement between a patentee and an improver of the patented device to take out a new joint patent makes them, in equity, joint-owners of the improved invention, and each can restrain the other from using it except for their joint benefit, see Duke *v.* Graham (1884), 19 Fed. Rep. 647.

That where the patentee and the inventor of an improvement re-issue the original patent for the improved device in their joint names, each can restrain the other from using the patent except for their joint benefit, see Duke *v.* Graham (1884), 19 Fed. Rep. 647.

[2] That a suit for infringement against a stranger should be brought in the names of all the joint-owners, and the damages recovered be distributed among them according to their respective interests in the patented invention, see Herring *v.* Gas Consumers' Association (1878), 3 McCrary, 206; 21 O. G. 203; 3 Bann. & A. 253; 9 Fed. Rep. 556, and cases cited under §§ 937–945, 1070, 1098–1102, *post*.

§ 799. Joint Grantees.

Joint grantees occupy toward each other in respect to their limited territorial ownership the same relations which subsist between the joint-owners of the entire interest for the whole United States. Within their local boundaries the complete property in the invention and the monopoly is vested in them as co-owners, and each may practise the invention, dispose of his own interest, or license others in the same manner as a joint assignee. Their several rights may be increased, diminished, or changed in character by mutual agreements, and in enforcing them against infringers they act as a collective body, in whom the indivisible monopoly resides. Owners of different territorial interests may similarly combine their privileges, or enter into contracts with each other whereby their rights, as otherwise defined by law, are variously modified.[1]

SECTION III.

OF THE TRANSFER OF LETTERS-PATENT: EXECUTORS AND ADMINISTRATORS.[1]

§ 800. Property of Decedent in Patented Inventions Vested by Federal Statutes in his Executor or Administrator.

Upon the death of any owner of a patented invention his interest vests immediately in his executor or administrator, by virtue of the statutes of the United States.[2] The title of

§ 799. [1] That owners of different territorial rights do not mingle their rights by appointing a common attorney to convey, see May *v.* Chaffee, (1871), 5 Fisher, 160; 2 Dillon, 385.

That two assignees of different territory may appoint an agent to manage for both, and may thus restrict themselves in perpetuity from doing anything to injure each other, see Ladd *v.* Mills (1884), 20 Fed. Rep. 792; 22 Blatch. 242.

§ 800. [1] For a discussion of this subject, in another connection, see §§ 404–406, and notes, *ante*.

[2] That the interest of the owner of a patented invention vests, upon his death, in his executor or administrator, see Shaw Relief Valve Co. *v.* New Bedford (1884), 19 Fed. Rep. 753; 28 O. G. 283; Bradley *v.* Dull (1884), 19 Fed. Rep. 913; 27 O. G. 625.

That the executor or administrator in whom the patent vests is the one

the administrator or executor is not derived from the local laws of the State in which he was appointed, or in which the property is situated, though his official character may be determined by such laws.[3] His title rests upon the acts of Congress which control alike the nature of his ownership and the extent of his authority and obligations.[4]

§ 801. Nature of the Property of an Executor or Administrator in the Patented Inventions of his Decedent.

The property in a patented invention in the hands of an executor or administrator is not personal property belonging to the decedent's estate, nor assets liable to the claims of creditors or of distributees. It is a franchise which he holds, not in his official capacity under the probate laws, but in a different and special capacity under the Patent Laws.[1] It does not enter into his dealings with the estate as such, nor is he accountable for it to the personal representatives of the deceased. Though he is often said to be a trustee, in whom the patented invention vests for the benefit of the owner's

appointed at the domicile of the deceased owner, see Hodge *v.* North Missouri R. R. Co. (1869), 4 Fisher, 161; 1 Dillon, 104.

That the executor or administrator owns the entire interest of his decedent in every part of the United States, see Hodge *v.* North Missouri R. R. Co. (1869), 4 Fisher, 161; 1 Dillon, 104.

That where an inventor dies before application the executor or administrator must apply for the patent; and where he dies pending application the executor or administrator must receive the patent, see Rice *v.* Burt (1879), 16 O. G. 1050.

That where the inventor dies, pending the application, the executor or administrator may file a new application, but the rights of third parties cannot be affected thereby, see *Ex parte* Smith (1888), 43 O. G. 505; Rice *v.* Burt (1879), 16 O. G. 1050.

[3] That an administrator's title to a patent is not derived from the State law but from the United States law, and there is no necessity for local State administration, in order to enable him to sue anywhere, see Goodyear *v.* Hullihan (1867), 3 Fisher, 251; 2 Hughes, 492.

That the official character of an administrator is not a question for the United States Courts, see Northwestern Fire Extinguisher Co. *v.* Philadelphia Fire Extinguisher Co. (1874), 6 O. G. 34; 1 Bann. & A. 177.

[4] That State laws cannot limit the powers of administrators under the Patent Laws of the United States, see Brooks *v.* Jenkins (1844), 3 McLean, 432.

§ 801. [1] That a patent in the administrator's hands is not personalty belonging to the decedent's estate, but is a franchise held in trust for the heirs, see Goodyear *v.* Hullihan (1867), 3 Fisher, 251; 2 Hughes, 492.

heirs or devisees,[2] he is not a true trustee having a legal title to the property, but a mere instrument of the law, charged to perform certain duties in the interest of those to whom the patented invention properly belongs.[3]

§ 802. Relations of the Executor or Administrator to the Heirs and Devisees of the Decedent in reference to those Patented Inventions.

The title of an executor or administrator to a patented invention is identical with that of his decedent, so far as the Patent Office, the courts, and third parties are concerned. As between him and the heirs of the former owner, or the devisees on whom the will may have conferred the ownership of the invention, the property vests in them, though managed and controlled by him. In procuring letters-patent or a reissue or an extension, in prosecuting actions for infringement or other wrongs against the property, in making contracts and assignments, and in granting licenses, he acts as if he were the independent owner of the patented invention, although accountable in equity to those in whom the beneficial interest in the invention legally resides.[1]

[2] That a patent granted to an administrator is held by him in trust for the heirs, but the patent need not so state, see Northwestern Fire Extinguisher Co. *v.* Philadelphia Fire Extinguisher Co. (1874), 1 Bann. & A. 177; 6 O. G. 34.

That where an inventor dies leaving a will devising the invention, and the executor obtains a patent, he holds it in *trust for the devisees by implication* of law, see Stimpson *v.* Rogers, Smith & Co. (1859), 4 Blatch. 333.

[3] In Wintermute *v.* Redington (1856), 1 Fisher, 239, Willson, J.: (241) "Administrators of an estate are not, properly speaking, trustees in whom is vested the legal title. The law clothes them with certain powers, by which they are enabled to transmit the legal title of property. They are mere instruments of the law, and the effect is given to their acts upon the same principle that title to property is transferred by the official act of a sheriff or marshal."

§ 802. [1] That an executor or administrator can assign a patent and *give a good title thereto*, see *Donoughe v.* Hubbard (1886), 35 O. G. 1561; 27 Fed. Rep. 742; Bradley *v.* Dull (1884), 27 O. G. 625; 19 Fed. Rep. 913.

That it is not necessary that all the executors or administrators should join in the assignment, see Wintermute *v.* Redington (1856), 1 Fisher, 239.

SECTION IV.

OF THE TRANSFER OF LETTERS-PATENT: JUDICIAL SALES.[1]

§ 803. Patented Inventions not Subject to Execution nor to any Ordinary Method of Appropriation for the Benefit of Creditors.

The general principle that all the property of a debtor is liable for his debts applies to the property in a patented invention.[2] No reason exists, either in the nature of the property or in the meritorious acts of which it is considered a reward, that should exempt it from the claims of creditors.[3] But in enforcing such claims several difficulties arise. The property is incorporeal, and therefore cannot be seized and appropriated to the satisfaction of a judgment by any of the methods known to the common law.[4] It is also universal, not local, and therefore cannot be directly reached, to any considerable extent, by any process issuing out of courts of local jurisdiction.[5] It is transferable, under the Patent Law of the

§ 803. [1] For a discussion of this subject in part, see § 766 and notes, *ante*.

[2] That a patent is liable for the debts of the patentee, see Shaw Relief Valve Co. *v.* New Bedford (1884), 19 Fed. Rep. 753; 28 O. G. 283.

[3] That property does not become "exempt from attachment" by its intrinsic nature, but by the provisions of positive law, see *In re* Keach (1884), 14 R. I. 571.

[4] That a patent privilege cannot be seized and sold on execution, see Carver *v.* Peck (1881), 131 Mass. 291; Pacific Bank *v.* Robinson (1881), 57 Cal. 520; Stevens *v.* Gladding (1854), 17 How. 447; Stephens *v.* Cady (1852), 14 How. 528.

[5] In Stevens *v.* Gladding (1854), 17 How. 447, Curtis, J.: (451) "There would certainly be great difficulty in assenting to the proposition that patent and copyrights, held under the laws of the United States, are subject to seizure and sale on execution. Not to repeat what is said on this subject in 14 How. 531, it may be added that these incorporeal rights do not exist in any particular State or district; they are co-extensive with the United States. There is nothing in any act of Congress, or in the nature of the rights themselves, to give them locality anywhere, so as to subject them to the process of courts having jurisdiction limited by the lines of States and districts. That an execution out of the court of common pleas for the county of Bristol, in the State of Massachusetts, can be levied on an incorporeal right subsisting in Rhode Island, or New York, will hardly be pretended. That by the levy of such an execution, the entire right

United States, only by the patentee or his alienee or personal representatives, and therefore cannot be decreed by any court to vest in any person without the required conveyance from its actual owner.[6] For these reasons patented inventions were for a long time regarded as practically exempt from the ordinary liability for the debts of their owners, though methods are now adopted by which they are with great facility made subject to the claims of creditors.[7]

§ 804. Patented Inventions Subjected to the Claims of Creditors only through some Form of Assignment by their True Owner.

These methods are in form or in effect assignments by the owner of the patented invention. Only by a grant can incorporeal property be transferred from one person to another. Only by a grant from some authority, having a jurisdiction over the property which is as universal as the property itself, could any beneficial transfer be accomplished. Only by a grant from the real owner of the patented invention can the requirements of the Patent Law concerning transfers be fulfilled. Hence any method which effects such transfer must be a conveyance by the lawful owner or its equivalent. Such is not the case with the judgment or order of any court or the act of any officer. In the absence of a statute of the United States to that effect, neither an adjudication in bankruptcy nor the voluntary assignment of the owner could put the property in the patented invention at the disposal of the court or assignee, unless the one was followed, and the other accompanied, by an actual transfer of the patented invention in the mode provided by the Patent Law.[1] Thus all the

could be divided, and so much of it as might be exercised within the county of Bristol sold, would be a position subject to much difficulty."

See also Carver *v.* Peck (1881), 131 Mass. 291.

[6] See §§ 765, 766, and notes, *ante*.

[7] In Carver *v.* Peck (1881), 131 Mass. 291, Gray, J.: (292) "The incorporeal and intangible right of an inventor or an author in a patent or a copyright cannot be taken on execution at law; and a general assignment of his property under a bankrupt or insolvent act will either by its own force pass this right to the assignee in bankruptcy or insolvency, or will at least entitle the latter by proper proceedings to compel the debtor to convey it to him for the benefit of creditors." See also § 805 and notes, *post*.

§ 804. [1] That an assignment by an in-

methods that might be devised are reducible in substance to one, — a voluntary or compulsory transfer by the owner of the patented invention.

§ 805. Owner of Patented Invention may be Compelled by a Court of Equity to Assign it for the Benefit of Creditors.

That courts of equity, acting in aid of courts of law, have the authority to compel the owner of a patented invention to assign it to a trustee or receiver, to be sold for the satisfaction of his judgment-debts, seems now to be decided.[1] This method

solvent to his trustee of all his property, not exempted by law, does not carry a patent, see Campbell *v.* James (1880), 18 Blatch. 92; 5 Bann. & A. 354; 18 O. G. 1111; 2 Fed. Rep. 338.

That the title to a patent does not vest in a receiver, see Dick *v.* Struthers (1885), 25 Fed. Rep. 103; 34 O. G. 131.

That neither the assignee in insolvency nor a receiver can assign or pass title to a patent except by a written instrument, signed by the owner of the patent and duly recorded, see Gordon *v.* Anthony (1879), 16 O. G. 1135; 16 Blatch. 234; 4 Bann. & A. 248.

That an assignment made by a judge of Probate under a State insolvent law, does not transfer the title to a patent, but an instrument of assignment must be executed by the owner, see Ashcroft *v.* Walworth (1872), 2 O. G. 546; Holmes, 152; 5 Fisher, 523.

That a receiver may convey the equitable title, though unable, without the concurrence of the real owner, to transfer the legal title, see Adams *v.* Howard (1884), 23 Blatch. 27; 22 Fed. Rep. 656.

§ 805. [1] In Pacific Bank *v.* Robinson (1881), 20 O. G. 1314, McKee, J.: (1314) "The question is, has a court of equity power to compel its assignment and sale for the benefit of judgment creditors? In 1852 Mr. Justice Nelson, in Stephens *v.* Cady (14 How. 528), held that a copyright to print and publish maps of the State of New Hampshire could be reached by a creditor's bill and applied to the payment of debts of the owner of the copyright, under a decree compelling a transfer in conformity with the provisions of the act of Congress. That, however, was mere *obiter*, because the decision of the question was not necessarily involved in the case. And afterward, in 1854, in the case of Stephens *v.* Gladding (17 How. 447), which was a branch of the case of Stephens *v.* Cady, Mr. Justice Curtis declined to pass upon the question, because neither the copyright nor any interest in it had been attempted to be sold. But in 1875 the supreme court of New York, in the case of Barnes *v.* Morgan (3 Hun, 703), took up the *dictum* of Mr. Justice Nelson in Stephens *v.* Cady and approved of it as a sustainable legal proposition. An order had been made at special term, directing the defendant in the case to deliver to a receiver, appointed under supplementary proceedings, certain patents and models appertaining thereto. From the order defendant appealed to the supreme court. Assignability of the patents by the voluntary act of the owner under the act of Congress which created them was conceded, and according to the authority of Hesse *v.* Stevenson (3 B. & P. 577), Nias *v.* Adamson (3 B. & Ald. 225), and Coles *v.* Barrow

satisfies all the requirements of the law. Where the owner refuses to execute the necessary conveyances or is incapable of

(4 Taunt. 754), it had been established that patent rights of a bankrupt pass by act and operation of law to his assignees in bankruptcy for the benefit of creditors. In Hesse v. Stevenson, Lord Alvanley, in delivering the opinion of the court, used this language: 'It is said that although by the assignment every right and interest, and every right of action, as well as right of possession and possibility of interest, is taken out of the bankrupt and vested in the assignees, yet that the fruits of a man's own invention do not pass. It is true that the schemes which a man may have in his own head before he obtains his certificate, or the fruits which he makes of such schemes, do not pass, nor could the assignees require him to assign them over, provided he does not carry his schemes into effect until after he has obtained his certificate; but if he avails himself of his knowledge and skill, and thereby acquires a beneficial interest, which may be the subject of assignment, I cannot frame to myself an argument why that interest should not pass in the same manner as any other property acquired by his personal industry.' Patent rights being, therefore, assignable by the voluntary act of the owner and by act and operation of law, it followed that a court of equity could compel the defendant to assign them to a receiver, to be sold and applied to the satisfaction of judgments against him, and the supreme court affirmed the order of the special term. 'If,' said the court, 'the use of a monopoly which such a grant confers is not sufficiently productive in the hands of the inventor to pay his debts, the privilege bestowed, being a right of property as declared by Chief Justice Taney, should be transferred to the person designated by law and sold for the benefit of the creditor. It would be a marvellous, if not unjust, perpetuation of the ideal if an inventor, having obtained a patent, thus divulging his secret and at the same time acquiring a property in it for practicable purposes, should be permitted to hold it unused against his creditors until, either by compromise or the lapse of time, his obligations should be discharged, and this, too, although it might be one which, by assignment or upon manufacture of the thing invented, would readily yield enough to pay all existing liabilities.'" 57 Cal. 520 (523).

In Ashcroft v. Walworth (1872), 2 O. G. 546, Shepley, J.: (547) "It might have been competent for the court under the insolvent law to have compelled the debtor to execute such an instrument in writing as, in accordance with the provisions of the Patent Act, would have been effectual to transfer the title in the patent to the assignee. If a right in a patent were such property as did not come within the exceptions of the insolvent law as property not liable to attachment, or if it is of such a nature that it is subject to the operation of State insolvent laws, this would seem to have been the only proper and effectual mode to have made it available for the benefit of the creditors. Without such a conveyance as the statute of the United States contemplates, we do not think the assignee acquires any legal title to any interest the debtor may have in any letters-patent. To invest the assignee with the legal title the court must compel a transfer in conformity with the requirements of the Patent Act." Holmes, 152 (154); 5 Fisher, 528 (530).

That the receiver of an insolvent is entitled to his patents, and the court

doing so, it has been held that the court of equity, in order to effectuate its own decree, may appoint a trustee to make the assignment in the name and on behalf of the recalcitrant or incapacitated owner, and that this conveyance is equivalent to one executed by himself.[2] Whether a State insolvent court could exercise the former power over the owner of a patented invention depends on the authority conferred upon it by the local law. The latter power, whose existence in any court is still open to question, must be derived expressly or impliedly from the laws of the United States.

SECTION V.

OF THE TRANSFER OF LETTERS-PATENT: LICENSES.

§ 806. License Defined: Distinguished from Assignment and Grant.

Any conveyance of an interest in a patented invention, which cannot operate as an assignment or a grant, is a

may order the debtor to assign them to him, see *In re* Keach (1884), 14 R. I. 571; Carver *v.* Peck (1881), 131 Mass. 291.

That a patent may be reached by a creditor's bill, see Gillett *v.* Bate (1881), 86 N. Y. 87; 10 Abb. N. C. 88.

That a patent may be subjected to the debts of the patentee by a creditor's bill, even against a fraudulent assignee, and where the citizenship of the parties is different the Federal courts have jurisdiction, see Gorrell *v.* Dickson (1886), 26 Fed. Rep. 454.

That a patent is assigned by the operation of law upon the bankruptcy of the owner, and though it cannot be seized on execution, it can be reached by a creditor's bill and by proceedings supplementary to execution, see Barnes *v.* Morgan (1875), 3 Hun, 703; 6 Thomp. & C. 105.

That the want of novelty or utility is no defence to a creditor's bill against the patentee or a fraudulent assignee, see Gillett *v.* Bate (1881), 86 N. Y. 87; 10 Abb. N. C. 88.

That unpatented inventions cannot be reached by a creditor's bill, see Gillett *v.* Bate (1881), 86 N. Y. 87; 10 Abb. N. C. 88.

That an incomplete and experimental invention cannot be reached by a creditor's bill, see Ryan *v.* Lee (1882), 14 Mo. App. 599.

[2] That a court of equity may direct the sale of an inventor's interest in his patent to satisfy a judgment against him, and will require the patentee to assign as provided in Sec. 4898, Rev. Stat., and, if he refuses, will appoint a trustee to make the assignment, see Murray *v.* Ager (1881), 20 O. G. 1311; 1 Mackey, 87.

That a patent right cannot be reached by a creditor's bill under Gen. Stat. Mass. c. 113, § 2, cl. 11, see Carver *v.* Peck (1881), 131 Mass. 291.

license.[1] A license is distinguished from those other forms of transferring letters-patent by the single characteristic that an assignment and a grant transfer the monopoly as well as the invention, while a license transfers only the invention and does not affect the monopoly otherwise than by estopping the licensor from exercising its prohibitory powers in derogation of the privileges conferred by him upon the licensee.[2] Whether a given conveyance carries both the monopoly and the invention is usually determined by the language in which it describes the transferred interest in the invention, such instrument rarely mentioning the monopoly or treating it as the subject-matter of the alienation. Hence if the interest in the invention which the conveyance purports to transfer is one to which the law annexes the monopoly, the instrument is a grant or an assignment; and, on the contrary, if this interest is such that its alienation leaves the monopoly still residing, in contemplation of law, in the alienor, the conveyance is a mere license. This contract of license is governed and defined by State law, as distinguished from statutory Patent Law, and is subject to the incidents which attach to all agreements.[3]

§ 806. [1] That anything less than a grant or an assignment is a license, see Potter *v.* Holland (1858), 1 Fisher, 327; 4 Blatch. 206.

[2] In Sanford *v.* Messer (1872), 2 O. G. 470, Shepley, J.: (471) "Any assignment which does not convey to the assignee the entire and unqualified monopoly which the patentee holds in the territory specified, or an undivided interest in the entire monopoly, is a mere license." 5 Fisher, 411 (412); Holmes, 149 (150).

See also Theberath *v.* Celluloid Mfg. Co. (1880), 3 Fed. Rep. 143; 5 Bann. & A. 577.

That while an assignment and grant convey the monopoly, a license merely waives the monopoly as to the licensee, see Howe *v.* Wooldredge (1866), 12 Allen, 18; Buss *v.* Putney (1859), 38 N. H. 44.

That the sole matter conveyed in a license is the right not to be sued, see Hawks *v.* Swett (1875), 4 Hun, 146; 6 Thomp. & C. 529.

That a license may be granted before the patent issues, see Kelly *v.* Porter (1883), 8 Sawyer, 482; 17 Fed. Rep. 519.

[3] That licenses are governed by State laws, see State of Missouri *v.* Bell Telephone Co. (1885), 23 Fed. Rep. 539.

That the Federal courts may determine, in an infringement case, whether there is an outstanding license or not, see Hammacher *v.* Wilson (1886), 26 Fed. Rep. 239; 36 O. G. 233.

That a common carrier, though licensed by a patentee to carry on business with one customer only, may be compelled to carry it on with all, see State of Missouri *v.* Bell Telephone Co. (1885), 23 Fed. Rep. 539.

That a license under an expired pat-

§ 807. The Invention, not the Monopoly, Transferred by a License.

It is a necessary consequence of the indivisibility of the monopoly that nothing less than the conveyance of the entire interest in the invention, or of an undivided part of such entire interest, can operate upon it as a transfer. Though the subordinate rights in the invention are separable and may be alienated at the pleasure of its owner, the monopoly cannot be subdivided to correspond with them and be transferred with them to independent owners. The monopoly remains in him on whom the issue of the letters-patent conferred it, until he transfers to another person all the rights for whose vindication the monopoly was created, or makes that other person a joint-owner with himself. As long, therefore, as any interest resides in him to which the monopoly must attach, the interests which he conveys to others, unless they thereby become jointly interested with himself, are interests in the invention merely, not affecting the monopoly; and however extensive in its terms the instrument transferring them may be, it still leaves the monopoly in him.[1] The only alienation which can carry the monopoly is that of the exclusive right, or of an undivided interest in the exclusive right, to practise the invention, including the exclusive right to make, the exclusive right to use, and the exclusive right to sell the patented invention.[2]

§ 808. Any Transfer of less than the Entire Interest in the Patented Invention, or an undivided part of such Entire Interest, is a License.

Judged by this test every conveyance which does not transfer the exclusive right, or an undivided interest in the exclusive right, to practise the invention is a license.[1] All

ent, among others, is no evidence of Fed. Rep. 100; 37 O. G. 781; McKay *v.* Jackman (1883), 17 Fed. Rep. 641.

§ 807. [2] See §§ 753–758, and notes, *ante*, for a more extended discussion of these principles.

[2] See § 763 and notes, *ante*.

§ 808. [1] That any grant which does not convey either an undivided interest

fraud, since all parties are chargeable with notice as to the term of patents, see Pope Mfg. Co. *v.* Owsley (1886), 27 Fed. Rep. 100; 37 O. G. 781.

That a license taken to avoid a suit is not taken under duress or fraud, see Pope Mfg. Co. *v.* Owsley (1886), 27

alienations of the right to make, or the right to use, or the right to sell, or of the right to make and use, or of the right to make and use and sell, are merely licenses.[2] All transfers of the exclusive right to use, or of the exclusive right to make and use, or of the exclusive right to use and sell, are also simple licenses.[3] Conveyances of the exclusive right to use in a certain manner, or of the exclusive right to make and use and sell in a particular form or for a particular purpose, are only licenses.[4] But an instrument conferring the exclu-

or an exclusive local interest, is a mere license, see Nelson *v.* McMann (1879), 16 Blatch. 139; 4 Bann. & A. 203; 16 O. G. 761.

That any grant less than an exclusive right within a given territory, is a mere license, see Sanford *v.* Messer (1872), 2 O. G. 470; 5 Fisher, 411; Holmes, 140; Farrington *v.* Gregory (1870), 4 Fisher, 221; Gayler *v.* Wilder (1850), 10 How. 477.

[2] That the grant of a right to use and sell only, but not to make, is a mere license, see Sanford *v.* Messer (1872), 2 O. G. 470; 5 Fisher, 411; Holmes, 149.

That a grant "to use and sell" in a given territory is a mere license, see Farrington *v.* Gregory (1870), 4 Fisher, 221.

That an agreement that the promisee may make and sell in a given territory, is a mere license, see Gayler *v.* Wilder (1850), 10 How. 477.

That an agreement by the patentee not to sue or disturb one who uses the invention is only a license, not affecting the patent right, see Bull *v.* Pratt (1815), 1 Conn. 342.

That a conveyance of the power to sell, use, and grant to others the right to use the patented device within certain territory for a certain period, is not a mere power of attorney, but a contract vesting rights in the grantee, see Burdell *v.* Denig (1875), 92 U. S. 716.

That the contract of a workman to give his employer the benefit of his inventions is a license, not a grant, see Whiting *v.* Graves (1878), 13 O. G. 455; 3 Bann. & A. 222.

That an agreement between conflicting patentees for a common use of their patents, and the mutual defence of their rights, is not an assignment, but a mere license to each to use the inventions of the other, see Aultman *v.* Holley (1873), 5 O. G. 3.

