ANNOTATED

RULES OF PRACTICE

IN THE

UNITED STATES PATENT OFFICE

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BY

E. J. STODDARD
DETROIT BAR

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1920

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PREFACE

The system governing the practice before the United States Patent Office is unique. There is,

First, The Constitution;
Second, The Statutory Law;
Third, The Decisions of the Courts;
Fourth, The Rules of Practice; and
Fifth, The Decisions of the Commissioners.

These are interdependent and should be considered in the order named.

This book relates to that part of the practice which is governed by the rules and the constructions that have been placed upon them by the decisions of the Commissioners and the Courts. It contains the data of the daily practice, often arbitrary, without which there would be an unnecessary burden on the memory of the practitioner.

These notes have been a gradual growth commencing twenty-five years ago and kept up to date by the adding of current constructions. From these the reader gets a view from the inside as well as from the outside of "The Office".

Our Patent Office Practice is still incomparably the best in the world. Let us keep it so.

The difficulties* of the judges in comprehending the facts involved in patent cases, which have been cumulative with the increasing complexity of the Arts and Sciences, have somewhat weakened the authortiy of their opinions. Pending legislation proposes to remedy this.

E. J. STODDARD.

May 1, 1920.

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*"Neither courts nor ordinary juries are perfectly adapted to the

investigation of mechanical and scientific questions."—Cochrane v. Deener, 11 Brodix, 333 (Supreme Court, 1877).

"The defense of want of invention in the Diddell machine is not urged here because it is said that the decision of that question depends upon mechanical comparisons too numerous and complicated to be conveniently made by a bench of judges."—Continental Paper Bag Co. v. Eastern Paper Bag Co., 136 O. G., 1297 (Supreme Court, 1908).

"How long we shall blunder along without the aid of unpartisan and authoritative, scientific assistants in this administration of justice, no one knows; but all fair persons not conventionalized by provincial legal habits of mind ought, I should think, unite to effect some such advance."—Judge Hand in Park Davis & Co. v. Mulford Co., 189 F. R. 95–115.

"The truth is that the worst effect of the existing situation is that it undermines confidence. It demoralizes the Bar. A lawyer does not know how to advise his clients. It tempts both attorney and client to take chances. The law-abiding citizens, who want to obey the law, who want to respect valid patents, but do not want to be terrorized into acquiescence in invalid patents, do not know what to do and can not find out. There is but one remedy and it is in a single court of last resort in patent causes."—Judge Robert S. Taylor, Chairman, Committee of American Bar Association.

"It is a travesty on justice to try to patent cases before a judge, who is not a mechanic nor a patent expert and who has no imagination, who can not picture the improvements that certain changes will make in the development of an art and who can not connect the operation of the invention with the practical work in a factory."—Commissioner, James T. Newton (Present Commissioner).

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ANNOTATED RULES OF PRACTICE IN THE UNITED STATES PATENT OFFICE

The following rules of practice, duly adopted and approved by the Secretary of the Interior, designed to be in strict accordance with the Revised Statutes relating to the grant of patents for inventions, are published for gratuitous distribution. Marginal references to corresponding provisions of the Revised Statutes are given for the convenience of the public and of the office.

The observance of the appended forms, in all cases to which they may be applicable, is recommended to inventors and attorneys.

Printed copies of the Revised Statutes relating to the grant of patents may be obtained on application to the Commissioner.

THOMAS EWING,
Commissioner of Patents.

Rev. Stat., secs. 481, 483, 489.

PAPERS PREPARED BY THE EXAMINING CORPS.

Beginning in the summer of 1914, the corps has been assembled in weekly sessions during the fall and winter months to hear papers prepared by members of the corps in exposition of the law of patents.

All but 5 of the 43 divisions have produced papers, and the total number of papers will run close to 70. The point has been reached where it is difficult to select new subjects for treatment.

These papers have been and are being printed at the expense of the examining corps and such attorneys as have subscribed. The edition started at 500, but has been increased to meet the demand and is now 800.

In addition to the papers read by the corps, we have had addresses by Messrs. Melville Church of the Washington bar, Frederick P. Fish of the Boston bar, the late J. Nota McGill of the Washington bar, and Hon. Arthur C. Dennison, United States circuit judge, sixth circuit.

This office is the experimental station of the patent system. Everything in the way of growth or advance in the law either originates here or must be applied in its early development in granting or refusing patents. The ready response which the corps has made to the call for papers is greatly appreciated as indicating that it is awake to its duty to study the law and to keep abreast with any development therein.

REPORT OF THE COMMISSIONER OF PATENTS FOR 1916.

Such of these papers as are in print may be obtained from Mr. Geo. P. Tucker, Room 275, U. S. Patent Office.

The journal of the Patent Office Society is published monthly. W. J. Wesseler, Business Manager, 1315 Clifton St., Washington, D. C.

HISTORY.

"The Act of 1839, sec. 12, conferred on the Commissioner of Patents the authority required for the making of regulations in respect to the taking of evidence to be used in contested cases before him; this power was further enlarged by the Act of March 2, 1861, sec. 1.

"These provisions were reenacted in section 43 of the Act of 1870, and are now embodied in section 4905 of the Revised Statutes.

"The Act of March 2, 1861, sec. 2, established a board of examiners-in-chief, and provided that they should be governed in their action by the rules to be prescribed by the Commissioner of Patents.

"The Act of 1870 greatly enlarged this power, and in its nineteenth section authorized the commissioner, subject to the approval of the Secretary of the Interior, to establish rules and regulations for the conduct of proceedings in the patent office.

"It is from this enactment, repeated in section 483 of the Revised Statutes, that the accompanying rules derive their force."

Lowery's Annotated Interference Rules.

1907 *Note as to Changes in Rules.*

The rules of date November 1, 1869, are simply signed Samuel S. Fisher, Commissioner; the rules of July, 1870, pro-

fess to be under the amended laws of 1870, and are signed by Commissioner Fisher and approved by J. D. Cox, Secretary of the Interior. They are quite similar to the rules of 1869. The rules of 1870 served as a model for other editions up to the general revision under Commissioner Paine in 1879, which latter have served for a model up to the present time, except the edition under Commissioner Seymour, which separated the laws and rules and matters of mere information and advice, and published the laws and rules together. The present general form was soon returned to under Commissioner Betterworth in 1897.

The changes in the rules since 1879 have been noted in recent editions, these notes taken from the rules of 1907 are as follows:

General revision, December 1, 1879, to take effect January 1, 1880.

First revised edition, September 1, 1880, under which Rules 20, 30, 31, 89, par. (1) of 50, 55, 94, 101, 111, 116, 117, 118, 119, 120, 134, 144, 160, 171, and 209 were amended.

Second revised edition, April 15, 1882, under which Rules 39, 46, 85, 86, 94, 124, and 171 were amended, and Forms 17 and 18 consolidated and amended as Form 17.

Third revised edition, February 1, 1883, under which Rules 26, 26, 39, 47, and 59 were amended, and notes * * inserted at bottom of pages 9 and 17.

Fourth revised edition, November 15, 1883, under which Rules 20, 26, and 165 were amended.

Fifth revised edition, March 1, 1884, under which Rules 26, 62, and 209, and Form 37 were amended.

Sixth revised edition, August 12, 1884, under which Rules 35, 67, 137, and 138 were amended.

Seventh revised edition, March 3, 1885, under which Rules 53, 94, 97, 102, 104, 105, 106, 107, 116, 119, 126, 157, and 171 were amended.

Eighth revised edition, November 16, 1885, under which Rules 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 44, 45, 47, 86, 140, 144, and 145 were amended.

Ninth revised edition, July 13, 1886, under which Rules 40, 67, 74, and 77 were amended.

Tenth revised edition, March 9, 1887, under which Rule 171 and Form 21 were amended and Forms 19, 52, and 53 were inserted.

Eleventh revised edition, April 18, 1888 (being a general revision), under which new Rules 44, 2d and 3d pars of 46, 2d par. of 77, 105, 2d par. of 111, 132, 157, 166, 228, and 229

were inserted, and the numbering of the rules changed to correspond therewith.

Twelfth revised edition, July 1, 1891, under which Rules 17, 51, 52, 83, 84, and 218 were amended, and Form 36 changed.

Thirteenth revised edition, April 1, 1892, under which Rules 24, 26, 31, 48, 7th par. of 51, 4th par. of 63, 66, 70, 73, 77, 88, 97, 116, 119, 124, 125, 151, 3d and 8th pars. of 154, 162, 171, 205, 218, 223, 225, and Forms 12 and 17 were amended.

Fourteenth revised edition, February 9, 1897, under which the rules were substantially rewritten, reduced in number to eighty-eight, and rearranged, and the forms were revised throughout.

Fifteenth revised edition, June 18, 1897, under which the rules of the thirteenth revised edition, April 1, 1892, were restored, except Rules 181-194, inclusive, relating to extensions, and Rules 223 and 228. Rules 12, 17, 20, 25, 46, 48, 3d par. of 50, 55, 56, 61, 63, 64, 66, 71, 81, 83, 84, 91, 97, 116, 119, 1st par. of 122, 1st par. of 124, 127, 128, 129, 135, 145-150, inclusive, 154, 156, 162, 163, 169, 179, 218, 221, 226, and 229 of the thirteenth revised edition, and Forms 1, 8, 9, 15, 20, and 48 of the fourteenth revised edition were amended.

The changes in the numbering of the rules in the thirteenth edition (April 1, 1892), were as follows in the fifteenth edition, of June 18, 1897:

No. in edition of April 1, 1892	No. in edition of June 18,1897	No. in edition of April 1, 1892	No. in edition of June 18, 1897	No. in edition of April 1, 1892	No. in edition of June 18, 1897
195	181	206	192	217	203
196	182	207	193	218	204
197	183	208	194	219	205
198	184	209	195	220	206
199	185	210	196	221	207
200	186	211	197	222	208
201	187	212	198	224	209
202	188	213	199	225	210
203	189	214	200	226	211
204	190	215	201	227	212
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Fifteenth revised edition, June 18, 1897 (second edition, December 1, 1897), contains an appendix with amendments to Rules 24 (first paragraph), 29, 31 (last paragraph), 39 (section 1), 46 (first paragraph), 63 (second paragraph), 75, 77 (first and second paragraphs), 94, 166, 168, 171 (first paragraph), and 198.

Sixteenth revised edition, July 18, 1899, under which Rules 9, 18, 25, 33, 41, 46, 47, 60, 77, 78, 91, 96, 107, 110, 112, 124, 128, 149, 154, 156, and 162 are amended, Rule 214 added, and in which the changes noted in the appendix to the last edition and those appearing in the Official Gazette since the publication of the fifteenth edition have been incorporated in the rules.

Forms 1 to 17, and 37 are amended, Form 7 added, and the forms renumbered as necessary.

The first reprint, February 28, 1900, of the sixteenth edition embodies changes in the rules appearing in the Official Gazette since the publication of that edition, which are indicated by capital letters, also certain changes in Forms 16, 18, 29, 30, 31, 32, 35, and 45, and chart for guidance of draftsmen.

The second reprint, March 30, 1901, of the sixteenth edition changes the requirements of Rule 162 in regard to the number of copies of printed testimony to be furnished.

The third reprint, January 4, 1902, of the sixteenth edition has no changes except the cancellation of the paragraphs in Rules 18, 154, and 204, relating to revenue stamps.

Seventeenth revised edition, January 2, 1903, under which Rules 24, 30, 31, 48, 50, 51 (7), 60, 68, 79, 81, 84, 97, 124, 125, 151, 170, 173, 197 (2), 204, and Forms 16, 18, and 21 are amended.

The first reprint, April 15, 1903, of the seventeenth edition embodies changes in Rules 24, 29, 46, 47, 48, 79, 110, 114, 184, 189, the cancellation of Rule 186, and the numbering of the rules to correspond therewith.

The second reprint, January 1, 1904, of the seventeenth edition embodies changes in Rules 25 and 81, the division of Rule 81, the latter portion being made Rule 82, the renumbering of old Rules 82 and 83 as 83 and 84, and the cancellation of old Rule 84; changes in Rules 96, 110, and in 203 in the matter of the price of Rosters of Attorneys, also in Form 16.

Eighteenth revised edition, July 2, 1904, under which Rules 41, 133, 134, 135, and 145, and Form 18 are amended.

Nineteenth revised edition, February 28, 1905, under which Rules 17, 46, 51, 52, 86, 110, 122, 124, 203, and 206 are amended.

The first reprint of the nineteenth revised edition September 1, 1905, has no changes.

The second reprint, July 31, 1906, of the nineteenth edition embodies changes in Rules 46, 109, 114, 122, 124, 130, 141, and 162.

The third reprint, October 15, 1906, of the nineteenth revised edition has no changes.

Lowery's Annotated Interference Rules.

"The conclusiveness of the Patent Office Rules has been considered in—Arnold v. Bishop, 1841, Cranch, Ch. J., 1 MacA. Patent Cases; Nichols v. Harris, 1854, Morsell, J., 1 MacA. P. C. 3028; O'Hara v. Hawes, 1859, Morsell, J., Laws. Digest 96.

"The authority of these rules as a construction of the statute is stated in Arnold v. Bishop, 1841, Cranch, Ch. J., 1 MacA. Pat. Cases 27; Nichols v. Harris, 1854, Morsell, J., ibid. 302; Dyson, ex parte, 1860, Dunlap, 1 ibid. 96."

CONSTRUCTIONS.

The approval of the Secretary of the Interior being necessary to the adoption and establishment of a rule, we think the contrary would be true that where a rule of procedure is in force it can only be repealed, modified or suspended by the commissioner, with the approval of the Secretary of the Interior. (Question not before the court, however.)

Mill v. Midgley, 136 O. G. 1534.

It is true that the examiner's decision was rendered upon June 4, 1906; that the rule was not amended until June 12, 1906, and that the amendment was not promulgated until June 19, 1906. This appeal was not filed, however, until June 22, 1906, and it is clearly barred by the amended rule.

It is well settled that alterations in procedure and practice are retrospective in effect unless there is some good reason against it.

Wheeler v. Seeberger, 125 O. G. 2363.

Rule 86 has the force and effect of a statute while it stands.

Pender, 123 O. G. 2975.

Administrative officers should regard the opinions of the attorney-general upon questions referred to him for his opinion under section 356 of the Revised Statutes as law until either withdrawn by the attorney-general or overruled by the courts. (See 20 Op. Atty.-Gen., pp. 648-655, 1895; 20 Op. Atty.-Gen., 719, 1894; also Berger v. U. S., 36 Ct. Claims, 247, 1901.)

Ex parte Theodare and Carl Weil, 122 O. G. 352.

Change of practice not retroactive.

Naef, 115 O. G. 2135.

In the actions upon cases both by the office and by appli-

cants the reasons for the rules of procedure should be kept in mind, and they should not be lost sight of by too close attention to supposed technical requirements as to form.

Murray, 111 O. G. 2491.

If there be no such inconsistency with the express provisions of the statutes, the rules are valid and have the force and effect of law.

U. S. ex. rel. Steinmetz v. Allen, Com., 1903 C. D. 578, 102 O. G. 231.

Rules of practice should only be applied to cases after their adoption.

Pfaudler, '83 C. D. 1-3.

For the above purpose a divisional application takes the date of the original.

Balzer, 101 O. G. 2824.

The following case relates to this subject:

Downing v. Fisher, 125 O. G. 2765.

That the rule having been adopted while the case was pending applies to it, is clear.

Farquhar, 89 O. G. 706; Hawkes, 69 O. C. D. 37. See, however, the case of Stone v. Greaves, 1880 C. D. 70.

The action of the German Patent Office considered.

Bedford et al. v. Duell, Com., 1899 C. D. 357, 87 O. G. 1611.

It is a well settled principle of law that alterations of procedure or practice are always retrospective unless there be some good reason against it.

MacMaster, 1897 C. D. 51, 80 O. G. 1475.

Rule 207 should not be held to apply to certificates of deposit issued prior to the approval of the rule.

Griffith, 1897 C. D. 46, 80 O. G. 1126.

I think that under section 483 of the Revised Statutes, I have authority by an order made with the approval of the Secretary of the Interior to authorize him to introduce such affidavits.

Rodgers, 1879 C. D. 333, 16 O. G. 1233.

To construe a rule of the Patent Office is at least a quasi-judicial act, and hence an appeal from the decision of the Commissioner to the Secretary of the Interior, based upon an alleged disregard of a certain rule must be dismissed.

Warner v. Stimson, 1897 C. D. 199, 78 O. G. 1901.

The attorney general will not advise the Commissioner how to decide a case pending before him on appeal when he conceives that the parties appealing have a right to expect the personal judgment of the Commissioner.

Ex parte H. Manske & Co., 1893 C. D. 137, 63 O. G. 1687.

In view of the practice that has been allowed to obtain, the public should have due notice of the adoption and enforcement of the new rule of practice.

Wiegand, 1891 C. D. 249, 56 O. G. 803.

Congress, in creating the Patent Office has; by express legislation, given that Office the power to enact rules for its conduct. These rules, if they are within the power of the Office, are just as authoritive as the laws of Congress itself, if within the limitations of its powers.

U. S. v. Marble Com., etc., 22 O. G. 1365; Dec. of Sec. Ex parte Pfandler, 23 O. G. 629.

The rules of the Office have the force of law so long as they remain unrepealed, and are as binding upon its officials as they are upon the general public.

Smoot, 1877 C. D. 51.

The Commissioner of Patents exercising the power conferred, established among others of the Rules of Practice, Rule 41. It thereby becomes a rule of procedure, and constituted, in part, the Powers of the Primary Examiner. In other words, it became an authority to those officers, and necessarily an authority under the United States.

U. S. ex rel. Steinmetz v. Allen, Co., 24 Supreme Ct. R. 420.

Eaving, Commissioner, v. U. S. ex rel. The Fowler Car Co., 226 O. G. 700.

Cases passing on the subject matter of this rule.

Helbig, 131 O. G. 1687; Balzer, 1902 C. D. 470, 101 O. G. 2824; Crown Cork & Seal Co., etc., v. Aluminum Stopper Co., 96 O. G. 2530; Kroeninger, 1900 C. D. 84, 91 O. G. 2002; Bedford v. Duell, Com., 1899 C. D. 357, 87 O. G. 1611; Griffith, 1897 C. D. 46, 80 O. G. 1126; Higgins, 1897 C. D. 73, 80 O. G. 2037; Smoot, 1877 C. D. 51, 11 O. G. 1010; Murray, 111 O. G. 2491.

Appeal to Secretary of the Interior.

Refusal of appeal under Rule 122 because substantially for unappealable matter under Rule 122, not appealable to Secretary.

Blackmore v. Hall, 120 O. G. 1477.

The Secretary has no authority to interfere to determine whether or not anyone may be a proper party to an interference.

Jenkins v. Jenkins and Armat, 1897 C. D. 202, 78 O. G. 1902.

Secretary of the Interior has jurisdiction of appeals arising from Rule 201.

Cote Company, 1893 C. D. 138, 65 O. G. 1915.

None from refusal to admit amended preliminary statement.

Noakes, 1892 C. D. 243, 60 O. G. 575.

"The Jurisdiction of the Secretary of the Interior on Appeal from Commissioner" considered by the Supreme Court.

Betterworth v. Hoe, 29 O. G. 615, 112 W. S. 50-60.

Citing this rule.

Casey (in re), 1902 C. D. 492, 101 O. G. 2567.

See Journal of the Patent Office Society, Vol. 1, Nos. 8 and 9.

CORRESPONDENCE AND INTERVIEWS.

Rule 1. Business to be Transacted in Writing.

All business with the office should be transacted in writing. Unless by the consent of all parties, the action of the office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is a disagreement or doubt.

CONSTRUCTIONS.

No attention given to an alleged verbal agreement between attorneys and examiner.

W. H. McLellan, 72 C. D. 152.

Postal Authorities are not agents of the Patent Office.

Ravelli, 130 O. G. 982; Meier, 136 O. G. 657; Kauermann, 157 O. G. 207; Cannon, 94 O. G. 2165; Dempsey, 132 O. G. 1074.

P. O. agent of applicant.

O'Brien, 181 O. G. 1073.

It is not good practice to base action in a case upon oral understanding or agreements without stating upon the record the reasons for the action.

Hunter, 116 O. G. 1731; See Kroeninger, 1900 C. D. 84, 91 O. G. 2002.

Rule 2. Correspondence to be in the Name of the Commissioner.

All office letters must be sent in the name of the "Commissioner of Patents." All letters and other communications intended for the office must be addressed to him; if addressed to any of the other officers, they will ordinarily be returned.

Rule 3. All Charges to be Prepaid.

Express charges, freight, postage, and all other charges on matter sent to the Patent Office must be prepaid in full; otherwise it will not be received.

Rule 4. Personal Attendance of Applicants Unnecessary.

The personal attendance of applicants at the Patent Office is unnecessary. Their business can be transacted by correspondence.

Rule 5. Correspondence with Assignees.

The assignee of the entire interest of an invention is entitled to hold correspondence with the office to the exclusion of the inventor. (See Rule 20.)

CONSTRUCTIONS.

See Rules 6, 26, 183.

It is not necessary that the assignment should contain a request to issue to the assignee.

Hill and Hill, 206 O. G. 1437.

The Patent Office will not consider disputes.

Patridge, 183 O. G. 781.

An option, though exclusive, not recognized under this rule.

Newman, 183 O. G. 220.

Must be an assignee of the legal title and a request to issue the patent to the assignee necessary.

Steinford, 138 O. G. 527.

The validity of this rule will not be considered by the secretary of the interior in a collateral attack.

Adams, 129 O. G. 1612.

The inventor should be excluded when the assignee of the entire interest so requests without the necessity of a showing of reasons by the assignee why such action should be taken. (MacLaughlin, 55 O. G. 864, overruled to this extent.)

The Kellop Switchboard & Supply Company, 123 O. G. 2310.

Also cites Duncan and Duncan, 109 O. G. 805.

The assignee of the entire interest wrote a letter to the office stating that the invention had been in public use more than two years prior to the application. Held sufficient to warrant refusing the patent on the ground of public use.

Cummings, 114 O. G. 2090.

The rule laid down in ex parte McTammany, 33 O. G. 751, is modified to this extent that where there are conflicting assignments of an application which is involved in interference the first assignee, if he intervenes, will be recognized to prosecute that application until his assignment is set aside.

Sparks v. Small, 113 O. G. 1970-1-2.

Where an applicant has two applications for the same invention pending, one of which is assigned, held that he may inspect the assigned application in order to properly limit the other.

MacLaughlin, 1891 C. D. 68, 55 O. G. 864.

Where an application has been filed and assigned, the assignee may prosecute the application just as if a subsequent application by the same inventor had not been filed.

McLaughlin, 55 O. G. 863, 1891 C. D. 67.

Until an assignee of the entire interest asserts his right to hold correspondence with the office to the exclusion of the inventor, it is the practice of the office, except in exceptional cases, to recognize a correspondingly exclusive right on the part of the attorney of the inventor.

Baker, 1889 C. D. 232, 49 O. G. 1363.

It is important that the office should require the assignee of the entire interest before a patent is issued to join in the power of attorney granted by the inventor or to appoint some attorney to represent their interests.

Ackerman, 1880 C. D. 131.

This refers to a legal interest, and one having the right to have the entire interest assigned to him upon the happening of a condition, as the granting of the patent, is not entitled to appoint the attorney.

Martin v. Olney, 1876 C. D. 124, 9 O. G. 1107.

Cases passing on the subject-matter of this rule.

Stebler, 177 O. G. 1044; Loclertrand v. Cornwall, 148 O.

G. 1344; Duncan & Duncan, 1904 C. D. ——, 109 O. G. 805; Bryant, 1902 C. D. 334, 100 O. G. 2773.

Rule 6. Correspondence with Inventor and Assignee.

When there has been an assignment of an undivided part of an invention, amendments and other actions requiring the signature of the inventor must also receive the written assent of the assignee; but official letters will only be sent to the post-office address of the inventor, unless he shall otherwise direct.

CONSTRUCTIONS.

See notes to Rules 5, 31, 26, and 183.

In issuing either original or reissue patents, grantees of interests therein shall not be considered to be other than assignees because of an outstanding license, whether exclusive or not, and the patents shall issue to the same parties as they would if such licenses did not exist.

Dudley, 187 O. G. 829.

An appeal does not lie to the Secretary of the Interior from a decision of the Commissioner, in reference to assignments.

In re Wurtz, Jr., 123 O. G. 320.

Until the assignment has been set aside by a competent tribunal the office must give it full effect thereto. (See note to R. 25.)

In re Wurtz, Jr., 123 O. G. 320.

A petition to allow the assignee of a part interest to prosecute the case is proper, when, and only when, it appears necessary to prevent abandonment.

Fitzhugh, 120 O. G. 660.

It is the settled practice not to permit the assignee of a part interest, upon his mere demand, to prosecute the application to the exclusion of the inventor. On the contrary, the inventor is permitted to prosecute the application to the exclusion of everyone save the assignee of the entire interest.

Sandstrom, 113 O. G. 850.

The office has no jurisdiction to investigate and decide disputed questions of title, since these matters are left to the courts. It acts in a ministerial capacity in regard to assignments and must follow the record without attempting to adjudicate the rights of the parties on disputed questions of fact.

Turner, 1902 C. D. 329, 100 O. G. 2603.

Affidavits alone not sufficient to establish the fact of assignment.

Collins, 1902 C. D. 324, 100 O. G. 2601.

A licensee is not entitled to access to papers.

Adam, 1900 C. D. 106, 92 O. G. 190.

The assignee of an entire interest may prosecute an interference on behalf of the application of his principal who died while the interference proceedings were pending.

Chase v. Ryder, 1892 C. D. 219, 61 O. G. 885.

The Commissioner of Patents has no judicial authority to take action in disputed questions of title under an assignment, nor is it ordinarily within his discretion to interfere to prevent the revocation of a power of attorney by an applicant.

Gallatin, 1892 C. D. 106, 59 O. G. 1104.

The assignee of an inventor who died before making his application has no standing as an applicant before the Patent Office, and this is true where the application sought to be made by the assignee is a division of one properly filed by the inventor.

Stevens, 1892 C. D. 87, 59 O. G. 299.

Where one of two joint applicants subsequently files a sole application for the same improvement, a power of attorney, executed by the other of the joint applicants and their assignee, will be accepted by this office as sufficient.

Ex parte Benjamin & Bailey, 1892 C. D. 85, 59 O. G. 298.

A party who bases his rights as an assignee upon an instrument recorded in the Patent Office before application was made and not specifically identifying the invention will not be permitted to examine the files because such an instrument is not an assignment, but a mere executory agreement.

Lorentz, 1892 C. D. 77, 59 O. G. 158.

An instrument granting all right, title, and interest in the invention except as to a certain combination set forth in the application, is not an assignment, and an attorney appointed by a person holding such an instrument will not be recognized in the prosecution of the case.

Hunter, 1891 C. D. 122.

The grantee of a territorial interest is not within the rule.

Funston, 1889 C. D. 223, 49 O. G. 1044.

If the assignee does not assert his right the attorney appointed by the inventor should be recognized.

Baker, 1889 C. D. 232, 49 O. G. 1363.

The commissioner has no equitable jurisdiction over the

rights of parties claiming under assignments and grants of inventions and patents.

McDonough v. Gray, v. Bell, v. Edison, 1889 C. D. 9, 46 O. G. 1245.

The requirement that both parties shall sign "amendments and other actions" applies only where the personal signature of the inventor is required, such as supplementary oaths, disclaimer, concession of priority, etc.

Ackerman, 1880 C. D. 131, 17-18 O. G.

See Graham, 112 O. G. 1752.

See note to Rule 26.

Chillingsworth, 1897 C. D. 72, 80 O. G. 1892.

See note to Rule 20.

Anderson, 1893 C. D. 12, 62 O. G. 449.

Seven instances where the signature of the assignee of an undivided part of an invention is required:

Journal of the Patent Office Society, vol. 1, No. 1, pp. 26-27.

Rule 7. Correspondence with Attorney.

When an attorney shall have filed his power of attorney, duly executed, the correspondence will be held with him.

A double correspondence with the inventor and an assignee, or with a principal and his attorney, or with two attorneys, can not generally be allowed.

CONSTRUCTIONS.

Where a power of attorney is given to a party who is not registered.

Order No. 2047, April 30, 1913.

Where perpetual motion is involved.

Notice of January 30, 1918.

A principal attorney has a right to amend over his own signature, but it is best that the case should be conducted in the name of either the principal of associate alone.

Eggan. 172 O. G. 1091.

Where two firms are nominated as principal attorney, one of which is a resident of Washington, in the absence of any direction to the contrary correspondence should be with the latter firm.

Jewett, 1887 C. D. 17, 38 O. G. 781.

The nomination of an "associate attorney," made by appli-

cant without the consent of the principal attorney, can not be recognized or acted upon.

Ranks, 1887 C. D. 7, 38 O. G. 329.

Double correspondence with principal and associate attorneys not allowed.

Ranks, 1887 C. D. 7, 38 O. G. 329.

Rule 8. Separate Letters.

A separate letter should in every case be written in relation to each distinct subject of inquiry or application. Assignments for record, final fees, and orders for copies or abstracts must be sent to the office in separate letters.

Papers sent in violation of this rule will be returned.

Rule 9. Letters Relating to Applications.

When a letter concerns an application, it should state the name of the applicant, the title of the invention, the serial number of the application (see Rule 31), and the date of filing the same (see Rule 32).

CONSTRUCTIONS.

Applies to oaths. They should properly identify the application.

Heusch, 1899 C. D. 172, 88 O. G. 1703.

Rule 10. Letters Relating to Patents.

When the letter concerns a patent, it should state the name of the patentee, the title of the invention, and the number and date of the patent

Rule 11. Protests.

No attention will be paid to unverified *ex parte* statements or protests of persons concerning pending applications to which they are not parties, unless information of the pendency of these applications shall have been voluntarily communicated by the applicants.

CONSTRUCTIONS.

See Rules 12 (Rule 128 of 1870) and Rule 15.

If one does not wish to make the claims suggested to him under Rule 96, he can not prevent such claims from being allowed to others.

Bryant, Wolcott, and Davidson, 121 O. G. 2663.

Question first raised in appeal to the Commissioner. The question of patentability of the issue is an ex parte one, and Hedlund has no right at this time to argue the question before any of the tribunals of this office. His protest will be considered by the Primary Examiner when the respective applications come before him for ex parte action. Hedlund has no right to argue the question of the pertenancy of the references against C's claims, and the motion to strike the brief from the files is therefore granted.

Hedlund v. Curtis, 114 O. G. 544-5.

A party defeated in an interference can not be heard to protest against the grant of a patent to his opponents, on the ground that they were falsely represented as joint inventors.

Robin v. Muller & Bonnet, 113 O. G. 2506.

After the determination of an interference a protest by the unsuccessful party against the issue of a patent to the successful party will not be entertained.

Kempshall v. Seiberling, 107 O. G. 541; see also Coleman, 107 O. G. 1662, and Green v. Hall v. Siemens v. Field, 1889 C. D. 166, 470 O. G. 1663.

A mandamus commanding the commissioner of patents to institute public use proceedings refused for want of a legal interest in the petitioner.

The U. S. of America ex rel. Nat. Phonograph Co. v. Allen, Commissioner of Pat., 1902 C. D. 571, 101 O. G. 1133.

Where a protestant against the issue of a patent only filed an affidavit describing a device which he alleged had been in public use more than two years before the applicant had filed his application and failed to file an exhibit, model, or drawing, clearly showing the nature of the device so alleged to have been in public use. Held that such an affidavit was insufficient to warrant public use proceedings.

Fay v. Conrad, Com., 1893 C. D. 129, 65 O. G. 751.

A protest against the issuance of a patent to an applicant is fatally defective unless it embodies something equivalent to a distinct denial of the applicant's sworn statement of invention.

Riley v. Barnard, 1892 C. D. 134, 59 O. G. 1921.

The fact that an applicant has incorporated a notice of his intention to apply for a patent in an amendment to a former application taken notice of.

See Dec. Sec., 23 O. G. 629.

A party to an interference may protest against the granting of a patent because of abandonment by public use.

Hidges v. Daniels, 1880 C. D. 10, 17 O. G. 152; Rehearing, 1880 C. D. 64; Fowler v. Benton, 1180 C. D. 39, 17 O. G. 266.

Formerly the rules of the patent office interdicted the consideration by the commissioner of any ex parte protests against the issue of letters patent to an applicant. The rule has disappeared. The rule requiring pending applications to be kept in secrecy must be duly considered in the adoption of any general rule for the disposition of ex parte protests against the issue of letters patent. I have concluded to consider no such protests, except upon legitimate proof showing conclusively or presumptively that the application against which the protest is directed has been, or is about to be filed. The proof must rest upon disclosures made by the applicant himself, or upon facts otherwise lawfully discovered.

Neale, 1879 C. D. 11, 15 O. G. 511.

The results of the proceedings in interference cases under the old rules, allowing an appeal from a decision affirming patentability, were beneficial to the public, for it often prevented the issue of worthless patents. But the same results are obtainable by ex parte protests against the grant of patents subject to the restrictions of Rule 12, which protests are always in order.

Such protest would be entertained by the Commissioner either forthwith or after the determination of the interference, or at such other time as justice might seem to require in the particular case.

Fowler v. Benton, 80 C. D. 39, 17 O. G. 266.

See Wilder, 128 O. G. 455.

Rule 12. Mail.

Mail reaching the post office at Washington, D. C., up to 4.30 p. m. on week days, excepting holidays, and 1 p. m. on half holidays, is entered as received in the Patent Office on the day it reaches the post office.

Special-delivery letters and other papers may be

deposited in a box provided at the watchman's desk at the F Street entrance of the Patent Office up to midnight on week days, including holidays, and all papers deposited therein are entered as received in the Patent Office on the day of deposit.

Letters received at the office will be answered, and orders for printed copies filled, without unnecessary delay. Telegrams, if not received before 3 o'clock p. m., can not ordinarily be answered until the following day.

"On weekdays, including holidays," inserted after "midnight" by amendment, see Gazette of June 20, 1916, 228 O. G. 1.

Rule 13. Interviews with Examiners.

Interviews with examiners concerning applications and other matters pending before the office must be had in the examiners' rooms at such times, within office hours, as the respective examiners may designate, in the absence of the primary examiners, with the assistant in charge. Interviews will not be permitted at any other time or place without the written authority of the Commissioner. Interviews for the discussion of pending applications will not be had prior to the first official action thereon.

INFORMATION TO CORRESPONDENTS.

Rule 14. Subjects on which Information can not be Given.

The office can not respond to inquiries as to the novelty of an alleged invention in advance of the filing of an application for a patent, nor to inquiries propounded with a view to ascertaining whether any alleged improvements have been patented, and, if so, to whom; nor can it act as an expounder of the patent law, nor as counsellor for individuals, except as to questions arising within the office.

Of the propriety of making an application for a patent, the inventor must judge for himself. The office is open to him, and its records and models pertaining to all patents granted may be inspected either by himself or by any attorney or expert he may call to his aid, and its reports are widely distributed. (See Rule 196.) Further than this the office can render him no assistance until his case comes regularly before it in the manner prescribed by law. A copy of the rules, with this section marked, sent to the individual making an inquiry of the character referred to, is intended as a respectful answer by the office.

Examiners' digests are not open to public inspection.

Rev. Stat., secs. 475 481, 484, 4883.

Rule 15. Pending Applications Kept in Secrecy.

Pending applications are preserved in secrecy. No information will be given, without authority, respecting the filing by any particular person of an application for a patent or for the reissue of a patent, the pendency of any particular case before the office, or the subject matter of any particular application, unless it shall be necessary to the proper conduct of business before the office, as provided by Rules 97, 103, and 108.

CONSTRUCTIONS.

Authorized officers of the army and navy may inspect in the public interest.

Amendment, 247 O. G. 249.

This rule in force since 1851. "The rule is such a one as the statute authorizes the department to make and for that reason has the force and effect of law.

Decision of the Secretary of the Interior, Pfaudler, 1883 C. D. 1, 23 O. G. 269.

Since the prior application is a part of the office records

and can be inspected at any time by its tribunals, G may present argument without seeing F's prior application.

Felming v. Gardner, 228 O. G. 1457.

The fact that a party stated that he found out that applications were pending through the application of one W in a petition for public use proceedings gives applicant's opponents no right of access to W's files.

Decré v. Mariser Co., 176 O. G. 273.

Rule not inconsistent with Rule 43.

Summers, 160 O. G. 1039.

A refusal to allow access to a pending application until a matter of title between the parties is settled in the courts, is an exercise of a proper discretion and will not be controlled by mandamus.

Moore, Com., v. U. S. ex rel. Boyer, 138 O. G. 530; see also (S. C. D. C.), 138 O. G. 529.

The fact that an application is referred to incidentally during an interference but is not relied upon in any way does not give an opponent a right to see the files.

Lindstrom v. Lipschultz, 121 O. G. 1977.

All the reasons for preserving original applications in secrecy do not exist in reissue applications, and therefore the same character of showing is not required to warrant furnishing copies.

A reissue applicant has no secret invention to be concealed from the public, since he has necessarily disclosed it in his patent. All that can be concealed in a reissue case is the procedure and new claims made.

The New York Woven Wire Mattress Company, 121 O. G. 688.

No violation of this rule to permit cross-references between two applications owned by the same party.

Kellogg, 120 O. G. 2754.

When an interference has been dissolved neither party has a right to be heard upon the consideration of claims subsequently presented by the third party.

Meigs, Hughes and Slout v. Gordon, 116 O. G. 1184.

A party derives no right to see an application from the fact that he was at one time in interference with it. After the conclusion of the interference he stands upon the same footing as a third party and must establish his right derived from other sources.

The fact that he is about to commence suit for infringement against his opponent in the interference proceeding is not sufficient, an order or certificate from the court should be required.

Mygatt, 1905 C. D. 110, 115 O. G. 1066.

The office should not under any technical construction of the rule of secrecy conceal from the public the proceedings which lead to the grant of a patent. When a patent is granted, all proceedings leading to its grant should be public property.

Doman, 1905 C. D. 101, 115 O. G. 804.

Where a patent is granted containing the statement that it is a continuation in part of a prior application, access to such prior application will not be granted to strangers without a proper showing of interest and without giving the applicant an opportunity to oppose such action, particularly where such prior application is still pending, and it appears that its subject-matter is not identical with that of the patent.

Wixford, 120 O. G. 1166, distinguished from ex parte Dorman, 115 O. G. 804.

Applications are in general preserved in secrecy. Exceptions are made where the applicant waives his right to its enforcement by reference to his application in a patent or in an interference proceeding or suit (109 O. G. 1070, 112 O. G. 1480, 48 O. G. 1263), or where a judge certifies that it is probably material and relevant evidence (109 O. G. 1885, 110 O. G. 860). Exceptions to the rule are not made because the application has been in interference (96 O. G. 1238).

Heard, 1905 C. D. 66, 114 O. G. 2381; Brown, 115 O. G. 248.

Conditions may arise, however, to justify the removal of the bar of secrecy from persons making a showing of interest in the invention disclosed in such application.

As in the declaration of an interference, or the assignment of the invention, the commissioner, in his discretion, may throw the applications open to the inspection of parties in interest. In this particular case the petitioner has filed an order from the court, and it should be respected, provided, of course, the records of the office indicate that the court was not deceived as to facts which induced it to issue the order.

Davis & Roesh Temperature Controlling Company, 114 O. G. 1549.

If an applicant refers to his application in his testimony his opponent may have access to the files of said application.

Patterson, 109 O. G. 1070.

The Examiner of Interferences referred to applications of one of the parties outside of the record as having a bearing on the question of diligence. Held to be improper.

Under the rules a party ordinarily has the right to expect that all applications filed by him will be preserved in secrecy.

It is only under unusual circumstances that information will be given to third parties.

Robinson v. Copeland, 102 O. G. 466.

It is improper for the examiner to cite a decision of the office upon another pending application to which the applicant has not access. Even the statement that such a case is on file of doubtful propriety.

Morley, 1902 C. D. 144, 99 O. G. 668.

When an application is referred to in a subsequently granted patent, it is prima facie evidence that the patentee relies upon the pending application for certain purposes, and access to the same will ordinarily be granted to a party making a proper showing of interest. It must be accompanied by a verified statement of facts, however.

Dayton Fan Co., 1901 C. D. 157, 97 O. G. 552.

Where a patentee has in the papers in his application referred to a prior application filed by him and the petitioner asking copies of the prior application for use in a suit shows that the record therein is pertinent. Held, that he has a prima facie right to obtain copies.

Reed Mfg. Co., 1900 C. D. 141, 92 O. G. 2001.

An applicant by referring to a caveat and quoting therefrom in an affidavit filed under Rule 75 to overcome a prior patent upon which the application stands rejected does not withdraw the caveat from the confidential archives of the patent office and lose the right to have it "preserved in secrecy" so that another applicant with whose application his application is placed in interference becomes entitled to a copy of the caveat.

In re Lowry, 1900 C. D. 1, 90 O. G. 445.

Copies of papers furnished equitable owners in an interference proceeding.

Reiner v. MacPhail, 1899 C. D. 196, 89 O. G. 521.

It is in accordance with public policy and correct practice to refuse to give strangers to the record copies of pending applications without the consent of the applicants or assignees.

Stockton, 1897 C. D. 24.

For obvious reasons the greatest possible degree of secrecy should be exercised to prevent the marauding of patentable devices, and Rules 18 and 19 were promulgated with this end in view.

Knight v. Bagnall v. Curtis v. Morgan, 1896 C. D. 109, 76 O. G. 1115.

The office is not warranted in furnishing copies of the papers in pending applications, except to parties in interest, unless advised by a court of competent jurisdiction, having a

case before it, that evidence of this sort within the possession of the office is essential to the proper decision of the case.

Ex parte American Bell Telephone Company, 1893 C. D. 46, 63 O. G. 152.

The statute does not limit the period of secrecy relative to a caveat to one year.

Pollock, 1892 C. D. 103, 59 O. G. 939.

Because an applicant has been forced to use an application in an interference proceeding to establish a record date, it does not follow that the office should allow any and everyone to obtain copies of said application.

Dyer, 1891 C. D. 12, 56 O. G. 1564.

Whether wise or unwise, this rule is in force and must be considered in the adoption of any general rule for the disposition of ex parte protests against the issue of Letters Patent.

Neale, 1879 C. D. 11, 15 O. G. 511.

Where an application is put into interference with a patent, the attorneys for the patentee are not entitled to receive the same information of the applicant's application that the records of the patent office give him of the patentee's.

See Davis v. Garrett, 123 O. G. 1991.

Rule 16. Records and Copies in Patented Cases.

After a patent has issued, the model, specification, drawings, and all documents relating to the case are subject to general inspection, and copies, except of the model, will be furnished at the rates specified in Rule 191.

See notes to Rule 179.

ATTORNEYS.

Rule 17. Register of Attorneys.

An applicant or an assignee of the entire interest may prosecute his own case, but he is advised, unless familiar with such matters, to employ a competent patent attorney, as the value of patents depends largely upon the skillful preparation of the specification and claims. The office can not aid in the selection of an attorney.

A register of attorneys will be kept in this office, on

which will be entered the names of all persons entitled to represent applicants before the Patent Office in the presentation and prosecution of applications for patent. The names of persons in the following classes will, upon their written request, be entered upon this register:

(*a*) Any attorney at law who is in good standing in any court of record in the United States or any of the States or Territories thereof and who shall furnish a certificate of the clerk of such United States, State, or Territorial court, duly authenticated under the seal of the court, that he is an attorney in good standing.

(*b*) Any person not an attorney at law who is a citizen or resident of the United States and who shall file proof to the satisfaction of the Commissioner that he is of good moral character and of good repute and possessed of the necessary legal and technical qualifications to enable him to render applicants for patents valuable service and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office.

(*c*) Any foreign patent attorney not a resident of the United States, who shall file proof to the satisfaction of the Commissioner that he is registered and in good standing before the patent office of the country of which he is a citizen or subject, and is possessed of the qualifications stated in paragraph (*b*).

(*d*) Any firm will be registered which shall show that the individual members composing the firm are each and all registered under the provisions of the preceding sections.

(*e*) The Commissioner may require proof of qualifications other than those specified in paragraph (*a*) and reserves the right to decline to recognize any at-

torney, agent, or other person applying for registration under this rule.

(*f*) Any person or firm not registered and not entitled to be recognized under this rule as an attorney or agent to represent applicants generally may, upon a showing of circumstances which render it necessary or justifiable, be recognized by the Commissioner to prosecute as attorney or agent certain specified application or applications, but this limited recognition shall not extend further than the application or applications named.

(*g*) No person not registered or entitled to recognition as above provided will be permitted to prosecute applications before the Patent Office.

CONSTRUCTIONS.

Rev. Stat., secs. 475, 481, 484, 4883.

For amendment to this rule, see 205 O. G. 308.

An amendment constituting section (h) regulating advertising matter used or to be used by attorneys added 252 O. G. 747.

See Journal of the Patent Office Society, vol. I, No. 2, pp. 66, 67.

In the District of Columbia an attorney may not act as notary in his own case (Amendment to law). 215 O. G. 1267.

Where an applicant dies pending his application the authority of his solicitor ceases.

Phillips v. Sensenich, 134 O. G. 1806.

A person in the employ of the United States as a U. S. Commissioner can not act as attorney.

Bloch, 128 O. G. 457.

Inadvertence of attorney may be remedied by reissue.

Heroult, 127 O. G. 3217; see note under Rule 86.

Rule cited in Cazin, 120 O. G. 660.

Negligence of the attorney is negligence of the principle.

White v. Hewitt and Nolen, 115 O. G. 1847.

The assignment must definitely identify the application.

Williamson, 88 O. G. 2065, 1899 C. D. 177.

The power of attorney given by the assignees (½ interest) may be recognized as giving the attorneys the right to inspect

and obtain information as to the case but not the right to amend.

Sandstrom, 1904 C. D. 486, 113 O. G. 850.

Attorneys have power to make proper amendments to the drawing.

Wilcox, 101 O. G. 1829.

May not sign a drawing in addition to inventor.

McDonald, 1902 C. D. 408, 101 O. G. 1829.

Delay can not be considered unavoidable where it is due to the negligence of the attorney.

Collins, 1901 C. D. 181, 97 O. G. 1372.

Mistake of attorney in doubtful point of law not attributable to applicant.

Newton v. Woodward, 1900 C. D. 406, 93 O. G. 2319.

If an attorney has been appointed orally and recognized by the Office, after filing a formal power of attorney he may sign and appeal nunc pro tunc.

Pitney v. Smith & Egge, 1889 C. D. 193, 49 O. G. 129.

The law seems to prescribe no qualifications, either of capacity, character, age, sex or citizenship, or of any other kind for patent agents.

Hoosier Drill Co. v. Inglis, 1879 C. D. 80; Beck, 1880 C. D. 54, 17 O. G. 329.

Attorneys, original and substitute, have liens on papers.

Bowers, 1879 C. D. 275, 16 O. G. 1004.

An attorney has no such claim upon his client's papers as a mortgagee has upon mortgaged property whether personal or real. He has a right to retain possession of them until his fees are paid. The same rule ought to be applied to patent agents. The substitute attorney has a right to retain possession of the Letters Patent until the fees of the principal attorney are paid. Having given the patentee notice before he has paid the fees, the substitute attorney has a right to demand that his portion of the fees should be paid directly to him.

Bowers, 1879 C. D. 275, 16 O. G. 1004.

May not eliminate an essential feature of the invention.

Murdock, C. D., 16 O. G. 95.

The office of a patent solicitor is merely temporary; it is unlike that of an attorney before a court of law; it begins and ceases with each particular case.

Hoosier Drill Co. v. Ingells, 15 O. G. 1013.

May sometimes sign petition.

Higginbotham, 1875 C. D. 93, 8 O. G. 237; see notes, Rules 5, 6, 7, and 8.

Rule 18. Power of Attorney.

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

CONSTRUCTIONS.

One of two joint applicants can not appoint an attorney without the concurrence of the co-applicant except upon a showing of inability to obtain such concurrence.

Benjamin and Bailey, 59 O. G. 298; Barrett and Aller, 127 O. G. 847; Forrest and Horton, 141 O. G. 566.

That rule of the Office which denies recognition to general powers of attorney seems to be applicable here. The power should be signed by the executor himself.

Rogers, 125 O. G. 2766.

Under the usual and long established practice written power was not necessary to entitle counsel to take part in the examination of the witnesses.

Fairbanks v. Sauer v. Karr, 1904 C. D. 503, 113 O. G. 1148.

Associate attorneys are appointed by the principal attorneys and not by the assignees of the inventor.

Hertford, 1904 C. D. 487, 113 O. G. 851.

An attorney may sign a petition for the renewal of a caveat.

Reim, 103 O. G. 2173.

Where one of two joint applicants subsequently files a sole application for the same improvement, a power of attorney, executed by the other of the joint applicants and their assignees, will be accepted by the Office as sufficient.

Benjamin and Bailey, 1892 C. D. 85, 59 O. G. 2983.

Papers signed *nunc pro tunc.*

Pitney v. Smith v. Egge, 1889 C. D. 193, 49 O. G. 129.

When two or more attorneys are appointed the applicant should designate with which correspondence should be held.

If he does not and one is a Washington attorney, correspondence will be held with him.

Jewett, 1887 C. D. 17, 38 O. G. 781.

It is not within the power of an attorney to abandon the application by canceling all the claims.

Lasscell, 1884 C. D. 42, 28 O. G. 1274.

Rule 19. Substitution and Association.

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

CONSTRUCTIONS.

No appeal from the Commissioner refusing to ignore an assignment.

In re Wurtg, Jr., 123 O. G. 320.

The greatest possible degree of secrecy should be exercised to prevent the marauding of patentable devices, and Rules 18 and 19 were promulgated with this end in view.

Knight v. Bagncell v. Curtis v. Morgan, 1896 C. D. 109. 76 O. G. 1115.

An associate attorney cannot be appointed by the principal without the consent of the attorney.

Rule 19 seems specific on this subject.

Ranks, 38 O. G. 329; Beck, 1880 C. D. 54, 17 O. G. 329.

An associate power of attorney given by the applicant will not be recognized without the assent of the principal attorney.

Ranks, 1887 C. D. 7, 38 O. G. 329.

"Whether principal or associate, it makes no difference." (Endorsement by Com. Ewing on a Petition.)

So far as published decisions go, Ex parte Ranks still stands.

Journal of the Patent Office Society, Vol. 1, No. 1, page 37.

The acts of an associate attorney are binding upon the principal.

Clausen, 1899 C. D. 183, 88 O. G. 2242-43.

Rule 20. Revocation.

Powers of attorney may be revoked at any stage in the proceedings of a case upon application to and ap-

proval by the Commissioner; and when so revoked the office will communicate directly with the applicant, or another attorney appointed by him. An attorney will be promptly notified by the docket clerk of the revocation of his power of attorney. An assignment will not operate as a revocation of the power previously given, but the assignee of the entire interest may be represented by an attorney of his own selection.

CONSTRUCTIONS.

There is no provision of law giving the Commissioner a right to refuse the revocation of a power of attorney.

Rosell, 197 O. G. 535.

Death of principal does not revoke a power of attorney in all respects.

(147 U. S. 209, 2291); Meta Mathillath, 179 O. G. 853.

Must be a legal title, an equitable title is not sufficient. There must be a request to issue the patent to the assignee.

Stanford, 138 O. G. 527.

A collateral attack on validity of rule not considered.

Adams, 129 O. G. 1612.

This rule is only applicable to cases in charge of the examiner. There is no express provision for changing attorneys while cases are in the issue division. All powers of attorney, or revocations thereof received while the case is in the issue division, will be submitted to the Commissioner for his action.

Morley, 37 O. G. 337; Pitney, 1880 C. D. 76, 17 O. G. 447.

On the death of the inventor an assignee of the entire interest may appoint an attorney.

Wick, 117 O. G. 902.

A power of attorney accompanied by an assignment of an interest to the attorney is irrevocable. A power coupled with an interest.

Edwards & Gregory, 1904 C. D., 110 O. G. 860.

Death of inventor revokes power of attorney.

Ex parte Jones, 1903 C. D., 103 O. G. 228.

An equitable assignee of the entire interest refused recognition.

MacPhail, 1899 C. D. 196, 89 O. G. 521.

A power of attorney coupled with a promise to pay to the attorney ten per cent of all money received for the invention

does not give him such an interest in the invention as to render the said power of attorney irrevocable.

Firsching, 1897 C. D. 49, 80 O. G. 1272.

The assignee of an entire interest may control the appointment and dismissal of an attorney to the exclusion of the applicant; but when an applicant joins with an assignee of less than the whole interest, or with the grantee or a licensee, in making a power it will require the cooperation of both to revoke.

Anderson, 1893 C. D. 12, 62 O. G. 449.

Practice where a revocation of power of attorney is received, a time and place of hearing will be fixed by the docket clerk and entered upon the docket, and notice thereof given to the parties interested, including in all cases applicant and the assignee, if there be one, and the attorneys sought to be deposed, and in case of substitution also the attorney sought to be substituted.

Morley, 1886 C. D. 32, 37 O. G. 337.

A power of attorney which is part of the security for the performance of a contract, as to assign an interest, is not revocable.

Morley, 1886 C. D. 32, 37 O. G. 337; Harrison, 1878 C. D. 58, 13 O. G. 547.

Death of an inventor revokes power of attorney.

Eagleton Mfg. Co. v. West, Bradley & Cary Mfg. Co., 1880 C. D. 532, 17 O. G. 1504; (Supreme Court, 1884 C. D. 261, 27 O. G. 1237).

Under rule 121 (1878), patent agents are discharged, not on motion allowed by the Patent Office, but on notice communicated to the Patent Office.

Hoosier Drill Co. v. Ingels, 1879 C. D. 86, 15 O. G. 1013.

Cases passing on the subject matter.

Hill and Hill, 206 O. G. 1437, see notes to Rule 5; Lotterhand v. Cornwall, 148 O. G. 1344; Hinkson, Hey, and McConahy, 1904 C. D., 111 O. G. 2220; Collins, 1902 C. D. 324, 100 O. G. 2601.

Rule 21. Attorneys' Room.

Parties or their attorneys will be permitted to examine their cases in the attorneys' room, but not in the rooms of the examiners. Personal interviews with examiners will be permitted only as hereinbefore provided. (See Rule 13.)

Rule 22. Decorum and Courtesy in Business.

(*a*) Applicants and attorneys will be required to conduct their business with the office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Commissioner, and returned by his direct order.

(*b*) Complaints against examiners and other officers must be made in communications separate from other papers, and will be promptly investigated.

(*c*) For gross misconduct the Commissioner may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons for the refusal will be duly recorded and be subject to the approval of the Secretary of the Interior.

(*d*) The Secretary of the Interior may, after notice and opportunity for a hearing, suspend or exclude from further practice before the Patent Office any person, firm, corporation, or association shown to be incompetent, disreputable, or refusing to comply with the rules and regulations thereof, or with intent to defraud, in any manner deceiving, misleading, or threatening any claimant or prospective claimant, by word, circular, letter, or by advertisement, or guaranteeing the successful prosecution of any application for patent or the procurement of any patent, or by word, circular, letter, or advertisement making any false promise or misleading representation (Sec. 5, act approved July 4, 1884), or who use the name of any members of either House of Congress or of any officer of the Government in advertising his business. (Act approved April 27, 1916.)

CONSTRUCTIONS.

Rev. Stat., sec. 487.

Amendment pending, H. B. 11984, empowering the Commissioner to prescribe rules and regulations governing the recognition of attorneys.

Add to subdivision (d) "Or who use the name of any mem-

ber of either House of Congress or of any officer of the Government in advertising business. Act approved April 27, 1916."

205 O. G. 308.

A complaint and petition under R. 145 at the same time improper.

Eggan, 172 O. G. 1091.

Complaint ordered expunged from petition and brief.

Duryed & White v. Rice, 1904 C. D., 114 O. G. 761.

It is a general principle of law that the statements of counsel with regard to a case are privileged and that he is permitted to use language in his argument and make statements in his brief which if used out of court might be considered objectionable.

Schellenbach v. Harris, 1903 C. D., 111 O. G. 2223.

An elaborate discussion of misconduct of attorneys.

John Wedderburn & John Wedderburn & Co., 1897 C. D. 77, 81 O. G. 159.

Irrelevant personal reflections on an attorney struck out of the Office letter and the reply of the attorney thereto returned under Rule 22.

Oliver, 1896 C. D. 29, 76 O. G. 961.

See Anderson, 1889 C. D. 167, 47 O. G. 1633.

Communications will not be returned except after being submitted to the Commissioner and by his direct order.

Kouns, 1887 C. D. 139, 41 O. G. 1271.

The judgment of the Commissioner of Patents disbarring a solicitor for surreptitiously placing a copy of a caveat in the official files extends only to the exclusion of the solicitor, and not to the effect of the paper as evidence in pais, although its effect upon the instrument as a caveat of record might be greater.

Campbell v. James, 1880 C. D. 633, 18 O. G. 979; Robertson v. Le · Mfg. Co., 3 O. G. 412.

If attorneys and others think they have reason for the use of abusive language toward the Examiner, they should file direct charges, so that the Examiner may have opportunity to be heard. To interpolate such charges in an argument before the Commissioner is unprofessional.

Chambers, 1873 C. D. 56.

Rule 23. Services of Senators or Representatives.

Inasmuch as applications can not be examined out of their regular order, except in accordance with the provisions of Rule 63, and Members of Congress can

neither examine nor act in patent cases without written powers of attorney, applicants are advised not to impose upon Senators or Representatives labor which will consume their time without any advantageous results.

APPLICANTS.

Rule 24. Who is Entitled to a Patent.

A patent may be obtained by any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, not known or used by others in this country before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, or more than two years prior to his application, and not patented in a country foreign to the United States on an application filed by him or his legal representatives or assigns more than twelve months before his application, and not in public use or on sale in the United States for more than two years prior to his application, unless the same is proved to have been abandoned, upon payment of the fees required by law and other due proceedings had. (For designs, see Rule 79.)

CONSTRUCTIONS.

The subject of invention has been so fully treated in the text books and digests that no attempt to completely collect the decisions has been made here.

Rev. Stat., secs. 4886, 4887.

A collapsible tube differing from another in that its end is rounded and it has a bead is lacking in patentable invention.

Lambert, 119 O. G. 1925.

In the present case merely allowing the corners of the buckle frame to remain angular instead of rounding them, as in the references, involves nothing of inventive genius.

Knothe, 102 O. G. 1294.

Process, lacking in novelty.

Colton, 1902 C. D. 436. 101 O. G. 2285.

Coaling ships, held to cover function of a machine and not a true process.

Trepler v. Lende, 1892 C. D. 444, 101 O. G. 2288.

Where the art of advertising as claimed produces no physical effect it is not patentable.

Turner, 1894 C. D. 36, 66 O. G. 1593.

Bar of public use not avoided by caveat.

Meucci, 1890 C. D. 65, 51 O. G. 299.

The discovery that a natural production possesses certain qualities which fit it for a certain use entitles the discoverer to a patent for such use.

Floyd, 1874 C. D. 104.

To be patentable it is not necessary that the device should be any improvement over what has been done before.

Stone, 1873 C. D. 105.

An article of manufacture must be complete and ready for use and sale in the market.

Campbell, 1872 C. D. 228.

An article of manufacture is a device complete in itself for some special use, and not to be applied to general purposes likes pipes or tubes.

Sellers, 1872 C. D. 197.

The process by which an article is made is a matter altogether distinct from the article itself so far as the patentability of the article is concerned.

Sellers, 1872 C. D. 197; Ackerson, 1869 C. D. 74; Truesdell, 1870 C. D. 120; Designolle, 1878 C. D. 10.

While wood and zinc had previously been used to protect carpets, etc., from the radiant heat of the stove, still that combination, with the addition of tar, to keep the wood from warping whereby a thin piece of wood could be used, making a convenient article for sale, is patentable as a new article of manufacture.

Cottrell, 1872 C. D. 93.

Invention must be exhibited in articles of manufacture as well as in machines.

Wattles, 1873 C. D. 50.

The tests of the patentability of articles of manufacture are: 1st, Is the device of itself an article of trade? 2d, Is it useful? 3d, Is it so different in essential points, from other articles of the class to which it belongs, as to be easily distinguished in the market? These being answered in the

affirmative, a patent should be allowed. "The beauty of an ornament is one great test of its utility."

Moore, 1871 C. D. 249, 1872 C. D. 154, 1871 C. D. 256.

The law never was intended to give a man a design patent to serve merely the purpose of a trade-mark. Questioned if colors or the blending of them is patentable as a design.

Weinberg, 1871 C. D. 244.

A billiard table having a bed made by cement is patentable as a new article of manufacture.

Bond, 1869 C. D. 17; Harris, 38 O. G. 104.

Utility in the eye of the patent law, refers rather to a utility of purpose than a utility of means. If the means are inferior to the old way of doing the same thing, or inferior to other new ways the invention sinks into obscurity, and is soon forgotten.

Cheesbrough, 1869 C. D. 18; Moody v. Hudson, 1869 C. D. 108; Brown, 1870 C. D. 45.

Rule 25. Executors and Administrators.

In case of the death of the inventor, the application will be made by and the patent will issue to his executor or administrator. In that case the oath required by Rule 46 will be made by the executor or administrator. In case of the death of the inventor during the time intervening between the filing of his application and the granting of a patent thereon, the letters patent will issue to the executor or administrator upon proper intervention by him. The executor or administrator duly authorized under the law of any foreign country to administer upon the estate of the deceased inventor shall, in case the said inventor was not domiciled in the United States at the time of his death, have the right to apply for and obtain the patent. The authority of such foreign executor or administrator shall be proved by certificate of a diplomatic or consular officer of the United States.

In case an inventor become insane, the application may be made by and the patent issued to his legally

appointed guardian, conservator, or representative, who will make the oath required by Rule 46.

CONSTRUCTIONS.

Rev. Stat., sec. 4896, Act of Feb. 28, 1899.

There should be filed either a certificate of a German Court of Record that Mrs. N. is entitled to administer the estate, such certificate being properly proved by the certificate of a consular, or diplomatic, officer, or else a formal statement to that effect from the German embassy or the German consulate at Baltimore.

Niedenführ, 130 O. G. 981.

See order No. 1,792, 138 O. G. 970. This order modified by order No. 1827, Oct. 22, 1909, 148 O. G. 837.

Proof of authority shall in all cases be recorded in the assignment records. A reference to this record to be placed in each application involved.

In Germany a certificate of inheritance may take the place of letters testamentary, etc., but must be properly proved.

Niedenführ, 130 O. G. 981.

The proper way to prove the power of executors and administrators to intervene in the prosecution of applications for patents is by a certified copy of the letters testamentary or letters of administration signed by an officer of the court, authenticated by the seal of the court.

Rogers, 125 O. G. 2766.

A certificate of the Probate Court is not sufficient evidence on which to permit an alleged administrator or executor to prosecute an application of a deceased person. When an administrator desires to intervene it is necessary to file in each case certified copies of the letters of administrations, so that the Office can determine for itself the powers and duties conferred upon such administrator. The request that the executor or administrator may intervene should also be signed by the administrator or executor and not by attorney. This applies to foreign executors, etc.

Pilgrim Paper Company, 125 O. G. 993.

The deeds and contracts made by insane persons before they are adjudged insane, but within the period overreached by the finding of the jury, are not necessarily void.

Wurtz, 123 O. G. 320.

Where the inventor dies after filing an application it is not necessary for the administrator to file a new application. He

takes up the work where the inventor left off. Said in a case where papers were prepared but not filed at inventor's decease.

Jones, 103 O. G. 228.

Executor or administrator should make the application even when the inventor executes papers before he dies.

Lewis, 93 O. G. 1311.

That a guardian has been appointed by a foreign court is not sufficient.

Hummel, 1900 C. D. 15, 94 O. G. 583.

Practice in case of interference. It cannot be properly held that an application has no standing before the Office because the inventor is dead and the executor has not asserted his rights.

Handly v. Bradley, 89 O. G. 522.

If the inventor dies during the pending of the application it is not necessary to withdraw the application and file a second; but there is no objection to such a course provided the rights of third parties are not infringed.

Rice v. Burt, 1879 C. D. 2991, 16 O. G. 1050.

Proof that the applicant is the administrator of the deceased inventor must be made. Foreign letters of administration are not sufficient. Ancillary letters of administration must be taken out in the United States.

Executors of Robert Ransome, 1870 C. D. 143.

Cases passing on the subject matter of this rule.

Deeter, 1900 C. D. 162, 93 O. G. 190; Decker v. Loosley, 1896 C. D. 106, 77 O. G. 2140; Chose v. Ryder, 1892 C. D. 219, 61 O. G. 885.

Rule 26. Patents to Assignees.

In case of an assignment of the whole interest in the invention, or of the whole interest in the patent to be granted, the patent will, upon request of the applicant embodied in the assignment, issue to the assignee; and if the assignee hold an undivided part interest, the patent will, upon like request, issue jointly to the inventor and the assignee; but the assignment in either case must first have been entered of record, and at a day not later than the date of the payment of the final fee (see Rule 188); and if it be dated subsequently to the execution of the application,

it must give the date of execution of the application, or the date of filing, or the serial number, so that there can be no mistake as to the particular invention intended. The application and oath must be signed by the actual inventor, if alive, even if the patent is to issue to an assignee (see Rules 30, 40); if the inventor be dead, the application may be made by the executor or administrator.

CONSTRUCTIONS.

See Rules 5, 6 and 183.

Rev. Stat., sec. 4895.

See order No. 1,792, 138 O. G. 970.

Whether the request to issue the patent to the assignee, together with a record of the assignment is necessary to vest the legal title in the assignee has been variously decided.

Harrison v. Morton, 83 Md. 477; Walker on Patents, 235-236; Robinson on Patents, p. 580 affirmative; Wende v. Harine, 191 Fed. 620, negative; Hildreth v. Averbach, 200 Fed. 972.

The assignee of a part interest is joined in the issue of a patent only upon request of the applicant imbodied in the assignment.

Ryle, 193 O. G. 753.

A different rule has been advanced but it is thought that one rule should prevail.

Dudley, 187 O. G. 831.

A patent will not be issued to the assignee upon an assignment subject to an exclusive license.

Hubert, 171 O. G. 745.

A license of record will not prevent the issuance of a patent on a proper assignment (authorities).

Hubert, 171 O. G. 745.

It is purely discretionary with the commissioner whether he shall issue the patent to the assignee.

In re Pearsall, 31 App. D. C. 205; Moore, Com. v. U. S. ex rel. Boyer, 138 O. G. 530.

An assignment of the legal title including a request to issue the patent to the assignee necessary.

Stanford, 138 O. G. 527.

P filed an application Sept. 15, '02 and assigned his interest to V Sept. 18, '04. B made a second application and assigned his interest to W. The Patent Office issue a patent on the

second application and rejected the first application on said patent.

Affirmed by Court of Appeals.

In re Pearsall, 135 O. G. 221.

Assignments from an executor, without copies of the letters testamentary, may be recorded, but the patent may not issue to the assignee.

Pilgrim Paper Company, 125 O. G. 994.

Where each of two applications filed by the same inventor contain some claims for the same subject matter and both applications and the inventions disclosed therein are assigned, respectively to different assignees the application which was first assigned should be passed to issue and the claims in the other application should be only such as can not be properly made in the first.

McCormick, 116 O. G. 1183.

The reservation of a license does not prevent the transfer of the legal title to the invention and patent to be granted.

Rowand, 114 O. G. 2091.

The instrument, however, lacks the request that the patent be issued to the assignee (Rule 26) and it therefore does not convey the legal title, which still remains in the applicant.

Hertford, 113 O. G. 851.

Where there were two assignments, one containing a request to issue the patent to the assignee. Held that with such request the legal title was perfect that an assignment without such request conveyed only an equitable interests. That the legal title should be observed by the Office.

Graham. 112 O. G. 1752.

In case of conflicting assignments the patent will issue to the inventor.

Moller, 1904 C. D., 108 O. G. 2144.

The office uniformly refuses to render judicial decisions in matters relating to the recording of papers of the nature of assignments. It requires that applications intended to be covered by assignments be identified therein otherwise than by subject matter and the same rule applies where it is intended to except certain matter from the assignment.

Long, 1903 C. D., 104 O. G. 851.

The power conferred upon the Commissioner to issue the patent to the assignee is discretionary. If there is doubt if an undivided interest is assigned, the patent should issue to applicant.

Eickemeyer, 1902 C. D. 174, 99 O. G. 1622.

Questions under this rule to be determined by record exclu-

sively. An assignment should contain a request to issue patent to assignee.

Tracy, 1900 C. D. 12, 94 O. G. 431.

If there are two conflicting assignments only one of which contains a request to grant the patent to the assignee, the one in which the request is, shall prevail.

If there are two proper conflicting assignments correspondence shall be with the inventor.

McTammany, 93 O. G. 751.

It must be a technical assignment a license is not sufficient.

Rosback, 1899 C. D. 202, 89 O. G. 705.

A request that a power of attorney given by an alleged assignee be approved and that the patent issue to said assignee denied, as the assignment fails to fully identify the application and to specifically request the issue of the patent to the assignee.

Chillingsworth, 1897 C. D. 72, 80 O. G. 1892.

The Office must follow the record, since it has no means of determining disputed questions of fact.

Nichols, 1897 C. D. 70, 80 O. G. 1891.

The Office is not the place to try doubtful questions of title.

It is not even mandatory for the Commissioner to issue a patent to the assignee.

McFarlane, 1896 C. D. 37, 76 O. G. 1418.

Where an assignment from one of several joint inventors contains a request that the patent shall issue to his assignee. Held that the request will be observed and the patent be issued jointly to the remaining inventors and the assignee.

Fowler, 1894 C. D. 109, 69 O. G. 1641.

Where one of two joint inventors assigned his interest to a third person and requested that the patent issue jointly to such third person and the other inventor in the absence of any objection there was no error in issuing the patent as directed.

Fowler & Hutton, 1893 C. D. 111, 64 O. G. 1131.

The statute is not mandatory, and in case of contest between the parties, the Commissioner may in his discretion issue the patent to the inventor.

Spielman, 1892 C. D. 1, 58 O. G. 141.

Patent may not be granted to a party having only a territorial interest.

Buchanan, 1891 C. D. 104, 56 O. G. 140.

The issue of the patent will not be stayed to have the courts determine the equitable title when the legal title is shown by the record.

Shedlock et al. v. Hannay et al., 1890 C. D. 4, 50 O.

G. 166; Agee, 1902 C. D. 399, 101 O. G. 1609.

Rule 27. Inventor Believing Himself to be First Inventor.

If it appear that the inventor, at the time of making his application, believed himself to be the first inventor or discoverer, a patent will not be refused on account of the invention or discovery, or any part thereof, having been known or used in any foreign country before his invention or discovery thereof, if it had not been before patented or described in any printed publication.

Rev. Stat., sec. 4923.

Reduction to practice in a foreign country can never operate to destroy a patent applied for here, however widely known such reduction to practice may be, either among foreigners or among persons living here, unless the invention be patented or described in a printed publication.

Westinghouse Machine Co. v. General Electric Co., 196 O. G. 276.

Rule 28. Joint Inventors.

Joint inventors are entitled to a joint patent; neither of them can obtain a patent for an invention jointly invented by them. Independent inventors of distinct and independent improvements in the same machine can not obtain a joint patent for their separate inventions. The fact that one person furnishes the capital and another makes the invention does not entitle them to make an application as joint inventors; but in such case they may become joint patentees, upon the conditions prescribed in Rule 26.

CONSTRUCTIONS.

"Former rule 32 of the Patent Office, which was promulgated in 1897 and provided that new parties might be added to a pending application of joint inventors, that some of the parties might be dropped where all consented in

writing and when the nonjoinder or misjoinder was by mistake and without fraudulent intent." C. A of D. C., In re Roberts, 273 O. G. 410. This was one of the rules of Com. Seymour's anomalous edition, which lasted only a few months.

A joint application by three parties is by a different applicant from one by two of the three.

Hertzberg & Wohl, 184 O. G. 805; Kauermann, 157 O. G. 207.

A joint application may not be changed to a sole application.

Weil and Grant, 173 O. G. 1081, 2.

Where one coapplicant does not join in the written abandonment of an application, it can be given no effect.

Barrett and Aller, 127 O. G. 847.

Where one of two joint inventors seeks to cause abandonment of their application by preventing amendment thereof claiming that he is a sole inventor, and also files a written abandonment of the application. Held that permission will be given to the coinventor to prosecute the application through an attorney of his own selection.

Barrett and Alter, 127 O. G. 847.

Questions of joint or sole inventor arising in an interference must be determined by a separate proceeding.

Hull v. Hallberg, 110 O. G. 1428.

While it is customary for both the joint inventors to sign the same paper, yet duplicates may be executed by the joint inventors.

S. T. and C. H. Wellman, 88 O. G. 2065.

Illustration of what are joint inventors.

De Wallace v. Scott, 1899 C. D. 416, 88 O. G. 1704.

When through ignorance a party who is not an inventor joins with the inventor in making application, the inventor can not legally succeed as sole applicant the joint applicants. The fact that for a time the rules permitted the substitution now asked for does not make it possible or equitable to grant relief not in accordance with law.

Erne & Bridges, 1897 C. D. 197, 81 O. G. 2247.

One of two joint inventors may not make an application for himself and the other joint inventor.

Schaeffer, 1896 C. D. 30, 76 O. G. 1118; Benjamin and Bailey, 1892 C. D. 85, 59 O. G. 298.

Where a caveat has been filed and abandoned by joint inventors, a sole applicant need not furnish proof that he is not one of joint inventors.

Drury, 1891 C. D. 144, 56 O. G. 1447.

Where a patent is granted to joint inventors and an application is made for a sole patent for the same subject matter the burden of proof is on the applicant, and he must overcome not only his adversary's testimony, but his own former oath of joint invention.

The denial of the applicant's sole invention by the other party is not conclusive, however.

Lovrien v. Banister, 1880 C. D. 152.

Doubted if the cases of De Lill v. Avery, and De Lill, 1870 D. D. 128, and Chase & White v. Chase, 1873 C. D. 99 are authority to the contrary of the last clause, and if they are they should not be followed.

Lovrien v. Banister, 1880 C. D. 152.

There are different rules in England as to joint and sole invention.

Siemens, 1877 C. D. 41, 11 O. G. 1107.

Where a patent has issued to two persons as joint inventors, and an application was subsequently made by one of them as the sole inventor of the same subject matter, the doctrine of estoppel does not apply, but the proper course is for the Office to declare an interference between the parties to determine the question of priority of invention, as in other cases. Vol. 4, p. 269.

Quoted in Lovrien v. Banister, 1880 C. D. 152, 18 O. G. 299.

A patent issued to joint applicants for an invention actually made by but one of them is absolutely void, and the mistake can not be rendered valid by any act of the parties or the Patent Office.

Barsaloux James & Lyon, 1878 C. D. 154 S. 16 O. G. 233.

The matter of joint or sole inventors should as a rule be left where the parties themselves choose by their declaration to place it, and when the presumption of joint invention has once been created by the filing of a joint application upon a joint oath it can be overthrown only by evidence of the most unquestionable character.

Wheeler v. Russell & Miller, 1872 C. D. 32; Carter & Dwyer v. Perry & Dickey, 1875 C. D. 111.

Rule 29. Foreign Patents.

No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery by reason of its having been first patented or caused to be patented by the inventor or his legal

representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months prior to the filing of the application in this country, in which case no patent shall be granted in this country.

An application for patent filed in this country by any person who has previously regularly filed an application for a patent for the same invention or discovery in a foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention or discovery was first filed in such foreign country, provided the application in this country is filed within twelve months from the earliest date on which any such foreign application was filed; but no patent shall be granted upon such application if the invention or discovery has been patented or described in a printed publication in this or any foreign country, or has been in public use or on sale in this country, for more than two years prior to the date of filing in this country.

Rev. Stat., sec. 4887.

CONSTRUCTIONS.

(Ante 1897.) A process patented in a foreign country does not limit an apparatus patent in U. S.

Fireball Gas Tank & Ill. Co. v. Commercial Acety. Co., 221 O. G. 1039.

Date of filing complete specification, when provisional canceled. G. B.

Hayes, 209 O. G. 1317.

Under the old law a patent expired with a previous granted British Patent notwithstanding the provision of Art. 4 bis. of the international convention that a patent shall be independent of every patent in other countries.

Sup. Ct. Cameron, etc., v. Knoxville, 187 O. G. 232.

A certified copy of original application necessary under the convention.

Barthels, 179 O. G. 574.

Under section 4887 of the R. S. two years must elapse before the invention disclosed by appellee in the British patents become forfeited and the property of the public.

Young v. Struble, 157 O. G. 488.

Statute is not retroactive.

Winter et al. v. Latorer, 157 O. G. 209.

The Commissioner has no power to extend the time. The P. O. authorities are not agents of the Patent Office.

Kauermann, 157 O. G. 207.

Substantial but not formal identity of claims necessary to identity of foreign patent with American (4887 R. S.).

United Shoe Machy. Co. v. Duplessis Shoe Machinery Co., 148 F. R. 31.

First day excluded in computing the 12 months.

Hero-Bright Mfg. Co. v. Standard Roller Bearing Co., 147 O. G. 521.

If the fee is not paid the application is not complete.

McElray, 140 O. G. 1207.

It is a "patent" granted for an invention which has been previously "patented" in a foreign country, etc., which is limited (R. S. 4887). All through it is one patent against another. In the United States nothing is patented except what is covered specifically by the claims required by statute. The same was the law in England at the time the patent relied upon by the petitioner was then issued. (Edmuns on Patents, 2d Ed., 181 et seq.)

Westinghouse Elec. & Mfg. Co. v. Stanley Instrument Co., 138 F. R. 826.

It is incumbent upon a party if he would rely upon his alleged foreign application to establish by competent evidence that he is the party who filed the foreign application and he also must show that the invention set forth in the foreign application is the same as that covered by his application in this country. (Rousseau v. Brown, 104 O. G. 1120; Sander v. Crowell, 16 O. G. 405; Pauling, 115 O. G. 1848.)

De Ferranti v. Lindenark, 137 O. G. 731.

The Commissioner has no authority to extend the time for filing.

Meier, 136 O. G. 657.

The Commissioner has no authority to extend the time.

Ravelli, 130 O. G. 982; Meier, 136 O. G. 657.

Though the American claim may be broader than that of the Prior British Patent it is still true that what is claimed

under the generic claim has already been patented in a foreign country. I can see no reason why the rules which are applied to determine the question of double patenting when United States Patents are involved are not also applicable when the question is whether the invention has been first patented in a foreign country.

Sawyer Spindly Co. v. Carpenter, 133 O. G. 240, (when the relation of generic and specific claims exists).

For the reason stated in Stiff v. Gilbraith, 107 O. G. 532, I am of the opinion that the second clause of section 4887 of the Revised Statutes as amended March 2, 1903, was not intended to have and should not be given, a retroactive effect.

Marconi v. Shoemaker, 131 O. G. 1939.

Second paragraph. This should not be construed retroactive. "To give the U. S. application filed subsequently to the date of the act the benefit of the foreign application filed prior to the act, would make the act retroactive and might disturb vested rights and render invalid patents which were valid before the act, in the same manner as would the extension of the provisions of that act to applications filed in the U. S. prior to the date of the act."

DeFerranti v. Sindmark, 128 O. G. 610.

A decision in favor of applicant under the statute is not appealable by an opponent in an interference proceeding.

Gueniffit, Benoit, and Nicault v. Wichtorsohn, 117 O. G. 1492.

Amendments apparently date back to time of filing of application so far as bar of two years public use is concerned.

Edison v. American Mutoscope Co., 110 F. R. 660.

But it does not relieve against abandonment.

E. P. Casalonga, 105 O. G. 261.

The act of March 3, 1903, applies to all applications pending whether filed before or after its passage.

Klingelfuss, 104 O. G. 2149.

The words "previously patented in a foreign country" must then be taken to mean "patented according to the laws and usages of such foreign country" provided a substantial monopoly is thereby granted.

Atlas Glass Co. v. Simonds Mfg. Co., 102 F. R. 647.

The date of the provisional specifications' filing is the date of filing of the British Patent.

In re Swinburne, 99 O. G. 1625.

An instrument which gives only limited and temporary protection is not the patent contemplated by the statute (4887 R. S.).

Societe Anonyme Pour La Transmission De La Force Par L'Electricite, 97 O. G. 604 F. R.

Where a British patent to applicant became void prior to the filing of the United States application, by reason of failure to pay a renewal fee. Held properly rejected for that reason, since no valid patent could issue to him.

Armstrong, 1895 C. D. 18, 71 O. G. 1615.

Where there are two foreign patents for a subject matter that is properly claimed in one application for a U. S. patent, the U. S. patent should be restricted in view of the one having the shortest term.

Unsworth, 1879 C. D. 69.

If an American patent is divisible, and one or more foreign patents have been granted for part of the invention secured by the American patent, a reissue may be had omitting the part included in the expired foreign patents, or a disclaimer of such part included in a foreign patent forfeited for nonpayment of fees.

Pulvermacher, 1876 C. D. 154, 10 O. G. 2.

If only a provisional specification is enrolled in England it is not patented there.

Lowry, 1869 C. D. 85. (See Rule 27.)

Relates to matter claimed, only in the foreign application.

Commercial Acetylene Co. v. Searchlight Gas Co., 197 F. R. 908 (act is not retroactive).

It seems to be what is claimed in the British patent that is to be considered.

Acme Acetylene A. Co. v. Commercial Acelyleis Co., 192 F. R. 321.

The "Ausgegeben" date is the one contemplated for German patents.

Merrell-Saire Co. v. Natural Milk Co., 22 Fed. 913.

The identity of the foreign patent must appear in its claim.

Siemens v. Sellers, 123 U. S. 276; Westinghouse Elec. & Mfg. Co. v. Stanley Instrument Co., 138 F. R. 823; Sawyer Spindle Co. of Maine v. Carpenter, 133 F. R. 238; Commercial Co. v. Fairbank Co., 135 U. S. 176; Walker on Patents (4th ed.), 150; Robinson on Patents, sec. 623; Bate Refrigerator Co. v. Sulzberger, 157 U. S. 1; Sawyer Spindle Co. v. Carpenter, 143 F. R. 976; United Shoe Mach. Co. v. Duplesses Shoe Mach. Co., 148 F. R. 31; Diamond Meter Co. v. Westinghouse Elec. & Mfg. Co., 152 O. G. 704; Thomson-Houston Elec. Co. v. McLean, 153 F. R. 833; Gueniffet, Benoit and Vecault v. Wechorsohn, 131 O. G. 1685.

THE APPLICATION.

Rule 30. Requisites of Application.

Applications for letters patent of the United States must be made to the Commissioner of Patents, and must be signed by the inventor, or by one of the persons indicated in Rule 25. (See Rules 26, 33, 40, 46.) A complete application comprises the first fee of $15, a petition, specification, and oath; and drawings, when required. (See Rule 49.) The petition, specification, and oath must be in the English language. All papers which are to become a part of the permanent records of the office must be legibly written or printed in permanent ink.

Rev. Stat., secs. 4888 to 4892.

CONSTRUCTIONS.

(1) DATE OF FILING.
(2) PROCESS.
(3) APPLICATION AS A REDUCTION TO PRACTICE.
(4) ADDITIONAL CASES.

(1) *Date of Filing.*

An unsigned application filed, then a carbon copy signed, then a properly written original, the last is the date of filing in absence of special circumstances.

Gilmore et al., 228 O. G. 1093.

If the application is altered after being executed it is insufficient to give a filing date to establish a constructive reduction to practice.

Ames v. Sindstrom, 167 O. G. 241, 168 O. G. 250.

Whether an application with a defective oath gives date of filing.

Mygatt, 160 O. G. 773.

A subsequent application, though not a division, may be a continuation of an older application when the two have common subject matter. In such case the applicant is entitled to the date of the original for the subject matter which is common to both.

Prase, 157 O. G. 208.

A claim introduced into the application by amendment relates back to the date of filing the application.

McFarland v. Watson and Walson, 146 O. G. 257.

There are good reasons for refusing to give filing dates to application papers until various formalities have been complied with. Where the informalities are discovered by the Office without undue delay; but where the application has been examined and considerable time has elapsed before the necessary corrections are required there should be no change in filing dates except in those cases where the Office is clearly without authority to entertain the application until the corrections are made.

Dukesmith v. Corrington v. Turner, 1906 C. D. 426, 125 O. G. 348.

These requirements should be insisted upon before giving the application a filing date.

Sassin, 1906 C. D. 205, 122 O. G. 2064.

The application should not be filed until all the drawings are received. If the omitted drawing is subsequently filed the Primary Examiner will consider a petition to give the application the filing date of the remainder of the papers.

Michaelis, 1906 C. D. 1231, 121 O. G. 1349.

Fifteen dollars, a sketch, and a request that the Office send blanks for making an application can not be considered even an incomplete application. The fifteen dollars should simply be entered to the sender's credit.

Elberson, 1906 C. D. 94, 121 O. G. 338.

As indicated, applications shall not be given serial numbers as complete applications and forwarded to the examining division for examination (1) when the petition has not been signed by the inventor; (2) when the specification and claims have not been signed by the inventor and the signature attested by two witnesses (sec. 4888, Rev. Stats.); (3) when the drawing has not been signed by the inventor or his attorney in fact and the signature attested by two witnesses (4889, Rev. Stats.), and (4) when the oath to the application does not fill the requirement of sections 4887 and 4892, Revised Statutes.

The requirements of section 4896, Revised Statutes, respecting the right of executors or administrators to make application for a patent for the invention of a deceased person must also be observed before the application will be considered as complete and forwarded for examination.

Order, 120 O. G. 1001.

Only one figure was shown in the drawing, but three were

referred to. Date of application that of the filing of the last two drawings.

Ehrendriech, 1904 C. D. 75, 109 O. G. 275.

The defects in the original application were such as called for correction by amendment, and none of the necessary parts of a complete application were lacking, the date of filing will not therefore be made later.

Brough, 1904 C. D. 29, 108 O. G. 564.

An application, signed Charles Prince de Loewenstein, required to be signed by applicant with his actual name, but given a date as an imperfect application in view of fact that otherwise application would be barred by foreign applications.

Charles Prince de Loewenstein, 1904 C. D. 25, 108 O. G. 562.

Date of payment into treasury of fee, and not date of certificate receipt, governs.

Connell, 1903 C. D. 495, 107 O. G. 2235.

A petition granted that certain papers be entered as a complete application, the question being as to whether or not the case admitted of illustration by a drawing.

Kozminski, 1903 C. D. 42, 103 O. G. 429.

Specification written in fugitive ink returned. Petition to give application date of filing of such specification refused.

Webster, 1902 C. D. 456, 101 O. G. 2570.

A wrong specification filed by mistake not a complete application. Page 97 O. G. 551, 1901 C. D. 151, but see Lawson, 101 O. G. 1833.

An invention for a certain kind of leather could not be illustrated, therefore date of filing retained through a drawing might be required later.

Kozminski, 103 O. G. 92.

Seems to have been held a complete application when all the formal parts were present notwithstanding the attorney alleged the specification belonged to one application and the drawings to another.

Lawson, 1902 C. D. 419, 101 O. G. 1833.

All ink to be subjected to a chemical test.

Order 1,506. 101 O. G. 1135.

An application complete in all respects except that a wrong specification is filed with it, is to be treated as an incomplete application and given the date at which the corrected papers are filed.

Page 97, O. G. 551, 1901 C. D. 156.

The date of filing of the application is the date at which all the parts in proper form are received.

Ex parte Arndt, 1900 C. D. 167, 93 O. G. 751.

Discretion of Examiner to require the use of permanent ink in papers offered for filing at this Office.

Ritter, 1891 C. D. 242, 57 O. G. 1883.

(2) *Process.*

All applications for processes alone should be entered as filed complete when all the parts except the drawing, model, or specimen are filed. (Russell, 84 O. G. 2021, 1898 C. D. 208.)

Schmidmer, 1905 C. D. 74, 115 O. G. 249-250.

When the application is drawn to cover a process and discloses the invention sufficiently to permit of examination on the merits, although no drawing is furnished. Held that it must be given the time of filing as the date of application, although a drawing is subsequently found to be desirable, and is required not to show the invention, but as showing some means for carrying into practice.

Ludington, 1902 C. D. 241, 100 O. G. 236; Russell, 1898 C. D. 208, 84 O. G. 2021.

(3) *Application as a Reduction to Practice.*

The application considered complete, for the purpose of a constructive reduction to practice, although the oath was taken before one not competent to administer it.

Dalton and Magnus v. Wilson, 224 O. G. 741.

The legal conclusion that the invention is completed or constructively reduced to practice when the application is filed applies only in case of an allowable application.

Haskell v. Miner v. Ball, 1904 C. D. 131, 109 O. G. 2170.

An application is a reduction to practice, if allowable.

Osborn v. Hotsapillar, 1903 C. D. 47, 102 O. G. 1296.

Oath must identify the applications to which it relates.

Heusch, 1899 C. D. 172, 88 O. G. 1703.

An application is a constructive reduction to practice.

Early in the history of this court, the question was presented for our determination, and for the reasons given in the opinion delivered by Chief Justice Alvey, the court adopted the doctrine maintained in the Patent Office (Porter v. Louden, 1895 C. D. 707, 73 O. G. 1551, 7 App. D. C. 64-72).

Davis v. Garrett, 1906 C. D. 724, 123 O. G. 1991.

An application is evidence of perfected invention when sufficient to authorize the granting of a patent.

Lindsay v. McDonough, 1891 C. D. 89, 55 O. G. 1402.

Sworn to in blank.

Ayres, 1890 C. D. 103, 51 O. G. 1944.

A patent granted upon a specification sworn to in blank and subsequently filled out without the inventor having a chance to examine it is void *ab initio*.

Benton, 1882 C. D. 3, 23 O. G. 341.

The application is not reduction to practice.

Crane v. Whitehead and Atherton, 1875 C. D. 26, 7 O. G. 219.

(4) *Additional Cases.*

Cases passing on the subject matter of this rule.

Kumley, 1904 C. D. 240, 110 O. G. 2235; Barr Car Co. v. Chicago & Northwestern Railway Co., 1901 C. D. 521, 97 O. G. 2534; see 91 O. G. 2211.

Rule 31. Incomplete Application not Filed.

An application for a patent will not be placed upon the files for examination until all its parts as required by Rule 30 shall have been received.

Every application signed or sworn to in blank, or without actual inspection by the applicant of the petition and specification, and every application altered or partly filled up after being signed or sworn to, will be stricken from the files.

Completed applications are numbered in regular order, the present series having been commenced on the 1st of January, 1915.

The applicant will be informed of the serial number of his application.

The application must be completed and prepared for examination within one year, as indicated above, and in default thereof, or upon failure of the applicant to prosecute the same within one year after any action thereon (Rule 77), of which notice shall have been duly mailed to him or his agent, the application will be regarded as abandoned, unless it shall be shown to the satisfaction of the Commissioner that such delay was unavoidable. (See Rules 171 and 172.)

Rev. Stat., secs. 4888, 4889, 4890, 4891, 4892, 4894.

CONSTRUCTIONS.

If the first fee is not paid within a year the application is abandoned.

Kurz, 119 O. G. 961.

A petition to strike an application from the files because signed and sworn to in blank after assignment and after a year's delay refused. If a patent had been granted on their application, applicants would have been estopped from denying its validity.

Force v. Sawyer-Boss Mfg. Co. et al., 111 F. R. 902.
Siemons Halske Electric Co. v. Duncan Electric Mfg. Co. et al., 142 F. R. 157.
Mathews Gravity Carrier Co. v. Lister et al., 154 F. R. 490.

It is believed that in this case, by a parity of reasoning, he could be estopped from denying that the application which he has signed was properly executed.

Shaver, 131 O. G. 2422.

Motion by party in interference to strike application from files because not properly signed and verified.

The objection to the legality of G's application is purely technical, but if sustained would result in removing him from the field of claimants to this invention, since public use of the invention has intervened to operate as a bar to the filing of a new application. The result would, therefore, be irreparable injury to G. Such purely technical objection should not be sustained except on the clearest proof.

In the course of the proceedings G had made affidavit that he was the inventor of the subject matter several times.

Davis v. Garrett, 1906 C. D. 724, 123 O. G. 1991.

The question of striking Hopkin's application from the files because of alleged alterations therein after it was sworn to is not a matter for the action of the Primary Examiner but is exclusively within the jurisdiction of the Commissioner.

The inking in of a drawing is not a material alteration under these rules.

Hopkins v. Scott, 1903 C. D. 261, 105 O. G. 1263.

It is exclusively within the jurisdiction of the Commissioner whether an application shall be stricken from the files.

Snider v. Bunnell, 1902 C. D. 460, 101 O. G. 2572.

Where it appeared that the sheets of the specification were removed, and other substituted, application removed from files (see Official Gazette, June 1, 1897) (79 O. G. 1369).

Altman, 1897 C. D. 52, 80 O. G. 1475.

It is a clear violation of this rule for the solicitors to substitute a clean draft of an application for one altered as to the description and signed and sworn to by the applicant. Such an application should be stricken from the files.

Sheridan v. Latus, 1883 C. D. 76, 25 O. G. 501.

Rule 32. All Parts of Application to be Filed Together.

It is desirable that all parts of the complete application be deposited in the office at the same time, and that all the papers embraced in the application be attached together; otherwise a letter must accompany each part, accurately and clearly connecting it with the other parts of the application. (See Rule 10.)

The Petition.

Rule 33. Petition.

The petition must be addressed to the Commissioner of Patents, and must state the name, residence, and post-office address of the petitioner requesting the grant of a patent, designate by title the invention sought to be patented, contain a reference to the specification for a full disclosure of such invention, and must be signed by the inventor or one of the persons indicated in Rule 25.

Rev. Stat., sec. 4888.

CONSTRUCTIONS.

Applicant's address at which he customarily receives his mail. Care of attorney not sufficient. Object to communicate with applicant direct.

Official Notice, 225 O. G. 375.

SPECIFICATION.

Rule 34. Written Description.

The specification is a written description of the invention or discovery and of the manner and process

of making, constructing, compounding, and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make, construct, compound, and use the same.

Rev. Stat., sec. 4888.

CONSTRUCTIONS.

See "Protection of Invention" having special reference to electrical methods and bearing of the doctrine of equivalents on function and method, a paper read October 5, 1916, before the Examining Corps of the United States Patent Office, by Richard E. Marine, Principal Examiner, Division Twenty-Six, U. S. Patent Office.

Chemical Inventions and Discoveries, a paper read November 23, 1916, before the Examining Corps of the United States Patent Office by George S. Ely, Principal Examiner, Division Thirty-One, U. S. Patent Office.

The gist of a disclosure is that it be so full as will enable those versed in the art to thereafter use the device, and where such use, practice, mechanism, formula, etc., are fully disclosed, the requirements of the law are satisfied without claiming every advantage such device may have.

Mead-Morrison Mfg. Co. v. Exeter Mach. Works, 225 F. R. 497.

The suggestion of equivalents used in construing the claims.

Hildreth v. Auerbach, 223 F. R. 651.

If the growth of the patent system at the time of the decision of Merrill v. Yeomans, 94 U. S. 568, had reached a stage in its progress which warranted the court in saying that there was no longer "excuse for ambiguous language or vague descriptions," we may at this time speak even more strongly and say that an invention depicted in such slovenly and illconsidered and inconclusive language as this is not yet ready for protection by letters patent.

International Mausoleum Co. v. Seevert, 197 Fed. 940.

Disregarding the evidence, we have the case of an element not defined, vital to the validity of the patent as now construed by the appellee, and which is utterly without function or use. Within the loosest construction of the statute requiring full, clear, concise description, the appellee's contention

respecting the lawful scope of the patent in suit can not be sustained. (Cases.)

Wolff Truck Frame Co. v. Am. Steel Foundry, 195 Fed. 945.

But the patentee is not confined. He expressly says that the machine is capable of "a large range of modifications within the scope" of the invention.

Sleiger v. Waite Grass Carpet Co., 194 F. 883.

It can come under no claim of the patent, and is so divergent from any description that, if it is under the patent, it must be regarded as within the reservation, a mere modification without material departure from the principle and spirit of the invention.

Phoenix Knitting Works v. Rich, 194 F. R. 723.

This contention is made notwithstanding the manifest fact that the mechanism which feeds the wire forward is in continuous action. The argument seems to us purely fanciful. It substitutes a metaphysical intermittency for a mechanical one.

American Steel & Wire Co. v. Denning Wire & Fence Co., 194 F. R. 14.

I am further of opinion that a person reasonably skilled in the art could not from description alone have made an operative machine, because he would have to have worked out for himself the proportions which are just as important as the combination so far as successful operation is concerned.

Electro-Dynamic Co. v. Westinghouse E. & Mfg. Co., 191 F. R. 508.

As is frequently the case when a patentee attempts *ex post facto* a physical explanation of what he has found by experiment, a collateral issue is raised which diverts attention from what is more important—the means whereby he effects his result.

Combustion Utilities Corp. v. Worcester Gaslight Co., 190 F. R. 161.

Whatever may be the correctness of the theory of operation if a new application of old means is sufficiently described to enable those skilled in the art to produce a new and useful result, that is enough. Diamond Rubber Co. v. Consolidated Rubber Co., 220 U. S. 428, 31 Sup. Ct. 444 (Sup. Ct. of U. S., April 10, 1911).

Combustion Utilities Corp. v. Worcester Gaslight Co., 190 F. R. 159.

He refers to the various terms which he uses. Inasmuch as there has been some contention in reference to his meaning,

I quote fully the description of his manner of employing technical words.

National Electric S. C. v. United Wireless Tel. Co., 189 F. R. 730.

A patentee who has sufficiently described and distinctly claimed his invention is entitled to every use to which his device can be applied, whether he perceived or was aware of such uses at the time he claimed and secured his patent or not (cases).

Acme Truck & Tool Co. v. Meredith, 1883 F. 14125.

Within the limits of accuracy and reasonable clearness applicant is entitled to state his invention in his own language.

Williams, 183 O. G. 503-4.

It is objected that the advantage of avoiding side tones is not mentioned in the specifications. This is true, but the omission was not fatal if the advantage was necessarily achieved through the invention. (72 F. 67, 73, 75; 115 F. 886, 895; 117 F. 410, 415; 176 F. R. 100, 107.)

Electric Co., 182 F. R. 998.

Purely laudatory statements have no place in a specification.

Gregg, 181 O. G. 266.

A statement that certain electrical arrangements shown in the drawing are not absolutely essential, are general statements of a character that are continually made and considered admissible.

Jennings, 178 O. G. 1151.

The drawings accompanying the specification and referred to in the descriptive parts thereof will be examined to ascertain the true meaning of the terms used in describing the invention. (R. S. 644889, 98 W. S. 31-38, 64 F. R. 594, 106 F. R. 918, 120 F. R. 267, 135 F. R. 95, 145 F. R. 923.)

Steiner, etc., v. Tabor Sash Co., 178 F. R. 831-836.

Specifications and claims must be broad enough to cover the claimed range of equivalents. Read Holliday & Sons v. Shulze-Berge, 78 F. 493.

Ellis, 167 O. G. 982.

We, however, think that patents are grants made in consideration of discoveries which promote the progress of science and the useful arts, and that they are to be construed liberally so as to effect their real intent.

Bossert Electric Const. Co. v. Prott Chuck Co., 159 O. G. 747.

We would regret to be compelled to decide a case by the acceptance or rejection of a theoretic explanation upon which

it is still possible that authorities in science disagree. Supreme Court.

Steward v. American Lava Company, 149 O. G. 602.

In the construction of a patent, the omission of the patentee to point out or refer in his specification or claims to the special feature which he subsequently maintains is the most important part of his invention, is very significant, and should be carefully scrutinized. If this feature be an advantage, as now claimed, it is strange that no allusion is made to it in the specification.

Fastner Co. v. Kraetzer, 150 U. S. 111. Ended in Sterling Co. v. Rust Boiler Co., 144 F. R. 852-3.

As the term "wheel" has not received a special meaning in the art the parts pertaining to the different stages of a turbine may be called a wheel.

Lindmark v. Hodgkinson, 137 O. G. 228.

If a machine or apparatus is claimed and it is desired to claim the process also, other means of carrying the process out, if not obvious, must be shown.

White, 136 O. G. 1771.

Where the meaning of an expression is clear, no reason exists for delaying the prosecution of a case by insisting upon merely formal changes in the language.

White, 134 O. G. 2027.

A description sufficient for those skilled in the art is enough.

Hopkins v. Newman, 134 O. G. 2028.

"This fact and the failure to mention the notches shown in Fig. 3 leave it uncertain whether the termination of the end of the strip in such a position in this figure as to show a notch rather than a passage was anything more than an accident of the draftsman. It appears certain that Fullagar had no comprehension of the importance of the notch construction.

Emmet v. Fullagar, 1906 C. D. 386, 124 O. G. 2178.

Means for narrowing and widening a knit tube. Certain "pickers" necessary to the operation omitted, but reference is made to an ordinary stocking knitter in which such devices are used. Held a sufficient description.

Kilbourn v. Heiner, 1906 C. D. 367, 124 O. G. 1842; Sassin, 122 O. G. 2064.

Since the claims are to be construed with reference to the specification and to the applicant's understanding and intent in using the particular terms which appear in the claims, it must be held that there is sufficient warrant for retaining Figs. 2 and 5.

Engel, 1906 C. D. 109, 121 O. G. 1011.

Descriptive matter which sets forth alleged advantages over the prior state of the art in language broad enough to apply to a prior patent, as well as to applicant's construction should be canceled.

Kenney, 1905 C. D. 546, 119 O. G. 2237.

Descriptive matter in a specification which consists merely in statements relative to the construction and operation of specific prior devices, made with the idea of pointing out the purpose and application of applicant's improvements, is not objectionable as being in derogation of the inventions of others.

Sjungstrom, 119 O. G. 2235.

Statements in the specification setting forth the purpose and function of the construction claimed are not objectionable and should be distinguished from mere laudatory statements inserted for advertising purposes.

Schoshusen, 1905 C. D. 214, 116 O. G. 2008.

It is not alleged that the invention can not be fully and readily understood from the present specification, nor does it appear that the claims are rendered indefinite or ambiguous by the word "stretcher" or that the applicants' use of the work is absurd or clearly erroneous.

Welch, 115 O. G. 1850.

The purpose of the specification is to describe the construction and operation of the invention sought to be patented. Statements of mere obvious facts are objectionable, because they are mere surplusage.

The law gives the applicant the right to employ equivalents. and a statement of this fact is also unnecessary.

Champ, 1905 C. D. 54, 114 O. G. 1827.

A specification for a patent should be confined to a description of the structure of the device and the manner of its use.

Theoretical discussion suitable for an advertising circular should be excluded.

Wellington, 1904 C. D. 564, 113 O. G. 2218.

The proceedings in the Office leading to the grant of a patent are regarded by the courts as having an important bearing upon the validity and scope of the claims.

They are also of importance if the question of granting a reissue is at any time raised.

Lewis & Unger, 106 O. G. 543.

Good practice requires that applicant distinguish between what is old and what is regarded as new.

In ex parte Blakeman (98 O. G. 791) it was said that statements which were merely laudatory of the applicant's invention should not appear in the specification; but this

ruling does not apply to ordinary descriptive matter which attempts to distinguish between what is old and what is new.

Eynon, 1903 C. D. 231, 105 O. G. 499.

Private identifying mark must be removed from the specification.

Ball, 1902 C. D. 326, 100 O. G. 2602.

An important discussion of the subject as to the relation of the specification to claims.

The Carnegie Steel Company, Ltd., v. The Cambria Iron Company, 1902 C. D. 592, 99 O. G. 1870.

It is not necessary to state what others have failed to do, but merely what applicant has done. Laudatory matter should be canceled.

Blackman, 98 O. G. 791.

And this is an answer to the contention based upon the peculiar property of American asphalt to interpose a shield against a blasting heat to protect itself from destruction, a virtue in American asphalt, no doubt. If it is a virtue resulting from a peculiar application of heats there is nothing in the record to show that Perkins was aware of it. He certainly did not reveal it in the specifications of his patent nor describe it as part of his method.

The United States Repair & Guaranty Co. v. The Assyrian Asphalt Co., 98 O. G. 582 and 584.

A well known part to which the improvement is attached must be shown so that one skilled in the art would recognize it. or else must be described.

Morse, 1901 C. D. 260, 97 O. G. 2982.

It is not sufficient to refer to another pending application for the description of a part.

Scott, 1901 C. D. 59, 95 O. G. 2683; Kellog, 1905 C. D. 84, 120 O. G. 2754.

The punctuation of the specification and claims is to be adhered to in printing.

95 O. G. 1054.

It is the well-settled policy of the Office to permit an applicant to use his own terms of reference so long as their use does not lead to ambiguity.

Hollis, 86 O. G. 489; Welch, 115 O. G. 1850.

The proximate and not the remote use of the device is to be stated.

Ex parte Hinkle & Ashmore, 1899 C. D. 176, 88 O. G. 2410.

Where an application originally contained claims for a method, a product, and as apparatus for carrying out the

method, and upon an Office requirement of division the applicant canceled the claims for the apparatus, and where the disclosure of the apparatus does not make it clearer how the method might be carried out, the drawing and description of the apparatus should be canceled.

Hofely v. Redlefsen, 1893 C. D. 94, 64 O. G. 559.

An applicant is entitled to state as specifically and categorically as he chooses the difficulties and troubles which are cured or ameliorated by his improvement, but he is not entitled to state such matters in a way that amounts to a recital of the history of the art as he understands it, combined with an argument as to the importance of his improvement.

Johnston, 1892 C. D. 150, 60 O. G. 295.

The history of the art is not proper in a specification.

Wadsworth, 1900 C. D. 139, 92 O. G. 1798.

An applicant will not be permitted to use words in his specification that are likely to create an ambiguity in the strict construction of his claims, and an objection by the Primary Examiner in such a case is properly taken.

Petzold. 1892 C. D. 39, 58 O. G. 1091.

Presenting at the Patent Office an inferior form of invention while claiming to have a better form in possession discussed with reference to Campbell v. James (C. D. 1882, 67).

Ligowsky v. Peters v. Hisey, 1891 C. D. 220, 57 O. G. 1593.

A reference to a copending application for a description of a device is not sufficient.

Chadwick, 1891 C. D. 169, 57 O. G. 124.

While the defects which applicant designs to remedy may be pointed out, this may not be done relative to the invention of another specifically.

Shaw, 1890 C. D. 31, 50 O. G. 1129.

The petition omits any reference to the specification for a full disclosure of the alleged invention. It is evident that without such reference it is defective. No reason is shown why the omission may not be cured by the attorney.

Mason, 1888 C. D. 33-34, 43 O. G. 627.

The Examiner has no right to require the applicant to acknowledge the subject matter shown to be old by the references.

Massicks and Crooke, 1887 C. D. 20, 38 O. G. 1489.

The word apparatus is static, machine dynamic.

Blythe, 1884 C. D. 82, 30 O. G. 1321.

Modifications should be illustrated and described.

Howe, 1883 C. D. 102, 25 O. G. 1189.

Applicant must distinguish between what is new and what is old. If he admits that all is old except the combination claimed he must substitute a statement to that effect for the assertion of novelty in the elements.

Gilbert, 1879 C. D. 233, 16 O. G. 763.

The averment in the petition that the applicant is the patentee named in a certain English patent is not evidence of that fact in an interference proceeding.

Lauder v. Crowell, 1879 C. D. 177.

Applicant required to describe in his specification some particular manner of constructing his device.

Schoonmaker, 1878 C. D. 40, 13 O. G. 595.

The drawing model and specification should correspond.

Schoonmaker, 1878 C. D. 40, 13 O. G. 595.

"In a reissue patent, as compared with the original, there is not the same reason for indulgence in the use of vague language, because the reissue is taken after the working of the machine may be supposed to be understood, and broad claims are inserted for the very purpose of being construed broadly."

Hatch v. Moffitt, 15 F. R. 252.

It is unnecessary to specifically describe a process, well known to those skilled in the art, that is used in the embodiment of an applicant's invention.

Floyd, 1874 C. D. 104, 6 O. G. 451.

A reference to a caveat concerns the history and not the description of an invention and is not therefore admissible in a specification.

Clubb, 1872 C. D. 224, 2 O. G. 519.

In applications for patents the Examiner should interfere as little as possible with the language chosen by the applicant in describing his invention.

In applications for reissues the applicant should be held rigidly to the language adopted in his patent. The rule should be liberality with original applications; strict construction with applications for reissues.

Underwood, 18782 C. D. 118, 1 O. G. 549.

A discussion of the merits, or demerits, of other patents, or inventions, in the body of the specification is improper.

Williams, 1872 C. D. 46, 1 O. G. 225.

Rule 35. Detailed Description.

The specification must set forth the precise invention for which a patent is solicited, and explain the

principle thereof, and the best mode in which the applicant has contemplated applying that principle, in such manner as to distinguish it from other inventions.

Rev. Stat., sec. 4888.

See notes to Rule 34.

Rule 36. Improvements.

In case of a mere improvement, the specification must particularly point out the parts to which the improvement relates, and must by explicit language distinguish between what is old and what is claimed as new; and the description and the drawings, as well as the claims, should be confined to the specific improvement and such parts as necessarily cooperate with it.

See notes to Rule 34.

Rule 37. Claims.

The specification must conclude with a specific and distinct claim or claims of the part, improvement, or combination which the applicant regards as his invention or discovery.

R. S. 4888.

HISTORY.

The character and facilities of the courts should make their decisions particularly enlightening on subjects relating to use of the English language. I have, for this reason and because of the importance of the subject, digested some of the recent Federal cases. Of course, this is not intended to take the place of the Text Books and General Digests.

Papers read before the Examining Corp of the U. S. Patent Office are:

History and Purpose of Claims in U. S. Patent Law, by N. J. Brumbaugh, Feb. 11, 1915.

Multiplicity of Claims, by Wm. R. Pratt, Nov. 16, 1916.

CONSTRUCTIONS.

(1) In General.
(2) Procedure.
(3) Words and Phrases.
(4) Form of Claim.
(5) Construction of Claim.
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(24) Reading Words, Etc., Into.
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(26) Concluding Clause in Claim.
(27) Analysis of Claims.

(1) *In General.*

Claims. A definition can not be given except after the most perfect conception of the subject of the definition. The truth is, no word can be truly defined until the exact idea is clearly understood in *all its relations* which the word is designed to represent.

Quoted from Matthews' "Words, Their Use and Abuse," by Andrews' American Law, p. 96.

Remark by U. S. Supreme Court. The use of ill-defined abstract phraseology is the frequent source of error. It requires no great ingenuity to mystify a subject by the use of abstract terms of indefinite or equivocal meaning.

Boyden Power-Brake Co. v. Westinghouse, 170 U. S. 537.

It appears to me clear that the crying abuse of superfluous and obscure claims is due to the failure on the part of both

the Examiners and the attorneys to see to it that each claim has a definite point in view, is concise, and that the claims of a set are self-distinguishing and self-classifying. It is quite possible that the profession has made a fetish of form.

Completeness of wording is very different from completeness of sense.

Assistant Com. Clay *ex parte* Brown, 235 O. G. 1335.

Previous to the Patent Act of 1836, which established a Board or Bureau composed of competent examiners, patents had frequently been adjudged invalid from the insufficiency of the specification. Few inventors,, or even learned lawyers, were capable of correcting and clearly setting forth in a specification the proper limits of the just claim of the invention.

Burr v. Duryee, 1 Wall. 175.

These "separately are termed" subordinate integers of the combination, referring to the elements of a combination.

Roberts' British Patents.

"The meticulous American claim."

British Comptroller of Patents.

To define a new thing accurately so that it may all be embraced within the description, but nothing included which is not essential, is an art of itself, and as Justice Brown indicated, a difficult art, one requiring long and careful training and in the practice of which oversights and mistakes of judgment are bound to occur.

Com. Ewing in Litle Jr. v. Armstrong, 232 O. G. 935.

As stated by the court (Morgan, 179 O. G. 242), certain devices are common to all arts as a whole because they are adapted for use in many situations.

Fisher, 229 O. G. 1255.

The claims are therefore rejected on the ground that they are broader than applicant's conception and are presented for the purpose of covering something different from the essential elements of his idea of means, the production of which, moreover, has involved inventive work of a very high order.

Foutts, 227 O. G. 741; see United Wireless Tel. Co. v. National Elec. Signally Co., 198 F. R. 386.

It is not the legitimate office of a patent claim to state merely a mechanical problem or function. It must also clearly indicate the mechanical means for its solution or accomplishment.

Union Special Mach. Co. v. Singer Mfg. Co., 215 F. R. 598-602.

Each claim should be directed at some function, step, or

advantage to give it individuality; it should have a characterizing thought or point by which it can be identified; and if the court which is to construe the claim can find this dominant thought, its task will be simplified.

Denison, J., in Scaife & Sons Co. v. Falls City Woolen Mills, 209 F. R. 210-213.

It has always been the policy of the Office to allow some latitude to applicants in drawing their claims—provided, of course, the claims are clear of the prior art and are clear in their meaning.

Pease, 202 O. G. 631.

The patent statutes require the patentee himself to claim and define his invention, so that the public may know its rights, and so that there shall not be imposed upon the courts the burden of constructing upon a hearing new claims from the interpretation that experts may place upon language of the most sweeping and general character. Quoted from the Bell Tel. cases in

United Wireless Telegraph Co. v. National E. S. Co., 198 Fed. R. 395.

There is only one claim in the English patent. But that claim, under the English patent system, entitled the patentees to their entire invention, and is at least as broad and comprehensive as all four claims of the American patent.

Commercial Acetylene Co. v. Searchlight Gas Co., 197 F. R. 912.

See remarks as to assignment of error in

Lord Baltimore Press., Inc., v. Labombarde, 197 Fed. R. 739.

A pipe with an outer coating composed of an inner layer of copper and an outer layer of zinc. It was urged that the copper being electrically deposited was superior to the article. Cited as a reference.

This did not appear in the claims, however, unless by saying that the outer coating was of uniform density, purity and thickness, and this was alleged of the reference and the court would not reverse the experts of the Office.

Hodkinson, 182 O. G. 251.

The fact, however, that the defendant's device may be within the language of the claim does not of itself prove that it is an infringement. Infringement is not a mere matter of words. Authorities cited and commented upon.

General Electric Co. v. Allis-Chalmers Co., 171 F. 669. See this case in Court of Appeals, 178 F. 273. See Curtain Supply Co. v. National Lock Washer Co., 178

F. R. 95. These claims were, however, drawn to cover claims in a patent.

I am inclined to think he did discover them, without himself knowing it, but that he never fully understood or claimed them, and that his discovery has become public property.

General Const. Co. v. Nelther, 167 F. R. 554.

A claim may be so prolix as not to comply with the requirement of the statute.

Lagan, 162 O. G. 538.

By an ingenious and acute process of analysis nearly everything may be resolved into elements which are old.

Electric Candy Machine Co. v. Morris, 156 F. R. 976.

The purpose of this requirement is not only to secure to the inventor the benefit of his invention, but also that the public may know what they are prevented from doing during the existence of the monopoly. (Brooks v. Fiske, 15 How. 211, 214; O'Reilly v. Morse. 15 How. 62-119.)

In re Gardner, 140 O. G. 258.

The courts recognizing the fact that the ordinary inventor is not usually skilled in technical rules of construction and is apt to suppose that his claims protect him in the essential elements mentioned in them and that these claims and specifications are usually drawn by men who are strangers to and ignorant of the art within which they lie, and that even skilled solicitors are not infallible in framing technical documents, have sanctioned reissues which permit the framing of claims adequate to secure the full benefits of the inventions designed to be protected by the patent laws.

Crown Cork & Seal Co. v. Aluminum Stopper Co., 96 O. G. 2573.

The fact that in its progress through the Patent Office the specification and claims of the patent in suit were made more clear and accurate so as to express the patentee's actual invention, affords no reason for casting doubt upon the validity of the patent.

Pullman Co. v. Boston & Albany, 90 C. D. 533.

Uniformity is necessary to the proper conduct of the affairs of the Patent Office.

Buffalo-Pitts Co., 89 O. G. 2069.

(2) *Procedure.*

The Examiner should not attempt to compel the applicant to insert elements in his claim which he does not desire to have there.

Compos, 182 O. G. 719.

The complainant having canceled all his original claims is now estopped to claim the benefit of them, or such a construction of his present claim as would be equivalent thereto.

Langan v. Warren Axe & Tool Co., 181 F. R. 146.

The fact that a new claim was inserted in the application by the attorney without any new oath does not render the patent invalid as to such claim where it was within the invention described in the specification.

Cutler-Hammer Mfg. Co. v. Union Electric Mfg. Co., 147 F. R. 266.

A claim introduced by amendment relates back to the date of the filing of the application.

Mr. Farland v. Walson and Walson, 146 O. G. 257.

Had the applicant insisted that he was the first to apply this device as an aid to the starter, he would no doubt have secured the allowance of his claim as first made, without any restriction as to manner of pivoting nor as to location of gate, whether between, ahead of, or behind the supports. But he elected to make the change and must abide the consequence.

Ryan v. Metropolitan Jockey Club, 139 F. R. 579.

Where an applicant before the Patent Office acquiesces in the ruling that his claim is not patentable without amendment, he can not be heard to question whether it is right or wrong.

Computing Scale Co. of America v. The Automatic Scale Co., 1905 C. D. 704, 119 O. G. 1586.

The proceedings in this office leading to the grant of a patent are regarded by the courts as having an important bearing upon the validity and scope of the claims. (Shepard v. Corrigan, 1886 C. D. 116, 34 O. G. 1157; 116 U. S. 593; McCormack v. Graham, 129 U. S. 1; Roemer v. Peddie, 1889 C. D. 682, 49 O. G. 2151, 132 U. S. 313.)

Doman, 1905 C. D. 101, 115 O. G. 804.

They are also of importance if the question of granting a reissue is at any time raised.

Lewis & Auger, 1903 C. D. 303, 106 O. G. 543.

The Office should not permit claims of doubtful propriety, even if the courts have saved the validity of patents having such claims by a forced construction.

McLellan, 1872 C. D. 152; Simonds, 1870 C. D. 22; Cornell, 1872 C. D. 120, 1 O. G. 573; Shepler, 1903 C. D. 17, 102 O. G. 468.

The action of one Examiner should be at least extremely persuasive upon his successor.

Ealin, 1897 C. D. 174.

Applicant should present his whole case at one time by both broad and narrow claims.

Miller, 1900 C. D. 65, 91 O. G. 1034.

An applicant should present his whole case at one time by both broad and narrow claims.

Snow, 1897 C. D. 48, 80 O. G. 1271.

If the claims granted are inconsistent with former expressions of the Office and admissions of the patentee, the logical inference is that further examination led to a change of views.

Sugar Apparatus Manufacturing Co. v. Garyon Mfg. Co., 53 O. G. 920.

The Patent Office, in cases where the prior art admits of such a course, should grant to the applicant a claim or claims which will enable him to cover his invention, even when an infringer interchanges or reverses some of the elements.

Tobie, 1890 C. D. 28, 50 O. G. 992.

Cancellation of the claims is an abandonment of the application.

Lascell, 1884 C. D. 42, 28 O. G. 1274. This is not free from doubt.

Lascell, 1884 C. D. 66, 29 O. G. 861.

No more than a single device, or combination, should form the subject of a single claim.

Bland, 1897 C. D. 40, 15 O. G. 828.

A claim for substantially a new method of doing business is not patentable.

Sheldon, 1878 C. D. 44, 13 O. G. 817.

I do not think it proper to say that the recognized practice of the Office discountenances any particular form of claim. The mere form itself is of little or no consequence; and it is impossible to decide that because the form is bad in one case, it will be bad in every other.

It is the uniform practice of the Office to discountenance in a particular case any form of claim which does not set forth clearly the nature of the invention, but leaves in uncertainty the thing which is to be patented.

Acting Com. Spear in Dahne, 1875 C. D. 66, 7 O. G. 1095. See also, Haasz, 1873 C. D. 170, 4 O. G. 610; The Collins Company, 1872 C. D. 251, 2 O. G. 617; Designolle, 1878 C. D. 10, 13 O. G. 227.

The Office has uniformly allowed some latitude to applicants in stating in different forms, claims for substantially the same invention.

Martin v. Boyle, Runyan & Patric, 1877 C. D. 106, 12 O. G. 625.

It is admissible, under proper restrictions, for parties to put their claims in different forms to prevent misconstruction of them by the public or by the courts.

Shippen, 1875 C. D. 126, 8 O. G. 727; Hahn, 1875 C. D. 107, 8 O. G. 597.

(3) *Words and Phrases.*

The words "closed or nearly closed" applied to a magnetic circuit is a claim.

Kuhlman Electric Co. v. General Elec. Co., 147 F. R. 709. See Dorsey, 1870 C. D. 17.

Means *between* certain pumps and their driving means. "Between" is not limited to a geometrical location, "the unforced meaning of the language used is that the compensating means accomplishes its effect in the action of the driving means upon the pumps."

Lemp v. Randall & Bates, 1906 C. D. 240, 123 O. G. 319.

A claim for "lumber partially saturated with sulfric acid" objectionable, the words "partially saturated" being inapt.

Chapman, 1906 C. D. 79, 120 O. G. 2446.

"Outlet" is not objectionable in all cases as referring to something intangible.

Ljungstrom, 1905 C. D. 541, 119 O. G. 2235.

The terms of description used in the claims should accurately describe the construction disclosed in the application.

The word "keyed" does not accurately describe a washer upon a squared shaft.

Mueller & Braunsdorf, 1905 C. D. 336, 118 O. G. 5270.

A party will not be permitted to attempt to distinguish claims by the words "substantially as described" since they impart no definite limitations into the claims and since it is the duty of the Office to require that the limitations intended to be included in a claim be clearly and definitely stated therein.

Shepler, 1902 C. D. 17, 102 O. G. 468.

A hole is an intangible thing and may not be an element of a combination. There is no objection to describe the element as provided with a hold.

Davin, 1902 C. D. 251, 100 O. G. 453.

Under the court decisions the introductory phrase is not an element of the combination and does not limit the claim to such apparatus.

Casler, 1899 C. D. 5, 90 O. G. 446.

If the term binary substance has a fixed meaning in chemistry, indicating a chemical combination of two elements, and if it be true that no chemical combination takes place in the mixture, the term is objectional, if "binary compound" has such meaning "binary substance" will not be objectionable because of its similarity to binary compound.

Du Motay, 1879 C. D. 195, 16 O. G. 499.

(4) *Form of Claim.*

Claims 2 and 3, each of which comprises a reference to the preceding claim, with a statement of the structural features distinguishing it therefrom. Held to meet the requirements of the law, and in this case to clearly point out the invention.

Brown, 235 O. G. 1355.

The theory of the claim is that the ray of light which effects the sensetized paper is a recording medium projected against the strip. This is not accurate. The light is no part of applicant's record, it being only utilized to change the material of the strip.

Fritts, 227 O. G. 737. Illustrative example.

Of course, as is well known, an applicant for a patent will use varying phraseology in his claim in order to obtain as comprehensive a patent as possible or and by such use, to avoid the pitfalls of language, so that if later one claim is inaptly worded, some other claim will stand the test of attack.

Vacuum Cleaner Co. v. Am. Roty Valve Co., 219 O. G. 587.

While the use of the term "for example" is somewhat misleading, we are of the opinion that the specification is ample to establish the fact that the patentee claimed specifically the device shown in the drawings and specification, i. e., a structure erected in the particular manner shown in the drawings, even though not described in terms in the specification, thus covering the advantages of reduced power and wide rotation.

Jones v. Evans, 215 F. R. 588. The device was claimed generally but was only new as applied to a greenhouse window.

When we say a thing is substantially the same, we mean it is the same in all important particulars. It must be of the same material, when the material is important; it must be of the same thickness, when thickness is important.

Valoma Marchiony Co. v. Perella, 207 F. R. 379.

The complainant advances the ingenious argument that the defendant's barrel is mounted upon the frame, because the

bolt carrier upon which it is actually mounted, is slidingly mounted on the frame. Disapproved.

Colts' Patent Firearms Mfg. Co. v. New York S. G. Co., 190 F. R. 562.

It is asserted that there is error in the statement that complainant "is making claims which are broader than the use of any particular device, when he attempts to patent as a combination the use of the wickless burner and any increased supply of oil, whether supplied by old device or not." The authority referred to, Expanded Metal Co. v. Bradford, 214 W. S. 366, involved a process patent. The trial judge (168 F. 712) correctly characterized the claims.

Central Oil & Gas Stove Co. v. Silver & Co., 184 F. R. 457-8.

We think it may be affirmed as a rule resting upon the fundamental principles of patent law that, where the essence of the invention is the location, form, size, or any other characteristic of the means employed, the patentee must distinctly specify the peculiarities in which the invention is to be found.

American Lava Co. v. Steward, 155 F. R. 936; cites
Germer Stove Co. v. Art Stove Co., 150 F. R. 147;
Bullock Electric Co. v. General Electric Co., 149 F. R. 409.

This being a comparatively new art, and it not appearing that the term "wheel" as applied to it has obtained a fixed and definite meaning, we see no reason why each series of units is not entitled to be called a wheel in construing the claims of the issue.

Lindmark v. Hodgkinson, 137 O. G. 228.

The word "then" introducing a clause in a process claim construed.

Kalin v. Starrells, 131 F. R. 464.

"A pounder attached to the arm of said lever which projects laterally within the tub from its pivotal support." No pivotal support is previously recited in the claim. If the pivotal support is to be referred to in locating the parts, it should be made a positive element of the claim.

Dodge, 1906 C. D. 439, 125 O. G. 665.

Patentability of claims can not properly be predicated on alleged differences of construction which are not specified therein.

McNeil and Sturtevant, 1906 C. D. 383, 124 O. G. 2177.

The claims to the mechanism are not proper to define, a novel arrangement of the work in connection with such mechanism.

McNeil & Sturtevant, 1906 C. D. 383, 124 O. G. 2177.

The claims should distinguish the invention by words and not require construction to this end.

Cutler, 1906 C. D. 247, 123 O. G. 655.

Claims which purport to cover a process, but which describe the operation of an apparatus, the putting together of an apparatus, and perhaps the apparatus itself, held objectionable.

Dixon, 1906 C. D. 242, 123 O. G. 653.

Where the claim read in the light of the specification of one party means one thing and the same claim read in the light of the specification of another party means another thing, held that the same phraseology should not be employed.

Podlesak & Podlesak v. McInnerney, 1906 C. D. 558, 120 O. G. 2127.

A claim for certain printed matter including among other features properly set forth "another form" located at a certain place with respect to other features is not objectionable as being indefinite, the language involving a question as to the scope of the claim rather than its form. Examples of functional claim.

McClain, 1905 C. D. 519, 119 O. G. 1585.

The essential feature upon which an invention rests should not be left to conjecture and inference.

B. v. P. P. Wks., 107 F. R. 475.

Similarities and differences in machines, process or product do not depend upon mere names of things, words used to describe them, or immaterial matters by which they may be distinguished.

Palmer Co. v. Lozier, 84 F. R. 669. Citing, Glue Co. v. Upton, 97 U. S. 3 and Bates v. Coe, 98 U. S. 31-42.

In order to face toward opposite ends of the press, the folders must clearly be between those ends.

Annand v. Spalckhavor, 1901 C. D. 212, 97 O. G. 2083.

If in a claim one or more articles may constitute a single element it is sufficient to mention one only as more than one includes one.

Thorsen, 1893 C. D. 75, 63 O. G. 1688, see also Hulbert, 1893 C. D. 74, 63 O. G. 1687.

While an applicant will generally be allowed all possible latitude in framing his claims, parenthetical clauses which do not contribute to clearness or exactness in stating applicant's invention, but which at least are only superfluous, will not be allowed.

Cahill, 1893 C. D. 78, 63 O. G. 1815.

A claim containing words of limitations which are depend-

ent upon the location or operation of mechanism that forms no part of the invention claimed and is neither shown or described, is objectionable.

Baackes, 1893 C. D. 70, 63 O. G. 909.

An article of manufacture should not as a rule be defined in a claim by reference to the process of producing it, but when it can not be otherwise defined an exception to the rule is presented.

Painter, 1891 C. D. 200, 57 O. G. 999.

A product of nature rendered usable by a certain process covered by a process and not by a product claim.

Latimer, 1889 C. D. 123, 46 O. G. 1638.

A combination of elements arranged in a certain position as to each other, which certain position is fixed and restricted by the terms of the specification and claim, is a proper claim.

Rernolds, 1876 C. D. 88, 9 O. G. 744.

Every claim must be so drawn as to plainly indicate what kind of invention is sought to be covered, whether an improvement in an art or in a manufacture, whether a process or product. A claim for the use of a thing is ambiguous.

Mayall, 1873 C. D. 134, 4 O. G. 210; Brownlie, 1872 C. D. 208, 3 O. G. 212; Hooper, 1872 C. D. 150, 2 O. G. 4, 1872.

A claim for a result or effect is bad. The whole genus of claims in the present participle form are bad.

Simonds, 1870 C. D. 23; Arkell, 1871 C. D. 263; Beavis, 1879 C. D. 331, 16 O. G. 1233; Hobson, 1872 C. D. 20, 1 O. G. 141.

Every claim must be so drawn as to plainly indicate what kind of invention is sought to be covered, whether an improvement in an art or in a manufacture, whether a process or product.

A claim for the use of a thing is ambiguous.

Mayall, 1873 C. D. 134; Brownlee, 1872 C. D. 208; Hooper, 1872 C. D. 150.

Each claim must be to a complete and operative combination in the direction of the invention.

Holt, 1884 C. D. 43, 29 O. G. 171.

A claim for an "arrangement" disapproved a claim for a combination is better.

Eynon, 1871 C. D. 239; see Martz, 1870 C. D. 16.

(5) *Construction of Claim.*

See "Construction of Issue" under Rule 95.

The patent of Hug 1154314, granted September 21, 1915,

has as its first claim simply the one word "polihydrocolchicin." This claim is proper notwithstanding it leaves the reader without any knowledge of the invention patented unless he has read the specification and is able to bear it in mind.

Assistant Com. Clay in *ex parte* Brown, 235 O. G. 1355.

A claim may be limited beyond its terms by reference to the specification. A very good case with authorities, Fowler & Wolfe Mfg. Co. v. McCrum Howell Co., 215 F. 905. Com. Ewing cites this case as holding—If an infringer's use includes a specific feature which is essential to patentable novelty and is not recited in the claim, the defect is sometimes cured by construction.

See Feud v. Miggett, 223 O. G. 649.

A claim should be given the broadest interpretation its terms will permit. Miland, 135 O. G. 1122; Pratt v. De Ferranti and Hamilton, 148 O. G. 568. Nevertheless it can not be enlarged beyond the plain import thereof as set forth in the specification on which the claim is based. Sinclair v. Engel, 147 O. G. 769.

It is in the specification of a patent that the invention, if there be one, must be discovered. References to prior art are useful to clear up obscurities (Hall Borchert, etc., Co. v. Ellaman, etc., Co., 213 F. R. 341).

Barrett Company & Schulte v. Ewing, Com., 228 O. G. 761.

But, even if F's apparatus shows the continuous application of the received energy, he is not for that reason entitled to claim an unbroken current under this patent. F's conception was no broader than the essential elements of his idea of means, and this was not broadly current operation, but specifically current operation on the galvanometer principle. (Quoted from 198 F. 386.)

Fritts, 227 O. G. 741.

Since he made this general suggestion as to supporting the candy, and since he was a pioneer in providing the "figured" motion, a meritorious improvement in the art, infringement of his patent might be found.

Hilbreth v. Auerbach, 223 F. R. 651.

The only feature of the claim for which there can be any color of novelty is in raising the center sills above the bolsters into the floor stringer space. But even this feature is anticipated in 615, 118.

Guaranty Trust Co. v. Beltendorf Axle Co., 223 F. R. 542.

When the language of a claim is clear and distinct the patentee is bound by it. If elements are omitted there is no infringement.

Evans v. Hall Printing Press Co., 223 F. R. 539.

Therefore claim 23 may be disregarded at once; because where so many claims are put into a patent each element in a given claim must be supposed to be especially necessary to the combination.

Victor T. M. Co. v. T. A. Edison, 221 O. G. 351.

Construction of claims in view of the previous art.

Victor Talking Machine Co. v. Thomas A. Edison, Incorporated, 221 O. G. 357.

While the ultimate disposition of the case must depend upon the construction of the claim in respect to an express limitation found therein, this in turn depends in part upon the advance which Rowley made over existing knowledge; and the inquiry may well be approached along the road adopted in 217 F. 775. This is to inquire: First, what was R's real advanced step or new concept? Second, is defendant's structure within the limits of such advance? And, third, if so, do the terms of the claim, when fairly read, require such an interpretation as to sanction defendant's appropriation of Rowley's idea.

Dennison J. Rowley Co. v. Columbus, etc., 220 Fed. R. 128.

The prior art contains nothing which should require it to be narrowly construed.

Autopiano Co. v. American Player Action Co., 217 O. G. 1055.

Claims so functional in character and form as those in suit must be read in the light of the drawings and description of the patent and be closely limited to what is there shown and described.

Union Special Mach. Co. v. Singer Mfg. Co., 215 F. R. 598-602.

The court will remember that the specification and claims are often unskillfully drawn and that the claim shall be construed, if possible, to sustain the patentee's right to all that he has invented.

Benjamin Memo Card Co. v. Rand, M'Nally & Co., 210 F. R. 287.

A patent claim is a formal instrument, and its meaning depends upon its words and not on the mind of the inventor.

National Elec. S. Co. v. Telefunken Wireless T. Co., 209 F. R. 865.

Where a patent contains both a broad and a narrow claim and a suit is brought on the broad claim, we can not construe into it a limitation not therein expressed, but which is expressed in the narrower claim and by which alone one is distinguished from the other.

National Tube Co. v. Mark, 209 O. G. 335-6.

It is only applying to a patent the ordinary rules of construction applied to other grants, to say that, in determining whether a given element should be considered as present with a limiting effect in a claim in that respect ambiguous, we should observe the occasion or the necessity for its introduction by the claim draftsman. If its presence was necessary to distinguish the claim in point of patentability from the prior art or in point of effect from the other claims, it should be implied, but if it can be of no use in either of these particulars, it should not operate as a limitation.

Scaife & Sons Co. v. Falls City Woolen Mills, 209 F. R. 216.

In practice, however, the claim elements often can not be effectively labeled "generic" or "specific;" terms are used capable of either construction; and here is the interpretative usefulness of claim differentiation.

Scaife Sons Co. v. Falls City Woolen Mills, 209 F. R. 214.

The defendant claims that the language in the claim said "indented mold" restricts it to a particular form which it does not use.

The defendants' variation does not effect the functional action, and therefore is not an avoidance of the claim.

Valoma Marchiony Co. v. Marchiony, 207 F. R. 383.

Unless a patentee has especially limited himself to a specific form of construction, or such limitation is imposed by the state of the prior art, or such limitation was imposed by the action of the Patent Office in rejecting a broad claim, applicant is entitled to a broad construction of his claims in accordance with the language thereof.

Ryder v. Lacey, 200 Fed. Rep. 971.

The claim of a patent is a statutory requirement prescribed for the very purpose of making the patentee define precisely what his invention is, and it is unjust to the public, as well as an invasion of the law, to construe it in a manner different from the plain import of its terms.

Loraine Development Co. v. General Electric Co., 198 F. R. 115.

If even common words have a special, extended, or restricted

meaning when used in that art, courts are bound to give them that meaning.

Loraine Development Co. v. General Electric Co., 198 F. R. 115.

There are such fundamental difference between the two inventions by which the battery plates are produced that a broad construction of claim 2, such as its literal wording would seem to imply, should not be accorded to it.

Electric Storage Battery Co. v. Gould Storage Battery Co., 197 Fed. R. 749.

Where the language of a claim is plain in its meaning, when read in connection with the subject matter, and when so read describes a valid, patentable combination, it should not be interpreted according to other possible meanings of the terms used, by which not only would the claim be rendered invalid, but by which other patentable combinations would be made apparent infringements and would then in turn have to be relieved from the consequences of such infringement by a return to the conclusion that the construction of the claim rendered it invalid.

Hall v. Frank, 195 Fed. R. 951-952.

Elements in claims should be read with reference both to the structure and the function given in the description of invention.

Lowden Machinery Co. v. Strickler, 195 Fed. R. 756.

Whether or not there is any force to these criticisms of the specifications and claims (misleading, confusing, multifarious claims) can be determined only when the court is advised as to the state of the art when the patent was granted.

Marconi Wireless Tel. Co. v. New England Nat. Co., 191 F. R. 194.

Wording of claim just the reverse of that intended.

Crown Cork & Seal Co. v. Brooklyn Bottle Stopper Co., 190 F. R. 327.

It is frequently the case when a patentee attempts *ex post facto* a physical explanation of what he has found by experiment, a collateral issue is raised which diverts attention from what is more important—the means whereby he effects his result.

Combustion Utilities Corp. v. Worcester Gaslight Co., 190 F. R. 161.

It is urged that the decision of the Court of Appeals in Tyden v. Ohio Table Co., 152 F. R. 183, holds that a claim generally to "means" is functional and invalid. I do not so understand Judge Lurton's opinion. In that case the means

shown were so ordinary and common, and the device so lacking in invention, except possibly in the result or function disclosed, as to compel the conclusion that the patentee intended to claim the result by whatever means accomplished.

Mershon & Co. v. Bay City Box & Lumber Co., 189 F. R. 749.

But applicant has specified a large number of substances containing the common quality which fits them for use in his invention, in the absence of evidence to the contrary, we believe that the doubt should be resolved in his favor.

Ellis, 167 O. G. 983.

The entire structure of the claim comprehends new elements applied to a structure of an old type. If in this claim the inventor, by including the words "retorts therein" has limited himself to a claim for his invention when applied to use in a structure of special type, it would be a harsh and unusual construction of his claim to say that, because he had unnecessarily limited himself to the use of his invention for the purpose of heating retorts, he should lose it altogether.

Combustion Utilities Corporation v. Werceslor Gaslight Co., 190 F. R. 161. Also what follows above quotation. See Langan v. Warren Axe & Tool Co., 166 O. G. 986-987.

To single out as the actual and dominant factor in maintaining a low temperature the heat absorbtion which results from CO introduced in the draft current seems to give a fallacious emphasis to a part of what occurs above the grate.

Combustion Utilities Corp. v. Worcester Gaslight Co., 190 F. R. 160.

The invention stands as it was asserted and accepted at the close of the proceedings regardless of what had passed previously. Said in a case where claims had been withdrawn and again reasserted.

Dodge Needle Co. v. Jones, 153 F. R. 190.

It is well settled that where a party copies the claim of a patent for the purpose of interference, such claim must be read in the light of the disclosure of the patent.

Chirney v. Clause, 116 O. G. 597; Brown v. Hill, 123 O. G. 1284; Sobey v. Holsclaw, 126 O. G. 304; Sinclair v. Engel, 147 O. G. 769.

Claims are to be constructed by the specification as amended.

Wenberth v. Lizotte, 141 O. G. 1102.

A claim will be given the broadest interpretation of which its terms are capable.

Milans, 135 O. G. 1122.

As to interpretation of claims.

Leonard v. Horton, 189 O. G. 781; Jund v. Harrington, 131 O. G. 691.

A claim should be given the broadest interpretation which it will support, and limitations should not be imported into the claim from the specification to meet the exigencies of the particular situation in which the claim may stand at a given time.

Miel v. Young, 128 O. G. 2532.

The function is not inherent in the mechanism shown for the reason that the function does not flow from the mechanism as shown and described, but from that mechanism minus one of its parts.

Scott v. Southgate, 125 O. G. 1203.

There is not a word in the claims limiting them to a current double the old capacity and we are unable to perceive any reason why the claims should be eviscerated by importing into them the statements of a formula intended only as an illustration.

Electric Smelting & Aluminum Co. v. Pittsburg Reduction Co., 125 F. R. 926-938.

Reference may be had to the French patent for the purpose of discovering the scope of the patent in suit.

Central Lighting Co. v. Northern Light Co., 137 F. R. 427.

A device not within the wording of the claim, but within its spirit held to infringe. See also Schoeder v. Brammer, 98 F. R. 880 and 106 F. R. 918.

Benbow-Brammer Mfg. Co. v. Simpson Mfg. Co., 132 F. R. 315.

No better method of construing claims is perceived than to give them in each case the broadest interpretation which they will support without straining the language in which they are couched.

Podlesak & Podlesak v. McInnerney, 1906 C. D. 265, 123 O. G. 1989.

In reading a claim to construe it heed must not only be paid to the specification proper, and to the drawings, but also to the other claims of the patent. (Ryder v. Schlichter, 126 F. R. 487.)

Andrews v. Wilson, 1906 C. D. 717, 123 O. G. 1667.

Whether two patents having claims with the same wording ought ever to issue.

Allfree v. Sarver, 1906 C. D. 214, 122 O. G. 2391.

The meaning given to the counts of an interference is that

of the party first making the claim. (Tracy v. Leslie, 14 App. D. C. 126; Púete v. Elwell, 15 App. D. C. 21.)

Podlesak & Podlesak v. McInnerney, 1906 C. D. 558, 120 O. G. 2127.

In a case of doubt the intent of the applicant in using a term in a claim and the understanding of the Office in allowing the claim have a material bearing upon its meaning and scope, and therefore the applicant should not be required to cancel statements where such cancellation may result in a more limited construction of the claim than is necessary.

Jansson, 1906 C. D. 62, 120 O. G. 2126.

All the words of a claim will be given force and effect when this can be done without contradiction or inconsistency.

Reese, 1904 C. D. 484, 113 O. G. 849.

A limitation that a fuse is "within the casing" means anywhere within the casing as imbedded in its walls. In the absence of express words, it should not be limited to a fuse within the cavity of the casing.

A fuse covered by the outer wrapper of a casing is within the issue and is reduction to practice.

Sachs v. Hundhausen, 1903 C. D. 625, 105 O. G. 1534 et seq.

Nothing beyond this was described in the patent as a function of the invention, and nothing more can now be successfully maintained.

Consolidated Car Heating Co. v. An Elec. H. Corp., 82 F. R. 995.

He must, indeed, make such disclosure and description of his invention that it may be put into practice. In this he must be clear. It is no concern of the world whether the principle upon which the new construction acts be obvious or obscure, so that it inheres in the new construction.

Diamond Rubber Co. v. Consolidated Rubber Tire Co., 31 Supreme Court Reporter 448.

Words are to be explained by their context.

O. Greenough v. Drummond, 1879 C. D. 213; Greenough v. Drummond, 1879 C. D. 269, rehearing.

(6) *Reference to the Specification.*

It is clear that neither the language employed nor the state of the art requires this limitation, and that its presence is almost necessarily negatived by comparison with claim 4, which is differentiated alone by the inclusion of this feature.

Knoley Co. v. Columbus Co., 220 Fed. R. 133.

The claims are a part of the description required by the statute, and in them, and in that part of the description

which is now commonly called "specification," is the proper place in which to define the breadth of the invention.

National Tube Co. v. Marks, 216 Fed. R. 507.

General language in a claim which points to an element or device more fully described in the specification is limited to such an element as is there described.

Attumwa Box Car Loader Co. v. Christy Box Car Loader Co., 209 O. G. 688.

The construction of the third claim of the patent is made the more evident, when the language of this claim is contrasted with that of the first claim of the D'Arcy patent, which, although itself not directly involved under this appeal, may, under the general rule that a patent as any other written instrument, is to be construed as a whole and due effect given to all its parts, be looked to for the purpose of aiding in the proper construction of the third claim. (53 F. 367, 370, 108 F. 379, 383, 123 F. 416-419.)

Sheffield Car Co. v. D'Arcy, 194 F. R. 690.

A claim of a patent depending for its validity upon a feature not disclosed by specification or drawing is invalid.

Herman v. Youngstown Car Mfg. Co., 191 F. R. 579.

Each claim of the process patent is expressly limited by the expression "the herein before-described process" and when read in connection with the specification is intelligible though claims 10 and 13 of the process patent are not clearly expressed.

Combustion Utilities Corp. v. Worcester Gaslight Co., 190 O. G. 164.

In a large sense every operation by electricity is by current; but the patentee does not leave us to this general use of the word "current." He does not leave us in any doubts as to what he means by "current-operated." He makes his meaning clear in the specification, wherein he clearly draws the distinction between the coherer, the imperfect electrical contact of the previous art, and his method of operating by a constantly flowing current.

National Electric S. Co. v. United Wireless Tel. Co., 189 F. R. 733.

Whether a claim is valid the advantages of the device defined not being pointed out in the specification.

Morgan Engineering Co. v. Alliance Machine Co., 157 O. G. 1244-1246.

If the crane can not be constructed without securing such advantage, this is alone sufficient.

Cases cited, 72 F. R. 67-73 to 75, 115 F. R. 886-895, 117 F. R. 410-415.

It is possible that in Forster's device the water, to some extent, impinges upon the inside of the "tubular body" though he does not suggest it. But he would be entitled to claim that feature, if it in fact existed. (Goshen S., 72 F. R. 67, 116 F. R. 363, 117 F. R. 410-415, 123 F. R. 67-71. Indeed, the Supreme Court has decided that novelty is negatived by a prior patent which shows the device in its drawings and describes it in the specifications, but does not clearly state its use. Walker's Patents, sec. 55.)

Forest City Foundry & Mfg. Co. v. Barnard, 157 O. G. 756.

In the construction of a patent, the omission of the patentee to point out or refer in his specification or claims to a special feature, which he subsequently maintains is the most important part of his invention is very significant, and should be carefully scrutinized.

Stirling Co. v. Rust Boiler Co., 144 F. R. 849.

Limitation by description.

Continental Paper Bag Co. v. Eastern Paper Bag Co., 136 O. G. 1297.

In other words reference may be made to the specification to explain but not to extend or limit the claims. The words "to operate substantially as described" mean "substantially as described in regard to the combination which is the subject of the claim.

General Electric Co. v. International Specialty Co., 126 F. R. 759.

It is, no doubt, true that an element not stated in a claim can not be brought forward from the specification and imported into it. McCarty v. Railway, 160 W. S. 110-16, Sep. Ct. 240, 40 L. Ed. 358. But that is by no means to say that the specification which precede do not limit it, or that they are not to be resorted to, as they always are, to explain it and give it character.

National Meter Co. v. Neptune Meter Co., 122 F. R. 75.

The claim of a patent must always be explained by and read in connection with the specification and as this claim clearly includes metal taken from the blast-furnaces, the question whether it includes every molten metal is as much eliminated from our consideration in this case as if it were sought to show that the word "metal" might include other metals than iron.

Podlesak & Podlesak v. McInnerney, 1906 C. D. 558, 120 O. G. 2127.

The specification may be referred to for ascertaining the meaning of the claims.

Holley v. Vergennes Machine Co., 1880 C. D. 659, 18 O. G. 1177; Jansson, 1905 C. D. 62, 120 O. G. 2126.

Features described as preferable in the specification do not constitute a limitation of the claim.

Krajewski v. Pharr, 105 Fed. Rep. 518.

The point is made that in the original application for a patent, filed in May, 1882, the defendant in error designated his invention a mechanism to form a "noiseless, self-adjusting treadle," and that he made no allusion to the feature thereof which is now deemed of prime importance until his specification was subsequently so amended by his attorneys as to contain the declaration that his invention had for one of its objects to provide means "to keep the treadle bearing in line and at a fixed distance apart to avoid friction." It is argued from this circumstance that the court must hold the invention of the defendant in error to be a mechanism to secure a noiseless, self-adjusting treadle and nothing more. We are unable to assent to the doctrine that an inventor is thus circumscribed by the words which he may first use to describe the advantages of his invention and that he may not afterward, on further consideration, either upon his own suggestion or that of his counsel, amend his specification so as to assert and maintain all the advantages which his device possesses.

The claim throughout was substantially the same.

Singer Mfg. Co. v. Cramer, 97 O. G. 555.

It is earnestly contended that inasmuch as the claim of the Cramer patent calls for a "treadle provided with trimmers," the trimmers are made an essential feature of the construction of the treadle and that there can be no infringement by the use of a treadle which has no trimmers. We do not think, however, that the court should have taken the case from the jury upon that ground.

If the patentee was entitled to the doctrine of mechanical equivalents, his right certainly is not affected or diminished by the use of the words "provided with trimmers" as found in his claim.

Singer Mfg. Co. v. Cramer, 1901 C. D. 492, 97 O. G. 552.

The particular expressions used in the claims are not clear as they have not been defined and explained in the specifications.

To merely state in the claim the function or result without first including therein the structure by means of which the

function or result is obtained renders a claim vague and indefinite.

Kotler, 1901 C. D. 12, 95 O. G. 2684.

If any particular kind of gripping device was specified it might, to that extent, perhaps, be saved; but as it depends upon the general combination of the elements brought together, it is of no novelty.

Thompson Scenic Ry. Co. v. Chestnut Hill Casino Co., 119 F. R. 362.

Where expressions used in the claims have not been specially defined or explained in the specification so that their meaning can be understood. Held that the claims are objectionable as not being so clear and concise as required in the statutes and rules.

Kotler, 1901 C. D. 62, 95 O. G. 2684.

Where the claims of a patent are not supported by a description in the patent, such claims are of no validity.

Pacific Cable Co. v. Buette City R. R., 94 O. G. 205.

Where claims in a patent are not supported by a description in the patent such claims are of no validity.

Pacific Cable Railway Co. v. Butte City Street R. R. Co., 1894 C. D. 205, 66 O. G. 1758.

Claim and operative method must correspond.

Barney, 1890 C. D. 171, 53 O. G. 1569.

It is the province of claims to relegate to the specification the enumeration of such details of construction as shall be found upon examination to be immaterial to the true scope of the actual invention.

Laskey, 1889 C. D. 181, 48 O. G. 539.

On referring to the specification we find it there expressly declared that the invention consists "in the construction and combination of parts hereinafter fully described and claimed, reference being had to the accompanying drawing."

This seems to have been construed as limiting the claims.

Singer Mfg. Co. v. Cramer, 24 S. C. R. 299.

Claim—"The hereinbefore described compound, or composition of matter, consisting of the ingredients mentioned, prepared in the manner and proportion substantially as described, for the purposes set forth."

This is clearly improper, and distinguishable from the case of Tweddle, 1876 C. D. 221. The ingredients are well known and should be specified in the claim. A general reference to the specification is not specifically pointing out the invention claimed.

Williams, 1876 C. D. 227, 10 O. G. 748.

A mere reference to the specification by the terms "Substantially in the manner described" is not "particularly" pointing out and "distinctly" claiming the alleged invention.

Rice, 5 O. G. 552; Shepler, 1903 C. D. 17, 102 O. G. 468; Williams, 1876 C. D. 227, 10 O. G. 748.

The claim "the combination of the window sash and the rubber strips arranged as described" is not ambiguous and is unobjectionable.

McIntire, 1876 C. D. 34, 9 O. G. 300.

Claim "As a new article of manufacture, the petroleum product hereinbefore specified, and having the characteristics described."

This claim is proper because this is one of those anamalous cases in which the nature of the product described does not admit of a more distinct mention in the claim without repeating therein the greater part of the specification. Opinion of General Chemical Examiner.

Tweddle, 1876 C. D. 221, citing 2 Wallace Jr. 365; Moule & Bannehr, 1871 C. D. 87; Arkell, 1871 C. D. 263; Shepler, 1902 C. D. 17, 102 O. G. 468.

A claim for a rake "to gather" or "discharge" the grain construed to be for a rake that would do both in view of the specification which describes such a rake.

Dorsey, 1870 C. D. 17.

It should be remembered that the question is not now before the Office how the specification should be drawn. In that case it might properly be required that all ambiguity should be eliminated.

Dorsey, 1870 C. D. 17.

The practice of allowing claims for inventions which can only be distinguished from those previously invented, or patented by the construction given to such words as "substantially as described," "as herein set forth," etc., can not be too strongly condemned. They are, at best, ambiguous and dangerous phrases and however else they may be used, they must not be employed in the granting of letters patent to make a claim good that without them would be bad and unpatentable.

Rubens & Co., 1869 C. D. 104; Waterman, 1870 C. D. 107; Moule & Bannehr, 1871 C. D. 87.

(7) *Generic and Specific.*

Suppose that elements A, B, and C are each old in several specific forms, but are operative only in the combination A. B, C. An inventor perfects new and useful specific forms of

each *a*, *b*, *c*. The most desirable form of his invention is the combination *a*, *b*, *c*, and this the inventor considers his perfect work; but he may use and is entitled to monopolize one or two of the old forms in combination with two or one of his new forms. He may have, and the proper drafting of his patent will secure for him. a series of combination claims like this (capitals representing generic, lower case, his new specific forms): (1) *a*, *b*, *c*; (2) a, *b*, C; (3) *a*, B, *c*; (4) *a*, B, C; (5) A, *b*, *c*; (6) A, B, *c*; (7) A, *b*, C.

Scaife & Sons Co. v. Falls City Woolen Mills, 209 F. R. 214.

The same invention may be generic to the individuals of its own genus, and specific in its relation to some wider invention representing the group to which itself belongs.

Sec. 535, Robinson on Patents, Vol. 2, p. 151.

The same invention may be generic to the individual of its genus, and specific in relation to some wider invention representing the group to which it belongs.

Rosell v. Allen, 1900 C. D. 333, 92 O. G. 1036.

It is a familiar rule that a generalization or a definition that is too broad can not be made good by making an arbitrary exception of each case that comes within its terms, but should not have been included. A single contrary example destroys the generalization. (Noted from Bell Tel. case.)

A generalization so broad as to cover the prior art must be withdrawn, and a new one made that is narrower and is limited by the point of difference.

United Wireless Tel. Co. v. National E. S. Co., 198 Fed. R. 396.

Where a composition was claimed enumerating a number of constituents, and a large number of equivalents coming under one generic chemical class were mentioned, a generic term might be employed including all such equivalents. *In re* Ellis, 167 O. G. 981. Where only one was mentioned and there was no evidence that the invention was broader the generic term was inadmissible.

Dosselman & Neymann, 167 O. G. 983. See 159 U. S. 465 and 78 F. 910.

Of course, the more logical way would have been to include the genus and its various species in a single patent, avoiding thus what seems to be an unnecessary multiplication of patents. But the rules of the Patent Office do not allow of any such simplification permitting in a single application only a generic and one specific claim. It would be a failure of justice if a meritorious invention should be deprived of the fruits of

his labors because an arbitrary rule of the Patent Office has brought about complications not contemplated if authority can be found for securing it to him. Such authority is not wanting in this circuit. (52 F. 137; 71 F. 396; 82 F. 461.)

Badische Anilin & Soda Fabrik v. A. Klepstein & Co., 125 O. G. 554.

Where a set of claims can be based upon one specific product, there is no reason why they should not be permitted to remain in the same application. Chemical claims. Good example of a generic, sub-generic and specified claims.

Gaesmann, 1900 C. D. 20, 90 O. G. 959.

Doubted if the doctrine of genus and species as affecting articles of manufacture can properly be applied to combinations and sub-combinations growing out of the general structure.

Freese, 1880 C. D. 133, 17 O. G. 1095.

A genus is defined at "A precisely defined and exactly divided class" and as "An assemblage of species possessing in certain characters in common."

Kent, 1880 C. D. 115, 17 O. G. 686.

In a claim for a genus the characteristics common to the species of that genus must be pointed out.

Kent, 1880 C. D. 115, 17 O. G. 686.

When the different forms are such that the substitution of one for the other involves invention, the differences are patentable, and the several forms constitute different species of the genus. When the substitution of one for the other involves no invention, but only mechanical skill, the differences are not patentable, and the forms are all modifications of a single species.

Kook, 1879 C. D. 202, 16 O. G. 543; Cowper, 1879 C. D. 194, 16 O. G. 499; Morrison, 1879 C. D. 169, 16 O. G. 359.

A generic claim and one specific claim may be had in one application, but no more than one specific claim.

Cowper, 1879 C. D. 194, 16 O. G. 499; Morrison, 1879 C. D. 169, 16 O. G. 359; Heaton, 1879 C. D. 95, 15 O. G. 1054; Smith, 1879 C. D. 137; Eagle, 1870 C. D. 137.

A so-called mechanical process—that is to say a process which depends upon some mechanism in the practice of it—must amount to a new way of using an old machine, to be patentable.

Dailey, 1878 C. D. 3, 13 O. G. 228.

In addition to a generic claim, one who has invented the

genus way, under the established practice of the Office, claim one particular species illustrative, or typical, of the genus.

Kent, 1880 C. D. 115, 17 O. G. 686; Walsh v. Shinn, 1879 C. D. 279, 16 O. G. 1006; Cowper, 1879 C. D. 194, 16 O. G. 499; Ewart, 1880 C. D. 78, 9 O. G. 1038.

A generic claim and one specific claim may be had in one application, but no more than one specific claim.

Smith, 1879 C. D. 216, 16 O. G. 630; Eagle, 1870 C. D. 137; Cowper, 1879 C. D. 194, 16 O. G. 499; Morrison, 1879 C. D. 169, 16 O. G. 359; Heaton, 1879 C. D. 95, 15 O. G. 1054.

A specific claim is a bar to the grant of a generic claim for the same subject matter in a subsequent patent.

Atwood, 1869 C. D. 98; Lowe, 1870 C. D. 39; Hyde, 1871 C. D. 109; Holt, 1884 C. D. 43, 29 O. G. 177.

(8) *Combination.*

Invention of a combination does not lie in gathering up the elements that are employed, but consists in first perceiving that a new and desirable result might be attained by bringing about a relationship of elements which no one has before perceived and then going forth to find the things that may be utilized in the new required relationship.

Railroad Supply Co. v. Hart Steel Co., 217 O. G. 704.

We are not impressed with applicant's claims of aggregation as applied to claims 14 and 17; in our judgment the parts co-operate to produce an improved furnace and are therefore properly treated as a combination.

Masonic Fraternity Temple Ass'n v. Murphy Iron Works, 215 F. R. 590-594.

The record satisfies us that the combination in the exact form described in the patent would throw the coal to the ends of the cars, was practical and useful, and that the utility and success of the commercial combination is attributable to C's discovery or invention of the mode of operation and combination, and not to the slight change in form of the top of his carrier to which he was not limited by his specification or claims.

Ottumwa Box Car Loader Co. v. Christy Box Car Loader Co., 209 O. G. 683.

Obviously if the new element coacts with the other elements in a different manner from the corresponding elements of the old combination, and a new result is obtained thereby, a new and patentable combination may be made.

Mumford, 206 O. G. 878.

The word is used in two senses, one involving a consideration of the previous art (cases) another ("which in the interest of accurate terminology, might well be taken as the exclusive sense") aggregation means that the claims, in and of themselves, independently of the prior art, show the elements are incapable of coacting to produce a unitary result.

Krell Auto Grand Piano Co., etc., v. Story & Clark Co., 206 O. G. 313.

An aggregation (independent of the Act) is proper where there is no direct coaction between the elements, and where the only coaction comes through the mediation of the operator (or what seems to us the same, the mediation of the thing or material operated upon).

Krell Auto Grand Piano Co., etc., v. Story & Clark Co., 206 O. G. 313.

The color is non-functional.

Coca Cola Co. v. Goy Ala Co., 200 F. R. 724.

Two of the elements seem to have been merged into one, with an omission of the function upon which patentability depended. No infringement.

Star Bucket Paint Co. v. Butler Mfg. Co., 198 Fed. R. 857.

No new or novel means for making paper are claimed. The old means are employed; but the arrangement of these means while paper making is going on is different, not with relation to each other, but with relation to the "stock" discharged on the screen, and then the speed of the screen with relation to the speed of flow of the stock is regulated.

Eibel Process Co. v. Remington Martin Co., 197 F. R. 762.

It must be conceded that in the last analysis the patent does not do much more than move signals from one place to another without changing their function, but in doing this a real contribution has been made to the art, and a contribution I think of considerable value, each part has been made *more effective to accomplish the common object*, and in which the increased efficiency is due to the new relation. Proper combination.

Burdett-Rowntree Mfg. Co. v. Standard Plunger Elevator Co., 196 F. R. 43.

It is true that the two devices do not act simultaneously, but they co-operate with respect to the work to be done, and in furtherance of it.

Westinghouse Electric & Mfg. Co. v. Condit E. Mfg. Co., 194 F. R. 438.

Claims 3, 4 and 5 are also void, because they cover only aggregations of machines operating successively and independently, and do not embody patentable combinations.

Loggiet Puget Sound Mills, 194 F. R. 164.

Apparently conceded that the material acted upon could not be an element of a combination.

Union Paper Bag Mach. Co. v. Advance Bag Co., 194 F. R. 139.

It was finally held on appeal that, as an apparatus for storing and distributing acetylene gas, the solvent, with supersaturated solution of acetylene, might constitute an element of the combination, and a claim was suggested by the board, which is claim of the patent in suit.

Acme Acetylene Appliance Co. v. Commercial Acetylene Co., 192 F. R. 321.

S's device was novel and patentable, for while the desirability of insulating the inside of a socket was recognized, while the use of insulating material retained in place by its yielding nature in other portions of a socket was common, and while it was known in the bottle-stopping art that a yielding lining material could be sprung into the interior of a stopper and there retained, yet the existence of these elements in severalty suggested to no one their combined use to fill a recognized want in electric lighting.

Freeman Electric Co. v. General Electric Co., 191 F. R. 168-169.

The fact that there is novelty in one of the elements, as in the present case in the change in the plane of the nozzle pivot, does not justify a claim to the combination of the elements, unless there is coaction between them to produce a new result.

Pelton Water Wheel Co. v. Doble, 190 F. R. 765.

It is generally sufficient if there be such coaction that a result is produced which is new, and the result is new and substantially a better result than has been accomplished by other combinations. (Loom Co. v. Higgins, 105 W. S. 580.)

Pelton Water Wheel Co. v. Doble, 190 F. R. 760.

The inventive act in a combination patent is the making of the component parts, capable of combination, and fit to be united to constitute the combination. The physical putting together of the two parts is no part of the invention.

Kreplik v. Couch Patents Co., 190 F. R. 567-568.

The defendant apparently has in its machine at all times a pair of upper pressers. It sometimes uses three upper

pressers, but when it uses three, of course, it uses a pair as part of the three.

Labombarde v. Lord Baltimore Press, 190 F. R. 187.

If the plaintiff were the first to put them together to produce a useful result, and his putting them together involved invention, no one else has the right to put the old things together in plaintiff's way to do plaintiff's work. If he can do such work without using some one of the elements which go to make up plaintiff's combination, plaintiff can not complain.

Labombard v. Lord Baltimore Press, 190 F. R. 186.

It is so generally the practice of patent solicitors to draw claims for an invention as applied to its most important use, and to file combination claims which cover the invention in a special field of application, that the doctrine of "aggregation" should not be applied to defeat this claim merely because it includes a gas product and a gas bench, with retorts heated by the combustion of a gas generated by the producer, as well as Doherty's new regulating means, whereby the producer gas is generated more economically, and thus the illuminating gas is more cheaply generated from the retorts.

Combustion Utilities Corp. v. Worcester Gaslight Co., 190 F. R. 161-162.

He did not invent the combination. He invented, if he invented anything, an improved grab-hook.

The combination claim is not good because one of its elements is an invention in itself.

Langans v. Warren Axe & Tool Co., 166 O. G. 986.

See 190 F. R. 161-162.

Where a combination of elements is old, claims to that combination should not be allowed, whether they state the elements of the combination broadly or specifically, unless the specific form of the elements themselves enter into the combination to produce a new result.

Baker, 183 O. G. 505.

The patentee is not confined to his combination claims unless all of the elements are old. If any of the elements are new and useful, and show invention, these may be claimed and patented. This may be done in a separate or by separate and distinct claims in the patent covering the combination, even though such parts are without utility save in combination with the other parts of the device. (Quotes authorities.)

The purchaser has the right to the full enjoyment of his purchase, and an implied license to make repairs even to re-

storing a part unless such part is made the subject of a patented change (authorities).

National M. Casting Co. v. Amer. Steel Foundries, 182 F. R. 639-640.

The law is well settled that every part of the combination claimed is conclusively presumed to be material to the combination. No evidence to the contrary is admissible. (Walker, § 349; Hubbell v. U. S., 179 W. S. 82, 21 Sup. Ct. 24; 7 L. L. Ed. 98.)

Automatic Switch Co. v. Monitor Mfg. Co., 180 F. R. 988.

While there is not a new mode of operation, except the feature of the dash-pot, nor a new result, yet the old result is attained in a more beneficial and efficient way.

Toledo Computing Scale Co. v. Moneywcight S. Co., 178 F. R. 563.

While it is true that in the invention defined by the appealed claim the appellant has used features of construction which are independently old, as shown in the three patents cited, yet it is apparent that the appellant has brought these elements together in one practical device, so that they are made to cooperate one with another to produce a new and useful result patentable.

Armstrong, 172 O. G. 259.

A combination claim may not be construed as a good claim to one of its elements.

Langan v. Warren Axe & Tool Co., 166 O. G. 986.

A number of the elements of this combination are undoubtedly old, but by means of its compact unitary structure and easy accessibility for purposes of inspection and repair and other advantages, it has achieved a result which entitled it to be characterized as an advance in the art for which patentability was properly claimed.

Lasher v. Barrett, 166 O. G. 751.

He is not entitled to a new combination merely because he has improved a single element of that combination. (In re McNeil, 20 App. D. C. 294.) He has improved an element of but has not made a new combination.

Ratican, 162 O. G. 540-541.

Though the combination of old elements in appellants' structure is undoubtedly an improvement over the prior art, and probably has resulted in the production of a stronger and more durable locker, and one of easier construction than before existed, it is well settled that mere aggregation, when the

result is but a combination of the known functions of the various parts, is not invention.

Hailes v. Van Warmer, 20 Wall 353; James Spear Stove & Heating Co. v. Kelsey Heating Co., 158 Fed. R. 622; *In re* Davenport, 23 App. D. C. 370.

The contention that the patent calls for an aggregation of elements can not be sustained. The rule has been much modified in later years, and it is no longer held that in order to constitute a valid combination patent, each element must directly coact upon each of the others to produce the result. Where all are necessary to produce the desired end, a combination may be implied. (Cases) 53 F. R. 367-371; 63 F. R. 582; Walker on Patents, S. 32.

Dayton Malleable Iron Co. v. Forster, Waterbury Co., 153 F. R. 201.

Taking the whole pin-setter into consideration, I am of the opinion that it was possessed of patentable novelty of a low order, to be sure, but appreciable—and that such novelty could not be and was not in any way to be found in the mere form of apparatus for standing the pins upright in the openings of the pin-setting rack at any time.

Brunswick-Balke-Collender Co. v. Backus Automatic Pin Setter Co., 153 F. R. 288. See *per contra* Wells v. Scranton Cold Storage & Warehouse Co., 153 O. G. 181.

A combination of three wheels, one of which is entirely dispensable, is not an infringement of a patent on a three-wheeled combination, no one of which can be dispensed with.

Columbia Wire Co. v. Kokomo Steel & Wire Co., 139 F. R. 578.

There is no cooperation between the alarm and the specific form of the means employed to actuate the engine-stopping mechanism.

Adams, 111 O. G. 1623.

It is not necessary in a new combination of old elements that each element should modify or change the mode of operation of all the others, but only that the combination should produce a new and useful result as a product of the combination. (Indicator & Casing.)

McCormick v. Robinson, 1906 C. D. 416, 124 O. G. 2903.

A new part does not confer patentability upon an alleged combination claim, in which it appears as an element when such part acts in its own appointed way, performing its function in the combination irrespective of the other. (In re McNeill, 20 App. D. C. 294-297.)

In re Hawley, 1906 C. D. 576, 121 O. G. 691.

In a time-lock safe doors a combination which makes no provision for automatically locking the door when closed, is inoperative.

Sargent v. Burge, 1877 C. D. 62, 11 O. G. 1055.

A claim for a machine or for a combination of mechanical devices is not invalid or insufficient because it fails to include mechanical devices for uniting or operating the machine or combination which readily suggest themselves to a mechanic skilled in the art, or which are pointed out in the specification and drawings as means for the purpose.

Bramer v. Schroeder, 106 F. R. 918.

All ingredients specified in a claim to composition are thereby made essential in analogy to combination claims.

Ct. of Apps. D. of C. Lane v. Levi, 1903 C. D. 601, 104 O. G. 1898.

A combination claim seems to have been held to be infringed by a device which omitted one of the specific elements but retained the function thereof.

McSherry Mfg. Co. v. Dowagiac Mfg. Co., 101 F. R. 716.

A claim having an "oscillating tub" as an element is substantially different from one having a "tub" without limitation.

Casler, 1902 C. D. 292, 100 O. G. 1330.

In an electric elevator system, the combination with a motor-supply circuit and contact blades and terminals for closing and opening the same of an armature-circuit arranged to remain closed until after said contact-blades have been brought to and past the stop position.

Claim not found objectionable, but limited to locality and not time by the history of the case.

Automatic Switch Co. v. Monitor Mfg. Co., 80 F. R. 988.

The coiling device being merely an element of a combination and not claimed as new *per se*, it may properly be presented in terms broad enough to cover all forms of coiling device shown and described and all other known devices for performing the same function.

Baackes, 1893 C. D. 70, 63 O. G. 909.

Where there are claims which severally cover substantially the whole mechanism comprised in the invention, or a combination of several partially independent but co-operating parts of the same, and other claims, each covering a part or sub-mechanism, division will not be required unless the particular part or sub-mechanism in question is capable of

use in other relations and has acquired a distinct status in the arts.

Hine, 1892 C. D. 11, 58 O. G. 385.

It is well settled that it is not necessary to include in a claim for a combination, as elements thereof, all parts of the machine which are necessary to its action, save as they may be understood as entering into the method of combining and arranging the elements of the combination.

Kitson, 1881 C. D. 49, 20 O. G. 1750; Skinner, 1881 C. D. 12, 19 O. G. 662.

No element will be "read in" to a claim in order to limit its scope.

Holley v. Vergennes Machine Co., 1880 C. D. 659, 18 O. G. 1177; National Car Brake Shoe Co. v. Lake Shore R. R., 1880 C. D. 664, 18 O. G. 1179.

The absence of the operating device is not fatal to any combination. A combination is patentable when it takes up a result, or effect, produced by any other part of the mechanism and impresses upon that result a new character, or form, or adds to it a new result.

Banks v. Snediker, 1880 C. D. 95, 17 O. G. 508; Kent, 1871 C. D. 301; Barcellos, 1880 C. D. 4, 17 O. G. 110; Franklin, 1873 C. D. 116, 4 O. G. 105; McMurray, 1875 C. D. 134, 8 O. G. 943; Wilder, 1871 C. D. 125.

A combination of five elements will anticipate a combination of six including the five and producing the same effect, but the reverse is not true.

Banks v. Snediker, 1880 C. D. 95, 17 O. G. 508.

What is auxiliary and may be dispensed with can not be claimed.

Wheat, 1879 C. D. 170, 16 O. G. 360.

It is no objection to a combination claim that the parts are all cast together.

Bland, 1879 C. D. 40, 15 O. G. 828.

In a combination, the elements composing the same should cooperate to produce a common result.

Lee, 1879 C. D. 12, 15 O. G. 512.

A combination of distinct organisms is patentable.

Scott v. Ford, 1878 C. D. 106, 14 O. G. 413.

If the parts do not cooperate it is an aggregation and not patentable.

Flagg, 1870 C. D. 104; Wagenen, 1872 C. D. 15; Campbell, 1878 C. D. 88.

A combination claim for "A combined instrument which

use certain parts in common," is proper.

Sherman, 1875 C. D. 60, 7 O. G. 1054; Lehman, 1870 C. D. 70.

No ambiguity arises by the omission of an element from specific mention in a claim, which element may be omitted from the combination, and such a claim is not inoperative.

McMurray, 1875 C. D. 134, 8 O. G. 943; Farrow, 1872 C. D. 148, 2 O. G. 57; Rheutan, 1874 C. D. 51, 5 O. G. 521.

A claim may be sometimes made in the collection of machines, or devices, which do not in any sense cooperate in what may be strictly called their action.

Sherman, 1875 C. D. 60, 7 O. G. 1054.

The result or effect is the proper test of the validity of a combination. If the parts do not coact in producing a result it is not a proper combination.

Lenes Vernon and Holden, 1873 C. D. 165, 4 O. G. 582; Hooper, 1874 C. D. 91, 6 O. G. 360.

Where the elements cooperate to form a locking device a combination claim is proper.

Farrow, 1872 C. D. 148, 2 O. G. 57.

A legitimate combination claim which has only recently been recognized is where several devices are brought together but produce no new operation by that means, yet the combination embraces some lement which is new in itself and gives the whole a new effect, and is thereby rendered patentable.

Baker, 1873 C. D. 127.

To form a proper combination it is only necessary that each device shall fill a necessary office, and act a necessary part in producing the result. They may act simultaneously or successively. Neither is it necessary that the parts of the combination shall be connected together by operating mechanism.

Eynon, 1871 C. D. 239; Lynch & Ralf v. Dryden & Underwood, 1873 C. D. 73, 3 O. G. 407; Sol Kuh, 1876 C. D. 190.

The claim should specify by some form of language the elements entering into the actual combination.

Duckworth, 1870 C. D. 150.

An arithmetical combination is not necessarily a combination within the meaning of the patent law.

Underwood, 1870 C. D. 52; Webster, 1869 C. D. 9; Smith, 1874 C. D. 99, 6 O. G. 470.

There is a class of combinations into which patented improvements may enter as elements and of which they may form legitimate members. Such cases are those in which the patented device is itself improved, or made more effective by

the combination, or in which a new whole is produced by the union, or in which the combination does not lie in the legitimate and ordinary use of the patented improvement, but is so far out of the track of it as not to be obviously suggested by it, or in which the additional element is itself new, and could not have been in the contemplation of the patentee, among the modes of using, or applying his improvement.

Rubens & Co., Assignees, 1870 C. D. 49.

The words "connecting mechanism" required to be inserted in a combination claim.

Thorne, 1869 C. D. 76.

The correct rule as regards combinations would seem to be that the parts must necessarily be specified only up to that point beyond which the presence of the parts not named will be presumed as a matter of course, by reason of the known state of the art, or from the very necessities of the case.

Wilder, 1871 C. D. 125; Kent, 1871 C. D. 301. See also cases of McMurray, 1875 C. D. 134, 8 O. G. 943; Farrow, 1872 C. D. 148, 2 O. G. 57; Thorne, 1869 C. D. 76.

In re Thomson; 1906 C. D. 566, 120 O. G. 2756.

A legitimate combination may be claimed which includes an element not shown or specifically described in the specification and drawings.

Rubens & Co., Assignees, etc., 1870 C. D. 49.

(7) *Elements.*

The Office is no more competent than the courts to say that an element which an applicant has placed in his claims is an immaterial one. (Streta v. Freckleton, 87 O. G. 695.)

Collom v. Thurman, 131 O. G. 359.

No valid reason is apparent why the actuating connection and one of its elements should not be independently recited in the claim. The function of said element is distinct from that of the actuating mechanism.

Duncan, Prichard and Macauley, 1906 C. D. 348, 124 O. G. 1207.

A description of an element that necessarily confines it to a certain locality, limits the claim to elements having that location seemingly.

Annand v. Spalckhaver, 1901 C. D. 212, 97 O. G. 2083.

The man skilled in the art would not have found in that art anything which would have told him precisely what that length of wire should be. The claims does not give any formula for determining what it should be, and if the specifi-

cation were equally silent there might be some question as to whether Stanley had really contributed anything of importance to the art, certainly it would yet remain for others to inform the art just how to find out a length which would operate as indicated in the claim. But when the patentee enumerates in his claim as one element of his combination a wire. It is not believed to be proper practice for the Office to give its sanction to a statement in the claims intended merely to define its scope..

Schwietzer, 1901 C. D. 179, 97 O. G. 1372.

Combination element.

Porter v. Loreden, 1895 C. D. 707, 73 O. G. 1551.

A combination claim including the subject operated upon with the machine operating upon it is inappropriate as is also a combination including the operating mechanism, the machinery operating, and the subject operated upon.

Franklin, 1873 C. D. 116, 4 O. G. 105.

(10) *Reference Letters.*

The claims are lettered, and while such claims do not necessarily, and in all cases, prevent an invocation and application of the doctrine of equivalents, still as a general rule they are deemed restrictive. It depends upon the state of the art.

Washburn v. Consolidated Safety Pin Co., 197 Fed. R. 556.

A claim including as an element "a tooth 5" construed to be limited to a tooth located on a rib as the tooth 5 was.

The claim could not have been sustained unless the rib was included.

Irvington Mfg. Co. v. Utica Drop Forge & Tool Co., 191 F. R. 169.

The use of reference letters does not necessarily confine a claim to a part having all the characteristics of the part, in the drawings, as indicated by that letter or numeral, because a claim which expressly covers a particular device impliedly covers any equivalent of that device. Walker on Patents (4th Ed.) pp. 101-102. The breadth or narrowness of a claim as the case may be, does not depend upon any artificial rule of interpretation, and to narrow a broad invention by reference letters or numerals alone, would be to frame and enforce such a rule. Walker on Patents, 117, and cases there cited.

Electric Candy Machine Co. v. Morris, 156 F. R. 974.

The use of reference letters in the claim does not necessarily limit the inventor to the exact form or configuration of parts which is thus portrayed and described, without re-

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gard to possible equivalents thereto. It may, or it may not, according to circumstances, as the authorities abundantly show. Reed v. Chase, 25 F. R. 94; Delemator v. Heath, 58 F. R. 414; Campbell Printing Press v. Marden, 64 F. R. 782; McCormick Harvesting Machine Co. v. Aultman, 69 F. R. 371-393; Muller v. Tool Co., 77 F. R. 621; Kelsey Heating Co. v. Spear Stove Co., 155 F. R. 980; Sprinkler Co. v. Koehler, 82 F. R. 428-431; Ross Mfg. Co. v. Randall, 104 Fed. R. 355; National Brake Beam Co. v. Interchangeable Brake Beam Co., 106 Fed. R. 715. Nor are the cases which are sometimes cited to the contrary (Weir v. Morden, 125 U. S. 98; Hendy v. Miners Iron Works, 127 U. S. 370; Lehigh Valley R. R. v. Kearney, 58 U. S. 461) to be differently understood. It is after all a matter of construction, in which while a reference by letters to the drawings and specifications may be regarded as a rule. as involving a greater particularity of description than without them the real scope of the invention is nevertheless to be considered and given due weight. No doubt there are cases where, by reasons of the limitations imposed by the prior art, it is necessary, in order to distinguish and save the invention, to confine it to a certain form or arrangement of parts, which the use of reference letters may effectively serve to do. But where no such necessity exists, the patent is to be taken as a whole in which the reference to the drawings merely goes in with the rest.

Kelsey Heating Co. v. James Spear Stove & H. Co., 155 F. R. 980-981.

If a patentee acquiesces in the limitations suggested by the Patent Office, and the essential elements of the claim are alluded to by reference letters indicating that the Patent Office intended to restrict the claim to the particular device described, a claim to a broader scope can not be maintained.

Good Form Mfg. Co. v. White, 153 F. R. 759.

Letters of reference do not restrict claim to the specific form.

Hall, Hollow Brake Beam Co. v. Interchangeable Brake Beam Co., 1897 C. D. 739, 106 O. G. 693.

Reference letters in claims.

Ross-Moyer Mfg. Co. v. Randall, 104 F. R. 355.

Reference letters used in claim.