That the conveyance of a right to canvass for and sell the patented article as an agent, conveys no interest in the monopoly, and may be oral, see Springfield *v.* Drake (1876), 58 N. H. 19.

[3] That an exclusive territorial right to use and sell, but not make, is a mere license, see Hill *v.* Whitcomb (1874), 5 O. G. 430; Holmes, 317; 1 Bann. & A. 34; Sanford *v.* Messer (1872), 5 Fisher, 411; 2 O. G. 470; Holmes, 149.

That the grant of the sole right to sell the patented article within certain territory does not carry any part of the patent right, but is a mere license, the grantor still owning the entire patent, see Ingalls *v.* Tice (1882), 14 Fed. Rep. 297; 22 O. G. 2160.

That an irrevocable and exclusive power to act as "sole agent" for making and selling, to retain his commission, and pay the balance to the principal, is not an assignment but a mere license, see Kempton *v.* Bray (1868), 99 Mass. 350.

[4] That the grant of an exclusive

sive right to make and sell carries the entire invention, since the exclusive right conferred gives to the alienee complete dominion over the use also, and thus transferring the monopoly becomes either an assignment or a grant.[5] These limitations of the interest transferred may appear either in the description of the interest itself, or in the reservation of rights to the alienor, or may be implied from the remaining portions of the contract. The conveyance of the entire interest in the patented invention, reserving to the alienor a right to make it, or a right to sell it, even though not exclusive, vests in the alienee only an independent partial interest and makes him a mere licensee.[6] The transfer of the entire in-

right to make and sell one form of the invention is a mere license, see Nellis *v.* Pennock Mfg. Co. (1882), 22 O. G. 1131 ; 13 Fed. Rep. 451.

That the grant of a right to use for a specific purpose is a mere license, see Bogart *v.* Hinds (1885), 33 O. G. 1268 ; 25 Fed. Rep. 484.

That the grant of the exclusive use of an invention for a certain purpose in a certain territory, and for a certain time, is a mere license, see Oliver *v.* Rumford Chemical Works (1883), 109 U. S. 75 ; 25 O. G. 784.

That a right to make, use, and sell for a particular purpose, in specified places, is only a license, see Gamewell Fire Alarm Telegraph Co. *v.* Brooklyn (1882), 14 Fed. Rep. 255 ; 22 O. G. 1978.

That an exclusive license to make or use for special purposes is not an assignment, see Dorsey Revolving Harvester Rake Co. *v.* Bradley Mfg. Co. (1874), 12 Blatch. 202 ; 1 Bann. & A. 330.

That a non-exclusive right to make and sell is a mere license, see Dorsey Revolving Harvester Rake Co. *v.* Bradley Mfg. Co. (1874), 12 Blatch. 202 ; 1 Bann. & A. 330 ; Hussey *v.* Whitely (1860), 1 Bond, 407 ; 2 Fisher, 120.

That the purchaser of an exclusive privilege of making and selling acquires an interest in the franchise secured by the patent, see Mitchell *v.* Hawley (1873), 16 Wall. 544 ; 3 O. G. 241 ; 6 Fisher, 331.

That an assignment of the exclusive right to make, use, and sell, and to vend to others to use and sell, carries the entire interest, although the right to sell the privilege of making is not mentioned, and not reserved to the assignors, see Pickhardt *v.* Packard (1884), 23 Blatch. 23 ; 30 O. G. 179 ; 22 Fed. Rep. 530.

That the grant of an "exclusive right to make and sell" the invention "in the United States for the whole term" of the patent, is an assignment of the whole patent and there is no right left in the assignor, see Nellis *v.* Pennock Mfg. Co. (1882), 13 Fed. Rep. 451 ; 22 O. G. 1131.

[5] That the conveyance of the exclusive right to make and sell carries the right to use, see Nellis *v.* Pennock Mfg. Co. (1882), 22 O. G. 1131 ; 13 Fed. Rep. 451 ; Turnbull *v.* Weir Plow Co. (1880), 23 O. G. 91 ; 9 Bissell, 334 ; 5 Bann. & A. 288 ; 14 Fed. Rep. 108.

[6] That any reservation of a right in the grantor renders the grant a license, not an assignment, see Hussey *v.* Whitely (1860), 1 Bond, 407 ; 2 Fisher, 120.

That a grant, reserving the right of

terest with a reservation of the right to use, however, gives to the alienee an absolute control over the patented invention, because without a making and a selling there can be no use, and hence such a conveyance is regarded as an assignment coupled with a license to the alienor to use the patented invention whenever, through the exercise of his rights by the alienee, the former may be able to procure it.[7] The covenants embraced in the instrument may similarly determine whether the conveyance is an assignment or a license. When they impose such obligations on the parties as can exist only while the monopoly remains in the alienor, the granting clause and the description must be regarded as relating to the invention alone, and the instrument itself construed to be a license. A covenant on the part of the alienor to protect the alienee by prosecuting infringers, for example, indicates that in whatever terms the interest transferred may be described, the prohibitory powers are still in the alienor, that the interest conveyed is, therefore, less than the entire interest or an undivided part thereof, and that the transfer operates only as a license.[8]

making to the grantor, is only a license, see Hamilton *v.* Kingsbury (1880), 4 Fed. Rep. 428; 17 Blatch. 460; 17 O. G. 847; 5 Bann. & A. 157; Sanford *v.* Messer (1872), Holmes, 149; 2 O. G. 470; 5 Fisher, 411.

That a grant reserving to the grantor certain uses of the invention is a mere license, see *Ex parte* Paine (1878), 13 O. G. 408.

That an assignment of the entire interest in the patent, within a certain territory, but reserving to the assignor the right to sell devices of his own making, is a mere license, see Hussey *v.* Whitely (1860), 2 Fisher, 120; 1 Bond, 407.

That a patentee who sells all his interest in the patent, reserving a right to certain specified uses of the invention, is no longer an owner but a mere licensee under his assignee, see Frankfort Whiskey Process Co. *v.* Pepper (1885), 26 Fed. Rep. 336.

That a contract for an exclusive right to make, construct, and use in a given State, and to sell to others to be used, but reserving to the grantor the right to sell devices of his own make in the State, though neither an assignment nor a grant, is more than a mere license and is assignable, and vests a fixed right in the purchaser, see Pitts *v.* Jameson (1853), 15 Barb. 310.

[7] That the conveyance of all rights in the invention within certain territory, except the right to use the patented device for a certain specific purpose, is a grant of the invention to the assignee, and a special license back to the assignor, see Littlefield *v.* Perry (1874), 21 Wall. 205; 7 O. G. 964.

[8] That the presence in the instrument of a covenant binding the grantor to protect the grantee by suit, etc., shows that the instrument is a mere license, see Theberath *v.* Celluloid Mfg. Co. (1880), 5 Bann. & A. 577; 3 Fed. Rep. 143.

§ 809. License may be either Express or Implied: Express Licenses.

A license may consist in an express agreement between the owner of the patented invention and the licensee, or it may be implied from circumstances. An express license may be oral or in writing, and when in writing it may take any form that can be legally interpreted as a conveyance of those interests which a license is sufficient to transfer.[1] Thus, if an instrument attempting to convey the entire interest in the patented invention, or an undivided portion of it, is insufficient for that purpose, it may still be valid as a license.[2] A contract for such conveyance, or an agreement to bestow a license, when accepted and acted on by the proposed licensee, has the same effect.[3] A compromise of litigated claims in which each party abandons all his rights to interfere with or restrain the other, or one by which the contending parties league together for the common enjoyment and common defence of their respective inventions, are other forms which this mode of conveyance may assume, and which are equally valid with licenses of greater definiteness of expression, provided the intention of the parties to transfer the proper interests can be clearly ascertained.[4] The scope of an implied

§ 809. [1] That a license need not be written, see Buss *v.* Putney (1859), 38 N. H. 44; Potter *v.* Holland (1858), 4 Blatch. 206; 1 Fisher, 327.

[2] That a contract for any part of the patent right may be good as a license, see Gayler *v.* Wilder (1850), 10 How. 477.

That an optional contract to purchase a patent does not operate as a license to the vendee's licensees to make an infringing article during the option, see Iowa Barb Steel Wire Co. *v.* Southern Barbed Wire Co. (1887), 30 Fed. Rep. 615; 40 O. G. 578.

[3] That an agreement to license, if acted on, becomes an actual license according to the intent of the parties, see Magic Ruffle Co. *v.* Elm City Co. (1875), 13 Blatch. 151; 2 Bann. & A. 152; 8 O. G. 773.

[4] That where the parties to a suit compromise it by an agreement allowing each party to do what he pleased, without regard to their conflicting claims, it is a license, see Troy Iron & Nail Factory *v.* Corning (1849), 1 Blatch. 467.

That an agreement, in settling a suit, that the defendant has infringed and has paid for it, is no license for the future, see Pickering *v.* Phillips (1876), 4 Clifford, 383; 2 Bann. & A. 417; 10 O. G. 420.

That where a written license is found in the hands of the licensee, a person who claims that it was delivered as an escrow must prove it, see Mellon *v.* Delaware, Lackawanna, & Western R. R. Co. (1882), 21 O. G. 1616.

license is determined by the circumstances out of which it has arisen.[5]

§ 810. Express Licenses may Cover one or more of the Rights Embraced in the Invention.

A license may relate to any or to all of the subordinate rights embraced in the invention. These rights are in their nature independent of each other, and can be exercised either separately or together, and can vest in different persons or in a single individual. It is optional with the owner of the patented invention to divide them, and to confer upon one licensee the right to make, upon another the right to use, and upon another the right to sell, or to bestow the three, or any two of them, on the same licensee.[1] To which and to how many of these rights a given license relates depends upon its terms, interpreted by the intention of the parties as shown by all the circumstances of the case.

§ 811. Express Licenses: License to Make.

A license to make confers upon the licensee the right to construct the article which is described and claimed in the letters-patent. If conferred alone, it gives the licensee no right to use or sell the article when constructed, and hence is generally coupled expressly with one or the other of these additional rights, as in licenses to make and use, or to make and sell.[1] Where the express words of the license embrace only the right to make, and the other rights are necessary to enable

[5] That the scope of an implied license is ascertained from the circumstances, see Montross *v.* Mabie (1887), 41 O. G. 931 ; 30 Fed. Rep. 234.

§ 810. [1] In Steam Cutter Co. *v.* Sheldon (1872), 10 Blatch. 1, Woodruff, J. : (8) "True, the patent granted to an inventor confers upon him the right to make, to use, and to vend to others to be used ; and it is possible for him, in granting to others a share in his exclusive right, to limit the privilege granted, as he may see fit, and it is, therefore, possible for him to keep these privileges distinct, if he can find persons willing to pay for one without the right to enjoy either of the others. Each case, however, must be judged of as well by the terms of the grant of privilege, as, also, by the situation of the parties or the circumstances under which they act." 5 Fisher, 477 (484).

See also Porter Needle Co. *v.* National Needle Co. (1883), 17 Fed. Rep. 536.

§ 811. [1] That the right to make is distinct from the right to use, see Bicknell *v.* Todd (1851), 5 McLean, 236.

the licensee to derive any advantage from the license, the presumption that the licensor intended that the right conveyed should be beneficial to the licensee controls the interpretation of the license, and extends it to include the right to use or sell, rather than permit it to be practically void. Thus a license to make the invention, conferred upon a licensee in whose business the thing made is ordinarily employed, carries by implication a right to use it when constructed. A similar license to a manufacturer of articles for sale, who has no use for this particular article when made, authorizes him to sell as well as make it.[2] The scope of the license is governed by the same presumption. A license to make an article which is covered by several patents, all owned by the same licensor, is a license under each of these patents, to whatever extent the making of the invention may require.[3]

§ 812. Express Licenses: License to Use.

A license to use varies in signification according to the nature of the invention to which it relates. When the invention is an art a license to use it is a license to practise the invention, and confers a right to do whatever the specification of the patent may prescribe or suggest, no other form of license being appropriate to this class of inventions. When the invention is an instrument, however, a license to use bestows merely the right to employ the completed article for practical purposes, but not the right to make it nor to sell it.[1]

[2] In Steam Cutter Co. *v.* Sheldon (1872), 10 Blatch. 1, Woodruff, J.: (8) "If a party engaged exclusively in the construction of machines of various kinds, for sale to others, were to receive a license to manufacture a patented machine, for a consideration presently paid to the patentee, a construction which would deny him all opportunity to make the privilege of any value, forbidding his sale of the machines when manufactured, should be very clearly imported by the license, or the court would hold that the parties meant that he should derive some benefit from the license, and not be left thereafter wholly dependent on the will of the patentee." 5 Fisher, 477 (484).

[3] That a general grant of the right to make the patented device, by the owner of two patents which cover the making, confers the right under both patents, see Day *v.* Stellman (1859), 1 Fisher, 487.

That a license under a foreign patent does not authorize the licensee to make the articles abroad for sale here, see Société Anonyme *v.* Tilghman's Patent Sand Blast Co. (1883), L. R. 25 Ch. D. 1.

§ 812. [1] In Steam Cutter Co. *v.* Sheldon (1872), 10 Blatch. 1, Wood-

In the absence of express restrictions in the license, this right of use is unlimited as to place, quantity and method, and may be continued during the term for which the patent has been granted, although the use must be confined to the precise invention covered by the patent of the licensor.[2] Express restrictions as to place, time, quantity or mode of use, are binding on the licensee and render all use contrary to such restrictions an infringement of the patent. A license to use within a certain district only, or at a certain shop, or on a certain line of railway, gives no authority to the licensee or his vendees to employ the invention in another district, or at a different shop, or on a new or an extended line of railway.[3] A license to use a specified number of the patented

ruff, J. : (8) "On the other hand, when the patentee, having made machines, sells one with the right to use the same, his grant may, with propriety, be limited to the particular machine sold ; and it is also clear that such a sale would (unless limited in terms, or by special circumstances), import the right to use, although not so expressed. So, a sale of a patented invention to a dealer, not for use but for sale to others, would carry with it the right, in the ultimate purchaser, to use the machine sold. Limitations in respect to territorial limits, extent of use, and the like, may be, and in general are, provided by express terms or stipulations." 5 Fisher, 477 (484).

[2] That a license does not authorize the use of any other invention than the one described in the license, though invented by the same licensee, see Miller's Falls Co. *v.* Ives (1877), 14 O. G. 203 ; 14 Blatch. 169 ; 2 Bann. & A. 574.

That the sale of an invention, the use of which involves the use of a process patented by the same grantor, is a license to use the process, see Downton *v.* Yaeger Milling Co. (1879), 17 O. G. 906 ; 1 McCrary, 26 ; 5 Bann. & A. 112 ; 1 Fed. Rep. 199.

That the sale of a machine with right to use a patented article therewith gives a license to use the article, but is not an assignment and need not be in writing, see Buss *v.* Putney (1859), 38 N. H. 44.

[3] In Dorsey Revolving Harvester Rake Co. *v.* Bradley Mfg. Co. (1874), 12 Blatch. 202, Woodruff, J. : (204) "The right to make and vend, and the right to use, are completely severable ; and, while a grant of the right to make and sell to others might be deemed to imply the right in the purchasers to use the thing purchased, a patentee may restrict the use. The patent as effectually secures to him a monopoly of the right to use as it does of the right to make. The patentee or his assignee may, therefore, give the exclusive right to make and sell for *use* within certain territory ; and such a restriction would be entitled to enforcement." 1 Bann. & A. 330 (332).

That a license to use within a certain district confers no rights beyond the limits of that district, see Chambers *v.* Smith (1870), 5 Fisher, 12 ; Woodworth *v.* Cook (1850), 2 Blatch. 151.

That a right to use in one place only makes a user in any other place an infringement, but such infringement does

articles, or to use the patented process for the production of a certain quantity of its results, does not empower the licensee to use a greater number or produce a greater quantity, even though he is willing to pay the licensor additional royalties or license-fees in proportion to the increase of his use of the invention.[4] A license to use for a given purpose only, or in

not revoke the right to use in the place specified, see Steam Cutter Co. *v.* Sheldon (1872), 10 Blatch. 1; 5 Fisher, 477.

That a machine licensed to be used in certain territory cannot be used elsewhere by other purchasers, and a demand by an agent for royalties properly due cannot ratify its improper use, see Wicke *v.* Kleinknecht (1874), 1 Bann. & A. 608; 7 O. G. 1098.

That the purchaser of a machine from one who has a right to use, and to sell to others to be used, only in a certain territory, has no right to use it elsewhere, and if he does, is liable for royalties to the patentee, see Burke *v.* Partridge (1878), 58 N. H. 539.

That a license to manufacture "at their shop," in a place described, is not transferable, see Searls *v.* Bouton (1881), 21 O. G. 1784; 20 Blatch. 426; 12 Fed. Rep. 140.

That a license to one to use "at his own establishment" does not cover a use at a shop owned by himself and others, see Rubber Co. *v.* Goodyear (1869), 9 Wall. 788.

That the sale of certain buildings and machinery with the right to use certain patented processes, gives no license to use the processes elsewhere, see Wetherell *v.* Passaic Zinc Co. (1872), 2 O. G. 471; 9 Phila. 385; 6 Fisher, 50.

That a personal license to use a patented device in one certain shop does not forbid its being made elsewhere, see Wood *v.* Wells, Crittenden & Co. (1873), 6 Fisher, 382.

That a license to a railway company to use a patented device on their road extends no farther than the road was built and used by it at the time the license was given, the use on roads built or leased afterwards not being protected, see Emigh *v.* Chicago, Burlington, & Quincy R. R. Co. (1863), 1 Bissell, 400; 2 Fisher, 387.

That a license to use the invention on a railroad fifty-eight miles long does not confer the right to use it on a new road owned by the same licensee, see Emigh *v.* Chicago, Burlington, & Quincy R. R. Co. (1863), 2 Fisher, 387; 1 Bissell, 400.

That a license to use a device on a certain railroad does not carry the right to use the device on the cars of the licensee over whatever railroad they may be run, see Hodge *v.* Hudson River Railroad Co. (1868), 6 Blatch. 85; 3 Fisher, 410.

That a railroad company, running its cars on another railroad, is not operating said road within the meaning of a license granted "to the operator" of such road, see Hodge *v.* Hudson River Railroad Co. (1868), 6 Blatch. 85; 3 Fisher, 410.

That a license to use the patented device "on any road now or hereafter owned," etc., covers its use on all machines on such roads, see Matthew *v.* Pennsylvania R. R. Co. (1881), 8 Fed. Rep. 45.

[4] That a license based on the pre-payment of a specific sum for each machine used, will not permit the use of other machines unless paid for in the same manner, see Wooster *v.* Seidenberg

a particular manner, or *for a period less than the duration* of the patent, binds the licensee with equal strictness, and makes him liable as an infringer for any excess of use beyond what is distinctly conferred upon him.[5] In licenses to use the law often implies the grant of other powers which in the case in question are essential to the enjoyment of the right to use.[6] A license to use a specific article carries the right to repair it as long as its identity remains.[7] A license to use a certain number of articles bestows the right to keep the number in use complete, by purchasing, or if necessary by making, new ones as the old are worn out or destroyed.[8]

§ 813. Express Licenses: License to Sell.

A license to sell confers the right to vend the patented article. Being comparatively valueless without the right to

(1875), 10 O. G. 244; 13 Blatch. 88; 2 Bann. & A. 91.

That the tender of an agreed price per machine for machines used beyond the scope of the license does not cure an infringement consisting in the use of such machines, see Steam Cutter Co. *v.* Sheldon (1872), 10 Blatch. 1; 5 Fisher, 477.

[5] That a license to use only upon specified conditions confines the use to such conditions, see Woodworth *v.* Cook (1850), 2 Blatch. 151.

That the words "licensed to use once only," if stamped on an invention, is notice that it is used under such a license and that the license expires on its first use, see American Cotton Tie Supply Co. *v.* Bullard (1879), 17 O. G. 389; 17 Blatch. 160; 4 Bann. & A. 520. *Contra:* American Cotton Tie Supply Co. *v.* Simmons (1878), 13 O. G. 967; 3 Bann. & A. 320.

That a license granted for a certain period to a person, but not to "his assigns," will expire at his death, see Oliver *v.* Rumford Chemical Works (1883), 109 U. S. 75; 25 O. G. 784.

[6] That a license to one man and "his legal representatives" of the "full and exclusive right to use and to sell to be used," reserving to the assignor the right to make "for himself and his representatives," gives to the licensee the right to make the invention, since without it the license would be valueless, see Hamilton *v.* Kingsbury (1878), 15 Blatch. 64; 14 O. G. 448; 3 Bann. & A. 346.

That an exclusive license to a person and his assigns to make and use includes a right to sell without express words to that effect, see Bellas *v.* Hays (1819), 5 S. & R. 427.

[7] That a gratuitous universal license to use machines confers the right to use them until they are used up, see Wooster *v.* Sidenberg (1875), 13 Blatch. 88; 2 Bann. & A. 91; 10 O. G. 244.

That a license "to use to the extent of one machine" includes the right to make for such use and to repair indefinitely, see Steam Cutter Co. *v.* Sheldon (1872), 10 Blatch. 1; 5 Fisher, 477.

[8] That the grant of a right "to use any number of" the patented devices, carries the right to make them and have them made, see Steam Stone Cutter Co. *v.* Shortsleeves (1879), 16 Blatch. 381; 4 Bann. & A. 364.

produce the articles to be sold, it is usually coupled with a license to make. Whether granted alone, or in connection with the right to construct the invention, it may be restricted as to time, place, and quantity, and by such restrictions the licensee is bound as rigidly as in the case of a license to use. In this, as in all other instances where a license covers two or more rights, the restrictions may apply only to one right, or in the same or different degrees to each of the rights conveyed. A license to make and sell may thus limit only the place and time of making, leaving the maker to find his market when and where he can; or it may confine his sales within a given territory, and fix no boundaries to the act of manufacture. Provisions in the license may, to the same extent, curtail the rights of purchasers of the patented article from the licensee, by limiting his power to sell it except for use within a specified area or for a certain purpose.[1] When a license to practise an art is joined with an unrestricted license to sell its product, the latter license is superfluous unless the product also is a patented invention; but if the license to sell is limited as to time or place or purpose it may operate as a

§ 815. [1] In Dorsey Revolving Harvester Rake Co. *v.* Bradley Mfg. Co. (1874), 12 Blatch. 202, Woodruff, J.: (207) "Does the right to make and sell carry with it the right to use? If, by implication, the right to use is incident to, or implied in, the right to make and sell, does not the limitation of the right to make and sell to specific territorial limits, operate with equal strictness upon the right of use which is incidental thereto or is so implied? Is the incident broader in its scope than the principal grant? If it be true, as claimed, that when one who has the whole right in the invention, to make, sell, and use (either for the whole or a part of the United States), sells a machine, it passes from under the dominion of the patent, and may be used anywhere, does that follow when a mere licensee to make and sell within specified limits sells the patented invention to another? Does the cautiously guarded decision of the Supreme Court in Adams *v.* Burke (17 Wallace, 453), carefully limited to the precise case then under consideration, reasonably import an affirmative to the last question? Especially may one having a license to make and sell within a limited territory only deliberately contract to supply the patented invention for use in other territory, provided his manufacture and his actual negotiation of sales are within the privileged limits, and may he practically avail himself of the markets of the whole country?" 1 Bann. & A. 330 (335).

That the assignee of a territorial right to make, use, and sell a machine may sell the product of the machine anywhere, as the territorial restriction relates to the machine only, see Simpson *v.* Wilson (1846), 4 How. 709; 2 Robb, 469.

condition governing the enjoyment of the former license, and confining the use of the art to the production of such results as can lawfully be sold.[2] A license to sell, or to use and sell, may embrace by implication the right to make, when, under all the circumstances of the case, the rights expressly granted would otherwise be unavailable to the licensee.[3]

§ 814. Express Licenses: Exclusive or Non-Exclusive.

Licenses may be exclusive or non-exclusive. An exclusive license confers upon the licensee the sole right to make, use, or sell the invention within the area or for the purposes described.[1] A non-exclusive license confers this right upon him in common with the licensor, and with all other persons upon whom the licensor may see fit to bestow it. The nature of the right in either case is the same; its value alone being

[2] In Boyd *v.* Brown (1843), 3 McLean, 295, *per Curiam:* (296) "There can be no doubt that the original patentee, in selling rights for counties or States, might, by a special covenant, prohibit the assignee from vending the article beyond the limits of his own exclusive right. But in such a case the remedy would be on the contract, and not under the Patent Law. For that law protects the thing patented, and not the product. The exclusive right to make and use the instruments for the construction of this bedstead in Hamilton County is what the law secures, under his assignment, to the complainant. Any one violates this right who either makes, uses, or sells these instruments within the above limits. But the bedstead, which is the product, so soon as it is sold, mingles with the common mass of property, and is only subject to the general laws of property." 2 Robb, 203 (205).

[3] That a license to use and sell carries the right to make, if without it the expressed privilege cannot be reasonably enjoyed, see Hamilton *v.* Kingsbury (1878), 15 Blatch. 64; 14 O. G. 448; 3 Bann. & A. 346.

That the right to make and sell includes the right to use, see Turnbull *v.* Weir Plow Co. (1880), 14 Fed. Rep. 108; 9 Bissell, 334; 5 Bann. & A. 288; 23 O. G. 91; also § 808 and notes, *ante*.

§ 814. [1] That a covenant in a license not to give the same right to any other is equivalent to an exclusive right in the licensee, see Day *v.* Cary (1859), 1 Fisher, 424.

That the contract of a workman to give his employer the exclusive benefit of his inventions is an exclusive license during the life of the patent, see Wilkens *v.* Spafford (1878), 13 O. G. 675; 3 Bann. & A. 274.

That a licensor granting an exclusive territorial license excludes himself and all others from using any device, though different in name, which is substantially the same, see Ferree *v.* Smith (1877), 29 La. Ann. 811.