McCormick Harvesting Machine Co. v. Aultman & Co., 1895 C. D. 754, 73 O. G. 1999; Perrin v. Manhattan R. R., 1893 C. D. 212, 62 O. G. 1209; Parry Co. v. Hitchcock Co., 1893 C. D. 463, 64 O. G. 860.

It is difficult to see how the applicant could have been more explicit without specifying all the parts by letters.

Shippen, 1895 C. D. 126, 80 O. G. 727.

The substitution of letters of reference for the proper verbal description may tend to render a claim ambiguous, never more exact, while with the proper description in words their use becomes altogether unnecessary.

Parker, 1871 C. D. 293.

A claim relying on the use of reference letters to indicate structure is vague, indefinite, and does not convey an intelligible idea.

Thomas, 15 Gourick's Digest 38-18, May, 1903.

A claim relying on the use of reference letters to indicate structure is vague, indefinite, and does not convey an intelligible idea.

Thomas, 15 Gourick's Digest 38-18, May, 1903.

(11) *Multiplicity of Claims.*

See paper upon this subject read before the Examining Corps of the U. S. Patent Office, Nov. 16, 1916, by William R. Pratt.

Applicant can not be permitted to multiply his claims by presenting alleged combinations which distinguish from the real invention only by including elements which are old in the art and perform no new function.

Whitelaw, 219 O. G. 1237.

Scale case, see Standard Typewriter Co. v. Standard Folding, etc., 219 O. G. 269.

"Means for maintaining said carrier and pattern in parallelism with themselves." The defendants have no such means. Their machine is equipped with the pegs or dowel pins of the old art, instead of the V-shaped guide bars which constitute the complainant's means for maintaining the parallelism referred to and these pegs or pins do not prevent tilting of the plate as it is drawn, no infringement.

Tabor Mfg. Co. v. Mumford Co., 191 F. R. 160.

The consideration of the merits of the applicant's alleged novel combination was embarrassed, and possibly prejudiced, by the great number of claims presented and insisted upon throughout the proceedings in the Patent Office.

Thomson, 1906 C. D. 566, 120 O. G. 2756.

Multiplication of claims not permitted as it imposes a needless burden upon the Office and may lead to a strict construction of the patent.

Chapman, 1906 C. D. 79, 120 O. G. 2446.

It is clearly the duty of this Office to see that patents do not issue with claims so multiplied as to embarrass and confuse the public. It should allow sufficient claims to amply protect the real invention, but should not permit needless repetition.

Both, 182 O. G. 974; Chapman, 120 O. G. 446.

But the only valid objection to a multiplication of claims is when it appears that the applicant is trying deceitfully to go beyond the fair scope of his invention.

There is nothing improper so far as I can see, in first putting your claims as broadly in good faith as you can, and then *ex abundante Cauteli,* following them with narrower claims designed to protect you against possible anticipations of which you are not aware.

No one can know in advance how far anticipation will go or how little in the end his patent will cover.

Parke-Davis & Co. v. H. K. Mulford Co., 189 F. R. 102.

It must differ from each of the rejected claims in other respects than in form since if there is no difference in substance there is no justification for retaining both claims.

Said of a claim presented for appeal under Rule 68.

Wirt, 1905 C. D. 247, 117 O. G. 599-600.

The practice of unduly multiplying claims is to be condemned; but on the other hand, an applicant should be given a reasonable latitude in presenting claims in order that he may not be deprived of his right to adequately cover his invention.

Massie, 1904 C. D. 567, 113 O. G. 2505.

The claims should not be unnecessarily multiplied.

Carpenter, 1904 C. D. 669, 112 O. G. 503.

If claims are needlessly multiplied the Office should reject all except those necessary to define the subject matter.

Johnson, 1891 C. D. 16, 54 O. G. 505.

A repetition of a claim is proper in cases which are difficult of definition, and where one set or form of words would be inadequate to clearly cover the invention and prevent misconstruction, or where the applicant can not set forth in a single claim the device broadly, so that it will cover all other devices which are equivalents at the same time the specific device he has invented and described.

Woodruff, 1880 C. D. 90, 17 O. G. 453.

Repetition of claims.

See Bland, 1879 C. D. 40, 15 O. G. 828.

(12) *Means, Mechanism, Etc.*

Its definition has been settled by this court in the case of Lecoroix v. Tyberg, 33 App. D. C. 586, 150 O. G. 267.

Johnson v. Martin, 201 O. G. 267.

He described and claims means; but this did not exclude others from devising and obtaining a patent for means to accomplish the same result, keeping the light-emitting part of an arc-lamp globe clean and clear of deposits, provided they devised different means, however much simplified, not within the range of equivalents for those described and claimed.

Loraine Development Co. v. General Electric Co., 198 F. R. 115.

The unqualified terms "cutters" "means for reciprocating one of said parts with respect to the other" and a "mechanism for finding" said cutters, elements of claim 2, are limited to cutters which reciprocate in their operation on a lead blank as distinguished from a constant relation of the cutters in the same direction, and to a feeding mechanism consisting of a feed screw for moving cutters toward each other.

Electric Storage Battery Co. v. Gould Storage Battery Co., 197 Fed. R. 750.

It is well settled that means accompanied by a statement of function is a proper way to cover one element of a combination.

Williams, 183 O. G. 504.

In view of the fact that the Priest patent ties the patent down to means for automatically supporting the latch, and as the defendants have ignored the means of the other patent and means working on a different principle and adopted other radically different means, I think the defendants do not infringe.

General Electric Co. v. Altes Chambers Co., 171 O. G. 620. See case in Court of Appeals, 178 F. R. 273.

A device using substantially a different means held not infringing.

General Electric Co. v. Allis-Chalmers Co., 178 F. R. 273. See also, Curtain Supply Co. v. National Lock Washer Co., 178 F. R. 95.

It may be permissible at times to claim, as an element of a combination "means" otherwise unspecified, for effecting a certain mechanical result, this being particularly the case in inventions of a broad and primary character. But without undertaking to decide just when it may and may not be employed, it is enough to say that, for the reasons given, it is not a sufficient assignation here.

Eastern Dynamite Co. v. Keystone Powder Mfg. Co., 164 F. R. 59.

Claims. Means, etc.

Lacroix v. Tyberg, 150 O. G. 266.

The distinction between a practically operative mechanism and its function is said to be difficult to define. (Rob. Pat's, sec 144 et seq.) It becomes more difficult when a definition is attempted of a function of an element of a combination which are the means by which other elements are connected and by which they coact and make complete and efficient the invention. But abstractions need not engage us. The claim is not for a function, but for mechanical means to bring into working relation the folding-plate and the cylinder. This relation is the very essence of the invention, and marks the advance upon the prior art. It is the thing which has never been done before.

Continental Paper Bag Co. v. Eastern Paper Bag Co., 136 O. G. 1297.

The use of the word *Means* limited by a statement of function has long been recognized as a proper method of stating an element of a combination claim (Cases cited).

Young v. Eick, 1904 C. D. 465, 113 O. G. 547.

An example of a claim limited by mechanical construction that seems to me only expressible properly by its function.

Macdonald v. Eeison, 1902 C. D. 243, 105 O. G. 973.

Claims containing the term "mechanism" limited only by the functions which such mechanism performs, to designate the specific device and equivalents thereof which the applicant has grouped together as the elements of his combination, have of late been uniformly held to be in proper form.

Halfpenny, 1895 C. D. 91, 73 O. G. 1135.

Claims which define the construction as "means," "mechanism" or "devices" for effecting certain results or define certain named elements or the device by statement of function instead of structure should be objected to if vague or indefinite or rejected on references disclosing the combination and the functional qualifications of both.

Knudsen, 1895 C. D. 29, 72 O. G. 589.

Where the words "means" was employed to set forth functions and contained no limitation with respect to the construction or mode of operation as distinguished from the result, and it designated that portion of the claim in which the novelty resided, held that such claim was vague and indefinite.

Pacholder, 1890 C. D. 55, 51 O. G. 295.

Where in a claim the language following the words "means" and "mechanism" was employed to set forth function, but contained limiting or qualifying words other than those which set forth the result accomplished. Held that such claim was not vague and indefinite.

Pacholder, 1890 C. D. 55, 51 O. G. 295.

The expression "Means for effecting operating functions in the embroidering machine," the claims containing this expression (operating function) can not be readily understood. If the intention was to limit the claims by the expressions in question merely to an operating element of an embroidering machine, such result should be effected unmistakably by the use of this or equivalent language, but if the intention was that the claims should be limited to a specific element or to an element belonging to a particular class of elements in such machines this intention should likewise be carried out with certainty by the use of unmistakable language.

Groeble, 1905 C. D. 453, 118 O. G. 2537.

An applicant should be allowed to claim his invention as broadly as possible in view of the state of the art. The use of the term "means" with the proper qualifying words, is not prohibited by any decision of the Office or courts.

Weaver, 1897 C. D. 165, 81 O. G. 967.

"Means" followed by a statement of function is properly readable on a structure in which such means consists of more than one element.

Lacroix v. Tybug, 148 O. G. 831.

(13) *Process—Function of a Machine.*

The function of a machine, or the result produced by its operation, is not patentable.

National Hollow Brake Beam Co. v. Interchangeable Brake Beam Co., 1897 C. D. 739, 81 O. G. 1423.

Where the word "Adapted" is used it does not necessarily imply a combination with an element to which the word adapted refers.

Kertey v. Clements, 216 O. G. 1319.

It has long been settled law with respect to machine patents that no patent can validly issue for the mere function or abstract effect of a machine, but only for the mechanism which performs or produces it.

Union Special Mach. Co. v. Singer Mfg. Co., 215 F. R. 598-602.

The patentee could not obtain a valid patent for the mere statement in language of the physical phenomena observable

by the operation and use of the different parts of the device. (Marchane v. Emken, 132 U. S. 195.)

Lovell-M'Connell Mfg. Co. v. Automobile Supply Co., 212 F. R. 204.

It was not necessary that he should have claimed it in specific terms if the device itself disclosed it in Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 W. S. 428, the S. C. said . . . It is no concern of the world whether the principle upon which the new construction acts be obvious or obscure, so that it inheres in the construction.

Horton Mfg. Co. v. White Lily Mfg. Co., 208 O. G. 655.

Although the word "Combustible" has no functional significance still as it tends to more definitely define the invention it is within the discretion of applicant to use it.

Pease, 202 O. G. 631.

3. In a spring-cushion structure, the combination of an upright vertically coiled spring; a strip of sheet metal with inturned opposite edges folded onto and embracing the opposite sides of the bottom coil of said spring, whereby said spring is supported and retained in position.

This does not cover the devices as to its function of acting as a beam to support the spring from vertical movement.

Sheffield Car Co. v. D'Arcy, 194 F. R. 690.

The heater and cooler had been made the subject of an application for a patent. The application for the process was later. No patent shown to have issued on first; but the fact that the applicant claimed the apparatus as an invention is sufficient of itself to eliminate the function or operation of that apparatus from the claim of invention for the process.

W. S. Consol. Raisins Co. v. Selma Fruit Co., 194 F. R. 269-270.

The invention or discovery of a process or method involving mechanical operations and producing a new and useful result may be within the Federal Statutes and entitle the inventor to a patent for his discovery. (Supreme Court of the U. S.)

Expanded Metal Co. v. Bradford and The General Fireproofing Co. v. The Expanded Metal Co., 143 O. G. 863.

One can not describe a machine which will perform a certain function and then claim the function itself, and all other machines that may be invented by others to perform the same function.

Gardner, 140 O. G. 258.

Claim 2—"In a machine for the manufacture of crayons, carpenters' chalk or other like articles, the combination of two

sectional mold plates together forming a complete mold, said mold being open at one end, said mold plates adjustable relative to each other in line with the length of the mold."

The movement of a machine irrespective of the mechanism which causes it can not be patented, it would be virtually giving a patent for the result, regardless of how reached. (The doctrine of equivalents was, however, applied and infringement of other claims was found.)

American Crayon Co. v. Sexton, 139 F. R. 564.

It would seem that a claim that recites a function and some structure, but not enough to support the function, stands on the same footing as a functual claim and should be rejected.

Bitner, 140 O. G. 256.

It is competent, when the circumstances of the case permit of it, for an inventor in describing a machine or apparatus which he has devised to make a claim for a process which his patented device is capable of carrying out. But to entitle him to do this, the process must be one capable of being carried out by other means than by the operation of his patented machine, and unless such other means are known or within the reach of ordinary skill and judgment, the patentee is bound to point out, for unless the public are informed by what other means the process can be carried out, the process is to them nothing else than the operation of the machine, in other words the exercise of its function. The function of a machine is not patentable.

White, 136 O. G. 1771.

Functional claims, that is, claims for a function merely or which fails to include sufficient mechanical elements to effect the function expressed in the claim, are open to objection, and from objection made on such ground petition may be taken to the Commissioner.

On the other hand, claims which while including sufficient mechanical elements to effect a function stated therein, depends upon that statement of function to distinguish them from what is old in the prior art are not to be objected to as functional, but are open to rejection if in the opinion of the Examiner the statement of function is insufficient, the question being a question of merits and not of form.

Flumb, 131 O. G. 1165; citing McMullen, 84 O. C. 507.

The mere function of a machine is not patentable.

Steinmetz, 1905 C. D. 249, 117 O. G. 901; Frasch, 1905 C. D. 264, 117 O. G. 1167.

To merely state in a claim the function or the result without first including therein the structure by means of which the

function or result is obtained renders a claim vague and indefinite.

Kotler, 1901 C. D. 62, 95 O. G. 2684.

Functional claims are: First, those covering a function, result or effect not a product or composition of matter; second, those covering the function of a machine or apparatus; third, those reciting the functions of elements and not their structure; and fourth, those defining sets of mechanism by statements of the results produced. 1st. Should be rejected. 2d. Should be rejected. 3d. Should be objected to if vague or indefinite, otherwise receive action on their merits. 4th. Are bad in form and should be objected to, but should also receive action on their merits.

Knudsen, 1895 C. D. 29, 72 O. G. 589.

A description of the function which a feature performs and the manner of its construction does not render a claim objectional as being functional.

National Car Brake Shoe Co. v. Lake Shore & Mich. Southern R. R. Co., 1880 C. D. 664, 18 O. G. 1179; Keith, 1876 C. D. 93, 9 O. G. 744; Hahn, 1875 C. D. 1078, 8 O. G. 597; Gray, 1877 C. D. 18, 11 O. G. 329; Shippen, 1875 C. D. 126, 8 O. G. 727. See, however, Ives, 1878 C. D. 134, 15 O. G. 385; Scott v. Ford, 1878 C. D. 106, 14 O. G. 413. Claims of this description involved in Sargent v. Hall, etc., Co., 15 A. E. 573; Holley v. Vergennes Co., 1880 C. D. 661, 18 O. G. 1177.

That a claim is purely functional is always a proper objection to it.

Shippen, 1875 C. D. 126, 8 O. G. 727; Harrison, 1876 C. D. 170, 10 O. G. 373; Hicks, 1879 C. D. 200, 16 O. G. 546.

A claim fairly susceptible of an interpretation which renders it functional is inadmissible.

Ives, 1878 C. D. 134, 15 O. G. 385.

A claim to a mechanism having certain capabilities without reference to the mechanism, or instrumentalities whereby those capabilities, or functions, are obtained is bad, unless it be construed to mean the combination of instrumentalities whereby the recited effects or functions, are produced. Good practice requires that the specification and claims in a patent shall mean just what they seem to mean.

Anders v. Gilliland, 1880 C. D. 1, 19 O. G. 177; Arkell, 1871 C. D. 263; Ives, 1878 C. D. 134, 15 O. G. 385.

A claim reciting definitely the article invented, and quali-

fying its structure by describing the function performed is not functional, but an approved form.

Gray, 1877 C. D. 18, 11 O. G. 329; Keith, 1876 C. D. 93, 9 O. G. 744.

The function of a machine is that operation, which when set in motion it inevitable performs.

Shippen, 1875 C. D. 126, 8 O. G. 727.

(14) *Difference in Claims.*

The claims may be to the same thing though this thing was used in quite different devices.

Walker v. Brunhoff, 1905 C. D. 454, 118 O. G. 2537.

A claim stating that a reagent is added during the manufacture of a compound is not a duplicate of a claim in which "during the manufacture of the compound" is omitted.

Reese, 1904 C. D. 484, 113 O. G. 849.

If two claims are only distinguished by the words "substantially as described" one must be cancelled.

Shepler, 1902 C. D. 17, 102 O. G. 468.

Two claims in the same application which differ only in reference letters are so similar as not to be both allowable.

Ex parte Osborn, 1900 C. D. 137, 92 O. G. 1797.

The Office is more liberal in construing the difference between claims in one application than if they were in separate application, both as to the materiality and patentability of those differences.

The tests of patentability are the same in kind but are not so rigidly applied as if the claims were in different applications.

Griffith, 1898 C. D. 233, 85 O. G. 936.

Two claims are not, as a matter of form, substantially alike when corresponding elements are set forth broadly in one and specifically in the other, and when one includes an element neither actually nor impliedly included in the other.

Baackes, 1893 C. D. 70, 63 O. G. 909.

(15) *Indefiniteness, Vagueness.*

Claims for an apparatus which includes among other elements an "arrester," a "mechanical separator," and a "chemical separator," are not vague and indefinite on account of their failure to state the specific characteristics of such elements where the description fully and clearly describes the construction referred to by such terms, the objection going to the breadth or scope of the claims rather than to their form.

Donk, 1905 C. D. 498, 119 O. G. 965.

It is not alleged that the invention can not be fully and readily understood from the present specification, nor does it appear that the claims are rendered indefinite or ambiguous by the word "stretcher" or that the applicant's use of the word is absurd or clearly erroneous. Objection to use of word overruled.

Welch, 1905 C. D. 136, 115 O. G. 1850.

As to indefiniteness of claims, see,

Scott v. Ford, 1878 C. D. 106, 14 O. G. 413.

A claim is improper that refers to a substance as a gas, after it has been liquified, and that makes the process of liquification a part of the process of making the gas. The claim "as an article of manufacture and sale, liquified chloromethyl sulphurous gas in a receiver, substantially as described" is indefinite, as it may mean either the receiver and its contents, or its contents alone.

Du Motay, 1879 C. D. 269, 12 O. G. 1002.

The constructing, etc., is ambiguous.

Cornell, 1872 C. D. 120, 1 O. G. 573.

(16) *Alternative—Modifications—Equivalents.*

If part of a combination is stated to be a square table on four legs, and neither the shape of the table nor the number of legs is a matter of any importance, so long as the table is large enough and is maintained in a horizontal position, a triangular table on 3 legs would be an equivalent of the element specified.

Autopiano Co. v. American Player Action Co., 217 O. G. 1055-6.

The equivalency of other metals with iron is to be found not in their chemical structure, but in their functional efficiency when combined with cerium in a metallic alloy (cases distinguished). If in the claimed scope there is an element not having the function the claim is too broad, etc.

Treibacher v. The Roessteret, 209 O. G. 1689.

Yielding means for forcing rolls together infringed by rolls having yielding surfaces.

Palmer v. Jordan, 192 F. R. 42.

The words "or equivalents" objectionable in claims.

Phillips, 135 O. G. 1801.

Where an applicant employs two terms to designate a particular element, both of which terms describe the element correctly, the claim has been held to be unobjectionable since

the applicants alternativeness is of language rather than of structure (cites Holder, 107 O. G. 833).

Phillips v. Sensenich, 132 O. G. 677.

The range of equivalents depends upon the extent and nature of the invention. If the invention is broad and primary in its character, the range of equivalents will be correspondingly broad under the liberal construction which the courts give to such inventions.

Continental Paper Bag Co. v. Eastern Paper Bag Co., 136 O. G. 1297.

There seems to be no good reason, therefore, why the applicants should not in their claims identify the substance used by a statement of the characteristics necessary. The words "brick or the like" are not a broad statement of the characteristics, but are alternative in form and indefinite in substance.

Caldwell and Barr, 1905 C. D. 58, 120 O. G. 2125.

A mechanical equivalent must be adapted to use as a substitute for something else, and competent to perform the function of a particular device for which it may be substituted. The word "equivalent" means equal in force or effect. 11 Am. & Eng. Enc. Law (2d Ed.) 252.

Alacka Parkers Assn. v. Lelson, 119 F. R. 611.

The maxim "*inumeratio unius exclusio alterius*," by reason of the doctrine of equivalents does not apply as fully to patents as to instruments in general.

Reece Button-Hole Machine Company v. Globe Button-Hole Machine Company, 1894 C. D. 360, 67 O. G. 1720.

In the present case if the applicant desires nothing more than the benefit of the law of equivalents, the expression "or equivalent cleaning device" is surplusage. If he desires some advantage beyond that which the law of equivalents gives him, he is seeking more than can properly be accorded him.

Cook, 1890 C. D. 81, 51 O. G. 1620.

Modification can not be claimed.

Bogart, 1876 C. D. 163, 10 O. G. 113.

A claim having the phrase "one or more" is alternative in form, if the elements covered by such phrase are not duplicates.

Hulbert, 1893 C. D. 74, 63 O. G. 1687; Thorsen, 1893 C. D. 75, 63 O. G. 1688.

Alternative claims and claims for modifications have been repeatedly condemned, the former for uncertainty, the latter for the reason that if the alleged modifications are in fact the same invention, a claim to one obviously covers the other, and

if they are for different inventions they are not allowable in one application.

McDougall, 1880 C. D. 147, 18 O. G. 130; Ried, 1879 C. D. 70, 15 O. G. 882. See Walker on Patents, sec. 176, p. 126.

The word "equivalents" in a claim should be very carefully scrutinized, especially in reissue applications, but it might be admitted if it did not render the claim ambiguous.

Haase, 1873 C. D. 170, 4 O. G. 610.

The words "or their equivalents," when they refer to well defined devices, are not objectionable.

McLelland, 1872 C. D. 152; Continental Windmill Co., 1870 C. D. 74.

(17) *Article of Manufacture.*

A sound record made from a cut laterally undulatory groove diverging from the bottom of the same to the surface of the record tablet..

Victor Talking Machine Co. v. American Graphophone Co., 189 Fed. R. 359-366.

Of course, claims for a product not defined as the product of a process must contain in themselves adequate differentia, or they will not be good.

Parke-Davis & Co. v. H. K. Mulford Co., 189 F. R. 95-102.

As a new product, crystalline calcium carbid existing as masses of aggregated crystals substantially as described. Sustained. But said to be limited to an aggregated crystals. Patentable novelty in a case like the present, may be founded upon superior efficiency; upon superior durability, including the ability to retain a permanent form when exposed to the atmosphere; upon a lesser tendency to breakage and loss; upon purity and in connection with other things, upon comparative cheapness. Commercial success may properly be compared with mere laboratory experiments.

Union Carbide Co. v. American Carbide Co., 160 O. G. 493:

Seems to and does recognize claims for articles defined by the method of making them.

Mosler Safe Co. v. Mosler, 127 U. S. 354.

"The process may be referred to in defining the article only when it can not be otherwise defined." (Apparently *dictum*.)

"The structure of the article when finished does not reveal the particular procedure specified in the claim." Therefore, the claim is improper.

Schreckner, 106 O. G. 765.

If an article of manufacture is a new thing, a useful thing,

and embodies invention, and that article can not be properly defined and discriminated from the prior art otherwise than by reference to the process of producing it, a case is presented which constitutes a proper exception to the rule.

Refers to Globe Nail Co. v. W. S. Horse Nail Co., 19 F. R. 819; Painter, 57 O. G. 999 (approved 106 O. G. 765).

Dental plate made of hard rubber. The material made it possible to make a satisfactory plate as well as contributing by its characteristics to make the completed plate successful.

Smith v. Goodyear, 93 U. S. 486.

A claim for an article defined by the process of making it was rejected for this reason and the rejection affirmed by the Board and the Commissioner returned it to the Primary Examiner for consideration on the merits.

Rogers, 1890 C. D. 121, 52 O. G. 460.

After a patent is granted for an article described as made by causing it to pass through a certain method of operation to produce it, the inventor can not afterwards, on an independent application, secure a patent for the method or process.

Cited from Trevette, 97 O. G. 1174; Mosler Safe & Lock Co. v. Mosler, Bohmann & Co., 43 O. G. 1115.

Risdon Iron & Locomotive Works v. Medart et al., 71 O. G. 751.

A plate or dish cut or scooped from a block of wood in concavo-confix form. Good.

Oval Wood Dish Co. v. Sandy Creek Wood Mfg. Co., 60 F. R. 285.

Said not to be an authority to the effect that an article may never be defined by the process of making it.

Painter, 57 O. G. 1000; Rumford Chemical Works v. Sauer, 10 Blatch 162.

Type-block with letters, figures or characters produced thereon in the manner substantially as described. The article was old, the novelty was in the process entirely. Said not to sustain the proposition that a claim to an article may never be defined and limited by the process of making the article.

Painlir, 57 O. G. 1000; Draper v. Hudson, 6 Fish. 327, 3 O. G. 354.

"Artificial alizarine produced from anthracine or its derivatives by either of the methods herein described, or by any other method which will produce a like result."

If this product is the same as the alizarine obtained from matter it is old; if it is different and is only the product pro-

duced by the process described, it is not shown that defendant has infringed.

Every patent for a product or composition of matter must identify it so that it can be recognized aside from the description of the process of making it, or else nothing can be held to infringe the patent which is not made by that process. Page 817.

Cochrane v. Badische Anilin Co., 27 O. G. 813, 111 U. S. 293-313.

A difference in the physical characteristics of the pulp made by the process was alleged.

It seems to be assumed that if the facts were so, the product of that process would be patentable, but it is said that this was not the fact.

The Wood Paper Patent, 23 Wall. 566.

A nail made by punching or cutting from hot-rolled ribbed bars of metal a headed blank, substantially as described, and by elongating hardening, and compressing the shanks of such blanks by cold-rolling from the head to the point, thereby giving to all parts of the nail so produced the peculiar qualities specified. Good claim, see Painlir *infra.*

Globe Nail Co. v. W. S. Horse Nail Co., 19 F. R. 819.

A valve-cup constructed of or from horn.

"The claim is to be for an article of manufacture; and it will cover the same article whether manufactured by the process described or otherwise."

Shalters, 1879 C. D. 79, 15 O. G. 970.

"Molded in the manner and for the purpose" may mean that a certain process is pursued, or that the artificial charcoal, when completed, is possessed of certain distinguishing characteristics.

In the first case it has nothing to do with the finished product, in the second resort, must be had to the specification and the claims must express their own meaning.

Designolli, 1878 C. D. 10.

An inodorous and waterproof straw plastering board made in continuous lengths and wound in rolls. Reference to process improper.

Judd M. Cobb, 1874 C. D. 60.

The fact that an article is only useful in connection with some other thing does not necessarily make it unpatentable, as incomplete and inoperative. It is patentable if it is capable of separate manufacture and sale.

Johnson, 1880 C. D. 207, 18 O. G. 1052; Blanchard, 1870 C. D. 59.

A stovepipe elbow made from a blank of sheet iron, having a single longitudinal seam and formed without crimping and cutting, this presenting a smooth surface of uniform thickness throughout when finished.

Proper. "The stovepipe elbow in question is to be contemplated independent of any process."

Lupton, 1874 C. D. 40.

Packing composed of canvass strips, preliminarily treated with bees-wax or other lubricant, followed by rubber solution, as described, and then wound spirally in successive, separate, concentric layers on a suitable mandrel or form.

It indirectly indicates its nature by reference to the method or methods employed in its construction, instead of directly setting out the characteristics of the packing itself. This is objectionable because a claim for a manufacture must rest upon the novelty of the product without reference to the "art" employed in its construction.

Mayall, 1873 C. D. 134.

Reference to the process of manufacture in a claim for an article of manufacture is improper.

Sellers, 1872 C. D. 197, 2 O. G. 246; Ackerson, 1869 C. D. 74; Truesdell, 1870 C. D. 123; Designolle, 1878 C. D. 10, 13 O. G. 227; Cobb, 1874 C. D. 60, 5 O. G. 751; Lupton, 1874 C. D. 40, 5 O. G. 751; Shalters, 1879 C. D. 79, 15 O. G. 970. But see Oval Wood Dish Co. v. Sandy Creek Mfg. Co., 60 F. R. 285.

A claim for an article put up for sale is a more convenient form sustained.

Horlick, 1875 C. D. 57; Heide & Wirtz, 1875 C. D. 135, 8 O. G. 817.

An applicant for an article of manufacture is not confined to one claim.

Sumner, 1871 C. D. 180, 3 O. G. 19; Adams, 1873 C. D. 18, 3 O. G. 150.

If an article is capable of use only in connection with a certain machine, if in other words, it is a mere fraction of a machine, it can not be claimed separately as an article of manufacture.

Blanchard, 1870 C. D. 59.

A rolled out column. The process of making did not confer patentability.

Sellers, 1872 C. D. 197.

As the claim is for a car wheel the process of making it, that is, the mode of putting the parts together, can not enter

as an element to qualify the character of the manufactured article.

The distinguishing feature of the article seems to have been anticipated.

Truesdell, 1870 C. D. 123.

(18) *Process—Sub-Process.*

"The three steps to be taken are the 'blowing off,' the 'washing' and 'refilling' processes. Of course, these may be regarded as successive. A structure may have for its purpose the accomplishment of either one alone. But the broad purpose sought to be accomplished does not place any limitation upon the endeavors to incorporate the so-called units into a single structure, seeking thereby to discharge the various functions successively and cooperatively."

Wenstow Co. v. National Boiler, etc., 226 F. R. 954.

The definitive part of claim 5 refers only to an alleged method of producing mechanical motion. It is not contended that this method of producing mechanical motion is novel in and of itself and the patentability of the method could accordingly rest, if at all, only upon the steps by which the mechanical motion is utilized for regulating the generator, which steps are not set forth in this claim.

In re Creveling, 117 O. G. 1167.

The alleged process claims in this case are not patentable in view of a prior patent to the same applicant upon the apparatus disclosed under the particular circumstances of the case.

In re Creveling, 117 O. G. 1167.

Where an alleged process claim includes the step of rotating an armature and concludes "and by said motion in one direction increasing the output of the generator and in the other direction decreasing the said output," but it appears that the result stated is not accomplished by the mere motion of the armature, but by the interposition of a rheostat, held that the claim is not patentable since it does not include all of the steps necessary to effect the result stated or any useful result.

In re Creveling, 1905 C. D. 684, 117 O. G. 1167.

The mere function of a machine is not patentable and claims to it should be rejected; but there seems to be no good reason for requiring division between a machine and the mere function of that machine. Such a relation argues unity rather than diversity of invention.

Steinmetz, 1905 C. D. 249, 117 O. G. 901; Frasch, 1905 C. D. 264, 117 O. G. 1167.

2. The process of preparing oryphenyltartronic acids which

consists in introducing a condensation product of phenol and alloxan into alkali solution and heating the whole.

3. The process of preparing oxyphenyltartronic acids which consists in introducing a condensation product of phenol and alloxan into alkali solution and heating and stirring the whole over a water-bath.

If the only difference between the pair of claims was the mere act of stirring it would not be a substantial one. Heating at a moderate temperature, i. e., over a water bath is, however, a substantial difference and both claims may remain.

Ex parte Ach, 1901 C. D. 140, 96 O. G. 2411.

An applicant may properly in one case have claims covering the principal or essential steps of his process and other claims including those steps together with other specific steps which are not absolutely necessary to the performance of the process, but which add to its efficiency or make its operation more perfect.

Axnard & Baur, 88 O. G. 1527.

Claim 1 of the method patent is for a combination and describes the operation.

Edison v. Allis-Chalmers, 191 Fed. R. 841.

The process is patentable and not the mere function of a machine, although but one apparatus is known or suggested for carrying the process out.

Holt, 1894 C. D. 82, 68 O. G. 536.

Passing upward through falling impurities and flour commingled, a current of air purified by centrifugal action, then subjecting the dust-laden air to centrifugal action, and finally passing the air so purified back to be used again in the same series of steps, all in closed chambers and conducts, constitute a true process.

Holt, 1894 C. D. 82, 68 O. G. 536.

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

Rudd, 1894 C. D. 79, 68 O. G. 535.

Process. Functional claim.

Williams, 1892 C. D. 213, 61 O. G. 423.

A mechanical process that is not patentable.

Jaeger, 1889 C. D. 121, 46 O. G. 1637.

Claim to a mechanical process.

Young, 1889 C. D. 116, 46 O. G. 1635. (See 1892 C. D. 214, 1890 C. D. 165-166.)

To sustain a claim to a mechanical process the steps taken must be novel, and some means must be described by which the process can be carried on.

Tyne, 1880 C. D. 2, 17 O. G. 56.

The question whether a complete process, chemical or mechanical, can be subdivided in an application, and whether, when it is so subdivided, a claim for one of the subdivisions can be joined with a claim for another, or with a claim for the complete process, turns on the question whether such subdivision constitute subprocesses, effecting themselves distinct results subsidiary to the general result of the entire process.

Smith, 16 O. G. 630; McDougall, 1880 C. D. 1407; Dailey, 1878 C. D. 3, 13 O. G. 228; Wheat, 16 O. G. 360; Leoser, 76 C. D. 104, 9 O. G. 837.

Where the operation of a machine, or series of machines, is supplemented by some new method of operation not contemplated in the construction of the machine, and not the inevitable result of its operation, it may amount to a patentable process, even though the operation depends necessarily upon the machinery.

Shippen, 1875 C. D. 126, 8 O. G. 727. See Harrison, 1876 C. D. 170, 10 O. G. 373; Hicks, 1879 C. D. 200, 16 O. G. 546.

Claims for what are called mechanical processes are, in the majority of instances, objectionable, as they are for the function of the machine.

Case v. Hastings, 1875 C. D. 37, 7 O. G. 557.

(19) *Printed Matter.*

A contract unconnected with any tangible device is not a patentable invention.

In re Moeser, 1906 C. D. 685, 123 O. G. 655.

The [illegible] duplication of closures is not patentable.

Seabury, 1903 C. D. 222, 110 O. G. 2013.

Claims for new arrangements of printed matter on tickets, circulars, pads, books, etc., are generally arbitrary in their nature, and due entirely to mere fancy, or simple mechanical skill, and are not proper subjects for patents.

Gerson, 1877 C. D. 19, 11 O. G. 244.

(20) *Introductory Clause.*

The real question here is whether it conduces to a clear and distinct pointing out of the invention, if the "supporting

structure be specified in the form of a preamble sharply separated and distinguished from what is the description of the real invention.

Assistant Commissioner Clay in Ex parte Jepson, 243 O. G. 525.

Forsyth v. Garlock, 142 Fed. Rep. 461, although it was a case unlike the case at bar in that the preamble stated a use and not a supporting structure, yet shows how the preamble of a claim is very properly a part of it for the purpose of stating the use which is part of the invention, even though it does not import any structure into the claim.

Assistant Commissioner Clay in Ex parte Jepson, 243 O. G. 525.

The preamble may be an actual limitation if the real invention can not exist apart from it, whereas if the real invention does not at all depend upon it, then the preamble is a mere explanatory name and title. (A discussion of the whole matter with cases bearing thereon.)

Jepson, 243 O. G. 525-528.

While these words have as a matter of law no real effect at all upon the claim, still they sometimes signify the draughtsman's sense that his terms, while very broad, are to be read upon the actual disclosure.

National Elec. S. Co. v. Tellefunken W. T. Co., 209 F. R. 857.

The introductory clause disregarded and a device held to infringe notwithstanding it did not come within this clause.

Western Electric Co. v. La Rue, 139 U. S. 601.

The preamble to a claim does not render it patentable.

Colts Patent Firearms Mfg. Co. v. Wission, 122 F. R. 95.

The introductory phrase is not an element of the combination and does not limit the claim to such apparatus.

Casler, 1899 C. D. 5, 90 O. G. 448. See also Stearns v. Russell, 85 F. R. 218; Colts Patent Firearm Co. v. Wesson, 122 F. R. 90-94.

Where a claim is drawn to cover a mechanical movement and that claim is amended by inserting at the beginning of the same a descriptive phrase indicating the nature of the machine in which the invention is used. Held that the status of the claim is not changed by such an amendment.

Gally, 1903 C. D. 480, 107 O. G. 1660.

The introductory phrase is not an element of the claim.

Casler, 1899 C. D. 5, 90 O. G. 446.

Where a claim is drawn to cover a mechanical movement and that claim is amended by inserting at the beginning of

the same a descriptive phrase indicating the nature of the machine in which the invention is used. Held that the status of the claim is not changed by such an amendment.

Gally, 1902 C. D. 480, 107 O. G. 1660.

(21) *Expression of Degree in Claims.*

It is not possible when dealing with fractional niceties to use any safer language else the risk is run of escape from the patent by some technical scientific variations.

Vacuum Cleaner Co. v. Am. Rty. Valve Co., 219 O. G. 587. See also Woerheide v. Johns-Manville, 215 F. R. 604; 220 F. R. 674.

It is contended that such expressions as "sufficient abruptness" and "arched transversely" are vague and do not give that information to which the public are entitled.

I can not agree with this contention. It is difficult, if not impossible task, to express "sufficient abruptness" and "arched transversely" in terms of mathematical accuracy.

Woerheide v. H. W. Johns-Manville Co., 215 F. R. 606.

Besides being made of this material the shell is to be relatively to the core inclosed "of such thickness as to give it the required rigidity."

Haskell Golf Ball Co. v. Sporting Goods Sales Co., 210 O. G. 625.

The claims in issue require that the gutter be resilient to a degree such that the resilience performs some useful function in practical use.

Kawner Mfg. Co. v. Ventwill Store Front Co., 210 Fed. R. 459-461. This was said of claims in which the degree was not referred to.

"As a new article of manufacture, a detachable razor blade of such thinness and flexibility as to require external support." This seems to be a good claim.

Clark Blade & Razor Co. v. Gillette Safety Razor Co., 194 Fed. R. 421.

The combination, with a water meter having its chamber-forming case made relatively strong of an inclosing head therefore made relatively weak, whereby to form a yielding part against undue interior pressure. Sustained.

National Meter Co. v. Neptune Meter Co., 122 F. R. 75.

Of a length which will accomplish the result sought to be achieved, and his patent discloses a method for determining that length with mathematical exactness, his claim may fairly be sustained for the length thus shown, although it might be

that some other length covered by the language of the claim, but not of the rule, would fall outside the claim.

Westinghouse Electric & Mfg. Co. v. Orange County Gas & Electric Co., 119 F. R. 365; Vid. 113 F. R. 884.

"Equidistant" and "approximately" read into the claim in view of the function of the machine.

Krajewski v. Pharr, 105 Fed. Rep. 519.

"More or less" in claim approved.

Krajewski v. Pharr, 105 Fed. Rep. 518.

(22) *Process, Combination and Article Claims.*

The claims are all limited to the location of the lower reservoir in a deep pit, it adds nothing to their patentability for it is purely a structural idea and not a process idea. The cycle of operations and the relation of cause and effect in the various steps of the process are exactly the same, whatever the nature of the supports for the water tanks and whatever their location relative to a selected part of the earth's surface. (Court of Appeals quoting the Commissioner.)

In re Fessenden, 226 O. G. 1081.

S. C. U. S.—Fireball Gas Tank & Ill. Co. et al. v. Commercial Accty. Co. et al., 221 O. G. 1039.

"Applicants' invention is of that nature where it is difficult to express the entire invention by the article and it is difficult to express the exact invention by the process."

In such case both forms of claims should be allowed.

Kilbourn, Smith and Kilbourn, 221 O. G. 737.

Whether the invention lies in the apparatus or process is a difficult question from which the applicant should not suffer because of a wrong conclusion.

Edison, 220 O. G. 1373.

The new process clearly does not make new that which was old.

McNeil Ct. of App., 200 O. G. 583.

While it is true that a combination of old steps to produce a new result amounts to invention, yet in this case, so far as we are advised by the record the various steps of the process produce but a combination of known results. This is a mere aggregation.

In re Merrill, 199 O. G. 620.

A claim a decaffinized coffee, the caffein having been removed after the coffee was roasted, anticipated by coffee from which the caffein had been removed before roasting.

The process was patentable but the product was the same thing.

Roselius, 162 O. G. 272.

He did three things, which differentiate his method and the product of it, in three steps which are sequential, the order of which is essential, and all so dependent on each other that none may be omitted without destroying or at least failing to obtain the resultant product.

Farmers Mfg. Co. v. Spruks Mfg. Co., 119 F. R. 597.

Process and product identical in scope. Cases cited and distinguished.

Trevette, 97 O. G. 1174.

If the claims contain limitations, whether proper or improper, which make the alleged process claims indivisible from the apparatus claims division can not be required. A mere mode of operating apparatus can not be regarded as so unrelated to the apparatus itself that division can be required between claims to processes which amount to a mere statement of the former and claims to the latter.

Fraseh, 117 O. G. 1166.

The authority and propriety of the practice of requiring division between inventions found to be independent is too well settled to require rediscussion here. It is sufficient to state that nothing is found in Steinmetz v. Allen, etc., 109 O. G. 549, to make process and apparatus any exception to this practice.

Frasch, 117 O. G. 1166.

Where the article may be made by other methods then the process claims should undoubtedly be allowed.

Kilbourn, Smith, and Kilbourn, 24 O. G. 737.

(23) *Positive Inclusion of Elements of Claims.*

These two elements being separately called for in the claims, can not be the same thing, and the drawing-rolls in defendant's machine being in practically the same form as in the patented machine can not be both the central lower gripper and the mechanism for drawing a fold away from it.

Union Paper Bag Mach. Co. v. Advance Bag Co., 194 F. R. 138.

No valid reason is apparent why the actuating mechanism and one of its elements may not be independently recited.

Duncan, Prichard and Macauley, 124 O. G. 1207-8.

Also Iserman, 188 O. G. 807.

Where claims are clear as to the elements intended to be covered thereby, and the structure is such that it can only be described with clearness by referring to other parts of the

device, there is no objection to wording the claims in this way. Without including such other parts.

Compos, 182 O. G. 719.

The rack is itself the second element of the claim, and can not therefore be the means of the fourth element.

General Electric Co. v. Allis-Chalmers Co., 171 F. R. 668.

It is well settled that where it is necessary to refer to certain elements of an invention in order to locate or define other elements they should be positively included in the claim. (125 O. G. 665.)

Stimpson, 160 O. G. 1271.

(24) *Reading Words, Etc., Into.*

Only when necessary to make the claims operative or in case of ambiguity apparent on the face of the claims, or induced by their study in connection with the specification and prior art, is a court permitted to read in an element not expressly named therein, in order to narrow a claim, so as to make valid one otherwise invalid.

Crown Cork & Seal Co., etc., v. Sterling Cork Co., 218 O. G. 875. Examples and cases—When the claim contained some general term of reference which was capable of being so narrowed by interpretation without importing an element distinctly foreign. 218 O. G. 877.

The intermittency is expressly claimed in most of the claims of the patent, and must be read into the others from the specification, in order to sustain such claims.

American Steel & Wire Co. v. Denning Wire & Fence Co., 194 F. R. 119.

Apparently an element read into a claim from the description of the patent and a device held not to infringe, because it did not include such element.

No disclosure of a device not having this element in the specification.

Edison General Electric Co. v. Crouse-Hinds Electric Co., 152 F. R. 437.

(25) *"Whereby Clause" in Claims and Operative Environment.*

The mounting has nothing to do with the essential invention of the claim, except to provide *an operative environment* and the defendants mounting accomplished the same result. Either one is "suitable."

German v. Youngstown Car Mfg. Co., 191 F. R. 583.

That this "whereby clause" adds nothing to the claim is fundamental. It is a statement of asserted result, not of method or means of reaching it; and in this instance it is but a repetition of the stated "object of the invention" with which the application begins, a sort of a Q. E. D. triumphantly affixed to the asserted solution of the problem.

Electro-Dynamic Co. v. Westinghouse E. & Mfg. Co., 191 F. R. 508.

In the present case the "whereby" clause is so worded that it is uncertain whether applicant is depending for the patentability of the claim upon the structure of the relay as set out therein or upon the characteristics of the circuits in which the relay is to be placed. To this extent the claim is indefinite.

Hoge. 173 O. G. 1081.

(26) *Concluding Clause in Claim.*

A very full discussion of the meaning of these words in a claim.

National Tube Co. v. Marks, 209 O. G. 329.

Where the claims of a patent specify the elements of a combination, but do not specify the means whereby those elements perform their functions, but call for means generally, and close with the words substantially and as for the purpose described or specified, or set forth, such words impart into the claims the specific means described in the specification and the claims are limited accordingly.

Star Bucket Pump Co. v. Butler Mfg. Co., 198 F. R. 861. See also Union Match Co. v. Diamond Match Co., 162 F. R. 148.

To make the claims valid, in view of the statement of the nature and scope of the invention in the specification and particularly in view of the prior art, the words "substantially as described" must be taken to limit the claims to a structure which will accomplish the stated object of the invention in substantially the manner described in the invention.

American Air Co. v. General Compressed A., etc., Co., 195 Fed. R. 751.

"The words 'substantially as specified' means substantially as specified in regard to the combination which is the subject of the claim." Quoted from Lake Shore, etc., R. R. Co. v. Car Brake Shoe Co., 110 W. S. 235 by the court in Commercial Acetylene Co. v. Searchlight Gas Co., 197 Fed. R. 914.

The words "as set forth" at the end of the claims, necessitates reference to the description to ascertain their scope.

Ellis v. Rochester Egg Carrier Co., 197 Fed. R. 765.

These words have the effect of imparting into the claims the particulars of the specification relating to the process to illustrate its operation, but not the function or operation of the mechanism there described. The specification does not add to or detract from the claims. The patent can not be extended beyond the claims. (Cases.)

U. S. Consol. S. Raisin Co. v. Selma Fruit Co., 194 F. R. 269.

The claims it will be observed all terminate with the statement "substantially as set forth." Although the language of some of them might be construed as covering a wider range of devices, it is deemed proper in view of the condition of the prior art, to limit the invention to the disclosure of the specification and drawing.

Friestedt v. National Interlocking Steel Sheeting Co., 182 O. G. 837.

Taking the description as given in the claim, it is not at all clear what is meant by a "consolidated return curved track crossing itself" and standing alone, it is a question how far it would be good. But the added words "substantially as described for the purpose set forth" carry us back to the specification. The inventor has thus committed himself to an eliptical form of track.

Thompson Scenic Ry. Co. v. Chestnut Hill Co., 119 F. R. 362.

Herein described.

Simonds R. M. Co. v. Hathorn Mfg. Co., 90 F. R. 201 et seq.

(27) *An Analysis of Claims.*

A claim may be diagrammed by placing its elements in separate numbered paragraphs with the qualifying clauses adjacent to and indented with reference to that which they qualify, thus, claim 1 of Form No. 14 might be diagrammed as follows:

The combination, in a meat-chopping machine, of
(1) A rotary chopping block
  (a) having an annular rib, with
(2) a table
  (b) having an annular recess
  (c) to receive said rib, and

(3) a pocket

(d) communicating with the said recess,

all substantially as set forth.

Some courts have treated the qualifying clauses as elements, and these qualifying clauses have been lettered.

"Some of the elements of these claims are Miehle's: such of them as indicate H's improvement we have italicised."

Miehle P. P. Co. v. Whitlock P. P. & M. Co., 223 F. R. 684.

Claim.

3. In a reversing mechanism a reciprocatency member, relatively movable shoes carried thereby to form a guideway, a reversing member movable in a circular path and having *parallel plane bearing-faces,* to enter said guideway intermittently and cooperate with the shoes, *means to position* the *bearing-faces* of said reversing member to enter the guideway and means to effect relative movement of the shoes to permit the entrance to and departure of the reversing member from the guideway.

A functional qualification as "Adapted to, etc., treated as an element."

Evans v. Hall Printing P. Co., 223 O. G. 539-541.

"These thirteen claims may be divided into two groups, one relating to the prevention of the shift or change from zigzag to straightaway or from straightaway to zigzag stitching when the needle is at the wrong stitch, and the other to the prevention of the shift from zigzag to straightaway stitching, or conversely, when the needle is in the work or material to be sewed.

Union Special Mach. Co. v. Singer Mfg. Co., 215 F. R. 598-608.

(1) A rotary member having (a) numerous elongated blades, (b) arranged lengthwise in approximately axial direction, and (c) in substantially drum form, (d) so as to enclose within them a relatively large and *practically* unobstructed intake-chambers, and (e) in transverse section arranged relatively to the axis and direction of rotation to carry with them rotatively and discharge it tangentially; and (2) a means for so mounting said rotary number as to permit tangential escape of the fluid discharged from the vanes.

Sirocco Engineering Co. v. B. T. Sturtevant Co., 208 F. R. 151.

Analysis of Claims.

Conley v. Thomas, 204 Fed. R. 93.

Analysis of claim.
Swindell v. Hagen, 198 F. R. 490.
Claims. Analysis of.
See Equitable Asphalt M. Co. v. Parker Washington Co., 197 Fed. 922-923.

The requisite elements are: (1) Opposing blades or bars; (2) Having cooperating serrated edges; (3) Means for vibrating one or more of the blades or bars to produce the feeding action.
Steiger v. Waite Grass Carpet Co., 194 F. R. 884.

Rule 38. Reference to Drawings.

When there are drawings the description shall refer to the different views by figures and to the different parts by letters or numerals (preferably the latter).

CONSTRUCTIONS.

The expressed preference for figures was inserted in 1885. If figures are used it is a little confusing to indicate section lines by the same kind of figures. Roman figures have been used for this latter purpose and the number selected that shall indicate the figure, the section of which is indicated thus: Fig. 4 is a section on the line IV—IV figure 1.

If small letters are used the "caps" may indicate the section lines and that "cap" selected which has a position in the alphabet corresponding to the figure the section locus of which it indicates. Thus, "Fig. 4 is a section on the line D—D, figure 1. Exponents should not be used, but it is sometimes convenient to indicate a part as a whole by a letter and its constituent parts by the same letter followed by a figure, thus a and a2, a3, etc. Corresponding parts in modified forms may be indicated in this way.

A part shown only in dotted lines is sometimes indicated by a reference character surrounded by a dotted line.

If the German rule is followed the drawings can generally be reproduced photographically for foreign applications.

The German Rule.

Für die Bezugszeichen sind die kleinen lateinischen Buchstaben (a, b, c) in einfacher lesbarer Schrift zu verwenden. Sind mehr als 25 Zeichen nötig, so sind arabische Ziffern zu verwenden. Zur Bezeichnung von Schnittlinien dienen die grossen lateinischen Buchstaben. Winkel sind mit kleinen griechischen Buckstaben (α, β, γ) zu bezeichnen.

The French Rules.

8. Les lettres de référence et le mot Fig. placé avant le numéro de chaque figure, devront être du type des caractères latins d'imprimerie. Les mêmes pièces seront désignées par les mèmes lettres ou chiffres dans toutes les figures. Une même lettre on un même chiffre ne pourra pas désigner des pièces différentes.

11. Les dessins ne contiendront aucune légende ou indication, timbre, signature ou mention d'aucune sorte autre que le numéro des figures et les lettres ou chiffres de référence, dont la hauteur sera de 3 à 8 millimètres. On ne devra employer que des caractères latins. Les Lettres ou chiffres de référence, que devront être de dimensions uniformes et très correctement dessinés (1) pourront être pourvus d'un exposant, dans des cas exceptionnels. Ils seront rejetés en dehors des figures et des lignes, auxquelles on les raccordera par des attaches. Les lignes de coupe et de raccordement seront indiquées par des lettres ou chiffres semblables:

A A. B B. a a. b b. 1 1. 2 2.

Les caractères grecs pourront être employés pour désigner des angles

The British Rule.

"Reference letters and figures and index numerals used in conjunction therewith, must be bold, distinct and not less than one-eighth of an inch in height. The same letters should be used in different views of the same parts. Where reference letters are shown outside the figure, they must be connected with the parts referred to by fine lines." (Part of Rule 22).

Rule 39. Arrangement of Specification.

The following order of arrangement should be observed in framing the specification:

(*a*) Preamble stating the name and residence of the applicant and the title of the invention.

(*b*) General statement of the object and nature of the invention.

(*c*) Brief description of the several views of the drawings (if the invention admit of such illustration).

(*d*) Detailed description.
(*e*) Claim or claims.
(*f*) Signature of applicant.

CONSTRUCTIONS.

212 O. G. 1063.

(f) As Frank is a common Christian name, an affidavit that it is a complete name should not be required.

Moehn, 106 O. G. 995.

(f) Middle name may be abbreviated, but first name should be written in full.

Gentry, 1888 C. D. 115.

See also Smith & Kimble, 97 O. G. 2533.

(a) While an applicant will be allowed within reasonable limits to say what the title of his patent shall be, he has not an absolute right in this or any similar matter of detail and it is the province of this Office to determine whether any title given to an invention is one which satisfies section 4884 of the Revised Statutes.

Nickola, 1891 C. D. 215, 57 O. G. 1425.

(b) The law and rules contemplate that an applicant shall point out at the outset of the specification the particular part, machine, article or composition of matter to which his invention relates, so that the remainder of the specification may be read with reference to some object clearly had in view. But that at the outset the applicant shall state the exact scope of his invention as he intends to claim it is nowhere required, and is inconsistent with law which declares this to be the object of the claim alone.

Thompson, 79 C. D. 212, 16 O. G. 588.

(b) It might not be improper for the Examiner to insist upon this statement at the outset, but after the expiration of eighteen months spent on the merits of the case, it is unreasonable to insist upon such formal objection.

Bate, 1879 C. D. 84, 15 O. G. 1012.

(b) A statement that "The invention consists of the several parts shown in the drawing" seems to be improper.

Gould, 1876 C. D. 164.

See also Bate, 1879 C. D. 84, 15 O. G. 1012.

It is not a presumption of law that a subscribing witness has a knowledge of the contents of the document to which he attaches his name; he merely attests the signature of the party, or execution of the deed.

Cushman v. Parham, 76 C. D. 130, 9 O. G. 1108.

Doubtless if the patent were actually issued, with but a single witness to the specification, or without a petition or the payment of fees, these formalities would not avoid the patent.

Atwood, 1869 C. D. 98.

Sec. 51-6.

'The requirement for two witnesses to the drawing and specification was canceled by Act of Congress, March 9, 1915.

Sec. 212 O. G. 1063.

(a) Applicant's address at which he customarily receives his mail. Care of attorney not sufficient. Object to communicate with applicant direct. Official Notice.

225 O. G. 375.

An applicant should be permitted to retain the title he thinks appropriate unless there are substantial reasons to the contrary.

Wiland, 152 O. G. 957.

Omission of address is not such a vital mistake as will warrant a refusal to consider application.

Becker, 1901 C. D. 198, 97 O. G. 1597.

Rule 40. Signature to Specification.

The specification must be signed by the inventor or one of the persons indicated in Rule 25. Full names must be given, and all names must be legibly written.

Rev. Stat., sec. 4888.

See notes to Rule 39(f).

CONSTRUCTIONS.

An application can not be received where only one of two joint inventors has signed the specification, even where the other refuses to sign.

In re Crane, 106 O. G. 999.

The words "and attested by two witnesses" struck out of the statute by amendment approved March 3, 1915.

212 O. G. 1063.

And of course the rule was amended to conform to the statute.

No affidavit required that "Ray" was applicant's full first name.

If an application is returned from the Issue Division for correction of alleged informality a ruling by the Primary Examiner on the point is conclusive.

Faulkner, 128 O. G. 886.

Where different forms of the applicant's name appear in the preamble and signature to the specification, one of them presumably a corruption or nickname, an affidavit should be required stating which is the correct form. Where the incorrect form appears in the preamble correction should be made by amendment. Where the abbreviated form or nickname appears in the signature, the patent may issue after the filing of the affidavit above referred to.

Clark, 124 O. G. 910. Cases reviewed.

The signature of the applicant by his attorney may be admitted.

Heginbotham, 1875 C. D. 93; Voelter, 1870 C. D. 84.

There are numerous decisions (Am. & Eng. Encycl. of Law, Vol. 21, p. 309) to the effect that the courts will take judicial notice of ordinary and commonly used abbreviations and equivalents of Christian names. As was stated, however, in Ex parte Boston Fountain Pen Company, Supra, the cases referred to show that where names have been differently written questions have arisen requiring judicial decision and it is one of the functions of this Office to prevent such uncertainty in connection with instruments which the law authorizes it to issue.

Clark, 124 O. G. 910; Gentry, 1888 C. D. 115; Smith and Kimble, 97 O. G. 2533; Boston Fountain Pen Co., 116 O. G. 2531.

In Gentry, 1888 C. D. 115, it was held on the authority of Gaines et al. v. Stiles, 14 Peters 322, that the insertion or omission of the middle name or initial was immaterial and that the full first given name and surname were necessary to constitute compliance with the law.

Clark, 124 O. G. 910.

"Marie, Princess of Jsenburg" informal but full name may be supplied by amendment in substitute paper.

108 O. G. 2145.

The name of the applicant must be signed. Charles Prince de Lowenstein, is not sufficient.

In re Charles, Prince de Lowenstein, 108 O. G. 562.

A signature by another person is not sufficient.

Taylor, 107 O. G. 1098.

If first name appears to be an abbreviation an affidavit to the contrary must be filed.

Smith & Kimble, 1901 C. D. 231, 97 O. G. 2533.

The application may not be passed to issue until the full first name of applicant is supplied.

Cerdes, 93 O. G. 193.

An application must not be passed to issue until the specification is signed with the full name of applicant.

(Order of Commissioner), 92 O. G. 1441.

A specification and petition signed by both inventor and assignee is fatally defective and should not be sent to the Primary Examiner.

Henze, 1899 C. D. 253, 90 O. G. 2507.

Attestation by two witnesses imperative.

Ackroyd, 1893 C. D. 58, 63 O. G. 466.

A clean draft of a specification may not be substituted for one altered as to the description and signed and sworn to by the applicant. Such an application should be stricken from the files.

Sheridan v. Latus, 1883 C. D. 76, 25 O. G. 501.

A patent granted upon a specification sworn to in blank and subsequently filled out without the inventor having a chance to examine it, is void *ab initio*.

Benton, 1882 C. D. 3, 23 O. G. 341.

It is not a presumption of law that a subscribing witness has a knowledge of the contents of the document to which he attaches his name, he merely attests the signature, or execution of the deed.

Cushman v. Parham, 1876 C. D. 130, 9 O. G. 1108.

Doubtless, if the patent were actually issued, with but a single witness to the specification, or without a petition or the payment of fees these informalities would not avoid the patent.

Atwood, 1869 C. D. 98.

Order No. 600 modified so that if an abbreviation is also a first name, like "Fred," an affidavit need not be furnished.

Bowen, 247 O. G. 245.

DIVISION OF APPLICATION.

Rule 41. Joinder of Inventions.

Two or more independent inventions can not be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application.

HISTORY.

Rule 41, of July 18, 1899, added to the wording of the present rule the following paragraph:

"A machine, a process and a product are separate and independent inventions, and claims for each must be presented in a separate application."

By request, the *Patent Law Association of Washington* carefully considered this rule, with the above quoted clause therein and reported their opinion, with the reasons therefor, to the Commissioner.

Most of our notes are omitted up to 1900, and instead thereof is quoted a part of the report as follows:

Report of the

PATENT LAW ASSOCIATION

of Washington

On the subject of Rule 41 of July 18, 1899.

Appendix to Report

The report notes that Ex parte Boucher, 88 O. G. 545, and preceding that, Ex parte Blythe, 30 O. G. 1321, and Ex parte Horr, 41 O. G. 463, assume that Congress, in the statute, section 4886 of the Revised Statutes, has recognized a *natural* classification of inventions in *four great divisions,* and, after fully giving reasons for a contrary opinion, conclude:

"We are of the opinion that 'statutory classification' does not exist."

The report then continues as follows:

V. The Court Opinions and Decisions.

(Note.—It should be remembered in the discussion of the court cases that the Supreme Court has held that a statutory bar may be applied and a patent held invalid, whether the bar be formally set up as a defense or not. See, for example, Hill v. Wooster, 132 U. S. 693-701, citing numerous cases where the principle was applied.)

We think that in the light of the court decisions the question is always one of fact, and that, as a general rule, the claims should follow the disclosure—that is, when the disclos-

ure of one invention involves or compels the disclosure of another, and claims are made for both, they should ordinarily be embraced in one application.

1. The new section of the rule is objectionable because it undertakes to convert a supposed rule of law into a rule of practice. If the rule is correct as a matter of law, it is wholly superfluous, since no rule of practice is necessary to enable a rule of law to be enforced.

2. The rule is objectionable because it casts a cloud upon thousands of existing patents which contain claims on a plurality of the subjects matter mentioned. The practice and adjudications of the Patent Office have an influence upon the courts, it sufficing in this connection to cite

Hogg v. Emerson, 6 Howard 437; Huber v. Nelson, 148 U. S. 270.

The statement of the rule, if permitted to stand, will unquestionably be used to fortify contentions against the validity of patents, and perhaps with success. Patents, in contravention of the principle of the rule, have been granted for over a hundred years, and none has been declared invalid for this reason.

3. Although, as just stated, numerous patents obnoxious to the principle of the rule have been adjudicated, we have been unable to find a single instance of a patent being declared invalid for that reason. As late, at least, as 1892, the Supreme Court has sustained a patent containing claims for method and apparatus.

Hoyt v. Horne, 145 U. S. 302.

To illustrate the fact that no such rule is recognized by the courts or known to the legal profession, let us refer to the Bell patent for the telephone (126 U. S.). No patent has ever been so sharply criticised and so keenly contested by individuals and powerful combinations, including the Government. Reference is usually made to the fifth claim only, this claim was held to be a method or process. But the patent has a claim for "a system of telegraphy, one for a combination of mechanical parts, two for methods for producing undulations in a continuous voltaic current," in two somewhat different ways, while, as stated, the fifth claim is for "the method of and apparatus for," etc.

We have the statement of the president of the association, who was of counsel for the defense, that the question of misjoinder was considered in preparing the attack upon the patent, and yet the point was never even raised or suggested in

court. Though millions of dollars would have freely been given to avoid the patent, it stood.

Had any such rule of law existed it would not have escaped the attention of bar and bench for a hundred years.

4. The statement of the rule is not in accordance with the opinions and decisions of the Supreme Court.

In Powder Co. v. Powder Works, 98 U. S. 126-137, the Supreme Court discussed two classes of cases. In the case before the court the processes described in the original patent had no connection with the compounds claimed in the reissued patent. The compounds were not made by the process, the invention of one did not involve the invention of the other, and the two inventions might have been made by different persons and at different times, as the court states. In the discussion of this matter the court read with approval, as applying to the other class, the rule announced by Mr. Justice Grier in Goodyear v. R. R. Co., 2 Wall., Jr., 356, and said: "The product in Goodyear's invention was the direct result of the process. They were parts of one invention and, except in imagination, could no more be separated from each other than the two sides of a sheet of paper or than a shadow from the body that produces it."

It is hence clear that at least a process and the product may constitute one invention, and therefore that whether they do constitute one invention or two is a question of fact and not of law. The rule is hence objectionable because attempting to lay down a rule of law (which is erroneous) instead of specifying the character of the facts which must be present in order, as a matter of office policy, to justify the requirement of separate applications for such always intimately connected subjects matter.

We have carefully examined what we believe to be all of the authorities and find none which overrule Powder Co. v. Powder Works (ubi supra) or which are inconsistent therewith.

In the appendix will be found a list of the pertinent Supreme Court cases.

In these cases the Supreme Court, with substantial uniformity treated the question as one of fact and not of law. This may be aptly shown by a comparison of Rubber Co. v. Goodyear, 9 Wallace 788, with Mosler Safe Co. v. Mosler & Co., 127 U. S. 354. In the earlier case the original Goodyear patent had been reissued in two divisions, one of which claimed the process and the other the product of that process. The court below had held the process reissue to be invalid, and no appeal from this finding had been taken. It was con-

tended before the Supreme Court that the product reissue was also invalid because the product was the result of the invalid process. In disposing of this contention, the court said: "A machine may be new, and the product or manufacture proceeding from it may be old. In that case the former would be patentable and the latter not. The machine may be substantially old and the product new. In that event the latter, and not the former, would be patentable; both may be new, or both may be old. In the former case, both would be patentable; in the latter neither.

"The same remarks apply to processes and their results. Patentability may exist as to either, neither, or both, according to the fact of novelty, or the opposite. The patentability, or the issuing of a patent as to one, in nowise affects the rights of the inventor or discoverer in respect to the other. They are wholly disconnected and independent facts. Such is the sound and necessary construction of the statute."

It is thus plain, in view of the point which was raised for decision, that the patentability of the process and that of the product were treated as independent facts, and it was the question of fact which was decided.

In the Mosler case two patents (amongst others) were involved, one for an article or product and the other for a method or process. The article patent was granted July 17, 1883, on an application filed December 27, 1881. The method patent was granted August 14, 1883, on an application filed December 11, 1882. In declaring the second patent, for the method, invalid, the Supreme Court said: "After a patent is granted for an article described as made by causing it to pass through a certain method of operation to produce it, as, in this case, cutting away the metal and then bending it so as to produce the identical article covered by the previous patent, which article was described in that patent as produced by the method or process sought to be covered by taking out the second patent."

If there be any inconsistency between these two cases, the Mosler case, being the later, must control. Regarding the questions involved in the two cases as questions of fact, the two cases are harmonious. In both cases the questions are treated as questions of fact, and in one case the contention that the two patents were invalid because granted for the same invention was dismissed because contrary to the facts; in the second case the later method patent (although concurrently pending) was declared invalid because for the same invention as the earlier article patent.

The present rule is objectionable because it undertakes to lay down an incorrect rule of law which compels separate applications, although the facts may be such as to require the different subjects matter to be embraced in a single patent. The present rule would require an inventor, under the circumstances involved in the Mosler case, to take out separate patents, one of which would necessarily be declared invalid by the courts in view of the decision of the Supreme Court in the Mosler case.

The only language which might be thought at first to support the rule, so far as we know, in the decisions of the Supreme Court, is in the extract above quoted from the case of Rubber Co. v. Goodyear. At best, however, this is but a dictum, because the court did not there decide that a single patent was void because containing different subjects matter, but on the contrary, sustained the propriety of reissuing a single original patent in two divisions for allied subjects matter where the facts showed the subjects matter to be separable. This case did not attempt to lay down a rule of law, and if it did it is inconsistent with the later cases of Powder Co. v. Powder Works, 98 U. S. 126, and Mosler Co. v. Mosler & Co., 127 U. S. 154, and the latter must control.

In other words, the courts have never held a patent invalid on the ground of misjoinder, while they have held one of two patents invalid where the same disclosure formed the basis of both.

The following citation is strongly suggestive and practically presents the attitude of the court on joinder of inventions, whether this question has arisen directly or indirectly.

Merrill v. Yeomans, 94 U. S. 568: "There is no question here but that the patent is good for the second claim, for the superheating coil with its steampipe, etc.; and we are all of the opinion that it is good for the process of distillation described in the specifications, by which the heavy hydrocarbon oils are deodorized. It is therefore a valid patent for two important matters well set forth and described."

5. There are a number of cases which at different times have been applied as supporting, indirectly, the separation of method and apparatus. For example, in Ex parte Blythe, Corning v. Burden, McKay v. Dibert, Dederick v. Cassell, James v. Campbell, and Piper v. Brown.

We believe that a critical examination of these citations will not only make it apparent that they are not applicable, but, furthermore, that they are against the argument of the decision. For example, in reference to James v. Campbell, 21 O.

G. 337, no one disputes that machine and process may be independent and distinct, nor is it questioned that a supposed process may be but the functional operation of the machine. In Tilghman v. Proctor, 19 O. G. 859, the court recognizes what no one disputes, that a process may be the subject of invention and patent, and that some means for carrying out the process should be set forth, so that the public can practice it. In Piper v. Brown, 4 Fisher 175, two patents for different inventions of different dates were before the court; and under Corning v. Burden, 15 How. 267, it is, of course, apparent that A may invent a process, and B an apparatus for carrying it out. No one wants them to put both their claims in the same patent.

Because O'Reilly v. Morse, 15 How. 62, is supposed to indicate that a patent can issue for but one means of effecting a result, it is not in point. No one is contending for alternative means in the same application.

A curious citation is that of McKay v. Dibert, 19 O. G. 1351. In that case a patent was issued for the machine, and afterwards one for the process and one for the product. The patent for the machine expired and the patents for the process and the product were declared valid, and a restraining order given against the use of the machine. If this case illustrates anything it illustrates an evil that may flow from division. Another curious citation is that of Dederick v. Cassell, 20 O. G. 1233. In that case several patents to the same individual were before the court, in one of which a claim for a process was allowed to stand with mechanical claims, and in others they were stricken out as being merely functional or old.

Whatever view may be held of the conclusions in Ex parte Blythe, we think a careful reading of the authorities there cited will discover the unfortunate nature of the selection.

After a study of those "authorities" we think it is proper to say that the conclusion of Ex parte Blythe becomes nothing but a mere assertion. That conclusion is in these words: "I am compelled to hold that the plain provisions of the statute, as well as the weight of judicial opinion and the dictates of what seems to me common sense, require that arts (or 'processes'), machines (including apparatus), manufactures and compositions of matter should be made the subject of separate and independent patents, except as above indicated."

We have touched upon the first two reasons. In the matter of "common sense" the jury sees it otherwise, and happily the exception kills the rule.

6. The reissue decisions have been used, though not at the present juncture, to support the separation of method and apparatus. All those decisions discuss the question of whether or not the reissue is for the same invention as the original, and whether or not the additions were within the purpose and meaning of the original description. So far as they are in point they are directly against division, for they recognize the necessity of determining as a question of fact whether or not the added invention was covered by the original description. They do not hold it as a fixed rule of law that the mere fact that one claim is for a method and the other for an apparatus, for example, is sufficient in itself to render the patent invalid.

7. The question of joinder of inventions was directly raised in the Fire Extinguisher Case, 21 F. R. 90, and in the case of Wilkins Shoe Button Fastener Co. v. Webb et al., 89 F. R. 982.

In the first case method and apparatus were included in one patent and the defense that they were not properly joined was held not a good defense.

In the latter case Judge Hammond elaborately reviews the authorities, and at page 984, says:

"I dwell upon these cases because they represent the law of the Supreme Court on this important point, as it was declared more than 50 years ago, and seemingly has scarcely been touched upon since by that tribunal, certainly not departed from or modified, so far as I can discover from the cases, subsequently. But, incidentally noticing the point, I should say, from this reading of them, that to make a patent invalid because of duplicity or double invention, the two things patented should be not only independent in form or substance, physically and structurally, but likewise independent in objective results—one to spin cotton and another to make paper, as these opinions illustrate the matter. There must be a total disconnection between the two, subjectively and objectively, if it may be so expressed."

8. The danger of separate patents for the same invention is illustrated, for example, in the well-known cases of Miller v. Eagle, 151 U. S. 186, and Underwood v. Gerber, 149 U. S. 224.

The following quotations present the views of two of the ablest judges on the bench:

"The result of this subdivision of the main invention, the alteration of specifications, and the grant of divisional patents at different dates, was to make an entangled mass of patents,

which are to some extent intertwined with each other—a confusion which has caused perplexity to experts, counsel, and judges, and which has endangered the strength and the validity of the patents themselves."—Judges Lacombe and Shipman (C. C. A.) in Electrical Accumulator Co. et al. v. Brush Electric Co., 52 F. R. 130, 137.

"For some unexplained reason (probably because of some arbitrary rule of the Patent Office), instead of allowing a reissue with appropriate claims, the Office on the same day allowed two separate reissues—the one above quoted, and another, numbered 10375, which purports to cover practically the same invention, only not restricted as to the composition of the nonconducting sheets. This practice of so-called 'divisional issue' has been most unfortunate for patentees. Witness the result in Underwood v. Gerber, 149 U. S. 224; 13 Sup. Ct. 854. And, as was to be expected, the defendants contend that No. 10376 is anticipated by No. 10375. Fortunately, in the case at bar it will not be necessary to deprive the inventor wholly of his patent because the Patent Office saw fit to split it into two." Judge Lacombe in H. W. Johns Mfg. Co. v. Robertson et al., 89 F. R. 504, 506.

It has been suggested that a new statute might be provided which would protect prior patents and at the same time provide for the future separation of machine, process and product. We believe it to be doubtful if Congress could justly validate an invalid patent, and we believe it to be inexpedient and impolitic to put in the statute such a law. We think it too strongly suggestive of other bills having in view the interpretation of patents, and inflexibility where the opposite is desirable. In any event, the passage of the law is yet to be accomplished, and after a careful consideration we are of the opinion that it would be the duty of this association to oppose to the utmost such a bill.

9. We do not go beyond the court opinions and decisions. We do not take the "popular" or "layman" view of joinder of inventions. We appreciate the practical advantages of the separation of divisions of a machine, and yet we find in certain expressions of the legislators a reason for caution in pressing too strongly upon the public academic or arbitrary rules. For example, Senator Windom, in a speech delivered in Congress, December 18, 1878 (see Cong. Rec., 45th Cong., vol. 214. p. 269), said: "The object of this amendment is to prevent the oppression and great injustice that is being perpetrated upon hundreds of thousands of innocent people by means of the patent law. A common coal stove, I am in-

formed, is covered by at least twenty patents, almost every part of it, and your laws encourage the issue of the largest possible number of patents. If, for instance, an applicant thinks he has devised a new and useful kind of a stove, and that device includes a dozen different contrivances, instead of taking a single patent for the whole and getting a patent for that kind of a stove, your laws, and this bill, I believe, expressly provides that he may divide his application into different patents, giving him the opportunity after they are subdivided, to assign one to A, another to B, another to C; and then for a single coal stove, which the poor man uses upon the prairies to keep his family from freezing, a dozen men may sue him for a dozen different royalties."

The typical argument and illustration of the effect of a free rule of joinder is found in the exceptional case of Sessions v. Romadka, 28 O. G. 721. In that, four articles of general applicability were claimed in one patent, showing them applied to a trunk. The court evidently did not think them "connected in design and operation," and yet did not hold the patent void. This case, an extreme one, is in point only as against the joinder of separate machines or articles of manufacture when they do not "mutually contribute to produce a simple result." It is therefore not quoted in the decisions separating method and apparatus, or method, apparatus and process.

10. How are machine patents interpreted? As the Supreme Court says, in Machine Company v. Murphy, 97 U. S. 120, 125, "in the light of what they do, or what office or function they perform, and how they perform it." So the disclosure should read to cover the function, and must in many cases read to cover the process, and conversely in many cases a description of the process must include a description of the machine.

This is always true of process and product. Rarely is one separated from the other where the two inventions were made by the inventor at the same time. In that class of invention the disclosure of one compels the disclosure of the other.

11. It is universally accepted that patents for a genus and a species are valid, and that the separate claims of a patent may, in fact must, cover different inventions.

What difference in effect can there be between a single patent covering a process and an apparatus for working that process, and a patent having generic and specific claims? And do not process and product bear an even closer relation in general than generic and specific claims?

There can be no doubt that the generic claim gains strength from the specific claim, and so does a process gain strength by the disclosure and claiming of the machine, and above all does a process gain strength by the disclosure and claiming of its alter ego, its products, and vice versa.

And what is the relation between broad, narrow, and improvement claims?

And what is the relation between the separate claims of some elaborate machine such as a printing press, a typographic machine, a voting machine, etc.?

12. It has been said by the courts, for example, in Bennet v. Fowler, that joinder of inventions is in a measure within the discretion of the Commissioner. It is true that this was said with reference to different machines; but if this be a matter of discretion with the Commissioner, then he should not frame a rule of law. The rule as it stood permitted the proper exercise of the discretion of the Commissioner; but we do not think the statutes or the courts contemplated an inflexible rule like the one now in force, made by the officer whose duty it is, in our opinion, to exercise that discretion in view of the facts of each particular case.

13. It seems clear, therefore, to us that the rule is untenable as it now stands. We are unable to see that any reason of policy exists at the present time which should require any rule at all upon the subject. It seems to us that each particular application should stand on its own basis, and its disposition should be determined by the particular facts.

Without undertaking to lay down an absolute criterion, which is impossible, as the peculiarities of all possible cases can not be borne in mind, it seems to us that a safe guide to follow generally would be to let the question of separation depend upon the character of disclosure.

Assuming novelty and patentability in each instance, if the disclosure of one subject matter involves or compels the disclosure of another subject matter, then such subjects matter should be embraced in the same application. For example, if a new product has been invented, the statute obliges the inventor to disclose in full how the product is made. If the inventor in so doing discloses a new process, he should be permitted to claim it in the same application.

In other words, the protection should be commensurate with the disclosure. If the inventor, in disclosing his new product, is obliged at the same time to disclose a new process, there is no consideration which he can offer in exchange for two

grants. The public gets all it is entitled to from the single disclosure and obtains no benefit from a second grant.

14. In our opinion, the court opinions and decisions and the illustrations they furnish are against the rule.

VI. Office Classification.

In the appendix to this report we have placed a digest of the Commissioners' decisions. Those decisions evidence that the great majority of the Commissioners treated division as a question of fact, especially where method, apparatus, and product were in question.

1. The average view is expressed in the first division of the present rule (41) and, for example, in the following quotation from Ex parte Dailey, 1878 C. D. 3:

"The Examiner, in refusing to consider these claims (mode, machine and product), followed the letter of the decision referred to (Murray v. Wuterich, 1873 C. D. 96), and felt bound by that decision; but I think that it has not been the practice of the office to adhere so closely to that decision as to make it apply indiscriminately to all cases in which processes or machines were involved; and I am of the opinion that the ends of justice are better subserved by allowing in one patent the claims for machines or processes and products, wherever their relation is such to each other as not to make it plain that they are independent inventions."

In answer to the practical difficulties, Commissioner R. H. Duell, in Ex parte Clinton and Knowlton, 1876 C. D. 30, said:

"The great inconvenience and confusion which the Examiner apprehends will arise from this decision may be obviated, in cases like the present one, by the Examiners furnishing to other classes duplicate drawings of those parts, which, if made the subjects of separate applications, would properly belong to such other classes."

In the report of the Examiners-in-Chief to Commissioner Montgomery, hereinbefore referred to, they say:

"Is it any relief to the work of the Office to have two cases instead of one, to receive, and enter of record, and inspect, and jacket, and stamp, and assign, and enter in the Examiner's minutes, and examine, and conduct the correspondence, and go through with all the necessary steps and proceedings up to final allowance, and to prepare, and sign, and seal, and record, and deliver the patents, and make briefs and copies of claims for publication, and print, and publish the same? If this duplication of the work of the Office be not a saving of labor,

what shall we say when, as is frequently the case, a single application is divided into a dozen or more?"

2. We do not believe the classification of the Office will be benefited by a continuance of the rule.

The classification of patents should, we think, be in accordance with disclosure and not claims. In classifying patents the Office should ignore the claims altogether and be guided solely by the disclosure made. The practical defects of the present classification are mainly due to the fact that the claims of a patent control its classification, and its specification is largely ignored. In the rare cases where a search through a single folio reveals a complete anticipation, the same end can be reached by a proper cross-reference. Except in the few cases of interferences and reissues, after a patent has been issued the Patent Office has no further interest in the claims, but it has a very great interest in the disclosures made. Bearing this in mind, it will be seen that the application of the new rule will be of no benefit to the Office classification. If a patent for a product necessarily discloses a new process, or if a patent on a new apparatus necessarily discloses a new process and a new product, these disclosures, in addition to what is claimed, must be recognized in the Office classification if it is to be of any value. There is no way of compelling an inventor to take out different patents for these allied subjects matter, and he might not be able to afford it, even if he should desire to do so, and consequently his single patent must be put into as many different classes as its disclosures warrant, provided the classification is to be accurate. The question of Office classification is thus wholly outside of the character of the claims in the patents, and the convenience of Office classification is not, in our opinion, a sufficient ground for the rule.

VII. The Fiscal Argument.

We think that the fiscal argument should not be advanced directly against the inventor, nor do we think that the larger view at present compels this argument.

Unfortunately, Congress has not correlated revenues and appropriations. If the expenses of the Patent Office exceeded its receipts, the matter of securing additional fees might be of importance, and the reason of the rule might be justified, providing it were surely effective and no better way of increasing the receipts of the Office could be devised.

But this condition of affairs does not exist. On the contrary, the Patent Office is a source of profit to the Government.

There is a large annual surplus, and a total surplus of about $5,000,000. If the 6,000 or 7,000 patents, including method or apparatus, etc., had been divided, this surplus might have been increased by from $40,00 to $60,000. Instead, therefore, of being solicitous to increase its fees, the aim of the Office should be to either diminish the burden upon inventors or to increase its facilities and the boundaries of an application.

Quoting again from the report of the Examiners-in-Chief:

"But is it right to rob the inventor merely to get the fees, and compel him to take two or more patents where one would give him all the evidence of title to the exclusive use of his invention contemplated by the constitution and promised him by the law? . . . And often from poverty the inventor is forced to submit to be shorn of his rights and go before the world with a patent which covers only a fraction of his inventive work, and giving him only questionable protection for what it has been allowed to embrace."

The report then goes on to discuss the practical dangers to the public.

VIII. The Rule as a Finality.

In Ex parte Boucher the Commissioner, in closing, says:

"In addition to all the reasons that have been and might be adduced in favor of the requirement of division between process and apparatus claims, it is self-evident that this question is always going to be an unsettled one unless it is disposed of by rule."

Then why not abolish Rule 41?

Or would not the arbitrary rule of not requiring division between method, apparatus, and product be as efficient to this end?

But might not the rule rest on the disclosure, thereby following the courts, the opinion of the bar, the wishes of the applicant, and the natural suggestion of the facts? This would at the same time provide the proper safeguard to the public of putting in one grant one invention or connected inventions, making the claims commensurate with the necessary disclosure?

Can the Commissioner expect to settle this by rule? See the varying rules in the appendix. It is a matter of recent history that one Commissioner prepared and published a whole new set of rules, and that the next Commissioner canceled the whole edition and replaced the preceding rules, all within five months.

It has been suggested that this rule could be given the force of law, at the same time protecting previous grants.

We have very carefully considered this proposal. We are doubtful if the validity of prior grants could justly be the subject of a statute, and we think it inexpedient to file a bill of this sort while we are so strenuously opposing many interpreting bills before Congress. In addition to this, we believe that such a law would be hurtful for the reasons we have fully set forth; and upon the consideration of the whole matter we should deem it our duty to use our utmost endeavor against such a bill.

In the meantime, however, the rule still stands, and even if such a law were desirable it might be neither politic nor possible to secure its passage.

IX. Practical Objections.

There are many practical reasons which, in our opinion, far outweigh the supposed advantages and "convenience" of the present rule.

1. It seems manifest that the rigid application of the substance of the rule would work great hardship upon inventors. It would in many instances compel the inventor desiring to claim the protection he considered himself entitled to, to take out different patents, some of which might be declared invalid in the courts, following the decision of the Supreme Court in the Mosler case.

2. In many cases an inventor could not afford to make more than one application, and in such event the rule would restrict him to a claim for one subject matter, although in disclosing it he would be obliged to disclose other novel subject matter. In such case the inventor is obliged to select that particular subject matter which for the time being he regards as the most important to claim. The rule obliges him to disclose the remainder of his invention without corresponding protection except at onerous additional cost. The inventor must either sacrifice a portion of what he is entitled to, or at grievous burden to himself, pay out additional fees to increase the idle surplus funds of the Patent Office.

3. The present rule opens up opportunities for fraud. It compels an inventor who has invented a new product, made by a new process, which may be the only process by which the

product can be made, to file separate applications. The patent granted on either of these applications may be sufficient to monopolize the industry built upon the invention. The fact that separate applications are on file, each sufficient to support the monopoly, would enable the inventor to dispose of both applications to different people, since when the patents were granted each assignee would be wholly unable to proceed without the other.

4. The new rule also opens the door to the grant of patents to different inventors on the same invention. For example, two inventors may have invented the same new product made by the same new process. Neither may be able to afford to file independent applications. One in his application may claim the process only, while the other may claim the product only, although each may disclose the entire subject matter. In such event the patents would be granted to both on the same disclosure; the Government would have given two grants for a single disclosure; the question of priority would—in contravention of the statute—not be determined, and the public would, perhaps, be deprived of the use of the invention for seventeen years, because neither patentee could proceed without the consent of the other.

The same is true of apparatus and process, which are frequently difficult to distinguish.

5. We quote from one of the printed briefs referred to hereinbefore:

"There are several important advantages to the public in making the claims to a process and to a machine for carrying out the process in the same patent, when the two are so inseparably connected that the use of one involves the use of the other; when the practice of the process involves the use of the machine and the use of the machine involves the practice of the process.

"First. The inventions will necessarily be patented at the same time, and both inventions will become public property at the same time. If separate patents are granted, this will not necessarily be the case.

"Second. The inventions can not become the property of different owners, and the public subjected to the claims of different parties.

"Third. Infringers can not be subjected to different suits either by the same or by different plaintiffs, as they may be if separate patents are issued.

"Fourth. In case the separate patents were the property of different owners, each would be entitled to claim of an infringer damages or profits for the infringement of his own patent, and thus the party would become liable to two parties for the acts which constituted the infringement.

"Fifth. Each owner of one of the patents could be prevented by the other patent from using the invention.

"Sixth. The owner of the machine patent could not sell a machine with the right to practice the process, and the owner of the process patent could not grant a right to use the process with the right to use the machine, without which the process could not be practiced.

"Seventh. The issue of two patents gives to unscrupulous parties an opportunity to speculate upon the community, by offering them for sale separately and with the assurance that each guaranteed the right to use the invention without the interference of others.

"Eighth. If the inventions are to be embraced in separate patents, they may be sold to different parties before the applications are made, and each assignee will have the right to adopt such course as he may judge to be for his interest, independently of the other. One may file his application at once; the other may have justifiable reasons for delaying as long as the law allows. They may both be put into interference with other parties, and each be entitled to take evidence and be heard. Increased expense and delay will arise from this duplication of the parties, and additional labor to the Office.

"Ninth. Even if the two patents were allowed on the same day, the final fee for one might be paid at once and the party would be entitled to the issue of the patent. The party entitled to the other patent might, for the purpose of securing foreign patents, or for other reasons, delay the payment of the final fee to the end of the limit allowed by law. The Office could not justly delay the issue of one patent or hasten the issue of the other.

"Tenth. After the issue of one of the patents, the public, having no knowledge of the pendency of the other, might acquire rights under it by the purchase of machines, for instance, which they would have no right to use after the other patent was issued to another party."

All that has been thus stated applies with even greater force to process and product.

APPENDIX TO REPORT.

A.

DIVISIONAL APPLICATIONS.

Patent Office Rules.

Prior to 1855 there appears to have been no specific Patent Office rule governing divisional applications. Applicants were allowed to claim as many different inventions as they pleased under one patent, and such patents were sustained by the courts.

Evans v. Eaton, 1 Robb. 68; Evans v. Jordon, 3 Wheaton 454.

were cases relating to a patent granted prior to 1836, covering claims to several distinct machines relating to the art of manufacturing flour.

Typical cases subsequent to the act of 1836 were those of

Wyeth v. Stone, 2 Robb. 23, 1840; Hogg v. Emerson, 6 How. 437, 1848; Hogg v. Emerson, 11 How. 587, 1850.

The first provision on the subject of divisional applications is found in the Patent Office rules of 1855, as follows:

"11. Two or more separate machines will not be allowed to be the subject of one patent whatever be the purpose for which used."

"This is intended to change the practice of the Office in those respects wherein in certain cases all the machines used in the manufacture of one article are allowed to be claimed in one application."

This rule apparently continued in force until 1859, when it was changed to read as follows:

"11. Two or more separate machines will not be allowed to be the subject of one patent unless connected in their design and operation."

This apparently implies that a patent would be allowed covering two or more separate machines if connected in design and operation.

In 1863 this rule was changed to read as follows:

"12. Two or more distinct inventions should not be claimed under one application for letters patent.

"No positive rules for guidance can be laid down on this point, but in general where there are several parts or elements of a machine, art, process, manufacture or composition of matter having no necessary or dependent connection with each other, and each susceptible of separate use or application either

by itself or in other connections, all set forth and claimed under one application for letters patent, the Office requires the party to divide the application and confine the claim to whichever invention he may elect."

This was changed in 1866 to read as follows:

"12. Two or more distinct and separate inventions may not be claimed in one application; but where several inventions have a necessary and dependent connection with each other so that all cooperate in attaining the end which is sought, they may be claimed."

"13. If more than one invention is claimed in a single application, and they are found to be such that a single patent may not be issued to cover the whole, the Office requires the inventor to divide the claim and confine the invention to whichever he may elect."

In 1870, Rule 12 was changed as follows:

"12. Two or more distinct and separate inventions may not be claimed in one application; but where several inventions are necessarily connected each with the other they may be so claimed."

In 1871, Rule 12 remained unchanged, save that it became Rule 15, and Rule 13 was changed as follows:

"16. If more than one invention is claimed in a single application, and they are found to be of such a nature that a single patent may not be issued to cover the whole, the Office may require the inventor to confine the description and claim of the pending application to whichever invention he may elect.

"The other inventions may be made the subject of separate applications."

In 1876, Rule 12 was changed as follows:

"15. Two or more separate and independent inventions can not be claimed in one application, but where several distinct inventions are dependent upon each other and mutually contribute to produce the new result, they may be so claimed."

This rule remained unchanged until 1885, except that in the revised edition of 1879 it was numbered 40.

"41. If several inventions claimed in a single application shall be found to be of such a nature that a single patent may not be issued to cover them, the inventor will be required to limit the description and claim of the pending application to whichever invention he may elect; the other inventions may be made the subject of separate applications which must conform to the rules applicable to original applications.

"If the independence of the inventions be clear such limita-

tions will be made before any action upon the merits; otherwise it may be made at any time before final action thereon, in the discretion of the Examiner.

"42. When an applicant make two or more applications relating to the same subject matter of invention, all showing but only one claiming the same thing, those not claiming it must contain disclaimers thereof with references to the application claiming it."

In 1885 the following addition was made to Rule 40:

"An application should not ordinarily embrace matters belonging to distinct official classes, nor matters belonging to distinct subclasses in cases where a contrary practice has heretofore prevailed among applicants."

This paragraph was canceled in 1886.

In 1888 the numbers of the above rules were changed to "41, 42 and 43" respectively, and the following rule was added:

"44. A reservation for a future application of subject matter disclosed but not claimed in a pending application, but which subject matter might be claimed therein, will not be permitted in the pending application."

These rules remained substantially unaltered until 1897, when the following addition was made to Rule 41:

"A machine, a process and a product are separate and independent inventions, and claims for each must be presented in a separate application."

B.

The following pertinent Supreme Court cases have been particularly considered:

(1) Evans v. Eaton, 3 Wheaton 454; (2) Hogg v. Emerson, 6 Howard 437; (3) Hogg v. Emerson, 11 Howard 587; (4) Le Roy v. Tatham, 14 Howard 156; (5) O'Reilly v. Morse, 15 Howard 62; (6) Corning v. Burden, 15 Howard 252; (7) Bennett v. Fowler, 8 Wallace 445; (8) Rubber Co. v. Goodyear, 9 Wallace 788; (9) Clark v. Bousfield, 10 Wallace 133; (10) Du Bois v. Railroad, 12 Wallace 47; (11) Mowry v. Whitney, 14 Wallace 424; (12) Wood Paper Patent, 23 Wallace 566; (13) Merrill v. Yeomans, 94 U. S. 568; (14) Cochrane v. Deener, 94 U. S. 780; (15) Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S. 274; (16) Bates v. Coe, 98 U. S. 31; (17) Powder Co. v. Powder Works, 98 U. S. 126; (18) Parks v. Booth, 102 U. S. 96; (19) Tilghman v. Proctor, 102 U. S. 707; (20)

James v. Campbell, 104 U. S. 356; (21) Heald v. Rice, 104 U. S. 737; (22) Wing v. Anthony, 106 U. S. 142; (23) Cochrane v. Badische, etc., 111 U. S. 293; (24) Western Electric Co. v. Ansonia Co., 114 U. S. 447; (25) Eachus v. Broomall, 115 U. S. 429; (26) Grier v. Wilt, 120 U. S. 412; (27) New Process Co. v. Maus, 122 U. S. 413; (28) Smith v. Sprague, 123 U. S. 249; (29) Lawther v. Hamilton, 124 U. S. 1; (30) Dryfoos v. Wiese, 124 U. S. 32; (31) Andrews v. Hovey, 124 U. S. 694; (32) The Telephone Cases, 126 U. S. 1; (33) Mosler Safe Co. v. Mosler & Co., 127 U. S. 354; (34) Crescent Brewing Co. v. Gottfried, 128 U. S. 158; (35) Bene v. Jeantet, 129 U. S. 683; (36) Burt v. Evory, 122 U. S. 349; (37) Commercial Co. v. Canning Co., 136 U. S. 176; (38) Grant v. Walter, 148 U. S. 547; (39) Underwood v. Gerber, 149 U. S. 224; (40) Leggett v. Standard Oil Co., 149 U. S. 287; (41) Brigham v. Coffin, 149 U. S. 557; (42) Miller v. Eagle, 151 U. S. 186; (43) Risdon v. Medart, 158 U. S. 68.

In addition to these cases, see cases cited under heading "The Court Opinions and Decisions" in body of report.

C.

DECISIONS OF THE COMMISSIONER OF PATENTS TOUCHING UPON DIVISION OF APPLICATIONS.

1869-1899.

Collated from a Digest Prepared by Wm. D. Baldwin, Esq.

Between two or more devices or processes.
Between apparatus or machine and process or method.
Between apparatus or machine and product.
Between process or method and product.
Between genus and species.
Between compositions of matter.
Between designs.
Questions of practice.

BETWEEN TWO OR MORE DEVICES OR PROCESSES.

Yale, 1869 C. D. 110.

Cited in numerous cases.

It is within the discretion of the Commissioner whether an application shall be divided.

Two or more inventions which are capable of division, and

belong to different classes, or involve a double labor of examination, or which have no community of operation, should be presented in different applications.

Lehmann, 1870 C. D. 70; Sumner, 1871 C. D. 180; Combs, 1871 C. D. 209; Shepard, 1872 C. D. 244; Adams, 1873 C. D. 18; Stow, 1873 C. D. 30; Franklin, 1873 C. D. 116; Nichols, 1873 C. D. 118; Barker & Mack, 1873 C. D. 123; Lones et al., 1873 C. D. 165; Rice, 1874 C. D. 44; Birun, 1874 C. D. 52; Westenhaven & Adair, 1874 C. D. 58; Tucker, 1874 C. D. 97; Knott, 1875 C. D. 96; Noyes, 1875 C. D. 105.

Where the subject matter of an application consisted of a set of devices for charging cartridge-cases, and the first claim was for a cartridge-shell holder, and the second for a canister. Held that as the devices covered by these claims were in their operation especially adapted to each other, belonged to the same class of inventions, and were used in connection to subserve a common end, they formed an exception to the general rule that separate inventions should form the subject of separate applications.

The third claim was for the combination of the shell-holder, the canister and a ramming device. As these also were especially adapted to each other, all cooperated to produce a certain result, and the use of each was necessary to that result. Held that they constituted a legitimate combination.

Jopling, 1875 C. D. 153; Clinton & Knowlton, 1876 C. D. 30, 9 O. G. 249; Sergeant, 1876 C. D. 101, 9 O. G. 963; Sobinski, 1876 C. D. 161, 10 O. G. 3; Kuh, 1876 C. D. 190, 10 O. G. 587; Gillies, 1876 C. D. 195, 10 O. G. 415; Westcott, 1876 C. D. 206, 10 O. G. 546; Dieterich, 1877 C. D. 14, 11 O. G. 195; Pintsch, 1877 C. D. 43, 11 O. G. 597; Law, 1877 C. D. 119, 12 O. G. 940; Elbers, 1877 C. D. 123; Hamilton, 1878 C. D. 16, 13 O. G. 122; Bigelow, 1878 C. D. 65, 13 O. G. 913; Cardwell, 1878 C. D. 124, 15 O. G. 293; Gokey, 1878 C. D. 144, 15 O. G. 295; Sargent, 1879 C. D. 14, 15 O. G. 512; Andrews, 1879 C. D. 99, 16 O. G. 1056; Smith, 1879 C. D. 216, 16 O. G. 630; David, 1879 C. D. 310, 16 O. G. 1139; Preston, 1880 C. D. 125, 17 O. G. 853; Holub et al., 1880 C. D. 127, 17 O. G. 854; McDougall, 1880 C. D. 147, 18 O. G. 130; Van Matteson, 1883 C. D. 52, 24 O. G. 389; Martin, 1883 C. D. 79, 25 O. G. 502; Mefford, 1883 C. D. 95, 25 O. G. 881; Holt, 1884 C. D. 43, 29 O. G. 174. Leading case, cites many court cases.

Applications for letters patent are to be divided only upon lines drawn between separable and distinct parts of the thing invented. No invention can be divided upon an imaginary line, one determined by a mere difference in words, as by the relative breadth of claims to identical subject matter—that is, upon a distinction of scope, not of substance, of the mind, not of matter. Divisional applications which relate to the same machine or structure and contain claims to the constituent parts thereof which interweave with each other or overlap one another, are improper.

Overruled in Drawbaugh, 64 O. G. 155.

Roberts, 1887 C. D. 61, 40 O. G. 573; Sartell, 42 O. G. 295, 1888 C. D. 10; Maxim, 1888 C. D. 126, 43 O. G. 506; Simonds, 1888 C. D. 89, 44 O. G. 449; Gillette, 1888 C. D. 107, 44 O. G. 819; Willcox & Borton, 1888 C. D. 144, 45 O. G. 455; Bullard, 1888 C. D. 169, 45 O. G. 1569; Coe, 1889 C. D. 191, 48 O. G. 119; Iljinsky, 1889 C. D. 192, 48 O. G. 1399; Stearnes, 1890 C. D. 49, 50 O. G. 1768; Woodward. 1890 C. D. 169, 53 O. G. 1090; Speckbauch, 1891 C. D. 36, 54 O. G. 1265; Sawn, 1891 C. D. 44, 54 O. G. 1561; Steinhilber, 1891 C. D. 336, 57 O. G. 1720; Hine, 1892 C. D. 11, 58 O. G. 385; Kerr, 1892 C. D. 61, 58 O. G. 1553.

"Although it appears that certain claims in an application are for a mechanism capable of use in other relations than that which forms the specific subject matter of the application, division will not be required if these claims have elements in common with the more specific claims of the application."

Wendell, 1892 C. D. 95, 59 O. G. 530; Connelly, 1892 C. D. 102, 59 O. G. 787; Hunter, 1892 C. D. 149, 60 O. G. 295; Learned, 1893 C. D. 84, 63 O. G. 1962; Korff, 1894 C. D. 11, 64 O. G. 653; Olan, 1897 C. D. 24, 79 O. G. 861; Burgess, 1897 C. D. 64, 80 O. G. 861.

"It does not follow because the courts would not hold a patent invalid that it is the duty of the Patent Office to allow more than one invention to be claimed in the same application. Whether a given invention or improvement shall be embraced in one, two, or more patents is a matter about which some discretion must be left with the head of the Patent Office.

"The time arrived long since when a proper classification in the Patent Office, so as to facilitate examination and prevent mistakes in the granting of patents, requires that improvements on an old machine having a distinct status in the arts

and classified separately in this office should be presented in separate applications."

Williams, 1898 C. D. 76, 83 O. G. 1346.

Division required where two devices are independent and do not mutually contribute to produce a single result, and the action of one does not in any manner change or affect the action of the other.

Lawrence, 1898 C. D. 142, 84 O. G. 1141; Healey, 1898 C. D. 157, 84 O. G. 1281.

Separate parts of a bicycle distinct and independent inventions requiring divisional applications.

Moore, 1898 C. D. 214, 85 O. G. 152; Crowell, 1898 C. D. 219, 85 O. G. 289; Matthews, 1898 C. D. 34, 85 O. G. 1691; Richter, 1898 C. D. 274, 85 O. G. 1908; Rappleye, 1898 C. D. 289, 85 O. G. 2096; Oxnard & Baur, 88 O. G. 1526; Rouse, 88 O. G. 2242.

BETWEEN APPARATUS OR MACHINE AND PROCESS OR METHOD.

Lowe, 1870 C. D. 39.

Shippen, 1875 C. D. 126, 8 O. G. 727.

Each part of this series ' machines without the others, or some equivalents of the others, would be absolutely useless, and since the invention lies mainly in the series as a complete set, and not in an improvement upon separate parts of an old set, they ought to be allowed in one application, and in one only.

Elbers, 1877 C. D. 55, 12 O. G. 2; Dailey, 1878 C. D. 3, 13 O. G. 228; Cobb, 1879 C. D. 123, 16 O. G. 175; Holub et al., 1880 C. D. 127, 17 O. G. 854; Holt, 1884 C. D. 43, 29 O. G. 174; Blythe, 1885 C. D. 82, 30 O. G. 1321.

Important Case.

The plain provisions of the statute, as well as the weight of judicial opinion and the dictates of what seems to be common sense, require that "arts" (or processes), "machines" (including apparatus), "manufactures" (articles), and "compositions of matter" should be made the subjects of separate and independent patents, except as indicated.

The exceptions are (1) when the product is entirely new, and hence the process also; (2) when the exercise of the process would produce no other product, and when the product could be produced by no other process.

Young, 1885 C. D. 108, 33 O. G. 1390.

The statute does not forbid the joinder in one patent of claims for method and apparatus.

If an applicant comes to the Office alleging a "unitary invention consisting of the process and the product thereof," which are shown to be novel and useful and are "in their nature and operation connected together," such invention may be and ordinarily should be included in one patent. Overrules Blythe, 1885 C. D. 82.

Herr, 1887 C. D. 105, 41 O. G. 463.

Reaffirms Ex parte Blythe as to "statutory classes" of invention. The method is wholly and entirely separate and distinct from the machine. This has been settled by the very highest authority.

Simonds, 1888 C. D. 78, 44 O. G. 445; Tainter, 1889 C. D. 133, 47 O. G. 135.

Important Case.

"While there is no express provision of the statute limiting or controlling the discretion of the Commissioner in embracing more than one invention in the same letters patent, and the courts would not for that reason declare such a patent void, the statute does prohibit the introduction into reissue patents of new matter or other invention than that covered by the original patent. The Supreme Court has held that under this prohibition no new matter could be introduced; that process and apparatus are separate and distinct inventions, and that when a patent for one has issued, although the other was distinctly shown, a reissue for both could not be maintained. (Burr v. Duryee, 1 Wall, 531; James v. Campbell, 104 U. S. 356; Powder Co. v. Powder Works, 98 U. S. 126; Heald v. Rice, 104 U. S. 737.)

"The opposite conclusion has been reached in regard to process and product when both were new and the process could produce no other product and the product could be made by no other process. This conclusion is based upon the premise that such process and product constitute one single invention. It must be deemed settled by the highest authority that such processes and products are not separate and distinct, but unitary inventions, and that the process and product may be regarded and claimed as parts of such invention, much as different elements in a combination may be separately claimed. This conclusion finds satisfactory support in the nature of the invention itself, as well as in the character of legal property residing in it.

"This conclusion excludes all other cases of process and

product, such as when either process or product is not new, or when the product can be made by some other process or the process will produce some other product."

McMahan, 1889 C. D. 169, 48 O. G. 255; Lord, 1890 C. D. 16, 50 O. G. 987.

"Although a process and an apparatus for carrying out the process are separate inventions, they are not necessarily independent inventions within the meaning of Rule 41, and when they are dependent upon each other and mutually contribute to produce a single result they may be joined in one application.

"Rule 41 does not require that in order to authorize a single patent for several distinct inventions which mutually contribute to a single result there must be such intimacy of interconnection and cooperation as to result in a third invention or combination.

"Perhaps a good working rule would be that process and apparatus are presumptively connected in design and operation where the examination of both belongs to the same division of the Office."

Norwood, 1890 C. D. 29, 50 O. G. 1129; Hyde, 1890 C. D. 41, 50 O. G. 1293; Chambers, 1890 C. D. 101, 51 O. G. 1943.

"When an application containing claims for a process and a described apparatus for practicing the process has been divided in compliance with the requirements of the Office, and patent thereafter issues for the apparatus, the Examiner is not warranted in subsequently rejecting the application for the process on the ground that the patent for the apparatus disclosed and covered the process. Such action is in effect a reversal of his decision, requiring division, and if his present action be correct division should not have been required."

Lillie, 1890 C. D. 181, 53 O. G. 2041; Forbes v. Thomson, 1890 C. D. 185, 53 O. G. 2042; Hopkinson, 1891 C. D. 4, 54 O. G. 264; Perkins, 1891 C. D. 63, 55 O. G. 139; Curtis, 1891 C. D. 206, 57 O. G. 1128.

"Division of an application as between claims for apparatus and claims for process is unnecessary where no wider range of search is required for the two than for the one."

Kerr, 1892 C. D. 61, 58 O. G. 1553; Hafely & Rediefson, 1893 C. D. 94, 64 O. G. 559; Tymeson & Borland, 1898 C. D. 48, 83 O. G. 503.

A woven fabric, a process of producing the fabric and winding yarn, an apparatus for winding yarn on the spool, and a yarn spool or bark spool are each separate and independent

inventions and should form the subject of separate applications.

Boucher, 88 O. G. 545.

Leading Case.

Process and apparatus are separate and independent inventions and claims covering both should not be joined in the same application.

Decision based upon the "statutory classification" elaborated in Ex parte Blythe; on the recognition by the courts of these different classes of invention; on the increased revenue to the office from separate applications; on the requirements of the examining system; on the belief that the time has come to establish stability of practice on this question.

BETWEEN APPARATUS OR MACHINE AND PRODUCT.

Murray & Wuterich, 1873 C. D. 96.

A claim for a machine and a claim for the product of the machine will not be allowed in the same application. Each must be presented in a separate application for a distinct patent.

Lupton, 1874 C. D. 40; Chamberlin, 1874 C. D. 111; Junker & Wolf, 1877 C. D. 10, 11 O. G. 110; Elbers, 1877 C. D. 55, 12 O. G. 2; Dailey, 1878 C. D. 3, 13 O. G. 228; Cobb, 1879 C. D. 123, 16 O. G. 175; Wintherlich, 1879 C. D. 171, 1 O. G. 404; Wintherlich et al., 1879 C. D. 240, 16 O. G. 808; Tyne, 1880 C. D. 2, 17 O. G. 56; Bancroft & Thorne, 1881 C. D. 55, 20 O. G. 1893; Holt, 1884 C. D. 43, 29 O. G. 174; Hafely & Redlefsen, 1893 C. D. 94, 64 O. G. 559.

BETWEEN PROCESS OR METHOD AND PRODUCT.

Stow, 1873 C. D. 30; Mayall, 1873 C. D. 134; Lupton, 1874 C. D. 40; Elbers, 1877 C. D. 55, 12 O. G. 2; Arkell, 1877 C. D. 73, 11 O. G. 1111; Dailey, 1878 C. D. 3, 13 O. G. 228; Covv, 1879 C. D. 123, 16 O. G. 175; Du Motay et al., 1879 C. D. 269, 16 O. G. 1002; O'Neill, 1879 C. D. 290, 16 O. G. 1049; Holt, 1884 C. D. 43, 29 O. G. 174; Pastor Perez de la Sala, 1888 C. C. 3, 42 O. G. 95; Simonds, 1888 C. D. 78, 44 O. G. 445; Tainter, 1889 C. D. 133, 47 O. G. 135; Fefel, 1891 C. D. 176, 57 O. G. 409; Greenfield, 1892 C. D. 5, 58 O. G. 274; Hines, 1892 C. D. 164, 60 O. G. 576; Hafely & Redlefsen, 1893 C. D. 94, 64 O. G. 559; Demeny, 1893 C. D. 125, 64 O. G. 1649.

"Within the limits of validity of the grant claims for distinct but dependent inventions may be joined in the same application or be made in separate applications, at the option of the applicant. This general rule leaves to the discretion of the Office the requirement of division in those exceptional cases in which the inconvenience resulting from a single application amounts to the necessity to divide, and leaves room, also, for the exercise of that inherent discretion necessarily left on this subject to the Office (Bennett v. Fowler, 8 Wall. 445."

Kny, 1893 C. D. 131, 65 O. G. 1403; Thomson, 1894 C. D. 8, 66 O. G. 653.

"Where a process and its product are claimed in one application the Office will not concern itself with the inquiry whether the article might be made by any other process or whether the process will necessarily result in the particular product for the purpose of determining whether division should be ordered between process and product.

"Process and its product concern inventions which are so related that they may, at the option of the applicant, be placed in the same application, he taking all the risks of future difficulties in the courts, and it is generally thought to be the better practice to include them both in one application, since division between process and product may produce confusion in the arts and conflicting interests, as intimated by the court in McKay v. Dibert (C. D. 1881, 238; 19 O. G. 1351; 5 Fed. Rep. 587), since no patent has been declared void by reason of the joinder of such claims, while many have been held to be valid, since manifest advantages would follow from one uniform rule as to division, and more important than all else, since division or joinder approaches, if it does not present, a question of right in the applicant to choose between two courses, both of which are open to him, it is broadly announced that division in such cases will not be required."

Tymeson & Borland, 1898 C. D. 48, 83 O. G. 503.

BETWEEN GENUS AND SPECIES.

Atwood, 1869 C. D. 98.

It belongs to the Commissioner to determine whether a patent shall cover more than one invention or whether all the inventions or parts of an invention described in an application shall be included in one patent or several.

The case of the Suffolk Co. v. Hayden in no way controls the practice of the Patent Office.

Every new device described in an application should be patented under it or under a division of it.

Cited in Numerous Cases.

Eagle, 1870 C. D. 138.

Genus and species. Can not claim two species in same application.

Bogart, 1876 C. D. 162; Howland, 1877 C. D. 120; Du Motay et al., 1879 C. D. 269, 16 O. G. 1002; Freese, 1890 C. D. 133, 17 O. G. 1095; Smith, 1888 C. D. 131, 44 O. G. 1183; Neiswanger, 1890 C. D. 37, 50 O. G. 1132; Oxnard & Baur, 88 O. G. 1526.

BETWEEN COMPOSITIONS OF MATTER.

Loeser, 1876 C. D. 104, 9 O. G. 837; Lippincott, 1879 C. D. 212, 16 O. G. 632; Hentz, 1884 C. D. 6, 26 O. G. 437.

BETWEEN DESIGNS.

Brower, 1873 C. D. 151; Tieman, 1877 C. D. 1, 11 O. G. 1; Rogers and Huggins, 1878 C. D. 62, 13 O. G. 596; Beattie, 1879 C. D. 142, 16 O. G. 267; Patitz, 1883 C. D. 101, 25 O. G. 980; Gerard, 1888 C. D. 37, 43 O. G. 1235; Petzold, 1891 C. D. 95, 55 O. G. 1651; Petzold, 1891 C. D. 97, 55 O. G. 1653; Bennett, 1891 C. D. 100, 55 O. G. 1820; Hess & Hess, 1891 C. D. 142, 56 O. G. 1334; Petzold, 1892 C. D. 235, 61 O. G. 1789; Haggard, 1897 C. D. 47, 80 O. G. 1126; Hill & Renner, 1898 C. D. 38, 82 O. G. 1988; Brand, 1898 C. D. 62, 83 O. G. 747; Wiessner, 1898 C. D. 236, 85 O. G. 937; Sherman & Harris, 89 O. G. 2067.

QUESTIONS OF PRACTICE.

Nichols, 1870 C. D. 71; Bramwell, 1870 C. D. 76; Heginbotham, 1875 C. D. 93; Siemens, 1877 C. D. 75, 11 O. G. 969; Unsworth, 1879 C. D. 69, 15 O. G. 882; Hogan, 1879 C. D. 253, 16 O. G. 907; Emerson, 1880 C. D. 143, 17 O. G. 1451; Wheeler, 1883 C. D. 12, 23 O. G. 1031; Henderson v. Reese, 1883 C. D. 67, 25 O. G. 191; Long, 1883 C. D. 104, 25 O. G. 1189; Rohn, 1883 C. D. 106, 25 O. G. 1190; Finch, 1884 C. D. 1, 26 O. G. 273; Buell, 1884 C. D. 4, 26 O. G. 437; Clarke, 1884 C. D. 16, 26 O. G. 824.

Derby, 1884 C. D. 21, 26 O. G. 1208.

Abandonment of an invention is not to be presumed from

the fact that it is shown and described, though not technically claimed in a patent, if there is coupled with such description and disclaimer a notice and reservation of the right and declaration of the purpose to claim such invention in a subsequent application, which is in fact filed with reasonable diligence.

Ex parte Rolin, 25 O. G. 113, overruled.

Upton, 1884 C. D. 26, 27 O. G. 99; Gaboury, 1886 C. D. 28, 37 O. G. 217; Ransom, 1887 C. D. 22, 39 O. G. 119; Roberts, 1887 C. D. 61, 40 O. G. 573; Maxim, 1888 C. D. 26, 43 O. G. 506; Simonds, 1888 C. D. 89, 44 O. G. 449; Gillette, 1888 C. D. 89, 44 O. G. 819; Smith, 1888 C. D. 131, 44 O. G. 1183; Regan, 1888 C. D. 161, 45 O. G. 589; Bullard, 1888 C. D. 169, 45 O. G. 1569; Carter, 1889 C. D. 100, 46 O. G. 1391; Neiswanger, 1890 C. D. 37, 50 O. G. 1132; Forbes v. Thomson, 1890 C. D. 61, 51 O. G. 297; Bailey, 1890 C. D. 123, 52 O. G. 608.

Feister, 1890 C. D. 167, 53 O. G. 1089.

The formal abandonment of an application should not be required as a condition precedent to allowing another application of the same inventor pending concurrently and in condition for allowance to proceed to issue, nor should the Examiner require the erasure of any claims which would be allowed if no other application awaited consideration. The true course to be pursued is that pointed out in Ex parte Gaboury (C. D. 1886, 28, 37 O. G. 217).

Forbes v. Thomson, 1890 C. D. 185, 53 O. G. 2042.

Fuller, 1891 C. D. 243, 57 O. G. 1883.

An action of an Examiner that amounts in effect to a holding that an alleged divisional application covers matter that could not be legitimately divided out of the earlier application of which it purports to be a division, is reviewable by the Commissioner on petition and does not involve a question that can be taken to the Examiners-in-Chief by way of appeal.

Hine, 1892 C. D. 11, 58 O. G. 385; Van Depoele v. Daft, 1892 C. D. 15, 58 O. G. 520; Freeman, 1892 C. D. 20, 58 O. G. 522; Fuller, 1892 C. D. 27, 58 O. G. 804; Sprague v. Hunter, 1892 C. D. 115, 59 O. G. 1605; Feister, 1892 C. D. 203, 61 O. G. 152; Perkins, 1892 C. D. 222, 61 O. G. 1015; Cahill, 1893 C. D. 1878, 63 O. G. 1815; Drawbaugh, 1893 C. D. 85, 64 O. G. 155.

Henry, 1893 C. D. 88, 64 O. G. 290.

A divisional application should only contain matter carved out of the parent case; but if the matter has been fully disclosed in the earlier application, although not reached by any claim or statement of invention, such disclosure should be sufficient to secure to the applicant the benefit of the date of the parent case.

The matter claimed additional to what was claimed in the parent case should always be supported by a proper supplemental oath, or if claimed in the divisional application as first filed the oath prescribed by Rule 46 should be correspondingly changed.

Seymour, 1893 C. D. 127, 65 O. G. 751; Silvers (trademark), 1894 C. D. 54, 67 O. G. 811; Richardson v. Leidgen, 1896 C. D. 63, 77 O. G. 153; Phelps v. Hardy, 1896 C. D. 63, 77 O. G. 631; Hunter v. Wightman, 1897 C. D. 175, 81 O. G. 1788; Barry, 1898 C. D. 9, 82 O. G. 337; Osborne, 1898 C. D. 15, 82 O. G. 894; Keyser, 1898 C. D. 65, 83 O. G. 915.
Videl, 1898 C. D. 122, 84 O. G. 808.

Divisional application takes benefit of the filing date of its original.

Richter, 1898 C. D. 276, 85 O. G. 1908; Bullier, 88 O. G. 1161; Freucht, 88 O. G. 2068; Claussen, 88 O. G. 2242; Farquhar, 89 O. G. 706.

The above report is dated January 19, 1900.

The reprint of the rules of February 28, 1900, replaced the paragraph added July 18, 1899, by the following:

"Claims for a machine and its product must be presented in separate applications.

"Claims for a machine and the process in the performance of which the machine is used must be presented in separate applications.

"Claims for a process and its product may be presented in the same application."

This rule was considered by the Supreme Court of the United States in United States ex rel., Steinmetz v. Allen, Commissioner, etc., 1904 C. D. 703, 109 O. G. 549. The 6th and 7th head notes of this case read as follows:

"6. The provision which compels the separation of claims for a process and claims for its apparatus is invalid, because it precludes the exercise of any judgment, however related or connected they may be.

"7. The statute gives the right to join inventions in one application in cases where the inventions are related, and it can not be denied by a hard and fixed rule which prevents such joinder in all cases."

This additional matter was canceled in 1904, 111 O. G. 584. Upon the subject of division, see further, papers read before the Examining Corps of the U. S. Patent Office.

"Title Practice in Cases Involving Division."

W. H. Whitten, Jr., Dec. 14, 1916, notes to Rule 42.

"Title Practice Relating to Division."

Loren A. Sadler.

Read before the U. S. Examining Corps, U. S. Patent Office, Dec. 17, 1914.

Rule 42. Division of Application.

If several inventions, claimed in a single application, be of such a nature that a single patent may not be issued to cover them, the inventor will be required to limit the description, drawing, and claim of the pending application to whichever invention he may elect. The other inventions may be made the subjects of separate applications, which must conform to the rules applicable to original applications. If the independence of the inventions be clear, such limitation will be made before any action upon the merits; otherwise it may be made at any time before final action thereon, in the discretion of the examiner. A requirement of division will not be repeated without the written approval of a law examiner. After a final requirement of division, the applicant may elect to prosecute one group of claims, retaining the remaining claims in the case with the privilege of appealing from the requirement of division after final action by the examiner on the group of claims prosecuted.

CONSTRUCTIONS.

The requirement of the approval of a Law Examiner in this and some other cases, is an innovation of the present

administration. A part of the Commissioner's Report to Congress relating to this subject is inserted after the notes.

The last clause in the rule had its origin in Ex parte King, 190 O. G. 548.

(1) PROCEDURE.
(2) FILING DATE.
(3) AMENDMENT REQUIRING DIVISION.
(4) COMBINATION, SUBCOMBINATION AND ELEMENTS.
(5) OFFICE CLASSIFICATION.
(6) GENERIC AND SPECIFIC.
(7) ELECTION TO PROSECUTE ONE OF SEVERAL INVENTIONS.
(8) PROCESS, PRODUCT, APPARATUS, ETC.
(9) PARTICULAR DEVICES.
(10) APPEALS.

(1) *Procedure.*

A requirement for division between claims darwn to two variations of an invention does not preclude the rejection of a divisional application containing one set upon a patent issued to applicant upon the other.

Isherwood, 231 O. G. 1211.

An application by two parties can not be a division of an application by three joint parties.

Hortzborg and Wohl, 184 O. G. 805.

Where in requiring an amendment an Examiner chooses to give an action on the merits, the action should extend to all of the claims in order that the applicant may not be mislead in selecting the species to be retained. (100 O. G. 234; 156 O. G. 257.)

Burk, 184 O. G. 288.

Pressed by a technical and stubborn examiner, who seems to have been pursuing what has been called the "division fad."

Toledo Computing Scale Co. v. Moneyweight S. Co., 178 F. R. 562.

If after a requirement of division affirmed by the Commissioner, the requirement is complied with the decision of the Commissioner does not preclude the Examiner from requiring a division of one of the divided applications.

McHall, 135 O. G. 1361.

In requiring a division "it is not the duty of the Examiner to make an exhaustive search of the art, but the nearest references readily available should in each case be cited."

Moorehead, 132 O. G. 1586.

The law as we understand it does not favor the multiplica-

tion of applications and of patents for devices so closely related to each other, when they can properly be included in one application and in one patent.

Norden v. Spaulding, 114 O. G. 1829, C. P. D. C.

The question of division must be settled before an examination on the merits is had.

Snyder, 1904 C. D. 242, 110 O. G. 2236; Shaft Bearing.

Where a division has been required the divisional application should not be rejected for want of proper line of division unless the patent would undoubtedly be void if issued.

Davis, 1904 C. D. 85, 109 O. G. 1068.

The Examiner inadvertently made his action final requiring a division. In the petition to review the action of the Examiner the question of division was considered. Swing back car seat.

Pickles, 1904 C. D. 75, 109 O. G. 275.

An application rejected on the ground that the claims were not divisible from those upon which a patent was granted to applicant.

Hallowell, 1903 C. D. 268, 105 O. G. 1533; Pressed Metal Hanger.

For a later application to be a division of a prior application the invention disclosed in the latter application must contain nothing more than what was disclosed in the prior application. Upsetting Tool for Drills.

Hicks, 1903 C. D. 148, 104 O. G. 309.

Process of making and reproducing sound records. It is not intended to hold that the process of casting from a die is not an independent invention from the die and process of making it, but merely that the claims as now presented contain such limitations that it is impossible to draw any proper line of division.

Clay, 1902 C. D. 449, 101 O. G. 2567.

We do not mean to say that there may not be a way in which the power to enact Rule 41 might be brought in question as necessarily involving the denial of a substantial right under the law.

History of the rule S. C. D. C. Frasch, 1902 C. D. 560, 100 O. G. 1977.

The fact that a patent issued with two sets of claims in it is no reason that the error should be repeated.

Cavanagh, 1902 C. D. 113, 98 O. G. 2588-9.

The practice announced in some of the above decisions of rejecting aggregation claims preparatory to requiring division

will not be followed hereafter, but the question of division will first be settled.

Mansfield & Hayes, 98 O. G. 2363.

Only a cursory action should be taken on requiring division.

Reid, 96 O. G. 2060.

If the independence of the inventions is clear it is not necessary to cite references or state reasons for requiring division.

Same, 1901 C. D. 123.

The requirement of a division of an application presupposes that matter exists which might constitute the subject of two or more patents.

Pantsch, 77 C. D. 43, 11 O. G. 597.

(2) *Filing Date.*

The original application having been filed previous to Jan., 1898, the divisional application filed subsequent to that date is subject to the old law limiting the time to amend to two years.

Balzar, 101 O. G. 2824.

The divisional application has the benefit of the filing date of the original case as a date of constructive reduction to practice and under the statute relating to public use.

Waterman, 1902 C. D. 235, 100 O. G. 234.

(3) *Amendment Requiring Division.*

It is no reason for refusing an amendment that it would require the division of the application.

Law, 1904 C. D. 292, 111 O. G. 1039; Krause, 1904 C. D. 292, 111 O. G. 1039.

In the case where an applicant asserts claims for the first time by amendment to an independent invention after the Examiner has acted upon the case as originally presented, the Examiner should not require the applicant to elect which set of claims he will retain, but should require him to cancel the new set. Method for producing color photographs.

Selle, 1904 C. D. 221, 110 O. G. 1728.

If a division is required, an amendment which would still require division should not be entered.

Metzger, 1902 C. D. 407, 101 O. G. 1612.

While the rule permits a process and products to be joined, nevertheless in a proper case the Office may require a division between them.

E. P. Erdman, 1900 C. D. 197, 93 O. G. 2531.

It is the settled practice of the Office that an amendment which would require a division should not be entered.

E. P. Murmann, 1900 C. D. 183, 93 O. G. 1721.

If the mechanism for operating a self-playing instrument is a separate invention from the instrument, still a combination of the two may be admissible. Rewinder for music sheets, etc.

Gally, 1903 C. D. 480, 107 O. G. 1660.

(4) *Combination, Subcombination, and Elements.*

Claims to a particular form of propeller should be divided from claims to the general ship construction. Roller Boat.

Belair, 1903 C. D. 426, 107 O. G. 540.

Division should not be required between claims to an apparatus for painting and claims to the same combination, including as an additional element a mixer which adapts the device for use as a cleaner. The structure is unitary and the claims are related as combination and subcombinations. Painting for Cleaning Apparatus.

Vegiard Dit. Labonte, 1903 C. D. 317, 106 O. G. 766.

While the claim, if presented in a separate application, might be properly classified in the class of brush and broom handles, it is nevertheless a subcombination of the combinations covered in claims 1 to 8, inclusive, and it is not shown that it has become an independent subject matter of invention and manufacture from the general invention covered in the preceding claims. Claim 9 may be prosecuted in the same application with claims 1 to 8. Mop.

Davis, 1903 C. D. 280, 105 O. G. 1783.

Though each of these claims states that the subcombinations defined by it is for use in a pump-driving apparatus, the subcombination is a separate and independent invention from the general pump construction in which it is used. Electric Pump.

Hall & Fraser, 1903 C. D. 233, 105 O. G. 743.

The claims bear the relation of combination and subcombination claims. They do not cover separate and independent inventions. As the structure covered by claims 1 and 2 is not adapted for independent use as a buckle, but is peculiarly designed for use in a harness construction, it is held that the requirement for division should not be insisted upon.

Wehner, 1902 C. D. 479, 101 O. G. 3106.

Motor vehicle and feeder and condensor required to be divided.

The claim to the latter two being combination claims and not to specific construction should not be required to be separated.

Tyson, 1902 C. D. 476, 101 O. G. 3105.

A copyholder and clamp required to be divided notwithstanding there were claims to combinations of the two. Copyholder.

Williamson, 1902 C. D. 459, 101 C. D. 2571.

Churn, the motor and combination of the paddle therewith should not be divided.

Lemire, 1902 C. D. 396, 101 O. G. 1607.

Motor and washing machine. Each claim covers a motor and none cover anything beyond the frame to be oscillated thereby division not required.

Cramer & Haak, 1902 C. D. 352, 101 O. G. 220.

Claims 1 and 2 are drawn specifically to an umbilical structure; claims 3, 4 and 5 are not so limited; but they nevertheless cover the unitary structure of the invention. Division not required.

Alminana, 1902 C. D. 293, 100 O. G. 1331.

A clutch is a distinct and independent invention from the mechanism in which it is employed. A division should be made.

The introductory words, "in a lawn mower" does not make it a unitary invention.

Adams, 1902 C. D. 252, 100 O. G. 453.

Leveling devices alone for billiard tables are classified separately from the table structure, but when the levelers are made a part of the combination this combination is classified with the table structure and not with the levelers.

In the present case there are not separate claims for the leveler which can be separated from the table structure. Division should not be required.

Burrows, 1902 C. D. 250, 100 O. G. 452.

A divisional application can contain only matter carved out of the original case. A mechanical application can not be carved out of a design.

Goldman, 1902 C. D. 238, 100 O. G. 234.

Claims distinguished from each other by the addition of an element, held not divisible especially if it does not appear that the two have acquired distinct status in the art.

Cushing, 1902 C. D. 256, 100 O. G. 681.

Each of these inventions is capable of separate and independent use. They should not, therefore, be presented in the same application. They are useful otherwise than as elements of combination.

Moriarty, 1902 C. D. 201, 99 O. G. 2549-50.

Division ought not to be required between elements of a

combination. Claims to an alleged combination and claims for one of the elements thereof. Such claims must be considered upon their merits, for there is no warrant for the requirement of division between the claims for the combination and those for the single element.

Kugler, 1902 C. D. 84, 98 O. G. 2173.

Where claims for two elements were presented in a combination the requirement for division was avoided by inserting a claim for the combination of such elements.

Kugler, 1902 C. D. 84, 98 O. G. 2173.

It does not appear that the devices covered by the claims are such separate articles of manufacture as would necessitate a separate application for each. They are not useful in other relations or separately complete machines or articles.

Whitney, 1901 C. D. 218, 97 O. G. 2305.

Division should not be required between claims covering operating mechanism of a locomotive hand car and claims for subcombination of such mechanism where it does not appear that these subcombinations are useful in other relations or they are such as would be separate articles of manufacture.

Henderson, 1901 C. D. 201, 97 O. G. 1699.

Apparently if part of one operation is performed by two mechanisms they should not be divided even if one could have done it all.

Prossor, 1901 C. D. 164, 97 O. G. 958.

While each invention tends to improve the grain drill as a whole it does not follow that they may mutually contribute to a single result.

Pelton, 1901 C. D. 37, 95 O. G. 633.

If the inventions are independent in their actions and differently classified in the Office they may not be joined though forming constituent parts of one structure.

Brownell, 1901 C. D. 31, 94 O. G. 988.

It is not broadly true that in all cases where a party makes and is entitled to a combination claim, he is also entitled in the same case to claim as many subcombinations, i. e., elements in that combination as he desires. The question is whether those elements and subcombinations are useful in other relations and are mere improvements on independent devices which have acquired a distinct status in the art and classification.

Johnston, ex parte, 1900 C. D. 125, 92 O. G. 1235.

Division should not be required between a claim to a combination of elements in a grinding machine and a claim for

an attachment to be used in that machine for grinding curved surfaces, there being no separate classification of the devices.

Bancroft & Thorne, 1900 C. D. 33, 90 O. G. 1539.

Where there are claims for specific structure and combinations of the structures and the structures have acquired a distinct status in the arts, division should be required between the claims for one of the structures and combination of the structures on the one hand and the claims for the other structure on the other hand.

Korff, 1893 C. D. 120, 64 O. G. 1397.

Where certain devices were claimed separately and also in combination, division should not be required unless one or each of such devices could be used in other relations and belonged to a class that had acquired a distinct status in manufacture to trade.

Learned, 1893 C. D. 84, 63 O. G. 1962.

Where applicant's machine was in its entirety a mangle or ironing machine, the Examiner properly required division as to certain claims in the application which related purely to a belt-shifting device.

Wendell, 1892 C. D. 95, 59 O. G. 630.

Although it appears that certain claims in an application are for mechanism capable of use in other relations than that which forms the specific subject matter of the application, division will not be required if these claims have elements in common with the more specific claims of the application.

Kerr, 1892 C. D. 61, 58 O. G. 1553.

In order to necessitate the dividing out of elements, when the combination as a whole is held to be patentable, it must appear *first*, that the elements or parts of the invention which are to be divided out have obtained a definite place in the art and manufacture, and *second*, that they can be used in other relations.

Speckbauch, 1891 C. D. 36, 54 O. G. 1265.

When one particular element of a machine is dependent upon and acts with the other elements thereof to produce a single result, it may be claimed in the same application with them without regard to the office classification.

Coe, 1889 C. D. 191, 48 O. G. 119.

If the devices are so united as to form a combination they may be united in one application.

Herr, 1887 C. D. 105, 41 O. G. 463.

It is not the policy of the Office to require a division where the several parts composing the device are intimately con-

nected and operate in the accomplishment of a specific result.

Freese, 80 C. D. 133, 17 O. G. 1095; Carter & Dwyer v. Perry & Dickey, 75 C. D. 111.

Where elements forming parts of two foreign patents are included in one combination a division should not be required.

Unsworth, 1879 C. D. 69, 15 O. G. 882.

Where an invention lies mainly in a series of devices forming a complete set, the operation of each in a certain order being necessary to accomplish the desired result, a division should not be required.

Gokey, 1878 C. D. 144, 15 O. G. 295; Shippen, 1875 C. D. 126, 8 O. G. 727.

Combinations parts of one machine.

If there is a proper combination presented a division can not be required on the ground that some of the elements are old.

Wenzel, 1880 C. D. 104, 10 O. G. 512.

A single patent will not be granted for a combination of a principal mechanism with a number of different elements when each of said elements in combination with the principal mechanism forms a machine for a distinct and separate purpose.

Shepard, 1872 C. D. 244, 3 O. G. 522.

An article of manufacture may be claimed in the same application with combinations of said article with other elements.

Adams, 1873 C. D. 18, 3 O. G. 150.

(5) *Office Classification.*

If the claims would be classified in the same subclass it does not follow that the requirement for division was improper, for it is well settled that the Office classification is not controlling on the question of division, but is evidential only as to the independence of the inventions.

Strimban, 180 O. G. 323 (cases cited).

As a general rule applicants are required to restrict the claims of their application in accordance with the Office classification. When therefore there are claims so independent that each requires a distinct and independent search, then clearly the applicant should restrict his claims.

When, however, the inventions, though distinct, are dependent upon each other and the field of search for all is the same then ordinarily there is no reason for requiring division.

Kalsomine composition and process of producing same.

Adams, 1903 C. D. 299, 106 O. G. 541.

Division should be required between an apparatus for manufacturing roofing paper and the specific structure of the

cooling and drying apparatus which is used in the complete machine. Because the two have attained to distinct places in the art and are separately classified. Apparatus for manufacturing of roofing paper.

Kidde, 1903 C. D. 278, 105 O. G. 1782.

Office classification is not and never has been the absolute test upon the question of division. It is merely evidence.

Davison, 1902 C. D. 392, 101 O. G. 1371.

Two inventions may not be included in one application because they are classified alike.

Davison, 1902 C. D. 392, 101 O. G. 1371.

If the two inventions are recognized by the Office classification and also by inventors as separate inventions, and if they are capable of separate use and sale, the application should be divided. (Vessel, hull and rudder, propelling.)

Bustin, 1902 C. D. 285, 100 O. G. 1111.

They are not separately classified by the Office. It is true that each of the mechanisms is separately constructed and either one of them can be removed from the machine without disturbing the other; nevertheless each one so coacts with the other as to mutually contribute to produce a uniform result, and in view of the further fact that they are not recognized by inventors and manufacturers as having a distinct place in the arts manufactures in that they are not separately manufactured and sold, the requirement of division should not be insisted upon.

Smith, 1902 C. D. 196, 99 O. G. 2547.

Office classification, etc.

Brown, 99 O. G. 2320.

Office classification, etc.

Brill, 1902 C. D. 189, 99 O. G. 2319.

Furthermore these various devices are separate subjects of invention as is shown by the numerous patents contained in the subclasses referred to by the Examiner and it appears that they are to some extent separate subjects of manufacture and sale. Under these circumstances it is well settled that division should be required.

The parts of a typewriter performing its different functions required to be divided.

Berry v. Fitzsimmons, 1902 C. D. 153, 99 O. G. 862.

Office classification is not the sole test of unity of diversity of invention; it is only one test.

Pelton, 1901 C. D. 37, 95 O. G. 633.

Discussion of Office classification as affecting the question of division.

Ex parte Casler, 1900 C. D. 15, 90 O. G. 440.

The matter of subclasses having acquired a distinct place in the arts is in itself no ground for division.

Carr, 1894 C. D. 11, 66 O. G. 653.

Where contrivances which mutually contribute to produce a unitary result are essential in producing the result, it should make no difference whether they belong to one or a dozen classes.

Sol Kuh, 1876 C. D. 190, 10 O. G. 587.

(6) *Generic and Specific.*

Apparently condemns the Patent Office rule requiring a division of specific claims from generic.

"This case is a striking example of the unfortunate result of too close adherence to rule."

Benjamin Electric Mfg. Co. v. Dale Co., 158 F. R. 618; see Weston, 173 O. G. 286; 141 F. R. 286.

Two species may not be claimed. Lubricator.

Brown, 1904 C. D. 50, 108 O. G. 1052.

The substance is no less impervious because at intervals it has been cut away. The word impervious seems to have been confused with the word imperforate. Not two species of the invention. Medicated Plaster.

Nash, 1903 C. D. 181, 104 O. G. 1896.

In view of the fact that claims 1 to 5 can be read on both figures and claims 6 to 10, inclusive, are specific to but one of the figures, it follows that all of the claims may be presented in the same application, and division should not be required. Traveler's Guide.

MacKaye, 1903 C. D. 112, 103 O. G. 888.

One generic and only one specific invention in one application. (Refers to 141 F. R. 989 and 158 F. R. 617.)

Where certain claims are broad to all forms and other claims are specific to one form of the invention, and another set of claims cover a construction which is shown only in connection with one specific form, but can be used as well with both forms. Held that the several claims bear the same relation to each other of combinations and subcombinations, and are not specific to different forms of the same invention. Division should not be required.

Shevill, 1902 C. D. 469, 101 O. G. 2824.

Improvements in the elemental machine which go to perform a certain office in a sewing machine, the mechanism for performing that function being old, must be divided.

Lyons, 1902 C. D. 430, 101 O. G. 2078.

Claim 1 being generic to all forms of the invention, and claims 2 and 3 being specific, a division should not be required even when the first claim is unnecessarily limited by a specific form of one element.

Metzger, 1902 C. D. 407, 101 O. G. 1612.

A spring-holding device is a generic claim covering either one or two springs. The application need not be divided between one and two spring-holding devices.

Plumley, 1902 C. D. 353, 101 O. G. 447.

The requirement that the application shall be limited to one specific claim under the generic claim is equivalent to the requirement of division. Under Rule 42, the divisibility of the application is clear and therefore it is proper to require division before action.

Worden, 1902 C. D. 176, 99 O. G. 1622-1623.

(7) Election to Prosecute One of Several Inventions.

No reason is seen for permitting an applicant to nullify an election deliberately made and after the application has been prosecuted to an allowance on one invention present claims for an entirely different invention even for the purpose of interference.

Stimson, 226 O. G. 699.

Ex parte King, 190 O. G. 548, not in conflict with rule; anticipated Stampel, 197 O. G. 907, objections considered.

An election may be made by the original presentation of claims.

Michell, 196 O. G. 525.

The adoption of a claim under Rule 96 does not constitute an election of species.

Burk, 184 O. G. 288.

Two species sought to be included—"While the Examiner's requirement of division is right the applicant should be required to elect which one of the specific inventions he desires to prosecute in this application." Sash Lock.

Butcher, 1904 C. D. 60, 108 O. G. 1587-88.

Having prosecuted to rejection a claim for a process and product an applicant can not shift his ground and insert a claim to the apparatus by which the process is carried out. Construction of cast iron pipes.

Ferrell, 1903 C. D. 316, 106 O. G. 766.

The fact that in the first action references are cited against only one of the inventions does not permit applicant to shift his ground having elected to prosecute the other.

Randall & Luck, 1901 C. D. 47, 95 O. G. 2063.

(8) *Process, Product, Apparatus, Etc.*

A process and an apparatus by which it is performed, are distinct things. They may be found in one patent; they may be made the subject of different patents. So may other dependent and related inventions.

If patented separately, a foreign patent for either would not affect the other. (Quoted from 213 U. S. 301-318.)

Fireball Gas Tank & I. Co. v. Commercial Acetylene Co., 198 F. 655.

"Normally process and product form two inventions; not one. Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U. S. 301; 29 Sup. Ct. 495 L. Ed. 805."

Adrian Wire Fence Co. v. Jackson Fence Co., 190 F. R. 195.

An invention is not made different by the mere fact that one is disclosed in a claim for an apparatus and the other in the form of a method or process. Where the one invention is disclosed, but one patent can issue.

Rowe, 192 O. G. 519-520.

An applicant having presented claims for process and article and a requirement for division having been made, can not cancel the process claims, get an action on patentability, and then reinsert process claims.

Scott and Deats, 147 O. G. 520.

Process an apparatus claims may in some cases be so related as to make it proper to include them in one application. A rejection should be based upon the conclusion that the particular process and apparatus are not so related as to warrant including them in one case. Grain Binders for Self-Binding Harvesters.

Ament, 116 O. G. 596.

Process and Apparatus. The process and the apparatus can be included in separate patents only because they are separate inventions. and it is believed that the validity of these patents is not effected by the question whether they are issued on the same day. Regulating Alternating Current. Electromotive Force.

Stuart, 1904 C. D. 485, 113 O. G. 850.

Rule 41 (old) invalid as to process and apparatus.

Frach, 1904 C. D. 716, 109 O. G. 554.

Joinder of invention for machine and process.

Rule is contrary to statute. U. S. S. C. directed mandamus to court to allow appeal from an order requiring division.

Steinmetz v. Allen, 24 Sup. Ct. Rep. 416; 109 O. G. 549; 1904 C. D. 703.

The process of making a matrix and the article cast in it are seperate inventions. Art of making matrices for casting relief work.

Jennens, 1904 C. D. 58, 108 O. G. 1587.

It is, of course, true that a process is always a distinct invention from a composition of matter where, however, the process and the composition produced by it are so closely related as in this case, they may properly be regarded as dependent inventions, and it is held they may be retained in one application. Artificial fuel and the process of making same.

Dallas, 1903 C. D. 325, 106 O. G. 996.

Process and article. The facts are such in this case as to warrant the requirement of division. Rubber Foot Covering.

Very, 1903 C. D. 318, 106 O. G. 766.

So far as appears the process claimed necessarily results in the composition claimed, although it is possible that the composition might be produced by other process. Division not required.

Adams, 1903 C. D. 299, 106 O. G. 541.

Division between process and article required when article could be made by different process. "While the requirement of division may be a hardship upon the assignee, this reason is not sufficient to warrant the waiver of the requirement of division." Mop.

Davies, 1903 C. D. 280, 105 O. G. 1783.

Process and article. The latter can be made by a different process. No division required. Access to Abandoned Caveat.

Williams, 1903 C. D. 5, 105 O. G. 1780.

While applicant may be permitted to claim a process and the product which necessarily results therefrom in a single application, he can not be allowed to claim in addition a device or article in which the product merely forms an element. Lightning Arrester.

Bennett, 1903 C. D. 258, 105 O. G. 1262.

Process and product, when latter can be made by some other process, required to be divided.

Christensen, 1903 C. D. 256, 105 O. G. 1261.

It is clear, therefore, that the article covered in claims 3 to 6 can be made by other methods than that covered by claims 1 and 2 and that a disclosure of the article does not necessarily disclose the method. Division required.

Foulis, 1902 C. D. 233, 100 O. G. 232-233.

Insulating compound and process of making it should be

divided from an insulated conductor and process of making it. being insulated by above compound.

The Office classification, while not conclusive, is very persuasive.

See Lee, 1902 C. D. 234, 100 O. G. 233.

The permission of the last clause (old Rule 41) does not go so far as to allow the joinder of a process and its product at the will of the applicant. If it appears that the process and product are classified separately. If it is clear that the process does not necessarily result in the product or that the product may be made by some other process. The inventions in such a case are independent and should be claimed in separate applications.

Powell, 1902 C. D. 163, 99 O. G. 1384.

Process and Product.

Ex parte Parent, 1902 C. D. 74, 98 O. G. 1970-1.

A composition and the process of using it may not be claimed in the same application.

Tschirner, 1901 C. D. 141, 97 O. G. 187.

Process and machine must be divided.

Fish, 1900 C. D. 69, 91 O. G. 1615.

Process and Apparatus.

See Frasch, 1900 C. D. 50, 91 O. G. 459.

The words "mutually contribute to produce a single result" are not confined to the result of the process, but to the ultimate result with a view to which the whole invention was made.

Kny, 1893 C. D. 131, 65 O. G. 1403.

(9) *Particular Devices.*

Centrifugal machines for separating solid matter from liquid.

Sjungstrom, 119 O. G. 2235. See note to Rule 68.

Taper calipers.

Creamer & Knowlton, 1904 C. D. 295, 111 O. G. 1040.

Voting machine—general construction—key locking mechanism and apparatus for irregular votes are three separate inventions. Voting machine.

Benke, 1904 C. D. 63, 108 O. G. 1588-9.

Division required between the telephone switchboard and the rest of the system. Telephone exchange apparatus.

Ford, 1904 C. D. 56, 108 O. G. 1327.

A mixing machine for kneading dough, etc., could be turned into a machine for cleaning currents by the introduction of a screen. Division insisted upon.

Stacey, 1904 C. D. 45, 108 O. G. 1050.

Velocity regulator for fluids in motion. In the first form the governing device is connected directly to a valve in the conduit, while in the second form the governing device is connected to the throttle valve in the steampipe to the engine. Each of the forms nevertheless is capable of accomplishing the same ultimate result. No division required.

Herreshoff, 1903 C. D. 376, 106 O. G. 1779.

An improvement in door frames generally must be regarded as an independent invention from the arrangement of a port over the door in a refrigerator.

E. P. Stevenson, 1903 C. D. 238, 105 O. G. 744.

Bookkeeping and account book.

The process does not result in the article, and the articles have no connection with the process.

Stocking e. p., 1902 C. D. 468, 101 O. G. 2823.

Two different constructions for fastening horse shoes constitute independent inventions though both may be used on one shoe.

Rodenbaugh and Laurentz, 1902 C. D. 412, 101 O. G. 1830.

Device for making coffee.

The fact that claims 2 and 3 include broadly as an element of the combination a device for producing the extract does not make those claims for the same invention as claim 1.

Before the extract can be measured it must of course be produced by some means.

Schofield, 1902 C. D. 412. 101 O. G. 1830-31.

End thrust and lateral bearings required to be divided.

Stuver, 1902 C. D. 381, 101 O. G. 1130.

Gas Engine.

Tyler, 1902 C. D. 320, 100 O. G. 2177.

Gas engine. Division between sparking igniter, governor valve. relief valve and general structure of the engine.

Tyler, 1902 C. D. 269, 100 O. G. 686.

Boiler and furnace separate inventions.

Downie and Messner, 1902 C. D. 240, 100 O. G. 235.

Claims 1 to 14, inclusive, and claims 17 and 18, though drawn to cover several distinct inventions, are held to cover inventions so "dependent upon each other that they" mutually contribute to produce a single result and therefore may, under the provisions of Rule 41, be claimed in one application.

The single result is the construction of a complete railway block system. It is otherwise if the inventions are not mutually dependent, e. g.

Kintner, 1902 C. D. 22, 98 O. G. 581.

The mere fact that the slide rule in this case is adapted by reason of the information conveyed thereby for use in the same general art as the shoemaker's measure does not make the two constitute the same or dependent inventions.

Dwyer, 1901 C. D. 41, 95 O. G. 1247.

Division in motor vehicle. Case—

Roby, 1900 C. D. 118, 92 O. G. 1035.

(10) *Appeals.*

Mandamus requiring Commissioner to direct Primary Examiner to forward appeal on question of division to Examiners-in-Chief. In error to the Court of Appeals of the District of Columbia.

Ex rel. Steinmetz v. Allan, Com., 1904 C. D. 703, 109 O. G. 549.

Questions of division appealable to the Examiners-in-Chief. 178 O. G. 320.

The question whether a design application covers two or more inventions is a question of division which is to be determined on appeal in the first instance by the Examiners-in-Chief. Design for a font of type.

Schraubstadter, 1904 C. D. 229, 110 O. G. 2015.

The fact that questions of division are now appealable to the Examiners-in-Chief is no reason why a divisible application should receive a more extensive examination on the merits. Swing back car seat.

Pickels, 1904 C. D. 126, 109 O. G. 1888.

Petition dismissed as matter is appealable to board in first instance. Production of sound records.

Emerson, 1904 C. D. 118, 109 O. G. 1610.

It appears from the decision, Steinmetz v. Allen, 109 O. G. 549, 1904 C. D. 703, that a requirement for division is to be regarded as a rejection of the application and is appealable to the Examiner-in-Chief and that the applicant is entitled to demand that his appeal be forwarded, notwithstanding the fact that the Commissioner has reviewed the Examiner's decision and affirmed it upon the petition of applicant.

This decision approves the first paragraph of rule. Means for removing incrustation of calcium sulphate from brine heating surfaces.

Frasch, 1904 C. D. 104, 109 O. G. 1338.

Appeal from the Commissioner requiring a division does not lie to the Court of Appeals of the district.

Frasch, 1902 C. D. 560, 100 O. G. 1977.

REPORT OF THE COMMISSIONER OF PATENTS FOR 1916.

REQUIREMENT OF DIVISION.

During the year the practice of having all requirements of division referred to a law examiner before being made final was continued. A total of 793 applications were passed upon. Of these, 529 were approved wholly or in part and 363 were disapproved. There was a steady decrease in the percentage of disapprovals as the year went on, indicating that the result sought—uniformity of practice—is being approximated in the different divisions.

In addition to applications in which formal memorandum was written, many applications were informally considered prior to first requirement. In a number of applications it has been found necessary to withhold approval until action on forms or merits. Frequently disclosures and claims are found in such condition that it is not possible to draw clear lines, and action on the form and sometimes on merits has been found to be the most speedy and satisfactory manner of preparing the way for a clear line of division or to avoid division.

The disapprovals have been largely of requirements of division, not properly founded, between process and product and combination and subcombination in machines or in compositions.

Where the process and product are mutually dependent as where the process is the necessary and obvious way of making the product or where the process can produce nothing else and the product be made in no other practical way, no reason for division exists. Division in such cases might result in an effectual extension of the monopoly, when the patents are not concurrent, and in commercial disadvantages flowing from separate ownership of related patents.

When the claims of an application to process and product are not clearly distinct in terms, as where, for example, the process claims are defined in part by terms of structure, or product claims by steps taken in making the product, division is not a proper remedy; action upon the merits should be given. Division in some such cases may be required ultimately, if the claims, when cast in correct form, present two distinct subjects matter.

Where, however, the product and process claims present different inventive ideas and the product may be made by other processes, known at the time, it is clear that no mutually dependent relation exists and there is no reason for

joining the product with any particular one of the various processes usable to produce it. Division in such cases will ordinarily be approved, particularly where the process is capable of making other products and the product claimed is one of a known class or type of developed products.

The questions arising with relation to division between combination and subcombinations are many often difficult to determine. The subcombination, to be divisible, must be capable of use apart from the combination and in other relations, and be of a class of devices which has acquired a distinct position of its own in the art, as the subject of separate manufacture, or invention. This situation is frequently well evidenced by separate office classification and fields of search for the two. The subcombination may be a simple element, as a gear; or a complex organization, as a governor, conveyor, or transfer mechanism. In all cases there should be two distinct inventive ideas embodied in mechanism and it is not believed that in enforcing division the office can disregard the real character of the invention. Many elements as governors, coin-controlled operations, clutches, and gauges are usually or necessarily attached to a machine. An invention may lie in one of these devices and be capable of application to many machines, but it is illustrated with a preferred machine. The naming of the illustrated machine or its broad or conventional statement as an element of a claim (in a case where the ijnvention or improvement is obviously or apparently in the element alone, and where also claims are directed to the element alone) may raise a question of the form of claims, but should not in the preliminary treatment induct a requirement of division; since division should not be required except where the office has formed the opinion that there are two real invtntions. Division is not the proper remedy for claims improperly drawn but in fact based on one invention.

The principles governing joinder of combination and subcombination claims to compositions of matter are clearly set forth in Ex parte Hentz, 1884 C. D. 6, and are the same as those governing other classes of inventions. As there stated, a composition may contain a certain number of ingredients forming a complete compound, although a lesser number of ingredients may contain the basic and essential part of the invention and contribute most largely to produce the result. The mere fact that one claim names three elements or ingredients and another two or four elements or ingredients is not sufficient reason to require division. The further questions are to be determined whether the claims are to composi-

tions having the same character and purpose, operating in substantially the same manner, and whether the subcombinations are useful in other relations and have a distinct status in the arts.

Division is a requirement with regard to which the Commissioner has a wide discretion. The Office can take care of searches and classification by cross-referencing and where hardship to applicants may result or apparent injustice be done, benefit of doubt should be given to applicants and requirements which may cause injustice be waived.

The effect of reference to a law examiner of second requirements of division, it has been hoped, would be to reduce to some extent the first requirements by eliminating trivial requirements and requirements unwarranted by the practice and not sustainable on reference, since, obviously requirements should not be made at all, unless they are well founded in the fixed policy of the office. This expectation has to some extent been realized. There were first requirements of division made in 1915 in 6,393 cases, or 1 in 11.13 new cases acted on, and in 1916 in 5,662 cases, or 1 in 12.01 cases acted on, a reduction from 8.98 to 8.33 per cent.

The examiners' reports show a wide difference in the number of requirements of division in the first instance in the several examining divisions, in proportion to the total number of cases handled, and also a divergence in the proportion of those sent up for approval compared with those made. Divergence to a considerable degree is to be expected on account of the widely variant character and complexity of applications in different divisions, but it is believed to be larger than should be the case. During the coming year efforts will be directed to the reduction of first requirements to a more uniform basis.

The policy of requiring submission of requirements of division to a single law examiner has been amply justified.

The judicial work of the office as distinguished from the clerical work of handling the applications is conducted under the direction of 43 primary examiners. Each one must study those arts wherein applications are assigned to him for examination so that he may be able to form an intelligent judgment as to whether the assistant has properly cited the art bearing on applications as they are filed and so that he may apply the prior art intelligently in determining questions of patentability.

No one should interfere with this work of the examiner excepting as his conclusions may be reviewed on appeal.

There arise, however, throughout the office a great variety of questions respecting which the practice of the office should be uniform, and such questions should be submitted to some one person in order that they may be passed on in accordance with a definite theory and not according to the individual opinions of 43 different primary examiners. It is physically impossible for the Commissioner to do this work, and frequently the decisions arrived at must be reviewed on appeal or petition. Therefore, he could not properly direct a decision in the first instance.

The law examiners are engaged in supervisory work regarding the inception of interferences, the dissolution of interferences; the prevention of delay in the prosecution of applications; requirements of division; practice in reissuing applications, and as to affidavits under Rule 75. Each one of these subjects requires substantially the entire time of one man. There are other lines of work which can be established with great advantage if the number of law examiners can be increased. I have asked for two additional law examiners, which have so far been denied me.

Rule 43. Cross-References in Cases Relating to Same Subject.

When an applicant files two or more applications relating to the same subject matter of invention, all showing but only one claiming the same thing, the applications not claiming it must contain references to the application claiming it.

CONSTRUCTIONS.

This rule introduced 1879. See rules of that date. This requirement is so that the limit of each application shall be definitely determined.

Drawbaugh v. Blake, 1883 C. D. 17, 23 O. G. 1220.

Rule 42 of 1879 abolished in 1888 and present Rules 43 and 44 substituted.

The cross-reference should include serial number and date of filing.

This rule not inconsistent with Rule 15, Summers, 160 O. G. 1039.

The requirement that a new application shall contain a reference to a prior application is not limited to those cases

in which the two applications are copending and continuous. (Ex parte Lewis and Unger construed.)

There should be a reference in a new application to an abandoned application.

Britt, 116 O. G. 298.

A reference to applicant's forfeited case required.

Taylor, 114 O. G. 1265.

After allowance of claims by the Examiner-in-Chief the application was abandoned and another substituted. Applicant required to insert reference to abandoned application.

Lewis & Unger, 106 O. G. 543.

The statement that the application was a division of another required to be canceled in view of new matter introduced.

Hicks, 104 O. G. 309-310.

See note to Rule 78.

Anderson, 1893 C. D. 51, 63 O. G. 463.

Cross-references must be of such a nature that they will impart a more or less definite conception of their scope. A reference by serial number alone is not sufficient.

Everitt, 1889 C. D. 213, 49 O. G. 564.

A reference in an application for a patent to a contemporaneous pending application or for another patent, for a fuller description is not permissible.

Borgfeldt, 1859 C. D. 149, 49 O. G. 132.

But if a patent is issued on the first application without such disclaimer the patent issued on the first application does not bar the patent on the second application for that reason.

Roberts, 1887 C. D. 61, 40 O. G. 573.

The disclaimers contemplated by this rule are between several applications of the same individual covering either by claiming or showing the same device or invention, and the rule was adopted to prevent the party from procuring a prolongation of the monopoly of his patent by securing two patents for the same thing, and also to prevent an abuse which occasionally might occur of a reissue upon a patent which showed but did not claim the whole invention.

Firm, 1887 C. D. 27, 39 O. G. 1199.

Rule 44. Reservation Clauses not Permitted.

A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application.

HISTORY.

Introduced in 1888. See first note to Rule 43.

Rule 45. Legible Writing Required.

The specification and claims must be plainly written or printed on but one side of the paper. All interlineations and erasures must be clearly referred to in marginal or footnotes on the same sheet of paper. Legal-cap paper with the lines numbered is deemed preferable, and a wide margin must always be reserved upon the left-hand side of the page.

Rev. Stat., sec. 4888.

The Oath.

Rule 46. Oath of Applicant.

The applicant, if the inventor, must make oath or affirmation that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever known or used before his invention or discovery thereof, and shall state of what country he is a citizen and where he resides, and whether he is a sole or joint inventor of the invention claimed in his application. In every original application the applicant must distinctly state under oath that to the best of his knowledge and belief the invention has not been in public use or on sale in the United States for more than two years prior to his application, or patented or described in any printed publication in any country before his invention or more than two years prior to his application, or patented in any foreign country on an application filed by himself or his legal representa-

tives or assigns more than twelve months prior to his application in this country. If any application for patent has been filed in any foreign country by the applicant in this country, or by his legal representatives or assigns, prior to his application in this country, he shall state the country or countries in which such application has been filed, giving the date of such application, and shall also state that no application has been filed in any other country or countries than those mentioned, and if no application for patent has been filed in any foreign country, he shall so state. This oath must be subscribed to by the affiant.

If the application be made by an executor or administrator of a deceased person or the guardian, conservator, or representative of an insane person, the oath shall allege the relationship of the affiant to the inventor and, upon information and belief, the facts which the inventor is required by this rule to make oath to.

The Commissioner may require an additional oath in cases where the applications have not been filed in the Patent Office within a reasonable time after the execution of the original oath.

CONSTRUCTIONS.

Rev. Stat., secs. 4887, 4892, 4896.

Amended.

90 O. G. 449 and 89 O. G. 2466.

Notaries in District of Columbia.

215 O. G. 1267.

History as to notary being also the attorney.

Dalton and Magnus, 224 O. G. 741.

An oath will generally be presumed. Its absence from the file wrapper is not conclusive.

Mine & Smelter Supply Co. v. Braeckel Concentrator Co., 197 F. R. 897.

The statute does not require an applicant for a patent to

state whether he is a sole or joint inventor of the art or machine or improvement for which he solicits a patent. A false statement in this regard is not perjury.

United States of America v. Patterson, 174 O. G. 289.

The informality of lack of a certificate excused in view of the circumstances.

Graham v. Sanghaar, 164 O. G. 740 and 741.

Word "sole" omitted.

Mygatt, 169 O. G. 773; Cites 150 O. G. 826; 127 O. G. 3642; 125 O. G. 348; 97 O. G. 1597; 124 O. G. 626.

The oath is defective; it refers to the invention claimed in the application, where it should refer to the invention described and claimed. It fails to state that the invention has not been patented or described in any printed publication for more than two years prior to the filing of the application. It fails to state that no application for patent has been filed by applicants' assigns in foreign countries more than twelve months prior to the application in this country.

Dukesmith v. Corrington v. Turner, 125 O. G. 348.

See note to Rule 30.

Sassin, 122 O. G. 2064.

As a reason why a new oath is not filed it is alleged that differences have arisen between the assignee and the inventor, in view of which the inventor refused to execute another oath. This is not a sufficient excuse where when the application was filed there had been a period of nineteen months wherein public use of the invention would bar a patent, which period was not covered by original oath.

Hoschke, 122 O. G. 1045.

It is equally clear, however, that they can not secure that benefit by the mere allegation that they have filed a foreign application which entitled them to claim the benefit, but only by proving the foreign application.

Pauling, 115 O. G. 1848.

If no patent is granted on a foreign application, applicant is not required to state that the application was not filed more than twelve months previous to present application.

Gerardot, 115 O. G. 1584.

Every portion of Rule 46 is material and it can not be held, therefore, that a compliance with some of its requirements is a compliance with all of them.

Levenstein & Naef, 110 O. G. 1726.

It is not sufficient to state that no foreign patent has been filed in any foreign country more than three months before the application.

Thorsten von Zweiberg, 110 O. G. 859.

The statement that the inventor or applicant has declared his intention to become a citizen does not comply with the provision of this rule. He is still a citizen of the foreign country notwithstanding his declaration, until he is admitted to citizenship.

Rhodes, 105 O. G. 1261.

In the case of a joint application the allegations that the inventors are sole inventors is not sufficient.

E. P. Cole, 105 O. G. 744.

The oath in a divisional application must conform to all the requirements as to original applications.

There is no difficulty in the oath to the divisional application in making it appear that the allegation as to two years' public use relates to the date of the original application. This can be done by a mere change in form without omitting any of the essential allegations of the original oath.

Halsey, 102 O. G. 1294.

In the absence of a special showing to excuse further delay three weeks may be taken as the time limit for the original oath.

Brauna, 1901 C. D. 232, 97 O. G. 2534; Mochu, 106 O. G. 995; Hicks, 104 O. G. 309, 310.

Five weeks' time, plus time for transmission, not unreasonable. No new oath required.

Heinze, 265 O. G. 145.

The omission of the address is not such a fatal defect as warrants a refusal to accept, as complete, an application otherwise without error.

Becker, 1901 C. D. 198, 97 O. G. 1592.

Known or used in American is not a compliance with this requirement. Neither is belief without knowledge such compliance.

Nicholson, 1901 C. D. 86, 96 O. G. 1035.

Only the inventor may make the oath. Even an assignee of the entire interest when the inventor refuses may not make the oath.

Richards, 1901 C. D. 46, 95 O. G. 1853.

The assignee may not make the additional oath, even when the inventor refuses to do so.

McCoy, 1897 C. D. 74, 80 O. G. 2037.

Where an application, executed in Liverpool, England, was filed forty-eight days later, the delay was not unreasonable and an additional oath should not be required, previously decided cases reviewed.

Wilson, 1893 C. D. 57, 63 O. G. 465.

Instead of the phraseology required by the rules applicant avers that the invention "has not been patented to him nor with his knowledge or consent in any foreign country," the words "to others" being omitted, and the word "foreign" being introduced before "country," the effect of which is to omit from his oath the statement whether or not a patent for the same invention has been issued to others in this country.

Mason, 1888 C. D. 33-34.

This oath that the applicant is the first and original inventor is sufficient to avoid the objection that an English patent was taken out jointly in England by applicant and another.

Siemens, 1877 C. D. 41, 11 O. G. 1107.

A new oath must accompany a divisional application.

Tiegman, Simpson & Collins, 1877 C. D. 1; Livingston, 1881 C. D. 42; Lippincott, 1879 C. D. 212.

This affidavit constitutes prima facie evidence, for the purpose of the ex parte application, of the fact of invention by the applicant. But it constitutes no evidence of any date of the application itself.

Lauder v. Croswell, 1879 C. D. 177, 16 O. G. 405.

Except in comparatively few cases this affidavit furnishes all the proof, which is ever presented to the Office, that the applicant himself made the invention and therefore the provisions of this rule must be strictly complied with.

Warnant v. Warnant, 1880 C. D. 36, 17 O. G. 265.

Rule 47. Officers Authorized to Administer Oaths.

The oath or affirmation may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, the oath being attested in all cases in this and other coun-

tries, by the proper official seal of the officer before whom the oath or affirmation is made, except that no oath or affirmation may be administered by any attorney appearing in the case. When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

When the oath is taken before an officer in a country foreign to the United States, all the application papers must be attached together and a ribbon passed one or more times through all the sheets of the application, and the ends of said ribbon brought together under the seal before the latter is affixed and impressed, or each sheet must be impressed with the official seal of the officer before whom the oath was taken.

CONSTRUCTIONS.

History as to the notary being also the attorney.

Dalton and Magnus v. Wilson, 224 O. G. 741.

The purpose of the statute was to require that the authority of the notary public be approved directly by a certificate of a diplomatic or consular officer.

Low, 190 O. G. 549; (citing Rose, 180 O. G. 559).

The oath in question was taken before a notary of one state who affixed his jurat to an affidavit the venue whereof was laid in another. This might have furnished ground for a rejection of the affidavit by the Examiner or Commissioner of Patents, but there is no fraud shown and the recital in the letters patent that the required oath was made is therefore conclusive upon this court.

Empire Cream Separator Co. v. Sears-Roebuck & Co., 157 F. R. 238.

This being so the amendment required an oath that Dolan might have found it difficult to take and for want of which the patent is void.

Steward v. American Lava Co., 149 O. G. 602 (S. C. U. S.).

The Hall Safe Co. v. Herring, Hall, Marvin Safe Co., 135 O. G. 1804.

Notary may not be attorney.

Opinion of the Attorney General, 127 O. G. 3642.

A single certificate is not sufficient to cover a number of jurats signed by the same notary in a foreign country.

In re Dieterich & Co., 110 O. G. 309.

This rule was amended to take effect May 1, 1900, in regard to oaths taken in a foreign country. See amendment. The substance of this amendment was contained in 89 O. G. 2071, in Ex parte Altman, 80 O. G. 1475.

Hosking, 91 O. G. 1615; Bagot & Dishart, 91 O. G. 1802.

A notary public in and for the Republic of Mexico is not authorized to administer the required oath.

Hirran v. Bolade, 1893 C. D. 80, 63 O. G. 1961.

An application oath administered by an official not named in Rule 47 held to be defective and not to be received as in full compliance with the rule.

Hakansson, 1893 C. D. 76, 63 O. G. 1688.

A notary who is not authorized by the law of his country to administer oaths or take affidavits lacks the requisite authority to administer the oath required by R. S., sec. 4892.

(No name), 1892 C. D. 245, 60 O. G. 1481.

It is not sufficient that the oath was taken before a Belgian Burgomaster, unless he was also a notary public, and in the latter case competent proof of his official character should be furnished.

Warnant v. Warnant, 1880 C. D. 36, 17 O. G. 265.

Rule 48. Supplemental Oath for Matter not Originally Claimed.

When an applicant presents a claim for matter originally shown or described but not substantially embraced in the statement of invention or claim originally presented, he shall file a supplemental oath to the effect that the subject matter of the proposed amendment was part of his invention, was invented before he filed his original application, was not known or used before his invention, was not patented or described in a printed publication in any country more than two years before his application, was not

patented in any foreign country on an application filed by himself or his legal representatives or assigns more than twelve months prior to his application, was not in public use or on sale in this country for more than two years before the date of his application, and has not been abandoned. Such supplemental oath must be attached to and properly identify the proposed amendment.

In proper cases the oath here required may be made by an executor or administrator of a deceased person or a guardian, conservator, or representative of an insane person. (See Rule 46.)

CONSTRUCTIONS.

An applicant for a patent upon a method, a product, and a machine, after striking out the claim for the machine and being defeated upon the other two claims in an interference proceeding can not reinstate the claim to the machine in the same application. Rule introduced in 1871.

Cobb, 1879 C. D. 123, 16 O. G. 175.

Matter within the original disclosure is covered by the original oath.

Mine & S. Supply Co. v. Braeckel Co., 197 F. 900.

The amendment required and oath that Dolan might have found it difficult to take and for want of it the patent is void. Supreme Court.

Steward et al. v. American Lava Co., 149 O. G. 602.

A claim for matter introduced without a supplemental oath, invalid. Cases cited.

American Lava Co. v. Steward, 155 F. R. 737.

The amendment in this instance was within the scope of the original application. In such a case a different rule applies. Neither the applicant nor his administrator in case of his death, is required by the statutes relating to patents to make oath to such an amendment.

De LaVergne Machine Co. v. Featherstone, 147 U. S. 209, 229; Phillips v. Sensenich, 134 O. G. 1806.

The question whether or not a supplemental oath should be required has been uniformly held by this Office to be an ex parte matter upon which the proper determination of priority

is not dependent (Cites 108 O. G. 238; 99 O. G. 445; 84 O. G. 1142; 58 O. G. 1415).

Phillips v. Sensenich, 132 O. G. 677.

An amendment filed in good faith sufficient to prevent abandonment even though it was informal for lack of a supplemental oath.

Gaylord, 117 O. G. 2366.

It is well established that the requirement for a supplemental oath is an ex parte matter not open to argument in interference proceedings. (Auerbach and Gubing v. Wiswell, 108 O. G. 289.)

Schubert v. Munro, 113 O. G. 283-4.

The question whether a supplemental oath should be furnished is an ex parte one not to be argued on an interference.

Auerbach and Gubing v. Wiswell, 108 O. G. 289.

When claims for product were introduced into a process application a supplemental oath was required. Where the requirement would work special hardship or cause irreparable injury it might be waived temporarily, but ordinarily a claim can have no standing in the case until supported by the required oath.

Ex parte Ruckrich and Bode, 106 O. G. 765.

An appeal was taken and the board recommended a certain claim, the Primary Examiner required a supplemental oath, held, under the circumstances a supplementary oath should not be required.

Matthes, 101 O. G. 3108-3109.

Supplying connection in drawing suggested in specification.

Wareham, 97 O. G. 1600.

Only the inventor may make this oath; the assignee of the entire interest can not even when the inventor refuses.

Richards, 1901 C. D. 46, 95 O. G. 1853.

The absence of a supplemental oath, although it may be necessary before allowance, does not furnish a ground for the rejection of the claims, and is an ex parte matter not open to argument by an opponent in an interference proceeding.

Weidemann, 1897 C. D. 194, 81 O. G. 2245.

The matter claimed additional to what was claimed in the parent case should always be supported by a proper supplemental oath, or if claimed in the division application as first filed the oath prescribed by Rule 46 should be correspondingly changed.

Henry, 1893 C. D. 88.

A supplemental oath is required to justify the insertion of a claim through the medium of a divisional application where

it would be required if the claim were to be inserted in the parent application.

Forbes v. Thomson, 1890 C. D. 185; cited, 1893 C. D. 90.

It is not necessary that a supplemental oath specify the serial number and date of filing of the application to which it refers if the proposed amendment is otherwise properly identified.

Cook, 1892 C. D. 232, 61 O. G. 1480.

See note to Rule 70.

Perkins, 1891 C. D. 63, 55 O. G. 139.

There is no rule which excludes a case where apparatus and process are appropriately described and but one of them claimed from being brought within the remedial agency of a supplemental oath.

Lillie, 1890 C. D. 181, 53 O. G. 2041.

A supplemental oath should be required when it is sought to claim anything new. The oath filed with the application covers only what is claimed in said application.

Clarke, 36 O. G. 120; Foster, 33 O. G. 113. See, however, Railway Register Mfg. Co. v. North Hudson Ry. Co., 33 O. G. 355.

Where a division of the application should have been made, but was not required by the Examiner, a claim equivalent to one of the former claims may be inserted by amendment.

Andrews, 1879 C. D. 99, 16 O. G. 1056.

THE DRAWINGS.

Rule 49. Drawings.

The applicant for a patent is required by law to furnish a drawing of his invention whenever the nature of the case admits of it.

Rev. Stat., sec. 4889.
Precautions to be observed in forwarding drawings.
223 O. G. 653.

Rule 50. Requisites of Drawings.

The drawing may be signed by the inventor or one of the persons indicated in Rule 25, or the name of the applicant may be signed on the drawing by his attorney in fact. The drawing must show every feat-

ure of the invention covered by the claims, and the figures should be consecutively numbered, if possible. When the invention consists of an improvement on an old machine the drawing must exhibit, in one or more views, the invention 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 invention therewith.

See notes under Rule 49.

HISTORY.

The words "and attested by two witnesses" struck out of the statute by amendment approved March 3, 1915, and of course the rule was amended to conform to the statute, 212 O. G. 1063.

CONSTRUCTIONS.

(1) In General.
(2) Drawings as Evidence.
(3) Practice.
(4) No More Drawings Than Necessary.
(5) What Should be Shown.
(6) How Illustrated.
(7) Amendments to Drawings.

(1) *In General.*

It is also claimed that the patent drawings, if scaled, do not exactly accord with the written description of the claims. But drawings are to be taken as illustrative of the idea of the patent, not as working plans (131 Fed. 77).

American Valve & Meter Co. v. Fairbanks-Morse Co., 249 Fed. 239.

The drawing with the specifications constitutes a part of the patent when issued.

Phillips v. Sensenich, 134 O. G. 1806.

That Motsinger had such a definition in mind when he drew up his letters patent is evidenced by the fact that his drawings show nothing else and that there is nothing in the description that the drawings are meant to be only a preferable or alternative method.

Motsinger Device Mfg. Co. v. Hendricks Novelty Co., 149 F. R. 995.

Drawings are a part of the specification of a patent, and for the purpose of ascertaining the sufficiency of the description of the invention must be read with it.

Brammer v. Schroeder, 106 F. R. 918.

An application for a process filed complete except a drawing, and a drawing is not necessary for a full disclosure of the invention, held sufficient to give a date of filing.

Ludington, 1902 C. D. 211, 100 O. G. 236; Russell, 1898 C. D. 208, 81 O. G. 2021.

The date at which the drawing is returned properly signed is the date of filing of the application.

Arndt, 1900 C. D. 167, 93 O. G. 751; Palmer and Thompson v. Bailey, 1899 C. D. 66, 83 O. G. 1207.

An illustration which amounts to no more than a suggestion is not sufficient warrant for a claim filed nearly two years after the application and nine days after an interfering patent.

Dewey v. Colby, 1896 C. D. 12.

The drawing filed with an application is one of its most important and essential parts. It becomes a permanent record in the Office and no one had authority to change any of its features by erasure or otherwise mutilating the same.

Wharton, 1887 C. D. 88, 40 O. G. 917.

The drawing of a patent are addressed to those skilled in the art and must also be considered in connection with the claims and specification and with each other; and a patent is not invalidated by a clerical mistake in a drawing, which, when so considered, would not mislead one skilled in the art to which it relates.

Cutler Hammer Mfg. Co. v. Union Electric Mfg. Co., 147 F. R. 266.

Drawings are a part of the specification of a patent, and for the purpose of ascertaining the sufficiency of the description of the invention must be read with it.

Emmet v. Fullagar, 124 O. G. 2178. See Rule 173 and note (Earnham, 114 O. G. 2090; Schmedmer, 115 O. G. 249).

Held to involve new matter, since where the drawings are uncertain they can not be made controlling.

Lindgren, 266 O. G. 137.

(2) *Drawings as Evidence.*

Where Y offered in evidence a drawing said to have been made during a certain time which is fixed by dates written on the drawing and there is only Y's unsupported allegation that

he made the drawing at that time, held that such testimony is insufficient to establish these dates.

Young v. Donnelly, 1898 C. D. 20, 82 O. G. 1417.

A drawing perfect in every detail and plainly demonstrating the principle and practical utility of an invention is not reduction to practice, nor is a model, designed, constructed, and intended merely as a model.

McCormick v. Cleal, 1898 C. D. 492, 83 O. G. 1514.

No statutory drawing having been filed by Palmer & Thompson until after the complete application of Bailey was filed, the burden of proof in the interference is upon Palmer & Thompson.

Palmer & Thompson v. Bailey, 1898 C. D. 66, 83 O. G. 1207.

Drawings or models not sufficient to establish date of reduction to practice.

Kassen v. Hetheringen, 88 O. G. 1157.

Disclosure in a drawing alone if sufficiently plain and clear may be sufficient to show an anticipation of an invention.

Reed v. Duel, Com., 1901 C. D., 96 O. G. 1241.

Relating to machinery, the invention may be exhibited as well in a drawing as in a model, so as to lay the foundation of a claim to priority, if such drawing be sufficiently plain to enable those skilled in the art to understand it.

Christensen v. Noyes, 1900 C. D. 21, 90 O. G. 227.

A drawing offered showing one of the elements of the combination, but vaguely, held that when other evidence is submitted which establishes the fact that the inventor had, at the time he made the original drawing, a complete conception of this vaguely illustrated element, the fact of conception of the invention of the issue is satisfactorily established.

Robinson v. Copeland, 1904 C. D. 237, 111 O. G. 579.

(3) *Practice.*

The conclusions of the chief draftsman as to whether or not the drawings should be accepted will not be disturbed unless there is such palpable abuse of his discretion as would warrant the exercise of the supervisory authority of the Commissioner.

Mealus, 136 O. G. 438.

The drawing should not be changed unless and until the question of new matter in the amendment has been determined in favor of the applicant.

Luber, 1894 C. D. 47, 67 O. G. 529.

The validity of the claim should first be determined before

a petition can be taken from the Examiner's action requiring the cancellation of the figure and the description relating to the same.

Schmidt, 1904 C. D. 165, 110 O. G. 603.

In questions of new matter new drawings should not be entered until decision on appeal.

Furness, 104 O. G. 1655.

(4) *No More Drawings Than Necessary.*

Applicant required to limit his drawings to one sheet.

Hilliker, 183 O. G. 1035.

Figures unnecessary to understanding of case required to be canceled.

Rosenbluth, 176 O. G. 274.

There are two reasons why drawings should be limited to as few sheets as possible, one to save storage, second to save expense of reproducing the drawings for a patent.

In order to decrease the number of sheets of drawings and at the same time obviating the necessity of caring for an additional sheet it is held that Figs. 4 and 5, contained on sheet three, and the descriptions specifically relating thereto, shall be canceled.

Pfautz, 159 O. G. 489.

Superfluous drawings.

Nestler, 119 O. G. 1259.

The entire invention might have been shown on one sheet of drawings, and there is very clearly no necessity for four sheets. It is not believed, however, that the present sheet one can be amended to show all features claimed without considerable trouble, and therefore the applicant will be permitted to retain sheets 1 and 3.

Roadhause, 111 O. G. 1259.

Where only one sheet of drawings, including one figure, is filed with the application and the specification described four figures, and this discrepancy is not discovered until the case is examined on the merits. Held that the application must be regarded as incomplete until the date when the additional drawings are furnished.

Ehrendriech, 1904 C. D. 75, 109 O. G. 275.

Since the figures on sheet 1 of the drawings show the invention clearly, it is contrary to the letter and the spirit of the above rules to allow further illustration of the device.

Phillips, 105 O. G. 1779.

While an applicant is entitled to all reasonable latitude in illustrating his invention he can not be permitted unneces-

sarily to cumber the records with additional sheets of drawings when a mere statement in the specification will suffice.

Lundes, 103 O. G. 1681.

Appeal from the requirement that the number of sheets of drawings be reduced from ten to six.

Examiner affirmed. The growing custom of multiplying drawing condemned, when the Examiner and draftsman agree, their decision will be taken as correct in a clear case.

Dieschir, 1900 C. D. 166, 93 O. G. 551-552.

A sheet showing a feature not included in the claims is superfluous and should not be permitted to remain in the case.

Griffin, 1899 C. D. 224, 85 O. G. 454.

No more drawings than necessary.

Krause, 1891 C. D. 164, 56 O. G. 1708.

(5) *What Should be Shown.*

All claims should read on one figure if practicable.

Daum, 267 O. G. 183.

Only such matter as is claimed should be illustrated and described.

Parks, 191 O. G. 831.

A feature not appearing in the claims required to be distinctly shown so as to facilitate examination of the case and of the art.

Good, 164 O. G. 739.

If the device is shown sufficiently, it is unnecessary to show a form of its application.

Perkins, 142 O. G. 855.

Whether a figure should be canceled or not depends upon the question whether the state of the art is such as to render it necessary to limit the claims to the form of the device shown in other figures.

Engel. 121 O. G. 1011.

Where certain figures of the drawing show apparatus for making an article and all claims to such apparatus have been divided from the case and these figures do not aid in obtaining an understanding of the article, these figures, and the description of the apparatus illustrated therein, should be canceled.

Crecilius, 115 O. G. 1849.

The drawing and specification should be limited to the invention covered by the claims which have been allowed.

Anderson, 113 O. G. 2504.

It is well settled that an alleged lack of novelty furnishes

no good reason for a failure to illustrate matter which is claimed.

Bowman, 113 O. G. 1703.

A figure illustrating the previous state of the art required to be canceled.

Elliott, 109 O. G. 1337.

A sheet of drawing showing another application of the invented device and showing the details of the machine to which it is applied, should be canceled.

Crisler, 108 O. G. 1869.

Under the established practice of the Office an applicant is permitted to show several species of his invention when the state of the art permits the claim to be presented and allowed which is broad enough to cover all of the species shown and described.

Garland, 107 O. G. 267.

When one figure does not show the device claimed, but does show details of the surroundings in connection with which the device is to be used, held that the figures are objectionable.

Kidd, 105 O. G. 745.

As to figure 2 of the drawings, the Examiner says that it shows a modification covered by the claims, but is unnecessary and should be canceled because the applicant has another application covering that specific form.