That an exclusive license, with an agreement to assign after the license expires, is without consideration if the patent is void, such a license conveying no rights which the licensee did not already have, see Harlow *v.* Putnam (1878), 124 Mass. 553.

affected by its confinement to himself or its indefinite distribution to others. To this statement there is apparently a single exception,—an exclusive license to make and use and sell operating upon the monopoly as well as the invention and vesting both in the licensee, while a non-exclusive license of the same extent merely conveys the rights in the invention.[2] But the exception is apparent only,—such an exclusive license being in reality, though not in form, an assignment or a grant, according to the territory to which it relates.

§ 815. Express Licenses: By whom Granted: Caveat Emptor.

Any owner of a patented invention may issue licenses within the limits of his own right, in any form and to any extent which he may deem expedient. A patentee or assignee, whether sole or joint, may license for the whole or for any part of the United States. A grantee can license only within the territory covered by his ownership of the invention. A license issued by one joint-owner is valid by estoppel against the other owners, though contrary to their will, whatever remedy they have under the present law being in an account for their share of the license-fee from the licensor.[1] But no part-owner can grant an exclusive license, or in any other manner restrict the licensing powers of the other owners of the patent.[2] As between the licensee and licensor the doctrine of *caveat emptor* is rigidly applied.[3] The rights of

[2] In Mitchell *v.* Hawley (1872), 16 Wall. 544, Clifford, J.: (548) "Purchasers of the exclusive privilege of making or vending the patented machine hold the whole or a portion of the franchise which the patent secures, depending upon the nature of the conveyance." 3 O. G. 241 (242); 6 Fisher, 331 (333).

See also Pickhardt *v.* Packard (1884), 23 Blatch. 23; 30 O. G. 179; 22 Fed. Rep. 530; Nellis *v.* Pennock Mfg. Co. (1882), 13 Fed. Rep. 451; 22 O. G. 1131; Farrington *v.* Gregory (1870), 4 Fisher, 221; and § 808, note 5, *ante*.

§ 815. [1] That a license by one joint-owner is valid, see Washburn & Moen Mfg. Co. *v.* Chicago Galvanized Wire Fence Co. (1884), 109 Ill. 71; Curran *v.* Burdsall (1883), 20 Fed. Rep. 835; 27 O. G. 1319; Dunham *v.* Indianapolis & St. Louis R. R. Co. (1876), 7 Bissell, 223; 2 Bann. & A. 327; De Witt *v.* Elmira Nobles Mfg. Co. (1876), 66 N. Y. 459; Clum *v.* Brewer (1855), 2 Curtis, 506; and § 796 and notes, *ante*.

[2] See cases cited in note 1, and § 796 and notes, *ante*.

[3] That the doctrine of *caveat emptor* obliges the licensee to ascertain whether the licensor has a good title, see Abbett *v.* Zusi (1879), 5 Bann. & A. 38.

the licensee can never exceed those of his licensor, and it is his duty to ascertain, before he purchases his rights, whether the licensor is able to convey the interest he proposes to bestow.[4] No previous conveyance, whether assignment, grant, or license, can be affected by the one which he receives, and thus he takes his right subject to all the limitations these may impose upon him.[5]

§ 816. Duration of Express License: Effect of its Termination.

Unless otherwise agreed, an express license expires at the end of the original term of the patent.[1] No one but the patentee, or an assignee or grantee to whom the patentee has conveyed the extended term, can authorize the practice of the invention under the extension; and a license even by these is never presumed to cover the extended term unless such an intention clearly and unequivocally appears upon the face of the license itself.[2] A license for the "whole term for which let-

[4] That the rights of a licensee cannot be broader than those of his licensor, see Waterman *v.* Wallace (1875), 13 Blatch. 128; 2 Bann. & A. 126.

[5] That an assignee, having assigned all his interest in the patent, cannot confer any right on a subsequent purchaser to use the invention, either during the present or an extended term, see Union Paper Bag Mach. Co. *v.* Nixon (1876), 1 Flippin, 491; 2 Bann. & A. 244; 9 O. G. 691.

§ 816. [1] That a license to practise an invention expires with the patent on which it is based, see Wetherell *v.* Passaic Zinc Co. (1872), 6 Fisher, 50; 2 O. G. 471; 9 Phila. 385; Mitchell *v.* Hawley (1872), 16 Wall. 544; 3 O. G. 241; 6 Fisher, 331; England *v.* Thompson (1869), 3 Clifford, 271.

That an exclusive license expires when the term of the patent ends, see Union Paper Bag Mach. Co. *v.* Nixon (1882), 105 U. S. 766; 21 O. G. 1275.

That a grant to make and use within certain territory for the term of the patent expires with the original term, and does not remain under an extension, see Wood *v.* Michigan Southern & Northern Indiana R. R. Co. (1868), 3 Fisher, 464; 2 Bissell, 62.

That a sub-license to practise an invention expires with the term of the patent, see Hawley *v.* Mitchell (1871), 4 Fisher, 388; 1 O. G. 306; Holmes, 42.

That an express license to use an invention expires with the original patent, see Union Paper Bag Mach. Co. *v.* Nixon (1881), 105 U. S. 766; 21 O. G. 1275; Wooster *v.* Sidenberg (1876), 10 O. G. 244; 13 Blatch. 88; 2 Bann. & A. 91; Mitchell *v.* Hawley (1872), 16 Wall. 544; 3 O. G. 241; 6 Fisher, 331.

[2] That the license is presumed to cover only the original term of the patent, and one who claims that it covers the extended term must prove it, see Hodge *v.* Hudson River Railroad Co. (1868), 6 Blatch. 85; 3 Fisher, 410.

That a license may be made to endure under an extension, and the royalty will be collectible, see Union Mfg. Co. *v.* Lounsbury (1869), 41 N. Y. 363.

That a license to endure till all pat-

ters-patent are or may be granted," or under "any letters-patent granted by the United States," does not satisfy the requirements of this rule, and will be operative only during the original term.[3] The effect of the termination of the license

ents now or hereafter to be granted for the invention expire is good, and will run until the expiration of the latest patent, see McKay *v.* Mace (1884), 23 Fed. Rep. 76.

That after an extension by act of Congress the licensee stands on his original title, not on the act of Congress granting the extension, such act not conferring rights but merely protecting them, see Union Mfg. Co. *v.* Lounsbury (1869), 41 N. Y. 363.

That one who takes a license under an extension thereby admits that he has no existing rights which he did not then set up, and is estopped from asserting them against the patentee, see Wooster *v.* Taylor (1874), 12 Blatch. 884; 1 Bann. & A. 594; 8 O. G. 644.

[3] In Hodge *v.* Hudson River Railroad Co. (1868), 6 Blatch. 85, Blatchford, J.: (89) "The presumption of law in regard to every license under a patent is that the parties deal in regard only to the term existing when the license is given, unless an express provision is inserted looking to a further interest. (Wilson *v.* Rousseau, 4 How. 646, 685, 686). Unless there be such a stipulation, showing that the parties contemplated an extension, the court is bound to construe the instrument, in each and all of its provisions, as relating to the then existing term only. (Gibson *v.* Cook, 2 Blatchf. C. C. R. 144, 146.) The language of the license in the present case is very different from the language of the instrument in the case of Phelps *v.* Comstock (4 McLean, 353). In that case the language was 'to the full end of the *term or terms* for which *letters-patent* are or may be granted for said improvements.' The court held that that language embraced any subsequent extension of the patent. So, also, in Case *v.* Redfield (4 McLean, 526), where the court held that the language of the instrument embraced an extension, the language was 'all the right, title, and interest . . . in said invention and improvement, as secured . . . by said letters-patent, for the whole of the United States, . . . for which *letters-patent* were or may be granted for said improvements.' In Clum *v.* Brewer, (2 Curtis, C. C. R. 506, 508), where the court held that the parties intended to cover an interest in any extension, the language was 'one undivided fourth part of my said invention, and of all my rights and property therein, secured by my said caveat or otherwise, that I have or may have from *any letters-patent* for the same, granted by the Government of the United States and within the limits thereof.' In Pitts *v.* Hall (3 Blatchf. C. C. R. 201), where the court held that there was no doubt that the parties intended by the language used to refer to and provide for an extension, the language to that effect was clear and unambiguous. In all four of the cases referred to, the instrument under consideration was one purporting to convey, by assignment or grant, an interest in the invention patented, and an interest in the entire right granted by the existing patent to make and use and vend to others to be used the invention patented. As Mr. Justice Curtis says, in Clum *v.* Brewer (p. 521), 'where the invention is the subject sold it would be natural to expect to find, in the instrument of sale, something showing an intention that the purchaser should be interested, not merely in the original letters-patent, but in any ex-

upon the privileges of the licensee, however, differs according to the right which forms the subject-matter of the license, and the class to which the patented invention properly belongs. If the invention is an instrument a license to make it, or to sell it, expires with the original term of the patent, and no further manufacture or sale will be lawful without a license under the extension.[4] But a license to make and use, or a license to use a particular instrument manufactured under the patent and duly sold to the licensee, remains in force, so far as the use is concerned, until the instrument made or purchased is worn out and can no longer be repaired without destroying its identity.[5] A license to use a certain number

tension thereof, securing the exclusive right to the same invention which was the subject of the sale.' In the present case neither the invention, nor any interest in it, nor any interest in the entire right covered by the patent was granted, but merely a license to use the invention, and to construct brakes containing it for such use on certain cars, on a certain railroad; and such license is to continue during *the term* for which *said* letters-patent are or may be granted. *The term* for which *said* letters-patent — that is, the letters-patent granted October 2d, 1849, and re-issued March 1st, 1853 — were granted, or might be granted, was a term ending October 2d, 1863. It is impossible, on any fair construction of the language, and in view of the adjudged cases, to hold that the license was intended by the parties to cover an extended term of the patent." 3 Fisher, 410 (414).

See also Wetherell *v.* Passaic Zinc Co. (1872), 6 Fisher, 50; 2 O. G. 471; 9 Phila. 385.

[4] That a license to make or to sell, or to make and sell, a patented article expires with the original patent unless otherwise provided in the license, see Mitchell *v.* Hawley (1872), 16 Wall. 544; 3 O. G. 241; 6 Fisher, 331; Wood *v.* Michigan Southern R. R. Co. (1868), 2 Bissell, 62; 3 Fisher, 464. That a license to make, use, and sell *runs for the term of the patent*, see Birdsell *v.* Shaliol (1884), 112 U. S. 485; 30 O. G. 261.

[5] In Mitchell *v.* Hawley (1872), 16 Wall. 544, Clifford, J.: (548) "Purchasers of the exclusive privilege of making or vending the patented machine hold the whole or a portion of the franchise which the patent secures, depending upon the nature of the conveyance; and of course the interest which the purchaser acquires terminates at the time limited for its continuance by the law which created the franchise, unless it is expressly stipulated to the contrary. But the purchaser of the implement or machine for the purpose of using it in the ordinary pursuits of life stands on different grounds, as he does not acquire any right to construct another machine either for his own use or to be vended to another for any purpose. Complete title to the implement or machine purchased becomes vested in the vendee by the sale and purchase; but he acquires no portion of the franchise, as the machine when it rightfully passes from the patentee to the purchaser, ceases to be within the limits of the monopoly." 3 O. G. 241 (242); 6 Fisher, 331 (333).

In Wetherell *v.* Passaic Zinc Co. (1872), 2 O. G. 471, McKennan, J.:

of patented instruments in like manner confers upon the licensee the right to keep that number in employment during

(474) "A broad distinction is thus indicated between the use of an invention and the use of a patented machine. While the right to the use of the invention expires with the end of the term of the original patent, the right to the continued use of the machine which embodies it is protected. The law did not intend to revive an assignment or grant which expired with the term of the original patent, but to protect a species of tangible property, sold by the patentee, the value of which depended chiefly upon the owner's right to use it, and which, without some saving provision, would fall within the grasp of the exclusive rights vested in the patentee by the extension. It was manifestly, then, something less than the entire right to use the invention which the act contemplated. What that is is clearly stated in the opinion of the court, not as a dictum of the judge who delivered it, but as an exposition of the meaning of the act, which was necessary to a decision of the cause. 'The thing patented' is the subject of the use, and the court say, where these words are employed in the act in connection simply with the *right* to use, they refer only to the patented machine, and not to the invention. This, then, is an authoritative definition of their significance in the clause in question, and they must therefore be taken to mean a specific machine, and, in connection with the other words of the clause, to confer a right to use *it*, 'nothing more.' And it has since been held that this right is restricted to the mere use, and does not cover the reconstruction of the machine. It necessarily follows that this saving clause is applicable only to inventions which are susceptible of embodiment in a substantial and tangible form, and not to those which consist in a formula for producing prescribed results, and when those results are obtained there is an end of the thing patented, and which, as often as it is employed in practice, involves the renewed use or reproduction of the entire invention." 6 Fisher, 50 (58); 9 Phila. 385 (389).

In Hawley *v.* Mitchell (1871), 1 O. G. 306, Shepley, J.: (307) "No words of limitation, however clearly expressed, confining an *assignee's* right to the original term, will have any effect to deprive the assignee or his assigns of the right to use, during the extended term of the patent, machines lawfully constructed and used by them during the original term. But this right applies only to machines which have passed outside of the monopoly by a lawful sale of the whole monopoly in the particular machine during the original term." Holmes, 42 (44); 4 Fisher, 388 (390).

In Wood *v.* Michigan Southern & Northern Indiana R. R. Co. (1868), 2 Bissell, 62, McDonald, J.: (65) "To every assignee or grantee of a patent holding the right, at the expiration of the first *term* of it, to use the *thing* patented, this section of the act plainly gives the same right to use it during the term of the renewal of the patent, exactly to the extent to which he had the right to use it under the first term of the patent. And it is clear that he may not only use it, but repair it for use till it is worn out. So the Supreme Court has decided. On the contrary, it is equally clear that this section does not authorize the assignee or grantee either to sell or to manufacture for sale the thing patented; for the terms of the section only embrace 'assignees and grantees of the right to *use*.' . . . (67) The same doctrine was adhered to in

the original term, to replace them with others as they become unserviceable, and to use those actually on hand when the patent expires until they are no longer capable of use.[6] A general license to use the invention, having no reference to particular instruments or to a specific number of the patented articles, and not granted in connection with an unrestricted sale of

Wilson *v.* Simpson, 9 How. 109. And Mr. Justice Wayne, in delivering the opinion of the court in that case, said that the decision in Wilson *v.* Rousseau 'does not permit an assignee of the first term of a patent, after its renewal and extension, to make other machines.' The subsequent cases of Bloomer *v.* McQuewan, 14 How. 539; Chaffee *v.* The Boston Belting Co., 22 How. 217; Bloomer *v.* Millinger, 1 Wallace, 340,—all recognize and approve the same doctrine. The doctrine established in all these cases 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 time of its subsequent extension, continue to use it, and even repair it for use; but that he cannot make it for use, or for any other purpose. It is true that in the cases in the Supreme Court referred to, there was a remarkable diversity of opinion among the judges. But that diversity had no reference to anything favorable to the defence in this case. It seems to have arisen solely from an opinion, on the part of the minority of the judges, that the assignee of a patent for its first term had no right even to *use* the thing patented after the expiration of that term, unless the assignment, by its terms, gave him that right. And this circumstance may well admonish us not to extend this right to the thing patented." 3 Fisher, 464 (468).

See also Union Paper Bag Mach. Co. *v.* Nixon (1882), 105 U. S. 766; 21 O. G. 1275; Eunson *v.* Dodge (1873), 18 Wall. 414; 5 O. G. 95; Brooks *v.* Bicknell (1845), 4 McLean, 64.

That the right to use includes the right to repair and to purchase new when the old are worn out, see Bicknell *v.* Todd (1851), 5 McLean, 236.

That a right to use subsists with the same limitations as to place, etc., after an extension as before, see Day *v.* Union India Rubber Co. (1856), 3 Blatch. 488.

That the owners of an extension and their grantees take their title subject to the rights of the existing owners of the patented devices, see Union Paper Bag Mach. Co. *v.* Nixon (1882), 105 U. S. 766; 21 O. G. 1275.

That a licensee is neither an assignee nor a grantee, under Sec. 4928, Rev. Stat., but must be a purchaser of the patented article or be protected by some agreement of sale lawfully made by the owner of the patent, see Wooster *v.* Sidenberg (1875), 10 O. G. 244; 13 Blatch 88; 2 Bann. & A. 91.

That where an agent of the patentee, for a valuable consideration, licenses another to construct a device embodying the invention, the patentee has no right to the device, but the licensee may use the invention in connection with such device even under an extension, see Black *v.* Hubbard (1877), 3 Bann. & A. 39; 12 O. G. 842.

[6] That a license to use one device is a license to make one for use and to use it until it is worn out, and to supply its place with another and so on, till the patent expires, and then to use the one at that time in use until it is also worn out, see Woodworth *v.* Curtis (1847), 2 W. & M. 524; 2 Robb, 603.

the patented article, on the contrary, expires with the patent.[7] If the invention is an art, a license to use it is a license to practise the invention as a whole, and in analogy with the preceding rules should also terminate with the original patent.[8] But it has been held that such a license granted by the patentee, or by an assignee to whom the extension has already been conveyed, continues during the extended term and authorizes the licensee not only to employ the process but to procure new apparatus for its use after the extension.[9] These various rights the licensee will waive if he takes a new license from the owners of the extended term.[10] A license to a specific person ceases at his death.[11]

§ 817. Express License not Recordable.

A license is not such a conveyance of an interest in the patented invention as to affect its ownership, and hence is not required to be recorded.[1] All subsequent purchasers

[7] That a general license to use expires with the patent, see Union Paper Bag Mach. Co. *v.* Nixon (1882), 105 U. S. 766; 21 O. G. 1275; Wooster *v.* Sidenberg (1875), 10 O. G. 244; 13 Blatch. 88; 2 Bann. & A. 91.

[8] That the grant of a right to use a process, even though coupled with the sale of apparatus suitable for use in that process, does not convey the right to use the process during an extension, see Wetherell *v.* Passaic Zinc Co. (1872), 2 O. G. 471; 9 Phila. 385; 6 Fisher, 50.

[9] That the right to practise a patented process, if derived from the patentee himself, continues during an extension, even against an assignee of the extended term, and even though the licensee makes new apparatus to do it with after the extension, see Day *v.* Union India Rubber Co. (1856), 3 Blatch. 488.

[10] That where a licensee has articles in use at the expiration of the patent, and has the right to use them during the extension and until they are used up, but takes a new license under the extension and forfeits it, his old license cannot avail him even as to these articles, see Wooster *v.* Taylor (1874), 12 Blatch. 384; 1 Bann. & A. 594; 8 O. G. 644.

[11] That a personal license granted for a certain period will expire at the death of the licensee unless also granted to his assigns, see Oliver *v.* Rumford Chemical Works (1883), 109 U. S. 75; 25 O. G. 784.

That under a personal and unassignable license to make and sell, the articles on hand at the death of the licensee may be sold by his representatives, see Montross *v.* Mabie (1887), 30 Fed. Rep. 234; 41 O. G. 931.

§ 817. [1] That a license need not be recorded, see Hamilton *v.* Kingsbury (1879), 17 Blatch. 264; 17 O. G. 147; 4 Bann. & A. 615; Chambers *v.* Smith (1870), 5 Fisher, 12; Farrington *v.* Gregory (1870), 4 Fisher, 221; Brooks *v.* Byam (1843), 2 Story, 525; 2 Robb, 161.

take their titles subject to the rights of existing irrevocable licensees, as assignees of other property receive it subject to the obligations imposed upon it by the contracts of its previous owners.[2] The value of the patented invention to the vendee may be impaired by such outstanding licenses, but of this he must inform himself at his own risk as best he may. The record of a license, not being legally required, is not constructive notice to any person or for any purpose.[3]

§ 818. Express Licenses: How Construed.

A license is construed by the courts according to the intention of the parties, as manifested by the language they employ.[1] If the license is in writing all previous parol agreements covering the same subject-matter are merged in the written instrument, and oral evidence is not admissible to expand, contract, or vary its provisions.[2] When several licenses or other contracts constitute together one transaction, all are to be considered in the interpretation of each, as if they were a single instrument.[3] The scope of any license, if general in its terms, is to be limited by the patent on which it is based; and where the conduct of the parties and their dealings with each other have given a practical construction to the conveyance, not inconsistent with its letter, this also is regarded in determining its meaning.[4] A license conferred before the is-

[2] That an irrevocable license is good without record against subsequent purchasers of the patent, see Farrington *v.* Gregory (1870), 4 Fisher, 221.

[3] That the record of a license is not constructive notice, see Chambers *v.* Smith (1870), 5 Fisher, 12.

§ 818. [1] That a license is to be construed by the intent of the parties, see Wetherell *v.* Passaic Zinc Co. (1872), 2 O. G. 471; 9 Phila. 385; 6 Fisher, 50.

That in enforcing a license the courts will follow the contract, not the moral conditions outside it, see *Ex parte* Fuller (1874), 5 O. G. 643.

[2] That a parol agreement, made before a written license, is merged in the license, see Evory *v.* Candee (1879), 17 Blatch. 200; 4 Bann. & A. 545.

That oral evidence is not admissible to explain a written license, but the parties must stand by it as made, see Troy Iron & Nail Factory *v.* Corning (1849), 1 Blatch. 467.

[3] That several contracts for sale and license, made between the same parties on the same day, may all be construed together, see Hammond *v.* Mason & Hamlin Organ Co. (1875), 92 U. S. 724.

[4] That a license is limited in scope by the patent on which it is based, see Stuart *v.* Shantz (1872), 6 Fisher, 35; 2 O. G. 524.

That a license to use the invention

sue of the patent must be construed as applying to the actual invention patented, however this may differ from the one described and claimed in the original application.[5]

§ 819. Reciprocal Rights and Duties of Licensors and Licensees.

The reciprocal rights and duties of licensors and licensees are determined by the express provisions of the license, and by implication of law from the relation which exists between them. If the licensee fulfils the conditions of the license, he is entitled to enjoy the privileges therein conferred upon him without interference from the licensor, and to be protected by the licensor against the violation of his rights by others.[1] Corresponding to this right of the licensee is the duty of the

covered by one Claim of a patent gives no right to use the inventions covered by its other Claims, see United Nickel Co. *v.* California Electrical Works (1885), 25 Fed. Rep. 475.

That the practical construction given to a license by the act of the parties is of great weight, see Rubber Co. *v.* Goodyear (1869), 9 Wall. 788.

[5] That a license given pending an application for a patent covers the patent as granted, however it may differ from the original application, see Kelly *v.* Porter (1883), 17 Fed. Rep. 519 ; 8 Sawyer, 482.

§ 819. [1] In Cohn *v.* National Rubber Co. (1878), 3 Bann. & A. 568, Clifford, J. : (568) "Inventors whose inventions are secured by valid letters-patent have the exclusive right, for the period allowed by law, to make, use, and vend the thing patented ; and by virtue of that right they may assign the patent, or license others to practise the invention. Persons duly licensed by the owner of the patent may make, use, and vend the patented product, within the terms and conditions of their license, without hindrance or interruption by the patentee, if they themselves comply with those terms and conditions." 15 O. G. 829 (829).

That a licensee, acting within his license, is not an infringer, see Kelly *v.* Porter (1883), 8 Sawyer, 482 ; 17 Fed. Rep. 519.

That a licensee cannot extend his license by acting beyond its terms, even where the conduct of his licensor is hostile, see Aspinwall Mfg. Co. *v.* Gill (1887), 40 O. G. 1133 ; 32 Fed. Rep. 697.

That a licensee, authorized to sell materials to be used in a patented process to the licensees of such process, becomes an infringer if he sells the materials for use to others known by him not to be licensees, see Willis *v.* McCullen (1886), 38 O. G. 1017 ; 29 Fed. Rep. 641.

That a license does not free the licensee from liability when he infringes a different patent not owned by the licensor, see Stuart *v.* Shantz (1872), 6 Fisher, 35 ; 2 O. G. 524.

That a licensee may deny that his acts are infringements even though his contract forbids him to deny it, see White *v.* Lee (1882), 23 O. G. 1621 ; 14 Fed. Rep. 789.

That a licensee is bound by his license though he neglects to read it before signing or accepting it, see McKay *v.* Jackman (1883), 17 Fed. Rep. 641.

licensor not to permit others to use gratuitously the privilege for whose enjoyment the licensee is compelled to pay, and to prosecute infringers whenever their wrongful acts become injurious to the licensee.[2] If the license is granted upon con-

[2] In Goodyear *v.* Honsinger (1867), 2 Bissell, 1, Drummond, J. : (8) "It was unfair, and is always unfair, to those who are licensed to use the particular article or method, under letters-patent, to allow others to use what the licensees have thus purchased. It is true that this conduct may be explained. There may be circumstances such as would not warrant any inference against the patentee, from such conduct; as, for instance, if the patentee were unable to prosecute the parties thus infringing the patents; or, if circumstances were such as to indicate that there was no acquiescence, expressed or implied, in the violation; or, as appears in this case, that there was a suit pending in one of the circuit courts of the United States, where the right under the patent was to be tested. That would constitute a reason why the patentee, or those claiming under him, should not involve themselves in great expense while there might be a question as to the validity of the patent." 3 Fisher, 147 (153).

That an exclusive license implies no warranty against infringers, see Baker *v.* Mason (1854), 3 R. I. 45.

That a licensor fulfils his agreement to prosecute infringers if he stops the infringement in any way, see Foster *v.* Goldschmidt (1884), 22 Blatch. 287; 21 Fed. Rep. 70 ; 28 O. G. 915.

That a licensor covenanting to sue infringers, not to license others, and to use diligence in securing the licensee's rights, is not bound to protect the licensee against those who claim under adverse patents, nor does he warrant against them, nor is he estopped to deny the validity of the patent in an action against him for not suing, or for

That a patentee, after granting an exclusive license for the term of the patent and agreeing to assign the extended term, cannot contract with third parties against the interests of his licensee, see Adams *v.* Bridgewater Iron Co. (1880), 20 Fed. Rep. 324 ; 34 O. G. 1045.

That a new license, granted to others in violation of the rights of an existing licensee, makes the licensor liable for all damage resulting, see Pitts *v.* Jamison (1853), 15 Barb. 310.

That an agreement by the licensor not to license any other person is broken by every concession, by suit or otherwise, which operates as a recognition of the rights of others to make and use, whether they are later patentees or not, see Jackson *v.* Allen (1870), 120 Mass. 64.

That where a licensor agrees that royalties shall be reduced if subsequent licenses are granted to others upon lower terms, the licensee cannot insist on the reduction unless he accepts the other burdens imposed upon the later licensees, see Foster *v.* Goldschmidt (1884), 22 Blatch. 287 ; 21 Fed. Rep. 70 ; 28 O. G. 915.

That a licensor will not be enjoined from suing for his license fees on the ground that he charges the plaintiffs more than he agreed to, their relief being at law, but he may be enjoined from declaring the license void and thus causing damage to the plaintiffs, see Baker Mfg. Co. *v.* Washburn & Moen Mfg. Co. (1883), 18 Fed. Rep. 172 ; 5 McCrary, 504.

That suing out and serving an injunction is a breach of the licensor's contract,

dition precedent, the condition must be performed before the privileges described can vest in the licensee, and any premature exercise of them will be an infringement of the patent, and render the licensee liable to an injunction.[3] Pending the license, a violation of its concurrent conditions by the licensee suspends his privileges, and subjects him to an action for a breach of contract.[4] If he persists in using them after he has, either by words or conduct, repudiated his license, he may be sued as an infringer, and cannot plead his license as a defence.[5] When the license is not made irrevocable by its terms, or paid for by a gross sum in advance, the licensor may recall it on condition broken;[6] but an unconditional license, limited

see Sullings *v.* Goodyear Dental Vulcanite Co. (1877), 36 Mich. 313.

That a license may be annulled on account of fraudulent representations of the licensor as to the salability of the invention, see Hull *v.* Fields (1882), 76 Va. 594.

[3] In Goodyear *v.* Congress Rubber Co., (1856), 3 Blatch. 449, Ingersoll, J.: (455) "When a license is granted to any one to use a patent in the manufacture of goods, which license is accompanied with an obligation, in favor of the patentee, on the part of the one to whom it is granted, to do or not to do a particular thing, and which obligation is the consideration upon which the license is granted, he upon whom the obligation rests must perform it, and, if he will not perform it, an injunction will be granted to restrain him from any further right to use the patent under the license."

[4] That a licensee, violating the provisions of his license, may be sued on the contract or for infringement, and if the suit is on the contract the damages are the damages from the infringement, see Magic Ruffle Co. *v.* Elm City Co. (1875), 8 O. G. 773; 13 Blatch. 151; 2 Bann. & A. 152.

[5] In Colin *v.* National Rubber Co. (1878), 3 Bann. & A. 568, Clifford, J.: (571) "Licensees, if they fulfil the stipulations of their licenses, are entitled to practise the invention within the terms and conditions of the instrument, to the extent of the authority conferred without question or impediment by the owner of the patent. Doubt upon that subject cannot be entertained; but if they refuse to perform on their part, and repudiate the license, they may be treated by the owner of the patent, at his election, as infringers. He may have his remedy by suit upon the license, in case they have repudiated the license, or he may elect to treat them in future as infringers of his exclusive rights under the patent. Being infringers, they cannot set up the license in defence of a suit, any more than if they had never possessed any such authority." 15 O. G. 829 (830).

See also Moody *v.* Taber (1874), Holmes, 325; 5 O. G. 273; 1 Bann. & A. 41; Brooks *v.* Stolley (1845), 3 McLean, 523; 2 Robb, 281.

That a purchaser from a repudiating licensee, with notice, will be an infringer, see Moody *v.* Taber (1874), 1 Bann. & A. 41; 5 O. G. 273; Holmes, 325.

[6] That where a license is conditional a breach of the condition will avoid the license at the option of the licensor, see

in duration by the life of the patent, is irrevocable.[7] The surrender of a license by one of several joint-licensees does not affect the privileges of the others.[8]

§ 820. Licensee under Express License: When Estopped to Deny Validity of the Patent.

A licensee, having accepted a license, and while exercising under its protection the rights therein conferred, is estopped from denying the validity of the patent in any suit in which such exercise of his license privileges is the basis of the controversy.[1] In the absence of express provisions in the license

Woodworth *v.* Cook (1850), 2 Blatch. 151.

That where a license is avoided for breach of condition both parties are remitted to their original rights, and the licensee may defend against the patent, as if there were no license, see Woodworth *v.* Cook (1850), 2 Blatch. 151.

[7] That a license, unlimited as to time and not conditioned otherwise than on the grant of the patent, is irrevocable, see Kelly *v.* Porter (1883), 8 Sawyer, 482; 17 Fed. Rep. 519.

[8] That the surrender of a license by a part of the licensees does not avoid it as to the others, see Theberath *v.* Celluloid Mfg. Co. (1880), 3 Fed. Rep. 143; 5 Bann. & A. 577.

§ 820. [1] That an assignor taking a license under his assignee is estopped to deny the validity of the patent, see Consolidated Middlings Purifier Co. *v.* Guilder (1881), 3 McCrary, 186; 9 Fed. Rep. 155.

That a licensee who has enjoyed without disturbance the benefit of a patent cannot dispute its validity in a suit for compensation, see Deane *v.* Hodge (1886), 35 Minn. 146.

That an exclusive licensee, not evicted, and benefiting by the license, cannot impeach the patent on a suit for royalties, see Rogers *v.* Reissner (1887), 41 O. G. 351; 30 Fed. Rep. 525; McKay *v.* Jackman (1883), 17 Fed. Rep. 641; White *v.* Lee (1882), 14 Fed. Rep. 789; 23 O. G. 1621.

That a defendant in a suit brought to recover license fees, payable according to the quantity made, cannot deny the validity of the patent unless fraud has been practised upon him, for having had the benefit he must pay for it, see Wilder *v.* Adams (1846), 2 W. & M. 329.

That a purchaser from the licensee is not estopped to deny the validity of the patent, in a suit for infringement, see Baltimore Car Wheel Co. *v.* North Baltimore Passenger R. R. Co. (1884), 21 Fed. Rep. 47.

That a licensee is not necessarily estopped by his license, nor prevented from making any defence that any other defendant could, see Burr *v.* Duryee (1862), 2 Fisher, 275.

That a licensee, while claiming under the license, is estopped to deny the validity of the patent, see Brown *v.* Lapham (1886), 23 Blatch. 475; 27 Fed. Rep. 77; 37 O. G. 676; Baltimore Car Wheel Co. *v.* North Baltimore Passenger Ry. Co. (1884), 21 Fed. Rep. 47.

That a licensee cannot deny the consideration of his license after long delay and the enjoyment of all its benefits, see Davis *v.* Gray (1867), 17 Ohio St. 330.

That a licensee sued for license fees may deny the originality of the inven-

to the contrary, however, he may repudiate the license, cease to claim its protection, and as to his future exercise of the privileges described therein defend himself upon the ground that the patent is invalid.[2] After such a repudiation of the license he may also dispute the validity of the patent in actions against him for license fees for the past making or use of the invention, but not for royalties on completed sales.[3] When the license in its terms admits the validity of the patent, and provides that no act of either party shall impair the effect of this admission, the licensee cannot, at any time during the period for which the license was granted, attack the patent in his own defence.[4] Neither an offer to take a

tion unless the license estops him, see Morse Arms Mfg. Co. *v.* U. S. (1880), 16 Ct. of Cl. 296.

That although a patent may not be good for all it claims, a licensee taking its benefits cannot set up its invalidity in a suit against him for royalties, see Milligan *v.* Lalance & Grosjean Mfg. Co. (1884), 21 Fed. Rep. 570; 29 O. G. 367.

[2] That a licensee cannot repudiate his contract without notice to his licensor, see Marsh *v.* Dodge (1875), 4 Hun, 278.

That where a licensee has the right to terminate the license on a three months notice, and notifies the licensor of his present intention to terminate it after three months, this is sufficient notice, see Wilde *v.* Smith (1879), 8 Daly, 196.

That a licensee, having repudiated his license with the knowledge of the licensor, may dispute the validity of the patent, see Brown *v.* Lapham (1886), 23 Blatch. 475; 27 Fed. Rep. 77; 37 O. G. 676; White *v.* Lee (1880), 3 Fed. Rep. 222; 5 Bann. & A. 572.

That if the licensor repudiates the license, the licensee is not estopped thereby, see Baltimore Car Wheel Co. *v.* North Baltimore Passenger Ry. Co. (1884), 21 Fed. Rep. 47.

[3] For the cases in which a licensee can or cannot dispute the validity of the patent in actions for license-fees and royalties due before his repudiation, see §§ 1251, 1252, and notes, *post*.

[4] That a licensee is estopped to deny the validity of the patent, while the license is in force, if the license so provides, see Pope Mfg. Co. *v.* Owsley (1886), 27 Fed. Rep. 100; 37 O. G. 781; Magic Ruffle Co. *v.* Elm City Co. (1875), 13 Blatch. 151; 8 O. G. 773; 2 Bann. & A. 152.

That if a licensee binds himself not to deny the validity of the patent, his only defence is that he keeps within his license, see Pope Mfg. Co. *v.* Owsley (1886), 27 Fed. Rep. 100; 37 O. G. 781.

That a license is not affected by judgments in favor of third parties against the validity of the patent, if the licensee agreed not to dispute it, see Pope Mfg. Co. *v.* Owsley (1886), 27 Fed. Rep. 100; 37 O. G. 781.

That where a license admits that the patent was lawfully granted, and provides that the revocation shall not impair the effect of this admission, the licensee is estopped to deny the validity of the patent, see Every *v.* Candee (1879), 17 Blatch. 200; 4 Bann. & A. 545.

That a licensee under a license ad-

license, nor an expired license under which the defendant no longer claims, works such an estoppel.[5] A licensee stamping articles answering to the description given in the patent with the name and date of the patent thereby admits that they were made under the protection of his license, and as to these is estopped from disputing the validity of the patent or his own obligations to the licensor.[6]

§ 821. Express License: Consideration Therefor: Royalties.

The consideration for the license, moving from the licensee to the licensor, may be money or any other object or obligation, as the parties may agree. Where the consideration is in money, it may be payable in a gross sum either in advance or at any other specified time, or it may be payable in periodical instalments, or in amounts determined by the extent to

mitting the validity of the patent, and binding him to defend it, is estopped to deny the patent and must pay royalties while he uses the invention, see Washburn & Moen Mfg. Co. *v.* Cincinnati Barbed Wire Fence Co. (1884), 22 Fed. Rep. 712.

That an agreement not to set up the invalidity of the patent as a defence, except under special circumstances, will be enforced, see Ball *v.* Murry (1848), 10 Pa. St. 111.

That a covenant by the licensee as to the mode of using the invention does not estop him to deny the validity of the patent when sued thereon, see Bliss *v.* Negus (1811), 8 Mass. 46.

That an agreement not to deny the validity of the patent will prevail, whatever the invalidity may consist in, see Heilner *v.* Battin (1856), 27 Pa. St. 517.

That taking a license for a definite period does not operate as an admission of validity after that period, nor work an estoppel, see Rich *v.* Atwater (1844), 16 Conn. 409.

That a licensee is not estopped in equity from denying the validity of the patent on an infringement suit, unless the license expressly estops him, see National Mfg. Co. *v.* Meyers (1881), 7 Fed. Rep. 355.

[5] That an offer to take a license does not estop the offeror from denying the validity of the patent, see Evans *v.* Eaton (1816), Peters, C. C. 322; 1 Robb, 68.

That an expired license is no bar to the denial of the validity of the patent, see Blatherwick *v.* Carey (1881), 10 Bissell, 494; 9 Fed. Rep. 202.

That one who was formerly a licensee and also claimed to own the patent is now estopped to deny its validity, see Burr *v.* Kimbark (1886), 28 Fed. Rep. 574; 37 O. G. 1480.

[6] That when licensees stamp articles with the name and date of the patent they admit that the articles were made under the patent, see Jones *v.* Vankirk (1865), 2 Fisher, 586.

For a review of the cases concerning estoppel of licensee, see Morse Arms Mfg. Co. *v.* U. S. (1880), 16 Ct. of Cl. 296; and §§ 1250–1252, and notes, *post*.

which the licensee has practised the invention.[1] When the license is paid for by a gross sum in advance, it is not revocable by the licensor unless expressly so provided; but if by periodical license-fees or royalties, the question of its revocability is not affected by their payment.[2] A licensee remains liable for his license-fees or royalties until evicted by the licensor, although it is the duty of the licensor, unless otherwise agreed, to demand them and not wait for the licensee to pay them.[3] A failure to make the stipulated payments

§ 821. [1] That a licensee acting within his license is liable only for the royalty agreed on, see Kelly *v.* Porter (1883), 17 Fed. Rep. 510; 8 Sawyer, 482.

That a licensee is liable for royalties while he takes the benefit of any of the patents covered by his license, see Pope Mfg. Co. *v.* Owsley (1886), 27 Fed. Rep. 100; 37 O. G. 781.

That on a license to practise the invention, as distinguished from selling, the royalty is not collectible if the patent is worthless, see Jenkins *v.* Abbotts (1874), 54 N. H. 447.

That a licensee is liable for royalties on a patent apparently valid, until the patent is rescinded, or revoked, or notice is given to the licensor that no more royalties will be paid, see Marston *v.* Swett (1880), 82 N. Y. 526.

That after a patent has been annulled and priority awarded to another, no more royalties can be recovered, see Marston *v.* Swett (1880), 82 N. Y. 526.

That an agreement to pay a certain royalty on every article made on the patented machine, is not an agreement to run the machine to its utmost capacity, see Newell *v.* Wheeler (1867), 36 N. Y. 244.

That an agreement in a license to pay a certain royalty for each of a certain number of devices is not an agreement to make and pay for the whole number, see Babcock *v.* Northern Pac. R. Co. (1886), 26 Fed. Rep. 756; 36 O. G. 942.

That an agreement to pay royalties to a certain amount within a specified time, and the other accruing royalties within a year, obliges the licensee to pay the amount absolutely, and whatever other royalties may accrue within the year, see Babcock *v.* Northern Pac. R. Co. (1886), 26 Fed. Rep. 756; 36 O. G. 942.

That where royalties are made payable quarterly on the first days of January, April, July, and October, and the license is dated and executed January 7th, the first royalty becomes payable April 1st, see Dare *v.* Boylston (1880), 6 Fed. Rep. 493; 18 Blatch. 548; 19 O. G. 725.

That a right to royalties is property, and is insurable like other property, and its owner has an insurable interest in the factory where the articles are made, see National Filtering Oil Co. *v.* Citizens Insurance Co. (1885), 34 Hun, 556.

[2] That a license fully paid for in advance, and not upon condition, is irrevocable, see Wood *v.* Wells, Crittenden & Co. (1873), 6 Fisher, 382.

[3] That royalties must be paid unless there has been an eviction, see McKay *v.* Jackman (1883), 17 Fed. Rep. 641; White *v.* Lee (1882), 14 Fed. Rep. 789; 23 O. G. 1621.

That it is the duty of a licensor to demand the license fee if he has no other agreement, and not wait for the

renders the licensee liable to an action at law to recover them, and to a proceeding in equity for the rescission of the license, but does not authorize the licensor to treat the license as already forfeited, and prosecute the licensee for an infringement.[4]

§ 822. Express License: How Forfeited.

It was formerly held that any breach of condition by the licensee, even the non-payment of royalties or license-fees, forfeited his license and made him an infringer of the patent.[1] This doctrine is in harmony with the nature of a license, which is not merely the conveyance to the licensee of an interest in the invention, but also an agreement not to exercise against him the prohibitory powers created by the patent, provided he fulfils the obligations which he has assumed. His failure to fulfil these obligations ought, therefore, to remove the restraint imposed upon the licensor by the agreement and enable him at once to enforce his monopoly against the offending licensee. Two practical difficulties, however, attend the application of this doctrine: one, that it permits the licensor to inflict the extreme penalty, of his own motion, for every trifling violation of his contract by the licensee; the other, that in suits for infringement, when a license is set up as a defence and its forfeiture alleged, a multiplicity of issues may arise, not involving the actual merits of the cause and preventing ultimate justice to the parties. To avoid the first of these difficulties, the doctrine has been modified by the courts so far as to require an ex-

licensee to pay it, see Dare *v.* Boylston (1880), 6 Fed. Rep. 493; 18 Blatch. 548; 19 O. G. 725.

[4] See § 822 and notes, *post*.

That an agreement by parol with a licensee that if he becomes satisfied that the patent is void he need pay no royalties is no defence to a suit for license fees, under a written license, see Evory *v.* Candee (1879), 17 Blatch. 200; 4 Bann. & A. 545.

That where the defendant claims under a license and sustains his claim, a decree may be made against him for overdue license fees, see McKay *v.* Jackman (1882), 20 Blatch. 466; 22 O. G. 85; 12 Fed. Rep. 615.

§ 822. [1] That a license paid for by notes, and forfeitable for non-payment, is forfeited by the failure to pay the first note, see Woodworth *v.* Weed (1846), 1 Blatch. 165.

That a conditional license is avoidable at the option of the licensor for breach of condition, see Woodworth *v.* Cook (1850), 2 Blatch. 151.

press stipulation to that effect in the license in order for a mere breach of condition to work a forfeiture.[2] To overcome the second, later decisions hold that licenses containing express stipulations for their forfeiture are not *ipso facto* forfeited upon condition broken, but remain operative and pleadable until rescinded by a court of equity.[3] The reme-

[2] That a breach of the covenant in a license does not work a forfeiture *per se*, unless it is so expressly agreed, see Consolidated Middlings Purifier Co. *v.* Wolf (1886), 37 O. G. 567; 28 Fed. Rep. 814; White *v.* Lee (1880), 5 Bann. & A. 572; 3 Fed. Rep. 222.

That a license to make and sell, not limited on its face, cannot be terminated by the licensee, without the consent of the licensor, see Starling *v.* St. Paul Plow Works (1887), 29 Fed. Rep. 790.

That a license may be conditioned to become void if the patent is infringed, see Wood *v.* Wells, Crittendon, & Co. (1873), 6 Fisher, 382.

For the construction of a special contract as to revocation of license, see Weed *v.* Draper (1870), 104 Mass. 28; Weed *v.* Draper (1868), 99 Mass. 53.

That an agreement in a license that the license may be declared forfeited if the licensee fails to pay the royalties is valid and enforceable, see Hammacher *v.* Wilson (1886), 26 Fed. Rep. 239; 36 O. G. 233.

[3] In White *v.* Lee (1880), 3 Fed. Rep. 222, Lowell, J.: (224) "No court of equity will say that a plaintiff, even if he have an election to put an end to a contract in a certain way, shall assume it to be ended without following that method, and proceed accordingly. This contract still exists until one party or the other, or both, bring it to an end. It cannot be treated as ended, as a legal consequence of a failure to pay the royalties. To this effect are the authorities, even before the late and controlling case of Hartwell *v.* Tilghman, 99 U. S. 547. See Wilson *v.* Sanford, 10 How. 99; Hartshorn *v.* Day, 19 How. 211; Goodyear *v.* Union R. Co., 4 Blatchf. 63; Blanchard *v.* Sprague, 1 Cliff. 288; Mercerole *v.* Union Paper Collar Co. 6 Blatchf. 356-7." 5 Bann. & A. 572 (574).

That a license "conditioned to be void," etc., may be annulled in equity, see Adams *v.* Meyrose (1881), 7 Fed. Rep. 208; 2 McCrary, 360.

That a contract to give an exclusive right to sell on payment of royalties is not revocable on failure to pay, without a proceeding in equity, see Burdell *v.* Denig (1865), 2 Fisher, 588.

That a license is not avoided by the failure of the licensee to comply with its terms, even though it contains an express condition to that effect, and the licensee cannot be treated in equity as an infringer, though the license so declares, until the license has been judicially annulled, see Adams *v.* Meyrose (1881), 2 McCrary, 360; 7 Fed. Rep. 208; Hartell *v.* Tilghman (1878), 99 U. S. 547.

That written notice of his default must be served on the licensee in order to terminate his license, when the license so provides, see White *v.* Lee (1880), 3 Fed. Rep. 222; 5 Bann. & A. 572.

That a notice that the license "will be revoked" is not a notice of revocation, see Pope Mfg. Co. *v.* Owsley (1886), 27 Fed. Rep. 100; 37 O. G. 781.

That the contract is not dissolved *ipso facto* when the licensor forbids the licensee to further use the invention, see Union Mfg. Co. *v.* Lounsbury (1864), 42 Barb. 125.

dies now open to the licensor against a licensee who still claims under the license, but fails to perform his obligations, are a suit upon the contract for the damages sustained, or a bill in equity for the rescission of the license, followed by a suit for the infringement of the patent.[4] In determining the questions presented by a bill in equity for the rescission of a license, the court is guided by the ordinary principles which govern its decisions in other cases. Thus where the breach complained of is the non-payment of money at the time fixed in the license, the license will not be rescinded if payment has been subsequently tendered or complete justice can be done by a judgment for the amount already due.[5]

[4] That where the licensee exceeds 3 McLean, 523, it has been held that his rights he breaks his contract and infringes the patent both, see Pope Mfg. Co. *v.* Owsley (1880), 27 Fed. Rep. 100; 37 O. G. 781; Magic Ruffle Co. *v.* Elm City Co. (1875), 8 O. G. 773; 13 Blatch. 151; 2 Bann. & A. 152.

That when a license has been terminated by due notice the licensee becomes an infringer as to all subsequent acts, see Hammacher *v.* Wilson (1886), 26 Fed. Rep. 239; 36 O. G. 233.

[5] In White *v.* Lee (1880), 5 Bann. & A. 572, Lowell, J.: (573) "The theory of the bill is that any failure by the licensee to pay the royalties, or to render an account, avoids the license immediately at the election of the licensor. A license is often compared to a lease of land, and many decisions follow this analogy. Now, so far is equity from decreeing the forfeiture of a lease for a breach of covenant, that it often interferes to prevent a forfeiture which would exist at law. I know of no case in which a more failure to pay money, or keep some engagement of that nature, has been held a good cause for asking a court of equity either to declare a forfeiture, or to proceed as if one had been incurred. In some few patent cases, beginning with Brooks *v.* Stolley, a patentee enjoyed the unusual privilege of treating a breach of covenant as if it, of itself, worked a forfeiture. No doubt the parties may agree that such an effect shall follow; and this will account for some of the decisions. The others of this sort are overruled by Hartell *v.* Tilghman, 99 U. S. 547." 3 Fed. Rep. 222 (223).

That failure to pay royalties at the date agreed upon is not *ipso facto* a forfeiture of the license, even though the license so provides, see Daro *v.* Boylston (1880), 6 Fed. Rep. 493; 18 Blatch. 548; 19 O. G. 725.

That a licensor who fails in his duties will not be aided by equity against his licensee, see Foster *v.* Goldschmidt (1884), 22 Blatch. 287; 21 Fed. Rep. 70; 28 O. G. 915.

That a provision for avoiding a license for non-payment of royalties is only a means of securing payment and is cured by tender after pay-day, see Dare *v.* Boylston (1880), 18 Blatch. 548; 6 Fed. Rep. 493; 19 O. G. 725.

That where an exclusive licensee fails to pay as he agrees and the patentee thereupon grants an exclusive license to another, who has notice of the prior license, the first licensee may at any time tender what is due and assert his

Nor will infringement by the licensee, by means of wrongful acts outside the limits of his license, be ground for a rescission, unless his conduct is so hostile to the patent as to amount to a denial of its claims.[6] But a non-payment of royalties or license-fees, coupled with an abandonment of the privileges of the license and working other injuries to the licensor than the mere detention of money due, or arising from circumstances which indicate that future royalties and license-fees will likewise be unpaid, and any other breach of condition which under the agreement of the parties, interpreted according to the rules of equity, should operate as a forfeiture of the privileges conferred upon the licensee, are grounds upon which equity will annul the license, and restore the parties to their original rights, — the licensor to his right to maintain an action for infringement, and the licensee to his right to defend against it by denying the validity of the patent or the title of the licensor.[7] The foregoing modifications have no application to cases where the licensee has openly repudiated his license, either by words or conduct. Such repudiation is more than a mere ground of forfeiture.[8]

rights as against the second licensee, see Dare *v.* Boylston (1880), 19 O. G. 725; 18 Blatch. 548; 6 Fed. Rep. 493.

That where the patentee revokes one license and then licenses another party who has notice of the first license, the second licensee is chargeable with notice that the first licensee still claims that his license is good, see Dare *v.* Boylston (1880), 18 Blatch. 548; 19 O. G. 725; 6 Fed. Rep. 493.

That if a royalty is based on the number of articles sold, and the licensee ceases to make and sell, he abandons his license, and the licensor may then license other parties, see Pitts *v.* Jameson (1853), 15 Barb. 310.

[6] That the infringement of a patent by a licensee does not forfeit his license, unless his conduct is so hostile toward the patent as to amount to a repudiation of his rights as a licensee under it, see Wood *v.* Wells, Crittenden & Co. (1873), 6 Fisher, 382.

That the use of the same machine as the invention of another than the licensor revokes the license to that extent, see Steam Cutter Co. *v.* Sheldon (1872), 10 Blatch. 1; 5 Fisher, 477.

[7] That a license is forfeited by non-payment of royalties and disclaimer of licensor's rights, see Bell *v.* McCullough (1858), 1 Fisher, 380; 1 Bond, 194.

[8] In White *v.* Lee (1880), 3 Fed. Rep. 222, Lowell, *J.*: (224) "It is true, as the plaintiffs contend, that if a licensee has renounced the license he may, on the one hand, defend against the agreement and set up the invalidity of the patent; and, on the other, may be treated as an infringer. Moody *v.* Taber, 1 Holmes, 325; Cohn *v.* National Rubber Co., 15 O. G. 829." 5 Bann. & A. 572 (574).