The figure retained.

Leonius, 1903 C. D. 126, 103 O. G. 1164.

Where the claim of an application is for leather having certain characteristics used in a gas meter and no claim is made to the form of the gas meter. Held, that the application will be accepted without a drawing, since it is impossible to illustrate the character of the leather.

A drawing may, however, be subsequently required.

Kozminski, 1903 C. D. 92, 103 O. G. 429.

Claim 1 covers the invention shown in all the figures of the drawings. A distinction should be made between the invention disclosed and a specific illustration of said invention.

Mitzger, 1902 C. D. 407, 101 O. G. 1612.

The statute means not merely a drawing, but one showing what is described in the specification if it is capable of illustration.

A part of what is described can not be omitted any more than the whole of it.

The statute does not say that a drawing shall be furnished when the invention can not be understood from description alone.

Edgerton, 101 O. G. 1131.

The drawing must show every feature covered by the claims. This disk is shown in section in one of the views; but a drawing in section when it does not clearly and completely illustrate a structure is not sufficient to show the invention described and claimed.

Alminana, 100 O. G. 1331.

Imitation of graining required where this was an element of the claim.

Davin, 100 O. G. 453.

It is not necessary to retain in the drawing of an application for a patent for an article a figure to illustrate a process or step in its manufacture.

Henry, 1900 C. D. 159, 99 O. G. 1170.

Division required between machine and article made by it. Drawings of the machine required to be eliminated.

King, 1902 C. D. 158, 99 O. G. 1169.

A conventional part shown only to illustrate connection therewith should be shown so as to be recognizable by one skilled in the art.

Morse, 1901 C. D. 260, 97 O. G. 2982.

We do not think, however, that the appellant should be limited in his invention to the use of the angle which appears in the drawing. The specification contains no designation of a specific angle, and it is clear that patentee contemplated that the angle should be such as would successfully overcome the defect which his invention was designed to remedy.

Johnson v. Woodburn, 97 O. G. 403.

If a modified form of the apparatus is described in the specification it must be shown in the drawing.

Peck, 1901 C. D. 136, 96 O. G. 2409.

Where a party wishes to claim the general combination of parts and the specific form of some of the elements, he should include the preferred form of the elements in the figure of the drawings illustrating the combination which he wishes to claim, so that all claims will read upon the device shown in a single figure.

Welch, 1900 C. D. 190, 93 O. G. 2104.

Where the drawings show only detached portions so that they do not show their cooperation, it is impracticable for the Examiner to point out specifically, the necessary amendment.

General objections are sufficient to enable a skilled draftsman to cure the defects.

Tuttle, 1900 C. D. 25, 90 O. G. 1365.

Where an air compressor was an element of the claim, on

changing air compressor to source of compressed air, the requirement that the compressor should be illustrated was overruled.

Rouse, 88 O. G. 2242.

Claims should cover specifically only what is illustrated in the drawings; but since it can not be decided in this case whether the spurs of cleats are properly illustrated, without passing upon the question of new matter involved in some of the claims, this petition is dismissed.

Shearman, 1898 C. D. 190.

Objection to a drawing that an unnecessarily large variety of forms is shown should not be insisted upon when it appears that the several figures relate to and show modifications of the generic invention claimed.

Olan, 1897 C. D. 24, 79 O. G. 861.

An applicant can show and describe as many different forms of his invention as can be covered by a generic claim or claims.

Cook, 51 O. G. 1620.

The drawing must show every feature of the invention.

Crandall, 35 O. G. 625, R. S. 4889.

A drawing must be furnished if the nature of the case admits of it whether necessary or not.

Bennett, 35 O. G. 1003; Crandall, 35 O. G. 625; Chase, 1879 C. D. 245.

Modifications described in the specification should be shown in the drawing.

Witty and Caffrey, 29 O. G. 862; Howe, 25 O. G. 1189.

Every feature claimed must be illustrated if capable of illustration even if a drawing is unnecessary.

Chase, 1879 C. D. 245.

In an application for a process patent every stage, or subprocess distinctly claimed, which is capable of illustration by drawing, must be illustrated, but it is not in general necessary to illustrate by drawings the several steps in each stage of a subprocess claimed.

Carter, 1879 C. D. 243.

A part not claimed must be illustrated if such illustration is necessary to such an understanding of the subject matter as will enable those skilled in the art to practice the invention.

Carter, 1879 C. D. 243, 16 O. G. 809.

Separate views of the parts which are not claimed should be eliminated.

Kemp, 1879 C. D. 41, 15 O. G. 775.

If the invention is a combination it should be illustrated

as a combination, detached views of the parts are not sufficient.

Kemp, 1379 C. D. 41.

Where the operation of the parts is modified, controlled, or unusually affected by the added improvement, the whole machine should be illustrated.

Kemp, 1879 C. D. 41.

The specification and drawing must reveal some means of carrying the invention into effect.

Schoonmaker, 1878 C. D. 40.

The drawing and specification must correspond.

Schoonmaker, 1878 C. D. 40.

One or more modifications of the device claimed may be shown in the drawing.

Schoonmaker, 1878 C. D. 40; Eagle, 1870 C. D. 137.

If the machine is well known or if a description is readily accessible, it is only necessary to show so much of said machine as will illustrate the connection of the improvement claimed with it.

Tracy, 1875 C. D. 80; Kemp, 1879 C. D. 41; Smith, 1871 C. D. 84; Woodbury, 1869 C. D. 86; Gatling, 1870 C. D. 92.

(6) *How Illustrated.*

Stippling in appropriate cases if well executed may be used.

Kohler, 116 O. G. 569. Modified Bryant, 228 O. G. 1457.

If in a trade-mark case the drawing indicates colors, they must be described. If the colors indicated according to the chart are unessential a new drawing omitting this feature should be filed.

Tinnerman Co., 127 O. G. 1991.

Must be line drawings. A dotted line drawing not admissible.

Lloyd, 112 O. G. 251-2.

The Office is warranted in requiring that the drawings of applications be presented in such shape as to facilitate an examination of the case.

Wolferperger & Moran, 113 O. G. 1418.

Where applicant showed a bottle without stating of what material it consists he should not be required to indicate that it is of glass according to the chart.

Person, 110 O. G. 1583.

The drawing should be so plain that the invention may be understood by simply inspecting them without the necessity of reading the specification.

Motsinger, 110 O. G. 601; Whitney, 110 O. G. 603.

The insulating material should be indicated as provided in the chart.

Whitney, 110 O. G. 603.

The invention appears to relate to the improvement of engines, tanks and receivers of known construction and their connection by pipes and valves and is probably more clearly illustrated by the present diagrammatic drawing than would be possible by views showing the parts in detail.

Clark, 109 O. G. 2169.

It is a great desideratum of Patent Office drawings that they should tell their story to the eye without making it necessary to go into the specification for explanation, which should be apparent upon inspection.

Sturtevant, 108 O. G. 563.

The fact that one skilled in the art could make the invention from the present disclosure does not overcome the necessity for such representation of the invention in the drawings as will make it intelligible for the purposes of search.

Sturtevant, 108 O. G. 563.

The scale of the drawing should be sufficiently large so that the structure is clear.

Hodges, 105 O. G. 1534.

The art of the mechanical draftsman has improved within recent years to such an extent that a drawing filed as part of an application for a patent should be so clear that the structure which it is intended to illustrate may be easily understood from a mere inspection of the drawings when the art is known to the person who is called upon to read the drawing.

Hodges, 105 O. G. 1534.

It is not necessary that the exact proportions of the parts should be indicated.

Creveling, 1902 C. D. 60, 98 O. G. 1708; Turner, 1902 C. D. 429, 101 O. G. 2078.

A drawing need not be made to scale, but should show all features.

Turner, 101 O. G. 2078.

The drawing should be such that a mechanic could with certainty from it make and use the device which the inventor has in mind.

Weitsinger, 1902 C. D. 333, 100 O. G. 2773.

If the grain of wood running in a certain direction is an element of the claim it should be so shown in the drawing.

Davin, 100 O. G. 452.

When possible a drawing should be so complete that the purpose and operation of the invention may be readily understood by one skilled in the art by means of a mere inspection of said drawing.

The necessity of reading the specification in connection with the drawing should be avoided if possible.

The Examiner has suggested adding to the parts of the drawings showing the different connection words indicative of the particular connection. This suggestion is believed to be a good one.

Hartley, 97 O. G. 2746.

Modified forms of construction should be shown, if at all, in separate figures and in full lines and not in dotted lines.

Badger, 97 O. G. 1596-7.

The object of the drawings filed in the Patent Office is attained if they clearly exhibit the principle involved and in a case like this rigid adherence to the dimensions is not required or expected.

Crown Cork & Seal Co. of Baltimore City v. Aluminum Stopper Co. of Baltimore City, 96 O. G. 2575.

The policy of the Office is now to require drawings to be made so full and clear that in all simple easily understood cases models may be dispensed with.

Jove, 1880 C. D. 122, 17 O. G. 122.

Parts concealed by intervening portions of the machine should be represented by dotted lines.

Barcellos, 1880 C. D. 4, 17 O. G. 110.

Every feature claimed must be illustrated if capable of illustration even if a drawing is unnecessary.

Chase, 1879 C. D. 245.

(7) *Amendments to Drawings.*

See Rule 72 and notes.

Where all the figures were canceled from the drawings except some at one end of the sheet, so that the drawing would present peculiar and inartistic appearance in the patent. Held that new drawings should be furnished.

Burscheck, 119 O. G. 1258.

A general statement in the original specification as to a modification of the invention does not warrant an amendment to the drawing showing a species of the invention not originally disclosed.

Mother, 1904 C. D. 500, 113 O. G. 1145.

A drawing may be amended to correspond to a clear description in the drawing.

Zwiebel, 1904 C. D. 198, 110 O. G. 1428.

By the written permission of the Examiner in charge, in a proper case, a drawing may be amended upon filing a blue-print of the original drawing and illustrating either on this print or by means of a sketch the change in the original drawing which it is desired to make.

Zwiebel, 1904 C. D. 198, 110 O. G. 1428.

Where one of the figures of the drawing, showing an unimportant detail, was objected to in the same action in which the claims were rejected on references. Held that a subsequent amendment overcoming this objection and requesting a second action upon the claims places the case in condition for final rejection.

Marks, 1904 C. D. 115, 109 O. G. 1608.

An applicant will not be permitted to illustrate a specific form of the invention not originally disclosed, although it illustrates the generic invention.

Butcher, 1904 C. D. 60, 108 O. G. 1587.

The mere inking of a drawing after it is sworn to is not such an alteration in the application as would warrant striking it from the files.

Hopkins v. Scott, 1903 C. D. 261, 105 O. G. 1263.

Where blue-prints of original drawings have been made a part of the record, it is permissible to make slight changes in the original drawings, but not such changes as practically obliterate the identity of any of the original figures.

Kuhlman & Carpenter, 1903 C. D. 6, 102 O. G. 229.

Permitted to add a figure to drawing by amendment.

Larson, 1902 C. D. 452, 101 O. G. 2568.

A new drawing may not be substituted after allowance to eliminate a modification.

Cooper, 99 O. G. 669.

The right to make proper amendments to drawings is clearly within the authority given to attorneys to prosecute applications.

Wilcox, 1902 C. D. 409, 101 O. G. 1829.

An applicant can not be permitted to erase the lines of his drawing and delineate anew the construction and operation of a part fully shown and described or replace or well-described but inferior arrangement by a preferable form of his invention.

Clay, 1901 C. D. 256, 97 O. G. 2980.

Where in a decision upon appeal the Examiners-in-Chief call attention to imperfections in the drawing and specification. The amendments indicated, only, may be made.

Beck, 1901 C. D. 246, 97 O. G. 2746.

Since applicant indicates in his description that there must be a connection between the bar and the sheet, it is clear that the amendment is not for such new matter as it was proposed to insert in Delbey's (1901 C. D. 103) application.

Wareham, 1901 C. D. 204, 97 O. G. 1600.

New matter may not be introduced into the drawing such as to show a preferable form of the invention.

Baptist, 1901 C. D. 150, 97 O. G. 191; Alman, 1901 C. D. 151, 97 O. G. 191.

Where it appears that the changes sought to be made to the drawing include matter not originally shown and described and are not merely for the correction of clear and unmistakable error of the draftsman. Held that such changes constitute new matter and should not be admitted.

John, 1901 C. D. 118, 96 O. G. 1649; Delbey, 1901 C. D. 103, 96 O. G. 1240.

A new drawing may not be filed arbitrarily at the option of applicant, the office having made no objection to the old drawing.

Pugh, 96 O. G. 841-2.

Reference having been made in the original application to spurs or cleats, they can be shown, so long as the illustration of them does not involve a departure from the original disclosure; but the question as to whether a particular figure of the drawings illustrating them and covered specifically by the claims involves new matter is for the Examiners-in-Chief to decide.

Shearman, 1898 C. D. 190, 84 O. G. 1730.

A tintype not signed by the inventor or his attorney and not attested by two witnesses can not be considered a drawing within the statutes.

Palmer & Thompson v. Bailey, 1899 C. D. 66, 83 O. G. 1207.

The strips should be placed at right angles to their present position. The device as now illustrated is inoperative, and it seems obvious that the defects in the illustration are such as could only have occurred through a clerical error in making the drawing. Amendment permitted.

Bailey, 1898 C. D. 16, 82 O. G. 894.

There was a clear mistake in the original drawings. Though the mistake did not render the patent wholly inoperative, it was of such a character that a machine constructed in accordance with some of the drawings would have been in-

operative for some purposes which the inventor was entitled to cover by his claims. Reissue proper.

Beach v. American Box Machine Co., Horace Inman et al., 69 O. G. 1067.

The drawing should not be changed unless and until the question of new matter in the amendment has been determined in favor of the applicant.

Tuber, 1894 C. D. 47, 67 O. G. 529.

A drawing filed in one application can not be transferred to an application filed in place thereof.

Ayres, 1890 C. D. 103, 51 O. G. 1944.

If a new attorney appears in the case, or it is necessary to have different witnesses from the original ones, such a change would be a departure from the original record and can not be permitted. The only remedy in such a case is to file a new sheet of drawing.

Arder, 48 O. G. 119; Zacharias, 1902 C. D. 80.

Rule 51. Two Editions of Drawings.

Two editions of patent drawings are printed and published—one for office use, certified copies, etc., of the size and character of those attached to patents, the work being about 6 by 9½ inches; and one reduction of a selected portion of each drawing for the Official Gazette.

Rule 52. Uniform Standard.

This work is done by the photolithographic process, and therefore the character of each original drawing must be brought as nearly as possible to a uniform standard of excellence, suited to the requirements of the process, to give the best results, in the interests of inventors, of the office, and of the public. The following rules will therefore be rigidly enforced, and any departure from them will be certain to cause delay in the examination of an application for letters patent:

(*a*) Drawings must be made upon pure white paper

of a thickness corresponding to two-sheet or three-sheet Bristol board. The surface of the paper must be calendered and smooth. India ink alone must be used, to secure perfectly black and solid lines.

(*b*) The size of a sheet on which a drawing is made must be exactly 10 by 15 inches. One inch from its edges a single marginal line is to be drawn, leaving the "sight" precisely 8 by 13 inches. Within this margin all work and signatures must be included. One of the shorter sides of the sheet is regarded as its top, and, measuring downwardly from the marginal line, a space of not less than 1¼ inches is to be left blank for the heading of title, name, number, and date.

(*c*) All drawings must be made with the pen only. Every line and letter (signatures included) must be absolutely black. This direction applies to all lines, however fine, to shading, and to lines representing cut surfaces in sectional views. All lines must be clean, sharp, and solid, and they must not be too fine or crowded. Surface shading, when used, should be open. Sectional shading should be made by oblique parallel lines, which may be about one-twentieth of an inch apart. Solid black should not be used for sectional or surface shading. Free-hand work should be avoided wherever it is possible to do so.

(*d*) Drawings should be made with the fewest lines possible consistent with clearness. By the observance of this rule the effectiveness of the work after reduction will be much increased. Shading (except on sectional views) should be used only on convex and concave surfaces, where it should be used sparingly, and may even there be dispensed with if the drawing be otherwise well executed. The plane upon which a sectional view is taken should be indicated on the

general view by a broken or dotted line, which should be designated by numerals corresponding to the number of the sectional view. Heavy lines on the shade sides of objects should be used, except where they tend to thicken the work and obscure letters of reference. The light is always supposed to come from the upper left-hand corner at an angle of 45°.

(*e*) The scale to which a drawing is made ought to be large enough to show the mechanism without crowding, and two or more sheets should be used if one does not give sufficient room to accomplish this end; but the number of sheets must be more than is absolutely necessary.

(*f*) The different views should be consecutively numbered. Letters and figures of reference must be carefully formed. They should, if possible, measure at least one-eighth of an inch in height, so that they may bear reduction to one twenty-fourth of an inch; and they may be much larger when there is sufficient room. They must be so placed in the close and complex parts of drawings as not to interfere with a thorough comprehension of the same, and therefore should rarely cross or mingle with the lines. When necessarily grouped around a certain part they should be placed at a little distance, where there is available space, and connected by lines with the parts to which they refer. They should not be placed upon shaded surfaces, but when it is difficult to avoid this, a blank space must be left in the shading where the letter occurs, so that it shall appear perfectly distinct and separate from the work. If the same part of an invention appear in more than one view of the drawing it must always be represented by the same character, and the same character must never be used to designate different parts.

(*g*) The signature of the applicant should be placed at the lower right-hand corner of each sheet, and the signatures of the witnesses, if any, at the lower left-hand corner, all within the marginal line, but in no instance should they trespass upon the drawings. (See specimen drawing, appendix.) The title should be written with pencil on the back of the sheet. The permanent names and title constituting the heading will be applied subsequently by the office in uniform style.

(*h*) All views on the same sheet must stand in the same direction and must if possible stand so that they can be read with the sheet held in an upright position. If views longer than the width of the sheet are necessary for the proper illustration of the invention the sheet may be turned on its side. The space for heading must then be reserved at the right and the signatures placed at the left, occupying the same space and position as in the upright views and being horizontal when the sheet is held in an upright position. One figure must not be placed upon another or within the outline of another.

(*i*) As a rule, one view only of each invention can be shown in the Gazette illustrations. The selection of that portion of a drawing best calculated to explain the nature of the specific improvement would be facilitated and the final result improved by the judicious execution of a figure with express reference to the Gazette, but which must at the same time serve as one of the figures referred to in the specification. For this purpose the figure may be a plan, elevation, section, or perspective view, according to the judgment of the draftsman. All its parts should be especially open and distinct, with very little or no shading, and it must illustrate the invention claimed only, to the

exclusion of all other details. (See specimen drawing.) When well executed, it will be used without curtailment or change, but any excessive fineness, or crowding, or unnecesasry elaborateness of detail will necessitate its exclusion from the Gazette.

(*j*) Drawings transmitted to the office should be sent flat, protected by a sheet of heavy binder's board; or should be rolled for transmission in a suitable mailing tube, but should never be folded.

(*k*) An agent's or attorney's stamp, or advertisement, or written address will not be permitted upon the face of a drawing, within or without the marginal line.

CONSTRUCTIONS.

See notes under Rules, 49, 50.

The chart for draftsmen should be followed as to insulation.

Whitney, 110 O. G. 603.

Sectional surfaces of such thinness that they may be represented by a single line do not come within the prohibition of the last clause.

Millin and Reed, 160 O. G. 1037.

See note to Rule 38.

The same reference letter may not be used to designate parts claimed to be equivalents but differing in structure. In such cases a part may be designated by a letter and the modified form by the same letter with an appended figure.

Cook, 1890 C. D. 81, 51 O. G. 1620.

The lettering of the drawings should correspond to the references contained in the descriptive portion of the specification.

Borgfeldt, 1889 C. D. 199, 49 O. G. 132.

The illustration of the invention in Figure 3 is not clear. This due partly to the fact that many of the reference letters are too small to be easily discernible.

Hodges, 105 O. G. 1534.

It is suggested that letters or numerals be used without exponents.

120 O. G. 907.

The above is a notice published in the Official Gazette under a quotation from Rule 52.

Wherever possible the reference letters must be so placed so as to be read with the sheet in an upright position.

Notice, 172 O. G. 835.

In defense of a suit it was alleged that one of the witnesses signed inventor's and attorney's name.

This court holds that such irregularities in the signing of the drawings, conceding them to exist, are not a defense to this action. Should an action be brought to set aside the patent, a different question would be presented.

Hallock v. Babcock Mfg. Co., 124 F. R. 226.

Where an application executed by the inventor is filed after his death and the drawing is signed by the attorney appointed by the inventor, held that it is to be presumed that the drawing was signed before the death of the inventor and while the attorney had power to act.

Jones, 1903 C. D. 81, 103 O. G. 228.

If the attorney add his signature after it has been signed and duly executed by the inventor, it is objectionable under this clause.

McDonald, 101 O. G. 182.

Figures 1 to 4 of the drawings illustrate clearly all the features of construction covered by the claims. Figure 5 shows the same device only on a smaller scale and in addition it shows other parts of the harness all in position on the animal. Fig. 5 requires to be canceled.

Phillips, 105 O. G. 1779.

When the signature appears on a sheet of drawing in the wrong place, upon filing a blue-print of the original sheet, the signatures may be erased and written correctly thereon by the identical people if the same be done without mutilating the sheet or removing it from the Office.

If the signatures must be changed the only remedy is to file a new sheet. (Order 480-33 O. G. 119.)

Zacharais, 98 O. G. 2171.

Drawings must be signed. Stamped signatures not sufficient.

Krause, 1891 C. D. 164.

A member of the firm of applicant's attorneys who signs the firm name to the drawing is not also a competent witness to the signature of the firm.

Kyle, 1890 C. D. 84, 51 O. G. 1621.

Views if possible must be placed so that the sheet will not have to be placed on its side to read them.

Com. Order, 172 O. G. 71.

Rule 53. Drawings for Reissue Applications.

All reissue applications must be accompanied by new drawings, of the character required in original applications, and the inventor's name must appear upon the same in all cases; and such drawings shall be made upon the same scale as the original drawing, or upon a larger scale, unless a reduction of scale shall be authorized by the Commissioner.

The foregoing rules relating to drawings will be rigidly enforced. A drawing not executed in conformity thereto may be admitted for purposes of examination if it sufficiently illustrate the invention, but in such case the drawing must be corrected or a new one furnished before the application will be allowed. The necessary corrections will be made by the office, upon applicant's request and at his expense. (See Rule 72.)

Rev. Stat., sec. 4895.

Rule 54. Defective Drawings.

The foregoing rules relating to drawings will be rigidly enforced. A drawing not executed in conformity thereto may be admitted for purposes of examination if it sufficiently illustrate the invention, but in such case the drawing must be corrected or a new one furnished before the application will be allowed. The necessary corrections will be made by the office, upon applicant's request and at his expense. (See Rule 72.)

Sheets are broken at one or more points and eventually by reason of handling thereof they will undoubtedly separate on the broken lines. The well settled practice in the Office of refusing to accept mutilated drawings is founded upon the necessity of preserving the records of the Office for an indefinite period and must be enforced.

Frankman, 136 O. G. 1999.

Rule 55. Drawings Furnished by Office.

Applicants are advised to employ competent draftsmen to make their drawings.

The office will furnish the drawings at cost, as promptly as its draftsmen can make them, for applicants who can not otherwise conveniently procure them.

In the absence of explicit and definite instructions, the Office will not remake a drawing at its own expense.

Rosenheim & Moonbil, 122 O. G. 1722.

THE MODEL.

Rule 56. When Models are Required.

A model will be required or admitted as a part of the application only when on examination of the case in its regular order the primary examiner shall find it to be necessary or useful. In such case, if a model have not been furnished, the examiner shall notify the applicant of such requirement, which will constitute an official action in the case. When a model has been received in compliance with the official requirement, the date of its filing shall be entered on the file wrapper. Models not required nor admitted will be returned to the applicants. When a model is required, the examination may be suspended until it shall have been filed.

Rev. Stat., sec. 4891.

CONSTRUCTIONS.

At the present time the black photographic prints which are required to be furnished before any modification of the drawing can be made are of a permanent character and can be easily photographed. Under these circumstances it does not seem that Order 55 should be so construed as to prohibit the removal of an original figure.

Bishop & Bishop, 186 O. G. 560.

Models filed during the prosecution of an application for a patent but not entered as part of the record thereof.

Stratton et al., 157 O. G. 755.

Beath, 111 O. G. 2220.

If the description is such that the invention can not be understood without a model, a model must be furnished. The Examiner can not be permitted to leave his work on other applications to give his exclusive time to one until he can go to Woonsocket, R. I., to examine the full sized machine.

E. P. McTammany and Wright, 103 O. G. 661.

The Office required a model, which applicant furnished, clearly indicating, however, at that time and subsequently that he wished the model returned. The Office did not, in response to applicant, insist upon the permanent filing of a model, nor were the receipt and application of the model to the case under consideration entered on the file wrapper. On renewed request the model should be returned.

Hunter, 1892 C. D. 192, 60 O. G. 1477.

A model should not be endorsed upon the file wrapper and be considered a part of the application unless the applicant has been required by the Office to furnish one.

Beaumel, 1891 C. D. 137, 56 O. G. 1203.

The specification drawing and model must correspond.

Schoonmaker, 1878 C. D. 40; Crandall, 1886 C. D. 5, 35 O. G. 626.

Definite reasons why a model is required must be given by the Examiner in his answer to an appeal from such requirement.

Jove, 1880 C. D. 122, 17 O. G. 801.

The policy of the Office now is to require drawings to be made so full and clear that in all simple easily understood cases models may be dispensed with.

Jove, 1880 C. D. 122, 17 O. G. 801.

In case an application is divided one model may serve for both applications.

Morse, 1873 C. D. 81, 3 O. G. 467.

A model required if the case admits of it even if not necessary to the understanding of the invention. (Old practice.)

Murdock, 1874 C. D. 103.

Rule 57. Requisites of Model.

The model must clearly exhibit every feature of the machine which forms the subject of a claim of invention, but should not include other matter than that covered by the actual invention or improvement, unless it be necessary to the exhibition of the invention in a working model.

Rule 58. Material.

The model must be neatly and substantially made of durable material, metal being deemed preferable; but when the material forms an essential feature of the invention, the model should be constructed of that material.

Rule 59. Working Models.

A working model may be required if necessary to enable the office fully and readily to understand the precise operation of the machine.

Rule 60. Models in Rejected and Abandoned Cases.

In all applications which have become abandoned, the model, unless it be deemed necessary that it be preserved in the office, may be returned to the applicant upon demand and at his expense; and the model in any pending case of less than one year's standing may be returned to the applicant upon the filing of a formal abandonment of the application, signed by the applicant in person and any assignee. (See Rule 171.)

Models belonging to patented cases shall not be taken from the office except in the custody of some sworn employee of the office specially authorized by the Commissioner.

Rev. Stat., sec. 485.

Rule 61. Models Filed as Exhibits.

Models filed as exhibits in contested cases may be returned to the parties at their expense. If not claimed within a reasonable time, they may be disposed of at the discretion of the Commissioner.

SPECIMENS.

Rule 62. Specimens of the Composition.

When the invention or discovery is a composition of matter, the applicant, if required by the Commissioner, shall furnish specimens of the composition, and of its ingredients, sufficient in quantity for the purpose of experiment. 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. (Rules 56, 60, and 61 apply to specimens also.)

Rev. Stat., sec. 4890.

THE EXAMINATION.

Introduction to Rules on the Examination.

"This, I believe, we owe in large measure to the civil service rules which were first put into effect during General Grant's administration, by that great Commissioner, Samuel S. Fisher. As a result of his wise action the standard has been set so high that the whole examining corps is made up of professional men with the stability of character and high ideals which the study of any great profession helps to develop. No one can find in the history of the Office any basis for objection to trusting its integrity in any way that the disposition of its business demands."

Com. Thomas Ewing, address Annual Banquet, American Patent Law Association; Washington, Feb. 28, 1916.

I think that every attorney before being admitted to the practice should be required to serve as Commissioner for at least six months. But since this is not practicable, let me give you this general suggestion by way of warning: Don't teach the Office bad tricks; don't do sloppy work; don't make dilatory actions; don't try to stop someone else who is entitled to it from getting a patent. In a word, don't do all the things you complain of when the Office does them.

Com. Thomas Ewing, address Annual Banquet, American Patent Law Association, Washington, Feb. 28, 1916.

Rule 63. Order of Examination.

Applications filed in the Patent Office are classified according to the various arts, and are taken up for examination in regular order of filing, those in the same class of invention being examined and disposed of, so far as practicable, in the order in which the respective applications have been completed.

Applications which have been put into condition for further action by the examiner shall be entitled to precedence over new applications in the same class of invention.

The following cases have preference over all other cases at every period of their examination in the order enumerated:

(*a*) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service, and when for that reason the head of some department of the Government requests immediate action and the Commissioner so orders; but in this case it shall be the duty of the head of that department to be represented before the Commissioner in order to prevent the improper issue of a patent.

(*b*) Applications for reissues.

(*c*) Cases remanded by an appellate tribunal for further action, and statements of grounds of decisions provided for in Rules 135 and 142.

(*d*) Applications which appear to interfere with other applications previously considered and found to be allowable, or which it is demanded shall be placed in interference with an unexpired patent or patents.

(*e*) Applications which have been renewed or revived, but the subject matter not changed.

(*f*) Applications filed more than twelve months

after the filing of an application for the same invention in a foreign country.

Applications will not be advanced for examination excepting upon order of the Commissioner either to expedite the business of the office or upon a verified showing that delay will probably cause the applicant serious and irreparable injury.

CONSTRUCTIONS.

Applications will not be given precedence over other cases in the order of examination merely because the applicant asks for an interference with a patent, but only in those cases where it appears that there is proper foundation for the request.

Lux, 116 O. G. 2011.

The question of classification rests entirely with the Office and is within the discretion of the Chief of the classification division to whom the Examiner refers the case if he has any doubt as to its classification. Petition to transfer the application refused.

Stevenot, 1904 C. D. 337, 111 O. G. 1939.

The Office can not take up cases in the order of their importance to the applicant, but must be governed by the rules.

Bischoff, 1902 C. D. 329, 100 O. G. 2603.

An application will not be transferred from one division to another on the ground that it is not receiving proper treatment by the Examiner in charge of it. Other relief will be applied when it is clear that the Examiner is not performing his duties as he should.

Weaver, 1897 C. D. 165, 81 O. G. 967.

The classification of the Office is not arbitrary. It is the natural work of those who create and develop the arts by invention and otherwise. The Office simply recognizes those relations and classes which exist in the nature of things.

Her, 41 O. G. 463; Wilcox & Borton, 45 O. G. 455;
Combs, 1871 C. D. 209; Sartell, 42 O. G. 295.

Cases which have been appealed and returned to the Examiner should take precedence for action over all other applications awaiting action except other similar cases.

Bigelow, 1878 C. D. 114, 14 O. G. 821.

There is a special propriety, when a patent has only a short time to run, in endeavoring to facilitate the determina-

tion of the issue which may arise in the application for a reissue.

Evarts, 1874 C. D. 39.

Rule 64. Merits Treated Throughout. At Last Form Insisted Upon.

Where the specification and claims are such that the invention may be readily understood, the examination of a complete application and the action thereon will be directed throughout to the merits; but in each letter the examiner shall state or refer to all his objections.

Only in applications found by the examiner to present patentable subject matter and in applications on which appeal is taken to the examiners in chief will requirements in matters of form be insisted on. (See Rules 95 and 134.)

HISTORY.

Rule 29 of 1873 reads in part as follows:

"The first step in the examination of an application will be to determine whether it is in all respects in proper form. If, however, an objection as to form is not vital, the Examiner may proceed to the consideration of the application on its merits; but in such case he must, in his first letter to applicant, state all his objections, whether formal or otherwise."

1879. Rule 63 adds to above matter: "And until the formal objections are disposed of no further action will be taken upon its merits without the order of the Commissioner," and inserts "if possible" after "must" in the last clause.

Present rule inserted in the edition of February 9, 1897.

See notes to Rule 67.

CONSTRUCTIONS.

If any patentable subject matter has been found, the formal requirements must be complied with.

Daum, 267 O. G. 183.

Not only does no reference cited anticipate appellant claim, but no combination of the references can be devised which will accomplish this end.

Heath, 230 O. G. 335-6.

The claims are therefore rejected on the ground that they are broader than applicant's conception.

Frietts, 227 O. G. 741.

In the absence of proof of mechanical skill only, and where the question of patentability is close, the doubt should be resolved in favor of applicant.

Heath, 230 O. G. 335-6.

The mere fact that one element of a structure forms part of each of two means which are set up as forming a combination of elements whereby certain functions may be accomplished is not of itself sufficient ground for holding the claim indefinite.

Isherman, 188 O. G. 807.

The objection that applicant has not shown "dual means, etc.," as specified in claims, should have been a rejection.

Iserman, 188 O. G. 807.

It is therefore seen that the application has been found by the Examiner to "present patentable subject matter" and consequently he is justified if the conditions of the case warrant in insisting upon his requirements for amendment in matters of form.

Fritsch, 173 O. G. 864.

The rule contemplates that all formal objections should be made in the first action. But they may, if necessary, be made afterward.

Fritsch, 173 O. G. 864.

If the invention may be understood the fact that additional drawings are required does not warrant postponing action on the merits.

Perkins, 142 O. G. 855.

Bitner, 140 O. G. 256. (See notes to Rules 65-66.)

The question of main interest is the merits and the postponement of formal matters is for the purpose of preventing delay in reaching a conclusion upon that question.

Severy, 97 O. G. 2745; Green, 130 O. G. 299.

Where the applicant states in his specification that he does not regard his invention as limited to the exact details of construction and it appears that his claims are not so limited, held that he should not be required to cancel the statement

as superfluous. (Ex parte Champ, 114 O. G. 1827, distinguished.)

Jansson, 120 O. G. 2127.

Where an applicant in good faith by amendment attempts to cure formal objections, if the amendments are not satisfactory the Examiner should so state in specific language.

Sjungstrom, 119 O. G. 2235.

The question of superfluous illustration should be finally raised only after the application has been restricted to allowable claims.

Metler, 119 O. G. 1259.

After several objections on the ground of insufficiency of disclosure, the claims should be rejecttd.

Stevens, 119 O. G. 1258.

The requirement of a supplemental oath (Matthes, 101 O. G. 3108) should be disposed of before an appeal is forwarded.

Teller, 113 O. G. 548-549.

The outlet to the atmosphere from the three-way valves 12, 12 should be shown in figure 1 before final action, but their appearance upon the drawing is not essential to an understanding of the invention and does not warrant suspension of action upon the merits of the invention.

Clark, 1904 C. D. 573, 109 O. G. 2169.

In case of alleged duplicate claims an action on the merits should be given and formal objection made at the same time to the multiplicity of the claims. Under no conditions, however, is refusing an action on the merits justifiable (as was said in Laperle and Baulard, 67 M. S. Dec. 9429).

Under this rule the Examiner was required to act upon the merits of the application without regard to the action upon mere reason for suspending action upon merits.

Segelhorst, 1904 C. D. 125, 109 O. G. 1887.

As to final rejection before formal matters disposed of.

Marks, 1904 C. D. 115, 109 O. G. 1608.

It is as essential that the formal question on which petitions are taken should be twice acted upon as it is that questions involving the merits should be twice acted upon. (Sec. 4909 R. S.) before appeals from the decisions of the Primary Examiners are taken to the Examiners-in-Chief.

Shone, 1902 C. D. 155, 99 O. G. 863.

The invention is a complicated one and can not of course be readily understood upon a mere inspection of the drawing. The drawing, however, is clear when read in connection with the specification, and the invention can be understood.

The condition of this application warrants an action throughout on the merits.

Springborn, 1902 C. D. 142, 99 O. G. 667.

If a part of an amendment is inadmissible the whole should be refused admission.

Pugh, 1901 C. D. 78, 96 O. G. 841.

The Examiner's action in making formal requirements after the case had been decided by the Examiners-in-Chief and the Commissioner on appeal was regular.

Olan, 1897 C. D. 24, 79 O. G. 861.

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

Becker, 1893 C. D. 95, 64 O. G. 559.

Final rejection should not be given until all matters of form are settled.

Where a claim was finally rejected and at the same time the statement of invention was criticised as being too broad, the final rejection was premature and an amendment touching the merits may properly be admitted thereafter.

Klaus, 1893 C. D. 87, 64 O. G. 299.

The course prescribed by this rule was not followed and on this account serious embarrassment has arisen in its prosecution.

Rogers, 1890 C. D. 121, 52 O. G. 460.

Where the Examiner had objected to a claim because of its undue breadth only and declined to further consider it upon the merits until it had been restricted in form, held that the reason given was a reason why the claim should be rejected and not why an examination should be refused.

Opdyke, 1890 C. D. 39, 50 O. G. 1293.

No requirement of amendment insisted upon as a condition precedent to future examination can be either legal or permissible which tends in the minutest degree to prevent the applicant from obtaining a full investigation of his rights on appeal.

Rogers, 1889 C. D. 227, 49 O. G. 1361.

Where two office letters were written, one containing formal objections and objections to the merits, and the second repeating the former objections to the merits, it was held two rejections warranting an appeal.

Mill, 1887 C. D. 92, 40 O. G. 918.

If the formal objections are vital no further action than to object on account of said formal defects should be taken until they are removed.

Mill, 1887 C. D. 92, 40 O. G. 918; Silltiman, 1886 C. D. 1, 34 O. G. 1389.

It is not until the Examiner signs the file wrapper and forwards the case to the issue division that he can be considered as having rendered a favorable judgment upon it.

Fredericks and Burns, 40 O. G. 591; Buell, 26 O. G. 437; Starr, 1879 C. D. 91.

An Examiner has jurisdiction until the case is allowed and passed to issue.

Fredericks and Burns, 40 O. G. 691; Starr, 1879 C. D. 91; Buell, 26 O. G. 437.

The office of Primary Examiner in the Patent Office is a continuing one, and does not change with the person of the incumbent.

Fredericks & Burns, 1887 C. D. 66, 40 O. G. 691.

If formal objections are not vital, all objections should be stated in the first letter, but the claims should not be rejected until the formal defects are removed.

Silltiman, 1886 C. D. 1, 34 O. G. 1389.

Applicants should be told distinctly and definitely what the objections are to their applications, reference to pencil marks on the specification is not sufficient.

Wilkins, 1883 C. D. 65, 24 O. G. 1271.

The practice of multiplying actions on cases on questions of mere form without at the same time touching the merits of the case, condemned as in violation of the spirit of Rule 63.

Kitson, 1881 C. D. 49, 20 O. G. 1750.

The matter of form referred to and contemplated in Rule 63 are such as relate to putting the case in condition to go to the Examiner; such as are required to remedy and utter absence of compliance with the prerequisites of an application under the law.

Kitson, 1891 C. D. 49, 20 O. G. 1750.

An Examiner can not submit a question to the Board of Examiners-in-Chief without expressing an opinion.

Coleman, 1880 C. D. 205, 18 O. G. 1051.

Upon a decision and notice that all formal objections have been removed, followed by a consideration of the case upon its merits, neither the same formal objections nor any other ought to be insisted on by the Examiner without the authority of the Commissioner.

Starr, 1879 C. D. 91, 15 O. G. 1053.

I do not think it reasonable after eighteen months spent on the merits of the case to insist upon such formal objections.

Bate, 1879 C. D. 84, 15 O. G. 1012.

REJECTIONS AND REFERENCES.

Rule 65. Notice of Rejection, with Information and References.

Whenever, on examination, any claim of an application is rejected for any reason whatever, the applicant will be notified thereof. The reasons for the rejection will be fully and precisely stated, and such information and references will be given as may be useful in aiding the applicant to judge of the propriety of prosecuting his application or of altering his specification, and if, after receiving this notice, he shall persist in his claim, with or without altering his specification, the application will be reexamined. If upon reexamination the claim shall be again rejected, the reasons therefor will be fully and precisely stated.

Rev. Stat., sec. 4903.

HISTORY.

Rule 33 of 1870 reads as follows:

"Whenever, on examination, any claim for a patent is rejected for any reason whatever, the applicant will be notified thereof, and the reasons for such rejection will be given, together with such information and references as may be useful in judging of the propriety of renewing the application or of altering his specification; and if, after receiving such notice, he shall persist in his claim for a patent, with or without altering his specification, the case will be reexamined."

The present rule is substantially the same as Rule 64 of June 18, 1897.

(For matter relating to abandonment and time limit, see Rules 77, 171, and 172.)

(See also notes to Rule 68.)

CONSTRUCTIONS.

The Examiner should follow the decision of the higher tribunal whether he agrees with it or not. It would not, however, be proper for the Commissioner to instruct the Examiner that the claims of a particular application should be

allowed in view of a prior decision. The Examiner thinks the prior decision is not pertinent if he is in error an appeal should be taken to the Board in the first instance.

Konald, 133 O. G. 279.

While it is not incumbent upon the Office to answer all the arguments presented by counsel, yet the prosecution of the case should be so conducted as to permit a fair chance for the amendment of the claims after the decision of the Office is made clear.

Herbst, 131 O. G. 361.

It does not appear that the Examiner has answered the contention of the applicant as to the reasons why he regards the patent cited as belonging to the same art so as to justify its citation in this case. It is quite clear that if an appeal should be taken from the final rejection it would be necessary for the Examiner to touch upon the subject. It is believed that the Examiner should do so before an appeal is made necessary.

Burge, 129 O. G. 1611.

Where several claims are rejected it should appear in the Examiner's letter whether all the references are cited against each claim, or whether they are cited distributively against the various claims. In the latter event it should be made clear in connection with each claim, which references are relied upon in the rejection thereof. Where several references are cited against a claim it should be made clear whether each reference is regarded as sufficient in itself to defeat the claims or whether the references are to be taken jointly. If to be taken jointly the theory upon which they are combined must be pointed out.

Lincoln, 127 O. G. 3216.

The common impression, however, the Examiner should ordinarily apply the references to the claims, element for element is unwarranted.

Lincoln, 127 O. G. 3216.

The Examiner should not be required to instruct the applicant upon the general principles or definitions of the patent law. The specific application of the law to this case as understood by the Examiner seems to have been sufficiently set forth by him.

Wainright, 1906 C. D. 495, 125 O. G. 2047.

When an applicant for a design patent presents a claim and the Patent Office says you can not have that claim, and you can have no claim but the one we suggest, such ruling is in effect a rejection of the claim presented and if the appli-

cant persists in his demand he is entitled to an appeal to the Examiners-in-Chief.

Delavoye, 1906 C. D. 320, 124 O. G. 626.

The Examiner stated that certain claims were so broad that they were "manifestly" impertinent in view of the prior art. Such a general statement without some reference to the disclosure in the prior art would not have been proper, but it appears that Examiner subsequently cited a reference and rejected the claims. It does not appear that he had cast a cloud upon or expressed a doubt as to the validity of claims allowed by him.

Holzer, 1906 C. D. 110, 121 O. G. 1011.

If two or more claims are met in a single reference or if the same ground of rejection apply to them, a single statement to that effect makes his position just as clear as would a repetition of the statement for each separate claim.

Murray, 1904 C. D. 358, 111 O. G. 2491.

It is not necessary that the Examiner shall meet every argument advanced by an applicant. It is necessary only that the Examiner's position be made plain on the record.

Stier, 1904 C. D. 156, 110 O. G. 559-600.

The Examiner's action was as full and complete as could be required of him. There was simply a disagreement between the applicant and the Examiner as to the "case" patent after discussion.

Leilich, 1904 C. D. 21, 108 O. G. 561.

It is a well recognized principle of law that doubts as to the patentability of a claim may be waived in favor of the applicant; but this should be a mental process and should not be formally expressed in the record.

Overstrom, 1903 C. D. 263, 105 O. G. 1531.

It is not fair to the applicant to throw a cloud upon his claims by a suggested doubt to their validity without rejecting any claim. The statement will be made specific but not expunged from the record.

Jungerfeld, 1903 C. D. 175, 104 O. G. 1655.

When applicant asks that certain features which he is unable to find in the references be pointed out ordinarily the Examiner should comply.

Miller, 1903 C. D. 147, 104 O. G. 309.

No statement in the Office letter that certain claims are novel can be held to be binding upon the Office to the extent that the claims of necessity must be subsequently allowed.

Fowler, 1902 C. D. 465, 101 O. G. 2822.

It is one of the best settled principles of practice that an

applicant shall be fully informed of the reasons for rejection and shall have ample opportunity to meet them.

Morely, 1902 C. D. 114, 99 O. G. 668.

The objection of inoperativeness should be made only when supported by a statement of the reason therefor and not dogmatically. The applicant obviously can not know what argument to make in the effort to convince the Examiner until he know what position the Examiner takes.

Gibon, 1902 C. D. 117, 99 O. G. 227.

The application as a whole should not be rejected, but only the claims thereof, and the rejection should be plain, unmistakable terms and the word "rejected" should be used.

Byrnes, 191 C. D. 152, 97 O. G. 191; Gammonds, 1902 C. D. 78, 98 O. G. 2171; Kendall, 1900 C. D. 174, 93 O. G. 754; Eastman, 1891 C. D. 178, 57 O. G. 410.

All references should be cited on first action, but it is sometimes impossible.

Waters, 1901 C. D. 243, 97 O. G. 2744.

To what degree it is necessary to point out such pertinence depends upon the circumstances of the case.

Sandman, 1900 C. D. 229, 97 O. G. 2532.

The purpose of requiring an explanation by the Examiner is not arbitrary, but is to enable the applicant to properly understand his position, and therefore the extent and scope of the explanation necessary must depend upon the circumstances of the particular case. Some formal defects are so plain that the mere mention of them is sufficient.

Schweitzer, 1901 C. D. 179, 97 O. G. 1371.

Where no objections to a claim are made it is to be concluded that there are no objections.

Albert, 1901 C. D. 66, 96 O. G. 426.

The Examiner must refer to the Office letter to which his action is a reply.

Official Order, 94 O. G. 1189.

This rule must be complied with no matter how well known the old way or device it.

Garnis, 1900 C. D. 160, 93 O. G. 190.

The Examiner is only required to comply with applicant's request for fuller explanation when applicant points out on what specific points he is in doubt. Henderson, 91 O. G. 228, 97 C. D. 1599. But when he points out the specific points, and asks to have explained the applicability of the references to them the Examiner should comply.

Kroeninger, 1900 C. D. 84, 91 O. G. 2002.

A general statement by the Examiner that the drawing was

unsatisfactory because the parts were not shown assembled, was held to be sufficiently specific.

Tuttle, 1900 C. D. 25, 90 O. G. 1365.

The Examiner should definitely define his position and point out the part of the devices referred to which he regards as anticipating applicant's claim.

Perkins, 1899 C. D. 141, 88 O. G. 548.

Applicant is entitled, before the case is closed before the Examiner, to an explanation of the references and their bearing on the claims rejected as full and clear as any explanation that would be considered necessary at any subsequent stage in the progress of the case.

Barnes, 1897 C. D. 76, 80 O. G. 2038.

Where on a question of division applicant alleges that his article can not be produced except by his process, and the Examiner says it can, without pointing out the mode, the Examiner's position is not tenable.

Hines, 1892 C. D. 164, 60 O. G. 576.

Applicant is entitled to have his claims allowed or to have them rejected in such language as to make it unmistakable that action has been had under R. S. 4909.

Wiard, 1890 C. D. 52, 51 O. G. 155.

The Examiner should assign all grounds that exist for rejection, in order that the whole case may be carried up on one appeal to the Examiners-in-Chief.

Roberts, 1890 C. D. 51, 51 O. G. 155; Wiard, 1890 C. D. 52, 51 O. G. 155.

It should never be considered a work of supererogation to give an applicant such full and complete information as will enable him to judge of the propriety of complying with the demands of the Examiner or of taking a petition or an appeal.

Burt, 1889 C. D. 251, 49 O. G. 1986.

The applicant has a right to have his applications examined as it stands until reasons of the Examiner for requiring an amendment are given.

Templeton, 1880 C. D. 128, 17 O. G. 910.

It is not worth while to make suggestions of claims. The applicant's attorney is entitled to present the case in his own way in the first instance, and to exercise his own judgment as to what course he will pursue to protect the applicant's interest when he is informed of it.

Evarts, 1874 C. D. 39, 5 O. G. 429.

Reasons must be definite, such as will allow of an issue being formed.

Evarts, 1874 C. D. 39, 5 O. G. 429.

Disparaging remarks as to the character of the invention of doubtful propriety.

Cheesebrough, 1869 C. D. 18.

Rule 66. On Rejection for Want of Novelty best References to be Cited.

Upon taking up an application for action on the merits the examiner shall make a thorough investigation of the prior art with respect to the invention sought to be protected in the application. Upon the rejection of an application for want of novelty, the examiner must cite the best references at his command. When the reference shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of the reference, if not obvious, must be clearly explained and the anticipated claim specified.

If domestic patents be cited, their dates and numbers, the names of the patentees, and the classes of invention must be stated. If foreign patents be cited, their dates and numbers, the names of the patentees, and the classes of inventions must be stated, and such other data must be furnished as may be necessary to enable the applicant to identify the patents cited. In citing foreign patents the number of sheets of drawing involving the parts relied upon for anticipation must be specified, and in case part only of the patent be involved, the particular sheets of the drawing containing the parts relied upon must be identified by number, or by stating the numbers of the figures involved. If printed publications be cited, the title, date, page or plate, author, and place of publication, or place where a copy can be found, shall be given.

When reference is made to facts within the personal knowledge of an employee of the office, the data shall be as specific as possible, and the reference must be supported, when called for, by the affidavit of such employee (Rule 76); such affidavit shall be subject to contradiction, explanation, or corroboration by the affidavits of the applicant and other persons. If the patent, printed matter, plates, or drawings so referred to are in the possession of the office, copies will be furnished at the rate specified in Rule 191, upon the order of the applicant.

HISTORY.

Rule 37 of 1869 reads as follows:

"Upon the rejection of an application for want of novelty, the applicant will be furnished with a specific reference (by name, date, and class) to the article or articles by which it is anticipated, so that he may be enabled to judge of the propriety of renewing his application, or of amending his specification to embrace only that part of the invention which is new. If he desires a copy of the cases so referred to, or of the plates or drawings connected with them, they will be forwarded to him, if in possession of the Office, on payment of the cost of making such copies."

The 35th to the 65th words, both inclusive, were omitted in 1870 and in 1871, omit all after "will" first occurrence, to end of bracketed clause and substitute therefore "if he demands it, be entitled to a specific reference (by name, date, and class, or the equivalent thereof.)"

1873. After "novelty," insert "the Examiner must cite the best references at his command."

The next change was to Rule 65 of 1879.

Rule 66 of 1888 reads as follows:

Upon the rejection of an application for want of novelty the Examiner must cite the best references at his command. When the reference shows or describes inventions other than that claimed by the applicant, the particular part relied on will be designated as nearly as practicable. The pertenence of the reference, if not obvious, must be clearly explained and the anticipated claim specified.

If domestic patents be cited, their dates and numbers, the names of the patentees, and the classes of inventions must be

stated. If foreign patents be cited, their dates and numbers must be stated and such other data must be furnished as will enable the applicant to identify the patents cited. If printed publications be cited, the title, date, page, or plate, and place of publication, or place where a copy may be found, will be given. When reference is made to facts within the personal knowledge of an employe of the office, the data will be as specific as possible, and the reference must be supported, when called for, by the affidavit of such employe (Rule 76); such affidavit shall be subject to contradiction, explanation, or corroboration by the affidavits of the applicant and other persons. If the patent, printed matter, plates, or drawings so referred to are in the possession of the Office, copies will be furnished at cost upon the order of the applicant.

In 1892 the words "at the rate specified in Rule 218" were inserted instead of "at cost," last line.

June 18, 1897, the requirement relative to foreign patent that "the names of the patentees, titles of the inventions, and classes of inventions must be stated" was inserted and with reference to publications that the "author" must be given.

See Rules 68, 69 and 77.

CONSTRUCTIONS.

(1) GROUNDS OF REJECTION IN GENERAL.
(2) PROPRIETY OF REFERENCES.
(3) ACTION BY THE OFFICE.
(4) ACTION BY THE OFFICE AS CONSTITUTING A PROPER FINAL REJECTION OF REOPENING THE CASE.
(5) NEW MATTER.
(6) REJECTION ON APPLICANT'S OWN PATENT OR APPLICATION.
(7) ACTION OF OFFICE AS TO UNITY OR DIVERSITY OF INVENTION.
(8) ADDITIONAL CASES.

(1) *Grounds of Rejection in General.*

If the Examiner knows of, or can find any art bearing upon the disclosure of the application he should cite it without reference to the wording of claims. Said of a delayed application for a reissue.

Altman, 220 O. G. 1373.

The Examiner ruled that he could not suggest a claim.

Vesey, 195 O. G. 273.

When the pertenency of the references is obvious as where the invention is simple or includes only the invention of the

applicant a detailed application of the references is unnecessary (133 O. G. 1188; 152 O. G. 229; 154 O. G. 1411).

Inman, 160 O. G. 1038.

The fact that a new claim was inserted in an application for a patent by the attorney for the applicant without any new oath does not render the patent invalid as to such claim, where it was within the invention described in the specification.

For cases in point, see Vol. 38, Cent. Dig. Patents, section 40?

Cutler-Hammer Mfg. Co. v. Union Electric Mfg. Co., 147 F. R. 266.

In the absence of proof of mechanical skill only, and where the question of patentability is close the doubt should be resolved in favor of the applicant.

Hiath, 230 O. G. 335-6.

The claims are therefore rejected on the ground that they are broader than applicant's conception.

Fritts, 227 O. G. 741.

Where an application is a continuation of one of prior date to the reference cited against common subject matter, the reference should not be insisted upon.

Allport, 220 O. G. 1374.

The piecemeal presentation of the art was of course annoying to the applicant and is not consistent with the attempt to hold the applicant strictly to the rule of prompt prosecution.

Levy, 220 O. G. 1043.

It is the policy of the Office closely to scrutinize claims after they have been pending in the Office an unusual length of time.

Cases, Fritts, 227 O. G. 737, distinguished from Goodwin Film Co. v. Eastman Kodak Co., 213 F. 231.

In view of the facts shown, no good reason is seen why the Examiner should be required to repeat in each letter an explanation of the reference once given.

Shillabarger, 200 O G. 855.

When a patent has inadvertently been granted, an application should not be rejected unless in a very clear case.

Both v. Burr, 200 O. G. 582.

Examiner required to identify figure of drawing of foreign patents referred to and, if only one sheet, that fact shall be stated.

Order No. 2,096, 199 O. G. 311.

When the applicant canceled two claims that were held

objectionable and immediately reinserted one a statement to that effect was held sufficiently explicit.

Ehrlich and Berthem, 191 O. G. 1068.

An action by the German Office cited—considered, but not followed.

Maas, 180 O. G. 1138.

Complete actions on the part of the Office are as important as the avoidance of piecemeal prosecution on the part of the applicant.

Garrett, 158 O. G. 701.

The requirement by the Examiner that a statement be made pointing out the parts or elements of his claims, approved.

Hoch v. McCaskey v. Hopkins, 141 O. G. 1161.

In all cases where Examiner holds a claim otherwise clear and intelligible to be functional, that is for a function merely or because it fails to include sufficient mechanical elements to effect the function expressed in the claim, the action of the Examiner shall be a rejection of the claim upon the ground that the claim does not point out the invention with sufficient particularity and distinctness to meet the requirements of section 4888, Revised Statutes. The rejection shall at the same time include all of the grounds enumerated in Rule 133 that the Examiner thinks applicable. Applicant's remedy from such action is by way of appeal successively to the Examiners-in-Chief, the Commissioner and the Court of Appeals of the District of Columbia. Second, that only where claims are indefinite, in the sense that they are ambiguous, equivocal, lacking in clearness, or unintelligible shall the Examiner's action be in the form of an objection. The remedy from this action is by petition to the Commissioner in person.

Bitner, 140 O. G. 256.

The Examiner finally rejected claims on a request for explanation. The Examiner did not refuse the request on the ground that the pertinency had been fully explained; but by coupling his explanation with a final rejection he rendered the information of no avail except through petition.

Walker, 129 O. G. 481; Andrews, 172 O. G. 1089.

As a general rule the Office may take judicial notice of its own records; but it should not in violation of the rule of secrecy refer to these records in communications which go to strangers to the cause except for imperative reason.

Robinson v. Copeland, 102 O. G. 467-6; Morley, 1902 C. D. 144, 99 O. G. 668.

Substantially the same claim as that herein presented was

found to be patentable in the earlier application. Upon renewal of that application after forfeiture it was subject to a new examination (Rule 176) and was again adjudged to be patentable. Under these circumstances any doubt as to the patentability of the claim in the new application should have been resolved in the applicant's favor. Petition to direct the Examiner to withdraw his rejection granted. The decision of a former Examiner should be very persuasive on his successor. (Starr, 15 O. G. 1053; Nealson, 81 O. G. 1787; Fowler, 101 O. G. 1833.)

Hay, 139 O. G. 197.

A claim will be given the broadest interpretation of which its terms are capable.

Milans, 135 O. G. 1122.

The Examiner should follow the decision of the higher tribunal whether he agrees with it or not. It would not, however, be proper for the Commissioner to instruct the Examiner that the claims of a particular application should be allowed in view of a prior decision. The Examiner thinks the prior decision is not pertinent if he is in error an appeal should be taken to the Board in the first instance.

Konold, 133 O. G. 2179.

Where the specification of a patent cited as an anticipation does not state of what material the article is composed it can not ordinarily be assumed to be of any particular material.

Walters, 130 O. G. 1483.

After previous claims—"What remains would appear to be a mere carrying out of the purpose of the original invention."

Wickers and Farlong, 129 O. G. 2074.

It does not appear that the Examiner has answered the contention of the applicant as to the reasons why he regards the patent cited as belonging to the same art so as to justify its citation in this case. It is quite clear that if an appeal should be taken from the final rejection it would be necessary for the Examiner to touch upon the subject. It is believed that the Examiner should do so before an appeal is made necessary.

Burge, 129 O. G. 1611.

No absolute right is conferred by the grant of the patent. The patentee is merely put in position to assert his *prima facie* right in case of infringement and have the same adjudicated in a court where extrinsic evidence, if important, may be heard and not confined as in this court, to a review of the decisions of the Patent Office upon the record as made up

therein. (In re Thomson, 26 App. D. C. 426-429; Seymour v. Osborne, 11 Wall 516-544; Parker & Whipple Co. v. Yale Clock Co., 1887 C. D. 584, 41 O. G. 811.)

Heroult, 127 O. G. 3217.

Where several claims are rejected, it should appear in the Examiner's letter whether all the references are cited against each claim, or whether they are cited distributively against the various claims. In the latter event it should be made clear in connection with each claim which references are relied upon in the rejection thereof. Where several references are cited against a claim it should be made clear whether each reference is regarded as sufficient in itself to defeat the claims or whether the references are to be taken jointly. If to be taken jointly, the theory upon which they are combined must be pointed out.

Lincoln, 127 O. G. 3216.

The common impression, however, that the Examiner should ordinarily apply the references to the claims element for element is unwarranted.

Wickers and Furlong, 127 O. G. 2074.

Because we are of the opinion that the claims 6 and 7 do meet such requirements and to that extent mark an advance over the prior art, we decide that such claims should have been allowed by the Commissioner of Patents.

Hill, 1906 C. D. 572, 121 O. G. 340.

It is only when the question of novelty is in doubt that the fact that the device has gone into commercial use, displacing others employed for the same purpose or supplying the place of others whose intrinsic defects have prevented their general adoption and use, is sufficient to turn the scale in favor of invention. (Potts v. Creager, 155 U. S. 597, 699.)

Thomson, 1906 C. D. 566, 120 O. G. 2756.

In examining an application the office should consider that by the grant of a patent a patentee is merely put in a position to assert his *prima facie* right against infringers who may in their defense raise the question of the validity of the patent and have the same finally adjudicated in the light of a full presentation and consideration of all the evidence attainable in respect of anticipation, prior knowledge, use and the like.

Thomson, 1906 C. D. 566, 120 O. G. 2756.

Where there was doubt as to the sufficiency of the references and the applicant demonstrated that he had produced an apparatus of great utility, held that the doubt should be resolved in favor of the applicant's claim.

Thomson, 1906 C. D. 566, 120 O. G. 2756.

It is the duty of the Patent Office to require applicants to make their claims clear and definite and therefore it will not read limitations into claims pending before it to avoid references, but will require applicant to include them clearly and definitely.

Seely v. Baldwin, 1905 C. D. 316, 117 O. G. 2633.

One who accomplishes a result by a process which is only partially or not at all understood by him has invented nothing, and can not deprive another, who afterwards discovers and proclaims the true principle of the operation, of the rights of an inventor.

Judge Gray's dissenting opinion in Johnson v. Chisholm, 115 F. R. 633.

Reference in analogous art.

115 F. R. 324.

The object of the provision of this rule is to enable the applicant to understand clearly the position taken by the Examiner.

Fletcher, 1905 C. D. 26, 114 O. G. 545.

In general, when the claims are rejected, all grounds of rejection should be given in order that the case may be disposed of upon a single appeal. When, however, claims are made to a machine or device the alleged operation of which is based on principles in direct conflict with the fundamental laws of science and mechanics, it is thought a case is presented which should be made an exception.

Payne, 1904 C. D. 42, 108 O. G. 1049 (see Gibon, 99 O. G. 227).

The first action should be careful and complete and new requirements or references should not be necessary except when rendered so by applicant's amendments.

Lewis, 1904 C. D. 16, 108 O. G. 559.

While a favorable action by an Examiner should be very persuasive, it is not binding upon his successor when called upon to pass a claim previously acted upon.

Fowler, 1902 C. D. 420, 101 O. G. 1833-4.

When two claims substantially the same are presented they should be rejected and no objection is seen to referring to the fact that claims to the real invention have been allowed in the case.

Riley, 1902 C. D. 416, 101 O. G. 1832.

The reasons why the Examiner thinks the subject matter *inoperative must be given.*

Gibon, 1902 C. D. 117, 99 O. G. 227.

It is the purpose of Rules 65 and 66 to lay down a course

of procedure which will facilitate the speedy prosecution of applications and not to permit the applicants to delay such prosecutions by insisting on a compliance with the rules on the part of the Office without a like compliance on their own part.

Sandman, 1901 C. D. 229, 97 O. G. 2532.

There is no interference in fact between the constructions covered in counts for the reason that these counts, though identical in language, cover in fact mechanisms which differ materially in construction and operation.

Goss v. Scott, 1901 C. D. 80, 96 O. G. 842.

Rule must be read as whole.

Buck, 1900 C. D. 5, 94 O. G. 222.

The Examiner rejected the application upon his knowledge of public use. On appeal Examiner reversed. Affidavit filed by direction of Examiner and application rejected upon the affidavit. Return of appeal fee refused because no request for affidavit was made by applicant.

Van Ausdal, 1900 C. D. 74, 91 O. G. 1617.

Similarities and differences in a machine, process or product do not depend upon mere names of things, words used to describe them or immaterial matter by which they may be distinguished.

Palmer Co. v. Lozier, 84 Fed. 669, citing Glue Co. v. Upton, 97 U. S. and Bates v. Coe, 98 U. S. 31-42; Edgecombe v. Eastman & Houston, 1899 C. D. 207, 89 O. G. 707.

While a claim deemed allowable by one Examiner is always subject to rejection by his successor upon references or reasons not before considered and it may be, in exceptional cases, on the references previously considered, the spirit of Rule 144 would seem to indicate that the favorable action of an Examiner should be at least extremely persuasive upon his successor.

Nealon, 1897 C. D. 174, 81 O. G. 1787.

There being no doubt as to lack of invention in this case, there is no room for consideration of the doctrine, which the appellant enunciates, that in case of doubt, that doubt should be resolved in favor of the applicant.

Snider, 1894 C. D. 23, 66 O. G. 1309.

Where a claim was finally rejected and at the same time the statement of invention was criticised as being too broad, the final rejection was premature and an amendment touching the merits may properly be admitted thereafter.

Klaus, 1893 C. D. 87, 64 O. G. 299.

A rejection for "lack of invention" is in effect a rejection for "want of novelty" and the Examiner must cite references under Rule 66.

Clifford, 1893 C. D. 9, 62 O. G. 316.

Practice in the examination of an application prescribed.

Eastman, 1891 C. D. 178, 57 O. G. 410.

The matter of examinations and the function of the Examiner treated at length by Commissioner Mitchell.

Rogers, 1889 C. D. 227, 49 O. G. 1361.

Where two Office letters were written, one containing formal objections and objections to the merits, and the second repealing the former objections to the merits, it was held two objections warranting an appeal.

Mill, 1887 C. D. 92.

Applicants should be told distinctly and definitely what the objections are to their applications, reference to the pencil marks on the specification is not sufficient.

Wilkins, 1883 C. D. 65, 24 O. G. 1271.

A reference relied on to anticipate the novelty of the invention must contain the devices claimed, either in a drawing or description: and in either case the invention must be so distinctly shown or described as to be a matter of certainty, not of inference.

Herron, 1872 C. D. 135, 1 O. G. 608.

Irregularities in practice pointed out. References cited as to one claim, and no objections made as to the other in first letter; more particular specification as to invention in one of the claims required in the second letter; in the third letter first and second claims rejected upon references, additional references cited as to first claim, then an appeal to the Board taken, then an amendment submitted withdrawing the second claim, and first claim rejected.

Buxton, 72 C. D. 226.

Such matters and such only as are in point should be brought into the case. It is vexatious to all concerned to cite a number of random references, all different from each other and for that reason impossible to apply to meet a specific claim.

Brownlee, 1872 C. D. 208, 3 O. G. 212.

There are almost as many different rules of practice in finding references and making rejections as there are different examiners in the Office.

Moore, 1871 C. D. 250.

(2) *Propriety of References.*

Not only does no reference cited anticipate applicant's claim, but no combination of the references can be devised which will accomplish this end.

Hiath, 230 O. G. 335-6.

Patents filed before, but granted after the application was filed, are properly cited.

Bryder, 178 O. G. 886 (cases); see also Lemley v. Dobson-Evans Co., 243 F. R. 391; Jackson Cushion Spring Co. v. Adler, 243 F. R. 386; Gressling Box Co. v. Gumb, 243 O. G. 241.

Affidavits as to utility and state of the art. In the case of Eastwood, 144 O. G. 819, 33 App. D. C. 291 and *In re* Moore, 172 O. G. 891, 38 App. D. C. 276, affidavits of this character were considered by the Court of Appeals and the court reversed the Office largely in the case made in said affidavits.

Asst. Com. Mss. Dec.

See paper by Mark L. Whitney, read before the Examining Corp of U. S. Patent Office, Feb. 15, 1917.

See notes to Rule 76.

When requested so to do in good faith the Examiner should apply the references. Cases collected.

Andrews, 172 AO. G. 1889.

A design patent may anticipate a mechanical patent.

Williams Bulk Co. v. Nevership Mfg. Co., 136 Fed. 210.

In order to constitute a bar the printed and published description must exhibit the invention in such full and intelligible manner as to enable persons skilled in the art to understand the operation of the invention and to carry it into practice (cases).

Marconi v. Shoemaker, 131 O. G. 1941.

Applicant's own patent for a process granted less than two years previous to this for the apparatus is not a good reference.

Isaacs & Speed, 130 O. G. 2717.

Where the specification of a patent cited as an anticipation does not state of what material the article is composed it can not ordinarily be assumed to be of any particular material.

Walters, 130 O. G. 1483.

The patent to which attention was called is in a remote art, and the Examiner, it is understood, has held the claims in issue patentable there over. No such unusual circumstances as will justify the exercise of supervisory authority exists.

Dagett v. Kaufmann, 127 O. G. 3641.

"They" (the elements) are all perfectly well known, and if not known in the combination described, they are known in combinations so analogous that the court is at liberty to judge for itself whether there be any invention in using them in the exact combination claimed.

Hill, 1906 C. D. 572, 121 O. G. 340.

Considering the references and the general state of the art, we fully agree with the Commissioner, that the record made shows nothing more than the work of a skilled mechanic.

Baker, 1906 C. D. 594, 121 O. G. 1352.

When a prior combination cited against the combination claimed included elements in addition to those used by the applicant which result in differences in operation undesirable for the purpose of the applicant's device and one of the elements of the prior combination is different from the corresponding element of the applicant's combination, held that a patent should not necessarily be refused on account of the prior combination.

Thomson, 1906 C. D. 566, 120 O. G. 2756.

Separate features may be found in different references.

Sindingchristensen, 1906 C. D. 88, 120 O. G. 2755.

A foreign patent is prima facie published at the date it indicates. The burden is upon applicant to show to the contrary.

Beck, 1903 C. D. 277, 105 O. G. 1781.

An apparatus is not an anticipation of the process of using the same.

Wagner (Ct. of Ap. D. C.), 1903 C. D. 629, 105 O. G. 1783.

"Indeed, while there are expressions in the opinion of the Commissioner of Patents which imply that all which the applicant invented was an apparatus and the function of that apparatus, yet it is conceded that the apparatus was only one of the various modes for giving effect to the process."

Wagner, 1903 C. D. 629, 105 O. G. 1783.

In designs the doctrine of double use is not limited to the selection of devices in the same or analogous mechanical arts.

Knothe, 1903 C. D. 42, 102 O. G. 1294.

Where the Examiner rejects a claim because he thinks its subject matter old he should either recite a specific reference showing the prior art or make the affidavit called for by Rule 66. Where the Examiner referred to an accessible device as illustrating an alleged common practice, no oath required.

Walker, 1903 C. D. 12, 102 O. G. 465-6.

To anticipate a process patent, it is necessary not only to

show that the prior patent might have been used to carry out the process, but that such use was contemplated, or at least that it would have occurred to any mechanic. It is now too late to insist that it would have been suggested to any mechanic of ordinary skill and intelligence.

The Carnegie Steel Co., Limited, v. The Cambria Iron Co., 1902 C. D. 592, 99 O. G. 1870.

It is true that the Jones patent is a simple one and in light of present experience it seems strange that none of the expert steel makers, who approached so near the consummation of their desires, should have failed to take the final step which was needed to convert their experiments into an assured success. This, however, is but the common history of important inventions, the simplicity of which seem to the ordinary observer to preclude the possibility of their involving the exercise of the inventive faculty.

The Carnegie Steel Company, Limited, v. The Cambria Iron Company, 1902 C. D. 592, 99 O. G. 1870d.

Some of the expressions, taken by themselves, seem to foreshadow the Jones idea; but there was nothing in any of these discussions that filled the requirement of the law. (R. S., sec. 4886) of a description in a publication sufficient to anticipate the patent.

The Carnegie Steel Company, Limited, v. The Cambria Iron Company, 1902 C. D. 592, 99 O. G. 1870c, 1870d.

A process can only be anticipated by a similar process. It is not sufficient to show a piece of mechanism by which the process might have been performed.

The Carnegie Steel Co., Limited, v. The Cambria Iron Co. Works, 1902 C. D. 592.

Rejection upon two references. An ozone producer consisting of a high frequency apparatus and an ozonizer is anticipated by the same high frequency apparatus and the same ozonizer, separately.

Varley, 1902 C. D. 172, 99 O. G. 1621.

That which infringes if later anticipates if earlier. See Miller v. Eagle Mfg. Co., 95 C. D. 161, 80 O. G. 661, and numerous authorities cited.

Steck, 1902 C. D. 9, 98 O. G. 228.

Where differences in degree cause a different mode of operation.

Potts v. Creager, 1900 C. D. 39, 90 O. G. 2134; and McBerty v. Cook, 1900 C. D. 248, 90 O. G. 2295.

When a foreign patent is cited the burden of proof is upon applicant to show that it bears a wrong date.

Hummel v. Tingley, 1900 C. D. 22, 90 O. G. 959-960.

Combination held to be old, if it is clear that by assembling these elements in ont structure no new effect which is different or more than the sum of the effects of the separate elements is secured.

Perkins, 1899 C. D. 141, 88 O. G. 548.

Complete anticipation is rare and to reject a claim on the ground that it is substantially met by a reference is practically the same as to reject it on the ground of lack of invention in view of the reference, such difference as remains not involving invention.

Ferguson, 1894 C. D. 6, 66 O. G. 651.

Novelty is not negatived by any prior patent or printed publication, unless the information contained is full enough and precise enough to enable any person skilled in the art to which it relates to perform the process or make the thing covered by the patent sought to be anticipated. Foreign patent as reference.

Deprez & Carpenter v. Bernstein v. Hunter, Gaulard and Gibbs, 1891 C. D. 53, 54 O. G. 1711.

After a patent is granted for an article described as made by causing it to pass through a certain method of operation to produce it the inventor can not afterwards on independent application secure a patent for the method or process of cutting away the metal and then binding it, so as to produce the identical article covered by the previous patent, which article was described in that patent as produced by the method or process sought to be covered by taking out the second patent.

The Mosler Safe & Lock Co. v. Mosler B. & Co., 1888 C. D. 420, 43 O. G. 1115.

An English provisional specification should be referred to as a publication and not a patent.

Maynard, 1870 C. D. 54; Cochran, 1869 C. D. 60; Lauder v. Croswell, 1879 C. D. 177; 16 O. G. 405; Lowry, 1869 C. D. 85.

A combination is not anticipated by its elements separately.

Stone, 1873 C. D. 105, 4 O. G. 54.

When a new use of a thing produces an important effect never before produced or develops or makes practical some new property of matter not previously known, the new use is not analogous to the former uses, and therefore, the novelty of the mere agent is immaterial.

Hawes, 1871 C. D. 225.

A patent should not be granted with broad claims after

one for the same invention with narrow claims has been issued to the same applicant.

Edison, 1 O. G. 263.

An Examiner is not limited in his inquiry into the novelty of an invention on which a patent is asked, to investigation in the particular subdivision of inventions of which he has charge.

Burnham, 1872 C. D. 26, 1 O. G. 164.

References should be limited to things of a kindred nature and there should be some analogy between the use and the result of the device in question and the reference upon which it is rejected.

Hawes, 1871 C. D. 255; Moore, 1871 C. D. 249; for example, see Lesnew, 1871 C. D. 204; Hillard, 1871 C. D. 179; Williams, 1871 C. D. 177.

(3) *Action by the Office.*

A rejection of the claims as anticipated by references is not objectionable as throwing a cloud on the title.

McPherson, 196 O. G. 1051-1052.

When a clear issue has been reached and it is evident that applicant understands the application of the references, no further explanation of the references is necessary.

Kelley, 183 O. G. 220.

A reference to a decision of the Commissioner held sufficiently definite.

Patterson, 178 O. G. 885.

An acting by the German Office cited, considered, but not followed.

Maas, 180 O. G. 1138.

In case of ordinary doubt, the policy of the patent system, as customarily maintained in the Patent Office, has been to give the applicant the benefit thereof because no absolute right of property is conferred by the grant of a patent. (Thomson, 26 D. C. 419-425.)

Moore, 178 O. G. 891; see 177 O. G. 772.

When the Examiner required applicant to diminish the number of claims and grouped the same in accordance with the practice in Ex parte Kadow, 154 O. G. 1412, and Ex parte Chapman, 120 O. G. 446, held that he should have also acted upon the merits of each group of claims.

Both, 182 O. G. 974.

The Examiner should reject the claim if he thinks the structure recited is insufficient to sustain the whereby clause.

Hoge, 173 O. G. 1081.

If the Commissioner recommends certain claims, only these claims should be considered.

Selden, 164 O. G. 741, 36 App. D. C. 428; 173 O. G. 1080.

Claims should not be allowed merely because they present a multitude of elements all of which do not appear in one or two or even more references.

Fagan, 162 O. G. 538-539.

It is the duty of the Examiner to consider not only the claims but the invention disclosed. If he is of the opinion that an application discloses no invention over the references, it is perfectly proper for him to so state.

Fox, 157 O. G. 485.

When Hall applied for his patent he neither conceived nor disclosed any such retardant action of clay, or indeed made clay an element in any claim and that the subsequent introduction thereof into the patent was suggested as a mere theory to overcome valid objections to the grant of the patent. We are satisfied that this theory was neither based on previous experience or proved by subsequent devtlopments. Rejection was right.

Casem Co. v. Collins Co., 155 O. G. 554.

The Examiners-in-Chief on appeal made a recommendation that one claim be rejected upon a reference not cited by the Primary Examiner. The Primary Examiner adopted such suggestion but refused to receive a general amendment to the case approved. "If, however, the applicant will present an amendment either amending claim 6 or presenting a claim or claims limited to the subject matter covered by that claim, the same may be entered and considered.

Dietrich, 142 O. G. 568; 157 O. G. 1244; 170 O. G. 482.

The issue being strictly formed and the amendment to claims not being substantial, the request at the end of applicant's argument that if a favorable decision could not be given there should be a final rejection, should be complied with.

Marshall, 139 O. G. 198.

Where an Examiner finds it necessary to give reasons explaining the application of a reference, a final rejection should not be entered in the same letter where the reasons have been cited for the first time.

Jackson, 132 O. G. 1324.

It is a liberal practice that permits a party to extend the prosecution of a case and increase the work of the Office to

the detriment of other applicants by presenting new claims after action by the Office, which are not responsive to the Office action, without showing why they were not earlier presented. There are good reasons why this practice should be continued, but when amendments of this character are made applicant should assist the Office by presenting the reasons why they believe the new claims allowable.

Richards, 124 O. G. 2534.

Final action on a case marks the close, not merely of the consideration of the particular claims before the Office, but the close of the consideration of any claims in that application.

Casselman, 116 O. G. 2012.

Applicant should not be cut off from the right of amendment in such a summary way in a complicated case like this, as it is the policy of the Office to give applicants every reasonable opportunity.

Stuart, 109 O. G. 1069.

The Office action is not complete until proper data is given to enable applicant to judge of the propriety of the action.

Stead, 107 O. G. 834.

A final rejection requiring a showing under this rule may be made before all formal matters are disposed of.

Severy, 97 O. G. 2745.

It is the fact of a second rejection and not the language of the letter of rejection that closes the case. However, the Examiners are directed hereafter to definitely state that the claim is finally rejected.

Kendall, 1900 C. D. 174, 93 O. G. 754.

Where the case is simple in its nature, where the applicant has an attorney of skill and experience, where the Examiner clearly rejects all the claims upon certain patents cited, and applicant "clearly understands that the Examiner in charge considers that the entire case lacks invention and such ground of rejection is accepted fully," a basis does not exist for further action under Rule 66.

McGarrell, 1892 C. D. 45, 58 O. G. 1256.

Material amendments in matter of substance made in good faith can not lawfully be refused consideration by the Office at any time before the issuance of the patent.

Winchester, 80 C. D. 92; see, however, Thurmond, 1886 C. D. 30, 37 O. G. 217.

No more than two rejections can be had for the same reason.

Evarts, 1874 C. D. 39.

In entering a final rejection there is no impropriety in

arguing the applicability of the references of record anew provided the new grounds of rejection are cited. In this case, however, the rejection set forth for the first time the exact grounds upon which the claims were held unpatentable. Examination not closed.

Mygatt, 184 O. G. 801.

(4) *Action by the Office as Constituting a Proper Final Rejection or Reopening the Case.*

See Rules 77 and 171.

Although there were but two actions it is clear that an issue has been reached between the Examiner and the applicant. No further action necessary.

McPherson, 196 O. G. 1051-1052.

Stating his reasons for rejection more fully does not reopen a case.

Movley, Jr., 185 O. G. 1379.

If the letter ends, the applicant may consider this action final if he wishes. This does not close the case and the applicant is entitled to further amend.

Mygatt, 185 O. G. 828.

As a general rule a final rejection should not be given on the second action on the merits.

Mygatt, 185 O. G. 828.

The response made to the final rejection was clearly a sufficient response to a rejection upon new grounds. The Examiner is therefore directed to consider the application on its merits in view of the argument.

Mygatt, 184 O. G. 802.

Rule is applicable to design applications.

Beltendorf, 184 O. G. 801.

Examiner required an explanation, which being given under head of remarks, was required to be inserted in specification. A final rejection proper when this was not done.

Dean, 177 O. G. 1295.

August 12, 1910, Examiner held that claims 5 and 6 were allowable after correction and finally rejected other claims.

January 3, 1911, amendment cancelling the finally rejected claims and adding three new ones.

Entry refused.

August 21, amendment cancelling claims offered, case abandoned.

After the case was finally rejected applicant should, within one year from the date thereof, either have cancelled

the claims, taken an appeal, or taken steps which resulted in having that final rejection set aside as premature.

Dietricks, 174 O. G. 829.

Whether the action of the Office was such as to confer the right to amend is one that may not be controlled by mandamus.

Lang v. Moore, Com., 172 O. G. 834.

A criticism of the theory of operation of the device that does not amount to holding it inoperative does not reopen a case.

Hardy, Jr., 161 O. G. 268.

However, if it is pointed out that the claims do not contain the matter relied on and if they did they would be anticipated by a reference of record, this does not constitute the citation of a new reference.

Scott, 166 O. G. 985.

After a case is ready for appeal if a new reference is cited the applicant may continue his appeal in view of such amendment or to further prosecute the case before the Primary Examiner. (Mevey, 56 O. G. 805.)

Scott, 166 O. G. 85.

Two claims rejected on three references, one claim withdrawn, the other claim rejected in view of said references. Good final rejection.

Gentry, 162 O. G. 537.

Applicant was entitled to have the claims considered and the reasons of rejection fully stated, and such action should now be taken.

Pledger, Jr., & Campbell, 157 O. G. 486.

After final rejection no affidavit under Rule 75 will be received. (Berg, 120 O. G. 903.)

Romunder, 157 O. G. 209.

Following the interference certain previously allowed claims were rejected because applicant was not the first inventor thereof, as disclosed by the interference proceeding. Such rejection is based upon a new ground and is a new reason for rejection, in view of which applicant has the right to amend under Rules 65 and 68 and section 4903 of the Revised Statutes.

Klepelko, 126 O. G. 387.

Where the Examiner acts on formal objections after the final rejection of the claims, the applicant is entitled to a year from the Examiner's action in which to cure the objections and in the absence of any rule or practice to the contrary he should likewise be allowed this year in which to

appeal to the Examiners-in-Chief or to cancel the rejected claims.

Thomas, 124 O. G. 623.

The mere fact that the letter closing primary consideration of the case stated the grounds of rejection at greater length than they had been before stated does not present new reasons for rejection. The final rejection was in order and was properly given.

Flindall, 122 O. G. 1396.

A petition to set aside a final rejection dismissed as premature where no request had been made of the Primary Examiner to withdraw that rejection.

Lawton, 122 O. G. 259.

A more extended statement of grounds of decision does not reopen case.

Kinney & Schultz, 121 O. G. 2325.

Application rejected upon two references. Affidavit under Rule 75 filed to overcome one reference. By refusing consideration of the affidavit because the other reference was sufficient in itself, the Examiner does not reopen the case.

Berg, 120 O. G. 903.

The applicant is clearly entitled to be informed which claims previously rejected are the same in substance as those placed under final rejection.

But the giving this information does not relieve the case from final rejection.

Thayer, 118 O. G. 2252.

The withdrawal of a ground of rejection does not reopen a case.

Wagner, 118 O. G. 1684.

While the explanatory matter in the letter of final rejection states more explicitly the grounds for refusing the reissue in the form requested, the original letter nevertheless stated these grounds with such clearness that the applicant could have intelligently planned his course of action. Rejection proper.

Wagner, 118 O. G. 1684.

An applicant should have an opportunity to amend after he understands or has had an opportunity to understand thoroughly the Examiner's position.

Greth, 116 O. G. 2532.

After rejection claims canceled. A requirement of amendment to the specification did not reopen the case to admit new claims.

Casselman, 116 O. G. 2012.

May amend as often as the Examiner presents new references or reasons for rejection against any of the claims.

Booth, 113 O. G. 2216.

It is not sufficient to justify a final rejection that a patent has been cited against other claims; but it must appear that the Examiner and the applicant have clearly reached an issue as to the pertinency of the patent as regards the specific claim said to be anticipated by it.

The pertinency of references if not obvious should be pointed out.

Booth, 113 O. G. 2216.

After final rejection Examiner received and entered an amendment containing an allowable claim. Held that this did not reopen the case for further amendment. The practice should be analogous to that under Rule 78.

Meacham, 113 O. G. 1417.

If the Examiner acts upon a suggestion of the Examiner-in-Chief it is an action on his own motion and restores applicant's right to a reconsideration.

Burrowes, 110 O. G. 599.

A final rejection was proper although a reference cited in the action before the last and not cited in the last action was again cited.

Minich, 107 O. G. 1971.

If the last action finally rejecting the application was informal an amendment is a proper action.

Goldman, 100 O. G. 234.

If it is intended to close the matter the Examiner should use the words "finally rejected."

Gammons, 98 O. G. 2171; Byrnes, 97 O. G. 191. Citation of new references opens case. Gammons, 98 O. G. 2171; Lawton, 97 O. G. 187.

A proposed amendment was offered to a case under final rejection, the Examiner refused to enter it because it did not comply with the second paragraph of the rule, and at the same time cited references alleged to anticipate new claims. Held that by citing new references the Examiner opened the case.

Lawton, 1901 C. D. 142, 97 O. G. 187-188.

Gray, 1889 C. D. 91, 46 O. G. 1277.

After the first rejection the applicant may insist upon his claim as presented. If the Examiner reaffirms his former decision without supporting it with fresh references, the rejection is final as there is no remedy but appeal. But if the Examiner gives new references the applicant has a right to

reply to them, or to amend his application by reason of them if he desires to do so.

Appleton, 1869 C. D. 8.

(5) *New Matter.*

See Rule 70.

If the Examiner is of the opinion that the amendment presents new matter he should reject all claims affected thereby, and applicant may appeal to the Examiners-in-Chief.

Smyth, 114 O. G. 762.

When new matter is introduced the whole application should be examined and the application rejected because of such new matter.

Soley, 1900 C. D. 71, 91 O. G. 1616.

If in the opinion of the Examiner, the proposed amendment to the drawing involves new matter, the changes in the drawing should not be allowed until the question of new matter has been determined, but claims based on this matter should be considered and rejected on the ground of departure and for all other reasons that are applicable, so that all matters may be settled at one appeal.

Ernest, 1896 C. D. 33, 76 O. G. 1417.

If in the opinion of the Examiner the application as amended involves a departure from the original invention such want of identity would furnish ground for rejection.

Bennett, 1886 C. D. 11, 35 O. G. 1003.

(6) *Rejection on Applicant's Own Patent or Application.*

Applicant's own patent for a process granted less than two years previous to this for the apparatus is not a good reference.

Isaacs & Speed, 130 O. G. 2717.

Anticipation by one's own patent and estoppel in previous record.

Newark Spring Mattress Co. v. Ryan, 102 F. R. 693.

It is proper in some cases to reject a claim because of the allowance to the same party of other claims.

Riley, 1902 C. D. 416, 101 O. G. 1832; Leonius, 1903 C. D. 126, 103 O. G. 1164.

It is suggested that there is not proof that the Bundy who filed the earlier application is the same party as the Bundy who filed the later case. There is, however, *prima facie* evidence that they are the same such as will justify placing the burden of proof upon Rumbarger. If they are not the same, Rumbarger may show it by the proofs.

Bundy v. Rumbarger, 1900 C. D. 145, 92 O. G. 2002.

It is well settled that it is proper under certain circumstances to reject the claims in an application on an allowed application filed by the same party.

Osborne, 1900 C. D. 137, 92 O. G. 1797.

References to applicant's previous patent.

Jones v. Larter, 1900 C. D. 111, 92 O. G. 383.

Rejection on patent to same inventor.

Edison, 1891 C. D. 1, 54 O. G. 263.

The formal abandonment of an application should not be required as a condition precedent to the allowance of another application of the same inventor pending concurrently and in condition for allowance, nor should the Examiner require the erasure of any claim which would be allowed if no other application awaited consideration. The true course to be pursued is that pointed out in Ex parte Gaboury, 1886 C. D. 28, 37 O. G. 217.

Feister, 1890 C. D. 167, 53 O. G. 1089.

Anticipation by one's own patent.

Woodward, 1890 C. D. 169, 53 O. G. 1090.

Anticipation by one's own patent. Application pending at the same time.

Feister, 1890 C. D. 167, 53 O. G. 1089.

Where the invention described and not claimed in a prior patent to the same inventor which might have been lawfully claimed in the first patent there is a presumption of dedication from the failure to make reservation or to file a concurrent application.

Biggs, 1890 C. D. 32, 50 O. G. 1130.

A claim in an application is not anticipated by a patent to applicant showing but not claiming the invention when such invention could not have been properly claimed in said patent.

Johnston, 1889 C. D. 130, 46 O. G. 1641.

The question we have to decide is whether the description of another invention in a prior patent by the same inventor forfeits his rights to take out a subsequent patent for such invention. I do not understand that the Supreme Court has held that such prior description is a dedication to the public of the second invention. Judge Colt in

Eastern Paper Bag Co. v. Standard Paper Bag Co., 1887 C. D. 537, 41 O. G. 231, and cases cited.

A patent for either a machine or process will not bar a patent for the one of said inventions not patented provided the statutory forfeiture of two years use has not been.

Eastern Paper Bag Co. v. Standard Paper Bag Co., 1887 C. D. 537, 41 O. G. 231.

A failure to file a disclaimer under Rule 42 does not make the patent issued upon one application a bar to the other.

Roberts, 1887 C. D. 61, 40 O. G. 573.

It is undoubtedly true that when a patent issued for an invention, all of which is shown but only part of which is claimed, there is a dedication to the public of that part which is unclaimed.

Roberts, 1887 C. D. 61, 40 O. G. 573.

A patent should not issue upon an application which is not properly a division of the subject matter of a patent to the same party, even though the application upon which the patent was granted was concurrent.

Lowe, 1870 C. D. 39, 20 O. G. 176; Ransom, 1887 C. D. 22, 39 O. G. 119; Roberts, 1887 C. D. 613, 40 O. G. 573; Holt, 1884 C. D. 43, 29 O. G. 171.

The fact that an applicant has two applications pending for the same thing is no reason for the rejection of the second application unless the first has been passed to issue or a patent granted upon it.

Gaboury, 1886 C. D. 28, 37 O. G. 217.

If two applications are pending at the same time a patent granted upon the first, which shows but does not claim the subject matter of the second, will not bar a patent upon said second application.

Emerson, 1880 C. D. 143, 17 O. G. 1451; Roberts, 1887 C. D. 61, 40 O. G. 573; Derby, 1884 C. D. 21, 26 O. G. 1208; Holt, 1884 C. D. 43, 29 O. G. 171.

If two applications are not pending at the same time, a patent granted upon the first showing but not claiming the subject matter of the second, will not bar a patent upon second application if a reservation clause as to such matter is inserted in the application upon which the patent is granted.

Atwood, 1869 C. D. 98; Derby, 1884 C. D. 21, 26 O. G. 1208; Contra Rohm, 1883 C. D. 106, 25 O. G. 1190; Long, 1883 C. D. 104, 25 O. G. 1189.

"A question is made by the defendants whether an inventor is not to be presumed to abandon his design when he exhibits it in the drawings of a mechanical patent. I do not see why this consequence should follow until the design has been in use for two years, but I do not decide this point . . ."

Burton v. Greenville, 1880 C. D. 602.

When two applications by the same applicant are pending at the same time, and a patent is issued upon the application last filed, the claims which might have been inserted in either application when both were pending can not be inserted in the

application first filed, but must be inserted, if at all, in the reissue of the patent. Or, if the applications are not pending at the same time.

Loring v. Hall, 1879 C. D. 8, 15 O. G. 471; Emerson, 1879 C. D. 330, 12 O. G. 1232; Arkell, 1877 C. D. 73, 11 O. G. 1111; Stempel, 1879 C. D. 161, 16 O. G. 316.

I am much inclined to think that the mere fact that a new article is shown in the drawing of a patent for a machine would not of itself be an abandonment of the new article which would properly be the subject of a different patent, until the statutory forfeiture of use for two years had been incurred.

Hatch v. Moffitt, 15 F. R. 255.

(7) *Action of Office as to Unity or Diversity of Invention.*

See Rule 42.

Final rejections are given in cases where division is required without closing the case to amendment.

Sanders v. Howthorne v. Hoyt, 1906 C. D. 467, 125 O. G. 1347.

Applicant must comply with the requirement for division or appeal to the Examiners-in-Chief.

Wallace, 1906 C. D. 461, 125 O. G. 992.

"They" "(the courts)" do not look with favor upon the refinements of division which lead to many patents being issued for various improvements incorporated upon a single device.

Briede, 1906 C. D. 677, 123 O. G. 322-324.

The facts of each case must be considered, with the burden upon the applicant who asserts that two statutory inventions are one unitary invention. We are confirmed in this conclusion by the utterances of the court in the Steinmetz case.

Frasch, 1906 C. D. 648, 122 O. G. 1048.

A requirement for division is to be treated something like a demurrer upon which the allegations of fact are assumed to be true. The things claimed are assumed to be inventions for the purpose under consideration and the only question is whether these things are so closely related as to warrant their inclusion in one application. The assumption of course is not to be continued after the question of division is settled and the question of patentability of the several claims is taken up.

Steinmetz, 117 O. G. 901.

Before refusing to examine a new claim because of alleged new matter the question of division should be settled.

Lawley, 1904 C. D. 539, 113 O. G. 1967.

The Examiner will not be directed to select the invention to be retained.

This is left to applicant except where an amendment is presented which necessitates a requirement of division. In this case applicant is required to cancel claims upon which an examination has not been made. (Sille, 110 O. G. 1728.)

Tuttle, 1904 C. D. 537, 113 O. G. 1967.

An amendment which in the opinion of the Examiner would require division if offered, should nevertheless be entered, since the appeal is now to the Examiners-in-Chief.

Deane, 1904 C. D. 330, 111 O. G. 1937.

The practice of refusing to enter amendments necessitating division was based upon the practice of considering the matter upon interlocutory petition, and it has no application now, since the question of division is appealable.

Selle, 1904 C. D. 221, 110 O. G. 1728.

Good practice requires that a requirement for division be made at the earliest date upon which it appears that division is necessary.

Lewis, 1904 C. D. 16, 108 O. G. 550; Baer, 1904 C. D. 117, 109 O. G. 1609.

An amendment which if entered would require division should be refused notwithstanding the fact that it was presented before action by the Office.

Dubern, 1904 C. D. 61, 108 O. G. 1588.

An amendment that would require division should not be entered.

Murmann, 1900 C. D. 183, 93 O. G. 1721; Mitzger, 1902 C. D. 407, 101 O. G. 1612; Osborne, 1902 C. D. 100, 98 O. G. 2365; Gally, 1903 C. D. 480, 107 O. G. 1660.

Applicant given the benefit of a doubt while separate applications for these distinct inventions may be warranted by the classification, it does not of itself preclude the prosecution of claims for these distinct inventions in the same application.

Uhlig, 1903 C. D. 300, 106 O. G. 541.

The suggestion that an amendment should not be entered because it would immediately necessitate the requirement for division is not applicable for the reason that the rejection of the claims called for an amendment to them. The amendment has reference solely to the rejection.

Beck, 105 O. G. 1782.

The question of division is one of form and not of merits, and according to the provisions of Rule 42, should ordinarily be settled before action on the merits.

Collamore & Kerst, 1903 C. D. 241, 105 O. G. 746.

The action in this case rejecting certain claims which the Examiner regarded as covering one form of the invention on references and then rejecting other claims on the ground merely that they cover a modification is thought to be erroneous.

Collamore & Kerst, 1903 C. D. 241, 105 O. G. 746.

An action on the merits with a requirement of division prohibited by Rule 42.

MacKaye, 1903 C. D. 112, 103 O. G. 888-9.

The order 83 O. G. 301, requiring a cursory examination, approved. This is not an action on the merits. This is not applicant's right, but a courtesy extended by the Office.

MacKaye, 1903 C. D. 112, 103 O. G. 888-9.

The Examiner is required to give his reasons. Question of division.

Tyson, 1902 C. D. 476, 101 O. G. 3106.

A requirement of division is not an action on the merits.

Frasch, 1902 C. D. 560, 100 O. G. 1977.

In requiring that the Examiner should cite references against both inventions means such references as he has in mind. If he cites none it is to be supposed that he has none in mind.

Albert, 1901 C. D. 66, 96 O. G. 426.

Where a division is required the Examiner should cite such references as are in his mind. (830. G. 301) but applicant is not authorized to rely on such action.

Randall & Luck, 1901 C. D. 47, 95 O. G. 2063.

Where a division is required the Examiner (apparently) should cite the state of the art in reference to both inventions.

Thurman, 1901 C. D. 30, 93 O. G. 1721.

An objection to a claim for a design that it is not single, but on the contrary, calls for three separate articles aggregated, is one pertaining to the merits and should therefore have been a rejection.

Myres, 1893 C. D. 103, 64 O. G. 859.

If the Examiner is of the opinion that there is a want of divisibility of invention between the claims of an application and the claims of a patent to the same applicant, both applications having been pending concurrently, he should reject the claim for that reason.

Appeal is to Examiners-in-Chief.

Feisler, 1892 C. D. 203, 61 O. G. 152.

A second invention can not be introduced as a modification of the first.

Bogart, 1876 C. D. 162, 10 O. G. 113.

Where an application is amended so as to eliminate one invention there would seem to be no objection to retaining all the figures of the drawing, and the description thereof in the body of the specification, unless other applications are to be made on this subject matter.

Shepard, 1872 C. D. 244, 3 O. G. 522.

The Examiner should require a division before an examination is made.

Rice, 1874 C. D. 44, 5 O. G. 522; Pastor Perez de la Sala, 1888 C. D. 3, 42 O. G. 95.

(8) *Additional Cases.*

Hallowell, 1903 C. D. 268, 105 O. G. 1533-34; Scriven, Ex parte, 1891 C. D. 204, 57 O. G. 1127-28; Opdyke, 1890 C. D. 39, 50 O. G. 1293 (see note to Rule 67); Luber, 1894 C. D. 47, 67 O. G. 529 (see Rule 70); Knudsen, 1895 C. D. 29, 72 O. G. 589 (see note to Rule 37); Cahill, 1893 C. D. 78, 63 O. G. 1815 (see note to Rule 37); Miller, 139 O. G. 730; White, 134 O. G. 2027 (see note to Rule 34).

Rule 67. Adverse Decisions on Preliminary Questions in Ex Parte Cases.

Whenever, in the treatment of an *ex parte* application, an adverse decision is made upon any preliminary or intermediate question, without the rejection of any claim, notice thereof, together with the reasons therefor, will be given to the applicant, in order that he may judge of the propriety of the action. If, after receiving this notice, he traverse the propriety of the action, the matter will be reconsidered.

HISTORY.

This rule introduced in 1879.

See notes to Rule 64.

CONSTRUCTIONS.

Where an applicant in good faith, by amendment, attempts to cure formal objections, if the amendments are not satisfactory, the Examiner should so state in specific language.

Lungstrom, 1905 C. D. 541, 119 O. G. 2235.

After several objections on the ground of insufficiency of disclosure, the claims should be rejected.

Stevens, 1905 C. D. 502, 119 O. G. 1258.

Where an applicant secures a dissolution of an interference upon his allegation that the claims are not patentable, held that he should be required to cancel the claims. To reject the claims implies that there is an open question as to applicant's right, and there is not a question in fact.

Miller, 116 O. G. 2532.

Where an applicant does not desire suspension of his application to await the termination of an interference, proceedings in which another application of the same applicant is involved, the Examiner should reject the claims in the case under consideration on the interference issue.

McCormick, 1904 C. D. 575, 113 O. G. 2508.

The requirement of a supplemental oath (Matthes, 101 O. G. 3108, 1902 C. D. 484) should be disposed of before an appeal is forwarded.

Teller, 1904 C. D. 468, 113 O. G. 548-549.

When applicant fails to make a claim suggested under Rule 96 within the time limited, when the claim is presented, it should be entered and rejected.

Swift, 1904 C. D. 365, 111 O. G. 2495.

If the Examiner is of the opinion that the device is inoperative, he should reject it for this reason. It is irregular to require a model (Stocker, 1902 C. D. 53, 968 O. G. 1705).

Beath, 1904 C. D. 343, 111 O. G. 2220.

Only one species may be prosecuted in one application. The Examiner does not waive his right to object upon such a ground by inadvertently receiving and acting upon claims to two species.

1904 C. D. 170, 110 O. G. 857.

The Examiner is undoubtedly authorized to raise and determine the question of inoperativeness.

Brisband, 1903 C. D. 459, 107 O. G. 1097.

But must give his reasons for such an opinion.

Gibon, 1902 C. D. 117.

If claims are involved in an interference on a separate application action suspended awaiting termination of such interference.

Robinson, 1902 C. D. 433, 101 O. G. 2079.

An applicant should not be required to elect between two claims to the same invention unless those claims are substantially the same. The allegation that they are not patentably different is no ground for the requirement.

Lahue, 1902 C. D. 357, 101 O. G. 448.

The applicant was defeated in an interference proceeding and filed a new application with the same claims in it. The Examiner refused to consider it *res adjudicata*. Applicant contended that admitting his opponent's patent was a part of the prior art, still he was entitled to a patent. It was held that his application should be acted on.

Schüpphaus, 1902 C. D. 339, 100 O. G. 2775.

In case a division is required references are recited cursorily, but this does not constitute an action on the merits generally, but may do so if it is made to appear distinctly.

Goldman, 1902 C. D. 238, 100 O. G. 234.

The Examiner ruled that a heavier-than-air flying machine was necessarily inoperative. The Commissioner said:

"It is the very purpose of invention to do that which had not been done before, and this Office can not consistently allege a reason for refusing a patent the mere fact that no one heretofore has succeeded in accomplishing the result."

Gibon, 1902 C. D. 117, 99 O. G. 227.

When the invention is not properly claimable as a process, it is the duty of the Office tribunals to so hold if they be of that opinion.

Trevette, 1901 C. D. 170, 97 O. G. 1173.

Claims refused admission because they were for aggregations and other reasons.

Brownell, 1901 C. D. 30, 94 O. G. 988.

Claims merely aggregating two independent inventions should be rejected before requiring a division.

Griffith, 1898 C. D. 233, 85 O. G. 936.

The degree of utility of a device is unimportant in determining whether a device be patentable. If the invention is not frivolous or prejudicial and has any degree of usefulness, then within the meaning of the law it is useful and may be patented. The degree of utility is not a question for the Patent Office to arbitrarily determine.

Sanche, 1897 C. D. 32, 80 O. G. 185.

Where the art as claimed omits a step necessary to its lawful practice, such omission is a proper ground of rejection.

Turner, 1894 C. D. 36, 66 O. G. 1595.

It is proper sometimes to stand upon a mere legal opinion, but it is only advisable in the absence of any other ground of adverse action. When there is a reference "a simple dictum" should not be resorted to.

Fairbanks v. Robinson, 1873 C. D. 12, 3 O. G. 65.

It is improper to require the elimination of a claim or

claims because they present illegitimate combinations, the claims should be rejected.

Wiard, 1890 C. D. 52, 51 O. G. 155.

Where the Examiner had objected to a claim because of its undue breadth only and declined to further consider it upon the merits until it had been restricted in form, held that the reason given was a reason why the claim should be rejected and not why an examination should be refused.

Opdyke, 1890 C. D. 39, 50 O. G. 1293.

The Patent Office has jurisdiction to see that the requirements of the statute, as to the specification and claims shall be complied with.

Paigel, 1887 C. D. 71, 40 O. G. 807.

Material amendments in matter of substance made in good faith can not lawfully be refused consideration by the Office at any time before the issuance of the patent. Immaterial amendments should not be received.

Winchester, 1880 C. D. 92, 17 O. G. 453.

AMENDMENTS AND ACTIONS BY APPLICANTS.

Rule 68. Right to Amend.

The applicant has a right to amend before or after the first rejection or action; and he may amend as often as the examiner presents new references or reasons for rejection. In so amending the applicant must clearly point out all the patentable novelty which he thinks the case presents in view of the state of the art disclosed by the references cited or the objections made. He must also show how the amendments avoid such references or objections.

After such action upon an application as will entitle the applicant to an appeal to the examiners in chief (Rule 134), or after appeal has been taken, amendments canceling claims or presenting those rejected in better form for consideration on appeal may be admitted; but the admission of such an amendment or its refusal, and any proceedings relative thereto, shall not operate to relieve the application from its condi-

tion as subject to appeal, or to save it from abandonment under Rule 171. If amendments touching the merits of the application be presented after the case is in condition for appeal, or after appeal has been taken, they may be admitted upon a showing, duly verified, of good and sufficient reasons why they were not earlier presented. From the refusal of the primary examiner to admit an amendment a petition will lie to the Commissioner under Rule 142. No amendment can be made in appealed cases between the filing of the examiner's statement of the grounds of his decision (Rule 135) and the decision of the appellate tribunal. After decision on appeal amendments can only be made as provided in Rule 140, or to carry into effect a recommendation under Rule 139.

HISTORY.

Rule 34 of 1869 was the same as Rule 31 of 1870 except that the last sentence was omitted and instead of the words "Assistant Commissioner" the words "Commissioner in Person" was used.

Rule 31 of 1871 reads: "The applicant has a right to amend after the first rejection; and he may amend as often as the Examiner presents any new references. After a second rejection and at any time before the issue of a patent, special amendments may be made if sufficient reason therefor be shown."

Rules of 1873 inserted "on approval by the Commissioner" after "made," and added, "but such amendments must first be submitted to the tribunal last acting on the case, for recommendation or objection. Affidavits in support of applications will not be received at any stage of the examination unless the Office denies that the device is operative."

In 1878 the clause "and will be subject to revision and restriction the same as original amendments" appears between "objection" and the period before "affidavits."

In 1884. "After an appeal or" was inserted in the revised Rule 67 of 1879 before "After such action the" and the following matter was added: "No amendment can be made between hearing on appeal and decision; and after decision by any appellate tribunal amendments can be made only in

accordance with such decision, except as provided in Rule 137."

Substantially the present rule, omitting the last clause, in 1888.

Following the notes to this rule I have reproduced the paper read by Examiner Wm. A. Kinnan, Jan. 28, 1915, before the Examining Corps of the U. S. Patent Office; another paper relating to the Examination was read by Examiner James H. Colwell, March 25, 1915.

See Rules 66, 69 and 77.

CONSTRUCTIONS.

(1) PROPRIETY OF APPLICANT'S ACTION.
(2) APPLICANT'S ACTION AS A FOUNDATION FOR A FINAL REJECTION.
(3) SHIFTING GROUND.
(4) ACTION BY THE OFFICE.
(5) REOPENING AFTER FINAL REJECTION.
(6) AMENDING AFTER APPEAL.
(7) AMENDING FOR APPEAL.
(8) ADDITIONAL CASES.

(1) *Propriety of Applicant's Action.*

A joint application may apparently be amended by eliminating one of the applicants.

In re Roberts, 273 O. G. 410.

If necessary, an amendment may be made during an interference.

Liebman et al. v. Newcomb, 229 O. G. 613.

A broadening of the claims without explanation is improper. If the Examiner objects to the multiplicity of claims this should be replied to.

Creviling, 197 O. G. 779.

Amendment by telegram confirmed by letter is proper.

Wheary, 197 O. G. 534.

Claims can only be taken out of the case by definite instructions of the applicant.

Iddings & Iddings, 197 O. G. 239.

In asking the withdrawal of a final rejection proper action should be taken.

Morley, Jr., 185 O. G. 1379.

The response made to the final rejection was clearly a sufficient response to a rejection upon new grounds. The Examiner is therefore directed to consider the application on its merits in view of the argument.

Mygatt, 184 O. G. 802.

If one has not complied with this rule in pointing out all

the novelty he has no right to assume that he will be allowed a claim under Rule 78.

Goldsmith & Whiting, 184 O. G. 553.

An issue should be reached. A final rejection should not be given upon the second rejection unless an unmistakable issue has been reached.

Bass, 183 O. G. 506.

The action of the Examiner in apparently allowing claim 8 warranted applicant in assuming that in presenting his claims relating to the same subject matter an argument was unnecessary.

Beard, 178 O. G. 319.

Aug. 12, 1910, Examiner held that claims 5 and 6 were allowable after correction, and finally rejected other claims. Jan. 3, 1911, amendment cancelling the finally rejected claims and adding three new ones. Entry refused.

Aug. 21. Amendment cancelling claims offered. Case abandoned. After the case was finally rejected applicant should, within one year from the date thereof, either have cancelled the claims, taken on appeal, or taken steps which resulted in having that final rejection set aside as premature.

Dietrich, 174 O. G. 829.

Where there is a rejection of the ground that no sufficient elements are enumerated to sustain a functional clause, or for want of particularity "it may be urged that if he is obliged to seek his remedy by appeal and the action of the Examiner is affirmed the applicant is precluded from going back to the Examiner and further amending his claims, the obvious answer is that before appealing the claims and before they are finally rejected the applicant should introduce other claims having the structure stated with sufficient particularity to avoid this ground of the Examiner's rejection.

Bitner, 140 O. G. 256; 173 O. G. 1081.

An applicant may not insert a new set of claims after a requirement of division.

Moorehead, 173 O. G. 1079.

The applicant should point out how his device differs from that of the references to entitle him to have the Examiner point out the pertenency of the same.

Levy, 173 O. G. 288.

Claims to the motor allowed. Petition to withdraw from issue to present claims to the combination of the motor with washing machine. Refused for want of showing.

Weber & Swalter, 173 O. G. 288.

If applicant does not consider all the references cited and

point out where in his opinion the references do not apply the action is not responsive and the case is abandoned.

Sachs, 157 O. G. 755.

The Examiner rejected two claims a second time and cited a new reference against other claims, applicant acted on said other claims but said nothing about the first two.

"I am of the opinion that applicant's amendment was as complete as he could have made it without repetition.

"If the applicant has seen fit to present further reasons why the rejected claims should be allowed it was his privilege to do so; but it is presumed that he had no further reasons to present. Having once presented his argument, it was not incumbent upon him to repeat it. Not abandoned."

Newbold, 155 O. G. 553.

A claim introduced by amendment relates back to the date of the filing of the application.

McFarland v. Watson & Watson, 146 O. G. 257.

The practice of repeatedly filing amendments which can serve no purpose except to prolong the life of the case or which are presented in the hope of wearing the Examiner into allowing a claim upon the ground that because of its specific character it can do no harm, can not be too strongly condemned.

Perry, 140 O. G. 1001; 157 O. G. 1243; 172 O. G. 1089.

It is not sufficient that applicant distinguishes his device from one of the references, it must be from all.

Inman, 160 O. G. 1038; 172 O. G. 1089.

It may be, as the patentee's counsel declares, that the criticisms of the Examiner led to the present form of the claim. But if the Examiner's criticisms were unsound the patentee could have had them reviewed by an appropriate appeal.

Logan v. Warren Axle and Tool Co., 166 O. G. 986.

In Ex parte Perry the practice was condemned of repeatedly filing amendments in the hope of wearing the Examiner into allowing a claim upon the ground that because of its specific character it can do no harm.

Pledger, Jr., & Campbell, 157 O. G. 486; 172 O. G. 1089.

The Examiner rejected two claims a second time and cited a new reference against these claims, applicant acted on said other claim but said nothing about the first two.

"I am of the opinion that the applicant's amendment was as complete as he could have made it without repetition." If the applicant had seen fit to present further reasons why the rejected claims should be allowed it was his privilege to do

so. but it is presumed that he had no further reasons to present. Having once presented his argument it was not incumbent upon him to repeat it.

Newbold, 155 O. G. 553.

Amendment embodying the theory of the attorney, patent held void.

Steward v. American Lava Co., etc., 149 O. G. 602.

Where claims were rejected and canceled and broader claims substituted it was necessary that applicant should state why he regarded them as patentable.

Opeland, 149 O. G. 309.

Inserting claims by attorney without new oaths does not invalidate.

Cutler-Hammer Mfg. Co. v. Union Electric Mfg. Co., 147 T. R. 266. See Singer Mfg. Co. v. Cramer, 97 O. G. 555.

Affidavits as to utility and state of the art.

In re Eastwood, 144 O. G. 819.

The Examiner-in-Chief on appeal made a recommendation that one claim be rejected upon a reference not cited by the Primary Examiner. The Primary Examiner adopted such suggestion but refused to receive a general amendment to the case. Approved. "If, however, the applicant will present an amendment either amending claim 6 or presenting a claim or claims limited to the subject matter covered by that claim, the same may be entered and considered."

Dietrich, 142 O. G. 568.

The practice of repeatedly filing amendments which can serve no purpose except to prolong the life of the case or which are presented in the hope of wearing the Examiner into allowing a claim upon the ground that because of its specific character it can do no harm, can not be too strongly condemned.

Perry, 140 O. G. 1001.

The excuse that the files were misplaced seems to have been considered a sufficient excuse for delay beyond the year.

Curtis, 138 O. G. 767.

Piecemeal action is contrary to the spirit and the letter of the rules and the statutes and is not to be permitted.

Schmitt & Tanody, 121 O. G. 689; Sperry, 121 O. G. 687.

Apparently if applicant inserts claims that are not properly included in the case they should be rejected for this reason and the other claims examined on their merits. The inser-

tion of the claims does not seem to warrant the Examiner in refusing to act as the merits of the other claims.

Scott, 100 O. G. 681; Goeby, 133 O. G. 991.

Without such a showing the amendments submitted were not admissible although it would have been proper to cure the informalities by proper amendment (Paige, 108 O. G. 1587). Such an amendment, however, under the provisions of Rule 68 would not relieve the application from its condition as subject to appeal or save it from abandonment.

Green, 130 O. G. 299.

A request for explanation of the Examiner's position should be full and specific and should not be confused with the argument upon the merits of the action.

Knapp and Cade, 128 O. G. 1687.

Applicants should fully present their case upon each action.

Knapp v. Cade, 128 O. G. 1687.

Where an applicant before the Patent Office acquiesces in the ruling that his claim is not patentable, he can not be heard to question the ruling thereafter, and it is immaterial whether it is right or wrong.

Computing Scale Co. of America v. The Automatic Scale Co., 119 O. G. 1586.

An amendment erroneously entitled in one case can not be transferred to another.

"Since the amendment has been placed in the record of one case and replied to therein, it must remain there to preserve the record."

Haultain & Stovel, 119 O. G. 649.

Whether well founded or not the Examiner's action is binding upon the applicant until set aside, and it is incumbent upon him to take steps to have it set aside within the year allowed by law for action.

Read, 119 O. G. 337.

Claims should be amended, not construed, to avoid references and the same course should be followed in all other cases when the meaning of claims is not clearly expressed by their language.

Briggs v. Little v. Cooke v. Jones and Taylor, 116 O. G. 871.

Sound reason requires as much of the applicants a clear and proper explanation of their position as it does of the Examiner.

Murray, 111 O. G. 2491.

Application for method, claims for apparatus and product,

introduced subsequently. These latter claims take date of filing of application so far as bar of public use is concerned.

Edison v. American Mutoscope Co., 110 F. R. 660.

"In an ex parte case the applicant has no knowledge what references and reasons for rejection the Examiner may discover and has no opportunity to argue the matter before the Examiner's decision is rendered." Applicant is undoubtedly entitled to argue the matter and since he can not do so before the decision, the statute gives him the right to do so after decision.

Newcomb v. Lemp, 110 O. G. 308.

When the claims were twice rejected as involving new matter an amendment not remedying this defect is not responsive and should not be admitted.

Edwards, 109 O. G. 1051.

Where certain formal objections are made and the claims are finally rejected, held that the applicant may amend to avoid the formal objections, but can not make amendments presenting new claims or affecting the merits.

Paige, 108 O. G. 1587.

It is the duty of an applicant not only to prepare the papers required by the Office, but to see that they are received. If he receives no acknowledgment from the Office within a reasonable time after mailing the paper, it is his duty to make inquiries and correct the mistake which apparently exists.

Stuckgold, 1900 C. D. 307, 106 O. G. 544.

If an amendment is made inserting words after "and" in a certain line and "and" occurs twice in that line, a mistake is the fault of the applicant.

Curtiss, 105 O. G. 500.

Definitions and admissions made by an applicant for a patent in the course of the proceedings in the Patent Office, in order to avoid or differentiate his invention from those disclosed considered in the subsequent construction of his patent.

New York Asbestos Mfg. Co. v. Ambler Asbestos Air Cell Covering Co., 103 F. R. 316.

Applicant has a right to amend claims that have been rejected after an interference.

Harvey, 102 O. G. 621.

Acquiescence. Estoppel. Construction.

Electric Railway Company of the United States v. Jamaica & Brooklyn Railroad Company, 1894 C. D. 406.

Apparently if applicant inserts claims that are not properly included in the case, they should be rejected for this reason and the other claims examined on their merits. The insertion of the claims does not seem to warrant the Examiner in refusing to act on the merits of the other claims.

Scott, 100 O. G. 681; *Greely*, 133 O. G. 991.

The Examiner required one of two claims to be eliminated because they were identical; in complying, the applicant limited the scope of his invention by estoppel.

The United States Repair & Guaranty Co. v. The Assyrian Asphalt Co., 98 O. G. 582-584.

Effect of arguments in construing patent.

Swain v. Holyoke Machine Co., 97 O. G. 400.

If a part of an amendment is inadmissible the whole should be refused entry.

A new drawing may not be filed arbitrarily at the option of the applicant, the drawing already in the case being satisfactory.

Pugh, 1901 C. D. 78, 96 O. G. 841-2.

Unwarranted persistency condemned. Letters and amendments may be returned.

Dravo and Miller, 91 O. G. 460-1.

Affidavits under Rule 75 are responsive to the Examiner.

Wright & Stebbins, 1899 C. D. 153, 88 O. G. 1161.

Applicants are not required to make amendments at all unless good reasons therefor are in the first place presented by the Office.

Winchester, 80 C. D. 92.

The burden is upon the applicant to establish by proof that is clear and conclusive, the patentability of the invention as claimed.

Durham v. Com., 1895 C. D. 307, 71 O. G. 601.

An amendment to an application for a patent made to introduce a new theory of the invention, and which contains new claims covering a process based on such theory neither of which were mentioned in the original application, if permissible as within the invention, should be verified by the oath of the inventor. (For cases in point, see Cent. Dig., Vol. 38, Patents 152.) Amendment of application, see note to

Cleveland Foundry Co. v. Detroit Vapor Stove Co., 68 C. C. A. 239.

The most casual inspection of the cases cited in support of the appellant's contention, for example, Topliff v. Topliff (59 O. G. 1257, 1892 C. D. 402), shows that the expression quoted from the opinion referred to differences of construction and

of function so wide as to make the citation inapposite in this case.

Snider, 1894 C. D. 23, 66 O. G. 1309.

A claim was erased to secure an allowance, a petition to withdraw the case from issue in order to reinstate the claim was denied.

Potter, 1890 C. D. 163, 53 O. G. 760.

If an applicant makes an amendment in compliance with the demand of an Examiner as to some particular matter, it is not necessary for the applicant to state his reasons therefor, unless his amendment is of greater scope than the requirement of the Examiner.

Winchester, 1880 C. D. 92.

Material amendments in matter of substance made in good faith can not lawfully be refused consideration by the Office at any time before the issuance of the patent. Immaterial amendments should not be received.

Winchester, 1880 C. D. 92, 17 O. G. 453.

(2) *Applicant's Action as a Foundation for a Final Rejection.*

That the final rejection was a surprise is not a ground for an extension of time for amending claim.

Hartford, 184 O. G. 551.

Final rejection should not be given upon the second official action unless an unmistakable issue is reached to the patentability of the invention claimed.

Bass, 183 O. G. 506; Cook, 231 O. G. 285.

Applicant has canceled claims in view of the references of record and it is not unreasonable to assume that he understands them and their points of similarity and differences.

Inman, 160 O. G. 1038.

If the claims have been broadened or not materially altered a final rejection is in order.

Lasance, 131 O. G. 1421.

The final rejection in response to a request for fuller information as to the pertinence of the reference was not based upon a request for a reconsideration or upon any action by the applicant which would justify reconsideration of the case, and is therefore set aside.

Wainwright, 125 O. G. 2047.

No good reason is seen why an applicant should question the propriety of a final rejection or why the Office should entertain such a question unless the applicant desires to continue the prosecution of the case by a proper action. In such event the applicant should offer the amendment or argu-

ment constituting the desired continued prosecution along with his argument denying the propriety of the final rejection.

Thayer, 122 O. G. 1724.

It is true that the Office desires to afford an applicant ample opportunity for amendment and where the pertinence of the references has not been made clear and explanation thereof is asked the action should not be final. But the pressure of work in the Office requires that the prosecution of a case be closed as soon as possible.

Cox, 122 O. G. 1045.

Rejected for inoperativeness, affidavits filed again, and finally rejected. Proper final rejection.

Schmid, 121 O. G. 1675.

If the Examiner's action was insufficient to enable the applicants to respond intelligently, a request for an explanation would have been a proper action.

Schmitt and Tanody, 121 O. G. 688.

Where a claim for a process is rejected, which claim is qualified by a brief statement of the article produced, and an amendment is filed more specifically defining the structure of the article, held that the process claim is not changed in scope, and a final rejection is in order.

Crecelius, 116 O. G. 2531.

The amendment and argument were within the year, but not filed at the same time. Held sufficient to entitle applicant to a reconsideration.

Weinmer, 115 O. G. 1585.

The mere cancellation of the finally rejected claims does not reopen the case for the prosecution of other claims.

Almy, 115 O. G. 1584-1585.

Where the applicant is proceeding promptly and in apparent good faith to secure further information as to the position of the Office before amending further, he should be given a second opportunity to bring the claims into allowable condition.

Wieser, 110 O. G. 1726.

Applicant requested an explanation of the Office letter and also reconsideration. Final rejection regular.

Silsby, 109 O. G. 1051.

"It is true, as the Examiner states, that the invention is a simple one; but when the applicant has read the references carefully and fails to find therein certain specified features included in his claims and asks that the Examiner point out wherein these features are found in the references the Ex-

aminer should not consider it unduly burdensome to comply with the applicant's request."

"This case is very different from that where an applicant asks merely that the Office explain the references without pointing out wherein he regards them as not pertinent."

Starr, 106 O. G. 263.

A consideration of the claims and the amendment makes it appear that the applicant is not attempting to shift his ground, but is merely attempting to so change and limit the claim as to avoid the rejection and objections made by the Examiner.

Day, 105 O. G. 1782.

The amendment included a new claim which was held to be the same as the old claim 3 and the application finally rejected. The third claim had as an element a "tub," the new claim four "an oscillating tub." Held rejection premature.

Casler 2d case, 100 O. G. 1330.

If the amendment is merely formal a final rejection is proper.

Casler, 1902 C. D. 292-3, 100 O. G. 1330.

Only an argument on the merits was presented.

"The petitioner's action did not call for a further explanation, and therefore the Examiner was justified in finally rejecting the claims."

Sorenson, 1901 C. D. 16, 98 O. G. 415.

The presenting of reasons why the references do not meet the claims is equivalent to a request for further action.

Vose, 1901 C. D. 202, 97 O. G. 1599-1600.

Where claims are amended the amendment may not be held as not involving a matter of substance merely because such amendment does not avoid the references.

Pfeffer, 1894 C. D. 11, 66 O. G. 845.

When an applicant asks a reconsideration he waives any right he might have had to a fuller statement by the Office.

Mahleeke, 1892 C. D. 206, 61 O. G. 285.

An uncalled for and superfluous drawing should not be received and filed.

Shepard, 1892 C. D. 162, 60 O. G. 575.

If, as a matter of language, the amended claim does not present the same idea of invention presented by the previous claim, an amendment has been made in matter of substance and the applicant is entitled to a second rejection upon the amended claim.

Griswold, 1890 C. D. 13, 50 O. G. 838.

If a figure is added to a drawing on file in the Office without permission of the same, the figure must be erased.

Cordrey, 1889 C. D. 171; 1889 C. D. 252.

An applicant must not acquiesce in an erroneous judgment of the principal Examiner.

Hyde, 1871 C. D. 109.

(3) *Shifting Ground.*

Adoption of claims suggested under Rule 96 does not constitute an election of a species.

Burk, 184 O. G. 288.

In re Moore, 173 O. G. 891; Sutin, 170 O. G. 482.

A party can not be permitted to reinstate claims canceled in view of a requirement for division.

Wick, 117 O. G. 902-903.

If applicant voluntarily confines his claims to one of two inventions he can not change and present claims to the other after the claims first presented are rejected.

Barnes, 115 O. G. 247.

After a case has been examined and finally disposed of on one line the applicant can not shift his ground.

Applicant is no more entitled to insert a new claim after appeal than to insert one that has been canceled. The fact that an interference would result from insertion of the claim makes no difference.

Recklinghausen & Potter, 113 O. G. 1146.

An applicant may not change his claims from a process to an article after case is disposed of. It is, however, proper to permit a proper change in form.

Walker, 113 O. G. 284.

Applicant may not change his claims from a process to an apparatus.

Feld, 112 O. G. 252.

Having elected to prosecute one class of claims applicant can not shift his ground and insert another.

Ferrell, 106 O. G. 766.

When an applicant has elected to retain one class of specific claims he can not after rejection insert a different species.

Maddux, 106 O. G. 764.

After making a combination claim which is rejected applicant will not be permitted to shift his ground to make his application for an element of such claim. Such element being a different invention and differently classified from the combination.

Swantuseh, 1902 C. D. 377, 101 O. G. 1129.

If one presents an application for a process he can not change it to one for an apparatus, even on recommendation of the Examiner-in-Chief.

Alberli, 1900 C. D. 95, 91 O. G. 2731.

Where an application originally contained claims for a method, a product, and an apparatus for carrying out the method, and upon an Office requirement of division the applicant canceled the claims for the apparatus, and where the disclosure of the apparatus does not make it clearer how the method might be carried out, the drawings and description of the apparatus should be canceled.

Hofely & Redlefsen, 1893 C. D. 94, 64 O. G. 559.

An applicant having originally presented only claims for a method and having prosecuted them to a final rejection and taken an appeal to the Examiners-in-Chief, has made his election, and he can not be permitted to thereafter substitute claims covering mechanism alleged to be capable of carrying out the method originally believed to be patentable and do not include new matter.

Eschner, 1893 C. D. 68, 63 O. G. 760.

(4) *Action by the Office.*

Even if it were not clear from the amendment that applicant did not understand the objection, if he came in promptly and showed this, the final rejection should be withdrawn.

Huntley, 196 O. G. 863.

Stating his reasons for rejection more fully does not reopen a case.

Morley, Jr., 185 O. G. 1379.

A final rejection is in order notwithstanding the fact that an applicant has failed to respond to an objection of a formal character made by the Examiner.

Sabofish, 183 O. G. 1033.

An issue should be reached. A final rejection should not be given upon the second rejection unless an unmistakable issue has been reached.

Bass, 183 O. G. 506.

When a clear issue has been reached and it is evident that applicant understands the application of the references. No further explanation of the references is necessary.

Kelley, 183 O. G. 220.

In case of ordinary doubt the policy of the patent system, as customarily maintained in the Patent Office, has been to give the applicant the benefit thereof, because no absolute right

of property is conferred by the grant of a patent (Thomson, 26 App. D. C. 419, 425).

Moore, 178 O. G. 891.

A reference to a decision of the Commissioner held sufficiently definite.

Patterson, 178 O. G. 835.

The action of the Examiner in apparently allowing claim warranted applicant in assuming that in presenting his claims relating to the same subject matter an argument was unnecessary.

Beard, 178 O. G. 319.

When requested so to do in good faith the Examiner should apply the references. Cases collected.

Andrews, 172 O. G. 1889.

Whether the action of the Office was such as to confer the rights to amend is one that may not be controlled by mandamus.

Sung v. Moore, Com., 172 O. G. 834.

However, if it is pointed out that the claims do not contain the matter relied on and if they did they would be anticipated by a reference of record, this does not constitute the citation of a new reference.

Cott, 166 O. G. 985.

If the Commissioner recommends certain claims only these claims should be considered.

Silden, 164 O. G. 741.

Claims should not be allowed merely because they represent a multitude of elements all of which do not appear in one or two or even more references.

Quagan, 162 O. G. 538, 539.

A criticism of the theory of operation of the device that does not purport to holding it inoperative, does not reopen a case.

Hardy, Jr., 161 O. G. 268.

It is the duty of the Examiner to consider not only the claims but the invention disclosed. If he is of the opinion that an application discloses no invention over the references, it is perfectly proper for him to so state.

Fox, 157 O. G. 485.

It is the obvious intent of sections 4803-4909 of the R. S., and Rules 65-68, inclusive, to bring about a clear understanding between the Examiner and the applicant before the final rejection of the case is entered from which appeal may be taken (130-302).

Miller, 139 O. G. 731.

The issue being distinctly formed, and the amendment to claims not being substantial, the request at the end of applicant's argument, that if a favorable decision could not be given there should be a final rejection, should be complied with.

Marshall, 139 O. G. 198.

Where an Examiner finds it necessary to give reasons explaining the application of a reference, a final rejection should not be entered in the same letter where those reasons have been stated for the first time.

Jackson, 132 O. G. 1324f.

The Examiner finally rejected claims in reply to a request for explanation at the same time giving the information sought. With a final rejection he rendered the information of no avail except through a petition.

Walker, 129 O. G. 481; 68 Atwood, 162 O. G. 1183.

After final rejection no affidavit under Rule 75 will be received.

Berg, 120 O. G. 903; Romunder, 157 O. G. 209.

(5) *Reopening After Final Rejection.*

That the final rejection was a surprise is not a ground for an extension of time for amending claims.

Hartford, 184 O. G. 551.

Adoption of claims suggested under Rule 96 does not constitute an election of a species.

Burk, 184 O. G. 288.

Without such a showing the amendments submitted were not admissible although it would have been proper to cure the informalities by proper amendment (Paige, 108 O. G. 1587). Such an amendment would not relieve the application from its condition as subject to appeal or save it from abandonment.

Green, 130 O. G. 299.

The statement of the attorney that the subject matter of a proposed amendment filed after final rejection was not earlier called to his attention by the inventor is not a sufficient showing upon which to admit the amendment.

Schrader, 120 O. G. 2127.

The amendment after final rejection being unaccompanied by a showing as to why it was not sooner presented was rejected.

Marks, 109 O. G. 1609.

After final action in a case it is not to be reopened at the request of applicant except for good reasons. The affidavit

simply setting forth that the new claims contained features which had been overlooked is insufficient.

Nettles, 107 O. G. 541.

When an application has been prosecuted to final rejection, it is not just to other applicants to reopen it for consideration of amendments which should have been earlier presented.

Brown, 107 O. G. 269.

That the attorney has got further light upon the subject is not a good reason for admitting additional claims.

Schmidt, 1902 C. D. 327, 100 O. G. 2602.

The showing of facts to excuse delay must be correct in form and sufficient in substance. The fact that applicant did not fully understand the case is not sufficient.

Raymond, 1902 C. D. 170, 99 O. G. 1386.

Where amendment is filed after final rejection it must be accompanied by an affidavit showing good and sufficient reasons why it was not presented before in view of special circumstances amendment ordered entered.

Lansing, 96 O. G. 2063.

A new claim refused admission after testimony taken in an interference.

Potter v. Van Vleeck v. Thomson, 1901 C. D. 53, 95 O. G. 2484.

An affidavit to the effect that applicant did not fully appreciate the value and importance of certain features, and therefore, did not present claims for them, is not sufficient showing to warrant the reopening of the case.

Beckwith, 1901 C. D. 43, 95 O. G. 1451.

An amendment upon the merits after final rejection should be accompanied by a verified showing of good and sufficient reasons why it was not earlier presented.

Peloubet, 1891 C. D. 121, 56 O. G. 928.

Amendment presented nearly two years after case in condition for appeal refused. Reopening case refused. No showing.

Cordrey, 1889 C. D. 171, 98 O. G. 397; c. c. 1889 C. D. 252.

When a certain specific claim was suggested to the applicant (Rule 96), but he refused to insert it, an amendment containing this claim was refused entry after ten years' delay.

Gray, 1889 C. D. 91, 46 O. G. 1277.

An applicant can not reassert a claim after final rejection which he had previously voluntarily erased. In such case he must file a new application.

Johnson, 1887 C. D. 64, 40 O. S. 574.

An amendment can not ordinarily be admitted after two rejections.

Thurmond, 37 O. G. 217.

(6) *Amending After Appeal.*

After a case is ready for appeal if a new reference is cited the applicant may continue his appeal in view of such amendment or elect to further prosecute the case before the Primary Examiner.

Mevey, 56 O. G. 805; Scott, 166 O. G. 985.

Claims admitted after final rejection under that part of Rule 68 requiring a "showing duly verified, of good and sufficient reasons why they were not earlier presented," are for consideration by the Primary Examiner and not for the purpose of appeal only.

Meyer, 148 O. G. 1088.

Cases will not be reopened for amendment after appeal except under very unusual circumstances. The fact that the applicant was surprised by the interpretation put on the claims does not constitute such circumstance.

135 O. G. 1122.

Without such a showing the amendments submitted were not admissible although it would have been proper to cure the informalities by proper amendment (Page, 108 O. G. 1587). Such an amendment, however, under the provisions of Rule 68 would not relieve the application from its condition as subject to appeal or save it from abandonment.

Grien, 130 O. G. 299.

Where a new reference is cited, however, upon appeal in the Patent Office, the practice is to require the applicant to elect whether the case shall be returned to the Primary Examiner for consideration of amendments or whether the appeal shall be continued without amendment, and if he chooses the latter course he is considered to have waived his right to amend.

Millett and Reed, 125 O. G. 2764.

If the Examiners-in-Chief have recommended new claims which are rejected on new references, the applicant may not substitute other claims.

Myers, 122 O. G. 351.

It is contrary to the practice of the Office to reopen cases for amendment after appeal except under unusual circumstances where the interest of justice plainly demands it.

Lesler, 117 O. G. 2631; Auer, 116 O. G. 595.

After appeal to the Examiners-in-Chief an application will

not be reopened for the consideration of claims which require a reexamination merely because the applicant has concluded that he wishes to present such claims.

Merrill, 116 O. G. 1186; East, 116 O. G. 1186.

The proper course to be pursued by an Examiner on discovering a new ground for rejection subsequently to an appeal to the Examiners-in-Chief is to direct the attention to it of both the applicant and the Examiners-in-Chief. The applicant may then elect to continue the prosecution of the appeal or to withdraw it and be heard by the Primary Examiner.

Teller, 113 O. G. 548-549.

Claims allowed in original application and omitted by mistake in reissue application permitted insertion after appeal.

Gilmer, 109 O. G. 1337.

As long as applicant keeps within the law no delay is unreasonable or works a forfeiture of his rights. A failure to manufacture does not work forfeiture.

Osborne v. Holsapillar, 103 O. G. 1296-1297.

Amendments after appeal may be admitted for the purpose of putting the rejected claim in better form for consideration on appeal. Such amendments should not vary the scope of the claim. If they have been admitted and do vary the scope of the claim, the appellate tribunal should not pass upon the merits, but the case should be sent back to the Primary Examiner for action.

Hooper & Clark, 1891 C. D. 123, 56 O. G. 929.

Where an applicant has taken an appeal from the Primary Examiner to the Examiners-in-Chief and obtained their decision, if he sees fit thereafter to go back to the Primary Examiner under proper authority from the Commissioner and amend his case in such a manner as to change its nature or character with reference to the subject matter involved in the appeal, he in effect abandons and waives his right to appeal, and must take his stand upon the new case as he has made it.

Williams & Raidabaugh, 40 O. G. 1337.

The rule precludes all amendment of the claim after it leaves the Examiner, except as provided in the rule for special amendments; in which case the amendment, if admitted, is sent to the Examiner for his action.

Hammond, 1872 C. D. 149.

When an appeal is taken the case is closed before the Primary Examiner, unless it is regularly remanded with leave to amend or with direction for further examination. If it be so remanded the case is reopened below, and can not return to the appellate tribunal until the applicant has re-

sponded to the new examination either by amendment or fresh appeal.

Appleton, 1869 C. D. 8.

(7) *Amending for Appeal.*

Claims can only be taken out of the case by definite instructions of the applicant.

Iddings and Iddings, 197 O. G. 239.

If applicant accompanies his appeal with an improper amendment, the appeal should be forwarded and the amendment refused.

Pillard, 191 O. G. 585.

Rule is applicable to design application.

Bittendorf, 184 O. G. 801.

Structural changes sought to be introduced to put the claims in better form for appeal. Held amendment related to the merits and was inadmissible without a verified showing.

Brown & Sprink, 1801 C. D. 135, 160 O. G. 1039.

Claims *differing in scope from those under final rejection* can not be admitted without a proper showing.

Kenney, 119 O. G. 2237.

Claims admitted after final rejection under that part of Rule 68 requiring a "showing duly verified, of good and sufficient reasons why they were not earlier presented" are for consideration by the Primary Examiner and not for the purpose of appeal only.

Meyer, 148 O. G. 1088.

Cases will not be reopened for amendment after appeal except under very unusual circumstances. The fact that applicant was surprised by the interpretation put on the claims does not constitute such circumstances.

Milans, 135 O. G. 1122.

Amendments cancelling claims or presenting those rejected in better form for consideration on appeal may be admitted after final rejection without reopening the case for further consideration. For a similar reason amendments to the description presenting the invention more clearly when they do not touch the merits of the application should be entered.

Loppenstein, 122 O. G. 1723.

Descriptive matter relating to constructions involved in claims on which appeal is taken should not be required to be canceled prior to appeal.

Kenney, 119 O. G. 2237.

There is nothing inconsistent in filing an amendment with an appeal.

Bach, 118 O. G. 1363.

If a claim differing in substance from those acted upon is presented ostensibly for appeal with his answer, Examiner should forward the appeal with his answer as to the rejected claims and should call attention to the fact that the additional claim has not been entered or acted upon and is not appealable.

Wirt, 117 O. G. 599-600.

A claim that brings forth no new or unconsidered point, but is simply more specific, is in better form for consideration on appeal.

Marks, 111 O. G. 2492.

Change of claims admissible to put them in better form for appeal must not change them in substance. The latter kind of claim can only be admitted on a proper showing.

Novotny, 108 O. G. 1327.

Where claims are canceled a requirement for division and are presented in a separate application they can not properly be reinstated in the original case and considered on appeal.

Fritts, 105 O. G. 2059.

The drawing may be amended by the attorney without special authorization by inventor.

Wilcox, 1902 C. D. 409, 101 O. G. 1829.

New claims in substance may not be introduced after final rejection for appeal.

Downing, 100 O. G. 2176.

Amending application after filing.

Grinnell v. Bruel, 89 O. G. 1863 Mlf.; Hobbs v. Beach (U. S. S. C.), 94 O. G. 2357.

Amending application after filing.

Bechman v. Wood, 89 O. G. 2459-2462; Chicago & Northwestern R. R. Co. v. Sayles, 97 W. S. 554, 15 O. G. 243, 1879 C. D. 349; Newton v. Furst & Co., 15 O. G. 243, 119 W. S. 373; White v. Dunbar, 26 O. G. 353, 119 W. S. 47; Brown v. Davis, 116 W. S. 237; Mieter v. Brais Co., 216 O. G. 201, 104 W. S. 350; Topliff v. Topliff, 59 O. G. 1257, 146 W. S. 156; Powder Co. v. Powder Works, 186 O. G. 1339, 98 W. S. 126; Halett v. Long, 89 O. G. 1141; Rouse, 88 O. G. 2242.

Amendments cancelling claims or presenting those rejected in better form for consideration on appeal may be admitted either before or after the appeal has been taken without a showing why they were not earlier presented.

The applicant's opinion may properly be consulted as to whether the proposed amendment is in better form than the corresponding claim which has been rejected.

Collins, 1890 C. D. 27, 50 O. G. 992.

(9) *Additional Cases.*

These cases pass on the subject matter of this rule.

Luten, 170 O. G. 482; Atwood, 162 O. G. 1183; Barrett and Alter, 127 O. G. 847; Rogers, 125 O. G. 2766; Peirce, 121 O. G. 1347; Richmond, 120 O. G. 905; Lefever, 1904 C. D. 205, 110 O. G. 1430; Durafort, 1904 C. D. 234, 110 O. G. 2017; Landis, 1903 C. D. 127, 103 O. G. 1164; Bowles (second paragraph), 1903 C. D. 95, 103 O. G. 429; Grant, 1900 C. D. 199, 93 O. G. 2532; Willer, 1900 C. D. 62, 91 O. G. 1033; Woodward, 1892 C. D. 179, 60 O. G. 1052; Barrett, 1891 C. D. 154, 56 O. G. 1564.

METHODS OF SHORTENING EXAMINATIONS.

A Paper by Examiner Wm. A. Kinnan.

January 28, 1915.

The subject of patent law has been described as covering a very limited portion of the field of general law. While not extensive, it is, gentlemen, as deep as a well.

It is believed to be generally recognized that there is no other branch of the law that requires a greater mentality, a wider knowledge, or greater skill and training.

The Examiner, who with the all too little time for each case, is able to apply this law with reasonable accuracy, to the multitude of different inventions, embraced in applications possessing a multitude of different imperfections and insufficiencies, and adjudicate the enormous number of claims required to mark the limits of the rights involved, must indeed possess a degree of skill, judgment and learning that is, to say the least, unusual. He must be at once judge, jury and counsel. He must determine the law, weigh the evidence, and combat and expose the fallacies in the arguments presented by the too zealous applicant. All this he must do with a maximum of speed, if the work before him is not to hopelessly accumulate.

It is the purpose of this paper to make some suggestions looking to the shortening of the time required to finally adjudicate the application. That every effort to this end is necessary is abundantly evidenced by the fact that steadily the number of applications filed each year has increased, and as steadily the time required to adjudicate each case has also increased, until now, the corps staggers under a load it is well nigh impossible to carry.

It is of little utility, perhaps, to discuss the reasons for this increase. It will be sufficient to merely note, in passing, that they are found in the fact that we are the most inventive people in the world; that our industrial and commercial supremacy is in a considerable measure due to this fact, and the steady increase in our population brings with it the natural increase in the number of applications filed each year. In 1840, there were 765 applications filed; in 1860, over 7,000; in 1880, 23,000; in 1900, 41,000; in 1913, 70,000. The examiners will, in the near future, be facing the stupendous task of examining a hundred thousand new cases a year.

Experience has shown that there is no such thing as an exhausted art.

Even where there are lulls in the advance of some of the arts, these are more than offset by the sudden activity in others, brought about by the invention of some radically new thing.

The invention of the wireless telegraph; of the successful flying machine; of the automobile, have resulted in a flood of applications for inventions in the nature of improvements and refinements, all having their bearing upon the creation of the eventually practical, commercial form of apparatus.

These pioneer inventions also bring about an increased activity in a large number of related arts.

A wireless telegraph station must have its source of high frequency current, its structural towers of great height, its special conductors of high insulation. In fact, these new conditions have brought about an increased activity in almost every branch of the electrical art.

A flying machine and an automobile must each have a gas engine, with its electric igniting means, its gas mixing apparatus, and its multitude of related devices pertaining to many mechanical and metallurgy arts. All these take on special designs and refinements incident to their new use, and bring their multitude of applications to the various divisions of the office having in charge the cases relating to these various arts.

The art that must be searched is increasing by leaps and bounds, and reclassification, imperative as it is, and helpful as it is, can not solve this part of the problem, and is only a partial, though welcome aid.

The complexity of the subject-matter of the applications is ever increasing. The fact that more and more of the complicated manual operations and processes are being accomplished by machinery, and that existing machinery is being more and more refined, made automatic, and made to do things requiring almost a human intelligence, with a minimum of supervision, brings about this result.

There has also grown up a class of people who are desirous of a patent of some sort, of any sort, who keep an application which is fairly anticipated before the Examiner as long as possible, hoping by some argument or shift, or amendment, to find some slight point on which to hang an allowable claim, or to weary or argue the Examiner into allowing some sort of a claim, so that counsel may obtain his fee, or satisfy an uninformed client or a client who is indifferent to the validity of his patent but wishes to mark his device patented merely for the intimidating effect upon would-be rivals.

It is plain enough, therefore, that in the near future the work of the examining corps will not grow less. The situation, as we are all aware, has resulted in the cases awaiting action reaching the somewhat startling number of over 25,000.

There are several very cogent reasons why applications should be speedily brought to a final adjudication.

Applications long pending are a source of scandal and abuse. Often they do not embody the inventions in commercial form; they are kept pending in the office while others, ignorant of them, and therefore obtaining no aid from them, invent and produce successful devices, create a commercial value and status at great expense and risk, only to find that the owner of the long pending application has placed therein a claim dominating all that the later inventors have done, has issued the patent, and by legal process lays tribute upon

the labors and the rewards of the later innocent inventors. Such a proceeding is so repugnant to justice and equity that this office is warranted in doing all it can to prevent such applications from being kept pending during long periods.

Further, by removing the cause, legislation honestly intended to reach this class of cases, but also doing great harm to inventors whose applications are necessarily delayed in the office, will be rendered needless.

The long pendency of a large number of applications before the office, by consuming its time in reconsidering them over and over, renders the period before a new application is reached for the first examination so long that the inventor frequently suffers great loss. The art may pass beyond his invention. He may lose his opportunity to sell. He dare not incur the expense incident to manufacture because of lack of protection. Having no indication of the attitude of the office, his commercial interests, so far as that invention is concerned, are entirely halted.

The foregoing considerations are sufficient to show that the office has reached a condition that may be regarded as almost critical, and one that fully justifies it in adopting any means, not inconsistent with law, and which will not injure the rights of inventors, that will enable the corps to reduce the number of times applications must be reconsidered, the period they may be kept pending, and the number awaiting action.

How is this to be done?

I shall not consider here possible future legislation, but will consider only what can be done with the means at hand.

The standard of work must be maintained. If the examination and adjudication of applications are to be worth while, are to possess any real value justifying the enormous cost involved, the work can not be slighted. Enough patents, more than enough, in spite of the best we can do, are declared invalid in whole or in part.

It is believed there is room for improvement in a conservation of energy.

I am reminded of a youth whom I knew in my younger days, who was wont to contest in foot races. When he was in full action, he had such a habit of waving his arms and moving his body up and down that he had too little energy or time left for making progress forward. He always came in last. It has seemed possible the office sometimes progressed a little like this youth; that it takes too many unnecessary actions, and the following suggestions are made, with a good deal of diffidence, in the hope that some economy of time and effort may be realized.

In the first examination of the application, if the action is to go to the merits, let it be a complete one.

In matters of form all objections should, so far as possible, be embodied in the first office letter, and be kept before the applicant in subsequent letters, if necessary, by simple reference to the first letter. This generally enables them to be all out of the way by the time the matters of merit are determined. I recall a letter received in a division in which I was an assistant many years ago, which read something like this: "The informalities and objections, which seem to increase in number with each reexamination of this case, have, we hope, all been cured."

Just a word here about formal objections. It is a well-recognized fact that a great many are made that are subsequently waived. Bear-

ing in mind the specification and drawing are addressed to those ordinarily skilled in the art, and they should be clear and understandable, yet so few formal objections should be made as is consistent with this ultimate end. Merely because the Examiner would state a matter differently, or could even state it better, were he writing the description, is no reason for requiring revision or change. If the matter is not incorrect, is not misleading, and the meaning of the inventor is plain, objection should, ordinarily, not be made. The Examiner should be sure his formal objections are really necessary. This saves time, argument and friction.

Before making a search for anticipatory art, the application and the invention should be fully understood. It pays to take time to fully and completely comprehend the disclosure every time the case is acted upon. Then the first search should be as nearly complete as it is possible to make it. Not only the broadest and the narrowest claims should be held in mind in searching, but the invention, the thing itself, and its functions should be held in view. Where the invention is simple, and fully comprehended, a second search is rarely necessary. In the more complex and extensive cases, however, second or even third searches are often necessary, it is true, but even here the gain of a complete search is proportionally great, and second searches will be proportionally fewer.

In regard to the search:

It is said all men are equal before the law. Someone has added, "this is true, however, only in theory." The same is true of claims.

A narrow claim limited to the precise embodiment of the invention disclosed is much less likely to be anticipated by anything found outside the class where the case belongs. A search on such a claim, therefore, should seldom be prosecuted beyond rather restricted limits.

Further, a narrow structural claim is seldom sued upon. An alleged infringer almost always adopts a modification and escapes the terms of such a claim. Also courts are very apt to sustain a specific claim where an infringer uses the very same thing on which it is based.

For these reasons, therefore, the narrow structural claim is not so important, is of less value and is much less frequently heard of after being once granted.

It is the broad claim that is important. It is this claim that dominates an art, that spreads over the territory that others may seek to occupy. It is almost always this type of claim that is brought before a court, and by which the plaintiff seeks to restrain an alleged infringer who uses something different.

This type of claim is valuable, if it is good, and is harmful if it is invalid. The inventor should have it, if he is entitled to it, and it should be denied him if it is not rightly his. Such a claim should be more carefully weighed. The chance of anticipating such a claim outside the class where the case belongs is proportionally great. Before searching in any place, however, the Examiner should first weigh the question as to whether, if he found something there, it would be in an analogous art and would be a proper reference.

Where an incomplete search is made, the Examiner takes very nearly as much time to make it and fully as much to adjudicate the claims on the art he finds as if he made a complete search. The attorney, in response, amends his case to define from the art found. The Examiner reviews the case, possibly months later and

after he has forgotten both the case and how faithfully he searched it. He will usually research the ground previously covered as well as the additional ground he originally should have searched. Here is a great loss of time because he covers the same territory twice. The whole status of the case may now be changed. The first action taken in the case as well as the response of the attorney are rendered almost useless, possibly quite so. The application is now just where it should and would have been had a complete search been made at first. The practice of not making a full and complete search in the first instance has resulted in some attorneys making a practice of not attempting to really advance their cases until after the second or even third action by the Office. It is easy to see that time and energy are lost by such proceedings.

The temptation is great, where an Examiner is driven at top speed to get off his cases so as to make the necessary weekly gain, to make an incomplete search, hoping that when the case comes up again he will have more time. But he merely puts off the evil day, and in the end does more work and gives more time in reaching a final adjudication of a given case than he otherwise would. When this case is multiplied by a hundred or even a thousand, the Examiner is, like the youth in the foot race, wasting a great deal of energy and time. When the search has been made and the Examiner comes to apply his references and adjudicate the claims, some of them may be squarely met by some references. Little time need be wasted here. Some claims, however, may require a combination of references. Here it is almost always best to explain, in as few words as possible, just how the combination is made. Even where the invention is simple, this is often advisable. It puts the matter specifically and squarely before the applicant and he can and must either point out why the combination is not proper or amend the claims. Where a reference lacks an element recited in a claim or must be modified in any way, even if ever so slightly, it is well to make an explanation, in a few specific words, just why the element of the claim which is not in the reference is regarded as insufficient, or just what the modification of the reference consists of. Where the subject-matter is more complicated, these explanations are correspondingly more advantageous. Where an attorney is known to be well skilled in the art, less explanation is necessary. Where an inventor is prosecuting his own case but exhibits sufficient knowledge of patent law to warrant the Examiner in the belief that suggestions will enable the inventor to conclude his case without the aid of an attorney, the explanations should be correspondingly extended and made as specific as possible.

This practice places before the inventor or his counsel all formal objections, the complete art, and the Examiner's interpretation of the relation of such art to the application. It is evident the termination of the prosecution of the case before the Examiner need not be greatly prolonged. In the reasonably simple cases, where the entire scope of the invention can be readily seen and comprehended, the third action by the Examiner with the same references before him should ordinarily be sufficient to conclude the case. There are some cases, where special reasons exist, in which further consideration will be necessary. The Examiner should exercise judgment in each case and not make any fixed rule. With the increase in the complexity and extent of the subject-matter of other cases, a reasonable increase in the number of actions is inevitable.

Even in these cases, however, the early citation of the complete art, and the notation of all formal objections, will go far to reduce the number of reconsiderations and reexaminations, while in no manner preventing the applicant obtaining full protection for all he has invented.

Whenever final rejection is about to be taken, and whenever the condition of the case indicates such a course would be helpful, the Examiner should suggest in brief specific terms any amendment which he thinks would advance the case or render the claims allowable.

There is a class of applications that I can not approach without realizing I am standing on holy ground. These are the *old* pending cases. Some have been pending, five, ten, fifteen, and even twenty-five and more years. I know of no one, or half a dozen, things that will bring about so great an improvement in the condition of work before this Office as the conclusion of the pendency of these cases. Over and over again have they been examined. Unusually they have been amended once a year, some are so old that they fall under the old law of requiring amendment only once every two years. For a variety of reasons, some good and some bad, these cases have been kept in the Office, growing older, their records larger and more cumbersome, and adding very greatly to the labors of the examining corps. The annual amendments made to them have not been calculated or intended to really advance them toward a conclusion. The Examiners, too, have in the past despaired of making much advancement, and their annual actions have sometimes been less complete than they might have been. Until a comparatively recent time the Examiners have felt helpless to solve this problem.

Section 4904, R. S., states: "Whenever, on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejections, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specifications, the Commissioner shall order a reexamination of the case."

Rule 68 is based on this statute and provides that an applicant "may amend as often as the Examiner presents new references or reasons for rejection."

Section 4909, R. S., states: "Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected . . . may appeal from the decision of the Primary Examiner."

Rule 134, which is based on this statute, specifies: "There must have been two rejections of the claims as originally filed, or, if amended in matter of substance, of the amended claims, and all the claims must have been passed upon, . . . before the case can be appealed to the Examiners-in-Chief."

These two sections of the statutes and these two rules have constituted the basis for a practice that existed from the adoption of the law, to almost the present time, and which was to the effect that an Examiner could never close the prosecution of a case before him so long as an applicant presented at each reconsideration at least one claim that was different in scope from any previously

considered. When it is recalled that an application may have anywhere from half a dozen to several hundred claims, it is at once apparent any skilled attorney could, under such practice, keep an application pending so long as he desired.

This has been the cord that tied the hands of the Examiners and has rendered possible this great accumulation of old cases. By the decision in *Ex parte* Miller (139 O. G. 730), the cord was severed and the examining corps was relieved from this helpless condition which had become well-nigh intolerable. That decision is based upon the view, which is clear enough, that the statute does not contemplate nor require the repeated reconsideration of an application, dependent only upon the will of the applicant or the skill of his counsel in varying the language used to define the invention.

That decision held: "Where the Examiner has held that certain claims are unpatentable and has fully advised the applicant of his reason for such holding and the latter, after reasonable prosecution of the case, has failed to so amend as to necessitate the citation of new references and has been unable by argument to convince the Examiner that he was in error, an issue is reached, and the Examiner is justified in refusing to accept further amendment and in finally rejecting the claims then of record in the case."

This ruling, which has been subsequently fully upheld in *Ex parte* Perry (140 O. G. 1001), a second *Ex parte* Miller (150 O. G. 827), and *Ex parte* Lang (153 O. G. 1081), constituted a very marked departure from the old practice, in that it transferred from the applicant to the Examiner, the power to bring the prosecution of an application before the Examiner to a close. This at once made it possible for the corps to put a check upon what was becoming, in some instances, a grave abuse of the latitude of the Office procedure.

In explaining this holding of *Ex parte* Miller, Perry, etc., Mr. Billings pointed out that while it was true Rule 68 provided that an applicant had a right to amend as often as the Examiner presented new references or reasons, this rule also made it incumbent upon the applicant in amending to "clearly point out all the novelty which he thinks the case presents in view of the art disclosed." It is a natural deduction that if an applicant really does this, when he amends, a condition will ordinarily be reached in one or two actions where the Examiner has no new references or reasons to present.

Still the Examiners are not out of the wilderness. These old cases are often complex and extensive in subject-matter. It is not difficult, and the more complicated they are the easier it is, in amending them, to drive the Examiners to "new references or new reasons." This precludes the application of the Miller doctrine, in such instances, and brings them under Rule 68, giving applicants the right to further amend and argue.

Many inventors and attorneys, since the real condition of the Office and the possibility of stringent legislation being enacted have been made known to them by the Commissioner, have recognized the necessity, in the interests of all, for prompt action looking to a bringing to a conclusion these old cases, and have presented carefully prepared amendments which have enabled the Office to considerably reduce the number of such cases. In passing it is worthy to remark that it is surprising and also gratifying to note the

extent to which it is possible to advance one of these old cases, by a carefully prepared amendment, without sacrificing any of the inventor's rights.

There are, however, quite a number of these old cases where financial and other reasons impel the applicant to seek a further delay. Sometimes large rival concerns have many applications pending relating to a general subject or art, and are involved in many interferences which delay their cases in the office. Their interests are financially very great. Millions have been and are being expended in the production and perfection of these inventions. The securing of patents which will protect the owners in the use of such inventions is vital. To take out some of their patents, while so much is being litigated, and while rival concerns still have pending cases relating to analogous subject-matter, would be productive of enormous loss. These considerations must be given due weight.

Some cases, in which a plea for further delay is made, it would appear that counsel merely hopes, by repeating and impressing his arguments in various forms, to finally win over the Examiner.

Whether rightly or not a good many attorneys do not wish to be denied the privilege of impressing their arguments on the Examiner over and over again. This should not be necessary. If the applicant and the Examiner fully understand the case and the art, there is no necessity for this repeated review.

Some few of these applicants whose cases have been long pending are undoubtedly actuated by motives similar to those which actuate the citizen who does not want to enlist. They hope that, by some hook or crook, to keep their cases going a year or two longer and by that time, they are trusting, the war may be over, and they will finally escape the firing line.

So grave has become this evil of long pending cases, so great is the inertia of this load, so clearly is a remedy necessary to the preservation of our patent system and the interests of inventors and the public alike, that the Commissioner has seriously set about the work of bringing these cases to a conclusion. Results are plainly apparent, but the end has not been reached. Eager to afford these tardy prosecutors an additional opportunity to protect their inventions as he is, yet he has firmly impressed upon these applicants that he will not permit any needless delay. To that end he has sought to limit amendments to those that will not longer delay the case. He has taken over the personal consideration of all amendments to applications pending five years or over.

"If an amendment is filed in such a case which puts it in condition for allowance or final rejection, it will be accepted, but if the amendment does neither of these two things, as, for example, when an applicant undertakes to put in new claims the amendment will be considered without being entered and the applicant notified by the Commissioner of the character of a supplemental amendment which will put the case in condition for allowance or final rejection. If the applicant fails to file such supplemental amendment, the amendment which has already been filed will be refused admission and the case when the year is up will be held abandoned." (Commissioner's address to the Patent Bar Association, Chicago, Ill., Nov. 19, 1914, Sci. Am. Dec. 12, 1914, p. 491.)

It will be readily apparent that this plan is going to bring the prosecution of this class of cases to a close, yet there is given each

applicant, after all the opportunities he has already had, a still further opportunity to draw his claims to cover what he believes he has invented, and if he can not agree with the Examiner to obtain the judgment of the higher tribunals. Even where an applicant seeks to expand his case anew, at this late date, by claiming something he has not claimed before, thereby necessitating "new references or reasons of rejection" the office goes so far as to examine this new amendment and indicate to him what part, if any, is allowable, and gives him an opportunity to incorporate this part in his patent.

It would seem that this plan is as liberal as is possible, consistent with the end had in view, and that no one can justly claim his rights have not been safeguarded.

Returning to the consideration of applications generally, there is thought to be some loss of time due to what may be called debatable rejections. There is no need to discuss here practices that are settled, grounds of repection that are fixed, but there are several grounds of rejection that are very frequently used and possibly a little more uniformity throughout the corps would be an economy of time.

I have read office letters rejecting claims on the ground they recite aggregations, where the claims would seem to be for true combinations, which were merely old combinations. Perhaps the ultimate end, the amendment of the claim, is finally reached, but often such rejection precipitates argument and needless waste of time.

While the United States Supreme Court in the decisions of Hailes v. VanWormer (20 Wall. 368); Florsheim v. Schelling (53 O. G. 1737); Adams v. Bellaire Stamping Co. (57 O. G. 1280); Richards v. Chase Elevator Co. (71 O. G. 1456); Reckendorfer v. Faber (92 U. S. 347), and the U. S. C. C. of Appeals, Seventh Circuit, in the case of Deere and Co. v. Rock Island Plow Co. (82 O. G. 1561), discuss very fully this question of aggregation versus combination, the following from a decision of the Examiners-in-Chief, made in a recent case, is so pertinent that I take the liberty of quoting it.

"In the first place, it should be observed that the problem of whether a given claim sets out a patentable combination or an aggregation is not to be solved by the citation of references. A true combination of elements, working together under a cooperative law, and producing a given result, remains a true combination for all time, irrespective of the antiquity of its original creation, . . . the ground of rejection which is proper is not that the combination is illegitimate, but that it is old."

The question settles itself by determining whether the elements named in the claim *cooperate, work together,* though not necessarily simultaneously, but so that by virtue of what they *together* accomplish, a different result is secured from what would be secured if the elements were used separately. As was said by the Supreme Court in the Reckendorfer v. Faber case, *supra:* "There must be a new result produced by their union; if it is not so it is only an aggregation of separate elements." This case was based on a lead pencil with a rubber eraser at one end. The court aptly pointed out that the rubber did not perform any function in connection with the writing. It remained inoperative, and could as well be absent. So in erasing the marks, the pencil remained inactive, did nothing, could

as well be absent. These two things never worked together, and never accomplished any joint function or result.

A second ground of rejection that gives rise to much trouble and creates considerable argument and friction is applied to claims for alleged machine or apparatus methods or processes as distinguished from chemical and article methods.

It is not the purpose of this paper to discuss this class of claims from an academic viewpoint or quote from the many learned expounders of this subject. Further, the matter has been ably treated in a previous paper presented to this body. It is desired here, however, to make, if possible, a few practical, rough suggestions which may be helpful in determining whether a claim is for a true method or for the function of the apparatus.

The authorities are pretty well settled that the old definition of the United States Supreme Court in Cochrane v. Deener (11 O. G. 687), stands as about the most tangible and workable definition yet given. There must be present an act or a series of acts and they must be performed upon something to change it to a different state or thing. Remembering that only so-called machine processes are under consideration, and that the main difficulty is to distinguish them from the function of the machine or apparatus, it may be helpful to first note that the claim does not recite specific means or mechanism. If this specific mechanism is necessary to support the alleged steps, it is probable these latter are inevitably the function of such mechanism. It is well to try to discover what the step is or what the series of steps are; to recognize them in the language used in the claim. Then the thing they are performed on should, if possible, be identified. This may be the electric current, as in the Telephone Cases (126 U. S. 1532), and O'Reilly v. Morse (15 Howard 62). If these can be identified it is generally easy enough to determine whether the steps are so tied to specific mechanism as to be but its function, or whether they can be performed, within the language or terms of the claim, by different mechanisms differently organized, or, if the nature of the steps permit, by hand. While no function can be carried out without some means to do it, yet the function must be distinct from the means, from its practical embodiment, and its immediate effect. There must be some other means, with some other embodiment, to which this function is common. Robinson on Patents cites the example of smoothing something, and explains how different things, like running water, a single knife, a sliding weight, a group of revolving knives, may perform this function. The machine step of smoothing, therefore, is performed by some means, but is not a function of any specific means, but is a function of several different mechanisms or means, and is a proper step of a method. Again, this author cites the function of exploding or igniting a substance, and notes this may be accomplished by different means, as a red hot iron, a flame, the electric spark, etc. The function is common to these different devices, and also these different devices can operate without producing the function of exploding or igniting a substance. These things have separate existence, the means is a permanent thing and the function is a transient, intangible thing.

If these principles concerning this class of claims can be had in mind considerable time can be saved, both in determining when a claim should be rejected and in making suggestions to an applicant who discloses but is not succeeding in properly claiming a method of this character.

There is another ground of rejection which is not uniformly interpreted throughout the office. This is that the claim is functional in that it fails to recite the means for accomplishing the results specified. Sometimes the mere length of a functional statement, predicated upon a properly included means, is made the basis of rejection. Obviously this is in error.

The so-called "whereby" clauses, and those beginning with the word "adapted," are often found to be unsupported by the inclusion in the claim of the means for accomplishing these functions. In such cases, the means should be included. But the statement of means, mechanisms, or devices, accompanied by their functions, constitute the long accepted manner of drawing claims for mechanical inventions. If the elements are recited, the length of the functional clause is of no moment. If recited generically, the claim is merely broad and if otherwise patentable is allowable.

There is a class of claims wherein the entire invention is recited in the generic words "means," mechanism, or devices, accompanied by the functions of such means, or mechanism, without defining anywhere in the claim the structural nature of the means or mechanisms or devices. Of course, these claims are as broadly drawn as possible, and in language, cover any and all means for accomplishing these functions, cover means substantially different.

There are at least two views held in this Office as to such claims. One is that they are too broad, are broader than the invention, and that they are therefore unpatentable. Beside several Commissioner's decisions there are decisions of the United States courts which look to the support of this view. (Consolidated Electric Light Co. v. McKeesport Electric Light Co., U. S. Supreme Court, 159 U. S. 465; Madison v. Campbell, U. S. C. C., 78 Fed. Rep. 910; Wilson Trolley Catcher Co. v. Frank Ridlon Co., U. S. C. C. of Appeals, First Circuit, 159 O. G. 244; *Ex parte* Denning, 26 O. G. 1207; *Ex parte* Knudson, 72 O. G. 589; *Ex parte* Pacholder, 51 O. G. 295.)

The other view is that no matter what the breadth of terms used in the claim, an inventor is only entitled to what he has invented and produced, and substantially its equivalents and, if the invention is of a pioneer character, the range of equivalents will be proportionally broadened when, on proofs, this is made to appear. These claims, if they can not be met by references, are, therefore, to be allowed.

The cases where courts have held such claims void on this ground alone, of being broader than the invention, are so few, and modern judges are so prone to construe claims to save a really meritorious invention that the question is one of no very great moment.

There is one other ground of rejection of which mention may be made. This is upon the so-called Hawley doctrine. This doctrine was first emphasized and made prominent in the decision of the Court of Appeals of the District of Columbia, *In re Hawley* (121 O. G. 691), although it is but a repetition of the substance of *Ex parte* Griffith (85 O. G. 936). This holding has been confirmed by the same court *In re* McNeil (20 Ct. App. D. C. 294), and *In re* Ratican (162 O. G. 540). Later the Circuit Court of Appeals, Third Circuit, held a claim void on this ground in the case of Langan v. Warren Axe and Tool Co. (166 O. G. 986).

This doctrine is to the effect that where the combination recited in the claim is old and the distinction over the prior art resides in one element only of the combination and does not result

in a modified or improved action of the other elements of the combination the claim is unpatentable and should be limited to the element *per se*.

The doctrine has been quite extensively applied by some Examiners and but little used by others. It is a proper ground of rejection when properly applied.

It is believed the vital determining factor is whether the element which has been improved constitutes a complete thing itself capable of separate and independent use, or one that has acquired a distinct status in the arts and trades. If neither of these conditions is present, it is doubtful if the doctrine applies.

In the Hawley case, the improvement was in a tape to be used in a recording mechanism. The latter was not modified in any way and was admittedly old. Obviously the tape fulfilled the conditions above noted. No one would buy a new recorder every time he used up the tape, any more than one would buy a new typewriter machine every time he used up his supply of paper. The tape was clearly a separate subject of invention, a separate article of manufacture and sale and should not have been claimed in combination with the old recorder.

In the Ratican case, the invention resided in a nozzle for a street washing machine, otherwise old. It is plain enough the nozzle was a separate, complete unitary thing, did not in any manner change the operation of any part of the machine, was a separate subject of manufacture and sale. Obviously no one, wishing a new nozzle, would purchase an entire new street washing machine.

The case of Langan v. Warren Axe and Tool Co. is a very much more important one. The decision was rendered by the United States Circuit Court of Appeals, the patent was already granted and the claim was held invalid.

There exists some difference of opinion as to whether this ruling may be said to uphold the so-called Hawley doctrine. There was a very plain discrepancy between the statement of invention in the specification and the structure covered by the claim. The specification made it very clear that the patentee had invented a new kind of grab-hook, and merely described how such hooks were to be used, in pairs, with a draft device in skidding logs. The claim, however, was for the combination of a pair of hooks with the draft device. The novel details of the hook were, however, specified in the claim.

The court emphaized this lack of consistency between the statement of invention in the description, which was that applicant had merely improved the hook, and the statement of the claim, and in doing so said: "There is no suggestion that any part of the patentee's invention resides in the combination of the grab-hooks and the draft appliance. The connection between the grab-hooks and the draft appliance by means of links or claims is mentioned, but such connection was as old as grab-hooks themselves, and the patentee expressly states that his invention consists, not in any such combination, but in the particular and peculiar form of hook. . . . Not only is the claim for a combination foreign to what is set forth in the specification, but there is no new coaction or cooperation of the elements of the combination. The grab-hooks and the draft appliance of the patent, in combination, coact as grab-hooks and draft appliances have always done. The grab-hook of the patent, by reason of its peculiar construction and form, is very probably an improvement of no little utility. But the patentee can not, merely

because of this fact, have a patent for a combination, which shall have, as one of its elements, a pair of such grab-hooks. He did not invent the combination. He invented, if he invented anything, an improved grab-hook."

On being urged by counsel to construe the claim as for the hook alone, the court said: "Manifestly, we can not so construe it. The claim is for a combination of grab-hooks, of a peculiar form, and a draft device. We are not at liberty to distort its plain language."

Whatever may be the view as to the general effect of this decision, the fact is plain enough that this patentee lost his invention because he did not claim the hook alone, because he claimed it in the old combination which it did not affect in any new way.

It is hardly to be presumed the court would have found the claim valid if the patent itself had not contained the inconsistencies noted by the court, provided the proofs adduced at the trial had been such as to set forth this same state of facts.

This decision is sufficiently suggestive, that in plain cases, the doctrine should be applied.

In the usual house door-bell arrangement, in use all over this city, there is a push button switch, a bell, a battery, and the wire conductors. Each is a separate subject of invention and has a distinct status in the art and trades. An inventor may improve the bell, the switch, the battery, or the wires. None of these improvements would affect the mode of operation of the other elements, and the claims should be confined to whichever element—the switch, the bell, the battery or the conductors—that is improved. A combination claim should not be allowed.

But if an invention is made in a part of the switch, or the bell, or the battery, which part has no general utility, no separate status, it is doubtful if the Office is warranted in objecting to a claim that includes the entire switch or the entire bell, or battery. These are unitary things, and to carry the Hawley doctrine to their details of structure constitutes a refinement of procedure that can only result in harmful confusion, friction and delay.

An adherence to this firmer ground in the application of this doctrine will in no way endanger the validity of any grant, but will save much time and needless argument.

In conclusion, I leave with you, therefore, this suggestion:

If this great and ever-increasing quantity of work is to be carried on at all, if there is not to be such an accumulation of pending applications as will cause the whole examining system to fall of its own weight, there must be a greater uniformity of practice on the part of the various Examiners, there must be fewer needless objections, fewer needless rejections, better first searches, more carefully considered actions, both on the part of the Examiners and on the part of the applicants as well, and a more prompt conclusion of the pendency of cases before the corps.

By Wm. A. Kinnan, Examiner, Division Sixteen.

Rule 69. Request for Reconsideration.

In order to be entitled to the reexamination or reconsideration provided for in Rules 65 and 67 the applicant must make request therefor in writing, and he must distinctly and specifically point out the sup-

posed errors in the examiner's action; the applicant must respond to every ground of objection and rejection of the prior office action except as provided in Rule 64, and the applicant's action must appear throughout to be a *bona fide* attempt to advance the case to final action. The mere allegation that the examiner has erred will not be received as a proper reason for such reexamination or reconsideration.

CONSTRUCTIONS.

See notes to Rule 68.

A broadening of the claims without explanation is improper, if the Examiner objects to the multiplicity of claims this should be replied to.

Creviling, 197 O. G. 779.

Amendment by telegram confirmed by letter is proper.

Whear, 197 O. G. 534.

A petition to set aside a final rejection dismissed as premature where no request had been made of the Primary Examiner to withdraw that rejection.

Lawton, 172 O. G. 259.

The claims rejected on three references, one claim withdrawn. The other claim rejected on two of said references. Good final rejection.

Guitry, 162 O. G. 537.

It is not sufficient that applicant distinguishes his device from one of the references it must be from all.

Inman, 160 O. G. 1038.

If applicant does not consider all the references cited and point out where in his opinion the references do not apply the action is not responsive and the case is abandoned.

Sachs, 157 O. G. 755.

Applicant was entitled to have the claims considered and the reasons of rejection fully stated and such action should now be taken.

Pledger, Jr., and Campbell, 157 O. G. 486.

In Ex parte Perry the practice was condemned of repeatedly filing amendments in the hope of wearing the Examiner into allowing a claim upon the ground that because of its specific character it can do no harm.

Pledger, Jr., and Campbell, 157 O. G. 486.

It is clear that a mere request for a reconsideration is useless unless accompanied by some statement or argument which

controverts rulings made by the Examiner or throw light upon the facts of the case.

Einstein, 121 O. G. 1675.

A mere request for a reconsideration is not sufficient.

Ruthinburg, 121 O. G. 337.

The applicant must give reasons why he thinks the Examiner erred, for lack of which reasons the case may be held to be abandoned.

Linde, 115 O. G. 1329.

The questions have not been presented for reconsideration with the specification of errors as required by the rules and without a request for a reconsideration applicant is not entitled to have the matter reviewed.

Gally, 115 O. G. 802.

Action must be responsive.

Parkes, 113 O. G. 2213.

It is not inconsistent with section 4903 to require applicant to give his reasons for requesting a reconsideration.

Alton, 113 O. G. 1968-1969.

Where applicant made a slight amendment to one of the claims and discussed various references it was properly construed by the Examiner as a request for a reconsideration.

Leilich, 108 O. G. 561.

A communication from applicant saying "Such action as will permit appeal is requested" is not a compliance with this rule.

Lewis, 108 O. G. 559.

The applicant is required to state why he thinks the Examiner has erred.

Tyson, 1902 C. D. 476, 101 O. G. 3105.

Must point out the supposed error in Examiner's action.

Shone, 99 O. G. 863.

Last clause reaffirmed.

McKnight, 1901 C. D. 238, 97 O. G. 2742.

The burden of proof is upon applicant to establish by proof which is clear and conclusive the patentability of the invention as claimed (this is a case of a bill in equity).

Durham v. Seymour, Com., 71 O. G. 457.

Where applicant claimed a method of transmitting speech by intermittent impulses he must show: First, that his apparatus makes and breaks contact; second, that this action causes the articulate speech.

Barney, 1890 C. D. 171.

See also,

Krejci, 121 O. G. 1011.

Rule 70. Amendments to Correspond to Original Drawing or Specification.

In original applications all amendments of the drawings or specifications, and all additions thereto, must conform to at least one of them as it was at the time of the filing of the application. Matter not found in either, involving a departure from the original invention, can not be added to the application even though supported by a supplemental oath, and can be shown or claimed only in a separate application.

HISTORY.

Rule 35 of 1869 reads in part as follows: "All amendments of the model, drawings, or specification, must conform to at least one of them as they were at the time of the filing of the application."

In 1870 the words "in the case of original applications" were added after "specification."

In 1871, Rule 32 read in part as follows: "All amendments of the model, drawings, or specification, in the case of original applications which are capable of illustration by drawing or model, must conform to at least one of them as they were at the time of the filing of the application, further changes than this can only be made by filing a new application. If the invention does not admit of illustration by drawing, amendment of the specification may be made upon proof satisfactory to the Commissioner that the proposed amendment is a part of the original invention."

In 1873, the words "involving a departure from the original invention" were inserted after "further changes than this."

In 1879, Rule 69 read substantially as present Rule 70, except that substantially the last sentence of the previous rule was retained, with the addition of the words "or model" after "drawing" and the clause "the affidavits prescribed in Rule 47 may or may not be sufficient" was added. The affidavits referred to were "supplemental oaths."

The present rule was made in 1892.

See notes to Rules 66, 68 and 69.

CONSTRUCTIONS.

We do not see that the plaintiff is bound to find in his original claims one which is substantially the same as his amended claim, if his original application did cover his amended claim in the sense that it included that claim and more.

Motion Picture Co. v. Colehoff Co., 248 Fed. 229.

If rejected for new matter the new matter should be definitely pointed out.

Ferguson, 229 O. G. 939.

An applicant may amend to make his case correspond with the one of which it is a division.

Ayers, 220 O. G. 1375.

In determining whether matter introduced by way of amendment is new matter the original drawings are to be understood with such variations in form, shape, and proportions as common sense and mechanical skill in that art would suggest (on the verge).

Mine & Smelter Supply Co. v. Braeckel Concentrator Co., 197 Fed. 897.

An elaborate discussion of this subject matter is included in

Mine & Smelter Supply Co. v. Braeckel Concentrator Co., 197 Fed. 897.

The additional matter in the second was a mere amplification of the disclosure of the first.

Clark Blade & Razor Co. v. Gillette Razor Co., 194 Fed. 421. and

The cases of Orewiler, 170 O. G. 481 and Hilliker, 183 O. G. 1035, were not intended to apply to cases in which applicant filed his own case and afterward employed an attorney such as here are in question. The substitute specification and drawing should be received and considered.

Clifford, 193 O. G. 511.

Rejected for want of operativeness on amendment because of new matter reviewable on appeal and not by petition.

Thomas, 191 O. G. 832.

The fact that an amendment contains new matter is no reason for refusing to enter it. It should be entered a requirement made to eliminate new matter and any claims based thereon rejected.

Meyers, 184 O. G. 802.

This holding which is in substance that the disclosure as it stands is insufficient to support the claims, but that it may

be amended in such a way that it will support them is clearly inconsistent.

Seacombe v. Burks, 1912 C. D. 270, 182 O. G. 974.

Claims to apparatus and product may apparently be introduced into a method apparatus.

Edison v. American Mutoscope Co., 110 F. R. 660.

An applicant can not insert matter from an abandoned case.

Hagey, 173 O. G. 1081.

A claim may afford the basis for an amendment of the drawing.

160 O. G. 775.

Question of new matter appealable to the Examiners-in-Chief.

Fadern and Berman, 155 O. G. 553.

An applicant permitted to change his application from a design to an article of manufacture where it is shown that this was the original intention of the applicant.

Saunders, Jr., 131 O. G. 1164.

The statement in the original specification that the cutter 20 is secured to the leg of the landside by a pivot or bolt, when taken in connection with the statement in claim 5 that the cutter is adjustable is believed to constitute a sufficient disclosure of the adjustable feature of this invention to warrant amendment to the drawing showing an ordinary means for adjusting said cutter.

Sylvestersen, 129 O. G. 3160.

As there is no suggestion in the application relative to the omission of this part, a claim specifying a mode of operation that can be secured only when said part is omitted constitutes new matter.

Scott v. Southgate, 1906 C. D. 491, 125 O. G. 1703.

A drawing showing the tool-shank in any other form than that originally shown inadmissible although such form might also result from a twisting operation.

Freund, 1905 C. D. 477, 119 O. G. 651.

Where a claim, inserted by amendment, includes matter not originally disclosed, held that if the change from the original is an obvious one which would occur to any one it is not patentable, and if it is not obvious it constitutes new matter.

Scott, 1905 C. D. 665, 117 O. G. 278.

Applicant is not permitted at any time to introduce new matter into his application and obtain therefor a date as of the date of the original application.

It is the duty of the Commissioner of Patents to reject

all claims, a basis for which is not found in the application as originally filed.

Dilg, 1905 C. D. 620, 115 O. G. 1067.

Mere clerical or draftsman's errors may be corrected where the errors are clear from the application itself; but changes can not be made in the application based upon allegations of fact not shown by the record. Not even to make the device disclosed operative.

Willits, 1905 C. D. 107, 115 O. G. 1064.