It severs the relations between the licensee and licensor, and from that time forward authorizes the latter to treat all acts of the former, within the scope of the patent, as infringements, and estops the former from pleading his license in any suit for such acts of infringement that may be brought against him by the licensor.

§ 823. Express License: When Transferable.

Whether or not a license is transferable depends on the intention of the parties. There is nothing in the nature of a license, considered as the conveyance of an interest in the invention or as a release from the monopoly, which precludes its alienation as long as this does not extend the privileges thereby conferred. Clearly a licensee, unless receiving express authority to that effect, would have no right to multiply his privileges by sub-licenses, and thus increase the number of the individuals who could lawfully practise the invention. His authority to divide his rights, and to apportion them to others, must be measured by the circumstances of each case, and be so limited that the sum of all the rights distributed shall be no greater than his own. In view of the abuses likely to arise from the practical exercise of such powers of alienation, and the difficulties attending any attempt to vindicate the rights of the licensor, the courts have held that a license is not assignable unless it affirmatively appears that such was the intention of the parties.[1] Even where the license

§ 823. [1] In Dorsey Revolving Harvester Rake Co. *v.* Bradley Mfg. Co. (1874), 12 Blatch. 202, Woodruff, J.: (208) "Whether a license is or is not assignable is to be determined, not merely by the term 'license,' but by an inquiry into the fair meaning and intention of the parties; and it may be affected not only by the words of license, but by the nature of the transaction, the consideration paid, and other circumstances showing that an assignable right was conferred." 1 Bann. & A. 330 (336).

That licenses are generally personal, not assignable, see Adams *v.* Howard (1884), 23 Blatch. 27; 22 Fed. Rep. 656.

That a license to use is personal and not assignable, see Eclipse Windmill Co. *v.* Woodmanse Windmill Co. (1885), 24 Fed. Rep. 650; 32 O. G. 1605.

That a license to make and use is personal and does not pass to the receiver of the licensed firm, see Curran *v.* Craig (1884), 22 Fed. Rep. 101.

That a "shop right" license is personal, not assignable, and is available only in the manner stipulated, see Gibbs *v.* Hoefner (1884), 22 Blatch. 36; 19 Fed. Rep. 323.

That a personal license is not assign-

is granted to the licensee "and his assigns," the force of the latter phrase is qualified or neutralized if the rights conferred upon the licensee himself are evidently not transferable.[2] A license to use "in the licensee's own business," or "at his shop," is personal only and cannot be assigned.[3] But a license to use to a certain quantity on payment of a gross sum is *prima facie* alienable, since it can make no difference to the licensor by whom the quantity is used.[4] A license to a partnership is not affected by a change of members in the firm, unless the license otherwise provides, and when such license is limited in number or amount it will enure to the benefit of each member of the firm, after the dissolution, if the limits named are not exceeded.[5] Assignees of a license

able, see Racine Seeder Co. *v.* Joliet Wire Check Rower Co. (1886), 27 Fed. Rep. 307; 37 O. G. 452.

That a license to use for a special purpose is not transferable unless so expressed, not even passing to the licensee's administrator, see Oliver *v.* Rumford Chemical Works (1883), 109 U. S. 75; 25 O. G. 784.

That a license cannot be apportioned out to others by the licensee, see Consolidated Fruit Jar Co. *v.* Whitney (1874), 1 Bann. & A. 356.

That the exclusive right to supply the licensor with articles to be made on the patented machine, under a "personal" license, does not authorize the licensee to arrange with others for their manufacture and supply, and if the licensee cannot manufacture personally the license ceases, see Houghton *v.* Rowley (1874), 9 Phila. 288.

That where an exclusive right is granted to a licensee it vests at his death in his personal representatives so far as to enable them to finish up and dispose of the devices on hand, and then ceases, see Pitts *v.* Jameson (1853), 15 Barb. 310.

That a license to use an invention may be subjected in equity to the claim of a judgment in favor of the licensor, see Matthews *v.* Green (1884), 19 Fed. Rep. 649.

[2] That the word "*assigns*" in the license is not conclusive, if the subject-matter is not transferable, see Brooks *v.* Byam (1843), 2 Story, 525; 2 Robb, 161.

[3] That a license to use in "his own proper business" to a certain amount yearly is not transferable, see Putnam *v.* Hollender (1881), 6 Fed. Rep. 882; 19 Blatch. 48; 19 O. G. 1423.

That a license to use the patented invention at the licensee's shop, and to associate others with him in such use, is not assignable, see Gibbs *v.* Hoefner (1884), 19 Fed. Rep. 323; 22 Blatch. 36; Searls *v.* Bouton (1882), 21 O. G. 1784; 20 Blatch. 426; 12 Fed. Rep. 140; Rubber Co. *v.* Goodyear (1869), 9 Wall. 788.

[4] That a license to use the invention to a certain extent on payment of a gross sum is *prima facie* assignable, see Belding *v.* Turner (1871), 8 Blatch. 321; 4 Fisher, 446.

[5] That a license to a partnership is good, if paid for in advance, though one member of the firm retires and new members are admitted, unless the contrary is expressed, see Belding *v.* Turner (1871), 8 Blatch. 321; 4 Fisher, 446.

That where a firm is licensee a change

take it subject to all the obligations and conditions imposed upon the original licensee, and run their own risk of his right to transfer it.[6] An unauthorized transfer may be ratified by the acceptance of the royalties or license-fees from the assignee after notice of the assignment.[7]

§ 824. Implied Licenses: License to Use Implied in Favor of Purchaser at any Lawful Sale of a Patented Article.

There are certain cases in which the law implies a license from the dealings of the parties with each other, or from the

in partners does not affect its duties or rights as such licensee, but the retiring partner is merely a surety for the royalties, and if he has to pay them he is entitled to be repaid by the firm, see Sizer *v.* Ray (1881), 87 N. Y. 220.

That a license granted to a firm and limited only as to the quantity to be made confers a right upon the remaining member of the firm after its dissolution, see Bolding *v.* Turner (1871), 4 *Fisher*, 446 ; 8 Blatch. 321.

That a license to A., B. & C., "constituting the firm of A., B. & Co., and their executors, administrators, and assigns," is a license to A., B. & C., not to the firm, and the receiver of the firm has no right in it, but each party can assign his interest in it separately, see Adams *v.* Howard (1884), 23 Blatch. 27 ; 22 Fed. Rep. 656.

That a license to a partnership cannot be transferred to a corporation composed of the same persons, see Locke *v.* Lane (1888), 35 Fed. Rep. 289.

That the receiver of a bankrupt corporation, carrying on its business of making patented articles under a license by order of the court, cannot be interfered with by a new licensee without contempt of court, see *In re* Woven Tape Skirt Co. (1877), 12 Hun, 111.

That licenses bind, as to terms, etc., all the assignees of the licensee, whether recorded or not, see Hamilton *v.* Kingsbury (1879), 17 O. G. 147 ; 17 Blatch. 264 ; 4 Bann. & A. 615.

That an assignment of a license on an annual royalty resembles the assignment of a lease, and follows the same rules, see Wilde *v.* Smith (1879), 8 Daly, 196.

That it is doubtful whether the same privity exists between the assignee of a license and the licensor as between the assignee of a lessee and the lessor, see Wilde *v.* Smith (1879), 8 Daly, 196.

That in a suit by a retiring partner, as surety for royalties which he has paid, the attitude of the firm toward the patentee is of no consequence, and judgment against the surety is conclusive against the firm, nor is it material whether the firm made a profit or not by their sales, see Sizer *v.* Ray (1881), 87 N. Y. 220.

[6] That the purchaser of a licensee's right must take his own risks as to the vendor's right to sell, see Chambers *v.* Smith (1870), 5 Fisher, 12.

[7] That an assignment contrary to the terms of a license is validated by the acceptance of the royalty from the assignee, unless the licensor shows the contrary, see Wilde *v.* Smith (1879), 8 Daly, 196 ; Bloomer *v.* Gilpin (1859), 4 Fisher, 50.

That a notice by the licensor to the assignee that the royalty is due, and demanding payment, shows that the licensor knows of the assignment, see Wilde *v.* Smith (1879), 8 Daly, 196.

relations which subsist between them. The most frequent and important of these cases arises when a patented article is sold by any one who has a right to sell it. From such a sale the law implies a license to the purchaser, and to every subsequent owner of the article, to use it as long as its identity can be preserved.[1] This implied license rests upon the principle that the owner of the patented invention, having once received his recompense for releasing the article from the *monopoly*, either *in its price directly paid to him or in* the license-fee which he collects from its vendor, he can thereafter neither limit nor demand compensation for its use,[2] but

§ 824. [1] That an absolute lawful sale of a patented device carries both the right to use it and the ownership of the device itself, see Porter Needle Co. *v.* National Needle Co. (1883), 17 Fed. Rep. 536.

That a patentee may sever the ownership of a patented article from the right to use it, if he chooses, see Porter Needle Co. *v.* National Needle Co. (1883), 17 Fed. Rep. 536.

That a machine may be sold without the right to use it, and the purchaser does not then acquire by the sale a right to use, see Rodgers *v.* Torrant (1880), 43 Mich. 113; Wortendyke *v.* White (1875), 2 Bann. & A. 25; Wilson *v.* Stolley (1847), 4 McLean, 273.

That where an inventor submits his invention to the United States for adoption and use, no presumption of a gratuitous license arises, but a license is implied at a reasonable royalty, see McKeever *v.* United States (1878), 14 Ct. of Cl. 396; 23 O. G. 1525.

That the sending of persons to buy of a suspected infringer after injunction is no consent, and raises no implied license, see Knowles *v.* Peck (1875), 42 Conn. 386.

That the capture of an article by an American vessel gives no right to use it as against the patentee, see Opinions Atty. Gen. (1820), 5 Op. At. Gen. 725.

That the use by the defendant, without interference, for years, is no evidence to show a right in his vendors, see Baldwin *v.* Sibley (1858), 1 Clifford, 150.

[2] In Adams *v.* Burke (1873), 17 Wall. 453, Miller, J.: (456) "But, in the essential nature of things, when the patentee, or the person having his rights, sells a machine or instrument whose sole value is in its use, he receives the consideration for its use, and he parts with the right to restrict that use. The article, in the language of the court, passes without the limit of the monopoly. That is to say, the patentee or his assignee, having in the act of sale received all the royalty or consideration which he claims for the use of his invention in that particular machine or instrument, it is open to the use of the purchaser, without further restriction on account of the monopoly of the patentees. If this principle be sound as to a machine or instrument whose use may be continued for a number of years, and may extend beyond the existence of the patent as limited at the time of the sale, and into the period of a renewal or extension, it must be much more applicable to an instrument or product of patented manufacture which perishes in the first use of it, or which, by that first use, becomes in-

by the sale delivers it from all the restrictions of the patent and makes it common property like any other personal estate.[3] To have that effect, however, the sale must be a lawful and an unconditional sale. The sale is lawful when the vendor is the patentee himself, or some one to whom he has conveyed the right to sell without conditions, or some one upon whom such right to sell has been conferred by law.[4]

capable of further use, and of no further value." 5 O. G. 118 (119).

In Goodyear *v.* Beverly Rubber Co. (1859), 1 Clifford, 348, Clifford, J.: (354) "Patentees may grant an interest in the patent, or they may license another to manufacture the product produced by their process, and authorize him to sell the same in the market. Whether the inventor in any given case has a patent for the article manufactured, or only for the product or the material of which it is composed, the unconditional sale of the manufactured article carries with it the absolute dominion over the material as well as over the manufactured article. Having manufactured the material and sold it for a satisfactory compensation, whether as material or in the form of a manufactured article, the patentee, so far as that quantity of the product of his invention is concerned, has enjoyed all the rights secured to him by his letters-patent; and the manufactured article, and the material of which it is composed, go to the purchaser for a valuable consideration, discharged of all the rights of the patentee previously attached to it, or impressed upon it, by the act of Congress under which the patent was granted."

[3] In Howe *v.* Wooldredge (1866), 12 Allen, 18, Gray, J.: (22) "When a single machine, made under a patent, has been sold, either by the patentee or by his assignee or licensee, acting within the authority conferred by an assignment or license, the machine thus sold is no longer subject to the franchise or monopoly, but may be freely used or resold by the purchaser during the term of the patent, without making himself or any subsequent purchaser liable to the patentee, or his assignee or licensee, for any use which may be made of the machine."

In Goodyear *v.* Beverly Rubber Co. (1859), 1 Clifford, 348, Clifford, J.: (356) "By virtue of the contract of sale and the unconditional delivery of the manufactured article, it passes outside of the monopoly, and is no longer under the peculiar protection granted to patented rights. Whenever a valid sale of the patented article is thus made, it then becomes the private property of the purchaser, and is no longer protected by the laws of the United States, but by the laws of the State in which it is situated."

That the patented article, thus lawfully sold, is no longer under the monopoly, see also Holliday *v.* Matheson (1885), 24 Fed. Rep. 185; 31 O. G. 1444; 23 Blatch. 239; Detweiler *v.* Voege (1881), 8 Fed. Rep. 600; 19 Blatch. 482; American Cotton Tie Co. *v.* Simons (1878), 3 Bann. & A. 320; 13 O. G. 967; Mitchell *v.* Hawley (1872), 16 Wall. 544; 6 Fisher, 331; 3 O. G. 241; Adams *v.* Burke (1871), 1 O. G. 282; Holmes, 40; 4 Fisher, 392.

[4] That a purchaser from the patentee himself has an implied license to use, see Detweiler *v.* Voege (1881), 8 Fed. Rep. 600; 19 Blatch. 482; Black *v.* Hubbard (1877), 12 O. G. 842; 3 Bann. & A. 39.

That where an American patentee

Thus an assignee whether sole or joint, a grantee selling within his own territory,[5] and a licensee whose right to

sells the patented article abroad without restrictions, the purchaser can use and sell it in the United States, see Holliday *v.* Matheson (1885), 24 Fed. Rep. 185; 31 O. G. 1444; 28 Blatch. 239.

That if a factory and machinery are sold with the acquiescence of the patentee of the machines, and without notice to the buyer, he may use them, see Dotweiler *v.* Voege (1881), 8 Fed. Rep. 600; 19 Blatch. 482.

[5] In McKay *v.* Wooster (1873), 3 O. G. 441, Sawyer, J.: (443) "At the date of the assignment to Billings the patentees were still the holders of the entire interest under the patent. Had they at that time, at Chicago, sold one of the patented articles in question without restriction or condition, that undoubtedly would have been a lawful sale without restriction or condition; and the article so sold would have been taken out of the monopoly, and the purchaser, or any one deriving title through him, would have been entitled to use it till worn out in any part of the United States. The patentee himself could not, by a subsequent assignment of his patent, have limited the right of the purchaser already vested. The vendor being at that time entitled to the whole monopoly for the entire jurisdiction of the United States, it was competent for him to wholly emancipate the article sold by taking the entire royalty for the use in any part of the territory. And a sale without restriction or limitation would work such emancipation. In such case any party subsequently purchasing the right to any specific portion of territory would take that right subject to the use of the machine so sold at any point within the territory purchased. What the patentees could do with respect to one machine, they could do as to any number of machines in existence or to be brought into existence. What they could do themselves they could by contract authorize or convey the right to any other party to do. As the patentees themselves could *lawfully sell* those patented articles at Chicago *without restriction or condition*, so as to authorize the purchasers, or those claiming under them, to use the machines anywhere in the United States, they could convey the right to Billings to lawfully do the same. This authority to emancipate from the monopoly by an unrestricted sale was a part of their 'right, title, and interest in the invention secured by the patent,' that could be exercised and enjoyed at Chicago or other place east of the Rocky Mountains as well as elsewhere. The assignment to Billings is in the broadest terms. It is of 'all the right, title, and interest which the said John L. and George W. Stevens had in and to the said letters-patent, and the invention as secured to them by said letters-patent, and all their rights, liberties, privileges, and franchises which they had or might acquire by or under said letters-patent,' 'for, to, and in all the States and Territories of the United States east of the Rocky Mountains.' There is no limitation of the power to vend within the territory. The patentees could lawfully make without restriction or condition, could use without restriction or condition, or could *vend without restriction or condition*, anywhere within the specified territory; and all their rights they conveyed to Billings *without restriction or condition*, who thereupon stepped into the shoes of the patentees as to the territory sold. Had they intended to limit the right of vending 'to vending to be used' by the purchasers within the territory sold only, they should at least

soll is unrestricted by limitations as to the use of the thing

have so specified the intention, and by some apt words restricted the right of use in the deed of assignment. This unrestricted assignment of the right to vend put it in the power of Billings to *lawfully* vend the patented article within his territory without restriction or condition, and thereby wholly emancipate from the monopoly the article so sold. The complainant subsequently purchased his territory, and, whatever the terms of his grant, he could of course obtain only what was left of the franchise or monopoly. As the patentees, after their sale to Billings, could not object to sales by him without restrictions or conditions, their subsequent assignee cannot object. The latter's right is subject to the right of Billings and those who have lawfully purchased without restriction or condition from him." 6 Fisher, 375 (380); 2 Sawyer, 373 (379).

So far as the foregoing opinion proceeds on the assumption that the grant of all a patentee's "right, title, and interest" in the invention, within a given territory, transfers the right to license others to use, without the territory, the invention sold by the grantee within the territory, it is manifestly unsound. The error arises from confounding the *personal* right of the patentee with his *territorial* right. The patentee's territorial right consists in the right to make within the territory, to use within the territory, to sell within the territory, and to grant or license others to make, use, or sell within the territory. His personal right consists in the right he has as the owner of the whole monopoly, wherever he may be, to grant or license others to make, use, or sell, in any territory whatsoever, except that already covered by grants or exclusive licenses to other parties. The power of a patentee in Chicago to grant a license to use in California is not a part of his territorial right in Chicago, but of his territorial right in California, and resides in him in Chicago only as a part of his personal right. This personal right is limited as to the area over which it may be exercised by his successive territorial transfers, but it never passes from him to any other person unless by an entire or partial assignment of all the interest remaining in him. Were this not so the first grantee of any territory, however small, would obtain the personal right of the patentee, and could license anywhere within the United States; and since his right in his own territory is exclusive of the patentee, the most important interest under the patent would vest in him, rendering the remaining interests of little security and value. Moreover, if the interest of the patentee "within the territory" includes his power to confer the right to use the invention everywhere, it must also embrace the power to confer the right to make and sell everywhere, and thus transfer the complete monopoly to the grantee, irrespective of any territorial boundaries, which is contrary to the fundamental idea of a grant of territory. Logically and consistently, only the patentee, and he only while he has as yet bestowed no exclusive rights on any person, can transfer the right to use the invention everywhere; and after such exclusive rights have been conferred, only he and his assignees can create rights co-extensive with the area uncovered by previous exclusive interests. Neither a grantee nor a licensee of specific territory possesses this authority, nor can they vest in any vendee of the articles made or sold under their grants or licenses any right to use outside the territory covered by their several conveyances. If the doctrine that a purchaser from a grantee has the

sold[6] have, equally with the patentee, the power to transfer such a title to the purchaser as will draw after it a license to use the article as long as it exists, and to sell it to others with the same right to use. Thus, also, a sheriff, levying an execution on the assets of the patentee, or on the assets of another person with the patentee's consent, may sell the patented article if embraced among such assets, and the same license will attach thereto as if the sale had been made by the patentee.[7] The sale must furthermore be un-

right to use the purchased article outside the vendor's territory has any legal basis, it is in the rule that public policy requires that such a right must be recognized as against all parties interested in the patent, in order to avoid the public inconvenience which the enforcement of their logical and otherwise inevitable rights would occasion. So broad a rule as this has never been sanctioned by any series of decisions, although in a few cases it has been advanced in justification of the judgment actually rendered. See the remainder of this note, and § 826, note 2, *post*.

Further, that a lawful sale by a grantee within his own territory frees the article sold from the monopoly throughout the United States, see Hobbie *v.* Smith (1886), 27 Fed. Rep. 656; Adams *v.* Burke (1873), 17 Wall. 453; 5 O. G. 118; Hawley *v.* Mitchell (1871), 4 Fisher, 388; 1 O. G. 306; Holmes, 42; Adams *v.* Burke (1871), Holmes, 40; 4 Fisher, 392; 1 O. G. 282.

[6] In Birdsell *v.* Shaliol (1884), 112 U. S. 485, Gray, J.: (487) "A license from the patentee to make, use, and sell machines gives the licensee the right to do so, within the scope of the license, throughout the term of the patent; and has the same effect upon machines sold by the licensee, under authority of his license, that a sale by the patentee has upon machines sold by himself, of wholly releasing them from the monopoly, and discharging all claim of the patentee for their use by anybody; because such is the effect of the patentee's voluntary act of licensing or selling, in consideration of the sum paid him for the license or sale." 30 O. G. 261 (262).

That a license to a maker, with a covenant not to sue his vendees, works an implied license to them, see Colgate *v.* Western Electric Mfg. Co. (1886), 28 Fed. Rep. 146; 37 O. G. 893.

That a purchaser of the patented articles from a licensee whom he knows to have forfeited his license may be sued in spite of such license, see Moody *v.* Taber (1874), Holmes, 325; 5 O. G. 273; 1 Bann. & A. 41.

[7] In Wilder *v.* Kent (1883), 15 Fed. Rep. 217, Acheson, J.: (218) "We are therefore called upon to decide what rights a purchaser at sheriff's sale takes in a patented machine belonging to and sold as the property of the owner of the patent, — the defendant in the execution. The learned counsel agree that the question has never been judicially determined; and upon diligent search no case has been found involving the precise point now presented for decision. In Sawin *v.* Guild, 1 Gall. 485; 1 Robb, 47, the sheriff, upon an execution against the patentee, levied on and sold the '*materials*' of several of the completed patented machines, and such sale was held to be no infringement of the patent right. 'He sold,' said Mr. Justice Story, 'the *ma-*

conditional. Not only may the patentee impose conditions, limiting the use of the patented article, upon his grantees

territs as such, to be applied by the purchaser as he should by law have a right to apply them. The purchaser must therefore act at his own peril, but in no respect can the officer be responsible for his conduct.' The specific ruling in Chambers *v.* Smith, 5 Fisher, 12, was that a purchaser at a marshal's sale of a patented machine was an infringer in operating it outside of the district to which its use was limited by the license granted to the defendant in the execution. The position taken by the plaintiff's counsel is that when the owner of a patent who does not manufacture for sale makes a machine for his own use only, and such patented machine is sold at a forced sale by the sheriff, the right to use it does not pass with it, but only the ownership of the materials of which the machine is constructed. To sustain this proposition reliance is placed upon the cases of Stephens *v.* Cady, 14 How. 528, and Stevens *v.* Gladding, 17 How. 477, in which it was held that the seizure and sale of the copperplate of a copyrighted map, under an execution against the owner of the copyright and plate, did not carry with it the right to print and publish the map. But the reason assigned for this is, that the copyright — the exclusive and intangible right to multiply copies of the original work — does not inhere in, and has no necessary connection with, the plate, which is the mere instrument for producing the copies. The copyright and the plate are wholly distinct and disconnected subjects of property, each capable of being owned and transferred independent of the other (id.), and therefore a judicial sale of the one does not carry any title to the other. But the lawful sale of a patented machine takes it out of the monopoly, either altogether or *pro tanto*, according to the nature of the contract. The purchaser of a machine from the patentee acquires no right in the patent itself, and needs none to enable him to enjoy his acquisition. By implication he is invested with a license to use that particular machine, and, in the absence of express stipulation to the contrary, such license passes with the machine to successive owners as an incident of proprietorship. That such is the law in case of a voluntary sale of a patented machine by the patentee is incontrovertible. But wherefore should the rights of the sheriff's vendee, under an execution against the patentee, be less than those of a purchaser directly from the patentee? The rule is that the purchaser at a sheriff's sale succeeds to the beneficial rights of the defendant in the execution to the property sold. Chambers *v.* Smith, *supra*. But why should an exception be made where the subject-matter of sale is a patented machine? To deny to the sheriff's vendee the right to use such machine would in effect prevent its sale upon an execution at law as an operative apparatus, and practically withdraw it from the reach of the owner's execution creditors. The mischievous consequences to such creditors to which the doctrine contended for would lead (now that patented machinery has come into almost universal use) can hardly be estimated. The plaintiff's position is untenable. It is very true that the patent-right itself, being incorporeal and resting exclusively upon statutory grant, cannot be levied on at law, and is available to creditors only by proceedings in a court of equity. Ager *v.* Murray, 105 U. S. 126. But a patented machine is susceptible of manual seizure, and the unrestricted sale thereof does not involve

and express licensees, but any person having the right to sell may at the time of sale restrict the use of his vendee within specific boundaries of time or place or method, and these will then become the measure of the implied license arising from the sale.[8] But when the sale is unconditional; as is the case in ordinary sales by authorized vendors in open market, the implied license gives to the purchaser and his vendees the unrestricted right to use the article unless such use infringes some other patent than the one by which the article itself has been protected.[9]

the transfer of any interest in the patent. The conclusion, therefore, is, that whatever right to use the patented machine a defendant in an execution may have passes with the machine when sold by the sheriff to his vendee." 23 O. G. 831 (832).

That where the owner of a patent consents to the sale of the patented invention under an execution, the purchaser has an implied license, see Detweiler *v.* Voege (1881), 19 Blatch. 482; 8 Fed. Rep. 600.

That a foreclosure sale of a patented device, to which the patentee is a party, frees the device from the monopoly, see Detweiler *v.* Voege (1881), 8 Fed. Rep. 600; 19 Blatch. 482.

[8] In Dorsey Revolving Harvester Rake Co. *v.* Bradley Mfg. Co. (1874), 12 Blatch. 202, Woodruff, J.: (204) "I have no doubt of the right of a patentee to grant the right to make and sell the patented invention within specified territory, and to make that right exclusive in the grantee, and yet limit the use of the thing so made and sold within specified limits." 1 Bann. & A. 330 (332).