Mere clerical or draftsman's errors may be corrected where the errors are clear from the application itself; but changes can not be made in the application based upon allegations of fact not shown by the record, not even to make the device disclosed operative.

Willets, 115 O. G. 1064.

May not amend to claim a species not originally claimed.

Lillie, 1905 C. D. 15, 114 O. G. 541.

The contention that applicant has the right to amend the original disclosure by the addition thereto of a specific structure if the same is not new, and falls within the scope of general statements in the original specification is fallacious as (e. g.) the patentability of combination claims drawn to include the added parts would be independent of the novelty of these parts.

Scott, 1904 C. D. 4, 114 O. G. 260.

The description of a specific form briefly referred to in the original specification may not be inserted.

Mothes, 1900 C. D. 500, 113 O. G. 1146.

In Luger v. Browning, 10 O. G. 1123, it was held that when new matter is introduced into an application it can not be allowed to dominate previous claims of another applicant; but when matter has been disclosed, but not claimed, it is proper to include it in claims, and they may take precedence over previous claims of another applicant.

Galley v. Brand, 1904 C. D. 488, 113 O. G. 851.

While the omission of elements in some cases may involve new matter the omission of unnecessary elements does not.

Smith & Hoyland, 1900 C. D. 176, 93 O. G. 939.

The strips should be placed at right angles to their present position. The device as now illustrated is inoperative, and it seems obvious that the defects in the illustration are such as could only have occurred through a clerical error in making the drawing. Amendment permitted.

Bailey, 1898 C. D. 16, 82 O. G. 894.

The objection to new matter can not be avoided by changing the date of filing to that of the proposed amendment.

Kinney, 1904 C. D. 240, 110 O. G. 2235.

A rejection on the ground that the amendment involves new matter, appealable to the Examiner-in-Chief, and the question should be determined before discussing the question of cancellation of the matter.

Schmidt, 1904 C. D. 165, 110 O. G. 603.

Applicant may not insert a third specific form of the invention which was not in the papers as originally filed.

Butcher, 1904 C. D. 60, 108 O. G. 1588.

A change from a sole to a joint application can only be made by a new application.

Gordon, 1904 C. D. 20, 108 O. G. 561.

Matter can not be read into a case or inserted by way of amendment merely because it was invented before the application was filed and was intended to be included.

Dow v. Converse, 1903 C. D. 404, 106 O. G. 2291.

An applicant is not entitled to shift his ground from the article to the process, whether or not both inventions were disclosed originally.

Christensen, 1903 C. D. 256, 105 O. G. 1261.

When an amendment is filed which in the judgment of the Examiner substantially varies the scope of the application as originally filed and necessitates a change in the drawings, the amendment should be entered and rejected on the ground of new matter and for all other reasons which bar its patentability.

The drawing should not be changed until question is settled.

Luber, 1894 C. D. 47, 67 O. G. 529; Furness, 1903 C. D. 174, 104 O. G. 1655.

Where the parts described will not operate as stated and it appears from the whole case that through a clerical error the parts were misnamed, an amendment correcting the error and adding a new figure to the drawing permitted.

Larson, 1902 C. D. 452, 101 O. G. 2568.

Where applicant showed and described two forms of the invention and his claims were broad enough to cover both forms, held that he was entitled to claim a specific form. "The original claims and description included both forms of the invention. The claims did not include one form to the exclusion of the other. Distinguished from Heaton, 15 O. G. 1054.

Plimpton, 1902 C. D. 452, 101 O. G. 2567.

A claim was made for a washing machine and a combina-

tion of such machine with a particular kind of hinge. These were rejected. Applicant was not permitted to insert a claim to the hingle alone, it being a differently classified invention.

Swantusch, 1902 C. D. 377, 101 O. G. 1129.

Two parts originally jointed together, amendment stating that they are practically integral, new matter. Where an element performs several functions the statement that it has only one function is inaccurate and involves new matter.

Kieffer, 1902 C. D. 360, 101 O. G. 449.

If the Examiner considers the matter sought to be introduced by amendment to be a departure from the original he should reject the application for this reason, from such a rejection appeal lies to the Examiners-in-Chief.

Keith, 1901 C. D. 155, 97 O. G. 551; Howlett, 1902 C. D. 338, 100 O. G. 2775.

Where the applicant is dissatisfied with the original disclosure and desires to take out the patent based upon another disclosure which he considers a better mode of applying the principle of the invention, the proper course to pursue is to file a new application. This discrepancy can not be cured by amendment.

Heogh, 1902 C .D. 254, 100 O. G. 453.

Matter in the specifications sufficient to found a new claim on.

Silverman v. Hendrickson, 1902 C. D. 123, 99 O. G. 446.

If to make the device operative requires a radical change in the construction shown and in the description thereof, such change can not be made. If the device is operative, though not to the degree of perfection desirable, it can not be changed to a preferable form.

Clay, 1901 C. D. 256, 97 O. G. 2980.

Where a connection between parts was suggested in the specification, but none shown in the drawing, a form of connection may be shown but he must file a proper supplemental oath.

Wareham, 1901 C. D. 204, 97 O. G. 1600.

May change form of claim (from one statutory class to another) by consent of Examiner before appeal or on recommendation of Board after appeal.

Travette, 1901 C. D. 170, 97 O. G. 1176.

If an amendment is presented which in the opinion of the Examiner involves new matter, he should enter the same and then reject the claims so presented for want of identity with the original invention.

Keith, 1901 C. D. 155, 97 O. G. 551.

If to make the device operative requires a radical change in the construction shown and in the description thereof, such change can not be made if the device is operative, though not to the degree of perfection desirable, it can not be changed to a preferable form.

Clay, 1901 C. D. 256, 97 O. G. 298.

If the omission of a part changes the mode of operation the amendment is within the prohibition of this rule.

Cook, 1900 C. D. 19, 95 O. G. 585.

An illustration which amounts to no more than a suggestion is not sufficient warrant for a claim filed nearly two years after the application and nine days after an interfering patent.

Dewey v. Colby, 1896 C. D. 12, 75 O. G. 1360.

A drawing may not be amended to correspond with a model not a part of the record of the case.

Austin, 1891 C. D. 127, 67 O. G. 1059.

If the idea of constructing an apparatus without the flushing chamber had occurred to B, he would have set forth such construction in one of the figures of the drawing, because the omission of the flushing chamber would have promoted both cheapness and simplicity.

Huber v. N. O. Nelson Mfg. Co., 63 O. G. 311.

The question raised upon an amendment sought to be introduced into a pending application is not whether the applicant's invention of its subject matter dates back to the filing of his original application, but whether such subject matter is itself new so far as it relates to said pending application.

Burson, 1892 C. D. 53, 58 O. G. 1414.

Where a proposed amendment embodied a substitute claim and descriptive matter relation to the subject matter of such claims, the amendment should be entered, and if, in the opinion of the Examiner, it included matter not disclosed by the application as originally filed the claim should be rejected.

Harvey, 1892 C. D. 47, 58 O. G. 1257.

Where an application as filed discloses an apparatus and also a patentable process and the relation between them is such that they could be joined in one application, and the apparatus only is embraced in the statement of invention, and claims as originally presented, claims for the process may be subsequently incorporated, if seasonably presented and supported by a supplemental oath.

Perkins, 1891 C. D. 63, 55 O. G. 139.

Amendments can not be made to correspond with a model that was never filed in the case.

Rissner, 1890 C. D. 164, 53 O. G. 919.

The unauthorized addition of new figures to the drawings is a violation of the rules.

Burt, 1889 C. D. 251, 49 O. G. 1986.

Cases passing on the subject matter of this rule:

Rolin v. Slingluff, 182 O. G. 975; Kilbourn v. Hirner, 128 O. G. 1689; Ernest, 1896 C. D. 33, 76 O. G. 1417; Robinson, 1902 C. D. 433, 101 O. G. 2080; Dilg, 1904 C. D. 463, 113 O. G. 547; Grinnell v. Buel, 1899 C. D. 235, 89 O. G. 1863; Hulett v. Long, 1899 C. D. 446, 89 O. G. 1141; Snyder, Ex parte, 1882 C. D. 22, 22 O. G. 1975; Nicholin & Ochsenreiter, 1891 C. D. 155, 56 O. G. 1565; Smith, 1892 C. D. 70, 58 O. G. 184.

See Luberger v. Dodge, 1905 C. D. 603, 114 O. G. 2382.

Rule 71. Inaccuracies or Prolixity.

The specification and drawing must be amended and revised when required, to correct inaccuracies of description or unnecessary prolixity, and to secure correspondence between the claim, the specification, and the drawing. But no change in the drawing may be made except by written permission of the office and after a photographic copy of the drawing as originally presented has been filed.

HISTORY.

Rule 39 of 1869 reads: "The specification, especially if the claim be amended, will be subject to examination and revision by the Examiner, for the purpose of correcting inaccuracies of language or unnecessary prolixity, and of securing correspondence between the description of the invention and the claim."

Rule 36 of 1870 reads: "The specification, especially if the claim be amended, must be amended and revised, if required by the Examiner, for the purpose of correcting inaccuracies of language or unnecessary prolixity, and of securing correspondence between the description of the invention and the claim."

"Mere errors of orthography or of grammatical construction will be corrected by the Examiner in charge" was added to the rule in 1871, and in 1873 the words "statement and" inserted after "between the" and before "description."

Rule 70 of 1879 reads: "The specification must be amended

and revised, when required, for the purpose of correcting inaccuracies of description or unnecessary prolixity, and of securing correspondence between the claim and the other parts of the specification."

In 1888 the words "and drawing" were inserted after "specification" in the first line, and "the claim, the specification and the drawing" substituted for "other parts of the specification." The present rule in the revision of June 18, 1897.

Rule 72. Specification not to be Returned.

After the completion of the application the office will not return the specification for any purpose whatever. If applicants have not preserved copies of the papers which they wish to amend, the office will furnish them on the usual terms.

The drawing may be withdrawn only for such corrections as can not be made by the office; but a drawing can not be withdrawn unless a photographic copy has been filed and accepted by the examiner as a part of the application. Permissible changes in the construction shown in any drawing may be made only by the office and after an approved photographic copy has been filed. Sketches filed to show proposed changes in construction must be in permanent ink. (Amendment of April 17, 1919.) Substitute drawings will not be admitted in any case unless required by the office.

HISTORY.

Rule 40 of 1869 reads: "The Office will not return specifications for amendment; and in no case will any person be allowed to take any papers, drawings, models, or samples from the Office. If applicants have not preserved copies of such papers as they wish to amend, the Office will furnish them on the usual terms."

The sentence between the semicolon and period does not appear in the rule in 1878.

In 1879, Rule 71 read: "After the completion of the application the Office will not return the specification for any purpose whatever. The model or drawing (but not both at the

same time), may be withdrawn for correction. If applicants have not preserved copies of such papers as they wish to amend, the Office will furnish them on the usual terms."

In 1883 there is a footnote which reads: "Note—Drawings will in no instance be returned to an applicant or his authorized agent unless a model has been filed and accepted by the Examiner as a part of the application."

In 1888, Rule 72 read: "After the completion of the application the Office will not return the specification for any purpose whatever. If applicants have not preserved copies of the papers which they wish to amend, the Office will furnish them on the usual terms.

"The model or drawing, but not both at the same time, may be withdrawn for correction. But a drawing can not be withdrawn unless a model has been filed and accepted by the Examiner as a part of the application."

The words "or photograph copy of the drawing" added 1907. Present rule 1908.

CONSTRUCTIONS.

A substitute drawing refused admission where it appeared that the original could be corrected to embody all that was sought to be introduced into the substitute.

Conner and Pearson, 193 O. G. 753.

The rules and practice of the Patent Office do not permit the return of a complete application or the transfer of parts thereof to a new and different application.

Giles, 190 O. G. 547.

A photographic copy of the original drawing should be filed where a change is made in any of the original sheets, whether by amendment of a figure or addition of a new figure.

Campbell, 1905 C. D. 196, 116 O. G. 1452.

A photographic copy of the drawing must be filed before altering the signature thereon.

Hanson, 114 O. G. 2381.

The applicant should file a blue print of the original drawing and indicate either on this print or by means of a sketch the change on the original drawing which it is desired to make. The blue print and sketch should then be filed, accompanied by a written request for permission to alter the drawing.

Zwiebel, 1904 C. D. 198, 110 O. G. 1428.

"It is the settled practice of the Patent Office to refuse to return any of the papers of a complete application, that is, an

application which comprises all necessary papers properly executed and on which the filing fee has been paid.

Applications which do not comprise all papers necessary to a complete application properly executed may be returned where their return is necessary in order to enable the applicant to complete the papers, and this may be done whether the filing fee has been paid or not."

Van Etten, 1897 C. D. 68, 80 O. G. 1760.

Doubtful if any papers that have been received and stamped may be returned. If so, stamp should be erased.

Van Etten, 1897 C. D. 68, 80 O. G. 1760.

Rule 73. Amendments must be Specific.

In every amendment the exact word or words to be stricken out or inserted in the application must be specified and the precise point indicated where the erasure or insertion is to be made. All such amendments must be on sheets of paper separate from the papers previously filed, and written on but one side of the paper. Erasures, additions, insertions, or mutilations of the papers and records must not be made by the applicant.

Amendments and papers requiring the signature of the applicant must also, in case of assignment of an undivided part of the invention, be signed by the assignee. (Rules 6, 107.)

HISTORY.

In 1869, Rule 35 read in part as follows: "And all amendments of specifications or claims must be made on separate sheets of paper from the original, and must be filed in the manner above directed. Even when the amendment consists in striking out a portion of the specification, or other paper, the same course should be observed. No erasure must be made. The papers must remain forever as they were when filed, so that a true history of all that has been done in the case may be gathered from them."

In 1870 "by the applicant" was inserted after "erasure" and the following matter added to the rule:

"In every case of amendment the exact word or words to be

stricken out or inserted should be clearly specified, and the precise point indicated where any insertion is to be made."

The present rule in 1888, except that instead of "additions, insertions, or" in the last sentence of the first paragraph there was the word "and."

Rule 74. Specification Rewritten.

When an amendatory clause is amended it must be wholly rewritten, so that no interlineation or erasure shall appear in the clause as finally amended, when the application is passed to issue. If the number or nature of the amendments shall render it otherwise difficult to consider the case, or to arrange the papers for printing or copying, the examiner may require the entire specification to be rewritten.

HISTORY.

This is Rule 73 of 1879.

CONSTRUCTIONS.

The specification may not be arbitrarily rewritten by an applicant.

Hilliker, 183 O. G. 1035; see Oreweiler, 170 O. G. 1067; Henrick, 191 O. G. 1067.

A substitute specification will not be admitted unless requested by the Office.

Orewiler, 170 O. G. 481.

Neglect of the requirement of this rule held not to cause abandonment.

Gaylord, 117 O. G. 2366.

If it is desired to restore a claim previously canceled, the claim must be rewritten, it is not sufficient to refer to it as "the original language."

Mumler, 1883 C. D. 62, 24 O. G. 1090.

Case which passes on the subject matter of this rule.

Gally, 1903 C. D. 480, 107 O. G. 1661.

Rule 75. Patents Showing but not Claiming Invention.

When an original or reissue application is rejected on reference to an expired or unexpired domestic

patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention in this country before the filing of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, and shall also make oath that he does not know and does not believe that the invention has been in public use or on sale in this country, or patented or described in a printed publication in this or any foreign country for more than two years prior to his application, and that he has never abandoned the invention, then the patent or publication cited shall not bar the grant of a patent to the applicant, unless the date of such patent or printed publication be more than two years prior to the date on which application was filed in this country.

HISTORY.

Substantially this rule introduced, as Rule 74, in 1879. The concluding clause, "except upon interference as provided in Rule 94," of the 1879 rule was omitted in 1886, "in this country" was inserted after "completion of the invention" in 1888 and the wording "before the filing of the application for the domestic patent" was changed to "before the filing of the application upon which the domestic patent issued."

The wording of the present rule appears in 1899.

Oath to be submitted to Law Examiner Order 2,255, 227 O. G. 1.

Since May 18, 1916, oaths forming part of applications for reissue, and affidavits filed under the provisions of Rule 75 for the purpose of carrying the applicant's date of invention back of a cited reference, have been referred to and passed upon by a law examiner.

As to the affidavits under Rule 75, it became clear at once from the character of the affidavits submitted and the arguments presented by counsel that the practice under this rule had been very different in the various divisions of the Office. The essentials of affidavits under Rule 75 are set forth in a

harmonious line of Commissioner's decisions reaching back 35 years (Ex parte Gasser, 1880; Ex parte Saunders, 1883; Ex parte Donovan, 1890; Ex parte McElroy, 1909). In passing upon the affidavits referred under this order it has been the purpose to enforce the rulings in these decisions as to essential requirements, but with an eye to the substance of the matter rather than a strict adherence to form or manner of statement.

Commissioner Report, 1916.

CONSTRUCTIONS.

Discussion of rule.

Thomas, 251 O. G. 850.

The acquiescence of an applicant in a rejection on references precludes him from carrying his date of invention back of such references in a suit.

Milber v. School District of Pitsburg, 243 F. R. 196.

A very full discussion of this rule by Com. Newton Thomas, 251 O. G. 850.

As to showing diligence. Question raised but not decided on petition. The question is appealable to the Board.

Hamby, 182 O. G. 511.

If applicant relies upon a foreign application he must furnish a copy of the original application certified to by the country in which it was filed.

Burlnels, 179 O. G. 574.

Affidavits should so describe the device relied upon to show the completion of the invention, either verbally or by sketches, that the Office can of itself determine whether the device so constructed constitutes the completion of the invention at the date upon which it is alleged to have been made.

Romunder, 157 O. G. 209.

Affidavits under Rule 75 will not be accepted after the claims have been finally rejected in the absence of good and sufficient showing duly verified why such affidavits were not earlier presented. (Berg, 120 O. G. 903.)

Romunder, 157 O. G. 209.

Apparently an affidavit under this rule should contain a showing of diligence in completing the invention.

McElray, 140 O. G. 1207.

It is the practice of the Office to accept testimony taken in an interference in lieu of an affidavit (Homan, 117 O. G. 2088). But an excerpt of the interference testimony relied upon, should apparently be filed.

Newman, 135 O. G. 1122.

Copy of affidavit refused a party to an interference.

U. S. Standard Voting Machine Co., 130 O. G. 1486.

A party in an interference proceeding is not entitled to see affidavits filed under this rule.

Davis v. Garrett, 1906 C. D. 724, 123 O. G. 1991.

After a claim has been finally rejected on several references an antedating affidavit under Rule 75 tending to overcome one of the references can not be admitted.

Berg, 1905 C. D. 36, 120 O. G. 903.

A question of whether ones own patent may be avoided as a reference by affidavits under this rule is appealable to the Examiners-in-Chief.

Marsteller, 1905 C. D. 431, 118 O. G. 2250.

Where an interference is declared, it is the practice of the Office to seal up affidavits filed under Rule 75 during the ex parte prosecution of a case.

Kinsman v. Kintner, 1905 C. D. 363, 118 O. G. 837.

If applicant specifically points out what portion of the evidence in an interference proceeding he wants considered this may be used in lieu of an affidavit under this rule. The decision in the interference need only be followed when the decision indicates a finding that the applicant is not entitled to an earlier date of invention than those found.

Homan, 1905 C. D. 288, 117 O. G. 2088.

The question of the sufficiency of affidavit is appealable to the Examiners-in-Chief.

Nordstrom, 1905 C. D. 114, 115 O. G. 1327.

A preliminary statement held equivalent to an affidavit under this rule. (See notes to Rule 110.)

Forsyth v. Richards, 1905 C. D. 115, 115 O. G. 1327.

The Primary Examiner rejected the claims on several patents cited as references, the Examiners-in-Chief overruled the Primary Examiner as to all the references except one, a petition to reopen the case before the Primary Examiner to permit the filing of an affidavit under this rule granted.

Parrish, 1905 C. D. 113, 115 O. G. 1327.

One can not overcome a patent granted to himself in this way.

Hallowell, 1903 C. D. 268, 105 O. G. 1533.

Rule 75 says that when the inventor makes the affidavit no further proof is necessary. (Johnson, 89 O. G. 1341.) In the absence of such affidavit the question of the amount of proof which will be regarded as sufficient is a matter for the judgment of the tribunal having jurisdiction of the question."

Where the affidavit of the inventor can not be obtained, the affidavit of the assignee or other party may be received.

Foster, 1903 C. D. 123, 105 O. G. 261.

These affidavits are not open to inspection either by the public or by parties in interference. Before the files are exhibited to parties to an interference the affidavit must be either removed or sealed up.

Gasser, 1880 C. D. 94, 17 O. G. 507; Davis v. Ocumpaugh v. Garrett, 1903 C. D. 130, 103 O. G. 1679.

Rule 75 is not inconsistent with law. The affidavit presented referring to inventions abroad are incompetent to show invention in this country prior to the date of the references.

Grosselin, 1901 C. D. 248, 97 O. G. 2980.

If there is a patent and an application the patent containing claims which interfere, the affidavit under Rule 75 may be postponed until after the interference.

Sorrle, 1900 C. D. 42, 90 O. G. 2133.

An affidavit under this rule disclosing the contents of a caveat in part may be placed in the confidential archives on request.

Lowry, 1900 C. D. 1, 90 O. G. 445.

An affidavit required if a patent be issued upon one of two applications pending at the same time, upon the prior application, the patent containing no claim to the invention.

Sorrle, 1900 C. D. 42, 90 O. G. 2133.

If, however, the Examiner believes that the applicant's affidavit is fraudulent and so charges, the applicant would be given leave to file corroborative affidavits.

Hurlbut, 1890 C. D. 135, 52 O. G. 1062; Johnson, 1899 C. D. 212, 89 O. G. 1341.

The affidavit of others than the applicant can not be required.

Hurlbut, 1890 C. D. 135, 52 O. G. 1063; Johnson, 1899 C. D. 212, 89 O. G. 1341.

Sufficiency appealable to Examiners-in-Chief, cumulative evidence required appealable to Commissioner, also as to producing original drawing or structure. Latter requirement is within the discretion of the Examiner.

Ex parte Johnson, 1899 C. D. 212, 89 O. G. 1341.

Sufficiency of affidavit not appealable to Commissioner.

Schmirtz v. Appert, 1896 C. D. 95, 77 O. G. 1784.

Affidavit construed with a subsequent preliminary statement.

Schmirtz v. Appert, 1896 C. D. 95, 77 O. G. 1784.

What the affidavit should contain. An example of a too liberal construction of the language.

Schmirtz v. Appert, 1896 C. D. 95, 77 O. G. 1784.

A deposition taken in an interference proceeding admitted as an affidavit under this rule.

Keller, 1892 C. D. 238, 61 O. G. 1790.

"The rule says that the inventor's affidavit will be sufficient; but it does not say that the fact may not be established in some other way. For instance, if the testimony taken in an interference proceeding showed invention by the applicant before the patentee's date it is very clear that there is no necessity for the affidavit provided for in Rule 75.

Keller, 1892 C. D. 238, 61 O. G. 1790.

If the applicant rests his claim of invention upon drawings or devices made by him, he should produce such drawings or machines or furnish copies or representations of the same, in order that the Office may judge whether he in fact made the invention claimed in his application.

Saunders, 1883 C. D. 23, 23 O. G. 1224; Donovan, 1896 C. D. 109, 52 O. G. 309; Hansen v. Davis, 1891 C. D. 72, 55 O. G. 998; Hurlbut, 1890 C. D. 135, 52 O. G. 1062.

Where it was alleged that a drawing was made and disclosed to others previous to a certain date, held that the drawing should be filed but that the affidavits of such other persons need not be furnished.

Hurlbut, 1890 C. D. 135, 52 O. G. 1062.

No affidavit required where application was in the Office previous to that on which the patent was granted.

Bonna, 1890 C. D. 126, 52 O. G. 751.

The mere statement that he disclosed the invention is of no avail, either to constitute evidence of disclosure or to impart sufficiency to a statement of facts in themselves inadequate. What facts should be stated.

Donovan, 1890 C. D. 109, 52 O. G. 309.

An insufficient affidavit. Did not state facts.

Boyer, 1889 C. D. 249, 49 O. G. 1985.

This interpretation of Rule 75 by Mr. Commissioner Paine (1879) is doubly valuable from the fact that the rule was made by him, and it is therefore to be presumed that he was fully advised as to its scope.

Hunter, 1889 C. D. 220, 49 O. G. 1043.

Where a patent had been issued to joint inventors and more than two years of public use had occurred before the filing of a separate application by one of the joint inventors, and the applicant in the joint application claimed to be the sole inventor of the device claimed in the joint patent, held that the

said public use was a bar to his obtaining a patent on his sole application.

MacLay, 1889 C. D. 220, 49 O. G. 1043.

Where an affidavit filed under Rule 75 showed that the applicant had conception of the invention prior to the dates of the references, but there was no complete reduction to practice until after said date, and also stated that he had "used every diligence possible in putting the invention into use" without setting forth facts tending to show such diligence. Held not to be a sufficient compliance with the rule.

Hunter, 1889 C. D. 218, 49 O. G. 733.

The applicant must state on oath facts showing either that a reduction to practice had been before the filing of the application on which the patent was granted, or that the invention had been conceived before that time and by due diligence connected with a subsequent reduction to practice.

The mere statement that the invention was made by applicant before that time is not sufficient and as that may be a matter of opinion.

Gasser, 1880 C. D. 94, 17 O. G. 507; Laufrey, 1881 C. D. 39, 20 O. G. 892; Saunders, 1883 C. D. 23, 23 O. G. 1224.

These affidavits are not open to inspection either by the public or by parties in interference.

Gasser, 1880 C. D. 94, 17 O. G. 507.

Cases which pass on the subject matter of this rule.

Eddleblute, 1890 C. D. 124, 52 O. G. 124; Tournier, 1901 C. D. 306, 94 O. G. 2166; Byron v. Maxwell, 1903 C. D. 230, 105 O. G. 499; Card & Card, 1904 C. D. 383, 112 O. G. 499; McNeil, 1901 C. D. 313, 10 O. G. 1976; Annand v. Spalekhaver, 1901 C. D. 234, 97 O. G. 2741; Martin v. Goodrum v. Dyson v. Gully and Goodrum, 130 O. G. 1485.

Rule 76. Application Rejected on References Showing but not Claiming Invention, etc.

When an application is rejected on reference to an expired or unexpired domestic patent which shows or describes but does not claim the invention, or on reference to a foreign patent, or to a printed publication, or to facts within the personal knowledge of an employee of the office, set forth in an affidavit (when

requested) of such employee (Rule 66), or when rejected on the ground of public use or sale, or upon a mode or capability of operation attributed to a reference or because the alleged invention is held to be inoperative or frivolous or injurious to public health or morals, affidavits or depositions supporting or traversing these references or objections may be received, but affidavits will not be received in other cases without special permission of the Commissioner. (See Rule 138.)

HISTORY.

The last sentence of Rule 31 of 1873 reads: "Affidavits in support of applications will not be received at any stage of the examination, unless the Office denies that the device is operative."

In 1878 the words "or useful" were added.

The present rule was introduced in 1879, except in Rule 75 of that date, which rule is now 76, a request for the Examiner's affidavit was not required and there was not reference to "Rule 86," which provided for affidavits of employees of the Office and others traversing or confirming the applicant's affidavit in reissue cases. The parenthetical clause (when requested) and reference to Rules 66 and 140 (now 66 and 141) appear in 1888.

See paper read by Elonzo T. Morgan, Sept. 21, 1916, before the Examining Corp of U. S. Patent Office, entitled, Establishing Novelty by Affidavits.

CONSTRUCTIONS.

The Court of Appeals refused to review the decision of the Commissioner because there were no affidavits tending to establish patentability.

In re Merrill, 199 O. G. 619.

Affidavit should set forth facts other than appear on the face of the document discussed.

Chapman, 198 O. G. 237.

No evidence was taken nor were affidavits called for in the Patent Office. The statement of appellant in his application must be accepted as true.

Harbeck, 191 O. G. 586.

Had applicant so desired he could have filed rebutting affi-

davits under Rule 76 and the court would then have had the benefit of those affidavits and the comments thereon by the Patent Office tribunals.

In re Gold, 180 O. G. 606.

Affidavits as to public use only effective when there is doubt.

McElray, 161 O. G. 753.

In the present case there is no doubt that the appellant's font of type is ornamental in appearance, and the fact that it has gone into very extensive use, as shown by affidavits of record in this case, confirms in my mind the artistic value of the design.

Smith, 130 O. G. 1688.

"In addition there were affidavits showing the large sale of the patent in suit, and tending to show that no prior weeder had been a success."

Cooperating Merchants' Co. v. Hallock, 128 F. R. 596-598.

Affidavits explaining a mistake in an amendment considered where the question related to abandonment.

Richards, 1906 C. D. 321, 124 O. G. 627.

Affidavits and arguments presented as to operativeness.

Durvea & White v. Rice, Jr., 1906 C. D. 172, 122 O. G. 1395.

Affidavits going to show the practical success of the applicant's device where the truth thereof is substantially conceded are entitled to material weight in view of the fact that the grant of a patent confers no absolute right of property and in view of the customary rule of resolving ordinary doubts in favor of applicant.

Thompson, 1906 C. D. 566, 120 O. G. 2756.

The Examiner is not bound to accept the conclusion of affidavits filed to overcome a rejection on the ground of inoperativeness, nor is he compelled to cite references and authorities.

Davidson, 1905 C. D. 81, 120 O. G. 2753.

When the party fails to make his demonstration and to submit his evidence in response to the original rejection before prosecuting his case to final rejection the case will not be thereafter reopened except upon showing of good and sufficient reasons why the evidence whose admission is sought was not earlier presented.

Richmond, 1905 C. D. 41, 120 O. G. 905.

The affidavit of a party that his device was operative questionable in view of the fact that others were available and were not called. (Interference.)

Kelly v. Flynn, 1900 C. D. 339, 92 O. G. 1237.

Although met by the same substantial objection from the beginning the applicant made no effort to enlighten her contention through the aid of experts in the art.

In the absence of such enlightenment there arises in our own minds nothing beyond a mere conjecture that the appellant's claim may have attained the dignity of invention.

Beswick v. Com., 1900 C. D. 294, 91 O. G. 1436.

Decisions under old rules not thought to be applicable to the present rule.

Stone v. Greaves, 1880 C. D. 70, 83 O. G. 1805; Anson v. Woodbury, 1877 C. D. 49 and 1877 C. D. 4, 12 O. G. 1; Hedges v. Daniels, 1880 C. D. 64, 17 O. G. 394.

The affidavits filed at the hearing from different manufacturers giving their opinions and experiences in regard to the novelty of the invention and its utility, as well as its extensive adoption by the trade, have been carefully considered. It is true that where the patentability of a device is not clear extensive sales may resolve the doubt. This is, however, an unsafe criterion (authorities cited).

Flomerfelt, 1896 C. D. 59, 76 O. G. 2007.

The affidavits referred to include not only the special affidavits provided for by Rule 75, but all other affidavits supporting or traversing references or objections.

Grosselin, 1896 C. D. 39, 76 O. G. 1573.

The Examiner's action in holding that no testimony as to the operativeness of an invention would be sufficient to warrant the withdrawal of the objection to the granting of a patent unless confirmed by a personal inspection of the Examiner or his deputized assistant, not warranted by the rules.

Munn & Co., 1893 C. D. 48, 63 O. G. 153.

Pending applications not effected by others in interference.

Woodward, 1892 C. D. 62, 58 O. G. 1554.

Affidavits of mechanics tending to show that the description in an Eng. Prov. Spec. was insufficient to enable one to make the device received, but the practice of filing such affidavits disapproved.

Taylor & Banks, 1872 C. D. 239, 2 O. G. 519; Webster v. Sanford, 1888 C. D. 92, 44 O. G. 567.

A special order made by the Commissioner and approved by the Secretary of the Interior permitting the filing of affidavits to prove that a mixture operated more effectually or rapidly and was more convenient in use than any of the substances of which it was compounded.

Rodgers, 1879 C. D. 333, 16 O. G. 1233.

The rules now in force contain no provision for counter-affidavits on the question of the operativeness of these devices. Such affidavits can not therefore be received in this case.

Fuller v. Brush, 1879 C. D. 328, 16 O. G. 1188.

As to relative utility in respect to reference cited, as a claim to patentability.

Mosley, 1870 C. D. 53.

Affidavits which assert a decided superiority of operation over the devices cited certainly make a prima facie case of superior utility for applicant's device, and a decided difference in utility may well import a difference in principle.

Tuttle, 1870 C. D. 3.

Cases which pass on the subject matter of this rule:

Davis v. Ocumpaugh v. Garrett, 1903 C. D. 130, 103 O. G. 1679; Dickinson v. Thibodeau v. Hildreth, 1902 C. D. 202, 99 O. G. 2550.

Rule 77. Abandonment.

If an applicant neglect to prosecute his application for one year after the date when the last official notice of any action by the office was mailed to him, the application will be held to be abandoned, as set forth in Rule 171.

Suspensions will only be granted for good and sufficient cause, and for a reasonable time specified. Only one suspension may be granted by the primary examiner; any further suspension must be approved by the Commissioner.

Whenever action upon an application is suspended upon request of an applicant, and whenever an applicant has been called upon to put his application in condition for interference, the period of one year running against the application shall be considered as beginning at the date of the last official action preceding such actions.

Whenever, during a time when the United States is at war, publication of an invention by the granting of a patent might in the opinion of the Commissioner

be detrimental to the public safety or defense or might assist the enemy or endanger the successful prosecution of the war, he may suspend action on the application therefor.

As amended in July, 1914, see 239 O. G. 945.

Rev. Stat., sec. 4894.

HISTORY.

As to first paragraph see Rule 171.

Second paragraph, in 1888, read: "Whenever action upon an application is suspended upon request of an applicant, the period of two years running against such application shall be considered as beginning at the date of the last official action preceding such request.

Next to last paragraph added 1892.

Last paragraph added 1899.

The following paragraph added in 239 O. G. 945:

Whenever, at any time when the United States is at war, publication by the granting of a patent might, in the opinion of the Commissioner, be detrimental to the public safety or defense, or might assist the enemy or endanger the successful prosecution of the war, he may suspend the action on the application therefor.

CONSTRUCTIONS.

See notes to Rules 65, 66, 68, 69 and 171.

Any application pending more than five years to be reported to the Commissioner.

Order 2,107, 200 O. G. 1119; Order 2,095, 199 O. G. 1.

If an applicant is referred to this rule he should examine it.

Vesey, 195 O. G. 213.

Affidavit under Rule 75 filed and held insufficient and a new reference cited, argument as to sufficiency of affidavit. Final rejection premature.

Hamby, 183 O. G. 1031.

That claims under Rule 96 were not suggested is no excuse for failure to amend.

McRie, 130 O. G. 980.

That a case was inadvertently crossed off the attorney's docket not sufficient excuse where it appears that delay until near the close of the period was intended.

Duryea, 128 O. G. 1291.

A person has a perfect right to delay action until near the

end of the year but in so doing he risks a delay due to a mistake.

Grant, 128 O. G. 885.

Where the Examiner suspends action upon a case and fixes a definite period, as required by the rule, he should take the case up for action at the expiration of the time.

Herzog v. Wheeler, 1905 C. D. 216, 116 O. G. 2009.

Where after amendment of a case the Examiner writes suspending action to permit the applicant to file another amendment agreed upon at an oral interview and no further action is in the case for more than two years. Held that the case is abandoned, notwithstanding the fact that the Examiner made his suspension for the definite period of thirty days.

Herzog v. Wheeler, 1905 C. D. 216, 116 O. G. 2009;
Hunter, 1905 C. D. 199, 116 O. G. 1731.

The petition is not only objectionable in asking an indefinite suspension but requests suspension beyond the year in which action must be taken as required by statute. In such cases the Commissioner has no authority to grant the petition and it is therefore denied.

Whitney, 1904 C. D. 139, 109 O. G. 2442.

The Commissioner has no power during the time limited to grant an extension beyond the limit.

Bauercamper, 1902 C. D. 130, 99 O. G. 448.

The above case was where the Examiner held that the claims were identical with those of another application by the same applicant, which was involved in interference. The applicant has a right to appeal from such a ruling.

Ostergen v. Tripler, 1901 C. D. 350, 95 O. G. 838.

It is contrary to the well settled policy of the Office to suspend action on any application pending before it unless such suspension is absolutely necessary to determine the right of the applicant to a patent on that application.

Bullier, 1899 C. D. 155, 88 O. G. 1162.

Rule 78. Amendment after Notice of Allowance without Withdrawal from Issue.

Amendments after the notice of allowance of an application will not be permitted as a matter of right, but may be made, if the specification has not been printed, on the recommendation of the primary ex-

aminer, approved by the Commissioner, without withdrawing the case from issue. (See Rule 165.)

CONSTRUCTIONS.

The establishment of a proper line of division between this case and the other can be effected under the provisions of Rule 78 without withdrawal from issue.

Dyson, 233 O. G. 755.

The presumption is that applicant made as broad claims as he was entitled to make and a broadened claim requiring a reexamination will not be made under this rule.

Goldsmith & Whiting, 184 O. G. 553.

Amendment under this rule not a matter of right and will not be permitted when the Examiner reports the claim as not allowable.

Fleming, 126 O. G. 2590; Goldsmith & Wheling, 184 O. G. 553.

A specific claim allowed a successful party after interference upon a generic claim.

Van Yorx, 170 O. G. 243.

If no sufficient reason why the claim was not previously presented is given and the Examiner is of the opinion that it is lacking in patentable novelty, its entry will be refused.

Langhaar, 159 O. G. 747.

Rule 78 does not provide for withdrawing cases from issue, but for the admission of amendments without withdrawing the case from issue. It is the well settled practice that where amendments are presented under Rule 78, containing claims which the Examiner recommends as patentable, such amendments will be entered, but that amendments presenting claims which the Primary Examiner holds are not patentable will not be entered.

Orndoff, 140 O. G. 100.

It is not necessary for the Examiner to give in detail his reasons for holding that the claims are unpatentable, and the rule does not provide for an indirect prosecution of the application.

Orndoff, 140 O. G. 1001.

The allowance was one day later than the receipt of the amendment, the allowance was therefore irregular. It should be withdrawn from issue (even if it should require a division).

Law, 111 O. G. 1038.

Where claims are sought to be inserted by amendment under the provision of Rule 78 in an allowed application it is

not necessary for the Examiner to state fully and in detail his reasons for reaching the conclusion that the claims are not patentable, as is necessary in the ordinary examination of a case. His action is merely in the nature of advice to the Commissioner upon which he can base his action in approving or disapproving the entry of the amendment.

Stone, 1902 C. D. 434, 101 O. G. 2080.

It is not the practice of the Office to permit the withdrawal of applications from issue for the purpose of further amendment except as provided by Rule 78.

Pierce, 1901 C. D. 224, 97 O. G. 2307.

Second clause. This allows broadening the claims in proper cases.

O'Connor, 1899 C. D. 446, 89 O. G. 1141.

Only where it is not necessary to reopen the case.

91 O. G. 1034; Woodward, 91 O. G. 1801.

Where an applicant has two applications in the Office disclosing different species of the same invention, each containing specific claims and one containing a claim broad enough to cover both species, and the one containing only specific claims has been allowed, a cross-reference disclaiming the subject matter of the broad claim may be inserted into the allowed case under Rule 78 without withdrawing it from issue.

Anderson, 1893 C. D. 51, 63 O. G. 463.

When such amendments affect the merits, they can not be made without withdrawing the case from issue upon a proper showing.

Cornelius, 1891 C. D. 124, 56 O. G. 929.

Amendment after allowance only permitted in cases where its refusal would work irreparable injury as to introduce claims that could not be patented in a separate application.

Myers, 1889 C. D. 198, 49 O. G. 131.

Subject of affidavits considered.

Steinmetz, 244 O. G. 363.

Cases which pass on the subject matter of this rule:

Meacham, 113 O. G. 1417; 94 O. G. 2169.

See Order No. 1365, 93 O. G. 557.

DESIGNS.

Rule 79. Design Patents, to Whom Granted.

A design patent may be obtained by any person who has invented any new, original, and ornamental

design for an article of manufacture, not known or used by others in this country before his invention thereof, and not patented or described in any printed publication in this or any foreign country before his invention thereof, or more than two years prior to his application, and not caused to be patented by him in a foreign country on an application filed more than four months before his application in this country, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, upon payment of the fees required by law and other due proceedings had, the same as in cases of inventions or discoveries.

Rev. Stat., secs. 4929 to 4933.
See The Law of Patents for Designs, by Wm. L. Symons.

CONSTRUCTIONS.

In this case the Circuit Court decided (182 F. 150), that a painting, if it possess artistic merit and be suitable, also, for use as a design may, at the owner's election, be protected either by copyright or by patent. On this broad question we express no opinion.

Louis De Jonge & Co. v. Brenker & Kessler Co., 191 F. R. 35.

The liability of one article being taken for the other.

Graff, Washbourne & Dunn v. Webster, 189 F. R. 905.

If the characteristics of the device relate to its mechanical function it is not patentable even if this mechanical function is to produce an appearance supposed to be beautiful.

Mygatt, 188 O. G. 1055.

The plain simplicity and beauty of the defendant's tomb is not due to anything found in the second claim of the patent. The patent is not for a design.

Tayntor Granite Co. v. Goelchius, 183 F. R. 130-131.

Where, as in the art of printing, the field of inventive design is limited to modifications of details in predetermined forms of letter and an inventor has succeeded in producing a new font having clearly distinguishing characteristics running through the whole and the esthetic value of the production is

confirmed by an extensive demand for the same, it is believed that he should be granted the right to a lawful monopoly of the results of his labors for the limited time provided by the design statutes.

Smith, 130 O. G. 1688.

It is not enough that the design should comprise features which would commend it to persons familiar with the art because of its functional value; it must possess an inherent beauty.

Bettendorf, 127 O. G. 848.

The application of mica flakes to the surface of insulating tubes.

The effect is one of design and can not be rightfully appropriated as a trade-mark any more than can the distinctive functioning features of a machine. The latter when new, useful and involving invention, are the legitimate subjects of mechanical patents. The former when new, ornamental and the result of invention are subjects of design patents.

American Circular Loom Co., 122 O. G. 1725.

Congress in enacting the patent statutes, relating as well to designs as to mechanisms, was not establishing a school of the fine arts and did not provide for juries of artists, or artistic experts, to pass upon the questions of originality and invention.

Schraubsladter, 120 O. G. 1168.

Where a font presents peculiarities in some of the letters, but these peculiarities do not bear such relation to the font as a whole as might distinguish novelty and invention in the font, even though such qualities could be predicated upon these peculiarities for the individual letters in which they appear and the letters display no common or pervading characteristic which might appeal either to the ordinary observer or to the trained expert as new and ornamental. The font is not patentable.

Scott v. Emmet & Hesolett, 116 O. G. 1184.

To apply to the W. & G. letters the wavy outline of the I letters is to provide them with the same effect of ornamentation that has been disclosed by I and in the same manner.

Schmohl, 115 O. G. 505.

Novelty and invention in designs.

Schmohl, 115 O. G. 505.

"The ground of rejection here is not aggregation, but lack of invention, by reason of the mere obviousness of the changes relied upon to distinguish over prior designs."

Barnhart, 115 O. G. 247.

"It is to be noted that in designing his lamp the appellant has changed the form and arrangement of parts designed to perform mechanical functions; but it is also to be noted that the changes were made solely for the purpose of obtaining the new and ornamental appearance." Held patentable.

Gray, 114 O. G. 543.

The doctrine of genus and species does not apply to designs and there can be no modification of a design.

Schraubstadter, 1904 C. D., 110 O. G. 2015.

Change in form to conserve mechanical function not patentable as a design. Lack of invention. Movable parts.

Nickel & Crane, 1903 C. D., 109 O. G. 2441.

Substantial difference is required to render two several devices patentable as designs. The difference between patentable novelties in mechanical matters and patentable novelties in matters of design, results from the different nature of the two things. Detail is of little consequence in the latter; it may be all important in the former.

Freeman, 109 O. G. 1339.

So far as this design possesses any peculiarity of appearance, due to a configuration created and employed for the performance of a mechanical result, that is to say, by which it fits the place where it is to be used, such appearance must be eliminated from consideration of this subject as an ornamental design.

Kern, 1903 C. D., 105 O. G. 2061.

There is, in reference to a design, lack of invention in an aggregation of old parts.

Hanson, 1903 C. D., 105 O. G. 2058.

A design may properly be placed upon a device having mechanical utility; but the design itself is not founded upon such utility. The function of the design is to appeal to the esthetic taste, or to produce "pleasure or admiration in its contemplation."

Hartshorn, 1903 C. D., 104 O. G. 1395.

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations.

Blistein v. Donaldson Lthgph. Co., 102 O. G. 1553.

Movability of parts: The subject matter of patents must be definite and certain, and since designs relate solely to shape or configuration the subject matter must be of a fixed and definite shape. This is not possible in the case of a machine made up of movable parts whose change in position changes the appearance of the devices. It is probably because of this

fact that the design law was limited to articles of manufacture.

It has, however, never been the practice of the Office to require absolute immovability of the parts of an article.

Steck, 98 O. G. 229-231.

Useful: Our ideas of beauty are derived to a certain extent from our ideas of the fitness of things for the purpose for which they were designed, and therefore it is practically impossible to disassociate the ideas of beauty from that of use in all articles intended for mechanical use.

Steck, 1902 C. D. 9, 98 O. G. 228.

Must be an invention. Example of lack of invention.

Westinghouse Electric and Mfg. Co. v. Triumph Electric Co., 90 O. G. 603.

As to an APPEARANCE of having a certain mechanical construction.

Feder v. Poyet, 89 O. G. 1344.

A design as a whole should be of unchanging character and should not include moveble parts, since the shape or configuration of a device is varied by varied positions of its elements.

Smith, 1897 C. D. 170, 81 O. G. 969.

Where applicant presents two distinct articles of manufacture, a cradle-supporting frame and a cradle-body, and claims them as such, held that the application should be restricted to one or the other of these two designs (cases cited).

Haggard, 1897 C. D. 47, 80 O. G. 1126.

A mechanical patent is no bar to a design patent for the same thing.

Lunken, 1896 C. D. 22, 76 O. G. 785.

The range or scope of a design patent is to be determined by the courts and not by the Patent Office.

Finck, 1892 C. D. 139, 60 O. G. 157.

As high a standard of originality is required for design patents as for any other class, and such originality goes to appearance or ornamentation rather than to utility.

Williams, Jr., 1892 C. D. 23, 58 O. G. 803.

Only one design may be protected by one patent.

Petzold, 1891 C. D. 207, 57 O. G. 1277.

The practice of allowing two or more forms to be included in a single design patent would result in confusion in the Office and ought not to be permitted.

Hess & Hess, 1891 C. D. 142, 56 O. G. 1334.

A dwelling-house is not a "manufacture" in the statutory sense, and a design for the exterior of a dwelling-house is not patentable.

Lewis, 1891 C. D. 61, 54 O. G. 1890.

Statutes first passed in 1842 used the word "useful" in connection with "patterns or prints or pictures, to be either worked into or worked on, etc." It has since been modified to the form here shown. Too much prominence was formerly given to the word "useful," the subject of invention so far as shape, for or configuration is concerned must be useful in the sense that it tends to promote pleasure, refinement, comfort, depending upon the sense of the beautiful. It must be useful in the sense that it must not be mischievous, or obscene in its tendency.

Schulze-Berge, 1888 C. D. 4, 42 O. G. 293; Parkinson, 71 C. D. 251.

A design patent relates to form or configuration and not to color or the material used. A patent might be granted for a combination of colors or material, but not a design patent. The distinction should be observed between design and other patents.

Traitel, 25 O. G. 783.

A previous mechanical patent is no bar to the grant of a patent to the patentee therein for a design shown in such patent.

Palmer, 21 O. G. 111; Burton v. Greenville, 80 C. D. 602.

If the design is new and original and also useful it is patentable as a design under the law whether it be or not ornamental or beautiful.

Shoeninger, 1878 C. D. 128, 15 O. G. 384; Bartholomew, 1869 C. D. 103; Fenno, 1871 C. D. 52; Crane, 1869 C. D. 7.

A previous design patent is no bar to the grant of a mechanical patent to the same applicant.

Bartholomew, 1871 C. D. 298; Collender, 1872 C. D. 217.

A design patent and a mechanical patent would not be granted on the same subject matter. But a design patent may be granted for the configuration and a mechanical patent for the construction.

Bartholomew, 1871 C. D. 298; Collender, 1872 C. D. 217.

There can be but little doubt that in the enumeration of subjects for design patents as contained in the statute, regard was had to the external ornamentation of articles of manufacture; and that to this end it was the intent of the law that the various designs should be so affixed to the manufactured articles or so wrought into their texture as to become in

effect a part of them. A trade-mark can not be patented as a design.

William Whyte, 71 C. D. 304.

See subject of design patents for a combination of colors discussed in Weinberg, 1871 C. D. 244. Produced in the statutes relating to designs means created.

Weinberg, 1871 C. D. 244.

The kind of material used and process of construction have nothing to do with the patentability of a design, a claim which stands only upon novelty of forms, and can not be strengthened by their introduction.

G. H. Sellers, 1870 C. D. 58.

Doctrine of genus and species as applied to designs discussed.

W. M. Bartholomew, 1869 C. D. 103.

Rule 80. Terms of Design Patents.

Patents for designs are granted for the term of three and one-half years, or for seven years, or for fourteen years, as the applicant may, in his application, elect.

Where the applicant requests that the patent issue for one of the shorter terms, he may, at any time before the allowance of the application, upon the payment of the additional fee, amend his application by requesting that the patent be issued for a longer term.

HISTORY.

Rev. Stat., sec. 4931.

Add to Rule 80 the following paragraph, where the applicant requests that the patent issue for one of the shorter terms, he may at any time before the allowance of the application upon the payment of the additional fee, amend the application by requesting that the patent be issued for a longer term.

Order No. 2,102, 200 O. G. 1.

CONSTRUCTIONS.

The election may be changed any time before allowance.

Forward, 196 O. G. 275.

Rule 81. Proceedings.

The proceedings in applications for patents for designs are substantially the same as in applications for other patents. Since a design patent gives to the patentee the exclusive right to make, use, and vend articles having the appearance of that disclosed, and since the appearance can be disclosed only by a picture of the article, the claim should be in the broadest form for the article as shown.

Rev. Stat., sec. 4933.

CONSTRUCTIONS.

A number of patents were introduced in evidence to show the prior state of the art. These do not show to the court such a universal knowledge of the features which the plaintiff's patent, No. 38,855, sought to protect as would require a limitation of the claim. While one or two of the letters or figures of the font may be similar to the like characters or character of the prior patents, a casual examination clearly demonstrates that as a whole there is such dissimilarity of configuration and ornamentation of the font described in patent No. 38,855 as involves patentable novelty.

Keystone Type Foundry v. Wynkoop, 239 F. R. 355.

The invention is not the article and is not the design *per se*, but is the design applied.

Cady, 232 O. G. 621.

The invention resides at least partly in the very act of adaptation to the article.

Cady, 232 O. G. 620.

The statute requires the applicant to specify some one article of manufacture to which he has applied the design, it seemingly can not be required that his patent be limited to one article.

Cady, 232 O. G. 620-621.

The applicant should state in his specification that his design is to be used as the figure of an enumerated number of articles.

Cady, 232 O. G. 679.

A disembodied design or mere picture is not the subject of patent and the specification must not so state.

Cady, 232 O. G. 621.

Applicant may state that his design is not to be limited to an article in three dimensions.

Cady, 232 O. G. 621.

Where applicant has shown the design applied to one article he has reduced it to practice and he may state other articles to which the design is to be applied if, and only if, the mode and effect of such application have been rendered obvious by the example given.

Cady, 232 O. G. 621.

A design patent gives no right to a name by which the design may become known.

Wilson v. Hecht, 216 O. G. 1319.

Block letters had been previously used, no invention in putting them in sets to be used by children.

Baker & Bennett Co. v. W. D. Case Co., 216 O. G. 1014.

May apply to things having movable parts.

Klemm & Schreiber, 218 O. G. 603, 1.

Mechanical advantages no bearing upon the question of the patentability of a design.

Sherman, 147 O. G. 237.

The St. Louis, Premier, and Shirly were exhibited side by side in the courtroom at the time of the argument. We thought then, and further examination convinces us, that defendant's radiator does not infringe. There is nearly as much difference between the Shirly and Premier as the Premier and St. Louis. Both patents may be treated as valid within narrow limits.

Am. Radiator Co. v. Shirly, etc., 199 Fed. 424.

It is evident that the mere fact that one device looks like another has no controlling effect in determining the validity of a design patent, because such patent does not operate as a trade-mark, nor involve considerations of unfair competition in business. Color constitutes no element of a design patent.

Star Bucket Pump Co. v. Butler Mfg. Co., 198 F. R. 863.

The ornamental design for leather or like material as shown is proper. The amendment cancelling "substantially" and substituting "or any colorable imitation thereof" disapproved.

Owen, 195 O. G. 1049.

We suppose it is true that a design which by mere merit attains quick and great popularity must have the grace of novelty; but a great popular demand which is stimulated and worked up by much money and ingenuity spent in advertising does not go far in suggesting the same attribute.

Phoenix Knitting Works v. Rich, 194 F. R. 716.

It seems somewhat absurd to claim such configuration as

part of an ornamental design which is only visible when the article to which it pertains is not in use.

Phoenix Knitting Works v. Hygenic, etc., 194 F. R. 699.

The practice of dispensing with a formal description referred to but not criticised.

Phoenix Knitting Works v. Hygenic, etc., 194 F. 699;

Phoenix Knitting Works v. Louer Bros., 194 F. 701.

Requirement of the elimination of the description disapproved.

Phoenix Knitting Works v. Rich, 194 F. R. 710.

There is no invention in aggregating separate designs.

Phoenix Knitting Works v. Hygenic, etc., 194 F. R. 699.

Surface ornamentation taken into account.

It is not clear what if any part shape and configuration may play as the basis for a design patent.

Phoenix Knitting Works v. Hygenic Co., 194 F. R. 699.

Where the seemingly unimportant variations in details produced an important general effect, there was invention and the design was patentable.

Weatherly, 191 O. G. 833.

Design patents no longer attempt to describe in literary parlance the effect of the ocular sensation conveyed by the drawings; and the court in the present instance must limit the scope of the complainant's design patent to the discovery or teaching shown in the patent, and must examine the exhibits.

Graff, Washbourne & Dunn v. Webster, 189 F. R. 905.

Suggestion of utility as an element of beauty.

Ashley v. Talum Co., 186 F. R. 339, pages 342-3.

As to description, see Cady, 232 O. G. 620 and 621, in connection with Ashley v. Talin Co., 186 F. R. 339.

Whether a painting possessing artistic merit, but suitable also for use as a design, may at the owner's election be protected either by copyright or by patent. I believe the question should be answered in the affirmative, but it can only be treated in one way.

Louis De Jonge Co. v. Brenker & Kessler Co., 182 Fed. 150.

A certain production held to be either copyrightable or patentable, but not both.

Louis De Jonge Co. v. Brenker & Kessler Co., 182 Fed. 150.

We can not find in the lower dome of his patent combined with a square base any useful function, although the com-

pleted structure may be more artistic and attractive; but that element would be the subject of a design patent.

Ashley v. Talum Co., 172 O. G. 262.

It is well settled that a design patent can be granted only upon a single shape or configuration, and not upon several, and that there is no distinction between generic and specific design patents as is recognized in mechanical patents (82 O. G. 1988; 83 O. G. 1994; 83 O. G. 1513; 110 O. G. 2015; 97 O. G. 1373; 113 O. G. 2215).

Lette, Jr., 160 O. G. 1272-3.

Mygatt, 121 O. G. 1676; Cheney Bros. v. Weinret, 157 O. G. 1002.

A design patent held not invalid for want of description in words.

Cheny Bros. v. Weinret & Weiner, 157 O. G. 1002.

Utility an argument in favor of a design.

In re Sherman, 154 O. G. 839.

Generally speaking the mere looks of things do not bear upon their novelty, except in case of a design patent.

Dayton Malleable Iron Co. v. Forster Waterbury & Co., 153 O. G. 201-204.

A design patent though invalid may apparently anticipate a mechanical patent. (Cary Mfg. Co. v. Neal (C. C.), 90 Fed. 725.)

Williams Calk Co. v. Neverslip Mfg. Co., 136 F. R. 212.

A mechanical patent may be void because of a previously granted design patent where the two are indistinguishable in their characteristics, and manifestly the outcome of one and the same invention idea.

Williams Calk Co. v. Neverslip Mfg. Co., 136 Fed. 212.

An examination of the model of the design and the drawing leads us to the conclusion that the design in question relates to that class where a description is not only proper, but necessary, and that the claim should carry a description of the salient features of the design. This is rarely the case.

Mygatt, 121 O. G. 1678.

The absence of any description of the design is authorized by the Patent Office rules relating to designs.

Schraubstadter, 120 O. G. 1167.

The preamble to a claim should be limited to the words "I claim."

Weihman, 118 O. G. 2252.

The drawing should show the article as it appears to observers and should not include a panoramic view of the ornaments to be placed thereon.

Weihman, 118 O. G. 2252.

He describes matters which are clearly shown in the drawing. The present practice of the Office is to dispense with all such descriptions as surplusage and as calculated to mislead.

Mygatt, 117 O. G. 598.

The description should not deal with the use to which the article is put, the function which it performs or its mechanical construction, since it would lead the unskilled to suppose that they constitute essential elements of the design for which protection is furnished by the design patent.

Mygatt, 117 O. G. 598.

In design cases the claim covers merely the design which the applicant discloses, and any attempt to vary the scope of the claim by the words used is objectionable, since it is likely to confuse the public.

Claim "for design and form" the words "and form" should be canceled.

Kahn, 116 O. G. 2008.

The statement that "the shape or outline of the blade forms no part of the design" required to be canceled, in accordance with the rule announced in Ex parte Freeman, 104 O. G. 1396. and Ex parte Goldsmith, 110 O. G. 309.

Remington, 114 O. G. 761.

The claim must be limited to a single article of manufacture, by changing the words "metal blades" to metal blade.

Remington, 114 O. G. 761.

The claim should be to the design as a whole, any limitation to specific features may make the claim objectionable in form, but can not make the application allowable that was not so without such limitation.

Kurz, 113 O. G. 2215.

When the ornamental appearance must be seen by a glance at the drawing, it is clearly superfluous to attempt to describe its appearance in the specification. Descriptive matter and reference letters on the drawing required to be erased.

Lloyd, 112 O. G. 251.

A drawing should show every feature, but a description except to indicate the figure is unnecessary.

Goldsmith, 110 O. G. 309-310.

Amendment to the specification is not necessarily an alteration of the claims.

Segelhorst, 109 O. G. 1887.

In a patent for a design a picture of the design serves to convey a greatly more adequate idea of the design than any description could possibly do; and in the presence of the pic-

ture, a superadded verbal description is generally useless and often times confusing.

Freeman, 109 O. G. 1339.

This descriptive language in connection with the drawings in the case, illustrates the utter futility of attempting by words to describe the appearance of an object which may be perceived immediately upon the inspection of a picture thereof. In designs the appearance is the new thing which is to be secured by a patent. Words do not explain, but rather confuse when added to the disclosure of the drawing. For this reason such descriptive material should be reduced to a minimum, or better still, entirely eliminated from a design patent specification.

Freeman, 104 O. G. 1396; Freeman, 109 O. G. 1339.

Amended descriptive matter may emphasize one feature or another, but it can not change the design.

Hanson, 103 O. G. 1417.

The claim covered the design as an entirety and that can not be changed.

Hanson, 103 O. G. 1417.

If an applicant claims in a design application subject matter for which a design patent can not be granted the claims must be rejected.

Waterman, 1902 C. D. 235, 100 O. G. 233.

A figure illustrating the internal construction of an article should be eliminated from the drawing.

Tucker, 1901 C. D. 140, 97 O. G. 187.

Experimental use does not apply to a design. As to anticipating,

See Tournier, 90 O. G. 1948; same case on appeal to the Court of Appeals; 94 O. G. 2165.

All reasons for rejecting shall be given by the Examiner at one time.

Sherman & Harms, 89 O. G. 2067.

There is no such distinction as generic and specific in design patents as there is in mechanical patents.

Feder v. Poyet, 1899 C. D. 218, 89 O. G. 1343.

The claims of a design patent are related as generic and specific when one has more elements than the other.

Coe, 1897 C. D. 187, 81 O. G. 2086.

An applicant may describe and claim variations in his patentable form within such limits as are consistent with unity of design and to the extent claimed, and may use mechanical language.

Lunken, 1896 C. D. 22, 76 O. G. 785.

In a design application showing more than one modification applicant is permitted to show, describe, and claim modifications generally.

Bark, 1894 C. D. 108, 69 O. G. 369.

Where certain words and figures (numerals) appeared on the illustration of a design, held that they should be erased if they form no part of the design.

Van Slyke, 1892 C. D. 175, 60 O. G. 893.

A specification comprising two separate descriptions of the same subject matter of invention that are substantially alike except that one contains references to the drawings, is unnecessarily prolix.

Kinney, 1892 C. D. 72, 60 O. G. 737.

The word "manufacture" does not include such a generic term as the word "tableware."

Proeger, 1891 C. D. 182, 57 O. G. 546.

Sufficiency of description.

Pegel, 1891 C. D. 93, 55 O. G. 1528.

The question of similarity or dissimilarity arising upon the comparisons of designs is determined by the eye of the ordinary observer and not by the judgment of experts.

Petzold, 1891 C. D. 97, 55 O. G. 1652.

An application for a design patent, which the applicant has elected to prosecute for the shortest period prescribed by law, can not be amended to run for a longer period after favorable action on the merits.

Kinnear, 1890 C. D. 54, 51 O. G. 156.

A claim must be for a segregable integral part, or for the entire design.

Pope, 1883 C. D. 74, 25 O. G. 290.

Applicant is not confined to one claim.

Sheppard, 1870 C. D. 22; Beattie, 1879 C. D. 142.

Applicant should be required to erase from his description all referenee to the function of the device.

Diffenderfer, 1872 C. D. 154; Norton, 22 O. G. 1205; Fairchild, 1873 C. D. 45.

More than one design can not be included in one patent.

Beattie, 1879 C. D. 142, 16 O. G. 267.

If the device claimed is not shown either in drawings or models, and is capable of such illustration, the applicant has not complied with section 27 of the Act of July 8, 1870, and Rule of Dodge, 1870 C. D. 149.

The application for the reissue was based solely upon alleged ambiguities and uncertainties in the wording of the

claims rendering them in effect mechanically inoperative. Therefore, under the application itself, there was no warrant for amending the claims except in so far as verbal corrections were necessary to make them mechanically operative.

Grand Rapids Show Case Co. v. Baker et al., p. 1360.

Rule 82. Arrangement of Specification.

The following order of arrangement should be observed in framing design specifications:

(*a*) Preamble, stating name and residence of the applicant, title of the design, and the name of the article for which the design has been invented.

(*b*) Description of the figure or figures of the drawing.

(*c*) Claim.

(*d*) Signature of applicant.

CONSTRUCTIONS.

The words "in testimony whereof" immediately preceding the signature is surplusage.

Pappenhagen, 79 Ms. D. 157.

Rule 83. Model.

When the design can be sufficiently represented by drawings a model will not be required.

Rev. Stat., sec. 4930.

Rule 84. Drawings.

The design must be represented by a drawing made to conform to the rules laid down for drawings of mechanical inventions.

(For forms to be used in applications for design patents, see appendix.)

CONSTRUCTIONS.

An unsigned photograph is not a compliance with this rule.

Bennett, 189 O. G. 1032.

A cross-section may be used at the election of applicant if it helps to illustrate the exterior construction of the article.

Lahmann, 184 O. G. 287.

Additional drawings required.

Mygatt, 180 O. G. 1395.

The edges of the prism that form the upper surface of the shade constitute reflecting surfaces and are not merely superficial ornamentation. It is therefore obvious that the contour of the article is as much a part of the design as the prisms which are formed on the outside of the shade. It is necessary that the design be shown accurately in the drawing. A side elevation proper.

Mygatt, 171 O. G. 125.

The drawing in design cases should show the article as it appears to observers and therefore (in this case) a cross-sectional view is not admissible.

Kohler, 116 O. G. 1185.

The fact that the present drawing was made with a pen does not remove the objection to it, since it is made up of fine dots instead of continuous lines.

Lloyd, 112 O. G. 251-2; Kohler, 116 O. G. 596.

Design patents have nothing to do with the interior construction, but are concerned solely with the external appearance, a figure showing the interior construction is objectionable.

Colton, 104 O. G. 1119.

Applicant should not be permitted to show in his drawing anything more than the design on which he wishes a patent.

Modifications do not exist in design.

Burdick, 1901 C. D. 184, 97 O. G. 1373.

In design patents it is the showing of the design which is of primary importance, the description being merely auxiliary to the showing.

Feder v. Poyet, 89 O. G. 1344.

If an inventor has a generic design capable of modification, that is, a design made up of a small number of simple elements to which other elements may be added without modification of the essential elements, he should, in order to secure protection for the generic design, show the design in his application in its simplest form. He must show the genus stripped of additions.

Feder v. Poyet, 1899 C. D. 218-220-221, 89 O. G. 1343.

A drawing of a design case should disclose the entire design, not merely a part thereof.

Parker, 1897 C. D. 73, 80 O. G. 1892.

Under the old rule allowing photographs in some cases.

The discretion of the Commissioner of Patents is not limited by the statute to dispensing with the model of the design.

The chief draftsman is the proper person to decide whether a line drawing is practicable.

Aumonier, 1893 C. D. 77, 63 O. G. 1815.

The discretion as to whether a photograph or line drawing shall be required rests with the Commissioner.

Poole, 1892 C. D. 233, 61 O. G. 1655; Petzold, 1892 C. D. 235, 61 O. G. 1789.

Unessential features should be erased from the drawing.

Requa, 1892 C. D. 148, 60 O. G. 295.

Every applicant for a design patent has an undoubted right to show both the observe and reverse of the ornamental work which he has devised. Should illustrate like portions of the device claimed.

Diffenderfer, 1872 C. D. 154.

REISSUES.

Rule 85. Granting Reissue.

A reissue is granted when the original patent is inoperative or invalid by reason of a defective or insufficient specification, or by reason of the patentee claiming as his invention or discovery more than he had a right to claim as new, provided the error has arisen through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention.

Reissue applications must be made and the specifications sworn to by the inventors if they be living.

Rev. Stat., secs. 4895, 4916.

CONSTRUCTIONS.

The proposition that A was under a special duty arising out of the fact that he is a reissue applicant, which is the main ground of my decision, is in accord with the general treatment of the subject of reissues by the courts.

Lette, Jr., v. Armstrong (motion for rehearing), 232 O. G. 938.

A reissue application should be expidited.

Altman, 220 O. G. 1373.

A first reissue abandoned claims in the original, a second reissue allowed to reinsert them, but one who had gone into the manufacture of such device because of the first reissue was allowed to continue. One judge thought the original claims ought not to have been inserted in second cases.

Autopiano Co. v. American Player Action Co., 217 O. G. 1055.

Defendant's position seems to be that there never can be a reissue of a claim once allowed in the original and omitted from a first reissue; but to this proposition we do not assent.

Autopiano Co. v. American Player Action Co., 217 O. G. 1055.

There is no reason why the mistake should not be corrected even though it occurred in an attempt to amend, as by mistake as to what the prior art contained.

Autopiano Co. v. American Player Action Co., 217 O. G. 1055.

These can not be remedied by reissue nor can the deliberate act of applicant's attorney in protracted proceedings in the Patent Office leading to the issue of the patent, be treated as the result of inadvertence, accident, or mistake.

Grand Rapids Show Case Co. v. Baker et al., 208 O. G. 1359.

Regardless of the question as to whether the entire reissue patent is rendered void by the insertion of a new and unauthorized claim, as suggested, *obiter* in Liggett v. Avery, 101 U. S. 259, it is clear that such claim of the reissue patent is itself void and will not sustain a bill for infringement. (Cases.)

Grand Rapids Show Case Co. v. Baker et al., 208 O. G. 1359-1360.

If, by reason of inadvertence, accident or mistake, a patentee fails to claim any part or all of the actual invention disclosed in his specification and drawings, and intended or sought to be covered, the patent is to be deemed to such extent "inoperative" and may be lawfully reissued so as to cover the entire invention in its claims. (Cases.)

Grand Rapids Show Case Co. v. Baker et al., 208 O. G. 1359.

If the patentee has described but failed to claim the means used by this defendant, probably he may apply to the Patent Office and claim them yet.

Loraine Development Co. v. General Electric Co., 198 F. R. 116.

As clearly they did not intend to abandon the claim that

the drop-bars in themselves constituted an invention, we should not impute to them an intention to abandon the arrangement and location of their drop-bars whereby they could gain the advantage due to the special form of drop-bar.

Coldwell Geldard Co. v. Stafford Co., 197 F. R. 573.

We find no case where it has been held that when a patent has been issued to a party for all he claimed in his application the party may subsequently make a new application for a new patent upon omitted matters, and that such new application was a continuation of the first or original application, without surrendering the first patent and obtaining a reissue of the first for the unexpired term of the first patent, as provided in section 4916 R. S.

Model Bottling Machine Co. v. Anheuser Busch B. Assn., 190 F. R. 576.

Weber v. Automobile & Accessories Mfg. Co., 190 F. R. 193.

A reissue is not necessarily void because it contains broadened claims.

Weber v. Automobile & Accessories Mfg. Co., 189 F. R. 193.

A reissue to correct manifest errors in the specification and to more fully describe the construction illustrated in the drawing rests upon a different footing from a reissue to include enlarged claims, and a showing in excuse of the delay which would be sufficient in the first case may not be so in the second.

Tilden, 182 O. G. 971.

A patent will not be reissued with enlarged claims upon an application filed more than two years after the grant of the original patent unless unusual circumstances are shown to excuse the delay.

Tilden, 182 O. G. 971.

Apparently the rule is more strict as to delay in the case of a second reissue.

Tilden, 182 O. G. 971.

Claims abandoned in original can not be reinstated (after ten years).

National Casket Co. v. Stolls, 197 F. R. 940.

The defense of laches being negative does not strongly appeal to the courts where the reissue narrows the claims. In such cases more delay in applying for a reissue, even for a long period (12 years) does no more than suggest laches. There being nothing on the face of the original patent to charge the patentee with notice that his claims were too

broad, proof that the patentee acted with reasonable diligence when he was put to the inquiry whether his claims were confined to the actual invention is sufficient to negative laches. (Mahn v. Harwood, 112 U. S. 554.)

Steiner, etc., v. Tabor Sash Co., 178 F. R. 831-842.

Neither the defendant nor any other member of the public obtained any rights by infringing the device, disclosed in the original patent, and which is protected by the reissue. The doctrine of intervening rights can not be invoked in such a case. The claims were narrowed in this case.

Steiner, etc., v. Tabor Sash Co., 178 F. R. 831-843.

If the solicitor fails to understand and properly describe or claim the real invention, by making claims so broad as to be anticipated, or so narrow as to be inoperative, this is such a mistake as to authorize a reissue if authorized on other grounds.

Toledo Computing Scale Co. v. Moneyweight S. Co., 178 F. R. 559.

The general power of reissue, however, does not depend upon statute, but on the general spirit and purpose of the constitution, and the laws relating to patents.

Toledo Computing Scale Co. v. Moneyweight S. Co., 178 F. R. 560. See this case in Court of Appeals. This was held by the Supreme Court in Grant v. Raymond, 6 Pet. 218.

While inadvertence and diligence are usually mixed questions of fact and law, yet as all the facts are generally of record, without dispute or conflict, the proper deduction is a conclusion of law and will be reconsidered by the court.

Toledo Computing Scale Co. v. Moneyweight S. Co., 178 F. R. 559.

Certain mistakes, even though present, are not enough. Examples of these are mistakes creating public rights acted on or arousing an estoppel in favor of another patentee, as in Dobson v. Lees, 137 U. S. 258, and mistakes attended with negligence and laches.

Toledo Computing Scale Co. v. Moneyweight S. Co., 178 F. R. 558-9.

A disclaimer was introduced into the specification which was afterwards found erroneous. The public had acted on the disclaimer. Reissue to remove the disclaimer improper.

Casem Co. v. Collins Co., 155 O. G. 554.

That the invention was shown in the original drawing not sufficient.

Nelson v. Felsing and Felsing v. Nelson, 142 O. G. 289.

A delay of two years in filing an application for a reissue of a patent with broader claims will usually be treated as an abandonment to the public of everything not claimed in the original. The rule is based upon the analogy between a reissue application and the case of an inventor who fails to apply for a patent of his invention within two years from the date of its public use or sale.

Ams., 127 O. G. 3644.

A patent may be reissued to include a process when only the apparatus was originally claimed. Inadvertence of attorney may be remedied by reissue.

Heroult, 127 O. G. 3217.

The original claims were directed to the holding and adjusting means alone, and it is now sought to insert by reissue claims covering broadly the combination of the gage with the holding and adjusting means.

It is believed that the invention now sought to be claimed is the "same invention" as that intended to be claimed in the original patent within the meaning of the statute.

Hansen, 125 O. G. 2050.

A delay of five years not excused because counsel advised that the claims were as broad as could be secured in view of the previous state of the art.

Arns, 125 O. G. 347; affirmed by C. A. D. C.

A patent upon an apparatus can not be reissued for the purpose of incorporating claims to a process.

Hirault, 124 O. G. 1843; cites Heald v. Rice, 1882 C. D. 215.

A reissue with broadened claims may be proper.

In re Briede, 123 O. G. 323.

Foreign inventor and attorney as an excuse for a delay.

In re Briede, 123 O. G. 323.

We must now regard the law as settled by the Supreme Court of the United States, that after the lapse of two years after the issue of a patent, a reissue which seeks to enlarge the claims of the original patent will not be granted, or if granted, will be held invalid, unless special circumstances are shown to excuse the delay.

Felbel v. Aguilar, 121 O. G. 1012.

The entire failure to disclose these in the original application effectually precludes the allowance of claims based thereon in any application which relates back to or takes benefit from such original application.

Briede, 117 O. G. 2085.

There was no attempt to claim the subject matter in the

original application and there is no intimation in the original application that the invention covered by the claim submitted in the reissue was the invention of the applicant, held that the invention covered by the reissue claim must be regarded as abandoned or waived.

Briede, 117 O. G. 2085.

The intention to claim the invention must evidently appear in the original application.

Briede, 117 O. G. 2085.

What would have been new matter in the original may not be claimed in the reissue.

Briede, 117 O. G. 2085.

It is irregular to permit a reissue during an interference.

Lalleg & Goodrum v. Dean, 111 O. G. 301-2.

There is no arbitrary limit of two years for the time of filing application.

Powers, 108 O. G. 1051-3.

A lapse of six years before application, even after a recent decision unfavorable to applicant, is fatal to the application, also the decision shows that the matter sought to be introduced is *new matter*.

Starkey, 105 O. G. 1259.

It would seem to be intimated that a patent may be reissued to correct a mistake in withdrawing a claim because it was said to be identical with another.

98 O. G. 582-585.

Analysis of them will show that there is a distinction well marked between reissues broadening the claims of the original but confined to the invention therein exhibited, which the courts sustain and reissues that depart from the invention exhibited in the original and included under its statement of invention.

Crown Cork & Seal Co., etc., v. Aluminum Stopper Co., etc., 1901 C. D. 450, 96 O. G. 2579.

The case shows that the court fully recognized the right to modify the claims so as to secure fully the invention described or attempted to be described in the original.

Crown Cork & Seal Co., etc., v. Aluminum Stopper Co., etc., 1901 C. D. 450, 96 O. G. 2578.

Where an applicant acquiesced in the limited construction put on his invention, and at no time during the prosecution of his original application suggested or intimated that the invention resided in the broad device now sought to be claimed in the reissue application, held that the failure to make the

claim in the original patent did not arise through inadvertence, accident, or mistake.

Bryant, 1896 C. D. 66, 76 O. G. 451.
Wollensak v. Sargent & Company, 1894 C. D. 164.

Identity of language in the claims of two patents does not necessarily import that the invention patented to each is identical, nor does a difference of phraseology necessarily import that they are for different inventions.

The test of identity is whether both, when properly construed in the light of the description, define essentially the same thing.

Thompson-Houston Co. v. Elmira Co., 74 O. G. 144.

Where the claim sought to be reissued is similar to one that was presented in the original application and rejected by the Office and canceled by applicant in order to obtain his patent, held that under such circumstances the applicant is estopped from setting up such claim in an application for a reissue.

The claim has apparently properly withdrawn.

Bowman, 1894 C. D. 25, 66 O. G. 1310.

Where an applicant has by "inadvertence" claimed less than he was entitled to claim he may have a reissue with enlarged claims.

Stanley, 1892 C. D. 166, 60 O. G. 735.

If an applicant omits to claim an invention that might have been claimed, because he did not believe it to be patentable, that fact is not sufficient ground for a reissue. It is not inadvertence, accident, or mistake.

Mahnken, 40 O. G. 915; Whiteley v. Bayley & Dyer, 36 O. G. 1142.

If the associate attorney cancels a claim, the applicant is bound by his act and can not afterwards reassert the withdrawn claim by reissue.

Hatchman, 25 O. G. 979.

A delay of more than two years is fatal.

Timken, 24 O. G. 1089.

An unexplained delay of more than five years is altogether unreasonable in a case where the reissue is for the purpose of expanding and enlarging the claims. Scope of the claims.

See 23 O. G. 342, 1882 C. D. 6.

Claims for inventions patented in foreign countries which patents have expired will not be allowed in reissue.

C. W. Siemens, 1877 C. D. 41, 11 O. G. 1107.

A clerical mistake in the specification of a patent can only be cured by a reissue.

Andrew, 1870 C. D. 75.

When mistakes are those of the Office, they will be corrected without expense to the applicant; but when he makes them, they can be cured only by a surrender of his old patent for corrections payment of the fee, and the issue of an amended patent.

Havemeyer Elder & Loosey Assin's Kronig, 1870 C. D. 5.

Until the reissue is actually issued from the Office the original patent remains uncancelled, it is usually deposited in the Office with the application. The uniform practice has been to return the original patent if a reissue is finally refused.

Whiteley, 1869 C. D. 72.

Rule 86. Abstract of Title.

The petition for a reissue must be accompanied by an order for a certified copy of the abstract of title, to be placed in the file, giving the names of all assignees owning any undivided interest in the patent. In case the application be made by the inventor it must be accompanied by the written assent of such assignees.

A reissue will be granted to the original patentee, his legal representatives or assigns, as the interest may appear.

CONSTRUCTIONS.

Abstract of title and assent of assignee necessary.

Powers, 108 O. G. 1053-4.

It is not necessary that the abstract of title and petition should agree in all cases. Where the records of the Office show an assignment and the assignee's name does not appear in the reissue application papers, the Office may properly refuse to proceed with the examination of the application. This, however, is not merely because the abstract of title and the petition do not agree, but because the assignee of record has not consented to the application.

Gold, 106 O. G. 998.

Filing date will not be given until abstract of title is furnished. The object of rule is not only to show what assign-

ments have been made, but whether an assignment has been made.

Blackmore, 102 O. G. 622.

A petition to change date of filing in order to bring that date within two years from date of patent refused as useless.

Griffin, 1900 C. D. 83, 91 O. G. 2001.

Where an application for reissue of a patent which has been assigned was not accompanied by the written assent of the assignee, but subsequent to the filing of the application the assignee reassigned to the inventor, held, that the date of filing of the complete application as entered upon the file wrapper should be changed to the date upon which the abstract of title was filed showing the reassignment.

Pender, 123 O. G. 2975.

Abstracts of title ought to be insisted upon.

Wright, 1876 C. D. 217; Fassett, 1877 C. D. 32.

Rule 87. Prerequisites.

Applicants for reissue, in addition to the requirements of the first sentence of Rule 46, must also file with their petitions a statement on oath as follows:

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

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

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

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

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

CONSTRUCTIONS.

Oath to be submitted to Law Examiner, Order 2,255, 227 O. G. 1.

No mere inference can take the place of such proof. Ordinarily what is called for by the words same invention should appear in some way on the face of the original patent, and it can not be gathered from mere inferences or suggestions with reference to what the patentee might or might not have conceived.

Stafford Co. v. Coldwell Gildard Co., 202 O. G. 745.

While some of the requirements of Rule 87 may possibly go beyond the power conferred, a matter which we are not now called upon to decide, there is nothing in so much of the rule as is mentioned above that is inconsistent with the statute.

Fullagor, 192 O. G. 1263.

Having disclosed the process, the failure to claim was either intentional or the result of inadvertence, accident or mistake for which section 4916, Revised Statutes, furnishes a remedy.

Heruilt, 127 O. G. 3217.

Where a domestic patent was granted Feb. 20, 1883, and a British patent for the same invention was sealed August 20, 1883, and a reissue application was filed January 21, 1893, held, that since the term of the reissue would not be affected by the foreign patent, it was unnecessary to require the reissue applicant to recite the British patent in his oath.

Cowles, 1893 C. D. 135, 65 O. G. 2060.

Order of proceeding by the Examiner: First, whether or not the original patent is inoperative or invalid; second, if so, for what reason?; third, if so, did the error arise from an advertence, accident or mistake, and without fraudulent intention; fourth, whether there are any references.

Ernst, 33 O. G. 235.

The statement must allege facts, the opinion of the allegor is not sufficient.

Timken, 24 O. G. 1089; Pfaudler, 23 O. G. 269.

Applicant should state if foreign patents have been issued for the invention, and the dates of such patents should be given.

C. W. Siemens, 1877 C. D. 41.

Rule 88. New Matter.

New matter shall not be allowed to be introduced into the reissue specification, nor in the case of a machine shall the model or drawings be amended except each by the other.

CONSTRUCTIONS.

Claims for matter not in the inventor's mind when original application was made void.

Smith Incandescent Light Co. v. Welsbach Gaslight Co., 197 F. R. 951.

An application can only be reissued for matter that was contemplated in the original.

Sovereign et al. v. Lettie, 185 O. G. 830.

The invention was shown in the original drawings, but was only referred to in the application for a reissue. Held void.

Marvel Buckle Co. v. Alma Mfg. Co., 180 F. R. 1002; refers to Parker & Whipple Co. v. Grele Lock Co., 123 U. S. 87, 8 Sup. Ct. 38, 31 L. Ed. 100.

The new matter added is not limited to a new theory. It contemplates an intentional variation in construction, and the new theory explains what takes place with the new construction. Not admissible.

Taylor, 183 O. G. 1032.

Original for combined devices reissue for one of the combined devices. Reissue valid.

Hareford v. Hollander, 163 F. R. 948.

A reissue which seeks to enlarge the claims of the original patent will not be granted or if granted will be held invalid unless special circumstances are shown to excuse the delay.

In re Starkey, 104 O. G. 2150; Court of Appeals D. C.

A patent for a machine can not be reissued to cover a process.

Pfaudler, 1882 C. D. 17, 22 O. G. 1881.

A claim can not be inserted in a reissue for matter which was described but not claimed in the original specification.

Pfaudler, 22 O. G. 1881.

An applicant for reissue is entitled to make use of any terms in describing his invention in a reissue application which would have been correct in the original application.

Bissell & Moore Mfg. Co., 1870 C. D. 157; Coleman, 1880 C. D. 205.

A suggestion of a new use may be inserted in a reissue.

Palmer, 1880 C. D. 129, 17 O. G. 976.

It is proper to remedy a defective description by reissue.

Siemens, 1877 C. D. 98, 12 O. G. 626.

Affidavits can not be received as to an element not shown in the model.

Stockwell v. Haines, 1877 C. D. 82, 12 O. G. 137.

Illustrations of last clause.

Ingraham, 1871 C. D. 164; Dieckerhoff, 1877 C. D. 77, 12 O. G. 429.

A reissue can not be based upon a void patent, as upon one issued upon an application subscribed and sworn to in blank.

Benton, 23 O. G. 341.

Or upon a patent issued to joint inventors for an invention made by but one.

Barsaloux, James & Lyon, 1878 C. D. 154.

Where the ambiguity is explained in a manner not inconsistent with the original invention, and where the patent is clearly inoperative by reason of such ambiguity, it is but just that the discretion reposed by the law in the Commissioner should be exercised in favor of the patentee upon sworn statements of the character herein filed.

Gottstein, 1877 C. D. 47; Winslow, 1876 C. D. 96.

A patent may be reissued to include an invention shown in the original drawing, but not shown in the drawing attached to the patent.

Baldwin, 1876 C. D. 76.

No new matter should be introduced.

Aldrach & Evans, 1876 C. D. 40.

The Office has been compelled to construe the provisions of this rule as literally as a court would a criminal statute.

Warring, 1871 C. D. 228.

The applicant should be held rigidly to the language adopted in his patent except when good reasons appear for departing from such language.

Underwood, 1872 C. D. 118, 1 O. G. 549.

Testimony may be received as to a lost model as a basis for an amendment of the drawings.

Neal & Adams v. Daniels, 1871 C. D. 156.

Examples of new matter.

Lewis, 1871 C. D. 82.

The drawings can not be amended by the written description alone.

Keith, 1870 C. D. 69; Dodge, 1869 C. D. 27.

Rule 89. Division of Reissue of Application.

The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for each division of such reissued letters patent. Each division of a reissue constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division; and the drawing may represent only such part or parts, subject to the provisions of Rule 50. Unless otherwise ordered by the Commissioner, all the divisions of a reissue will issue simultaneously; if there be any controversy as to one division, the others will be withheld from issue until the controversy is ended, unless the Commissioner shall otherwise order.

CONSTRUCTIONS.

Where an application is filed for the reissue of a patent, held that division can not be required. (Ex parte Lippincott, 16 O. G. 632, overruled.)

Van Nostrand, 1913 C. D. 215.

Examples of a division required by the Commissioner.

Lippincott, 1879 C. D. 212, 16 O. G. 632; see Van Nostrand, 1913 C. D. 215.

The Commissioner has power to issue the several divisions at different times.

Greaves, 1880 C. D. 213; Decision of Secretary, 18 O. G. 623.

An applicant can not disaggregate his machine, and set up as a part of the same invention a special organization of parts producing some special effect he desires to cover, to the entire exclusion of all other results regularly flowing out of the complete device as originally organized.

Powell, 1878 C. D. 72, 13 O. G. 911.

A patent may be divided and reissued to eliminate the part covered by expired foreign patents.

Pulvermacher, 1876 C. D. 154.

In an application for reissue parts of a device can not be

selected to make up a new device not hinted at in the original patent.

Wheeler and Wheeler, 1873 C. D. 101, 4 O. G. 3.

If the inventor of a process finds that the same result can be obtained without carrying out the entire operation, he is entitled to the benefit thereof, and he may secure it, if he be a patentee by reissue.

Wooten, 1872 C. D. 264, 3 O. G. 521.

Rule 90. Reexamination of Reissue Claims.

An original claim, if reproduced in the reissue specification, is subject to reexamination, and the entire application will be revised and restricted in the same manner as original applications, excepting that division will not be required.

CONSTRUCTIONS.

It is proper to cite patents which were granted subsequently to applicant's filing date, but on applications filed prior to that date.

Bryan, 178 O. G. 886.

Rule 91. Original Patent.

The application for a reissue must be accompanied by the original patent and an offer to surrender the same, or, if the original be lost, by an affidavit to that effect, and a certified copy of the patent. If a reissue be refused, the original patent will be returned to applicant upon his request.

CONSTRUCTIONS.

If claims in patent are rejected on reissue application it does not affect the claims in the patent before the original patent is canceled and reissue issued.

100 O. G. 449.

Rule 92. Matter to be Claimed only in a Reissue.

Matter shown and described in an unexpired patent which is an indivisible part of the invention claimed

therein, but which was not claimed by reason of a defect or insufficiency in the specification, arising from inadvertence, accident, or mistake, and without fraud or deceptive intent, can not be subsequently claimed by the patentee in a separate patent, but only in a reissue of the original patent.

CONSTRUCTIONS.

See notes under the heading "Reference to Applicant's Previous Patent." Rule 66.

An interference dissolved as one of the applicants contains claims made in violation of this rule.

Du Bois v. McCloskey, 1880 C. D. 142.

An inventor can not claim in a second patent matter described but not claimed in a former patent to himself.

Hill v. Prentice, 24 O. G. 1176; Hill v. the Com. of Patents, 33 O. G. 757.

This rule must be administered in subordination to the statute securing the right of issue. If the thing shown, but not claimed, in the two patents can not be lawfully claimed on reissue of the earlier, but can be lawfully claimed on reissue of the later patent, it may be so claimed, notwithstanding the rule; for the rule can not be permitted to defeat the law.

Locke, 1879 C. D. 311.

INTERFERENCES.

Rule 93. Interference Defined.

An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention. *In order to ascertain whether any question of priority arises, the Commissioner may call upon any junior applicant to state in writing the date when he conceived the invention under consideration. All statements filed in compliance with this rule will be returned to the parties filing them. In case the applicant makes no reply*

within the time specified, not less than ten days, the Commissioner will proceed upon the assumption that the said date is the date of the oath attached to the application. The fact that one of the parties has already obtained a patent will not prevent an interference, for although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who proves to be the prior inventor. (As amended June, 1917.)

Rev. Stat., sec. 4904.

HISTORY.

See Ewing, Com., v. U. S. ex rel. The Fowlor Car Company Case, Ct. of A. D. C. and S. C., 226 O. G. 700.

See notes to 127.

Lowery's Interference Rules, §§ 1, 3 and 4, page 111, has the following:

§ 1. *Introduction.*

The first statutory provision relating to interferences was that of the Act of 1793, Chap. XI. Section 8, which provided that interfering applications should be submitted to arbitration, and established a rule for the selection of the arbitrators.

There was no further legislation on the subject until the Act of 1836, which established the United States Patent Office, with the Commissioner of Patents as its head, and which provided in Section 8 for a form of procedure in the Patent Office in cases of interferences.

Section 16 of the same act gave a remedy by bill in equity on an adverse decision of the Board of Examiners in the case of an interfering application and an unexpired patent.

The Act of 1870 repealed that of 1836 and reenacted in Sections 42 and 46 the substance of Section 8 of 1836. To these correspond Sections 4904 and 4909 of the Revised Statutes now in force.

§ 3. *Rules of the Patent Office.*

The Act of 1839, Section 12, conferred on the Commissioner of Patents the authority required for the making of regulations in respect to the taking of evidence to be used in

contested cases before him; this power was further enlarged by the Act of March 2, 1861, Section 1.

These provisions were reenacted in Section 43 of the Act of 1870, and are now embodied in Section 4905 of the Revised Statutes.

The Act of March 2, 1861, Section 2, established a Board of Examiners-in-Chief, and provided that they should be governed in their action by the rules to be prescribed by the Commissioner of Patents.

The Act of 1870 greatly enlarged this power, and in its nineteenth section authorized the Commissioner, subject to the approval of the Secretary of the Interior, to establish rules and regulations for the conduct of proceedings in the Patent Office.

It is from this enactment, repeated in Section 483 of the Revised Statutes, that the accompanying rules derive their force.

The conclusiveness of the Patent Office rules has been considered in:

Arnold v. Bishop, 1841, Cranch Ch. J. 1 Mac A., Pat. Cases 27; Nichols v. Harris, 1854; Morsell, J. Ibid 302; O'Hara v. Hawes, 1859; Morsell, J. Law's Digest 96; Dyson, ex parte 1860; Dunlop, J. Ibid 96.

§ 4. *Editions of the Rules.*

It is said that in 1820 the Secretary of State issued a set of instructions relating to applications for patents, and as early as 1828 we find in the Franklin Journal, 2d Sr., Vol. 2, page 332, directions of a semi-official nature for the guidance of persons applying for patents; but the first official publication of Patent Office rules is undoubtedly that of 1836, which appeared simultaneously with, and was based upon, the new law of the same year. From then on various editions have been issued with which we are not concerned; that of November, 1869, being the last prior to the passage of the Act of July, 1870."

CONSTRUCTIONS.

The Commissioner is required to put the machinery of the law in operation by the declaration of an interference. It is not possible for him by any short cut he may devise to deprive the applicant of this right.

Ewing, Com., v. U. S. ex rel. The Fowler Car Company, 226 O. G. 700.

The Supreme Court reversed the Court of Appeals in this case.

Ewing, Com., v. Fowler Co., 238 O. G. 983.

During the year the practice of having all prospective interferences between applicants for patents submitted to one of the law examiners has been continued. A total of 1,823 interference proposals were reviewed by the law examiner assigned to this task. Of these, 924, or 51 percent, were approved as submitted; 583, or 29 percent, were approved after modification; and 369, or 20 percent, were disapproved; 1,286 new interferences were declared, and in 168 existing interferences new parties were added. In 344 of the interferences orders to show cause were issued to all junior parties. But for the mandamus granted by the Court of Appeals of the District of Columbia in the case of United States ex rel. Fowler Car Co. v. Commissioner of Patents, the number of interferences actually declared would have been reduced by several hundred. The amount of labor involved, both for the office and litigants, in disposing of several hundred interferences in which no question of priority of invention is involved is very great, and several hundred applicants are denied their patents when they demand them and are harrassed and put to expense at the instance of applicants who presumably have no right to the invention in controversy. The Fowler case has been taken up by the Supreme Court of the United States on a writ of certiorari and is to be argued there, it is hoped, at an early date.

Commissioner's Report. 1916. See paper by Commissioner Ewing, read before the Examining Corp.

T's design application was rejected upon design patent to A. The Examiner thought A's application was allowable over the previous state of the art and that T's was not, and refused to declare an interference, but said if T's and A's devices were held to be alike on appeal, he would declare the interference. Held the interference should not be declared until the subject matter was held to be patentable.

Taylor, 174 O. G. 287.

Whether the senior applicant may be entitled to priority of invention as against all persons, is not the issue in an interference case between two claimants of the invention; but the question is whether the junior applicant has established his own claim to priority over that of his apponent.

Boisart v. Pohl, 135 O. G. 453.

In re Mills, 117 O. G. 904.

Schubert v. Munro, 113 O. G. 284.

Equities are not with a sole applicant in trying to dissolve an interference with an application that he has made as a joint applicant. The question should be investigated.

Girard v. Abbott, Girard & McGerr, 103 O. G. 662.

Recent amendment.

Lane v. Hunter, Jr., 1893 C. D. 43.

There may be an interference in fact on a generic issue based on two devices which are specifically different.

Kolb v. Hemingway v. Curtis, 120 O. G. 2445.

Some of the claims constituting the issue were made in this case; but others have not been made and can not be made here for the reason that there is no foundation in this case for them. It is therefore impossible to include this case in the interference upon the issues there stated. The declaration of a second interference including a part of the issue in the first would also be improper.

Adams, 119 O. G. 650.

Where the terms of an issue are generic there may be an interference in fact although the device of the parties may differ in specific details.

Sanders v. Melvin, 119 O. G. 1921.

The devices were different, but the issue was to parts having corresponding functions. Held properly declared.

Walker v. Brunhoff, 118 O. G. 2537.

Where the devices of the parties are identical in substance so far as they are defined by the claims in issue, though such devices differ in specific characteristics to which said claims are not limited, held that there is interference in fact as to such claims.

Greer v. Christy, 116 O. G. 297.

If the Examiner does not regard the claims as patentable he should reject them and applicant's remedy is by appeal on the question of patentability.

Dukes, 115 O. G. 803.

Where one of two alleged joint inventors refused to sign the specification the Commissioner said since no patent could be issued upon this application, the Office must refuse to make the examination which is ordinarily made and must refuse to conduct an interference which is one form of species of examination. (Refers to 4 Wall. 527.)

In re Adam, 106 O. G. 999.

Do not claim substantially the same invention when the counts include an element not found in one applicant's claims and when the claims include elements not found in counts.

Wheildon v. Tench, 106 O. G. 763.

An interference will not be declared where the Office is willing to allow applicant's claims over the issued patent.

Gibloney, 105 O. G. 976.

In order to constitute an interference in fact the language of the counts must mean the same thing when applied to each of the interfering inventions.

MacDonald v. Edison, 105 O. G. 973.

There is an interference in fact between two applications disclosing the same process notwithstanding one describes two preliminary steps as preferable, or if one describes as preferable though not essential the employment of an additional intermediate step.

Power v. Procger, 1902 C. D. 482, 101 O. G. 3108.

Whether application was altered or not in issue, at least in this particular case.

Snider v. Bunnell, 1902 C. D. 460, 101 O. G. 2572.

Questions proper to an interference will not be considered in a separate application.

Stone, 1902 C. D. 434, 101 O. G. 2080.

The question of originality, except as between the parties, will not be considered.

Trufant v. Prindle v. Brown, 1902 C. D. 397, 101 O. G. 1608.

The interference was between an application and a patent and also an application for the reissue of said patent. Two claims that were in the patent were rejected in the application for reissue on reference to opponent's English patent and the rejection acquiesced in. Held that the two claims were still involved in the interference.

Read v. Scott, 1902 C. D. 242, 100 O. G. 449.

Interference cases will not be entertained for the purpose of settling a moot question but only to determine priority.

Weston v. Jewell, 1902 C. D. 20, 98 O. G. 417.

In trade-marks the practice follows that of mechanical patents.

Carey v. New Home Sewing Mch. Co., 1901 C. D. 165, 97 O. G. 1171.

Reece v. Fenwick, 1901 C. D. 143, 97 O. G. 188.

Between designs applications.

Tyler v. Amand, 1901 C. D. 301, 94 O. G. 1969.

The applicant must be found entitled to a reissue before the interference is declared.

Bagot & Dishart, in re, 1900 C. D. 80, 91 O. G. 1802.

Substance, not words, the test of identity.

Edgecombe v. Eastman v. Houston, 1899 C. D. 207, 89 O. G. 707.

The gist of an interference resides in the claim and not in mere disclosures in the application.

Van Depoele v. Daft, 1892 C. D. 15, 58 O. G. 520.

Where a patent has issue inadvertently and interference is subject to the same rules as when between two applications.

Beckman v. Johnson, 1889 C. D. 184, 48 O. G. 673.

Doubted if after applicant has voluntarily eliminated his claims and apparently abandoned them should be permitted after invention has been developed to return after eleven years and amend and claim an interference.

McDonough v. Gray v. Bell v. Edison, 1889 C. D. 9, 46 O. G. 1245.

An interference is properly declared between the applications of joint applicants and one of said joint applicants claiming to be a sole inventor.

Lovrien v. Banister, 1880 C. D. 152, 18 O. G. 299; Kohler v. Kohler & Chambers, 1888 C. D. 19, 43 O. G. 247; Welpton, 1873 C. D. 21.

Where two combinations producing the same effect are identical except as to a single element, which is present in one but wanting in the other, a case of interference arises, because the latter combination if first invented will anticipate and defeat the former.

Banks v. Snediker, 1880 C. D. 95, 17 O. G. 508; see Fletcher v. Abraham, 1870 C. D. 26.

An application put in interference with two patents so that the patentees should incidentally prove their rights as to each other.

Wilson & Matthews v. Yakel & Rogers, 1876 C. D. 245, 10 O. G. 944.

An interference is declared between the applications or the invention involved rather than between the applicants or patentees.

Hicks v. Keating v. Purvis & Bilgram, 1887 C. D. 40, 40 O. G. 343.

The two applications must claim the same invention. Description in the specification is not sufficient ground for an interference proceeding.

Drawbaugh v. Blake, 1883 C. D. 17, 23 O. G. 1221; Emerson, 1880 C. D. 143, 17 O. G. 1461; Wright, 1870 C. D. 60.

Neither the spirit of the law nor public policy sanction the

granting of patents with specific claims while applications with generic claims are still pending.

Upton, 1884 C. D. 26, 27 O. G. 99; see Gardner v. Dudley, 1880 C. D. 123, 17 O. G. 801; Bacheller v. Porter & Bancroft, 1869 C. D. 64; Boon v. Hinman, 1870 C. D. 7.

But the Commissioner seems to think differently in

Drawbaugh v. Blake, 1883 C. D. 17, 23 O. G. 1221.

The Commissioner can not declare an interference with an unlawful application, as with one improperly divided.

Holt, 1884 C. D. 43, 29 O. G. 171; or with unpatentable claims, Jackson v. Nichols, 1871 C. D. 278.

It is not as a prior patentee that one of two conflicting applicants, who have inadvertently obtained a patent, obstructs the application of the other, but as a rival claimant or conflicting applicant, necessitating an interference. An interference should be declared *nunc pro tunc* under the first clause of Rule 93. (Marston, 1882 C. D. 1, 21 O. G. 633.)

An affidavit seems to have been required in Upton, 1884 C. D. 26, 27 O. G. 99, however.

An interference should not be declared between a native and a foreign invention in order to allow the foreign inventor to establish the date of his invention in a foreign country, as this is an immaterial question. But, upon a proper affidavit being presented, an interference may be declared to give the foreign inventor a chance to establish the dates of introducing the knowledge of the invention into this country. An interference will not be declared in order to show dates of publication.

Thomas v. Reece, 1879 C. D. 335, 26 O. G. 1234; 1888 C. D. 12, 17 O. G. 195.

The word "showing" should be construed as in Rule 74.

Graydon, 1883 C. D. 71, 25 O. G. 192.

If the original patent is involved in an interference proceeding and a reissue is sought, the examination should be proceeded with and if the reissue is allowed, the reissue patent should be substituted in the interference proceeding.

Zay, 1881 C. D. 20, 19 O. G. 1496; see also Wright, 1870 C. D. 60.

If, pending an interference between A, B, & C whose preliminary statements have been filed, D shall file an application not claiming or showing the invention in interference, but claiming other matter claimed by A and shown by B and C, he will be entitled to an interference with A and also upon due amendment of the applications with B and C without

waiting for the final adjudication of the pending interference between A, B, and C.

Smith, 1880 C. D. 77, 17 O. G. 447.

The claims must conflict in substance not necessarily in words.

Drawbaugh v. Blake, 1883 C. D. 17, 23 O. G. 1221; Greenough v. Drummond, 1879 C. D. 213 and 267, 16 O. G. 959 (16 O. G. 586, 213 and 267).

The Commissioner can not declare an interference with a forfeited application.

1877 C. D. 122, 12 O. G. 979; Holt, 1884 C. D. 43, 29 O. G. 171; Spear, 1874 C. D. 25.

The Commissioner can not declare an interference with an abandoned application.

Casilear v. McIntire, 1875 C. D. 117; Contra Rouse v. Stoddard, 1875 C. D. 33, 7 O. G. 169; see Leavitt, 1873 C. D. 27.

It is not necessary to an interference that the combination of each party should consist of elements identically the same in form so long as the combinations as entireties are the equivalents in arrangement and mode of operation.

Withington v. Locke, 1877 C. D. 27, 11 O. G. 417.

It was at one time thought that the Commissioner had no authority to declare an interference with reissues.

Becker v. Throop, 1875 C. D. 87; Paris v. Bussey, 1875 C. D. 145.

But the practice was soon resumed in proper cases.

Sargent v. Burge, 1876 C. D. 175, 10 O. G. 285; Carroll v. Morse, 1876 C. D. 61, 9 O. G. 452.

Where the claim in interference is broader in scope than the special devices shown by either of the parties, the subject matter involved can not be limited to just what is shown by either of said parties.

Sacroix and Welch, 1873 C. D. 155.

Or by a patent having been granted without an interference as where a caveator failed to receive the notice sent by the Office, of the second application.

Frevert v. Gahr, 1873 C. D. 92.

The claims differ in this: Chapman claims the process described and Finley the article produced; but either might, by amendment or reissue, insert the clause of the other.

I have no hesitancy in deciding that the interference was properly declared.

Liggett in Finley v. Chapman, 1872 C. D. 53; see also Chesebrough v. Toppan, 1872 C. D. 100.

An application will not be prejudiced by the mistake of the Office in granting a patent to his opponent instead of declaring an interference between the applications.

Goodman v. Scribner, 1872 C. D. 254; Hamilton v. Foster, 1869 C. D. 30.

The devices of applicants differ as much from each other as they do from the device which was prior to both of them. They are improvements upon that original, but not upon each other. They perform the same result, but they differ in their mode of performing it, which is their principle of operation, as much as they differ from the original; there can, therefore, be no conflict between them.

Barton v. Babcock, Manton & Boyd, 1869 C. D. 67.

Rule 94. When Declared.

Interferences will be declared between applications by different parties for patent or for reissue when such applications contain claims for substantially the same invention which are allowable in the application of each party, and interferences will also be declared between applications for patent, or for reissue, and unexpired original or reissued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved: *Provided*, That where the filing date of any applicant is subsequent to the filing date of any patentee, the applicant shall file an affidavit that he made the invention before the filing date of the patentee.

Parties owning applications or patents which contain conflicting claims will be required before an interference is declared to show cause why these claims shall not be eliminated from all but one of the applications or patents of common ownership.

CONSTRUCTIONS.

The Supreme Court say that an applicant has two (2) years from the grant of a patent in which to insert the claims thereof, reversing the Court of Appeals D. C. as shown in next paragraph.

Chapman v. Wintroath, 272 O. G. 913.

Failure for more than a year to make claims of patent an estopped unless explained.

Wintroath v. Chapman et al., 248 O. G. 1003, 1004.

Rules 125 and 91 seemingly conflict in the present instance. The inventor can not be bound to make concession of Rule 125.

Schreiber v. Bauer, 258 O. G. 813.

If two applications are pending at the same time no affidavit required in order to justify an interference.

Soille, 90 O. G. 2133.

If a patent is issued upon an application claiming an invention, while another application showing but not claiming it is pending, the second applicant may make the claims and have an interference declared without making the affidavit.

Tinsley, 1899 C. D. 248, 89 O. G. 2259.

When two applications are pending contemporaneously the necessity for such an affidavit does not exist.

Simonds, 114 O. G. 1549.

Specific and generic claims do not interfere.

Williams v. Perl, 87 O. G. 1607.

A case passing on the subject matter of this rule:

Forbes v. Thomson, 1890 C. D. 61, 51 O. G. 297.

An interference with an unexpired patent will not be declared until the application is rejected with reference to that patent.

Massicks & Crooke, 1887 C. D. 20, 38 O. G. 1489.

The affidavit under Rule 94 does not call for a showing of facts. The Office may call for such a showing.

Ries v. Thomson, 1891 C. D. 233.

The affidavit required must identify the invention in controversy and state that affiant made it before the patentee's application was filed, but it does not call for a statement of facts showing date of invention. The right to call for such a showing is discretionary with the Office.

Davis, 1893 C. D. 41.

Said not to require a statement of facts as in Rule 75.

Ries v. Thomson, 1891 C. D. 233, 57 O. G. 1598.

The affidavit must state facts from which the conclusion can be reached that the invention was made before the patentee's application was filed.

Graydon, 1883 C. D. 71, 25 O. G. 192.

Rule said to have been amended since Graydon was decided and above said to be a mere dictum.

Ries v. Thomson, 1891 C. D. 233, 57 O. G. 1598.

Rule 95. Preparation for Interference.

Before the declaration of interference all preliminary questions must be settled by the primary examiner, and the issue must be clearly defined; the invention which is to form the subject of the controversy must have been patented to one of the parties or have been decided to be patentable, and the claims of the respective parties must be put in such condition that they will not require alteration after the interference shall have been finally decided, unless the evidence adduced upon the trial shall necessitate or justify such change.

In case the subject matter in controversy has been patented to one of the parties but is deemed by the examiner not to be patentable, he shall call the case to the attention of the Commissioner, who may direct the declaration of the interference.

CONSTRUCTIONS.

See notes to Rules 96 and 97.

Disclosure must be shown in original application, and must be such as required for an application by the statute.

Cooper v. Downing, 230 O. G. 909.

In reaching a conclusion as to what one skilled in the art would do we are confined to the application as originally filed. Testimony not admissible.

Cooper v. Downing, 230 O. G. 909.

Apparently to warrant the introduction of a claim of a patent the disclosure in the original application must be that required for the invention of an application.

Cooper v. Downing, 230 O. G. 909-10.

Where it is necessary that an application be amended before a patent can issue, it is desirable that the amendment be made during the interference.

Liebmann et al. v. Newcomb, 229 O. G. 613.

In declaring an interference each count of the issue should be patentably distinct from all the others.

Votey v. Walsh, Jr., v. Duncan, 111 O. G. 1627.

The Examiner states that if broader claims are allowed a

new interference will be necessary, this is a matter relating to the merits. The proposed claims should be entered.

Thurman, 111 O. G. 1625-26.

95 and 96 should be considered together. When so considered it will be noted that 95 relates only to the claims of the issue. There is no rule which prohibits the formal entry and consideration of an amendment after the proceeding has terminated.

Thurman, 111 O. G. 1625-26.

The question whether or not an applicant, whose application is involved in interference, has a right to make the claim put in issue is determined and becomes *res adjudicata* by the declaration of interference so far as the interference proceedings are concerned.

Herman v. Fullman, 109 O. G. 1890.

The declaration of an interference is an allowance of the claims it would seem.

Luger v. Browning, 1902 C. D. 230, 100 O. G. 231.

If claims are not formally allowed it is not such a matter as will be considered on appeal on other grounds.

Luger v. B., 1902 C. D. 230, 100 O. G. 231.

Should be construed together. It is not the policy of the Office to delay the declaration of an interference after one of the interfering applications is ready for issue any longer than is absolutely necessary.

The same reasoning applies where one is a patentee.

It is not fair to a patentee for the Office to permit delays in the declaration for the purpose of first requiring questions to be settled which do not in any way affect the interference issue.

It is otherwise where the claims would form counts of the issue.

Sponi, 97 O. G. 1375.

The claims should be liberally construed in favor of declaring an interference.

Drawbaugh v. Blake, 1883 C. D. 17, 23 O. G. 1221.

There can be but little hesitation in choosing between the natural interpretation which sustains the interference as declared and a forced construction of the same, which, in effect puts two of the parties out of court. Especially where former action of the Office had indicated the first construction.

Locke v. Levalley, 1881 C. D. 26, 20 O. G. 671.

In determining whether two applications conflict, the claims should be construed with reference to the specification.

Greenough v. Drummond, 1879 C. D. 213 and 267, 16 O. G. 586 and 959; Duthie v. Caslear, 1872 C. D. 50.

Confusion caused by a violation of this rule illustrated the Primary Examiner allowed matter alleged to have been improperly introduced in violation of Rule 69 to remain in the specification.

Wm. Carlock, 1875 C. D. 88.

See example of unsettled claim in Farnsworth v. Andrews, 1876 C. D. 3, 9 O. G. 195.

The patent to Clinton and McNamara is not an anticipation of any of the counts for the same reason that the "Hillard's Exhibit No. 2 typewriter equipped with escapement of 1891" is not a reduction to practice of the invention.

Brooks v. Hillard, 1903 C. D. 335, 106 O. G. 1237.

Construction of the Issue.

See also notes to Rules 96 and 97.

A claim should be given the broadest interpretation that it will reasonably support, and limitations will not be read into it to meet exigencies. (Miel v. Young, 29 App. D. C. 481; Getz et al. v. Crozier, 32 App. D. C. 324; Western Electric Co. v. Martin, 39 App. D. C. 147; Leonard v. Horton, 40 App. D. C. 22.) But, where the difference in the inventions clearly appears, the claims should be given a *reasonable* interpretation consistent with the specification in which they originated to the end that the real inventor may be given the award of priority.

Murphy v. Cooper, 228 O. G. 1458.

Evidence considered and held to justify an award of priority to appellee, especially in view of the original attitude of appellant as to the name and function of an important element of his early machine. (Headnote.)

Ruggles v. Ash, 226 O. G. 699.

"Means for causing said nozzles to follow the direction of the tube."

We agree with the tribunals of the Office that such means must be within the blower itself, and does not include a ball and socket joint which permits of the nozzles being guided by resting in the tubes.

Coe v. Brown, 225 O. G. 372-373.

The additional bend forms no part of the loop, especially in appellee's device, and hence to insert it into the claim would not be the mere construing of it, but the reading into the claim of a limitation not called for to save it from destruction.

Clulee v. Aat, 224 O. G. 742.

In an interference proceeding we must give to claims the broadest interpretation which they will reasonably support, and we are not at liberty to import limitations therein to meet the exigencies of a particular situation. (Cases.)

Kirby v. Clements, 216 O. G. 1319.

"Adapted" does not necessarily imply an actual combination with the element to which it refers.

In making his claim the inventor is at liberty to choose his own form of expression, and while the court may construe the same in view of the specifications and the state of the art, they may not add to or detract from the claim. (Quoted from Unhairing Co. v. American Co., 198 U. S. 399) in

Diamond Patent Co. v. Carr Co., 216 O. G. 327.

Seymour's device includes means for cutting the sheets one at a time, etc., and there is a substantial advantage in this process.

In Barber's machine the sheets are cut two at a time and there is no suggestion in his application of a mechanism by which it would be possible to cut sheets one at a time, etc. By no fair interpretation of the language could "a sheet" be construed to cover a group of sheets. Barber had no right to make the claim.

Barber v. Seymour, 215 O. G. 1500.

Where the application of W. & H. discloses two compositions, one containing wax but not benzol and the other benzol but not wax, this application does not disclose the use of both benzol and wax in the same composition.

Wilson & Harris v. Ellis, 211 O. G. 957.

The division of the issue into counts implies that the Patent Office considers there is a patentable difference between the counts (dictum).

Wilson & Harris v. Ellis, 211 O. G. 957.

There is a rule which has been long established and many times confirmed that all limitations appearing in the counts of an interference will in interference proceedings in the Patent Office be regarded as material to the invention covered by said counts.

Wilson & Forrest v. Ellis, 211 O. G. 286.

On the facts as we find them one conclusion of law is that claims 1 to 7, inclusive, are limited by their own terms and by the prior art to high pressure and small volume means, and that claims 8 and 9, unless likewise limited, are void as seeking to monopolize the general result.

Atlas Portland Cement Co. v. Sandusky Portland C. Co., 196 Fed. 398.

This rotary motion of the barrel has no purpose in complainant's pistol except to permit disassembling. The expert for complainant so concedes, and since he further concedes that in defendant's pistol rotation of the barrel plays no part in disassembling, we do not deem it necessary to enter into any discussion of the prior art.

Colts Patent Firearms Mfg. Co. v. New York Sporting Goods Co., 190 F. R. 564.

In order to construe the claim properly recourse must be had to the specification and the prior art. We can not permit speculation and guesswork to guide us as to the character and structure of the elements of the claim. The answers to these questions are made clear by an examination of the specification and drawings and the proceedings in the Patent Office.

Colts Patent Firearms Co. v. New York S. G. Co., 190 F. R. 561.

When the inventor of a particular device chooses to make claims broader than necessary to cover the same, he can not when thrown into interference with another inventor in the same general field, ask that they be limited to correspond with his own particular structure.

Leonard v. Horton, 189 O. G. 781.

The words "Pivoted directly to the lazy tongs" does not necessarily involve a point in common and is answered by a construction which comes substantially within it though not literally.

Leonard v. Pardee, 188 O. G. 516, 559 (186 O. G. 559.)

The issue may be construed in light of the previous art.

Richards v. Benniss, 187 O. G. 514.

The addition of a new party is no excuse for not having comprehended the breadth of the issue.

Onderdonk v. Routke v. Moffat, 183 O. G. 507.

The holding which is in substance that the disclosure as it stands is insufficient to support the claims, but that it may be amended in such a way that it will support them, is clearly inconsistent on its face.

Seacombe v. Burks, 182 O. G. 973.

We have been cited to nothing in the prior art which limits this expression to the specific construction shown in the application since the prior patents all disclose no more than means for drawing from a shallow pan.

Rolin v. Slinghoff, 182 O. G. 975.

To read the issue, therefore, on to appellee's device where the question of patentability is exceedingly close, would be to

give him something strongly anticipated by the prior art; while confining it to appellant's invention we have an easy application of the issue to a device distinctly novel, where the resetting operation is clearly confined to the breakdown connection.

Rice v. Schutte, 180 O. G. 605.

The issues should be construed as broadly as possible, without giving a strained or unnatural meaning.

Emerson v. Sanders, 174 O. G. 831.

The question of the scope of the issue is, however, not one upon which testimony should be permitted. The question is one to be determined by the tribunals of the Office under the well settled practice of giving claims in issue the broadest construction which they will support. Von Keller v. Hayden v. Kruh will support Jackson, 173 O. G. 285.

Von Keller v. Hayden v. Kruh v. Jackson, 173 O. G. 285.

The decisions of the Court of Appeals of the District of Columbia in the case of Blackford v. Wilder, 127 O. G. 1255, and Horines v. Wend, 129 O. G. 2858, in which the court discountenances second interferences, emphasize the importance of a clear and definite issue.

Walker & Walker v. Gichrist, 164 O. G. 507.

We, however, think that patents are grants made in consideration of discoveries which promote the progress of science and the useful arts, and that they are to be construed liberally so as to effect their real intent.

Bossert Electric Const. Co. v. Prott Chuck Co., 159 O. G. 747.

A limitation in a claim that is without function ought not to be used to deprive an inventor of his rights.

Arbettor v. Lewis, 154 O. G. 516, 519.

"Independent circuits" construed in a previous case on a different device.

Weintraub v. Hewett, 148 O. G. 1087.

Apparently a limitation was disregarded as being non-functional, but this limitation was what distinguished it from the art. Overruled.

Sinclair v. Engel, 147 O. G. 769.

A limitation of the issue not required by the prior art refused in order to avoid opponent's date of reduction to practice.

Gutz & Hosack v. Crozier, 140 O. G. 757.

The party who first presents claims should not later be heard to urge limitations upon terms thereof which might

readily have been expressed therein had it been intended that they should be so restricted. (Cases.)

Junge v. Harrington, 131 O. G. 691.

In the case of patents for improvements, it is necessary to consider the state of the art.

Oehrle v. W. H. Horstmann Co., 131 F. R. 490.

The function is not inherent in the mechanism shown for the reason that it does not flow from the mechanism as shown and described, but from that mechanism minus one of its parts.

Scott v. Southgate, 125 O. G. 1703.

A metal bar with corrugated sides, the relative position of the corrugations on the respective sides being accidental, is not evidence of the conception of the invention set forth in a claim for a metal bar provided with interceptions in the surface and having substantially the same cross-sectional area throughout its length.

Johnson v. Mueser, 124 O. G. 2533.

Good case.

Manley v. Williams, 1911 C. D. 397.

Podlesak v. Podlesak, 123 O. G. 1989.

Would not construe the qualification in the issue, that the tongue was of nonmagnetic material.

Andrews v. Wilson, 123 O. G. 1667.

Where claims are copied from a patent they are to be construed in light of such patent.

Bourn v. Hill, Jr., 123 O. G. 1284.

Meanings should not be construed into claims, nor should the claims be limited by construction.

Cutler, 123 O. G. 655.

Words given a broad meaning so as to include both devices.

Limp v. Randall & Bates, 123 O. G. 319.

Where the terms are broad enough to cover both structures it matters not that there are specific differences in function.

Gordon v. Wentworth, 120 O. G. 1165; Heintzelman v. Vroalstad, 120 O. G. 906; see Goss v. Scott, 96 O. G. 842.

Limitations read into a claim by the moving party is not ground for dissolution.

Votey v. Gally, 119 O. G. 339.

Claims pending in the Office should not be narrowed by reading limitations into them to avoid the prior art. Practice condemned.

Briggs v. Lillie v. Cooke, 116 O. G. 871.

Rule 96. Failure to Prepare for Interference.

Whenever the claims of two or more applications differ in phraseology, but relate to substantially the same patentable subject matter, the examiner, when one of the applications is ready for allowance, shall suggest to the parties such claims as are necessary to cover the common invention in substantially the same language. The examiner shall send copies of the letter suggesting claims to the applicant and to the assignees, as well as to the attorney of record in each case. The parties to whom the claims are suggested will be required to make those claims and put the applications in condition for allowance within a specified time in order that an interference may be declared. Upon the failure of any applicant to make the claim suggested within the time specified, such failure or refusal shall be taken without further action as a disclaimer of the invention covered by the claim, and the issue of the patent to the applicant whose application is in condition for allowance will not be delayed unless the time for making the claim and putting the application in condition for allowance be extended upon a proper showing. If a party make the claim without putting his application in condition for allowance, the declaration of the interference will not be delayed, but after judgment of priority the application of that party will be held for revision and restriction, subject to interference with other applications.

Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney, the examiner shall notify each of said principal parties and also the attorney of this fact.

HISTORY.

A part of Rule 51 of 1878 reads as follows: "Where a party who is required to put his case in proper shape for the purposes of an interference delays doing so beyond a reasonable time specified, the interference will at once proceed. After final judgment of priority the application of such party will be held for revision and restriction, subject to interferences with other applications or new references."

Only verbal changes were made in 1879.

The present form of the rule had its origin in the case of Hammond v. Hart, decided April 25, 1898. (1898 C. D. 52.)

See Rule 94 of 1879 as to suggestion of claims.

In Wolfenden v. Price, 1898 C. D. 87, Commissioner Duell said: "In deciding the case of Hammond v. Hart it was my intention to bring about a practice in the Office that would result in making the issue of an interference both definite and clear, and to that end to cause the parties to the proposed interference to claim substantially the same patentable invention so as to obviate the many motions and appeals that have unnecessarily arisen in the Office."

The correctness of this decision has been called in question in a pamphlet by Mr. J. H. Whitaker published by the Patent Law Association of Washington, D. C.

The edition of the Rules of July 18, 1899, reads: "Whenever two or more applications disclose the same invention, and one of said applications is ready for allowance and contains a claim to said invention, the Primary Examiner will notify the other applicant of such fact, furnish him with a copy of the patentable claim, and require him to make such claim and put his case in condition for allowance within a specified time, so that an interference can be declared. Upon the failure of any applicant to make the claim suggested within the time specified, such failure or refusal shall be taken without further action as a disclaimer of the invention covered by the claim, and the issue of the patent to the applicant whose application is in condition for allowance will not be delayed unless the time for making the claim and putting the application in condition for allowance be extended upon a proper showing. If a party make the claim without putting his application in condition for allowance, the declaration of the interference will not be delayed, but after judgment of priority the application of such party will be held for revision and restriction, subject to interference with other applications.

See notes to Rules 95 and 97.

CONSTRUCTIONS.

(1) PURPOSE AND MEANING OF RULE.
(2) WHEN SUGGESTION PROPER.
(3) CONSTRUCTION AND EFFECT OF CLAIMS.
(4) NEGLECT AND REFUSAL TO MAKE CLAIM—TIME LIMIT.
(5) ADDITIONAL CASES.

(1) *Purpose and Meaning of Rule.*

An action under this rule establishes a date, from which the one year limited for action by the applicant runs.

Coulson v. Callendar, etc., 1902 C. D. 395, 101 O. G. 1607.

Rule 109 contemplates the possibility of the allowance by the Examiner upon argument of claims which were for some reason not suggested under Rule 96.

Davis v. Ocumpaugh v. Garrett, 103 O. G. 1679.

The procedure of this rule is applicable where it is proposed to place an application into interference with a patent.

Card & Card, 112 O. G. 499.

The requirement as to the form of a claim is not for the purpose of bringing about a conflict, but to define the conflicting subject matter in the same words, so as to avoid confusion and to prevent disputes.

Card & Card, 112 O. G. 499-500.

Claims taken from a patent were refused entry because involving new matter.

Dilg, 112 O. G. 953.

The purpose of Rule 96 is to bring about uniformity in the wording of the claims. The practice is a good one. No reason appearing why the claims of R. and B. should not be brought to correspond in phraseology, the interference should have been dissolved on the ground of irregularity in the declaration.

Reichert v. Brown, 124 O. G. 2903.

I am of the opinion that the adoption of suggested claims and the prosecution of an interference can not be construed as an election of the species involved in the absence of other acts or statements on the part of the applicant binding him to such species.

Burk, 184 O. G. 2089.

An application abandoned and renewed, meanwhile a patent issued to another applicant. The first applicant inserted

claims from the patent, held that this was not contrary to the principles laid down in Beehman v. Wood, 89 O. G. 2459.

Jansson v. Sarsson, 132 O. G. 477.

Cases passing on the subject matter of this rule.

Harnisch v. Gueniffit, Benert and Nicault, 128 O. G. 455;

Martin v. Mullin, 127 O. G. 3216.

(2) *When Suggestion Proper.*

Three applications showing apparatus for performing a process only one of which claimed the process. In the latter division was required. The process claimed should not be suggested to the other applicants as they were not trying to claim it (Myers v. Brown, 139 O. G. 197), but if an apparatus claim covering the three applications can be found it should be suggested.

Wirner, 139 O. G. 197.

A second species may be suggested to an applicant, and incorporated into his application, for the purpose of an interference, but may afterward be required to be canceled.

Priebe, 221 O. G. 351.

An examination of the record of the patent makes it clear that the invention of this issue was not disclosed in the original specification and drawings. This omission, coupled with the fact that he failed to disclose the same until it was admittedly disclosed to him, is almost sufficient of itself to warrant the conclusion that McKnight never independently invented the invention of the issue.

McKnight v. Pohle & Croasdale, 105 O. G. 495.

The question as to the right of Brown to make the claims is one relating to the merits of the case and depends upon the disclosure made by B in his application. The Examiner has held that the disclosure in the Brown application is sufficient to support the claims corresponding to the issue, and from this affirmative decision there is no appeal. (Rule 124.)

Myers v. Brown, 112 O. G. 2093-4.

Where motion for dissolution is based upon the contention that the suggestion of the claim in interference to a party by the Examiner was improper because said party had not claimed substantially the same invention. Held that the question raised involves no such irregularity in declaring the interference as might preclude proper determination of the question of priority of invention, and that no ground for dissolving the interference is presented.

Meden v. Curtis, 117 O. G. 1795.

An interference was decided on the record. In view of the fact that the new claims were made by the successful party,

that they differ from the issue in other respects than in scope, and that the defeated party already has an allowable claim relating to the same subject matter, it is held that the Examiner may properly suggest the new claims to the party under Rule 96.

Cramer & Hoak, 118 O. G. 1068.

Where an applicant appealed from the refusal of an Examiner to inform him of the subject matter of the issue in a proposed interference in order that he might amend so as to include the issue in his claims. Held that it is not the practice of the Office to suggest claims to an applicant in order to create possible interferences.

Weeden, 1892 C. D. 185.

Where a party shows a certain structure and claims it broadly, and his claims are all rejected, and another party claims the same structure more narrowly and such claims are allowed and suggested to the other party. Held no error in so suggesting such claims, as both parties were attempting to claim the same invention within the meaning of Rule 96.

Templin v. Sergent, 119 O. G. 961.

Claims should be suggested only when parties are attempting to claim the same thing.

Myers v. Brown, 112 O. G. 2093; Templin v. Sergent, 119 O. G. 961; Bryant, Wolcott & Davidson, 121 O. G. 2663.

In the case at bar, however, the tension controller of the Quest and Hogan application was specifically different from the tension controller of the Ostrom application. The practice announced in Hammond v. Hart, therefore, would not have warranted the Examiner in suggesting the Quest and Hogan claims to Ostrom.

Quest v. Ostrom, 106 O. G. 1502; see also Townsend v. Thullen, 142 O. G. 1116.

The Examiner ignoring the plain dissimilitude between T's claim one, allowed by his superiors over his rejection only on the narrow construction, and the mufflers Mead is talking about in his application, invited the latter as above stated to adopt it, and thus gave it a breadth of application for which neither its originators ever contended, nor the Examiners-in-Chief granted.

Phoenix Knitting Co. v. Rich, 194 Fed. 725.

The claims were suggested to appellant under the provisions of Rule 96. When appellant accepted the claims and included them in his application, he laid claim to the possession of the invention which they define.

If now the appellant wishes to withdraw the claim to the

possession of the invention disclosed in the issue, he may properly do so by conceding priority or abandoning the invention.

Miller v. Perhams, 127 O. G. 2667.

(3) Construction and Effect of Claims.

See notes to Rules 95 and 97.

Where there are two applications each making a specific claim and no generic claim to an invention that might be included in one generic claim, in the absence of any means of avoiding the possible question as to equivalents, the Examiner will suggest a generic claim to the applicants.

Thompson, 1902 C. D. 6, 98 O. G. 227.

The question whether those claims can be made by Costello and are suggested to him under Rule 96, can not be considered as affecting Hicks' rights unless and until Costello makes them.

Hicks v. Costello, 103 O. G. 1164.

The question of identity of invention is in general one which should be settled by the experts of the Office.

Luger v. Browning, 104 O. G. 1123.

The Hammond v. Hart decision, 83 O. G. 743, (1898 C. D. 52) did not make it mandatory on Examiners to suggest claims, but merely stated that under certain conditions, no good reason appearing for not doing so; the only condition expressly referred to was where two applicants disclosed the same specific structure and one of the applicants had specific claim to the structure and the other a generic claim thereto.

Quest v. Ostrom, 106 O. G. 1501.

There seems to be no reason why the Examiner should enter into a discussion or argument with these applicants as to the patentability of suggested claims.

Sutton & Steele, 107 O. G. 541.

The claims were suggested to appellant under the provisions of Rule 96. When appellant accepted the claims and included them in his application, he laid claim to the possession of the invention which they define.

If now the appellant wishes to withdraw the claim to the possession of the invention disclosed in the issue, he may properly do so by conceding priority or abandoning the invention.

Miller v. Perham, 123 O. G. 2667.

Where claims are copied from a patent they are to be construed in light of such patent.

Bourn v. Hill, Jr., 123 O. G. 1284; Townsend v. Thullen, 142 O. G. 1116.

Each of the two applicants for patent has made a claim in identical language. The claim reads without violence to the proper natural meaning of its terms upon the devices disclosed by each party; but the patentable invention which this claim is supposed to represent is found only in the device of one of the parties; clearly under these circumstances the claim fails to define the invention.

Podlesak & Podlesak v. McInnerney, 123 O. G. 1989.

(4) Neglect and Refusal to Make Claim—Time Limit.

A time limit should be set where claims are rejected on a prior patent on the ground that the applicant can make certain thereof and can establish his right to a patent only by an interference.

Card and Card, 112 O. G. 499; Weber and Woodford, 264 O. G. 863.

Rule 96 provides that upon a proper showing the time for making the suggested claims may be extended. It is within the discretion of the Examiner to grant such extension if in his opinion the showing warrants it.

Curtis, 97 O. G. 189.

If applicant is prosecuting his own case, and has gone abroad, time to communicate with him should be allowed.

Hellmund, 141 O. G. 555.

See example of unsettled claim.

Farnsworth v. Andrews, 1876 C. D. 3, 9 O. G. 195.

Where a party unreasonably delays to put his application in such form that an interference may be declared, a patent will be issued to his opponent.

Lombard, 1888 C. D. 56, 43 O. G. 1347.

Claim proposed by Examiner but not accepted for ten years and until after an interference on broader claim.

Gray, 1889 C. D. 91, 46 O. G. 1277.

The Office and not the applicant is the judge of the reasonableness of the time.

Lombard, 1888 C. D. 56, 43 O. G. 1347.

The time at which the request is made, whether the request and accompanying showing be within the time limited or not, may affect the character of the showing, but it does not affect the jurisdiction of the Examiner.

Curtis, 1901 C. D. 147, 97 O. G. 189.

In this case there is an allowable claim under consideration,

and a party who can make it and will not do so within a specified time.

Furman v. Dean, 111 O. G. 1366-68.

Where applicant seeks to enter the suggested claim after the expiration of the time limited, the claim should be entered and then rejected.

Swift, 111 O. G. 2494.

Where an amendment is filed under the provisions of Rule 96, after the limit of time specified by the Examiner has expired and the Examiner rejects the claims in accordance with the rule, the rejection relates to the merits and is not reviewable by the Commissioner upon petition, but should be considered on appeal in the first instance by the Examiners-in-Chief.

Haug, 97 O. G. 192.

Applicant refused to put his claims in proper shape insisting upon his right to amend any time within one year. Held that the Examiner should suggest claims to both parties, and proceed with the interference leaving any question of estoppel for future consideration. If applicant refuses to make claims suggested he should be held to have abandoned their subject matter.

Ferris, 114 O. G. 541.

Where an applicant is a resident of a foreign country, the Examiner should grant the attorney's petition for a sufficient extension of time to consult his client.

Schulze, 114 O. G. 1550.

Rule 96 contemplates that the issue shall be in the terms of the claims actually made by both parties, or at least that both parties should have had an opportunity to make such claims. If neither party has made a claim which can be made by the other party by reason of the inclusion of elements which are not of the essence of the invention, then as pointed out in *ex parte Thompson* (98 O. G. 227), the Examiner should suggest a claim to each which will cover the real invention common to the two cases, omitting such limitation.

McBride v. Kroder, 133 O. G. 1680.

(5) *Additional Cases.*

Cases that pass on the subject matter of this rule:

Klepetko, 126 O. G. 387; Harvey, 102 O. G. 621-22; Holland, 1902 C. D. 199, 99 O. G. 2548; Haug, 1901 C. D. 153, 97 O. G. 192; Tizley, 89 O. G. 2259; Hildreth, 1899 C. D. 248, 1901 C. D. 186, 97 O. G. 1374;

Van Auken v. Osborne v. Harrison v. Canfield & Van Auken, 119 O. G. 1584; Egly v. Schulze, 117 O. G. 2366; Blackwood v. Wilder, 124 O. G. 319; Anderson v. Vrooman, 123 O. G. 2975; Weidemann, 1897 C. D. 194, 87 O. G. 2245.

Rule 97. Examiner Preparing Interference Notices, etc.

When an interference is found to exist and the applications are prepared therefor, the primary examiner shall forward to the examiner of interferences the files and drawings; notices of interference for all the parties (as specified in Rule 103) disclosing the name and residence of each party and those of his attorney, and of any assignee, and, if any party be a patentee, the date and number of the patent; the ordinals of the conflicting claims and the title of the invention claimed; and the issue, which shall be clearly and concisely defined in so many counts or branches as may be necessary in order to include all interfering claims. Where the issue is stated in more than one count the respective claims involved in each count shall be specified. The primary examiner shall also forward to the examiner of interferences for his use a statement disclosing the applications involved in interference, fully identified, arranged in the inverse chronological order of the filing of the completed applications, and also disclosing the issue or issues and the ordinals of the conflicting claims, the name and residence of any assignee, and the names and residences of all attorneys, both principal and associate.

HISTORY.

Previous to the Revision of December, 1879, the Primary Examiner was required to notify the parties, and in the Rules of 1878 he was required to "briefly and concisely define the interfering subject matter."

See Rule 97 of 1879.
See notes to Rules 95 and 96.

CONSTRUCTIONS.

Issue and Notices.

If the Examiner of Trade-Marks finds it necessary to include two applications he should take care to specifically inform the other party of that fact.

Hoeker v. Farr, 193 O. G. 220.

A case that passes on the subject matter of this rule.

Hick, 172 O. G. 261.

"Means" followed by a statement of function is properly readable on a structure in which such means consists of more than one element.

Lacroix v. Tyberg, 148 O. G. 831.

A claim should be given the broadest interpretation its terms will permit.

Milans, 135 O. G. 1122; Pratt v. De Ferrantiand Hamilton, 148 O. G. 569.

Nevertheless it can not be enlarged beyond the plain import thereof as set forth in the specification on which the claim is based.

Sinclair v. Engel, 147 O. G. 769.

It is well settled that where a party copies the claim of a patent for the purpose of interference such claim must be read in the light of the disclosure of the patent. (Cherney v. Clause, 116 O. G. 597; Bowen v. Hill, 123 O. G. 1284; Sobey v. Holsclaw, 126 O. G. 304.)

Sinclair v. Engel, 147 O. G. 769.

When an interference is declared between an applicant and a patentee and the Examiner is of the opinion that the applicant has presented claims which do not differ, materially from the issue of the interference he should append to the declaration of the interference a statement that such claims, specifying them by number, will be held subject to the decision in the interference. If in his opinion there are no such claims he should append to the declaration a statement to that effect. The Primary Examiner directed to proceed in conformity to this practice.

Earll v. Love, 140 O. G. 1209.

Where the only claims are too broad in view of the state of the art.

Kafer & Gould v. Dennison, 1869 C. D. 14.

The devices in interference should so resemble each other

that a patentable form of claim could be framed which should include both devices.

Sargent v. Burge, 11 O. G. 1055.

The parties have no right to be heard as to what shall and what shall not be included in the interference.

White v. Demarest, 41 O. G. 1161.

The practice of appropriating literally the claim of a later inventor, which is drawn with reference to the employment of terms found in the preceding specification, and then applying the claims so appropriated to a specification of older date which does not contain words and expressions suitable to lead up to the language of the appropriated claim, condemned.

Rogers v. Winssinger, 1891 C. D. 111.

The test of an interference resides in the claims and not in mere disclosures in the application, and Office rules must be construed in connection with this settled principle of law.

Van Depoele v. Daft, 1892 C. D. 15; Searle v. Frumveller v. Sessions, 1892 C. D. 27; Dodd v. Reading, 1892 C. D. 49.

It is improper in declaring an interference, to include a broad claim in a narrow issue. The issue should be as broad as the broadest claim involved therein.

Short v. Sprague, 1891 C. D. 166.

The question whether an interference in fact exists depends not merely upon the language employed in the respective claims, but upon the question whether in addition to similarity in phraseology there is an interference between the subject matter of the respective claims.

Rogers v. Winssinger, 1891 C. D. 111.

It is a cardinal principle that in declaring an interference the issue must be as broad as the broadest claim included therein.

Morgan v. Hanson, 77 O. G. 154.

The correct solution of the question depends upon whether the two things disclosed by the respective parties have been clearly claimed and with the same limitations.

Essex v. Wood, 89 O. G. 353.

While it is unfortunate that there should be differences of opinion as to the meaning of the issue, such differences alone do not justify a dissolution of the interference.

Annand v. Spalckhaver, 97 O. G. 2083.

In an interference between a patent and an application, the issue is to be defined by reference to the patent.

Feder v. Poyet, 89 O. G. 1343-4.

Rule 97 contains nothing to authorize the disclosure of a

caveat which may have been referred to during the *ex parte* consideration of a case.

In re Lowry, 90 O. G. 445; Holland, 99 O. G. 2548.

The requirement of Rule 97 that "the invention claimed" be disclosed, means that the invention claimed should be disclosed by title.

Hoffstetter v. Kahn, 99 O. G. 1624.

The Office must define the issue and the testimony must be confined to this issue.

Brill & Adams v. Uebelacker, 99 O. G. 2966.

The Primary Examiner should arrange the parties in the inverse chronological order in which they filed their applications directly involved in the interference. He should call attention to any earlier application and leave the question of its effect for the determination of the Examiner of Interferences.

Raulet & Nicholson v. Adams, 114 O. G. 1827.

Without further delay of which there has been too much in this proceeding.

Normand v. Krimmelbein, 115 O. G. 249.

Though the applicant is the original inventor of the rotating baking surface he has presented no convincing evidence tending to prove originality of the combination claims, and priority upon these claims is awarded to the patentee.

Cherney v. Clauss, 115 O. G. 2137.

Remedy for failure to comply with this rule is by motion under Rule 122.

Cazin v. Von Welsbach, 119 O. G. 650.

Clerical error may be corrected by a letter from the Primary Examiner.

Gully v. Burton, 120 O. G. 325.

The terms of a claim should be given broadest construction.

Podlesak & Podlesak v. McInnerney, 120 O. G. 2127.

When a claim is taken from a patent to form an issue, that issue must be construed in reference to the specification of the patent.

Andrews v. Nilson, 123 O. G. 1667.

The senior party who has a patent may not be heard to ask that his claim be rewritten so that he may prevail in an interference.

Andrews v. Nelson, 123 O. G. 1667.

I am of the opinion that these terms are too vague and indefinite to point out with certainty any particular structure in either device, and that the interference should be dissolved as to this count on the ground of irregularity in declaration.

Anderson v. Vrooman, 123 O. G. 2975.

New references discovered "The Primary Examiner is directed to withdraw the notice of hearing which has been sent out and to determine whether the interference should continue without the aid of argument by either party."

Behrend v. Lamme v. Tingley, 124 O. G. 2536.

Care should be exercised in forming the issue that the terms used by the parties have a clear, definite, and common meaning in each application.

Anderson v. Vrooman, 123 O. G. 2975.

Less than half this number of counts should have sufficed.

Kempshall v. Royce, 129 O. G. 3162.

It is to the interest of the interfering parties, the public and the Office that the counts of the interference should properly cover the patentable invention which is common to the applications involved and that second interferences should be avoided.

Becker v. Otis, 129 O. G. 1267.

The Office is no more competent than the courts to say that an element which an applicant has put into his claim is an immaterial one.

Streat v. Freckleton, 87 O. G. 695; Collom v. Thurman, 131 O. G. 359.

In general while applications are pending in the Office the claims thereof will be construed as broadly as the ordinary meaning of the language will permit, for reasons stated in my decisions in Cuter, 123 O. G. 655.

Briggs v. Cooke v. Jones & Taylor, 116 O. G. 871; Podlesak & Podlesak v. McInnerney, 123 O. G. 1989; Lovejoy v. Cady, 123 O. G. 654; Junge v. Harrington, 131 O. G. 691; Jenne v. Brown v. Booth, 1892 C. D. 78.

See also notes under "Construction of the Issue," Rule 95.

Rule 98. Revision of Notices by Examiner of Interferences.

Upon receipt of the notices of interference, the examiner of interferences shall make an examination thereof, in order to ascertain whether the issues between the parties have been clearly defined, and whether they are otherwise correct. If he be of the opinion that the notices are ambiguous or are defective in any material point, he shall transmit his ob-

jections to the primary examiner, who shall promptly notify the examiner of interferences of his decision to amend or not to amend them.

CONSTRUCTIONS.

The Examiner properly objected to the declaration of an interference on the ground that the invention involved was met by the reference of record.

Lloyd v. Engeman, 1872 C. D. 253.

A case that passes on the subject matter of this rule.

Hoffstetter v. Kahn, 1902 C. D. 180, 99 O. G. 1624.

Rule 99. Reference to Commissioner.

In case of a material disagreement between the examiner of interferences and the primary examiner, the points of difference shall be referred to the Commissioner for decision.

CONSTRUCTIONS.

See Dixon v. Bliss, 185 O. G. 1381.

For example where the interference subject matter is not briefly and concisely stated and claims involved are not stated, this was an error of the Primary Examiner.

Stephen v. Bailey, 1878 C. D. 7, 13 O. G. 45.

Case referred to the Commissioner where there was a disagreement between the Examiner of interferences and the principal Examiner as to whether the claim was met by reference of record.

Lloyd v. Engeman, 1872 C. D. 253.

Cases that pass on the subject matter of this rule:

Smith v. Bunnel, 103 O. G. 890; Mills v. Torrance, 106 O. G. 544; Hoffstetter v. Kahn, 1902 C. D. 180, 99 O. G. 1624; Hildreth, 1901 C. D. 186, 97 O. G. 1374.

Rule 100. Primary Examiner Retains Jurisdiction.

The primary examiner will retain jurisdiction of the case until the declaration of interference is made.

See notes to Rules 101-123.

Rule 101. Jurisdiction of Examiner of Interferences.

Upon the institution and declaration of the inter-

ference, as provided in Rule 102, the examiner of interferences will take jurisdiction of the same, which will then become a contested case; but the law examiner will determine the motions mentioned in Rule 122, as therein provided.

See notes to Rule 123.

CONSTRUCTIONS.

The reference of motions to dissolve to the Law Examiner in the last revision, has made a part of the following notes of only historical interest.

For the reasons stated in my decision in Clements v. Richards v. Meissner, 111 O. G. 1627, it is competent for the Commissioner to entertain a motion to restore jurisdiction to the Examiner of Interferences, to hear and determine a motion to reopen while the case is pending before any of the appellate tribunals of this Office.

Clausen v. Dunbar v. Schellinger, 129 O. G. 499.

Jurisdiction of Examiner of Interferences.

Lowry and Cowley v. Spoor, 122 O. G. 2687.

Jurisdiction restored to the Examiner of Interferences after time limited for appeal had expired.

The party should have a hearing upon the question whether the showing made by him is sufficient to warrant the reopening of the case.

Lipscomb v. Pfieffer, 122 O. G. 351.

Motions to shift the burden of proof should be made before the Examiner of Interferences within the twenty days after the approval of the preliminary statements allowed for motions.

Changing jurisdiction from Primary Examiner to Examiner of Interferences.

Raulet & Nicholson v. Adams, 114 O. G. 1827.

The only apparent questions for consideration on a motion to restore jurisdiction to the Examiner of Interferences, are whether the motion is in proper form and whether so far as can be seen without going into the merits of that motion, it is brought in good faith.

Newell v. Clifford v. Rose, 122 O. G. 730.

Examiner of Interference refused to consider a motion to extend time for appeal, made on the last day of the time

limit and set for hearing two days after for want of jurisdiction, jurisdiction restored on motion.

Jean and Goode v. Hitchcock, 1902 C. D. 342, 100 O. G. 3011-12.

The restoration of jurisdiction for one purpose does not restore it for all.

Benger v. Burson, 1902 C. D. 164, 99 O. G. 1384.

Motion to reopen for the purpose of taking more testimony comes properly before the Examiner of Interferences.

McCallum v. Bremer, 1900 C. D. 186, 93 O. G. 1918.

The Examiner of Interferences has jurisdiction to hear and determine the fact of joint or sole invention in an interference between joint patentees and a sole applicant who is one of said patentees.

Lovrien v. Banister, 1880 C. D. 152, 18 O. G. 299; Ex parte Bruker, M. S.

If it is decided that there was no joint invention the sole applicant would be the prior inventor, as the entity the joint inventors never invented it at all.

Kohler v. Kohler & Chambers, 1888 C. D. 19, 43 O. G. 247; see Harrison v. Hogan, 1880 C. D. 191, 18 O. G. 921.

Upon a proper showing the jurisdiction of the Examiner of Interferences will be restored for the purpose of considering a motion to dissolve.

Short v. Sprague, 1891 C. D. 166.

Judgment of priority given by the Commissioner and the case remanded to the Primary Examiner to determine the question of a statutory bar by reason of public use.

Smith v. Dimond, 1881 C. D. 34, 20 O. G. 742.

A motion to dissolve an interference declared in violation of Rule 127 should be determined by the Examiner of Interferences.

Edison & Gilliland v. Phelps, 38 O. G. 539; see notes to Rule 142, 1887 C. D. 11.

Questions of statutory bar of public use referred to the Primary Examiner by the Commissioner without an appeal from the decision of the Examiner of Interferences.

Quimby v. Randall, 1878 C. D. 111, 14 O. G. 748.

Facts establishing two years' public use before application for a patent developed in an interference can not afterwards be explained away by ex parte affidavits. Case remanded to the Primary Examiner to consider such question.

Stearns v. Prescott, 1878 C. D. 24, 13 O. G. 121.

The question of two years' public use as a statutory bar receives consideration from the Examiner of Interferences. He overlooks in this connection, the question of sale. This appears to be a very important point. This case was remanded by the Acting Commissioner to the Primary Examiner to consider the question of sale more than two years before application.

Keller & Olmesdahl v. Felder, 1876 C. D. 246, 10 O. G. 944.

The law of 1836 provided that in connection with interference proceedings, like proceedings should be had to determine which or whether either of the applicants is entitled to receive a patent as prayed for. But in the Act of 1870 this provision was omitted.

Smith v. Perry, 1876 C. D. 12, 9 O. G. 688.

Questions of patentable combinations remanded to the Primary Examiner for consideration.

Lynch & Raff v. Dryden & Underwood, 1873 C. D. 73.

If in the judgment of the Examiner of Interferences neither party is entitled to a patent for want of novelty, he must send the question back to the Primary Examiner for determination. He can not decide it himself.

Neuboeker v. Schafhaus, 1873 C. D. 138.

Cases that pass on the subject matter of this rule:

Kugele v. Blair, 125 O. G. 1350; Behrend v. Lamme v. Tingley, 124 O. G. 2536.

Rule 102. Institution and Declaration of Interference.

When the notices of interference are in proper form, the examiner of interferences shall add thereto a designation of the time within which the preliminary statements required by Rule 110 must be filed, and shall, *pro forma*, institute and declare the interference by forwarding the notices to the several parties to the proceeding.

Rev. Stat., sec. 4904.

CONSTRUCTIONS.

Contains nothing to authorize the disclosure of a caveat that may have been referred to during the ex parte consideration of a case.

Lowry, 1900 C. D. 1, 90 O. G. 445.

Practice relative to trade-marks.
Frank & Gutmann v. MacWilliam, 114 O. G. 542.
Practice in case of a deceased inventor, heirs unknown.
Handley v. Bradley, 1899 C. D. 201, 89 O. G. 524.
Notice should be sent to the assignee of one of the inventors.
Aldrich & Spalding v. Bingham, 1871 C. D. 90.
Cases that pass on the subject matter of this rule.
Davis v. Garrett, 123 O. G. 1991; Kugele v. Blair, 127 O. G. 1253.

Rule 103. Notices to Parties.

The notices of interference shall be forwarded by the examiner of interferences to all the parties, in care of their attorneys, if they have attorneys, and, if the application or patent in interference has been assigned, to the assignees. When one of the parties has received a patent, a notice shall be sent to the patentee and to his attorney of record.

When the notices sent in the interest of a patent are returned to the office undelivered, or when one of the parties resides abroad and his agent in the United States is unknown, additional notice may be given by publication in the Official Gazette for such period of time as the Commissioner may direct.

CONSTRUCTIONS.

Replying to your letter of the 25th ultimo, you are advised that where a series of interferences are declared the issues of which are more or less closely related, each interference is provided with an identifying letter signifying that particular case is one of a series. It ordinarily has no significance to the parties and is used only for convenience in keeping the cases together.

Respectfully,
W. F. Woodlard, Chief Clerk.

Case that passes on the subject matter of this rule:
Commercial Mica Co., 129 O. G. 479; Hick, 172 O. G. 261.

Rule 104. Motion for Postponement of Time for Filing.

If either party require a postponement of the time for filing his preliminary statement, he shall present his motion, duly served on the other parties, with his reasons therefor, supported by affidavit, and such motion should be made, if possible, prior to the day previously set. But the examiner of interferences may, in his discretion, extend the time on *ex parte* request or upon his own motion.

CONSTRUCTIONS.

Court of Appeals will not review in ordinary cases.

Churchill v. Goodwin, 141 O. G. 568.

Facts considered sufficient to excuse the failure to file within the time limited.

Charlton v. Sheldon, 111 O. G. 2492.

The fact that applicant supposed notice to relate to one case when it in fact related to another is not a good excuse.

Hartley v. Mills, 110 O. G. 2236.

It is a matter of discretion with the Examiner whether time shall be extended.

Quick v. McGee, 107 O. G. 1376.

The question of primary importance is not whether they were able to file their statements within the time fixed, but why they did not make a showing of the facts and ask relief at the proper time.

Fowler v. Temple et al. v. Dyson v. McBerty, 107 O. G. 543.

A motion to extend time for filing preliminary statement must be for a definite time. Affidavit supporting it must be specific.

Keech v. Birmingham, 1902 C. D. 473, 101 O. G. 2825.

The declaration of interference and setting of time for filing of preliminary statements is constructive notice that testimony will be taken in a reasonable time.

Davis v. Cody, 1902 C. D. 388, 101 O. G. 1369.

Time for filing postponed by stipulation of counsel.

Jones v. Greenleaf, 1879 C. D. 23, 15 O. G. 560.

The attorney for the patentee refused to file their preliminary statement till they should find out as much of their

opponent's invention (an applicant) as he had means of knowing of theirs. An extension of time was refused.

Spalding & Aldrich v. Winchester, 1871 C. D. 94.

A case that passes on the subject matter of this rule.

110 O. G. 604.

Rule 105. Certified Copies Used in Interference Proceedings.

When an application is involved in an interference in which a part only of the invention is included in the issue, the applicant may file certified copies of the part or parts of the specification, claims, and drawings which cover the interfering matter, and such copies may be used in the proceeding in place of the original application.

HISTORY.

Rule 105 was introduced in 1888.

CONSTRUCTIONS.

Whether or not the copy filed is sufficient to enable one to understand the mode of operation of the device, is a matter which should be considered in the first instance by the Primary Examiner who will fix a day upon which the parties may be heard.

Kugele v. Blair, 125 O. G. 1350.

In a motion for dissolution based upon the certified copy, it was assumed that such copy contained everything pertinent.

Fagan v. Graybill, 121 O. G. 1013.

Where a rejected claim is included in a certified copy, all actions relative thereto should be included in the copy.

Fagan v. Graybill, 121 O. G. 1013.

Where a party files a copy of portions of his application for use in interference proceedings, the question of sufficiency of the copy is a matter to be determined by the Primary Examiner in the first instance. A day should be fixed upon which the parties may be heard.

Riker v. Saw, 120 O. G. 2754.

If the petitioners think that the disclosure made by the certified copies of the parts of the earlier case, filed by Canfield, is incomplete or insufficient as to the subject matter involved in this interference, they should bring the matter

before the Primary Examiner who will determine the question in the first instance after a hearing of the parties.

Riker v. Law, 120 O. G. 2754; Kugele v. Blair, 125 O. G. 1350; Lewis v. Deulch v. Lum v. Murphy v. Canfield, 181 O. G. 265.

The reason for the rule of secrecy would seem to apply in the case of patents issued upon divisional applications.

Dyer, 106 O. G. 1508.

Provides for concealing a clearly divisible invention, but does not provide for concealing any part of a divisible invention in issue.

Davis v. Ocompaugh v. Gerrett, 103 O. G. 1679.

In a process application a claim having an additional step is a separate invention and may be reserved under the rule, the product is a part of the invention and may not be reserved.

Powrie, 1902 C. D. 200-1, 99 O. G. 2549.

If an application contains a description and claims of one or more inventions not related to the one in issue in such a manner as to affect its scope or meaning, the opposing party should not be allowed to inspect this part of the application.

Zweilusch v. Witteman, 75 O. G. 183.

Rule 105 is in accordance with law.

Smith & Thomas v. Cowles, 1885 C. D. 12, 30 O. G. 343.

Cases that pass on the subject matter of this rule:

Hall v. Dolmer, 189 O. G. 251; Shavir v. Dilg & Fowler, 157 O. G. 1001; Bastian v. Champ, 128 O. G. 2837.

Rule 106. New Application for Claims not in Interference.

When a part only of an application is involved in an interference, the applicant may withdraw from his application the subject matter adjudged not to interfere, and file a new application therefor, or he may file a divisional application for the subject matter involved, if the invention can be legitimately divided: *Provided*, That no claim shall be made in the application not involved in the interference broad enough to include matter claimed in the application involved therein.

CONSTRUCTIONS.

A new application for claims in interference should be suspended to await that action.

Wickers & Furling, 129 O. G. 2076.

Claims suggested were made in a separate application. Though made before the interference was declared they were made in view of such interference and Rule 106 applies.

Gueniffel, Benovit, and Nicault, 119 O. G. 338.

Where a divisional application is filed for the purpose of interference with claims to the same specific form shown in the original case, though the claims in the divisional case are narrower than the claims in the original case, held that the original application will not be allowed until the contemplated interference is terminated.

Gueniffel, Benovit and Nicault, 119 O. G. 338.

The rule was designed to apply especially to an interference between applicants, and for the purpose of preventing one party, going out before the world with a patent, showing perhaps the subject matter of a pending interference, and thereby leading the public to suppose that it was protected by said patent, to the great detriment, perhaps, of the other party contesting the claim. To some extent the provisos also apply in interference between an application and patent, for a portion of the claims in an interfering application ought not to be allowed, to go to patent under any circumstances, unless they are for separate inventions, or that, if the interference should result in the grant of another patent to the same party, the two will be distinct from each other; but if as in this case, one party already has a patent, the grant of a patent of the later date to another party can work no damage to the first patentee, even though it show the subject matter of the interference; especially if the second patent is subordinate to the one already in existence, which is the fact in this case.

Lacroix & Welch, 1873 C. D. 166.

Questions properly considered in an interference will not be considered in a separate application.

Robinson, 1902 C. D. 433, 101 O. G. 2079.

No proper line of division between an element and its combination.

Porter v. Louden, 73 O. G. 155.

An applicant can only be allowed such claims in a separate application as can not be included in the interference by the other party under Rule 94.

Wheeler, 1883 C. D. 12, 23 O. G. 1031.

But only when the claims so withdrawn cover inventions which do not involve the device in manufacture.

Hermance v. Bussey, 1871 C. D. 216.

Cases that pass on the subject matter of this rule:

Phillips v. Sensenich, 122 O. G. 1047; Davis v. Garrett, 123 O. G. 1991; Assignee, 121 O. G. 689; Hildreth, 1901 C. D. 186, 97 O. G. 1374; Neiswanger, 1891 C. D. 37.

Rule 107. Disclaimer to Avoid Interference.

An applicant involved in an interference may, with the written consent of the assignee, when there has been an assignment, before the date fixed for the filing of his preliminary statement (see Rule 110), in order to avoid the continuance of the interference, disclaim under his own signature the invention of the particular matter in issue, and upon such disclaimer judgment shall be rendered against him.

CONSTRUCTIONS.

The statement of abandonment (Trade-Mark) was not so unequivocal and unconditional as required by the rules. The case is therefore remanded to the Examiner of Interferences with *directions to vacate the judgment and resume proceedings.*

The Thomson Wood Finishing Co. v. Renold Bros., 130 O. G. 980.

An ordinary amendment is not sufficient under this rule.

Colley v. Copenhaver, 107 O. G. 268.

The rules nowhere provide for the termination of an interference after it has once been declared on a mere cancellation of the claims.

Read v. Scott, 1902 C. D. 242, 100 O. G. 449.

The cancellation of claims is not sufficient.

Curtis v. Marsh, 1900 C. D. 127, 92 O. G. 1236.

If one makes a broad claim covering two species and the other makes a narrow claim to one species there is an interference which may be avoided by a disclaimer.

Kenyon v. Carter, 1894 C. D. 2; Grimmett v. Willett, 1894 C. D. 16.

This rule does not require a party who has been defeated in an interference proceedings and has canceled the claims

which were in interference to file a disclaimer of the matter covered by such claims.

Firm, 1887 C. D. 27, 39 O. G. 1199.

Where the Office has been in error in the declaration of the interference or has put a wrong construction upon the applicant's claim, he is enabled by the provisions of this rule to extricate himself from the controversy by properly restricting his application to the invention he desires to claim.

Drawbaugh v. Blake, 23 O. G. 1221.

A disclaimer should be put in proper form to be incorporated into the specification, and not as a preliminary statement.

Laverty v. Flagg, 1879 C. D. 303, 16 O. G. 1141.

Disclaimers must be as broad as the issue. Disclaiming the specific device claimed in opponents application will not extricate the disclaimant from an interference in which the issue is a general claim.

Walsh v. Shinn, 1879 C. D. 279, 16 O. G. 1006.

Parties can not stipulate patents into each others hands. Concessions of priority must be signed by the parties themselves and not by their attorneys, though the acts of the attorneys may be ratified by a party accepting the result of such stipulation.

Tucker v. Kahler, 1879 C. D. 71, 15 O. G. 966.

An applicant will be estopped from claiming in a reissue matter which was disclaimed in the original application, in order to avoid an interference. But a disclaimer not proved to have been authorized by applicant can not have that effect.

Lee v. Walsh, 1879 C. D. 29, 15 O. G. 563.

There is nothing in the nature of interference proceedings or in the character of the rights to be determined which precluded the application of the now well established doctrine of estoppel.

Berry v. Stockwell, 1876 C. D. 47, 9 O. G. 404; Walker on Patents, sec. 141.

An admission of priority will not debar a patent to the disclaimant on a subsequent application. Ex parte J. W. Cochran, 1871 C. D. 78, to the contrary cited and said to have been overruled by the Supreme Court of the District.

Allen & Moody v. Gilman, 1872 C. D. 204.

See note to Rule 119.

Cases that pass on the subject matter of this rule:

Townsend v. Corey, 119 O. G. 2237; Krakaw v. Harding, 107 O. G. 1662; Skinner v. Murray, 107 O. G. 542; Hildreth, 1901 C. D. 186, 97 O. G. 1374.

Rule 108. Inspection of Claims of Opposing Parties.

When applications are declared to be in interference, the interfering parties will be permitted to see or obtain copies of each other's file wrappers, and so much of their contents as relates to the interference, after the preliminary statements referred to in Rule 110 have been received and approved; but information of an application will not be furnished by the office to an opposing party, except as provided in Rules 97 and 103, until after the approval of such statements.

See note to Rule 105.

CONSTRUCTIONS.

No appeal lies from decisions which could not be made a ground of rejection of a claim after the determination of the interference.

Mortimer v. Thomas v. Brownson, 192 O. G. 215.

Where application is void, unless it has the filing date of the previous application, the opponent may have copies of the pertinent part of said first application.

Hall v. Folmer, 189 O. G. 251.

An interference held to be properly dissolved because of an insufficient affidavit under Rule 75.

Hidgkinson v. Roller, 185 O. G. 251.

It was suggested that the party had lost her right to conceal any part of her invention, by reason of delay, but it was held that it did not appear to be her fault altogether and was not sustained.

Harris v. Kennedy, 161 O. G. 530.

A party is entitled to copies of the communications relating to the invention in issue.

Harris v. Kennedy, 161 O. G. 530.

If an application filed under Rule 106 is referred to, it may be inspected.

Shaver v. Dilig and Fowler, 157 O. G. 1001.

After an interference is decided the parties are not entitled to further inspect each others papers.

Sirl, 138 O. G. 509.

Delay in filing an amendment in order to avoid inspection by the opposing party is not excusable.

Dilge and Fowler, Jr., 132 O. G. 1837.

An interference will not be suspended to secure the issuance of a patent on an application referred to but not included in the interference before the other party has access to the files.

Field, 130 O. G. 1687.

Where S requests copies of the decision of the Examiner upon a motion for dissolution in another interference in which F was a party and which is referred to in F's record, held that since S was not a party to the other interference and the claims forming the issue of that interference are not made by S, he should be denied access to the record of that interference even though the issue therefore is based upon the same structure as that upon which the claims in the present interference are drawn.

Slone v. Fessenden, 130 O. G. 1487.

Copy of affidavit under Rule 75 refused.

U. S. Standard Voting Machine Co., 130 O. G. 1486.

Where one party to an interference shows, describes, and claims an auxiliary invention which is not essential to the operativeness of the invention in issue and the other party has presented no claim which includes this auxiliary invention either broadly or specifically, there appears to be no reason why it should be disclosed to him.

Kugele v. Blair, 127 O. G. 1253.

A party who in a patent or in his testimony, refers to pending or an abandoned application, can not thereafter withhold such application from the inspection of the opposite party. (Authorities.)

Belle City Malleable Iron Co., 125 O. G. 1351.

Ordinarily when an application involved in interference contains a statement that it is a division of an earlier application the earlier application is thrown open to the inspection of the opposing party, and no reason is apparent for making an exception in the present case.

Steinmetz v. Thomas, 125 O. G. 1351.

The attorneys of the assignee of the entire interest is entitled to inspect papers.

Cazin v. Von Welsbach, 119 O. G. 650.

A copy of a previous application referred to in preliminary statement furnished opposing party.

Claasen v. Steffen, 113 O. G. 2507.

No good reason exists why a party to an interference should be permitted to examine papers relating to claims not in-

volved in the interference, even though the party in whose interest the papers were filed happens to be a party to the interference. (Op. Att'y Gen.)

Davis v. Garrett, 112 O. G. 1211.

If an applicant desires to avail himself of the date of his original application, the other party is entitled to see the original application.

Henderson, 107 O. G. 1661.

Requests for copies of pending or abandoned applications referred to in patents should be supported by a showing of reasons why they are desired.

Dyer, 106 O. G. 1508.

The parties to an interference are entitled to see so much of their opponent's cases as relate to the interference. This includes a copy of the specification, claims, and all claims relating to the interfering matter.

102 O. G. 228.

and specifically public use proceedings.

Mills v. Torrance, 106 O. G. 544.

Affidavits under Rule 75 not disclosed.

Davis Ocumpaugh v. Garrett, 103 O. G. 1679.

A motion to have the preliminary statement sealed up until the expiration of the time limited for motions to dissolve refused because not contemplated by the rules.

Whipple v. Sharp, 1902 C. D. 5, 98 O. G. 226.

If a former application is referred to to fix a date, opponent has a right to a copy of such application.

Gillespie, 1900 C. D. 149, 92 O. G. 2159.

After judgment of priority against applicant who makes a motion for dissolution and redeclaration of interference to include applicant's earlier application, the opposing party will be furnished with a copy of said earlier application.

Thorpe v. White, 1900 C. D. 46, 91 O. G. 227.

Contains nothing to authorize the disclosure of a caveat that may have been referred to during the ex parte consideration.

Lowry, 1900 C. D. 1, 90 O. G. 445.

Affidavits under Rule 75 may not be shown to opposing parties or copies furnished.

Guiser, 1880 C. D. 94, 17 O. G. 507.

The fact that the applicant has access to the specification and claims of the patentee is no reason why this rule should be violated by furnishing the patentee with a copy of the specification and claims of the applicant.

Spalding and Aldrich v. Winchester, 1871 C. D. 94.

Cases that pass on the subject matter of this rule.
Kugele v. Blair, 125 O. G. 1350; Davis v. Garrett, 123 O. G. 1991.

Rule 109. Invention Shown, but not Claimed in Application.

An applicant involved in an interference may, at any time within thirty days after the preliminary statements (referred to in Rule 110) of the parties have been received and approved, on motion duly made, as provided by Rule 153, file an amendment to his application containing any claims which in his opinion should be made the basis of interference between himself and any of the other parties. Such motion must be accompanied by the proposed amendment, and when in proper form will be set for hearing before the law examiner. Where a party opposes the admission of such an amendment in view of prior patents or publications, full notice of such patents or publications must be given at least five days prior to the date of hearing. On the admission of such amendment, and the adoption of the claims by the other parties within a time specified by the law examiner, the primary examiner shall redeclare the interference, or shall declare such other interferences as may be necessary to include the said claims. New preliminary statements will be received as to the added claims, but motions for dissolution with regard thereto will not be considered where the questions raised could have been disposed of in connection with the admission of the claims. Amendments to the specification will not be received during the pendency of the interference, without the consent of the Commissioner, except as provided herein, and in Rule 106.

Any party to an interference may bring a motion to

put in interference any claims already in his application or patent, which in his opinion should be made the basis of interference between himself and any of the other parties. Such motions are subject to the same conditions, and the procedure in connection therewith is the same, so far as applicable, as hereinabove set forth for motions to amend.

HISTORY.

Rule 109, previous to last revision, was as follows: An applicant involved in an interference may, at any time within thirty days after the preliminary statements (referred to in Rule 110) of the parties have been received and approved, on motion duly made, as provided by Rule 153, file an amendment to his application containing any claims which in his opinion should be made the basis of interference between himself and any of the other parties. Such motion must be accompanied by the proposed amendment, and when in proper form will be transmitted by the Examiner of Interferences to the Primary Examiner for his determination. On the admission of such amendment, and the adoption of the claims by the other parties within a time specified by the Examiner, as in Rule 96, the interference will be redeclared, or other interferences will be declared to include the same as may be necessary. New preliminary statements will be received as to the added claims, but motions for dissolution will not be transmitted in regard thereto where the questions raised could have been disposed of in connection with the admission of the claims. Amendments to the specification will not be received during the pendency of the interference, without the consent of the Commissioner, except as provided herein, and in Rules 106 and 107.

See Rule 94 of 1879.

Present Rule 109 was promulgated in view of the decisions of the Court of Appeals of the District of Columbia in Blackford v. Wilder, 127 O. G. 2855, Horins v. Wends, 129 O. G. 2858, in which the court refused to consider a second interference for the purpose of permitting applicants to present claims covering all the patentable subject matter common to the interfering applications. But the time for presentation must be confined to thirty days.

Mattice v. Langworthy, 132 O. G. 678.

See note to Rule 122.

CONSTRUCTIONS.

Insertion of Claims.

When some of the claims which are copied from a patent are found to be allowable, but others are not, the interference should be declared without waiting to determine the applicant's right to the remaining claims. If necessary applicant can bring up that question by motion under Rule 109.

Weber and Woodford, 264 O. G. 863.

In this case appellant did not comply with the rules of the Office and file an amendment containing these claims prior to the dissolution of the interference. We, therefore, agree with Patent Office that he was thereafter estopped to urge them.

In re Copen, 214 O. G. 685 (see also page 683).

A denial of a motion to insert claims in opponent's application under Rule 96, not appealable.

Stronach v. Shaw, 197 O. G. 989; Mortimer v. Thomas v. Brownson, 192 O. G. 215.

Unless the moving party is of the opinion that the claims are patentable, he can not move to insert them.

Rich v. Porter v. Hamlin, 192 O. G. 1261.

Patentability should be determined under the motion to amend. If not, a motion to dissolve not permitted.

Henderson & Cantley v. Kindervaler, 192 O. G. 741.

An amendment to the drawing which is to cure an obvious clerical mistake, might be made during an interference.

Moore, Com., v. U. S. ex rel. Colburn Machine Glass Co., 191 O. G. 293.

A motion to insert claims is inconsistent with a motion to dissolve an interference on the ground of nonpatentability of such claims.

Weinberg v. Boyer v. Russell and Russell, 185 O. G. 249.

After interference had been appealed R presented claims by an amendment and asked an interference with another patent of C's. Primary Examiner should consider whether a second interference should be instituted, but if not. the amendment should await termination of the present one.

Crers v. Ruby, etc., 184 O. G. 552.

The junior party being in default transmission was refused of a motion by the senior party to include certain counts.

Crone v. White, 181 O. G. 1074.

The purpose is to permit all questions to be determined in one interference. It is the interest of the parties to have the issue corrected before taking testimony.

Kurowski v. Ransey, 181 O. G. 820.

Practice under Niedich, 172 O. G. 551.

Where a disclaimer is filed, permission for the opposing party to inspect papers will not be given, even if the wishes to see if other claims can not be made under the provision of Rule 109.

Hick, 172 O. G. 261.

A specific claim allowed the successful party in an interference involving generic claims.

Van Gox, 170 O. G. 243.

It is claimed that new light has been thrown upon the real invention which is at issue between the parties by the hearings which have been had before the Primary Examiner on the merits of the conflicting inventions. There is reason to believe that the original invention was not properly defined originally, and that it might be more clearly defined. The delay warranted and transmission of the motion ordered.

Walker et al. v. Gilchrist, 164 O. G. 507-8.

The purpose of this rule is to settled all preliminary questions relating to the issue of an interference in a single proceeding and the Examiner should decide under such circumstances not only the question of dissolution of the interference, but also the questions raised by the claims presented under Rule 109, in order that all these questions may be reviewed, if necessary, by the appellate tribunal upon the same appeal. The fact that the decision of the Examiner dissolved the interference upon the issues originally set forth does not preclude the right to inter partes consideration of the claims presented under Rule 109.

Hammond and Donahue v. Colley v. Norris, 148 O. G. 573.

The requirement as a condition precedent to transmission that applicant point out the elements of the claim in the application approved.

Hock v. McCaskey v. Hopkins, 141 O. G. 1161.

Where an Examiner rejects claims presented by a party to an interference under Rule 109, he should set a limit of appeal from his decision whether the claims had been allowed to the other party or had been made for the first time by the moving party.

Mattice v. Langworthy, 132 O. G. 1073.

In the case of Townsend v. Copeland v. Robinson, 126 O. G. 1355, it was pointed out that the practice on motions under Rule 109 should follow the practice under Rule 124.

Josleyn v. Hirlse, 132 O. G. 844.

It is not intended to permit a party to present claims and

if they are not acceptable to amend them and thus enter upon a regular prosecution of the case before the Examiner, nor is it intended to permit an applicant to present his proposed claims in a piecemeal manner.

Mattice v. Langworthy, 132 O. G. 678.

This is not properly a motion under Rule 109, since the proposed claims are not claims of the Becker application, but is brought under the practice announced in Churchward v. Douglas v. Cutler, 106 O. G. 2016. It is necessary for interferants to include in the one interference all matter that could have been presented and determined therein.

The above case and Becker v. Otis, 129 O. G. 1267.

(Rule adopted previous to Rule 96.)

In view of the transmission of the portion of the motion based on Rule 109 the transmission of the remainder of the motion will not occasion additional delay.

Baslain v. Champ, 128 O. G. 2837.

In view of the transmission of the portion of the motion based on Rule 109, the transmission of the remainder of the motion will not occasion additional delay.

Bastian v. Champ, 128 O. G. 2837.

Harnisch v. Gurniffit, Benoit and Wieault, 128 O. G. 455.

The fact that one was unable to get the papers from the Patent Office until three days prior to the expiration of the time limited, considered a sufficient excuse for not filing motion within such time.

Kugele v. Blair, 125 O. G. 1350.

See note to Rule 122.

Townsend v. Copeland v. Robinson, 124 O. G. 1545.

The purpose of Rule 109 is clearly to avoid a second interference, and where a party fails to take advantage of that rule he loses the right to contest the question of priority as to the claims made by his opponent.

Ex parte Sulton, Steele, and Steele, 121 O. G. 1012.

Substance and not words is the test of conflicting claims.

Upton, 27 O. G. 99; Drawbaugh v. Blake, 1883 C. D. 17, 23 O. G. 1221.

It is the general spirit of the practice of the Office as well as of the courts to all questions that can fairly be considered at the same time should be so considered. Therefore, where U brought a motion to dissolve for lack of interference in fact and B moved to amend under Rule 109, it was error for the Examiner to refuse to entertain B's motion on the ground that his decision thereon would depend on the determination of U's motion on appeal.

Ubelacker v. Brill, 1899 C. D. 118, 87 O. G. 1783.

It is recognized in the Office practice as desirable that the question of priority of invention as to all matters which may come in issue between the parties be settled in one interference proceeding and this is the purpose of Rule 109, but the mere possibility that other claims may be made by the parties and new controversies may arise is no justification for dissolving an interference already in progress.

Annand v. Spalckhaver, 1901 C. D. 234, 97 O. G. 2741.

This rule does not provide for the insertion of claims suggested by counsel for both parties after consultation before filing a preliminary statement or taking testimony. Case remanded to Primary Examiner for the purpose of consideration of such an amendment, under the general supervisory power of the Commissioner—Rule 213.

Reece v. Fenwick, 1902 C. D. 145, 99 O. G. 669.

A motion pending under this rule is not a bar to a motion under Rule 122, nor does it excuse delay.

Perrussel v. Wichmann, 1902 C. D. 228, 99 O. G. 2970.

A motion to reopen interference for the purpose of introducing further evidence must be accompanied by good reasons.

Shaffer v. Dolar, 1902 C. D. 344, 100 O. G. 3012-13;
Harris v. Stern & Lotz, 1902 C. D. 386, 101 O. G. 1132-33.

The statement that the Examiner will redeclare the interference should be taken to mean that he will amend the declaration by adding a new count. It is a reformation or amendment and not a new declaration.

Mitchell v. Fitts, 103 O. G. 1915.

A third interference is refused.

Sarfert v. Meyer, 109 O. G. 1885.

Twelve to fifteen days after receiving papers not unreasonable.

Connell v. Tobey, 110 O. G. 2015.

As held in the case of Jenne v. Brown v. Booth, 59 O. G. 157, 78 C. D. 1842, any or all the motions provided for in Rule 122 may be brought in connection with the new claims included in the interference under the provisions of Rule 109 and therefore Pfingst's motion as to the new counts was a proper one.

Pfingst v. Anderson, 114 O. G. 264.

A refusal to admit claims under this rule because they are not patentable should be reviewed, if at all, in the first instance by the Examiners-in-Chief.

Limp v. Ball, 115 O. G. 249.

It is contemplated by Rule 94 that the claims made in either application may be introduced into the other application by

amendment, and included in the interference upon motion made in accordance with that rule.

Wheeler, 23 O. G. 1031.

It is within the judicial discretion of the Examiner of Interferences to extend the time for motion.

House v. Butler, 1893 C. D. 14.

May not introduce matter not warranted by application as originally filed.

Grinnell v. Buell, 89 O. G. 1863; Smith v. Carmichael, 93 O. G. 1123.

A person making a specific claim only can not insert a generic claim when in the meantime another applicant has applied for another species.

Bechman v. Wood, 89 O. G. 2459-62. See, however, McBerty v. Cook, 90 O. G. 2295.

Contemplates the possibility of an allowance by the Examiner upon argument of claims which were for some reason not suggested under Rule 96.

Davis x. Ocumpaugh v. Garett, 103 O. G. 1679.

Matters under this rule must come in the first instance before the Examiner of Interferences. If no claim is sought to be inserted the motion is unauthorized. Only matter contemplated by Rules 106, 107 and 109 may be included in an amendment during the continuance of an interference.

Smith v. Carmichael, 93 O. G. 1123.

It is not within the province of the Examiner of Interferences to consider the patentability or nonpatentability of the claims. This is so even if the proposed claims have been once rejected by the Primary Examiner. Applicant has a right to appeal. The purpose of this rule is to have counts added on motion of applicant if proper.

Reece v. Fenwick, 97 O. G. 188.

This rule does not provide for the insertion of claims suggested by counsel for both parties after consultation before filing a preliminary statement or taking testimony. Case remanded to Primary Examiner for the purpose of consideration of such an amendment under the general supervisory power of the Commissioner. Rule 213.

Reece v. Fenwick, 99 O. G. 669.

It is held that where a party promptly presents claims as proposed additional counts to the interference issue they should be considered by the Primary Examiner. The claims should be accompanied by a motion similar to that ordinarily presented under Rule 109 and by a motion before the Primary Examiner to transmit. Practice indicated.

Churchward v. Douglas, 106 O. G. 2016.

Tyden presented a claim in an amendment which was properly a second species which could not on that account be entered. This decision of the Examiner should only have been made after notice to the other party.

Tyden's divisional application should be considered and if there is interfering subject matter, an interference should be declared accordingly.

Myers v. Tyden, 108 O. G. 287.

Claims contained in a year old patent to one of the parties refused admission in view of the fact that the testimony was nearly complete.

Newell v. Hubbard, 108 O. G. 1053.

Practice prescribed where one of two interfering applicants wishes to file an amendment purporting to put the application in shape for another interference.

Moore v. Hewitt v. Potter, 115 O. G. 509.

Where a party considers that a claim of his opponent could be made by him under Rule 109, but believes that the claim is so vague and indefinite that proper determination of the question of priority could not be based thereon, held that the party should not ask the Office to make this claim an issue but should suggest some issue which would properly describe the invention.

Wickers & Furlong v. Weinman, 118 O. G. 1797.

P offers no new claim at this time though it would seem that from the inspection of these applications he might readily have formulated and presented by motion in analogy to motion under Rule 109 the broader allowable and interfering claims, which should, in his opinion, be included in the issue, if any such claim could be drawn.

Phelps v. Warmley v. McCullough, 118 O. G. 1069.

A motion to amend the issue of an interference under Rule 109 was properly refused transmission where it contained a proviso that the claims shall be added "without prejudice to the right to contest such claims under the provisions of Rule 122."

Wheeler v. Palmros, 133 O. G. 230.

Cases that pass on the subject matter of this rule:

Hick, 172 O. G. 261; Brown v. Inwood and Lavenberg, 130 O. G. 978; Kugele v. Blair, 127 O. G. 1253; Corey v. Eiseman & Misar, 122 O. G. 2063; Fagan v. Graybill, 121 O. G. 1013; Hicks v. Costello, 103 O. G. 1163; Berry v. Fitzsimmons, 1902 C. D. 153, 99 O. G. 862; Hildreth, 1901 C. D. 186, 97 O. G. 1374; Jenne v. Brown v. Booth, 1892 C. D. 78.

Rule 110. Preliminary Statements.

Each party to the interference will be required to file a concise preliminary statement, under oath, on or before a date to be fixed by the office, showing the following facts:

(*a*) The date of original conception of the invention set forth in the declaration of interference.

(*b*) The date upon which the first drawing of the invention and the date upon which the first written description of the invention were made.

(*c*) The date upon which the invention was first disclosed to others.

(*d*) The date of the reduction to practice of the invention.

(*e*) A statement showing the extent of use of the invention.

(*f*) The applicant shall state the date and number of any application for the same invention filed within twelve months before the filing date in the United States, in any foreign country adhering to the International Convention for the Protection of Industrial Property or having similar treaty relations with the United States.

If a drawing has not been made, or if a written description of the invention has not been made, or if the invention has not been reduced to practice or disclosed to others or used to any extent, the statement must specifically disclose these facts.

When the invention was made abroad the statement should set forth:

(*a*) That the applicant made the invention set forth in the declaration of interference.

(*b*) Whether or not the invention was ever patented; if so, when and where, giving the date and num-

ber of each patent, the date of publication, and the date of sealing thereof.

(*c*) Whether or not the invention was ever described in a printed publication; if so, when and where, giving the title, place, and date of such publication.

(*d*) When the invention was introduced into this country, giving the circumstances with the dates connected therewith which are relied upon to establish the fact.

The preliminary statements should be carefully prepared, as the parties will be strictly held in their proofs to the dates set up therein.

If a party prove any date earlier than alleged in his preliminary statement, such proof will be held to establish the date alleged and none other.

The statement must be sealed up before filing (to be opened only by the examiner of interferences; see Rule 111), and the name of the party filing it, the title of the case, and the subject of the invention indicated on the envelope. The envelope should contain nothing but this statement.

(For forms, see 36 and 37, appendix.)

HISTORY.

1869. NO SIMILAR RULE.
1870. RULE 53, SEE APPENDIX.

In 1871, Rule 53 read as follows: Before the declaration of an interference proper a preliminary interference will be declared, in which each party, without the name of the other party being made known to him, will be required to file a statement under oath giving a detailed history of the invention, describing its original conception, the successive experiments, the extent and character of use, and the various forms of embodiment, and giving, so far as practicable, the exact dates of each step in its development. This statement must be sealed up before filing (to be opened only by the examiner of interference), and the name of the party filing it and the subject of the invention indicated on the envelope.

These preliminary statements shall not be opened to inspection of the opposing parties until both have been filed or until the time for filing both has expired, nor then, until they have been examined by the proper officer and found to be sufficiently definite as regards their declarations of dates.

If the party upon whom rests the burden of proof fails to file a preliminary statement, or if his statement fails to overcome the prima facie case made by the respective dates of application, or if it shows that he has abandoned his invention, or that it has been in public use more than two years before his application, the other party will be entitled to an immediate adjudication of the case upon the record; unless a presumption is created that his right to a patent is affected by the alleged public use of the invention, in which case the interference may be proceeded with.

If the earlier applicant fails to file a preliminary statement, no testimony will subsequently be received from him going to prove that he made the invention at a date prior to his application. The preliminary statement can in no case be used as evidence in behalf of the party making it. Its use is to determine whether the interference shall be proceeded with, and to serve as a basis of cross-examination for the other party.

If either party requires a postponement of the time for filing the preliminary statements, he must present his reason therefor, in the form of an affidavit, prior to the day previously fixed upon.

In 1873, Rule 53 read as follows: Before the declaration of an interference proper a preliminary interference will be declared, in which the primary examiner will notify the respective parties when the applications of the other parties were filed, together with their names and residences. Each party to the interference will be required to file a statement under oath, giving a detailed history of the invention, showing the date of the original conception, and the date that the invention was reduced to drawings or model, and the date of its completion, and the extent and character of use. The parties will be strictly held in their proof to the dates set up in their preliminary statements. This statement must be sealed up before filing (to be opened only by the examiner of interference), and the name of the party filing it and the subject of the invention indicated on the envelope.

These statements shall not be open to the inspection of the opposing parties until both have been filed, or until the time for filing both has expired, nor then, until they have been

examined by the proper officer and found to be satisfactory. At the time of the examination of the preliminary statements the examiner of interferences will also make an examination of the preliminary declaration (instituted by the primary examiner), in order to ascertain whether or not the issue between the parties has been clearly defined. If it is found, upon such examination, that the preliminary declaration is ambiguous in this particular, the interference will be suspended and the case returned to the primary examiner for amendment.

If the party upon whom rests the burden of proof fails to file a preliminary statement, or if his statement fails to overcome the *prima-facie* case made by the respective dates of application, or if it shows that he has abandoned his invention, or that it has been in public use more than two years before his application, the other party will be entitled to an immediate adjudication of the case upon the record, unless a presumption is created that his right to a patent is affected by the alleged public use of the invention, in which case the interference may be proceeded with.

If the earlier applicant fails to file a preliminary statement, no testimony will subsequently be received from him going to prove that he made the invention at a date prior to his application. The preliminary statement can in no case be used as evidence in behalf of the party making it. Its use is to determine whether the interference shall be proceeded with, and to serve as a basis of cross-examination for the other party.

If either party requires a postponement of the time for filing the preliminary statements, he must present his reasons therefor, in the form of an affidavit, prior to the day previously fixed upon.

In 1878, Rule 53 read as follows: Before the declaration of an interference proper a preliminary interference will be declared, in which the primary examiner will briefly and concisely define the interfering subject-matter, and specify the claims embracing the same, and also notify the respective parties when the applications of the other parties were filed, together with their names and residences. * * *

If the party upon whom rests the burden of proof fails to file a preliminary statement, or if his statement fails to overcome the *prima-facie* case made by the respective dates of application, the other party will be entitled to an immediate adjudication of the case upon the record. Or where there are more than two parties to the interference, and any

of them fail to file a preliminary statement, judgment may be rendered against such parties and the interference proceed between the remaining parties. * * *

In case of material error in the preliminary statement, arising through inadvertence or mistake, it may be corrected, upon showing to the satisfaction of the Commissioner that its correction is essential to the ends of justice.

The motion to correct the said statement must be made before the taking of the testimony relating to the alleged error, and as soon as practicable after the discovery thereof, and it must be accompanied by notice to the adverse party or parties.

Rule 105 of 1879 in appendix: In 1885 the words, "of the making of a drawing, of the making of a model" appear in lines 3 and 4, and the words "reduction to practice" appear in line 5 and the following matter was added to the Rule of 1879.

When the invention was made abroad the statement should set forth when and where, if ever, the invention was patented (giving the date and number of the patent), and when, if ever, it was described in a printed publication (giving the date and place of publication), and when, if ever, it was introduced, or knowledge of it was introduced into this country (giving the circumstances which are thought to establish the fact thereof).

In the general revision of 1888, Rule 110 reads: Each party to the interference will be required to file a concise statement, under oath, on or before a date to be fixed by the office, showing the following facts:

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

If a drawing or model has not been made, or if the invention has not been reduced to practice or disclosed to others or used to any extent, the statement must specifically disclose these facts.

When the invention was made abroad the statement should set forth:

(1) That applicant made the invention set forth in the declaration of interference.
(2) Whether or not the invention was ever patented, if so, when and where, giving the date and number of each patent.
(3) Whether or not the invention was ever described in a printed publication, if so, when and where, giving the title, place, and date of such publication.
(4) Whether or not the invention was ever introduced into this country, if so, giving the circumstances, with the dates connected therewith, which are relied upon to establish the fact.

The preliminary statements should be carefully prepared, as the parties will be strictly held in their proofs to the dates set up therein.

The statement must be sealed up before filing (to be opened only by the examiner of interferences, see Rule 111), and the name of the party filing it, the title of the case, and the subject of the invention indicated on the envelope. The envelope should contain nothing but this statement.

In 1899 the words "the date of publication, and the date of sealing thereof" appear in the second numbered paragraph relating to inventions made abroad, and the following paragraph followed the caution that care should be used:

If a party prove any date earlier than alleged in his preliminary statement, such proof will be held to establish the date alleged and no other.

110 (7) (Added June 24, 1903.) The applicant shall state the date and number of any application for the same invention fixed within twelve (12) months before the filing date in the United States in any foreign country adhering to the international convention for the protection of industrial property or having similar treaty relations with the United States.

The requirement that the date of the first written description must be stated was added in the last revision.

CONSTRUCTIONS.

(1) IN GENERAL.
(2) AS A PLEADING.
(3) EFFECT OF PRELIMINARY STATEMENT.
(4) INACCURACY—VARIATION IN PROOF.
(5) REDUCTION TO PRACTICE.
(6) REDUCTION TO PRACTICE INDICATED BY UTILITY AND OPERATIVENESS.
(7) DILIGENCE IN REDUCING TO PRACTICE.

(8) MODEL AS A REDUCTION TO PRACTICE.
(9) EXTENT OF USE.
(10) CONCEPTION OF INVENTION.
(11) DISCLOSURE OF INVENTION.
(12) ADDITIONAL CASES.

(1) *In General.*

There seems to be a tendency to approximate the practice in patent cases under Equity Rule 58 to the Office practice in interference cases.

The rule requiring preliminary statements is a salutary one, its obvious object being to illicit from each of the parties certain vital information before any party is informed as to the statements of any other.

Thomas v. Weintraub, 177 O. G. 772.

A preliminary statement given the effect of an affidavit under Rule 75. (Perhaps this was in view of the particular circumstances of the case.)

Forsyth v. Richards, 1905 C. D. 115, 115 O. G. 1327.

Question if a disclosure to a wife is a disclosure within the meaning of the Patent Law.

Harter v. Barrett, 1905 C. D. 578, 114 O. G. 975; 24 App. D. C. 300.

Does not prohibit party's attorney from administering the oath.

Bundy v. Rumbarger, 1900 C. D. 94, 90 O. G. 2210.

After judgment on the record the defeated party may not examine the preliminary statement of his opponents.

Lindsay v. McDonough, 1891 C. D. 89.

Preliminary statements considered in connection with previously filed affidavit under Rule 75.

Schmertz v. Appert, 1890 C. D. 95, 77 O. G. 1784.

After judgment on the record permission to inspect the preliminary statement of the prevailing party refused.

Lindsay v. McDonough, 1891 C. D. 98, 66 O. G. 1402.

If there is any doubt as to the scope of the interference issue, each applicant should confine his preliminary statement to the invention contained in the claims of his application which are declared to be involved in the interference and not attempt to frame the statement to cover two or more possible constructions of the issue.

Haug v. DuBois, 1891 C. D. 131, 54 O. G. 1061.

The disclaimer authorized by Rule 104 can not be received as a preliminary statement.

Laverly v. Flagg, 1879 C. D. 303, 16 O. G. 1141.

(2) *As a Pleading.*

The sworn preliminary statements required when an interference has been declared constitute the pleadings of the parties, and we have had occasion several times and for reasons satisfactory now as then, to approve the practice of holding parties strictly to the dates given therein.

Parkes v. Lewis, 1906 C. D. 735, 123 O. G. 2313, 18 App. D. C. 1; Luger v. Browning, 1903 C. D. 593, 104 O. G. 1123, 21 App. D. C. 201; Podlesak & Podlesak v. McInnerney, 1906 C. D. 558, 120 O. G. 2127, 26 App. D. C. 399; Adams, 1905 C. D., 114 O. G. 2093, 24 App. D. C. 275; See Berger v. Dodge, 1905 C. D. 603, 114 O. G. 2383, 24 App. D. C. 481; Robinson v. Copeland, 1904 C. D. 664, 112 O. G. 501, 24 App. C. C. 68; Paul v. Johnson, 1904 C. D. 610, 109 O. G. 807, 23 App. D. C. 194; Bader v. Vagen, 1899 C. D. 1235, 87 O. G. 329, 14 App. D. C. 241; Stevens v. Seher, 1897 C. D. 761, 81 O. G. 1932, 11 App. D. C. 245; Cross v. Phillips, 1899 C. D. 342, 87 O. G. 1399, 14 App. D. C. 230; Hammond v. Basch, 1905 C. D. 615, 115 O. G. 804, 24 App. D. C. 469; Fowler v. Boyce, 1906 C. D. 659, 122 O. G. 1726, 27 App. D. C. 4852.

Preliminary statement in the nature of a pleading.

Huber v. Aiken, 1899 C. D. 166, 88 O. G. 1525.

Preliminary statements in interferences do not make the issue between parties and therefore they are not like pleadings in courts.

Woodward v. Kennedy, 1903 C. D. 166, 104 O. G. 1393.

The practice of requiring a preliminary statement approved. It is in the nature of a pleading. "Whether each statement is to be considered as a pleading in the case seems to me is not very material."

Hopkins v. LaRoy, 1880 C. D. 188, 18 O. G. 859; Guest v. Finch, 1876 C. D. 144, 10 O. G. 165; Schenck v. Rider, 1870 C. D. 135.

The rule that the proof and pleading must correspond is as applicable in the Office as in the courts.

Young v. Rogers, 1880 C. D. 178, 18 O. G. 733.

The failure to make objection by the contestant operates to cure a defect in a preliminary statement so far as he is concerned, in analogy to the rules of pleading.

White v. Farmer, 1874 C. D. 19, 5 O. G. 338.

(3) *Effect of Preliminary Statement.*

Can applicant go back of the dates alleged in his preliminary statement in a bill in equity under R. S. 4915?

See Greenwood v. Dover, 194 F. R. 95.

It is well settled that a party to an interference is bound by the allegations of his preliminary statement. (123 O. G. 1665, 122 O. G. 1726, 115 O. G. 804, 87 O. G. 1399.)

Phillips v. Sensenich, 132 O. G. 677.

The appellee contends that the allegation in the preliminary statement of B to the effect that he constructed an experimental machine in January, 1901, does not amount to an allegation of a reduction to practice, and hence, in respect of that machine and the two other machines thereafter constructed, to which no date is given, limits B to the date of his application as his first reduction to practice. We can not concur in this view of the effect of the statement. It is not so precise as it might have been and if exception had been taken to it on that ground, *in limine* its amendment might possibly have been compelled; at any rate, if unamended, after exception, the limitations of its averments now insisted upon might reasonably imposed.

Burson v. Vogil, 1907 C. D., 131 O. G. 942.

Unfortunately for them, under the rules of the Patent Office they are bound by the allegations of their preliminary statement that they did not reduce to practice the invention of the subject matter of this count until September, 1900.

Lowrie v. Taylor, 1906 C. D. 713, 123 O. G. 1665, 27 App. D. C. 522.

No evidence of conception prior to the date alleged could have been considered. (Cases cited.)

Neth & Tamplin v. Ohmer, 1906 C. D. 693, 123 O. G. 998, 27 App. D. C. 319.

F was refused permission to file an amended statement and in proceedings such as these we do not think that even consent of counsel, unless expressly approved by the Commissioner of Patents, warrants ignoring a rule of the Office that parties are limited to the dates set out in their preliminary statements, especially where leave has been asked and refused to permit the filing of an amended preliminary statement. Cases may often arise where the interest of the parties and the public will be best subserved by permitting dates earlier than set forth in preliminary statements to be proven. It should,

however, be done under the supervision of and with the approval of the Office.

Fowler v. Boyce, 1906 C. D. 659, 122 O. G. 1726, 27 App. D. C. 48-55.

Where a party in order to prevail depends upon earlier dates than those alleged in his preliminary statement and permission to amend the statement to set out said earlier dates has been refused the testimony relating to such earlier dates must be disregarded.

Fowler v. McBerty, 1906 C. D. 585, 121 O. G. 1015, 27 App. D. C. 41.

The meaning of words used in a preliminary statement must be ascertained at affiant's peril.

Dunn v. Halliday, 1905 C. D. 510, 119 O. G. 1261.

It is essential in interference proceedings that preliminary statements made by the respective parties without knowledge of their opponents' cases should not be disregarded where the proofs are taken.

Fowler v. Boyce, 1905 C. D. 615, 118 O. G. 2534, App. D. C. 48-55.

We have had occasion several times and for reasons satisfactory now as then, to approve the practice of holding the parties strictly to the dates given therein. (Bader v. Vajen, 14 App. D. C. 254; Stevens v. Seher, 11 App. D. C. 251; Cross v. Phillips, 14 App. D. C. 236.)

Hammond v. Basch, 115 O. G. 804, 24 App. D. C. 469,

Rule 110 and many published decisions have contained specific warnings to applicants that the statements must be carefully prepared and therefore there is no excuse for negligence in their preparation.

Woodward v. Kennedy, 1903 C. D. 166, 104 O. G. 1394.

The rule that one is bound by the statements in his preliminary statement applies only to the proceedings in which the parties are involved.

Sievert v. Shuman, 1896 C. D. 47, 76 O. G. 1714.

An allegation that the invention was reduced to practice in part at a certain date, held to limit affiant.

Carty v. Kellog, 1895 C. D. 83, 73 O. G. 285, 7 App. D. C. 542.

Warnant v. Warnant, 1880 C. D. 36, 17 O. G. 265.

An applicant is not permitted to carry his invention back of the date set up in his preliminary statement.

Hunt v. King, 1880 C. D. 22, 17 O. G. 200.

The preliminary statement goes for nothing as affirmative proof of the date of or fact of invention.

Lauder v. Crowell, 1879 C. D. 177, 16 O. G. 405.

The proof of the date of invention may be extended for-

ward but not backward from the date fixed in the preliminary statement.

Connor v. Williams, 1878 C. D. 137, 15 O. G. 387.

Evidence tending to show a date of invention earlier than that put down in the preliminary statement should be disregarded.

Hovey v. Hufeland, 1872 C. D. 229, 2 O. G. 493.

The testimony should be restricted to a substantial adherence to the date of invention set up in the preliminary statement.

Walpuski v. Jacobsen & Faber, 1876 C. D. 114, 9 O. G. 964.

The preliminary statement is conclusive against the party filing it, but can not be used as evidence against the adverse party.

Kenyen v. Wesson, 1871 C. D. 91; Schenck v. Rider, 1870 C. D. 135; Anson v. Woodbury, 1877 C. D. 49, 12 O. G. 1.

(4) *Inaccuracy—Variation in Proof.*

The looseness of assertion in the statement is inexcusable and tends to discredit him. (La Flare v. Chase, 74 O. G. 1735; Shafer v. Dolan, decided June 5, 1904.)

Blackman v. Alexander, 1903 C. D. 521, 113 O. G. 1703.

That a device alleged to be a model was in fact a reduction to practice is a variation that will not be permitted.

Basch v. Hammond, 1904 C. D. 474, 113 O. G. 552.

The allegations of M in his preliminary statement are so manifestly inaccurate that his whole case is rendered doubtful thereby.

Miles v. Todd, 1904 C. D. 420, 112 O. G. 1479.

The proof of such reduction to practice is on the part of both parties several months later than as alleged in the preliminary statement. This fact would indicate a reprehensible looseness of assertion in the preliminary statements, which tends to discredit both parties.

Shaffer v. Dolan, 1904 C. D. 592, 108 O. G. 2146.

Where there is a "Preliminary Statement" which has the alleged dates of conception and disclosure of a device within the issue of the interference sustained by the testimony and the date of reduction to practice is not sustained, but a later date is established, it can not be contended that the P. E. refers to a device not in issue. The Preliminary Statement is a valid one, and there is presented the simple case of one

of the dates in such statement having been erroneously alleged.

Storrie, 245 O. G. 845.

(5) *Reduction to Practice.*

If both parties reduced to practice on the same day priority will be awarded to the first to conceive.

McParland v. Ball, 231 O. G. 603.

These experiments sufficiently demonstrated the practicability of the invention and therefore amounted to reduction to practice.

Slingluff v. Sweet, 230 O. G. 659.

An applicant can not avail himself of a reduction to practice in a foreign country.

Loriner v. Erickson, 227 O. G. 1445.

Taking into consideration the original attitude of the appellant with reference to this device, its peculiar construction and the manner of its use, we are satisfied, as was the Patent Office, that the thing which is now caller a mixer was intended for and was in fact merely a discharge spout.

Ruggles v. Ash, 226 O. G. 699.

An experimental use apart from the complete apparatus for which it was intended held a reduction to practice.

Creveling v. Jepson, 226 O. G. 339.

The petitioner should allege his reduction to practice positively in the terms of the rule, or should comply with the Examiner's requirement for a statement alleging whether the device was successfully used.

Klocke v. Burk, 189 O. G. 779.

A design patent as evidence of conception and reduction to practice.

Lowrie v. Taylor & Taylor, 186 O. G. 1681.

This allegation of reduction to practice should be alleged positively, either in the terms of the rule, or in such other language as will leave no question as to the actual reduction to practice of the invention.

Williams v. Foyer and Kurz, 142 O. G. 1114.

Filing of an incomplete application not a constructive reduction to practice. (Payment of fee.)

McElray, 140 O. G. 1207.

The filing of an application by an official of the Patent Office does not constitute a constructive reduction to practice.

McElray, 140 O. G. 1207.

It was the idea of the telescoping arm that constituted the invention. No patent could have been obtained on the set-

screw because that was old in the art. We, therefore, hold that this set-screw was a mere mechanical addition to the device and obvious to any one skilled in the art, and that its absence did not prevent the original test from constituting a reduction to practice.

Howard v. Bowes, 137 O. G. 733.

It is well settled that after reduction to practice a mere delay of the inventor in applying for a patent, in the absence of concealment, abandonment or suppression, will not prevent the inventor from getting a patent based upon priority of invention. (Rolfe v. Hoffman, 26 App. D. C. 336.)

Rose v. Clifford & Newell, etc., 135 O. G. 1361.

An inventor conceived an invention and embodied it in a model which was submitted to the company that controlled the sale of the machine for which the improvement was designed, but the company refused to purchase the invention and returned the model to the inventor. An officer of the company disclosed it to the foreman of the factory of a subsidiary corporation, who set about adapting it to the machine made by them for the parent company, and a completed machine was built embodying such invention. Held that such a reduction to practice does not inure the inventor.

Howell v. Hess, 132 O. G. 1974.

When a publication is sufficient to constitute a bar against all later inventors, it should manifestly be accepted as establishing the right of the one who made that disclosure and who with reasonable promptness filed his application for patent in the United States.

Marconi v. Shoemaker, 1907 C. D., 131 O. G. 1939.

Article in the "Electrical World and Engineer," by Marconi, as a constructive reduction to practice.

Marconi v. Shoemaker, 1907 C. D., 131 O. G. 1939.

Altered machine, evidence as to extent and kind of alteration necessary.

Burson v. Vogil, 125 O. G. 2361.

The same act or sets facts may or may not constitute reduction to practice, modified, as they may be by the special circumstances of the particular case.

Andrews v. Nilson, 123 O. G. 1667.

An inventor having reduced his invention to practice is entitled to a period of two years in which to put the same into public use and on sale without a forfeiture of his right to receive a patent based upon an application filed before the statutory bar has arisen. Neither abandonment nor forfeiture

within that period can be presumed but must be proved.

Rolfe v. Hoffman, 121 O. G. 1350.

It is necessary to prove a fact from which it can be concluded that the reduction to practice was accomplished.

Bauer v. Crane, 118 O. G. 1071.

In order for a device to constitute a reduction to practice of an invention defined in an issue of an interference, it is essential for that device to embody all the elements of the combination defined by the issue. If the elements are not present in the device which is offered in evidence and on which reliance is made the absence of these elements should be explained by the testimony.

Robinson v. Seelinger, 114 O. G. 262-3.

Buffer springs were tested by being placed under a steam hammer and were broken. Held that the fact that they were broken shows that the springs were not a successful reduction to practice.

Gallagher v. Hien, 114 O. G. 97.

A failure to disclose an unclaimed element does not prevent the disclosure from being good evidence.

Paul v. Johnson, 106 O. G. 2013-14.

An accidental use of device will not serve to establish a date of reduction to practice.

Whitney v. Howard v. Stanley & Stanley, 104 O. G. 1391.

"MacDonald only testifies that the machine was 'tried' and was used at 'intervals.' He does not state the result of this use.

"It is not necessary, of course, that the success must be a commercial success or a very high degree of success; but it is essential that it be established that there was at least some degree of success."

MacDonald v. Edison, 105 O. G. 975.

The tests of that machine were sufficient to establish its practicability and under well settled principle of law a commercial use of it was not necessary to constitute a reduction to practice. (Roe v. Hanson, decided by Court of Appeals of the District of Columbia, April 1, 1902.)

Donnelly v. Wyman, 103 O. G. 657-9, 104 O. G. 310.

A shop test with dummy matches, made under all of the other conditions of actual use, demonstrates the practicability of the device as effectually as would use with real matches.

Donnelly v. Wyman, 103 O. G. 657-8; affirmed, 104 O. G. 310.

An allowable application is a constructive reduction to practice.

Osborne v. Hotsapillar, 1903 C. D. 47, 102 O. G. 1296.

By a reduction to practice a party's rights are perfected and are subject to be defeated only by some such course of conduct as that mentioned in Mason v. Hepburn, 84 O. G. 147; Estey v. Newton, 86 O. G. 799; Osborn v. Holspillar, 102 O. G. 1296.

Testifying to the identity of a piece of rubber tube produced by the party in interest with one used two years before in a construction that has since remained hidden from view lacks the weight necessary to overcome a former regularly issued patent.

Ruete v. Elwell, 95 O. G. 2119-22.

An allegation that the invention was reduced to practice in part at a certain date, held to limit affiant.

Carty v. Kellog, 1895 C. D. 83, 73 O. G. 285.

While the destruction or dismantling of a first construction and the loss of some of its parts or their use in making other machines are sometimes important, they are only important when depending upon other circumstances tending to cast doubts upon the claims of the earlier reduction to practice.

Funk v. Whitely, 17 O. G. 280.

(6) *Reduction to Practice Indicated by Utility and Operativeness.*

The ability to accomplish the general object of the machine apparently necessary. Failure apparently due to matters outside the invention.

Janin v. Curtiss, 231 O. G. 1539.

Taylor has offered to have the exhibit tested in order to show that it is now in operative condition. The result of such a test would, however, be immaterial.

The question involved is whether Taylor has established a reduction to practice and that must be decided on the record as presented.

Taylor v. Gilman, 158 O. G. 883.

A device proving itself.

Rolfe v. Kaisling v. Lieper, 143 O. G. 562.

A decision depends upon the facts of each case. Cases classified into three groups: First, those in which the device is simple so that it is clear that it will operate without trial; second, the device workable, but mechanically defective; third, those in which the device requires that its operations be demonstrated by trial. (Cases cited.)

In cases of the second and third class long delay in putting the machine in actual use has always been regarded as a

potent circumstance in determining whether the test was successful or only an abandoned experiment.

Sydeman & Meade v. Thoma, 141 O. G. 866.

Receiver for wireless messages. Sensitiveness of an iron core in a varying field. The invention clearly belongs to that class of inventions which require actual use or thorough test to demonstrate its practicability and in the absence of satisfactory proof of actual use or successful test it must be held that the devices were merely experimental in character and that none of them constitute a reduction to practice.

Marconi v. Shoemaker, 1907 C. D., 131 O. G. 1939.

A machine may be crude in construction but if it contains all the essential elements of the invention of the issue, and in its operation successfully demonstrates its practical efficacy and utility, reduction to practice is accomplished.

Burson v. Vogel, 1907 C. D., 131 O. G. 343, 29 App. D. C. 328.

Utilizing old material. This may be done without negativing reduction to practice.

McCormick v. Hullwood, 1907 C. D., 130 O. G. 1487, 31 App. D. C. 106.

Reduction to practice must produce something of practical use coupled with a knowledge, preferable by actual trial, that the thing will work practically for the intended purpose.

Sherwood v. Drewsen, 1907 C. D., 130 O. G. 657, 29 App. D. C. 161.

The device in controversy belongs to the type of simple devices requiring no demonstration referred to in Mason v. Hepburn, 13 App. D. C. 510; Roe v. Hanson, 19 App. D. C. 559, and analogous cases rather than to the devices disclosed in MacDonald v. Edison, 21 App. D. C. 527 and analogous cases.

Rolfe v. Hoffman, 1906 C. D. 588, 121 O. G. 1350, 26 App. D. C. 336.

When the exhibits were made and tested "the work of the inventor was finished, physically as well as mentally," and there was a complete reduction to practice.

Rolfe v. Hoffman, 1906 C. D. 588, 121 O. G. 1350, 26 App. D. C. 336.

Tests admitted not to be very satisfactory, plant soon dismantled, friends refused to assist in view of experiments, no application for a patent, no further attempts to operate for several years when other experiments were attempted, held merely abandoned experiment.

Pohl v. McKnight, 1905 C. D. 549, 119 O. G. 2519.

The fact that one of the parts of the device broke after long use is not a sufficient reason for denying the inventor thereof the benefit of a reduction to practice (under the circumstances).

Foote v. Wenk, 1905 C. D. 391, 118 O. G. 1366.

Where the construction of a device shows that it was adapted only for temporary experiments and there is no convincing evidence that it proved satisfactory in use, it must be regarded as an abandoned experiment.

Andrews v. Nilson, 1905 C. D. 384, 118 O. G. 1363.

Where an invention is for an electrical circuit protector formed of delicate cooperative parts to be used in an art where an unexpected change in the current may cause vastly different effects. *Held* that such device needs a test in order to establish its practicability. It is not sufficient to prove that a device was used, it must be proved that it was successfully used.

Rolfe v. Hoffman, 1905 C. D. 352, 118 O. G. 833.

It is not sufficient to show that a machine was built; it must be shown that it was capable of successfully performing the work for which it was designed.

O'Connell v. Schmidt, 1905 C. D. 342, 118 O. G. 588.

Such an invention does not belong to the class of simple inventions which were considered in Mason v. Hepburn, 1898 C. D. 510, 84 O. G. 147, 13 App. D. C. 86; Loomis v. Hauser, 1902 C. D. 530, 99 O. G. 1172, 19 App. D. C. 401; Coroch v. Barmett, 1904 C. D. 650, 110 O. G. 1431.

O'Connell v. Schmidt, 1905 C. D. 342, 118 O. G. 588.

Evidence of reduction to practice must embrace all the elements of the issue, leaving nothing to inference merely.

Robinson v. Seelinger, 1905 C. D. 640, 116 O. G. 1735, 22 App. D. C. 237.

In a case where the new devices are of an old type and their novelty consists in specific constructions of that old type, it may well be that their practical utility may be determined without actual use of them under conditions of industry. But not so where, as here, the type of device is a new type.

Paul v. Hess, 1905 C. D. 610, 115 O. G. 251, 24 App. D. C.

The commercial article would be made of metal, or of some substance more durable than wood; yet the wooden article is operative and is a complete reduction to practice.

Norden v. Spaulding, 1905 C. D. 568, 114 O. G. 1827, 24 App. D. C. 286.

A machine working imperfectly because of a mechanical

defect, roughness of work, may nevertheless be a reduction to practice.

Cummins v. McKenzie, 1904 C. D. 180, 110 O. G. 1167.

The operation of the tip in issue was self-evident and therefore no test was necessary to constitute reduction to practice.

Shaffer v. Dolan, 1903 C. D. 422, 107 O. G. 539.

A specific form held to constitute reduction to practice notwithstanding it might be improved.

Slaughter v. Halle, 1902 C. D. 210, 99 O. G. 2771, 21 App. D. C. 19.

It seems it is not necessary that the machine should be one capable of doing full and satisfactory and economical work day after day in an industrial plant.

Kelly v. Fynn, 1900 C. D. 339, 92 O. G. 1237, 16 App. D. C. 573.

A material part of an apparatus may be separate from the apparatus and temporarily held up to its work, and yet constitute reduction to practice.

Andrews v. Nilson, 1906 C. D. 717, 123 O. G. 1667, 27 App. D. C. 451; Loewer v. Ross, 1896 C. D. 40, 76 O. G. 1711.

(7) *Diligence in Reducing to Practice.*

Does not require an inventor to devote his entire time thereto, nor can he be held responsible for reasonable delays in the preparation of the application.

Courson v. O'Connor, 224 O. G. 1057.

We have heretofore had occasion to remark that the law encourages such delay as is required to test the thoroughness and utility of supposed inventions, and to prevent the Patent Office from being overloaded with applications for patent for crude and imperfect devices.

Woods v. Poor, 130 O. G. 1313.

Diligence will not wait on business arrangements. (Kaksen v. Hitherington, 88 O. G. 1157.)

Paul v. Hess, 115 O. G. 251.

A person may not excuse himself for delay by showing that he was trying to commercially exploit the invention.

Seeberber v. Dodge, 113 O. G. 1415.

It is necessary for O, if he is to prevail in this proceeding, to establish the fact that he was diligent in reducing his invention to practice from a time just prior to the date on which Norton entered the field.

Ocumpaugh v. Norton, 110 O. G. 1723.

Diligence, lack of, not attributable to the first to reduce to practice.

Paul v. Johnson, 109 O. G. 807.

Diligence will not wait on business arrangements.

Kassen v. Hetherington, 88 O. G. 1157; Paul v. Hess, 113 O. G. 847-9.

An accidental, occasional, incomplete and imperfect operation of a structure, especially when said structure was constructed and designed to perform another and wholly different function, is not sufficient to establish the fact of invention. Such structure is not a reduction to practice.

Brooks v. Hillard, 1903 C. D. 335, 106 O. G. 1237.

In an interference proceeding the subject matter of which is an article of manufacture, an applicant is not chargeable with laxness, when he has manifested his willingness to disclose the invention by filing an application for a machine to make such article.

Blood v. Brown, 105 O. G. 496.

In the present case it was the combination of the issue which proved unsatisfactory and not some other part of the machine. A plunger and flexible plunger rod are essential features of the present issue, and until they proved satisfactory the invention was not complete.

Swihart v. Mauldin, 1902 C. D. 137, 99 O. G. 666, 19 App. D. C. 570.

In order to constitute a reduction to practice, it is necessary that the device should be capable of performing the function for which it was intended.

Loomis v. Hauser, 1902 C. D. 131, 99 O. G. 450, 19 App. D. C. 401.

Apparently not a reduction to practice unless utility was recognized.

Silverman v. Hendrickson, 1902 C. D. 123, 99 O. G. 445, 19 App. D. C. 381.

If a device would have worked, without doubt and clearly, on the omission of an element, but such element was not omitted, it was not a reduction to practice.

Latham v. Armat, 1901 C. D. 337, 95 O. G. 252, 17 App. D. C. 345.

There seems to be a tendency to require such proof of practical operation of a device, after long delay, especially if some repairing was done after the alleged operation, as almost precludes the use of such testimony.

Howard v. Hey, 1901 C. D. 375, 95 O. G. 1647, 18 App. D. C. 142.

The law encourages such delay as is required to test the thoroughness and utility of supposed inventions, also the law fosters diligence.

Griffin v. Swenvers, 89 O. G. 191.

The question of due diligence is one to be determined by the particular circumstances of each case.

Griffin v. Swenvers, 89 O. G. 191.

It has sometimes been held in the decisions of the Patent Office that the necessity for diligence on the part of the first conceiver does not arise until the date of the second conception, but this we think can not be supported on principle.

Christie v. Seybold, 64 O. G. 1650.

(8) *Model as a Reduction to Practice.*

A device which merely illustrates the mode of mechanical construction and operation of the conceived idea and which may be said to be an embodiment of the invention in visible form is not necessarily a reduction to practice, for though the device is operative as a mechanical movement there is no certainty that it will perform its function when put to use under full conditions of practical use.

Ocumpaugh v. Norton, 1905 C. D. 632, 115 O. G. 1850, 24 App. D. C. 296.

The lock is full sized and well made, and since it embodies the invention it constitutes a reduction to practice. The suggestion on behalf of Hope that it must be regarded as a mere model is clearly without force.

Voigt v. Hope, 1905 C. D. 30, 114 O. G. 763.

A model, no matter how well constructed, and notwithstanding the fact that it is complete in details and fully illustrative of an operative construction is not in law a reduction to practice.

Ocumpaugh v. Norton, 1904 C. D. 207, 110 O. G. 1723, 25 App. D. C. 90.

Making a full sized collar, exhibiting it to a number of persons and putting it on sale, is a reduction to practice. (Cites Lormis v. Hauser, 19 App. D. C. 401, in which a full sized illustrated model was held to be a reduction to practice.)

Couch v. Barnett, 1904 C. D. 650, 110 O. G. 1431, 23 App. D. C. 446.

A full sized working model not a reduction to practice. The statement that by complying with (4) applicant meant

to comply also with (3) and (5) is ingenious but not convincing.

Guett v. Tregening, 1905 C. D. 23, 114 O. G. 544.

It is well settled that a model, no matter how complete, can not establish reduction to practice (Hunter v. Stikeman, 85 O. G. 610).

Paul v. Hess, 1904 C. D. 475, 113 O. G. 848, 24 App. D. C. 462.

If a model is full size and capable of use to a sufficient extent to demonstrate the practical utility of the invention, it may be a reduction to practice.

Hammond v. Basch, 1905 C. D. 615, 115 O. G. 804, 24 App. D. C. 469.

(9) *Extent of Use.*

It is important that the extent of use of a complete invention be disclosed for reasons other than that it may possibly disclose the statutory bar of public use. It is not necessary that such disclosure should be prolix and give unnecessary details, but it should set forth in concise and explicit terms, the extent of use of the completed invention.

Loeben v. Hamrick, 1899 C. D. 228, 89 O. G. 1672.

Courts do not relieve against mistakes of law.

Dahlgren v. Crocker, 1902 C. D. 107, 92 O. G. 2586.

The extent and kind of use of the invention should be stated if the invention was perfected previous to two years before filing the application.

Dermody v. Pennock, 1878 C. D. 93, 14 O. G. 202.

So far as public use is concerned on an invention completed within two years prior to filing the application, it is unnecessary that the extent of use after completing be stated, if the preliminary statement is clear in setting forth the actual date of completion, and its use in a single instance. Where both are applicants the statement of such public use by one can not bar the other without an opportunity is afforded of examination and cross-examination of witnesses.

Wheat, 1878 C. D. 110, 14 O. G. 787.

(10) *Conception of the Invention.*

It is the practical conception which the patent law requires.

Storck v. Reicklielm, 227 O. G. 365.

The making of the device, therefore, amounted to a demonstration of utility and constituted reduction to practice. Indeed, it would be difficult to find a clearer case. *Not used.*

General Electric Co. v. Duncan Electric Mfg. Co., 165 O. G. 242.

Mere knowledge by a foreign inventor or his agent is not equivalent to a conception of the invention in this country.

Gueniffet, Benoit & Vicault v. Wictorsohn, 131 O. G. 1685.

That H may have had a certain definite result in mind is quite probable, but that he had devised any means for accomplishing that result is disproved by the surrounding fact and circumstances.

Hansen v. Dean, 129 O. G. 483.

A case that passes on the subject matter of this rule.

Bless v. McElray, 128 O. G. 458.

At most this buckle produced by R as G's original disclosure, was an experimental model put away in a drawer for years.

It was in the nature of an abandoned experiment.

Gibbons v. Peller, 127 O. G. 3643.

A complete conception as defined in an issue of priority of invention is matter of fact and must be clearly established by proof. The conception of the invention consists in the complete performance of the mental part of the inventive act.

Ritter v. Krakaw & Conner, 111 O. G. 1935-6.

It seems probable that Talbot, after seeing Monell's process performed, has convinced himself that it was what he had done some years before, must have been an afterthought on his part in the light of Monell's disclosure, and the evidence does not support his claims. It must be held that Talbot had no conception of the process in issue until he had seen it performed by Monell.

Talbot v. Monell, 107 O. G. 1093.

A specific form is sufficient to show a conception and disclosure of the generic invention.

Slaughter v. Halle, 99 O. G. 2771.

Date of conception.

Wallace v. Scott, 88 O. G. 1704.

"A reasonable doubt on this point will be resolved against the inventor, and special circumstanc as, for example, unreasonable delay in making particular or commercial use of the invention or in applying for a patent and the like, would have a tendency to raise this doubt in a particular case."

Reute v. Elwell, 87 O. G. 2119.

"It is also apparent that he had no idea at the time and did not have until he saw Elwell's patent of the additional uses and advantages of a rubber insulating tube capable of being bent or curved without fracture either independent of or in combination with the metal armor tube. His failure,

however, to perceive this additional use and advantage would not bar his right to claim it as a part of his invention if it was a necessary incident, for it is well settled that one who is the first to make an invention is entitled to claim all the uses and advantages that belong to it, that is to say, that follow directly from it as described or manufactured whether they were conceived by him or not."

Reute v. Elwell, 87 O. G. 2119.

(11) *Disclosure of the Invention.*

Witness says he described the invention at a certain dinner. All the testimony goes to fixing the date of the dinner and there is no doubt but that a dinner occurred at that date. But there is no evidence of the disclosure at that time.

Steinmetz v. Thomas, 137 O. G. 479.

The communication of an idea of the desirability of accomplishing a certain result without a disclosure of the means to be employed, can not be regarded as a communication of an invention.

Fenner v. Blake, 134 O. G. 2244.

A wife is now a competent witness for or against her husband though she is apparently not compellable to testify.

Patee v. Cook, 167 O. G. 835.

Disclosure to a draftsman alleged but drawings and machine do not show it.

It must, therefore, be held on this branch of the case that appellant has failed to overcome the heavy burden resting upon him.

Peters v. Pike, Jr., 143 O. G. 259.

An effective disclosure is one that enables one skilled in the art to embody the invention in physical form.

Hopkins v. Newman, 131 O. G. 1161.

The sufficiency of a machine upon which a party would rely to establish his dates of invention as disclosure of the invention in issue should be determined by the official when the machine is introduced in evidence and in connection with the testimony which may be taken concerning it.

Barr v. Bugg, 122 O. G. 2061.

Competency of wife's.

Narsh v. Rein v. etc., 43 O. G. 1453; Dobeck v. Wovolny, 58 O. G. 804; Crawford v. Seickentstein, 61 O. G. 1480; Kowen v. Quinet, 23 O. G. 1329; Workman v. Cork, 107 O. G. 835; Patee v. Westcott, 1880 C. D. 167; Harton v. Barrett, 114 O. G. 975; Davis v. Kennard, 131 O. G. 695; Davis v. Garrett, 123 O. G. 1991.

Disclosure—Skilled in the art.

Papin v. Strong, 100 O. G. 931.

Disclosure in the sense of the patent law must be made ordinarily to persons competent to understand and appreciate the alleged invention. Otherwise there is no true disclosure. Examples:

Of the incompetent, Eastman v. Huston, 95 O. G. 2064; of the competent, Papin v. Strong, 100 O. G. 931.

When an inventor disclosed one form of invention to his attorney but did not disclose a form having a fewer number of elements, etc., it tends to show that he had not thought of the second form at that time.

Pierce v. Hallett, 18 O. G. 265.

(12) *Additional Cases.*

Cases that pass on the subject matter of this rule:

Clement v. Richards v. Meissner, 1904 C. D. 492, 113 O. G. 1143; Quest v. Ostrom, 1903 C. D. 348, 106 O. G. 1501; Fowler v. Boyce, 1906 C. D. 580, 121 O. G. 1014, 27 App. D. C. 48-55; Davis v. Garrett, 1906 C. D. 724, 123 O. G. 1991, 28 App. D. C. 9; Steinmetz v. Thomas, 1906 C. D. 478, 125 O. G. 1351, 31 App. D. C. 574; Matthes v. Burt, 1904 C. D. 296, 111 O. G. 1363, 24 App. D. C. 265; Gallagher, Jr., v. Hien, 1905 C. D., 115 O. G. 1330, 24 App. D. C. 269; Frunk and Mickle v. Whitely, 1905 C. D. 34, 114 O. G. 971; Robinson v. Phresher, 123 O. G. 2976. (Cites Robinson v. Phresher, 123 O. G. 2627; Frunk v. Whitely, 25 App. D. C. 313-315.)

Rule 111. When Opened to Inspection.

The preliminary statements shall not be opened to the inspection of the opposing parties until each one shall have been filed, or the time for such filing, with any extension thereof, shall have expired, and not then unless they have been examined by the proper officer and found to be satisfactory.

Any party in default in filing his preliminary statement shall not have access to the preliminary statement or statements of his opponent or opponents until he has either filed his statement or waived his

right thereto, and agreed to stand upon his record date.

A party who alleges no date in his preliminary statement earlier than the filing date of the application or applications of the other party or parties shall not have access to the preliminary statement of said party or parties.

CONSTRUCTIONS.

A preliminary statement unopened because the opposing party failed to overcome record date is not accessible even after patent issued.

Bacon, 1902 C. D. 151, 99 O. G. 861.

If a person makes a motion that requires a suspension of the running of the time limited he must take notice that the time begins to run again immediately upon the determination of the motion.

Whipple v. Sharp, 1902 C. D. 2, 98 O. G. 225.

Where an action is required to be taken within a certain time after a decision the date of the decision and not the date of the receipt of the notice of it is what governs.

Whipple v. Sharp, 1902 C. D. 2, 98 O. G. 225.

The statement will not be returned even if it is not opened.

Baxter, Jr., 1891 C. D. 147.

Rule 112. Notice to Amend.

If, on examination, a statement is found to be defective in any particular, the party shall be notified of the defect and wherein it consists, and a time assigned within which he must cure the same by an amended statement; but in no case will the original or amended statement be returned to the party after it has been filed. Unopened statements will be removed from interference files and preserved by the office, and in no case will such statements be open to the inspection of the opposing party without authority from the Commissioner. If a party shall refuse to file an amended statement he may be restricted to his

record date in the further proceedings in the interference.

CONSTRUCTIONS.

Where the application was made by the administrator and assigned, the assignee may make the statement.

The preliminary statement required in interference proceedings are in the nature of pleadings which require certainty of expression. It is within the jurisdiction of the Examiner of Interferences to require an amended statement whenever, in his opinion, the circumstances are such as to throw doubt upon the accuracy of the statement already submitted. The decision of the Examiner will not be reviewed except in a clear case.

Opaller v. Huges, 158 O. G. 481.

The rule requires that these dates and the extent of use be set forth, or, if there has been no model reduction to practice or use, that such facts be specifically disclosed. A preliminary statement lacking this should not be accepted until attention has been called to its defects and opportunity has been given for amendment. The objection should have been made before the parties were permitted to inspect the statements of their opponents. Not having been made then it should, in view of all the circumstances of the case, be made now.

Schoonmaker v. Sinz, 123 O. G. 2974.

The Office can not strike out part of a statement, but may strike out the entire statement because a part of it is improper, and then require a statement omitting the improper part.

Shaw v. Gally, 1902 C. D. 348, 100 O. G. 3014.

Rule 113. Motion to Amend.

In case of material error arising through inadvertence or mistake, the statement may be corrected on motion (see Rule 153), upon a satisfactory showing that the correction is essential to the ends of justice. The motion to correct the statement must be made, if possible, before the taking of any testimony, and as soon as practicable after the discovery of the error.

HISTORY.

Rule introduced about 1878.
See Historical Notes to Rule 110.

CONSTRUCTIONS.

IN GENERAL.
EXCUSE FOR MISTAKE.

In General.

The fact that applicant was not notified that two design applications by his opponent were included, is sufficient to warrant the allowance of an amendment.

Hocker v. Farr, 193 O. G. 1220.

Insufficient showing to warrant the allowance of an amendment.

Richnitzer v. Bernegau, 193 O. G. 512.

A motion to amend depending upon testimony should be made at the final hearing and should be appealed as a part of the decision on priority.

Grammeter v. Thropp, 190 O. G. 266.

Notice that motion to amend would be made on final hearing.

Perre v. Thoma, 188 O. G. 1053.

An amendment allowed in view of loss of memory due to sickness.

Lindstrom v. Macdonald, 187 O. G. 831.

A motion under this rule may very properly be postponed to the final hearing where it is necessary to consider all the testimony in deciding the motion.

Gammeter v. Thropp, 178 O. G. 320.

A preliminary statement allowed to be amended so as to permit evidence to show that an alleged model was in fact a full sized machine or apparatus.

Klink v. Kruse, 177 O. G. 1300.

The discretion of the Commissioner will not ordinarily be disturbed by the Court of Appeals.

Thomas v. Wientraub, 177 O. G. 772.

In matters of record or publications which do not depend upon fallible witnesses less strictness is required.

Cramer et al. v. Carrier, 177 O. G. 769.

Amendments largely within discretion of Examiner.

Cramer et al. v. Carrier, 177 O. G. 769.

An amendment will not be permitted except upon the most satisfactory proof of actual mistake and a showing of the

utmost care in the preparation of the original statement. Cases.

Whitall v. Gillispie v. Blaw, 171 O. G. 744.

The showing rather indicates that if the drawings had been examined with reasonable diligence the allowed new matter would have been discovered. Moreover neither a drawing nor a copy of them has been produced. Showing insufficient.

Goldberg v. Crumpton v. Carlin, 141 O. G. 286.

A motion to amend a preliminary statement will not be granted in the absence of a valid ground therefore, even though the proposed amendment does not seek to change the sequence of dates, but only to avoid any unfavorable presumptions arising owing to the discrepancy between the statement and testimony.

Ridgway v. Tilyon, 137 O. G. 979.

The Examiner of Interferences will not hereafter set a limit of appeal in decisions granting motions to amend preliminary statements. He will, however, set a limit of appeal in his decisions denying leave to amend preliminary statements.

Smith & Wickes v. Emerson v. Sanders, 133 O. G. 1433.

The failure of H, the assignee, to communicate this information to P, or to obtain data for the statement for counsel, clearly shows such negligence on the part of the parties interested as should preclude the granting of their request for relief.

Anderson v. Peck, 133 O. G. 229.

It is well settled that the applicant is chargeable with such acts of negligence on the part of counsel.

Anderson v. Peck, 133 O. G. 229.

No amendment after testimony.

Green v. Farley, 132 O. G. 235.

Lack of proper care. It is discretionary with the Examiner, by whom the testimony is to be considered, whether or not he will postpone the consideration of the motion until the final hearing.

Smith v. Ingram, 131 O. G. 2420.

The showing is deemed insufficient to warrant the amendment for reasons indicated above and more fully set forth in 112 O. G. 449; 108 O. G. 56; 116 O. G. 874.

Johnston v. Erekson and Carlson v. Burnard, 131 O. G. 2419.

After making preliminary statement, applicant consulted his wife and stenographer, and this recalled a matter that had

escaped his memory. In view of prompt action amendment allowed.

Davis v. Kinnard, 1907 C. D., 131 O. G. 695.

Apparently if a motion is made to amend in view of the fact that applicant had recalled material facts in consultation with others, the names of those consulted should be given.

Davis v. Kinnard, 1907 C. D., 131 O. G. 695.

Amendments to preliminary statements are to be permitted, after a party has had opportunity to inspect his opponent case, only in cases where bona fide mistakes of fact have been made and a full and clear showing is made that there was no negligence in discovering the true facts.

Borg v. Strauss, 130 O. G. 2719.

A party will not be permitted to amend his preliminary statement to carry back his date of disclosure to cover the date proved by his opponent in a prior interference with a third party where the amended date is earlier than that set up in a preliminary statement filed three years before in an interference between his and said third party and where the affidavit in support of the motion indicates an uncertainty whether the alleged disclosure took place prior to the date originally given.

Beall, Jr., v. Lyon, 126 O. G. 388.

Whether leave shall be given to amend a preliminary statement is a matter that rests in the discretion of the Commissioner and is not reviewable save possibly in a case of palpable abuse of that discretion.

Neth & Tamplin v. Ohmer, 1906 C. D. 693, 123 O. G. 998, 30 App. D. C. 478.

The filing of a statement after other statements are opened will not be permitted except in a clear case.

Dutcher v. Matthew v. Dutcher & Peters v. Jackson, 1905 C. D. 455, 118 O. G. 2538.

The question of extension of time for filing preliminary statements is left wholly within the discretion of the Examiner of Interference and that from his decision upon these matters no appeal will lie. In rare cases to prevent hardship an appeal may be allowed. In all such cases the decision of the Examiner must be complied with until the appeal is allowed.

Ohmer v. Neth & Tamplin, 1905 C. D. 412, 118 O. G. 1686.

On a motion to amend a preliminary statement the question

is not whether the moving party would be able to prove his case if amendment were permitted but is whether the showing made warrants permitting amendment.

Neth and Tamplin v. Ohmer, 1905 C. D. 177, 116 O. G. 874.

Whether an amendment shall be allowed under the rules of practice of the Patent Office calls for the exercise of a wide latitude of discretion by the Commissioner and certainly nothing less than an abuse of that discretion, causing a palpable miscarriage of justice, would warrant the review and reversal of this action. (Cross v. Phillips, 14 App. D. C. 228.)

Hammond v. Basch, 1905 C. D. 615, 115 O. G. 804, 24 App. D. C. 469.

Amendment of preliminary statement, question not reviewed by the Court of Appeals.

Richards v. Meissner, 114 O. G. 1831, 24 App. D. C. 305.

Acts in foreign country.

Emmet v. Fullager, 1905 C. D. 52, 114 O. G. 1551.

The publication is something which is fixed and certain both as to date and subject matter. Under such circumstances the rule requiring that the utmost diligence must be shown to have been exercised in preparing the original statement may be applied with less strictness.

Fullagar v. Junggren, 1905 C. D. 51, 114 O. G. 1550; Davis v. Ocumpaugh v. Garrett, 1903 C. D. 1987, 104 O. G. 2440; Emmett v. Fullagar, 1905 C. D. 52, 114 O. G. 1551.

After the testimony of one of the parties has been taken, relying upon the dates alleged by the other party, he will not be permitted to amend his statement to change these dates without a most clear and satisfactory showing. (Franklin v. Morton v. Cooley, 95 O. G. 2063.)

Bliss v. Creveling, 1904 C. D. 381, 112 O. G. 499.

It would seem that in view of the fact that the consideration of Bauer's testimony is necessary in order to rightly determine whether or not he is entitled to amend his preliminary statement, this consideration should be postponed until the date or final hearing.

Bauer v. Crone, 1904 C. D. 336, 111 O. G. 1930.

In case of a clerical error where the motion to amend is made promptly, it is proper to allow it.

Osborn v. Mitchell, 1904 C. D. 254, 111 O. G. 300.

The burden was upon him to show that he could not have

made the discovery by diligent and careful search and he has not done this.

Hamilton v. Carroll v. Goldberg v. Stahlberg, 1904 C. D. 248, 110 O. G. 2510.

If a fact is well known when the preliminary statement is made and is not set forth therein, the failure to include it is negligence and is not a mistake of fact, such as to warrant the amendment of preliminary statement.

June v. Linn, 1904 C. D. 203, 110 O. G. 1430; Solley v. Peck, etc., 1903 C. D. 259, 105 O. G. 1262.

Refused to let contestant change model to full sized machine to correspond with the testimony under the circumstances of the case.

Parkes v. Lewis, 1904 C. D. 142, 110 O. G. 305.

If parties exercised the care in preparing their statements which they exercise in discovering evidence after knowing their opponent's dates, motions to amend preliminary statements would seldom be made and parties would never find themselves in the position of being unable to produce pertinent evidence because of their preliminary statements. Amendment not permitted.

Fowler v. Boyce v. Temple & Goodrum, 1904 C. D. 22, 108 O. G. 562.

The motion to amend is defective in that he merely alleges that he made a mistake as to his date of reduction to practice and wishes to amend. He does not state the date he wishes to allege nor the facts upon which the allegation is to be based.

Fowler v. Boyce v. Dyson v. McBerty, 1903 C. D. 434, 107 O. G. 544.

Failure to mention the finding of a sketch to his attorney, or make any move to amend until after he had learned from the testimony taken by Andrews what date it was necessary for him to allege which is in itself a sufficient reason for denying the motion.

Andrews v. Nelson, 1903 C. D. 287, 105 O. G. 2059.

Insufficient reasons for amendment, laches.

McHarg v. Schmidt & Maryland, 1903 C. D. 216, 105 O. G. 263.

A showing of facts upon which the Commissioner can reach the conclusion that the mistakes arose from inadvertence, must be made.

Brown v. Keeney, 1903 C. D. 211, 105 O. G. 260.

The fact that a motion to amend a statement is brought after the testimony of the opposing party has been taken is

always a suspicious circumstance, and the showing in support of such a motion is to be carefully scrutinized.

Pope & Mimo v. McLean, 1903 C. D. 186, 104 O. G. 2147.

If amendments to preliminary statements were permitted merely because the evidence shows the facts to be in accordance therewith, the rule requiring preliminary statements might as well be abolished.

Woodward v. Kennedy, 1903 C. D. 106, 104 O. G. 1393.

It must appear clearly that the party used all reasonable care and diligence in preparing his original statement and in discovering the facts he alleged therein.

Woodward v. Kennedy, 1903 C. D. 106, 104 O. G. 1393.

It is not believed that the desire of the Office to discover all the facts and to issue the patent to the one who is in fact the first inventor justifies it in relieving a party from the effects of such negligence as has been exhibited in this case.

Steiver, 1902 C. D. 381, 101 O. G. 1130.

An amendment refused because of negligence in the first preparation.

King v. Hansen, 1902 C. D. 378, 101 O. G. 1129.

An amendment stating date of making a model admitted.

Williams v. Liberman, 1902 C. D. 295, 100 O. G. 1332.

A new preliminary statement will not be admitted upon a redeclaration of the interference with part of the counts in it only.

Seaman v. Brooks, 1902 C. D. 267, 100 O. G. 685.

It is not stated what the additional facts are; nor is it stated that the utmost diligence was exercised in making the discovery. The affidavit does not state the ways and means employed in finding the new facts neither does it point out why the same ways and means could not have been earlier employed. The showing is not sufficient.

Seaman v. Brooks, 1902 C. D. 267, 100 O. G. 685.

An affidavit by the inventor and by another received in support of the motion. Where no testimony has been taken and the new dates are not earlier than his opponent's, the motion will the more readily be granted.

Gales v. Berrigan, 1902 C. D. 232, 100 O. G. 232,

Courts do not relieve against mistakes of law.

V. v. M. v. Cooley, 1901 C. D. 49, 95 O. G. 2063; Dahlgren v. Crocker, 1902 C. D. 107, 98 O. G. 2586.

The rule is that only the utmost diligence will be a sufficient showing. But may be relaxed under proper circumstances.

Silver v. Eustes, 1902 C. D. 91, 98 O. G. 2361.

If the case has so far advanced that testimony has been

taken, each party relying on the other's statement for the dates which must be overcome, an amendment to set back these dates is open to suspicion and will be received only upon a clear showing of mistake, and, further than that, the moving party must be free from negligence and must show the utmost diligence in seeking to correct the mistake.

Henderson v. Noakes, 1892 C. D. 114, 29 O. G. 1431;

Lockwood v. Schmidt, 1902 C. D. 253, 100 O. G. 453;

McDermott v. Hildreth, 1902 C. D. 43, 98 O. G. 1282.

The preliminary statement ought not to be amended, after testimony taken, to insert facts which were within the knowledge of the affiant before the testimony was closed.

Mills v. Tortance, 1902 C. D. 17, 98 O. G. 416.

Must relieve of default before making motion.

Atkins v. Paul v. Johnson, 1901 C. D. 35, 94 O. G. 1785.

Must be presented to Examiner of Interferences.

China and Japan Trading Co., Limited, 1900 C. D. 157, 92 O. G. 2508.

May not be amended to read as early as May instead of in May.

Miehle v. Read, 1899 C. D. 191, 89 O. G. 354.

When the error is merely a mistake in a legal conclusion and it is not sought to set up a different state of facts, the amendment may be made.

Richardson v. Humphrey, 1899 C. D. 179, 88 O. G. 2241.

Motions to amend preliminary statements should not be disposed of upon affidavits alone, but upon the entire record.

Foster & Foster v. Bent, 1896 C. D. 89, 77 O. G. 1781.

Amendments to the preliminary statement should be governed by the same rules as are applied to pleadings by the courts. "The preliminary statement should be amended where indisputable fact or clearly proved circumstances support the necessary inference that a mistake has been made which would defeat the ends of justice, where with all reasonable diligence in ascertaining facts and in making the statement a drawing or a model or an abandoned application or some other fact of clear date and origin has been unearthed which by reasonable diligence could not have been found and which in fact was not found earlier.

Foster & Foster v. Bent, 1896 C. D. 89, 77 O. G. 1781.

A decision of the Commissioner of Patents denying an interfering party's motion to amend his preliminary statement is a judicial rather than a ministerial act, and consequently one over which the Secretary of the Interior has no appellate jurisdiction.

Noakes, 1892 C. D. 243, 66 O. G. 575.

No appeal lies to the Secretary of the Interior from the Commissioner's refusal to admit an amended statement.

Noakes. 1892 C. D. 243, 60 O. G. 575.

Utmost care and diligence must be shown before amendment allowed.

Henderson v. Noakes, 1892 C. D. 114, 59 O. G. 1431.

Motions to reopen brought in the first instance before the Examiner of Interferences.

Bowen v. Bradley, 1892 C. D. 13, 58 O. G. 386.

The Office acts judicially rather than ministerially in permitting or denying the amendment of a preliminary statement.

Henderson v. Noakes, 1892 C. D. 123, 59 O. G. 1762;
Washburn v. Hadfield, 1891 C. D. 234, 57 O. G. 1719.

When a preliminary statement is amended for any reason, the original statement remains to confront the applicant and to be considered in determining what the real truth was.

Zwietusch v. Stockheim, 1890 C. D. 151, 53 O. G. 755.

An amendment of the preliminary statement should not be permitted in order to allow the date of conception and reduction to practice in a foreign country to be inserted.

Boulton v. Illingworth, 1888 C. D. 32, 43 O. G. 508.

If a person knowing that the dates alleged in his preliminary statement are not the earliest he can establish, neglects to ask a postponement until he can refresh his memory, and waits until his opponent has put in his evidence before asking to amend, he has not used sufficient diligence to entitle him to an amendment.

Donnelan v. Berry, 1887 C. D. 140, 41 O. G. 1499.

A motion to amend the preliminary statement can not be repeated after having been once rejected without especial permission. Practice in such cases.

Clemson v. Fowler, 1886 C. D. 35, 37 O. G. 671.

The preliminary statement may be amended in respect to the date of invention upon a proper showing, so that the evidence taken may be at least considered.

Robinson v. Seymour, 1885 C. D. 98, 33 O. G. 113.

It is only in cases where parties have failed to comply with the law after having made reasonable and proper efforts to do so that further opportunity to amend is or should be accorded.

Smith v. Thomas v. Cowles, 1885 C. D. 12, 30 O. G. 343.

Where it is made reasonably certain that a mistake has been made an amendment of the preliminary statement should be allowed at any time before the closing of testimony. If

such amendment renders it necessary for the opposite party to take further testimony, he should be allowed to do so on proper motion.

Moore v. Brown, 1882 C. D. 20, 22 O. G. 1882.

Unless the party having made such statement asks to amend the same before any testimony is taken in the case. all parties have a rigat to proceed on the issue as made in the respective statements.

Hopkins v. LeRoy, 1880 C. D. 188, 18 O. G. 859.

It is contrary to public policy to allow amendments of preliminary statements after they are opened.

Oliver v. Zeller, 1876 C. D. 187, 10 O. G. 416.

Ignorance and carelessness are not adequate reasons for allowing an amendment of the preliminary statement after the statement is open to the inspection of the opposite party.

Guest v. Finch, 1876 C. D. 144, 10 O. G. 165.

If an applicant was of unsound mind at the time of making the preliminary statement he may be permitted to amend, or the preliminary statement can be dispensed with.

Brooks, 1874 C. D. 84, 6 O. G. 296.

An amendment to the preliminary statement after the decision by the Examiner and the Board, which attempts to carry back the date of invention, could, in the light of the proof, have no possible effect, unless to impugn deponents veracity.

Cutting v. Kaylor, 1872 C. D. 265, 2 O. G. 704.

The sole object of the rule requiring sworn preliminary statements is to prevent all shuffling with regard to the date, when a party in interference made his invention. Nothing but a fraud, perhaps, practiced on the deponent should relax this rule, but a mere clerical error might be corrected.

Allen & Moody v. Gilman, 1872 C. D. 205, 2 O. G. 293.

Excuse for Mistake.

F's explanation as to his misuse of the word "model" in its legal sense is a reasonable one, and in view of the fact that his motion was brought prior to the taking of any testimony it is thought his motion should have been granted, if the only change he desired to make was to allege that a device made in a certain date constituted a reduction to practice instead of a model.

Day v. Adt v. Hardy, 1906 C. D. 526, 125 O. G. 2765;
Fordyce v. Tarsey, 1903 C. D. 31, 102 O. G. 821.

A motion to amend a preliminary statement to correct the inadvertent use of the word "model" instead of the words "full sized machine" will not be granted where it is found

that the device referred to as the "full sized machine" does not disclose the issue.

Parkes v. Lewis, 1906 C. D. 2, 120 O. G. 323.

The meaning of words should be ascertained before using them in a preliminary statement. A mistake in this respect is not an excuse permitting an amendment.

Dunn v. Halliday, 1905 C. D. 510, 119 O. G. 1261.

That the search conducted was originally unsuccessful not sufficient excuse.

Hoyt v. Sanders v. Hawthorne, 1905 C. D. 508, 119 O. G. 1260.

Where the alleged error in a preliminary statement is discovered as soon as inspection of the opposing party's case reveals the fact that the allegation of an earlier date is necessary, the presumption is strong that the alleged error could have been discovered sooner if proper care had been exercised.

Neth & Tamplin v. Ohmer, 1905 C. D. 177, 116 O. G. 874.

Amendment to a preliminary statement will not be permitted where the excuse for the alleged error is forgetfulness and there is no showing what effort, if any, was made to refresh his recollection originally or what steps were taken to fix definitely and certainly the dates to be alleged.

Friestedt v. Harold, 1905 C. D. 161, 116 O. G. 594.

Negligence of attorneys is not sufficient excuse.

White v. Hewitt & Nolen, 1905 C. D. 130, 115 O. G. 1846.

G is the one to state what he understood. It is not sufficient for his attorney to allege what he supposed was G's understanding of the matter.

Guett v. Tregoning, 1905 C. D. 23, 114 O. G. 544.

It is for the Office to determine whether it was impossible for the deponent to get into communication with a witness.

Bliss v. Creveling, 1904 C. D. 381, 112 O. G. 499.

Where a preliminary statement was drawn under a fair misconception of the issue an amendment was permitted.

Carroll v. Stahlberg, 1904 C. D. 331, 111 O. G. 1937.

It is necessary not only to show that there was an actual mistake, but how it arose. Where original statement in writing shows certain dates and it is alleged that the dates were changed by oral conversation, it required a very good showing to permit their change to original condition.

Heinitch & Morairty v. Congdon v. Kelsea, 1903 C. D. 302, 106 O. G. 542.

If a fact is well known when the preliminary statement is

made and it is not set forth therein, the failure to include it is negligence and not a mistake of fact such as to warrant the amendment of the preliminary statement.

Soley v. Peck v. Clement v. Richards v. Meissner, 1903 C. D. 259, 105 O. G. 1262.

A mere statement that the mistake arose from inadvertence and mistake is not sufficient especially after two months delay.

Brown v. Cutler v. Keeney, 1903 C. D. 182, 104 O. G. 1896.

Rule 114. Failure to File Preliminary Statement.

If the junior party to an interference, or if any party thereto other than the senior party, fail to file a statement, or if his statement fail to overcome the *prima facie* case made by the respective dates of application, such party shall be notified by the examiner of interferences that judgment upon the record will be rendered against him at the expiration of thirty days, unless cause be shown why such action should not be taken. Within this period any of the motions permitted by the rules may be brought. Motions brought after judgment on the record has been rendered will not be entertained unless sufficient reasons appear for the delay.

CONSTRUCTIONS.

A party under an order to show cause can not have access to his opponent's papers.

Henderson and Camley v. Kindervater, 192 O. G. 741.

If the junior party, who is under an order to show cause, believes that the claims of the issue are improper or that he is the first inventor of subject matter common to the cases of the interferrants which is not set forth in the issue, it is his duty to present within the time allowed suitable motions either under Rules 122 or 109.

Crone v. White, 181 O. G. 1072.

If it is desired to take testimony a motion should be made to set the case down for hearing under Rule 130.

Noble v. Levin, 180 O. G. 602.

Barney v. Hess, 158 O. G. 702.

A party may move to dissolve for lack of patentability in reply to an order to show cause, but in order that he should be heard, it is incumbent on him to comply strictly with the rules. If filed subsequent to the thirty days very good reasons for the delay must be shown.

Ryder v. Brown v. Tripp and Means v. White, 137 O. G. 1228.

The affidavit of a physician that the applicant is mentally incapable of making a preliminary statement is insufficient if it does not "appear that any effort has been made to have a legal representative appointed."

Churchill v. Goodwin, 132 O. G. 1838.

A motion to dissolve on the ground of nonpatentability of the issue is a proper reply to an order to show cause under Rule 114.

Field v. Colman, 131 O. G. 1687.

Cause must be shown by motion.

Filbel v. Fox, 130 O. G. 2375.

A patent held not to evidence conception of invention at the date of filing the application inasmuch as the invention was improperly inserted.

McKnight v. Pohl, 130 O. G. 2069.

Hewitt v. Weintraub v. Hewitt & Rogers, 128 O. G. 1689.

See note under Rule 109.

Rule 114 was amended March 13, 1903, by the omission of the provision requiring a motion to be noticed within the limit of appeal and the practice under Meyrose v. Jahn, 1891 C. D., 56 O. G. 1447, has been modified in Kneedler v. Shepard, 1903 C. D. 180, 104 O. G. 1895, so that motions under said rule need not be noticed for hearing within the term allowed for filing motions.

Nanlly v. Cutler, 1907 C. D., 126 O. G. 3.

If a preliminary statement alleged a date between two limits and the later of said limits would not overcome the opponent's *prima facie* case, judgment should be rendered against affiant.

Steinmetz v. Thomas, 1906 C. D. 478, 125 O. G. 1351.

Rule does not clearly and unmistakably require the Examiner of Interferences to render judgment against a party who has been called upon to show cause under that rule and who fails to take any action in response. No appeal from a refusal to render judgment on the record.

Lemp v. Randall & Bates v. Thomson, 1906 C. D. 42, 120 O. G. 905.

Where the preliminary statement of N and T failed to over-

come the record date of O's application and motion by N and T to amend their preliminary statement has been denied and the denial affirmed on appeal. Held that O is entitled to an award of priority.

Neth & Tamplin v. Ohmer, 1906 C. D. 1, 120 O. G. 323.

A decision refusing to enter judgment on the record is not reviewable on an interlocutory appeal.

Mulligan v. Tempest Salve Co., 1905 C. D. 530, 119 O. G. 1924.

Under applicant's allegation of conception of invention in November, 1901, he is privileged, if he can, to establish conception of invention prior to November 16, 1901, the date on which Strouble filed his application. It is therefore seen that the statement filed by W does not fail to overcome the *prima facie* case made by Strouble's date of application.

Winsor v. Strouble, 1904 C. D. 158, 110 O. G. 600.

A showing to obtain an extension of time must necessarily be a verified one.

Kletzker & Goesel v. Dodson, 1904 C. D. 100, 109 O. G. 1336.

The original of a divided application fixes the date of filing. filing.

Gilbert Stringer v. Johnson, 1903 C. D. 20, 102 O. G. 621.

A judgment upon the record set aside in order to redeclare the interference with a prior application of the defeated party from which the conflicting claims had been eliminated. In asserting a legal right motives are immaterial.

Thorp v. White, 1900 C. D. 66, 91 O. G. 1435.

Showing not required if suitable motion is made under Rule 122.

Law v. Wolf, 1891 C. D. 91, 55 O. G. 1527.

It is not the practice to issue an order to show cause.

Kendall v. Frasch, 1890 C. D. 36, 50 O. G. 1132.

An earlier application, in order to entitle a junior party to judgment on the record, must be upon its face an application in behalf of the same person who filed the application immediately in interference.

Oliver v. Everett, 1889 C. D. 214, 49 O. G. 731.

Rule 107 is based on Rule 111. The motion to adjudicate the case upon the record under this rule is in the nature of a demurrer to the declaration, and calls up the case for decision upon the pleadings. The objection that the prior applicant has not reduced the invention to a practical form is not

good if the specification and drawings show the invention to be capable of being put into a practical machine.

Starr & Peyton v. Farmer, 1883 C. D. 34, 23 O. G. 2325; affirmed by Secretary, 23 O. G. 2327.

A preliminary statement alleging a date of invention. 1872, does not overcome the *prima facie* case made by the date of application for a patent filed January 4, 1873, as a division of an application filed July 12, 1871.

Huntley v. Smith, 1880 C. D. 182, 18 O. G. 795.

No notice to adverse parties is required in cases under this rule.

Booth v. Lyman, 1880 C. D. 62, 17 O. G. 393.

Where default is made a new hearing will be more readily granted.

Loring v. Hall,-1879 C. D. 8, 15 O. G. 471.

It was no excuse for a patentee for not filing his preliminary statement, that he was waiting to obtain as much information of applicant's invention as the applicant had of his. This information should be refused by the Office.

Spaulding & Aldrich v. Winchester, 1871 C. D. 94.

Additional Cases.

Cases that pass on the subject matter of this rule:

Benger v. Burson, 1902 C. D. 164, 99 O. G. 1384; Patten v. Wiesenfeld, 1902 C. D. 197, 99 O. G. 2547; Patten v. Wiesenfeld, 1902 C. D. 114, 98 O. G. 2589; Brough v. Snyder, 1901 C. D. 3, 94 O. G. 221; Meyer v. Sarfert, 1901 C. D. 91, 96 O. G. 1037; Bundy v. Rumbarger, 1900 C. D. 143, 92 O. G. 2003; Forbes v. Thomson, 1890 C. D. 61, 51 O. G. 297.

Rule 115. Failure to File Testimony Excluding Setting up Invention Prior to Application Date.

If a party to an interference fail to file a statement, testimony will not be received subsequently from him to prove that he made the invention at a date prior to his application.

See Rule 53 of 1871 quoted under Rule 110.

Rule 116. Presumption as to Order of Invention.

The parties to an interference will be presumed to have made the invention in the chronological order

in which they filed their completed applications for patents clearly disclosing the invention; and the burden of proof will rest upon the party who shall seek to establish a different state of facts.

HISTORY.

Rule 56 of 1869 reads in part as follows: "In case of interference the party who first filed his application for a patent will be deemed the first inventor in the absence of all proof to the contrary."

In 1870, inserted the words "so much of" between "his" and "filed" and the words "as illustrates his invention" between "patent" and "will."

In 1878, instead of "as illustrates his invention" the words "as is required by Rule 7" were used.

Rule 111 of 1879, see appendix.

The wording of the present rule is in the edition of September 1, 1880.

In 1892, instead of "filed" the words "claimed the same in" were used. The present wording restored June 18, 1897.

See notes under Rule 122, title "Shifting Burden of Proof." Also as to filing date, Rules 31 and 171.

CONSTRUCTIONS.

(1) BURDEN OF PROOF—RECORD DATE.
(2) CLEARNESS REQUIRED.
(3) DIVISIONAL APPLICATION.
(4) ABANDONED APPLICATION.
(5) FORFEITED APPLICATIONS.
(6) AMENDMENTS.
(7) FOREIGN PATENTS.

(1) *Burden of Proof—Record Date.*

A sole application may be a continuation of a joint application.

In re Roberts, 273 O. G. 410.

Mechanical application does not give a record date to a design application.

McArthur v. Gilbert, 1904 C. D. 245, 110 O. G. 2509; see also Lowrie v. Taylor et al., 186 O. G. 1681.

The question of shifting the burden of proof is a matter within the jurisdiction of the Examiner of Interferences and not the Primary Examiner, and there is no appeal from his decision prior to final judgment. (Raulet & Nicholson v. Adams, 114 O. G. 1827.)

Scott v. Southgate, 1906 C. D. 104, 121 O. G. 689.

A petition that a divisional application be substituted for the original application in interference and that an amendment be entered in the original case to eliminate the interfering subject matter and put the case in condition, for allowance granted.

The question whether the claims are patentable over the issue is one for the Primary Examiner.

Burchart v. Nolan & Wright v. Christianacu, 180 O. G. 601.

We must consider then the claim in issue as properly relating back to the filing of the original specification, and that date as the date of reduction to practice.

McFarland v. Watson and Watson, 146 O. G. 257.

The rule which permits a divisional application to relate back to the filing date subject-matter as long as it remains open in the Patent Office is a very liberal one that sometimes works hardship upon intermediate inventors and it ought not to be extended to cases not clearly within it, as where a patent has issued on the first application.

Spitteler, 134 O. G. 1299; Wainwright v. Parker, 142 O. G. 1115.

Where a patent is inadvertently issued while an application by another is pending without, an interference, no advantage accrues, to the patentee on the question of burden of proof.

Cutler v. Lenard, 136 O. G. 439.

A divisional application dates back to the original one and secures to the applicant the benefit of a constructively reduction to practice whether the claims of the divisional application were in the original when filed or not.

Lotz v. Kenny, 135 O. G. 1801.

The invention was embraced in the claims of the original application, and therefore no rights have become vested in later inventors which stop Newman from making these claims. (McBirly v. Cook, 1900 C. D. 248, 90 O. G. 2295.)

Hopkins v. Newman, 131 O. G. 1161.

Part of claims were in former application, the burden of proof different as to these claims.

Bliss v. McElrery, 128 O. G. 458.

The alleged improper placing of the burden of proof forms no proper basis for motion for dissolution and that the question should be presented by separate motion to shift the burden of proof.

Blackmore v. Hall, 118 O. G. 2538, 1905 C. D. 456.

Under the practice announced in Raulet & Nicholson v. Adams (114 O. G. 1827), the question of shifting the burden

of proof is a matter to be considered and decided by the Examiner of Interferences and is not appealable prior to the final decision in the case.

Duryea & White v. Rice, 118 O. G. 2249, 1905 C. D. 428.

Where an appeal was taken from the action of the Primary Examiner denying a motion to shift the burden of proof, the appeal not considered and case remanded to Examiner of Interferences. Head note to

Fisher v. Daugherty, 118 O. G. 1681, 1905 C. D. 399.

Opinion does not seem to bear out head note.

As a general rule, the burden of proof rests on the party against whom judgment would be rendered if no evidence were adduced on either side. This question, involving the taking of testimony, should be considered by the Examiner of Interferences and there is no appeal from his decision prior to the final appeal.

Fennell v. Brown v. Borsch, Jr., 115 O. G. 1328, 1905 C. D. 117.

Claimed that the invention was not shown in original application, but was introduced by amendment subsequent to the filing of opponent's application, "If well founded, this would entitle S, who was the first to conceive, the benefit, also, of the earlier reduction to practice, and an inquiry into the question of diligence would be unnecessary."

Seeberger v. Dodge, 114 O. G. 2382, 1905 C. D. 603, 24 App. D. C. 476.

As held in the case of Raulet & Nicholson v. Adams (114 O. G. 1827), no appeal will be entertained upon interlocutory motion relating to the burden of proof, but that the matter may be brought up with the final decision as to priority of invention. Such motions should be made before the Examiner of Interferences.

Osborne v. Armstrong, 114 O. G. 2091, 1905 C. D. 65.

A previous application which does not show all the elements of the issue can not avail to shift the burden of proof.

Norden v. Spaulding, 114 O. G. 1829, 1905 C. D. 588, 24 App. D. C. 286.

Motions to shift the burden of proof should be made before the Examiner of Interferences within the twenty days after the approval of the preliminary statements allowed for motions. This case withdraws jurisdiction from the Primary Examiner in this class of cases.

Raulet & Nicholson v. Adams, 114 O. G. 1827, 1905 C. D. 55.

Said by Commissioner on Appeal. Before the interference

proceeds further, it should be positively determined whether or not these new references anticipate the issue.

Wright & Stebbins v. Hansen, 114 O. G. 761, 1905 C. D. 27.

Motions to shift the burden of proof are brought under the provisions of Rule 116. In a proper case the burden of proof can be shifted without dissolving and redeclaring the interference.

Dinkel v. D'Alier, 113 O. G. 2507, 1904 C. D. 572.

The pendency of a motion for dissolution is no good reason for delay in bringing a motion to shift the burden of proof. (See McArthur v. Gilbert, 111 O. G. 1624.)

Harvey v. Lubbers v. Raspillaire, 112 O. G. 1215, 1904 C. D. 411.

F's patent does not make him the senior party in the proceeding, as D was the first to file an application, he is the senior party in this proceeding, and it is incumbent upon F in order to prevail to establish his case by a preponderance of evidence.

Furman v. Dean, 111 O. G. 1366, 1904 C. D. 305.

When an error is discovered by the Examiner of Interferences which would amount to such an irregularity as would preclude proper determination of the question of priority, such as the improper placing of the burden of proof, the interference should be forwarded to the Primary Examiner with a statement of facts, that he may correct his letter forwarded to the Examiner of Interferences under Rule 97.

Lutz v. Lewis, 110 O. G. 2014, 1904 C. D. 227.

A subsisting patent lawfully issued can not be invalidated or in any manner effected by any subsequent proceeding in the Patent Office even to the extent of imposing the burden of proof upon its holder that it was lawfully issued.

Lutz v. Lewis, 110 O. G. 2014, 1904 C. D. 227.

The date of invention can not be carried back to a previous joint invention.

Arnold v. Vaughen et al. v. Arnold et al., 109 O. G. 805, 1904 C. D. 78; Haskell v. Miner v. Ball, 109 O. G. 3170, 1904 C. D. 131.

This rule is applicable, notwithstanding the fact that a patent was inadvertently issued to the junior party without an interference.

Watson v. Thomas, 106 O. G. 1777, 1903 C. D. 370.

The burden of proof is upon the junior party to show that he was diligent.

Pihl v. Mersman, 106 O. G. 1777.

As Ostrom is entitled to his filing date as his date of reduction to practice and as Quest was wholly inactive at this time, Ostrom is entitled to priority.

Quest v. Ostrom, 106 O. G. 1501, 1903 C. D. 348.

An application for a patent when filed complete in the Patent Office which warrants the issue of a patent and is not abandoned, is in law a constructive reduction to practice. Before it is filed it may be only evidence of conception.

Hopfelt v. Read, 106 O. G. 768, 1903 C. D. 319.

If one wishes to establish the date of filing of an earlier application he should do so by a motion to shift the burden of proof, in which case the decision of the Primary Examiner as to the admission of claims will be final. If such earlier application is brought in the course of taking the testimony it will be considered like other testimony by all the tribunals having jurisdiction.

Robinson v. Copeland, 102 O. G. 466, 1903 C. D. 13.

Between two applicants one may have the benefit of the date of filing a previous application, but between an applicant and a patentee the rule is modified. A subsisting patent lawfully issued, can not be invalidated or in any manner affected by any subsequent proceeding in the Patent Office, even to the extent of imposing the burden of proof upon its holder that it was lawfully issued.

Asencio v. Russell, 99 O. G. 2321, 1902 C. D. 188.

The words "their completed applications" are not limited to mean only the applications involved in the interferences nor those pending concurrently thereupon. They refer to any completed application in which the invention is disclosed by means of which judgment of priority would necessarily be rendered in favor of the party so disclosing, provided no testimony at all (Rule 114) or no more testimony were taken.

Meyer v. Sarfert, 96 O. G. 1037, 1901 C. D. 91.

Motion to shift need not set up facts unless they are outside the record.

Sheppard v. Webb, 94 O. G. 1577, 1901 C. D. 32.

A reissue application is entitled to the date of the original application.

Walsh v. Hallbauer, 88 O. G. 2409, 1899 C. D. 184;
Austin v. Johnson, 95 O. G. 2585, 1901 C. D. 391, 18 App. D. C. 83.

A motion to shift the burden of proof may be founded upon matters outside of the record.

Bundy v. Rumbarger, 92 O. G. 2001, 1900 C. D. 143.

The first to make a claim in substance and effect covering the invention is the senior party.

Richards v. Leidgen, 77 O. G. 153, 1896 C. D. 63.

The word "claimed" does not include the description.

Edison v. Ball, 71 O. G. 1313, 1895 C. D. 811.

As recently amended and construed in the light of decisions bearing upon it, means that he who first made a claim of statement of invention covering the invention in interference should be considered the senior party.

Huson v. Crowell v. Yale, 64 O. G. 1006, 1893 C. D. 107.

Held on appeal that as the applicant disclosed, but did not claim the invention in controversy in an application antidating his opponent's earliest claimed date, the office must consider this in determining the question of priority.

O'Shaughnessy v. VanDepolle, 62 O. G. 1063, 1893 C. D. 19.

The date on which each applicant made his claim or equivalent statement of invention for the subject-matter involved in the interference issue determines his status.

Kennyson v. Merritt, 1892 C. D. 54; 58 O. G. 1415.

Burden of proof when originality denied.

Wherry v. Heck, 1889 C. D. 201, 49 O. G. 559.

To take back the record date to a former application, or to other records in the patent office, there must be something in the application in question identifying it with such records.

Booth v. Lyman, 1880 C. D. 151, 18 O. G. 132; Huntley v. Smith, 1880 C. D. 182, 18 O. G. 795.

Priority of invention, under rule 107 is determined prima facie as between two original applications by the dates of filing the applications; as between an original pending application and one or more patents by the date of filing the pending application, and the application on which the patents were granted; as between a pending reissue application and one or more unexpired patents by the date of filing the original application for the patent of which a reissue is asked and the application upon which the other patents were granted.

Booth v. Lyman, 1880 C. D. 62, 17 O. G. 393.

Date of filing, or perhaps date of jurat should be assumed as the date of invention in absence of other proof.

Knight v. Annan, 1871 C. D. 34.

Cases that pass on the subject-matter of this rule.

McGill v. Adams, 119 O. G. 1259; Byron v. Henry, 104 O. G. 1895; Brough v. Snyder, 1901 C. D. 1, 94 O. G. 221; Osborne v. Hotsapillar, 1901 C. D. 16, 94 O. G. 583; Oliver v. Everitt, 1889 S. D. 214, 49 O. G. 731.

(2) *Clearness Required.*

An applicant should not be given the record date of an earlier application if there is reasonable doubt if it disclosed the issue. The Examiner's decision that the issue was not so disclosed raises a doubt and the question should again be brought in question by introducing such earlier application in evidence instead of by appeal.

Munroe v. Alexander, 1903 C. D. 334, 106 O. G. 1000.

A claim suggested under rule 96 applicant did not insert it but made another application. Held that in view of the indistinctness upon the point in question of first application applicant could not have date of first application.

Krakaw v. Harding, 1903 C. D. 264, 105 O. G. 1531.

In the original application of which the one in controversy was a division the combination was not shown in the drawings as a unit but was described in the specification. Held sufficient to establish the date. Even a disclaimer would not prevent this provided the claims were made in a later application.

Dittigen v. Parmenter, 1902 C. D. 218, 99 O. G. 2966.

What constitutes clearly illustrating and deseribing.

Silverman v. Hendrickson, 1902 C. D. 527, 99 O. G. 1171, 19 App. D. C. 381.

(3) *Divisional Application.*

Date of original of a divisional application.

Robinson v. Seelinger, 1905 C. D. 640, 116 O. G. 1735, 25 App. D. C. 237; Duryea & White v. Rice, Jr., 1907 C. D. 28, 126 O. G. 1357, 28 App. D. C. 423.

An applicant should not be given the record date of an earlier patent application when there is reasonable ground to refuse it, he may, however, introduce the earlier application as a part of his evidence and contend that it shows the invention.

Greenwalt v. Marks, 1904 C. D. 352, 111 O. G. 2224.

As it has been finally decided that the disclosure is sufficient in the divisional application to support the claims, it follows that the disclosure in the original application is sufficient.

Hopfelt v. Read, 1903 C. D. 319, 106 O. G. 767.

If a divisional application also contains original matter it is a division of the former so far as it contains matter that was in the original but no further.

Gilbert-Stringer v. Johnson, 1903 C. D. 20, 102 O. G. 621.

Purpose of rule. Failure of junior party to bring motion

to shift the burden of proof raises no presumption that his application is not a division of an earlier one.

Phelps v. Hardy v. Gattman & Stern, 1896 C. D. 70, 77 O. G. 631.

When an application is filed describing and illustrating more than one invention, and during the pendency in the Office another application is filed by the same inventor, stating that it is a division of the original application and claiming an invention described and illustrated, the latter application is to be considered a divisional application for the purpose of interference proceedings, whether or not the divisional invention was claimed in the first application. It is to be noticed that this rule is entirely silent upon the subject of claiming the invention.

Forbes v. Thomson, 1890 C. D. 61, 51 O. G. 297.

Where an application is made clearly describing an invention but expressly disclaiming it with a view of making a second application for said invention, where the second application is put in interference the date of filing the first application is the date referred to by this rule.

Sellen v. Hockhausen, 1885 C. D. 103, 33 O. G. 995.

(4) *Abandoned Applications.*

Where an applicant files a complete application for a patent on a certain invention and thereafter files another application and allows the first to become abandoned, the applicant is entitled to his date of the first application for the date of his constructive reduction to practice for the invention which is common to the two applications. The effect is different if he permits the first application to become abandoned before he files the second one; but when the two applications are pending together the applicant has the benefit of the first date of filing for a constructive reduction to practice as the whole constitutes one continuous proceeding.

Lotterhand v. Hanson, 1904 C. D. 39, 108 O. G. 799.

An abandoned application gives the date of conception.

Silverman v. Hendrickson, 1902 C. D. 527, 99 O. G. 1171, 19 App. D. C. 381.

An abandoned application does not establish a date of reduction to practice, it is only evidence of conception.

Carty v. Kellogg, 1896 C. D. 188, 74 O. G. 657, 7 App. D. C. 542.

The original of a divisional application is the one to fix the date under this rule, but an abandoned application cannot be used for that purpose.

Henderson v. Reese, 1883 C. D. 67, 25 O. G. 191.

(5) *Forfeited Applications.*

Where an applicant has made a previous application in which he might have made the claims, this is sufficient to establish the date. Query if case was abanadoned for non-payment of final fee.

Lowry v. Spoon, 1904 C. D. 173, 110 O. G. 858.

Where one party has been at fault in causing an application to become forfeited, he cannot be permitted to take advantage of that fact. (Christensen v. Noyes, 99 O. G. 227 distinguished.)

Russell v. Asencio, 1904 C. D. 106, 109 O. G. 1605.

Where an application is abandoned by a failure to pay the final fee within six months after allowance, and a renewal application is filed within two years after the allowance of the first application, the date of the first application is to be taken.

Thomson v. Waterhouse, 1885 C. D. 2, 30 O. G. 177.

(6) *Amendments.*

These amendments were made prior to the time appellant entered the field, and the rule in this instances is far more liberal than where it is sought to enlarge the scope of an application to the prejudice of inventors whose rights have accrued between the date of filing and the date of amendment.

Young v. Struble, 157 O. G. 488.

Where the invention was caused to appear in a party's patent by an amendment to the application improperly extending the original disclosure. Held that the patent is not evidence of invention by the patentee at any time, as the matter in question is not supported by oath stating that it was invented by him.

Pohle v. McKnight, 1905 C. D. 549, 119 O. G. 2519.

A motion to shift the burden of proof because the invention in issue was introduced by amendment is improper. The remedy is by motion to dissolve under rule 122.

Tripp v. Wolff v. Jones, 1903 C. D. 141, 103 O. G. 2171.

An amendment is entitled to the date of filing.

Walsh v. Hallbauer, 1899 C. D. 184, 88 O. G. 2409.

Where a new invention is introduced by amendment, such amendment fixes the date of invention.

Hull v. Lowden, 1881 C. D. 30, 20 O. G. 741.

(7) *Foreign Patents.*

Even where a party secures for his application here the benefit of the filing date of a foreign application, the actual filing date in this country must appear and cannot be changed to the foreign filing date.

Pauling, 1905 C. D. 131, 115 O. G. 1848.

An ex parte affidavit is not sufficient to change the burden of proof by carrying back a party's filing date to that of a foreign application.

Raulet v. Nicholson v. Adams, 1905 C. D. 55, 114 O. G. 1827.

If the application is filed over 12 months after foreign application, applicant cannot have the benefit of the foreign filing date.

Muller v. Lauber, 1903 C. D. 387, 106 C. D. 2016.

Rule 117. Statement not Evidence.

The preliminary statement can in no case be used as evidence in behalf of the party making it.

CONSTRUCTIONS.

Even after amendment the original statement remains a part of the case, with its full effect under this rule.

Foster & Foster v. Bent, 1896 C. D. 89, 77 O. G. 1781.

Rule 118. Time for Taking Testimony.

Times will be assigned in which the junior applicant shall complete his testimony in chief, and in which the other party shall complete the testimony on his side, and a further time in which the junior applicant may take rebutting testimony; but he shall take no other testimony. If there be more than two parties to the interference, the times for taking testimony will be so arranged that each shall have an opportunity to prove his case against prior applicants and to rebut their evidence, and also to meet the evidence of junior applicants.

CONSTRUCTIONS.

Surrebuttal testimony on the subject of operativeness?

Keith et al. v. Lundquist v. Lorimer et al., 157 O. G. 754.

Where an inventor testifies in favor of the opponent of his assignee that he was not the inventor of a part of the alleged invention it constitutes a surprise and a motion to take surrebuttal should be allowed.

Sandage v. Dean v. Wright v. McKenzie, 130 O. G. 981.

A mere difference of opinion will not warrant rebuttal testimony.

Sandage v. Dean v. Wright v. McKenzie, 130 O. G. 981.

Testimony attacking the validity of the senior party's date of filing should be taken in the examination in chief and not in rebuttal.

Kinsman v. Strohm, 125 O. G. 1699.

Surrebuttal testimony will not be authorized merely that a party may strengthen his case upon finding that the case made out against him in his opponent's rebuttal testimony is stronger than he anticipated.

Herbst v. Record & Goldsborough v. The Rothenberg Co., 123 O. G. 2311.

Surrebuttal testimony should only be accepted from a party where new matter is introduced in his opponents proof, which is in the nature of a surprise to the party seeking surrebuttal proofs.

Marani v. Shoemaker v. Fessenden, 121 O. G. 2666.

Rebuttal testimony which related solely to the patentability of the issue, held to have been properly stricken out.

Parkes v. Lewis, 120 O. G. 323.

This Office has authority to make an order to perpetuate testimony by analogy to the practice in equity courts, and the circumstances here justify it.

Lowry v. Spoon, 117 O. G. 903.

It is very clear that Hull has simply changed his mind or received new light upon the law of the case and has not discovered any new facts which would warrant reopening a decided case.

Hull v. McGill, 117 O. G. 597.

Basch alleges conception prior to this date; but this testimony was taken within the time set for the taking of rebuttal testimony, and as such testimony is a part of his *prima facie* case and is not in rebuttal of any testimony taken by Hammond it clearly is improperly introduced and is entitled to no weight.

Basch v. Hammond, 113 O. G. 552.

Priority and originality are the only issues. Rebutting testimony relating to patentability stricken out.

Huber v. Aiken, 1899 C. D. 166, 88 O. G. 1525.

This rule cannot be disregarded by stipulation of parties, and its provisions should be rigidly enforced. Testimony taken in violation of this rule must be excluded.

Connor v. Williams, 1878 C. D. 137, 15 O. G. 387.

A case that passes on the subject-matter of this rule.

See Chesebrough v. Toppan, 1872 C. D. 100.

Unless the established rules of the Office are enforced the rights of the contestants will never be secured. Testimony taken in conflict with this rule excluded.

Neal & Adams v. Daniels, 1871 C. D. 156.

Rule 119. Failure to Take Testimony.

Upon the filing of an affidavit by any senior party to an interference that the time for taking testimony on behalf of any junior party has expired and that no testimony has been taken by him, an order shall be entered that the junior party show cause within a time set therein, not less than ten days, why judgment should not be rendered against him, and in the absence of a showing of good and sufficient cause judgment shall be so rendered. If any showing be made in response to the order, it must be served upon the opposing party and noticed for hearing by the party filing it.

CONSTRUCTIONS.

Affidavits accompanied motion for judgment on the record. It is clearly improper for counsel to request this Office to decide the question of priority on *ex parte* affidavits.

Horfnagle v. Beardsley, 193 O. G. 510.

If there were good reasons why judgment should not have been residered on the question of priority under this rule, he should have brought them forward in answer to the order to show cause. If he was dissatisfied with the judgment which was rendered, his remedy was by appeal from the judgment. He cannot have that judgment reviewed on appeal from the order to show cause.

Bombard v. United States Graphite Co., 129 O. G. 479.

A stipulation filed in lieu of testimony in which one of the two parties states that he is not the inventor of the subject-matter in issue, there is no reason for continuing the interference, and the Examiner may render judgment without setting a day for hearing.

Townsend v. Corey, 119 O. G. 2237.

If there were good reasons why judgment should not be rendered against McHarg, he should have brought them forward in answer to the order to show cause.

McHarg v. Schmidt et al., 106 O. G. 1780.

If the testimony relates exclusively to public use it should be stricken out upon motion properly made and judgment rendered under this rule.

Stroud v. Miller, 101 O. G. 2075, 1902 C. D. 423.

The date of the decision and not the date of the receipt of notice governs.

Whipple v. Sharp, 98 O. G. 225-6, 1902 C. D. 2, 5.

Cases that pass on the subject-matter of this rule.

Osborn v. Austin, 115 O. G. 1065; Trufant v. Prindle v. Brown, 111 O. G. 1035; Kempshall v. Sieberling, 110 O. G. 1427; Winsor v. Struble, 110 O. G. 600; Hoegh v. Gordon, 108 O. G. 797; Franklin v. Morton v. Cooley, 95 O. G. 2063, 1901 C. D. 49; Atkins v. Paul v. Johnson, 94 O. G. 1785, 1901 C. D. 35; Walsh v. Hallbauer, 94 O. G. 223, 1901 C. D. 9; Brough v. Snyder, 94 O. G. 221, 1901 C. D. 3; Knight v. Bagnall v. Curtis v. Morgan, 76 O. G. 1115, 1896 C. D. 109.

Rule 120. Postponement of Hearing.

If either party desire to have the hearing continued, he shall make application for such postponement by motion (see Rule 153), and shall show sufficient reason therefor by affidavit.

CONSTRUCTIONS.

If party has not been diligent no extension of time will be permitted.

Bryon v. Henry, 104 O. G. 1895.

The fact that the title of one of the parties is in litigation is not sufficient ground for the postponement of the hearing; either to await the determination of the question of title or to make the hearing coincident with another interference proceeding in which the same patent is involved.

Keith v. Faure, 25 O. G. 289, 1883 C. D. 72.

A case that passes on the subject-matter of this rule.
Olemkley v. Bickhius, 158 O. G. 886.

Rule 121. Enlargement of Time for Taking Testimony.

If either party desire an extension of the time assigned to him for taking testimony, he shall make application therefor, as provided in Rule 154(*d*).

See notes to rule 114.

CONSTRUCTIONS.

The setting of times for taking testimony is a matter peculiarly within the descretion of the Office.
Victor Talking Machine Co. v. American Graphophone Co., 161 O. G. 753.

It must appear that the motion is made in good faith and if there has been delay it must be excused. A prima facie case must be made out.
Roffe v. Super, 159 O. G. 991.

An order extending time cannot be appealed from.
Wickers and Farlong v. Weinwarm, 129 O. G. 2501.

An appeal should be allowed where permission to take testimony is refused.
Pym v. Hadaway, 128 O. G. 457.

Decisions of the Examiner of Interferences are final on motions to extend time for taking testimony, and no limit of appeal should be set.
Christensen v. McKenzie, 117 O. G. 277.

It is believed that it will be to the interest of all parties concerned, if the Examiner of Interferences in granting motions for extension of time for taking testimony should not set a limit of appeal from such decision.
Goodfellow v. Jolly, 115 O. G. 1064.

Three weeks delay in moving the court to compel witness to answer is sufficient reason for denial of motion to extend time for this cause.
Downing v. Anderson, 111 O. G. 582.

A third extension refused where petitioner was waiting for such time as he could get all his witnesses together at once.
Spindler v. Nathan & Bolge, 109 O. G. 2171.

The office will not fix the time for taking testimony so that the testimony may be taken in both cases at once.
Lipe v. Miller, 107 O. G. 1662.

The motion should be made before the expiration of the time limit. It should be accompanied by affidavits setting forth good reasons.

Turner v. Bensinger, 102 O. G. 1551.

Time for taking testimony will not be extended to permit testimony to be offered which is inadmissible in its nature.

Trufant v. Frindle v. Brown, 101 O. G. 1608, 1902 C. D. 397.

A stipulation for extending time for taking testimony which contemplates the absence of one of the attorneys may act to prevent the running of the 20 day provided for by rule 122.

McKean v. Morse, 94 O. G. 1572, 1901 C. D. 33.
See Sponsel v. Darling, 105 O. G .498.

Rule 122. Motion to Dissolve for Irregularity, Non-patentability, etc.

Motions to dissolve an interference (1) alleging that there has been such informality in declaring the same as will preclude the proper determination of the question of priority of invention, or (2) denying the patentability of an applicant's claim, or (3) denying his right to make the claim, should contain a full statement of the grounds relied upon and should, if possible, be made not later than the thirtieth day after the statements of the parties have been received and approved. Such motions and all motions of a similar character, if in the opinion of the Commissioner they be in proper form, will be heard and determined by the law examiner, due notice of the day of hearing being given by the office to all parties. If in the opinion of the Commissioner the motion be not in proper form, or if it be not brought within the time specified and no satisfactory reason be given for the delay, it will not be considered and the parties will be so notified.

When the motion has been decided by the law ex-

aminer the files and papers, with his decision, will be sent at once to the docket clerk.

Motions to shift the burden of proof should be made before, and will be determined by, the examiner of interferences. No appeal from the decision on such motions will be entertained, but the matter may be reviewed on appeal from the final decision upon the question of priority of invention.

HISTORY.

The Revision of December 1, 1879, reads as follows:

"116. Motions to dissolve an interference which deny the patentability of an applicant's claim, or his right to make the claim, will be submitted to the examiner of interferences before the day fixed for filing the statements provided for in Rules 97 and 102, and will be transmitted by him, with the files and papers, to the primary examiner, who will take jurisdiction of the case for the determination of such motions, and will return the files and papers to the examiner of interferences, with his decision, at the expiration of the time limited for appeal, if no appeal shall have been taken, or sooner if the party entitled to appeal shall file a waiver in writing of his right of appeal; and such decision will be binding on the examiner of interferences unless reversed or modified on appeal. From a decision of the primary examiner on such motion denying the patentability of a claim or the right of an applicant to make it, an appeal may be taken *ex parte* to the examiners-in-chief; but from his decision affirming its patentability or the applicant's right no appeal can be taken."

"118. Appeal may be taken directly to the commissioner from decisions on all motions, except motions to dissolve interferences denying the patentability of applicant's claims, or their right to make the claims, and other lawful motions involving the merits of the case, which, when appealable may be appealed to the board of the examiners-in-chief. (See Rule 116.)"

See Allen, Commissioner of Patents v. The United States of America, ex rel. Lowry and Planters Compress Company, 1905 C. D. 643, 116 O. G. 2253 (May 24, 1895).

Previous to the last revision, the rule read as follows:

Motions to dissolve an interference (1) upon the ground that there has been such informality in declaring the same as will preclude a proper determination of the question of priority of invention, or (2) which deny the patentability of an applicant's claim, or (3) which deny his right to make the claim, or (4) which allege that counts of the issue have different meanings in the cases of different parties should contain a full statement of the grounds relied upon, and should, if possible, be made not later than the thirtieth day after the statements of the parties have been received and approved. Such motions, and all motions of a similar character, should be accompanied by a motion to transmit the same to the primary examiner, and such motion to transmit should be noticed for hearing upon a day certain before the examiner of interferences. When in proper form the motion presented will be transmitted by the examiner of interferences, with the files and papers, to the proper primary examiner for his determination, who will thereupon fix a day certain when the said motion will be heard before him upon the merits, and give notice thereof to all the parties. If a stay of proceedings be desired, a motion therefor should accompany the motion for transmission.

When the motion has been decided by the primary examiner the files and papers, with his decision, will be sent at once to the docket clerk.

Motions to shift the burden of proof should be made before, and will be determined by, the examiner of interferences. No appeal from the decision on such motions will be entertained, but the matter may be reviewed on appeal from the final decision upon the question of priority of invention.

The following notes have references to this rule. The present rule has not been in force long enough to have been construed.

CONSTRUCTIONS.

(1) In General.
(2) General Policy and Meaning of Rule.
(3) Subject-Matter of Motion.
(4) Ground for Dissolution.
(5) Patentee—Applicant.
(6) Form of Motion.
(7) Transmission of Motion.
(8) Petition to Extend Time.
(9) Evidence—Affidavits.

(10) DELAY IN BRINGING MOTION—EXCUSE FOR SECOND MOTION.
(11) EXPEDITING PROCEEDINGS—EXAMINER'S ACTIONS—TIME LIMIT.
(12) GROUNDS OF APPEAL.
(13) SHIFTING BURDEN OF PROOF.
(14) MISCELLANEOUS.

(1) *In General.*

The practice under the present rule is to render judgment upon the opening of the preliminary statements, without an order to show cause why such award should not be made, leaving the party failing to prevail to bring any of the motions permitted by the rules within the time limited for appeal.

Kendall v. Frasch, 1891 C. D. 36

It is contended by B. that under long standing practice he should be permitted to give notice of other references five days before the hearing of the motion. The reasons for this practice which was followed in the past, but which has not been permitted for some time, do not now exist. Since the date of the decisions under which an applicant was permitted to give notice five days before the hearing, of additional reasons for dissolving the interferences, Rule 122 has been amended and the time within which motions may be made extended from twenty to thirty days. It has also been amended to require that a motion for dissolution must contain a full statement of the grounds relied upon.

Papendell v. Bunnell v. Reizenstein v. Gaisman v. Gillett, 131 O. G. 362.

(2) *General Policy and Meaning of Rule.*

Last clause applies where judgment is rendered on the record under rule 114.

Barney v. Hess, 158 O. G. 702.

Last clause (authorities).

Braun v. Wahl, 189 O. G. 254.

The first ground mentioned while in a sense broad, is exclusive of the other three grounds.

Rountree v. Sloan, 189 O. G. 1282.

The practice of the Office contemplates that the question of the patentability of the subject-matter of an interference should be decided before an interference is declared. But

if it has not been, then it must be before the interference can go on.

Lynch & Raff v. Dryden & Underwood, 73 C. D. 73.

There is nothing in the rules that limits the question to be discussed upon a motion to dissolve to those which have not previously been considered by the Primary Examiner.

Law v. Woolf, 55 O. G. 1527.

One object of motion is to enable the Examiner to decide inter partes what he had previously decided without a hearing.

Law v. Woolf, 1891 C. D. 91; 55 O. G. 1527.

Motions must be made after the declaration of interference.

Seevert v. Shuman, 76 O. G. 1714.

Matters relating to marking can only be established by evidence. The motion not transmitted.

Earll v. Love, 140 O. G. 1209.

A motion to dissolve on the ground that the issue is not patentable will not be considered where based upon ex parte affidavits.

Barrett v. Swinglehurst, 144 O. G. 818; White v. Powell, 160 O. G. 776.

The additional patent which is now cited by White is in the same art as the patents previously considered and was presumably within his knowledge at the time the original motion was brought. It is well settled that such delay is fatal to a motion to dissolve. McKee v. Baker, 120 O. G. 657; Josleyn v. Hulse, 130 O. G. 1689.

Blackmore v. Hall, 132 O. G. 1587; White v. Powell, 160 O. G. 776.

If a disclaimer has been filed, or there is no subject-matter, the interference should be dissolved.

Jones, 180 O. G. 880.

When an interference has been dissolved as to a part of the counts, a new preliminary statement will not be admitted as to the remainder.

Seaman v. Brooks, 100 O. G. 685.

The absurdity of a declaration of interference with a reservation at the same time of the question of patentability for future adjudication, would be, so far at least as this count is concerned, too glaring to be tolerated.

Such questions should be referred for determination.

Oliver v. Felbel, 100 O. G. 2384.

If a motion to dissolve for want of interference in fact is not made, the decision of the interference is not conclusive on this point, and the defeated party may raise the question

when his competitors' patent is cited as a reference.

Schupphaus, 100 O. G. 2775.

There may be an interference in fact notwithstanding the devices are intended for different purposes.

Blue v. Power v. Owen, 101 O. G. 2076.

If a motion to dissolve because one applicant is not entitled to make the claim is not filed, the question cannot be considered on the final adjudication.

Woods v. Waddell, 106 O. G. 2017.

As stated in Maxwell v. Bryon v. Henry, 98 O. G. 1968, an interference should not continue between two parties as to certain counts and between three parties as to other counts.

Dow v. Benson, 107 O. G. 1378.

The differences in structure referred to, however are not included in the claims, and are, therefore, immaterial.

Auerbach & Gubing & Wiswell, 108 O. G. 289-290.

Dissolution is necessary only where the irregularity is such as will preclude a proper determination of the question of priority It is not necessary in all cases of irregularity. For instance, the fact that one applicant inserted a second specific claim in order to secure an interference is not material.

Hoefer, Hoefer & Hoefer v. Barnes, 108 O. G. 560.

Where the claims of interfering parties are in identical language and each party has a construction responding in function to the broad terms thereof, there is an interference in fact, although the constructions are specifically different.

Gordon v. Wentworth, 120 O. G. 1165.

Action should not be taken by the Office without sufficient reason where an adverse determination upon the merits of the patent may result; but where reasons for action exist the Office is not to be deterred therefrom because, as an incident thereto, a cloud may be cast upon a patent.

Griffith v. Dodgson, 122 O. G. 2064.

No testimony as to inoperativeness, or public use, previous to motion to dissolve.

Barber v. Wood, 127 O. G. 1991.

Where claims have been suggested to an applicant and he makes the same under protest accompanying the protest with a statement that he does not believe that he has a right to make them, giving his reason for that statement, and where after inspecting the other parties application he still contends that he has no right to make them, he should be permitted to argue the question before the primary Examiner.

The practice announced in Miller v. Perham, 121 O. G. 2667, is modified to this extent, 129 O. G. 3161.

Eichelberger and Hibner v. Dillen, 129 O. G. 3161.

The Office has found by experience that in order to properly transact business the questions which are sought to be raised by applicants appearing before it must be presented according to certain procedure. While it is not desired to be too technical, yet applicants must be required to follow the simple and well-known procedure laid down in the Office rules and in a long line of decisions.

Filbel v. Fox, 130 O. G. 2375.

A motion under this rule is a proper way of showing cause under rule 114.

Filbel v. Fox, 130 O. G. 2375.

(3) *Subject-Matter of Motion.*

When dissolved the matter becomes ex parte and one party can not interfere with the issuing of a claim to the other.

Sovereign et al. v. Lillie, 185 O. G. 830.

In an interference between a patent and an application for the reissue of a patent, it appears that the invention was not shown in the original patent, priority awarded to patentee.

Nelson v. Felsing and Felsing v. Wilson, 142 O. G. 289.

Under the rulings of the Court of Appeals of the District of Columbia in Foster v. Antisdel, 88 O. G. 1527, Prendle v. Brown, 112 O. G. 957, this question could not be considered in the Interference. If it were established that Ashton alone were the inventor this of itself would afford no ground whatever for the award of priority to Pickard. In any case it would be necessary for Pickard to establish priority of invention on his part to warrant a decision in his favor.

Pickard v. Ashton and Curtis, 137 O. G. 732.

That the application of a third party should be included.

Carroll v. Hallwood, 135 O. G. 897.

That a concession of priority was obtained by duress may not be considered collaterally.

Wilson v. Felsing and Felsing v. Nelson, 142 O. G. 289.

An interference should be dissolved when the interference claim is improperly introduced into a reissue application by one of the parties.

Evans, Bussel & Vose, 1873 C. D. 36.

An interference should be dissolved when the interference claims are not legitimate combinations.

Pearl & Sawyer, 1874 C. D. 58; Lynch & Roff v. Dryden & Underwood, 1873 C. D. 73.

A motion to dissolve the interference on the ground of lack of patentable invention in the claim involved allowed.

Dunton v. Young & McFarren, 10 O. G. 243; Chambers & Mendham v. Tucker et al., 11 O. G. 1009.

Motion to dissolve for non-interference in fact, only involves all inquiries which assume patentability of the claims.

Zeidler v. Leech, 1891 C. D. 9.

If the applicant does not choose to restrict his application in the manner pointed out in Rule 104, but thinks the claims do not interfere, he may move to dissolve the interference under this rule.

Drawbaugh v. Blake, 23 O. G. 1221.

If one party is a joint applicant and is not a joint inventor, the opposite party may move to dissolve the interference on the ground that his opponent has no right to make the claim. (Authorities reviewed.)

Hicks & Keating v. Purvis & Bilgram, 40 O. G. 348.

After the time limit has expired it is discretionary with the Examiner of Interferences whether or not he will transmit the motion.

Scribner & Warner v. Childs v. Balsby, 1892 C. D. 104.

Motion to dissolve on the ground that the affidavit under Rule 75 was insufficient.

Schmertz v. Appert, 77 O. G. 1784.

(4) *Ground for Dissolution.*

Since the date on which the Suedeker applications were filed are subsequent to the date of invention alleged in Kitselmans Preliminary statement the patents cited are not valid references (Forsyth v. Richards, 113 O. G. 1537). Even when such patents claim the invention in question and therefore could not be overcome by affidavits. Motion should not be transmitted.

Raymond v. Kitselman v. Sommers et al., 134 O. G. 2243.

In this case the Primary Examiner dissolved the interference on the affidavit of one of the Trauts as a sole inventor. This order was irregular; after the declaration of an interference it cannot be dissolved except by the Examiner of Interferences, or the Commissioner, or by the Board of Examiners, or Commissioner on appeal.

Traut & Traut v. Disston & Morse, 70 O. G. 99.

A motion for dissolution should not be based upon testimony, affidavits, or other actions of an adverse party filed after the approval of the preliminary statements and which,

if accepted by the office, may form grounds for judgment of priority.

Sullivan v. Thomson, 94 O. G. 585; Page v. Bugg, 89 O. G. 1342; Felbel v. Oliver, 92 O. G. 2339; Winton v. Jeffery, 112 O. G. 500; Ellis v. Schoreder v. Allen, 134 O. G. 1803.

Insufficiency of opponents affidavit under rule 75 held to be sufficient ground for dissolution. .

Hodgkinson v. Potter, 185 O. G. 251.

Where applicant's preliminary statement shows two years' public use.

Schenck v. Rider, 1870 C. D. 135.

Where the proof shows that neither party made the invention, the question of priority is at an end, and there can be no further interference. Interference dissolved.

A sole inventor is not a party to an interference between third party and himself and another as joint inventor.

Pugh v. Hamilton, 1871 C. D. 116; Walters et al. v. Yost et al., 1875 C. D. 59.

Where the specifications disclose compositions that are essentially different both as to proportions and the character of the ingredients used and the process of using the composition, the interference should be dissolved.

Jackson v. Nichols, 1871 C. D. 278.

An interference should be dissolved when the interfering claim is to elements which are not shown to be capable of use by themselves.

Jackson v. Nichols, 1871 C. D. 278.

The interference dissolved by the Examiners-in-Chief on the ground that the two applications did not interfere, on an appeal from the final judgment of the Examiner of Interferences.

Frick, 1872 C. D. 124.

An interference should be dissolved when the two inventions are radically different and designed for entirely different purposes.

Pearl & Sawyer, 1874 C. D. 58; Dod v. Cobb (1876 C. D. 232), 10 O. G. 826.

An interference dissolved because the claim was too broad in view of the state of the art.

Scott v. Ford, 14 O. G. 413.

If the claims are substantially the same the interference should not be dissolved.

Drawbaugh v. Blake, 23 O. G. 1221.

A motion to dissolve an interference on the ground that the oath to one of the applications was not taken before a

proper officer considered, and the Commissioner says: "Judgment as to the application of A and B has been admitted to examination, notwithstanding the effect under consideration, the examination will not be suspended." But no patent should issue until the mistake was rectified.

Warnant v. Warnant, 17 O. G. 265.

When an interference is sent back to the Primary Examiner on a motion to dissolve or suspend the interference, or by direction of the Commissioner upon the allegation that there exists a statutory bar to the claim, or that the claim is not patentable, or that the applicant has no right to make the claim (Rule 116-120), which motion is granted by the Examiner, the interference is *pro hac vice* dissolved, and the application involved becomes *ex parte*.

Faure v. Bradley v. Cowles & Cowles, 40 O. G. 243.

Interference dissolved to permit Primary Examiner to require an oath applying to date of completion of the application.

Miller v. Lambert, 72 O. G. 1903.

The mere possibility that the claims may be made by the parties and new controversies may arise is no justification for dissolving an interference already in progress.

Annand v. Spalckhaver, 87 O. G. 2741.

Matter which has been raised on a motion to shift the burden of proof cannot be again raised on a motion to dissolve.

Baetz v. Kukkuck, 148 O. G. 1343.

Motion to dissolve interference upon the ground of estoppel by oath of applicant to a preliminary statement and by the testimony of his witnesses in a previous interference wherein he was one of two applicants.

Mead & Brown, 48 O. G. 397.

Where foreign patent expired because of non-payment of tax and applicant summoned to show cause why interference should not be dissolved for want of right to make the claim. His failure to respond construed an admission.

Armstrong, 71 O. G. 1615.

A motion to dissolve because opponents were estopped from having this interference in view of a prior interference transmitted.

Foglesing v. Hutt & Phillips, 61 O. G. 151.

Interference dissolved because of non-patentability of issue, claims were limited and new interferences declared; motion to dissolve because patentability was *res adjudicata* refused.

Kitsee v. Robertson, 97 O. G. 2306.

In that case (121 O. G. 1978) the existence of interference

in fact was regarded as doubtful, and it was in view of the doubt that the consent of the parties was permitted to turn the decision in favor of dissolution. I have no doubt as to the existence of interference in fact in the present case. The interference must accordingly continue. (Trade-Mark.)

Hirsch & Co. v. Jennen v. Hilbert & Sons v. Sample & Co., 122 O. G. 1724.

A motion for dissolution bases upon the ground that the moving party has no right to make the claim to the subject-matter in issue should not be transmitted.

Martin v. Mullin, 127 O. G. 3216; Miller v. Perham, 121 O. G. 2667; Bellows v. King, 106 O. G. 997; Robins, Jr., v. Titus, 110 O. G. 310.

In Hirsey v. Peters (6 App. D. C. 68) this court said an applicant who claims an alleged patentable invention is not to be heard to urge non-patentability of his claim after it has been placed in interference with other claims.

Potter v. McIntosh, 127 O. G. 1995.

(5) *Patentee—Applicant.*

So far as the question of estoppel is concerned counsel has referred to no case, and I have been able to find none, in which an applicant has been held estopped to present claims copied from, and to contest an interference with a patent during the pendency of the application where the invention covered by these claims was disclosed in the application as, originally filed.

Stevens v. Grissinger, 202 O. G. 951.

When a patent has been inadvertently granted an application should not be rejected unless in a very clear case.

Both v. Barr.

Should it be determined in the interference that the applicant did not make the invention until after his opponent, a patent on his application will be refused for this reason, and there will be no occasion for attempting to establish a statuary bar.

Luden v. Claus & Claus, 190 O. G. 265.

Had the patentee moved to dissolve because the Applicant had no right to question the patentability of the issue it would have been granted.

At this stage of the proceeding, however, it is thought best to terminate the proceeding by an award of priority.

DeFerranti v. Lindmakr, 183 O. G. 783.

Where both the parties are applicants the fact that each of them moved to dissolve the interference on the ground that the issue is not patentable does not warrant the dis-

solution of the same if the Examiner is of the opinion that the issue is patentable.

Thomlinson v. Kelly, 183 O. G. 784.

It is well settled that where an applicant is involved in an interference with a patentee and alleges in a motion to dissolve the non-patentability of the issue, his conclusion will be accepted and the interference dissolved without transmitting the motion. See 109 O. G. 1608, 111 O. G. 584, 111 O. G. 810, 115 O. G. 2136, 116 O. G. 1731.

Paterson v. Neper, 192 O. G. 215; Blood v. Ross, 161 O. G. 267.

Patentee applicant.

Earll v. Love, 140 O. G. 1209.

The issue should have the broadest construction possible, even when one party is a patentee.

Morgan v. Taylor v. Hanson, 208 O. G. 985.

Patentee can not contend that the Interference should be dissolved because it is too narrow to include applicant.

Morgan v. Taylor v. Hanson, 208 O. G. 985.

A patentee can not be heard to contend for the non-patentability of an invention defined in the claim of his patent, for this would be to give him a right of opposition based upon a patent which pro tanto is void and from which no right can be derived.

Kennedy v. Hazelton, 128 U. S. 667; Commissioner Ewing in Fend v. Miggett.

An applicant should not be permitted to unnecessarily consume the term of a Patent.

Gregory, etc. v. Ledux, 219 O. G. 929.

Transmission refused to examine into the question of public use alleged to be shown by preliminary statement of an applicant on motion of a patentee. Cases reviewed.

Thomson & Unbehend v. Hisley, 66 O. G. 1596.

Where a patentee claiming specifically would be entitled to all his claims, even if he were an applicant, in spite of a judgment of priority in favor of his opponent, the fact that his opponent's claim would dominate his own is no sufficient reason for declaring or continuing an interference. Rule 75 provides for precisely such a case.

Reed v. Landman, 1891 C. D. 73.

Where a party's opponent is a patentee said party can not move to dissolve on the ground that he has no right to make the claims adopted by him when suggested under Rule 96, otherwise if opponent is an applicant.

Hernsdorf v. Driggs v. Schneider, 133 O. G. 1189.

An applicant for reissue moved to dissolve the interference on the grounds that the issue was not patentable. Held, such motion should not be considered.

Bellows v. King, 106 O. G. 997.

Where R., an applicant, moved to dissolve on the ground that the issue was not patentable, it was said:

"The only question to be determined in the interference is whether a patent should issue to R., since he is the only applicant claiming the invention, and since he admits by his motion that he is not entitled to the claims there seems to be no reason why the Office should consume time in considering the matter."

Robbins, Jr., v. Titus and Titus, 110 O. G. 310.

A patentee is clearly entitled to make a motion upon any of the grounds specified.

Fickinger & Balke v. Hulett, 110 O. G. 859.

An applicant may move to dissolve interference on the ground that a patentee had no right to make the claims.

Hull v. Hallberg, 110 O. G. 1428.

Where one of the parties to an interference is a patentee and the applicant brings a motion to dissolve on the ground that the issue is not patentable, held that the interference will be dissolved, and the applicant will be thereafter regarded as estopped from insisting upon the claims.

Weissenthanner v. Goldstein, 111 O. G. 810; Lippe v. Miller, 109 O. G. 1608; Robins, Jr., v. Titus et al., 110 O. G. 310; Griffith v. Dodgson, 116 O. G. 173; DeFerranti v. Lindmark, 183 O. G. 782.

A patentee may move to dissolve an interference on the ground that the claims are not patentable.

Baltzley v. Seiberger, 115 O. G. 1329 (overruling Manson v. Huchinson, 201 O. G. 569).

Where an applicant is in interference with a patentee and moves for a dissolution of the interference on the ground of non-patentability of the issue, the interference should be dissolved even where patent has been inadvertently issued during pending of application.

Griffith v. Dodgson, 116 O. G. 1731; Garnell v. Pope, 115 O. G. 2136.

The statute does not specifically provide for the consideration of motions, and Rule 122 both in the letter and reason limits the fight to such consideration to those cases where the opponent of the moving party is an applicant.

Griffith v. Dodgson, 116 O. G. 1731.

In Hisey v. Peters (6 App. D. C. 68) this court said an

applicant who claims an alleged patentable invention is not to be heard to urge non-patentability of his claim after it has been placed in interference with other claims.

Potter v. McIntosh, 127 O. G. 1995.

(6) *Form of Motion.*

Transmission of motion.

Winter v. Slick v. Wollkommer, 97 O. G. 1837.

The statements should be such as to advise an opponent of the reasons which are to be urged at the hearing.

Burleigh v. Elliott, 197 O. G. 242.

A concession of priority is a basis for a judgment of priority and is not a ground for dissolution.

Mesnard v. Hodgkinson, 190 O. G. 1027.

It is asserted on behalf of L. that in order to read the issue upon the McD. construction, it must be given a certain construction which interpretation is inapplicable to the L. device. This is a matter of right to make the claim and not a difference of meaning.

Lindstrom v. MacDonald, 187 O. G. 832.

Right to make claim, and difference of meaning do not depend upon the prior art nor necessitate any consideration of the prior art by the Primary Examiner.

Fowler v. Uptegraff, 184 O. G. 803.

A motion partly on the ground of alleged lack of right to make the claim and in part upon an alleged difference in the meaning of the counts, as informal.

Vandervild v. Smith, 159 O. G. 490.

It is well settled that where a party moves to dissolve an interference when more than one reference is relied upon, it must be pointed out how the references are to be combined.

Vandervild v. Smith, 159 O. G. 490.

An appeal to the Commissioner. The motion is irregularly presented in that it is not accompanied by a motion to restore the Jurisdiction to the Examiner of Interferences, or by a motion to transmit the same. Furthermore no excuse is given why the grounds set forth in the present motion were not urged at the time the original motion for dissolution was presented.

Langslow v. Malocsay, 155 O. G. 1043.

The matter that is not readable upon the device should be clearly stated. If new matter improperly introduced is alleged it should be clearly stated of what that new matter consists.

Baetz v. Kukkuck, 148 O. G. 1343.

If the motion has reference to a certain word that occurs in some but not all the counts, it must be specified which counts it refers to.

Baetz v. Kukkuck, 148 O. G .1343.

Form of Motion. That some of the counts do not properly read on the patented structure of the moving party relates to the right of the patentee to make the claims and is not a question of formality on the declaration.

Earll v. Love, 140 O. G. 1209.

That the counts of the issue when considered in the light of the disclosure of C. who first made the claim, will not read on applicants structure or in other words, that applicant has no right to make the counts of the issue; that the counts have a different meaning when read upon C.'s structure from what they have when read upon his own. Neither of these reasons is proper subject-matter to urge under the head of informality in the declaration.

Corey v. Eiseman and Mason, 122 O. G. 2063; Danquard v. Courisville, 131 O. G. 242; Skinner v. Carpenter, 135 O. G. 661.

If it is to be contended that the claims are vague and indefinite there should be a statement to that effect.

Skinner v. Carpenter, 35 O. G. 661.

An objection to the patentability of a claim should be made by a motion to dissolve the interference and not by an attempt to restrict the issue.

Hockhausen v. Weston, 18 O. G. 857.

Form and practice under this rule.

Green v. Siemens v. Hall v. Field, 37 O. G. 1475.

Irregularity in declaring an interference has reference to a case where, in consequence of some defect, some misdescription, some error in describing the thing alleged to be the subject of the interference, or something of that character, a proper solution of the question of priority can not be reached. It does not refer to what are irregularities in consequence of a violation of the provisions of Rules 121 and 122.

Edison & Gilliland v. Phelps, 38 O. G. 539.

The decision must be confined to the question presented.

Zeidler v. Leech, 1891 C. D. 9.

If facts are relied upon other than those disclosed by the record, they should be stated in order to receive consideration.

Law v. Woolf, 1891 C. D. 91, 55 O. G. 1527.

Patentability is not in question in a motion to dissolve for non-interference in fact.

Forslund v. Matthews, 1891 C. D. 237.

On the granting of a motion to dissolve the interference after judgment on the record the Examiner of Interferences will vacate the judgment of priority.

Garrison v. Hubner, 1891 C. D. 59.

Failure to make a motion to dissolve, upon a ground that an accepted amendment to one of the applications involved is for new matter, amounts to an acquiescence in such acceptance and in the decision of the Office that such amendment does not involve new matter.

Croskey v. Atterbury, 1896 C. D. 437.

Moving to dissolve an interference upon any of the grounds stated in Rule 122 before the preliminary statements are opened and approved is a practice not to be encouraged.

King v. Babendrier v. Libby, 89 O. G. 2653.

A motion to vacate judgment is not an alternative remedy with a motion to dissolve.

Patten v. Weisenfeld, 98 O. G. 2589.

In a decision the four reasons for dissolution should be kept distinct.

Woodward v. Newton, 86 O. G. 490.

The case remanded to have a decision having regard to the distinctions pointed out above.

Owens v. Richardson, Jr., 111 O. G. 1038.

A motion to extend time for filing an appeal should be accompanied by appeal.

Greuter v. Matthew, 112 O. G. 253.

That the counts are vague and indefinite is such an irregularity in the declaration of an interference as to preclude a proper determination of the question of priority.

Dinkel v. D'Olier, 113 O. G. 2507.

It is proper in motion to dissolve to allege that a party has no right to make the claims giving the reasons therefor and to follow that allegation by the other allegation that the counts of the issue have different meanings in the event that the motion to dissolve should be denied on the first ground. The reason for this ground should also be given.

Rowntree v. Sloan, 189 O. G. 1281.

To justify transmission of motion to dissolve because of difference in meaning of the count of facts must be alleged indicating something more than a possible lack of right of one of the parties to make the claims.

McIntosh v. Riley, 184 O. G. 801.

The motion to extend the time for filing motions was properly denied by the Examiner, who stated that the rea-

sons set forth might justify the excuse for delay should a motion be made.

Egly v. Schulze, 117 O. G. 276.

If the motion is for the purpose of including "allowable claims" in another pending application which has been filed by applicant, the motion should be accompanied by a copy of such claims.

Normand v. Krimmelbein, 115 O. G. 249.

A motion to dissolve for non-interference which does not specify which of two opponents does not interfere is irregular and should not be transmitted.

Vreeland v. Fessenden v. Schloemilch, 117 O. G. 2633.

The four grounds for dissolving interferences relate respectively to very different matters and should not be confused with one another.

The question raised by the contention of non-interference in fact is whether the claims as found in the cases of the respective parties define one and the same invention, and the question is independent of the patentability of the claims, the right of the parties to make them or any irregularity in the declaration of the interference.

Kaczander v. Hodges & Hodges, 118 O. G. 836.

As pointed out in the cases of Woodward v. Newton, 86 O. G. 490, and Owens v. Richardson, 111 O. G. 1037, the four grounds for dissolution given in Rule 122 have distinct meanings which should not be confused.

Pfingst v. Anderson, 118 O. G. 1067.

A motion for dissolution should give the opposing party a reasonably definite idea of the points to be considered when the hearing is had. The counts of the issue against which non-interference is alleged should be specified.

Vreeland v. Fessenden v. Schloemilch, 119 O. G. 1259.

In a motion to dissolve the bare allegation that there is no interference in fact is insufficient.

The point or points to be argued should be specified with great particularity. Not only the count or counts, but the particular element or elements which are to be brought into question should be specified.

Dunker v. Reist, 119 O. G. 1925.

Dissolution for non-interference in fact must be based only on those facts and reasons which show that the counts of the issue have such different meanings that they might properly be allowed to both parties.

Townsend v. Copeland v. Robinson, 119 O. G. 2523.

A motion to transmit because opponents' application did

not originally contain the subject-matter of a combination claim must specify what element or elements of the combination were wanting.

Latour v. Lundell, 122 O. G. 1046.

In setting forth facts in motions for dissolutions the distinction between the general grounds of dissolution which have been pointed out in Woodward v. Newton, 86 O. G. 490, Owen v. Richardson, 111 O. G. 1037, and Kaczander v. Hodges & Hodges, 118 O. G. 836, must be carefully observed. The observance of these distinctions is necessary to the logical presentation of the question raised and to the avoidance of confusion in the matter of appeals.

Klepetko v. Becker, 120 O. G. 658.

It is to be noted that the motion does not specify the element or elements of the counts which can not be read on the two devices with the same meaning and gives no information to the opposing parties of the points to be argued.

Therefore the motion was not in proper form and should not have been transmitted.

Miller v. Mann, 122 O. G. 730.

A motion to dissolve alleging non-patentability of the opposing parties' claims in view of certain specified patents is not indefinite simply because the patents are enough to anticipate the claims of both parties.

Latour v. Lundell, 122 O. G. 1046.

The recently established practice requiring definiteness requires that motions shall distinctly and definitely set forth the points to be argued, but not arguments themselves.

Garcia v. Pons, 122 O. G. 1396.

In a motion to dissolve because of indefiniteness of the counts the moving party should point out wherein the supposed indefiniteness lies, so that the opposing party will know the character of the arguments that he will be called on to meet.

Berry, Kane & Stengard v. Hildreth, 122 O. G. 1722.

The right of the appellant to allege and urge that there is no interference in fact is recognized, but under the present practice of the Office he is required to make clear upon what point he intends to base his arguments.

Dickinson v. Hildreth, 122 O. G. 1397.

Where matter is set forth in a motion for dissolution as basis for one ground thereof which should only be considered in connection with another and different ground, the motion is not in proper form and should not be transmitted.

Corey v. Eisman & Misar, 122 O. G. 2063.

The statement contains no positive allegation that certain terms appearing in the issue have such distinct meaning when read as claims in the different applications that different inventions are represented thereby in the respective cases.

Motions to dissolve on this ground are not in proper form unless they contain specific allegation of the kind mentioned.

Booth, Booth & Flynt v. Hanan & Gates v. Marshall, 123 O. G. 319.

The question of incompleteness of the claims is one of merits, and can not be raised under the allegation of informality.

Lotterhand v. Cornwall, 148 O. G. 1344.

A motion to dissolve on the ground that the testimony shows the affidavit under Rule 75 was false, refused.

Schuler v. Barnes v. Swarturrio, 140 O. G. 505.

The failure to include claims not patentably different from the issue furnishes no ground for dissolution of the interference.

Earll v. Love, 140 O. G. 1209.

Public use is not a basis for a motion to dissolve.

Gardner v. Delson v. Sampliver v. Meyers, 184 O. G. 1073-4.

The practice to be pursued in establishing public use of an invention is clearly set forth in the following decisions.

Sanford Mills v. Aveyard, 88 O. G. 385; Van Ausda, 91 O. G. 1617.

The question of intervening rights is not one which is material to the question of priority. A right to a reissue is an ex parte question.

Perkins et al. v. Wecks, 188 O. G. 1052.

It is not enough to state certain facts, it is desirable to state that those are the facts he desires to prove.

Henderson & Chanley v. Kindervater, 192 O. G. 741.

Any or all motions provided for in Rule 122 may be brought in connection with claims introduced under Rule 109 or the issue including the same, even though such motion were brought and the question raised thereby decided, under the interference as originally declared.

Jenne v. Brown v. Booth, 1892 C. D. 78.

Failure to make a motion to dissolve upon a ground that an accepted amendment to one of the applications involved is for new matter amounts to an acquiescence in such acceptance and in the decision of the Office that such amendment does not involve new matter.

Croskey v. Atterbury, 1896 C. D. 437.

Trade-Mark. If the issue in respect to the class of goods is narrower than the class of goods upon which the other party uses the mark, there has been such irregularity in declaring the interference that it should be dissolved.

Banigan Co. v. Bloomingdale, 89 O. G. 1670.

The contention that the issue is devoid of patentable novelty is not a proper one for consideration, since it is *ex parte* in character.

Benjamin v. Searle, 59 O. G. 630.

The question of operativeness may best be determined when the witnesses are called and each party given a chance to make such tests as may be desirable.

The question as to whether one applicant has the right to make the claim and whether he did in fact make it, are not properly appealable.

Eastman v. Houston, 87 O. G. 1871.

These motions must be solely based on the applications.

Felbel v. Oliver, 92 O. G. 2339.

It is well settled that motions to dissolve an interference can not properly be based on matter outside of the record.

Bundy v. Rumbarger, 92 O. G. 2002.

It is well settled that the bar to a party's right which is contemplated by the rule—must exist independent of the interference.

Horton v. Summer, 93 O. G. 2339.

The fact that applicant asserts that his application is a division of a former one does not constitute an irregularity under this rule.

Meyer v. Sarfert, 96 O. G. 1037.

One party discovered that his opponent's device did not act as described in the application on cross examination of the party—not matter coming within this rule.

Sullivan v. Thomson, 94 O. G. 585.

The question of public use is not a proper foundation for a motion under this rule, but the question of anticipation by patents is.

Davis v. Smith, 96 O. G. 2409.

The motion to the Examiner of Interferences should be accompanied by a motion to transmit. If not made within twenty days excuse should be made. This is not the proper way to try the question of joint or sole ownership.

Frederick v. Frederick & Frederick, 99 O. G. 1865.

It is the settled practice of this Office that nothing can be considered by the Primary Examiner on a motion to dissolve on interference which is not contained in the record of the

case, unless timely notice of such matter as may be urged in support of the motion which is not of record, is served upon the opposing party before the time set for hearing.

Summers v. Hart, 98 O. G. 2585.

Where W. had two applications pending in either of which the claims in controversy could be made and he elected to make them in the later case, held that he is entitled to the date of his earlier case as his record date, even if the earlier application should have been included. In the absence of some substantial contention the interference will not be dissolved for this reason after judgment.

Holland, 99 O. G. 2548.

Facts which are alleged to be established by the testimony are to be determined on final hearing and not on motion for dissolution.

Shallenberger v. Andrews, 100 O. G. 3013.

The question as to whether it was a serious error for the Examiner to have declared the interference without formally allowing the claim is one which should be raised under this rule.

Luger v. Browning, 100 O. G. 231.

A protest against the declaration of an interference. Such motions should be determined under this rule. It is contrary to the settled practice of the Office for the Commissioner to consider in advance the propriety of the proposed action of a lower tribunal.

Sarfert, 102 O. G. 1049.

The question of operativeness of invention should be determined by a motion under this rule.

Osborn v. Hotsapillar, 102 O. G. 1296.

A petition asking that the action setting aside a default resulting in abandonment, dismissed for lack of equity.

Gerand v. Abbott, Grand & McGirr, 103 O. G. 662.

A motion upon alleged anticipatory matter should be made under this rule in due time and not under Rule 126.

Dittgen v. Parmenter, 103 O. G. 1164.

Two interferences declared between the same parties. That these two issues are not patentably distinct is not ground for dissolution under this rule.

Dorr v. Ames & Rearson, 106 O. G. 263.

Questions as to new matter must be brought up under this rule and not by motion to shift the burden of proof under Rule 116.

Tripp v. Wolff v. Jones, 103 O. G. 2171.

The case will not be transmitted under this rule to the Primary Examiner to investigate the question of public use.

Shrum v. Baumgarten, 104 O. G. 577; Kneisley v. Kaiserling, 174 O. G. 830.

Whether or not the junior party materially altered his application after filing it, is a question not to be considered by a motion under this rule.

Hopkins v. Scott (See Rowe & Brickmann, 133 O. G. 515), 105 O. G. 1263.

If the matter of the propriety of suggested claims under Rule 96 is to be discussed it should be by motion under Rule 122.

Sutton v. Steele, 107 O. G. 541.

No appeal from the refusal of the Examiners in Chief to direct the attention of the Commissioner to certain patents alleged by one of the contestants to constitute a statutory bar.

Schmedl v. Walden, 1891 C. D. 150.

The question whether or not a supplemental oath should be furnished is an *ex parte* question. The absence of such an oath even where it should have been furnished is not such irregularity as will preclude the proper determination of the question of priority.

Auerbach & Gubing v. Wiswell, 108 O. G. 289; vid. Rowe v. Brinkmann, 133 O. G. 515.

Motion made to dissolve because of lack of oath. Refused transmission. But time given to file oath with a notice that if it was not filed the interference would be dissolved. A formal defect in the oath filed was excused.

Graham v. Langhaar, 164 O. G. 740.

Where, however, the moving party to an interference calls attention to an informality in an oath and contends that he should not be compelled to contest the interference unless and until his opponent files an oath in compliance with the rules, it would seem that an order may properly be issued calling upon the delinquent party to file an oath in compliance with Rule 46, within a limited time set under penalty of dissolution of the interference.

Graham v. Langharr, 164 O. G. 740.

Patentability of opponent's claims must be presented under this rule and not by appeal against award of priority.

Kempshall v. Sieberling, 110 O. G. 1427.

Joint or sole inventor. Interference not suspended to determine.

Hull v. Hallbery, 110 O. G. 1428.

Failure to make a motion to dissolve upon a ground that

an accepted amendment to one of the applications involved is for new matter amounts to an acquiescence in such acceptance and in the decision of the Office that such amendment does not involve new matter.

Croskey v. Atterbury, 1896 C. D. 437.

If it were true that the counts of the interference covered two specific forms not to be included in one application, still this would be no ground for dissolution.

Atherton & Happ v. Cheney, 111 O. G. 1040.

It is well settled that the question as to whether the original application contains the invention should be raised by a motion to dissolve. It will not be considered upon an appeal upon the question of priority of invention.

Seeberger v. Dodge, 113 O. G. 1415.

Question of joint inventorship relates to a statutory bar and not to priority of invention, and therefore such an inquiry in an interference proceeding is not proper.

Robin v. Muller & Bonnett, 113 O. G. 2506.

Facts outside of the record should be stated in the motion to receive consideration.

Law v. Woolf, 1891 C. D. 91, 55 O. G. 1527.

Trade-Marks. A motion to dissolve based on the ground that the date of adoption and use alleged by one of the parties was subsequent to that of registration of H. and Co. Held properly refused transmission but in view of the fact that an interference, between the application of this party and the registration of H. and G. had been finally decided in favor of the former.

Gobel & Sons Grocer Co. v. Johnson, 180 O. G. 880.

In trade mark cases an appeal as to priority and indentity of subject-matter will not be considered.

Horne v. Somer and Co., 129 O. G. 1609.

The Examiner decides nothing but the question raised by the motion and appeal brings up nothing but the decision and the motion decided.

Zeidler v. Leech, 1891 C. D. 9.

As held in the case of Jenne v. Brown v. Booth, 50 O. G. 157; C. D. 1892-78, any or all motions provided for in Rule 122 may be brought in connection with the new claims included in the interference under the provisions of Rule 109, and therefore P.'s motion as to the new counts was a proper one.

Pfingst v. Anderson, 114 O. G. 264.

It is the general policy of this Office to have all questions

which may be brought in issue between the parties settled in one interference.

Normand v. Krimmelbein, 115 O. G. 249.

Error in suggesting a claim under Rule 96, is not considered such an irregularity in the declaration as will preclude a proper determination of the questions of priority, and is not therefore a sufficient warrant for dissolving the same.

Templin v. Sergeant, 119 O. G. 961.

The presumptive is that the Office did its duty in notifying the caveators of the filing of the interfering application, and the burden is upon them to establish their allegation of no notice by adequate proof.

Killeher & Grimm v. Mayhew, 72 O. G. 895.

Where a motion for dissolution rests only on limitations into the claims by the moving party and not stated in such claims. Held that the motion was properly denied.

Voter v. Tally, 119 O. G. 339.

A person is not estopped from moving to dissolve because he made the claim constituting the issue and filed a preliminary statement relating thereto.

Van Auken v. Osborne v. Harrison v. Canfield & Van Auken, 119 O. G. 1584.

The improper issuing of a patent to one's opponent is not a ground for dissolution.

Dunker v. Reist, 119 O. G. 1925.

Non-interference in fact was placed in the rules as a ground for dissolution of interference at a time when parties were put in interference proceedings who had not made the same claims; it can only occur now where the same terms, though properly used in the application of each party, have distinctly different meanings in the respective cases.

Blackmore v. Hall. 119 O. G. 2533. See Townsend v. Copeland v. Robinson, 119 O. G. 2533.

Upon a petition that the Examiner be directed to hear a party upon his opponents' motion to amend on the question his opponent's right to make proposed claims. Held, that petitioner may present his arguments upon motion for dissolution in case the proposed claims are admitted.

Moore v. Curtis, 120 O. G. 324.

Unsubstantial and clerical errors do not form proper basis for dissolution.

Gally v. Burton, 120 O. G. 325.

Matters which may be considered in determining the question of priority should not be transmitted to the Primary Examiner. Such as effect of prior applications.

Struble v. Young, 121 O. G. 339.

Lack of Notarial Seal not a sufficient reason for dissolving interference.

Scott v. Hayes & Berger, 121 O. G. 2326.

The right of the moving party to make the claims corresponding to the issue can not properly be raised on a motion to dissolve the interference, because he is of the opinion that he has no right to make the claims, he should take action in accordance with the provisions of Rule 125, concerning priority or abandoning the invention.

Miller v. Perham, 121 O. G. 2667; Bellows v. King, 106 O. G. 997; Robinson v. Titus, 110 O. G. 310; Martin v. Mullen, 127 O. G. 3216; Balzley v. Seiberger, 115 O. G. 1329; Griffith v. Dodgson, 116 O. G. 1731; Garnall v. Pope, 115 O. G. 1329; Potter v. McIntosh, 127 O. G. 1995.

Where two interferences are declared, one between application of S. and a divisional application of P., and the other between the same application of S. and the parent case of P., the fact that the issue involving the parent case could as well have been included in the interference involving the divisional application does not constitute such an irregularity as will prevent a proper determination of the question of priority.

Phillips v. Sensenich, 122 O. G. 1047.

So long as the parties are claiming common features of the invention it is not of consequence which is superior, and the alleged superiority of one over the other is no ground for a dissolution of the interference.

Kolb v. Hemingway v. Curtis, 122 O. G. 1397.

If it is decided that one party has no right to make the claims, the question of interference in fact will not be considered after decision becomes final.

Warner v. Mead, 122 O. G. 2061.

The motion for dissolution in this case seems to have been based upon the ground of non-interference in fact, in addition to that of a lack of right of a party to make claims, in order that the same facts of reason may be urged in connection with either or both grounds; but this is exactly what a party should not be permitted to do, in view of the labor and delay attending such double consideration both before the Primary Examiner and on Appeals.

Booth, Booth & Flynt v. Hanan & Gates v. Marshall, 123 O. G. 319.

Where the interference is generic the first inventor of a species is entitled to judgment.

Lovejoy v. Cady, 123 O. G. 654.

If a party has no reasons to allege in his motion to transmit which would support dissolution upon appealable grounds, he would not be permitted to waste the time and labor of his opponents and of the Office with appeals which can have no other object than to obtain a review of an unappealable decision.

Pym v. Hadaway, 123 O. G. 1283.

Interference and patentability considered by the Primary Examiner a careful examination nevertheless made to determine whether there is anything in the record of this case, as there was in the case of Podlesak and Podlesak v. McInnerney (Court of Appeals Jan. 4, 1906) necessitating limitations of the claims in the respective applications to specific non-interfering features.

Bechman v. Southgate, 123 O. G. 2309, citing Sobey v. Holselaw, 119 O. G. 1922; Potter v. McIntosh, 120 O. G. 1823; Bechman v. Wood, 89 O. G. 2459; Bechman v. Wood, 89 O. G. 2462.

The failure to include the claims did not constitute an irregularity.

Locke v. Crebbin, 124 O. G. 317.

It is to be noted that the question involved in the contention of Blackford relates to the patentability of the present issue over the subject-matter of the issue of the former interference, and not of the right of Wilder to make the claim by reason of the nature of the disclosure. The question is therefore not in the class indicated in my decisions as subject to consideration in determining the award of priority.

Blackford v. Wilder, 124 O. G. 319.

Question of *res adjudicata* properly raised under this rule.

Blackford v. Wilder, 124 O. G. 319, citing Blackford v. Wilder, 104 O. G. 578; Potter v. McIntosh, 122 O. G. 1721; Sobey v. Holselaw, 119 O. G. 1922; Pohle v. McKnight, 119 O. G. 2519; Kilbourne v. Hirner, 122 O. G. 729; Podlesak v. McInnerney, 120 O. G. 2127.

Apparently an interference dissolved because of the inoperativeness of one party's device is not res adjudicata.

Moore, Commissioner, v. U. S. ex rel. Coburn Machine Glass Co., 191 O. G. 293.

So far as now appears there is nothing in the statute or

rules requiring the defects in Turner's oath to be corrected before the same is accepted as a complete application. Such being the case the correction of these defects is an *ex parte* matter which may be attended to after termination of interference.

Dukesmith v. Carrington v. Turner, 125 O. G. 348.

A motion to require a supplementary oath and to shift filing date to the date of such oath should be presented as a motion to dissolve.

Dukesmith v. Corrington v. Turner, 125 O. G. 348.

It is the general policy of this Office to have all questions which may be brought in issue between the parties settled in one interference. (99 O. G. 669.)

Normand v. Krimmelbein, 115 O. G. 249.

Interlocutory motions are not permitted upon questions requiring the taking of proof such as originality and public use. (44 O. G. 945; 87 O. G. 180; 96 O. G. 2409; 103 O. G. 1164; 104 O. G. 577.)

Cory, Gilhart & Martin, Jr., v. Blakely, 115 O. G. 1328;
Knoisly v. Kaiserling, 174 O. G. 830.

A motion under this rule is a proper reply to an order to show cause under Rule 114.

Filbel v. Fox, 130 O. G. 2375.

The real meaning of the words of the claims may not be apparent when viewed solely in the light of the disclosure of one party. It is believed therefore that the best practical results will be obtained by permitting a party when moving to dissolve an interference not only to raise the question of the right of the other party to make the claims of the issue, but also the question of the meaning of the claims when applied to the respective structures involved.

Eilerman v. McElroy, 130 O. G. 2721.

To be continued in the light of accompanying amendment.

Newberth v. Sizotte. 141 O. G. 1162.

Motion denied transmission for the reason that the question of interference in fact is no longer a part of the grounds enumerated in Rule 122.

Eilerman v. McElroy, 130 O. G. 2721.

A motion to dissolve which alleges that the opposite party is not entitled to receive a patent on his reissue application, involving matters that should be considered on the *ex parte* reissue application should be transmitted.

Emmet v. Fullagar, 130 O. G. 2719.

A motion to dissolve on the ground of non-patentability of

the issue is a proper reply to an order to show cause under Rule 114.

Field v. Colman, 131 O. G. 1686. See Moffat v. Weiss, 137 O. G. 1481.

But formalities must be strictly complied with and the motion brought within the time limit.

Ryder v. Brown v. Tripp and McMann v. White, 137 O. G. 228.

Vagueness and indefiniteness of the issue have uniformly been held a proper question to raise under informalities, or irregularity in the declaration of the interference, and it is thought properly so held.

Field v. Colman, 131 O. G. 1686.

It would seem that misrepresentation in a collateral matter would be sufficient for dissolution of a trade-mark interference.

L. W. Levy & Co. v. Uri, 131 O. G. 1687.

Appeal on motion to shift the burden of proof dismissed.

Dukesmith v. Carrington v. Turner, 125 O. G. 348.

The redeclaration of an interference to include new counts does not relieve against negligence in making a motion as to original claims.

Murphy v. Borland, 132 O. G. 231.

Grounds three, four and five, allege the bar of prior knowledge and use based upon the affidavit of one Plumb. These grounds were properly refused transmission under the well-established practice set forth in 66 O. G. 1596; 96 O. G. 2409; 104 O. G. 577; 115 O. G. 1328. M. contends that because these decisions refer primarily to the bar of public use the practice set forth therein is not applicable. This contention however, is not well taken, since the bar of prior knowledge and use alleged in the Plumb affidavit would have to be proved in a manner similar to the bar of public use.

Murphy v. Borland, 132 O. G. 231.

Motion to dissolve upon the ground that public use was shown by the preliminary statement of the applicant. Transmission joint and sole invention.

Thomson & Unbehend v. Hisley, 66 O. G. 1596.

The question whether a third party not involved in the interference is the real inventor of the subject-matter in issue is not pertinent to the question of priority of invention.

Hamm v. Black, 132 O. G. 841. (Cases cited.)

The question whether or not a supplemental oath should be required has been uniformly held by this Office to be an

ex parte matter upon which the proper determination of priority is not dependent.

Auerback & Gubing v. Wiswell, 108 O. G. 289; Silverman v. Hendrickson, 99 O. G. 445; Kane v. Brill & Adams, 84 O. G. 1142; Rennyson v. Merritt, 58 O. G. 1415; Phelps v. Sensenich, 132 O. G. 677.

It was directed in this case that the interference be suspended to give applicant a chance to file a proper oath and that in default the interference should be dissolved.

Rowe v. Brinkman, 133 O. G. 515.

Where one of the parties to an interference added the claims in issue by amendment, without a supplemental oath, the court of appeals would not be justified in awarding priority to the opposing party because of such failure. The most that the court could do under the circumstances would be to remand the proceeding in order that a supplemental oath may be made and matter reviewed.

Phillips v. Lensenich, 134 O. G. 1806.

The question whether the applicant will be permitted to amend his specification after such dissolution to incorporate the matter submitted or any other amendment is an *ex parte* question, which must be determined independently of any interference proceeding.

Wheeler v. Palmros, 133 O. G. 230.

Facts which are alleged to be established by the testimony are to be determined on final hearing and not on motion to dissolve.

Mead v. Brown, 48 O. G. 397; Campbell v. Brown, 56 O. G. 1565; Chase v. Ryder, 61 O. G. 885; Lotticem v. Force and Parenteau, 82 O. G. 185; Shiels v. Lawrence, 87 O. G. 180; Felbel v. Oliver, 92 O. G. 2339; Horton v. Summer, 92 O. G. 2339; Shellenberger v. Andrews, 100 O. G. 3013; Faure v. Bradley and Crocker v. Cowles and Cowles, 44 O. G. 945; Paget v. Bugg, 89 O. G. 1342; Sullivan v. Thomson, 94 O. G. 585; Frederick v. Frederick and Frederick, 99 O. G. 1865; Ritter v. Krakaw and Connor, 104 O. G. 1897; Thompson and Unbehend v. Hisley, 66 O. G. 1596; Hopkins v. Scott, 105 O. G. 1263; Winlow v. Jeffery, 112 O. G. 500; Cory, Gebhart and Martin, Jr., v. Blakey, 115 O. G. 1328; Struble v. Young, 121 O. G. 339; Schroeder v. Allen v. Ellis, 134 O. G. 1803; Falk Tobacco Co. v. Kinney Tobacco Co., 142 O. G. 567; Schuler v. Barnes v. Swartout, 140 O. G. 509.

Where no testimony has been taken and there is no ob-

jection by the other parties who have made similar motions —a motion to transmit to reform the issue should be granted.

Townsend v. Copeland v. Robinson, 124 O. G. 623 (but see same case 124 O. G. 1845).

A motion to amend the specification involved in an interference for the purpose of curing an alleged error therein should not be transmitted. (See also note to 109.)

Wheeler v. Palmros, 133 O. G. 230.

A motion based on defective oath should not be transmitted.

Rowe v. Brinkmann, 133 O. G. 515.

Apparently a defective oath in a reissue application may form a basis for dissolution.

Emmet v. Fullagor, 130 O. G. 2719.

A motion should not be transmitted to inquire whether or not one application can be changed from a joint to a sole application.

Gasaw & Co. v. Odell, 190 O. G. 1028.

The transmission of a motion filed outside of the regular time is a matter resting largely within the discretion of the Examiner of Interferences (cases).

Bastian v. Champ, 126 O. G. 2837.

An indefinite motion should not be transmitted.

Rowe v. Brinkmann, 133 O. G. 515.

A petition to transmit on the ground of informality in that certain additions to original disclosure were improper, refused transmission. As the matter relates to right to invoke the claim and not as to form.

Losher v. Barrett, 166 O. G. 751.

The only contentions and arguments which are in order in support of motions to dissolve interferences for non-interference in fact where the parties have made the same claims are those tending to show that the claims have different meanings in the case of the respective parties notwithstanding a perfect right upon the part of each party to make the claims.

Goodwin v. Smith, 123 O. G. 998.

The objection urged to ground C is that non-patentability of the issue is alleged therein, not generally but to Hadaway. The objection is not a valid one as it is conceivable that the claims might have such different meanings in the cases of the respective parties as to represent patentable subject-matter in one case and non-patentable subject-matter in the other.

Pym v. Hadaway, 123 O. G. 1283.

It is urged that if the claims are literally construed they are not patentable in view of a certain specified patent, and

for this reason they must be limited by construction to the specific device shown by the respective parties and that as so limited there is no interference in fact. The question of patentability can not be thus raised on a motion to dissolve alleging non-interference in fact.

Klepetko v. Becker, 124 O. G. 908.

Grounds must be specific. If it is alleged that new matter has been improperly introduced the new matter should be pointed out.

Lizotte v. Newberth, 124 O. G. 1842.

Robinson's motion to amend the issue does not come within the provisions of Rule 109. The proposed claims are claims not made by either of the opposing parties and were asserted for the first time in this motion. Besides there was too much delay in bring the motion.

Townsend-Copeland v. Robinson, 124 O. G. 1845.

In inaugurating the practice of requiring definiteness in motions to dissolve it was not the intention to require the parties to give the arguments, but it was the intention that the opposite party should be given reasonable notice of the points to be argued.

If the moving party is of the opinion that each of the references is a substantial anticipation of each of the claims it should be so stated; if not the motion should enumerate the reference in connection with the claims to which they will be applied in the argument.

Heyne, Haywood and McCarthy v. DeVilbiss, Jr., 125 O. G. 669.

Where a motion is made before the Examiner of Interferences to set times for taking testimony as to operativeness, a showing of reasons which do not apply to applicants' own case must be made.

Clement v. Browne v. Stroud, 125 O. G. 992.

Where a party makes a reasonable showing before the Examiner of Interferences tending to show that his opponent has no right to make a claim, and that showing does not extend to his own structure, he may be permitted to take testimony provided that the proposed testimony is of a character to justify such action.

Pym v. Hadaway, 125 O. G. 1702.

Townsend's argument that it is useless for him to appeal on the question of his right to make the claim until it is settled that the claims are patentable is not sound. As well might he argue that it would be useless for him to contest

the patentability of the claims as long as it was held he had no right to make the claims.

Townsend v. Ehret, 125 O. G. 2051.

The distinction between the several grounds for dissolution —refused to exercise supervisory power upon question of patentability under the circumstances.

Daggett v. Kaufmann, 127 O. G. 3641.

M. moved to dissolve as to one set of counts if the other set were found unpatentable on T.'s motion. Transmission refused because it was alternative and bad in form.

Turner v. Macloskie, 128 O. G. 2835.

The statement that this count "does not involve patentable invention over each of the following letters patent" after which certain patents are specified, is a sufficient compliance with the practice of the Office as set forth.

Heyne et al. v. De Vilbiss, 125 O. G. 1292.

Nothing is alleged in this case in support of the motion to dissolve because the counts have different meanings in the two applications, which may not be fully accounted for by lack of right of one or the other of the parties to make the claim, or which indicates that any other reason exists for dissolving the interference; under these circumstances the refusal to transmit the motion was right.

Cushman v. Edwards, 128 O. G. 457.

It is not pointed out in the motion what meaning may be given to counts four and five in one case that would justify the allowance of these claims to each party without regard to which was the prior inventor. Such a statement is essential for transmission on the ground of different meanings.

Cushman v. Edwards, 128 O. G. 456.

M. moved to dissolve as to one set of counts if the other set were found unpatentable on T.'s motion. Transmission refused because it was alternative and bad in form.

Turner v. Macloskie, 128 O. G. 2835.

Where claims have been suggested to an applicant and he makes the same under protest, (accompanying the protest with a statement that he does not believe that he has a right to make them, giving his reasons for that statement, and where after inspecting the other parties' application he still contends that he has no right to make them, he should be permitted to argue the question before the Primary Examiner. The practice announced in Miller v. Perhan, 121 O. G. 2667, is modified to this extent.

Eichelberger & Hibner v. Dillon, 129 O. G. 3161; Hermsdorf v. Driggs v. Schneider, 133 O. G. 1189.

Fifteen patents were cited but their pertinency was not

explained. Should not be transmitted. (Same case.)

Eichelberger & Hibner v. Dillon, 129 O. G. 3161.

The ground of motion based upon the prior art is entirely too indefinite to satisfy the requirement of the present practice. It gives the opponent no information as to what patents are to be urged against the respective counts or how applicant purposes to use or combine them to anticipate the inventions of the counts.

Brown v. Inwood and Lavenberg, 130 O. G. 978.

That the claims are unpatentable to C, and because lacking in invention, considered separately, and in light of the prior art as evidenced by patents cited against the respective applications of the parties and other patents known to the Examiner and the parties hereto, is so obviously indefinite as to need no comment. It is well settled that where patents are relied upon they must be named specifically and applied.

Brown v. Inwood and Lavenberg, 130 O. G. 978; Phillips v. Scott, 130 O. G. 1312; Lotterhand v. Cornwall, 148 O. G. 1344.

The invention involved in this controversy is exceedingly simple in character, and the application of the reference would appear to be obvious upon their inspection. In my opinion the general statement above quoted when read in connection with the specific discussion of each patent is ample to apprise the other parties and the Examiner of the application of the respective references to the claims.

Herber v. Payne and Simmins v. Friedlander, 177 O. G. 1046.

The reasons given are general and do not point out the specific portions of the claims which are alleged to have different meanings in the two applications, and is too indefinite to be transmitted.

Eichelberger & Hibner v. Dillon, 129 O. G. 3161.

Where the reasons for delay appear clearly upon the record it is unnecessary to call attention to them in the motion to transmit.

Cutler v. Carichoff, 130 O. G. 656.

If a machine is alleged as an anticipation it should be stated where it can be found.

Brown v. Inwood & Lavenberg, 130 O. G. 978.

The ground of the motion based upon the prior art is entirely too indefinite to satisfy the requirements of the present practice. It gives the opponent no information as to what patents are to be urged against the respective counts or how

applicant proposes the use or combine them to anticipate the inventions of the counts.

Brown v. Inwood & Lavenberg, 130 O. G. 978.

It is stated in the motion that each of the counts from one to nine inclusive is unpatentable in view of the eight cited patents, and it is said: "Each of the counts is also met in each of the above patents, singly or in combination." This statement is clearly alternative and therefore the motion in that particular instead of being clear and specific, which was the end desired to be accomplished by inaugurating the present practice, is vague and indefinite.

Thullen v. Townsend, 130 O. G. 1312; Phillips v. Scott, 130 O. G. 1312.

Where a motion is brought which in accordance with the practice can not be transmitted, it is no excuse for the delay in bringing the motion in proper form that numerous appeals and petitions have been taken in an attempt to have the original motion transmitted.

Brantingham v. Draver & Draver, 130 O. G. 2720.

The first ground of the motion is insufficiently stated, for the reason that it is not pointed out in what respect the claims of the issue comprise aggregations and not combinations.

Papendell v. Bunnell v. Reizenstein v. Gainsman v. Gillett, 131 O. G. 362.

The second ground is insufficiently stated since the difference in the meanings of the claims are not pointed out.

Papendell v. Bunnell v. Reizenstein v. Gaisman v. Gillett, 131 O. G. 362.

A motion to dissolve because the issue is anticipated, must specify the anticipation. The practice of allowing additional references to be cited five days before the hearing has been discontinued.

Papendell v. Bunnell v. Reizenstein v. Gaisman v. Gillett, 131 O. G. 362.

The refusal of the Examiner to dissolve the interference on the ground that there is no interference in fact was correct, notwithstanding affidavits which have been filed alleging that no confusion has resulted from the use of the marks referred to (Trade-Mark).

Philadelphia Watch Case Co. v. The Dueber Watch Case Co. v. etc., 122 O. G. 1725.

Dow can not be permitted to establish the fact that he made the invention and its date by *ex parte* affidavits.

Dow v. Converse, 106 O. G. 2291.

Motion to dissolve an interference, affidavits as to operativeness received. Motion to remove from files refused (D. v. T. v. H., 99 O. G. 2550).

Dickinson v. Thibodeau v. Hildrett, 1902 C. D. 202.

The allegations is in the alternative that the counts are "anticipated or necessarily limited", but the motion does not state which counts he intends to urge as being anticipated and which limited, nor does it state which of the patents cited he relies upon as showing anticipation and which for restriction of the counts.

Murphy v. Borland, 132 O. G. 231.

It is not intended to follow the technical rules of the Court, but merely to require that motions shall clearly and definitely set forth the points to be urged.

Murphy v. Borland, 132 O. G. 231.

Ground eleven does not state what grounds it is alleged against, and for that reason is indefinite and should not be transmitted. (125 O. G. 669.)

Murphy v. Borland, 132 O. G. 231.

A motion alleging that the opposing party has no right to make the claims on account of informality of his specification is too indefinite. If petitioner meant that new matter had been improperly introduced into his opponent's specification he should have said so definitely.

Roe v. Brinkmann, 133 O. G. 515.

(7) *Transmission of Motion.*

(See "Form of Motion.")

Transmission refused. "The part B. may move on or before October 5, 1914, accompanied by a showing of facts, for leave to take testimony to establish that the forfeiture worked abandonment.

Gehring et al. v. Barry v. Long v. Wittiemore v. Molyneux, 225 O. G. 371.

Trade-Mark. The reasons why interference did not exist did not state whether the question related to the goods or the mark. Indefinite.

Hickor Jones Jewell Co. v. Ballard, 192 O. G. 992.

A motion to dissolve made as to the same counts in a previous interference between the same parties *res adjudicata.*

Townsend v. Thullen v. Young, 138 O. G. 768.

A motion to dissolve alleging that one of the parties can not make the claims because the subject-matter formed no

part of the original application since it did not include certain specified elements. Sufficiently Definite.

Stoddard v. Malins v. Peterson and Peterson, 196 O. G. 804.

The necessity for this motion according to Schulze, arises out of the holding of the Examiner in his decision on the first motion in which the counts were interpreted in a wholly unexpected way. I am of the opinion that S.'s position on this point is sufficiently well founded to justify the transmission of the motion.

Schulze v. Sinnox, 181 O. G. 541.

It is not the practice to transmit motions to dissolve filed before the preliminary statements are opened. (Whipple v. Sharp, 96 O. G. 2229) an exception may be made where the circumstances are such that the parties would be held bound by the decision rendered on such motion (as where files furnished by opponent are relied on).

Dunn v. Douglas, 184 O. G. 804.

The assignee being the real party in interest in a previous motion, can not make the same motion in his own name. Such motion should not be transmitted.

Townsend v. Ehrit v. Young v. Struble, 137 O. G. 1485.

A motion to dissolve because opponent had no right to make the claim in the earlier of two applications which are divisions of each other is one relating to the shifting of the burden of proof and should be decided by the Examiner of Interference and not transmitted.

Townsend v. Ehrit v. Young v. Struble, 137 O. G. 1484.

A motion founded on public use should be refused transmission; one based on affidavits should be refused as far as the affidavits are concerned.

Dunn v. Douglas, 184 O. G. 805.

It is no reason for refusing to transmit a motion, that the question has been considered *ex parte*.

Reynolds v. Haberman, 49 O. G. 130.

When motion in proper form and made within the former. For these reasons grounds seven and nine, should the time limit the Examiner of Interferences can not refuse to transmit it.

Cammet v. Hallett, 93 O. G. 939.

Motion to transmit in order to consider the question of shifting the burden of proof. Examiner of Interferences only decides if it is in proper form.

Sheppard v. Webb, 94 O. G. 1577.

These motions should not be transmitted previous to the approval of the preliminary statements.

Whipple v. Sharp, 96 O. G. 2229.

Under the Practice announced in Picard v. Ashton and Curtis, 137 O. G. 977; Thien v. Bowen, 143 O. G. 1345; Knight v. Cutler, 140 O. G. 119) the transmission of motions to dissolve is left largely to the discretion of the Examiner of Interferences.

Blood v. Ross, 161 O. G. 267.

Where no objection is made to the transmission of a motion on the ground of indefiniteness it may be assumed that the motion is sufficiently definite to meet the view of the parties to the interference, under such circumstances the motion should be transmitted.

Hicker Jones Jewell Milling Co. v. Ballard and Ballard, 192 O. G. 992.

Where a motion made in good faith is denied transmission because the same is not sufficiently definite. A properly made motion curing this defect will be transmitted.

McQuarrie v. Manson, 142 O. G. 288.

A motion to dissolve a trade-mark interference based on the ground that the label introduced during the taking of testimony contains certain deceptive statements, should not be transmitted as it is based on matter brought out in testimony, and applicant should be given an opportunity to explain on final hearing.

Falk Tobacco Co. v. Kenney Tobacco Co., 142 O. G. 567.

A motion to dissolve on the ground of intervening rights refund transmission.

Perkins et al. v. Weeks, 188 O. G. 1052.

A motion to dissolve because an oath had not been required covering the matter, not transmitted.

Berg v. Miller, Moon & Bell v. Frost, 192 O. G. 159.

For the same reasons which apply to motion to amend preliminary statements (Smith and Wickers v. Emerson v. Sanders, 133 O. G. 1433) and to motions with respect to the taking of testimony (Goodfellow v. Jolly, 115 O. G. 1064) the question of transmitting motions to dissolve should be left largely to the deseretion of the Examiner of Interferences, and where he grants a motion to transmit, his decision will not be disturbed unless it be clearly shown that such discretion has been abused.

Pickard v. Ashtmand Curtis, 137 O. G. 977.

Affidavits as to operativeness should not be transmitted for consideration upon motion for dissolution.

Horton v. Leonard, 155 O. G. 305; Keys and Kraus v. Yunck, 182 O. G. 248.

A motion to insert claims under Rule 109, and a motion to dissolve because such claims are unpatentable, should not be transmitted.

Weinberg v. Boyce v. Russel and Russel, 185 O. G. 249.

The first ground while in a sense broad is exclusive of the other three grounds (quoting Weis v. Mack, 185 O. G. 830).

Rowntree v. Sloan, 189 O. G. 1281.

If the references are not applied motion should not be transmitted.

Rowntree v. Sloan, 189 O. G. 1282.

A motion to dissolve on the ground the opponent had no right to make the claim because of long delay, should not be transmitted as it can be argued at final hearing.

Long v. Plagg & Livermore, 190 O. G. 265.

If in a case containing a number of claims, a motion to dismiss is made and refused, as to patentability in view of references cited, but is granted as to one claim upon another ground and dissolved as to that ground and redeclared with a substitute claim alleging non-patentability and citing other references which are also applicable to the other claims, should not be transmitted as to such other claims.

Kennedy v. McLain, 158 O. G. 547.

A petition to transmit on the ground of informality in that certain additions to original disclosure were improper, refused transmission as the matter relates to rights to make the claim and not to form.

Lasher v. Barrett, 166 O. G. 751.

If the motion is made within the twenty day limit the Examiner of Interferences seems to have no discretion but to transmit the motion. If made after that time it is a matter of discretion and will not be disturbed except when there has been an abuse of this discretion. The specific facts upon which a motion to dissolve is based need not be stated when the only facts relied upon are disclosed in the record.

Winter v. Slick v. Vollkommer, 97 O. G. 1837.

Ritter's motion to dissolve was based upon the testimony taken and was properly refused transmission.

Ritter v. Kralkaw & Connor, 104 O. G. 1897.

In the absence of an explanation of the delay the motion will not be transmitted, or when the cause for dissolution arises out of the testimony.

Hopkins v. Scott, 105 O. G. 1263.

A motion to transmit an amendment canceling claims before statements filed will not be transmitted under this rule.

Colley v. Copenhaver, 107 O. G. 268.

It is not ground for a motion to transmit because the Examiner has requested such a course in another case.

Parkin & Parkin v. Riotte, 109 O. G. 1335.

As a general rule motions to dissolve an interference are not transmitted when the reasons for bringing the same arise out of the testimony. (Felbel v. Oliver, 92 O. G. 2339.)

Winton v. Jeffrey, 112 O. G. 500.

When an applicant has had ample opportunity to present such claims as he wished and had presented several sets, a motion to transmit the interference in order to permit the Examiner to consider another set of claims was properly denied.

Scott v. Emmet & Hewlett, 116 O. G. 1184.

One party appealed to the Board on the question of patentability but recommended changes. The motion to transmit for reformation and dissolution should be denied as it appears that no good purpose would be served thereby.

Brown, Lindmark, 109 O. G. 1071.

Where a motion for dissolution is brought long after the time fixed by the rules and is based upon patents discovered six months before the motion was made, the motion should not be transmitted to the Examiner for consideration.

Wilcox v. Newton, 116 O. G. 1452.

A motion to dissolve should not be transmitted when the Commissioner has ruled upon the point involved.

Egly v. Schulze, 117 O. G. 2366, 1900 C. D. 237.

A decision of the Examiner of Interference refusing to transmit will not be disturbed unless it is shown that it was clearly erroneous.

Dann v. Halliday, 119 O. G. 2236.

The Examiner of Interferences properly refused to transmit to the Primary Examiner motions which the Primary Examiner has no authority to decide.

Becker & Patiz v. Edwards, 123 O. G. 1990.

The Examiner of Interferences properly refused to transmit to the Primary Examiner motions which the Primary Examiner has no authority to decide.

Becker & Patiz v. Edwards, 123 O. G. 1990.

A motion to transmit for inserting claims that: it appears from a decision of the Primary Examiner in the case can not be made by the party, should be refused.

Townsend v. Copeland v. Robinson, 124 O. G. 623.

(8) *Petition to Extend Time.*

The Examiner of Interferences was right in not extending the time for filing motions, for the granting of such extension would have no other effect than to cause unnecessary delay in the proceedings in those cases where the motion contemplated was not filed.

Egly v. Schulze, 117 O. G. 226, 1905 C. D. 237.

The time within which to bring motions was first set to expire January 11, but in view of stipulations by the parties this was extended to expire on February 11.

Barratt v. Swindlehart, 144 O. G. 818.

A petition to extend the limit of appeal to include an appeal filed after the expiration thereof must be supported by verified showing in excuse for the delay.

Kletzker & Goesel v. Dodson, 109 O. G. 1336; Autenrith & Rane v. Soresen, 120 O. G. 2126.

When an appeal is filed after the time limited it should be accompanied by a motion to restore jurisdiction.

Greuter v. Mathiew, 112 O. G. 253.

As the present motion is not accompanied by affidavits showing why appeal has not been taken to the Examiner-in-Chief within the limit of appeal originally set, it has no standing and must be dismissed from further consideration.

Kletzker & Goesel v. Dodson, 109 O. G. 1336; 110 O. G. 305-308.

Although the date of a reference relied upon in a motion to dissolve alleging anticipation of the issue is later than the date of conception set in the preliminary statement of the opposing party, the motion may nevertheless be transmitted in order that the Primary Examiner may consider the pertinency of the reference and permit the filing of an affidavit alleging the facts required by Rule 75, outside of those contained in such preliminary statement.

Martin v. Goodman v. Dyson v. Suttig & Goodrum, 130 O. G. 1485.

No reasons being given in support of the reasons for dissolution, transmission was properly refused.

Miller v. Wallace, 131 O. G. 1689.

The original counts, one and two, stand so related to the added counts that whatever conclusion the Examiner reaches regarding the dissolution of the interference as to the latter counts would probably be applicable to be transmitted as to all counts.

Murphy v. Borland, 132 O. G. 231.

A motion alleging informality showing that the real grounds relate to the right of a party to make the claim should not be transmitted.

Danguard v. Courville, 131 O. G. 2421.

Where a party acting in good faith files a motion which is held to be indefinite and an amended motion covering the informality is promptly filed within the limit of appeal set from the prior decision, the Examiner of Interferences should transmit the second or amended motion. He can not, however, be permitted to present his case experimentally. The first motion having been denied because not sufficiently definite and decisions cited, the second motion should have cured the defect, a third motion refused transmission.

Gold v. Gold, 131 O. G. 1422; Rockstroh v. Warnick, 131 O. G. 234; Papendell v. Bunnell v. Reizenstein v. Gaisman v. Gillette, 132 O. G. 1837.

Where the reasons for delay appear clearly upon the record it is only necessary to call attention to them in the motion to transmit.

Cutler v. Carichoff, 130 O. G. 656.

The transmission of a motion filed outside of the regular time is a matter resting largely within the discretion of the Examiner-of-Interference (cases).

Bastian v. Champ, 128 O. G. 2837.

Where an amendment to a motion was filed after the time limit had expired, the original motion having been filed in time, and no delay being occasioned, held that the time of filing the amendment was no objection.

Smith v. Fox, 130 O. G. 1312.

(9) *Evidence—Affidavits.*

Affidavits received on both sides as to public use.

Young v. Hoard, 1870 C. D. 59.

Affidavits asserting inoperativeness of opponents device improper.

Quensel v. Knox v. Pries v. Murphy, 185 O. G. 248.

Affidavits as to non-patentability should not be considered.

Ellis v. Boyce v. Burchenal, 195 O. G. 273.

Affidavits received as to utility of device.

Munger, 1869 C. D. 3; Cheesbrough, 1869 C. D. 18.

Backed by affidavits of others.

Harris, 1870 C. D. 62; Phillips, 1871 C. D. 273; Richardson, 1872 C. D. 144.

As to the former practice of invention with the affidavits of experts.

William Thie, 1870 C. D. 61.

Ex parte affidavits are not completent to establish the statutory bar of two years' public use.

Wicks & Wyman v. Knowles, 11 O. G. 196; Anson v. Woodbury, 12 O. G. 1.

It is not enough for the applicant to charge fraud, which is never presumed, but must always be strictly proved, and then to demand that he be relieved from the burden of proof which the law has imposed upon him. Such a course will not shift the burden of proof.

Hansen v. Davis, 1891 C. W. 72.

If the operativeness of the device is denied, whether on a motion to dissolve the interference, or in any other proceeding, the applicant has a right, under Rule 31 (76) to submit affidavits in proof of the operativeness of his invention. An applicant can not by indirection be deprived of the benefit of this rule.

Fuller v. Brush, 79 C. D. 328, 16 O. G. 1188.

This rule (76) is in accordance with law.

Hidges v. Daniels, 1880 C. D. 64.

The Commissioner is not authorized to reject an application on the ground of more than two years' public use and sale, on *ex parte* affidavits, without giving the applicant an opportunity to cross-examine the affiants. The proof should conform to the fundamental canons of the law of evidence.

Alteneck, 23 O. G. 269; decision by the Supreme Court of the District of Columbia.

Public use and sale asserted, and affidavits tending to establish such facts filed, an order that all files be forwarded to the Commissioner. Upon examining the affidavits and files, an order issued requiring applicant to show cause, at a certain date, assigned, why an order directing an inquiry, into the question of public use and sale, should not be made. A copy of order directed to be served on applicant.

Barricklo, 37 O. G. 672; see also Barricklo, 38 O. G. 417.

The oaths of the applicant that he is the first and original inventor and does not know and does not believe that the same was ever before known or used, and that letters patent for the same invention for the United Kingdom of Great Britain and Ireland have been granted to Charles William Siemens, as a communication from abroad bearing date the 5th of June, 1873, etc., is sufficient to identify the applicant with the British patentee, so as to defeat a motion to dis-

solve the interference on the ground that the same invention was described in said previous British patent.

Van Alteneck v. Thompson, 17 O. G. 57.

Where on final hearing before the Commissioner an interference is suspended and the case remanded to the Primary Examiner for consideration of the question of operativeness, this question will not be considered *inter partes* but will be determined by the Examiner, subject to the regular course of appeal in *ex parte* proceedings.

Archer, 1891 C. D. 191, 57 O. G. 696.

The affidavit of a party that the device was operative is questionable in view of the fact that the testimony of others, who were not produced, was accessible.

Kelly v. Flyn, 92 O. G. 1237.

Where certain patents and publications are referred to on a motion to dissolve, and opposing party states on the record that he has no objection to their consideration, although five days' notice has not been given, the reference should be considered.

Lake v. Cahill, 110 O. G. 2235.

Where there were two attorneys of record the sickness of one is not sufficient excuse for neglect to look up evidence.

Ingoldsby v. Bellows, 113 O. G. 2214.

Motion to dissolve an interference, affidavits as to operativeness received. Motion to remove from files refused.

Dickinson v. Thibodeau v. Hildreth, 99 O. G. 2550, 1902 C. D. 202.

Affidavits as to interference in fact and as to scope of claims in support of motion under Rule 122 refused.

Dickinson v. Thibodeau v. Hildreth, 99 O. G. 2550; Summers v. Hart, 98 O. G. 2585.