That a patentee may sell a patented article with restrictions as to its use, and these will bind the vendee, see Holliday *v.* Matheson (1885), 31 O. G. 1444; 24 Fed. Rep. 185; 23 Blatch. 239.

[9] In American Cotton Tie Co. *v.* Simmons (1878), 3 Bann. & A. 320, Shepley, J.: (321) "The company clearly had the right, in selling a patented article, to put a restriction on its use or sale, and to convey only a restricted title, or to license only a restricted use, and the purchaser under such a restricted title could not convey a greater or better title than he had himself. The law upon this subject was fully stated in Hawley *v.* Mitchell, 1 Holmes, 42, and affirmed in the Supreme Court of the United States, 16 Wall. 544. But when the proprietor of a patented article sells it for the purpose of allowing it to be used in the ordinary pursuits of life, and to pass into the market of the country as an ordinary article of commerce, and subject to unrestricted purchase and sale, he waives his right to affix conditions or restrictions to its use or sale, and consents that, after one sale and the payment of one royalty, it shall pass out of the limits of the monopoly." 13 O. G. 967 (968).

That the unconditional sale of a patented article confers the whole title to it upon the vendee, and impliedly warrants full ownership in the vendor and a good title everywhere, though the sale were made abroad, see Holliday *v.* Matheson (1884), 30 O. G. 452.

§ 825. Implied License: License to Use not Implied from Sales unless the Invention Sold and the Invention Used are Identical.

The sale from which this universal license is implied must, moreover, be a sale of the precise article covered by the patent. A purchaser of the materials of which an article consists, or of the elements of which it is combined, obtains thereby no right to make and use the article, or to unite the elements and employ them in the combination, although the vendor is the owner of the patent in which the combination or the article is claimed. To this rule there is one exception. The sale of any object which can be used only in constructing a patented article, or in practising a patented art, is presumed to have been intended both by the buyer and seller, for that specific use; and when the seller is the owner of the patent for the article or art, his act of sale confers a license on the purchaser to employ the object for that purpose.[1] In order that the license may be implied in other cases the licensed article must be the subject-matter of the sale. Though the article has once been lawfully sold, if it is broken up and ceases to exist in its entirety, a purchaser of its severed parts obtains no right to reconstruct and use it.[2] But it is not im-

§ 825. [1] In Roosevelt *v.* Western Electric Co. (1884), 20 Fed. Rep. 724, Wallace, J.: (724) "The purchase of a patented article from the patentee or owner of the patent confers upon the buyer the right to use the article to the same extent as though it were not the subject of a patent; but the sale does not import the permission of the vendor that it may be used in a way that will violate his exclusive property in another invention. Where the article is of such peculiar characteristics that it cannot be dealt in as a trade commodity, and cannot be used practically at all, unless as a part of another patented article of the vendors, it would be preposterous to suppose that the parties did not contemplate its use in that way. It would be against good conscience to allow an injunction to a vendor under such circumstances. He would be estopped from asserting a right which the purchaser must have understood him to waive." 28 O. G. 812 (812).

That the purchaser of a machine covered by one patent does not, by using it, infringe a patent owned by the same party for a process which consists in the use of the machine, see Downton *v.* Yaeger Milling Co. (1879), 17 O. G. 906; 5 Bann. & A. 112; 1 McCrary, 26.

That the sale of a machine, in which needles covered by a different patent of the same patentee are used, carries a license to use those needles until they are used up, but not to replace them, see Aiken *v.* Manchester Print Works (1865), 2 Clifford, 435.

[2] That where an old licensed machine is broken up and sold at auction,

portant under what name the article is made the subject of the sale. The sale of the complete article by one who owns a patent for the materials of which it is composed, or of a combination by the patentee of its essential elements, carries a license to employ the materials in the article, or the elements in combination, and to use them, thus united or combined, without restriction.[3]

§ 826. Implied License: Right to Use Unlimited as to Time, Territory, Method, and Quantity.

This implied license of the purchaser and his vendees includes the right to use and the right to repair and the right to sell. His right to use is unlimited in duration. It continues not only during the original term of the patent, like the right under an express license, but unlike the right under an express license it subsists during an extension, even though such extension be conferred by special act of Congress.[1] It is

the purchaser has no right to use it, see Wortendyke *v.* White (1875), 2 Bann. & A. 25.

[3] That the license extends to the materials of which the article sold is composed, see Goodyear *v.* Beverly Rubber Co. (1859), 1 Clifford, 348; cited in § 824, note 2, *ante*.

§ 826. [1] In Adams *v.* Burke (1873), 17 Wall. 453, Miller, J.: (455) "We have repeatedly held that where a person had purchased a patented machine of the patentee or his assignee, this purchase carried with it the right to the use of that machine so long as it was capable of use, and that the expiration and renewal of the patent, whether in favor of the original patentee or of his assignee, did not affect this right. The true ground on which these decisions rest is that the sale by a person who has the full right to make, sell, and use such a machine carries with it the *right to the use of that machine to the* full extent to which it can be used in point of time." 5 O. G. 118 (119).

In Mitchell *v.* Hawley (1872), 16 Wall. 544, Clifford, J.: (546) "Patentees acquire by their letters-patent the exclusive right to make and use their patented inventions and to vend the same to others to be used for the period of time specified in the patent, but when they have made one or more of the things patented, and have vended the same to others to be used, they have parted to that extent with their exclusive right, as they are never entitled to but one royalty for a patented machine; and consequently a patentee, when he has himself constructed a machine and sold it without any conditions, or authorized another to construct, sell, and deliver it, or to construct and use and operate it, without any conditions, and the consideration has been paid to him for the thing patented, the rule is well established that the patentee must be understood to have parted to that extent with all his exclusive right, and that he ceases to have any interest whatever in the patented machine so sold and delivered or authorized to be constructed and oper-

also unlimited in place. The purchaser may use the article anywhere, whether within or without the territory covered by

ated. Where such circumstances appear, the owner of the machine, whether he built it or purchased it, if he has also acquired the right to use and operate it during the lifetime of the patent, may continue to use it until it is worn out, in spite of any and every extension subsequently obtained by the patentee or his assigns." 3 O. G. 241 (242); 6 Fisher, 331 (332).

In Blanchard *v.* Whitney (1855), 3 Blatch. 307, Nelson, J.: (309) "As I have already said, it would be a very forced and unreasonable construction of the transaction, to limit the duration of the use to the then existing term of the patent, in the absence of any express provision to that effect, inasmuch as the limitation of that term in no way operated necessarily as a restriction upon the title of the patentee and manufacturer. He could convey the right to an unlimited use. When the plaintiff built the machine now sought to be enjoined by him, he had a right to use it as long as it should last, for all coming time. This right he had irrespective of the patent. As the inventor and builder of the machine, he had this right to such use, without a patent. The patent secured to him the exclusive right to all machines made like it, and deprived all others of the right to make or use the same, without his consent, for a certain period of time. But the right to use the machine in question for all coming time was in the plaintiff, without the patent. The right which the plaintiff had to the machine in question, he conveyed to the defendant. He conveyed his whole right to it—his whole right to the use of it. And, as his whole right was a right to use it for all coming time, he conveyed to the defendant his right to that extent. By his voluntary act, his whole right to use the machine in question became vested in the defendant; and the act of Congress of 1847, which authorizes the renewal and continuance of the plaintiff's patent to his use, does not purport to take away, neither could it take away, any right vested in the defendant, or any one else, by the voluntary act of the plaintiff."

Further, that such license to use continues during an extension, unless expressly restricted to the current term of the patent, see Union Paper Bag Mach. Co. *v.* Nixon (1876), 2 Bann. & A. 244; 1 Flippin, 491; 9 O. G. 691; Wooster *v.* Sidenberg (1875), 10 O. G. 244; 2 Bann. & A. 91; 13 Blatch. 88; Hawley *v.* Mitchell (1871), 4 Fisher, 388; Holmes, 42; 1 O. G. 306; Adams *v.* Burke (1871), 4 Fisher, 392; Holmes, 40; 1 O. G. 282; Farrington *v.* Commissioners of Detroit (1870), 4 Fisher, 216; Farrington *v.* Gregory (1870), 4 Fisher, 221; Hodge *v.* Hudson River R. R. Co. (1868), 3 Fisher, 410; 6 Blatch. 85; Wood *v.* Michigan Southern & Northern Indiana R. R. Co. (1868), 3 Fisher, 464; 2 Bissell, 62; Bloomer *v.* Millinger (1863), 1 Wall. 340; Goodyear *v.* Beverly Rubber Co. (1859), 1 Clifford, 348; Day *v.* Union India Rubber Co. (1856), 3 Blatch. 488; Bloomer *v.* McQuewan (1852), 14 How. 539; Wilson *v.* Rousseau (1846), 4 How. 646; 2 Robb, 372; Simpson *v.* Wilson (1846), 4 How. 709; 2 Robb, 469.

That the right of the purchaser of a patented device to use it during an extension is the same though the extension be granted by a special act of Congress, see Bloomer *v.* McQuewan (1852), 14 How. 539.

That the purchaser of a patented device may use it under a re-issue, see Simpson *v.* Wilson (1846), 4 How. 709; 2 Robb,

his vendor's grant or license, except perhaps within a district owned by a grantee whose title is anterior to that of his vendor.[2] It is likewise unlimited in method. Of whatever use the article is capable he may avail himself, even although the right to apply the patented articles to a special purpose has previously been granted to a different licensee.[3] It is, finally, unlimited in quantity. The article vests in him as its absolute owner, and all the benefit which he can derive from its employment he is entitled to enjoy.

460 ; Wilson *v.* Turner (1846), 4 How. 712 ; 2 Robb, 467.

[2] As to the right of a purchaser from a grantee to use anywhere, see remarks on McKay *v.* Wooster, in § 824, note 5, *ante*.

That the purchaser from a territorial grantee or licensee, may use the article anywhere, except perhaps when the vendor's right is restricted to sales for use within such territory, see Hobbie *v.* Smith (1886), 27 Fed. Rep. 656 ; Adams *v.* Burke (1873), 17 Wall. 453 ; 5 O. G. 118 ; McKay *v.* Wooster (1873), 2 Sawyer, 373 ; 6 Fisher, 375 ; 3 O. G. 441 ; May *v.* Chaffee (1871), 2 Dillon, 385; 5 Fisher, 160 ; Hawley *v.* Mitchell (1871), 1 O. G. 306 ; 4 Fisher, 388 ; Holmes, 42 ; Adams *v.* Burke (1871), 4 Fisher, 392 ; Holmes, 40 ; 1 O. G. 282 ; Jenkins *v.* Greenwald (1857), 1 Bond, 126 ; 2 Fisher, 37.

That the purchaser of a patented article from a grantee may use it anywhere, and the sale is lawful though the grantee knows that it will be used outside his territory, see Hobbie *v.* Smith (1886), 27 Fed. Rep. 656.

That the purchaser of the patented device from an assignee of a territorial right to use and sell in that territory may use the device in any place in spite of other territorial assignments, see Adams *v.* Burke (1873), 17 Wall. 453 ; 5 O. G. 118.

That where a patented article is sold by the grantee of an entire territorial interest, the purchaser may use it anywhere, except perhaps in territory assigned prior to the assignment to his vendor, see McKay *v.* Wooster (1873), 3 O. G. 441 ; 6 Fisher, 375 ; 2 Sawyer, 373.

That no limitation in the assignment of his interest to a territorial assignee, will deprive a purchaser of the patented device from him of the right to use it always, see Hawley *v.* Mitchell (1871), 1 O. G. 306 ; 4 Fisher, 388 ; Holmes, 42.

That a limitation in a license as to the place and time of use of the patented devices made and sold by such licensee will bind his vendees, see Hawley *v.* Mitchell (1871), 1 O. G. 306 ; 4 Fisher, 388 ; Holmes, 42.

That a sale of the device by the patentee in a foreign country, without restrictions, confers a right to use it anywhere, see Holliday *v.* Matheson (1885), 24 Fed. Rep. 185 ; 31 O. G. 1444 ; 23 Blatch. 239 ; Holliday *v.* Matheson (1884), 30 O. G. 452.

[3] That the *lawful vendee of a patented* article may use it in any mode of which it is capable, see McKay *v.* Wooster (1873), 3 O. G. 441 ; 6 Fisher, 375 ; 2 Sawyer, 373 ; Adams *v.* Burke (1871), 4 Fisher, 392 ; Holmes, 40 ; 1 O. G. 282.

That the purchaser of a patented device from an assignee of the right to make it may use it for any purpose, though the right to use it for a special purpose has been granted to a different assignee, see Metropolitan Washing Machine Co. *v.* Earle (1861), 2 Fisher, 203 ; 3 Wall. Jr. 320.

§ 827. Implied License: License to Use does not Embrace the Right to Make, nor to Sell as Matter of Traffic.

The right of the purchaser to repair the article does not embrace the right to make a new one nor to reconstruct the old.[1] He may replace its worn-out parts or elements with others, even when these are of the essence of the invention.[2] He may remove the effects of accident or wear and tear. He may add to it such improvements as he is able to procure. But when its original materials disappear, the article which he purchased ceases to exist, and with it the implied license to repair and use it.[3] The power to sell the specific article

§ 827. [1] In Mitchell *v.* Hawley (1872), 16 Wall. 544, Clifford, J.: (548) "But the purchaser of the implement or machine for the purpose of using it in the ordinary pursuits of life stands on different grounds, as he does not acquire any right to construct another machine either for his own use or to be vended to another for any purpose." 3 O. G. 241 (242); 6 Fisher, 331 (333).

That the purchaser of a patented device from the patentee may use it till it is worn out, but has no right to make another like it, see Union Metallic Cartridge Co. *v.* United States Cartridge Co. (1877), 2 Bann. & A. 593; 11 O. G. 1113.

That a license implied from the purchase of a patented invention does not attach to it when rebuilt, see Gottfried *v.* Phillip Best Brewing Co. (1879), 17 O. G. 675; 5 Bann. & A. 4.

That where the use of an invention destroys it, there is no implied license to reconstruct as there is to repair it, see American Cotton Tie Co. *v.* Simmons (1882), 106 U. S. 89; 22 O. G. 1976.

[2] In Mitchell *v.* Hawley (1872), 16 Wall. 544, Clifford, J.: (548) "Sales of the kind may be made by the patentee with or without conditions, as in other cases; but where the sale is absolute, and without any conditions, the rule is well settled that the purchaser may continue to use the implement or machine purchased until it is worn out, or he may repair it or improve upon it as he pleases, in the same manner as if dealing with property of any other kind." 3 O. G. 241 (242); 6 Fisher, 331 (333).

That the lawful sale of a patented machine confers the right to replace worn-out parts, though these are the essence of the invention, see Farrington *v.* Water Commissioners of Detroit (1870), 4 Fisher, 216.

That the purchaser of a machine has an implied license to replace old parts as long as the identity of the machine remains, see Gottfried *v.* Conrad Seipp Brewing Co. (1881), 10 Bissell, 368; 8 Fed. Rep. 322.

That the right to repair continues during an extension, see Hodge *v.* Hudson River R. R. Co. (1868), 3 Fisher, 410; 6 Blatch. 85; Wood *v.* Michigan Southern & Northern Indiana R. R. Co. (1868), 3 Fisher, 464; 2 Bissell, 62.

[3] In Wilson *v.* Simpson (1850), 9 How. 109, Wayne, J.: (122) "But the questions which were argued by counsel, — when repairs destroy identity and encroach upon invention, or when the thing patented ceases to exist, so as to exclude the repair or

thus purchased for use is also unrestricted, but does not extend to sales made in the ordinary course of trade.[4]

replacement of any one part of its combination, in connection with the rest of it, not requiring repair or to be replaced, — are before the court upon the evidence in the record. We admit, for such is the rule in Wilson *v.* Rousseau, 4 Howard, that when the material of the combination ceases to exist, in whatever way that may occur, the right to renew it depends upon the right to make the invention. If the right to make does not exist, there is no right to rebuild the combination. But it does not follow, when one of the elements of the combination has become so much worn as to be inoperative, or has been broken, that the machine no longer exists for restoration to its original use by the owner who has bought its use. When the wearing or injury is partial then repair is restoration, and not reconstruction. Illustrations of this will occur to any one, from the frequent repairs of many machines for agricultural purposes; also from the repair and replacement of broken or worn-out parts of larger and more complex combinations for manufactures. In either case repairing partial injuries, whether they occur from accident or from wear and tear, is only refitting a machine for use; and it is no more than that, though it shall be a replacement of an essential part of a combination. It is the use of the whole of that which a purchaser buys when the patentee sells to him a machine; and when he repairs the damages which may be done to it, it is no more than the exercise of that right of care which every one may use to give duration to that which he owns, or has a right to use as a whole. This foundation of the right to repair and replace, and its application to the point we are considering, will be found in the answers which every one will give to two inquiries. The right to repair and replace in such a case is either in the patentee or in him who has bought the machine. Has the patentee a more equitable right to force the disuse of the machine entirely, on account of the inoperativeness of a part of it, than the purchaser has to repair who has, in the whole of it, a right of use? And what harm is done to the patentee in the use of his right of invention, when the repair and replacement of a partial injury are confined to the machine which the purchaser has bought?"

[4] In Goodyear *v.* Beverly Rubber Co. (1859), 1 Clifford, 348, Clifford, J: (356) "Suppose it to be an implement or machine, he may devise it or sell it, and if it be composed of various parts, he may break it up and use the materials for any other lawful purpose. Second purchasers acquire the same rights as the seller had, and may do with the article or its materials whatever the first purchaser could have lawfully done if he had not parted with the title."

That the purchaser of patented articles from a territorial grantee has no implied license to sell them outside such territory, as a matter of trade, though he may use them anywhere, see Hatch *v.* Adams (1884), 22 Fed. Rep. 434; 29 O. G. 776.

That the licensee of a grantee can sell within the territory to those who use the article outside the territory, but cannot himself sell outside the territory nor furnish the articles to others to be sold in the trade outside the territory, see Hatch *v.* Hall (1887), 30 Fed. Rep. 613; 40 O. G. 1342.

§ 828. Implied Licenses: License to Use not Restricted by Unknown Prior Agreements of Licensor.

The purchaser of a patented article runs his own risk of his vendor's right to sell.[1] But if his vendor has received this right, the vendee is not bound by any previous covenants between the vendor and third parties of which he has no notice at the time of sale, nor can he be affected by any subsequent conveyance of the vendor.[2] Even an act of Congress cannot interfere with his enjoyment of the property which the sale has vested in him and which he now holds, not under the statutes of the United States, but under the common law that governs the usual contracts of vendors and vendees.[3]

§ 828. [1] That the purchaser of a patented article runs the risk of the vendor's right to sell, see Mitchell *v.* Hawley (1872), 16 Wall. 544; 3 O. G. 241; 6 Fisher, 331.

[2] That covenants between patentees and their licensees do not follow the patented device into the hands of *bona fide* purchasers without notice, see Metropolitan Washing Machine Co. *v.* Earle (1861), 2 Fisher, 203; 3 Wall. Jr. 320.

That a licensee of a right to use the patented material for a certain article cannot hold as infringers those who purchase the article of licensed makers or sellers, and use the material for a different purpose, they having an implied license so to use it, see Metropolitan Washing Mach. Co. *v.* Earle (1861), 2 Fisher, 203; 3 Wall. Jr. 320.

That a recognition by the licensor of the rights of adverse patentees is binding on his prior licensees, see Jackson *v.* Allen (1876), 120 Mass. 64.

[3] In Bloomer *v.* McQuewan (1852), 14 How. 539, Taney, C. J.: (552) "The fair inference from all of these special laws is this, that Congress has constantly recognized the rights of those who purchase for use a patented implement or machine; that in these various special laws the patentee and purchasers of different inventions were intended to be placed on the same ground; and that the relative rights of both parties under the extension, by special act of Congress, were intended to be the same as they were when the extension was granted under the general law of 1836. It would seem that in some cases the attention of the legislature was more particularly called to the subject, and the rights of the purchaser recognized and cautiously guarded. And when the provision is omitted, the just presumption is that Congress legislated on the principle decided by this court in Evans *v.* Eaton, and regarded the special law as ingrafted on the general one, and subject to all of its restrictions and provisions, except only as to the time the patent should endure. Time is the only thing upon which they legislate. And any other construction would make the legislation of Congress on these various special laws inconsistent with itself, and impute to it the intention of dealing out a different measure of justice to purchasers of different kinds of implements and machines; protecting some of them, and disregarding the equal and just claims of others. And if such could be the interpretation of this law, the power of

§ 829. Implied License: License to Use Implied in favor of Innocent Purchaser at Unlawful Sale, if Vendor afterwards Acquires an Interest in the Patented Invention.

Another case of implied license, similar and collateral to the last, arises where a vendor, having no right to sell the patented article at the time of the purchase, afterwards acquires an interest in the patent by which a present right to sell is vested in him. Under these circumstances, the title of the former purchaser to the patented article becomes valid by estoppel, and from thenceforward his right to use it is complete against his vendor, and all subsequent vendees.[1] The acquisition by the vendee of an interest in the patent has the same effect upon a previous unlawful sale, and renders it thereafter operative both on the article, and on the right to its enjoyment.[2]

§ 830. Implied License: License to Use Implied in favor of Purchaser at Unlawful Sale if Vendor afterwards Compensates the Owner of the Patent for the Infringing Sale.

A third case, also collateral to the first, occurs where a vendor, who had no right to sell the article, is sued for the

Congress to pass it would be open to serious objections. For it can hardly be maintained that Congress could lawfully deprive a citizen of the use of his property, after he had purchased the absolute and unlimited right from the inventor, and when that property was no longer held under the protection and control of the general government, but under the protection of the State, and on that account subject to State taxation. The 5th amendment to the Constitution of the United States declares that no person shall be deprived of life, liberty, or property, without due process of law. The right to construct and use these planing machines had been purchased and paid for without any limitation as to the time for which they were to be used. They were the property of the respondents. Their only value consists in their use. And a special act of Congress passed afterwards, depriving the appellees of the right to use them, certainly could not be regarded as due process of law."

§ 829. [1] That where a person unlawfully sells a patented device, and afterwards acquires an interest in the patent, he is estopped from denying the right of his vendee to use the device till it is used up, see Gottfried *v.* Miller (1882), 104 U. S. 521; 21 O. G. 711.

That whether the other owners of the patent are also estopped, *quere*, see Gottfried *v.* Miller (1882), 104 U. S. 521; 21 O. G. 711.

[2] That where the purchaser of a patented article, from one who had no right to sell it, afterward obtains an assignment of the territorial right, his purchase of the invention becomes lawful, and he may use the article even during an extension, see Eunson *v.* Dodge (1873), 18 Wall. 414; 5 O. G. 95.

infringement by the owner of the patented invention, and satisfies the judgment which has been obtained against him. Here, if the owner of the patent receives his compensation by license-fees or royalties, or makes and sells the articles for public use, the damages which he recovers are the substitute for the license-fees which are his due, or for the profits he would have obtained if he himself had sold the article instead of the vendor. Thus by the satisfaction of his judgment he has already once received his lawful recompense for the release of this particular article from the monopoly, and estopped himself from claiming that the title of the purchaser is void. The purchaser, therefore, may retain the article as his rightful property, and use it and repair it as freely as if he had procured it from the patentee.[1] But where the owner of

§ 830. [1] In Allis *v.* Stowell (1883), 16 Fed. Rep. 783, Dyer, J.: (787) "'The recovery of profits and damages from the manufacturers of an infringing machine debars the patentee from recovering from a user for the use of the same machine,' where the user purchased the machine from the infringing manufacturers. Booth *v.* Seevers, 19 O. G. 1140, and cases there cited. These adjudications indicate the law to be that where a patentee recovers from an infringing manufacturer full damages and profits on account of the infringement, the purchaser from such manufacturer, who is a user of the machine, will be protected in such use against a suit for infringement, as he would be if he were a licensee from the patentee. But this could only be held on a clear showing that the purchaser was using the same patented machine or instrument as that involved in the suit between the patentee and the infringing manufacturer, and that the user was a vendee of such manufacturer; and under the authorities it would seem that to effect such a result it must further appear that the patentee's claim to profits and damages against the manufacturer has been actually paid and satisfied."

In Steam Stone Cutter Co. *v.* Windsor Mfg. Co. (1870), 17 Blatch. 24, Wheeler, J.: (31) "If the avails of the sales are claimed and taken, the right to the thing sold must be parted with; *solutio pretii emptionis loco habetur.* (2 Kent's Comm. 387.) It will be like taking judgment and satisfaction for the conversion of property, which always operates 'so that the defendant hath now the same property therein as the original plaintiff had, and this against all the world.' (Adams *v.* Broughton, Andr., 19, Strange, 1078.) And this relates back to the time of the conversion. (Addison on Torts, Wood's ed., 544; 6 Hen. VII., fols. 8, 9, pl. 4; Shep. Touch. 227; Barnett *v.* Brandão, 6 Man. & Gr. 640, note.) The sales must be adopted by the orator upon the very terms upon which the defendant made them, and as much right to the inventions must follow as if the sales had been made by the orator instead of by the defendant. It may be that this right will not follow until satisfaction is made; but whether it will or not is not now material. The question now is, how much the orator is entitled to recover by way of satisfaction; and this

the patent receives his compensation through his own use of the article, and neither licenses nor makes for sale to others,

is to be arrived at on the ground that satisfaction will be made. If not made, the defendant will not suffer unjustly by having it reckoned as if it would be. It follows, necessarily, that the defendant will be under no liability over to the purchasers after satisfaction, and that nothing should be deducted here on that account." 4 Bann. & A. 445 (451).