Dow can not be permitted to establish the fact that he made the invention and its date by *ex parte* affidavits.

Dow v. Converse, 106 O. G. 2291.

Affidavit of Expert received and considered as to identity of invention.

Felbel v. Oliver, 92 O. G. 2339.

A party's rights are not limited by proceedings had in another interference between different parties.

Gray v. McKenzie v. McElroy, 113 O. G. 1968.

No testimony as to inoperativeness or public use previous to motion to dissolve.

Barber v. Wood, 127 O. G. 1991.

If the Examiner when the case is reached for action rejects claims on the ground of non-invention the applicant may undoubtedly present in response to such rejection and

have admitted affidavits which include so much of the present affidavits as relate to the merits and efficiency of his device, but which omit the irrelevant statements made in the affidavits concerning the devices of others.

Robinson, 115 O. G. 1584.

The refusal of the Examiner to dissolve the interference on the ground that there is no interference in fact was correct, notwithstanding affidavits which have been filed alleging that no confusion has resulted from the use of the marks referred to. (Trade-Mark.)

Philadelphia Watch Case Co. v. The Dueber Watch Case Co. v. etc., 122 O. G. 1725.

I am of the opinion that testimony upon the operativeness of the device disclosed by the senior party should be accepted and considered in determining who is the prior inventor in this case, provided a *prima facie* case of imperativeness is made out and a satisfactory showing is presented that the proposed evidence is of a character to justify opening the case for taking testimony. Whether testimony may be taken in this case should be determined in the first instance by the Examiner of Interferences.

Lowry & Cowley v. Spoon, 122 O. G. 2687.

Consideration of affidavits upon motions to dissolve is not a right which the parties are entitled to demand. The rights of parties on such motions extend no further than is expressly provided by rules of practice. Usually will extend no further than testimony and rebuttal.

Browne v. Stroud, 122 O. G. 2689.

Affidavits as to operativeness of opponent's device in an interference proceeding.

Clement v. Brown v. Stroud, 125 O. G. 992.

Affidavits as to inoperativeness of opponent's device in interference cases proper for making a prima facie case.

Lowry & Cowley v. Spoon, 124 O. G. 1846.

Ex parte affidavits as to intervening rights in interference cases.

Donning v. Fisher, 125 O. G. 2765.

An *ex parte* affidavit is not enough to carry a party's filing date back to that of a foreign application and change the burden of proof.

Raulett & Nicholson v. Adams, 114 O. G. 827.

These affidavits as to operativeness of invention may be filed notwithstanding an interference has been dissolved because of the inoperativeness of the device.

Mark, 117 O. G. 2636.

An affidavit refused consideration on the ground that cer-

tain testimony referred to therein was not properly authenticated as to officer taking it.

Brown v. Inwood & Savenberg, 131 O. G. 1423.

A motion made and judgment passed upon it *res adjudicata* and can not be entertained a second time upon the same state of facts.

Little v. Little, Pillard & Sargent, 10 O. G. 543.

The matter at issue in an interference proceeding and a public use proceeding are different, and it is for this reason that testimony taken on the question of priority in an interference is not used on the issue of public use without further proceedings, in which the party adversely affected is given an opportunity to cross-examine the witnesses with that issue framed and to produce witnesses to explain the evidence. (Weber, 101 O. G. 2570.) For the same reason testimony taken in the public use proceeding can not be held conclusive of the question of priority of invention, and should not be used against Gilman without the institution of a second interference.

Ex parte Menzelman & Overholt, 132 O. G. 232.

(10) *Delay in Bringing Motion, etc.—Excuse for Second Motion.*

It does not appear that the references now principally relied upon could not have been found within the time originally set for bringing motions, if proper search had been made at that time. The Examiner of Interferences, properly refused therefore, to transmit the motion. (99 O. G. 774, 1385; 111 O. G. 222; 117 O. G. 597.)

Topping v. Price, 160 O. G. 774, 340.

R. and O. in interference afterward M. added R. moved to dissolve for non-patentability refused as the motion should have been made in first interference. The fact that M.'s device threw new light on the question not an excuse.

Onderdonk v. Rentke v. Moffat, 183 O. G. 507.

A subsequent motion may be treated as a motion for a new trial.

Fowler v. Uptegroff, 184 O. G. 803; Dunn v. Douglas, 184 O. G. 529.

A new meaning placed upon the issue by the Examiner no excuse for a second motion because the broadest possible interpretation will be given them.

Burden v. Manson, 185 O. G. 529.

The filing of a motion to take special testimony affords no excuse for the delay in bringing this suit.

Pettengell v. Webster and Towle, 186 O. G. 799.

The assignee of a party did not move to dissolve he was now permitted to do so afterward as an assignee of a subsequently added party.

Waller v. Coe v. Browne, 193 O. G. 511.

The rules contemplate that a motion to dissolve the interference on the ground of non-patentability of the subject-matter when the facts on which it is based are known should be made at the outset. Such a motion by a defeated party refused after judgment because of the delay.

Blinn v. Gale, 16 O. G. 459; Mark, 117 O. G. 2636.

Where both parties are applicants and under the head of informality in declaring the interference it is alleged in a motion to dissolve that the claims do not apply to the structure of either party. Held that this is not such an admission as to justify a decision on priority adverse to the moving party. The case of Lipe v. Miller, 109 O. G. 1608, distinguished.

Danquard v. Courville, 131 O. G. 2421.

The 20 days having elapsed a motion to restore jurisdiction to the Examiner of Interference for the purpose of moving to dissolve should be accompanied by the motion to dissolve.

If such latter motion can not be made within the time limit it should be made as soon thereafter as possible.

Niedermeyer v. Walton, 97 O. G. 2306.

In case of discovering new facts after granting the motion to transmit to the Primary Examiner, he may consider such facts provided due and timely notice thereof be given to the party opposing the motion. A petition to amend is unnecessary.

Kurz v. Jackson & Pierce, 98 O. G. 2586.

Whether a delay beyond the time limited shall be excused lies somewhat within the discretion of the Examiner.

99 O. G. 1383.

When a second motion to transmit is made on the ground of newly discovered evidence it is proper for the Examiner of Interferences to consider the question of due diligence.

Whitlock & Huson, 99 O. G. 1385.

Delay in making motion excused in view of the cost of obtaining a copy of opposite party's application, the difficulty of getting the money for the same, and the complicated nature of the case. In the above case the delay was due in part to the Office.

Kletzer & Goesel v. Dodson, 101 O. G. 2822.

A motion pending under this rule is not a bar to a motion under Rule 109, nor does it excuse delay.

Perrussel v. Wichmann, 99 O. G. 2970.

If a motion is not made within the 20 days limited, the burden is upon the mover to show that it could not have been sooner.

Niedringhaus v. Marquard v. McConnell, 101 O. G. 1610.

Under the circumstances of this case even admitting that Miller did not appreciate the pertineney of the patents referred to till April 21, 1903, a delay of over a month in bringing his motion after this date was not exercising due diligence. The affidavit accompanying witness' motion is defective in that it does not appear therefrom that the patents on which he relies to anticipate the issue could not have been obtained earlier by the exercise of reasonable diligence.

Lipe v. Miller, 105 O. G. 1532.

As the applicant has made no satisfactory showing that the references could not have been found before, and the motion presented earlier to grant his appeal would, in effect nullify the clause in Rule 122 requiring such motions to be made within twenty days following the approval of the preliminary statement.

Sturgis & Hopewell, 109 O. G. 1067.

When no testimony has been taken and the delay is slight, the motion may be entertained.

Harrison v. Shoemaker, 109 O. G. 2170.

Where parties have not seen each other's statements a slight delay may be excused.

Doble v. Eckhart v. Henry, 110 O. G. 604.

It appears, therefore, that the real reason for bringing the motion at this time is a change of purpose, arising from the fact that the applicant has appointed a new attorney. Such reason is not sufficient excuse for the delay.

Rayburn v. Strain, 110 O. G. 603.

A second motion to transmit considered as a motion for a new trial and no limit of appeal set.

Goodfellow v. Jolly, 110 O. G. 602.

After twenty days the burden of proof is upon applicant to show diligence. In the absence of such showing a refusal to transmit is proper. The pendency of a motion to shift the burden of proof is no excuse.

McArthur & Gilbert, 111 O. G. 1624.

The fact that an alleged anticipating patent was not dis-

covered until the expiration of the time limit not considered sufficient excuse.

Schirmer v. Lindemann & Stock, 111 O. G. 2222.

The pendency of a motion for dissolution is no good reason for delay in bringing a motion to shift the burden of proof. (See McArthur v. Gilbert, 111 O. G. 1624.)

Harvey v. Lubbers v. Raspillaire, 112 O. G. 1215.

A second motion for dissolution will not be entertained unless there is good showing why new reasons advanced were not presented at the time of the first motion.

Hedlund v. Curtis, 113 O. G. 1419.

The pendency of a motion to dissolve by one party does not excuse delay in making such a motion by another party.

Jackson v. Cuntz, 115 O. G. 510.

The excuse for delay in bringing motion was the non-discovery of a German patent.

Some of the grounds alleged had nothing to do with the German patent and therefore that was no excuse for delaying the motions on these grounds. No reason why the German patent was not discovered earlier was given and no sufficient excuse was given for the delay of more than two months after such discovery. "The pendency of an appeal upon the first motion, which had been decided against him is no excuse."

Pfingst v. Anderson, 117 O. G. 597.

A mere change of opinion after retention of new counsel will not justify transmission of the motion for dissolution long after (two months) the time when it should have been brought.

Carver v. McCanna, 117 O. G. 599.

It is against the policy of the Office to permit piecemeal motions in interference cases.

Egly v. Schulze, 117 O. G. 276; Crecent Oil Co. v. W. C. Robinson & Son Co., 142 O. G. 1113.

Unexcused delay in bringing motion.

Carney v. Latimer, 119 O. G. 6522.

If the excuse for delay in bringing a motion does not cover the entire time the motion should not be transmitted.

McKee v. Baker, 120 O. G. 657.

That one was not able to get copies of papers within the twenty days' limit received as an excuse. It was however unnecessary to allege the paper were furnished by the Office.

Steinmetz v. Thomas, 119 O. G. 1260.

The provisions of Rule 122 requiring motions to be brought, *if possible*, within a time fixed is conducive to

orderly procedure and must be enforced. The Examiner of Interference was right in refusing to transmit a motion not made in time and unaccompanied by a proper excuse.

Townsend v. Copeland v. Robinson, 124 O. G. 1210.

Where an amendment to a motion was filed after the time limit had expired, the original motion having been filed in time and no delay being occasioned, held that the time of filing the amendment was no objection.

Smith v. Fox, 130 O. G. 1312.

Motions on ground of inoperativeness are not favored and it is incumbent upon one bringing them to do so promptly.

Joslyn v. Hulse, 130 O. G. 1689.

In response to an order to show cause under Rule 114 applicant moved to dissolve for non-patentability of issue, but was not sufficiently specific in applying references, amendment filed seven days after limit. In view of this attempt to apply the references, the promptness with which the second motion was filed, and the fact that refusal of the motion will be fatal to appellant's case, it is thought that the last motion to dissolve should be transmitted to the Primary Examiner.

Anser v. Pierce, Jr., 131 O. G. 359.

A junior party, cited to show cause why judgment should not be rendered against him on the record, may move to dissolve for non-patentability of the issue.

Papendell v. Bunnell v. Reisenstein v. Gaisman v. Gillett, 131 O. G. 362.

The bringing of motions or the taking of petitions to the Commissioner will not stay the running of the limit of appeals from a decision on priority.

Pym v. Hadaway, 131 O. G. 692.

As to claims involved in a second interference between the same parties which could have been made in the first interference, held that a final decision in the first interference on the question of priority renders that question *res adjudicata.*

Hopkins v. Newman, 131 O. G. 1161.

It is well settled that piece-meal action can not be permitted, but where a party acting in good faith files a motion which is held to be indefinite, and an amended motion curing the informalities is promptly filed within the limit of appeal set from the previous decision, the amended motion should be transmitted.

Gold v. Gold, 131 O. G. 1422. See, however, Rockstroh v. Warnock, 132 O. G. 234.

To permit a party to prosecute separately by renewal motions, one or more separate grounds of dissolution advanced

in an original motion and then to appeal on the separate motions as they are decided against him would be to sanction a piecemeal procedure, which has been uniformly, and properly, condemned by the Office. W.'s renewal motion accordingly amounted to an abandonment of his right to appeal on the original motion. Appeal on original motion out of order appeal on renewal motion proper.

Williams v. Webster v. Sprague, 148 O. G. 880; Lotterhand v. Cornwall, 148 O. G. 1344.

A second interference between the same parties upon the same subject-matter should not be instituted.

Wenzelman & Overholt, 132 O. G. 232.

Delay not relieved against by redeclaration to include additional counts.

Murphy v. Borland, 132 O. G. 231.

Transmission of motion to dissolve refused in view of the fact that the excuse for delay was insufficient in that it alleged that business of great importance prevented him from consulting his attorney in time, but did not show why the matter could not be attended to by correspondence.

Blackmore v. Hall, 132 O. G. 1387.

The pendency of a motion to shift the burden of proof is no excuse for the delay in bringing a motion to dissolve.

Price v. Blackmore, 133 O. G. 514; McArthur v. Gilbert, 111 O. G. 1624.

In the absence of positive written law excluding Sundays from the period of time prescribed for any purpose, they are counted, even though the period ends on Sunday. (Lewis Southerland Statutory Construction, Vol. I, p. 335.) The same rule is applicable to holidays. (Trade-mark.)

Robert A. Keasley Company v. Portland Cement Fabrik Hemmor, 133 O. G. 1936.

The transmission of a motion filed outside of the regular time is a matter resting largely within the discretion of the Examiner of Interferences (cases).

Bastian v. Champ, 126 O. G. 2837.

(11) *Expediting Proceedings. Examiner's Actions—Time Limit.*

Motions under this rule formerly required to be noticed for hearing within the time limited for appeal, so that the jurisdiction should not be lost.

Meyrose v. Jahn, 56 O. G. 1417, 1891 C. D. 145.

The redeclaration of an interference to add a new party

does not excuse delay beyond thirty days from the original declaration.

Townsend v. Ehrit v. Young v. Struble, 137 O. G. 1484.

The fact that the Examiner discovered a new reference and brought it forward in a companion interference does not excuse delay in making the motion, if it does not appear that the reference could not have been found in time.

Townsend v. Ehrit v. Young v. Struble, 137 O. G. 1484.

The decision must be confined to the question presented.

Zeidler v. Leech, 1891 C. D. 9.

The time limited for the making of motions runs from the day the original statements are received and approved, and a subsequent amendment of a preliminary statement does not of itself operate to extend this time.

Scribner & Warner v. Childs v. Balsley, 1892 C. D. 104.

Upon a motion to dissolve an interference upon the ground of irregularity in declaring the same the Primary Examiner is not at liberty to decide the question of patentability.

Hutt & Phillips v. Foglesong, 1892 C. D. 190.

On hearing nothing should be considered by the Primary Examiner outside of the fact disclosed by the record unless a showing of such additional facts accompanies the motion to transmit, but that where moving parties rely upon the record it is unnecessary for them to state in the motion the facts upon which the motion for dissolution is based. In the case of the discovery of new facts after granting the motion to transmit, the Primary Examiner may consider such facts provided due and timely notice thereof be given to the opposite party.

Wells v. Packer, 90 O. G. 1947.

When motions to dissolve are brought upon the grounds specified in Rule 122, the Examiner should decide the motion on all grounds, and if this decision is of such a nature that appeals therefrom may be taken he should fix a limit of appeal.

Hingley v. Parker, 97 O. G. 2742.

The Examiner should decide the motion upon all the grounds presented.

Oldham & Padbury v. P. v. C. v. R., 99 O. G. 670.

If the Examiner is of the opinion that part of the claims are unpatentable he should dissolve the interference as to these claims and continue it as to the remainder. If the remaining claims are sufficient to base a conclusive decision upon, the interference should not be dissolved to present new claims in place of those held unpatentable. A motion to

amend may be granted conditioned on the filing of an affidavit under Rule 75.

Hillard v. Eckert, 101 O. G. 1831.

When a motion is made on all the grounds specified in Rule 122, it is the duty of the Examiner to consider and determine all these grounds and assign limits of appeal to all that are appealable.

Cutler v. Riddell, 100 O. G. 763. See also Hopfelt v. Read, 106 O. G. 767 and cases cited.

Where time is limited in which to take action after the rendering of a decision, the date of the decision and not the date of the receipt of notice thereof governs.

Greuter v. Mathieu, 112 O. G. 254.

If there is a broad invention common to the respective inventions, it would seem that this fact could be determined by the respective parties and the claims included in the issue, so that this interference can proceed on its merits without further delay, of which there has been too much in this case.

Normand v. Krimmelbein, 115 O. G. 249.

The time limit fixed in the rules for motions means actual time, and Sundays and holidays are not excluded in computing it.

Dickinson v. Norris, 116 O. G. 593.

Where an interference is transmitted to the Primary Examiner for the purpose of determining the right of one of the parties to make the claim, and the Examiner also decides the question of interference in facts—held that the Examiner exceeds his jurisdiction.

Podlesak & Podlesak v. McInnerney, 118 O. G. 835. See next case also, 118 O. G. 836.

The time limited for appeal begins to run when the case is returned to the Examiner of Interferences and formal resumption of proceedings is noted.

Hewitt v. Steinmetz, 122 O. G. 1396.

Where the questions involved are patentability and the right of party to make claim, the motion should not be granted on the ground of non-interference in fact.

Thullen v. Young & Townsend, 118 O. G. 2251.

Successive motions discouraged.

Scott v. Emmet & Hewlett, 119 O. G. 2233.

Prior *ex parte* decision by appellate tribunal not binding on Primary Examiner in *inter partes* consideration.

Felsing v. Nelson, 120 O. G. 2445.

The Examiner may upon a motion for dissolution of an interference where a party has filed a certified copy, determine whether or not it is necessary for the other party to see other parts or the whole of the original application.

Fagan v. Graybill, 121 O. G. 1013.

It is well settled that where an interference is transmitted to the Primary Examiner for the consideration of one question, he is without jurisdiction to consider an entirely independent question.

Moore v. Curtis, 121 O. G. 2325.

Where the Examiner finds on motion to dissolve an interference that the subject-matter in issue is not patentable, he should take such action in the applications subsequent to his decisions as will put them in condition for statutory appeal, so that the appeal may be continued directly to the Court of Appeals without the necessity of a second course of appeal through the Patent Office.

Newcomb v. Thomson, 122 O. G. 3013.

No good reason appears for holding that a tribunal may not properly render a decision on a motion for a hearing made within the time limited for an appeal but noticed beyond such limit.

Naulty v. Cutler, 126 O .G. 389.

If a motion is made before the expiration of the thirty days, the balance of the time is waived.

Rockstroh v. Warnick, 132 O. G. 234.

No limit of appeal should be set on a decision refusing to expunge testimony.

Green, Tweed & Co. v. Manufacturers' Belt Hook Co., 132 O. G. 680.

Where an Examiner rejects claims presented by a party for interference under Rule 109, he should set a limit of appeal from his decision whether the claims had been allowed to the other party or had been made for the first time by the moving party.

Mattice v. Langworthy, 132 O. G. 1073.

(12) *Grounds of Appeal.*

When an interference is dissolved on the ground of right of parties to make claims, the question becomes an *ex parte* one.

Woodridge v. Conrad, 165 O. G. 241.

When it appears upon the face of the paper that the real grounds of a motion to dissolve relates to the merits, the

Commissioner will not take jurisdiction either by appeal or petition.

Manny v. Easley v. Greenwood, Jr., 48 O. G. 538, 86 O. G. 490-491, 98 O. G. 415, 97 O. G. 1172, 110 O. G. 6036, 107 O. G. 1098, 88 O. G. 2409, 96 O. G. 844, 86 O. G. 1636, 89 O. G. 1862, 78 O. G. 1904.

It thus appears that the Court of Appeals will not entertain an appeal from a decision on a motion to dissolve an interference, even where the decision is adverse to the right of a party to make the claim. This latter question may be settled *ex parte* in the usual way after the interference. The whole proceeding relating to motion for dissolution is one of office procedure provided for by the authority of R. S. Sec. 483. Newcomb v. Lemp, 112 O. G. 1216. But see U. S. ex rel. The Newcomb Motor Co. v. Moore Com., 133 O. G. 1680.

Examiner required to set a limit for appeal upon the question of irregularity and interference in fact. If these grounds are mere pretenses to get the question not appealable under Rule 124 reviewed the appeal will be dismissed.

Duryea & White v. Rice, 115 O. G. 803.

It having been finally determined that Struble has no right to make claims corresponding to the counts of the issue, the question raised by the appeal, namely, the question of interference in fact, becomes moot and will not, therefore, be decided.

Coleman v. Struble, 114 O. G. 973.

All the reasons given where alleged but the case was not appealed *solely* upon the ground of non-patentability of his opponent's claim. The Examiner properly set a limit of appeal, as he is not the judge of the propriety of the appeal.

Harnisch v. Gueniffet Benvit & Nicault, 117 O. G. 1492.

A decision that a claim has not been abandoned by failure to prosecute is appealable under this rule.

Meden v. Curtis, 117 O. G. 1795.

It is not a question whether the issue applies to both structures and means the same thing in both cases, but whether giving it to its natural and ordinary meaning the issue is patentable. The Examiner's decision on patentability being favorable the motion to dismiss this appeal is granted.

White v. Thomson, 101 O. G. 1371 and 2825.

On appeal matters not urged before the Examiner will not be considered.

Pfingst v. Anderson, 118 O. G. 1067; McFarland v. Watson, 146 O. G. 257.

In trade-mark cases on an appeal as to priority, identity of subject-matter will not be considered.

Horne v. Somers & Co., 129 O. G. 1609.

Whether or not the application discloses the subject-matter of the interference, and, therefore, whether or not the interference is properly declared, is a question ordinarily to be determined by the Patent Office. (See Ostergen v. Tripler, 17 App. D. C. 558; Herman v. Fullman, 23 App. D. C. 264-265.) However, this Court has held that in extreme cases where palpable error has been committed, the decision of the Patent Office holding identity of invention between the devices of the parties to the interference may be reversed. (See Podlesak & Podlesak v. McInnerney, 26 App. D. C. 399.)

McMulken v. Bolee, 130 O. G. 1691.

Where the claims of the interfering party are in identical language there is an interference in fact, although there may be specific differences in the two constructions, such specific differences not being specified in the claims.

Gordon v. Wentworth, 1906 C. D. 52; 120 O. G. 1165.

(13) *Shifting Burden of Proof.*

See Rule 116.

Burden of proof when originality denied.

Wherry v. Heck, 49 O. G. 559.

It is not enough for the applicant to charge fraud, which is never presumed, but must always be strictly proved, and then to demand that he be relieved from the burden of proof, which the law has imposed upon him. Such a course will not shift the burden of proof.

Hansen v. Davis, 1891 C. D. 72.

The burden of proof in an interference is upon the contestant who fails to make a claim to the improvement in controversy or a statement equivalent thereto until the same was claimed by the other party to the interference.

Reichenbach v. Goodwin, 1893 C. D. 50.

A formal abandonment of the earlier application does not shift the burden of proof, if there is a clear continuity of action between it and the second application, where the two applications are filed by the same applicant and cover substantially the same subject-matter.

Parmly v. Hockhausen, 1891 C. D. 180.

The presumption is that the Office did its duty in notifying the caveators of the filing of the interfering application, and

the burden is upon them to establish their allegation of no notice by adequate proof.

Killeher & Grimm v. Mayhew, 72 O. G. 895.

A reissue has the same standing as to burden of proof as the original patent.

Hansen v. Davis, 1891 C. D. 72.

Motion to shift need not set up facts unless they are outside the record.

Sheppard v. Webb, 94 O. G. 1577.

A motion to shift the burden of proof because the invention in issue was introduced by amendment is improper. The remedy is by motion to dissolve under Rule 122.

Tripp v. Wolff v. Jones, 103 O. G. 2171.

If one wishes to establish the date of filing of an earlier application he should do so by a motion to shift the burden of proof, in which case the decision of the Primary Examiner as to the admission of claims will be final. If such earlier application is brought in the course of taking the testimony it will be considered like other testimony by all the tribunals having jurisdiction.

Robinson v. Copeland, 102 O. G. 466.

A motion to shift the burden of proof may be founded upon matters outside of the record.

Bundy v. Rumbarger, 92 O. G. 2001-2.

When an error is discovered by the Examiner of Interferences which would amount to such an irregularity as would preclude proper determination of the question of priority, such as the improper placing of the burden of proof, the interference should be forwarded to the Primary Examiner with a statement of facts, that he may correct his letter forwarded to the Examiner of Interferences under Rule 97.

Lutz v. Lewis, 110 O. G. 2014. (Sup.)

The pendency of a motion for dissolution is no good reason for delay in bringing a motion to shift the burden of proof (See McArthur v. Gilbert, 111 O. G. 1624).

Harvey v. Lubbers v. Raspillaire, 112 O. G. 1215.

F.'s patent does not make him the senior party in the proceeding; as D. was the first to file an application, he is the senior party in this proceeding, and it is incumbent upon F. in order to prevail to establish his case by a preponderance of evidence.

Furman v. Dean, 111 O. G. 1366.

Motions to shift the burden of proof are brought under the provisions of Rule 116. In a proper case the burden of proof can be shifted without dissolving and redeclaring the interference.

Motions to shift the burden of proof should be made before the Examiner of Interferences within the twenty days after the approval of the preliminary statement allowed for motions. This case withdraws jurisdiction from the Primary Examiner in this class of cases.

Raulet & Nicholson v. Adams, 114 O. G. 1827.

As held in the case of Raulet & Nicholson v. Adams (114 O. G. 1827) no appeal will be entertained upon interlocutory motion relating to the burden of proof, but that matter may be brought up with the final decision as to priority of invention. Such motions should be made before the Examiner of Interferences.

Osborne v. Armstrong, 114 O. G. 2091.

An *ex parte* affidavit is not sufficient to change the burden of proof by carrying back a party filing date to that of a foreign application.

Raulet & Nicholson v. Adams, 114 O. G. 1827.

A previous application which does not show all the elements of the issue can not avail to shift the burden of proof.

Norden v. Spaulding, 114 O. G. 1828.

An applicant shows two species but claims only one; held that a second application for the species not claimed may have the date of the original application.

Van Recklinghauser v. Dempsler, 148 O. G. 277.

Said by Commissioner on Appeal—Before the interference proceeds further it should be positively determined whether or not these new references anticipate the issue.

Wright & Stebbens v. Hansen, 114 O. G. 761.

Claimed that the invention was not shown in original application but was introduced by amendment subsequent to the filing of opponent's application. If well founded this would entitle S., who was the first to conceive, to the benefit, also, of the earlier reduction to practice, and an inquiry into the question of diligence would be unnecessary.

Seeberzer v. Dodge, 114 O. G. 2382.

As a general rule the burden of proof rests on the party against whom judgment would be rendered if no evidence were adduced on either side. This question involving the taking of testimony, should be considered by the Examiner of Interferences, and there is no appeal from his decision prior to the final appeal.

Fennell v. Brown v. Borsch, 115 O. G. 1328.

The alleged improper placing of the burden of proof forms no proper basis for motion for dissolution, and that

question should be presented by separate motion to shift the burden of proof.

Blackmore v. Hall, 118 O. G. 2538.

The question of shifting the burden of proof is a matter within the jurisdiction of the Examiner of Interferences and not the Primary Examiner, and there is no appeal from this decision prior to final judgment.

Raulet & Nicholson v. Adams, 114 O. G. 1827; Scott v. Southgate, 121 O. G. 689.

Where an appeal was taken from the action of the Primary Examiner denying motion to shift burden of proof, the appeal not considered and case remanded to Examiner of Interferences. (Head note.) Opinion does not seem to bear out head note.

Fisher v. Daigherly, 118 O. G. 1681.

(14) *Miscellaneous.*

See note to Rules 15, 66, 76 124, 126, 130, 145, 153.

Cases that pass on the subject-matter of this rule.

Allen, Com., etc., v. U. S. ex rel. Lowry et al., 116 O. G. 2253; Eschinger v. Drummond & Lieberknecht, 121 O. G. 1348; Ingoldsly v. Bellows, 116 O. G. 2532. See note to Rule 128. Wallace, 118 O. G. 1686; Cazen v. Von Welsbach, 119 O. G. 650; Sobey v. Holsclaw, 119 O. G. 1922; Park v. Lewis, 120 O. G. 323; Felsing v Nelson, 121 O. G. 1347; Garnall v. Pope, 115 O. G. 2136; Miller, 116 O. G. 2532; Hicks v. Costello, 103 O. G. 1163; Sibley Soap Co. v. Lambert Pharmacal Co., 103 O. G. 2172; Dickinson v. Thibodeau v. Hildreth, 99 O. G. 2550; Fessenden v. Potter, 101 O. G. 2823; Votey v. Weist, Jr., v. Donovan, 111 O. G. 1627; Macey v. Tobey v. Laning, 97 O. G. 1172; Potter v. Van Vleck v. Thomson, 95 O. G. 2484; Valiquet v. Johnson, 92 O. G. 1795; Banks v. Snediker, 17 O. G. 508; Carroll v. Stahlberg, 111 O. G. 1937; Fickinger & Blake v. Hulett, 111 O. G. 2492; Wilkinson v. Junggren, 112 O. G. 252; In re Lowry, 90 O. G. 445; Philadelphia Watch Case Company; The Dueber Watch Case Manufacturing Co.; The Keystone Watch Case Company v. Byron L. Strasburger & Company, 122 O. G. 1725; Kugele v. Blair, 127 O. G. 1253; Hewitt v. Weintraub v. Hewitt v. Rogers, 128 O. G. 1689; U. S. A. ex rel. The Newcomb Motor Co. v. Allen (Moore), Commissioner, 124-130 O. G. 302; Hewitt v. Weintraub v. Hewitt and Rogers, 128 O. G. 1689.

Rule 123. Motions to Effect Stay of Proceedings.

Setting a motion brought under the provisions of Rule 109 or of Rule 122 for hearing by the law examiner will act as a stay of proceedings pending the determination of the motion. To effect a stay of proceedings in other cases, motion should be made before the tribunal having jurisdiction of the interference, who will, sufficient grounds appearing therefor, order a suspension of the interference pending the determination of such motion.

(1) HISTORY.
(2) STAY OF PROCEEDINGS.
(3) JURISDICTION.

(1) *History.*

See case cited under History of Rules 122-124 above.
See Rule 117 of 1879 in appendix.
Rule 59 of 1878 reads in part as follows:
After the declaration of the interference and before the time for filing the preliminary statements, has expired, motions to dissolve the same on the grounds of lack of novelty, or that no interference in fact exists, or that there has been such other irregularity in declaring the same as will preclude the proper determination of the question of right between the parties, must be made before the examiner by whom the interference was instituted. After the declaration of interference such motion must be made before the tribunal having jurisdiction at the time. Appeal may be taken to the commissioner in person; but if the examiner should decide that the subject-matter is not patentable in view of the state of the art the interference will be dissolved, and the matter decided upon can be proceeded with *ex parte*.

Previous to the last revision the rule read as follows:

All lawful motions, except those mentioned in Rule 122, will be made before and determined by the tribunal having jurisdiction at the time. The filing of motions will not operate as a stay of proceedings in any case. To effect this, motion should be made before the tribunal having jurisdiction of the interference, who will, sufficient grounds appearing therefor, order a suspension of the interference pending the determination of such motion.

The following notes have this rule in view.

CONSTRUCTIONS.

(2) *Stay of Proceedings.*

A motion for a rehearing—even if filed within the limit would not operate as a stay.

Carmichael v. Fox, 104 O. G. 1656.

A motion to operate as a stay of proceedings should be accompanied by a petition to that effect. An order should then be entered at or before the hearing of said motion granting or refusing the petition.

Dubois v. McCloskey, 17 O. G. 1158.

When Alexander's motion to reopen was filed on March 11, only three days remained to him for the time limited for appeal. The suspension of proceedings at that time did not have the effect of setting aside and nullifying the order fixing thirty days as the limit of appeal, but merely stopped the running of the time until the question raised could be finally disposed of. As soon as that question was disposed of by the decision of May 13, the time for appeal again began to run. A limit of appeal will not usually be extended.

Blackman v. Alexander, 105 O. G. 2059.

There is no necessity for a suspension of proceedings, as there is now no limit of appeal running against any of the parties.

Robinson v. Townsend v. Copeland, 106 O. G. 997.

A petition under Rule 145 is not good ground for asking a suspension of the interference.

Churchward v. Douglas v. Cutler, 106 O. G. 2016-17.

It is deemed better in the interest of uniform practice to require that motions be filed as provided in Rules 122 and 123 should a suspension of proceedings be desired pending the determination of any lawful motion.

Hoegh v. Gordon, 108 O. G. 797.

A motion for rehearing does not operate as a stay of the running of the time in which an appeal from that decision should be taken.

Cole v. Zarbock v. Greene, 116 O. G. 1451.

It is no ground for the suspension of an interference that an infringement suit is pending.

McBride v. Kemp, 109 O. G. 1070; Kletzker & Goesel v. Dodson, 109 O. G. 1336.

If it is difficult to obtain testimony and a party elects to take his chances without it, he can not have the case reopened to introduce such evidence.

Grenter v. Matthew, 111 O. G. 583.

A stay will not be granted to await the determination in an *ex parte* consideration of an application not involved in the interference.

Mark v. Greenwalt, 118 O. G. 1068.

The pendency of one motion is no excuse for the failure to bring other motions, and a suspension of proceedings as to one motion does not extend the period of time for bringing other motions. (Cases cited.)

Moore v. Curtis, 121 O. G. 2325; Naully v. Cutler, 126 O. G. 389.

Cases in the Office will not be suspended to await the final decision of the Courts upon another case where similar questions are raised.

Potter v. McIntosh, 116 O. G. 1451.

(3) *Jurisdiction.*

The Examiner of Interferences has no jurisdiction to determine whether access to files may be had.

Shaver v. Dilg and Fowler, 157 O. G. 1001.

The interference is transmitted to the Examiners in Chief, and they are given jurisdiction to render a supplemental decision upon the question of right to make the claim from which they will set new limit of appeal.

Schutte v. Rue, 157 O. G. 753-754.

It is a matter wholly within the discretion of the Commissioner what questions or whether all questions arising out of interference cases shall be decided in the first instance, by the Examiner of Interferences or some other Primary Examiner.

Weitling v. Cabell, 72 C. D. 185. See also 22 O. G. 22-33.

To what tribunal they (questions arising in an interference proceeding) may be appealed may be determined altogetner by the nature of the questions themselves, and the law relating to them.

Weitling et al. v. Cabell, 1872 C. D. 187, 185.

Questions of patentable combinations remanded to the Primary Examiner for consideration.

Lynch & Raff v. Dryden & Underwood, 1873 C. D. 73.

The question of two years' public use as a statutory bar receives consideration from the Examiner of Interferences. He overlooks in this connection, the question of sale. This appears to be a very important point. This case was remanded by the acting Commissioner to the Primary Examiner

to consider the question of sale more than two years before application.

Keller & Olmesdahl v. Felder, 10 O. G. 944.

The Examiner of Interferences is the tribunal before whom an interference is originally to be heard. It is irregular to present the question to the Board of Examiners in the first instance.

Farnsworth v. Andrews, 9 O. G. 195.

The practice indicated by this Rule approved by McArthur J., but Judge Wylie said "I have no idea that it was the intention of the law makers that in questions of interferences the Office should go into the question of abandonment, and he did not think the Commissioner had a right to establish a rule permitting it."

Bigelow v. The Commissioner of Pats., 7 O. G. 606.

If in the judgment of the Examiner of Interferences neither party is entitled to a patent for want of novelty, he must send the question back to the Primary Examiner for determination. He can not decide it himself.

Neubocker v. Schafhaus, 1873 C. D. 138.

The Examiner of Interferences has no jurisdiction over questions of patentability. Such questions should go to the Primary Examiner as they are appealable to the Supreme Court of the District, and matters within the jurisdiction of the Examiner of Interferences can not be appealed from the Decision of the Commissioner.

Little v. Little et al., 10 O. G. 543.

Facts establishing two years' public use before application for a patent developed in an interference can not afterward be explained away by *ex parte* affidavits. Case remanded to the Primary Examiner to consider such question.

Stearns v. Prescott, 13 O. G. 121.

The Examiner of Interferences has no jurisdiction over of two years' public use as a bar to a patent.

Little v. Little et al., 76 C. D. 207; Ansen v. Woodbury, 77 C. D. 4.

Questions of statutory bar of public use referred to the Primary Examiner by the Commissioner without an appeal from the decision of the Examiner of Interferences.

Quimby v. Randall, 14 O. G. 748.

The Examiner of Interferences can not dissolve an interference in view of *ex parte* affidavits setting forth public use as a bar to the application. The question should be remanded to the Primary Examiner.

Hedges v. Daniels, 17 O. G. 152.

The Examiner of Interferences has jurisdiction to hear and determine the fact of joint or sole invention in an interference between joint patentees and a sole applicant who is one of said patentees.

Lourien v. Banister, 18 O. G. 299 (*ex parte* Bruker, M. S.)

If it is decided that there was no joint invention the sole applicant would be the prior inventor, as the entity, the joint inventors, never invented it at all.

Kohler v. Kohler & Chambers, 43 O. G. 247. See Harrison v. Hogan, 18 O. G. 921.

Judgment of priority given by the Commissioner and the case remanded to the Primary Examiner to determine the question of a statutory bar by reason of public use.

Smith v. Dimond, 20 O. G. 742.

After the declaration of an interference a motion to dissolve should be made to the Examiner of Interferences.

Barney v. Kellogg, 17 O. G. 1096.

The Examiner of Interferences is a proper person to hear and determine questions relative to abandonment.

Von Heffner v. Alteneck, 23 O. G. 2233.

The practice indicated by this rule (126?) seems to be that such reference by the Commissioner can only be made when the case is brought to him regularly on appeal. In a case where the testimony conclusively establishes the fact that the invention had been in public use for more than two years prior to the time when the application for a patent was filed, I do not know that it would be a violation of the Rule for the Commissioner to order that the question should be determined before any decision of priority is made. But as above stated such is not the practice under said Rule. Such reference will not be made if the testimony relating to public use is not conclusive.

Finch v. Bailey & Talbot, 25 O. G. 191.

The restoration of jurisdiction for one purpose does not restore it for all.

Benger v. Burson, 99 O. G. 1384.

Motion for the dissolution of the interference on the ground that it was declared in violation of the provisions of Rules 121 and 123 should be determined by the Examiner of Interferences.

Edison & Gilliland v. Philps, 38 O. G. 539.

Motion to reopen for the purpose of taking more testimony comes properly before the Examiner of Interferences.

McCallum v. Bremer, 93 O. G. 1918; Hildreth, 97 O. G. 1374.

After appeal it was refused to restore jurisdiction to the Examiner of Interferences in order to present a motion to dissolve.

Fessenden v. Potter, 101 O. G. 2823.

The fact that a similar question has been raised by another party furnishes no ground for a rehearing.

Davis v. Ocumpaugh v. Gerrett, 103 O. G. 227.

Motions to shift the burden of proof should be made before the Examiner of Interferences within the twenty days after the approval of the preliminary statements allowed for motions. (Changing jurisdiction from Primary Examiner to Examiner of Interferences.)

Raulet & Nicholson v. Adams, 114 O. G. 1827; Townsend v. Ehret v. Young v. Struble, 137 O. G. 1484.

Jurisdiction of Examiner of Interferences.

Lowry & Cowley v. Spoon, 122 O. G. 2687; Behrend v. Lammer v. Tingley, 124 O. G. 2536; Kugele v. Blair, 125 O. G. 1350.

The reason set up in the present petition why the motion should be remanded to the Examiner of Interferences, relate in the most part to the merits of that motion and are questions which should be presented before the Primary Examiner and not before the Examiner of Interferences.

Pickard v. Ashton and Curtis, 137 O. G. 977.

It is urged that the earlier application does not disclose the invention, and it is very clear that this is a matter which is to be considered and determined by the Examiner of Interferences and not the Primary Examiner.

Dickinson v. Hildreth, 122 O. G. 1397.

The only apparent questions for consideration on a motion to restore jurisdiction to the Examiner of Interferences are whether the motion is in proper form and whether so far as can be seen, without going into the merits of that motion, it is brought in good faith.

Newell v. Clifford v. Rose, 122 O. G. 730.

Jurisdiction restored to the Examiner of Interferences after time limited for appeal had expired. The party should have a hearing upon the question whether the showing made by him is sufficient to warrant the reopening of the case.

Lipscomb v. Pfeiffer, 122 O. G. 351.

An interference will not be suspended in order to give time for the issuing of a patent on an application referred to but not included in the interference, before the other party has access to the files.

Field, 130 O. G. 1587.

It is the well settled practice of this Office that the bring-

ing of motions or taking petitions to the Commissioner will not stay the running of the limit of appeal from a decision on priority.

Pym v. Hadaway, 129 O. G. 2073.

The pendency of a motion under Rule 109 no excuse for delay.

Josleyn v. Hulet, 130 O. G. 1689.

Rule 124. Appeals from Adverse Decisions.

Where, on motion for dissolution, the law examiner renders an adverse decision upon the merits of a party's case, as when he holds that the issue is not patentable or that a party has no right to make a claim, he shall fix a limit of appeal not less than twenty days from the date of his decision. Appeal lies to the examiners in chief in the first instance and will be heard *inter partes*. If the appeal be not taken within the time fixed, it will not be entertained except by permisison of the Commissioner.

No appeal will be permitted from a decision rendered upon motion for dissolution affirming the patentability of a claim or the applicant's right to make the same.

Appeals may be taken directly to the Commissioner, except in the cases provided for in the preceding portions of this rule, from decisions on such motions as, in his judgment, should be appealable.

HISTORY.

The rule previous to the last amendment read as follows:

Where, on motion for dissolution, the Primary Examiner renders an adverse decision upon the merits of a party's case, as when he holds that the issue is not patentable or that a party has no right to make a claim or that the counts of the issue have different meanings in the cases of different parties, he shall fix a limit of appeal not less than twenty days from the date of his decision. Appeal lies to the Examiners-in-Chief in the first instance and will be heard *inter partes*. If the appeal is not taken within the time fixed, it

will not be entertained except by permission of the Commissioner.

No appeal will be permitted from a decision rendered upon motion for dissolution affirming the patentability of a claim or the applicant's right to make the same or the identity of meaning of counts in the cases of different parties.

Appeals may be taken directly to the Commissioner, except in the cases provided for in the preceding portions of this rule, from decisions on such motions as, in his judgment, should be appealable.

See Historical note under Rule 122.

CONSTRUCTIONS.

(1) HISTORY AND SUBJECT-MATTER.
(2) ABANDONMENT—SHIFTING THE BURDEN OF PROOF.
(3) RIGHT TO MAKE THE CLAIM.
(4) AFFIRMING PATENTABILITY.
(5) AMENDMENTS.
(6) REHEARINGS.
(7) ASSIGNMENTS OF ERROR.
(8) DECISION OF THE COMMISSIONER.
(9) TIME WHEN TAKEN—EXCUSE FOR DELAY—PETITION TO EXTEND TIME.
(10) TO THE BOARD OR TO THE COMMISSIONER.
(11) DECISION OF THE BOARD.
(12) MISCELLANEOUS.

(1) *History and Subject-Matter.*

These rules cannot take away the right of an applicant to an appeal after two rejections by the Primary Examiner. (R. S. see 4909.)

U. S. ex. rel., The Newcomb Motor Co. v. Allen (Moore), Commissioner, 130 O. G. 302.

Refusal to suppress testimony not reversible error.

Rempshall v. Royce, 129 O. G. 3162.

No appeal to the Court of Appeals of the District on interlocutory motions in Trade-Mark cases.

The Union Distilling Co. v. Schnieder, 129 O. G. 2503.

No appeal from decision of the Examiner extending time for taking testimony. Can only be modified by exercise of supervisory authority of Commissioner, and this only in unusual cases.

Wickers and Furlong v. Weinwurm, 129 O. G. 2501.

Inoperativeness and public use question in motions to dissolve not appealable.

Barber v. Wood, 127 O. G. 1991.

There is no appeal from the decision of the Primary Examiner affirming the opponent's right to make the claims or the identity of meaning of the claims in their respective application.

Daggett v. Kaufmann, 127 O. G. 3641.

This rule is not inconsistent with section 4909 of the Revised Statutes.

Lowry v. Spoon, 112 O. G. 732. (See 133 O. G. 1680.)

The decision of the Examiner of Interference transmitting a motion will not be reviewed on appeal or petition.

Rich v. Porter v. Hamlin, 192 O. G. 1261.

No appeal from a decision denying a judgment on the record.

Christiant v. Brunneschenke v. Rosañz, 181 O. G. 819.

No appeal to the Secretary of the Interior in matters of a quasi judicial nature such as extending time for a final hearing so as to relieve against a default in filing printed testimony.

Dunkley v. Bukhuis, 158 O. G. 886.

The rule that there is no appeal from decisions on motions to shift the burden of proof, applies also to cases where such a motion is made in response to a rule to show cause and judgment on the record results from the decision of the Examiner of Interferences on such motion.

Barney v. Hiss, 158 O. G. 702.

A motion will not be considered on appeal—although the reason for dismissing it no longer exists.

Kieth, Erickson, etc., v. Lundquist v. Larimer, 158 O. G. 701.

A petition for the Commissioner to exercise his supervisory authority, is not a remedy that may be used instead of the appeal refused by this rule.

Frost v. Chase, 151 O. G. 741.

The Examiner's action refusing to declare an interference may not be appealed. (Trade-Mark.)

Yonkers Brewery Co. v. Iler and Burgweger, 143 O. G. 258.

No appeal from a decision of the primary examiner, that the evidence does not establish the bar of public use.

Hartley, 136 O. G. 1767.

Notice of opposition to trade-mark registration on the ground that the notice of opposition was not signed.

The motion is in effect a motion for judgment on the record and under the established practice of the Office no in-

terlocutory appeal lies from a refusal to render such a judgment.

Geo. Wostenholm & Son, Limited, v. Crowley, 135 O. G. 1121.

Previous to 1880 an appeal seems to have been allowed from a decision affirming the patentability of a claim. The same result can now be attained by a protest under Rule 12.

Fowler v. Benton, 17 O. G. 266.

Propriety of rule discussed. (Consolidating Interferences.)

Klein v. Groebli, 110 O. G. 305-308.

The practice indicated by Rules 122-123-125 may not be the best, but as long as it is the established practice it should be observed.

Brown v. La Dow, 18 O. G. 1049.

Determined means ended or decided. This rule should control Rules 116 and 120.

Hicks v. Keating & Bilgram v. Purvis, 40 O. G. 344.

The statutes do not provide for an appeal to the Examiners-in-Chief from a decision upon a motion to dissolve an interference.

Allen, Commissioner, v. U. S. ex rel. Lowry et al., 116 O. G. 2253.

Refusing to suspend interference to await determination of suit at law (having a different issue) is not such an abuse of discretion as will warrant the exercise of supervisory authority.

Brown v. Inwood and Lavenberg, 135 O. G. 895.

No appeal from a decision refusing to suppress testimony.

O'Brien v. Gale v. Limimer v. Colderwood, 133 O. G. 514; Dietsch Brothers v. Looner, 131 O. G. 2146.

No appeal from the Examiner of Interferences granting a motion to admit testimony the printed copies of which were not filed within the time requested by the rule.

Blackmore v. Hill, 137 O. G. 1237.

Whether or not, applicant should be requested to point out the elements of his claims in his application is a matter of procedure within the discretion of the Examiner. The question is not generally appealable.

Hoch v. McCaskey v. Hoppkins, 141 O. G. 1161.

No appeal as to new matter.

Samulson v. Flanders, 171 O. G. 745.

No appeal from decision affirming operativeness of opponents device.

182 O. G. 973.

No appeal from a refusal to strike out testimony.

Reed & Carnbrick v. Waterbury Chemical Co., 183 O. G. 219.

This rule refers to a decision affirming patentability rendered after an inter partes hearing.

Quensel v. Knox v. Pries v. Murphy, 185 O. G. 248.

The Commissioner has, however, supervisory authority over these matters.

Anderson & Dyer v. Lowry, 89 O. G. 1861.

It is more than doubtful whether a construction of Rule 124 which would deprive the Commissioner of jurisdiction would be a valid one.

Von Welsbach v. Lungen, 48 O. G. 537.

Questions arising under this rule are not reviewable by the Supreme Court of the District of Columbia on Appeal.

Hulett v. Long, 89 O. G. 1141. See however U. S. ex rel. The Newcomb Motor Co. v. Moore, Com., 133 O. G. 1680.

I know of no confusion in the practice at present existing as to the proper course of appeal upon the question of interference in fact. Rule 124 seems clear and unmistakable upon this point.

Allfree v. Sarver, 122 O. G. 2391.

Where a party may not appeal from a motion he may not appeal from a determination upon the admissibility of affidavits filed with that motion.

Brown v. Inwood et al., 131 O. G. 142.

Appeal denying motion to dissolve for non-interference in fact is to the Commissioner and not to the Board.

Zeidler v. Leech, 1891 C. D. 9.

The Rules cannot take away the right of an applicant to an appeal after two rejections by the Primary Examiner. See R. S. Sec. 4809.

U. S. ex rel The Newcomb Motor Co. v. Allen (Moore) Commissioner, 130 O. G. 302.

The same reasons for not permitting an appeal from a favorable decision exists in the case of a motion brought under Rule 109 as on motion to disolve. The practice on motions under Rule 109 should follow the practice under Rule 124.

Townsend v. Copeland v. Robinson, 126 O. G. 1355; Josleyn v. Hulse, 132 O. G. 844.

No appeal from the refusal of the Examiner-in-Chief to direct the attention of the Commissioner to certain patents alleged by one of the contestants to constitute a statutory bar.

Schmiede v. Walden, 1891 C. D. 150.

No appeal from a decision denying a motion to suppress testimony or requiring a party to print exhibits.

Deitsch Brothers v. Looner, 131 O. G. 2146.

No appeal from a decision setting aside a record judgment and fixink a time for final hearing, as this is not a final determination of the rights of petitioner in the premises.

O'Brien v. Gale v. Limmer v. Calderwood, 133 O. G. 514.

A party to an interference has no right to a review by the Commissioner of a favorable decision by the Primary Examiner in a motion to dissolve alleging non-patentability of the issue either on direct appeal or upon petition for the exercise of his supervisory authority (R. S. 4904) urged to the contrary.

Hawkins v. Coleman v. Thullen, 133 O. G. 1187.

A decision refusing to dissolve an interference on the ground of *res adjudicata* is a favorable decision on the merits and was not to be reviewed on appeal.

Degen v. Pfadt, 133 O. G. 514.

The provision of the statute giving an applicant the right to have a claim twice rejected (Sees. 4903-4909) does not apply in *inter partes* cases. Where a Primary Examiner, on motion to dissolve decides that one of the parties has no right to make the claims of an interference issue, and such party after filing an appeal from said decision fails to prosecute the same, and abandons it, such decision becomes final and binding on the parties and precludes the subsequent *ex parte* consideration of the same question.

U. S. ex rel. The Newcomb Motor Co. v. Moore, Commissioner of Patents, 133 O. G. 1680.

An appeal from the Examiner's ruling raises only the question whether or not the Examiner was right in postponing the consideration of the question, which is a matter that will not be reviewed and reversed except in a clear case of abuse of discretion.

Royce v. Kempshall, 119 O. G. 338.

(2) *Abandonment, Shifting the Burden of Proof.*

Appeal allowed from decision of Examiner of Interferences fixing dates for taking testimony as to abandonment of opponent's application.

Kinsman v. Strohm, 125 O. G. 1699.

No appeal is permitted prior to final judgment on a motion to shift the burden of proof. and any supposed error in the decision thereon will be reviewed in connection with the decision upon the question of priority of invention.

McGill v. Adams, 119 O. G. 1259.

A decision that a claim is not abandoned is not one that is not appealable under the last paragraph of this rule, but is appealable under Rule 122.

Meden v. Curtis, 117 O. G. 1795.

A mandamus refused to compel the Commissioner to allow an appeal where the question of abandonment was decided in favor of the applicant.

Bigelow v. Commissioner of Patents, 7 O. G. 603.

An appeal should be allowed where permission to take testimony is refused.

Pym v. Hadaway, 128 O. G. 457.

Refusal to suppress testimony not reversible error.

Kempshall v. Royce, 129 O. G. 3162.

It is believed that it will be to the interest of all parties concerned, if the Examiner of Interferences in granting motions for the extension of time for taking testimony would not set a limit of appeal from such motion.

Goodfellow v. Jolly, 115 O. G. 1064.

Decisions of the Examiner of Interferences are final on motions to extend time for taking testimony, and no limit of appeal should be set.

Christensen v. McKenzie, 117 O. G. 277.

No appeal from a decision refusing to shift the burden of proof.

Miller v. Wallace, 131 O. G. 1689.

Decision on a motion to shift the burden of proof will be reviewed only in a clear case of an abuse of discretion. Certainly his action will not be reviewed where no such motion has been brought.

Young v. Townsend v. Thullen, 134 O. G. 1804.

(3) *Right to Make the Claim.*

Whether certain additions to original disclosure was proper relates to right to make the claim and not to form.

Sasher v. Barrett, 166 O. G. 751.

No appeal from the refusal of the Examiner to suggest claims to opponent under Rule 96.

Stronach v. Shaw, 192 O. G. 989; Mortimer v. Thomas v. Brownson, 192 O. G. 215.

No appeal from a decision on a motion under Rule 109 that cannot be made the basis for the rejection of a claim.

Mortimer v. Thomas v. Brownson, 192 O. G. 215.

When it was contended that one of the parties did not interfere because he did not show one element of the issue,

the question was one of the right of the party to make the claim, and the question was not appealable.

Ball v. Rigo, 119 O. G. 1258.

Res adjudicata is a question of right to make the claim and will not be considered on petition from a favorable decision.

Eschinger v. Drummond & Lieberknecht, 121 O. G. 1348.

There is no appeal from a judgment of priority rendered in view of the admission of a party that he is not the inventor, and no limit of appeal need be set from such a decision.

Townsend v. Corey, 119 O. G. 2237.

Where both parties were agreed that the claim was unpatentable the appeal was entertained under the supervisory authority of the Commissioner.

Reichert v. Brown, 124 O. G. 2903.

Favorable decision as to right to make the claim not considered on appeal.

Blackford v. Wilder, 124 O. G. 319; Samuelson v. Flanders, 171 O. G. 745.

As the question of the operativeness of one of the devices now in interference is directly presented to us as an incident of the main question of priority, we hold that it is not one for our consideration. It is as we have before indicated a preliminary question determinable in the first instance in the case of every application for a patent, and when determined in favor of the applicant is not appealable. When determined in his favor, and an interference declared thereon with another similarly allowed application, the same rule applies.

Duryea & White v. Rice, Jr., 126 O. G. 1357.

Interferences are to determine priority. Though parties in these proceedings are permitted to secure reconsideration by the Primary Examiner of his *ex parte* conclusions that their opponents, aside from the conflicting claims of priority, are entitled to patents, and though they are entitled to appear and oppose such reconsideration, their opponents' right to a patent, the interest of a party has never been considered such that he should be permitted to appeal from the Examiner's *inter partes* conclusion affirming his opponent's right to a patent.

Gueniffet, Benoit & Nicault v. Wictorsohn, 117 O. G. 1492.

The provisions of the last clause cannot be avoided by a petition to the Commissioner to exercise his supervisory authority.

Kampshall v. Sieberling, 104 O. G. 1395.

. It is a well settled principle that a decision relating to sufficiency of disclosure will not be disturbed except for manifest error.

Auerbach & Gubing v. Wisweld, 108 O. G. 289.

No appeal from the decision of the Examiner that affidavit was sufficient to overcome the reference.

McChesley v. Kruger, 101 O. G. 219.

No appeal can be taken from the decision of the Primary Examiner allowing claims upon an affidavit under Rule 75, as this is a favorable decision.

Byron v. Maxwell, 105 O. G. 499.

Decision that a claim is a good combination and is not anticipated is not appealable.

Wickers & Furlong v. Weinwurm, 117 O. G. 1797.

Where a party requests an interference, and the Examiner rules that he is not entitled to make the interfering claim. Held that the matter will not be reviewed on interlocutory petition or appeal.

Hanson, 117 O. G. 2632.

Question of new matter is not one of regularity but one of right to make the claim, from which no appeal lies.

Brooker v. Smith, 119 O. G. 652.

Matters urged as irregularities, but which relate to right to make the claim, will not be heard on appeal.

Pryor v. Ball v. Brand, 119 O. G. 653.

There is no appeal from an affirmative decision upon the right of a party to make a claim, and equivalent consideration is not to be obtained by presenting the contention in different form and under a different name. As, for instance, whether the counts mean the same in reference to both applications.

Weintraub v. Hewitt, 124 O. G. 2534.

The contention that the opposing parties do not have a construction responding to a certain language in the issue is one relating to the right to make the claim and not to interference in fact—No appeal.

Carnell v. Glasgow v. Cook, 120 O. G. 901.

There is no appeal from the decision of the Primary Examiner affirming the opponent's right to make the claims or the identity of meaning of the claims in their respective applications.

Daggett v. Kaufmann, 127 O. G. 3641.

A petition to review a decision affirming patentability, or the right to make the claim, and identity of meaning of counts, in the exercise of supervisory authority, will be considered only in extraordinary cases.

Lipschutz v. Floyd, 130 O. G. 2718.

(4) *Affirming Patentability.*

The Examiners-in-Chief having allowed a claim corresponding to count five to Strouble, there is consequently no appeal from that decision.

Coleman v. Bullard v. Strouble, 114 O. G. 973.

The part of this rule denying an appeal in certain cases applies to appeals from the Examiners-in-Chief.

Langslow v. Malocasy, 155 O. G. 1043.

No appeal lies from the decisions of the Examiner-of-Trade-Marks adjudging that a party is entitled to the registration of a trade-mark.

Sibley Soap Co. v. Lambert Pharmacal Co., 103 O. G. 2172.

It would be only in a very clear case that the Examiner's decisions affirming patentability would be reviewed on appeal.

Rinsche v. Sandherr, 105 O. G. 1780.

There is no appeal from a decision of the Examiner holding that the issue is patentable when construed broadly enough.

Bachman v. Southgate, 111 O. G. 805.

An appeal does not lie from a decision affirming patentability.

White v. Thomson, 101 O. G. 2825.

No appeal lies from the refusal of the Examiners-in-Chief to call attention to the question of patentability under Rule 126. So long as this rule stands it must be enforced, and it has been approved by the different Commissioners.

Benet & Mercie v. McClean, 97 O. G. 1595.

The law makes no provision for an appeal from the favorable decision of the Examiners-in-Chief affirming patentability.

Barney v. Kellogg, 17 O. G. 1096.

Last clause affirmed.

Faure v. Bradley v. Crocker v. Cowles & Cowles, 40 O. G. 243.

The supervisory authority of the Commissioner will be exercised to review a favorable decision on patentability only in very exceptional cases.

Read v. Scott, 101 O. G. 449.

When the Examiner has decided in favor of the patentability of claims, it would seem that the right of the opposing party to raise this issue was at an end.

Sobey v. Holsclaw, 119 O. G. 1922.

The validity of this rule, as to denying an appeal in deci-

sions affirming patentability of a claim, affirmed by the Supreme Court of the United States, two justices dissenting.

U. S. ex rel. Lowry v. Allen, Com., 125 O. G. 2365.

(5) *Amendments.*

The fact that there has been a "final rejection" in the course of the interference should not be taken to mean, as the applicant seems to fear it may, that further amendments will not be permitted except as an act of grace or leniency.

Sanders v. Hawthorne v. Hoyt, 125 O. G. 1347.

This rule does not authorize amendment of the claims during the interference.

Sanders v. Hawthorne v. Hoyt, 125 O. G. 1347.

(6) *Rehearings.*

There is no appeal from a decision refusing a rehearing.

Carmichael v. Fox, 104 O. G. 1656; Bryon v. Henry, 104 O. G. 1895; Reynolds v. Bean, 101 O. G. 2821; Roemer v. Neumann, 49 O. G. 1535; Cole v. Zarbock v. Greene, 116 O. G. 1451.

The question of res adjudicata may be raised at any time, and may be raised by any tribunal of its own motion.

Carroll v. Hallwood, 135 O. G. [illegible].

If the claims could have been raised under the first trial they cannot be reheard.

Carroll v. Hallwood, 135 O. G. 896.

The court of appeals held that where in an interference it was held that neither party had a right to make the claim and the time for appeal had expired, that the matter was *res adjudicata* and could not be presented by one of the applicants prosecuting his application *ex parte*.

Herbst, 141 O. G. 287.

(7) *Assignment of Error.*

A question involving the right of an applicant to make the claim in interference will not be passed upon by the Commissioner on appeal from the decision of the Primary Examiner upon a motion to dissolve the interference.

Sweeney v. Jarvos, 1892 C. D. 97; Pryor v. Ball v. Brand, 119 O. G. 653; Weintraub v. Hewitt, 124 O. G. 2534.

Example of assignment of reasons.

Carroll v. Hallwood, 135 O. G. 896; Phillips v. Lensenich, 134 O. G. 1806.

We think the question of res adjudicator was preserved in

the assignment of error which assails the decision of the Examiner of Interferences in awarding priority on the whole case.

Carroll v. Hallwood, 135 O. G. 896.

On an appeal on priority the court will not review the finding of the Commissioner upon the sufficiency of a showing to support a petition for the reinstatement of an abandoned application where there appears to have been no abuse of power on the part of the Commissioner.

Kinsman v. Strohim, 136 O. G. 1769.

Where no irregularity in declaring the interference independent of the allegation of non-interference in fact was presented, held that the appeal as to the ground of irregularity in declaration would be dismissed.

Walker v. Brunhoff, 118 O. G. 2537; Blackmore v. Hall, 118 O. G. 2538.

Where the Examiner dissolves the interference because the issue is not patentable, Held, that an appeal relating to interference in fact involves a moot question, and will not be determined.

Newell v. Hubbard, 115 O. G. 1847.

There is no appeal from the Examiner's action holding that the counts are patentable, and therefore the sole question to be determined is whether the counts in question are the same when applied to the structure of both parties.

Anderson v. Vrooman, 123 O. G. 2975.

Questions cannot be raised on appeal which have not been raised by the motion and passed on below.

Larkin Company v. Pacific Coast Borax Co., 132 O. G. 679.

Where it has been decided that one of the parties to the interference has no right to make the claims, the question of interference in fact is a moot question and will not be considered on appeal.

Selden v. Gerts & Palmer, 105 O. G. 1531.

Right to make claims and patentability will not be reviewed upon appeals on non-interference in fact, and irregularity in declaration.

Thullen v. Young & Townsend, 118 O. G. 2251.

On appeal on question on priority, patentability will not be considered.

Fairbanks & Sauer v. Karr, 119 O. G. 651.

Where on an appeal to the Commissioner on the question of interference in fact it appears from the opinion of the Primary Examiner and the brief of the appellant that the

real question is one relating to the right to make the claims, the appeal will be dismissed.

Schofield v. McGovern v. Woods, 119 O. G. 1924.

Contentions which go to the right of a party to make claims can afford no proper basis for dissolution upon the ground of non-interference in fact. Appeal dismissed.

Blackmore v. Hall, 119 O. G. 2523; Blackmore v. Hall, 120 O. G. 1477.

The decision of Primary Examiner affirming patentability will not be reviewed in an appeal relating to other grounds permitted by Rule 122.

Wilkinson v. Junggren, 112 O. G. 252.

This appeal while nominally on appealable grounds is really for the purpose of getting a review of the Examiner's decision affirming patentability and applicant's right to make the claims. It is therefore dismissed.

Forsyth v. Emery, 113 O. G. 2215.

An affirmative decision upon the right of the appellee to make the claim is not appealable and will not be considered in an appeal on other grounds.

Kinney v. Goodhue, 123 O. G. 1663.

A new appeal fee must be paid on the appeal denying the patentability of a claim in an *inter partes* matter notwithstanding an appeal has been once taken on that point on an *ex parte* matter.

Cheney v. Venn, 125 O. G. 1703.

Applicant's claims were involved in two interferences. A motion has been made in each on the ground of lack of patentability, which was granted. Held that one appeal fee was sufficient.

Miller v. Mann v. Bacon v. Torrance, 115 O. G. 1063.

Where an interference is dissolved by the Primary Examiner on motion, appeal cannot be taken by the party bringing such motion, though granted on a part only of the grounds urged therein.

Zeitinger v. Reynolds v. McIntire, 1891 C. D. 212; Ries v. Thomson, 1891 C. D. 233.

No valid reason appears to exist for making an exception where the motion is appealable to the Examiners-in-Chief and in allowing only one party to the contested proceedings to appear and be heard.

Duncan v. Westinghouse, Jr., 66 O. G. 1005.

When both parties move to dissolve the interference upon all grounds permitted by the rules and the motions are granted, held that an appeal will not be entertained since

a party cannot appeal from a decision in his favor merely because he disagrees as to the reason.

Scott v. Badeau, 116 O. G. 2007.

Favorable decision not appealable.

Potter v. McIntosh, 116 O. G. 1451.

Where a review is requested by G. of Examiner's rulings upon the meaning of claims in his decision granting G.'s motion for dissolution, held that G. was not entitled to such review: his motion for dissolution as to counts embodying the substance of these claims having been granted.

Votey v. Gally, 119 O. G. 339.

Where a party made no motion for dissolution he cannot appeal from the refusal of a motion made by another party.

Townsend v. Copeland v. Robinson, 119 O. G. 2523.

The supervisory authority will not be exercised to review a favorable decision on the question of patentability except in a very clear case.

Eschinger v. Drummond & Lieberknecht, 121 O. G. 1348.

There is no reason, as was pointed out in Miller v. Perham, 121 O. G. 2627, why the Office, having once decided that a party is entitled to make certain claims should reconsider the question on the party's own motion.

Goodwin v. Smith, 123 O. G. 998.

It is the substance of the decision which determines whether it is appealable to the Commissioner and not the reason given by the Examiner.

Von Welsbach v. Lungren, 48 O. G. 537. Cited, 85 O. G. 1738.

Only one injured may appeal.

Judd v. Compbell, 110 O. G. 2017.

No appeal from favorable decision.

Cazin v. Von Welsbach, 119 O. G. 650.

Last clause. A petition will not be entertained except in a clear case, to review a favorable decision.

Denton et al. v. Riker, 98 O. G. 415.

Non-appeal lies from a refusal to declare an interference with an existing patent accompanied by an allowance of applicant's claims under the last clause.

Gibboney, 105 O. G. 976.

When ample opportunity to introduce a prior application is given, and the matter will be reviewed on appeal, a case will not be reopened because of difference of interpretation given by the Primary Examiner and the Examiner of Interferences.

Dixon v. Bliss, 185 O. G. 1381.

(8) *Decision of the Commissioner.*

The judgment of the Examiner will not be controlled by an order made in advance.

Marks v. Greenawall, 118 O. G. 1967.

An appellant will not be heard to argue that an interference should be dissolved, upon the ground under Rule 122, not argued before the Examiner.

Pfingst v. Anderson, 118 O. G. 1067.

Last clause. This clause may not be avoided by considering the standing of the application as evidence.

Shupphaus v. Stevens, 95 O. G. 1452.

The Commissioners may, upon appeal upon points not involving the question, declare that there is no conflict in fact.

Schupphaus v. Stevens, 95 O. G. 1454.

Does not prevent the Commissioner from considering any reason for dissolving an interference which may be brought to his attention or which he may discover. A petition will not be entertained when it seeks to obtain indirectly a review of an Examiner's decision from which no appeal lies, by merely misnaming the proceedings.

Goss v. Scott, 96 O. G. 844.

Decision of Primary Examiner. When a motion to dissolve is brought upon the grounds specified in Rule 122 the Examiner should decide the motion upon all grounds, and if the decision is of such a nature that appeal therefrom may be taken he should fix a limit of appeal.

Duryea & White v. Rice, 115 O. G. 803.

If appealable grounds are presented an appeal may not be refused by an Examiner because he chooses to decide the motion upon unappealable grounds.

Silverman v. Hendrickson, 88 O. G. 1703.

(9) *Time when Taken—Excuse for Delay—Petition to Extend Time.*

An appeal from a decision on a motion will not be entertained and considered *nunc pro tunc* after the limit of appeal has expired, because of a showing that it was the intention to appeal and the failure was due to a misunderstanding between attorneys.

Gerdon v. Ehrhardt, 116 O. G. 595.

No limit of appeal was set by the Examiner of Interferences, which should have put appellant upon notice that the Examiner did not regard the question decided as an appealable one; under such circumstances appeal should be taken promptly, if at all, in order that opposing parties may not

proceed under a misapprehension as to the condition of the case.

Geo. Wostenholm & Son, Limited, v. Crowley, 135 O. G. 1121.

Negligence or oversight of attorneys not sufficient excuse for not taking appeal within the time limited.

Brissenden v. Roesch, 118 O. G. 2253.

An appeal filed after the expiration, the limit of appeal will be entertained only in very unusual and extraordinary cases.

Briggs v. Conley, 104 O. G. 1119; Blackman v. Alexander, 105 O. G. 2059; Kiltzker and Goesel v. Donan, 109 O. G. 1336; Greuler v. Mathew, 112 O. G. 253; Gerdon v. Ehrhardt, 116 O. G. 595; Brisender v. Roesch, 118 O. G. 2253; Townsend v. Ehret, 125 O. G. 2051; Wenzelmann and Overholt, 123 O. G. 995; McKeen v. Jerdone, 134 O. G. 2027.

It is thought the Commissioner has authority to permit an appeal after the limit.

McKeen v. Jerdone, 134 O. G. 2027.

Since the defeated party failed to take his appeal within the limit set, he is not now entitled to have that decision reviewed by another tribunal.

Briggs v. Conley, 104 O. G. 1119.

A limit of appeal should be set in decisions denying a right to make a claim.

Judd v. Campbell, 110 O. G. 2016.

Where in an interference it is decided that one of the parties has no right to make the claim, it seems clear that it is not just to the other party to withhold indefinitely his application, which is ready to issue, merely to await the pleasure of the other party. A limit of appeal should be set.

Hutin v. LeBlanc v. Steinmetz v. Scott v. Fairfax, 97 O. G. 2744.

The exercise of discretion in refusing to longer continue the case in order to give appellant further time to file his preliminary statement is not subject to review by us, unless it clearly appears from the record that the rights of appellant have been prejudiced by an unwarranted departure from the law or rules of procedure regulating proceedings of this kind in the Patent Office.

Hallowell v. Darling, D. C. App.; Churchill v. Goodwin, 141 O. G. 569.

No appeal from a decision of the Examiner extending time for taking testimony. It can only be modified by the exercise

of the supervisory authority of the Commissioner, and this only in unusual cases.

Wickers & Furlong v. Weinwurm, 129 O. G. 2501; The Shaw and Willy Shirt Co. v. The Quaker City Shirt Mfg., 157 O. G. 1000. See, however, Kinsman v. Strohm, 125 O. G. 1699.

The bringing of motions or the taking of petitions to the Commissioner will not stay the running of the limit of appeal from a decision on priority.

Pym v. Hadaway, 131 O. G. 692.

(10) *To the Board or to the Commissioner.*

Appeal denying motion to dissolve for non-interference in fact is to the Commissioner and not to the Board.

Zeidler v. Leech, 1891 C. D. 9.

A motion of one party to amend his application by inserting two claims taken from his opponent's application, not appealable directly to the Commissioner.

Berry v. Fitzsimmons, 99 O. G. 863.

Interference in fact appealable to Commissioner in person.

Oldham & Padbury v. Peck v. Clement v. Richards, 99 O. G. 670.

Appeal, from decision dissolving interference because there is no right to make the claims, appealable to Examiners-in-Chief.

Story v. Criswell, 100 O. G. 683.

An appeal from an action holding that there is no such combination does not lie to the Commissioner.

Webber, 98 O. G. 2362.

(11) *Decisions of the Board.*

If the Examiners-in-Chief are equally divided, the Primary Examiner is affirmed, and upon questions of patentability there is no appeal.

Porter v. McIntosh, 120 O. G. 1823.

The only question that can be presented to the Board, under the statute, on an appeal in an interference case upon the merits, is priority of invention. The Board has no right to make the question of whether there is an interfering matter in the device a part of their decision.

Brown v. La Dow, 18 O. G. 1049.

No appeal from favorable decision of the Board on questions of right to make the claim.

Josleyn v. Hulse, 132 O. G. 844; Coleman v. Bullard v. Struble, 114 O. G. 973.

(12) *Miscellaneous.*

Cases that pass on the subject matter of this rule.

Mill v. Midgley, 136 O. G. 1534; Harnisch v. Gueniffet, Benoit and Nicault, 128 O. G. 455; Bechman v. Southgate, 123 O. G. 2309.

Last clause.

In re Locke, 94 O. G. 432; Myers v. Sarfert, 96 O. G. 1037; Reece v. Fenwick, 97 O. G. 188; Hinkley v. Barker, 97 O. G. 2742; Sharer v. McHenry, 91 O. G. 1034; Wheeler v. Seeberger, 125 O. G. 2363; Hopfelt v. Read, 106 O. G. 767; Myers v. Brown, 112 O. G. 2093-4; Schubert v. Munro, 113 O. G. 284-3; Gully v. Brand, 113 O. G. 852; Harnisch v. Gueniffet, Benoit & Nicault, 117 O. G. 1492-3; Allen, Commissioner, v. U. S. ex rel. Lowry et al., 116 O. G. 2254-3; Neth v. Tamplin v. Ohmer, 120 O. G. 323; Brewer, Tily, Rehfuss & Rehfuss v. Dement, 116 O. G. 2010; Duryea & White v. Rice, 123 O. G. 2627; Locke v. Baldwin, 124 O. G. 317; Harnisch v. Gueniffet, Benoit & Nicault, 128 O. G. 355.

Rule 125. Determination.

After an interference is finally declared it will not, except as herein otherwise provided, be determined without judgment of priority founded either upon the evidence, or upon a written concession of priority, or upon a written disclaimer of the invention, or upon a written declaration of abandonment of the invention, signed by the inventor himself (and by the assignee, if any).

CONSTRUCTIONS.

Both applications owned by the same party—one applicant could not be found.

Schreiber v. Bauer, 258 O. G. 813.

Both parties moved to dissolve because of non-patentability. They might simultaneously file abandonment.

Krakaw v. Harding, 107 O. G. 1662; Tomlinson v. Riely, 183 O. G. 784.

A declaration of abandonment should not give reason there-

fore. But one containing such reasons should not be stricken from the files.

Carrington v. Turner, 136 O. G. 1067; Clutcault v. The New York Herald Company, 136 O. G. 437.

Copy of a record under this rule.

Carroll v. Hallwood, 135 O. G. 896-7.

The inventor of his representative must sign the concession of priority even when the entire interest has been assigned.

Alt. v. Carpenter, 132 O. G. 1587.

Where applicant moves for dissolution upon ground of non-patentability and his opponent is involved upon a regularly issued patent and the motion is brought after the expiration of the time for taking testimony and no testimony has been taken, held that the practice announced in Lipe v. Miller, 109 O. G. 1068, should not be followed and that the case should proceed to judgment.

Smith v. Slocum, 123 O. G. 1990.

An unequivocal, unconditional, unlimited declaration of abandonment of the invention which forms the subject-matter of the issue of the present interference is the only abandonment which can be filed under this rule.

Gabrielson v. Felbel, 121 O. G. 691.

The declaration must be unequivocal and absolute.

Gabrielson v. Felbel, 1906 C. D. 108, 121 O. G. 691.

If during an interference a patentee applies for and obtains a reissue omitting the interfering claims, a motion for dissolution should be made and allowed.

Lattig & Goodrum v. Dean, 117 O. G. 1798.

One can not be adjudged the prior inventor upon the contention that his opponent's application does not disclose the issue. The contention, if sound, warrants dissolution, not judgment.

Jenner v. Dickinson v. Thibodeau, 116 O. G. 1181.

If one of the parties applies for a reissue omitting claims involved, this is to be regarded as a written concession of priority and judgment under this rule rendered accordingly.

Lattig & Goodrum v. Dean, 115 O. G. 505.

When an interference has been decided upon its merits, the judgment will not be set aside on a concession of priority by the successful party.

Humphrey v. Fickert, 112 O. G. 2094.

A judgment rendered upon a technicality reversed upon a concession of priority by the successful party.

Couper & Somers v. Bannister, 112 O. G. 1480.

The signature of the inventor is necessary to abandonment.

Skinner v. Murray, 107 O. G. 542.

The rules nowhere provide for a determination of an interference after it has been once declared on a mere cancellation of the claims.

Read v. Scott, 100 O. G. 449, 1902 C. D. 242.

A former decision should be rendered by the Primary Examiner. The practice should follow that under Rule 122.

Macey v. Tobey v. Laning, 97 O. G. 1172-3, 1901 C. D. 168.

Rule may not be evaded by means of a protest.

Schweitzer, 97 O. G. 1171, 1901 C. D. 179.

Where the structure of one of the parties to an interference is inoperative, priority of invention can not be awarded to him.

Glidden v. Noble, 67 O. G. 676, 1894 C. D. 51.

Cancellation of the claims is not sufficient.

Curtis v. Marsh, 92 O. G. 1236, 1900 C. D. 127.

The withdrawal of one of the applications does not end the interference.

Adler v. Van Wagener, 1875 C. D. 123; to the contrary, see Eames & Selley v. McDougal, 1871 C. D. 206.

If public use for more than two years is shown by preliminary statement the interference should be dissolved.

Schenck v. Rider, 1870 C. D. 135.

This rule was part of the rules of practice in 1871. See Rule 59 quoted in

Eames & Seeley v. McDougall, 1871 C. D. 206.

Rule 126. Statutory Bar Suggested.

The examiner of interferences or the examiners in chief may, either before or in their decision on the question of priority, direct the attention of the Commissioner to any matter not relating to priority which may have come to their notice, and which, in their opinion, establishes the fact that no interference exists, or that there has been irregularity in declaring the same (Rule 122), or which amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference. The Commissioner may suspend the interference and remand

the case to the primary examiner for his consideration of the matters to which attention has been directed. From the decision of the examiner appeal may be taken as in other cases. If the case shall not be so remanded, the primary examiner will, after judgment, consider any matter affecting the rights of either party to a patent which may have been called to his attention, unless the same shall have been previously disposed of by the Commissioner.

HISTORY.

Rule 120 of 1879 reads: "In their decision of the question of priority, or before such decision, the examiner of interferences and the examiners-in-chief will direct the attention of the commissioner to any fact not relating to priority which may have been brought to their notice (by motion or otherwise), and which in their opinion amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference.

The commissioner may, before judgment on the question of priority of invention, suspend the interference, and remand the case to the primary examiner for the consideration of the statutory bar so suggested, subject to appeal to the examiners-in-chief, as in other cases. If the case shall not be so remanded, the primary examiner will, after judgment, consider and determine the same, unless it shall have been previously disposed of by the commissioner."

Rule 59 of 1878 reads in part as follows: "In their decision of the question of priority, or before such decision, the examiner of interferences, or the examiners-in-chief, as the case may be, will direct the attention of the commissioner to any fact not relating to priority which may have come to their attention (by motion or otherwise), and which, in their opinion, amounts to a statutory bar to the grant of a patent to either or both parties. After final judgment the primary examiner will consider and determine any such matter not previously disposed of by the commissioner."

I find no provision in the Rules of September 1, 1873.

CONSTRUCTIONS.

A petition for public use proceedings to prove the use of anticipating machinery as much as twelve years and more ago. Held, insufficient where it was unaccompanied by a

print, photograph or like evidence as to the alleged anticipating structure.

Dwiggins, 229 O. G. 1573.

If no motion to dissolve under Rule 122 has been made action under this rule should be taken only when the case is perfectly clear.

White v. Wege, 227 O. G. 1107.

Question of statutory bar not in issue in interference proceedings.

Johnson v. Martin, 201 O. G. 267.

There is nothing in the showing to indicate that the alleged use was public rather than private, or that the alleged use in public was more than an abandoned experiment.

Price v. Adamson, 197 O. G. 1291.

An applicant in interference with patentee can not get an adjudication of the question of the patentability of the counts under this rule.

Pattersen v. Weber, 192 O. G. 215.

The petition should be served upon the opposing party and an offer to produce the witnesses and to bear the expense of investigation.

Duellen v. Claussen & Claus, 190 O. G. 265; Seebert v. Bloomberg, 124 O. G. 628.

Proceeding outlined in a public use proceeding.

Betts v. Gerson, 189 O. G. 524.

Public use proceedings can not determine the issue of priority.

Wenzelmann and Cloverholt, 180 O. G. 1394; Kennedy v. McLain, 158 O. G. 547.

Rule 130 provided that a party may urge that his opponent has no right to make the claims of the issue at final hearing, provided he has prosecuted a motion under Rule 122 for dissolution upon this ground. While it is not the practice where the junior party is under an order to show cause for the Examiner of Interferences of his own motion to set a case down for hearing under Rule 130, it is the practice to grant such a hearing where a motion or request, therefore, is made before, or within a reasonable time after the entry of judgment on the record.

Noble v. Levin, 180 O. G. 602.

Testimony being proposed in a proper showing.

This rule not applicable where the party is not entitled to make claim. See note to Rule 130.

McBerty v. Shore and Shore, 175 O. G. 843.

The question of public use is considered a question separate

from that of priority of invention raised in an interference proceeding and to require a separate investigation. It is not the practice to suspend an interference proceeding when at the present stage, in order to investigate public use, especially where the bar, if established, would apply only to the application of one party.

Perrault v. Pierce, 98 O. G. 793, 108 O. G. 2146, 131 O. G. 942; Kneisly v. Kaisling, 174 O. G. 830.

Public use proceedings are instituted only upon formal petition, accompanied by proof of service upon the applicant together with an offer to produce the witnesses and to bear the expenses of the investigation.

Kneisly v. Kaisling, 124 O. G. 628, 174 O. G. 830.

A petition for public use proceedings postponed to await the outcome of a motion to dissolve.

Snyder v. Woodward, 173 O. G. 863.

Will not suspend action in an interference proceeding where testimony has been taken and the case is ready for final hearing in order to institute public use proceedings. (Deoble v. Henry, 118 O. G. 2249; West v. Borst and Grosch, 122 O. G. 2062.)

Brenizer v. Robinson, 166 O. G. 1281.

The motion is informal, since the Commissioner and not the Primary Examiner is the official who determines whether a public use proceeding should be instituted. (Hartley, 136 O. G. 1767; Rolfe, 155 O. G. 799.)

Benizer v. Robinson, 166 O. G. 1281.

Some counts two and five are held to be unpatentable, the question of whether the Curtis structure covered thereby is operative or is a moot question which it would serve no useful purpose to determine in the interference proceeding. (100 O. G. 683, 105 O. G. 1531, 111 O. G. 2492, 115 O. G. 1847.)

Inasmuch as the interference now stands dissolved, the question of what claims Curtis may be entitled to is one for ex parte consideration.

Curtis v. Kleinert, 160 O. G. 1038; Yarnell v. Pope, 115 O. G. 2136.

The right of his adversary to make the claim at issue has been uniformly held to be ancillary to the question of priority of invention. This is also true where it is urged by a moving party that his opponent has no right to make the claim for the reason that the device shown in the application is inoperative. In the latter case the moving party has upon presentation of a sufficient showing been permitted the

right to take testimony to show that his opponent's device is inoperative.

Barney v. Hess, 158 O. G. 702.

Patentability was denied claims of an applicant that had inadvertently been patented to another. The Court of Appeals says, "In view of the inadvertence of the Patent Office in granting a patent which is now beyond the control of the Office it would probably have been more equitable practice to have assumed patentability for the purpose of determining the question of priority.

Orcutt, Etc., 141 O. G. 567.

Ordinarily the protestant is ignorant to a greater or less extent of the contents of applicant's case, and the Office is not warranted in giving the protestant information of the application or in offering him an opportunity to gain such information. The privilege of filing a brief gives the protestant all the privileges to which he is entitled.

Henry, Jr., 140 O. G. 508.

In public use proceedings it is customary merely to set a time within which the parties, the protestant as well as the applicant, may file briefs, with the Primary Examiner.

In re Henry, Jr., 140 O. G. 508.

A motion to require joint applicants to show by testimony that they are in fact joint inventors of the invention in issue, refused.

Pickard v. Ashton v. Curtis, 137 O. G. 732.

Public use proceedings are ex parte in their nature, the sole question being whether the applicant is barred from obtaining a patent on the invention claimed by reason of the public use or sale of devices embodying the invention claimed.

Hartley, 136 O. G. 1767.

The affidavits presented by the protestant were deemed sufficient to lay the foundation for the introduction of testimony, but they are not themselves testimony.

Hartley, 136 O. G. 1767.

While it is the practice to permit one of the general public to file a protest and to take testimony in behalf of the Patent Office upon this question, such party has no right in the controversy other than those authorized by the Commissioner.

Hartley, 136 O. G. 1767.

A motion to take testimony as to inoperativeness of opponent's apparatus, brought in the regular course of the proceedings, affords petitioner an adequate remedy without the necessity of invoking the supervisory authority of the

Commissioner, and should be determined in the first instance by the Examiner of Interferences.

Lowry & Cowley v. Spoon, 122 O. G. 2687; Barber v. Wood, 132 O. G. 1588.

The question whether one of the parties to an interference proceeding is debarred from receiving a patent by reason of his having secured a foreign patent for the same invention is a question for *ex parte* consideration after the termination of the interference.

Gueniffet, Benoit and Nicault v. Wictorsohn, 134 O. G. 255.

A petition that a rule be issued against an opposing party to show cause why it should not be held that he has abandoned his invention, and that petitioner be permitted to offer testimony upon such question, will not be entertained under the Commissioner's supervisory authority where the petitioner has other remedies and is in fact pursuing another remedy before the Examiner of Interferences.

(Cases cited) Barber v. Wood, 132 O. G. 1588.

Public use is considered in the practice of this Office as a separate question, requiring an investigation independent of the question of priority of invention involved in an interfering proceeding (96 O. G. 2409, 104 O. G. 577). No testimony has been taken and there is nothing in the case upon which the Primary Examiner at the present time can intelligently consider the bar of public use. No error is found in the refusal to transmit on this ground.

Barber v. Wood, 129 . G. 2835.

It is thought that the commissioner should remand the case and not decide it himself.

Serrel v. Donnelly, 129 O. G. 2501.

A protest on the ground of public use was once dismissed because unaccompanied by an offer to produce witnesses and bear expenses. It is now dismissed because affidavit set up conclusions instead of facts. Applicant should present this case as well as may be done by affidavits so as to give the opponent an opportunity to intelligently oppose the institution of the proceeding and the consequent delay.

Booth, 128 O. G. 1291; Wickers & Furlong v. McKee, 129 O. G. 1269.

A protest on the ground of public use was once dismissed because unaccompanied by an offer to produce witnesses and bear expenses. It is now dismissed because affidavits set up conclusions instead of facts. Applicant should present his case as well as can be done by affidavits so as to give the

opponent an opportunity to intelligently oppose the institution of the proceedings and the consequent delay.

Booth, 128 O. G. 1291.

An appeal should be allowed where permission to take the testimony is refused.

Pym v. Hadury, 128 O. G. 457.

It is designed by the practice instituted in this case to avoid these complications, in those cases where the recommendations of the examiners-in-chief covers matters considered and passed upon by the Primary Examiner in an *inter partes* decision, by substituting at the outset the entry of a rejection *Pro Forma* by the Primary Examiner putting the case at once in a condition for a course of appeals which may be carried to the Court of Appeals.

Holz v. Hewitt, 127 O. G. 1992. (See Bunnell, 103 O. G. 1993.)

Petitioner has not made such a showing as would warrant institution of public use proceedings. (Siebert v. Bloomberg, 124 O. G. 628.)

Barber v. Wood, 127 O. G. 1991.

. The affidavits fail to make out a *prima facie* case of public use of the invention more than two years prior to Siebert's filing date. They state the conclusions of the witnesses largely to the exclusion of the facts upon which such conclusions are based. Where facts are given they are not recited with sufficient particularity and certainty. A portion of the showing is also objectionable as hearsay. The Office should not institute a proceeding that may uselessly consume the time and labor of all parties upon such a showing.

Siebert & Bloomberg, 124 O. G. 628.

Thought that it would be an improvement if the Examiner of Interferences in these cases would make his opinion the bases of a judgment of priority of invention instead of calling attention to the supposed facts under Rule 126.

Brown v. Hodgkinson, 123 O. G. 2973. Cites Podlesak & Podlesak v. McInnerney, 120 O. G. 2127; Allen, Commissioner of Pats., v. The U. S. of America ex rel. George A. Lowry & P[illegible]rs Compress Co., 116 O. G. 2253.

The proper practice when a case is referred to the Primary Examiner upon suggestions by the Examiners-in-Chief of lack of right of a party to make claims, and the Primary Examiner disagrees with the conclusions of the Examiners-in-Chief, is to refer the case to the Commissioner for decision.

Duryea & White v. Rice, 123 O. G. 2627.

I see no reason why I should act to control the discretion of the Examiner of Interferences calling attention to matter under Rule 126 or refusing to call attention under that rule.

Wert v. Borst & Groscop, 122 O. G. 2062; Munro v. Walker, 122 O. G. 2062; Andrews v. Nilson, 123 O. G. 1667.

A consideration of the affidavit and testimony referred to by the protestant makes it seem probable that such bar does exist. It is not necessary to analyze that testimony to determine whether it is technically sufficient if true to prove public use.

Ashton, 122 O. G. 730; Duryea & White v. Rice, Jr., 122 O. G. 1395.

Examiners thought one party had not disclosed the invention.

The interference remanded to the Primary Examiner, to hear the parties and furnish his opinion as to the question raised, together with a statement of the reasons for his conclusions. The examiner's opinion placed in the interference file, copies sent to the parties and the case returned to the Commissioner for decision upon the appeal.

Kilbourn v. Hirner, 122 O. G. 729.

Where all the evidence is before the Office upon which to base a final determination upon priority, such final determination should in general be reached before consideratian of *ex parte* rights is undertaken.

Dunbar v. Schellenger, 121 O. G. 687.

An interference will not be suspended for the purpose of considering the question of estoppel against one party where dissolution of the interference would apparently leave the way clear to the allowance of a patent to another party who may not be the first inventor.

Dunbar v. Schellenger, 121 O. G. 687.

This rule does not provide for the filing of motions (as for the return of the case to the Primary Examiner to determine a question of Statutory Bar). Motion entitled under it dismissed.

Struble v. Young, 121 O. G. 340.

A suggestion by the Examiners-in-Chief referred to the Primary Examiner who agreed. There is no conflict of opinion, because the Examiner previously thought differently, to warrant a review by the Commissioner.

Snider v. Bunnell, 121 O. G. 338.

The parties are therefore notified that the testimony already taken will be used as a *prima facie* case in support of

the allegation of public use, and that if any one of them wishes to take testimony in explanation or rebuttal he must so notify the Office within 20 days.

Niedringhaus v. Marquard v. McConnell, 121 O. G. 337.

It is thought that the Commissioner should remand the case and not decide it himself.

Serrell v. Donnelly, 120 O. G. 2501.

Reference under Rule 126 consideration of merits of an application not postponed on account of possible erroneous decision on priority.

Newell v. Clifford v. Rose, 119 O. G. 1583; Sobey v. Holsclaw, 119 O. G. 1922.

The Examiner referred the case to the Commissioner because he thought the first count patentable to C. in the interference, N. v. C. v. R., and not patentable to N. or R: *Held*, that the two interferences should proceed.

Newell v. Rose, 119 O. G. 337.

The question of patentability and interference in fact were presented for consideration on motion but not pressed, and that they were argued before the Examiner of Interferences and the Examiners-in-Chief on final hearing and these tribunals asked to make a recommendation under Rule 126 and such recommendation was refused, these facts do not warrant a review by the Commissioner.

Bell v. Flora, 117 O. G. 2362.

If Carver is of the opinion that there is no invention in fact, he is not without remedy. The provisions of Rule 126 are available when this case comes on for final hearing.

Carver v. McCanna, 117 O. G. 599; In re Mill, 117 O. G 904.

If an applicant in contest with a patentee admits a statutory bar to himself the interference should be dissolved.

Griffith v. Dodgson, 116 O. G. 1731.

A case transmitted to consider patentability where one party was a patentee. The Office will not waste time deciding a moot question simply to avoid casting cloud upon a patent.

Yarnell v. Pope, 115 O. G. 2136.

Public use suggested by assignee of entire interest sufficient to warrant action by the Office.

Cummings, 114 O. G. 2090.

In the matter of trade-marks.

Frank & Gutmann v. Macwilliam, 114 O. G. 542.

Public use alleged against some of the counts, but not all.

Held that the question of public use if necessarily raised at all should be after the conclusion of the interference.

Moss v. Blaisdell, 113 O. G. 1703.

Originally there were two counts in the interference, but under the procedure set forth in Rule 126 one of these has been eliminated.

Spaulding v. Norden, 112 O. G. 2091.

If an alleged anticipating patent is discovered too late for a motion under Rule 122, it may still be called to the attention of the Commissioner under this rule.

Schrimer v. Lindemann & Stock, 111 O. G. 2222.

It is held, therefore, that when the question upon which the Examiner and the Examiner of Interferences differ relates to the patentability of the claims or the right of one of the parties to make the claims, and thereby involves the merits of the invention, the interference should be referred to the Examiners-in-Chief; but when the difference of opinion is merely upon formal matters, such as interference in fact or irregularity in declaring the interference, the case should be referred to the Commissioner for final determination.

Weber v. Hall, 111 O. G. 809.

A mechanical application can not affect the burden of proof in interference between designs.

McArthur v. Gilbert, 110 O. G. 2509.

The question of public use may be determined *inter partes.*

Mills v. Torrence, 110 O. G. 857; Judd v. Campbell, 110 O. G. 2017.

Successful applicant did not think the invention patentable to him. Interference dissolved.

Lipe v. Miller, 109 O. G. 1608.

In an interference between an applicant and a patentee if the Examiner of Interferences is of the opinion that the applicant is not entitled to make the claims, the case should be transmitted to the Primary Examiner for immediate determination.

Hall v. Weber, 109 O. G. 1607.

The rule provides sufficiently for the consideration by the Office on its own motion of matters which might have been made the basis of the motion mentioned in Rule 122, but which were not so presented; and the action of the Examiner refusing to transmit will not be disturbed except in a clear case.

Sturgis v. Hopewell, 109 O. G. 1008.

It is contrary to usual practice to suspend an interference

between two applicants to investigate the question of public use.

Perrault v. Pierce, 108 O. G. 2146.

Where public use is shown by testimony regularly taken, its effect can not be overcome by *ex parte* affidavits, but only by evidence regularly taken.

Tournier, 108 O. G. 798.

The question of patentability is *ex parte* in character, and if it becomes necessary to take testimony upon that question the Office will investigate in a proceeding independent of the interference.

Steinmetz v. Hewitt, 107 O. G. 1972.

If both parties file an abandonment of the invention the Examiner of Interferences should call attention to this bar.

Krakaw v. Harding, 107 O. G. 1662.

The question of public use is, furthermore, one which can not properly be decided against Winter without giving him an opportunity to take rebutting proofs, since that evidence was taken upon a different issue.

Weber, 101 O. G. 2570; Winter v. Slick v. Volkommer, 107 O G. 1659.

The Examiner's action or failure to act under this rule is not appealable. It is in effect a favorable decision as to the patentability of the claims.

Woods v. Waddell, 106 O. G. 2017; Kempshall v. Sieberling, 107 O. G. 541; Dittgen v. Parmenter, 107 O. G. 1098.

Where he (the Primary Examiner) disagrees with the other tribunals, it is believed that the question should be regarded as unsettled and should be referred to a higher tribunal for decision.

Snider v. Bunnell, 103 O. G. 890; Mills v. Torrence, 106 O. G. 544.

Under this rule, the Examiners-in-Chief may, if they deem it advisable, call the attention of the Commissioner to any matter not relating to priority which in their opinion establishes the fact that no interference exists or that there has been irregularity in declaring the same or which amounts to a statutory bar to the grant of a patent to either party for the claim in interference. This is not, however, compulsory upon them, and if they refuse to do so, no appeal lies.

Walsh v. Hallbauer, 94 O. G. 223; Wilcomb v. Lasher, 105 O. G. 743.

The Examiner of Interferences was of the opinion that one applicant had no right to make the claims. The matter referred to the Primary Examiner who thought applicant had

such right. The matter was then referred to the Board who held that applicant had no such right. The Commissioner directed that a limit of time to appeal from the decision of the Board be set.

Robinson v. Copeland, 105 O. G. 263.

Public use proceedings not applicable to trade-marks.

Dietz, 104 O. G. 1852.

Public use is considered in the practice of this Office as a separate question, requiring an investigation independent of the question of priority of invention involved in an interference proceeding. No testimony has been taken, and there is nothing in the case upon which the Primary Examiner at the present time can intelligently consider the bar of public use. No error is found in the refusal to transmit on this ground.

Davis v. Swift, 96 O. G. 2409; Shrum v. Baumgarten, 104 O. G. 577.

Such investigation, however, would not be made as a part of the interference, but as an independent proceeding. It would be made only upon motion for suspension for that purpose, accompanied by a satisfactory showing of public use and an expression of a willingness on the part of the moving party to produce the witnesses for examination and to bear the expense of the proceeding, including the expense of an officer detailed from the Office to conduct the proceeding.

Shrum v. Baumgarten, 104 O. G. 577.

Claims can not be rejected or held unpatentable upon such affidavits alone.

Shrum v. Baumgarten, 104 O. G. 577.

It is designed by the practice instituted in this case to avoid these complications in those cases where the recommendation of the Examiners-in-Chief covers matters considered and passed upon by the Primary Examiner in an *ex parte* decision by substituting at the outset the entry of a rejection *pro forma* by the Primary Examiner, putting the case at once in condition for a course of appeals which may be carried to the Court of Appeals.

Holz v. Hewitt, 127 O. G. 1992; Greenawalt v. Mark, 103 O. G. 1913.

In public use proceedings the Patent Office alone represents the public and its approval is necessary to make any agreement affecting the merits of the case binding.

Kephart, 103 O. G. 1914.

It is the question, not the evidence, which is transmitted for consideration and determination. In passing upon a question so transmitted the Examiner may avail himself of

any information which he may obtain throwing light upon the question. To prevent surprise, due and timely notice should be given of any facts to be considered which are not disclosed by the record.

Greenawalt v. Mark, 103 O. G. 1913.

Motion to transmit to Primary Examiner to consider question of two years' public use, noted by Examiner of Interferences, also asking to have a foreign patent considered as an anticipation. Refused. The evidence taken in an interference can not without further proceedings be used as the basis for the rejection of claims on the ground of public sale of the invention. Questions relating to anticipatory matter should be raised by a motion to dissolve under Rule 122.

Dittgen v. Parmenter, 103 O. G. 1164.

The rules properly provide that a favorable decision by the Examiner upon the merits is not appealable; but at the same time they provide for review of such a decision in certain cases, not as a matter of right by the parties, but as a matter of public policy.

Snider v. Bunnell, 103 O. G. 890.

The Board thought that no interference in fact existed and that one of the parties had no right to make the claim. Case remanded to Primary Examiner, who held that an interference existed and the party had a right to make the claim. Case placed on Commissioner's docket for final decision.

Snider v. Bunnell, 103 O. G. 890.

The question as to whether one of the parties received knowledge of the invention from a third party will not be considered in an interference proceeding. Otherwise, if it is a question of originality between the parties.

Trufant v. Prindle v. Brown, 101 O. G. 1608.

Public use proceedings instituted.

Weber, 101 O. G. 2570; Snider v. Bunnell, 101 O. G. 2572; Fessenden v. Potter, 101 O. G. 2823; Osborn v. Hotsapillar, 102 O. G. 1296-7.

If the Examiner be of the opinion that certain actions should be made in an application which is involved in an interference, and said actions relate to matters which do not in any way relate to or affect the interference then pending, the proper practice to follow is for the Examiner to file a request with the Commissioner that jurisdiction of the case be restored to him for the purpose of making such action.

Hildreth, 97 O. G. 1374; Felbel v. Oliver, 100 O. G. 2175-6; Read v. Scott, 101 O. G. 449.

Primary Examiner and Board take different views.

Thomson v. Weston, 94 O. G. 986.

Two years' public use in designs.

Fournier, 94 O. G. 2166.

Whether or not the Board shall suggest statutory bar, etc., is optional with them and can not be reviewed on appeal.

Walsh v. Hallbauer, 94 O. G. 223.

The question of statutory bar considered by Commissioner upon appeal on question under Rule 122.

Valiquet v. Johnson, 92 O. G. 1795.

The Commissioner may take notice of these matters on his own motion.

Anderson & Dyer v. Lowry, 89 O. G. 1861; Larter v. Jones, 92 O. G. 383.

In the public use proceeding a copy of an application involved refused protesting party.

National Phonograph Co., 89 O. G. 1669.

Bar arising should not be considered during the interference proceeding by subordinate tribunal, but referred to Commissioner.

Paget v. Bugg, 89 O. G. 1342.

Interference suspended to take testimony relative to public use proceedings, without a recommendation.

Sanford Mills v. Aveyard, 88 O. G. 129.

Where the structure of one of the parties to an interference is inoperative, priority of invention can not be awarded to him.

Glidden v. Noble, 67 O. G. 676.

With the small sum appropriated by Congress for conducting public use proceedings the Patent Office is not justified in instituting such proceedings unless a strong *prima facie* case is made.

Fay v. Conradson, 65 O. G. 75.

The establishment of abandonment or of two years' public use requires proof so clear as to put the matter beyond all reasonable doubt.

Bury v. Thompson, 58 O. G. 1255.

The invalidating two years' public use of the statute does not require the knowledge, allowance or consent of the inventor.

Drawbaugh, 57 O. G. 546.

The interference should not be delayed by public use proceedings unless for extraordinary and amply sufficient reasons.

Campbell v. Brown, 56 O. G. 1565.

When an allegation of public use comes up for consideration in connection with an application which is being considered *ex parte* after the termination of the interference pro-

ceedings, the proper practice is for the Examiners to pass upon the question whether or not a *prima facie* case of public use has been established, rejecting the claims in the case if he decided the question in the affirmative. Unsworn statements do not make a *prima facie* case.

Beatty, 56 O. G. 1563.

Bar of public use not avoided by caveat.

Meucci, 51 O. G. 299.

Public use proceeding on motion of defeated party to an interference refused.

Beardslee v. Moeslein, 46 O. G. 1640.

The question as to what is the correct practice under this rule when joint applicants prove not to be joint inventors has presented itself in a variety of phases to the Commissioners, and their conclusions are by no means in harmony. During the period covered by these decisions the rule has been changed and modified, but this fact will not explain the conflict in them. Decisions reviewed.

Hicks v. Keating v. Purvis & Bilgram, 40 O. G. 343.

The question of statutory bar as contemplated in Rule 120 relates to matter that is purely a bar as contradistinguished from title, or whether applicants are joint inventors. Under the present rule a statutory bar to either one of the parties in interference may call into exercise the action authorized by it. Formerly, it was only a statutory bar to both.

Hicks v. Keating v. Purvis & Bilgram, 40 O. G. 343.

If the question presents itself in the preliminary statement, applicant should be given a chance to avoid the objection by amendment; if he does not do so the preliminary statement should be approved if correct in other particulars, and in his decision of the question of priority the Examiner of Interferences should call the attention of the Commissioner to the existence of the statutory bar.

Hicks v. Keating v. Purvis & Bilgram, 40 O. G. 343.

The joint patentees proving not to be joint inventors the interference was decided against them and the case was remanded to the Primary Examiner to consider whether there was not a statutory bar existing to the grant of the patent by reason of the right of one of said joint patentees to obtain a patent.

Harrison v. Hogan, 18 O. G. 921.

The provisions of this rule must not be construed to provide an alternate remedy, but can only be availed of when motions relating to a statutory bar can not be made as prescribed in the other rules.

Barney v. Kellogg, 17 O. G. 1096.

When the Examiner of Interferences finds that neither party is the first and original inventor he should render his judgment accordingly. As this question relates to priority it should be appealed to the Board and not referred to the Commissioner under this rule.

Wood v. Eames, 17 O. G. 512.

The law of 1836 provided that in connection with interference proceedings, like proceedings should be had to determine which, or whether either of the applicants is entitled to receive a patent as prayed for. But in the act of 1870 this provision was omitted.

Smith v. Perry, 9 O. G. 688.

Nor can I think that an interference proceeding authorized by law for one specific purpose (i. e., to determine priority of invention), can be rightfully used by the Commissioner for any other purpose, and in my judgment, no part of the testimony taken and submitted in such case, if plainly outside the issue, is evidence at all against the right of the adverse party. This decision related to abandonment by public use apparently.

Smith v. Perry, 9 O. G. 688.

In the case of Rouse and Stoddard, 75 C. D. 33, the practice of sending letters of inquiry to the inventor who has filed and abandoned an application, calling for information in the form of affidavits as to public use of the invention, and informing the applicant that another application for the same invention is pending, was inaugurated; this practice was discontinued in the case of

Casilear & McIntire, 1875 C. D. 117.

I believe it has been the custom of the Commissioners, although such matters are purely *ex parte,* to hear other parties, in order that he might be as fully informed as possible in relation to the merits of the case.

Com. Spear in Carter & Dwyer v. Perry & Dickey, 1875 C. D. 111.

The question of novelty is always a proper one for consideration of the Office at any time prior to the grant of a patent An interference case reopened to admit testimony of that kind after the time for taking testimony had expired. The Examiner of Interferences directed to assign dates for taking such testimony.

Wood v. Morris, 1873 C. D. 39. See Hovey v. Hufeland.

If public use for more than two years is shown by preliminary statement the interference should be dissolved.

Schenck v. Rider, 1870 C. D. 135..

The question of priority decided by the Commissioner and the case referred to the Primary Examiner to determine the question of novelty in view of newly discovered references.

Yost v. Heston, 1871 C. D. 226.

Cases that pass on the subject matter of this rule.

Foster v. Bell, 159 O. G. 241; Hess v. Jorrissen v. Filbel, 131 O. G. 1419; Dixon and Marsh v. Graves and Whittemore, 130 O. G. 2374; Potter v. McIntosh, 127 O. G. 1995.

Rule 127. Second Interference.

A second interference will not be declared upon a new application for the same invention filed by either party.

CONSTRUCTIONS.

This rule prohibits the declaration of a second interference between the same contesting parties upon the same invention and a second interference between the same applications should be declared only in rare cases and under very exceptional circumstances. Reason of the rule. See also note to 122.

Blackford v. Wilder, 124 O. G. 319.

Held, that the testimony in a prior interference may be given the force and effect of an *ex parte* affidavit in the consideration of the question whether a second interference with a broader issue is justified.

Wende v. Horine, 118 O. G. 1070.

The decision in the first case is *prima facie* evidence that applicant was not the first inventor even when decision was rendered upon a default.

Votey, 114 O. G. 259.

Or because a party has enlarged the scope of his claims.

Corry and Barker v. Trout v. McDermott, 110 O. G. 306.

From the earliest organization of the office, it has been the settled practice to declare such second interferences, and therein when proper, to reverse the decision in the former one, and numerous patents have been granted to the successful parties upon such second interferences, notwithstanding patents have been granted to their adversaries upon the previous trials.

Abraham v. Fletcher, 1869 C. D. 50.

Rule 128. Suspension of Interference for Consideration of New References.

If, during the pendency of an interference, a reference be found, the primary examiner shall call the attention of the law examiner thereto, and the latter may request the suspension of the interference until the final determination of the pertinency and effect of the reference, and the interference shall then be dissolved or continued as the result of such determination. The consideration of such reference shall be *inter partes* and before the law examiner.

HISTORY.

Previous to the recent revision, this rule read as follows:

If, during the pendency of an interference a reference be found, the interference may be suspended at the request of the primary examiner until the final determination of the pertinency and effect of the reference, and the interference shall then be dissolved or continued as the result of such determination. The consideration of such reference *shall be inter partes.*

This provision is in the rules of 1892, but "*ex parte*" is replaced by "*inter partes*" in the Rules of June 18, 1897.

CONSTRUCTIONS.

Consideration of references should be *ex parte.*

Westinghouse v. Thomson, 1891 C. D. 110.

This rule can have no application before the opening of the preliminary statements, because the proceeding provided for must be *inter partes,* and there can be no proper *inter partes'* consideration of the question of dissolution prior to access to opponents' cases. The interference is not pending within the meaning of this rule previous to that time.

Behrend v. Lanime v. Tingley, 124 O. G. 2536.

If the Examiner has secured jurisdiction as to certain counts an applicant can not demand that he consider other counts.

Lugoldshy v. Bellows, 116 O. G. 2532.

On appeal from the decision of the Primary Examiner shifting the burden of proof on the Examiner requesting a return of the case for consideration of new references. Be-

fore the interference proceeds further it should be positively determined whether or not these new references anticipate the issue.

Wright & Stebbins v. Hansen, 114 O. G. 761.

Because the Primary Examiner has requested jurisdiction under this rule in one interference, it is no ground for granting a motion to transmit the files in another case in which the same application is involved as the subject matter is presumably different and therefore the reference not applicable in both cases.

Parkin & Parkin v. Riotte, 109 O. G. 1335.

The Examiner erred in practice in his action rejecting the claims and then setting a day for a hearing on this rejection. When the interference was transmitted he should have set a day for hearing upon the question of patentability. After the hearing if he was of the opinion that the claims were not patentable in view of the references he should have rendered a decision dissolving the interference on that ground. After the interference was dissolved each of the applications should have been considered *ex parte*.

Struble, 109 O. G. 1335.

Judgment of priority not suspended to await determination of *ex parte* questions relating to the application of the successful party not affecting in any manner the rights of the defeated party.

Smith v. Dimond, 20 O. G. 742, 1881 C. D. 34.

The interference will be suspended a sufficient time to permit the usual appeals from the primary examiner.

Stone v. Greaves, 17 O. G. 260, 1880 C. D. 23.

If at any time pending an interference, new references are discovered by the primary examiner, the interference may be suspended for examination.

Banks v. Snediker, 16 O. G. 1096, 1879 C. D. 304; Anson v. Woodbury, 11 O. G. 243; 1877 C. D. 4.

A party may have a reasonable time to appeal.

Abel & Dewar v. Maxim v. Nobel, 1891 C. D. 102.

Cases that pass on the subject matter of this rule:

Turner v. Macloskie, 128 O. G. 2835; Mill v. Midgley, 136 O. G. 1534; Cazin v. VonWelsbach, 119 O. G. 650; Durafort, 110 O. G. 2017; Parkin & Parkin v. Riotte, 109 O. G. 1336; Hicks v. Costello, 103 O. G. 1163; Macey v. Laning v. Casler, 101 O. G. 1608, 1902 C. D. 399.

Rule 129. For Addition of New Parties.

If, during the pendency of an interference, another case appear, claiming substantially the subject matter in issue, the primary examiner shall request the suspension of the interference for the purpose of adding said case. Such suspension will be granted as a matter of course by the examiner of interferences if no testimony has been taken. If, however, any testimony has been taken, a notice for the proposed new party, disclosing the issue in interference and the names and addresses of the interferants and of their attorneys, and notices for the interferants disclosing the name and address of the said party and his attorney, shall be prepared by the primary examiner and forwarded to the examiner of interferences, who shall mail said notices and set a time of hearing on the question of the admission of the new party. If the examiner of interferences be of the opinion that the interference should be suspended and the new party added, he shall prescribe the terms for such suspension. The decision of the examiner of interferences as to the addition of a party shall be final.

CONSTRUCTIONS.

The Primary Examiner requested that the interference be returned to him for dissolution.

Welch v. Aufiero, 219 O. G. 930.

If two parties are in interference upon certain issues and one inserts a claim of a patent, the proper course is for the Primary Examiner to request jurisdiction and suggest the patented claim to both parties and declare an interference between the three on that issue.

Dow v. Benson, 107 O. C. 1378.

As stated in Maxwell v. Byron v. Henry, 98 O. G. 1968, an interference should not continue between two parties as to certain counts and between three parties as to other counts.

Dow v. Benson, 170 O. G. 1378.

One of the applicants filed a second application. The Com-

missioner says, if the claims are patentable over the issue and can be made by the other parties to the interference the Examiner should ask to have the applications of the other parties restored to his jurisdiction for the purpose of suggesting claims of the petitioners' application. If, on the other hand, the claims in this application are not patentable over the issue of the old application they should be rejected thereon.

Robinson, 106 O. G. 1242.

After decision on priority by the Examiner, Examiners-in-Chief and Commissioner it is too late to dissolve merely for the purpose of adding a new party.

Such a motion should be denied rather than dismissed for irregularities.

Corry v. Barker v. Trout, 99 O. G. 2547, 1902 C. D. 195.

The junior party has taken testimony, and the time allowed the senior party has expired without the taking of testimony by him. The effect of adding a new party at this stage would be practically to reinstate the latter, and as there is ample opportunity for a second interference between the junior and the third party the present interference will not be suspended for the purpose indicated.

Wein v. Northrop, 58 O. G. 1416.

An interference dissolved in order to include a former application by one of the parties.

White v. Demarest, 41 O. G. 1161, 1887 C. D. 133.

A motion to dissolve an interference made in violation of this rule should be determined by the examiner of interferences.

Edison v. Gilliland v. Phelps, 38 O. G. 539, 1887 C. D. 11.

An interference may be suspended but not dissolved for the mere purpose of adding new parties before taking testimony.

Maloney v. Kidwell, 16 O. G. 1139, 1879 C. D. 311.

It is unnecessary to dissolve the interference in order to include a second interfering patent, but the matter may be corrected by the examiner of interferences in his notice to the parties upon giving the time for taking testimony.

Wilson & Matthews v. Yakel & Rogers, 10 O. G. 944, 1876 C. D. 245.

Rule 130. Nonpatentability at Final Hearing.

Where the patentability of a claim to an opponent is material to the right of a party to a patent, said

party may urge the nonpatentability of the claim to his opponent as a basis for the decision upon priority of invention. A party shall not be entitled to raise this question, however, unless he has duly presented and prosecuted a motion under Rule 122 for dissolution upon this ground or shows good reason why such a motion was not presented and prosecuted. When the law examiner has denied such a motion for dissolution the question shall not be reinvestigated by the examiner of interferences except in view of evidence which was not before the law examiner, but it may be raised before the appellate tribunals on appeal from award of priority by the examiner of interferences.

HISTORY.

See Podlesak and Podlesak v. McInnerney, 1906 C. D. 558. 120 O. G. 2127, and cases referring to it, especially United States of America ex rel. The Newcomb Motor Company v. Moore, Commissioner of Patents, 133 O. G. 1680.

CONSTRUCTIONS.

(1) *What May be Considered on Final Hearing.*

Patentability of the issue, and difference in meaning, may not be argued under this rule, and especially no testimony will be taken.

Molyneux v. Onderdonk, 191 O. G. 292.

R. 130, however, only gives a party the right to argue at final hearing the unpatentability of a claim to an opponent, and then only when it is material to such party's right to a patent.

Molyneux v. Onderdonk, 196 O. G. 292.

A motion to dissolve because the issue means different things when applied to the different applications is no ground for consideration as to whether the issue is patentable to the opponent.

Havemeyor v. Couqel, 186 O. G. 558.

A person is not entitled to argue that his opponent has no right to make the claim unless he has urged this in a motion to dissolve.

Weis v. Mack, 185 O. G. 830.

Neither an allegation by a party to an interference that he himself has no right to make the claims, nor an allegation that the counts have different meanings in the two cases, forms a basis for a decision on priority and can not be urged at final hearing.

Weis v. Mack, 185 O. G. 830.

I am of the opinion that the adoption suggested claims and the prosecution of an interference can not be construed as an election of the species involved in the absence of other acts or statements on the part of the applicant binding him to such species.

Burk, 184 O. G. 289.

"The method of treating molten blast furnace slag, consisting in flowing the same over an artificially cooled moving surface while passing from a fluid to a solid state." Referring to feeding the slag into a hollow cooled rotating cylinder, may not be made on an apparatus which feeds the slag between the fitting surfaces of cooled rolls. The results being different.

Wood v. Duncan, 183 O. G. 1033.

It is well settled that the patentability of the issue will be considered on final hearing only under the *supervisory* authority of the Commissioner and in a clear case.

DeFerranti v. Lindmark, 183 O. G. 783 (Cases).

The question of inoperativeness may be presented upon proper showing at the final hearing of the case, and if circumstances justify it, testimony may be taken in accord with the cases cited.

Keys and Kraus v. Yunck, 182 O. G. 248-9.

The refusal to include certain trade-marks in the interference does not preclude them from being introduced at the final hearing.

Blanke Tea & Coffee Co. v. Herst, 182 O. G. 247.

Claims added under Rule 109 may be objected to a final hearing if the question has been previously raised.

Josleyn v. Hulse, 132 O. G. 844; Hopkins v. Cleal, 180 O. G. 1393.

The question as to whether the renewal was properly filed raised under this rule.

Le Brow v. Wix, 177 O. G. 771.

Where it appears that one of the parties has no right to make the claims in interference, the Examiners-in-Chief properly awarded priority to the party, and did not recommend that the interference be dissolved.

McBerty v. Shore, 175 O. G. 843.

Question of new matter may be heard under this rule.

Samulesen v. Flanders, 171 O. G. 745.

In view of their conclusion that Schutte was the prior inventor the Board should have considered and determined the question of the right of Schutte to make the claim as ancillary to the question of priority of invention, notwithstanding that they had previously considered that question on motion and the Commissioner had refused to exercise his supervisory authority.

Schutte v. Rice, 157 O. G. 753.

Petitioner has an adequate remedy in the interference proceeding. where the question (right to make the claim) can be raised at final hearing under Rule 130.

Frost v. Chase, 151 O. G. 741.

Questions of public use not considered at final hearing.

Lacroix v. Tyberg, 148 O. G. 831.

That counts one, two and three have different meanings in the respective applications, and that there is consequently no interference in fact, that counts four and five are not readable on his own device, and that counts four, five and six are not patentable over the prior art, and that for these reasons the interference should be dissolved, do not relate to matter that can properly be considered at final hearing except under circumstances such as would warrant the exercise of the supervisory authority of the Commissioner.

Lacroix v. Tyberg, 148 O. G. 831.

Question not raised below will not be considered on appeal.

McFarland v. Watson and Watson, 146 O. G. 257.

An affidavit of counsel for the petitioner to the effect that efforts were made to obtain an amended preliminary statement should have been presented before the Examiner of Interference, and it is not entitled to consideration when presented on appeal in the first instance.

Williams v. Foyer and Kurz, 142 O. G. 1114.

In Podlesak v. McInnerney, 26 App. D. C. 405, the rule previously adhered to in this court was modified, and we held that in awarding priority of invention the right of a party to make a claim might be considered as an ancillary question. But the concurrent decisions of the lower tribunal on the question will not be disturbed except in a clear case, especially where the subject-matter is a complicated construction in reference to which we are more liable to ERR than the Experts of the Patent Office.

Lindmark v. Hodgkinson, 137 O. G. 228.

S. did not bring a motion to dissolve the interference on

the ground that the other parties had no right to make the claims, and as no showing was made why such motion was not brought, he is not entitled to urge this question under the provision of Rule 130. The fact that no such motion was made does not prevent the tribunals of the Office from considering the question of their own motion, when it clearly appears that one or more of the parties have no right to make the claims.

Smith v. Foley v. Anderson v. Smith, 136 O. G. 847.

It was incumbent upon appellant to raise this question (sufficiency of disclosure) before the Primary Examiner whose skill in the particular art peculiarly qualified him to consider it.

Cutler v. Leonard, 136 O. G. 438; McFarland v. Watson et al., 146 O. G. 257.

Inasmuch as the pertinency of the question can not be judged as well when taken by themselves as when considered in connection with the answers thereto, any serious doubts as to the propriety or materiality of the interrogatories should be resolved in favor of allowing them to remain subject to objection until the final hearing.

Actiengesellschaft & Aulanerbrau Salvator Braueri v. Conrad Seipp Brewing Co., 135 O. G. 1121.

If the cross-interrogatories were not suppressed until final hearing, it is clear that appellant might thereby improperly obtain information to the irreparable injury of the adverse party.

Actiengesellzchaft & Aulanerbrau Salvator Brauerei v. Conrad Seipp Brewing Co., 135 O. G. 1121.

A motion to suppress testimony decided at final hearing may not be appealed separately, but may be considered by the appellate tribunal on appeal upon the main question.

Dyson v. Sand v. Dunbar v. Browne, 133 O. G. 1679.

The fact that on appeal from a decision on a motion to dissolve the Examiners-in-Chief have held that a party has a right to make the claims does not prevent the question being raised before the Examiner of Interferences at final hearing under Rule 130.

O'Brien v. Gale v. Limmer v. Calderwood, 133 O. G. 514.

It is evident that what Rule 130 requires is that the question of the patentability of the claims to the other party shall have been duly presented and prosecuted before the Primary Examiner, and it is therefore immaterial whether

this was done on a motion to dissolve or on a motion to amend.

Josleyn v. Hulse, 132 O. G. 844.

Where testimony must be considered in determining a motion to amend a preliminary statement, it is within the discretion of the Examiner to consider such testimony for the purpose of deciding the motion prior to final hearing. When in his opinion the conditions of the case justify an early adjudication of the questions raised, his decision should not be delayed.

Smith v. Ingram, 131 O. G. 2420.

Rule in accordance with the holding of the Court of Appeals in the decision in Podlesak and Podlesak v. McInnerney (120 O. G. 2127), and in Kilbourn v. Hirner and in Wickers and Furlong (129 O. G. 869).

Hopkins v. Newman, 131 O. G. 1161.

The question of the patentability of the issue will not be considered on an appeal on priority except under such special circumstances as would warrant the exercise of the supervisory authority of the Commissioner.

Hess v. Jorrissen v. Felbel, 131 O. G. 1419.

Rule 130 does not confer upon a party the absolute right to contest his opponent's right to a claim, but allows him to do so only when the objection urged against his opponents to make the claim do not apply with equal force to his own case.

Pym v. Hadaway, 131 O. G. 692; Anderson & Dyer v. Lowry, 89 O. G. 1861; Beckman v. Southgate, 127 O. G. 1254; Beckman v. Wood, 89 O. G. 480; Briggs v. Conley, 104 O. G. 1119; Cory v. Gibhart & Martin, Jr., v. Blakey, 115 O. G. 1328; Denton v. Parker, 98 O. G. 415; Goss v. Scott, 96 O. G. 844; Gally v. Burton, 120 O. G. 325; Horne v. Somers & Co., 129 O. G. 1609; Jenner v. Dickson v. Thibodeau, 116 O. G. 1181; Kilbourn v. Hirner, 128 O. G. 1689; Kempshall v. Sieberling, 110 O. G. 1427; Locke v. Crebbin, 124 O. G. 317; McGill v. Adams, 119 O. G. 1259; Miel v. Yough, 121 O. G. 1350; Read v. Scott, 101 O. G. 449; Ruische v. Sandherr, 105 O. G. 1780; Seeberger v Dodge, 113 O. G. 1415; Shallenberger v. Andrews, 1902 C. D. 246; Sobey v. Holsclaw, 119 O. G. 1922; Talbot v. Morrell, 99 O. G. 2955; Weintraub v. Hewitt, 124 O. G. 2534; Hopkin v. Cleal, 180 O. G. 1393.

The Examiner of Interferences has jurisdiction to decide at final hearing the question raised upon this motion, namely, whether "mixed paints" and "ready mixed paints" are goods of different descriptive properties, for the trade-mark statute provides for the determination of the question of the "right of registration to such trade-mark." The trade-mark statute gives much larger jurisdiction than the patent statute, which merely provides for the determination of the question of priority.

Lewis & Bros. Co. v. Phoenix Paint & Varnish Co., 131 O. G. 361.

The sole contention on this appeal is that the issue is not patentable to either party. The question has been before the Primary Examiner both *ex parte* and *inter partes*, and in each case he has held the issue to be patentable. Both the Examiner of Interferences and the Examiner in Chief upon appeal on priority have refused to recommend under Rule 126 that the claims be rejected as being without patentable novelty. Under these circumstances the question presented will be considered only under my supervisory authority for the purpose of correcting a manifest error.

Dixon & Marsh v. Graves & Whittemore, 130 O. G. 2374.

See note to Rule 122.

McNulken v. Bollee, 130 O. G. 1691.

Evidence considered (by Court of Appeals) and held to show that the application on which the patent was granted did not, as originally filed, disclose the invention in issue, and priority therefore awarded to the junior party.

McKnight v. Pohle, 130 O. G. 2069.

Evidence considered (by Court of Appeals) and held to show that the application on which the patent was granted did not, as originally filed, disclose the invention in issue, and priority therefore awarded to the junior party.

McKnight v. Pohle, 130 O. G. 2069.

A motion to suppress testimony calling for an examination of a large part of the record will be postponed to the final hearing.

Dyson v. Sand v. Dunbar v. Browne, 130 O. G. 1690.

We greatly doubt whether the affidavits in this record presented for the consideration of this court and controverting the sufficiency of disclosure found in the Weinwurm application in interference, could be profitably considered by this court. The question should come before us upon testimony taken in the interference proceeding. C. A. D. C.

Wickers and Furlong, 129 O. G. 2074.

Not every case comes within the provision of Rule 130, and until it is shown that it does, a party has no right to argue the question of the non-patentability of his opponent's claims before the Examiner of Interferences.

Pym v. Hadaway, 129 O. G. 2073.

Rule 130 was intended to cover those cases where it was contended that one party had a right to make the claims, but the other did not, and that therefore the latter was not entitled to the date of filing of his application as a date of conception and constructive reduction to practice of the invention in issue. The reasons given must not be applicable to both cases.

Pym v. Hadaway, 129 O. G. 2073.

Trade-marks.

Harne v. Somers & Co., 129 O. G. 1609.

After record judgment of priority in favor of O. and upon motion by B. the interference was reopened in order to permit him to urge under Rule 130 that O. had no right to make the claims of the issue.

Becon v. Otis, 129 O. G. 1267.

In Podlesak v. McInnerney, 26 App. D. C. 399, this Court has held that the question of the right to make a claim may sometimes be an ancillary question to be considered in awarding priority of invention.

Wickers v. Furlong v. McKee, 129 O. G. 869.

In cases 122 O. G. 2687 and 2688, it was decided that where a party makes a reasonable showing before the Examiner of Interferences of the inoperativeness of his opponent's device, and that showing does not extend to his own structure, he may be permitted to take testimony provided that the proposed testimony is of a character to justify such action. No reason appears for making any distinction between a case where a party alleges that his opponent's device is inoperative and one where it is contended that the opponent has no right to make the claim in issue. Such testimony should be permitted only under Rule 130.

Pym v. Hadaway, 129 O. G. 480.

It is believed that testimony consisting wholly of the opinion of expert patent lawyers as to the legal effect of claims should not be received.

Pym v. Hadaway, 129 O. G. 480.

W.'s preliminary statement failed to overcome the record date of H. and W. In response to our order to show cause why judgment should not be rendered against him W. moved

to dissolve the interference on the ground that H. and R. had no right to final hearing on priority under Rule 130.

This proceeding should be a part of the main case and not a separate proceeding. All relates to priority.

Hewitt v. Weintraub v. Hewitt & Rogers, 128 O. G. 1689.

An award of priority is also proper under Rule 130 of the Rules of Practice of the Office, where it is shown at the final hearing of an interference that the application of a party relied upon as evidence of invention at the date thereof does not warrant the claim in issue.

Martin v. Mullin, 127 O. G. 3216.

Interferences are for the purpose of determining the question of priority only. That the issue is not patentable to either party has no bearing.

In cases contemplated by Rule 130, however, a decision that the issue is not patentable to one party would necessarily result in a decision of priority in favor of the other party.

Dixon & Marsh v. Graves & Whitemore, 127 O. G. 1993.

Where the operativeness of an opponent's device or his right to make the claim is material to the right of a party to a patent, said party may urge the matter at final hearing before the Examiner of Interferences as a basis for his award of priority; but as a condition precedent to such right, the party must first present the matter upon a motion for dissolution or show good reason why such motion was not made and prosecuted.

Barber v. Wood, 127 O. G. 1991.

After the present motion to dissolve is disposed of petitioner may pursue his motion for an order permitting him to take testimony under the practice announced in Browne v. Stroud, 122 O. G. 2687, and Lowry & Crowley v. Spoon, 122 O. G. 2687.

Barber v. Wood, 127 O. G. 1991; operativeness and public use.

The Court of Appeals in the District of Columbia, in the case of Podlesak v. McInnerney (120 O. G. 2127), held that the question of the right of a party to make a claim may be an ancillary question to be considered in awarding priority of invention. In my decision in the case of Pohle v. McKnight (119 O. G. 2519), and of Kilbourn v. Hirner (122 O. G. 729), certain reasons are set forth why the question of the right to make the claims may be considered as a basis for an award of priority rather than a dissolution of the interference. Under the practice indicated above it was held that one of the parties had no right to make the claim

of the issue because its subject matter was not shown in the original application.

Emmet v. Fullagar, 124 O. G. 2179; citing Gallager v. Hien, 115 O. G. 1330; Laas & Sponenburg v. Scott, 122 O. G. 352; Podlesak v. McInnerney, 120 O. G. 2127; Pohle v. McKnight, 119 O. G. 2519; Kilbourn v. Hirner, 122 O. G. 729; Robinson v. Seelinger, 116 O. G. 1735.

We greatly doubt whether the affidavits in this record presented for the consideration of this Court and controverting the sufficiency of disclosure found in the W. application *in interference could be profitably considered by this Court.* That question should come before us upon testimony taken in the interference proceeding. (A. D. C.)

Wickers v. Furlong v. McKee, 124 O. G. 908.

The right of McKee to make the claims questioned by Wickers and Furlong will be given consideration as ancillary to the question of priority.

Wickers & Furlong v. McKee, 124 O. G. 908, citing Podlesak & Podlesak v. McInnerney, 120 O. G. 2127; Pohle v. McKnight, 119 O. G. 2519.

The right of Crebbin to make the claims corresponding to the issue may be urged at the final hearing.

Locke v. Crebbin, 124 O. G. 317.

The consideration of the question of patentability or right to make the claims will not be considered at the final hearing, where the moving party is in no case entitled to receive a patent on the subject matter.

Potter v. McIntosh, 122 O. G. 1721.

I am of the opinion that the question raised by this attack (sufficiency of disclosure) is one properly considered in determining the question of priority in those cases where a holding that a party is entitled to make the claim in issue results in a judgment against a party, who, if he be the true inventor, is entitled to a patent.

Kilbourn v. Hirner, 122 O. G. 729.

The question of the right to make a claim is reviewable, if at all, with the final decision in the interference and not upon interlocutory appeal.

Zimmermann v. Lamboni, 121 O. G. 2326.

No interlocutory appeal on decision affirming right to make claims, but an opponent's right to make claims "may" be questioned upon appeal from decisions upon priority of invention where a holding of right on the part of one party

to make the claims operates to deny a patent to another party who if such holding be in error is the first inventor.

Miel v. Young, 121 O. G. 1350. See also Noble v. Sessions, 1210 O. G. 1348.

The question of the right of a party to make a claim goes to the very foundation of an interference, for if the party has not such right the interference falls. If it be incorrectly held that such a party has a right to make the claim priority may be awarded to him and his adversary be deprived of a substantial right in that he is not given a claim where he necessarily is the prior inventor, his adversary never having made the invention. Manifestly that question should not be finally determined by the Primary Examiner who originally declared the interference.

Podlesak v. Podlesak v. McInerney, 120 O. G. 2127.

Where the question is appealed to the Commissioner on the question of priority, a motion to transmit the interference to the Primary Examiner to consider the question of patentability will not be granted unless a clear and unmistakable error appears in the prior decision.

Parker v. Lewis, 120 O. G. 323.

A decision of the Examiner of Interferences refusing to expunge testimony will only be reviewed at the final hearing.

Royce v. Kempshall, 119 O. G. 338; Greene, Tweed & Co. v. Manufacturers' Belt Hook Co., 132 O. G. 680.

Where the defeated party alleges public use, *held*, that the matter will not be considered until the decision on priority becomes final.

Doble v. Henry, 118 O. G. 2249.

Questions of patentability raised for the first time on appeal to the Commissioner refused consideration and brief on question stricken from the files.

Hedlund v. Curtis, 114 O. G. 544-5.

It has been the uniform practice not to suppress the testimony before final hearing.

Andrews v. Nelson, 111 O. G. 1038.

Motions requiring the whole case to be gone into will be considered only at the final hearing.

Hall v. Alvord, 101 O. G. 1833.

In certain cases it is better to postpone the consideration of questions relating to the suppression of testimony until final hearing. The present case is not one of these. The Examiner of Interferences' decision granting motion to strike out affirmed.

Brill & Adams v. Uebelacker, 99 O. G. 2966.

To pass upon the question of whether or not the evidence should be suppressed would require such a consideration of the very voluminous record in this case as will necessarily be given at the final hearing, and for that reason a final disposition of the matter should be postponed until that time.

Talbot v. Monell, 99 O. G. 2965.

If a witness refuses to answer a material question and no application is made to the U. S. Court, testimony will not be stricken out except preparatory to final hearing.

Independent Baking Powder Co. v. Fidelity Mfg. Co., 94 O. G. 223.

The pendency of a motion to dissolve before the Primary Examiner does not prevent the parties from bringing any other proper motion before the Examiner of Interferences.

Mechlin v. Horn, Colclazer & Munger, 92 O. G. 2507-8.

Where the question of priority has been decided without the suspension of an interference proceeding, the question of patentability of a claim involved in the interference will be considered not *inter partes,* but *ex parte* by the Primary Examiner.

Pell v. Pierpoint, 76 O. G. 1573.

Question of patentability refused consideration on final hearing in view of the fact that no motion was made under Rule 122.

Schnabel v. Shellaberger, 68 O. G. 658.

Priority of invention can not be awarded to an applicant whose device is inoperative.

Glidden v. Noble, 67 O. G. 676.

Where an applicant copied the claims of a patent, all the tribunals must pass upon the question of the right of applicant to make the claim.

Reichenbach v. Goodwin, 63 O. G. 311.

Where the Examiner of Interferences refused to consider a motion to strike out a wife's testimony and reserved the question until final hearing, *held,* on appeal to the Commissioner, that this was a proper subject for interlocutory action.

Crawford v. Lichenstein, 61 O. G. 1480.

In view of the obvious irregularities in declaring the interference, it is extremely difficult to render a decision on the question of priority.

The Examiner is directed to carefully consider the question of patentability of the issue and take such action as the case demands.

Mets v. Crane & Bloomfield, 58 O. G. 947.

It is the clear duty of the Office in such a case to decline

to further consider the question of abandonment of Y's application until the question of priority of invention shall have been determined, when unquestionably a much fuller light will have been shed upon the whole matter.

Young v. Case, 58 O. G. 945.

Where on final hearing before the Commissioner an interference is suspended and the case remanded to the Primary Examiner for consideration of the question of operativeness, this question will not be considered *inter partes*, but will be determined by the Examiner subject to the regular course of appeals in *ex parte* proceedings.

Archer, 57 O. G. 696.

Cases that pass on the subject matter of this rule:

Kilbourn v. Hirner, 128 O. G. 1689; Beelman v. Southgate, 129 O. G. 1254.

Rule 131. Prosecution or Defense by Assignee.

When, on motion duly made and upon satisfactory proof, it shall be shown that, by reason of the inability or refusal of the inventor to prosecute or defend an interference, or from other cause, the ends of justice require that an assignee of an undivided interest in the invention be permitted to prosecute or defend the same, it may be so ordered.

CONSTRUCTIONS.

The American Steam Boiler Cleaner Co.'s assignment, not containing any request, was not noted on the file, and the Examiners in declining to interfere, probably overlooked the assignment. even though there was no request to issue the patent to it, it had the right to prosecute this application. (See *ex parte* Hill & Hill, 206 O. G. 1437.)

Schreiber v. Bauer, 258 O. G. 813.

Interference between the joint application of G. and L. and the sole application of G. The assignee of L. allowed to appoint an attorney.

Gilbert v. Gilbert and Lindley, 160 O. G. 775; Churchill v. Goodwin, 132 O. G. 1838.

An exclusive licensee permitted to have full knowledge of proceedings so that it might intervene if any evidence of collusion appears.

The National Railway Materials Co., 129 O. G. 481.

A separate motion such as is provided for by Rule 131 is unnecessary where the assignee holds the entire interest.

Hastings v. Gallagher, 93 O. G. 189; Sotterhad v. Cornwall, 148 O. G. 1344.

The record shows L. has taken no action in the case and has not filed a preliminary statement, although the time for filing has expired.

The circumstances are such as to warrant permitting the assignee of an undivided part interest to prosecute the interference.

Lottridge v. Eustice, 121 O. G. 689.

The motion is proper where applicant has assigned one of two applications containing claims in common, one of which is involved in an interference.

Adams, 119 O. G. 650.

After an inventor has assigned his entire interest, he can not obtain copies of the files without giving a good reason.

Duncan v. Duncan, 109 O. G. 806.

No appeal lies from the refusal of the Commissioner to expunge certain assignments from the records.

Casey, 101 O. G. 2567. C. D. 1902-492.

A merely equitable assignee refused recognition, McPhail, 89 O. G. 521, however, copies of papers furnished so that proceedings might be watched and if necessary the equitable owner permitted to intervene.

Renier v. MacPhail, 89 O. G. 521, 1899 C. D. 196.

The assignee of an entire interest may prosecute an interference on behalf of the application of his principal who died while the interference proceedings were pending.

Chase v. Ryder, 1892 C. D. 219.

Rule 132. Claims of Defeated Parties after Interference.

Whenever an award of priority has been rendered in an interference proceeding by any tribunal and the limit of appeal from such decision has expired, and whenever an interference has been terminated by reason of the written concession, signed by the applicant in person, of priority of invention in favor of his opponent or opponents, the primary examiner shall advise the defeated or unsuccessful party or

parties to the interference that their claim or claims which were so involved in the issue stand finally rejected.

HISTORY.

Rule introduced in 1888. Discussion of rule in 56 O. G. 141.

Rule 130 of 1899 reads: "Amendments to the specification will not be received during the pendency of an interference, except as provided in Rules 106, 107, and 109."

CONSTRUCTIONS.

May have a generic claim though defeated in an interference.

Kahn, 241 O. G. 623.

The winning party is entitled to the full benefit of the judgment, but where he seeks to broaden his claims the testimony and the ground upon which the judgment is based must always be considered in determining to what limits the privilege of enlargement of the claims may be extended.

Little v. Armstrong, 232 O. G. 935.

The grant should not be refused of claims for common subject-matter to a party who loses an interference upon an interpretation of the issue too narrow to cover the common subject-matter when such party had in his application throughout the interference claims broad enough to cover the common disclosure and the prevailing party fails to make any such claim either during or after the interference and takes a patent limited to the specific feature which was held to be disclosed by him alone. Decision of the Board of Examiner in Chief, 232 O. G. 939.

The Primary Examiner may and should consider whether the differences between the counts awarded U. and those awarded L. are patentable when the case is returned to him at the end of this priority contest and refuse to L. such counts as are not patentably different from those awarded U.

Leewellyn v. Upson, 227 O. G. 367.

After judgment a party may amend so as to avoid the issues.

The Underwood Typewriter Co. v. The Stenotype Co. and cases cited. 191 O. G. 831.

It is unfortunate perhaps that the Patent Office Practice permits amendments by the successful party to broaden the scope of his claims after a final decision in interference upon

claims for the same invention of narrower scope. That question, however, is not before us.

Horine v. Wende, 129 O. G. 2885.

The rejection upon reference to an opponent in an interference is for new ground. Such ground having been found to exist and the claims of the issue having been rejected thereon under Rule 132, the Rules (65-68) and the statute (4903) heretofore noted gives applicant the right to amend in an endeavor to avoid such references. Said rules, for the reason stated, are considered applicable to this application rather than Rule 142.

Klepetko, 126 O. G. 388.

Final rejections are given under Rule 132 and in cases where division is required without closing the case to amendments.

Sanders v. Hawthorne v. Hoyt, 125 O. G. 1347.

The rejection under Rule 132 is to be considered as a rejection in an *ex parte* case upon a new ground, an applicant is entitled to request a reconsideration and to point out why the rejection is not proper.

Lyon, 124 O. G. 2905.

Where a party to an interference did not appeal from the adverse decision of the Examiners-in-Chief upon priority, so that under Rule 132 of the Patent Office the claims which were involved in that interference stand finally rejected, such party has no standing before the Court in the interference as to these claims.

Fowler v. Boyce, 121 O. G. 1014.

Where the successful party to an interference inserts broader claims and his patent issues containing these claims, *held,* that the defeated party may contest the issue of priority of invention as to the broad claims upon making a *prima facie* showing that he invented the broad issue prior to the date established by the successful party.

Wende v. Horine, 118 O. G. 1070.

Where testimony has been taken in an interference proceeding, *held,* that new and patentable counts should not be suggested to the parties by the Examiner before judgment of priority of invention.

Freeman v. Parks, 117 O. G. 276.

The question whether the petitioner is entitled to the allowance of the new claims presented should be determined by a considration of the principles announced in Corry & Barker v. Trout v. McDermoth, 110 O. G. 306.

Greuter, 116 O. G. 596.

Bar of prior invention by another established in an interference proceeding. The bar was therefore a new reason for rejection discovered and cited against the claim. The petitioner was entitled to amend in an effort to avoid this new ground. (*Ex parte* Harvey, 102 O. G. 621.)

Greuter, 116 O. G. 596.

Where an interference is dissolved neither party has a right to be heard upon the consideration of claims subsequently presented by the other party.

Meigs, Hughes & Stout v. Gerdon, 116 O. G. 184.

The Examiner can not require an applicant to insert or abandon certain claims in less time than established by law in an *ex parte* proceeding.

Hewlett, 108 O. G. 1052.

It is only the claims as they stand that are finally rejected, new and amended claims may be substituted.

Harvey, 102 O. G. 621-23.

A motion to extend time for taking appeal made on the last day of limit and set for hearing two days after refused by Examiner for want of jurisdiction. This was restored on motion.

Jean & Goode v. Hitchcock, 100 O. G. 3011-12, 1902 C. D. 342.

It would seem that the applicant would under the rules have the right of appeal from such a rejection—notwithstanding, etc.

Schüpphaus, 100 O. G. 2776, 1902 C. D. 339.

A claim can not be canceled from an application involved in an interference by the mere filing of an amendment to that effect.

Read v. Scott, 100 O. G. 449, 1902 C. D. 242.

It would undoubtedly lead to confusion to have the applications involved in an interference under the jurisdiction of the Examiner of Interferences subject to amendment and change before an independent tribunal of the Office.

Annand v. Spalckhaver, 97 O. G. 2741, 1901 C. D. 234.

This rule prohibits amendments canceling claims unaccompanied by a disclaimer or abandonment of the invention covered by them.

Curtis v. Marsh, 92 O. G. 1236, 1900 C. D. 127.

This rule was established for the purpose of imposing the duty of making a formal final rejection in the case of the defeated party to an interference proceeding, and not for the purpose of prescribing the extent and measure of that duty.

Booth, 56 O. G. 141, 1891 C. D. 107.

No claim should be allowed the defeated party which could by any latitude of construction be held to embrace matter common to the structure of both parties to the interference.

Booth, 56 O. G. 141, 1891 C. D. 107.

Pending an interference between application pending and patent inadvertently issued an amendment which does not come within the terms of Rules 106, 107, 109 will not be received or considered.

Bechman v. Johnson, 48 O. G. 673, 1889 C. D. 184.

This is a mere matter of regulation and does not deny the fundamental right of the applicant to prosecute his application by any suitable action thereon within the life of said application.

Reynolds, 24 O. G. 993, 1883 C. D. 56.

Amendments by B. and C. claiming the subject-matter claimed by D., but not relating to the issue in the pending interference are not within the prohibition of Rule 124.

Smith, 17 O. G. 447, 1880 C. D. 77.

APPEALS TO THE EXAMINERS IN CHIEF AND TO THE COMMISSIONER AND PETITIONS TO THE COMMISSIONER IN THE EX PARTE PROSECUTION OF APPLICATIONS.

Rule 133. Appeal to Examiners in Chief.

Every applicant for a patent, any of the claims of whose application have been twice rejected for the same reasons, upon grounds involving the merits of the invention, such as lack of invention, novelty, or utility, or on the ground of abandonment, public use or sale, inoperativeness of invention, aggregation of elements, incomplete combination of elements, or, when amended, for want of identity with the invention originally disclosed, or because the amendment involves a departure from the invention originally presented; and every applicant who has been twice required to divide his application, and every applicant for the reissue of a patent whose claims have been twice rejected for any of the reasons above enumerated, or on the ground that the original patent

is not inoperative or invalid, or if so inoperative or invalid that the errors which rendered it so did not arise from inadvertence, accident, or mistake, may, upon payment of a fee of $10, appeal from the decision of the primary examiner to the examiners in chief. The appeal must set forth in writing the points of the decision upon which it is taken, and must be signed by the applicant or his duly authorized attorney or agent.

CONSTRUCTIONS.

(1) RULE IN GENERAL.
(2) LACK OF INVENTION.
(3) ABANDONMENT.
(4) INOPERATIVENESS.
(5) COMBINATION.
(6) AGGREGATION.
(7) WANT OF IDENTITY.
(8) DIVISION.
(9) REISSUE.
(10) APPEAL TO BOARD AND TO COMMISSIONER.
(11) SECOND APPEAL.
(12) INTERFERENCE.
(13) APPEAL TO BOARD—AFFIDAVITS UNDER RULE 75—SUFFICIENCY OF.
(14) CRITICISM AS TO WORDING AND DESCRIPTION.
(15) CLEARNESS—FUNCTIONAL.
(16) LACHES.
(17) TWO CLAIMS DIFFERENT.
(18) REJECTION ON APPLICANT'S PREVIOUS PATENT.
(19) REFERENCES.
(20) ADDITIONAL CASES.

Rev. Stat., sec. 4909.

(1) *Rule in General.*

A refusal to grant a design patent on the specification presented appealable in the first instance of the Board.

Goldsoll, 189 O. G. 523.

An appeal is the proper remedy in case of a refusal to dissolve a trade-mark interference on the ground of non-interference in fact.

George & Backer Co. v. The Laffray & Herrman Co., 188 O. G. 1051.

Question as to whether applicant has shifted ground appealable to Examiner-in-Chief.

Fast, 172 O. G. 552.

Applicant appealed to the Board who reversed the Primary Examiner but suggested other references and recommended that the application be rejected thereon. The Examiner rejected it on said references. Appeal to the Board.

Motsinger, 143 O. G. 1110.

B. has appealed, but in his assignment of errors does not challenge the decision of the Commissioner on the question of priority of invention, "and to this extent he is presumed to have acquiesced in the decision against him." (Beehman v. Wood, 15 App. D. C.)

Beehman v. Southgole, 127 O. G. 1254.

We have carefully scrutinized these several rules and we perceive nothing in them that can by any fair and reasonable construction be held to be inconsistent with the provisions of the statute.

U. S. ex rel. Steinmetz, 104 O. G. 853.

Proper subject matter for design patent, question appealable to Examiners-in-Chief.

Proudfit, 10 O. G. 585, 1876 C. D. 202, changing the practice; Pressprich, 11 O. G. 195, 1877 C. D. 18; Stetson, 36 O. G. 343, 1884 C. D. 20; Schulze-Berge, 42 O. G. 293, 1888 C. D. 4; Groves, 89 O. G. 1671; Sherman & Harmes, 89 O. G. 2067; Hale, 92 O. G. 1437.

Rule does not enumerate mutually exclusive points of appeal in such sense that one must be wholly different from another. The subject matter of each appeal is the rejection of a claim and not the reasons upon which it was rejected.

Briggs, 75 O. G. 1854, 1896 C. D. 17.

Question of whether design has patentable merit is not subject matter for an interlocutory appeal.

Walter, 62 O. G. 1205, 1893 C. D. 26.

Questions involving the rejection of a claim are not reviewable on petition.

Tobie, 50 O. G. 992, 1890 C. D. 28; Kuhn, 58 O. G. 1256, 1892 C. D. 46.

From the judicial acts of the Examiner an appeal lies to the Board, from his executive acts the appeal is to the Commissioner.

Krake, 1869 C. D. 100; Morton, 1871 C. D. 169.

(2) *Lack of Invention.*

Where claims are rejected the appeal is to the Examiners-in-Chief.

Davis, 109 O. G. 1068.

The question of completeness of conception to constitute invention relates to the merits and is appealable to the Board.

Auerbach & Gubing v. Wiswell, 108 O. G. 289-90.

Pertinency of reference.

Kerr, 28 O. G. 95.

Novelty and utility.

Buchanan, 1879 C. D. 288.

As to whether application contains patentable subject matter.

Underwood, 1872 C. D. 120.

(3) *Abandonment.*

The abandonment referred to is of the invention. Questions as to abandonment of the application are reviewable on petition.

Mygatt, 184 O. G. 801.

Question of abandonment of invention appealable to Board.

Springer, 120 O. G. 2754.

Whether a reissue omitting the claims in interference is an abandonment of the invention disclosed therein is a question appealable to the Examiners-in-Chief.

Lattig & G. v. Dean, 111 O. G. 301.

Questions relating to the merits and to abandonment are appealable to the Examiners-in-Chief.

100 O. G. 3012.

(4) *Inoperativeness.*

The question whether certain elements necessary to an operative combination are brought into the claims is obviously one that relates to the merits.

Lawton, 172 O. G. 259; Du Montay, 1879 C. D. 195; Muhl, 1880 C. D. 117; Ferguson, 56 O. G. 1334, 1891 C. D. 143; Brisbane, 107 O. G. 109; Davidson, 120 O. G. 2753; Nenninger, 122 O. G. 1379.

(5) *Combination.*

A claim for an illegitimate combination, including diverse inventions, should be rejected and appeal taken to Examiners-in-Chief.

46 O. G. 1391, 1889 C. D. 100; 83 O. G. 593, 98 O. G. 2364.

Lack of patentable combination. Aggregation.
Ellis, 1876 C. D. 140; Pintsch, 1877 C. D. 43; Keith, 1876 C. D. 93.
Cases that pass on the subject matter of this rule:
Ellis, 1876 C. D. 140; Kuth, 1876 C. D. 93; Pintsch, 1877 C. D. 43; Barcellos, 1880 C. D. 4; Ketson, 1881 C. D. 40; Eastman, 57 O. G. 410, 46 O. G. 139, 1889 C. D. 100, 1891 C. D. 178; McClellan, 59 O. G. 1763, 1892 C. D. 125; Dodge, 125 O. G. 665.

(6) *Aggregation.*

Questions of aggregation appealable to the Examiner-in-Chief.
Baker, 1889 C. D. 232.
Baker, 1889 C. D. 232; Feucht, 88 O. G. 2066.

(7) *Want of Identity.*

The question as to whether or not an applicant is entitled to amend his trade-mark application, is a question of new matter reviewable on petition.
Benach, 197 O. G. 241.
New matter goes to Examiner-in-Chief.
Fadem & Berman, 155 O. G. 553; Thompson, 183 O. G. 781.
New matter not appealable to Board.
Edwards, 108 O. G. 1051.
If the Examiner is of the opinion that the amendment constitutes new matter he should reject the claims affected thereby, and appeal should be taken to the Examiners-in-Chief.
Smyth, 114 O. G. 762.
A petition asking that the Examiner be instructed that it is not proper to insist upon cancellation of alleged new matter is premature before the Examiners-in-Chief have decided that the amendment is of that character.
Schmidt, 110 O. G. 603.
Questions of "Claims involve new matter" or are "unfounded in the disclosure" appealable to Examiners-in-Chief.
Hoegh, 100 O. G. 453.
Amendments involving the departure of invention from the original disclosure raise no question for the Examiners-in-Chief, unless they consist of new claims, either in whole or in part, or unless they alter or enlarge the meaning of old claims.
Gabel, 55 O. G. 863, 1891 C. D. 65.

When the objection of new matter is that it is merely in the descriptive part of the specification or drawing and does not effect the scope of the claim, an interlocutory appeal lies to the Commissioner; but when new matter appears in or affects a claim the appeal lies to the Examiners-in-Chief.

Suler, 59 O. G. 1431, 1892 C. D. 112.

For want of identity with the invention originally disclosed.

McDougall, 1880 C. D. 147; Lanstrom, 1880 C. D. 118; Bennett, 35 O. G. 1004; Woodruff, 1880 C. D. 90; Howlett, 1902 C. D. 338; Chapman, 120 O. G. 2446; Nenninger, 122 O. G. 1397; Nicolin & Ochsenreiter, 56 O. G. 1565, 1891 C. D. 155; Turner, Van Beck & Brown, 56 O. G. 1708, 1891 C. D. 165; Burt, 49 O. G. 1986, 1889 C. D. 251; Teller, 113 O. G. 548, 97 O. G. 191; Courville, 96 O. G. 2061, 1901 C. D. 125.

(8) *Division.*

Cases that pass on the subject matter of this rule.

Hulbert, 1894 C. D. 1; Frasch, 109 O. G. 1338; Tuttle, 113 O. G. 1967; Teller, 113 O. G. 548; Richardson, 112 O. G. 1751; Barnes, 115 O. G. 247; Gally, 115 O. G. 802.

See notes to Rules 41, 42.

(9) *Reissue.*

The questions of inadvertence and laches in applying for a reissue will not be reviewed upon petition.

McCombs, 105 O. G. 2057.

Whether the facts set forth in the statement filed with a reissue application constitute inadvertence accident, or mistake is one pertaining to the merits, and is appealable to the Board.

Murphy & Atkinson, 56 O. G. 1449, 1891 C. D. 149.

(10) *Appeal to Board and to Commissioner.*

An appeal was taken both to the Board and to the Commissioner in person. The case was decided a second time by the Commissioners on appeal from the Board.

W. v. T., 101 O. G. 2825.

Applicant appealed to the Board in an interference matter, then concluded that he ought to have appealed to the Commissioner after time limited for appeal had expired. The petition to transfer appeal to the Commissioner was refused.

Beck v. Long, 100 O. G. 451.

(11) *Second Appeal.*

It is well settled that a second appeal fee is not required upon taking a second *ex parte* appeal to the Examiners-in-Chief from the rejection by the Primary Examiner of an Applicant's claims.

Cheney v. Venn, 125 O. G. 1703.

See also note to 146.

If new references are cited by the Examiner after appeal to the Board which references should have been cited before appeal, applicant will not be required to pay a second fee.

Dysart, 34 O. G. 1390.

(12) *Interference.*

A decision of the Examiner-of-Interferences refusing to enter judgment on the record is not reviewable in an interlocutory appeal.

Mulligan v. Tempest Salve Co., 119 O. G. 1924.

Questions of non-interference in fact are not appealable to the Board of Examiners-in-Chief.

Kaczander v. Hodges & Hodges, 118 O. G. 836.

Questions of patentability arising under Rule 109 should be reviewed, if at all, in the first instance by the Examiners-in-Chief.

Lemp v. Ball, 115 O. G. 249.

The question whether the Examiner was right in rejecting the claims under the provision of Rule 96 would not be considered upon this petition if the final rejection was regarded as regular.

Schulze, 114 O. G. 1550.

Interference decided adverse to G. for want of diligence on his part, D. being a foreign inventor, G. petitioned Commissioner to order a reconsideration. Refused. G.'s remedy is by appeal to the Examiners-in-Chief.

Gallagher v. Desprackels, 114 O. G. 973.

The Examiners-in-Chief called the Primary Examiner's attention to the fact that one of the parties to the issue apparently had no right to make a claim to one count of the interference. The Examiner dissolved the interference as to this count. Appeal should be to the Examiners-in-Chief.

Dittgen v. Parmenter, 107 O. G. 1098.

A denial of motion to amend under Rule 122 is appealable to

E. I. C., 101 O. G. 1831.

The decision on a motion of a party to an interference to

amend his application by inserting claims from his opponent's patent is appealable to the Board.

B. v. F., 99 O. G. 862-3.

Notice to dissolve an interference brought on various grounds among other interferences in fact appeal dismissed by Board because appealable directly to Commissioner. *Held,* as this question was involved with the right to make the claim that the Board should have decided it.

O. & P. v. C. v. R., 99 O. G. 670.

(13) *Appeal to Board—Affidavit Under Rule 75—Sufficiency of.*

Sufficiency of affidavit under Rule 75 a question of merits.

Hamby, 183 O. G. 1031.

As to whether said affidavit under Rule 75 must show diligence is appealable to Board.

Hamby, 182 O. G. 511.

Cases that pass on the subject matter of this rule.

Boyer, 49 O. G. 1985, 1889 C. D. 249; Donovan, 52 O. G. 309, 1890 C. D. 109; Foster, 105 O. G. 261; Marstetler, 118 O. G. 2250; Nordstrom, 115 O. G. 1327.

(14) *Criticisms as to Wording and Description.*

Whether the structure recited is sufficient to sustain the whereby clause is appealable to the Board.

173 O. G. 1081.

An appeal from a requirement of the Examiner that an alleged erroneous description should be inserted goes to the merits, and is appealable to the Board.

Braseir, 125 O. G. 2365.

The question of the propriety of defining an article by reference to its mode of manufacture seems to be one which may be considered properly by the Examiners-in-Chief in connection with the other questions of patentability.

Warren, 120 O. G. 2755.

The requirement that unnecessary matter be canceled from the drawing and specification of a design case is a mere ruling as to the form of the application and is not appealable to the Examiners-in-Chief.

Mygatt, 118 O. G. 1685.

The question as to the meaning of a word in claims held to go to the merits and to be appealable to the Examiner-in-Chief.

Beucher, 104 O. G. 310.

Objection that added element of one of several claims is

old and well known and does not patentably distinguish claim goes to merits.

101 O. G. 499.

Sufficiency of description appealable to Examiners-in-Chief.

Coe, 81 O. G. 2086, 1897 C. D. 187.

As to whether the drawing sufficiently illustrates the invention.

Kitson, 81 C. D. 49; Barcellos, 80 C. D. 4.

(15) *Clearness—Functional.*

The objection that claims are functional apparently appealable to the Board.

Stimpson, 160 O. G. 1271.

When the objection that a claim is functional, is appealable to the Commissioner and when to the Board.

Plumb, 131 O. G. 1165.

From the rejection of a claim because it is distinguished from the previous state of the art only by a functional limitation appeal in the first instance is to the Examiners-in-Chief.

Morgan, 101 O. G. 2568, 1902 C. D. 451.

Rejection under Rule 96 appeal to Board.

97 O. G. 192.

Rejections of functional claims are appealable to the Examiners-in-Chief.

Halfpenny, 73 O. G. 1135, 1895 C. D. 91.

Question as to functional claim relates to merits.

Williams, 61 O. G. 423, 1892 C. D. 213.

The question of "incomplete combination of elements," and an objection that a claim covers only the function of a machine, involves the merits and are appealable to the Examiners-in-Chief *in the first instance.*

McClellan, 59 O. G. 1763, 1892 C. D. 125.

An appeal from an objection that a claim is so lacking in clearness that no certain meaning can be gathered from it, is appealable to the Commissioner; but when the vagueness relates to the bounds of the invention the appeal lies to the Board.

Reynolds, 1874 C. D. 119.

(16) *Laches.*

A question as to the propriety of rejecting a claim presented after the time limited under Rule 96 is appealable to the Examiners-in-Chief.

Ex parte Swift, 111 O. G. 2494; *Ex parte* Post, 112 O. G. 1214; Myero v. Brown, 112 O. G. 2093.

Laches in applying and inadvertences are questions that may only be appealed to the Board.

McCombs, 105 O. G. 2057.

Where an applicant who has been in interference seeks, after a decision of priority in his favor, to amend his claims, and the Examiner rejects his amendment as covering matter which applicant has claimed too late, the question should go to the Examiners-in-Chief.

Woodward, 60 O. G. 1052, 1892 C. D. 179.

Neither the rules nor the law confer upon the Commissioner the dangerous power of determining what appeals seasonably made are intended for delay.

Pitney v. Smith & Egge, 49 O. G. 129, 1889 C. D. 193.

(17) *Two Claims Different.*

Whether two claims are patentably different is appealable to the Board.

Chapman, 120 O. G. 2446, 1902 C. D. 416.

Whether certain features are novel and claimable as such must be appealed to the Examiners-in-Chief.

Petzold, 55 O. G. 1651, 1891 C. D. 95.

(18) *Rejection on Applicant's Previous Patent.*

Where the Examiner rejects a claim as not patentable in view of the allowance to the applicant of another claim, *held,* that the remedy is by appeal to the Examiners-in-Chief and not by petition.

Besant, 116 O. G. 2531.

It being settled that it is proper in some cases to reject upon reference to applicant's allowed case, the question whether the particular rejection was proper goes to the Examiners-in-Chief.

Davidson, 93 O. G. 191, 1900 C. D. 163.

Where the Examiner holds that there is no proper line of division and rejects a claim upon the allowed case, the question whether his holding is correct relates to the merits and is appealable to the Examiners-in-Chief. It will not be reviewed upon petition.

Osborne, 92 O. G. 1797.

Where an application was rejected on a previously allowed application taken cumulatively with a patent and the applicant petitioned the Commissioner for relief from such action, the question was appealable to the Examiners-in-Chief.

Seymour, 65 O. G. 751, 1893 C. D. 127.

The question whether or not the Examiner should cite as

a reference an applicant's former patent, the application for which was co-pending with the present application, is one pertaining to the merits and not reviewable on petition.

McDonald, 64 O. G. 857, 1893 C. D. 99.

(19) *References.*

A dispute as to the date of a foreign patent cited as a reference will not be considered on petition.

Beck, 105 O. G. 1781.

(20) *Additional Cases.*

Cases that pass on the subject matter of this rule.

Bitner, 140 O. G. 256; Millett v. Reed, 125 O. G. 2764; Mygatt, 121 O. G. 1675; Beath, 111 O. G. 2220; Kinney, 110 O. G. 2235; Harvey, 102 O. G. 622; Story v. Criswell, 100 O. G. 683, 1902 C. D. 262; Holland, 99 O. G. 2548-49; Keith, 97 O. G. 551, 1901 C. D. 155; Myers, 64 O. G. 859, 1893 C. D. 103; Johnson, 89 O. G. 1341; Kuhn, 58 O. G. 1256, 1892 C. D. 46; Thomson, 56 O. G. 1203, 1891 C. D. 138; Laskey, 48 O. G. 539, 1889 C. D. 181; Warren, 12 O. G. 2755.

Rule 134. Prerequisites.

There must have been two rejections of the claims as originally filed, or, if amended in matter of substance, of the amended claims, and all the claims must have been passed upon, and except in cases of division all preliminary and intermediate questions relating to matters not affecting the merits of the invention settled, before the case can be appealed to the examiners in chief.

HISTORY.

The first sentence was in the Rules of 1869. The rest of the rule was added, substantially, in 1871. The words, "Not affecting the merits of the invention," were not in the Rules of 1871 or 1873, but are found in Rules of 1876.

CONSTRUCTIONS.

That the claim of the applicant for a patent shall have been twice rejected by the Primary Examiner is jurisdictional and a condition precedent to any right of appeal

whatever. Such rejection has not been made in this case, and it can not be substituted by an order of rejection.

Mann v. Brown, 214 O. G. 1026.

Where, after thorough discussion of references with an Examiner, an issue has been reached and the applicant has received a second rejection upon the same claims in view of the same references he has a right to appeal at the time, notwithstanding the fact that the Examiner did not designate his action as a final action.

McPhail, 141 O. G. 1162.

Whether the words used in the claims are objectionable as alternative must be settled before appeal taken.

Phillips, 135 O. G. 1801.

Whether words used in the claims are objectionable as alternative must be settled before appeal taken.

Phillips, 135 O. G. 1501.

Formal objections should be remedied before the appeal is forwarded.

Dodge, 125 O. G. 665.

Under Rule 134 appeal can not be taken until all formal questions relating to matters not affecting the merits of the invention have been settled.

Thomas, 124 O. G. 623; Dodge, 125 O. G. 665.

The Examiner was right in refusing to forward the case until formal objections were removed.

Mygatt, 111 O. G. 2493.

The Examiner can not reject finally a claim that has been amended in matter of substance in one action.

Slaughter, 105 O. G. 498.

Appeal can not be taken on a part of the claims rejected.

Benjamin, 103 O. G. 1680; Holland, 99 O. G. 2548-549, 1902 C. D. 199.

The amendment changed the wording of the claims and strictly construed they might be held to set forth features of construction not specifically included in the previous claims and therefore they can not be considered the same, although for the practical purposes of the examination the real invention is the same. Amendment entered and claims stand rejected.

Courville, 96 O. G. 2061, 1901 C. D. 125.

It is the fact of a second rejection and not the language of the letter that is material. However, the Examiners are instructed to state definitely that the rejection is final, hereafter. They may, however, reconsider the case after final rejection if it is advisable in their judgment.

Kendall, 93 O. G. 1754.

The refusal of the Examiner to forward to the Examiners-in-Chief an appeal taken from his action holding that an application was not a proper divisional application, *held*, to have been properly made. Petition under Rule 145 proper.

Fuller, 57 O. G. 1883, 1891 C. D. 243.

The setting forth of the points of appeal are not of the essence of the proceeding, and do not confer jurisdiction as in appeals to the Court of Appeals. If the statement is defective the opponent may demand a better statement.

Pitney v. Smith & Egge, 49 O. G. 129, 1889 C. D. 193.

The first letter did not state that the claims were rejected, but after calling attention to certain formal objections, he cited references anticipating the claims (see Siliman, 34 O. G. 1389). After the formal objections had been eliminated the applicant was advised the references were adhered to. These actions justified the applicant in believing that there were two rejections and the appeal held to be proper.

Mill, 40 O. G. 919, 1887 C. D. 92.

Under Rule 129 two rejections are necessary to give either the Examiners-in-Chief, or the Commissioner, appellate jurisdiction of an application.

Mill, 40 O. G. 919.

An example of the setting forth of points of appeal.

Huntly v. Smith, 1880 C. D. 182.

Reasons for appeal not necessary to confer jurisdiction. If reasons are insufficient opponent may move to correct.

Pitney v. Smith & Egge, 49 O. G. 129, 1889 C. D. 193.

Amendments in matter of substance are such changes as affect the nature of the subject matter of the claim by the addition, or omission of certain features, or elements changing the character of the invention as at first set forth, and which must amount to something more than a mere change of phraseology.

Winchester, 1880 C. D. 92. (Hammond, 1872 C. D. 149.)

Neither the Commissioner nor the Examiners-in-Chief should act upon a case unless the case is in condition to go immediately to issue if the Examiner is reversed.

Mewes, 72 C. D. 163.

The rule excludes all amendments, except special amendments after the case leaves the Examiner.

Hammond, 1872 C. D. 149.

Rule 135. Examiner's Statement of Grounds of Decision.

Upon the filing of the appeal the same shall be submitted to theprimary examiner, who, if he find it to be regular in form, and to relate to an appealable action, shall within ten days from the filing thereof furnish the exanniners in chief with a written statement of the grounds of his decision on all the points involved in the appeal, with copies of the rejected claims and with the references applicable thereto, giving a concise explanation of the invention claimed and of the subject matter of the references so far as pertinent to the appealed claims. The examiner shall at the time of making such statement furnish a copy of the same to the appellant. If the primary examiner shall decide that the appeal is not regular in form or does not relate to an appealable action, a petition from such decision may be taken directly to the Commissioner, as provided in Rule 142.

HISTORY.

This statement of the reasons of appeal should point out distinctly and specifically the supposed errors of the Examiner's action and should constitute a brief of the argument upon which the applicant will rely in support of his appeal. Before the appeal is entertained by the Board, this statement will be submitted to the Primary Examiner who will make answer in writing touching all the points involved therein. Rule 42 of 1873.

The provisions making the Primary Examiner the judge of whether or not the appeal is regular in form was inserted in Rules of December 1, 1879, and also the requirement of copies of the rejected claims and references applicable thereto.

CONSTRUCTIONS.

The statement should have been complete in itself and not have referred to the decision in another case previously considered by the Examiner-in-Chief unless the decision was

cited in support of some contention of law which could be understood without understanding the invention.

Morrison, 157 O. G. 1271.

After new grounds of rejection the Examiner offered to let applicant withdraw his appeal, which he did not do. Too late after appeal.

Blackmore, 140 O. G. 1209.

The practice of raising objections for the first time in the the statement upon petition is not approved. To entertain such objections upon the petition where argument is made by the applicant in opposition to them would impose upon the Commissioner labor which should be performed as far as possible by the Examiner. The additional objection will not be considered upon this petition. (Trade-mark.)

Jos. B. Funke Company, 124 O. G. 2902.

If the Examiner discovers a new reason for rejection he should direct the attention to it of both the applicant and the Examiners-in-Chief. The applicant may thereupon continue to prosecute the application as though the new reference had been cited before the appeal had been taken or he may continue the prosecution of the appeal. (Mevey, 56 O. G. 805.)

Williams, 116 O. G. 298.

Where an appeal is regular in form it is the duty of the Examiner to answer it.

U. S. ex rel. Steinmetz & Allen Com., 109 O. G. 549.

No appeal from reasons for a decision.

Gebboney, 105 O. G. 976.

It is improper for an Examiner to refer in his answer to matters not of record. If after appeal he shall discover new grounds for rejection he shall notify applicant and the Examiners-in-Chief.

Dolan, 99 O. G. 2321, 1902 C. D. 193.

It is improper for an Examiner to cite a decision of the appellate tribunal in a pending case to which applicant has not access.

99 O. G. 668,, 1902 C. D. 144.

Petition to expunge argumentative matter and new reasons of rejection from the Examiner's statement refused.

If the Examiner discovers new grounds for rejection after appeal, he should call the attention of both applicant and the Board to them. Applicant may then elect whether to continue the appeal or to withdraw the same and be heard by the Primary Examiner.

Mevey, 56 O. G. 805, 1891 C. D. 115.

The present rules do not require that the reasons of appeal shall constitute a brief of the argument upon which applicant will rely, but is only that the point or points of decision from which appeal is taken shall be specified.

Callahan, 50 O. G. 990, 1890 C. D. 24.

All the references and reasons should be recited at or before final rejection; but if from any causes important reasons or references shall be overlooked or omitted the attention of the appellate tribunal should certainly be called to them.

Parker, 36 O. G. 119, 1886 C. D. 15.

If new references or reasons are discovered by the Examiner after appeal taken, applicant should be promptly informed of them.

Parker, 36 O. G. 119.

If the appeal is taken the Examiner should not only urge his objections to the validity of the combination (the appeal being on this point), but also cite all references he may have affecting the question of novelty, whether relating to the alleged combination or to other matters claimed in the application.

Pintsch, 1877 C. D. 43.

The Examiner should not raise new objections in his statement

Shippen, 1875 C. D. 126.

The Examiners-in-Chief are the judges of the sufficiencies of the reasons for the appeal. The principal Examiner can not refuse to allow an appeal because the reasons are insufficient.

Young, 1875 C. D. 124.

The Examiner's objections should be definite, such as will allow of an issue being formed.

Evarts, 1871 C. D. 39.

Rule 136. Appeal from Examiners-in-Chief to Commissioner.

From the adverse decision of the board of examiners in chief appeal may be taken to the Commissioner in person, upon payment of the fee of $20 required by law.

Rev. Stat., sec. 4910.

CONSTRUCTIONS.

Amendment of the claims suggested and case remanded with authorization to the Examiner to admit the amendment and allow the claims.

Burnham, 172 O. G. 260.

The practice of submitting new claims to Commissioner on appeal disapproved.

Sears, 148 O. G. 279.

Apparently no appeal from refusal to make a recommendation under rule.

Ball v. Flora, 117 O. G. 2362.

In the exercise of his authority the Commissioner may assign an appeal to the Assistant Commissioner for hearing.

U. S. ex rel. Stapleton v. Com., 93 O. G. 2532, 95 O. G. 1049.

The statute and rules allow applicants two (now one) years in which to appeal to the Commissioner.

Williams & Raidabaugh, 40 O. G. 1337.

If applicant goes back to the Primary Examiner and amends his case he waives his right of appeal.

Williams & Raidabaugh, 40 O. G. 1337.

It has been the established practice of the Office where both the lower tribunals are agreed upon the facts, not to overthrow their decisions thereon unless clearly at variance with the testimony.

Walpuski v. Jacobsen & Faben, 1876 C. D. 114; Fawcett v. Graham, 1869 C. D. 113; Dickson v. Kinsman, 1880 C. D. 211; White v. Purdy, 1870 C. D. 115; Berry v. Stockwell, 1869 C. D. 47; Blanchard v. Stain, 1870 C. D. 55; Russell v. Scow, 1874 C. D. 23.

A case that passes on the subject matter of this rule.

Millett v. Reed, 125 O. G. 2764. See note to 68.

Rule 137. Oral Hearing Before Examiners in Chief—Briefs.

The appellant shall on or before the day of hearing file a brief of the authorities and arguments on which he will rely to maintain his appeal.

If the appellant desire to be heard orally, he will so indicate when he files his appeal; a day of hearing will then be fixed, and due notice thereof given him.

CONSTRUCTIONS.

A written certificate of counsel will not be stricken out as a supplemental brief.

Lindstrom v. Lipschutz, 120 O. G. 90.

Briefs on interlocutory motions and appeals need not be printed, but must be filed before the hearing.

Royce v. Kempshall, 116 O. G. 2011.

In all cases briefs should be filed before the hearing. Only one brief.

Newcomb & Lemp, 109 O. G. 2171.

Rule 138. Application Remanded for Reconsideration on Affidavits.

Affidavits received after the case has been appealed will not be admitted without remanding the application to the primary examiner for reconsideration; but the appellate tribunals may in their discretion refuse to remand the case and proceed with the same without consideration of the affidavits.

HISTORY.

Rule 135 of 1879 reads as follows: "If affidavits be received, under Rule 75, after the case has been appealed, the application will be remanded to the Primary Examiner for reconsideration."

In 1880 affidavits "under Rules 75 or 86" were specified.

In 1892 Rule 141 read as in 1879, except "under Rule 75" was omitted.

Present rule introduced in 1906.

CONSTRUCTIONS.

Apparently the fact that the Commissioner did not remand the case was equivalent to refusing to consider the affidavits.

Merrill, 199 O. G. 618.

When presented after final rejection or appeal affidavits or other new evidence should be accompanied by a verified showing of reasons for the delay, such as required by Rule 68, in the case of tardy amendments touching the merits of an application.

Pierce, 121 O. G. 1347.

It is a well-settled principle that no evidence should be considered on appeal that was not before the tribunal from

which appeal was taken. The affidavit referred to may have a material bearing. For this reason the case is remanded.

Penn Tobacco Co., 125 O. G. 2764, 1906 C. D. 523.

It is probable that in order to have it passed upon, the applicant should have requested that his application be remanded to the Examiner with leave to amend by inserting said claim. It could then have been brought up in regular order.

Garrett, 122 O. G. 1047, 1906 C. D. 645.

An affidavit has been filed in behalf of Townsend, by one Fredenreich, which is wholly expert in character. At the hearing a motion was made in behalf of Copeland to strike this affidavit from the record. It was argued that if the motion to reopen was granted the affidavit might form a basis for or necessitate the introduction of expert testimony. Motion granted.

Robinson v. Townsend v. Copeland, 106 O. G. 997.

Rule 139. Decisions of Examiners in Chief.

The examiners in chief in their decision shall affirm or reverse the decision of the primary examiner only on the points on which appeal shall have been taken. (See Rule 133.) Should they discover any apparent grounds not involved in the appeal for granting or refusing letters patent in the form claimed, or any other form, they shall annex to their decision a statement to that effect with such recommendation as they shall deem proper.

Should the examiners in chief recommend the refusal of letters patent in the form claimed, their recommendation will stand as a rejection and will reopen the case for amendment or showing of fact, or both, before the primary examiner, responsive to that rejection. The recommendation of the examiners in chief is binding upon the primary examiner unless an amendment or showing of facts not previously of record be made which, in the opinion of the primary examiner, overcomes the recommendation. The ap-

plicant may waive the right to prosecution before the primary examiner and have the case reconsidered by the examiners in chief upon the same record, and from an adverse decision of the examiners in chief on reconsideration, appeal will lie to the Commissioner, as in other cases. The applicant may also waive reconsideration by the examiners in chief and appeal directly to the Commissioner.

Should the examiners in chief recommend the granting of letters patent in an amended form, the applicant shall have the right to amend in conformity with such recommendation, which shall be binding upon the primary examiner in the absence of new references or grounds for rejection.

If the Commissioner, in reviewing the decision of the examiners in chief, discovers any apparent grounds for refusing letters patent not involved in the appeal, he will, before or after decision on the appeal, give reasonable notice thereof to the applicant; and if any amendment or action based thereon be proposed, he will remand the case to the primary examiner for consideration.

Rev. Stat., secs. 482 and 4909.

CONSTRUCTIONS.

(1) RULE IN GENERAL.
(2) DECISION CONFINED TO ISSUE.
(3) RECOMMENDATIONS.
(4) PRIMARY EXAMINER.
(5) ADDITIONAL CASES.

(1) *Rule in General.*

As these claims were presented as a substitute for the appealed claims, the decision of the Examiner-in-Chief will be affirmed, and if the amendment containing proposed claims two and three, corrected as above indicated, is presented within 20 days from the date hereof, the Examiner is authorized to

enter it and allow the claims in the absence of further references.

Child, 231 O. G. 919.

It is well within the jurisdiction of the Commissioner to order a dissolution of the interference and the rejection of plaintiff's claims if convinced that the issues were barred by public use and therefore not patentable. From the decision of the Primary Examiner rejecting plaintiff's claims when the case goes back from the Board of Examiners-in-Chief plaintiff would have an appeal through the tribunals of the Patent Office to this court.

U. S. ex rel. Dwiggins v. Ewing Com. of Patents, 214 O. G. 1025.

If a new reference is cited the case should be reconsidered by the Primary Examiner.

Wade, 158 O. G. 704.

In the absence of one member of the Board, a decision by the other two constitutes a decision by the Examiners-in-Chief. If the two disagree, the case should be set down for hearing before the three.

Hilbig, 131 O. G. 1687.

New reference found after appeal in view of this fact, final judgment on the appeal will be suspended for 30 days. If an amendment or other action is filed, the case will be remanded to the Primary Examiner for further consideration. If no action is taken the right to amend will be regarded as waived, and a decision, considering the new reference, will be given. If the applicant does not desire to amend a rehearing of the appeal will be granted for argument on the new reference if desired.

Farling, 128 O. G. 886.

No decision upon patentability against any of the parties can be founded on the testimony taken upon the question of priority without permitting such parties to offer further evidence if they so desire.

Niedringhaus v. Marquard v. McConnell, 118 O. G. 1683.

An appeal includes only such claims as have been duly entered in the case.

Durafort, 110 O. G. 2017.

If only two members are present and these have opposite opinions, the Primary Examiner is affirmed.

91 O. G. 2207.

The Board of Examiners-in-Chief is a tribunal of appellate and not original jurisdiction. The principle Examiner can not submit a question to it without expressing an opinion.

Coleman, 1880 C. D. 205.

The third and fourth paragraphs are designed to secure the applicant from the effect of a final adjudication of his application upon ground of which he has had insufficient notice.

Reynolds, 24 O. G. 993, 1883 C. D. 56.