In Perrigo *v.* Spaulding (1876), 13 Blatch. 389, Johnson, J.: (391) "It seems to be well established that, when a patentee gets his remuneration by patent or license fees, a recovery of the license or patent fee from an infringer, and its payment, authorizes him to use the particular articles for which such recovery has been had. On the other hand, when a patentee chooses to use his invention himself, and find his remuneration in the sale of the products of its use, and to prevent others from using his invention, it is his right, and then a recovery for profits and damages will be limited to the profits and damages up to the time of the recovery. Such a recovery will not carry with it any right to the further use by the infringer of the invention. (Suffolk Co. *v.* Hayden, 3 Wall. 315; Spaulding *v.* Page, 4 Fisher's Pat. Cases, 641, 645, 646.) But where the patentee sells his patented instrument or machine for use by others, finding his remuneration in the profit of the sale of the manufactured machine or instrument, it is obvious that his interest is promoted by increasing the sale and that into his profit enters the value of the patented invention over and above the cost of manufacture and the ordinary fair profit of the manufacture. Even if no patent or license fee is fixed, the value thereof, as a profit, enters into the selling price, and, if not capable of exact ascertainment, may, nevertheless be approximated to by estimation, when necessary. When the patentee sells, he receives this profit, and thus obtains full compensation for the article sold and for the right to use it while it lasts. When, for an infringement, he obtains both the profits and damages, he will be presumed to have obtained a full compensation for all the injury he has sustained, and to be placed in as good a position as if he had made and sold the article himself. Such is, I think, the presumption between parties thus situated, and if any different rule is sought to be applied in any particular case, it should appear that a recovery has not been sought or obtained for the whole gains of the manufacture as well as for all the damages sustained. (Spaulding *v.* Page, before cited; The Gilbert & Barker Manufacturing Co. *v.* Bussing, 12 Blatchf. C. C. R. 426.) When a patentee manufactures and sells his patented article for use, the right to use passes by the sale. If an infringer manufactures and sells, he must account for and pay the profits, which are to be calculated upon the principle that the gain by the appropriation of the patentee's invention is their measure. If there are damages sustained and proved by the plaintiff, beyond the profits made by the infringer, these also may be recovered. But, when a full recovery and satisfaction from one party has been had, the patentee has obtained all that the law gives him, and the particular article or machine, if it be a machine, becomes, in effect, licensed by the patentee, and may be used so long as it lasts, free from any further claim by the patentee." 2 Bann. & A. 348 (350); 12 O. G. 352 (353).

In Spaulding *v.* Page (1871), 4 Fish-

his recovery of damages is a mere recompense for injuries inflicted by the infringer upon his exclusive use. The payment of such damages is not the payment of a license-fee, nor of the profit on the article unlawfully sold. It leaves the article still under the monopoly, and any future use will be as truly an infringement as the past has been.[2] From the

er, 641, Sawyer, J.: (649) "Where a patentee does not use the patented machine himself, nor establish a patent fee, but manufactures the patented article, and sells at fixed prices, seeking his compensation in the profits of the manufacture and sale at such fixed prices, and another party infringes the patent by making and selling the patented article, and where the patentee sues the party so infringing, and claims to recover, and does recover, the full amount of profits which he himself would have obtained on said articles had he manufactured and sold them at his ordinary prices, by such claim and recovery he adopts the sale made by the party infringing, and the right to use the specific articles so sold, and for which the recovery has been had, vests in the purchaser." 1 Sawyer, 702 (709).

See also Steam Stone Cutter Co. *v.* Sheldons (1884), 21 Fed. Rep. 875; 22 Blatch. 484; Booth *v.* Seevers (1881), 19 O. G. 1140; Gilbert & Barker Mfg. Co. *v.* Bussing (1875), 12 Blatch. 426; 1 Bann. & A. 621; 8 O. G. 144.

That a conversion ratified may be regarded as a sale for purposes of royalty, see Wilder *v.* Adams (1860), 16 Gray, 478.

That a mere judgment against an infringing seller, without satisfaction does not confer an implied license on the purchaser, see Tuttle *v.* Matthews (1886), 28 Fed. Rep. 98; 36 O. G. 694; Fisher *v.* Consolidated Amador Mine (1885), 25 Fed. Rep. 201; 11 Sawyer, 190; Birdsell *v.* Shaliol (1884), 112 U. S. 485; 30 O. G. 261; Gilbert & Barker Mfg. Co. *v.* Bussing (1875), 8 O. G. 144; 12 Blatch. 426; 1 Bann. & A. 621.

That when the judgment against an infringing seller is satisfied, the buyer has an implied license to use, see Steam Stone Cutter Co. *v.* Sheldon (1884), 22 Blatch. 484; 21 Fed. Rep. 875; Gilbert & Barker Mfg. Co. *v.* Bussing (1875), 8 O. G. 144; 12 Blatch. 426; 1 Bann. & A. 621.

That where a sale by an infringing vendor is ratified by his agreement with the patentee, the purchaser has an implied license to use and sell the device, see Alabastine Co. *v.* Richardson (1886), 26 Fed. Rep. 620; 35 O. G. 1225.

That the settlement of the vendor with the patentee for past infringements does not protect vendees subsequently purchasing, see Matthews *v.* Spangenberg (1882), 23 O. G. 92; 20 Blatch. 482; 19 Fed. Rep. 823.

That on an agreement to pay royalties on each article made by the licensee, royalties are due on articles made by infringers of the licensee's rights if he has received payment for the future use of such articles from the infringing makers, as if he himself had made them, see Porter *v.* Standard Measuring Mach. Co. (1886), 142 Mass. 191.

[2] See citation from Perrigo *v.* Spaulding (1876), 13 Blatch. 389, in note 1, *ante*.

That where no satisfaction has been made to the patentee, the purchaser from an infringing maker can be enjoined, for he cannot use the device without the consent of the patentee, see Gilbert & Barker Mfg. Co. *v.* Buss-

recovery and payment of mere nominal damages, in either case, no license is implied.[3]

§ 831. Implied License: License to Use Implied from Permission to Make before an Application for a Patent.

Another case in which a license is implied from the dealings of the parties with each other arises when, before his application for a patent, the inventor sells the article which is to be protected by the patent, or knowingly permits another to construct it, without a contract limiting the extent or method of its use. The purchaser or maker in this case obtains the right, by implication, to use or sell the specific article after the patent has been granted, with the same freedom from restrictions as if he had bought it from the patentee during the existence of the patent.[1]

§ 832. Implied License: License to Use Inventions of Workmen Sometimes Implied in favor of Employer.

The principal case in which a license is implied from the relations of the parties occurs where an employee, during the period of his employment, makes an invention in the line of his employer's business. An employer, simply as such, has

ing (1875), 8 O. G. 144; 12 Blatch. 426; 1 Bann. & A. 621.

[3] In Blake *v.* Greenwood Cemetery (1883), 16 Fed. Rep. 676, Benedict, J.: (677) "In this action the validity of the plaintiff's patent is not disputed, nor is it denied that the machine used by the defendant infringes upon that patent. But it is contended by the defendant that the recovery by the plaintiff of the sum of one dollar in the former suit, and the tender of that sum to him by the maker of the machine, is a bar to any recovery in this action against the user of the machine. To sustain this plea would be to hold that a decree for nominal damages recovered by a patentee against the manufacturer of infringing machines operates as a license to the manufacturer, and also to his vendees, as to all existing infringing machines made by such manufacturer. The law is not so understood. The infringement by the manufacturer and the infringement by the user of an infringing machine, are separate trespasses, and judgment because of one is no bar to an action for the other. To create a bar there must be satisfaction, and nominal damages is not satisfaction." 25 O. G. 89 (90); 21 Blatch. 222 (223).

§ 831. [1] See Sec. 4899, Rev. Stat.

That under this act a person making or buying an invention, before the application for a patent, has a right to use or sell only that specific thing, see Brickill *v.* City of New York (1879), 18 O. G. 463; 18 Blatch. 273; 5 Bann. & A. 544; 7 Fed. Rep. 479.

no right to the inventions of his employee.[1] If he contracts for his employee's inventive skill, and pays him for its exercise in his behalf, he may thereby become the equitable owner of the inventions which result, and be entitled to an assignment of the patents when they are obtained.[2] If their agreement is that the employer shall have the benefit, or the exclusive benefit, of the inventions of the employee, this is an express license to the employer to practise the inventions, but leaves their ownership in the inventor.[3] But where, without any express agreement to that effect, an employee uses the time and tools of the employer in making an invention, and then applies it practically in the employer's business, the law implies a license to the employer to continue his enjoyment of the invention, even after the relations between himself and the inventor have been dissolved.[4] The duration of

§ 832. [1] That an employer, as such, has no right to the inventions of his employee, see Hall *v.* Johnson (1883), 23 O. G. 2411; Hapgood *v.* Hewitt (1882), 11 Bissell, 184; 11 Fed. Rep. 422; 21 O. G. 1786; Damon *v.* Eastwick (1882), 14 Fed. Rep. 40; 22 O. G. 1709; Whiting *v.* Graves (1878), 13 O. G. 455; 3 Bann. & A. 222; and § 414, and notes, *ante*.

[2] That an employer may become the equitable owner of his employee's inventions through a definite prior contract between them, see Joliet Mfg. Co. *v.* Dice (1883), 105 Ill. 649; Continental Windmill Co. *v.* Empire Windmill Co. (1871), 8 Blatch. 295; 4 Fisher, 428; Appleton *v.* Bacon (1862), 2 Black, 699; and § 414 and notes, *ante*.

That where an employee assigned his invention to his employer, who patented it, and under it the employee made devices for his employer as and for the one patented, he cannot claim after leaving the employ that such devices were not the ones patented, and if he makes them himself he is an infringer, see Time Telegraph Co. *v.* Himmer (1884), 19 Fed. Rep. 322; 26 O. G. 826; 22 Blatch. 34.

[3] That a contract for the exclusive right to an employee's inventive skill for a specific period carries the exclusive license to use all inventions made during that period, under all patents and extensions, and also a license to use all inventions previously patented, but first made available during that period, see Wilkens *v.* Spafford (1878), 3 Bann. & A. 274; 13 O. G. 675.

[4] In Wade *v.* Metcalf (1883), 16 Fed. Rep. 130, Lowell, J.: (131) "This section of the statute, which first appeared in the law of 1839, § 7 (5 St. 354), has been usually applied to the case of employer and workman. If the workman, by *using the tools and time and money* of his employer with his consent, makes an invention and applies it in his employer's business, the employer may continue to use it. If the improvement is a process, it has been held that the employer may continue to practise the process for the whole period of the patent. McClurg *v.* Kingsland, 1 How. 202; Chabot *v.* American Button-hole, &c., Co., 6 Fisher, 71. But if the invention pertains to a machine, it is understood that only the specific machine or machines which have been so

his license in such cases depends upon the nature of the invention. If it is an art he may practise it until the origi-

made are licensed. Pierson *v.* Eagle Screw Co., 3 Story, 402; Brickill *v.* Mayor, &c., of New York, 7 Fed. Rep. 470."

Further, that where a workman makes an invention at the expense of his employer, and applies the invention practically in the employer's business, the employer has an implied license to use it after the relation ceases, see Jencks *v.* Langdon Mills (1886), 27 Fed. Rep. 622; 36 O. G. 347; Bensley *v.* Northwestern Horse Nail Co. (1886), 26 Fed. Rep. 250; 36 O. G. 689; Barry *v.* Crane Bros. Mfg. Co. (1884), 22 Fed. Rep. 396; Slemmer's Appeal (1868), 58 Pa. St. 155.

That an employer, merely as such, has no right in the inventions of his employee, unless it be a naked license to use or sell the invention in his ordinary business, see Hapgood *v.* Hewitt (1882), 21 O. G. 1786; 11 Fed. Rep. 422; 11 Bissell, 184.

That where an inventor, using the tools and time of his employer, makes an invention under an agreement that the employer should have his invention for a certain sum, and uses it in the employer's business, the invention belongs to the employer as against subsequent assignees of the inventor, or at least the employer has an implied license to use it, see Continental Windmill Co. *v.* Empire Windmill Co. (1871), 8 Blatch. 295; 4 Fisher, 428.

That where an employee incorporates his inventions into machines belonging to his employers, it gives the employers an implied license to use the inventions in such machines after the employment ceases, see Chabot *v.* American Buttonhole and Overseaming Co. (1872), 6 Fisher, 71.

That where an employee makes his experiments at the expense and in the factory of his employer, and has his wages increased as a result of his success, and having perfected his invention permits the employer to use it without claiming any pay, this operates as an implied license to the employer to continue its use, see McClurg *v.* Kingsland (1843), 1 How. 202; 2 Robb, 105.

That where an employee is hired to invent, and does so, and puts his invention into use in his employer's business, the latter has a right to use the particular device till it is worn out, but acquires no rights in the patent itself, see Whiting *v.* Graves (1878), 3 Bann. & A. 222; 13 O. G. 455.

That where an employee constructs his invention for the use of his employer, and uses it until he applies for a patent, the employer has a right to use it until it is worn out, see Magoun *v.* New England Glass Co. (1877), 3 Bann. & A. 114; 14 O. G. 1.

That an inventor and employee, having supervised and directed the building of his machine for his employer, a license in favor of the latter to use it as long as it lasts is implied, see American Tube Works *v.* Bridgewater Iron Co. (1886), 26 Fed. Rep. 334; 34 O. G. 1047.

That if an employee puts his invention into his employer's use without the consent of the employer and without any agreement for compensation, and the invention develops in the employer's use into a practical condition at his expense, he has an implied gratuitous license to use it as long as it lasts, see Barry *v.* Crane Bros. Mfg. Co. (1884), 22 Fed. Rep. 396.

That use by an inventor in his employer's business of a new design, without express contract, gives the employer an implied license to continue the use

nal term of the patent has expired.[5] If it is an article he may use it until it is worn out, and repair it as long as its identity can be retained.[6] His license, however, is not transferable like that of a purchaser of a patented article.[7] Arising out of the relations between himself and his employee it is personal in its character, and cannot be applied to the benefit or protection of any other users of the patented invention. A corporation, whether municipal or private, has the same right to the enjoyment of the inventions of its employees as is possessed by individual employers.[8]

§ 833. Implied License: License to Use Inventions of Co-partner sometimes Implied in favor of the Firm.

From the relations between a partnership and its members a similar license is implied. If one co-partner makes an invention at the cost of the firm, and applies it to their common benefit, the right to use it becomes vested in the partnership, and is not affected by the retirement of the inventor from the firm.[1] Upon the dissolution of the partnership this license

of the design until the patent expires, whether or not the employment continues, see Herman *v.* Herman (1886), 29 Fed. Rep. 92; 37 O. G. 892.

That if a workman uses his invention in his masters' employment without claiming it against them, they may have an implied license to use it, see Hall *v.* Johnson (1883), 23 O. G. 2411.

[5] See Wade *v.* Metcalf, cited in note 4, *ante*.

[6] See Wade *v.* Metcalf, cited in note 4, *ante*.

[7] That the implied license of an employer is personal, not assignable, see Hapgood *v.* Hewitt (1886), 119 U. S. 226; 37 O. G. 1247; Hapgood *v.* Hewitt (1882), 11 Fed. Rep. 422; 21 O. G. 1786; 11 Bissell, 184.

[8] That where the employee of a city invents a device, and uses it on machines belonging to the city before his application for a patent, a license to the city to continue its use on such machines, until the devices used are used up, is implied, see Brickill *v.* Mayor of New York (1880), 13 Blatch. 273; 5 Bann. & A. 544; 18 O. G. 463; 7 Fed. Rep. 479.

§ 833. [1] In Wade *v.* Metcalf (1883), 16 Fed. Rep. 130, Lowell, J.: (132) "The plaintiff contends that this law only applies to employers and employed. But there is no such limitation in the statute. When the plaintiff, as a member of the firm, and at the joint expense, made and altered these machines, and permitted their use by the firm, how does he escape the statute by being himself one of the firm? The law was applied without hesitation to a case of this kind in Slemmer's Appeal, 58 Pa. St. 155. Again, the plaintiff contends that if the statute has any application, it only grants a limited and personal license to a certain legal individual called a firm, which ends when the firm ends. But the section in question describes in

terminates; though where the patented invention is an article, and several having been constructed at the firm's expense are at its dissolution distributed among its members, each has the right to use the article conveyed to him, as if the partnership were still in being.[2] A license of the same character arises in favor of a corporation, one of whose members is the owner of a patented invention, if he knowingly permits its employment in their business, and receives his proportion of the benefit to be derived therefrom.[3]

§ 834. Implied License: Licenses Arising by Estoppel: Implied Licenses, how Construed.

Besides those special cases, which are of definite character and frequent occurrence, an implied license may arise out of any circumstances which operate as an estoppel on the owner of the patent to prevent him from denying the rights claimed by the apparent licensee.[1] Such circumstances must, however,

unmistakable language a complete and perpetual release of the specific articles from the monopoly."

That under circumstances like the above a license is implied in favor of each member of the firm, see Wade *v.* Metcalf (1883), 16 Fed. Rep. 130.

[2] That where one partner invents a device and permits the firm to use it, this is no implied license to a member of the firm to increase the number used after the firm is dissolved, although the firm paid the expense of procuring the patent, if the firm received from it a benefit greater than the expense, see Keller *v.* Stolzenbach (1884), 20 Fed. Rep. 47; 27 O. G. 209.

That where one member of a firm patented a design and used it in the firm's business, an implied license arose to use the design till the firm dissolved, and after dissolution to sell, by receiver or otherwise, all existing devices embodying such design, see Montross *v.* Mabie (1887), 30 Fed. Rep. 234; 41 O. G. 931.

That a firm, dealing with one of its members as if it were a licensee, is licensee until the firm can close up its business, and if a receiver is necessary for that purpose, he will be a licensee, see Montross *v.* Mabie (1887), 41 O. G. 931; 30 Fed. Rep. 234.

That articles made under an implied license to a firm may be sold by any one of the partners after dissolution for the benefit of the firm, see Montross *v.* Mabie (1887), 41 O. G. 931; 30 Fed. Rep. 234.

That articles used by a firm under an implied license from one of its members, and afterwards distributed among the partners at the dissolution of the firm, may be used by them in like manner, see Wade *v.* Metcalf (1883), 16 Fed. Rep. 130.

[3] That where the members of a corporation own patents, and permit the corporation to use the patented devices without objection, a license will be implied, see Detweiler *v.* Voege (1881), 19 Blatch. 482; 8 Fed. Rep. 600.

§ 834. [1] That a license may arise by estoppel, see Gear *v.* Grosvenor (1873),

be unequivocal and fulfil the ordinary requisites of an estoppel *in pais*. An acquiescence in known infringements does not authorize their continuance, nor does a judgment for past infringements license the infringer to practise the invention in the future.[2] An unmolested use during a defective patent affords no presumption of a license under the re-issue.[3] But any conduct by which the owner of the patent induces the person who employs the invention to place himself in a situation where he must suffer injury unless his right to practise the invention is conceded will be regarded as implying such a right, and as estopping the owner of the patent from asserting his prohibitory powers in its defeat. An implied license is construed primarily according to the legal rules under which it arises out of the circumstances or relations of the parties; and subject to these rules, by the evident intention of the licensor and licensee.[4]

6 Fisher, 314; Holmes, 215; 3 O. G. 380; Routgen *v.* Kanowrs (1804), 1 Wash. 168; 1 Robb, 1.

[2] That a license is not implied from the mere failure of the patentee to sue for infringements, see City of Concord *v.* Norton (1883), 16 Fed. Rep. 477; McWilliams Mfg. Co. *v.* Blundell (1882), 11 Fed. Rep. 419; 22 O. G. 177.

That no license is implied from a judgment for damages for past infringement, see Hayden *v.* Suffolk Mfg. Co. (1862), 4 Fisher, 86; Earle *v.* Sawyer (1825), 4 Mason, 1; 1 Robb, 490.

[3] That a use under a defective patent does not imply a license to use under a renewed patent, see McWilliams Mfg. Co. *v.* Blundell (1882), 11 Fed. Rep. 419; 22 O. G. 177.

[4] That an implied license is construed according to the circumstances of the case and the evident intention of the parties, see Montross *v.* Mabie (1887), 41 O. G. 931; 30 Fed. Rep. 234.

CHAPTER VI.

OF THE EXTENSION OF LETTERS-PATENT.

§ 835. Extension of Letters-Patent: Origin and History of Extensions.

From the earliest history of Patent Law the fact has been recognized that through various causes an inventor may fail to obtain an adequate recompense for his inventive skill during the original term of his patent, and that justice to him and a due regard to the public interest may thus sometimes require an extension of his monopoly in the invention. The ancient crown grants were on this account frequently renewed after the expiration of their original terms, and though for a long period after the statute of James I. no such increase of the patent privilege was permitted by the laws of England, yet with the development of industrial enterprise in the first quarter of this century the importance of additional protection to the inventor became so apparent that Parliament in 1835 expressly provided means for extending letters-patent, at first for seven and then for fourteen years. In this country the propriety of such extensions in special cases has always been conceded, — the principal variations in our law relating to the tribunal in which the authority to grant extensions should reside. Prior to the act of 1836 this power was lodged in Congress, by whom alone the original term of the monopoly could be prolonged. In 1836 jurisdiction over the renewal as well as the first issue of letters-patent was conferred upon the Patent Office, subject to numerous restrictions as to the grounds of renewal and the duration of the extended term. In 1861 this jurisdiction over extensions was withdrawn as to all patents granted after the passage of that act, and Congress thus became the only source from which an increase of the monopoly created by future patents could

be obtained.[1] This is the present state of the law, — the Patent Office having authority to renew a patent issued before March 2, 1861, and acting as an examining and advisory tribunal concerning the extension of later patents when the existence of the conditions precedent to such extension is submitted to its judgment by a special act of Congress. Occasions for the exercise of its former power cannot now arise; and an exposition of the current law upon this subject might therefore leave unnoticed those peculiar doctrines which apply only to extensions granted by the Office when having general jurisdiction under provisions similar to those of 1836. Inasmuch, however, as Congress may at any time restore this jurisdiction, and when restoring it will probably preserve unchanged the leading characteristics which it previously possessed, this aspect of the law will also be considered in connection with the rules now practically in force.

§ 836. Extension: to Whom Granted.

As the sole object of an extension is to furnish to an inventor an additional opportunity to secure the recompense which he has hitherto failed to obtain, so no extension will be granted unless the inventor is to enjoy at least a substantial portion of its benefits.[1] It is not necessary that the legal title to the extended patent should vest permanently in him, for he may already have contracted to convey this to another; but even here the consideration for the transfer must be reasonable in amount or the purpose of the extension will fail, and the extension itself will consequently be refused.[2]

§ 835. [1] That under Sec. 16, act of 1861, no future patents can be extended, see De Florez *v.* Raynolds (1880), 17 O. G. 503; 8 Fed. Rep. 434; 5 Bann. & A. 140; 17 Blatch. 436.

§ 836. [1] That an extension is for the benefit of the inventor, see Case *v.* Redfield (1849), 4 McLean, 526; 2 Robb, 741.

That no extension will be granted unless the inventor is to profit by it, see *Ex parte* Baker (1872), 1 O. G. 632.

That when the patentee is to receive but five per cent of the benefits of the extension it will be refused, see *Ex parte* Peberdy (1872), 2 O. G. 644.

[2] That an extension may be granted to an inventor who owns an interest in the patent, see *Ex parte* Woodman (1872), 1 O. G. 550.

That the patentee's interest in the extension may be equitable only, see Gear *v.* Grosvenor (1873), 3 O. G. 380; 6 Fisher, 314; Holmes, 215.

That a patent will not be extended where the assignees are to reap the entire benefit, see *Ex parte* Munger (1873), 3 O. G. 323.

Where there has been no contract to assign the extension the inventor will be presumed to have the beneficial interest therein, and the other conditions for its allowance being present he will receive it unaffected by his assignment of the original term or by any warrant of attorney which he may have previously made.[3] Where assignees of the original patent have re-issued it without his concurrence, his extension may be based either on the original or the re-issued patent, but if he has consented to the re-issue the extension of the latter is alone permitted.[4] The precise relation of the inventor to the patent must appear upon the face of his application for its extension, and if less than the whole future benefit is to be enjoyed by him, the proportion which he will receive must be specifically stated.[5] A joint patent will not be extended unless all the joint inventors desire it, though the application of one may be ratified by the subsequent application of the others.[6] The executor or administrator of a deceased inventor may apply for and obtain an extension in his own name, and will thereafter hold it in trust for the heirs or devisees of the inventor, or for such assignees as have already paid or have agreed to pay a valuable and reasonable consideration for its enjoyment.[7]

[3] That there is no presumption that the assignee of the original term is interested in the extension, see Goodyear *v.* Hullihen (1867), 3 Fisher, 251; 2 Hughes, 492.

That an inventor may obtain an extension, though he may have given to another an irrevocable power of attorney, see *Ex parte* Cox (1872), 2 O. G. 491.

[4] That an original patent may be extended to the patentee, though a re-issue has been obtained by an assignee, see *Ex parte* Low (1872), 1 O. G. 203; Crompton *v.* Belknap Mills (1869), 3 Fisher, 536.

That where an assigned patent has been re-issued to the assignee, and he has assigned half his interest therein to the inventor, the inventor cannot have an extension of the original, see *Ex parte* Dickinson (1873), 3 O. G. 91.

That no extension of the original patent can be granted after a re-issue, if the patentee consented to the re-issue, only the re-issue being extendible, see *Ex parte* Packer (1872), 2 O. G. 31.

[5] That where the applicant for an extension has parted with any portion of his interest in the invention, the application must clearly show what interest he has left, see *Ex parte* Lee (1872), 1 O. G. 435.

[6] That a joint patent will not be extended unless both patentees desire it, see *Ex parte* Wickersham (1873), 4 O. G. 155.

That one of two joint inventors may apply for an extension, if the other ratifies his act by applying also, see *Ex parte* Beadle (1872), 1 O. G. 434.