The applicant is entitled to an opinion which shall embody the judicial opinion of the Examiners-in-Chief.

Buchanan, 79 C. D. 288.

The Board may affirm the decision of the Examiner while it may discard entirely the adequacy of his reasoning.

Jones, 1874 C. D. 53; Rockwell, 1870 C. D. 111.

The board should give the reasons for their decisions in all cases

Chamblant, 1873 C. D. 119; Buchanan, 288.

(2) *Decision Confined to Issue.*

The alleged grounds seem to have been disregarded, and the appeal received upon the real or substantial grounds. Evidence not before Primary Examiner considered.

Harrison v. Shoemaker, 117 O. G. 1164.

An appeal in the Patent Office is analogous to an appeal in equity and not to writ of error, the whole case may be examined *de novo*.

Packard v. Sandford, 79 C. D. 314; Dickson v. Kinsman, 80 C. D. 211.

In an interference case appealed to the Board on the question of priority, it is improper to go into the question of identity of invention.

Brown v. La Dow, 1880 C. D. 199.

The Primary Examiner not having alluded to the question of new matter, the Examiners-in-Chief should have confined their action to the making of the statement to the Commissioner, as the rule provides.

Smoot, 1877 C. D. 51.

The Board cannot go outside of the record . . . as to cite new references.

Jones, 1874 C. D. 53.

As to matter of executive detail.

Rockwell, 1870 C. D. 111; Merton, 1871 C. D. 169.

The Board of Examiners-in-Chief are not confined in their decision to affirming, or reversing, the reasons for rejection given by the Primary Examiner.

Jones, 1874 C. D. 53; Rockwell, 1870 C. D. 111.

Remarks disparaging the character of the invention are of doubtful propriety.

Morse v. Clark, 1872 C. D. 58; Cheesborough, 1869 C. D. 18.

(3) *Recommendations.*

Had they so intended, they would have annexed a recommendation to this effect to their decision.

Norhind, 192 O. G. 989.

Where the Examiner-in-Chief recommended that certain claims be rejected upon new grounds stated by them, *held,* that the action of the Examiner in rejecting the claims upon the return of the case to him, for the reasons stated in the decision of the Examiner-in-Chief, was clearly a proper one, and since it was a new ground of rejection it opened the case for further prosecution as to the subject-matter of rejected claims.

Luten, 170 O. G. 482, citing Dietrich, 142 O. G. 568.

The recommendation is binding on the Primary Examiner.

White, 157 O. G. 1243.

Practice analogus to that under Rule 126 as set forth in Holz v. Hewitt. The Examiner is therefore directed to enter a rejection *pro forma* upon the grounds stated by the Examiners-in-Chief, and any other reasons which have not been considered by the Examiners-in-Chief.

Shaw, 131 O. G. 1687.

The suggestion of claim by the Examiners-in-Chief does not reopen the case for the admission of other claims.

Myers, 119 O. G. 902.

If the Examiners-in-Chief had concluded that amendment was proper and necessary to protect the invention set forth in the claims before them, it is to be presumed that they would have made a recommendation to that effect.

East, 116 O. G. 1186.

They made no recommendation under Rule 139 as they presumably would have done if they thought applicant was entitled to other claims.

Bourne, 110 O. G. 2510.

The Examiner is justified in holding that a case is beyond his jurisdiction when his ruling rejecting a claim has been affirmed on appeal unless the Examiners-in-Chief annex a specific recommendation to their decision.

LeBlanc, 98 O. G. 225.

If the Board recommend amendment of the drawings and specification, such amendments may be made, but not others.

Beck, 97 O. G. 2746.

It is proper for the Examiners-in-Chief to make a suggestion to that effect, when on the consideration of claims on appeal they become convinced that the applicant has made an invention, but has claimed it in a wrong form.

97 O. G. 1175.

The interpretation adopted by the Board in a collateral matter, as for example the mode of operation of the device is not binding upon the Primary Examiner.

Ex parte Christensen, 92 O. G. 1619.

It is not competent for the Board to recommend that an application for a process be changed to an application for an apparatus.

Adams v. Murphy, 91 O. G. 2373, but see case on rehearing, Adams v. Murphy, 91 O. G. 2209.

Such statement and recommendation can not be ignored or pleaded as of no effect. It is binding upon the Examiner and can not be disregarded.

Letellier, 81 O. G. 1611, 1897 C. D. 171.

A decision by the Examiners-in-Chief affirming a rejection by an Examiner, subject to certain recommendations made by them, is such an affirmance of the Examiner's decision that a petition to the Commissioner asking "that a record decision affirming the patentability of the invention in issue may be entered" will not lie.

McGowan, 1892 C. D. 168, 60 O. G. 735.

No appeal from a refusal of the Examiners-in-Chief to make a recommendation.

Schmiedl v. Walden, 1891 C. D. 150, 56 O. G. 1563.

The recommendations of the Examiners-in-Chief are not binding upon the Primary Examiner, but there is no good reason why an applicant should be put to the delay involved in going through a second appeal, simply to have the Examiners-in-Chief formally affirm what they have already decided in substance.

Williamson, 56 O. G. 1060, 1891 C. D. 128.

The Examiner may not allow amendments without the authority of the Commissioner after the decision of the Examiners-in-Chief.

Williams & Raidabaugh, 40 O. G. 1337.

An example of recommendation by the Board.

Dod v. Cobb, 1876 C. D. 196.

The authority of the Board extends to passing upon the merits of claims merely as they come from the Primary Examiner. It is also proper for them to make suggestions of alterations in either the specifications or claims, or with ref-

erence to other matters which may appear to them to be of importance either to the Office or to the applicant, and they would be derelict if they did not, but such suggestions have no binding force.

Dodge, 1872 C. D. 202.

(4) *Primary Examiner.*

If the Board and the Primary Examiner disagree, the case should be referred to the Commissioner, but not if amendments have been made.

Allen, 109 O. G. 1071.

When a case is sent back to the Primary Examiner with the recommendation of the Board, the Examiner must confine his decision to the point suggested by the Board.

Kirkbride, 1876 C. D. 123.

When a case is appealed to the Board the Examiner loses control over it, except to enter the amendment required by the Board. He can not require further amendments.

Brunner, 1872 C. D. 62.

(5) *Additional Cases.*

Cases that pass on the subject matter of this rule.

Duryea & White v. Rice, 123 O. G. 2627; Myers, 122 O G. 351; Steinmetz, 117 O. G. 901; Burrowes, 110 O. G. 599.

Rule 140. Rehearings.

Cases which have been heard and decided by the Commissioner on appeal will not be reopened except by his order; cases which have been decided by the examiners in chief will not be reheard by them, when no longer pending before them, without the written authority of the Commissioner; and cases which have been decided by either the Commissioner or the examiners in chief will not be reopened by the primary examiner without like authority, and then only for the consideration of matters not already adjudicated upon, sufficient cause being shown. (See Rule 68.)

CONSTRUCTIONS.

History reviewed.

Daniels v. Morgan, 1889 C. D. 150, 47 O. G. 811, 1889 C. D. 182.

Mandamus will not lie to compel the Commissioner to reopen an interference.

Briggs v. Commissioner, 257 O. G. 645 and 648.

Rehearing petition for 201 O. G. 569.

New information from client after appeal. A new trial not granted.

Wright, 193 O. G. 509.

An interference dissolved because of inoperativeness of one of the party's device not *res adjudicata.*

Moore Co. v. U. S., ex rel. Colburn Gloss Co., 191 O. G. 293.

A judgment against an applicant in a trade-mark case, precludes a new application.

Bostion Wine & Spirits Co., 189 O. G. 524.

A mistake as to the attitude of a witness toward a party is not such an excuse for not calling him as would justify reopening of the case to take his testimony.

Webber v. Wood, 184 O. G. 553.

There is no rule of the Patent Office providing for petitions for new trial or review, but the power to entertain such petitions and reopen the case has been exercised in the Office in two former instances.

Cooper and Somers v. Bannester, 112 O. G. 1480; Griffiths v. Taylor, 91 Ms. A. D. 1908.

The right assumed to exist, however.

Browne v. Dyson and Sand, 173 O. G. 866.

An interference between B. D. and L. I. did not appeal. After time for appeal had expired, D. conceded priority to L. and the case was reopened and judgment rendered in favor of L.

Browne v. Browne Dyson & Land, 173 O. G. 866.

Whether or not a ruling that the year begins to run at a certain date is correct or not will not be considered until the application is held to have been abandoned unless the error is clear.

Inman, 160 O. G. 1038 (149 O. G. 309).

A rehearing on the grounds that the tribunal was not informed as to the state of the art will not be granted because it was petitioner's duty to see that it was so informed.

White v. Powell, 160 O. G. 776.

Rehearing of an appeal will not be granted to present matter not presented to the Primary Examiner.

White v. Powell, 160 O. G. 776.

A rehearing peculiarly within the discretion of the Examiner of Interferences.

Denlap v. Creveling v. Rector, 160 O. G. 776.

Counsel considered evidence as proper rebuttal matter, when it was refused as not proper; rebuttal motion was made to open case for the purpose of extending the time to take testimony . . . is not an appealable question.

Goodfellow v. Jolly, 115 O. G. 1064; Christenson v. McKenzie, 117 O. G. 277; Wickers and Furlong v. Weinwurm, 129 O. G. 2501; California Fruit Canners Association v. Raticliff-Sanders Grocer Co., 146 O. G. 958.

An applicant who prosecutes broad claims to a final conclusion has no right to the reopening of the case for the insertion of narrower claims. Snow, 80 O. G. 1271. And after a decision by the Court of Appeals new claims may not be admitted because the appellate tribunal put an unexpected construction upon the claims.

Millans, 135 O. G. 1122.

An interference decided against a party who afterward found he had an earlier application in the Office which would have altered the result apparently. A petition to withdraw such case from issue for the purpose of an interference refused, and an interference refused on a renewed application after that one had lapsed.

Cutler v. Hall, 135 O. G. 449.

The Court of Appeals having held that a second interference involving claims differing only in scope from those involved in the first interference should not have been declared, the latter will not be reopened for the purpose of allowing the issue of second interference to be contested therein.

Wende v. Horine, 130 O. G. 1311.

That a patent showing the invention was issued to one of the contestants in an interference proceeding, will not warrant a rehearing.

Latshaw v. Duffy v. Kaplan, 130 O. G. 980.

The granting of a rehearing or a refusal to grant the same are matters within the discretion of the tribunal having jurisdiction of the case at the time, and it is a well-settled principle that the Commissioner will not control that discretion except to prevent irreparable injury.

Donning v. Fisher, 125 O. G. 2765.

If the interference is to be reopened at all it should be done at once and not delayed until appellant has had an opportunity to test the sufficiency of the present record before the various tribunals.

Newell v. Clifford v. Rose, 125 O. G. 665.

It appears that the Commissioner of Patents, under the provisions of Rule 143 of the Patent Office which does not prescribe a specific time within which an appeal may be taken from a decision of the Examiner of Interferences, and under the provisions of Section 4904 of the Revised Statutes, which prescribes that certain appeals may be taken within such time as the Commissioner of Patents may prescribe, "not less than 20 days," fixes the time for appeal in this case at 20 days.

Wenzelmann v. Oeerholt, 123 O. G. 995.

No cause for surprise if a rehearing is not granted so as to excuse taking an appeal within the time limit.

It is well settled that a mere request for a rehearing does not extend the limit of appeal.

Felsing v. Nelson, 122 O. G. 1722.

An interference case will not be reopened for the introduction of testimony which can only result in a denial of a patent and not in altering the result as to priority.

Dunbar v. Schellenger, 121 O. G. 2663.

The question of abandonment of an application decided by a former Commissioner will not be reviewed except upon a clear and satisfactory showing that the Commissioner was misled by the applicant, as to the facts, and mere expert affidavits can not be regarded as such showing.

Kinsman v. Strohm, 120 O. G. 2127.

An interference which has been reopened to admit deposition connecting an exhibit with original testimony will not be again reopened to correct said deposition.

Autenrieth & Kane v. Sorensen, 120 O. G. 1164.

If a second application is presented in place of one rejected it should be examined far enough to ascertain its nature and then rejected as *res adjudicata.*

Millitt and Ried, 128 O. G. 2836; Kenney, 118 O. G. 2936; Com. of Pat. v. Whitely, 71 U. S. Sup. Ct.

No amendment allowed between appeals. It is fundamental that the same case must be presented to the higher tribunal as was considered by the tribunal from which the appeal is taken.

Marks, 118 O. G. 2253.

The doctrine of *res adjudicata* applies to the decisions of

this Office as well as to decisions of the Courts. The new application should be received and rejected for above reason.

Kinney, 118 O. G. 2253.

Where it is alleged that there was error in the Examiner's decision because of a misunderstanding as to an oral waiver made at the hearing, *held,* that the error must be corrected by motion for rehearing promptly made and that it can not be corrected long after the limit of appeal has expired.

Hansen v. Wardwell, 116 O. G. 2008.

An applicant has no right to amend after decision on appeal except under unusual circumstances and where a proper showing is made.

Amer, 116 O. G. 595; Lesler, 117 O. G. 595.

An interference will not be reopened after decision upon an *ex parte* request of one of the parties, but only upon motion served upon the opposing party and supported by a showing of good reasons.

Smith v. Locklin, 116 O. G. 2009.

There is no appeal from a decision refusing to grant a rehearing.

Cole v. Zarbock v. Greene, 116 O. G. 1451.

Where a decision is rendered by a tribunal and it appears that an affidavit relating to the matters at issue was filed too late to be considered, *held,* that the appellant should move for a rehearing, rather than appeal, since matters not considered by the tribunal of original jurisdiction will not be reviewed on appeal.

Ocumpaugh v. McElroy, 115 O. G. 1847.

Case will not be reopened to take further testimony when it appears that the testimony already taken relates wholly to the right of the opposing party to make claims.

Osborn v. Austin, 115 O. G. 1065.

If there is error it should have been corrected by rehearing or by appeal. The decision has become final by the expiration of the limit of appeal, and it is now too late to raise the question of error, even by concession of priority by the successful party.

Humphrey v. Fickert, 115 O. G. 803.

A motion for a new trial is proper pending an appeal.

Clement v. Richards v. Meissner, 111 O. G. 1627.

The applicant is not entitled to demand consideration of new claims after appeal, whether they are patentable or not.

Bourne, 110 O. G. 2510.

The fact that a party failed to recollect certain facts is an insufficient reason for a new trial. Moreover the alleged new

evidence must be sufficient so that is might produce a different result.

French v. Halcomb, 110 O. G. 1727.

If the Examiners-in-Chief recommended the rejection of a claim upon a reference not cited by the Primary Examiner and the Primary Examiner adopts such suggestion, the applicant has a right to amend.

Burrowes, 110 O. G. 599.

Examiner extended limit of appeal upon the showing that applicant was a resident of England.

Wilderman v. Simm, 109 O. G. 275.

Where a motion to vacate a judgment of priority is not based upon newly discovered evidence, the question of primary importance is why the facts were not sooner presented by proper motion.

Fowler v. Boyce v. Temple et al. v. Dyson v. McBerty, 107 O. G. 543.

After a case has been decided by the Court of Appeals it must ordinarily be regarded as disposed of.

Starkey, 105 O. G. 745.

It is the practice not to grant hearings upon petitions to reopen an application after the same has been considered and disposed of on appeal.

Borton, 104 O. G. 851-2.

No appeal lies from a refusal of a lower tribunal to grant a rehearing.

Reynolds v. Bean, 101 O. G. 2821.

Refusal to rehear is not an appealable action.

Macey v. Laning v. Caster, 101 O. G. 1608.

A delay of six months with failure to show reasons of delay, or that rierparable injury will be the result of a refusal. Petition denied.

Harrison, 100 O. G. 3013.

Newly discovered evidence—a new trial for must show greatest diligence. Where a letter was found which had been wrongly labeled and therefore overlooked. New trial denied.

Robinson v. Townsend v. Copeland, 100 O. G. 683.

It is not the practice of the office to set for hearing motions for rehearing unless an examination of the record shows that a rehearing ought to be granted.

Adams v. Murphy, 91 O. G. 2373.

It is within the discretion of the Commissioner to refuse to reconsider a matter upon a new application.

Fay v. Com., 90 O. G. 1156.

Manifest error in law, being ground for a new trial, is also ground for a rehearing under Rule 144.

Green v. Hall v. Siemens v. Field, 1889 C. D. 161, 47 O. G. 1631, c. c. 1889 C. D. 110-156, 88 O. G. 459, 81 O. G. 2087.

The Court of Appeals has several times considered and denied the right of an applicant to burden the office with successive applications relating to the same supposed invention.

Barratt, 87 O. G. 1075; Fay, 90 O. G. 1157; Mond, 91 O. G. 1437; Nealon, 1897 C. D. 174, 81 O. G. 1787.

The Examiner can not, under the rules, after a decision of the Examiners-in-Chief, admit even allowable claims, unless such claims are recommended by the Examiners-in-Chief, without written authority from the Commissioner.

Hunter, 1897 C. D. 161, 81 O. G. 504.

Where on appeal only broad claims were presented which were refused, *held*, that the case should not be reopened to admit narrow claims.

Snow, 1897 C. D. 48, 80 O. G. 1271.

Rehearings should not be lightly granted or sought without weighty reasons.

Atwater, 1897 C. D. 36, 80 O. G. 965.

A new trial allowed after two years, and after patent issued.

Hibbard v. Richmond, 80 C. D. 136.

To a motion for a rehearing diligence is a prerequisite.

Wicks v. McAvoy, 80 C. D. 190; Aldrich v. Bingham, 71 C. D. 90; Covel v. Maxim & Radley, 69 C. D. 78; Munson, Imlay, etc., 72 C. D. 183; Stevens v. Putnam, 80 C. D. 160.

Evidence which is merely cumulative is insufficient to warrant a new trial.

Stevens v. Putnam, 80 C. D. 160.

Misstatements in an argument are not grounds for a new trial.

Wicks v. McAvoy, 80 C. D. 190.

On motions for a rehearing the question of fact always is, whether the findings of fact in the former decision are either wholly unsupported by or clearly in conflict with the evidence.

Packard v. Sandford, 79 C. D. 314; Huttner v. Knox, 79 C. D. 247.

Except upon a new state of facts or upon grounds which would support a motion for a new trial.

Lee v. Walsh, 79 C. D. 29; Huttner v. Knox, 79 C. D. 281; J. L. Mason, 70 C. D. 20.

A motion for a rehearing can not be entertained after the case adjudicated has been amended by the removal of one or more of the claims.

Hoffman, 79 C. D. 247.

Cases that pass on the subject matter of this rule.

Atwood, 162 O. G. 1183; Bitner, 140 O. G. 256.

Rehearings are not favored in any case, and only upon special circumstances. Motion for rehearing will not be entertained where there has been long delay in bringing it. Rehearings must be applied for within the limit of appeal.

Messinger, 78 O. G. 1903, 1897 C. D. 1.

A motion for a rehearing will not be entertained by the Commissioner for the purpose of enabling an applicant to make a further presentation of his case when there is no satisfactory showing, but that he might have done so in the first instance.

Atley, 1892 C. D. 38, 58 O. G. 1091; Jerome, 1892 C. D. 29, 58 O. G. 945.

A rejected application for a patent, pending on appeal in the Supreme Court of the District of Columbia, is not open to review by the Commissioner of Patents.

Jerome, 1892 C. D. 29, 58 O. G. 945.

Where a party misjudged his proper line of defense a new trial will not be granted on that account.

Spielman, 1892 C. D. 1, 58 O. G. 141.

A motion for rehearing ought to be governed, as far as practicable, by rules which in Courts govern new trials.

Spielman, 1891 C. D. 162, 56 O. G. 1707.

A case will not be reopened that has been decided by the Assistant Commissioner merely because the applicant wants a hearing by the Commissioner himself.

Hughes, 891 C. D. 148, 56 O. G. 1448.

Motions for rehearings by parties to an interference should be heard at one time.

Green v. Hall v. Siemens v. Field, 1889 C. D. 156, 47 O. G. 813.

An applicant by appealing his case waives his right to move for a rehearing, even if the appeal is unauthorized.

Gill v. Scott, 29 O. G. 949.

A notice in the following words, "Limit of Appeal ten days," should be taken as ten days from the receipt of the notice.

Pearson v. Lister v. Reixach, 1883 C. D. 119, 24 O. G. 1175.

As I understand the decision of the Honorable, the Secretary of the Interior in the case of Manz v. Swab v. Cherry, dated February 24 and May 29, 1883, a motion for reopening a case or for a new trial in this office is not to be determined by the same rules which obtain in courts of law, and even if there was such laches as would prevent a new trial at law, still if the new evidence is such as would change the result it should be admitted in a new trial.

Eccard v. Drawbaugh, 1883 C. D. 50, 24 O. G. 301.

It is an established rule in the Office that a rehearing in a case will only be granted on such a showing of the merits as would entitle a mover to a new trial in a suit at law.

Dod v. Cobb, 1876 C. D. 196; Hovey v. Muller, 1873 C. D. 26; Pattee v. Russell, 1872 C. D. 255; Marsh v. Dodge, 1876 C. D. 245; Wicks v. McAvoy, 1880 C. D. 136; Spielman, 1891 C. D. 162, 56 O. G. 1707.

A and B, application is in interference with C. C fails to comply with the rules of the office, and a patent is demanded by and granted to A and B by default. C proves to have been the prior inventor. A and B buys C's rights. A rehearing refused as all rights were lost by laches of C.

Jones v. Greenleaf, 1879 C. D. 23, 15 O. G. 560.

Where default is made a new trial will be more readily granted.

Loring v. Hall, 1879 C. D. 8, 15 O. G. 471.

A case will not be reopened on the ground of newly discovered evidence, when the matter constituting the new evidence is not affirmatively set out in the affidavits.

Dodd v. Cobb, 1876 C. D. 196; Pattee, 1872 C. D. 255.

The new evidence must be such as could not have been produced on the former trial.

Merrill & Merrill v. Glidden, 1876 C. D. 243; Kenyon v. Wesson, 1871 C. D. 10; Pattee, 1872 C. D. 255; Huttner v. Knox, 1879 C. D. 281; Marsh v. Dodge, 1872 C. D. 245.

A case will not be reopened on the ground that the attorney misunderstood the issue.

Dod v. Cobb, 1876 C. D. 196.

After the taking of testimony the case reopened to admit evidence tending to negative novelty. If the testimony had been of a different character it would not have been admitted.

Wood v. Morris, 1897 C. D. 39.

From the decision of the Examiner refusing to act appeal is directly to the Commissioner. A case should not be re-

opened to admit evidence that could have been as well produced at the former trial.

Marsh v. Dodge, 1872 C. D. 245; Gillen, 1877 C. D. 20, 11 O. G. P. 419.

A rehearing ought never to be granted except upon the clearest showing that the petitioner has suffered injury by reason of defects in his case, which were unavoidable and for which he is not to blame.

Mason Imlay, 1872 C. D. 183.

Newly discovered evidence must be such as would necessarily change the result of the trial.

Merrill & Merrill v. Glidden, 1876 C. D. 243; Hamilton v. Fisher, 1871 C. D. 271.

An instance of a violation of this rule by the Board of Examiners-in-Chief.

Strain, 1870 C. D. 75.

Newly discovered evidence as to abandonment deemed sufficient to secure a new trial.

Disston v. Emerson, 1870 C. D. 84.

Cases that passes on the subject matter of this rule.

McDonough v. Gray v. Bell v. Edison, 1889 C. D. 9, 46 O. G. 1245.

Rule 141. Jurisdiction.

After decision by an appellate tribunal the case shall be remanded at once to the primary examiner, subject to the applicant's right of appeal, for such action as will carry into effect the decision, or for such further action as the applicant is entitled to demand.

CONSTRUCTIONS.

See notes to Rules 78, 100, 101, 123, 140, 146.

Hereafter cases will be considered to be "pending before" the Examiner-in-Chief for the purpose of entertaining a motion for rehearing until the expiration of the statutory or specified limit of appeal or until such appeal shall have been taken.

Floyd, 129 O. G. 482.

The Examiner of Interference has no jurisdiction to extend the time for taking an appeal from a decision of the Examiners-in-Chief, even when the Board is not sitting.

Townsend v. Ehret, 125 O. G. 2051.

The Primary Examiner has no authority to extend the limit of appeal from his decision upon motion brought after said limit has expired.

Becker & Patitz v. Edwards, 123 O. G. 1990.

Motions to restore jurisdictions.

Hewitt v. Steinmetz, 122 O. G. 1395; Duryea & White v. Rice, Jr., 122 O. G. 1395.

Upon a motion to restore the jurisdiction of the Examiner of Interferences in a case pending on appeal before the Examiners-in-Chief, for the purpose of considering a motion to reopen the interference to take newly discovered evidence only a proper *prima facie* case is necessary the substance will be considered by the Examiner of Interferences.

Dunbar v. Schellinger, 118 O. G. 2536.

A motion to restore jurisdiction must be accompanied by a proper showing.

Brunker v. Schweigerer, 1903 C. D. 189, 104 O. G. 2148.

When limit of appeal has expired the tribunal before which the matter is pending has lost jurisdiction. The only way to restore it is by petition to the Commissioner.

Benger v. Burson, 1900 C. D. 185, 93 O. G. 1917; Osborn v. Hotsapillar, 1901 C. D. 16, 94 O .G. 583.

Where a case was rejected on August 15, 1895, under Rule 68, then in force, not on references. but on the ground that there had been intentional delay in prosecution, and such rejection made final under Rule 65, *held*, that as these rules have been revoked and there has been no final rejection on references, the action under Rule 65 is set aside and the case opened for reconsideration.

Higgins, 1897 C. D. 73, 80 O. G. 2037.

The Commissioner will not authorize the reopening of a case by the Primary Examiner, under Rule 142, in the absence of good and sufficient reasons for long delay on the part of the applicant in presenting his reasons therefor, or a showing of great hardship or irreparable injury.

Goldsmith, 1892 C. D. 41, 58 O. G. 1092.

Cases that pass on the subject matter of this rule.

Klepetko, 126 O. G. 387; Merrill, 116 O. G. 1186; Recklinghausen & Potter, 113 O. G. 1146; Gilmer, 109 O. G. 1337; Buck, 94 O. G. 222; Cutten & Fraser, 98 O. G. 2172; Grant, 93 O. G. 2532; McCallum v. Bremer, 93 O. G. 1918.

Rule 142. Petition to Commissioner, Without Fee.

Upon receiving a petition stating concisely and clearly any proper question which has been twice acted upon by the examiner, and which does not involve the merits of the invention claimed, the rejection of a claim or a requirement for division, and also stating the facts involved and the point or points to be reviewed, an order will be made directing the examiner to furnish a written statement of the grounds of his decision upon the matters averred within five days. The examiner shall at the time of making such statement furnish a copy thereof to the petitioner. No fee is required for such a petition. Hearing will be granted in the discretion of the Commissioner.

HISTORY.

In the Revision of the Rules of March 3, 1885, Rule 140 read:

Decisions of the Examiner upon preliminary or intermediate questions, not involving the merits of the case, once repeated, will be re-examined by the Commissioner upon written statements of the points of appeal, and of the grounds of the Examiners' decisions, as in other appeals. For appeals of this class no fee is required.

Commissioner Montgomery gave his reasons for the change of practice as follows:

Washington, D. C., November 25, 1885.

To the Patrons of the Patent Office:

I desire to invite especial attention to the recent amendment to Rule 140 of the Rules of Practice of this Office.

Before proposing this amendment I had thought the matter over very carefully, and had come to the deliberate conclusion that the subject of "interlocutory appeals" which obtained in this Office should be substantially corrected and a substitute therefore provided.

In the *first* place, it is exceedingly difficult to understand how an *appeal* can be taken from no action at all.

In the *second* place, it is many times next to impossible

to ascertain the particular thing which is complained of, and—

In the *third* place, the practice of permitting the Examiners to answer an appeal at any time before the hour of hearing, is not conducive to an intelligent examination of the questions involved.

I have decided, therefore, to establish a little different practice, which, it is to be hoped, will result in expediting all these matters, in more clearly presenting the questions, and in general benefit to the Office and its patrons. I have no doubt that every practitioner will agree that this is desirable.

It will be observed that the rule, as amended, contemplates that instead of taking a loose appeal, a petition shall be filed reciting as definitely as possible what has been done and the particular grievance which is complained of, and asking specifically for the remedy which is desired.

I suggest the following as an ordinary example of such a petition:

Sixth. That your petitioner was then informed by Office letter of the ..... day of .... that the former requirement relating to claim *one* would be adhered to, and that no action would be had on the merits of either claim until said amendment so required had been made;

Wherefore your petitioner requests that the Examiner in charge of such application be advised that such amendment so required by him to said *first* claim be not insisted upon, and directed to proceed to examine both said remaining claims upon their merits.

A hearing of this petition is desired on the .... day of .....

....., *Applicant.*

....., *Attorney for Applicant.*

Of course, this example must be varied to suit the particular facts of each case. It is not intended that a petition shall be required to contain a recital of *all* that has taken place since the filing of the application, but it would be well to state the date and the substance of the first action which is complained of, and which is sought to be reviewed, and thereafter to trace through, step by step, the things which were done both by applicant and the Office, which, in applicant's opinion, makes it necessary for him to ask the relief.

If any material facts are alleged in such petition which are not shown by the records or files of the case, such petition

should be verified. I suggest the following form of verification:

STATE OF .....
} ss:
COUNTY OF .....

On this ..... day of ...., A. D. 1885, personally appeared before me, a notary public in and for said county ....., the above-named petitioner, who, being by me duly sworn, says that he has heard said petition read and knows its contents, and that the same is true, except as to the matters therein alleged on information or belief, and as to those matters he believes it to be true.

.....,
Notary Public.

Upon receiving such petition an order will be made, as follows:

Referred to the Examiner in charge of Division ...., who is directed to file an answer on the ..... day of ....., which answer shall exhibit the reasons, if any, why the request of the petition hereto attached should not be granted.

.....,
Commissioner.

This answer will be required to be filed at least five days before the day of hearing, which day of hearing will be, when consistent, the one named by the petitioner.

I am also considering the subject of requiring copies of all such answers to be furnished to appellants, the same as copies of all other communications. This, however, will be determined hereafter.

CONSTRUCTIONS.

(1) MISCELLANEOUS.
(2) PETITION.
(3) EXECUTIVE QUESTIONS.
(4) TWO REJECTIONS.
(5) REFUSAL OF THE EXAMINER TO ACT.
(6) VAGUENESS.
(7) INTERFERENCES.
(8) ADDITIONAL CASES.

(1) *Miscellaneous.*

A question involving the wording and not the substance of a claim is reviewable on petition.

Owen, 195 O. G. 1049.

Abandonment of application reviewable on petitions.

Mygatt, 184 O. G. 802.

A refusal of the Examiners to permit an amendment of the drawing is reviewable on petition where the question is what the disclosure is and not whether it is operative.

Bogvoslawsky, 179 O. G. 1107.

As the points relied upon by the petitioner are technical, it is necessary to call attention to the fact that the rule requires two actions by the Primary Examiners.

Frelisch, 173 O. G. 864.

A petition and complaint at the same time improper.

Eggan, 172 O. G. 1091.

Whether or not a ruling that the year begins to run at a certain date is correct or not will not be considered until the application is held to have been abandoned unless the error is clear.

Inman, 160 O. G. 1038 (149 O. G. 309).

Matter of sufficiency of time allowed to make claims under Rule 96 considered by the Commissioner.

Hillmunch, 141 O. G. 565.

It seems a petition will lie to direct the Primary Examiner to allow a claim that has been previously allowed on a previous application and on a renewal of the same.

Hay, 139 O. G. 197.

Sufficiency of affidavit under Rule 75 is not reviewable on petition.

Nordstrom, 115 O. G. 1327.

Questions of division are not reviewable by petition.

Emerson, 109 O. G. 1610.

Questions of new matter go directly to the Commissioner.

Edwards, 108 O. G. 1056.

The question of operativeness of invention may not be considered by the Commissioner under this rule.

Brisbane, 107 O. G. 1097.

Refusal to register a trade-mark on the grounds that the label showed a misunderstanding not reviewable on petition.

Zinn, 107 O. G. 703.

It is not in accordance with good practice to present a matter for consideration on appeal which has not been considered and passed upon by the tribunal below.

Reppeto v. Stephens, 105 O. G. 1779.

The case presented to the Commissioner must be that presented to the Examiner.

McHarg v. Schmidt & Mayland, 105 O. G. 263.

Seems to be approved by C. of A. D. of C.

U. S. ex rel. Steinmetz v. Allen Com., 104 O. G. 853-6.

The question as to the propriety of disclosing records of the office is one properly reviewed on petition.

Robinson v. Copeland, 102 O. G. 466 *et. req.*

An appeal was taken both to the Commission and Board. The Commissioner decided the case a second time on appeal from the board.

101 O. G. 2825.

There is no more excuse for loose practice under this rule than there is for improperly prepared pleadings in court cases.

Grant, 1900 C. D. 199, 93 O. G. 2532.

The case must be twice acted upon.

Haug, 97 O. G. 192.

Proper subject matter for a design patent not a proper subject matter of petition.

Groves, 89 O. G. 1671.

Where a question of aggregation and unity and diversity of investion arise, the first question must be settled before petitioning the commissioner on the latter.

Feucht. 88 O. G. 2066.

The Commissioner will not consider an appeal taken from the action of an Examiner rejecting an application.

Kuhn, 1892 C. D. 46, 58 O. G. 1250.

The question of redundancy or multiplicity of claims is one of form and not one involving the merits, hence the proper remedy is by petition.

Lawn, 1891 C. D. 44, 54 O. G. 1561.

If the Examiner refused to receive a claim presented in an amendment because it is a departure from the original invention an appeal lies to the Commissioner.

Bennett, 35 O. G. 1004.

From a refusal by the Examiner to receive an amendment for the reason that it is a departure from the invention originally disclosed, an appeal lies directly to the Commissioner. In what cases an Examiner should refuse to receive an amendment for this reason. Bennett, 35 O. G. 1003. See Barker v. Mack, 1873 C. D. 123.

When a case is appealed to the Commissioner the entire case is before him and is subject to review.

Blythe, 30 O. G. 1321.

Where the reasons for requiring a division are given with clearness, his action will not be reviewed upon petition upon the allegation that the reasons given by him are insufficient.

Wallace, 18 O. G. 1686.

As to the form of claims.

Williams, 1876 C. D. 227.

There is no limit of time prescribed either by the law or rules within which an appeal shall be taken on interlocutory matters.

Little v. Little, Pillard and Sargent, 1876 C. D. 207.

(2) *Petition.*

B has appealed, but in his assignment of error does not challenge the decision of the Commission on the question of priority of invention and to this extent he is presumed to have acquiesced in the decision against him.

Beehman v. Wood, 15 App. D. C. 487; Beehman v. Southgate, 127 O. G. 1254.

The first paragraph of the petition is not a request for specific relief, but is in the nature of a complaint. It does not ask that the Examiner's action be set aside or overruled. It has therefore no proper place in a petition.

Lewis, 109 O. G. 559.

Questions involving the merits of invention are appealable in the first instance to the Examiners-in-Chief. A petition must state the facts involved and the point or points to be reviewed.

Organ, 100 O. G. 231.

(3) *Executive Question.*

Remedy by petition applies only where the Examiner has been requested to take a particular action and refused to do so after the reasons have been fully stated and considered.

Lewis, 109 O. G. 560.

The question whether a claim has been reasonably presented is an executive one.

Perkins, 189 C. D. 63, 55 O. G. 139.

If there is a disagreement between an Examiner and an applicant as to whether an amendment is a matter of substance, an interlocutory appeal lies to the Commissioner who will determine on such appeal not whether references which may have been cited meet or do not meet the case, but whether as a matter of language the amended claim presents the same idea or invention as the old ones.

Winchester, 1880 C. D. 92.

The only appeal from the executive action of the Examiner is the Commissioner in person.

Morton, 1871 C. D. 169.

(4) *Two Rejections.*

The practice prescribed (requiring two actions by the Primary Examiner) should be strictly followed.

Lendl, 115 O. G. 250; Shone, 99 O. G. 863.

Case dismissed as the question of division. It had not been twice acted upon.

Lovejoy, 108 O. G. 1053.

Two actions by the Primary Examiner are essentially prerequisite.

Shone, 99 O. G. 863, 100 O. G. 231-2; Lovejoy, 108 O. G. 1052.

Until there is an issue between the Examiner and applicant the right of petition does not ordinarily exist.

104 O. G. 1119.

There is a principle governing the regulations of Rule 145, that two actions should be made by the Examiner before a petition can be brought and this principle is that the issue between the Examiner and the applicant shall be well defined before a review of the requirement of the Examiner is asked for by the applicant. The practice of *pro formal* actions condemned.

Tyson, 101 O. G. 3105-06; Amand, 103 O. G. 661.

The practice of carrying up questions before they have been carefully considered by the Primary Examiner condemned. The Examiner can not be expected to answer matter brought up for the first time in the argument.

Amand, 103 O. G. 661.

Two actions by Primary Examiner necessary.

Auchu, 1892 C. D. 120, 59 O. G. 1761.

(5) *Refusal of Examiner to Act.*

If the applicant is not convinced by the reasons given by the Examiner, he should apparently appeal and can not compel further reasons by petition.

Leilich, 108 O. G. 561.

Refusal to act because case is *res adjodicata* may be reviewed under this rule.

100 O. G. 2775-6.

A petition asking that the Primary Examiner be directed to reconsider the claims will not be considered in the absence of any allegation that the final rejection was premature, the request apparently being made because applicant thought the Examiner was in error in rejecting the claims.

Eickelberg, 100 O. G. 2773.

An interlocutory appeal lies from a refusal of the Examiner to consider the merits of the claims as amended.

Hoffman, 1880 C. D. 247.

The question appealed is, however, whether the amendment shall be received or not, and the Examiner may reject the case for containing matter not warranted by the original papers after he has been directed by the Commissioner to receive the amendment.

Vaile, 37 O. G. 563; Bennett, 35 O. G. 1004.

Appeal lies to the Commissioner in person if the Examiner for any reason declines to examine the case upon its merits.

Barker & Mack, 73 C. D. 123; Bennett, 35 O. G. 1003.

An appeal from the Examiner's decision refusing to act upon an application for a design patent because the subject matter was the subject of a mechanical patent, appealable to the Commissioner direct and not to the Examiners-in-Chief. Practice changed, see Notes to Rule 133.

Morton, 1871 C. D. 169.

The Commissioner should not be called upon to instruct an Examiner until the case is properly before him on appeal.

Sellers, 1897 C. D. 164, 81 O. G. 803.

It is contrary to settled practice to remand a case for the decision and at the same time direct the lower tribunal how to decide it.

R v. C., 102 O. G. 466.

(6) *Vagueness.*

Objections that a claim is indefinite and that claims are substantially identical reviewable on petition.

Eastman, 1891 C. D. 178, 57 O. G. 410.

An appeal from the Examiner's decision, that the claim is vague and depends for its novelty entirely upon a device described only by its function, is to the Commissioner.

Doten, 1877 C. D. 115.

An appeal as to the clearness and fulness of the specification is to the Commissioner.

Gould, 1876 C. D. 164.

(7) *Interferences.*

Before the interference proceeds further it should be positively determined whether or not these new references anticipate the issue.

Wright & Stebbins v. Hansen, 114 O. G. 761.

It is eminently improper to encumber the records of an

interference with irrelevant matter as to the conduct of some particular officer or employee of the Department.

Duryea & White v. Rice, 114 O. G. 761.

Questions of interference in fact appealable to Commissioner and not to Board apparently.

Hein v. Shepard, 106 O. G. 2062.

A mere request by a party having an application on file is not sufficient to warrant ruling upon questions of procedure and practice in which he happens to be interested. The time to bring up such questions is after an adverse decision has been rendered upon them.

Hicks v. Costello, 103 O. G. 1163.

An appeal from the decision of the Examiner of Interferences dissolving an interference is to the Commissioner in person.

Marsh v. Dodge, 72 C. D. 245.

(8) *Additional Cases.*

Cases that pass on the subject matter of this rule.

Kaczander v. Hodges & Hodges, 118 O. G. 836; Lay, 107 O. G. 2237; Blackman v. Alexander, 1900 C. D. 186, 105 O. G. 2058; McCallum v. Brenner, 1900 C. D. 186, 93 O. G. 1917; Frasch, 100 O. G. 1967; Osborne, 92 O. G. 1797; Johnson, 89 O. G. 1341; Shearman, 1898 C. D. 190; Suter, 1892 C. D. 112, 59 O. G. 1431.

APPEALS TO THE EXAMINERS-IN-CHIEF AND TO THE COMMISSIONER IN CONTESTED CASES.

Rule 143. Remedy by Appeal.

In interference cases parties have the same remedy by appeal to the examiners in chief and to the Commissioner as in *ex parte* cases.

Rev. Stat., secs. 4904, 4909, 4910, 4911.

CONSTRUCTIONS.

The distinction between the two classes of appeals is recognized in the Rules of Practice. Rule 133 prescribes the conditions for Appeals from the Primary Examiner while Rule 146 provides for appeals in interference cases.

Cheney v. Venn, 125 O. G. 1703.

The question of patentability is not generally open in an appeal in interference cases.

Orcutt v. McDonald, Jr., and McDonald, 123 O. G. 1288; Wenzelmann & Overholt, 113 O. G. 995.

D. on the face of the record has no substantial standing in the interference, and H. identified with D. in interest should not be permitted to prolong the extensive delay which has already occurred on account of D.'s unwarranted appeal.

Dalton v. Hopkins v. Newman, 120 O. G. 906.

The question of right to make claims is different from that of interference in fact and will not be considered on appeal for the former reason.

Blackmore v. Hall, 119 O. G. 2523; Heintzelman & Co. v. Vraalstad & Doyle, 120 O. G. 906.

It is well settled that this court can not and should not interfere with such (interlocutory) rulings, unless perhaps, in extreme cases it should be necessary for the maintenance of the jurisdiction of this court.

Ritter v. Krakaw & Connor, Jr., 114 O. G. 1553-1554.

There is no appeal from a decision refusing a rehearing.

Carmichael v. Fox, 104 O. G. 1656.

Court of Appeals regards it as improper for them to adjudicate the question of priority before the question of patentability is fully settled.

Slaughter v. Halle, 102 O. G. 469.

Decisions (concurrent) of Office will be adhered to unless in a clear case.

Howard v. Hey, 95 O. G. 1647.

Appeal on question of Priority, Decision of Office, as to whether or not invention is shown by one applicant will be taken as conclusive.

Ostergren v. Tripler, 95 O. G. 837; Schupphaus v. Stevens, 95 O. G. 1452.

In general questions of patentability will not be considered on appeal. Explains Bachmeyer v. Wood, 89 O. G. 2459.

Newton v. Woodward, 93 O. G. 2320; Latham v. Armat, 97 O. G. 232.

Application of rule.

Brown v. La Dow, 80 C. D. 199; Adams v. Murphy, 91 O. G. 2207.

As the motion involves the question as to what constitutes proper evidence in a certain case, and is not one of merely office practice, it is a matter on which the Board of Appeals should be allowed to also express an opinion, especially in view of the fact that the Examiner of Interferences has

passed upon the point in rendering a final decision upon the question of priority.

Chambers v. Duncan, 1876 C. D. 82, 223.

An appeal from the decision of the Examiner of Interferences dissolving an interference is to the Commissioner in person.

Marsh v. Dodge, 1872 C. D. 245.

Rule 144. Briefs in Appealed Cases.

Appeals in interference cases must be accompanied by brief statements of the reasons therefor. Parties will be required to file six copies of printed briefs of their arguments, the appellant ten days before the hearing and the appellee three days. (See Rule 163.)

CONSTRUCTIONS.

All briefs should have conspicuously printed thereon a statement designating the particular tribunal of the Patent Office to which the brief is addressed.

(Order), 218 O. G. 607.

U. S. Statutes excusing the printing of record, etc., in case of poverty does not apply to these appeals.

In re Mattulath Adam, etc., 173 O. G. 1082.

A brief filed after oral argument and near the close of the hearing admitted. If counsel for P. wished to file a reply-brief he should have requested permission of the Primary Examiner to do so, when the brief of Stevens was filed, and it was within the discretion of the Examiner to grant such a request.

Stevens v. Paterson, 142 O. G. 568. See note to Rule 163.

One brief. Supplementary brief after hearing not admissible.

Newcomb v. Lenmp, 109 O. G. 2171.

Rule 145. Right to Open and Close.

The appellant shall have the right to make the opening and closing arguments, unless it shall be otherwise ordered by the tribunal having jurisdiction of the case.

Rule 146. Jurisdiction.

Contested cases will be regarded as pending before a tribunal until the limit of appeal, which must be fixed, has expired, or until some action has been had which waives the appeal or carries into effect the decision from which appeal might have been taken.

See Rules 140, 141, 123, 100, 101.

RECONSIDERATION OF CASES DECIDED BY FORMER COMMISSIONER.

Rule 147. Reconsiderations and New Trials.

Cases which have been decided by one Commissioner will not be reconsidered by his successor except in accordance with the principles which govern the granting of new trials.

CONSTRUCTIONS.

Cases decided by former Commissioner will not be heard.

Manifest error in law, being ground for a new trial, is also ground for a rehearing under Rule 144.

Green v. Hall v. Siemens v. Field, 1889 C. D. 161, 47 O. G. 1631.

History reviewed.

Daniels v. Morgan, 1889 C. D. 150, 47 O. G. 811; McDonough v. Gray v. Bell v. Edison, 1889 C. D. 9, 45 O. G. 1245; McDonough v. Gray v. Bell v. Edison, 1889 C. D. 9, 46 O. G. 1245; Nealson, 1897 C. D. 174, 81 O. G. 1787.

Except upon a new state of facts or upon grounds which would support a motion for a new trial.

Lee v. Walsh, 79 C. D. 29; Huttner v. Knox, 1879 C. D. 281; J. L. Mason, 1870 C. D. 20.

APPEALS OF THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

Rule 148. Appeal to Court.

From the adverse decision of the Commissioner upon the claims of an application and in interference

cases, an appeal may be taken to the Court of Appeals of the District of Columbia in the manner prescribed by the rules of that court. (See appendix.)

Rev. Stat., sec. 4911; sec. 9, act of February 9, 1893.

HISTORY.

The "Act to establish a Court of Appeals for the District of Columbia, and for other purposes," approved February 9, 1893 (27 Stats. 434, 436, ch. 74), as to Section 9, reads as follows:

Sec. 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the General Term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eight of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be and the same is hereby vested in the Court of Appeals created by this act; and in addition, any party aggrieved by a decision of the Comissioner of Patents in any interference case may appeal therefrom to said Court of Appeals.

This act was held constitutional in United States *ex rel.* Bernardin v. Duall, Commissioner of Patents, 86 O. G. 995.

The word "interference" in section 9 of the act establishing the Court of Appeals of the District of Columbia interpreted and *held* not to mean and include disputes in trade-marks under section 3 of the Trade-Mark law of 1881, but to be confined to an interference in patent law.

Einstein v. Sawhill, 65 O. G. 1918.

CONSTRUCTIONS.

(1) JURISDICTION.
(2) APPEAL.
(3) FINAL DECISIONS OF COMMISSIONER.
(4) MOTIONS.
(5) RECORD.
(6) RULES.
(7) WEIGHT GIVEN COMMISSIONER'S DECISIONS.
(8) MANDAMUS.
(9) EFFECT OF DECISION OF THE COURT ON COMMISSIONER.
(10) MISCELLANEOUS.

(1) *Jurisdiction.*

We have no more jurisdiction to question the patentability of the counts in an interference proceeding than in an *ex parte* proceeding.

Seewellyyn v. Upson, 227 O. G. 367.

The jurisdiction of the Court of Appeals of the District of Columbia to entertain appeals from the decisions of the Commissioner of Patents in proceedings relating to patents is limited to two classes—(1) Where the claims of an application for a patent or the reissue of a patent after having been twice rejected have been finally rejected on appeal to the Commissioner in due course of proceeding. (2) Where on an appal to the Commissioner in an interference proceeding there has been a final decision on priority in favor of one of the parties thereto. (R. S. Secs. 4909, 4910, 4911.)

Westinghouse v. Duncan, 2 App. D. C. 8, 17, 26; Union Distilling Co. v. Schneider, 29 App. D. C. 1; *In re* Fullager, 138 O. G. 259.

The Court of Appeals of the District of Columbia has no jurisdiction to entertain an appeal from a decision of the Commissioner of Patents on a motion to dissolve an interference between an appellant for reissue and an original application holding that appellant had no right to a reissue on the ground that his showing of inadvertence, accident, or mistake was insufficient and that he had failed to excuse the long delay of more than two years in filing the reissue application, as such judgment does not constitute an adjudication of the question of priority between the parties.

In re Fullagar, 138 O. G. 259.

The Court has jurisdiction of appeals from the Commissioner of Patents in certain matters defined by statute, but has no original jurisdiction to direct and supervise the administration of the affairs of the Patent Office. A petition to direct the Commissioner to allow petitioner to proceed with the taking of testimony refused.

DeFerranti v. Lindmark, 137 O. G. 733; Neill v. Commissioner of Patents, 82 O. G. 749.

The Act establishing the Court of Appeals did not by implication repeal the Statute providing remedy by bill in equity in a circuit court.

Bernardin v. Northall and Seymour, Commissioner of Patents, 78 O. G. 1740.

The statutes given right of appeal only in cases where the various tribunals of the Office have acted.

Serrell v. Donnelly, 129 O. G. 2501.

(2) *Appeal.*

Whether the patent was properly granted in view of the state of the art can not be considered in the Court of Appeals.

Lautenschlager v. Glass, 249 O. G. 1223-1224.

Where upon appeal, on a motion to dissolve, the Commissioner held that C., the junior party, had no right to make the claims because of an inoperative disclosure, and thereafter, at C.'s request, changed the order from one of dissolution to one awarding priority to G., an appeal was taken to the court: *Held,* that a motion to dissolve is interlocutory and the Commissioner is without authority to convert an appeal on such a motion into an appeal on priority.

Caspor v. Gold, 34 App. D. C. 194, and 36 App. D. C. 302, cited by the Commissioner, distinguished.

Carlin v. Goldberg, 236 O. G. 1222.

Patentability considered in an interference suit even if evidence was taken before the Patent Office.

Slingluff v. Sweet, 230 O. G. 659.

Appeal lies to the Court of Appeals from an exercise of the supervisory power of the Commissioner rejecting a claim.

Moore Com. v. U. S. *ex rel.* Chott, 192 O. G. 520.

Apparently there is no appeal from a decision dissolving an interference under Rule 122, because it is not a final decision, nevertheless if the motion is made to change the decision to a final action, as to priority it may be appealed from.

U. S. ex rel. Scott et al. v. Moore, Com., 180 O. G. 607; (Cooper v. Gold, 36 App. D. C. 302-307).

A motion by E. that he be made a party to an appeal to the Court of Appeals of the District of Columbia taken by F. from a decision of the Commissioner of Patents on a motion to dissolve holding that F. had no right to make the claims of the issue because of his delay in filing his reissue application involved in this interference denied on the ground that the Commissioner's decision did not result in award of priority to E., and therefore F. could not bring him before the Court by an appeal. For the same reasons E.'s motions to have the docket entry changed and to dismiss F.'s appeal denied.

In re Fullagar, 138 O. G. 259.

Where an interference is declared between three parties and all present testified and but one of the parties takes an appeal to the Court of Appeals, the case made out by the party who has not appealed can not be considered in the determination of the controversy.

Richard v. Meissner, 114 O. G. 1831.

(Interference) the argument of Porter's counsel have failed to satisfy us that the case before us is one of those extraordinary cases in which the court may be called upon to inquire whether there is a patentable invention involved.

Potter v. McIntosh, 127 O. G. 1995.

(3) *Final Decisions of Commissioner.*

Up to the present time the Court of Appeals has entertained appeals in interference cases only from the final decision of the Commissioner upon the question of priority of invention. (Allen, Commissioner of Patents, v. The United States of America *ex rel* Lowry and Planter Compress Co., 116 O. G. 2253.)

DeFerranti v. Lindmark, 137 O. G. 731; Marshutz v. Commissioner of Patents, 85 O. G. 778.

The statutes give right of appeal only in cases where the various tribunals of the Office acted and not when the Examiners-in-Chief suggest that the issue is not patentable.

Serrell v. Donnelly, 129 O. G. 2501.

Neither the rules of this Court, nor of the Patent Office, mention amendments to the reasons of appeal; but when made in due time, to correct an assignment that may not be sufficiently specific, or some inadvertance in its preparation, and no possible injury could be done to the opposing party, we see no reason why it should not be permitted.

Horine v. Wende, 129 O. G. 2858.

The discretion of the Commissioner, in extending time for filing preliminary statement not reviewed by Court of Appeals.

Churchill v. Goodwin, 141 O. G. 569.

In general, the question of patentability is not open in an appeal in interference cases.

Hisey v. Peter, 71 O. G. 892; Doyle v. McRoberts, 79 O. G. 1029; Orcutt v. McDonald, Jr., and McDonald, 123 O. G. 1288; Newton v. Woodward, 93 O. G. 2320 (explaining Beehman v. Wood, 89 O. G. 2320); Latham v. Armat, 95 O. G. 232. (See subject "Patentability" in section 6.) Potter v. McIntosh, 127 O. G. 1995; Mill v. Midgley, 136 O. G. 1534; Luger v. Browning, 104 O. G. 112. (Distinguishing from Oliver v. Felbel, 100 O. G. 2384.) Dodge v. Fowler, 82 O. G. 595; Doyle v. McRoberts, 79 O. G. 1529.

The Court of Appeals regards it as improper for them to adjudicate the question of priority before the question of patentability is fully settled.

Slaughter v. Halle, 102 O. G. 469.

It is well settled that this Court can not and should not interfere with such (interlocutory) rulings, unless perhaps in extreme cases it should be necessary for the maintenance of the jurisdiction of this Court.

Ritter v. Krakaw & Connor, Jr., 114 O. G. 1553-1554.

The reopening of a case for the introduction of newly discovered evidence is a matter of discretion for the trial court, and will not be reviewed by this Court.

Richards v. Meissner, 114 O. G. 1831; Dunbar v. Schellenger, 128 O. G. 2837; Omes v. Starr, 117 O. G. 1495.

The decision was an interlocutory one relating to the general practice of the Office (Rules 30, 31, 75) in all such cases, and the question of its propriety as presented, is not necessarily involved in the decision on its merits. For the reasons given it is not the subject of review.

Westinghouse v. Duncan, 66 O. G. 1009; Mill, 11 App. D. C. 584, 588; Frasch, 100 O. G. 1977, 192 U. S. 566; Davis v. Garrett, 123 O. G. 1991; Hulett v. Long, 89 O. G. 1141.

The question whether the description in a design case is a proper one is not reviewable by the Court of Appeals except in an extraordinary case.

Mygatt, 121 O. G. 1676.

A trade-mark interference declared under the act of 1881 but not decided until after the passage of the act of February 20, 1905, is appealable to the Court of Appeals of the District of Columbia under the act of February 20, 1905, where the only application involved has been amended to bring it under the provision of that act.

Giles Remedy Company v. Giles, 120 O. G. 826.

A decision against a party on the ground that his original application did not contain the inventions seems to be one of priority of invention and the decision should be such as to give the unsuccessful party opportunity to take an appeal in the interference to the Court of Appeals and not one dissolving the interference.

Pohle v. McKnight, 119 O. G. 2519.

Question of the identity of the inventions involved proper to be considered by the Court of Appeals on appeal from the final decision of the Commissioner.

Beehman v. Wood, 89 O. G. 2459; but see Beehman v. Wood, 89 O. G. 2462.

It is only by regarding the proceedings in the Patent Office as quasi-judicial in their nature that the validity of the leg-

islation which authorizes appeals to the Court of Appeals from the decision of the Commissioner of Patents can be sustained.

Barratt v. Duall, Commissioner of Patents, 87 O. G. 1075.

A refusal to consider patentability in cases of priority does not establish the conclusion that the decision of the Commissioner upon questions of patentability in such cases is final and conclusive. Such questions should come before the Court by regular course of appeal.

Breul v. Smith, 79 O. G. 153.

The right of a party to make a claim will be considered as an ancillary question to be considered in awarding priority of invention.

United States of America *ex rel.* The Newcomb Motor Company v. Moore Co., 133 O. G. 1680.

The Court will confine its decision to the matter passed upon by the Commissioner and not consider the question of abandonment, prior public cases, and anticipation of the invention which have not been acted on in the Patent Office.

Colhoun v. Hodgson, 70 O. G. 276; Cutler v. Leonard, 136 O. G. 438.

Whatever practice should have been pursued in regard to the additional claim presented for the first time to the Commissioner in person which was neither considered nor rejected, we do not consider that we are at liberty to pass upon it on this appeal.

Garrett, 122 O. G. 1047.

Only claims considered by the Office will be considered by the Court on appeal. As to bill in equity see Durhamy v. Seymour, Commissioner of Patents, 71 O. G. 601, and the construction given by the Office adhered to.

Breul v. Smith, 78 O. G. 1906.

The right of appeal in case of the refusal of a patent upon the ground of non-patentability of the claim, and refusal of a patent because of interference with a prior right of invention, are distinct rights. The latter does not involve the former This is clearly indicated in the Revised Statutes of the United States, section 4911, and in section 9 of the act of Congress of February 9, 1893, providing for the organization of this Court.

Hisey v. Peters, 71 O. G. 892.

The Court will not consider the question of patentability

a second time in a new application for the same subject matter.

Barratt v. Duall, Commissioner of Patents, 87 O. G. 1075.

Only appeals from final decisions considered.

Cross v. Phillips, 87 O. G. 1399; Hulett v. Long, 89 O. G. 1141; Westinghouse, Jr., v. Duncan, 66 O. G. 1009.

(4) *Motions.*

A motion to dismiss an appeal on the ground that it was taken in bad faith for the purpose of delay will not be postponed to the final hearing if a *prima facie* case is made out.

Jones v. Starr, 117 O. G. 1495.

The appellant having failed to have his cause filed and docketed, on motion of the appellee the cause was docketed and dismissed.

Cleveland v. Wright, 79 O. G. 886; Southall v. Seymour, Com., 79 O. G. 1684; McCreary v. Seymour, Com., 79 O. G. 1684; Morrissey v. Seymour, Com., 79 O. G. 1684.

Court will entertain a motion for a new trial pending an appeal.

Clement v. Richards v. Meissner, 111 O. G. 1627.

No appeal from orders refusing a new trial or rehearing.

Greenwood v. Dover, 109 O. G. 2172; Messinger v. Commissioner of Patents, 83 O. G. 1995.

(5) *Record.*

Confined to the record made up in the Office.

Heroult, 127 O. G. 3217.

Failure to print transcript of record is ground under Court Rule for dismissing appeal.

Munson v. Carper, 79 O. G. 160; Pelton v. Evered, 77 O. G. 16.

The record of the proceedings in the Patent Office upon being filed with the clerk of the Court of Appeals become a public record.

Drawbaugh, 66 O. G. 1451.

(6) *Rules.*

The Court of Appeals was duly authorized by statute to make rules limiting the time of appeal from the decisions of the Commissioner of Patents.

77 O. G. 507.

See "Rules," page 783, and Instructions to Applicants, page 790.

(7) *Weight Given Commissioner's Decisions.*

Three tribunals of the Office concurring a different conclusion will only be reached where there is manifest error.

Creveling v. Jepson, 256 O. G. 226.

ON QUESTIONS OF FACT THE CONCURRENT DECISIONS OF THE LOWER TRIBUNALS WILL BE TAKEN AS CONCLUSIVE, UNLESS THE CONTRARY IS CLEAR.

Arnold v. Tyler, 79 O. G. 156; Hisey v. Peters, 71 O. G. 892; Hien v. Bulloup, 81 O. G. 2088; Bull v. Flora, 121 O. G. 2668; O'Connell v. Schmidt, 122 O. G. 2065; Park v. Lewis, O. G. 2313; Ostergren v. Tripler, 95 O. G. 837; Schiipphaus v. Stevens, 95 O. G. 1452; Austin v. Johnson, 95 O. G. 2685; Kilbourn v. Hirner, 128 O. G. 1689; Orcutt v. McDonald, Jr., and McDonald, 23 O. G. 1287; Ries v. Kirkgaurd and Jelisen, 132 O. G. 845; Baur v. Crone, 120 O. G. 1824; Bourn v. Hill, Jr., 123 O. G. 1284; Bechman v. Southgate, 127 O. G. 1254; Herman v. Fullman, 109 O. G. 1888. But see Beals v. Finkerhiner, 82 O. G. 598; Ritter v. Krakaw and Connor, Jr., 114 O. G. 1553; Rosell v. Allen, 92 O. G. 1036; Stone v. Pupin, 100 O. G. 114; Duryea and White v. Rice, Jr., 126 O. G. 1357; Murphy v. Meissner, 114 O. G. 592; Cleveland v. Wilkins, 123 O. G. 1286; Weber v. Barry, Jr., 117 O. G. 1494; Seeberger v. Dodge, 114 O. G. 2382; Beswick v. Commissioner, 91 O. G. 1437; Latham v. Armat, 95 O. G. 232; Munster v. Ashworth, 28 O. G. 2088; Clunies, 123 O. G. 2361; Adams, 114 O. G. 2093; Dunbar v. Schellenger, 128 O. G. 2837; Clenn v. Adams, 83 O. G. 158; Howard v. Hey, 95 O. G. 1647; Flora v. Powrie, 109 O. G. 2668; Esty v. Newton, 86 O. G. 799; Munster v. Ashworth, 128 O. G. 2088; Richards v. Burkholder, 128 O. G. 2533; Wickers and Furlong v. McKee, 129 O. G. 869.

The rule that the concurrent decisions of the Office as to facts will be followed, except in a clear case, does not mean that the Court will be bound by the conclusions from such facts.

O'Connell v. Schmidt, 122 O. G. 2065; Orcutt v. McDonald, Jr., and McDonald, 123 O. G. 705.

The rule that concurrent decisions in the Patent Office will be followed, is especially applicable in a case which involves

complicated constructions about which the experts of the Patent Office are less liable to err than ourselves.

Lindmark v. Hodgkinson, 137 O. G. 228; Seeberger v. Dodge, 114 O. G. 2382.

That these tribunals have reached their conclusions by different paths does not detract from the weight to be given to their decisions.

Bourn v. Hill, Jr., 123 O. G. 1284.

Where the facts are admitted and a mere question of law is involved, the Court will not hesitate to reverse the judgment appealed from if convinced that an erroneous conclusion was reached.

Woods v. Poor, 130 O. G. 1313.

The burden of overcoming the cumulative decisions of the lower tribunals is on the applicant.

C. of D. of C. Bauer v. Crene, 120 O. G. 1824.

We have repeatedly held that except in extreme cases, we will not go behind the declaration of interferences in order to determine the question of identity of invention.

Beelman v. Southgate, 127 O. G. 1254.

The decisions of the expert tribunals of the Office (original disclosure) will be accepted, except in extreme cases where palpable error has been committed.

Kilbourne v. Hirner, 128 O. G. 1689.

We are not warranted in reversing a decision of the Office because of a mere doubt of its correctness.

Munster v. Ashworth, 128 O. G. 2088.

Where the tribunals of the Patent Office agree in deciding the same way in question of fact, this court will not reverse such a decision unless it clearly appears that the decision was against the weight of evidence.

Richards v. Burkholder, 128 O. G. 2533.

If the decisions of the lower tribunals had been the other way they would have been followed being as they are they will be followed.

Dunbar v. Schellinger, 128 O. G. 2937.

It is evident that the review of this case must be abridged as far as practicable.

In succession the three tribunals of the Office have agreed, in their conclusions, and as we have so often announced, this court will not reverse the unanimous decisions except in a very clear case.

Wickers v. Furlong v. McKee, 129 O. G. 869.

A unanimous decision by the experts of the Patent Office will be accepted as conclusive when there is no palpable error.

(Kilbourne v. Horner, 29 App. D. C. 54-52; Lindmark v. Hodgkinson, 31 App. D. C. 612.)

Beeker v. Bird, 228 O. G. 407.

Where the facts are admitted, and a mere question of law is involved, the court will not hesitate to reverse the judgment appealed from if convinced that an erroneous conclusion was reached.

Woods v. Pover, 130 O. G. 1313.

The rule that concurrent decisions in the Patent Office will be followed is especially applicable in a case which involves a complicated construction about which the Experts of the Patent Office are less liable to err than ourselves.

Lindmark v. Hodgkinson, 137 O. G. 228.

(8) *Mandamus.*

Where a party delays beyond the time limited to take his appeal, mandamus will not lie to the Supreme Court to compel the Court of Appeals to entertain the appeal.

Hein, 79 O. G. 507.

A mandamus to compel the Court of Appeals to hear appeal from Commissioner on question of division not the remedy. It should be to the Examiners-in-Chief in the first place.

Frasch, 109 O. G. 554.

Mandamus is not an alternative remedy with appeal.

United States *ex rel.* Tuttle v. Allen, Commissioner of Patents, 126 O. G. 760.

Mandamus to the Commissioner on appeal to the Court, the remedy where an appeal to the Board is denied. Frasch, 109 O. G. 554. No appeal as to the division of an application.

Frasch, 100 O. G. 1977.

No appeal can be taken to the Supreme Court of the United States from a decision of the Court of Appeals refusing a mandamus to compel the Commissioner to register a trade-mark.

The United States *ex rel.* the State of South Carolina v. Seymour, Commissioner, 67 O. G. 1191.

(9) *Effect of the Decision of the Court on the Commissioner.*

The Commissioner is bound to follow the decision above upon those points only which were raised by the appeal, and upon no other.

It is for a judge to say that a decision of the Commis-

sioner shall be affirmed or reversed, not to say that a patent shall or shall not issue.

Abraham v. Fletcher, 69 C. D. 50.

The Office is bound to take notice of the decision of the Court and may base its action upon the finding of facts contained therein.

Tournier, 108 O. G. 798.

After a decision by the Court of Appeals it is too late to dissolve for lack of interference in fact.

Gilbart, 85 O. G. 454.

It is conceivable that a case might arise where the Commissioner might grant a rehearing after a decision by the Court of Appeals on the question of priority.

Scott v. Brooks, 71 O. G. 1314.

After an appeal to the Court of Appeals refusing the allowances of certain claims, a case will not be reopened for the consideration of additional claims except under unusual circumstances. That the Court put an interpretation on the claims not contemplated by applicant not sufficient.

Milans, 135 O. G. 1122.

After an appeal on the question of priority, the Commissioner may refuse a patent to the successful party.

Sobey v. Holsclaw, 126 O. G. 3041.

(10) *Miscellaneous.*

The Court can not control the discretion of the Commissioner as to the length of argument he should permit.

Sobey v. Holsclaw, 126 O. G. 3041.

The Court is powerless to direct the action of an executive officer unless a positive legal right is being invaded by the officer where the duty imposed upon him is clearly prescribed and enjoined by law. The duty, however, must be so plain and pointed that the officer has no discretion left. (Merriel on Mandamus, p. 64.)

Moore, Com. of Pats., v. U. S. *ex rel.* Boyer, 138 O. G. 530.

Neither writ of error or appeal will be allowed by this Court. Decision not to prejudice an application to any one of the justices of the Supreme Court.

Rousseau v. Brown, 104 O. G. 1122.

The two lower tribunals of the Office held that the inventions were the same, and the Commissioner that they were different, the theory of the Commissioner accepted without enquiry.

Cushman v. Lines, 78 O. G. 2051.

Judgment in an interference proceeding will not be made final by the Office after the filing of a notice of appeal, on the ground that it was filed one day late, it being regarded as being within the discretion of the Court to relieve against the default.

Proutt v. Johnston and Johnston, 130 O. G. 2718.

The Court has no power to award costs.

Wells v. Reynolds, 69 O. G. 1507.

When a record was introduced, but on examination found to have no bearing in the case, it must be at the cost of the one offering it.

Stevens v. Seher, 81 O. G. 1932.

A general assignment of error in appeal from the Examiner to the Board is sufficient to base the question of *res adjudicata* upon, or it might have been raised by the Board on its own motion.

Carroll v. Hallwood, 135 O. G. 896.

B. has appealed, but his assignment of errors does not challenge the decision of the Commissioner on the question of priority of invention and to this extent he is presumed to have acquiesced in the decision against him.

Beckman v. Wood, 15 App. D. C. 487.

(In an interference case.) The present is no more than a moot cause since upon the face of the record itself the question of patentability has been expressly reserved for further and future consideration.

Oliver v. Felbel, 100 O. G. 2384.

A party may take advantage of all the time allowed by law without prejudicing his case.

Jones v. Starr, 117 O. G. 1495.

An assignment of a trade-mark permitted after notice and before appeal is perfected.

Levy & Co. v. Uri, 131 O. G. 1689.

We will not consider affidavits filed either in this Court or the Patent Office relating to changes that have occurred in drawings, models, experimental machines and like exhibits. These matters must be wholly settled in the Patent Office (Blackford v. Wilder, 104 O. G. 580.)

Greenwood v. Dover, 109 O. G. 2173; Willsin v. Bradshaw, 91 O. G. 648.

Affidavit verified before notary who was also attorney in the case is invalid. The prohibition of attorneys acting as notaries in the Code of the District applies to attorneys outside of the District.

The Hall Safe Co. v. Herring-Hall-Marvin Safe Co., 135 O. G. 1804.

Appeal from a decision upon the right to amend preliminary statement.

Cross v. Phillips, 87 O. G. 1399.

Rule 149. Notice to Commissioner of Appeal to Court.

When an appeal is taken to the Court of Appeals of the District of Columbia, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within forty days, exclusive of Sundays and holidays, but including Saturday half holidays, from the date of the decision appealed from, his reasons of appeal specifically set forth in writing.

Rev. Stat., sec. 4912; sec. 9, act of February 9, 1893.

CONSTRUCTIONS.

Court granted a petition relieving a default in view of the fact that the opposite party did not object.

Truby, 268 O. G. 383.

Reinstatement of an appeal not taken within the forty days allowed by Rule 21, refused.

Hitchcock, 247 O. G. 965.

Will entertain a motion for a new trial pending an appeal.

Clements v. Richards v. Meissner, 111 O. G. 1627.

This rule limits the time in which the appeal must be taken to forty days from the date of the order appealed from, excluding the day of date.

Burton v. Bentley, 87 O. G. 2326.

The Office has no power to extend time.

Clement v. Richards v. Meissner, 111 O. G. 1626-7.

Saturday after 12 o'clock is a legal holiday and is to be computed as one-half day.

Ocumpaugh v. Norton, 114 O. G. 545.

A party allowed to prosecute his appeal when notice was filed one day late.

Proutt v. Johnston and Johnston, 130 O. G. 2118.

The rule that all appeals taken from the Commissioner of Patents shall be taken within forty days from the date of the ruling and not afterward is a positive law to the Court and to the suitors therein.

Ross v. Loewed, 77 O. G. 2141; Bryant v. Seymour, Com. of Patents, 77 O. G. 1599.

The two years allowed for an action by R. S. 4894 is not applicable to appeals to the Court of Appeals.

77 O. G. 1600.

The running of the time limited for appeal is not arrested by a motion for a new trial.

Ross v. Loewer, 77 O. G. 2141; Bryant v. Seymour, Com. of Patents, 77 O. G. 1599.

Whenever the time for appeal has gone by the time for rehearing has elapsed with it.

Scott v. Brooks, 71 O. G. 1314.

Rule 150. Pro Forma Proceedings in Patent Office.

Pro forma proceedings will not be had in the Patent Office for the purpose of securing to applicants an appeal to the Court of Appeals of the District of Columbia.

(For forms of appeals and rules of the Court of Appeals of the District of Columbia respecting appeals, see, Rules 148, 149.)

Rule 151. Hour of Hearing.

Hearings will be had by the Commissioner at 10 o'clock a. m., and by the board of examiners in chief at 1 o'clock p. m., and by the examiner of interferences upon interlocutory matters at 10 o'clock a. m., and upon final hearings at 11 o'clock a. m., on the day appointed unless some other hour be specifically designated. If either party in a contested case, or the appellant in an *ex parte* case, appear at the proper time, he will be heard. After the day of hearing, a contested case will not be taken up for oral argument except by consent of all parties. If the engagements of the tribunal having jurisdiction be such as to prevent the case from being taken up on the day of hearing, a new assignment will be made, or the case will be continued from day to day until heard. Unless it shall be otherwise ordered before

the hearing begins, oral arguments will be limited to one hour for each party in contested cases, and to one-half hour in other cases. After a contested case has been argued, nothing further relating thereto will be heard unless upon request of the tribunal having jurisdiction of the case; and all interviews for this purpose with parties in interest or their attorneys will be invariably denied.

CONSTRUCTIONS.

The fact that two hearings before different tribunals are set at the same time is proper and does not invalidate the notice.

Bombard v. United States Graphite Co., 129 O. G. 479.

Rule 152. Wishes of Parties and Attorneys.

Hearings in *ex parte* and contested cases will, as far as is convenient and proper, be set, advanced, and adjourned to meet the wishes of the parties and their attorneys.

Rule 153. Practice in Motions.

In contested cases reasonable notice of all motions, and copies of motion papers and affidavits, must be served as provided in Rule 154 (*b*). Proof of such service must be made before the motion will be entertained by the office. Motions will not be heard in the absence of either party except upon default after due notice. Motions will be heard in the first instance by the officer or tribunal before whom the particular case may be pending. In original hearings on motions the moving parties shall have the right to make the opening and closing arguments. In contested cases the practice on points to which the rules are not applicable shall conform as nearly as possible, to that of the United States courts in equity proceedings.

CONSTRUCTIONS.

Setting of hearing.

199 O. G. 1.

A petition by an assignee of a part interest to intervene in the prosecution of an application will be dismissed, where such petition was not accompanied by proof of service upon the other assignees and upon the applicant.

Kyle, 193 O. G. 753.

An objection for want of notice of filing an amended preliminary statement disregarded in view of the fact that objector had ordered a copy of the same.

Klenk v. Kruse, 177 O. G. 1300.

In serving notice for taking testimony, ample time should be given counsel to communicate with his client and arrange his business affairs before he is compelled to start on his journey. Otherwise testimony should be stricken out.

Randerson v. Hanna & Hanna, 173 O. G. 586.

The sufficiency of the notice depends largely upon the circumstances. In this case a notice given in New York City on May 3 that certain witnesses would be examined at Battle Creek, Mich., on May 5, *held* sufficient.

Kuth et al. v. Lundquit et al. v. Lorimer et al., 157 O. G. 754.

A party taking his own testimony thought it was only necessary for him to commence taking his testimony within the time limited. Ignorance held not to excuse.

Mattice v. Langworthy, 140 O. G. 507.

The motion of October 8 which is entitled "a motion for a rehearing" was, in effect, a motion to set aside the decision of October 6 for lack of service of Pickard's motion. As no abuse of discretion on the part of the Examiner of Interferences has been shown in holding that the reasons given were not sufficient to justify the setting aside of his prior decision, it will not be disturbed.

Pickard v. Ashton and Curtis, 137 O. G. 977.

After pleadings have been filed, proofs taken, and the case ready for final hearing, an applicant for cancelation will not be permitted to withdraw his application without prejudice to his right to file a new application.

Ontcault v. The New York Herald Company, 136 O. G. 437.

The rule provides that reasonable notice of all motions must be given and that a motion will not be entertained in absence of proof of service. The same reason exists for re-

quiring notice of the renewal of a motion as of the motion itself, and the mere request at the final hearing is not such notice.

Dyson v. Sand v. Dunbar v. Browne, 133 O. G. 1679.

He therefore granted the motion because the certificate of the notary showed that the requirement of the rule had not been complied with, citing Rolfe v. Taylor, 111 O. G. 1938.

Rhodes v. Rhodes, 132 O. G. 680. But see note to Rule 159.

That a notice was not served in time should be remedied by an extension of time, and not noted on the record for subsequent consideration.

Phillips v. Scott, 130 O. G. 1312.

The statement made by an officer charged with the duty of correctly recording the testimony of a witness and such events as counsel may desire to have recorded can not be overcome by the oath of a single witness.

Munsler v. Ashworth, 129 O. G. 2085-2088.

A motion to amend declaration in a trade-mark case so as to insert a statement of ten years' exclusive use, which statement had been previously withdrawn in view of testimony in an interference case, refused.

Kenyon, 125 O. G. 1702.

The signature to a notice is sufficient if the party notified understands from the signature from whom or in whose interest the notice is given.

Heyne, Haywood & McCarthy v. De Vilbliss, Jr., 125 O. G. 669; Adams-Randall, 125 O. G. 1700.

Where affidavits are filed by any of the parties which are not in answer to affidavits filed by opponents, they must ordinarily be served upon the opponents at least five days before the hearing. Affidavits in rebuttal may then be filed, but should be served before the hearing.

Browne v. Stroud, 122 O. G. 2688.

The petition must be denied on the merits, but it is to be noted also that copies were not served upon the opposing parties, and that therefore it is informal.

Kolb v. Hemmingway v. Curtis, 122 O. G. 1397.

It is the well-settled practise of this Office, as announced in Kletsker & Goesel v. Dodson, 109 O. G. 1336, C. D. 1904, 100, and other decisions, that an appeal filed after the expiration of the limit of appeal will not be entertained except upon a verified showing why it was not presented in proper time.

Thullen v. Young & Townsend, 120 O. G. 904.

The time of hearing is a matter resting in the discretion of the tribunal before whom the case is pending.

Cazin v. Von Welsbach, 119 O. G. 550.

A petition to suspend an interference and declare a new one will not be considered when the opposing party was not notified.

Hansen, 117 O. G. 2632.

A notice given at 10 o'clock that testimony was to be taken at 2, where all parties attended and the testimony was brief, testimony not stricken out, notwithstanding moving party refused to cross-examine.

Roberts v. Webster, 115 O. G. 2135.

It seems service of papers on Saturday afternoon in the District of Columbia is legal.

Goodfellow v. Jolly, 115 O. G. 1064.

New grounds for dissolution, not of record in either application and not included in the motion, must be served upon the opposing party at least 5 days before the hearing. If notice of the new grounds is not served, and service is not waived, these grounds will not be considered by the Primary Examiner in deciding the motion. (Wells v Parker, 90 O. G. 1947; Summers v. Hart, 98 O. G. 2585; Kurz v. Jackson v. Pierce, 2586; Whitlock v. Hudson v. Scott, 99 O. G. 1385.) In cases where due service of the new grounds could not have been rendered, a postponement of the hearing should be requested, and the request being accompanied by a statement of facts.

Young v. Eick, 113 O. G. 547; Fowler, 113 O. G. 549.

A notice that would necessitate travel on Sunday is insufficient. Counsel must be given time to prepare for a journey.

Goodfellow v. Jolly, 111 O. G. 1940.

Notice served June 16, at 12 o'clock, for taking testimony in Erie, Pa., 10 A. M. June 18, is insufficient, even if it contained names of witnesses.

Tripp v. Wolff v. Ames, 108 O. G. 563.

An affidavit filed after the hearing relating to the merits stricken from the files, as these rules contemplate that a party shall be given notice of his opponent's case before the hearing.

Miller, 105 O. G. 1532-33.

It should be noted that both applications here involved are owned by the same party, and that the same attorney appears for both parties; under such circumstances the Office should be particularly on its guard to prevent unreasonable delays. Unreasonable delays in the prosecution of interferences will not be permitted merely because the parties agree to the delay.

Sponsel v. Darling, 105 O. G. 498.

Notice of new matter in cases transmitted under Rule 126.

Greenawalt v. Mark, 103 O. G. 1913.

All parties must be notified.

Grand v. Abbott v. Grand & McGraw, 103 O. G. 662.

Motions in which no proof of service upon the opposite party is made will not be entertained.

Bechman v. Johnson, 1889 C. D. 184; 48 O. G. 673; C. C.. 97 O. G. 2531; 92 O. G. 1236; 1890 C. D. 125.

The notice of certain named witnesses and, perhaps, others, does not warrant the taking of the testimony of any witnesses than those named, at least under the circumstances of the case. A notice one day that the testimony will be taken the next day is not sufficient where attorneys are in a distant city and only represented by an associate attorney.

Potter v. Ochs, 95 O. G. 1049, 1901 C. D. 39.

It is not the practice of the Office to require a party to serve upon his opponent copies of all office records referred to in a motion made by him.

Bundy v. Rumbacker, 92 O. G. 2002, 1900 C. D. 143.

A petition that a certain application be withdrawn from issue, and a rule made that cause be shown why the order should not be made permanent.

Spielman, 1892 C. D. 1; 58 O. G. 141.

A motion based upon the same state of facts and reasons as a previous one should be refused on the ground that the matter is *res adjudicata.*

Little v. Little, Pillard & Sargent, 1876 C. D. 207, 15 O. G. 543; Banks v. Snediker, 1880 C. D. 95, 17 O. G. 508.

A motion with notice is only necessary when a demand is made which may be refused. When a motion is made which must be granted, it is not a motion in the sense of this rule.

Booth v. Lyman, 1880 C. D. 170, 17 O. G. 393.

The usual rule is to exclude the first or last day of the notice, when not personally served.

Hoag v. Abbott, 1879 C. D., 15 O. G. 471.

A concession of priority excluded as evidence by the Examiner of Interferences for want of notice.

Tucker v. Kahler, 1879 C. D. 71, 15 O. G. 966.

A party cannot move to reform the declaration of interference without notice.

Gray v. Bell, 1878 C. D. 133, 15 O. G. 133; Bell v. Gray, 15 O. G. 776, 1879 C. D. 42.

If a party would be compelled to travel night and day, the notice is not reasonable.

Hoag v. Abbott, 1879 C. D. 3, 15 O. G. 471.

The appearance of a party in a case, and the submission of arguments on the merits of the disputed points, is a virtual waiver of the right of notice.

Keller & Olmsdahl v. Felder, 1876 C. D. 246, 10 O. G. 944

The usual rule is to exclude the first or last day of the notice when not personally served.

Hoag v. Abbott, 1879 C. D. 3, 15 O. G. 471.

The name of a witness was not given.

Kenerson v. Brown & Brown, 779 C. D. 249, 16 O. G. 857; Masury, 73 C. D. 110.

Rule 154. Notice of Taking Depositions.

The following rules have been established for taking and transmitting testimony in interferences and other contested cases:

(*a*) Before the depositions of witnesses shall be taken by either party due notice shall be given to the opposing party, as hereinafter provided, of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and of the names and residences of the witnesses to be examined, and the opposing party shall have full opportunity, either in person or by attorney, to cross-examine the witnesses. If the opposing party shall attend the examination of witnesses not named in the notice, and shall either cross-examine such witnesses or fail to object to their examination, he shall be deemed to have waived his right to object to such examination for want of notice. Neither party shall take testimony in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other can not be had.

(*b*) The notice for taking testimony or for motions must be served (unless otherwise stipulated in an instrument in writing filed in the case) upon the attor-

ney of record, if there be one, or, if there be no attorney of record, upon the adverse party. Reasonable time must be given therein for such adverse party to reach the place of examination. Service of such notice may be made in either of the following ways: (1) By delivering a copy of the notice to the adverse party or his attorney; (2) by leaving a copy at the usual place of business of the adverse party or his attorney with some one in his employment; (3) when such adverse party or his attorney has no usual place of business, by leaving a copy at his residence, with a member of his family over 14 years of age and of discretion; (4) transmission by registered letter; (5) by express. Whenever it shall be satisfactorily shown to the Commissioner that neither of the above modes of obtaining or reserving notice is practicable, the notice may be published in the Official Gazette. Such notice shall, with sworn proof of the fact, time, and mode of service thereof, be attached to the deposition or depositions, whether the opposing party shall have cross-examined or not.

(*c*) Each witness before testifying shall be duly sworn according to law by the officer before whom his deposition shall be taken. The deposition shall be carefully read over by the witness, or by the officer to him, and shall then be subscribed by the witness in the presence of the officer. The officer shall annex to the deposition his certificate showing (1) the due administration of the oath by the officer to the witness before the commencement of his testimony; (2) the name of the person by whom the testimony was written out, and the fact that, if not written by the officer, it was written in his presence; (3) the presence or absence of the adverse party; (4) the place, day, and

hour of commencing and taking the deposition; (5) the reading by, or to, each witness of his deposition before he signs the same; and (6) the fact that the officer was not connected by blood or marriage with either of the parties, nor interested, directly or indirectly, in the matter in controversy. The officer shall sign the certificate and affix thereto his seal of office, if he have such seal. He shall then, without delay, securely seal up all the evidence, notices, and paper exhibits, inscribe upon the envelope a certificate giving the title of the case, the name of each witness, and the date of sealing, address the package, and forward the same to the Commissioner of Patents. If the weight or bulk of an exhibit shall exclude it from the envelope, it shall be authenticated by the officer and transmitted in a separate package, marked and addressed as above provided.

(*d*) If a party shall be unable to take any testimony within the time limited, and desire an extension for such purpose, he must file a motion, accompanied by a statement under oath setting forth specifically the reason why such testimony has not been taken, and distinctly averring that such motion is made in good faith, and not for the purpose of delay. If either party shall be unable to procure the testimony of a witness or witnesses within the time limited, and desire an extension for such purpose, he must file a motion, accompanied by a statement under oath setting forth the cause of such inability, the name or names of such witness or witnesses, the facts expected to be proved by such witness or witnesses, the steps which have been taken to procure such testimony, and the dates on which efforts have been made to procure it. (See Rule 153.)

(*e*) Upon notice given to the opposite party before the closing of the testimony, any official record, and any special matter contained in a printed publication, if competent evidence and pertinent to the issue, may be used as evidence at the hearing.

(*f*) All depositions which are taken must be duly filed in the Patent Office. On refusal to file, the office at its discretion will not further hear or consider the contestant with whom the refusal lies; and the office may, at its discretion, receive and consider a copy of the withheld deposition, attested by such evidence as is procurable.

Rev. Stat., sec. 4905.

HISTORY.

In 1869, Rule 50 read in part as follows: "In contested cases no motion will be heard in the absence of the other party, except upon default after due notice; nor will a case be taken up for oral argument after the day of hearing except by consent of both parties. If the engagements of the tribunal before whom the case is pending are such as to prevent it from being taken up on the day of hearing, a new assignment will be made, or the case will be continued from day to day until heard."

And Rule 57 of 1869 reads: "If either party wishes the time for taking his testimony, or for the hearing, postponed, he must make application for such postponement, and must show sufficient reason for it by affidavit filed before the time previously appointed has elapsed, if practicable; and must also furnish his opponent with copies of his affidavits, and with seasonable notice of the time of hearing his application."

In 1870, the following rule was added: "Reasonable notice of all motions and copies of the motion papers and affidavits must be served upon the opposite party or his attorney."

In 1871 the rules read: "In contested cases, reasonable notice of all motions and copies of the motion papers and affidavits must be served upon the opposite party or his attorney. Proof of such service must be made before the motion will be entertained by the Office; and motions will not be heard in the absence of either party except upon default after due notice. Motions will be heard in the first instance by the officer

or tribunal before whom the particular case may be pending; but an appeal from the decision rendered may be taken to the commissioner in person."

See Rule 153 and notes.

CONSTRUCTIONS.

(1) NOTICE.
(2) ORAL STIPULATION.
(3) OFFICIAL CERTIFICATE.
(4) MOTIONS TO EXTEND TIME FOR TAKING TESTIMONY.
(5) OFFICIAL RECORDS AND SPECIAL MATTERS OFFERED IN EVIDENCE.
(6) DEPOSITIONS TO BE FILED IN PATENT OFFICE.
(7) MISCELLANEOUS.

(1) *Notice.*

A deposition was suppressed where a party had given notice once, but not attended at the time and place assigned; afterward he gave a second notice, and took the deposition which was suppressed.

Densten v. Burnham, 126 O. G. 388.

A notice given at 10 o'clock that testimony was to be taken at 2, where all parties attended, and the testimony was brief testimony not stricken out notwithstanding moving party refused to cross examine.

Roberts v. Webster, 115 O. G. 2135.

(2) *Oral Stipulation.*

The certificate of the notary on the record is sufficient proof of the agreement between counsel. An oral stipulation as to taking testimony is sufficient.

Fairbanks & Sauer v. Karr, 113 O. G. 1148.

(3) *Official Certificate.*

The omission of these formalities may be sufficient ground for suppressing the deposition.

Rolfe v. Taylor, 111 O. G. 1938.

(4) *Motion to Extend Time for Taking Testimony.*

The rule is very clear in requiring a verified showing, and there is no excuse for failing to comply with them.

Rippeto v. Stephens, 105 O. G. 1779.

If the irregularities arose through inadvertences, and not

through a desire to delay or overreach, it is proper, upon a satisfactory showing, to extend the time.

The Shaw & Welty Shirt Co. v. The Quaker City Shirt Co., 157 O. G. 1000.

If there is lack of diligence in procuring the testimony, no extension allowed.

McCallum v. Bremer, 1900 C. D. 186, 93 O. G. 1917.

The fact that one is financially unable to take the testimony accepted as an excuse when it appeared that there was a prospect of his becoming so.

Wightman v. Rothenstein, 1902 C. D. 82, 98 O. G. 2172.

A less showing of diligence is required in these than where a case has been decided. The unwillingness of witness.

Watson D. Thomas, 1902 C. D. 90, 98 O. G. 2361.

In the absence of good reasons for delay, the motion will be refused.

Brilland Adams v. Uebelacker, 1902 C. D. 220, 99 O. G. 2966.

Additional time will not be given to afford an opportunity to rebut the testimony that one of the exhibits does not disclose the invention.

Pfatischer v. Buck, 1902 C. D. 390, 101 O. G. 1370.

The action of Davis, in absenting himself beyond all ordinary means of communication, without even leaving his address by which he might be communicated with, must be considered as a waiver of his rights to present his testimony.

Davis v. Cody, 1902 C. D. 388, 101 O. G. 1369.

Ignorance, inadvertence or mistake on the part of a party or his attorney, is no ground for a new trial.

Roberts v. Bachelle, 1902 C. D. 415, 101 O. G. 1831.

Where a party delays taking his testimony until the last of the time allowed, and gives no good reason, time should not be extended.

Reynolds v. Bean, 1902 C. D. 461, 101 O. G. 2821.

The rule as to the sufficiency of the reason is not so strictly applied in regard to the first extension, but in all cases good reasons must be given.

Wilcomb v. Lasher, 1902 C. D. 485, 101 O. G. 3109.

Motion to reopen and further take testimony should be heard and determined in the first instance by the Examiner of Interferences.

Robinson v. Townsend v. Copeland, 106 O. G. 997.

Motion should contain names of witnesses that are to be examined.

Tripp v. Wolf v. Jones, 108 O. G. 563.

Extensions of time not favored.

Dunbar v. Schellinger, 113 O. G. 2213-4; Dalton v. Hopkins v. Newman, 121 O. G. 2666.

(5) *Official Records and Special Matters Offered in Evidence.*

The records of the Patent Office is sufficient to prove the contents of a French patent.

Robin v. Muller and Bonnet, 108 O. G. 292.

The Rules provide for the introduction of records as evidence during the period assigned for taking testimony; but the adverse parties are entitled to introduce such rebuttal as they may be advised to make, after which the case can proceed to hearing and decision upon all the evidence adduced.

Booth v. Lyman, 80 C. D. 151, 18 O. G. 132.

While it is proper, in some cases, to take cognizance of the records of this office which have not been placed in evidence in order that justice may be done (Cain v. Park, 86 O. G. 707), it is not thought that they should ordinarily be examined when not placed in evidence for the sole purpose of discrediting a witness. If they had been placed in evidence T. would have had an opportunity to explain them.

Bowditch v. Todd, 112 O. G. 1477.

(6) *Depositions to be Filed in Patent Office.*

Immediately after taking testimony the notary left for Europe, and did not file testimony until his return. In the absence of any showing of injury to the other side, a motion to suppress was refused.

Moss v. Blaisdell, 113 O. G. 2505.

(7) *Miscellaneous.*

Subject-mater of this rule.

Claasen v. Stiffen, 113 O. G. 2507-8.

The fact that H. said nothing about his invention when he examined the drawings of another might possibly be explained, but his failure to make an application for a year afterward hardly

Harter v. Barrett, 114 O. G. 975.

The provision of the statutes giving an applicant the right to have a claim twice rejected (Secs. 4903 and 4909 R. S.) does not apply in *inter partes* cases where a Primary Examiner, on motion to dissolve, decides that one of the parties has no right to make the claims of an interference issue, and such party, after filing an appeal from said decision, fails to prosecute the same, and abandons it, such decision becomes final and

binding upon the parties, and precludes the subsequent *ex parte* consideration of the same question.

United States of America *ex rel.* The Newcomb Motor Co. v. Moore, Com., etc., 133 O. G. 1680.

The question whether one of the parties to an interference proceeding is debarred from receiving a patent for the same invention is a question of *ex parte* consideration after the termination of the interference.

Gueniffet, Benoit and Nicault v. Wictorsohn, 134 O. G. 255.

It is incumbent upon a party to present the entire case in the first instance; when a case has been decided on stipulation it will not be reopened to take testimony.

De Ferranti v. Lindmark, 137 O. G. 731.

Refusal to explain a certain portion of the device because it was the subject-matter of a separate invention, and failure to file an application therefor, evidence of an abandoned experiment.

Reichenbach v. Rilley, 94 O. G. 1185.

It is essential to the reopening of a case, after the testimony is all taken, and a party is thus put in possession of the facts of his opponent's case, that a clear showing of diligence be made out, and it must be shown that the testimony is material.

Robinson v. Townsend v. Copeland, 1902 C. D. 405, 101 O. G. 1611.

A practice which would allow a contestant to experimentally conduct his own case to a probable failure, and then permit him, after consulting with competent assistance, to make further endeavors to show what he could and should have earlier shown with such assistance, would be contrary to all well-established rules and legal principles.

Werk v. McCurran, 103 O. G. 890.

Now while affidavits would be permitted to show or explain material changes that may have occurred by accident or otherwise, in an exhibit after its transmission to this court, when the details of its construction might be of importance in determining the issue, they will not be received in contradiction or correction of the record of the proceedings in the tribunals of the Patent Office.

Blackford v. Wilder, 104 O. G. 581.

It appears to be well settled that the right to take evidence to explain or surrebut evidence given in rebuttal is a matter resting in the discretion of the court (Greenleaf, Vol. 1, 16 Ed., pp. 601-2), and that this privilege will be extended to a party whenever he has been surprised by evidence or a line of

defense in rebuttal which he has had no reason to anticipate or opportunity to prepare against.

Donning v. Stackpole v. Lagank, 106 O. G. 264; Winton v. Jeffery, 112 O. G. 500.

Rule 155. Formalities.

The pages of each deposition must be numbered consecutively, and the name of the witness plainly and conspicuously written at the top of each page. The testimony must be written upon legal cap or foolscap paper, with a wide margin on the left-hand side of the page, and with the writing on one side only of the sheet.

Rule 156. Testimony.

The testimony will be taken in answer to interrogatories, with the questions and answers committed to writing in their regular order by the officer, or, in his presence, by some person not interested in the case either as a party thereto or as attorney. But with the written consent of the parties the testimony may be taken stenographically, and the deposition may be written out by other persons in the presence of the officer.

Where testimony is taken stenographically, a long-hand or typewritten copy shall be read to the witness, or read over by him, as soon as it can be made, and shall be signed by him as provided in paragraph 3 of Rule 154. No officer who is connected by blood or marriage with either of the parties, or interested, directly or indirectly, in the matter in controversy, either as counsel, attorney, agent, or otherwise, is competent to take depositions, unless with the written consent of all the parties.

CONSTRUCTIONS.

Where the testimony was taken stenographically, and transcribed, 24 days' delay was not considered unreasonable. In the absence of any stipulation, the objection that the notary permitted the exhibits to be taken out of his possession and custody is well taken.

Rolfe v. Taylor, 111 O. G. 1938.

The objection that the testimony was taken stenographically, without written consent, of no force when the moving party did not attend. This rule should be read with R. 159, that says no attention will be given to merely formal objections.

Rolfe v. Taylor, 111 O. G. 1938.

Objection to a notary because he was an employe of the attorney, not made at the taking of the testimony, is waived.

Royce v. Kempshall, 117 O. G. 2090.

Rule 156 does not apply to preliminary statements.

Bundy v. Rumbarger, 1900 C. D. 94, 91 O. G. 2210.

Rule 157. Testimony Taken in one Interference may be Used in Another.

Upon motion duly made and granted (see Rule 153) testimony taken in an interference proceeding may be used in any other or subsequent interference proceeding, so far as relevant and material, subject, however, to the right of any contesting party to recall witnesses whose depositions have been taken, and to take other testimony in rebuttal of the depositions.

CONSTRUCTIONS.

In an interference between H. and T., a witness testified to certain facts. Later, in an interference between H. and W., he denied any knowledge of these facts. Held, that T. and W. not being parties, the testimony in the former interference cannot be admitted in the latter except for the purpose of discrediting the witness, even if the witness is present and may be cross-examined.

Hewitt v. Weintraub, 134 O. G. 1561.

Where the real parties in interest in a pending interference are the same as in a prior interference, and the inventions involved are substantially the same, permission may be obtained

to use, in the pending interference, the testimony taken in the former interference.

Beall, Jr., v. Lyn, 127 O. G. 3215.

The motion should not be denied because the present interference relates to a process, whereas the other interferences relate to apparatus, or because it contains unnecessary matter.

Strube v. Young, 119 O. G. 338.

It is not contrary to the fundamental rules of evidence to use in one cause depositions given in another cause involving the same parties.

Kenny and Thordarson v. O'Connell v. Baird v. Schmidt, 117 O. G. 1163.

The object sought to be attained by consolidation can be accomplished by stipulating that the record taken in one interference can be used in the other.

Klein v. Groebli, 110 O. G. 305.

Where in one interference one of the applicants admits that the proceeding is closely related to another interference in which he was involved, and introduces in evidence the decision in that other interference in which he was involved, and says that there is no objection to the introduction of the entire record, Held, that the opposing party may refer to the entire record without printing it as a part of the proofs.

Hall v. Weber, 108 O. G. 1054.

If the new interference is declared, Foote may make a motion under Rule 157 to use the present testimony. Until the new interference is disclosed, such a motion cannot be entertained.

Brooks v. Foote v. Wenk, 108 O. G. 287.

It is well settled that Rule 157 relates merely to the form in which testimony may be introduced, and does not modify the other rules relating to the taking of testimony.

The motion under consideration is not accompanied by a showing why Stackpole and Langanke did not introduce the testimony of which they desire to avail themselves at the time originally set for taking testimony.

Doning v. Stackpole & L., 107 O. G. 268.

Even where such testimony is not admissible, it may be referred to for the purpose of discrediting a witness.

Talbot v. Morrell, 1902 C. D. 216, 99 O. G. 2965.

Subject-matter of this rule.

Wilson v. Haines, 1891 C. D. 210.

Rule 158. Testimony Taken in Foreign Countries.

Upon motion duly made and granted (see Rule 153) testimony may be taken in foreign countries, upon complying with the following requirements:

(*a*) The motion must designate a place for the examination of the witnesses at which an officer duly qualified to take testimony under the laws of the United States in a foreign country shall reside, and it must be accompanied by a statement under oath that the motion is made in good faith, and not for purposes of delay or of vexing or harassing any party to the case; it must also set forth the names of the witnesses, the particular facts to which it is expected each will testify, and the grounds on which is based the belief that each will so testify.

(*b*) It must appear that the testimony desired is material and competent, and that it can not be taken in this country at all, or can not be taken here without hardship and injury to the moving party greatly exceeding that to which the opposite party will be exposed by the taking of such testimony abroad.

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

(*d*) As soon as the interrogatories and cross-interrogatories are decided to be in proper form, the Commissioner will cause them to be forwarded to

the proper officer, with the request that, upon payment of, or satisfactory security for, his official fees, he notify the witnesses named to appear before him within a designated time and make answer thereto under oath; and that he reduce their answers to writing, and transmit the same, under his official seal and signature, to the Commissioner of Patents, with the certificate prescribed in Rule 154 (*c*).

(*e*) By stipulation of the parties the requirements of paragraph (*c*) as to written interrogatories and cross-interrogatories may be dispensed with, and the testimony may be taken before the proper officer upon oral interrogatories by the parties or their agents.

(*f*) Unless false swearing in the giving of such testimony before the officer taking it shall be punishable as perjury under the laws of the foreign state where it shall be taken, it will not stand on the same footing in the Patent Office as testimony duly taken in the United States; but its weight in each case will be determined by the tribunal having jurisdiction of such case.

Rev Stat., sec. 4905.

CONSTRUCTIONS.

A motion refused for want of a sufficient showing.

Winn v. Thuillier v. Frisbie & Baker, 180 O. G. 1138.

Motion to strike out improper cross-interrogatories properly granted before final hearing.

Actiengesellschaft Paulanerbrau Salvatorbrauerei v. Conrad Scipp Brewing Co., 135 O. G. 1121.

It appears that G. is not employed by the Company which is the assignee of Rupling's invention, and therefore that company has no such control over him as would make it incumbent upon them to send him to this country. A party who has regular employment cannot be presumed to be willing to give up that employment for the purpose of giving his testimony in a foreign country. Such cases differ from one in which the inventor himself, or a witness in his employ, de-

clines to leave his business for the purpose of testifying in a foreign country. Affidavits.

Lowry v. Rupling, 135 O. G. 662.

Expert evidence that the issues are not patentable to either party is not pertinent to the question of priority, and may not be admitted.

Dixion and Marem v. Graves & Whittemore, 127 O. G. 1993.

Written interrogatories necessary.

Herreschoff v. Knietsch, 111 O. G. 1039.

But not without mutual consent.

Heresehoff v. Knietsch, 111 O. G. 1039.

G. wishes to show that S. received his knowledge of the invention from parties who received their knowledge from G. The facts alleged tend to support this contention, and G. should not be prevented from proving those facts merely upon the suggestion of an ulterior motive. Any improper question will appear when the interrogatories are filed.

Stiff v. Galbraith, 108 O. G. 290.

Testimony cannot properly be taken in foreign countries otherwise than as prescribed by Rule 158 (3), unless the procedure be waived by stipulation of the parties. Rule 158 (5).

Raffard v. DeFerranti, 1892 C. D. 161.

The commissioner has power to issue letters rogatory for the taking of testimony, whereas in Germany, the ordinary commission cannot legally be executed. The letters will be issued upon a proper showing when the interrogatories to be propounded have been filed.

Potter v. Ochs, 97 O. G. 1835, 1901 C. D. 205.

The date of filing an application for a British patent is immaterial in a question of priority, and leave to take testimony for this purpose will not be granted. The convention has not been made effective in this country by Congress, notwithstanding the U. S. has adhered to it.

Butterworth v. Brac and Kymer v. Ecob, 97 O. G. 1596; 1901 C. D. 193.

Without the antecedent authority of the Commissioner, depositions taken in a foreign country are inadmissible as evidence.

Lander v. Crowell, 1879 C. D. 177, 16 O. G. 405.

Rule 159. Evidence on Hearing.

Evidence touching the matter at issue will not be considered on the hearing which shall not have been

taken and filed in compliance with these rules. But notice will not be taken of merely formal or technical objections which shall not appear to have wrought a substantial injury to the party raising them; and in case of such injury it must be made to appear that, as soon as the party became aware of the ground of objection, he gave notice thereof to the office, and also to the opposite party, informing him at the same time that, unless it be removed, he (the objector) will urge his objection at the hearing. This rule is not to be so construed as to modify established rules of evidence, which will be applied strictly in all practice before the office.

CONSTRUCTIONS.

The junior party alleges the filing of a caveat. He has also alleged other disclosures in his preliminary statement, and it is optional with him whether to rely upon the caveat or not. If he does not wish to rely upon his caveat, he is justified in withholding it from inspection. If he offers his caveat in evidence the other party will be able to inspect it.

Stauft v. Reeder, 157 O. G. 208.

Deposition not read. It was alleged reading was waived. No notice whatever appears to have been given either to the Office or to the opposing party. For this reason it is believed that the deposition should not have been suppressed.

Rhodes v. Rhodes, 132 O. G. 680.

A motion to suppress testimony in the decision of which a review of a large portion of the testimony would be involved will be postponed to the final hearing.

Dyson v. Sand v. Dunbar v. Browne, 130 O. G. 1690.

Where the motion to suppress testimony was granted after the testimony was printed, it will be a sufficient compliance with the ruling in Marconi v. Shoemaker v. Fessenden, 121 O. G. 2664, for the docket clerk to indicate in the usual manner in the printed record the matter which has been expunged.

130 O. G. 1690.

A refusal to suppress testimony not reversible error.

Kempshall v. Royce, 129 O. G. 3162.

Affidavit of a physician that a witness was unable to testify not admissible. The physician should have been called.

Munsler v. Ashworthy, 128 O. G. 2088.

Objections made when the testimony is taken must be specific. (Authorities.)

Emmet v. Fullagar, 124 O. G. 2178.

Where the witness, upon direct examination, refuses to answer practically every question regarding particular apparatus, and no questions are asked thereon about the detailed structure of the apparatus, or about theories, principles, operations, or results, a deposition on cross-examination setting forth such matters throughout fifty or more typewritten pages is *prima facie* bad.

Marconi v. Shoemaker v. Fessenden, 121 O. G. 2664.

An appeal from the Examiner's ruling raises only the question whether or not the Examiner was right in postponing the consideration of the question, which is a matter that will not be reviewed and reversed except in a clear case of abuse of discretion.

Royce v. Kempshall, 119 O. G. 338.

The objection to certificate because it fails to state whether a party or his attorney was present when the deposition was taken, but both of the parties agree that neither said party nor his attorney was present, is not substantial, nor is a slight delay, not caused by a party, sufficient to warrant the striking out of the testimony.

Royce v. Kempshall, 117 O. G. 2090.

The Court of Appeals will not review a decision of the Commissioner expunging testimony, but applicant may have relief under R. S. 4915 and 4918.

Jones v. Starr, 117 O. G. 1495.

The Notary acted outside of the territory in which he was authorized to administer oaths. "The reservation" (in the stipulation) "of certain objections, and the failure to reserve the one now made taken with the delay in making the objection must be regarded as a waiver."

Badger v. Morgan & Hoheisel, 117 O. G. 598.

If the testimony of a wife in favor of her husband in such a matter as the present is admissible at all, and if disclosure to a wife is disclosure of an invention to others or to the public, in the sense of the Patent Law, about which grave doubts may well be entertained, certainly such testimony must be rigidly scrutinized, and not lightly admitted as sufficient without corroboration.

Harter v. Barrett, 114 O. G. 975.

The testimony of Harter's father-in-law amounts to nothing, for he does not tell what was disclosed to him, except in a

most vague and general way that is utterly useless for the purpose of the corroboration of Harter's statement.

Harter v. Barrett, 114 O. G. 975.

When the deposition is suppressed because of unfair and overreaching conduct, to the prejudice of the adverse party, the denial of a motion to retake the testimony is proper.

Jones v. Starr, 111 O. G. 2221.

The omission of these formalities does not seem to be good grounds for suppressing the deposition.

Rolfe v. Taylor, 111 O. G. 1938.

It has been the uniform practice not to suppress the testimony before final hearing.

Talbot v. Monell, 1902 C. D. 216, 99 O. G. 2965; Hall v. Alvord, 1902 C. D. 418, 101 O. G. 1833; Andrews v. Nelson,, 101 O. G. 1038.

A motion to suppress testimony in the determination of which the entire case will have to be gone into will be postponed to the final hearing.

Hall v. Alvord, 1902 C. D. 418, 101 O. G. 1833.

Because of formal irregularities, testimony ordered retaken.

Blackman v. Alexander, 1902 C. D. 323, 100 O. G. 2383.

See also Hewitt v. Wientraub, 134 O. G. 1561.

Rule 160. Subpoenas.

The law requires the clerks of the various courts of the United States to issue subpoenas to secure the attendance of witnesses whose depositions are desired as evidence in contested cases in the Patent Office.

Rev. Stat., sec. 4906.

H. B. No. 11984 has a provision for subpoenas duces tecum.

CONSTRUCTIONS.

The filing of a motion in a court to compel a witness to answer is a simple matter, and an unexplained delay of three weeks is sufficient to authorize a refusal to extend time for taking testimony.

Donning v. Anderson, 111 O. G. 582.

Rule 161. Inspection.

After testimony is filed in the office it may be inspected by any party to the case, but it can not be withdrawn for the purpose of printing. It may be

printed by someone specially designated by the office for that purpose, under proper restrictions.

Rule 162. Copies of Testimony.

Thirty-one or more printed copies of the testimony must be furnished—five for the use of the office, one for each of the opposing parties, and twenty-five for the Court of Appeals of the District of Columbia, should appeal be taken. If no appeal be taken, the twenty-five copies will be returned to the party filing them. The preliminary statement required by Rule 110 must be printed as a part of the record. These copies of the record of the junior party's testimony must be filed not less than forty days before the day of final hearing, and in the case of the senior party not less than twenty days. They will be of the same size, both page and print, as the Rules of Practice, with the names of the witnesses at the top of the pages over their testimony, and will contain indexes with the names of all witnesses and reference to the pages where copies of papers and documents introduced as exhibits are shown.

When it shall appear, on motion duly made and by satisfactory proof, that a party, by reason of poverty, is unable to print his testimony, the printing may be dispensed with; but in such case typewritten copies must be furnished—one for the office and one for each adverse party. Printing of the testimony can not be dispensed with upon the stipulation of the parties without the approval of the Commissioner.

HISTORY.

Amended to read thirty-one and twenty-five. March 29, 1901.

95 O. G. 235.

CONSTRUCTIONS.

If junior party fails to print, judgment of priority in favor of opposing party.

Browne v. Gillitt, 191 O. G. 832.

If a party is excused from printing his testimony, if it is necessary for the offering party to appeal to the Court of Appeals, it would throw upon him the burden of printing his opponent's testimony. A party ought not, therefore, be excused except in extreme cases.

Landau v. Spitzenberg, 159 O. G. 742.

Default relieved against. Doubted if default is the penalty of disregarding this rule.

Dunkley v. Bickjuist, 158 O. G. 886.

The assets of the company should be set out in the affidavit.

McManus v. Hammer, 143 O. G. 562.

Must show that all interested parties are unable to print.

McManus v. Hammer, 143 O. G. 561.

That it is inconvenient for the party to print the record not sufficient.

McManus v. Hammer, 143 O. G. 562.

Considering C.'s request for sufficient time to permit him to print and file his testimony forty days before the final hearing, T. agreeing, it will be granted.

Corrington v. Turner, 136 O. G. 1067.

Appeal will lie from an order striking an application from the files on account of an unauthorized amendment or alteration.

Moore v. Heaney, 34 App. D. C. 31.

Will review a holding that an application is abandoned.

Selden, 164 O. G. 741.

The fact that the senior party took no testimony is not a sufficient reason for waiving the requirements of the rule.

Alberson Bros. Milling Co. v. Forest, 311 O. G. 1419.

Reopening of case to permit party to print his opponent's testimony refused in view of the delay.

Parker v. Corkhill, 130 O. G. 2067.

If only one party takes testimony, still he must print it.

Peak v. Brush, 129 O. G. 1268.

Last clause—This provision is not to be extended.

Dow v. DesJardins, 119 O. G. 1923.

Judgment on the record was rendered against a party who had failed to print his testimony without considering his testimony.

Cooper & Somers v. Bannister, 112 O. G. 1480.

Subject-matter of this rule.
Faller v. Lorimer, 111 O. G. 579.
Rule requiring testimony to be printed is of binding force.
Plummer v. Penniston, 1894 C. D. 60.

BRIEFS.

Rule 163. Size and Time of Filing Briefs.

Briefs at final hearing and on appeals from final decisions in contested cases shall be submitted in printed form and shall be of the same size and the same as to page and print as the printed copies of testimony. But in case satisfactory reason therefor is shown, typewritten briefs may be submitted. Six copies of the briefs at final hearing shall be filed three days before the hearing. Briefs on appeals shall be filed as provided in Rule 144.

At interlocutory hearings and on appeal from interlocutory decisions typewritten briefs may be used, and such briefs may be filed at or before the hearing. By stipulation of the parties or by order of the tribunal before whom the hearing is had briefs may be filed otherwise than as here prescribed.

CONSTRUCTIONS.

These rules were construed in Newcomb v. Simp (109 O. G. 2171), where it was held that the typewritten briefs might be received on motions and on interlocutory appeals, and that it was unnecessary to file printed copies, as required by Rule 147, except for final hearings.

Stevens v. Patterson, 142 O. G. 568.

See note to Rule 147.

It is a general principle of law that the statements of counsel with regard to a case are privileged, and that he is permitted to use language in his argument, and make statements in his brief which, if used out of court, might be considered objectionable.

Schellenbach v. Harris, 111 O. G. 2223.

One brief on a side. The requirement of printing not applicable to interlocutory motions and appeals.

109 O. G. 2172.

A brief filed after the hearing, without the consent of the Examiner, expunged from the files. An accompanying affidavit also canceled from the files.

Miller, 105 O. G. 1532.

The records of the office, being regular, will be accepted as evidence of allowance and notice of that fact. The Commissioner has no authority to extend the time for paying the final fee.

Haeseler & Taylor, 101 O. G. 2826.

Affidavits as to the opinions as to the scope and meaning of the issue, and as to the question of interference in fact between the claims involved in this interference, are inadmissible.

Summers v. Hart, 1902 C. D. 104, 98 O. G. 2585-6.

Proper divisional patents between process and product, machine and product and machine and method, should issue simultaneously, and not otherwise.

Holt, 29 O. G. 170.

ISSUE.

Rule 164. Notice of Allowance.

If, on examination, it shall appear that the applicant is justly entitled to a patent under the law, a notice of allowance will be sent him or his attorney, calling for the payment of the final fee within six months from the date of such notice of allowance, upon the receipt of which within the time fixed by law the patent will be prepared for issue. (See Rules 167, 194.)

Rev. Stats., secs. 4885, 4893, 4897.

CONSTRUCTIONS.

The records of the Office, being regular, will be accepted as evidence of allowance and notice of that fact. The Commissioner has no authority to extend the time for paying the final fee.

Haeseler & Taylor, 101 O. G. 2826.

Under the practice of the Office, after an application has been allowed, and the notice of allowance sent to the applicant or his agent, the act of allowance is complete, and the application can only be returned to the jurisdiction of the Ex-

aminer by a formal withdrawal of the application from the issue files.

100 O. G. 2774.

Proper divisional patents between process and product, machine and product and machine and method, should issue simultaneously, and not otherwise.

Holt, 29 O. G. 170.

Rule 165. Withdrawal from Issue.

After notice of the allowance of an application is given, the case will not be withdrawn from issue except by approval of the Commissioner, and if withdrawn for further action on the part of the office a new notice of allowance will be given. When the final fee has been paid upon an application for letters patent, and the case has received its date and number, it will not be withdrawn from issue on account of any mistake or change of purpose of the applicant or his attorney, nor for the purpose of enabling the inventor to procure a foreign patent, nor for any other reasons except mistake on the part of the office, or because of fraud, or illegality in the application, or for interference. (See Rule 78.)

CONSTRUCTIONS.

Will not be withdrawn for the insertion of an invention so distinct as to require a suplemental oath, even for the purpose of an interference.

Stimson, 226 O. G. 699.

The final fee having been paid, and the case having received its date and number, under Rule 165.

Orandoff, 140 O. G. 1001.

Applicant filed an amendment withdrawing claims rejected, and on the same day filed an appeal and withdrawal of such amendment. Held, that the appeal should be forwarded.

Kruse, 133 O. G. 229.

It is not the practice of the Office to withdraw a case from issue unless the Office has made an obvious mistake, except in cases where irremediable injury would occur. In this case applicant is not without remedy, for he can allow the case to be-

come forfeited, renew the same, and present the claims of the Parker patent, and secure the interference he desires.

Meyer, 130 O. G. 1689.

Issue not stayed to await result of bill in equity under R. S., sec. 4915.

Dunbar v. Shellinger, 129 O. G. 2087.

See order, 122 O. G. 735.

For interference. If the application is now withdrawn from issue, it will be necessary for this Office to stamp the patent "withdrawn" in seven thousand copies of the Official Gazette, and to make the proper entries in the records. Such a burden should not be placed upon the Office through no fault of its own, except under extraordinary circumstances. Petition denied.

Dorman, 102 O. G. 1049.

The application will not be withdrawn from issue to await the termination of an interference in which a divided application is involved, so that patents on the two applications may issue on the same day.

Carroll, 115 O. G. 510.

See 94 O. G. 2169.

The withdrawal of an application from issue for the purpose of inserting a claim previously presented and voluntarily canceled will not be permitted.

Blakeslee, 1893 C. D. 72, 63 O. G. 1201.

Motion to vacate an interference judgment because of alleged misunderstanding as to what applications were included denied.

Huntor v. Knight, 1892 C. D. 211.

An application will not be withdrawn from issue for the insertion of new claims because applicant was surprised by the allowance after the interference had terminated, when he knew it was ready for allowance.

Pierce, 1901 C. D. 224, 97 O. G. 2307.

For mode of procedure, see order No. 629, Oct. 15, '98, published in O. G., 92d volume, and page 1239.

An application will not be withdrawn from issue for the purpose of adding claims to a feature described and reserved, but not claimed in a prior patent to the same inventor, because of the fact that more than two years have elapsed since said prior patent was issued, when it appears that a new application can be filed in such a manner that the two applications may be considered continuous.

Schieling, 1892 C. D. 147, 60 O. G. 160; Nash, 1892 C. D. 146, 60 O. G. 15A.

The rule that an application will not be withdrawn from issue for the purpose of allowing an applicant to amend his claims is subject to exception only in cases where its enforcement would work irremediable injury.

Gold, 1892 C. D. 138, 59 O. G. 2067.

An application will not be withdrawn from issue to permit applicant to reinsert a claim originally presented, but voluntarily erased.

Wood, 1892 C. D. 4.

An application will not be withdrawn from issue if such withdrawal will have the effect, directly or indirectly, of extending the time allowed by law for the payment of the final fee.

Brand, 1891 C. D. 134, 56 O. G. 1062.

Where an application has been once forfeited and renewed, it will not be withdrawn from issue for the purpose of adding new claims in the absence of a showing of hardship.

Myer, 1891 C. D. 6, 54 O. G. 265.

A case will not be withdrawn from issue for the sake of incorporating the claims of a forfeited application.

Hopkinson, 1891 C. D. 4, 54 O. G. 264.

Amendment after allowance, in case a refusal would work irreparable injury; as to introduce claims that could not be claimed in a separate application.

Myer, 1889 C. D. 198, 49 O. G. 131.

A patent may be withheld any time before it is both signed and sealed.

Hunt, 1878 C. D. 149.

When the Commissioner may deem it improper to complete the issuance of a patent after it has been signed, he should forthwith transmit the case, before taking further action therein, with his reasons for declining to complete the issuance of such patent, to the Secretary of the Interior, for consideration and instruction.

Hunt, 1878 C. D. 149.

The Commissioner has a right to withhold from issue a patent allowed by one of his subordinate officers.

Hull v. The Commissioner of Patents, 2 McArthur, 90.

Subject-matter of the rule.

Simonson, 1890 C. D. 177, 53 O. G. 1571.

Rule 166. Withdrawal from Issue will not stay Abandonment.

Whenever the Commissioner shall direct the withdrawal of an application from issue on request of an applicant for reasons not prohibited by Rule 165, this withdrawal will not operate to stay the period of one year running against the application, which begins to attach from the date of the notice of allowance.

CONSTRUCTIONS.

Where an application is withdrawn from issue at the request of the applicant to await the allowance of a related application, and no action is taken therein until after the expiration of the statutory period allowed for taking action, which dates from the notice of allowance, the application is abandoned in the absence of special circumstances excusing the delay.

Brooks, 127 O. G. 847.

DATE, DURATION AND FORM OF PATENTS.

Rule 167. Date of Patent.

Every patent shall issue within a period of three months from the date of the payment of the final fee, which fee shall be paid not later than six months from the time at which the application was passed and allowed and notice thereof was sent to the applicant or his agent; and if the final fee be not paid within that period the patent shall be withheld. (See Rule 175.) In the absence of request to suspend issue the patent will issue in regular course. The issue closes weekly on Thursday, and the patents bear date as of the fourth Tuesday thereafter.

A patent will not be antedated.

Rev. Stat., secs. 4885, 4935.
See notes to Rules 164 and 194.

CONSTRUCTIONS.

The records of the Post Office taken as conclusive that a letter containing the final fee was not put into a receptacle set apart for the Patent Office until after the expiration of the time limited.

In re Dempsey, 132 O. G. 1074.

The Post Office is the agent of the sender in transmitting the final fee.

Dempsey, 132 O. G. 1072.

It was said the notice was not received. It is not alleged that no notice was mailed, and the record indicates clearly that it was mailed. Under such circumstances, this Office has no jurisdiction to extend the time for the payment of the final fee, either directly or indirectly.

Glafke, 122 O. G. 351.

It is the time of sending the notice that time is to be reckoned from. The records of the Office are proper to fix this date. The Office cannot extend the time.

Pieper, 115 O. G. 1063.

The final fee must be delivered. It is not sufficient that it was deposited in the mail in due time. Applicant is responsible for the agent he chooses for transmission.

Cannon, 94 O. G. 2165.

Notice to the inventor is equivalent to notice to the administrator.

Deeter, 93 O. G. 190-91.

Six calendar months.

Brown, 1893 C. D. 64, 63 O. G. 759.

There is no discretion in the Commissioner to receive the fee after the time limited.

Anderson, 1892 C. D. 221, 61 O. G. 886.

Not even if the last day falls on a holiday.

Mills, 1892 C. D. 11, 62 O. G. 317.

Handing twenty dollars to a watchman not employed by the Patent Office, at 11:55 P. M. on the last day of the six months' limit is not a payment of a final fee to the Office within the six months allowed by law.

Poulter, 1891 C. D. 205, 57 O. G. 1128; approved by sec. 1892 C. D. 241, 58 O. G. 241.

Inventor, or assignee, to file a new application for the invention within two years after the date of allowance. In the consolidation of the patent laws in 1870, however, the provisions of the Acts of 1863, that upon the forfeiture of the application the invention shall become public property, as against the applicant therefor, was omitted.

Hardy, 1877 C. D. 110; Livingston, 1881 C. D. 42.

Where a patent fee is paid to a subordinate specifying the case, it is effective as of the date of payment, and not the date when the certificate reaches the Office. (No reference given.)

Subject-matter of this rule.

Barri, 97 O. G. 1176.

Rule 168. Title of Invention.

Every patent will contain a short title of the invention or discovery indicating its nature and object, and a grant to the patentee, his heirs and assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery throughout the United States and the Territories thereof. The duration of a design patent may be for the term of three and one-half, seven, or fourteen years, as provided in Rule 80. A copy of the specifications and drawings will be annexed to the patent and form part thereof.

Rev. Stat., sec. 4884.

DELIVERY.

Rule 169. Delivery of Patent.

The patent will be delivered or mailed on the day of its date to the attorney of record, if there be one; or, if the attorney so request, to the patentee or assignee of an interest therein; or, if there be no attorney, to the patentee or to the assignee of the entire interest, if he so request.

CORRECTION OF ERRORS IN LETTERS PATENT.

Rule 170. Correction of Mistakes Incurred Through Fault of the Office.

Whenever a mistake, incurred through the fault of the office, is clearly disclosed by the records or files

of the office, a certificate, stating the fact and nature of such mistake, signed by the Commissioner of Patents, and sealed with the seal of the Patent Office, will, at the request of the patentee or his assignee, be indorsed without charge upon the letters patent, and recorded in the records of patents, and a printed copy thereof attached to each printed copy of the specification and drawing.

Whenever a mistake, incurred through the fault of the office, constitutes a sufficient legal ground for a reissue, the reissue will be made, for the correction of such mistake only, without charge of office fees, at the request of the patentee.

Mistakes not incurred through the fault of the office, and not affording legal grounds for reissues, will not be corrected after the delivery of the letters patent to the patentee or his agent.

Changes or corrections will not be made in letters patent after the delivery thereof to the patentee or his attorney, except as above provided.

CONSTRUCTIONS.

Petitioner asks a reissue at the expense of the Office because the errors were obvious, and ought to have been noted by the Examiner. Refused.

Conrad & Conrad, 192 O. G. 517.

It appearing that the attorneys were fully advised as to the record relating to the title, a certificate of correction in the issue refused, especially as not all the parties interested joined in the petition, nor does it appear that they were notified.

Jacobson, 183 O. G. 221.

A certificate of correction will not be granted to make a patent conform to a change in practice.

Rundle, 116 O. G. 593.

The patent was issued to the inventor instead of to the assignee. Held, that a certificate of correction would be granted on request, but that the patent would not be reissued.

Fish, 114 O. G. 2091.

A paragraph was sought to be canceled, but by mistake was printed in the patent. A certificate of correction was thought to be sufficient.

Barry, 112 O. G. 2095.

Application to trade-marks.

The Strobel & Wilken Co., 105 O. G. 2058.

It is only to correct discrepancies between the original record and the patent as printed that certificates of correction are endorsed upon patents.

105 O. G. 500.

The error in this case does not seem to be one calling for correction by the Office. The question is one of little importance, and it is not believed that it affects the validity or operativeness of the patent.

Long, 104 O. G. 851.

The fact that the Office suggested a claim which was adopted by applicant is not sufficient ground for accepting a reissue application without the usual fee.

Graves, 103 O. G. 228.

A reference letter which appeared in the specification was, by mistake, not put on the drawing; it was held that the error being inconsequential, it would be corrected neither by certificate nor reissue.

Dailey, 101 O. G. 2825.

The misspelling of a name is unimportant if the resemblance to the true name is sufficient for identification. A certificate is proper and sufficient to correct such a mistake.

101 O. G. 2569.

A certificate granted to correct the middle initial in the signature of applicant, and refused to correct the name of a witness. If a signature is illegible, it is not the fault of the Office.

Keen & Wims, 101 O. G. 1372.

This certificate is the only proper remedy for a clerical mistake which does not affect the scope of the patent.

Alexander, 98 O. G. 2365.

The misspelling of the name of one of the joint grantees of the patent, through the fault of the Office, should be corrected by a reissue and not by a certificate. Cancellation and granting a new patent suggested.

97 O. G. 2305.

The applicant requested a change in the title after the allowance. Request granted, and Examiner changed title in preamble, but title was not changed elsewhere. Held, a case for certificate of correction and not for reissue.

Dondict, 93 O. G. 551.

Certificates are only issued to make the patent correspond with the record in the office.

Rosback, 89 O. G. 705.

ABANDONED, FORFEITED, REVIVED AND RENEWED APPLICATIONS.

Rule 171. Abandoned Application.

An abandoned application is one in which all the essential parts have not been filed so that it is completed and prepared for examination within a period of one year, or which the applicant has failed to prosecute within one year after any action therein of which notice has been duly given (see Rules 31 and 77), or which the applicant has expressly abandoned by filing in the office a written declaration of abandonment, signed by himself and assignee, if any, identifying his application by title of invention, serial number, and date of filing. (See Rule 60.)

Prosecution of an application to save it from abandonment must include such proper action as the condition of the case may require. The admission of an amendment not responsive to the last official action, or refusal to admit the same, and any proceedings relative thereto, shall not operate to save the application from abandonment under section 4894 of the Revised Statutes.

Rev. Stat., sec. 4894.

HISTORY.

1869—"7—All applications not completed for examination within two years after the filing of the petition will be regarded as abandoned, unless it be satisfactorily proved to the office that such delay was unavoidable."

1870—"7—All applications for patents shall be completed and prepared for examination within two years after the filing of the petition. and in default thereof, or upon failure of the applicant to prosecute the same within two years after any ac-

tion therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable."

1871—"11. . . . two years after any action thereon, of which notice shall have been mailed to him or his agent . . . the model may be returned upon the filing of a formal abandonment signed by applicant in person."

1873—"40—When the application has been rejected, but not withdrawn, any act which calls it up for further consideration upon its merits will be regarded as constituting a renewal."

1878—Rule 39 under the general heading of "Abandoned Applications" reads as follows:

"When an application for a patent has been rejected, and the applicant fails to renew the same or to file a new one within two years after the date when notice of the last official action was mailed to him or to his agent, his application will be held to have been abandoned.

"Any action which calls such rejected application up for further consideration, within the time mentioned, will be regarded as constituting a renewal."

Rule 165 of 1879 "(and assignee, if any)" added 1883 "Serial number" and last sentence 1892, and two years changed to one year, 1897.

Prior to the law of 1870 there was no fixed time that worked abandonment of a rejected case.

Gordon, 6 O. G. 543, 1874 C. D. 108.

As to the effect of this law, see Gray v. Hale, 1871 C. D. 129.

See notes to Rules 31, 65, 66, 68 and Rules 77, 116, 172.

CONSTRUCTIONS.

(1) RULE IN GENERAL.
(2) ACTION BY THE OFFICE.
(3) ACTION BY APPLICANT.
(4) TIME LIMIT.
(5) DELAY WITHIN THE LIMIT.
(6) FORMAL ABANDONMENT.
(7) ADDITIONAL CASES.

(1) *Rule in General.*

In this exceptionally complex art the Office has found itself unable to bring about an improvement. Amendments are delayed in many instances until the end of the period allowed

by law, and when applications are passed to issue they frequently are forfeited and renewed with further amendments, and their slow prosecution is renewed.

The only possible relief from conditions which have become intolerable is to force an application to patent or abandonment whenever an opportunity presents itself.

Dyson, 233 O. G. 755.

The Court of Appeals will entertain the question of abandonment.

Selden, 164 O. G. 741.

But not by mandamus.

Sang v. Moore, Com., 172 O. G. 834.

The question of abandonment may be raised in an interference proceeding.

Kinsman v. Strohm, 125 O. G. 1699, 1906 C. D. 481, 31 App. D. C. 587.

The excuse that the last Office letter was not received is without weight when it was known to applicant that such a letter was written and he made no effort to get a copy. Furthermore, there is no affidavit on file relative to said letter.

Woods, 121 O. G. 689, 1906 C. D. 103.

Abandonment of application should be distinguished from abandonment of invention.

Springer, 120 O. G. 2754, 1906 C. D. 85.

If the first fee is not paid within a year the case is abandoned.

Kurz, 119 O. G. 961, 1905 C. D. 486.

The law never presumed abandonment.

Newberry v. O'Donohue, 111 O. G. 300, 1904 C. D. 249.

If the original application was filed previous to Jan. 1, 1893, the divisional application filed subsequent to that date is subject to the old law limiting the time for amendment to two years.

Balzer, 101 O. G. 2824, 1902 C. D. 470.

Apply to reissue application.

Laughlin & Reuleau, 92 O. G. 2003, 1901 C. D. 144.

Reissue cases are abandoned after two years of inactivity, like other cases, by operation of section 4894.

Messinger, 78 O. G. 1903, 1897 C. D. 1.

The fact that an inventor is dead, and that his executor has not asserted his rights, does not deprive an application of standing before the Office. It cannot be considered abandoned until the expiration of the time allowed by law for amendment.

Decker v. Loosley, 77 O. G. 2140, 1896 C. D. 106.

Where an applicant for a patent already has a prior patent three and one-half years old, which fully describes the invention claimed in the subsequent application, but does not claim it or make any reservation thereof, Held, to constitute abandonment.

Zipernowsky v. Edison, 58 O. G. 803, 1892 C. D. 23.

Abandonment is never presumed, but must be always strictly proved.

Clark v. Brown, 57 O. G. 1426, 1891 C. D. 217; Price, 57 O. G. 1000, 1891 C. D. 201.

Application abandoned by delay in not paying the first fee.

Fennon, 52 O. G. 1665, 1890 C. D. 138.

Abandonment is not favored, and must be conclusively proved.

Johnston, 18 O. G. 1052, 1880 C. D. 207; Golding, 8 O. G. 141, 1875 C. D. 98.

Abandonment of the application is not abandonment of the invention.

Golding, 8 O. G. 141, 1875 C. D. 98; Livingston. 20 O. G. 1747, 1881 C. D. 42; Crompton, 9 O. G. 5. 1876 C. D. 35; Casilear & McIntire, 8 O. G. 474, 1875 C. D. 117; see Mills. 7 O. G. 961. 1875 C. D. 74, 35 App. D. C. 377; Gray v. Hale, 1871 C. D. 129.

(2) *Action by the Office.*

Where affidavits as to operativeness were filed and found insufficient, the rejection should not have been made final.

McGill, 195 O. G. 817.

When an applicant is referred to this rule he must examine it.

Vesey, 195 O. G. 273.

Where applicant asks for an application of the references, and the Examiner thinks he has already given such, he should so state. and not finally reject the case.

Perkins, 192 O. G. 1262.

When two claims were objected to. and withdrawn, and one of them immediately reinserted. Held. the Examiner should have treated it as a request for a reconsideration, and not held the application abandoned because the action was not responsive.

Ehrlich Bertheim, 191 O. G. 1068.

Under these circumstances there is no excuse for the delay in correcting the drawings in accordance with the Examiner requirements, and his action holding the case abandoned is

clearly right. If the amendment is not substantial a final rejection is proper.

Thomson v. Reves, 184 O. G. 805, 806; Myers, 184 O. G. 802.

It would of course be improper for the Examiner to state fully for the first time his reasons for rejecting the claims in the letter in which the rejection was made final.

Hartford, 184 O. G. 551.

A reference to a decision held to be sufficiently definite statement of reasons.

Patterson, 178 O. G. 885.

Where a case is appealed, the decision of the Commissioner affirming the decision of the Examiner is sufficient without any action by the Examiner.

Gale, Sr., 161 O. G. 530.

A strained construction should not be placed upon an amendment in order that it may save the application from abandonment, but it should be construed according to the intent of the applicant as determines from a consideration of the whole instrument.

Richards, 124 O. G. 627, 1906 C. D. 321.

Where Office gave wrong date of filing, leading applicant to pay fee after expiration of time limit, held not abandoned.

Matthews, 117 O. G. 2631, 1906 C. D. 310.

The Primary Examiner has no discretion in the matter, but acts in a ministerial capacity in comparing the dates; he acts in a ministerial capacity in determining whether the applicant's action is sufficient. In such case it is proper to ask for a reconsideration, but such request should be made with diligence, and should be accompanied by a statement of reasons.

Naef, 115 O. G. 1583, 1906 C. D. 121.

Letters written by Examiner after the abandonment do not relieve against abandonment.

Ries, 113 O. G. 1147, 1904 C. D. 501.

The irregularity of the final rejection by the Examiner is no excuse for the delay. He should have tried to have the Examiner's action set aside as irregular.

Munson, 105 O. G. 264, 1903 C. D. 219.

If no appeal or petition is taken within the time fixed by law, no inquiry will be made to determine whether the action was right or wrong.

Munson, 105 O. G. 264, 1903 C. D. 219.

An action under Rule 96 establishes a date for the one year limitation.

Coulson v. Callender & Callender, 101 O. G. 1607, 1902 C. D. 395.

A formal defect.

Sack, 99 O. G. 2101, 1902 C. D. 187.

The tacitly favorable action of one Examiner upon a question of abandonment should at least be persuasive upon his successor.

Burson, 81 O. G. 2246, 1897 C. D. 196.

If an amendment, after rejection, inserting additional claims and requesting suspension of action upon other matters for stated reasons, be admitted without question, it cannot be objected to at a subsequent period as insufficient to obviate abandonment.

Burson, 81 O. G. 2246, 1897 C. D. 196.

Where it appears that at no time while the case has been before the Office has it been placed by the Examiner in condition for appeal to the Examiners-in-Chief upon its merits, Held, that although the action of the appellant has been irregular, the case has not become abandoned under second paragraph of Rule 171.

Blessing, 71 O. G. 1027, 1895 C. D. 9.

Error on the part of the Examiner does not cure parties' own laches.

Hien, 62 O. G. 316, 1893 C. D. 7.

Letters requiring division held to save case from abandonment.

Hunter, 57 O. G. 999, 1891 C. D. 198.

If in his letter of March 5, 1886, the Examiner had given the applicant clearly to understand that his action upon the question of division was simply a reiteration of his action in the same regard of February 13, 1885, I should hold that the application had become abandoned on the expiration of two years from and after February 13, 1885; but the Examiner is found as late at July 25, 1889, requiring a division in such a manner as to convey the inference that the case was still open for that action. I have grave doubts as to the right of the Office to thus practically nullify section 4894 of the statute, but the doubts do not justify me in holding that the application has become abandoned.

Hunter, 57 O. G. 999, 1891 C. D. 198.

(3) *Action by the Applicant.*

Piecemeal prosecution as an excuse for laches.

Levy, 220 O. G. 1043.

A petition from the ruling that the case is abandoned must be taken promptly.

Thomas, 197 O. G. 977.

If the Examiner objects to the multiplicity of claims, an answer that takes no notice of his objection is not responsive.

Creveling, 197 O. G. 779.

Amendment may be made by telegram, especially if confirmed.

Wheary, 197 O. G. 534.

If the part of the claims rejected are to be abandoned they must be definitely canceled.

Iddings v. Iddings, 197 O. G. 239.

Amendment filed in plenty of time and forwarded to an associate, who inadvertently failed to file it. Enquiry was made in a reasonable time. Excused.

Hilderbrandt, 196 O. G. 1051.

Design application. An unsigned photograph filed instead of a drawing. Case abandoned.

Bennett, 189 O. G. 1032.

After a final rejection applicant canceled claims. He cannot be heard to question the propriety of the final rejection, even if an appeal on another question is necessary.

Stickney, 185 O. G. 1379.

The claims were rejected and amended. The amendment was held to constitute new matter, and was withdrawn. Case abandoned.

Webster, 183 O. G. 1032.

A change of wording of the claim without changing the meaning will not save it from abandonment.

Kaufman, 182 O. G. 719. See Hice, 117 O. G. 2365.

A petition to the Commissioner to reopen a case, which was denied, will not save a case from abandonment.

Brenzinger, 182 O. G. 509.

After electing to prosecute one set of claims, an amendment presenting another set is not a proper response to save the same from abandonment.

Stroh, 180 O. G. 1137.

Neglect to place explanation in specification as required proper foundation for final rejection.

Dean, 177 O. G. 1295.

A request to point out the pertinency of the references is not sufficient if applicant has not tried to show how the device differs.

Sevy, 173 O. G. 288.

A Swedish patent was cited for the first time, but not specially applied. The applicant responded by canceling claims and substituting other claims which he said avoided the reference. The Examiner held that he had not pointed out how

the new claims avoided the references; held that the prosecution of the case (there being no evidence of intentional delay) met the requirement of the rules.

Watters, 163 O. G. 231.

A confused application filed—the specification was required to be rewritten, and in response a specification without claims filed. Not responsive.

Kehrhahn, 162 O. G. 537.

After the final rejection it was incumbent upon applicant to respond within a year either by appeal, by cancellation of the rejected claims, or by having the case reopened, as by submitting an amendment with verified excuse for not prosecuting it before final rejection.

Sorenz, 160 O. G. 1039.

The fact that the word "sole" was omitted from the oath held not to cause abandonment of the application.

Mygatt, 160 O. G. 773.

New drawings required blue prints only furnished, case held abandoned after one year from the requirements of new drawings.

Mastagler, 159 O. G. 489.

If claims are rejected and an amendment of the drawing required, a compliance with the latter requirement will not be sufficient to relieve from abandonment.

Sturtevant v. Sturtevant, 158 O. G. 885.

Where an applicant was notified that certain interferences had been decided in his favor and that the case awaited action in response to previous Office actions. The filing of an amendment containing the claims of a patent and requesting an interference therewith is not such action as the condition of the case required, and did not operate to stay the running of the year from the previous Office action.

Curtis, 138 O. G. 767.

A person may not delay amending because if he does amend his opponent will have access to the amendment under Rule 108.

Dilg and Fowler, Jr., 132 O. G. 1837.

Where, after a final rejection, the proceedings were not such as to save the case from abandonment, a petition to set aside such rejection more than one year after such rejections should not be considered, even if a reconsideration was requested within the year.

Fowler, 127 O. G. 1578; contra. More, 197 O. G. 533.

A claim was presented which was in part responsive, but in

addition limitations were removed without explanation. *Held,* that the case was abandoned.

Richards, 124 O. G. 2534, 1906 C. D. 403.

A mere request for reconsideration, without giving any reasons therefor, especially where a party has abandoned all hope or expectation of securing a patent, is not sufficient to save an application from abandonment.

Krejce, 121 O. G. 1011, 1906 C. D. 111.

If the action is not complete, it is not sufficient to prevent abandonment.

Schmitt & Tanody, 121 O. G. 688, 121 C. D. 102; Sperry, 121 O. G. 687, 1906 C. D. 100.

Supposed error in Examiner's action no excuse for delay beyond the time limit.

Richardson, 120 O. G. 2753, 1906 C. D. 83.

Where applicant's attorneys place the case in condition for final action and final action is given, an applicant can not secure an extension of the time allowed by law by revoking the power of attorney and filing a request for further explanation, even though such request is filed within the year.

Cazin, 120 O. G. 660, 1906 C. D. 30.

Where certain formal objections are raised and the claims are finally rejected, an amendment curing the formal objections will not save the case from abandonment, even though by curing the formal objections the scope of the claims is changed. A final rejection must be met by an appeal, and not by an amendment changing the scope of the claims.

Walton, 120 O. G. 659, 1906 C. D. 28.

A proposed amendment does not save a case from abandonment that was finally rejected.

Marr, 119 O. G. 2521, 1905 C. D. 556.

Where applicant filed an appeal within the year, and asked to temporarily withdraw it, the case not abandoned.

Dieterle, 118 O. G. 1685, 1905 C. D. 410.

A petition under Rule 145 is not in itself sufficient to prevent abandonment. "At the expiration of the year following final rejection the applicant must within that time file his appeal or take steps resulting in the setting aside of the final rejection"

Wagner, 118 O. G. 1684, 1905 C. D. 406, 22 App. D. C. 267.

If an appeal and an amendment are filed at the same time, and it is held that the amendment is not admissible, still the appeal is sufficient to prevent abandonment, as the law does not favor forfeiture.

Bach, 118 O. G. 1363, 1905 C. D. 383.

The attorney prepared and forwarded a proper amendment in ample time, but it was not received by the Office. Upon discovering that fact, the attorney prepared and filed a second amendment. Held not abandoned, though the second amendment was not received until the expiration of the time limited.

Eluere, 117 O. G. 2635, 1905 C. D. 321.

An application should not be held abandoned when an informal amendment was filed in good time.

Gaylord, 117 O. G. 2366, 1905 C. D. 309.

When a requirement for division has been made final, the only thing to prevent the time limit from running is to take a proper action to have the requirement set aside.

Tuttle, 117 O. G. 1796, 1905 C. D. 274.

"He had merely asserted twice that the references do not seem to anticipate the claims; but it is very clear that such assertion did not tend to furnish new light for the Examiner." Case abandoned.

Busenbenz, 117 O. G. 600.

The question whether an amendment presented was such proper action as the condition of the case required must be determined by the practice of the Office in force at the time, and it is not affected by a subsequent change of practice.

Naef, 115 O. G. 2135, 1906 C. D. 121.

A request for reconsideration, without giving reasons why applicant thinks the Examiner erred, is not such action as the case demands, and the case may be held to be abandoned.

Linde, 115 O. G. 1329, 1905 C. D. 118.

When there is a requirement of division applicant must appeal or amend within the year. The question of division will not be reviewed upon petition.

Galley, 115 O. G. 802, 1905 C. D. 95.

As it is evident that all the actions that have been made in this case by the applicant have been for the purpose of making a substantial advance, and not for the purpose of delay, it is *held* that the application has not been abandoned.

Smyth, 114 O. G. 762, 1905 C. D. 29.

While an attempt to claim a species not originally claimed is not such action as the case demands within this rule, still in view of apparent good faith a proper amendment will be received if promptly filed.

Lillie, 114 O. G. 541, 1905 C. D. 15.

To save from abandonment the action must be responsive.

Parkes, 113 O. G. 2213, 1904 C. D. 551.

The case became abandoned because applicant neglected to give his reasons for asking a reconsideration.

Alton, 113 O. G. 1968-1969, 1904 C. D. 541.

Where the Examiner finally rejects claims an appeal must be taken within a year or the propriety of the Examiner's action will not be considered.

LeFever, 110 O. G. 1430, 1904 C. D. 205.

If the applicant's action was within the year it is immaterial whether that of the office was or not.

Lovejoy, 108 O. G. 1053, 1904 C. D. 52.

The proposed amendment was not accompanied by a showing, duly verified, of good and sufficient reasons why it was not earlier presented. It was not therefore such proper action as the case required to keep it from abandonment.

Lay, 107 O. G. 2337, 1903 C. D. 501.

An action which does not and was not intended to make a substantial advance toward closing the prosecution of the application is not such a proper action as is required by the law and the rules.

La France, 105 O. G. 262, 1903 C. D. 215.

Must be such action as the case requires, either acquiescence in appeal to Examiners-in-Chief or a successful petition to the Commissioner.

Landis, 103 O. G. 1164-5, 1903 C. D. 127.

An amendment which, if entered, would require a division, is not such an action as will save the case from abandonment. The Commissioner is, however, vested with a judicial discretion to relieve against the penalty. (At this time a requirement of division was a formal action, appealable to the Commissioner in person.)

McGenniss, 101 O. G. 2075, 1902 C. D. 422.

A petition to the Commissioner which does not change the status of the case will not save it from abandonment.

Fritts, 101 O. G. 1131, 1903 C. D. 383.

Applicant filed a proper amendment within the required time, which was not entered for want of supplementary oath. The Examiner said "The applicant has not failed to act upon previous requirements, but has merely failed to anticipate a requirement subsequently made."

Yerdon, 101 O .G. 1830, 1892 C. D. 411.

The Examiner rejected the claims and required a division. Applicant amended the claims and asked a reconsideration of the requirement to divide. Though doubted if the request to reconsider was sincere, still it was an action interrupting the time.

Chamberlain, 101 O. G. 447, 1902 C. D. 354.

A request for reconsideration as to part of the requirement of division and a compliance with the rest is an action limiting the running of the time limit.

Naef, 100 O. G. 2601, 1902 C. D. 325.

A request for reconsideration accompanied by an argument, and also by an additional claim which was objectionable because requiring division, Held, that the request for consideration and argument was sufficient to save the case from abandonment.

Scott, 100 O. G. 681, 1902 C. D. 258, 25 App. D. C. 307.

Part of claims rejected for one reason and part for another an amendment or request for reconsideration, as to part of the claims does not save the case from abandonment.

Spiller, 99 O. G. 2320.

The insertion of an additional claim is not sufficient nor the request for reconsideration.

Kuper, 97 O. G. 2981, 1901 C. D. 258.

It must be an action made in good faith, with the purpose and effect of making a substantial advance toward closing the prosecution of the case.

Vaughen, 97 O. G. 957, 1901 C. D. 161.

A mere reassertion of a position is not such an action as will save a case from abandonment unless the rules provide for it.

Grant, 93 O. G. 2532, 1900 C. D. 199.

Petition may not be signed by the attorney in original case.

Thomas, 92 O. G. 1035, 1900 C. D. 116.

Action by an applicant made in good faith, and which is such as the condition of the case requires, is sufficient to save the case from abandonment; although it is not completely responsive to every requirement made, affidavits under Rule 75 is such an action as the rule contemplates.

Wright & Stebbins, 88 O. G. 1161, 1899 C. D. 153.

When upon a requirement of division claims for a process were canceled, and an application was limited to claims for an article, and a second application for the process was filed while the first application was pending, but not within two years from the cancellation of the process claims from the first application, *Held*, that the process claims were not abandoned and the second application was a division of the first.

Richardson v. Leidgen, 77 O. G. 153, 1896 C. D. 63.

When the Examiner makes a definite requirement and a suggestion, it is the requirement alone that must be acted upon within the time limit.

Hume, 57 O. G. 123, 1891 C. D. 168.

Amendments of no considerable importance filed the last day

of time limited. Held, that the section so far as it went was a proper action, and there was no such utter failure to prosecute within the two years as would warrant a judgment forfeiting rights.

Todd, 49 O. G. 732, 1889 C. D. 217.

The fact that one party to an interference has taken an appeal in which counsel of both parties participate does not relieve the other party from the operation of the rule of limitations.

Cruikshank v. Strong, 17 O. G. 511, 1860 C. D. 102.

The law evidently contemplates official action, either preliminary or on the merits taken in the regular course of the examination of the case. The abandonment of an application, or withdrawal of model requires no such action.

Graham, 3 O. G. 211, 1873 C. D. 34; Lee v. Smith, 5 O. G. 58, 1874 C. D. 14.

The official stamp of the Office is the proper evidence of the date of the last official action.

Blake, 3 O. G. 2, 1873 C. D. 6.

(4) *Time Limit.*

The Supreme Court distinguishes between the constructive notice incident to the grant of a patent and the "actual and specific" notice under this rule.

Chapman v. Wintroath, 272 O. G. 913.

Perhaps the year limit ought to run from the time of receipt of the notice and not from the time of the Patent Office action.

Time past due to a clerical mistake. Excusable.

Hinrich, 191 O. G. 1067.

Questioned if the one year limitation does not apply to action under Revised Statute, sec. 4915.

Wened v. Horine, 191 F. 620.

If the year ends on Sunday the amendment must be filed Saturday.

182 O. G. 971.

Records of attorney upon which he relied imperfect. Excuse insufficient.

Amigo, 174 O. G. 833.

Whether or not the ruling that the year runs from a given date is correct will not be considered until the case is held to have been abandoned, unless in a clear case.

Inneau, 160 O. G. 1038 (149 O. G. 773).

Subject-matter of this rule.

Barrett and Aller, 127 O. G. 847.

One of the requisites to a favorable decision on the question

of abandonment is that a proper action be filed, upon which action can at once be taken by the Office.

Roger, 125 O. G. 2766, 1906 C. D. 528.

In view of the fact that the proposed amendment would place the case in condition for allowance, and the fact that the delay over the year is slight, the doubt upon the question whether the total delay was unavoidable is resolved in the applicant's favor. See also note to Rule 68.

Richards, 124 O. G. 627, 1906 C. D. 321.

Action by the applicant was intentionally delayed until near the close of the year following the rejection. In such cases the applicant assumes the risk of such accidents as occurred in this case (misplaced files), and must bear the consequences.

Klussman, 123 O. G. 2311, 1906 C. D. 276.

Great stress is laid by the applicant on the value and importance of the invention. These are reasons for giving the showing made the most careful consideration, but are not reasons for relaxing the usual requirements in cases of this kind. I am not satisfied that the delay was unavoidable, and therefore I am without authority to regard this case as otherwise than abandoned.

Ilgner, 122 O. G. 1721, 1906 C. D. 182.

Where the time expired Sunday, March 5, and the Office was closed on the 4th, and the amendment would have been received that day, the closing of the Office not being known to applicant, case not abandoned.

Ries, 116 O. G. 2007, 1905 C. D. 211.

If the last day comes on Sunday, amendment must be filed Saturday.

Weirick, 97 O. G. 1373, 1901 C. D. 183; Koritski & Wipf, 113 O. G. 1145, 1904 C. D. 498.

The year begins to run from the last action which tends to cause a real advance in the prosecution of the case.

Naef, 110 O. G. 2016, 1904 C. D. 230.

Mistake in attorney's office record, but no showing that amendment could have been made before. Not "unavoidable."

Raymond, 109 O. G. 1608, 1904 C. D. 113.

The claims having been twice rejected finally, as involving new matter, and the proposed amendment not seeking to remedy this defect, the case is abandoned.

Edwards, 108 O. G. 1051, 1904 C. D. 48; Novotny, 108 O. G. 1327, 1904 C. D. 57.

This action was taken within the year, but the case was not reached for consideration by the Office until the expiration of the year. Applicant had a right to a reconsideration.

Lovejoy, 108 O. G. 1053, 1904 C. D. 52.

The word "unavoidable" in the statute means more than that to act would have been inconvenient. Since the delay in this case is attempted to be explained on the ground that Marconi did not furnish the necessary information, it cannot be held that the delay was unavoidable in the absence of a showing by him of good reasons why he did not furnish the information.

Marconi, 108 O. G. 796-7, 1904 C. D. 31.

The amendment was not accompanied by a showing as to why it was not presented before; it was not therefore such proper action as the case required to keep it from abandonment.

Lay, 107 O. G. 2237, 1903 C. D. 501.

The petitioner may not have the application revived and a limit of six months set for him to amend.

Miller, 105 O. G. 2057, 1903 C. D. 282.

An assignee refused a revival of the application because no excuse was given for the first nine months of the delay.

Miller, 105 O. G. 2057, 1903 C. D. 282.

After rejection by the Examiners-in-Chief, the claims in question were canceled, and more than a year after said rejection. An amendment was filed attempting to reinstate the abandoned claims. *Held,* that the amendment cannot be entered. The case was abandoned.

Oviatt & Dean, 107 O. G. 269, 1903 C. D. 419.

Time limit for appeal begins to run from time of definite final rejection.

Kuhlewind, 101 O. G. 3107, 1902 C. D. 481.

If the last day falls on Sunday, action must be taken on Saturday.

Beecher, 101 O. G. 1132, 1902 C. D. 384.

See notes to Rules 65 and 68.

Bursen, 81 O. G. 2246, 1897 C. D. 196.

The limitation does not run while an interference is pending.

Taylor v. Shreffler, 24 O. G. 1175, 1883 C. D. 63.

The day of the last action of the Office is excluded in the computation of the two years.

Musser, 16 O. G. 858, 1879 C. D. 252.

There is no rule which excludes the filing of any amendment more than two years after the filing of an application that would ever be admissible at all. There is no limit of time restricting amendments except that provided in the statute defining abandonment, and that has no relation to the character of the amendment or other matter presented.

Dodge, 3 O. G. 179, 1872 C. D. 202.

(5) *Delay Within the Limit.*

See Chapman v. Wintroath, 272 O. G. 913.

In this exceptionally complex art the Office has found itself unable to bring about an improvement (Automatic Telephones). Amendments are delayed in many instances until the end of the period allowed by law, and when applications are passed to issue they frequently are forfeited and renewed with further amendment, and their slow prosecution is resumed. The only possible relief from conditions which have become intolerable is to force an application to patent or abandonment whenever an opportunity presents itself.

Dyson, 233 O. G. 755.

The record seems to show a deliberate attempt to prolong the prosecution of the case, and under the circumstances having taken advantage of a technical application of the rules. Applicant is not in a position to complain of a like application by the Office.

Copeland, 140 O. G. 1207.

A person has a perfect right to delay action until near the end of the year, but in so doing he risks a delay due to a mistake.

Grant, 128 O. G. 885.

When an applicant intentionally delays to the last of the time limited, and by mistake the application is not filed until the day after time limited, he is not entitled to relief.

Clausen, 118 O. G. 838, 1905 C. D. 367.

If there was no excuse why applicant did not act during the first six months, or his attorneys during the second six months, the case held abandoned, notwithstanding excuses for the rest of the time.

Simon, 118 O. G. 838, 1905 C. D. 366.

Delay which is within the time limited will not be considered unfavorable to a contestant.

Jones v. Starr, 117 O. G. 1495, 1905 C. D. 694, 26 App. D. C. 64.

Where the record shows that the applicant is in the habit of waiting almost the full statutory period before amending, he is not in position to rely on any matters of equity when a question is raised whether he has acted in time, but only upon his strict technical rights.

Naef, 115 O. G. 2135, 1905 C. D. 137.

The applicant's rights are not prejudiced by any delay less than a year.

Booth, 113 O. G. 2216, 1904 C. D. 558.

Where a party relies upon his technical rights to delay, he

should not be heard to complain where he fails to meet the requirements.

Ries, 113 O. G. 1147, 1904 C. D. 501.

It is the right of an applicant to wait until the last of the time allowed him; but when he continually does so he is not in position to ask for leniency in the application of the rule against delay.

Pietzner, 103 O. G. 2171, 1903 C. D. 142.

It is settled by the Supreme Court that so long as a party complies with the law in prosecuting his application, no delay in the Office can be regarded as unreasonable and as operating as a forfeiture of his rights.

Osborn v. Hotsapillar, 102 O. G. 1297, 1902 C. D. 47.

If applicant waits till the latter part of the time limit he takes all risks.

Beecher, 101 O. G. 1132, 1902 C. D. 384; Smith, 101 O. G. 1369, 1902 C. D. 387.

When an applicant waits until the last day of the year to file an amendment he assumes all risks, and an action which would be insufficient if made earlier cannot be held to be sufficient for this reason. Said of an amendment which was refused because it would require division. The circumstances of this case are such as to entitle the applicant to favorable consideration if he will promptly file a proper amendment, accompanied by petition for revival.

Morrison, 99 O. G. 2969, 1902 C. D. 226.

In view of a suggestion that the inventor is in fault for any avoidable delay, the Court says: "The inventor does not determine the measure of his right or of his obligations. The law determines that for him, and if the government thinks that more speed is desirable in the interests of the public it should change the law." If an inventor is allowed two years to take an appeal, he may wait till the last day of the two years—same case.

Crown Cork & Seal Co. v. Aluminum Stopper Co., 96 O. G. 3576, 1901 C. D. 450.

Must be unavoidable for the entire time.

Warren, 96 O. G. 2410, 1901 C. D. 137, 22 App. D. C. 267.

A request for further information not sufficient to save case from abandonment. The Office will not scrutinize the record to find a way of saving an application from abandonment that has already been pending for more than eleven years, especially where the art during that period has rapidly developed, and where the grant of a patent upon the claims now in the case might be a menace to mere diligent inventors.

Hunter, 66 O. G. 1449, 1894 C. D. 34.

(6) *Formal Abandonment.*

The signature of the assignee is necessary.

Weideman, 81 O. G. 2245, 1897 C. D. 194.

Whether a declaration of abandonment shall be put in a set form of words is a matter in the discretion of the Office.

Lassell, 29 O. G. 861, 1884 C. D. 66.

It is thought that an erasure of all the claims, without substituting others, is an abandonment of the application.

Lassell, 29 O. G. 861, 1884 C. D. 66; Lassell, 28 O. G. 1274, 1884 C. D. 42.

One of the two joint inventors cannot abandon the joint invention without the consent of the other.

Sawyer & Mann v. Edison, 25 O. G. 597, 1883 C. D. 80.

(7) *Additional Cases.*

Subject-matter of this rule:

Kinsman v. Strohm, 120 O. G. 2127, 31 App. D. C. 581; Berg, 120 O. G. 903; Skinner v. Murray, 107 O. G. 542, 1903 C. D. 429; Bowles, 103 O. G. 429, 1903 C. D. 95; Raymond, 99 O. G. 1386, 1902 C. D. 170; Sibbald v. Cassidy & Smith, 61 O. G. 563, 1892 C. D. 214; Funston, 49 O. G. 1044, 1889 C. D. 224; Hamilton v. Fisher, 1871 C. D. 271.

Rule 172. Revival of Application.

Before an application abandoned by failure to complete or prosecute can be revived as a pending application it must be shown to the satisfaction of the Commissioner that the delay was unavoidable.

Rev. Stat., sec. 4894.

HISTORY.

Substantially Rule 166 of 1879.

CONSTRUCTIONS.

Revival of Application.

See notes to Rule 171.

Amendment must reach the Patent Office in time. It is not sufficient that it was mailed in time.

James, 189 O. G. 1032.

A case will not be revised merely for the sake of giving a date to a second application.

Girardill, 181 O. G. 1073.

The mere failure to file an amendment which was prepared at the end of the year from the Office, action does not, in my opinion, constitute any sufficient showing of unavoidable delay which would warrant the revival of an application within the provision of Section 4894 of Revised Statutes.

Ciofi, 137 O. G. 1238.

The Commissioner cannot reinstate an application formally abandoned by the applicant himself.

Hirth, 137 O. G. 977.

A person may not delay amending because if he does amend his opponent will have access to the amendment under Rule 108.

Digy & Fowler, Jr., 132 O. G. 1837.

That claims under Rule 96 were not suggested is no excuse for failure to amend.

McKee, 130 O. G. 980.

That a case was inadvertently crossed off the attorney's docket not sufficient excuse where it appears that delay until near the close of the period was intended.

Duryea, 128 O. G. 1291.

The showing relates to matter outside the Office, and is not verified nor has a proper amendment been filed. Delay will not be held unavoidable under these circumstances. Moreover, the excuse made does not cover the whole period.

Myers, 123 O. G. 1663, 1906 C. D. 263.

Matter tending to excuse the latter part of the delay is not sufficient.

Marburg, Jr., 121 O. G. 687, 1906 C. D. 98.

Delay in transmission through the mails from a foreign country unverified statement.

Botzky, 121 O. G. 338, 1906 C. D. 94.

An action before the Primary Examiner consisting of an appeal, held proper, notwithstanding it did not obviate the objection of the Examiner that it defined the article in the claim by reference to its mode of manufacture.

Warren, 120 O. G. 2755, 1906 C. D. 87, 30 App. D. C. 308.

A petition must be accompanied by an action.

Richardson, 120 O. G. 2573, 1906 C. D. 83.

A delay of four years difficult to excuse.

Gironcoli, 120 O. G. 2753, 1906 C. D. 82.

The fact that the amendment was mislaid by attorney does not show unavoidable delay.

Block, 119 O. G. 963, 1905 C. D. 493.

The contention on petition that the alleged final rejection was premature must be made within the year.

Read, 119 O. G. 337, 1905 C. D. 458.

Mistake of attorney as to date not sufficient excuse.

Hallot, 118 O. G. 592, 1905 C. D. 351.

Inventor prosecuting his own case, did not receive first notice; second notice reached him when he was ill, from which illness he died; his representatives acted promptly.

Sellers, 118 O. G. 270, 1905 C. D. 336.

Delay may not be excused because applicant was trying to improve his invention. The improvement cannot be included in the case.

Raymond, 118 O. G. 269, 1905 C. D. 334.

Only the Commissioner is authorized to pass upon the sufficiency of an excuse. The Examiner may not do so.

Reis, 116 O. G. 2007, 1905 C. D. 211.

Delay in acting upon an application is not to be excused for the purpose of permitting the applicant to devise means for making the delayed invention practical and useful. The law does not contemplate the filing of applications upon incomplete or useless inventions.

Murphy, 115 O. G. 1848, 1905 C. D. 132.

The applicant must present his petition accompanied by affidavits setting forth excuse for delay. He must do this promptly, and may not wait a year as with an amendment. Delay in presenting the petition must also be excused.

Naed, 115 O. G. 1583, 1905 C. D. 121.

A change in practice will not revive an abandoned case, but a change before it becomes abandonment may prevent its becoming abandoned.

Thompson, 113 O. G. 2504, 1904 C. D. 566.

Delay in presenting a petition for relief against the abandonment should be taken into consideration.

Koritski & Wipf, 113 O. G. 1145, 1904 C. D. 498.

It is necessary to see that amendments are received by the Office. The fact that the petitioner cannot file a new case by reason of foreign patents is not alone sufficient to excuse delay.

Stuckgold, 106 O. G. 545, 1903 C. D. 307.

An application allowed to lapse because, under the law then in force, a foreign patent was a bar, cannot be reinstated, notwithstanding the law has been changed so that it would remove the bar but for abandonment.

Casalonga, 105 O. G. 261, 1903 C. D. 212.

It is said by the applicant that he is barred from filing a new

application because of foreign patents. That fact might be sufficient to turn the scale in a doubtful case, but is not in itself a reason for holding that a case is not abandoned.

Pietzner, 103 O. G. 2172, 1903 C. D. 142.

The failure to act within the last few weeks was unavoidable, but they constitute only a small part of the delay. The law says that the delay must be unavoidable, and not merely that the last few weeks must be so.

McElroy, 101 O. G. 2823, 1902 C. D. 467.

The Commissioner has no discretion in reviewing an abandoned application unless it appears to him that the abandonment was caused by unavoidable delay.

Beecher, 101 O. G. 1132, 1902 C. D. 384.

A wrong entry on office books of attorney no excuse.

Beecher, 101 O. G. 1132, 1902 C. D. 384.

The existence of a bar to the filing of a new application is entitled to weight, and would justify this Office in resolving doubts as to the sufficiency of the showing in the applicant's favor on a request for a revival, but it does not alone warrant the revival of any case.

Bohlecke, 97 O. G. 2743, 1901 C. D. 239.

Delay cannot be considered unavoidable where it is due to the negligence of the attorney.

Collins, 97 O. G. 1372, 1901 C. D. 181.

Petitions for revival will not be docketed for hearing, but will be decided upon facts presented in the petition.

92 O. G. 561.

Showing must cover the entire period of delay.

Heine, 64 O. G. 1006, 1893 C. D. 106.

Excuse must cover entire period.

Clarke, 61 O. G. 286, 1892 C. D. 208.

The abandoned application of a foreign applicant will not be revised upon a showing that the two years' limit was allowed to expire without action solely through the inadvertence of the Associate Attorney's clerk.

Ralymaeckus, 60 O. G. 1749, 1892 C. D. 194.

Misunderstanding of attorneys not sufficient to excuse delay.

Macphail, 56 O. G. 1062, 1891 C. D. 134.

Excuse for delay must cover entire time. Neglect of attorneys not sufficient.

Murray, 56 O. G. 1060, 1891 C. D. 130; Edison, 56 O. G. 1061, 1891 C. D. 133, 30 App. D. C. 321.

A matter under this rule is addressed wholly and solely to

the discretion of the Commissioner, but by the discretion of the Commissioner is to be understood his judicial discretion.

Chapman, 29 O. G. 950, 1884 C. D. 72.

If a party seeks to escape from the operation of the limitation he must establish the utmost good faith and diligence in his conduct.

Mayor, 113 O. G. 912, 1878 C. D. 60; Chapman, 29 O. G. 950, 1884 C. D. 72.

Rule 173. New Application.

When a new application is filed in place of an abandoned or rejected application, a new petition, specification, oath, and fee will be required; but the old drawing, if suitable, may be used upon the filing of suitable permanent photographic copies thereof.

CONSTRUCTIONS.

A canceled sheet from the original application may be used.

Scheiner, 259 O. G. 383.

So long as he can make the prescribed oath, an applicant may file identical applications until the patience of the Office is exhausted.

Barrett v. Hart, 256 O. G. 225.

The drawings from an abandoned case may not be used in a new application.

Farnham, 114 O. G. 2090.

Renewed application seems to be a continuation of the former application, and the record should contain a reference to such former application.

Lewis v. Unger, 106 O. G. 543.

Where claims were allowed on appeal, then the case formally abandoned and another application substituted. In the allowance of the latter an entry should be made referring to the first case.

Lewis & Unger, 106 O. G. 543.

Petition may not be signed by the attorney in original case.

Thomas, 92 O. G. 1035.

The existence of a bar to the filing of a new application is entitled to weight, and would justify this Office in resolving doubts as to the sufficiency of the showing in the applicant's favor on a request for a revival, but it does not alone warrant the revival of any case.

Bohlecke, 97 O. G. 2743.

Rule 174. Forfeited or Withheld Application.

A forfeited application is one upon which a patent has been withheld for failure to pay the final fee within the prescribed time. (See Rule 167.)

Rule 175. New Application after Non-Payment of Final Fee.

When the patent has been withheld by reason of nonpayment of the final fee, any person, whether inventor or assignee, who has an interest in the invention for which the patent was ordered to issue may file a renewal of the application for the same invention; but any renewal application must be made within two years after the allowance of the original application. Upon the hearing of the new application abandonment will be considered as a question of fact.

Rev. Stat., sec. 4897.

CONSTRUCTIONS.

The renewal application should be accepted when made by the assignee within 2 years and 9 months.

(War Regulation Oct. 6, 1917) Tschunke, 266 O. G. 596.

Where an intent to continue is manifest, or is proven, the question is whether the specification of the earlier was sufficient as a basis for the claims ultimately founded on the later application.

General Electric Co. v. Continental Fibre Co., 268 O. G. 193.

An applicant may ordinarily make a new election in a renewal application and prosecute claims to a species other than that originally elected, provided that such species is fully disclosed in the original application.

Prouty, 264 O. G. 533.

All right to keep the reallowed application alive expired with the failure to pay the final fee within six months of the second allowance.

Barrett v. Hart, 256 O. G. 224.

M.'s patent was issued between the dates of T.'s forfeiture and application for renewal. No testimony taken as to aban-

donment. and the renewal by the Commissioner rebuts any such presumption. May have filing date.

Murphy v. Thompson, 246 O. G. 825.

The application has been once allowed, forfeited and renewed. A second forfeiture would presumably result in abandonment.

Dyson, 233 O. G. 755.

That an interfering application was filed during the period of forfeiture apparently is not sufficient to make out abandonment.

Gehring et al. v. Burry, etc., 225 O. G. 371.

Where W., with knowledge that B. was in the field, deliberately withheld his invention from the market, and neglected to renew his forfeited application or to reinsert his claims for a patent until practically the end of the period allowed, this amounted to an abandonment of the invention. (Dec. Ex.-in-Chief.)

Barbar v. Wood, 207 O. G. 299.

Attorney may sign petition for renewal.

Le Brow v. Nix, 177 O. G. 771, 180 O. G. 1139; per contra, *ex parte* Thomas, 92 O. G. 1035.

The Commissioner has no authority to accept a fee after two years.

159 O. G. 197.

The question of abandonment is one to be determined upon proof of the facts and circumstances, and will not be presumed from laches in filing the renewal application, although it may be within the power of the Commissioner, whenever he entertains a doubt as to whether there has been an abandonment to require an explanation of the delay.

Cutler v. Leonard, 136 O. G. 438.

An opinion of the Assistant Attorney-General for the Interior Department relating to the right to file a second renewal application rendered upon request of the Commission of Patents, might properly have been disregarded, and the custom which obtained for 30 years, of granting such, be persisted in. The appeal on such questions is to the Court and not to the Secretary.

In re Sambert, 135 O. G. 1584.

For all these reasons, the practice is restored which prevailed prior to 1894, of allowing more than one renewal of a forfeited application provided that it is made within two years following the date of allowance of the original application. Not retroactive.

Sumbort, 135 O. G. 1581.

Only one renewal permissible, or, if allowable, the final one must be within two years of the original.

Weston Electrical Inst. Co. v. Empire, 131 F. R. Co., 1894 C. D. 111.

But a new application may be made.

1895 C. D. 95.

The practice of refusing to entertain a second renewal application is founded upon opinions of the Attorney-General, published in 69 O. G. 639, 1894 C. D. 111, and in 70 O. G. 493, 1895 O. G. 95, which are controlling.

Theodor and Carl Weil, 122 O. G. 352.

The payment of the fee alone is not sufficient.

Ryan, 117 O. G. 599.

Last sentence sufficient authorization for signing and prosecuting renewal application.

Agee, 101 O. G. 1609.

But the law does not favor forfeiture, and it being a question of fact whether there has been abandonment, all reasonable doubt must be solved in favor of the patent.

96 O. G. 2576.

An application cannot be renewed until it has become forfeited by lapse of time.

Nicholson, 52 O. G. 310; Schulz, 111 O. G. 2494.

As, between an applicant resting upon a mere constructive reduction to practice, especially where his application is a renewal of a forfeited application, and a party who is really the first inventor, and to whom a patent has been issued for the invention. *Held*, that priority must be found for the patentee.

C. of A. D. of C., 90 O. G. 223. Above cases refer to Rules 174, 176, 177 and 178.

Although the third renewal of an application was received, acted upon the merits, and pending at the date of the Secretary's decision denying a right to a second renewal. Held, under the decision, that application cannot be prosecuted. (See C. D. 1894, 111; 69 O. G. 639.)

Vulte, 1895 C. D. 1, 70 O. G. 631.

The papers in an application, forfeited and abandoned by operation of law under Sec. 4897, cannot be withdrawn from the case to be used in a new application.

Vulte, 1895 C. D. 1, 70 O. G. 631.

Under Sec. 4897 R. S., a second application for renewal cannot be made, but a new application for a patent can be made.

1895 C. D. 95, 70 O. G. 493.

The right of an applicant to renew a forfeited application under Sec. 4897 is exhausted when once exercised.

1894 C. D. 111, 69 O. G. 639.

It is not sufficient that the final fee was mailed within the 6 months it must have been received.

Riley, 1891 C. D. 136, 56 O. G. 1203.

There is no authority of law permitting the renewal of an application, or the acceptance of the fee for such renewal, before the date on which the application would actually become forfeited for non-payment of the final fee.

Nicholson, 1890 C. D. 112, 52 O. G. 310.

The present application is by law, regardless of the wishes of the applicant, a continuation of the prior application. There can be no question but that the applicant may assert his earlier application to avoid bars, such as public use and prior invention, that might operate against the latter application. (Cases cited.)

Taylor, Jr., 44 O. G. 1265.

The 25th section (laws of 1870) gives to the Commissioner no power to revive a forfeited application when more than two years have elapsed since the date of its allowance. It is then absolutely abandoned, with no provision for reconsideration, and its subject-matter becomes the property of the public.

McCulley, 74 C. D. 76; contra Livingston, 81 C. D. 42; Sebald v. Cassidy & Smith, 61 O. G. 563, 1892 C. D. 223.

Subject-matter of this rule.

Barrett, 1891 C. D. 125, 56 O. G. 930; Ostergren v. Tripler, 95 O. G. 838; Myers, 1891 C. D. 6, 54 O. G. 265; Hopkinson, 1891 C. D. 4, 54 O. G. 264.

Rule 176. Old Application Papers may be Used in Renewal.

In a renewal the oath, petition, specification, drawing, and model of the original application may be used; but a new fee will be required. The renewal application will not be regarded for all purposes as a continuation of the original one, but must bear date from the time of renewal and be subject to examination like an original application.

CONSTRUCTIONS.

Petition not defective because it did not specify the original petition as one of the papers to be used.

Le Brow v. Nix, 177 O. G. 771, 180 O. G. 1139.

A second allowance of a claim after forfeiting adds to the presumption as to its patentability.

Hay, 139 O. G. 241.

If new matter is introduced, the old drawings may not be used.

Noyes, 122 O. G. 2062.

There must be some form of petition; the payment of the fee alone is not sufficient.

Ryan, 117 O. G. 599.

New claims may be presented.

Barrett, 1891 C. D. 154, 56 O. G. 1564.

From the first the Office has accepted the payment of a new fee and a request that the patent issue upon the old papers as a sufficient new filing, or refiling, within the spirit of the law.

Livingston, 1881 C. D. 42.

Subject-matter of this rule.

Agee, 101 O. G. 1609; Nelson, 1897 C. D. 174, 81 O. G. 1781; Brown v. Guild, 6 O. G. 392; Sexton, 1876 C. D. 251.

Rule 177. Forfeited and Abandoned Applications.

Forfeited and abandoned applications will not be cited as references.

Rule 178. Notice of Subsequent Applications.

Notice of the filing of subsequent applications will not be given to applicants while their cases remain forfeited.

Rule 179. Copies.

Copies of the files of forfeited and abandoned applications may be furnished when ordered by the Commissioner. The requests for such copies must be presented in the form of a petition properly verified as

to all matters not appearing of record in the Patent Office. (See Form 35.)

CONSTRUCTIONS.

It is not the practice to split up cases and furnish copies of parts.

Marsh Engineering Co., 193 O. G. 510.

The certificate of a judge is necessary.

Standard Adding Machine Co., 160 O. G. 257.

The trustee in bankruptcy has no such title to the applications as would justify his request for access to and copies thereof. Whether he has such an interest as would justify his being allowed to inspect them can only be decided after a hearing upon a petition duly filed, with proof of service upon the owner, in accordance with the practice set out in the decisions in the cases of Commercial Mica Co., 129 O. G. 479 and Bullock Electric Mfg. Co., 129 O. G. 1611.

In re Ives, 149 O. G. 309.

Where the patent in suit refers to an abandoned application, parties entitled to obtain copies.

Marvin Estate Co., 148 O. G. 571.

An order of the Court advisable but not necessary.

Marvin Estate Co., 148 O. G. 171.

A petition to inspect and obtain copies of an abandoned application of which patent in suit seems to be a division. The abandoned application of Reed, No. 397,553, is a part of the proceedings leading to the grant of the patent in suit, and for that reason virtually part and parcel of said patent. Petition granted.

Vacuum Specialty Co., 142 O. G. 1114.

The practice requires that access to pending applications will be refused except to parties showing a proper interest therein, and the mere allegation of an attorney that the company for which he is a counsel desires to defend a suit brought on a patent divided out of such application is not sufficient showing of interest.

In re Miami Cycle & Mfg. Co., 136 O. G. 1067.

Petition refused because references in patent was not of such a nature as to waive right of secrecy, because not accompanied by certificate of court; because not served on assignee of invention. (Service on attorney not sufficient.)

Commercial Mica Co., 129 O. G. 479; The Bullock Electric Mfg. Co., 129 O. G. 1611.

The petition, however, is not accompanied by proof of service

upon the applicant. For this reason the petition is dismissed without prejudice.

Standard Computing Scale Co. v. Stimpson, 125 O. G. 2047.

Where the patent purports to be a continuation of an earlier application, it is to be presumed that the right of the public to inspect the earlier application was affirmatively determined by the issue of the patent with such reference therein; but where the patent contains no reference to earlier applications, the patentee should be given opportunity to produce such reasons as he may have at his command why access should not be permitted.

Lanning, 124 O. G. 2902.

Copy of application of defeated party to an interference granted upon a petition duly served upon the applicant, no objection being offered, and a court stating that it would be admitted in evidence.

Benedict v. Morsell, 116 O. G. 874.

An application was required to be abandoned before patent allowed. A formal abandonment was filed. Held, that the record of the abandoned case was part of the proceeding leading to the grant of the patent, and as such accessible to the public.

Doman, 115 O. G. 804; Heard, 114 O. G. 2381.

It is the settled policy of the Office to preserve the various parts of complete applications as records of the cases in which they are originally filed. (Ayres, 51 O. G. 1944; Lawson, 101 O. G.; Priest, 103 O. G. 428. Rule 173.)

Farnhan, 114 O. G. 2090.

Petitioner wished a copy of the U. S. application if there was one, for use in defense against a French patent. Held, that the showing was insufficient.

Taupenet, 113 O. G. 1418.

To obtain copies of an abandoned application there must be shown some necessary connection between the applications and the patent upon which suit is brought.

Rusk, 113 O. G. 1418.

If the files are referred to in a record, the precise place should be specified.

Fowler, 113 O. G. 549.

Copies of an abandoned application referred to in a patent in litigation furnished upon affidavit quoted, the patentee not appearing to oppose the motion.

Standard Plunger Elevator Co., 112 O. G. 1480.

Abandoned application referred to in a suit for infringe-

ment. Judge certified that copy would be received in evidence. Petition granted. (109 O. G. 1885.)

Ashtabula Telephone Co., 110 O. G. 860.

Requests for pending or abandoned applications referred to in patents should be supported by a showing of reasons why they are desired, together with proof of service upon the applicant of the papers constituting the request and showing.

Dyar, 106 O. G. 1508.

The request is defective, in that it is not sufficiently explicit. The particular application, copies of which it is desired to obtain, is not specified.

McWilliams, 100 O. G. 2774.

Abandoned applications on file in the Patent Office are not open to public inspection.

Wycoff, 1892 C. D. 108, 59 O. G. 1104.

Abandoned applications on file in the Patent Office are not open to public inspection.

Wycoff, 1892 C. D. 108, 54 O. G. 1104.

A petition, accompanied by a reasonable suggestion of their necessity for purposes of evidence, for certified copies of an abandoned application, will be granted, though permission to inspect the abandoned cases in the Patent Office will be refused.

Fowler and Fowler, 1889 C. D. 209, 49 O. G. 562.

EXTENSIONS.

Rule 180. Extensions.

Patents can not be extended except by act of Congress.