[7] That an administrator may have an extension, and when granted will

§ 837. **Extension: Conditions of Grant.**

An inventor is entitled to an extension only when the recompense received by him during the original term of his patent is not commensurate with the benefit conferred by his inventive act upon the public. Whether or not the recompense has been in due proportion to the benefit depends upon the practical value of the invention in the arts, and the actual profit derived from it by the inventor under the original monopoly. The value of the invention must be demonstrated, either by experience or by the nature of the process or the instrument itself, and not rest in conjecture or on the mere assertions of the inventor.[1] If improvements have been made upon it since the issue of the original patent, its value must be due to the invention as first patented, and not solely to the subsequent improvements.[2] The sufficiency of the remuneration already obtained by the inventor is a special question of fact in each case, and cannot be measured by any general rules.[3] Where the invention is of great industrial value the

hold it as trustee for the heirs of the inventor, and not for assignees, though the entire patent were assigned, see Wilson *v.* Rousseau (1846), 4 How. 646; 2 Robb, 372; Brooks *v.* Jenkins (1844), 3 McLean, 432; 1 Fisher, 41; Brooks *v.* Jenkins (1843), 3 McLean, 250; 2 Robb, 118.

§ 837. [1] That no extension will b granted unless the value of the invention is proved, see *Ex parte* Lockwood (1873), 3 O. G. 439; *Ex parte* Marston, (1872), 1 O. G. 608.

That the value of the invention is not to be guessed at, but to be proved from experience, see *Ex parte* Dick (1872), 2 O. G. 147.

That an extension may be allowed though the invention is not yet in use, if it is of apparent value, and due diligence has been used, see *Ex parte* Winans (1872), 2 O. G. 440.

That an extension will not be granted on the mere allegation of the applicant that the invention is exceedingly useful, but its utility must be proved, see *Ex parte* Mathews (1872), 1 O. G. 405; *Ex parte* Falkenburg (1872), 2 O. G. 3.

That a patent will not be extended when the invention is in little demand, or has gone out of use, see *Ex parte* Bohr (1873), 3 O. G. 292.

That a contract to purchase the extension for $2,000 shows the value of it, see *Ex parte* Slemmons (1874), 6 O. G. 575.

[2] That a patent will not be extended if the chief value of the invention resides in the improvements since made, see *Ex parte* Roots (1874), 6 O. G. 391.

That on an application for an extension the value of the invention to the public must be shown, and if improvements have been made, the value shown must be that of the original, separate from the improvements, see *Ex parte* Haseltine (1875), 8 O. G. 45.

[3] That the sufficiency of the remuneration received is a special question of fact in each case, see *Ex parte* Voel-

enjoyment of large profits is not inconsistent with inadequacy of recompense; and, on the other hand, a small reward is ample when the advantage bestowed upon the public is of limited amount or short duration.[4] If the failure of proper compensation has resulted from the negligence of the inventor, as by continued acquiescence in infringements or unreasonable delay in amending a defective patent,[5] or if from sources not yet made available he will secure a profit proportioned to his merit, no reason exists for an extension and the application will therefore be denied.[6]

§ 838. Extension Must be for the Same Invention as Original.

As an extension is not a new patent, but a mere prolongation of the term of an original patent, it is obvious that it cannot embrace a different invention from the one claimed in and protected by the patent whose term it prolongs.[1] An inventor seeking this addition to his monopoly must base his application upon that precise form and scope of the monopoly which exists at the time when the extension, if granted, would

ter (1877), 12 O. G. 393; *Ex parte* Waterman (1872), 2 O. G. 247; *Ex parte* Dick (1872), 2 O. G. 147.

That want of proper remuneration must be affirmatively proved, see *Ex parte* Falkenburg (1872), 2 O. G. 3.

[4] That an extension will be granted where the invention is of great value, although large profits have been already realized, see *Ex parte* Sturtevant (1873), 5 O. G. 2.

That less than $5,000 is not sufficient remuneration in some cases, see *Ex parte* Lewis (1873), 3 O. G. 92.

[5] That to acquiesce in the acts of infringers for ten years is negligence in attempting to secure remuneration, see *Ex parte* Lyman (1872), 2 O. G. 705.

That where an inventor has been deprived of his proper remuneration through infringements, and has pursued his legal remedies, he has exercised due diligence in securing his reward, see *Ex parte* Blandy (1872), 2 O. G. 174.

That no extension will be allowed if the failure of remuneration has arisen from the neglect to obtain a re-issue, see *Ex parte* Emmert (1872), 1 O. G. 90.

That when the patent has always been in the hands of assignees, the failure to apply for a necessary re-issue will not prevent the inventor from obtaining a renewal, see *Ex parte* Emmert (1872), 1 O. G. 90.

[6] That an extension should be refused if the damages probably recoverable for past infringements will give recompense enough, see *Ex parte* Arnold (1874), 5 O. G. 553.

§ 838. [1] That an extension is presumed to be for the same invention as the original, see La Baw *v.* Hawkins (1874), 6 O. G. 724; 1 Bann. & A. 428.

That an extension cannot cover a new invention or one not embraced in the original patent, see Union Metallic Cartridge Co. *v.* United States Cartridge Co. (1884), 112 U. S. 624; 30 O. G. 771.

take effect. He is not permitted to introduce new elements into the invention, nor discard others which he has previously treated as essential; nor can he select subordinate parts of the invention which separately considered may be of great value and yet hitherto have returned him little profit.[2] He must take an extension of the patent as it stands, or not at all; and though, if defective, it may still be amended by a re-issue or disclaimer, he cannot use the extension as a method of curing its defects.[3] Where the patent has been re-issued during the original term with his consent, the re-issued patent, not the original, is the subject of extension, and if this contains new matter no extension will be conceded until the new matter has been disclaimed.[4] The identity of the original invention being preserved, the number of successive or divisional re-issues which have been allowed is unimportant. The extension rests upon the last re-issue in which the inventor has concurred, and in the event of a divisional re-issue each division may be separately prolonged.[5] Nor does it affect the inventor's rights that his original patent was limited by the duration of a prior foreign patent,—its term, whenever expiring, being capable of extension if justice and the public interest will be thereby promoted.[6]

[2] That an extension will not be allowed on an unimportant part of the invention, see *Ex parte* Collender (1873), 2 O. G. 727.

[3] That an extension will not be granted to cure an insufficient specification, not remedied by a re-issue during the original term, see *Ex parte* Morse (1874), 6 O. G. 296.

[4] That a re-issue containing new matter cannot be extended until the new matter is disclaimed, see *Ex parte* Allen (1872), 2 O. G. 89.

That a re-issue will not be extended if its claims are broader than the real invention, see *Ex parte* Sexton (1873), 3 O. G. 409; *Ex parte* Lyman (1872), 2 O. G. 705.

[5] That the concurrence of the inventor in a re-issue makes the re-issue alone extendible, see *Ex parte* Packer (1872), 2 O. G. 31.

That each re-issue may be separately extended, see Wheeler *v.* McCormick (1873), 6 Fisher, 551; 11 Blatch. 334; 4 O. G. 692.

[6] That an extension under the act of 1836 might be granted for patents limited by the terms of foreign patents, see New American File Co. *v.* Nicholson File Co. (1881), 8 Fed. Rep. 816; 20 O. G. 524.

That where, after a foreign patent had been issued, an American patent was granted, and the foreign patent expired before the American patent was extended, the extension was still valid, see Tilghman *v.* Mitchell (1871), 9 Blatch. 18; 4 Fisher, 615.

That under Sec. 4887, Rev. Stat., the extension of the foreign patent does not extend the American patent, see Reissner *v.* Sharp (1879), 16 Blatch. 383, 4 Bann. & A. 366; 16 O. G. 355.

§ 839. Extension of Invalid Patent not Permitted.

The extension of an invalid patent is manifestly unjust and improper, whether the invalidity is due to the nature of its subject-matter or to incurable defects in the instrument itself. Upon an application for a prolongation of the monopoly this entire question may be examined, and if it is apparent that the patent ought not to have been originally granted it will not be renewed.[1] Thus if it does not describe and claim a true invention, but covers simply a force, or function, or result; or if the invention which it claims was destitute of patentable novelty or utility, or had been abandoned; or if the original patent was obtained by fraud; or if it fails to disclose the invention to the public and cannot be amended,—in these and similar cases, where the grant may be at any time defeated, a continuance of the unlawful and unsustainable monopoly will not be attempted.[2] In determining this question, however, the presumption is in favor of the validity of the original patent, and this presumption is so far increased, if the patent has been upheld in the courts, that without new evidence the private opinion of the tribunal having jurisdiction over the allowance of the extension cannot prevail

§ 839. [1] That on an application for an extension the Commissioner may consider the novelty and utility and scope of the invention, see *Ex parte* Lyman (1872), 2 O. G. 705; Swift *v.* Whisen (1867), 2 Bond, 115; 3 Fisher, 343.

[2] That no extension will be allowed where the patent does not embrace an invention, see *Ex parte* Sabbaton (1872), 2 O. G. 703.

That an extension will not be allowed where the patent covers a function merely, see *Ex parte* Sexton (1873), 3 O. G. 409.

That a patent for a result will not be extended, see *Ex parte* Dick (1872), 2 O. G. 147.

That an extension ought not to be allowed if the original invention was not new, see *Ex parte* Arnold (1874), 5 O. G. 553; *Ex parte* Carrè (1873), 4 O. G. 180; *Ex parte* Stewart (1873), 4 O. G. 665.

That no extension will be allowed where the original patent claims a device that was old when the patent was granted, unless such device is disclaimed, see *Ex parte* Lewis (1873), 3 O. G. 92.

That an extension ought scarcely to be allowed after a free public use for years, see *Ex parte* Arnold (1874), 5 O. G. 553.

That fraud in obtaining an extension will be a fatal objection to the patent, see Goodyear *v.* Providence Rubber Co. (1864), 2 Clifford, 351; 2 Fisher, 499.

That an extension will not be allowed when an invention is kept secret from the public, see *Ex parte* Collender (1873), 2 O. G. 727.

That an extension will be allowed, though the patent is defective, if it can be cured by a re-issue, see *Ex parte* Mayall (1873), 4 O. G. 582.

against it.[3] An extension in the face of opposition strengthens this presumption, and in its turn may be urged in favor of the patent in the courts.[4]

§ 840. Extension: Procedure in Cases over which the Patent Office had Original Jurisdiction.

In cases of extension over which the Patent Office had original jurisdiction proceedings were commenced by filing a written application not more than six months, nor less than ninety days, before the expiration of the patent.[1] Upon receipt of the application the Commissioner caused notice to be given to persons interested adversely to the extension by publication in Washington and elsewhere, for at least sixty days before the hearing on the application,[2] and also instituted an examination in the ordinary method into the patentability of the invention. At the time appointed in the published notice

[3] That if the patent has been sustained by the courts, and no new evidence against it is offered on the hearing for an extension, it will be regarded as valid, see *Ex parte* Putnam (1873), 3 O. G. 240; *Ex parte* Blandy (1872), 2 O. G. 174; *Ex parte* Cox (1872), 2 O. G. 491; *Ex parte* Blake (1872), 1 O. G. 605.

That personal doubts of the Commissioner as to validity yield to the judgments of the courts, see *Ex parte* Putnam (1873), 3 O. G. 240.

That a patent for a combination whose elements do not co-operate may be extended, if the courts have upheld the combination as a true and patentable one, see *Ex parte* Lewis (1873), 3 O. G. 92.

That no extension should be allowed when the original invention was not new, even though the courts, in the absence of certain evidence now at hand, have sustained it, see *Ex parte* Lawson (1873), 3 O. G. 150.

[4] That an extension strengthens the presumption of novelty and utility, see Whitney *v.* Mowry (1867), 2 Bond, 45; 3 Fisher, 157.

§ 840. [1] That the ninety days under Sec. 12, act March 2, 1861, begin with the day on which the application for an extension is filed, see Johnson *v.* McCullough (1870), 4 Fisher, 170.

That an application for an extension being filed February 15, and the patent expiring the 15th of May, the application was filed within ninety days before the expiration of the patent, see Johnson *v.* Onion (1877), 3 Hughes, 290.

That the jurisdiction of the Commissioner over an extension begins on the filing of the petition, and all subsequent steps are subject to his control, see Gear *v.* Grosvenor (1873), Holmes, 215; 6 Fisher, 314; 3 O. G. 380.

[2] That the publication sixty days previous to the hearing may begin on the first day of the sixty, see Gear *v.* Grosvenor (1873), 3 O. G. 380; 6 Fisher, 314; Holmes, 215.

That a notice of an application to extend the original is sufficient notice of an application to extend the re-issue, see Crompton *v.* Belknap Mills (1869), 3 Fisher, 536.

the interested parties were heard with their evidence upon all points involved in the controversy, and if the Commissioner was satisfied that the patentee, without his fault, had failed to secure a reasonable remuneration for his labor and expense, and that justice and the public good required a prolongation of the monopoly, he entered a certificate upon the patent renewing it for seven years after the close of the original term.[3] This certificate being recorded in the Office gave the same effect to the patent as if it had at first been issued for the term of twenty-one years.[4]

§ 841. Extension: Procedure in Cases Referred to the Patent Office by Congress.

Applications for the extension of patents issued since March 2, 1861, must be made to Congress. Such applications may be directly granted or denied without further action, or may be granted subject to the decision of the Commissioner of Patents upon the merits of the application. In the latter cases the proceedings in the Patent Office, except as to the time and mode of their inception, closely resemble those arising under the former law. An application must be filed in the Office based upon the special act of Congress, a certified copy of which must accompany the application, and the applicant must at the same time furnish a statement under oath of the ascertained value of the invention, and of his receipts and expenditures on its account,

[3] That a patent will be extended if there is no opposition, and the Commissioner is satisfied as to diligence and merit, see *Ex parte* Robbins (1873), 3 O. G. 292.

That an extension may be allowed though the Commissioner has doubts as to the patentability of the invention, see *Ex parte* Lockwood (1873), 3 O. G. 439.

That, although priority is in dispute, an extension may be allowed upon *ex parte* proofs with a disclaimer of the disputed Claims, see *Ex parte* Nishwitz (1872), 1 O. G. 141.

That a patent will not be extended where the same invention is covered by a previous patent to the same grantee, see *Ex parte* Latta (1873), 3 O. G. 349.

[4] That the effect of an extension is to make the patent a patent for the old and new terms, see Gibson *v.* Harris (1846), 1 Blatch. 167.

That an extension vests an absolute and complete title in the patentee though the surrender and re-issue of the original was by another, see Potter *v.* Empire Sewing Machine Co. (1868), 3 Fisher, 474.

giving such facts and data in reference thereto as will enable the Commissioner to form an exact judgment concerning his real profits.[1] Any ambiguity or concealment in this statement is suspicious, and if it is unavoidably defective the reasons for the defect must appear. Upon this application four questions arise: the original patentability of the invention; its value to the public; the sufficiency of the remuneration already received by the inventor; and the effect of an extension upon the public interest. On the first point, in uncontested cases, no evidence is necessary. On the second, the testimony of disinterested persons must, if possible, be presented, and with such definiteness as to enable the Commissioner to estimate the industrial importance of the device or process covered by the patent. On the third point, it must be shown by sufficient proof that the inventor has employed all reasonable means to make his monopoly productive, and that without his fault he has failed to obtain a fair recompense for the time, ingenuity, and expense bestowed on the invention, and on its introduction into use.[2] The conclusions of the Commissioner on the fourth point are drawn from the facts disclosed by the preceding inquiries, and from his general knowledge of the condition of the art. The rules of evidence governing this investigation are those established by the

§ 841. [1] That the applicant for an extension must file an account showing facts and not mere opinions, see *Ex parte* Lee (1872), 1 O. G. 435.

That on an application for an extension, the account of receipts and expenditures need not give every item, but must give data enough for a clear judgment as to remuneration, see *Ex parte* Wilson (1872), 1 O. G. 185.

That on an application for an extension, the real gains received from the patented invention should be stated, although they are derived only from a part interest in the invention, see *Ex parte* Miller (1872), 1 O. G. 431.

That an account of profits taken on an extension hearing must include all profits received under foreign patents for the invention, see *In re* Newton's Patent (1884), L. R. 9 App. Cas. 592; *In re* Adair's Patent (1881), L. R. 6 App. Cas. 176.

That where an application for an extension withholds particulars as to remuneration it is suspicious, see *Ex parte* Wilson (1872), 1 O. G. 185.

That the expenses of introducing into use may properly be set off against receipts in estimating value and remuneration, see *Ex parte* Dick (1872), 2 O. G. 147.

[2] That a patentee may be estopped by neglect from asserting his rights under the extension, see Goodyear *v.* Honsinger (1867), 2 Bissell, 1; 3 Fisher, 147.

Office for other cases in which exterior proof may be required.[3] Any person may oppose an extension by serving notice of his opposition, and his reasons therefor, upon the applicant or his attorney, at least ten days before the day fixed for the closing of the evidence, and after such notice will be treated as an adverse party, and entitled to participate in all future proceedings, to offer testimony against the matters asserted by the applicant, and to be heard in argument. After the evidence has closed, the application is referred to the proper examiner for his determination of the patentability of the invention, and upon his report and the proof and arguments of the parties the Commissioner bases his decision, by which the extension is awarded or the application is dismissed.

§ 842. Extension: Decision of Patent Office Final.

In cases within the original jurisdiction of the Patent Office the decision of the Commissioner allowing an extension was final upon all matters necessarily involved in his judicial action.[1] If lawful on its face the extension could not be collaterally attacked for fraud or other irregularity, though the patent as extended was still open to all defences which could have been set up against it during the original term.[2]

[3] That in extension cases the usual rules of evidence apply, see *Ex parte* Lewis (1873), 3 O. G. 92.

§ 842. [1] That the decision of the Commissioner as to an extension is final, see New American File Co. *v.* Nicholson File Co. (1881), 20 O. G. 524; 8 Fed. Rep. 816; U. S. Rifle & Cartridge Co. *v.* Whitney Arms Co. (1877), 14 Blatch. 94; 2 Bann. & A. 493; 11 O. G. 373; *Ex parte* Sexton (1876), 9 O. G. 251; Gear *v.* Grosvenor (1873), Holmes, 215; 6 Fisher, 314; 3 O. G. 380; Tilghman *v.* Mitchell (1871), 4 Fisher, 615; 9 Blatch. 18; Whitney *v.* Mowry (1870), 4 Fisher, 207; Jordan *v.* Dobson (1870), 4 Fisher, 232; 2 Abbott, 393; 7 Phila. 533; American Wood Paper Co. *v.* Glens Falls Paper Co. (1870), 4 Fisher, 324; 8 Blatch. 513; Crompton *v.* Belknap Mills (1869), 3 Fisher, 536; Goodyear *v.* Providence Rubber Co. (1864), 2 Fisher, 499; 2 Clifford, 351; Clum *v.* Brewer (1855), 2 Curtis, 506; Colt *v.* Young (1852), 2 Blatch. 471.

[2] That an extension is a judicial act of the Commissioner, and cannot be collaterally impeached, see Dorsey Harvester Rake Co. *v.* Marsh (1873), 6 Fisher, 387; American Wood Paper Co. *v.* Glens Falls Paper Co. (1870), 8 Blatch. 513; 4 Fisher, 324; Rubber Co. *v.* Goodyear (1869), 9 Wall. 788.

That if an extension is regular on its face it cannot be attacked by the defendant in an infringement suit for fraud or irregularity, see Tilghman *v.* Mitchell (1871), 9 Blatch. 18; 4 Fisher, 615.

That extended letters-patent are not impeachable for fraud in a collateral

§ 843. Extension: Effect on Rights of Assignees, etc.

The rights of assignees under an extension are protected but not defined by the express provisions of the statutes. An extension does not purport to vary the contract relations between the inventor and other parties. Like the original monopoly it is property which may be transferred or enjoyed in every manner consistent with its nature, and rights under it may be created and enforced to the same extent as during the original term. Conveyances of the extension made before it is allowed, licenses so granted as to continue while the monopoly endures, and implied licenses to use the patented article free from the dominion of the monopoly, take effect under the extension, and are governed by the terms of the express or implied contracts in which they originate.[1] The inventor cannot make use of his extension to curtail any of these vested rights. An assignee of the original term, though having no interest in the extension, may nevertheless employ the patented devices which he has on hand at the expiration of the patent, until they are no longer capable of use. Grantees of territorial interests in the patent, and purchasers of the patented instruments at a lawful and unrestricted sale, enjoy a similar privilege. The owner of the extension is bound by the acts of the former owners of the patent in reference to these parties, and cannot prejudice their legal rights by any exercise of his prohibitory powers.[2]

suit, see Gear *v.* Grosvenor (1873), Holmes, 215; 6 Fisher, 314; 3 O. G. 380.

That the decision of the Commissioner allowing an extension has great weight, but not on the question of infringement, see Evarts *v.* Ford (1873), 5 O. G. 58.

§ 843. [1] That the right to use the invention during an extension depends on the right to use during the original term, see Union Paper Bag Mach. Co. *v.* Nixon (1876), 9 O. G. 691; 1 Flippin, 491; 2 Bann. & A. 244.

That the act concerning extensions avails assignees as well as patentees, according to the nature of their contracts, see Wilson *v.* Turner (1845), Taney, 278.

That an extension of the patent does not relieve a licensee from the duty of paying royalties, see Union Mfg. Co. *v.* Lounsbury (1869), 41 N. Y. 363; Union Mfg. Co. *v.* Lounsbury (1864), 42 Barb. 125.

[2] That the owners under an extension are bound by the acts of the patentee under the original patent, see Goodyear *v.* Honsinger (1867), 2 Bissell, 1; 3 Fisher, 147.

§ 844. Extension: Assignment of.

An extension may be assigned by the inventor even before the original patent is granted, though such an assignment is operative only as a contract until the extension is allowed, and then takes effect by vesting the title in the assignee.[1] No transfer made prior to or during the original term passes the extension, unless the language of the conveyance expressly embraces it, — the presumption being that the assignees of a patent are owners only of the monopoly created by the primary grant.[2] A contract to assign an extension may be specifically enforced in equity, and where an inventor having made such a contract dies before the extension can be procured, his executor or administrator may apply for and obtain it in trust for the true and equitable owner.[3]

§ 844. [1] That an extension may be assigned before it is granted, see *Ex parte* Holmes (1873), 4 O. G. 581; Nicholson Pavement Co. *v.* Jenkins (1872), 14 Wall. 452; 5 Fisher, 491; 1 O. G. 465; Clum *v.* Brewer (1855), 2 Curtis, 506.

That an extension may be assigned before the original patent is granted, see *Ex parte* Holmes (1875), 4 O. G. 581.

That an extension cannot be conveyed before it is granted, though it may be contracted for, see Day *v.* Candee (1853), 3 Fisher, 9.

That an agreement for the sale of an extension is good, see Pitts *v.* Hall (1854), 3 Blatch. 201.

That an assignment of an extension before it is granted operates from the date of the extension, and the legal title vests in the assignee, see Gear *v.* Grosvenor (1873), Holmes, 215; 6 Fisher, 314; 3 O. G. 380.

That an agreement to assign an extension when obtained makes the assignee the equitable owner of it when it is obtained, see Aiken *v.* Dolan (1867), 3 Fisher, 197.

[2] That an assignment of an "invention" before the patent, and requesting that the patent issue to the assignee, does not cover the extension, see Mowry *v.* Grand Street & Newtown R. R. Co. (1872), 5 Fisher, 586; 10 Blatch. 89.

That an assignment of an interest in the invention and letters-patent pending the original term, does not carry an extension, unless it is so expressly stated, see Jenkins *v.* Nicholson Pavement Co. (1870), 4 Fisher, 201; 1 Abb. 567. See also §§ 412, 770, 779, and notes, *ante*.

[3] That where a patentee, having agreed to convey an extension yet to be obtained, dies, his executor or administrator will take the extension in trust for, and may assign it to, the promisee, and the record of such assignment is notice to all concerned, see Nowell *v.* West (1876), 9 O. G. 1110; 8 O. G. 598; 2 Bann. & A. 113; 13 Blatch. 114.

§ 845. Extension under Special Acts of Congress.

Congress may extend a patent by special act in favor of the inventor or his heirs at any time before or after the expiration of the original term.[1] When such an extension is obtained, in addition to an extension under the original jurisdiction of the Patent Office, both are valid and the former is enjoyable after the termination of the latter.[2] As these extensions are entirely within the discretion of Congress, it may make such regulations as it pleases concerning the rights of assignees, though it cannot vary the relations which have been established by prior contracts between the inventor and other parties.[3] Under an extension by special act, assignees have no privileges other than those arising out of contract, unless the act expressly confers them.[4] All special acts of this character are considered as engrafted on the general law, and are interpreted in accordance with its permanent provisions.[5]

§ 845. [1] That an extension may be granted by special act of Congress, see Bloomer *v.* Stolley (1850), 5 McLean, 158.

That an extension may be granted by special act of Congress after the original has expired, see Jordan *v.* Dobson (1870), 2 Abbott, 398; 7 Phila. 533; 4 Fisher, 232.

That where an extension is granted by a special act of Congress, the certificate need not recite all the provisions of the act, see Agawam Co. *v.* Jordan (1868), 7 Wall. 583.

[2] That an extension granted by the Patent Office and one allowed by Congress are entirely distinct, and one will take effect after the other, see Woodworth *v.* Edwards (1847), 3 W. & M. 120.

[3] That Congress, in the special act of extension, may regulate the rights of assignees, see Blanchard Gun Stock Turning Co. *v.* Warner (1845), 1 Blatch. 258.

That special acts authorizing extensions do not vary the rights of parties *inter sese*, see Prime *v.* Brandon Mfg. Co. (1879), 16 Blatch. 453; 4 Bann. & A. 379.

That special acts of extension cannot affect rights under prior contracts, see Bloomer *v.* McQuewan (1852), 14 How. 539.

[4] That assignees have no rights under an extension by special act of Congress, unless it is so expressly provided in the act, see Gibson *v.* Gifford (1850), 1 Blatch. 529.

[5] See as to this point, and the text of this paragraph in general, §§ 46, 47, and notes, *ante*.

END OF VOL. II.