Rev. Stat., sec. 4924.

DISCLAIMERS.

Rule 181. Disclaimer of Parts of Inventions not New.

Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed as his invention or discovery more than he had a right to claim as new, his patent will be valid for all that part which is truly and justly his own, provided the same is a material

or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law ($10), make disclaimer of such parts of the thing patented as he or they shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of filing the same, except as to the question of unreasonable neglect or delay in filing it.

CONSTRUCTIONS.

The power to disclaim is a beneficial one, and ought not to be denied except where it is resorted to for a fraudulent and deceptive purpose. We think there is no force in the criticism that a disclaimer may not extend to a part of the specification as well as to a distinct claim.

The Carnegie Steel Co., Ltd., v. The Cambria Co., 99 O. G. 1870, 1902 C. D. 592.

This rule does not refer to disclaimers which are filed to make an application conform to the state of the art. (V. R. 182.)

Murdoch, 1879 C. D. 260.

The effect of a disclaimer is entirely neutralized when, in its substance, it is contradictory of the claim, and not merely explanatory of it.

Hobson, 1872 C. D. 20.

A disclaimer should specify by verbal description the particular thing or construction to which it was designed to apply. It is not sufficient to disclaim all things, arrangements and combinations shown and described in a certain patent.

Richardson, 1871 C. D. 303.

Rule 182. Different Kinds of Disclaimers.

The statutory disclaimers treated of in Rule 181 are to be distinguished from those which are embodied in original or reissue applications, as first filed or subsequently amended, referring to matter shown or described, but to which the disclaimant does not choose to claim title, and also from those made to avoid the continuance of an interference. The disclaimers falling within this present rule must be signed by the applicant in person and require no fee. (See Rule 107. For forms of disclaimers see appendix, Forms 28 and 29.)

ASSIGNMENTS.

Rule 183. Assignability of Patents.

Every patent or any interest therein is assignable in law by an instrument in writing; and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under the patent to the whole or any specified part of the United States.

Rev. Stats., sec. 4898.

CONSTRUCTIONS.

See Rules 5, 6 and 26.

It seems to be plain that legal title to a patent does not completely vest in the assignee until the patent is issued. Before that, an assignment of the right to a patent gives the assignee merely legal title to such right as the patentee may have. As between the assignee and the U. S. these rights are equitable.

Thompson v. Automatic Fire Protection Co., 197 F. 754.

Inasmuch as M. made a legal transfer of his inchoate right to the K. K. Mfg. Co., and requested the patent to issue to that Company, and the H. R. Miller Mfg. Co. is adjudged a bankrupt, the title of the bankrupt to the inchoate right is vested, by operation of law, in the trustee in bankruptcy under the provision of Bankruptcy Act, and the trustees in bank-

ruptcy having made a sale of the property in question to the petitioner, and that sale having been approved by a court of competent jurisdiction, it is held that the petitioner should be recognized in the prosecution of the above entitled applications, and that when patents are granted thereon they shall issue to the petitioner as assignee.

Slibler, 177 O. G. 1044.

Apparently a request to issue the patent to the assignee is not necessary to the completeness of the assignment.

Wende v. Horine, 191 F. 620.

Rule 184. May be Vested in Whom.

Interest in patents may be vested in assignees, in grantees of exclusive territorial rights, in mortgages, and in licenses.

(*a*) An assignee is a transferee of the whole interest of the original patent or of an undivided part of such whole interest, extending to every portion of the United States. The assignment must be written or printed and duly signed.

(*b*) A grantee acquires by the grant the exclusive right, under the patent, to make, use, and vend, and to grant to others the right to make, use, and vend, the thing patented within and throughout some specified part of the United States, excluding the patentee therefrom. The grant must be written or printed and be duly signed.

(*c*) A mortgage must be written or printed and be duly signed.

(*d*) A licensee takes an interest less than or different from either of the others. A license may be oral, written, or printed, and if written or printed, must be duly signed.

CONSTRUCTIONS.

The Supreme Court has said (Pope Mfg. Co. v. Gormully, 59 O. G. 471) that part of the claims of a patent cannot be assigned.

McCormick, 116 O. G. 1183-1184.

Subject-matter of this rule.
Hunter, 1891 C. D. 122, 56 O. G. 929.

Rule 185. Validity of Assignment.

An assignment, grant, or conveyance of a patent will be void as against any subsequent purchaser or mortgagee for a valuable consideration without notice unless recorded in the Patent Office within three months from the date thereof (or prior to such subsequent purchase or mortgage. Proposed Law H. R. 11984).

If any assignment, grant, or conveyance of any patent shall be acknowledged before any notary public of the several States or Territories or the District of Columbia, or any commissioner of the United States circuit court, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under section 1750 of the Revised Statutes, the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be *prima facie* evidence of the execution of such assignment or conveyance.

Rev. Stat., sec. 4898.
Act Mar. 3, 1897.

CONSTRUCTIONS.

Subject-matter of this rule.
Funiston, 1889 C. D. 225.

Rule 186. Recording.

No instrument will be recorded which is not in the English language and which does not, in the judgment of the Commissioner, amount to an assignment, grant, mortgage, lien, incumbrance, or license, or which does not affect the title of the patent or invention to which it relates. Such instrument should identify the patent by date and number; or, if the invention be unpatented, the name of the inventor,

the serial number, and date of the application should be stated.

CONSTRUCTIONS.

The transfer of an interest in a company which he agrees to form to promote invention is not a recordable assignment.

Farand, 181 O. G. 267.

It is held that the word "lien" in Rule 198 does not refer to an *ex parte* statement or affidavit by the beneficiary under the lien.

Clark, 115 O. G. 250.

An instrument may be an assignment and convey the legal title even if a license is reserved.

Rowand, 114 O. G. 2091.

The law does not provide for recording evidence relating to assignments, but merely for recording the instruments themselves. Letters are merely evidence, and cannot be recorded.

Charlton, 104 O. G. 1120.

The instrument must be of such a character that it may itself affect the title or the rights of the patentee. The Office cannot strike from the record any instrument regularly and properly recorded. It does not pass upon evidence as to validity, and does not record anything which merely constitutes such evidence.

Flanigan, 103 O. G. 428.

No residence given, nor filing date.

Brand, 821 O. G. 893, 1898 C. D. 12, 82 O. G. 893.

Rule 187. Conditional Assignments.

Assignments which are made conditional on the performance of certain stipulations, as the payment of money, if recorded in the office are regarded as absolute assignments until canceled with the written consent of both parties or by the decree of a competent court. The office has no means for determining whether such conditions have been fulfilled.

CONSTRUCTIONS.

Ratifications of assignment by persons not appearing as parties thereto are subject to fees for recording, in addition to those charged for recording the assignment.

Bradford v. Hood, 123 O. G. 1283.

A case that passes on the subject-matter of this rule.
Pender, 123 O. G. 2975.
An assignment of an application includes any application divided therefrom.
Wurtz, 120 O. G. 2441.
An assignment referring to an application filed by two parties as joint inventors cannot be applied to an application or patent in the name of one of them as a sole inventor, even where the same invention is claimed in both cases.
Harris, 116 O. G. 297.
The instrument is to be taken as a whole in identifying the application.
E. P. O'Leary, 91 O. G. 2001.
Assignment and license—difference.
Rosback, 89 O. G. 705.

Rule 188. Patent Issue to Assignee.

In every case where it is desired that the patent issue to an assignee, the assignment must be recorded in the Patent Office at a date not later than the day on which the final fee is paid. (See Rule 26.) The date of the record is the date of the receipt of the assignment at the office.

CONSTRUCTIONS.

An assignment by a master under order of the Court refused recognition.
McPherson, 117 O. G. 275.
An assignment must be given force by the Office until modified by the written consent of the parties or a decree of a competent court.
Milton, 97 O. G. 2307.
Questions under this rule reviewable by Secretary of the Interior.
Cole Co., 1893 C. D. 138, 65 O. G. 1915.
The provisions of the rule are never departed from except in cases where both the inventor and the assignee request that the patent shall issue to the assignee, the assignment being on record not later than the day of closing the weekly issue, namely, Thursday of every week.
Cole Co., 1893 C. D. 138, 65 O. G. 1915.

Rule 189. Acknowledgment of Assignments.

The receipt of assignments is generally acknowledged by the office. They are recorded in regular order as promptly as possible, and then transmitted to the persons entitled to them. (For form of assignment, see appendix, forms 38-43.)

CONSTRUCTIONS.

"It is believed that the Office should follow the uniform rule of not returning an assignment filed to any one save the person filing it or the beneficiary of the instrument. It may depart from the rule upon the advice of a court of competent jurisdiction, but has no machinery or jurisdiction to investigate and determine the rights of the parties except as shown by the instrument itself.".

Hogan, 105 O. G. 1780.

OFFICE FEES.

Rule 190. Payable in Advance.

Nearly all the fees payable to the Patent Office are positively required by law to be paid in advance—that is, upon making application for any action by the office for which a fee is payable. For the sake of uniformity and convenience, the remaining fees will be required to be paid in the same manner.

Rev. Stat., sec. 4893.

Rule 191. Schedule of fees.*

The following is the schedule of fees and of prices of publications of the Patent Office:

On filing each original application for a patent, except in design cases.....$15.00

On issuing each original patent, except in design cases..... 20.00

*It is proposed to make the filing fee $20.00 and the final fee $15.00.

In design cases:
For 3 years and 6 months..... 10.00
For 7 years..... 15.00
For 14 years..... 30.00
On every application for the reissue of a patent, 30.00
On filing each disclaimer..... 10.00
On an appeal for the first time from the primary examiner to the examiners in chief... 10.00
On every appeal from the examiners in chief to the Commissioner..... 20.00
For certified copies of patents if in print:
For specification and drawing, per copy... .10
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For manuscript copies of records, for every 100 words or fraction thereof..... .10
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For the drawings, if in print..... .10
For copies of drawings not in print, the reasonable cost of making them.
For photo prints of drawings, for each sheet of drawings:
Size 10 by 15 inches, per copy..... .25
Size 8 by 12½ inches, per copy..... .15

For recording every assignment, agreement, power of attorney, or other paper, of 300 words or under	1.00
Of over 300 and under 1,000 words	2.00
For each additional 1,000 words or fraction thereof	1.00

(It is proposed, H. B. 11984, to add "For each additional patent or application included in one writing, twenty-five cents additional.)

For abstracts of title to patents or inventions:	
For the search, one hour or less, and certificate	1.00
Each additional hour or fraction thereof	.50
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In paper covers..... 1.00

A single uncertified copy of a decision or action by any

tribunal of this Office will be furnished to an interested party without charge.

Tailor, 1892 C. D. 96.

Only one fee on appeal to the Examiners-in-Chiefs in a single case.

Thomson, 1891 C. D. 138, 56 O. G. 1203.

A case that passes on the subject-matter of the rule.

Bradford & Hood, 123 O. G. 1283. See note to Rule 198.)

Rule 192. Order for copy of Assignment.

An order for a copy of an assignment must give the liber and page of the record, as well as the name of the inventor; otherwise an extra charge will be made for the time consumed in making any search for such assignment.

Much time may be saved by making the order for copies definite. See notice, 233 O. G. 1.

Rule 193. Copies and Tracings from the Files.

Persons will not be allowed to make copies or tracings from the files or records of the office. Such copies will be furnished, when ordered, at the rates already specified.

Rule 194. Mode of Payment.

All payments of money required for office fees must be made in specie, Treasury notes, national-bank notes, certificates of deposit, post-office money orders, or certified checks. Money orders and checks should be made payable to the "Commissioner of Patents." Payment may also be made to the Treasurer, or to any of the depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose, who will issue a certificate of deposit in triplicate and will forward the original and the duplicate certificates to the Sec-

retary of the Treasury and the Commissioner of Patents, respectively, and will give the triplicate certificate to the depositor. Money sent by mail to the Patent Office will be at the risk of the sender. Letters containing money should be registered. In no case should money be sent with models.

Rev. Stat., sec. 4935.

CONSTRUCTIONS.

See notes to Rules 164 and 167.

Applicants and attorneys should take notice of the fact that the last regular mail delivery at the Patent Office is at about noon each day, and it would seem to be an act of prudence, where the matter is of vital importance, as in the present case, and it is doubtful whether the papers will reach the Patent Office in time by the regular mail, to employ some other agency, or at least to affix a special delivery stamp to the envelope.

136 O. G. 657.

The duplicate and not triplicate receipt sent to the Office. Date of payment and not date of receipt prevails.

Connell, 107 O. G. 2235.

It was his duty to pay the fee in time to obtain the certificate and mail it within the six months.

Baldwin, 106 O. G. 1780.

Coupons are only received when properly filled out.

92 O. G. 441.

A draft dishonored because of failure of bank does not constitute a payment of a patent fee. (Disc. of Sec.)

Wash, 1897 C. D. 204, 81 O. G. 799.

History of the rule.

Griffith, 1897 C. D. 46, 80 O. G. 1126.

This rule does not interfere with the right given an applicant by the statute of paying patent fees to the officers designated in section 4935 R. S. any time within the period fixed by law, but prevents the abuse of this privilege by requiring that the certificate of deposit shall be promptly forwarded to the Patent Office.

Griffith, 1897 C. D. 46, 80 O. G. 1126.

The part of this rule relating to certificates of deposit, adopted June 18, 1897, should not be held to apply to certificates of deposit issued prior to the approval of the rule, pro-

vided they are forwarded to the patent Office within a reasonable time after the publishing of said rule.

Griffith, 1897 C. D. 46, 80 O. G. 1126.

REPAYMENT OF MONEY.

Rule 195. Money Paid by Mistake Refunded.

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

Rev. Stat., sec. 4936.

CONSTRUCTIONS.

Hereafter all patent fees shall be paid to the Commissioner of Patents, who shall deposit the same in the Treasury of the United States in such manner as the Secretary of the Treasury shall direct, and said Commissioner is authorized to pay back any sum or sums of money paid to him by any person by mistake or in excess of the fee required by law. Excerpt from the Deficiency Appropriation Act, approved March 6, 1920.

Fee not returned or transferred when applicant finds that another than himself was the real inventor.

Giles, 190 O. G. 547.

A new reference cited in Commissioners decision, the appeal fees not returned, as new citation was made to cure a defect not previously pointed out by applicant.

Hofmann, 125 O. G. 991.

The Examiner's ruling was a judicial decision subject to review upon appeal, and since the applicant accepted his decision without appeal it is not entitled to the return of the fee in the present case.

The Chapot Shirlaw Co., 121 O. G. 2327.

A filing fee will not be transferred from a proper sole application to a joint application. A fee paid as a joint application which the Office has refused to file may be applied to a sole application.

Harris, 118 O. G. 1682.

The appeal was in order, and, having decided to take the same, the petitioner made no mistake in paying the necessary fee. The motion to reopen, with the consequent proceedings which the petitioner brought and carried on, instead of following up the appeal, represents a mere change of purpose on his part. The fee not returned.

Townsend, 118 O. G. 1386.

A joint application became abandoned for want of filing fee. One of the joint inventors filed an application with fee—a request to transfer the fee to a subsequent joint application refused.

Harris, 117 O. G. 1164.

Division requested found to be an error. The fee not returned.

Thompson, 107 O. G. 270.

The record of each application must be complete within itself, and the parts of an application once filed cannot be used as parts of a later application.

103 O. G. 428.

Money will not be returned merely because the applicant wishes to change the original application into one for a reissue.

Priest, 103 O. G. 428.

Mistake in payment, not a mistake in judgments, as where one makes an application as a sole inventor when he should have applied as a joint inventor. Application to a different application is equivalent to a repayment.

101 O. G. 2079.

Applicant filed an application which was rejected. He then sought to introduce new claims which were rejected for new matter, the Examiner saying that the matter was patentable. In a separate application, applicant filed an application for such new matter, which was rejected by the new Examiner. Fee not returned. (Motion for rehearing denied.) 101 O. G. 2827.

Fowler, 101 O. G. 1833-4.

Drawings in one case and specification which was a copy of a specification in another case filed. Refused to apply the filing fee in a new case.

Lawson, 101 O. G. 1833.

When a caveat was filed under the mistaken idea that it was only necessary to state the object of the invention, the fee will not be returned.

Landenberger, 99 O. G. 1866.

An appeal was taken to Examiner-in-Chief, who decided

that the appeal was improper under Rule 124. The return of the appeal fee refused.

Brill & Adams, 98 O. G. 2587.

Question as to whether an application with fee should be construed as for a design or mechanical patent.

Hartje, 95 O. G. 2485.

When an appeal is regularly taken, and the fee therefor paid, but thereafter the applicant changes his purpose, and concludes not to prosecute the appeal. Held that there was no such mistake in the payment as would warrant the return of the appeal fee.

Horton, 1897 C. D. 207, 81 O. G. 800.

An appeal fee will not be returned because applicant concludes not to prosecute.

Horton, 1896 C. D. 99, 77 O. G. 2137.

Request after examination for the return of fee paid upon an application for a design upon the same day that a patent issued to the same inventor for the same design refused.

Flomerfelt, 1895 C. D. 101, 73 O. G. 1411.

Where an applicant paid a second renewal fee on the very day that a decision was published to the effect that there was no authority in the statute for more than one renewal fee of an application. Held that the fee was paid by mistake, and should be returned.

Smith, 1895 C. D. 99, 71 O. G. 297.

Where the original application had been stricken from the files because it appeared that the inventor has signed and sworn to it in blank—Held, that the fee formerly paid upon said application could not be applied to a new application filed in place thereof.

Ayres, 1890 C. D. 103, 51 O. G. 1944.

When an application is made, by mistake, for a mechanical patent, the fee will not be applied as part payment for a design patent.

Sellers, 1870 C. D. 58.

A case that passes on the subject-matter of this rule.

Zehrbach, 108 O. G. 290.

Rule 196. Official Gazette.

The Official Gazette, a weekly publication which has been issued since 1872, takes the place of the old Patent Office Report. It contains claims of all patents issued, including reissues and designs, with por-

tions of the drawings selected to illustrate the inventions claimed, illustrations of trade-marks published, and lists of trade-marks, prints, and labels registered. It also contains decisions rendered by the courts in patent cases and by the Commissioner of Patents, and other special matters of interest to inventors.

The Gazette is furnished to subscribers at the rate of $5 per annum. When sent abroad, an additional charge is made for the payment of postage. Single copies are furnished for ten cents. All orders and remittances for the Gazette should be sent to the Superintendent of Documents, Government Printing Office, Washington, D. C. The Gazette is issued in monthly volumes, with a title page and index to each volume. An index is published annually, which is sent to all subscribers without additional cost.

On June 30, 1912, the publication of the monthly library edition, issued since 1872, containing the full specifications and drawings of all patents granted during the previous month, was suspended.

Rev. Stat., sec. 489.

LIBRARY REGULATIONS.

Rule 197. Removal of Books.

Officers of the bureau and members of the examining corps only are allowed to enter the alcoves or take books from the scientific library.

Books taken from this library must be entered in a register kept for the purpose, and returned on the call of the librarian. They must not be taken from the building except by permission of the Commissioner.

Any book lost or defaced must be replaced by a new copy.

Patentees and others doing business with the office can examine the books only in the library hall.

Translations will be made only for official use.

Copies or tracings from works in the library will be furnished by the office at the usual rates.

Rev. Stat., sec. 486.

AMENDMENTS OF THE RULES.

Rule 198. Publication of Amendment.

All amendments of the foregoing rules will be published in the Official Gazette.

QUESTIONS NOT SPECIFICALLY PROVIDED FOR.

Rule 199. Supervisory Authority of the Commissioner.

All cases not specifically defined and provided for in these rules will be decided in accordance with the merits of each case under the authority of the Commissioner, and such decision will be communicated to the interested parties in writing.

CONSTRUCTIONS.

In an interference case, when time seemed to be needlessly consumed by an applicant in contest with a patentee.

Gregory, Jackson & Connet v. Ledoux, 219 O. G. 929.

Upholding authority of the Commissioner, even after a favorable decision by the Board.

Case Moore v. U. S. ex rel. Chott, 192 O. G. 520.

The supervisory power of the Commissioner will not be exercised to require a dissolution of an interference unless a proper affidavit under Rule 75 was filed.

Hodgkinson v. Roller, 185 O. G. 251.

The Supervisory authority of the Commissioner will not be exercised where there is still an appeal to him.

Brown v. Inwood & Lavenberg, 135 O. G. 895; Frost v. Chase, 151 O. G. 741.

Interference dissolved, apparently under supervisory power.

Reechert v. Brown, 124 O. G. 2903.

See note to Rule 124.

The supervisory authority of the Commissioner will be exercised only in a clear case.

Munro v. Walker, 122 O. G. 2062.

There is no such error in the Examiner's decision as would warrant the review of the Primary Examiner's decision affirming the patentability of a claim.

Rinsche v. Sandherr, 105 O. G. 1780.

An interference may be dissolved, under the supervisory authority of the Commissioner, but the power should be exercised with caution, and only in a clear case.

Wilcomb v. Lasher, 105 O. G. 743.

It is only in rare cases that the supervisory authority of the Commissioner will be exercised, and then only to the extent of returning it to the Examiner to be reconsidered. (See Hicks & Costello, 103 O. G. 1163.)

Read v. Scott, 101 O. G. 449.

The discretionary power of the Commissioner should be exercised only in exceptional cases, and then only to correct some palpable error in the decision of the Examiner which is clear and evident on its face.

Goss v. Scott, 96 O. G. 2307; Denton & Denton v. Riker, 98 O. G. 415. See Ware, 97 O. G. 2744.

That authority should be exercised only where the rules present no remedy.

Curtis v. Matsh, 92 O. G. 1236.

The Commissioner has power to withhold a patent even after a favorable decision by a tribunal of the Office, but this power will only be exercised in extreme cases.

Strong, 1891 C. D. 175, 57 O. G. 274.

Cases that pass on the subject-matter of this rule.

Sipselutz v. Floyd, 130 O. G. 2718; Wickers and Furlong v. Weiwurm, 129 O. G. 250-1; Serrell v. Donnelly, 129 O. G. 250-1; Barber v. Wood, 127 O. G. 1991; Daggett v. Kaufmann, 127 O. G. 3641.

Rule 200. Application of Former Rules.

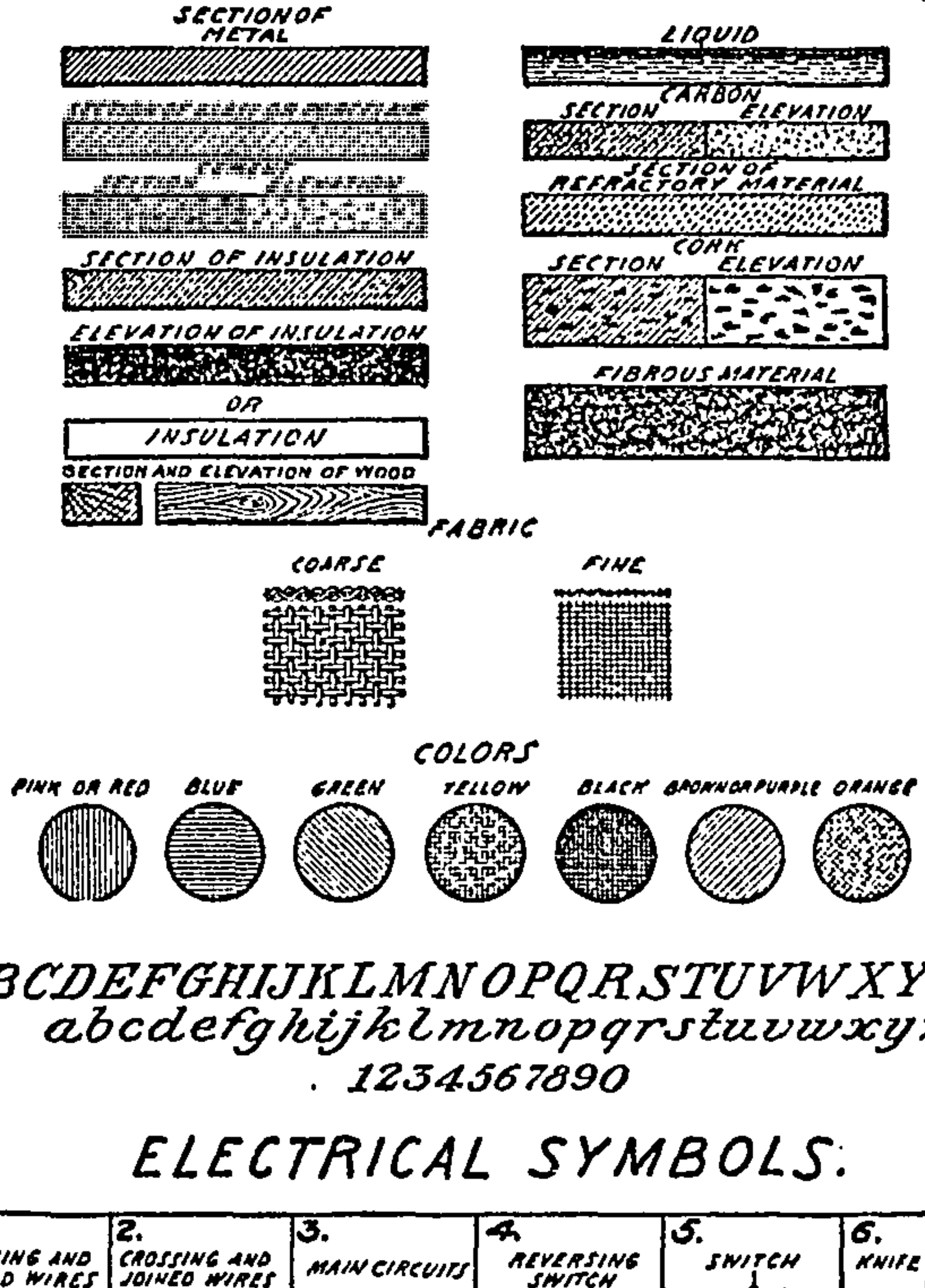
Questions arising in applications filed prior to January 1, 1898, where these rules do not apply, shall be governed by the rules of June 18, 1897.

THOMAS EWING,
Commissioner of Patents.

APPENDICES.

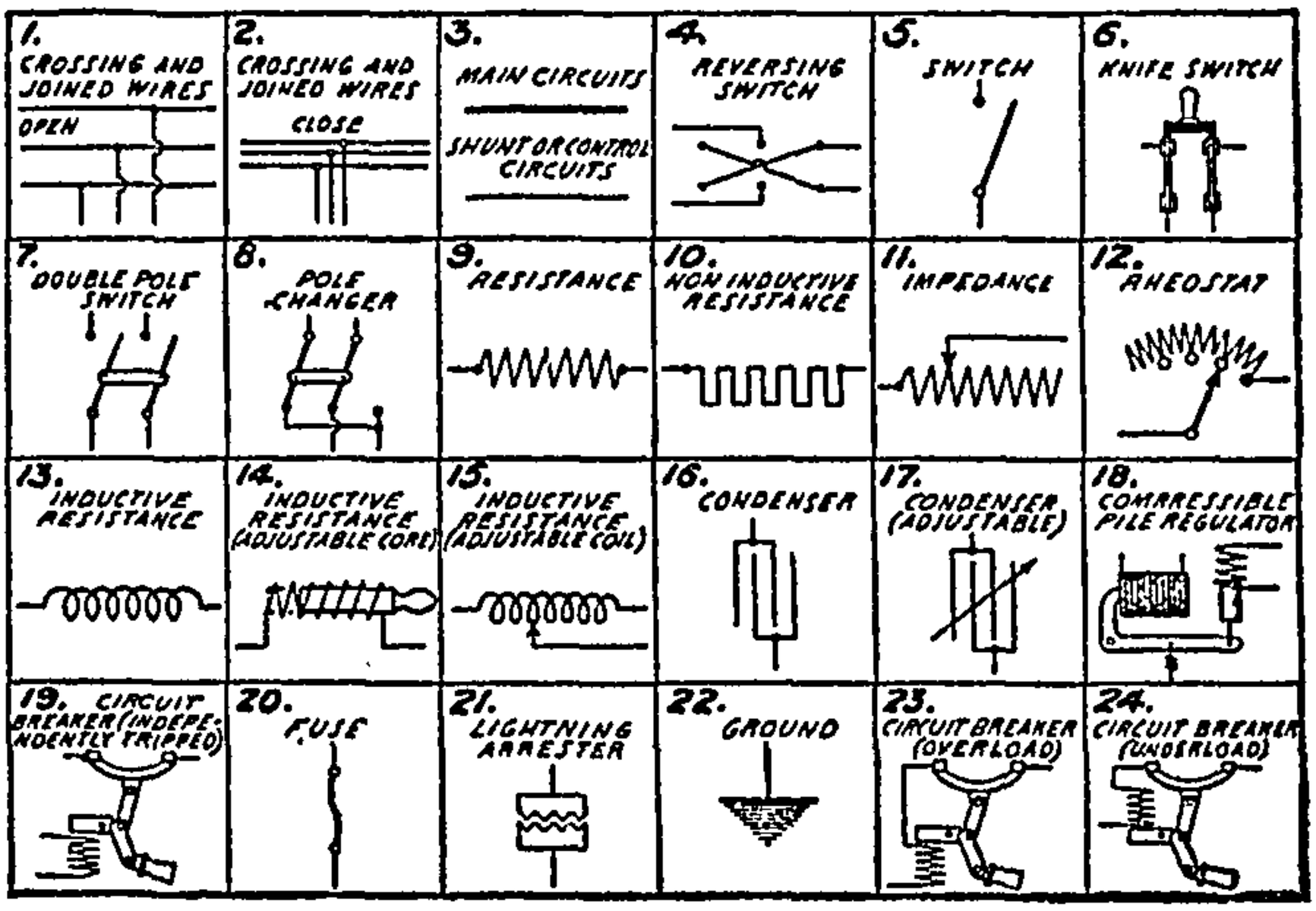
APPENDIX A.

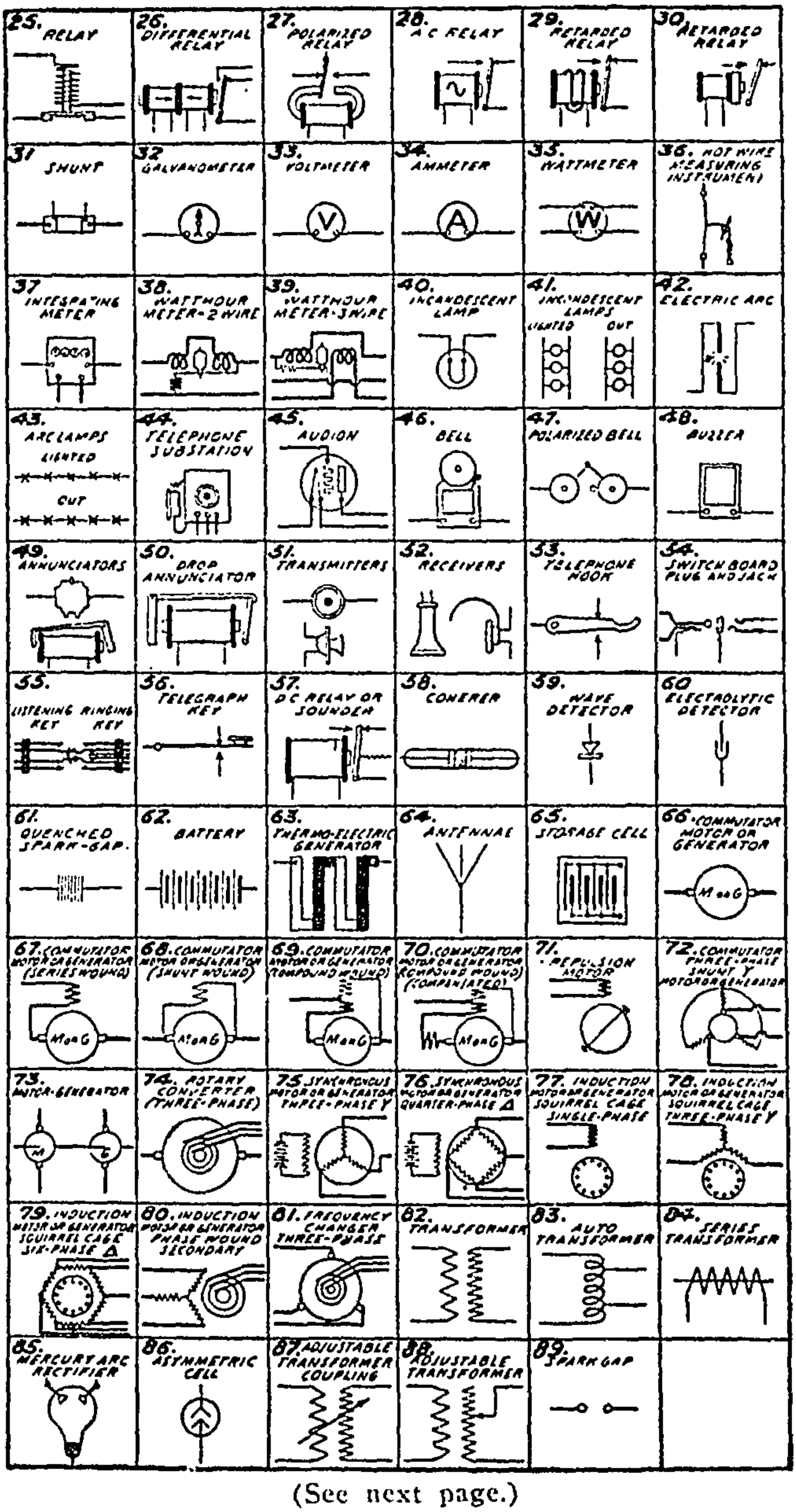
CHARTS FOR DRAFTSMEN.



ABCDEFGHIJKLMNOPQRSTUVWXYZ
abcdefghijklmnopqrstuvwxyz
1234567890

ELECTRICAL SYMBOLS.





(See next page.)

This chart should be followed.
Daum, 267 O. G. 183.

CONSTRUCTIONS.

The insulating material should be indicated as provided in the charts.

Whitney, 110 O. G. 603.

See Journal of American Society of Mechanical Engineers, Dec., 1912, page 48.

As to colors, see M. Zimmerman Company, 127 O. G. 1991.

"While a full and complete disclosure is essential, on the other hand, the invention should be disclosed in its *simplest aspect*. For instance, where the invention resides in a motor provided with a main field, an armature and a compensating winding, bearing certain space relations to each other, the invention is best illustrated by the simplest form of diagrammatic view (see Chart for Draftsmen, Rules of Practice) showing these parts conventionally in their proper space relations (Illus.-Pats., 946, 502; 1, 138, 673; 931, 336). To present working drawings or a photographic view of such a motor showing details of base supports, casings, journals and bearings, or even the specific form of pole pieces and windings, where such specific forms are not of the essence of the invention, not only places needless labor upon the office, but obscures the real invention. This is even more true of complicated systems of wiring involving many circuits *Only circuits typical of the invention* should be illustrated, and they in the *simplest form possible, duplication being ordinarily avoided.* An intricate working drawing of such a system is the bane of all who have to deal with it, and the amount of unnecessary time and labor in the aggregate, spent by the office, attorneys and the courts in deciphering it, both before and after patent, can not be estimated. If we multiply one such patent by the total number of this character among nearly one and a quarter million patents granted by our office we can appreciate what an unnecessary load our system labors under.

"The *main* circuit and *all apparatus connected in series* therewith should be shown in *heavy* lines and, so far as practicable, *in the same horizontal or vertical direction,* while the *shunt* and *control* circuits should be shown in *lighter* lines, preferably at right angles thereto. Lines should cross as little as possible. The arrangement of apparatus should be such as to keep the groups distinct and clearly show their relations at a glance (Illus.-Pats., 1, 113, 199; 900, 707; 1, 170, 211). Much ingenuity can be displayed in skillfully arranging the parts of electrical systems and all work in connection therewith is ever afterward facilitated thereby. So vital is this to a clear understanding of the invention that in some cases in division 26, it is necessary for the examiner to make his own layout of the system in working up the case.

"In the case of *methods,* each step of which involves a different particular arrangement of parts of an electrical system, in addition to the showing of the system *the arrangement of parts for each step should be diagrammatically illustrated in the most conventional manner, the diagrams being arranged in the order of the steps.* This is more important to a clear disclosure, even, than a complete layout of the system, including the controller features and connections, since given the sequence of steps desired the designer or draftsman may well supply the latter (Illus.-Pats., 527, 947; 516, 834; 1, 199, 453; 587, 340).

"Where the drawing alone can not be made to tell the whole story of an invention, often a *legend applied to a part* will facilitate search. For instance, where it is essential that the field magnet of a dynamo electric machine be normally saturated, the addition of the words "normally saturated" discloses at a glance the essential characteristic of the device."

—Richard E. Marine, *Paper before Examining Corps.*

APPENDIX B.

FORMS.

PETITIONS.

The forms given in the Rules of Practice are merely suggestive and not mandatory.

Cook, 1892 C. D. 232, 61 O. G. 1480.

No. 1. By a Sole Inventor.

To the Commissioner of Patents:

Your petitioner, ..., a citizen of the United States and a resident of ...., in the county of .... and State of ..... (*or*, subject, etc.), whose post-office address is ...., prays that letters patent may be granted to him for the improvement in .... set forth in the annexed specification.

Signed at ....., in the county of ..... and State of ...., this ..... day of ....., 19.....

.....

No. 2. By Joint Inventors.

To the Commissioner of Patents:

Your petitioners, ..., and ....., citizens of the United States and residents, respectively, of ...., in the county of ..... and State of ..... and of ...., in the county of .... and State of .....

(*or*, subjects, etc.), whose post-office addresses are, respectively, ... and ...., pray that letters patent may be granted to them, as joint inventors, for the improvement in ....., set forth in the annexed specification.

Signed at ....., in the county of ..... and State of ...., this ..... day of ....., 19.....

.....

.....

Two petitions may be used.
S. T. and C. H. Wellman, 88 O. G. 2065.

No. 3. By an Inventor, for Himself and Assignee.

To the Commissioner of Patents:

Your petitioner, ..., a citizen of the United States and a resident of ...., in the county of .... and State of ..... (*or*, subject, etc.), whose post-office address is ...., prays that letters patent may be granted to himself and ....., a citizen of the United States and a resident of ...., in the county of .... and State of ....., whose post-office address is ....., as his assignee, for the improvement in ...., set forth in the annexed specification.

Signed at ....., in the county of ..... and State of ...., this ..... day of ....., 19.....

.....

.....

No. 4. Petition with Power of Attorney.

To the Commissioner of Patents:

Your petitioner, ..., a citizen of the United States and a resident of ...., in the county of .... and State of ..... (*or*, subject, etc.), whose post-office address is ...., prays that letters patent may be granted to him for the improvement in ...., set forth in the annexed specification; and he hereby appoints ....., of ....., State of ....., his attorney, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the patent, and to transact all business in the Patent Office connected therewith.

Signed at ....., in the county of ..... and State of ...., this ..... day of ....., 19.....

.....

Last sentence sufficient authorization for signing and prosecuting renewal application.

Agee, 101 O. G. 1609.

No. 5. By an Administrator.

To the Commissioner of Patents:

Your petitioner, ..., a citizen of the United States and a resident of ...., in the county of .... and State of ..... (*or*, subject, etc.), whose post-office address is ...., administrator of the estate of .....

....., late a citizen of .....
....., deceased (as by reference to the duly certified copy of letters of administration, hereto annexed, will more fully appear), prays that letters patent may be granted to him for the invention of the said ..... (improvement in .....), set forth in the annexed specification.

Signed at ....., in the county of ..... and State of .....
....., this ..... day of ....., 19.....

.....,
Administrator, etc.

No. 6. By an Executor.

To the Commissioner of Patents:

Your petitioner, ..., a citizen of the United States and a resident of .....
....., in the county of .....
..... and State of ..... (*or*, subject, etc.), whose post-office address is .....
....., executor of the last will and testament of ....., late a citizen of .....
....., deceased (as by reference to the duly certified copy of letters testamentary, hereto annexed, will more fully appear), prays that letters patent may be granted to him for the invention of the said ..... (improvement in .....), set forth in the annexed specification.

Signed at ....., in the county of ..... and State of .....

....., this ..... day of ....., 19.....

.....,

Executor, etc.

No. 7. By a Guardian of an Insane Person.

To the Commissioner of Patents:

Your petitioner, ..., a citizen of the United States and a resident of ...., in the county of .... and State of ..... (*or*, subject, etc.), whose post-office address is ....., ..., and who has been appointed guardian (*or* conservator *or* representative) of .... (as by reference to the duly certified copy of the order of court, hereto annexed, will more fully appear), prays that letters patent may be granted to him for the invention of the said .... (improvement in .....), set forth in the annexed specification.

Signed at ....., in the county of ..... and State of ....., this ..... day of ....., 19.....

.....,

Guardian, etc.

No. 8. For a Reissue (by the Inventor).

To the Commissioner of Patents:

Your petitioner, ..., a citizen of the United States and a resident of ....., ..., in the county of .... and State of ..... (*or*, subject, etc.), whose post-office address is .....

....., prays that he may be allowed to surrender the letters patent for an improvement in ....., granted to him ...., 19....., whereof he is now sole owner (*or*, whereof ....., on whose behalf and with whose assent this application is made, is now sole owner, by assigmment), and that letters patent may be reissued to him (*or*, the said ....) for the same invention upon the annexed amended specification. With this petition is filed an abstract of title, duly certified, as required in such cases.

Signed at ....., in the county of ..... and State of ...., this ..... day of ....., 19.....

.....

[*Assent of Assignee to Reissue.*]

The undersigned, assignee of the entire (or of an undivided) interest in the above-mentioned letters patent, hereby assents to the accompanying application.

.....

No. 9. For a Reissue (by the Assignee).

[To be used only when the inventor is dead.]

To the Commissioner of Patents:

Your petitioner, ..., a citizen of the United States and a resident of ...., in the county of .... and State of ..... (*or*, subject, etc.), whose post-office address is ...., prays that he may be allowed to surrender the letters patent for an improvement in .....

....., No. ....., granted ....., 19....., to ...., now deceased, whereof he is now owner, by assignment of the entire interest, and that the letters patent may be reissued to him for the same invention, upon the annexed amended specification. With this petition is filed an abstract of title (*or*, an order for making and filing the same, etc.).

Signed at ....., in the county of ..... and State of ...., this ..... day of ....., 19.....

.....

No. 10. For Letters Patent for a Design.

To the Commissioner of Patents:

Your petitioner, ..., a citizen of the United States and a resident of ...., in the county of .... and State of ..... (*or*, subject. etc.), whose post-office address is ...., prays that letters patent may be granted to him for the term of three and one-half years (*or*, seven years or fourteen years) for the new and original design for ....., set forth in the annexed specification.

Signed at ....., in the county of ..... and State of ...., this ..... day of ....., 19.....

.....

No. 11. For a Caveat.

(This form is obsolete; law relating to caveats repealed by act of July 1, 1910.)

No. 12. For the Renewal of a Forfeited Application.

To the Commissioner of Patents:

Your petitioner, ..., a citizen of the United States and a resident of ...., in the county of .... and State of ..... (*or*, subject, etc.), whose post-office address is ...., represents that on ...., 19....., he filed an application for letters patent for an improvement in ....., serial number ....., which application was allowed ....., 19....., but that he failed to make payment of the final fee within the time allowed by law. He now makes renewed application for letters patent for said invention, and prays that the original specification, oath, drawings, and model may be used as a part of this application.

Signed at ....., in the county of ..... and State of ...., this ..... day of ....., 19 .....

.....

The attorney in the original case may not sign.
Thomas, 92 O. G. 1035. See also Barre, 97 O. G. 1176 and 94 O. G. 1791; La Brow v. Nix, 177 O. G. 771.

SPECIFICATIONS.

No. 13. For an Art or Process.

To all whom it may concern:

Be it known that I, ..., a citizen of the United States, residing at ....., in the county of ..... and State of ..... (*or*, subject,

etc.), have invented new and useful improvements in processes of extracting gold from its ores, of which the following is a specification:

This invention relates to the process of extracting gold from its ores by means of a solution of cyanide of an alkali or alkaline earth, and has for its object to render the process more expeditious and considerably cheaper.

In extracting gold from its ores by means of a solution of cyanide of potassium, sodium, barium, etc., the simultaneous oxidation of the gold is necessary, and this has hitherto been effected by the action of the air upon the gold which is rendered oxidizable thereby by the action of the cyanide solution.

Instead of depending solely upon the agency of the air for the oxidizing action I employ, to assist the oxidation of the gold, ferricyanide of potassium or another ferricyanogen salt of an alkali or of an earth alkali in an alkaline solution. By this means the oxidation, being rendered very much more energetic, is effected with a considerably smaller quantity of the solvent. Thus, by the addition of ferricyanide of potassium or other ferricyanides to the cyanide of potassium solution, as much as eighty percent of potassium cyanide may be saved.

It may be remarked that the ferricyanide of potassium alone will not dissolve the gold and does not therefore come under the category of a solvent hitherto employed in processes of extraction. It does not therefore render unnecessary the employment of the simple cyanide as a solvent, but only reduces the amount required owing to the capacity of the ferricyanide to assist the air to rapidly oxidize the gold in the presence of the simple salt. Consequently the

cyanogen of the latter is not used to form the gold cyanide compound.

I claim:

The process of extracting gold from its ores consisting in subjecting the ores to the dissolving action of cyanide of potassium in the presence of ferricyanide of potassium, substantially as herein described.

.....

No. 14. For a Machine.

To all whom it may concern:

Be it known that I, ..., a citizen of the United States, residing at ...., in the county of .... and State of ..... (*or*, subject, etc.), have invented a new and useful meat-chopping machine, of which the following is a specification:

My invention relates to improvements in meat-chopping machines in which vertically reciprocating knives operate in conjunction with a rotating chopping block; and the objects of my improvements are, first, to provide a continuously lubricated bearing for the block; second, to afford facilities for the proper adjustment of the knives independently of each other in respect to the face of the block; and, third, to reduce the friction of the reciprocating rod which carries the knives.

I attain these objects by the mechanism illustrated in the accompanying drawing, in which—

Figure 1 is a vertical section of the entire machine; Fig. 2, a plan view of the machine as it appears after the removal of the chopping block and knives; Fig. 3, a vertical section of a part of the machine on the line

3 3, Fig. 2; and Fig. 4, a detailed view in perspective of the reciprocating crosshead and its knives.

Similar numerals refer to similar parts throughout the several views.

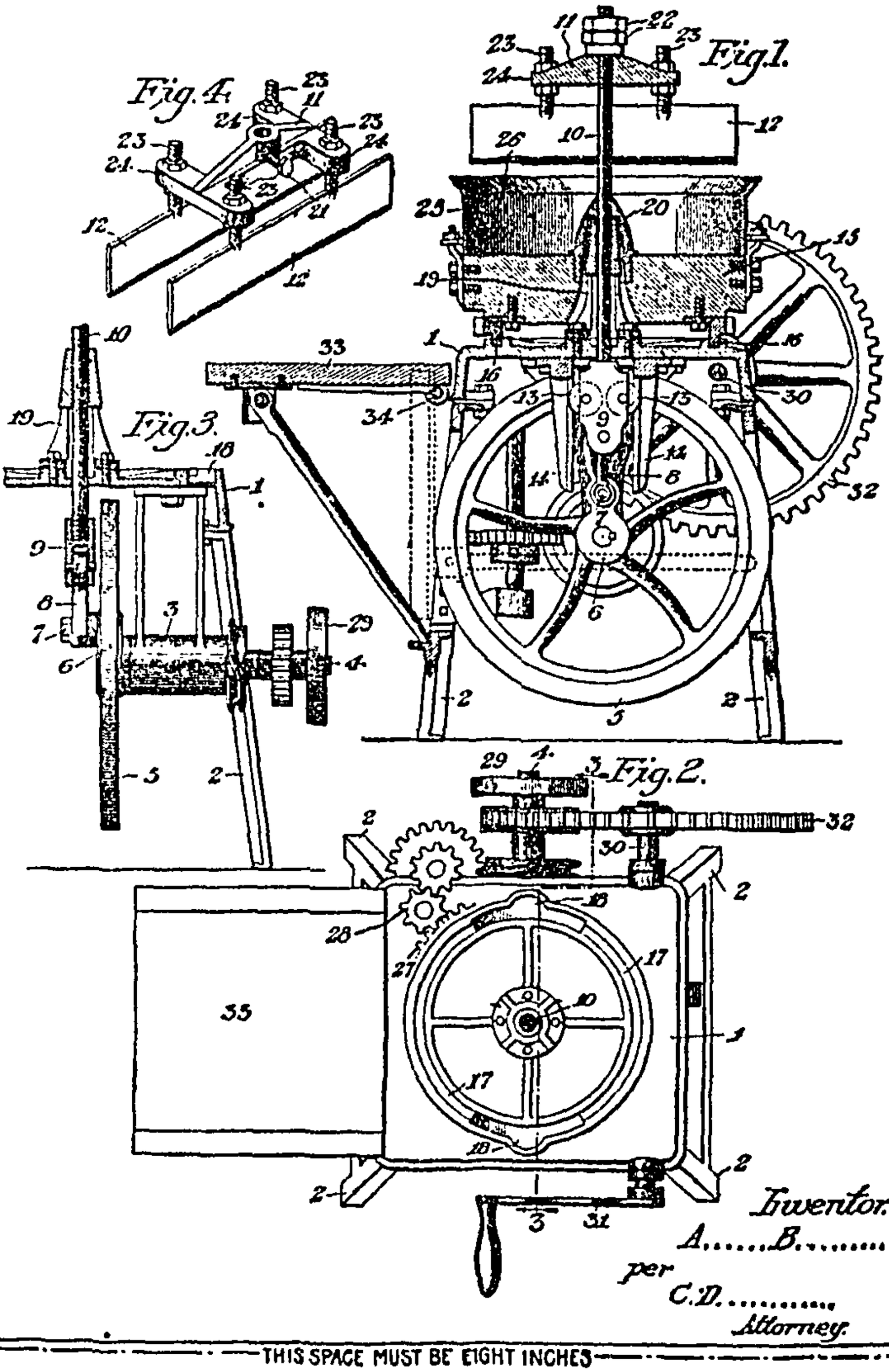
The table or plate 1, its legs or standards 2 2, and the hanger 3, secured to the underside of the table, constitute the framework of the machine. In the hanger 3 turns the shaft 4, carrying a fly-wheel 5, to the hub of which it attached a crank 6, and a crank-pin 7, connected by a link 8, to a pin passing through a crosshead 9, and to the latter is secured a rod 10, having at its upper end a crosshead 11, carrying the adjustable chopping knives, 12 12, referred to hereinafter.

The crosshead 9, reciprocated by the shaft 4, is provided with anti-friction rollers 13 13, adapted to guides 14 14, secured to the underside of the table 1, so that the reciprocation of this crosshead may be accompanied with as little friction as possible.

To the underside of a wooden chopping block 15 is secured an annular rib 16, adapted to and bearing in an annular groove 17 in the table 1. (*See Figs.* 1 *and* 2.) This annular groove or channel is not of the same depth throughout, but communicates at one or more points (two in the present instance) with pockets or receptacles 18, 18 wider than the groove and containing supplies of oil, in contact with which the rib 16 rotates, so that the continuous lubrication of the groove and rib is assured. The rod 10 passes through and is guided by a central stand 19, secured to the table 1, and projecting through a central opening in the chopping block without being in contact therewith, the upper portion of the said stand being contained within a cover 20, which is secured to the block, and which prevents particles of meat from escaping through the central opening of the same.

THE SIZE OF THE SHEET MUST BE EXACTLY
10 x 15 INCHES. SEE RULE 52, (b).

THIS SPACE MUST BE THIRTEEN INCHES



THIS SPACE MUST BE EIGHT INCHES

The crosshead 11, previously referred to, and shown in perspective in Fig. 4, is vertically adjustable on the rod 10, and can be retained after adjustment by a set-screw 21, the upper end of the rod being threaded for the reception of nuts 22, which resist the shocks imparted to the crosshead when the knives are brought into violent contact with the meat or the chopping-block.

The knives 12, 12 are adjustable independently of each other and of the said crosshead, so that the coincidence of the cutting-edge of each knife with the face of the chopping-block may always be assured.

I prefer to carry out this feature of my invention in the manner shown in Fig. 4, where it will be seen that two screw-rods 23, 23 rise vertically from the back of each knife and pass through lugs 24, 24 on the cross-head, each rod being furnished with two nuts, one above and the other below the lug through which it passes. The most accurate adjustment of the knives can be effected by the manipulation of these nuts.

A circular casing 25 is secured to the chopping-block, so as to form on the same a trough 26 for keeping the meat within proper bounds; and on the edge of the annular rib 16, secured to the bottom of the block, are teeth 27, for receiving those of a pinion 28, which may be driven by the shaft 4 through the medium of any suitable system of gearing, that shown in the drawing forming no part of my present invention.

This shaft 3 may be driven by a belt passing round the pulleys 29, or it may be driven by hand from a shaft 30, furnished at one end with a handle 31, and at the other with a cog-wheel 32, gearing into a pinion on the said shaft 4.

A platform 33 may be hinged, as at 34, to one edge of the table 1, to support a vessel in which the chopped meat can be deposited. The means by which it may be supported are shown in full lines, and the most convenient method of disposing of it when not in use is shown in dotted lines, in Fig. 1.

I am aware that prior to my invention meat-chopping machines have been made with vertically-reciprocating knives operating in conjunction with rotating chopping-blocks. I therefore do not claim such a combination broadly; but

I claim:

1. The combination, in a meat-chopping machine, of a rotary chopping-block having an annular rib, with a table having an annular recess to receive said rib, and a pocket communicating with the said recess, all substantially as set forth.

2. In a meat-chopping machine, the combination of a rotary chopping-block with a reciprocating cross-head carrying knives, each of which is vertically adjustable on the said cross-head independently of the other, substantially as described.

3. A chopping knife having two screw rods projecting perpendicularly from its back and parallel with the sides of the knife.

4. A meat-chopping machine provided with a rod carrying chopping knives and adapted to be reciprocated, a cross-head secured to said rod, anti-friction rollers mounted on the cross-head, and guides with which the rollers cooperate, substantially as described.

. . . . . .

This seems to have had its origin in U. S. letters patent No. 157,213, granted to August Nittinger, Jr., Nov. 24, 1874. The drawing has also been adopted by the Canadian Patent Office. The attorneys of record were unable to give the name of the draftsman.

Name of the Draftsman Sought.

We can not tell you at this date the name of the draftsman who made the original drawing, which is now used by the United States and the Canadian Patent Offices. We had several draftsmen at that time who were capable of making the drawings.

Regretting that we can not give you this information, we are,

Yours very truly,
Howson & Howson,
Solicitors of Patents, Philadelphia.

Specification forming part of Letters Patent No. 157,213, dated November 24, 1874; application filed January 21, 1874.

To all whom it may concern:

Be is known that I, August Nittinger, Jr., of Philadelphia, Pa., have invented an Improved Meat-Chopping Machine, of which the following is a specification:

My invention relates to meat-chopping machines in which vertically-reciprocating knives operate in conjunction with a rotating chopping-block; and the objects of my invention are, first, to diminish friction in driving the reciprocating rod which carries the knives; and, second, to provide a continuously-lubricated bearing for the rotating chopping-block, which objects I attain by the mechanism illustrated in the section, Figure 1, plan view, Fig. 2, and perspective view, Fig. 3, of the accompanying drawing.

The frame-work of the machine consists of a table, A, supported on suitable legs or standards, B, and in suitable bearings in the frame turns the driving-shaft D, carrying a fly-wheel, E, a crank-pin on the hub of

which is connected by a link, *a*, to the cross-head G, to which is secured a rod, H, having at its upper end a cross-head, I, carrying the adjustable chopping-knives C, referred to hereafter.

The cross-head G has anti-friction rollers, *e'*, adapted to guides M, secured to the under side of the table A, so that the reciprocation of the cross-head G, consequent upon the rotation of the driving-shaft, may be accompanied with as little friction as possible.

J is the chopping-block, to the under side of which is secured the annular rib *d*, adapted to an annular groove, *e*, in the table A. (See Fig. 2.)

This groove or annular channel is not of the same depth throughout, but communicates at one or more points (two, in the present instance) with deeper pockets, *f*, containing supplies of oil, so that as the annular rib rotates in the groove it will continuously convey from the pockets sufficient oil to insure proper lubrication.

The rod H passes through and is guided by a central stand, K, secured to the table A, the upper portion of this stand, which projects above the chopping-block, being contained within a cover, L, secured to the said block, so as to prevent the escape of particles of meat through the center of the block and the access of such meat to the standard K.

The cross-head I, best observed in the perspective view, Fig. 3, is vertically adjustable on the rod H, and can be secured after the adjustment by a set-screw, X, and from each side of the cross-head project two lugs, *h h*, each pair of lugs carrying a knife, *b*, and each knife having two screw-rods, *i*, passing through the said lugs, and furnished above and below with nuts, so that the knives can be readily adjusted

in the cross-head, while the latter with its knives can be easily adjusted on the rod H.

This plan of adjusting the knives, both in respect to each other and to the surface of the chopping-block, is an important feature of my invention, as one by which the best cutting effect of the knives can always be attained.

A trough, P, for keeping the meat within proper limits on the chopping-block, is secured to the latter, and on the edge of the annular rib *d*, on the under side of the chopping-block, are teeth for receiving those of a pinion, *m*, which may be driven from the shaft D through the medium of any suitable system of gearing, that shown in the drawing forming no part of my present invention.

Aplatform, Q, is hinged, at *h*, to one edge of the table A, and to the under side of this platform, near the outer edge of the same, is hinged the upper end of a diagonal rod, R, the lower end of which rests upon a ledge, *w*, on one of the stands B of the frame. This platform serves to support a vessel, into which the chopped meat can be deposited; but when the platform is not required for this purpose, and when the machine has to be moved about from place to place, the rod R may be detached from its ledge, the platform lowered, and both platform and rod arranged in the position shown by dotted lines in Fig. 1.

I claim as my invention—

1. The combination, in a meat-chopper, of the rod H, carrying the knives, the block G, secured to the lower end of the rod, and provided with rollers *e' e'*, the guides M M, and crank-shaft connected by the arm *a* to the block G, all as set forth.

2. The combination of the rotating block J, its annular rib *d*, the groove *e*, for receiving said rib, and pockets *f f*, communicating with said groove, all as specified.

In testimony whereof, I have signed my name to this specification in the presence of two subscribing witnesses.

AUGUST NITTINGER, JR.

Witnesses:
WM. A. STEEL,
HARRY SMITH.

No. 15. For a Composition of Matter.

To all whom it may concern:

Be it known that I, ..., a
(Full name of applicant.)
citizen of ....., residing at ....
....., in the county of .....
..... and State of .....
(*or*, subject of, etc.), have invented a new and useful Non-Conducting Plastic Composition, of which the following is a specification:

The object of my invention is the production of a plastic nonconducting composition or cement to be applied to the surfaces of steam-boilers and steam-pipes and other receptacles and conduits as a lagging for preventing radiation of heat and the permeation of water, and rendering them fireproof.

My composition consists of a mixture of paper-pulp or other vegetable fibrous material, a powdered mineral filler, such as soapstone or Portland cement, a mineral fibrous material, such as asbestos, and a mineral cementing material, such as silicate of sodium or potassium (soluble glass).

In preparing the composition I prefer to use the ingredients in about the following proportions, viz., fifty pounds of paper-pulp, fifty pounds of soapstone, twenty-five pounds of asbestos, and three quarts of a 33° Baumé solution of soluble glass. Good results may be obtained, however, when the ingredients are varied within the following limits: vegetable fibrous material, forty to sixty pounds; powdered mineral filler, forty-five to fifty-five pounds; mineral fibrous material, twenty to thirty pounds; soluble glass, two to four quarts of a 30° Baumé to 35° Baumé solution.

The asbestos may in some cases be omitted when a cheaper product is desired, though the composition is not then so efficient for the lagging of surfaces subjected to high temperatures.

These ingredients are mixed with a quantity of water sufficient to form a paste or mortar of such consistency as to enable it to be plastered over the surface to be protected. It may be applied in one or more coats or layers, in the ordinary manner, according to the nature of the article and the amount of protection required.

My composition is light, is fireproof, is a very efficient nonconductor of heat, is impervious to water, adheres without cracking when it dries to the surface to which it is applied, and, as a whole, possesses in a high degree all the desired properties of a lagging for steam-heated surfaces.

I claim:

1. A plastic composition adapted to form a lightweight, fireproof and waterproof lagging for steam-heated surfaces, comprising a vegetable fibrous material, a mineral filler in powdered form and a mineral cementing substance.

2. A plastic composition adapted to form a lagging for steam pipes and the like comprising forty to sixty pounds of paper-pulp, forty-five to fifty-five pounds of powdered soapstone, and two to four quarts of a 30° Baumé to 35° Baumé solution of soluble glass.

3. A plastic composition consisting of a vegetable fibrous material, a powdered mineral filler, a mineral fibrous material and a mineral cementing substance substantially as described.

4. A plastic composition consisting of fifty pounds of paper pulp, fifty pounds of powdered soapstone, twenty-five pounds of asbestos fiber and three quarts of a 33° Baumé solution of soluble glass.

No. 16. For a Design.

To all whom it may concern:

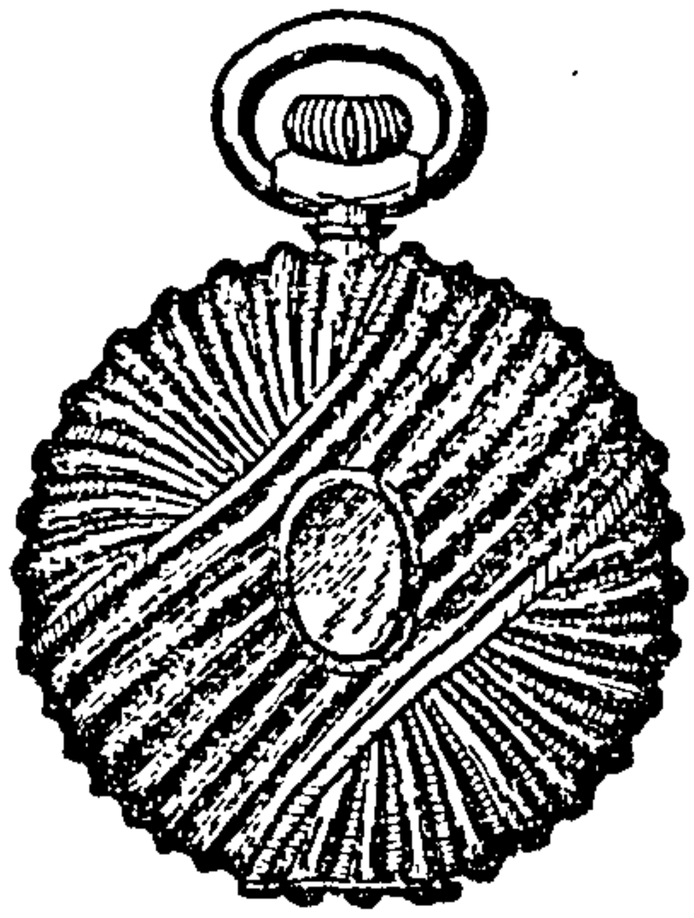
Be it known that I, ..., a citizen of the United States, residing at ...., in the county of ..... and State of ..... (*or*, subject, etc.), have invented a new, original, and ornamental Design for Watch-Cases, of which the following is a specification, reference being had to the accompanying drawing, forming part thereof.

The figure is a plan view of a watch case, showing my new design.

I claim:

The ornamental design for a watch case, as shown.

The size of the sheet must be exactly 10x15 inches. See rule 52(b).



This space must be thirteen inches.

Inventor:
T..... B.....
per
G..... C.....
Attorney.

This space must be eight inches.

Design: This descriptive language illustrates, in connection with the drawing of this case, the utter futility of attempting by words to describe the appearance of an object which may be perceived immediately upon inspection of a picture thereof. In designs the appearance is the new thing which is to be secured by a patent. Words do not explain, but rather confuse, when added to the disclosure of the drawing. For this reason such descriptive material should be reduced to a minimum, or, better still, entirely eliminated from design patent specifications.

Freeman, 104 O. G. 1396.

(It is believed the above dicta is more general in its language than is now warranted by the decisions.)—Ed.

"*In the testimony whereof,*" *immediately preceding the signature,* is surplusage.

Pappenhagen, 79 Ms. D. 157.

No. 17. For a Caveat.

(This form is obsolete; law relating to caveats repealed by act of July 1, 1910.)

OATHS.

No. 18. Oath to Accompany an Application for United States Patent.

.....
} *ss:*
.....

....., [1] the above-named petitioner....., being sworn (*or*, affirmed), depose..... and says..... that ..... citizen..... of[2] ..... and resident..... of[3] ....., that .... verily believe ..... to be the original, first, and[4] ..... inventor..... of the improvement in[5] .... described and claimed in the annexed specification; that ..... do..... ..... not know and do .....

not believe that the same was ever known or used before ..... invention or discovery thereof, or patented or described in any printed publication in any country before .... invention or discovery thereof, or more than two years prior to this application, or in public use or on sale in the United States for more than two years prior to this application; that said invention has not been patented in any country foreign to the United States on an appilcation filed by ..... or ..... legal representatives or assigns more than twelve months prior to this application; and that no application for patent on said improvement has been filed by ..... or ..... representatives or assigns in any country foreign to the United States, except as follows:[6] ....

Inventor's full name:[7] .....
.....

Sworn to and subscribed before me this ..... day of ....., 19....

[SEAL.]

.....,
[*Signature of justice or notary.*]

[8] .....,
[*Official character.*]

1. If the inventor be dead, the oath will be made by the administrator; if insane, by the guardian, conservator, or legal representative. In either case the affiant will declare his belief that the party named as inventor was the original and first inventor.

2. If the applicant be an alien, state of what foreign country he is a citizen or subject.

3. Give residence address in full; as "a resident of..... in the county of ....., and State of ....." or "of No.

..... street, in the city of ....., county of ....., and State (Kingdom, Republic, or Empire) of ....."

4. "Sole" or "joint." (174 O. G. 280.)

5. Insert title of invention.

6. Name each country in which an application has been filed, and in each case give date of filing the same. If no application has been filed, erase the words "except as follows."

7. All oaths must bear the signature of the affiant.

8. . . . "When the person before whom the oath or affirmation is made is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal."

A certificate of the official character of a magistrate, stating date of appointment and term of office, may be filed in the Patent Office, which will obviate the necessity of separate certificates in individual cases.

When the oath is taken abroad before a notary public, judge, or magistrate, his authority should in each instance be proved by a certificate of a diplomatic or consular officer of the United States.

No. 19. Oath to Accompany an Application for United States Patent for Design.

.....}
.....} *ss:*

.....,[1] the above-named petitioner....., being sworn (*or*, affirmed), depose..... and say..... that ....., citizen..... of[2] ..... and resident..... of[3] ....., that .... verily believe .... to be the original, first, and[4] .... inventor of the design for[5] .... described and claimed in the annexed specification; that ..... do..... not know and do..... not believe that the same was ever known or used before ..... invention thereof, of patented or described in any

printed publication in any country before .... invention thereof, or more than two years prior to this application, or in public use or on sale in the United States for more than two years prior to this application; that said design has not been patented in any country foreign to the United States on an application filed by..... or ..... legal representatives or assigns more than four months prior to this application; and that no application for patent on said design has been filed by ..... or ..... representatives or assigns in any country foreign to the United States, except as follows: [6].....

Inventor's full name: [7] {.....
.....

Sworn to and subscribed before me this .... day of ....., 19....

[SEAL.] [8].....,
[*Signature of justice or notary.*]

.....,
[*Official character.*]

1. If the inventor be dead, the oath will be made by the administrator; if insane, by the guardian, conservator, or legal representative. In either case the affiant will declare his belief that the party named as inventor was the original and first inventor

2. If the applicant be an alien, state of what foreign country he is a citizen or subject.

3. Give residence address in full; as "a resident of..... in the county of ....., and State of ....." or "of No. ..... street, in the city of ....., county of ....., and State (Kingdom, Republic, or Empire) of ....."

4. "Sole" or "joint" (124 O. G. 280).

5. Insert title of invention.

6. Name each country in which an application has been

filed, and in each case give date of filing the same. If no application has been filed, erase the words "except as follows."

7. All oaths must bear the signature of the affiant.

8. . . . "When the person before whom the oath or affirmation is made is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal."

A certificate of the official character of a magistrate, stating date of appointment and term of office, may be filed in the Patent Office, which will obviate the necessity of separate certificates in individual cases.

When the oath is taken abroad before a notary public, judge, or magistrate, his authority should in each instance be proved by a certificate of a diplomatic or consular officer of the United States.

A case on the subject-matter of this form.

Arms, 127 O. G. 3644.

No. 20. By an Applicant for a Reissue (Inventor).

[When the original patent is claimed to be inoperative or invalid "by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new," this form can be modified accordingly.]

.....
} *ss:*
.....

....., the above-named petitioner, being duly sworn (*or*, affirmed), deposes and says that he does verily believe himself to be the original, first, and [1]..... inventor of the improvement set forth and claimed in the foregoing specification and for which improvement he solicits a patent; that deponent does not know and does not believe that said improvement was ever before known or used; that deponent is a citizen of the United States of America, and resides at .....
....., in the county of .....
..... and State of .....;[2] that

deponent verily believes that the letters patent referred to in the foregoing petition and specification and herewith surrendered are inoperative (*or*, invalid), for the reason that the specification thereof is defective (*or*, insufficient), and that such defect (*or*, insufficiency) consists particularly in[3] .... ; and deponent further says that the errors which render such patent so inoperative (*or*, invalid) arose from inadvertence (*or*, accident, or mistake), and without any fraudulent or deceptive intention on the part of deponent;[4] that the following is a true specification of the errors which it is claimed constitute such inadvertence (*or*, accident, or mistake) relied upon:[3] ..... ; that such errors so particularly specified arose (*or*, occurred) as follows:[3] .....

Inventor's full name: .....
.....

Subscribed and sworn to before me this .....
..... day of ....., 19....

[SEAL.] .....,
[*Signature of justice or notary.*]

.....,
[*Official character.*]

1. "Sole" or "joint."
2. Rule 46.
3. Rule 87.
4. Rule 87 (5).

No. 21. By an Applicant for a Reissue (Assignee).

[To be used only when the inventor is dead.]

.....
.....
} *ss:*

....., the above-named petitioner, being duly sworn (*or*, affirmed), deposes and

says that he verily believes that the aforesaid letters patent granted to ..... are (*here follows Form* 20, *the necessary changes being made*); that the entire title to said letters patent is vested in him; and that he verily believes the said .... to be the first and original inventor of the invention set forth and claimed in the foregoing amended specification; and that the said .... is now deceased.

.....

Sworn to and subscribed before me this .... day of ....., 19....

[SEAL.] .....,

[*Signature of justice or notary.*]

.....,

[*Official character.*]

No. 22. Supplemental Oath to Accompany a Claim for Matter Disclosed but not Claimed in an Original Application.

.....
} *ss:*
.....

....., whose application for letters patent for an improvement in ...., serial No. ....., was filed in the United States Patent Office on or about the ..... day of ...., 19....., being duly sworn (*or*, affirmed), deposes and says that the subject matter of the foregoing amendment was part of his invention, was invented before he filed his original application, above identified, for such invention, was not known or used before his invention, was not patented or described in a printed publication in any country more than two

years before his application, was not patented in a foreign country or an application filed by his legal representatives or assigns more than twelve months before his application, was not in public use or on sale in this country for more than two years before the date of his application, and has not been abandoned.

.....

Sworn to and subscribed before me this .....
..... day of ....., 19....

[SEAL.]

.....,
[*Signature of justice or notary.*]

.....,
[*Official character.*]

No. 23. Oath as to the Loss of Letters Patent.

.....
} *ss:*
.....

....., being duly sworn (*or*, affirmed), depose..... and say..... that the letters patent No. ....., granted to him, and bearing date on the .....
..... day of ....., 19.....; have been either lost or destroyed; that he has made diligent search for the said letters patent in all places where the same would probably be found, if existing, and that he has not been able to find them.

.....

Subscribed and sworn to before me this .....
day of ....., 19....

[SEAL.]

.....,
[*Signature of justice or notary.*]

.....,
[*Official character.*]

No. 24. Oath of Administrator as to the Loss of Letters Patent.

....., } *ss:*
....., }

....., being duly sworn, depose..... and say..... that he is administrator of the estate of ....., deceased, late of ....., in said county; that the letters patent No. ....., granted to said ....., and bearing date of the ..... day of ...., 19, ..., have been lost or destroyed, as he verily believes; that he has made diligent search for the said letters patent in all places where the same would probably be found, if existing, and especially among the papers of the decedent, and that he has not been able to find said letters patent.

.....,
Administrator, etc.

Subscribed and sworn to before me this .... day of ....., 19....

[SEAL.]

....., [*Signature of justice or notary.*]

....., [*Official character.*]

No. 25. Power of Attorney After Application Filed.

[If the power of attorney be given at any time other than that of making application for letters patent, it will be in substantially the following form:]

To the Commissioner of Patents:

The undersigned having, on or about the .... day of ....., 19....., made application for letters patent for

an improvement in ..... (*serial number* .....), hereby appoints .....,[1] of ..... in the county of ..... and State of ....., his attorney, with full power of substitution and revocation, to prosecute said application, to make alterations and amendments therein, to receive the patent, and to transact all business in the Patent Office connected therewith.

Signed at ....., in the county of ....., State of ...., this ..... day of ....., 19.....

.....

1. If the power of attorney be to a firm, the name of each member of the firm must be given in full.

No. 26. Revocation of Power of Attorney.

To the Commissioner of Patents:

The undersigned having, on or about the .... day of ....., 19....., appointed ....., of ....., in the county of ....., and State of ....., his attorney to prosecute an application for letters patent, which application was filed on or about the ..... day of ...., 19....., for an improvement in .... (*serial number* .....), hereby revokes the power of attorney then given.

Signed at ....., in the county of . ..... and State of ...., this ..... day of ....., 19.....

.....

No. 27. Amendment.[1]

To the Commissioner of Patents:

In the matter of my application for letters patents for an improvement in ....., filed ....., 19..... (serial number .....), I hereby amend my specification as follows:

By striking out all between the .... and ..... lines, inclusive, of page .....;

By inserting the words "....." after the word "....." in the ..... line of the ..... claim; and

By striking out the ..... claim and substituting therefore the following:

.....

Signed at ....., in the county of ..... and State of ....

.....,
By .....,
His Attorney in Fact.

1. In the preparation of all amendments a separate paragraph should be devoted to each distinct erasure or insertion, in order to aid the Office in making the entry of the amendment into the case to which it pertains.

DISCLAIMERS.

No. 28. Disclaimer After Patent.

To the Commissioner of Patents:

Your petitioner, ..., a citizen of the United States, residing at ...., in the county of .....

and State of ..... (*or*, subject, etc.), represents that in the matter of a certain improvement in ....., for which letters patent of the United States No. .... were granted to ....., on the ..... day of ....., 19....., he is (*here state the exact interest of the disclaimant; if assignee, set out liber and page where assignment is recorded*), and that he has reason to believe that through inadvertence (accident *or* mistake) the specification and claim of said letters patent are too broad, including that of which said patentee was not the first inventor. Your petitioner, therefore, hereby enters this disclaimer to that part of the claim in said specification which is in the following words, to wit:

.....

Signed at ....., in the county of ..... and State of ...., this ..... day of ....., 19.....

.....

Witness:

.....

.....

No. 29. Disclaimer During Interference.

Interference.

.....
v. } Before the examiner of interferences.
.....

Subject matter: .....

To the Commissioner of Patents:

SIR: In the matter of the interference above noted, under the provisions of and for the purpose set forth

in Rule 107, I disclaim (*set forth the matter as given in declaration of interference*), as I am not the first inventor thereof.

Signed at ....., in the county of ..... and State of ...., this ..... day of ....., 19.....

.....

Witness:

.....

.....

APPEALS AND PETITIONS.

No. 30. From a Principal Examiner to the Examiners in Chief.

To the Commissioner of Patents:

SIR: I hereby appeal to the examiners in chief from the decision of the principal examiner in the matter of my application for letters patent for an improvement in ....., filed ...., 19....., serial number ...., which on the ...., 19....., was rejected the second time. The following are the points of the decision on which the appeal is taken: (*Here follows a statement of the points on which the appeal is taken.*)

Signed at ....., in the county of ..... and State of ...., this ..... day of ....., 19.....

.....

No. 31. From the Examiner in Charge of Interferences to the Examiners in Chief.

To the Commissioner of Patents:

SIR: I hereby appeal to the examiners in chief from the decision of the examiner of interferences in the matter of the interference between my applications for letters patent for improvement in .... and the letters patent of ...., in which priority of invention was awarded to said ..... The following are assigned as reasons of appeal: (*Here should follow an explicit statement of alleged errors in the decision of the examiner of interferences.*)

Signed at ....., in the county of ..... and State of ...., this ..... day of ....., 19.....

.....

No. 32. From the Examiners-in-Chief to the Commissioner in Ex Parte Cases.

To the Commissioner of Patents:

SIR: I hereby appeal to the Commissioner in person from the decision of the examiners-in-chief in the matter of my application for letters patent for an improvement in ....., filed ...., 19....., serial number .... The following are assigned as reasons of appeal: (*Here follow the reason as in Form* 30.)

Signed at ....., in the county of ..... and State of ...., this ..... day of ....., 19.....

.....

No. 33. From the Examiners-in-Chief to the Commissioner in Interference Cases.

To the Commisioner of Patents:

SIR: I hereby appeal to you in person from the decision of the examiners-in-chief, made ....., 19....., in the interference between my application for letters patent for improvement in ..... and the letters patent of ....., in which priority of invention was awarded to said..... The following are assigned as reasons of appeal: *(Here should follow an explicit statement of the alleged errors in the decision of the examiners-in-chief.*

Signed at ....., in the county of ..... and State of ....., this ..... day of ....., 19.....

.....

No. 34. Petition from a Principal Examiner to the Commissioner.

Application of .....
Serial number .....
Subject of invention .....

To the Commisioner of Patents:

Your petitioner avers—

First. That he is the applicant above named.

Second. That said application was filed on the ..... day of ..... 19.....

Third. That when so filed said application contained ..... claims.

Fourth. That your petitioner was informed by office letter of the ....., 19.....

(1) that his ..... claim was rendered vague and indefinite by the employment of the words "....," which words should be erased; (2) that his ..... claim was met by certain references which were given; and (3) that the ..... claim was mere surplusage and should be eliminated.

Fifth. That on the ..... day of ..... your petitioner filed an amendment so eliminating his ..... claim, and accompanied such amendment with a communication in which he declined to amend such .... claim, and asked for another action thereon.

Sixth. That your petitioner was then informed by office letter of the ..... day of ..... that the former requirement relating to claim ..... would be adhered to, and that no action would be had on the merits of either claim until said amendment so required had been made.

Wherefore your petitioner requests that the examiner in charge of such application be advised that such amendment so required by him to said .... claim be not insisted upon and directed to proceed to examine both said remaining claims upon their merits.

A hearing of this petition is desired on the .... day of ....., 19.....

.....,
Applicant.

.....,
Attorney for Applicant.

No. 35. Petition for Copies of Rejected and Abandoned Applications.

To the Commisioner of Patents:

The petition of ....., a resident of ....., in the county of ..... and State of ...., respectfully shows:

First. That on the ..... day of ....., 19....., patent No. ..... issued to one ....

Second. That your petitioner is informed and believes that on the ..... day of ....., 19....., said patentee filed in the United States Patent Office an application for patent for improvement in ....

Third. That your petitioner verily believes that said application has not been prosecuted during the past two years and upward; and he also verily believes that the last action had therein was on or about the ..... day of ...., 19....

Fourth. That said application has therefore become and now stands abandoned.

Fifth. That on the ..... day of ....., 19....., said patentee began suit, in the circuit court of the United States for the ..... district of ....., against your petitioner, which suit is based upon said patent, and the same is now pending and undetermined.

Sixth. Your petitioner is informed and believes that to enable him to prepare and conduct his defense

in such suit it is material and necessary that he be allowed access to and copies of the files of such abandoned case.

Seventh. Your petitioner therefore requests that he or ....., in his behalf and as his attorney, be permitted to inspect and be furnished copies of all or any portion of such case.

.....,
Petitioner.

By .....,
His Attorney.

.....
} *ss:*
.....

On this ..... day of ...., 19....., before me, a notary public in and for said county and State, personally appeared ....., the above-named attorney, who, being by me duly sworn, deposes and says that he has read the foregoing petition and knows its contents, and that the same is true, except as to the matters therein stated on information or belief, and as to those matters he believes it to be true.

.....,
Notary Public.

NOTE—A copy of this petition must be served upon the applicant named in the abandoned application or upon his attorney of record.

A case on the subject-matter of this form.
Marsh Engineering Co., 193 O. G. 510.

No. 36. Preliminary Statement of Domestic Inventor.

.....
v.
.....
} Interference in the United States Patent Office. Preliminary statement of .....
....., of .....,

in the county of ....., and state of ....., being duly sworn (*or*, affirmed), doth depose and say that he is a party to the interference declared by the Commissioner of Patents ....., 19....., between .....'s application for letters patent, filed ....., 19....., serial number ....., and the patent to ....., granted ...., 19....., numbered ...., for a .....; that he conceived the invention set forth in the declaration of interference' on or about the .... day of ....., 19.....; that on or about the ..... day of ....., 19....., he first made drawings of the invention (*if he has not made a drawing, then he should say that* no drawing of the invention in issue has been made); that on the .... day of ....., 19....., he made the first written description of the invention (*if he has not made a written description of the invention, he should so state*); that on or about the ..... day of ...., 19....., he first explained the invention to others; that he first embodied his invention in a full-size machine, which was completed about the ..... day of ...., 19....., and that on the .... day of ....., 19....., the said machine was first successfully operated, in the town of ....., county of ...., and State of ...., and that he has since continued to use

the same, and that he has manufactured others for use and sale to the following extent, viz.: (*if he has not embodied the invention in a full-size machine, he should so state; and if he has embodied it but has not used it, he should so state*).

....., [*Signature of inventor.*]

Subscribed and sworn to before me this ..... day of ....., 19.....

....., [*Signature of justice or notary.*]

....., [*Official character.*]

1. If the party has doubts as to whether the matter of his application is properly involved in the issue as declared, then in lieu of the term "the invention set forth in the declaration of interference" he may say "the invention contained in the claims of my application (or patent) declared to be involved in this interference," and should specify such claims by number.

No. 37. Preliminary Statement of Foreign Inventor.

.....
v.
..... } Interference in United States Patent Office. Preliminary statement of .....

....., of London, in the county of Middlesex, England, being duly sworn, doth depose and say that he is a party to the interference declared by the Commissioner of Patents, ..., 19....., between his application for patent, filed ....., 19....., serial number ....., and the patent of ....., granted ....., 19....., No. ....., for an improvement in .....; that he made the invention set forth in the declaration

of interference,[1] being at that time in England; that patents for such invention were applied for and obtained as follows:

Application filed in Great Britain, ...
....., 19....., patent dated .....
....., 19....., No. .....;
published the ..... day of .....
....., 19....., and sealed the ....
..... day of .....,
19.....; application filed in France .....
....., 19....., patent dated .....
....., 19....., No. .....;
published the ..... day of .....
....., 19....., and sealed the ....
..... day of .....,
19..... (*If a patent has not been obtained in any country it should be so stated.*)

That such invention was fully described in a magazine published at ....., on the
..... day of .....
.... ., 19....., by ....., entitled ..... (*see page .....
..... of such magazine*), and in the following newspapers: .....', of .....
....., 19,.....; .....
....., published at ....., on
....., 19..... (*If the invention was never described in a printed publication it should be so stated.*)

The knowledge of such invention was introduced into the United States under the following circumstances: On ....., 19.....,
the said ..... wrote a letter to
....., residing at .....

....., State of ....., describing such invention and soliciting his services in procuring a patent therefor in the United States. This letter, he is informed and believes, was received by the said ..... on ...., 19..... Also on ...., 19....., he wrote a letter to the firm of ....., of ....., State of ....., describing such invention and requesting their assistance in manufacturing and putting it on the market, which letter, he is informed and believes, was received by them on ....., 19..... Such invention was manufactured by such firm and described in their trade circulars, as he is informed and verily believes, on or about the ..... day of ....., 19..... (*If the invention has not been introduced into the United States otherwise than by the application papers, it should be so stated, and the date at which such papers were received in the United States alleged.*)

.....,

[*Signature of inventor.*]

Subscribed and sworn to before me this .... day of ....., 19....

.....,

[*Signature of justice or notary.*]

.....,

[*Official character.*]

1. If the party has doubts as to whether the matter of his application is properly involved in the issue as declared, then in lieu of the terms "the invention set forth in the declaration of interference," he may say, "the invention contained in the claims of my application (*or* patent) declared to be involved in this interference," and should specify such claims by number.

ASSIGNMENTS.

No. 38. Of an Entire Interest in an Invention Before the Issue of Letters Patent.

Whereas I, ..., of ...., county of ..... and State of ....., have invented a certain improvement in ....., for which I am about to make application for letters patent of the United States; and whereas ...., of ....., county of ....., and State of ...., is desirous of acquiring an interest therein:

Now, therefore, in consideration of .... dollars, the receipt of which is hereby acknowledged, I, ..., by these presents do sell, assign, and transfer unto .... the full and exclusive right to the said invention, as described in the specification executed by me on the ..... day of ...., 19....., preparatory to obtaining letters patent of the United States therefor; and I hereby request the Commissioner of Patents to issue said letters patent to ..... as the assignee, for his interest, for the sole use and behoof of said ..... and his legal representatives.

Executed ..... day of ...., 19.....

..... [SEAL.]

In presence of:

.....

.....

(If assignment, grant, or conveyance be acknowledged as provided for by Rule 185, the certificate will be *prima facie* evidence of the execution of such assignment, grant, or conveyance.)

No. 39. Of the Entire Interest in Letters Patent.

Whereas I, ..., of ...., county of ....., State of ....., did obtain letters patent of the United States for an improvement in ....., which letters patent are numbered ....., and bear date the ..... day of ...., 19.....; and whereas I am now the sole owner of said patent; and whereas ...., of ....., county of ....., and State of ...., is desirous of acquiring the entire interest in the same:

Now, therefore, in consideration of the sum of ..... dollars, the receipt of which is hereby acknowledged, I, ..., by these presents do sell, assign, and transfer unto the said ....., the whole right, title, and interest in and to the said letters patent therefor aforesaid; the same to be held and enjoyed by the said ....., for his own use and behoof, and for his legal representatives, to the full end of the term for which said letters patent are granted, as fully and entirely as the same would have been held by me had this assignment and sale not been made.

Executed ..... day of ...., 19.....

..... [L. S.]

In presence of:

.....

.....

(See note under Form 38.)

No. 40. Of an Undivided Interest in Letters Patent.

Whereas I, ..., of ...., county of ....., State of ....., did obtain letters patent of the United States for an improvement in ....., which letters patent are numbered ....., and bear date the ..... day of ....; and whereas ....., of ....., county of ...., State of ....., is desirous of acquiring an interest in the same:

Now, therefore, in consideration of the sum of ..... dollars, the receipt of which is hereby acknowledged, I, ..., by these presents do sell, assign, and transfer unto the said ....., the undivided one-half part of the whole right, title, and interest in and to the said invention and in and to the letters patent therefor aforesaid; the said undivided one-half part to be held by ....., for his own use and behoof, and his legal representatives, to the full end of the term for which said letters patent are granted, as fully and entirely as the same would have been held by me had this assignment and sale not been made.

Executed ..... day of ...., 19.....

..... [L. S.]

In presence of:

.....

.....

(See note under Form 38.)

No. 41. Territorial Interest After Grant of Patent.

Whereas I, ..., of ...., county of ....., State of ....., did obtain letters patent of the United States for an improvement in ....., which letters patent are numbered ....., and bear date the ..... day of ...., in the year 19.....; and whereas I am now the sole owner of the said patent and of all rights under the same in the below-recited territory; and whereas ....., of ...., county of ....., State of ....., is desirous of acquiring an interest in the same:

Now, therefore, for and in consideration of the sum of ..... dollars to me in hand paid, the receipt of which is hereby acknowledged, I, ..., by these presents do sell, assign, and transfer unto the said .... all the right, title, and interest in and to the said invention, as secured to me by said letters patent, for, to, and in the State of .....,

and for, to, or in no other place or places; the same to be held by ..... within and throughout the above-specified territory, but not elsewhere, for his own use and behoof, and of his legal representatives, to the full end of the term for which said letters patent are granted, as fully and entirely

as the same would have been held by me had this assignment and sale not been made.

Executed ..... day of ...., 19.....

..... [L. S.]

In presence of:

.....

.....

(See note under Form 38.)

No. 42. License—Shop-Right.

In consideration of the sum of .... dollars, to be paid by the firm of ...., of ....., in the county of ....., State of ...., I do hereby license and empower the said ..... to manufacture in said ..... (*or*, other place agreed upon) the improvement in ....., for which letters patent of the United States No. ..... were granted to me the ..... day of ...., in the year 19....., and to sell the machines so manufactured throughout the United States to the full end of the term for which said letters patent are granted.

Signed at ....., in the county of ..... and State of ...., this ..... day of ....., 19.....

.....,

In presence of:

.....

.....

No. 43. License—Not Exclusive—With Royalty.

This agreement, made this ..... day of ....., 19....., between ....., of ....., in the county of ..... and State of ....., party of the first part, and ....., of ....., ..., in the county of ..... and State of ....., party of the second part, witnesseth, that whereas letters patent of the United States No. ....., for improvement in ....., were granted to the party of the first part on the ..... day of ....., 19.....; and whereas the party of the second part is desirous of manufacturing ..... containing said patented improvements: Now, therefore, the parties have agreed as follows:

I. The party of the first part hereby licenses and empowers the party of the second part to manufacture, subject to the conditions hereinafter named, at their factory in ....., and in no other place or places, to the end of the term for which said letters patent were granted, ... containing the patented improvements, and to sell the same within the United States.

II. The party of the second part agrees to make full and true returns to the party of the first part, under oath, upon the first days of .... and ..... in each year, of all ..... containing the patented improvements manufactured by them.

III. The party of the second part agrees to pay to the party of the first part .....

dollars as a license fee upon every .... manufactured by said party of the second part containing the patented improvements; provided, that if the said fee be paid upon the days provided herein for semiannual returns, or within .... days thereafter, a discount of .... per cent shall be made from said fee for prompt payment.

IV Upon a failure of the party of the second part to make returns or to make payment of license fees, as herein provided, for ..... days after the days herein named, the party of the first part may terminate this license by serving a written notice upon the party of the second part; but the party of the second part shall not thereby be discharged from any liability to the party of the first part for any license fees due at the time of the service of said notice.

In witness whereof, the parties above named have hereunto set their hands the day and year first above written at ....., in the county of ..... and State of ....

.....

.....

In the presence of:

.....

.....

DEPOSITIONS.

No. 44. Notice of Taking Testimony.

....., ..., ..., 19.....

In the matter of the interference between the application of ..... for a .....

..... machine and the patent No. ....
....., granted .....
19....., to ....., now pending before the Commissioner of Patents.

SIR: You are hereby notified that on Wednesday, ..., 19....., at the office of ....., Esq., No. .... Street, ..., ..., at .....o'clock in the forenoon, I shall proceed to take the testimony of ...., and ....., all of ...., as witnesses in my behalf.

The examination will continue from day to day until completed. You are invited to attend and cross-examine.

.....,
By .....,
His Attorney.

Signed at ....., in the county of ..... and State of ...., this ..... day of ....., 19.....

.....

Witnesses:

.....
.....

Proof of service.

.....}
.....} *ss:*

Personally appeared before me, a .... (*or*, other officer) the above-named ...., who, being duly sworn, deposes and says that he served the above notice upon .....

....., the attorney of the said .....
....., at ..... o'clock
.....of the .....
day of ....., 19....., by leaving a copy at his office in .....,
in the county of ..... and State of ....., in charge of .....
.....

.....

Sworn to and subscribed before me at .....
....., in the county of .....
and State of ....., this .....
..... day of ....., 19....

[SEAL.] .....,
[*Signature of justice or notary.*]

.....,
[*Official character.*]

(*Service may be acknowledged by the party upon whom it is made as follows:*

Service of the above notice acknowledged this .....
..... of .....,
19.....

.....,
By .....,
His Attorney.

No. 45. Form of Deposition.

Before the Commissioner of Patents, in the matter of the interference between the application of .....
..... for a .....
and Letters Patent No. .....,
granted ....., 19:....., to
.....

Depositions of witnesses examined on behalf of .....
....., pursuant to the annexed no-

tice, at the office of ....., No. ..... Street, ..., ..., on ....., ..., 19..... Present, ..., Esq., on behalf of ...., and ....., Esq., on behalf of .....

....., being duly sworn (*or*, affirmed), doth depose and say, in answer to interrogatories proposed to him by ....., Esq., counsel for ....., as follows, to wit:

Question 1. What is your name, age, occupation, and residence?

Answer I. My name is .....; I am ..... years of age; I am a manufacturer of ..... and reside at ....., in the State of ....

Question 2, etc. .....

.....

And in answer to cross-interrogatories proposed to him by ....., Esq., counsel for ....., he saith:

Cross-question 1. How long have yon known ....?

Answer 1. .....

.....

No. 46. Certificate of Officer.

[To follow deposition.]

.....
} *ss:*
.....

I, ..., a notary public within and for the county of ..... and

State of ..... (*or*, other officer, *as the case may be*), do hereby certify that the foregoing deposition of ..... was taken on behalf of ..... in pursuance of the notice hereto annexed, before me, at ....., in the city of ...., in said county, on the .... day (*or*, days) of ....., 19.....; that said witness was by me duly sworn before the commencement of his testimony; that the testimony of said witness was written out by myself (*or*, by ..... in my presence); that the opposing party, ..., was present (*or*, absent or represented by counsel) during the taking of said testimony; that said testimony was taken at ....., and was commenced at ..... o'clock .... on the ..... of ....., 19....., was continued pursuant to adjournment on the ....., ... (etc.), and was concluded on the .... of said month; that the deposition was read by, or to, each witness, before the witness signed the same; that I am not connected by blood or marriage with either of said parties, nor interested directly or indirectly in the matter in controversy.

In testimony whereof, I have hereunto set my hand and affixed my seal of office at ....., in said county, this ..... day of ....., 19....

[SEAL.] .....,

[*Signature of justice or notary.*]

.....,

[*Official character.*]

(*The magistrate will then append to the deposition the notice under which it was taken, and will seal up the testimony and direct it to the Commissioner of Patents, placing upon the envelope a certificate in substance as follows:*)

I hereby certify that the within deposition of ..... (*if the package contains more than one deposition, give all the names*), relating to the matter of interference between .... and ....., was taken, sealed up, and addressed to the Commissioner of Patents by me this ..... day of ...., 19....

[SEAL.] .....,

[*Signature of justice or notary.*]

.....,

[*Official character.*]

APPEALS FROM THE COMMISSIONER OF PATENTS TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

An intention to appeal does not constitute an appeal, or even a step in that direction. If applicant had done something, though imperfectly, he might have come within the decision in Alaska Gold Mining Co. v. Keating, 116 Fed. 561. He is supposed to know the rules, and an appeal not taken within the 40 days refused reinstatement.

Hitchcock, 247 O. G. 965.

See Rule 148.

COURT RULES.

No. 8. Argument of Causes and the Preparation Therefor.

1. No more than two counsels shall be heard for each party, appellant and appellee, in the argument of the cause, except by special leave of the Court, upon sufficient reason shown.

2. Only one hour on each side shall be allowed in the argument, unless by special leave the time is extended by the Court before the argument is commenced; but counsel, in order to avail themselves of the opportunity to apply for additional time, must make request therefor to the Court, accompanied by a copy of their printed brief, at least five days before the case is liable to be called for argument. The time may be apportioned between counsel on the same side, at their discretion. In all cases, however, a full and fair opening must be made.

3. For the appellant, there shall be filed with the clerk of the court fifteen copies of his printed brief within thirty days after the record shall have been printed. *Provided, however,* That if such period of thirty days expires in vacation, and prior to September 10th, appellant shall have until said date to file his brief. One copy of appellant's brief shall, upon application, be furnished to each of the counsel on the opposite side; *and provided further,* That at the time of filing his brief the appellant shall serve a copy of the same upon the appellee or his counsel of record in the trial court. The brief for the appellant shall contain, in the order here stated:

(a) A concise statement of the case, presenting succinctly the questions involved and the manner in which they are raised.

(b) Such of the errors as shall be relied upon.

(c) A clear statement of the points of law or fact to be discussed, with reference to the pages of the record and the authorities relied on in support of each point.

(d) Whenever a decision of this Court, that has been published in the official reports of the Court,

shall be cited in a brief, the reference shall include the volume and page of the report wherein the same has been published.

(e) Every brief of more than twenty pages shall contain on its front fly leaves a subject index, with page reference, the subject index to be supplemented by a list of all cases referred to, together with references to pages where the cases are cited.

Senior v. Senior, 24 App. D. C. 160; Cooper v. Sellers, 30 Il. 567.

4. For the appellee, there shall be filed with the clerk fifteen copies of the brief for his side of the case within twenty days from the filing of appellant's brief: *Provided,* That if said period of twenty days expires in vacation, he shall have until the first day of the October Term to file his brief; *and it is further provided,* That if such period of twenty days expires in vacation in cases appealed from the Commission of Patents, he shall have until the first Monday in November. Such brief shall be of like character to that required of the appellant, except that no assignment of error is required, and no statement of the case, unless that presented by the appellant be controverted, or denied to be sufficiently full and complete to present the question for review.

The following sections added to Section 4, June 6, 1919:

(a) No party will be permitted to file a brief after the expiration of the time allowed for that purpose by Sections 3 and 4 of this Rule, without permission of the Court granted for good cause shown.

(b) When a case is called for hearing, if the appellant's brief is not on file, the appeal may be dismissed.

5. Errors not assigned, according to the rule of the Court, will be disregarded, though the Court, at its option, may notice and pass upon a plain error not assigned.

6. When, according to the provision of this rule, the appellee is in default, he will not be heard except upon request of the Court.

7. The appellant in this Court shall be entitled to open and conclude the case; but where there are cross-appeals they shall be argued together as one case, and the plaintiff in the Court below shall be entitled to open and conclude the argument in this court.

8. When a case is called for argument at two successive terms, and at the call at the second term neither party is prepared to proceed with the argument, the appeal shall be dismissed at the cost of the appellant, unless sufficient cause be shown for further postponement.

9. The case shall not be placed on the assignment for hearing until after the time for the filing of the brief for the appellee shall have expired. *Provided*, That parties may, by agreement, expedite the printing of the transcript and the printing of briefs, and have the appeal assigned for hearing at an earlier day.

No. 21. Appeals from the Commissioner of Patents.

1. All certified copies of papers and evidence on appeal from the decision of the Commissioner of Patents, authorized by section 9 of the act of Congress, approved February 9, 1893, shall be received by the clerk of this court, and the cases, by titling and number as they appear on the record in the Patent Office,

shall be placed on a separate docket from the docket of the cases brought into this court by appeal from the supreme court of the District of Columbia, to be designated as the "Patent Appeal Docket;" and upon filing such copies the party appellant shall deposit with the clerk, or secure to be paid as demanded, an amount of money sufficient to cover all legal costs and expenses of said appeal; and upon failure to do so his appeal shall be dismissed. The clerk shall, under this titling of the case on the docket, make brief entries of all papers filed and of all proceedings had in the case.

2. The appellant, upon complying with the preceding section of this rule, shall file in the case a petition addressed to the court, in which he shall briefly set forth and show that he has complied with the requirements of sections 4912 and 4913 of the Revised Statutes of the United States to entitle him to an appeal, and praying that his appeal may be heard upon and for the reasons assigned therefor to the commissioner; and said appeal shall be taken within forty days from the date of the ruling or order appealed from and not afterwards.

If the petition for an appeal and the certified copies of papers and evidence on appeal mentioned in this and the preceding section of this rule shall not be filed and the case duly docketed in this court within forty days (*exclusive of Sundays and legal holidays*) from the day upon which notice of appeal is given to the Commissioner of Patents, the commissioner, upon such facts being brought to his attention by motion of the appellee, duly served upon the appellant or his attorney, may take such further proceedings in the case as may be necessary to dispose of the same,

as though no notice of appeal had ever been given.

3. The clerks shall provide a minute book of his office, in which he shall record every order, rule, judgment, or decree of the court in each case, in the order of time in which said proceedings shall occur; and of this book the index shall be so kept as to show the name of the party applying for the patent, the invention by subject matter or name, and, in the cases of interference, the name of the party with whose pending application or unexpired patent the subsequent application is supposed to interfere.

4. The cases on this docket shall be called for argument on the second Tuesday of January, March, May, and November in each year, and the cases shall be called in regular order as they may stand on the docket. A copy of these rules shall be furnished to the Commissioner of Patents; and it shall be the duty of the clerk of this court to give special notice to the said commissioner at least fifteen days immediately preceding the times thus respectively fixed for the hearing of said cases; the said notice to name the place of the sitting of the court, the titling of the cases on the docket of this court, the respective numbers thereof, and the number of each case as it appears of record in the Patent Office; and thereupon the commissioner shall give notice to the parties interested or concerned by notice addressed to them severally by mail.

5. The clerk shall furnish to any applicant a copy of any paper in any of said appeals on payment of the legal fees therefor.

6. The appeals from the Commissioner of Patents shall be subject to all the rules of this court provided for other cases therein, except where such rules, from

the nature of the case, or by reason of special provisions inconsistent therewith, are not applicable.

7. *Models, diagrams, and exhibits of material forming part of the evidence taken in the court below or in the Patent Office in any case pending in this court on writ of error or appeal shall be placed in the custody of the clerk of this court at least three days before the case is heard or submitted.*

8. *All models, diagrams, and exhibits of material placed in the custody of the clerk for the inspection of the court on the hearing of the case must be taken away by the parties within twenty days after the case is decided. When this is not done, it shall be the duty of the clerk to notify the counsel in the case and the Commissioner of Patents, by mail or otherwise, of the requirements of this rule; and if the articles are not removed within ten days after the notice is given, he shall destroy them or make such other disposition of them as to him may seem best.*

No. 22. Opinions of Lower Court and Commissioner of Patents Made Part of Record.

Whenever the judgment, decree or order appealed from is based upon or has reference to a written opinion filed in the case by the court below, such opinion shall constitute a part of the transcript to be sent to this court; and such opinion, and also the written reasons or grounds assigned by the Commissioner of Patents in appeals from the Patent Office, shall be printed as part of the record to be printed under Rule 6.

No. 27. Sundays and Legal Holidays.

That whenever days are mentioned in the foregoing rules as limitations of time, they shall be construed

to exclude Sundays and legal holidays, *but to include Saturday half holidays.*

INSTRUCTIONS TO APPELLANTS.

The act of Congress creating the court of appeals of the District of Columbia, approved February 9, 1893, gives to that court jurisdiction of appeals from final decisions of the Commissioner of Patents both in *ex parte cases* and in interference cases.

Where an appeal of either class is to be prosecuted to the court of appeals of the District of Columbia, the first step is to file with the Commissioner of Patents a notice of appeal, together with an assignment of reasons of appeal. This step must be taken within forty days, exclusive of Sundays and legal holidays, *but including Saturday half holidays,* from the date of the decision of the Commisioner of Patents sought to be reviewed.

The next step in the prosecution of such an appeal is to file with the clerk of the court of appeals of the District of Columbia a certified transcript of the record and proceedings in the Patent Office relating to the case in question, together with a petition for appeal, addressed to the court of appeals of the District of Columbia, make a deposit of $15, and have the appearance of a member of the bar of that court entered for the appellant.

The notice of appeal and reasons of appeal required to be served upon the Commissioner of Patents may be signed by the appellant or by his attorney of record in the Patent Office, but the petition for an appeal that is filed in the court of appeals of the District of Columbia must be signed by a member of the bar of the court of appeals of the District of

Columbia, who should enter a regular appearance in the case in the clerk's office.

After the petition for the appeal, the certified transcript, and the docket fee of $15 have been lodged in the office of the clerk of the Court of Appeals of the District of Columbia, the clerk will send to the solicitor of record an estimate of the cost of printing the petition, transcript, etc.

When the amount called for is deposited, the clerk will cause the printing to be done under his supervision, and when the printing is completed the case will be put on the calendar for hearing at the next term at which patent appeals are heard.

In interference cases the clerk is authorized to receive printed copies of the evidence, such as have been used in the Patent Office, thus saving to the appellant the cost of reprinting such evidence. When such printed copies are supplied, twenty-five copies must be furnished.

As above stated, the notice of appeal and the reasons of appeal are required to be filed with the Commissioner of Patents within forty days, exclusive of Sundays and legal holidays, *but including Saturday half holidays*, of the date of the decision appealed from, but the petition for appeal and the certified transcript which are to be filed in the Court of Appeals of the District of Columbia are required to be filed in that court within forty days, exclusive of Sundays and legal holidays, *but including Saturday half holidays*, from the time of the giving of the notice of appeal; that is to say, if the decision complained of was rendered, for instance, on the 1st day of July, 1906, the party aggrieved might file his notice of appeal, with the reasons of appeal, at any

time within forty days, exclusive of Sundays and legal holidays, *but including Saturday half holidays*, thereafter; but if he filed his notice of appeal and reasons therefor on the 10th day of July, 1906, he would be required to file his petition for appeal and the certified transcript in the Court of Appeals of the District of Columbia within forty days, exclusive of Sundays and legal holidays, *but including Saturday half holidays*, of the 10th day of July, 1906.

For convenience of appellants and to secure uniformity in practice the following forms are suggested as guides in the prosecution of patent appeals:

No. 1. Form of Notice of Appeal to the Court of Appeals of the District of Columbia in an Ex Parte Case, with Reasons of Appeal and Request for Transcript.

IN THE UNITED STATES PATENT OFFICE.

In re application of
.....
Serial No.....
.....
Filed .....
.....
Improvements in.....
.....

To the Commissioner of Patents:

SIR: You are hereby notified of my appeal to the court of appeals of the District of Columbia from your decision, rendered on or about the ..... day of ....., 19....., rejecting my above-entitled application and refusing me a patent for the invention set forth therein:

The following are assigned as reasons of appeal:

[*Here insert in separate counts the specific errors complained of.*]

.....,

By .....,

His Attorney.

No. 2. Form of Petition for an Appeal to the Court of Appeals of the District of Columbia in an Ex Parte Case.

IN THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

In re application of .....
Serial No.....
.....
Filed .....
.....
Improvements in.....
.....

To the Court of Appeals of the District of Columbia:

Your petitioner, ..., of .....
....., in the county of .....
....., and State of .....,
respectfully represents:

That he is the original and first inventor of certain new and useful improvements in .....

That on the ..... day of .....
....., 19....., in the manner prescribed by law, he presented his application to the Patent Office, praying that a patent be issued to him for the said invention.

That such proceedings were had in said office upon said application; that on the .....
day of ....., 19....., it was

rejected by the Commissioner of Patents and a patent for said invention was refused him.

That on the ..... day of ...., 19....., your petitioner, pursuant to sections 4912 and 4913, Revised Statutes, United States, gave notice to the Commissioner of Patents of his appeal to this honorable court from his refusal to issue a patent to him for said invention upon said application as aforesaid, and filed with him, in writing, the following reasons of appeal:

[*Here recite the reasons of appeal assigned in the notice to the Commissioner.*]

That the Commissioner of Patents has furnished him a certified transcript of the record and proceedings relating to said application for patent, which transcript is filed herewith and is to be deemed and taken as a part hereof.

Wherefore your petitioner prays that his said appeal may be heard upon and for the reasons assigned therefor to the commissioner as aforesaid, and that said appeal may be determined and the decision of the commissioner be revised and reversed, that justice may be done in the premises.

.....,

By .....,

His Attorney.

[*To be signed here by a member of the bar of the Court of Appeals of D. C.*]

.....,

Solicitor and of Counsel.

No. 3. Form of Notice of Appeal to the Court of Appeals of the District of Columbia in an Interference Case, with Reasons of Appeal and Request for Transcript.

IN THE UNITED STATES PATENT OFFICE.

BEFORE THE COMMISSIONER OF PATENTS.

..... *v.*	Interference No. ..... Subject-matter: Improvements in .....

And now comes ....., by ...., his attorney, and gives notice to the Commissioner of Patents of his appeal to the Court of Appeals of the District of Columbia, from the decision of the said commissioner, rendered on or about the ..... day of ...., 19....., awarding priority of invention to ..... in the above-entitled case, and assigns as his reasons of appeal the following:

[*Here set out in separate counts the specific errors in the Commissioner's decision complained of.*]

.....,

By .....,

His Attorney.

No. 4. Form of Petition for an Appeal to the Court of Appeals of the District of Columbia in an Interference Case.

IN THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

In re Interference No. .....

.....,
Appellant,
v.
.....

To the Court of Appeals of the District of Columbia:

Your petitioner, ..., of ..... , in the county of ..... , and State of ....., respectfully represents:

That he is the original and first inventor of certain new and useful improvements in .....

That on the ..... day of ..... , 19....., in the manner prescribed by law, he presented his application to the Patent Office, praying that a patent be issued to him for the said invention.

That thereafter, to wit, on the ..... day of ....., 19....., an interference proceeding was instituted and declared between his said application and a pending application of one ....., serial No. ....., filed ..... , for a similar invention.

That the subject-matter of said interference as set forth in the official declaration was as follows:

[*Here state the issues of the interference.*]

That thereafter, to wit, on the ..... day of ....., 19.....,

the case having been submitted upon the preliminary statements and evidence presented by the parties thereto, the Examiner of Interferences rendered a decision awarding priority of invention to .....
.....

That, pursuant to the statutes and the rules of practice in the Patent Office in such case made and provided, ... appealed from the said adverse decision of the Examiner of Interferences to the Board of Examiners-in-Chief, and the case having been argued and submitted to said board, a decision was rendered by said board on the .....
..... day of ....., 19....., affirming (*or*, reversing) the decision of the Examiner of Interferences.

That thereafter, pursuant to said statutes and rules, ... appealed from the said adverse decision of the Board of Examiners-in-Chief to the Commissioner of Patents, and the same coming on to be heard and having been argued and submitted, a decision was, on the .....
..... day of ....., 19....., rendered by the commissioner adverse to your petitioner, affirming (*or*, reversing) the decision of the Board of Examiners-in-Chief and awarding priority of invention to the said .....

That on the ..... day of ....
....., 19....., your petitioner, pursuant to sections 4912 and 4913, Revised Statutes, United States, gave notice to the Commissioner of Patents of his appeal to this honorable court from his decision awarding priority of invention to said ....., as aforesaid, and filed with him, in writing, the following reasons of appeal:

[*Here insert reasons of appeal assigned in notice to Commissioner.*]

That the Commissioner of Patents has furnished your petitioner a certified transcript of the record and proceedings relating to said interference case, which transcript is filed herewith and is to be deemed and taken as a part hereof.

Wherefore your petitioner prays that his said appeal may be heard upon and for the reasons assigned therefor to the commissioner as aforesaid, and that said appeal may be determined and the decision of the commissioner be revised and reversed, that justice may be done in the premises.

.....,

By .....,

His Attorney.

[*To be signed here by a member of the bar of the Court of Appeals of D. C.*]

.....,

Solicitor and of Counsel.

APPENDIX C

RULES OF 1870.

RULES AND REGULATIONS FOR PROCEEDINGS IN THE PATENT OFFICE

United States Patent Office,
July 15, 1870.

The following information and regulations are designed to be in strict accordance with the revised, consolidated, and amended law relating to patents for inventions and designs and trade-marks, approved July 8, 1870, which law, the only one in force on these subjects, is printed in pamphlet form for gratuitious distribution.

Copious forms, to which inventors and attorneys are recommended to conform as nearly as possible, will be found in an appendix.

WHO MAY OBTAIN A PATENT

1. Any person, whether citizen or alien, being the original and first inventor or discoverer of any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent for his invention or discovery, subject to the conditions as to public use and abandonment hereinafter named.

2. In case of the death of the inventor, the patent may be applied for by, and will issue to, his legal representatives; and in case of an assignment of the whole, or of any individed (undivided) interest in the invention, the patent may issue to the assignee of the whole interest, or jointly to the inventor and the assignee of the undivided interest, the assignment being first entered of record, and the application being duly made and the specification duly sworn to by the inventor.

3. Joint inventors are entitled to a joint patent; neither can claim one separately; but independent inventors of separate improvements in the same machine cannot obtain a joint patent for their separate inventions; nor does the fact that one man furnished the capital and the other makes the invention entitle them to take out a joint patent.

4. Although an applicant may have actually made an invention, a patent therefor will not be granted him if the whole or any part of what he claims as new has been, before his invention, patented or described in any printed publication in this or any foreign country, or been invented or discovered in this country, nor if he has once abandoned his invention to the public, nor if it has been in public use or on sale for more than two years previous to his application.

5. If the inventor, at the time of making his application, be-

lieves himself to be the first inventor or discoverer, a patent shall not be refused on account of the invention or discovery, or any part thereof, having been before known or used in any foreign country; it not appearing that the same or any substantial part thereof had before been patented or described in any printed publication.

6. Merely conceiving the idea of an improvement or machine is not an "invention" or "discovery." The invention must have been reduced to a practical form, either by the construction of the machine itself, or of a model thereof, or by making a drawing of it, or by such disclosure of its exact character as that a mechanic can and does, from the description given, construct the improvement or a model thereof, before it will prevent a subsequent inventor from obtaining a patent.

MODE OF PROCEEDING TO OBTAIN A PATENT

APPLICATION

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

8. The application must be made by the actual inventor, if alive, even if the patent is to issue or reissue to an assignee: but where the inventor is dead, the application and oath may be made by the executor or administrator.

9. The application must be in writing, in the English language, and addressed to the Commissioner of Patents. The petition and specification must be separately signed by the inventor. All claims and specifications filed in this office (including amendments) must be written in a fair, legible hand, without interlineations or erasures, except such as are clearly stated in a marginal or foot note written on the same sheet of paper; otherwise the office may require them to be printed. All the papers constituting the application must be attached together.

SPECIFICATION

10. The specification is a written description of the invention or discovery, and of the manner and process of making, constructing, compounding and using the same, in such full, clear, concise, 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.

11. The applicant must set forth in his specification the precise invention for which he claims a patent; and in all applications for mere improvements, the specification must distinguish between what is admitted to be old and what is described and claimed to be the improvement, so that the office and the public may understand exactly for what the patent is granted.

12. Two or more distinct and separate inventions may not be

claimed in one application; but where several inventions are necessarily connected each with the other, they may be so claimed.

13. If more than one invention is claimed in a single application, and they are found to be of such a nature that a single patent may not be issued to cover the whole, the office requires the inventor to divide the application into separate applications, or to confine the description and claim to whichever invention he may elect.

14. The specification should describe the drawings (where there are drawings), and refer by letters and figures to the different parts; and having fully described the art, machine, manufacture, composition, or improvement, it should particularly specify and point out the part, improvement, or combination which is claimed as the invention or discovery.

15. The specification must be signed by the inventor, or by his executor or administrator, and must be attested by two witnesses. Full names must be given, and all names, whether of applicant or witnesses, must be legibly written.

16. The applicant must make oath or affirmation that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvements for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. The oath or affirmation may be made before any person within the United States authorized by law to administer oaths or, when the applicant resides in a foreign country, before any minister, charge d'affaires, counsul, or commercial agent, holding commission under the government of the United States, or before any notary public of the foreign country in which the applicant may be, the oath being attested in all cases, in this and other countries, by the proper official seal of such notary.

DRAWINGS

17. The applicant for a patent is required by law to furnish a drawing of his invention, where the nature of the case admits of it.

18. Such drawing must be on thick, smooth drawing paper, sufficiently stiff to support itself in the portfolios of the office. It must be neatly and artistically executed, with detached sectional views as to clearly show what the invention is in construction and operation. Each part must be distinguished by the same number or letter whenever it appears in the several drawings. The name of the invention should be written at the top, the shortest side being considered as such. This drawing must be signed by the applicant or his attorney, and attested by two witnesses, and must be sent with the specification. Tracings upon cloth pasted on thick paper will not be admitted. Thick drawings should never be folded for transmission, but should be rolled.

19. The duplicate drawing to be attached to the patent will be furnished by the office without charge, and will be a photo-lithographic copy of the thick drawing.

20. The following rules must be observed in the preparation of the drawings, in order that they may be photo-lithographed:

The paper must be thin Bristol board or thick drawing paper, with a smooth or calendered surface. The outlines must be

executed in deep black lines, to give distinctness to the print. Pale, ashy tints must be dispensed with.

In shading, lines of black ink should be used, and such lines should be distinct and sharp, and not crowded. Brush shadings or shadows will not be permitted.

All colors, except black, must be avoided in the drawing, lettering, and signatures; violet and purple inks must not be used.

No agent's, attorney's, or other stamp must be placed, in whole or in part, within the margin.

The sheet must not be larger than ten inches by fifteen, that being the size of the patent. If more illustrations are needed, several sheets must be used.

21. Copies of drawings of patents issued after January 1, 1869, will be furnished to anyone at the uniform rate of twenty-five cents per sheet of standard size.

22. Copies of drawings of patents issued prior to January 1, 1869, which can be photo-lithographed, will be furnished at twenty-five cents per sheet, when ten or more copies are ordered. Single tracings of such drawings, or less than ten, will be furnished at the cost of making them. One hundred copies or more will be furnished at ten dollars per hundred.

23. Applicants are advised to employ competent artists to make the drawings, which will be returned if not executed in strict conformity with these rules, or if injured by folding.

MODEL

24. An applicant, upon filing his specification and drawings, may submit to the Commissioner the question whether he shall deposit a model or specimen of his invention; otherwise a model will be required in every case, except for designs, where the nature of the invention admits of such illustration. Such model must clearly exhibit every feature of the machine which forms the subject of a claim of invention. Models filed as exhibits, in interference and other cases, may be returned to the applicant, at the discretion of the Commissioner.

25. The model must be neatly and substantially made, of durable material. It should be made as small as possible, but not in any case more than one foot in length, width, or height. If made of pine or other soft wood, it should be painted, stained, or varnished. Glue must not be used, but the parts should be so connected as to resist the action of heat or moisture.

26. A working model is always desirable, in order to enable the office fully and readily to understand the precise operation of the machine. The name of the inventor, and of the assignee (if assigned), and also the title of the invention, must be affixed upon it in a permanent manner. When the invention is a composition of matter, a specimen of each of the ingredients and of the composition must accompany the application, and the name of the inventor and of the assignee (if there be one) must be permanently affixed thereto.

27. The model, unless otherwise disposed of, will be returned to the applicant upon demand, and at the expense of the applicant, in all cases when as application has been rejected more than two years; and in any pending case of less than two years' standing, upon the filing of a formal abandonment of the application, signed by applicant.

COMPLETION OF THE APPLICATION.

28. No application can be examined, nor can the case be placed upon the files for examination, until the fee is paid, the specification, with the petition and oath, filed, and the drawings and model or specimen (when required) filed or deposited. *It is desirable that everything necessary to make the application complete should be deposited in the office at the same time.* If otherwise, a letter should accompany each part, stating to what application it belongs.

THE EXAMINATION

All cases in the Patent Office are classified and taken up for examination in regular order; those in the same class being examined and disposed of, as far as practicable, in the order in which the respective applications are completed. When, however, the invention is deemed of peculiar importance to some branch of the public service, and when, for that reason, the head of some department of the government specially requests immediate action, the case will be taken up out of its order. These, with applications for reissues, and for letters-patent for inventions for which a foreign patent has already been obtained, which cases have precedence over original applications, are the only exceptions to the rule above stated in relation to the order of examination.

30. The personal attendance of the applicant at the Patent Office is unnecessary. The business can be done by correspondence or by attorney.

31. The applicant has a right to amend, of course, after the first rejection; and he may amend as often as the examiner presents any new references. After a second rejection, and at any time before the issue of the patent, the applicant may draw up special amendments and present the same to the Assistant Commissioner, who may, in his discretion, grant leave to make such special amendments, and allow a reconsideration by the examiner in charge. But such amendments shall first be submitted to the examiner in order that he may indorse thereon his recommendation or objections.

32. All amendments of the model, drawings, or specification, in the case of original applications, must conform to at least one of them as they were at the time of the filing of the application; and all amendments of specifications or claims must be made on separate sheets of paper from the original, and must be filed in the manner above directed. Even when the amendment consists in striking out a portion of the specification, or other paper, the same course should be observed. No erasure must be made by the applicant. The papers must remain forever as they were when filed, so that a true history of all that has been done in the case may be gathered from them. In every case of amendment the exact word or words to be stricken out or inserted should be clearly specified, and the precise point indicated where any insertion is to be made.

33. Whenever, on examination, any claim for a patent is rejected, for any reason whatever, the applicant will be notified thereof, and the reasons for such rejection will be given, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, he shall persist in his claim for a patent, with or without altering his specification, the case will be reexamined.

34. Upon the rejection of an application for want of novelty, the applicant will be furnished with a specific reference (by name, date, and class) to the article or articles by which it is anticipated. If he desires a copy of the cases so referred to, or of the plates or drawings connected with them, they will be forwarded to him, if in possession of the office, on payment of the cost of making such copies.

35. When the rejection of an application is founded upon another case previously rejected but not withdrawn or abandoned, the applicant will be furnished with all information in relation to the previously-rejected case which is necessary for the proper understanding and management of his own.

36. The specification, especially if the claim be amended, must be amended and revised, if required by the examiner, for the purpose of correcting inaccuracies of language or unnecessary prolixity, and of securing correspondence between the description of the invention and the claim.

37. The office will not return specifications for amendment; and in no case will any person be allowed to take any papers, drawings, models, or samples from the office. If applicants have not preserved copies of such papers as they wish to amend, the office will furnish them on the usual terms.

DATE OF PATENT

38. Every patent will bear date as of a day not later than six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, and if the final fee shall not be paid within that period, the patent will be withheld. No patent will be antedated.

WITHDRAWN AND REJECTED APPLICATIONS

39. When an application for a patent has been rejected or withdrawn, prior to July 8, 1870, the applicant will have six months from that date to renew his application, or to file a new one; and if he omits to do either, his application will be held to have been abandoned; upon the hearing of such renewed application, abandonment will be considered as a question of fact.

40. The proper course will be, where the application has been withdrawn, to file a new application; and where it has been rejected but not withdrawn, to file a formal renewal, with or without amendment, as the status of the application with reference to previous action may require.

41. Upon considering such renewed applications of either class, if it be found that applications have been made or unexpired patents have been granted in which the device in controversy has been described or claimed, an interference will be declared between such applications or patents and such renewed application, in order that an opportunity may be given for the production of proof of abandonment or two years' public use, if either exist.

APPEALS

42. Every applicant for a patent or the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary

examiner, or of the examiner in charge of interferences, in such case, to the board of examiners-in-chief, having once paid a fee of ten dollars. For this purpose a petition in writing must be filed, signed by the party or his authorized agent or attorney, praying an appeal and setting forth briefly and distinctly the reasons upon which the appeal is taken.

43. The examiners-in-chief will consider the case as it was when last passed upon by the primary examiner, merely revising his decisions so far as they were adverse to the applicant.

44. There must be two rejections upon the claim as originally filed, or, if amended (in a matter of substance) upon the amended claim. Decisions of examiners upon preliminary or intermediate questions, or refusals to act, twice repeated, will be reexamined, upon application, by the Commissioner in person.

45. Cases which have been heard and decided by the examiners-in-chief will not be reheard by them except upon the order of the Commissioner.

46. All cases which have been acted on by the board of examiners-in-chief may be brought before the Commissioner in person, upon a written request to that effect, and upon the payment of the fee of twenty dollars required by law. A case deliberately decided by one Commissioner will not be disturbed by his successor. The only only remaining remdy will be by appeal, in those cases allowed by law, to the supreme court of the District of Columbia, sitting in banc.

47. The mode of appeal from the decision of the office to the supreme court of the District of Columbia is by giving written notice thereof to the Commissioner; said notice being accompanied by the petition addressed to the supreme court of the District of Columbia, by the reasons of appeal, and by a certified copy of all the original papers and evidence in the case. The reasons of appeal must be filed within thirty days after the notice of the decision appealed from.

48. Printed forms of notice of appeal, of the reasons of appeal, and of the petition will be forwarded on request. The original files in the case cannot be taken from the office to the court, but certified copies of the record and references, to be used as evidence, will be furnished at the usual rates.

HEARINGS

49. All cases pending before the Commissioner will stand for argument at one o'clock on the day of hearing. If either party in a contested case, or the appellant in an *ex parte* case, appear at that time, he will be heard; but in contested cases no motions will be heard in the absence of the other party, except upon default after due notice; nor will a case be taken up for oral argument after the day of hearing, except by consent of both parties. If the engagements of the tribunal before whom the case is pending are such as to prevent it from being taken up on the day of hearing, a new assignment will be made, or the case will be continued from day to day until heard. Unless otherwise ordered before the hearing begins, oral arguments will be limited to one hour for each counsel.

MOTIONS

50. Reasonable notice of all motions, and copies of the motion papers and affidavits, must be served upon the opposite party or his attorney.

INTERFERENCES

51. An "interference" is an interlocutory proceeding for the purpose of determining which of two or more persons, each or either of whom claims to be the first inventor of a given device or combination, really made the invention first.

An interference will be declared in the following cases:

First. When the parties have pending applications before the office at the same time, both or all the parties claiming to be the inventor of the same thing.

Second. When an applicant, having been rejected upon the prior unexpired patent or the prior application of another, claims to have made the invention before the prior applicant or patentee.

Third. When an invention is claimed in a renewed application which is shown or claimed in an application filed or unexpired patent granted prior to the filing of such renewed application.

Fourth. When an applicant for a reissue embraces in his amended specification any new or additional description of his invention, or enlarges his claim, or makes a new one, and thereby includes therein anything which has been claimed in any patent granted subsequent to the date of his original application, as the intention of another person, an interference will be declared between the application and any such unexpired patent, or pending application. If the reissue application claims only what was granted in the original patent, it may be put into interference with any pending application in which the same thing is shown, provided the later applicant claims to be the prior inventor and is not barred a patent by public use or abandonment.

Fifth. When an application is found to conflict with a caveat, the caveator is allowed a period of three months within which to present an application, when an interference may be declared.

Sixth. The office reserves to itself the right, when two applications are pending at the same time, in one of which a device may be described which is claimed in the other, to declare an interference to determine with whom is priority of invention, without reference to the order in which such applications may have been filed.

52. The fact that one of the parties has already obtained a patent will not prevent an interference; for, although the Commissioner has no power to cancel a patent already issued, he may, if he finds that another person was the prior inventor, give him also a patent, and thus place them on an equal footing before the courts and the public.

53. Upon the declaration of an interference each party will be required, before any time is set for the taking of testimony, to file a statement under oath giving the date and a detailed history of the invention, showing the successive experiments, steps of development, extent and character of use, and forms of embodiment. Such statement shall not be open to inspection by the other party, until both are filed, or until the time for filing both has expired. In default of such filing by either party, or if the statement of

either fails to overcome the *prima facie* case made by the respective dates of application, or if it shows that the invention has been abandoned or that it has been in public use for more than two years prior to the application of affiant, the other party shall be entitled to an adjudication by default upon the case as it stands upon the record.

54. Where no testimony is taken by the applicant upon whom rests the burden of proof, or where testimony has been taken by such applicant, but not by the other party, during the time assigned to the latter, the case will be considered closed, and may, at the expiration of the time assigned to such parties respectively, be set down for hearing, at any time, not less than ten days thereafter.

55. In cases of interference, parties have the same remedies by appeal as other applicants, to the examiners-in-chief and to the Commissioner, but no appeal lies, in such cases, from the decision of the Commissioner. Appeals in interference cases should be accompanied with a brief statement of the reasons thereof.

56. When an interference is declared, notice will be given to both parties, or to their attorneys. When one of the parties has filed a caveat or already received a patent, duplicate notices will be sent to the patentee or caveator and to his attorney of record. Where one of the parties resides abroad and has no known agent in the United States, in addition to the notice sent by mail, notice may be given by publication in a newspaper of general circulation in the city of Washington once in a week for three successive weeks.

57. In cases of interference the party who first filed so much of his application for a patent as illustrates his invention will be deemed the first inventor in the absence of all proof to the contrary. A time will be assigned in which the other party shall complete his direct testimony; and a further time in which the adverse party shall complete the testimony on his side; and a still further time in which both parties may take rebutting testimony, but shall take no other. If there are more than two parties, the times for taking testimony shall be so arranged, if practicable, that each shall have a like opportunity in his turn, each being held to go forward and prove his case against those who filed their applications before him.

58. If either party wishes the time for taking his testimony, or for the hearing, postponed, he must make application for such postponement, and must show sufficient reason for it by affidavit filed before the time previously appointed has elapsed, if practicable; and must also furnish his opponent with copies of his affidavits and with reasonable notice of the time of hearing his application.

59. Cases of interference will, when the issue is made up and the testimony taken, be tried before the examiner in charge of interferences. If an interference has been properly declared, it will not be dissolved without judgment of priority, founded upon the testimony or the written concession of one of the parties, unless the invention is found not to be patentable, or to have been abandoned, or that it has been in public use for more than two years prior to the application of either party, or that no interference in fact exists.

60. No amendments to the specification will be received during the pendency of an interference, except as provided in section 61. A second interference will not be declared upon a new application filed by either party during the pendency of an interference, or

after judgment, nor will a rehearing be granted, unless it be shown to the satisfaction of the Commissioner (in person) that the party desiring a new interference or rehearing has new and material testimony which he could not have procured in time for the hearing; or, unless other sufficient reasons be shown, satisfactory to the Commissioner.

61. When an application is adjudged to interfere with a part only of another pending application, the interfering parties will be permitted to see or obtain copies of so much only of the specifications as refers to the interfering claims. And either party may, if he so elect, withdraw from his application the claims adjudged not to interfere and file a new application therefor: *Provided*, That the claims so withdrawn cover inventions which do not involve the devices in interference: *And provided also*, That the devices in interference are eliminated from the new application. In such cases the latter will be examined without reference to the interference from which it was withdrawn.

REISSUES

62. A reissue is granted to the original patentee, his legal representatives, or the assignees of the entire interest, when by reason of a defective or insufficient specification the original patent is inoperative or invalid, provided the error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention: but although the patent has been assigned, the application must be made, and the specification sworn to by the inventor.

63. The petition for a reissue must show that all parties owning any undivided interest in the patent concur in the surrender. A statement, under oath, of the title of the party proposing to surrender must be filed with the application.

64. The general rule is, that whatever is really embraced in the orignial invention, and so described or shown that it might have been embraced in the original patent, may be the subject of a reissue; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended except each by the other; but, when there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.

65. Reissued patents expire at the end of the term for which the original patent was granted. For this reason applications for reissue will be acted upon as soon as filed.

66. A patentee, in reissuing, may at his option have a separate patent for each distinct and separate part of the invention comprehended in his original patent, by paying the required fee in each case, and complying with the other requirements of the law, as in original applications. Each division of a reissue constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division; and the drawing may represent only such part or parts. All the divisions of a reissue will issue simultaneously. If there be controversy as to one, the other will be withheld from issue until the controversy is ended.

67. In all cases of applications for reissues, the original claim, if reproduced in the amended specification, is subject to re-exam-

ination, and may be revised and restricted in the same manner as in original applications; but if any reissue be refused, the original patent will, upon request, be returned to the applicant.

DISCLAIMERS

68. Whenever, by inadvertence, accident, or mistake, the claim of invention in any patent is too broad, embracing more than that of which the patentee was the original or first inventor, some material or substantial part of the thing patented being truly and justly his own, the patentee, his heirs or assigns, whether of a whole or of a sectional interest, may make disclaimer of such parts of the thing patented as the disclaimant shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent; which disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office.

EXTENSIONS

69. Power is vested in the Commissioner to extend any patent granted prior to March 2, 1861, for seven years from the expiration of the original term; but no patent granted since March 2, 1861, can be extended. When a patent has been reissued in two or more divisions, separate applications must be made for the extension of each division.

70. The applicant for an extension must file his petition and pay in the requisite fee not more than six months nor less than ninety days prior to the expiration of his patent. There is no power in the Commissioner to renew a patent after it has once expired.

71. Any person who intends to oppose an application for extension may, at any time after such application has been made, give notice of such intention to the applicant. After this he will be regarded as a party in the case, and will be entitled to notice of the time and place of taking testimony; to a list of names and residences of the witnesses whose testimony may have been taken previous to his service of notice of opposition; to a copy of the application; and to any other papers on file, upon paying the cost of copying.

72. The applicant for an extension must furnish to the office a statement in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures on account thereof, both in this and foreign countries. This statement must must be made particular and in detail, unless sufficient reason is set forth why such a statement cannot be furnished. It must be filed within thirty days after filing the petition.

73. The questions which arise on each application for an extension are:

First. Was the invention *new* and *useful* when patented?

Second. Is it *valuable* and *important to the public*, and to what extent?

Third. Has the inventor been *reasonably remunerated* for the time, ingenuity, and expense bestowed upon it, and the introduction of it into use? If not, has his failure to be remunerated arisen from neglect or fault on his part?

Fourth. What will be the effect of the proposed extension upon the public interests?

No proof will be required from the applicant upon the first question unless the invention is assailed upon those points by opponents.

To enable the Commissioner to come to a correct conclusion in regard to the second point of inquiry, the applicant should, if possible, procure the testimony of persons disinterested in the invention, which testimony should be taken under oath. This testimony should have relation to nothing but what is actually covered by the claims of the patent.

In regard to the third point of inquiry, in addition to his own oath, showing his receipts and expenditures on account of the invention, the applicant should show, by testimony under oath, that he has taken all reasonable measures to introduce his invention into general use; and that, without neglect or fault on his part, he has failed to obtain from the use and sale of the invention a reasonable remuneration for the time, ingenuity, and expense bestowed on the same, and the introduction of it into use.

74. In case of opposition to the extension of a patent by any person, both parties may take testimony, each giving reasonable notice to the other of the time and place of taking said testimony, which shall be taken according to the rules prescribed by the Commissioner in cases of interference.

75. Any person opposing an extension must file his reasons of opposition in the Patent Office at least twenty days before the day of hearing.

76. In contested cases no testimony will be received, unless by consent, which has been taken within thirty days next after the filing of the petition for the extension.

77. Service of notice to take testimony may be made upon applicant, upon the opponent, upon the attorney of record of either, or, if there be no attorney of record, upon any attorney or agent who takes part in the service of notice, or the examination of the witnesses of either party. Where notice to take testimony has already been given to an opponent, and a new opponent subsequently gives notice of his intention to oppose, the examination need not be postponed, but notice thereof may be given to such subsequent opponent by mail or by telegraph. This rule, however, does not apply to *ex parte* examinations, or those of which no notice has been given when notice of opposition is served.

78. In the notice of the application for an extension a day will be fixed for the closing of testimony; a day ten days later for the reception of arguments, and for the filing of the examiner's report; and a day five days after this for a hearing; but no case will be set for a hearing more than three weeks prior to the expiration of the patent. Applications for a postponement of the hearing must be made and supported according to the same rules as are to be observed in cases of interference. But they will not be granted in such a manner as to cause a risk of preventing a decision in season.

DESIGNS

79. A patent for a design may be granted to any person, whether citizen or alien, who, by his own industry, genius, efforts, and expense, has invented or produced any new and original design

for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, pattern, print, or picture, to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, upon payment of the duty required by law, and other due proceedings had the same as in cases of inventions or discoveries.

80. Patents for designs are granted for the term of three and one-half years, or for the term of seven years, or for the term of fourteen years, as the said applicant may elect in his application. If granted prior to March 2, 1861, and unexpired, they may be extended for seven years, in the same manner as patents for invention.

81. The petition, oath, specification, and other proceedings in the case of applications for letter-patent for a design are the same as for other patents.

82. When a work of design can be sufficiently represented by a drawing, a model will not be required.

83. Photographs are received for the illustration of works of design only. One must be pasted upon thick drawing-paper, but in every case where this mode of illustration is employed by an applicant he will be required to deposit in this office the glass or other "negative" from which the photograph is printed, so that exact official copies may be made therefrom when desirable.

TRADE-MARKS

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

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

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

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

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

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

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

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

85. Such trade-mark shall remain in force for thirty years, and may be renewed for thirty years more, except in cases where such trade-mark is claimed for, and applied to, articles not manufactured in this country, and in which it receives protection under the laws of any foreign country for a shorter period, in which case it shall cease to have force in this country, at the same time that it becomes of no effect elsewhere.

86. No proposed trade-mark will be received or recorded which is not and cannot become a lawful trade-mark, or which is merely the name of a person, firm, or corporation only, unaccompanied by a mark sufficient to distinguish it from the name when used by other persons, or which is identical with a trade-mark appropriate to the same class of merchandise and belonging to a different owner, and already registered or received for registration, or which so nearly resembles such last-mentioned trade-mark as to be likely to deceive the public; but any lawful trade-mark already lawfully in use may be recorded.

87. Five duplicate copies of the proposed trade-mark, in addition to the one accompanying the statement and oath of applicant, must be deposited with each application. Certified copies will be furnished at the usual rates.

88. The right to the use of any trade-mark is assignable by any instrument of writing, and such assignment must be recorded in the Patent Office within sixty days after its execution. The fees will be the same as are prescribed for recording assignments of patents.

FOREIGN PATENTS

89. The taking out of a patent in a foreign country does not prejudice a patent previously obtained here, nor does it prevent obtaining a patent here subsequently, unless the invention shall have been introduced into public use in the United States *for more than two years* prior to the application; and *provided*, that the patent shall expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term; but in no case shall it be in force more than seventeen years.

90. When application is made for a patent for an invention which has been already patented abroad, the inventor will be required to make oath that, according to the best of his knowledge and belief, the same has not been in public use in the United States for more than two years prior to the application in this country.

91. An applicant whose invention has been patented abroad should state the fact that a foreign patent has actually been obtained, giving its date, and if there be more than one, of the one having the shortest term.

CAVEATS

92. Any citizen of the United States, or alien who has resided for one year last past in the United States, and has made oath of his intention to become a citizen thereof, can file a caveat in the secret archives of the Patent Office on the payment of a fee of ten dollars therefor. And if, at any time within one year thereafter, another person applies for a patent for the same invention, the caveator will be entitled to notice to file his application, and to go into interference with the applicant for the purpose of proving priority of invention and obtaining the patent if he succeed. He must file his application within three months from the day on which the notice to him is deposited in the post office at Washington, adding the regular time for the transmission of the same to him; and the day when the time for filing expires shall be mentioned in the notice or indorsed thereon.

93. The caveator will not be entitled to notice of any application pending at the time of filing his caveat, nor of any application filed after the expiration of one year from the date of filing the caveat; but he may renew his caveat at the end of one year by paying a second caveat fee of ten dollars, which will continue it in force for one year longer, and so on from year to year as the caveator may desire.

94. No caveat can be filed in the secret archives of the office unless accompanied by an oath of the caveator that he is a citizen of the United States, or, if he is an alien, that he has resided for one year last past within the United States, and has made oath of his intention to become a citizen thereof; nor unless the applicant also states, under oath, that he believes himself the original inventor of the art, machine, or improvement set forth in his caveat.

95. A caveat need not contain as particular a description of the invention as is requisite in a specification; but still the description should be sufficiently precise to enable the office to judge whether there is a probable interference when a subsequent application is filed.

96. Caveat papers cannot be withdrawn from the office nor undergo alteration after they have once been filed; but the caveator, or any person properly authorized by him, can at any time obtain copies of the caveat papers at the usual rates.

97. When practicable, the caveat must be accompanied by drawings or sketches.

ASSIGNMENTS

98. A patent may be assigned, either as to the whole interest or any undivided part thereof, by any instrument of writing. No particular form of words is necessary to constitute a valid assignment, nor need the instrument be sealed, witnessed, or acknowledged.

99. A patent will, upon request, issue directly to the assignee or assignees of the entire interest in any invention, or to the inventor and the assignee jointly, when an undivided part only of the entire interest has been conveyed.

100. In every case where a patent issues or reissues to an assignee the assignment must be recorded at the Patent Office at least five days before the issue of the patent, and the specification must be sworn to by the inventor.

101. When the patent is to issue in the name of the assignee the entire correspondence should be in his name.

102. The patentee may grant and convey an exclusive right under his patent to the whole or any specified portion of the United States, by an instrument in writing.

103. Every assignment or grant of an exclusive territorial right must be recorded in the patent Office within three months from the execution thereof; otherwise it will be void as against any subsequent purchaser or mortgagee for a valuable consideration without notice; but, if recorded after that time, it will protect the assignee or grantee against any such subsequent purchaser, whose assignment or grant is not then on record.

104. The patentee may convey separate rights under his patent to make or to use or to sell his invention, or he may convey territorial or shop rights which are not exclusive. Such conveyances are mere licenses, and need not be recorded.

105. The receipt of assignments is not generally acknowledged by the office. They will be recorded in their turn within a few days after their reception, and then transmitted to the persons entitled to them. A five cent revenue stamp is required for each sheet or piece of paper on which an assignment, grant, or license may be written.

OFFICE FEES AND HOW PAYABLE

106. Nearly all the fees payable to the Patent Office are positively required by law to be paid in advance, that is, upon making application for any action by the office for which a fee is payable. For the sake of uniformity and convenience, the remaining fees will be required to be paid in the same manner.

107. The following is the tariff of fees established by law:

On filing every application for a design, for three years and six months	$10.00
On filing every application for a design, for seven years	15.00
On filing application for a design, for fourteen years	30.00
On filing every caveat	10.00
On filing every application for a patent	15.00
On issuing each original patent	20.00
On filing a disclaimer	10.00
On filing every application for a reissue	30.00
On filing every application for division of a reissue	30.00
On filing every application for an extension	50.00
On the grant of every extension	50.00
On filing the first appeal from a primary examiner to examiners-in-chief	10.00
On filing an appeal to the Commissioner from examiners-in-chief	20.00
On depositing a trade-mark for registration	25.00
For every copy of a patent or other instrument, for every 100 words	10.00
For every certified copy of drawing, the cost of having them made.	
For copies of papers not certified, the cost of having them made.	
For recording every assignment of 300 words or under	1.00
For recording every assignment, if over 300 and not over 1,000 words	2.00
For recording every assignment, if over 1,000 words	3.00

108. The final fee on issuing a patent must be paid within six months after the time at which the patent was allowed and notice thereof sent to the applicant or his agent. And if the final fee for such patent be not paid within that time the patent will be forfeited, and the invention therein described become public property, as against the applicant therefor, unless he shall make a new application therefor within two years from date of the original allowance.

109. The money for the payment of fees may be paid to the Commissioner, or to the Treasurer, or any of the assistant treasurers, of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose, who shall give the depositor a receipt or certificate of deposit therefor, which shall be transmitted to this office. When this cannot be done without much inconvenience, the money may be remitted by mail, and in every case the letter should state the exact amount inclosed. Letters containing money may be registered. Post office money-orders now afford a safe and convenient mode of transmitting fees. All such orders should be made payable to the Commissioner of Patents.

110. All money sent by mail, either to or from the Patent Office, will be at the risk of the owner. In no case should money be sent inclosed with models. All payments to or by the office must be paid in specie, treasury notes, national bank notes, certificates of deposit, or post office money-orders.

REPAYMENT OF MONEY

111. Money paid by actual mistake will be refunded: but a mere change of purpose after the payment of money will not entitle a party to demand such return.

STAMPS.

112. Revenue stamps must be attached as follows:

First. A stamp of the value of fifty cents is required upon each power of attorney authorizing an attorney or agent to transact business with this office relative to an application for a patent, reissue, or extension.

Second. No assignment directing a patent to issue to an assignee will be recognized by this office, nor will any assignment be recorded, unless stamps shall be affixed of the value of five cents for every sheet or piece of paper upon which the same shall be written.

Third. The person using or affixing the stamp must cancel the same by writing thereupon the initials of his name and the date.

TAKING AND TRANSMITTING TESTIMONY

113. The law requires the clerks of the various courts of the United States to issue subpoenas to compel the attendance of witnesses whose depositions are desired to be read in evidence in any contested cases in the Patent Office.

In interference, extension, and other contested cases, the following rules have been established for taking and transmitting evidence:

First. That, before the deposition of a witness or witnesses be taken by either party, due notice shall be given to the opposite party, as hereinafter provided, of the time and place when and where such deposition or depositions will be taken, with the names and residences of the witness or witnesses then and there to be examined, so that the opposite party, either in person or by attorney, shall have full opportunity to cross-examine the witness or witnesses: *Provided*, That if the opposite party or his counsel be actually present at the taking of testimony, witnesses not named in the notice may be examined, but not otherwise. And such notice shall, *with proof of service of the same*, be attached to the deposition or depositions, whether the party cross-examine or not; and such notice shall be given in sufficient time for the appearance of the opposite party.

Second. That, whenever a party relies upon a caveat to establish the date of his invention, a certified copy thereof must be filed in evidence, with due notice to the opposite party, as no notice can be taken by the office of a caveat, filed in its secret archives.

Third. That all evidence, etc., shall be sealed up, entitled upon the envelope with the name of the case in which it is taken, and addressed to the Commissioner of Patents by the person before whom it shall be taken, and so certified thereon, and forwarded *immediately upon the close of the examination* to the Patent Office.

Fourth. In cases of extension, where no opposition is made, *ex parte* testimony will be received from the applicant; and such testimony as may have been taken by the applicant prior to notice of opposition shall be received, unless taken within thirty days after filing the petition for the extension: *Provided*, That immediately upon receiving notice of opposition the applicant shall give notice to the opposing party or parties of the names and residences of the witnesses whose testimony has thus been taken.

Fifth. That no evidence touching the matter at issue will be *considered* upon the day of hearing which shall not have been taken and filed in compliance with these rules: *Provided*, Notice of the objection has been given, as hereinafter prescribed (see Rule 118): *Provided also*, That if either party shall be unable, for good and sufficient reasons, to procure the testimony of a witness or witnesses within the stipulated time, it shall be the duty of said party to give notice of the same to the Commissioner of Patents, accompanied by statements, *under oath*, of the cause of such inability, and of the names of such witnesses and of the facts expected to be proved by them, and of the *steps* which have been taken to procure said testimony, and of *the time* or *times* when efforts have been made to procure it; which last-mentioned notice to the Commissioner shall be received by him previous to the day of hearing aforesaid.

114. The notice for taking testimony must be served by delivering a copy to the adverse party or his agent or attorney of record or counsel, as provided in Rule 77, or by leaving a copy at the party's usual place of residence with some member of the family who has arrived at the years of discretion. The notice must be annexed to the deposition, with a certificate duly sworn to, stating the manner and time in which the service was made.

115. The testimony must (if either party desires it) be taken in answer to interrogatories, having the questions and answers committed in writing in their regular order by the magistrate, or,

under his direction, by some person not interested in the issue, nor an agent or attorney of one who is. The deposition, when complete, must be signed by the witness.

116. The magistrate must append to the deposition his certificate, stating the time and place at which it was taken, the names of the witnesses, the administration of the oath, at whose request the testimony was taken, the occasion upon which it is intended to be used, the names of the adverse party (if any), and whether they were present.

117. No notice will be taken at the hearing of any merely formal or technical objection, unless it shall appear to have wrought a substantial injury to the party raising the objection; and even then as soon as that party becomes aware of the objection, he must immediately give notice thereof to this office, and also to the opposite party, informing him at the same time that, unless corrected, he shall urge his objection at the hearing.

118. In contested cases, whether of interference or of extension, parties may have access to the testimony on file prior to the hearing, in presence of the officer in charge; and copies may be obtained by them at the usual rates.

RULES OF CORRESPONDENCE

119. All correspondence must be in the names of the "Commissioner of Patents," and all letters and other communications intended for the office must be addressed to him. If addressed to the Acting or Assistant Commissioner, chief clerk, examiners, or any of the other officers, they will not be noticed, unless it should be seen that the mistake was owing to inadvertence. A *separate letter should in every case be written in relation to each distinct subject of inquiry or application*, the subject of the invention and the date of filing being always carefully noted.

120. When an agent has filed his power of attorney, duly executed, the correspondence will, in ordinary cases, be held with him only. A double correspondence with him and his principal, if generally allowed, would largely increase the labor of the office. For the same reason the assignee of an entire interest in an invention is entitled to hold correspondence with the office to the exclusion of the inventor. If the principal becomes dissatisfied, he must revoke his power of attorney and notify the office, which will then communicate with him.

121. All communications to and from the Commissioner upon official business are carried in the mail free of postage.

122. After a second rejection none of the papers can be inspected, save in the presence of a sworn officer; nor will any of the papers be returned to the applicant or agent.

123. Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney, the examiner in charge will notify each of said principal parties of this fact, and also the attorney.

124. Aside from the caveats, which are required by law to be kept secret, all pending applications are, as far as practicable, preserved in like secrecy. No information will therefore be given those inquiring whether any particular case is before the office, or whether any particular person has applied for a patent.

125. But information is given in relation to any case after a patent has issued, or after a patent has been refused, and the

further prosecution of the application is abandoned or barred by lapse of time.

126. The models, in such cases, are so placed as to be subject to general inspection. The specifications and drawings in any particular case can be seen by any one having particular occasion to examine them, and copies thereof, as well as of patents granted, will be furnished at the cost of making them. Copies will be made on parchment, at the request of the applicant, on his paying the additional cost.

127. Even after a case is rejected the application is regarded as pending, unless the applicant allows the matter to rest for two years without taking any further steps therein, in which case it will be regarded as abandoned, and will no longer be protected by any rule of secrecy. The specification, drawings, and model will then be subject to inspection in the same manner as those of patented or withdrawn applications.

128. Information in relation to pending cases is given so far as it becomes necessary in conducting the business of the office, but no further. Thus, when an interference is declared between two pending applications, each of the contestants is entitled to a knowledge of so much of his antagonist's case as to enable him to conduct his own understandingly.

129. The office cannot respond to inquiries as to the novelty of an alleged invention in advance of an application for a patent, nor upon inquiries founded upon brief and imperfect descriptions, propounded with a view of ascertaining whether such alleged improvements have been patented, and, if so, to whom; nor can it act as an expounder of the patent law, nor as counsellor for individuals, except as to questions arising within the office. A copy of the rules, with this section marked, sent to the individual making an inquiry of the character referred to, is intended as a respectful answer by the office.

130. All business with the office should be transacted in writing. Unless by the consent of all parties, the action of the office will be predicated exclusively on the written record. No attention will be paid to any alleged verbal promise or understanding in relation to which there is any disagreement or doubt.

ATTORNEYS

131. Any person of intelligence and good moral character may appear as the attorney in fact or agent of an applicant, upon filing proper power of attorney. As the value of patents depends largely upon the careful preparation of the specification and claims, the assistance of competent counsel will, in most cases, be of advantage to the applicant, but the value of their services will be proportioned to their skill and honesty. So many persons have entered this profession of late years without experience, that too much cannot be exercised in the selection of a competent man. The office cannot assume responsibility for the acts of attorneys, nor can it assist applicants in making a selection. It will, however, be a safe rule to distrust those who boast of the possession of special and peculiar facilities in the office for procuring patents in a shorter time or with more extended claims than others.

132. Powers of attorney must contain a clause of substitution, to authorize the attorney to substitute for, or associate with, him-

self a second agent; but such powers will not authorize the second agent to appoint a third.

133. A power of attorney must be filed in every case, both by original and associate attorneys, before such attorney will be allowed to inspect papers or take action of any kind; but a revenue stamp need be affixed to original powers only.

134. Attorneys will be expected to conduct their business with the office with decorum and courtesy. For gross misconduct, the Commissioner may refuse to recognize any person as a patent agent, either generally or in any particular case; and for lesser offenses attorneys may be refused the privilege of oral interviews, and be required to transact all business with the office in writing.

135. As members of Congress cannot examine cases, or act without regular powers of attorney, as cases cannot be taken up out of their regular order upon their request, and as the delay in transmitting papers to and from the Capitol involves a loss of time, which would be avoided by communicating directly with the office, applicants are recommended not to add to the sufficiently arduous duties of their representatives by ordering copies or attempting to transact business with the office through them.

LIBRARY

136. No persons are allowed to take books from the library except those employed in the office.

All books taken from the library must be entered in a register kept for the especial purpose, and returned on the call of the librarian.

Any book lost or defaced must be replaced by another.

Patentees and others doing business with the office can examine the books only in the library hall.

All translations will be made at the usual rates by the office.

No persons will be allowed to make copies or tracings from works in the library. Such copies will be furnished at the usual rates.

SAMUEL S. FISHER,
Commissioner.

APPROVED:
J. D. COX,
Secretary of the Interior.

APPENDIX D

RULES OF PRACTICE IN THE UNITED STATES PATENT OFFICE REVISED DECEMBER 1, 1879.

The following regulations, designed to be in strict accordance with the revised statutes relating to the grant of patents for inventions, are published for gratuitous distribution. Marginal references to corresponding provisions of the revised statutes, and of the rules of 1878, are given for the convenience of the public and of the office.

The observance of the appended forms, in all cases to which they may be applicable, is recommended to inventors and attorneys.

Printed copies of the revised statutes relating to the grant of patents may be obtained on application to the Commissioner.

CORRESPONDENCE

1. All business with the office should be transacted in writing. Unless by the consent of all parties, the action of the office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding, in relation to which there is disagreement or doubt.

2. All office letters must be sent in the name of the "Commissioner of Patents." All letters and other communications intended for the office must be addressed to him; if addressed to any of the other officers they will ordinarily be returned.

3. Express charges, freight, postage, and all other charges on matfer sent to the patent office must be prepaid in full; otherwise it will not be received.

4. The personal attendance of applicants at the patent office is unnecessary. Their business can be transacted by correspondence.

5. The assignee of the entire interest of an invention is entitled to hold correspondence with the office to the exclusion of the inventor.

6. Where there has been an assignment of an undivided part of an invention, the inventor and the assignee will both be recognized as the proper parties to hold correspondence with the office, and all amendments and other actions in such cases must be signed by both parties; but official letters will be sent in such case to the post-office address of the inventor, unless he shall otherwise direct.

7. When an attorney shall have filed his power of attorney, duly executed, the correspondence will be held with him.

8. A double correspondence with the inventor and an assignee, or with a principal and his attorney, or with two attorneys, cannot generally be allowed.

9. A separate letter should in every case be written in relation to each distinct subject of inquiry or application. Assignments for record, final fees and orders for copies or abstracts must be sent to the office in separate letters.

10. When a letter concerns an application, it should state the name of the applicant, the title of the invention, the serial number of the application (see Rule 31), and the date of filing the same.

11. When the letters concerns a patent, it should state the name of the patentee, the title of the invention, and the number and date of the patent.

12. No attention will be paid to *ex parte* statements or protests of persons concerning pending applications to which they are not parties, unless information of the pendency of such applications shall have been voluntarily communicated by the applicants.

13. Letters received at the office will be answered, and orders for printed copies filled, without unnecessary delay. Telegrams, if not received before 3 o'clock p. m., cannot ordinarily be answered until the following day.

INFORMATION TO CORRESPONDENTS

14. The office cannot respond to inquiries as to the novelty of an alleged invention in advance of an application for a patent, nor to inquiries propounded with a view of ascertaining whether any alleged improvements have been patented, and, if so, to whom; nor can it act as an expounder of the patent law, or as counselor for individuals, except as to questions arising within the office.

Of the propriety of making an application for a patent, the inventor must judge for himself. The office is open to him, and its records and models pertaining to all patents granted may be inspected either by himself or by any attorney or expert he may call to his aid, and its reports are widely distributed. (See Rule 216.) Further than this the office can render him no assistance until his case comes regularly before it in the manner prescribed by law. A copy of the rules, with this section marked, sent to the individual making an inquiry of the character referred to, is intended as a respectful answer by the office. Examiners' digests are not open to public inspection.

15. Caveats and pending applications are preserved in secrecy. No information will be given, without authority, respecting the filing by any particular person of a caveat or of an application for a patent or for the reissue of a patent, the pendency of any particular case before the office, the subject-matter of any particular application, unless it shall be necessary to the proper conduct of business before the office, as provided by Rules 95, 102, and 126.

16. After a patent has issued the model, specification, drawings, and all documents relating to the case are subject to general inspection, and copies, except of the model, will be furnished at the rates specified in Rule 209.

ATTORNEYS

17. Any person of intelligence and good moral character may appear as the agent or the attorney in fact of an applicant, upon filing a proper power of attorney. As the value of patents depends largely upon the careful preparation of the specifications and claims, the assistance of competent counsel will, in most cases, be

of advantage to the applicant; but the value of their services will be proportionate to their skill and honesty, and too much care cannot be exercised in their selection. The office cannot assume responsibility for the acts of attorneys, nor can it assist applicants in making selections. It will, however, be unsafe to trust those who pretend to the possession of any facilities except capacity and diligence for procuring patents in a shorter time or with broader claims than others.

18. Before any attorney, original or associate, will be allowed to inspect papers or take action of any kind his power of attorney must be filed. No power of attorney purporting to have been given to a firm or copartnership will be recognized, either in favor of the firm or of any of its members, unless all its members shall be named in such power of attorney.

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

20. If the principal become dissatisfied he may revoke his power of attorney and notify the office, which will then communicate directly with him, or with such other attorney as he may lawfully appoint. Attorneys will be promptly notified by the examiners in charge of the revocation of their powers of attorney.

21. Parties or their attorneys will be permitted to examine their cases in the attorneys' room, but not in the rooms of the examiners. Personal interviews with examiners will be permitted only as hereinafter provided. (See Rules 147, 148.)

22. Attorneys will be required to conduct their business with the office with decorum and courtesy. Papers presented in violation of this requirement will ordinarily be returned. Complaints against examiners and other officers must be made in separate communications and will be promptly investigated. For gross misconduct the commissioner may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons for such refusal will be duly recorded and be subject to the approval of the secretary of the interior.

23. Inasmuch as applications cannot be examined out of their regular order, except in accordance with the provisions of Rule 62, and members of congress can neither examine nor act in patent cases without written powers of attorney, applicants are advised not to impose upon senators or representatives labor which will consume their time without any advantageous results.

APPLICANTS

24. A patent may be obtained by any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, not known nor used by others in this country, and not patented nor described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned; and by any person who, by his own industry, genius, efforts, and expense, has invented and produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, pattern,

print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known nor used by others before his invention or production thereof, nor patented nor described in any printed publication, upon payment of the fees required by law and other due proceedings had.

25. In case of the death of the inventor, the application may be made by, and the patent will issue to, his executor or administrator. In such case the oath will be made by the executor or administrator.

26. In case of an assignment of the whole interest in the invention, or of the whole interest in the patent to be granted, the patent will, upon request of the applicant or assignee, issue to the assignee; and if the assignee hold an undivided part interest, the patent will, upon like request, issue jointly to the inventor and the assignee; but the assignment in either case must first have been entered of record, and at a day not later than the date of the payment of the final fee. The application and oath must be made by the actual inventor, if alive, even if the patent is to issue to an assignee. If the inventor be dead it may be made by the executor or administrator, or by the assignee of the entire interest.

27. If it appear that the inventor, at the time of taking his application, believed himself to be the first inventor or discoverer, a patent will not be refused on account of the invention or discovery, or any part thereof, having been known or used in any foreign country before his invention or discovery thereof, if it had not been before patented or described in any printed publication.

28. Joint inventors are entitled to a joint patent; neither can claim one separately. Independent inventors of distinct and independent improvements in the same machine cannot obtain a joint patent for their separate inventions; nor does the fact that one furnishes the capital and another makes the invention entitle them to make application as joint inventors; but in such case they may become joint patentees, upon the conditions prescribed in Rule 26.

29. The receipt of letters patent from a foreign government will not prevent the inventor from obtaining a patent in the United States unless the invention shall have been introduced into public use in the United States more than two years prior to the application. But every patent granted for an invention which has been previously patented by the same inventor in a foreign country will be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest unexpired term; but in no case will it be in force more than seventeen years.

THE APPLICATION

30. Applications for letters patent of the United States must be made to the commissioner of patents. A complete application comprises the petition, specification, oath, drawings, model, or specimen, when required (See Rules 28, 48, 55, 57, 61), and first fee of $15.00. The petition, specification, and oath must be written in the English language.

31. No application for a patent will be placed upon the files for examination until it is completed. Every application signed or

sworn to in blank, or without actual inspection of the petition and specification, or altered or partly filled up after being signed or sworn to, will, upon the discovery of such irregularity, at any time before the delivery of the patent, be stricken from the files. The completed applications of each year will be numbered in regular order, the annual series commencing on the 1st of January, 1880. The applicant will be promptly informed of the serial number of his completed application. The application must be completed and prepared for examination within two years after the filing of the petition; and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action thereon, of which notice shall have been duly mailed to him or his agent, it will be regarded as abandoned, unless it shall be shown, to the satisfaction of the commissioner, that such delay was unavoidable. (See Rules 165-167.)

32. It is desirable that all parts of the complete application should be deposited in the office at the same time, and that all the papers embraced in the application should be attached together; otherwise a letter must accompany each part, accurately and clearly connecting it with the other parts of the application. (See Rule 10.)

THE PETITION

33. The petition is a communication duly signed by the applicant and addressed to the commissioner of patents, stating the name and residence of the petitioner, and requesting the grant of a patent for the invention therein designated by name, with a reference to the specification for a full disclosure thereof.

SPECIFICATION

34. The specification is a written description of the invention or discovery, and of the manner and process of making, constructing, compounding, and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same. It must conclude with a specific and distinct claim or claims of the part, improvement, or combination which the applicant regards as his invention or discovery.

35. The following order of arrangement should be observed *when convenient in framing the specification, such portions* as refer to drawings being omitted when the invention does not admit of representation by drawings:

(1.) Preamble giving the name and residence of the applicant, the title of the invention, and the statement required by the last clause of Rule 39;

(2.) General statement of the object and nature of the invention;

(3.) Brief description of the drawings, showing what each view represents;

(4.) Detailed description, explaining fully the alleged invention, and the manner of constructing, practicing, operating, and using it;

(5.) Claim or claims;

(6.) Signature of inventor;

(7.) Signatures of two witnesses.

36. The detailed description above referred to must set forth

the precise invention for which a patent is claimed, explaining the principle thereof and the best mode in which the applicant has contemplated applying that principle, so as to distinguish it from other inventions.

37. Where there are drawings the description will refer by figures to the different views and by letters or figures to the different parts.

38. In applications for patents upon mere improvements, the specification must particularly point out the parts to which the improvement relates, and must by explicit language distinguish between what is old and what is claimed as the improvement; and in such cases the description and the drawings, as well as the claims, should be confined to the specific improvements and such parts as necessarily cooperate with them.

39. Every applicant must distinctly state, under oath, whether the invention has been patented to himself or to others with his consent or knowledge in a foreign country, and, if it has been, that, according to his knowledge and belief, the same has not been in public use in the United States for more than two years prior to the application in this country; and he must also name such foreign country and set forth the number and date of the patent.

40. Two or more independent inventions cannot be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result, they may be claimed in one application.

41. If several inventions, claimed in a single application, shall be found to be of such a nature that a single patent may not be issued to cover them, the inventor will be required to limit the description and claim of the pending application to whichever invention he may elect: the other inventions may be made the subjects of separate applications, which must conform to the rules applicable to original applications. If the independence of the inventions be clear, such limitation will be made before any action upon the merits; otherwise it may be made at any time before final action thereon, in the discretion of the examiner.

42. When an applicant makes two or more applications relating to the same subject-matter of invention, all showing, but only one claiming, the same thing, those not claiming it must contain disclaimers thereof, with references to the applications claiming it.

43. The specification must be signed by the inventor or by his executor or administrator, and the signature must be attested by two witnesses. Full names must be given, and all names, whether of applicants or witnesses, must be legibly written.

44. The specification and claims and all amendments must be written in a fair, legible hand, on but one side of the paper; otherwise the office may require them to be printed; and all interlineations and erasures must be clearly marked in marginal or foot-notes written on the same sheet of paper. Legal-cap paper with the lines numbered is deemed preferable, and a wide margin must always be reserved upon the left-hand side of the page, both of the specification and of the amendments.

45. The applicant, if the inventor, must make oath or affirmation that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent, and that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen,

and where he resides.* An applicant for a reissue must also, in his oath, state that he verily believes the original patent to be inoperative or invalid, 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 that the error arose by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention.

46. If the application be made by an executor or administrator, the form of the oath will be correspondingly changed. The oath or affirmation may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, charge d' affaires, counsul, or commercial agent holding commission under the government of the United States, or before any notary public of the foreign country in which the applicant may be, the oath being attested in all cases, in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made.

47. In case the applicant seeks by amendment to introduce any claim not substantially embraced in the statement of invention or claim originally presented and therefore not covered by the original oath, he will be required to file a supplemental oath to the effect that the subject-matter of the proposed amendment was part of his invention and was invented before he filed his original application; and such supplemental oath must be upon the same paper which contains the proposed amendment.

THE DRAWINGS

48. The applicant for a patent is required by law to furnish a drawing of his invention where the nature of the case admits of it.

49. The drawing must be signed by the inventor or by his attorney in fact, and attested by two witnesses, and must show every feature of the invention covered by the claims, and when the invention consists of an improvement on an old machine, it must exhibit, in one or more views, the invention 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 invention therewith.

50. Three several editions of patent-drawings are printed and published: one for office use, certified copies, etc., of the size and character of those attached to patents, the work being about 6 by 9½ inches; one reduced to half that scale, or one-fourth the surface, of which four will be printed on a page to illustrate the volumes distributed to the courts; and one reduction—to about the same scale—of a selected portion of each drawing to illustrate the Official Gazette.

This work will all be done by the photo-lithographic or other analogous process, and therefore the character of each original drawing must be brought as nearly as possible to a uniform standard of excellence, suited to the requirements of the process, and calculated to give the best results, in the interests of inventors, of the office, and of the public, generally. The following rules will

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*For *additional sworn statements which may be embraced in* this oath or in a separate oath see Rule 39.

therefore be rigidly enforced, and any departure from them will be certain to cause delay in the examination of an application for letters patent:

(1.) Drawings must be made upon paper stiff enough to stand in the portfolios. The surface of the paper must be calendered and smooth. Indian ink of good quality, to the exclusion of all other kinds of ink or color, must be employed, to secure perfectly black and solid work.

(2.) The size of a sheet on which a drawing is made must be exactly 10 by 15 inches. One inch from its edges a single marginal line is to be drawn, leaving the "sight" precisely 8 by 13 inches. Within this margin all work and signatures must be included. One of the shorter sides of the sheet is regarded as its top, and, measuring downward from the marginal line, a space of not less than 1¼ inches is to be left blank for the heading of title, name, number, and date.

(3.) All drawings must be made with the pen only. Every line and letter (signatures included) must be absolutely black. This direction applies to all lines, however fine, to shading, and to lines representing cut surfaces in sectional views. All lines must be clean, sharp, and solid, and they must not be too fine or crowded. Surface shading, when used, should be open. Sectional shading should be made by oblique parallel lines, which may be about one-twentieth of an inch apart.

(4.) Drawings should be made with the fewest lines possible consistent with clearness. By the observance of this rule the effectiveness of the work after reduction will be much increased. Shading (except on sectional views) should be used only on convex and concave surfaces, where it should be used sparingly, and may even there be dispensed with if the drawing is otherwise well executed. The plane upon which a sectional view is taken should be indicated on the general view by a broken or dotted line. Heavy lines on the shade sides of objects should be used, except where they tend to thicken the work and obscure letters of reference. The light is always supposed to come from the upper left-hand corner, at an angle of forty-five degrees. Imitations of wood or surface-graining should not be attempted.

(5.) The scale to which a drawing is made ought to be large enough to show the mechanism without crowding, and two or more sheets should be used if one does not give sufficient room to accomplish this end; but the number of sheets must never be increased unless it is absolutely necessary.

(6.) Letters and figures of reference must be carefully formed. They should, if possible, measure at least one-eighth of an inch in height, so that they may bear reduction to one-twenty-fourth of an inch; and they may be much larger when there is sufficient room. They must be so placed in the close and complex parts of drawings as not to interfere with a thorough comprehension of the same, and therefore should rarely cross or mingle with the lines. When necessarily grouped around a certain part, they should be placed at a little distance, where there is available space, and connected by short broken lines with the parts to which they refer. They must never appear upon shaded surfaces, and, when it is difficult to avoid this, a blank space must be left in the shading where the letter occurs, so that it shall appear perfectly distinct and separate from the work. If the same part of an invention appear in more than one view of the drawing it must always be represented

by the same character, and the same character must never be used to designate different parts.

(7.) The signature of the inventor is to be placed at the lower right-hand corner of the sheet, and the signatures of the witnesses at the lower left-hand corner, all within the marginal line. The title is to be written with pencil on the back of the sheet. The permanent names and title will be supplied subsequently by the office in uniform style.

When views are longer than the width of the sheet, the sheet is to be turned on its side, and the heading will be placed at the right, and the signatures at the left, occupying the same place and position as in the upright views, and being horizontal when the sheet is held in an upright position; and all views on the same sheet must stand in the same direction.

(8.) As a rule, one view only of each invention can be shown in the Gazette illustrations. The selection of that portion of a drawing best calculated to explain the nature of the specific improvement would be facilitated, and the final result improved, by the judicious execution of a figure with express reference to the Gazette, but which might, at the same time, serve as one of the figures referred to in the specification. For this purpose, the figure may be a plan, elevation, section or perspective view, according to the judgment of the draftsman. It must not cover a space exceeding sixteen square inches. All its parts should be especially open and distinct, with very little or no shading, and it must illustrate the invention claimed only, to the exclusion of all other details. When well executed, it will be used without curtailment or change; but any excessive fineness, or crowding, or unnecessary elaborateness of detail, will necessitate its exclusion from the Gazette.

(9.) Drawings should be rolled for transmission to the office, not folded. No agent's or attorney's stamp, or advertisement, or written address, will be permitted upon the face of a drawing within or without the marginal line.

51. These rules are modified as to drawings for designs. (See Rules for Designs, 81, 82.)

52. All reissue applications must be accompanied by new drawings, of the character required in original applications, and the inventor's name must appear upon the same in all cases of patents granted or assigned since July, 1870; and such drawings, if the original application was filed after July 8, 1870, shall be made upon the same scale as the original drawing or upon a larger scale, unless a reduction of scale shall be authorized by the commissioner.

53. The foregoing rules relating to drawings will be rigidly enforced; and every drawing not artistically executed in conformity therewith will be returned to the applicant; or, at the applicant's option and cost, the office will make the necessary corrections.

54. Applicants are advised to employ competent artists to make their drawings. The office will furnish the drawings, at cost, as promptly as its draftsmen can make them, for applicants who cannot otherwise conveniently procure them. No employes of the patent office, except those regularly assigned to such duty, will make any drawings, whether copies or originals, for applicants, agents, or attorneys.

THE MODEL

55. In all cases which admit of representation by model the applicant, if required, shall furnish a model to exhibit advantageously the several parts of his invention or discovery.

56. The model must clearly exhibit every feature of the machine which forms the subject of a claim of invention, but should not include other matter than that covered by the actual invention or improvement, unless it is necessary to the exhibition of the invention in a working model.

57. The model must be neatly and substantially made, of durable material, metal being deemed preferable; but when a material forms an essential feature of the invention, the model will be constructed of that material. The model must not be more than one foot in length, width, or height, except in cases in which the commissioner shall admit working models of complicated machines of larger dimensions. If made of wood, it must be painted, or varnished. Glue must not be used; but the parts should be so connected as to resist the action of heat or moisture. Where practicable, to prevent loss, the model or specimen should have the name of the inventor permanently fixed thereon. In cases where models are not made strong and substantial, as here directed, the application will not be examined until a proper model is furnished.

58. A working model is often desirable, in order to enable the office fully and readily to understand the precise operation of the machine.

59. In all cases where an application has been rejected more than two years the model, unless it is deemed necessary that it should be preserved in the office, may be returned to the applicant upon demand, and at his expense; and the model, in any pending case of less than two years' standing, may be returned to the applicant upon the filing of a formal abandonment of the application, signed by the applicant in person. (See Rule 165.) Models belonging to patented cases will not be taken from the office except in the custody of some sworn employe of the office specially authorized by the commissioner, with the written approval of the secretary of the interior.

60. Models filed as exhibits, in contested cases, may be returned to the applicant. If not claimed within a reasonable time they may be disposed of, at the discretion of the commissioner.

SPECIMENS

61. When the invention or discovery is a composition of matter the applicant, if required by the commissioner, shall furnish specimens of the composition, and of its ingredients, sufficient in quantity for the purpose of experiment. 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.

THE EXAMINATION

62. All cases in the patent office are classified and taken up for examination in regular order, those in the same class being examined and disposed of, as far as practicable, in the order in which the respective applications are completed. When, however, the

invention is deemed of peculiar importance to some branch of the public service, and when, for that reason, the head of some department of the Government specially requests immediate action, the case will be taken up out of its order. These, with cases remanded by an appellate tribunal for further action, statements of grounds of decisions by primary examiners provided for in Rules 130, and 140. applications for extensions, for reissue, for letters patent for inventions for which foreign patents have already been obtained, and for designs, have precedence over all others in the order enumerated. Action upon such cases in the order indicated will be promptly made by the examiner in charge, to the exclusion of all other business interfering therewith.*

63. The first step in the examination of an application will be to determine whether it is, in all respects, in proper form. If, however, the objections as to form are not vital, the examiner may proceed to the consideration of the application on its merits; but in such case he must if possible, in his first letter to the applicant, state all his objections, whether formal or otherwise, and until the formal objections are disposed of no further action will be taken upon its merits without the order of the commissioner.

REJECTIONS AND REFERENCES

64. Whenever, on examination, any claim of an application is rejected for any reason whatever, the applicant will be notified thereof, and the reason for such rejection will be fully and precisely stated, and such information and references will be given as may be useful in judging of the propriety of prosecuting his application or of altering his specification; and if, after receiving such notice, he shall persist in his claim, with or without altering his specification, the case will be reexamined. If upon reexamination it shall be again rejected, the reasons therefor will be fully and precisely stated. (See Rule 89.)

65. Upon the rejection of an application for want of novelty, the examiner must cite the best references at his command. If patents be cited, their dates and numbers, the names of the patentees, and the classes of invention must be stated. When the reference shows or describes inventions other than that claimed by the applicant, the particular part relied on will be designated as nearly as practicable. The pertinence of the reference, if not obvious, must be clearly explained and the anticipated claim specified. If printed publications be cited, the title, date, page, or plate, and place of publication, or place where a copy can be found, will be given. Where reference is made to facts within the personal knowledge of an employe of the office, the data will be as specific as possible, and the reference must be supported by the affidavit of such employe, which shall be subject to contradiction, explanation, and coroboration by the affidavits of the applicant and other persons. If the patent or other printed matter, plates, or drawings, so referred to, are in the possession of the office, copies will be furnished at cost upon the order of the applicant. (See Rule 171.)

66. Whenever, in the treatment of an *ex parte* application, an adverse decision is made upon any preliminary or intermediate ques-

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*Note.—If an application is found to contain patentable subject-matter interfering with a caveat, its allowance will be suspended, as hereinafter provided in Rule 196.

tion, without the rejection of any claim, notice thereof, together with the reasons therefor, will be given to the applicant, in order that he may judge of the propriety of the action. If, after receiving such notice, he traverse the propriety of the action, the matter will be reconsidered.

AMENDMENTS AND ACTIONS BY APPLICANTS

67. The applicant has a right to amend before or after the first rejection; and he may amend as often as the examiner presents any new references or reasons for rejection. In so amending the applicant must clearly point out all of the patentable novelty which he thinks the case presents, in view of the state of the art disclosed by the references cited or objections made. He must also show how the amendments avoid such references or objections. After such action on all the claims as shall entitle the applicant to an appeal to the board of examiners-in-chief amendment will not ordinarily be allowed. If such amendments are offered good and sufficient cause therefor must be shown, together with the reasons why they were not earlier presented; and, if satisfied on these points, the examiner may admit and consider them. If the examiner shall refuse to admit and consider such amendments an appeal will lie to the commissioner, as in other cases.

68. In order to be entitled to the reconsideration provided for in Rule 66, the applicant must make request therefor in writing, and he must distinctly and specifically point out the supposed errors of the examiner's action. The mere allegation that the examiner has erred will not be received as a proper reason for such reconsideration. This provision does not apply to the case of a dement for reexamination upon the rejection of a claim under Rule 64.

69. In original applications, which are capable of illustration by drawing or model, all amendments of the model, drawings, or specification or of additions thereto must conform to at least one of them as they were at the time of the filing of the application. Matter not found in either involving a departure from the original invention can be shown or claimed only in a separate application. If the invention does not admit of illustration by drawing or model, amendment of the specification is permitted upon proof satisfactory to the commissioner that the matter covered by the proposed amendment was a part of the original invention: the affidavits prescribed in Rule 47 may or may not be sufficient.

70. The specification must be amended and revised, when required, for the purpose of correcting inaccuracies of description or unnecessary prolixity, and of securing correspondence between the claim and the other parts of the specification.

71. After the completion of the application the office will not return the specification for any purpose whatever. The model or drawing (but not both at the same time) may be withdrawn for correction. If applicants have not preserved copies of such papers as they wish to amend, the office will furnish them on the usual terms.

72. All amendments of specification or claims must be made on sheets of paper separate from the original. Even when the amendment consists in striking out a portion of the specification or of the claims the same course must be observed. Erasures must not be made by the applicant. In every case of amendment the exact

word or words to be stricken out or inserted must be clearly specified, and the precise point indicated where the erasure or insertion is to be made.

73. When an amendatory clause is amended it must be wholly rewritten, so that no interlineation or erasure shall appear in the clause, as finally amended when the case is passed to issue. If the number or nature of the amendments shall render it otherwise difficult to consider the case, or to arrange the papers for printing, or copying, the examiner or commissioner may require the entire specification to be rewritten.

74. When an original or reissue application is rejected on reference to an expired or unexpired domestic patent, which substantially shows or describes but does not claim the rejected invention, or to a foreign patent, or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention before the filing of the application for the domestic patent, or before the date of the foreign patent, or before the date at which the printed publication was made, and shall also make oath that he does not know and does not 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, then the patent or publication cited will not bar the grant of a patent to the applicant, except upon interference as provided in Rule 94.

75. When an application is rejected on reference to an expired or unexpired domestic patent which shows or describes, but does not claim, the rejected invention, or to a foreign patent, or to a printed publication, or to facts within the personal knowledge of an employe of the office, set forth in an affidavit of such employe, or on the ground of public use or sale, or upon a mode or capability of operation attributed to a reference, or because the alleged invention is held to be inoperative, or frivolous, or injurious to public health or morals, affidavits or depositions supporting or traversing these references or objections may be received: but they will be received in no other cases, without special permission of the commissioner.

76. If an applicant neglect to prosecute his application for two years after the date when the last official notice of any action by the office was mailed to him the application will be held to be abandoned, as set forth in Rule 165.

77. Applications in interference can be amended only as provided in Rules 104, 124, 125. After notice of allowance of an application for a patent, no amendments will be received, nor will the examiner have any jurisdiction over the application, unless by authority of the commissioner. Amendments not affecting the merits may be made after allowance and after payment of the final fee, on the recommendation of the primary examiner, approved by the commissioner, without withdrawing the application from issue. (See Rule 160.)

DESIGNS

78. A patent for a design may be granted to any person, whether citizen or alien, in the cases specified in Rule 24, upon payment of the duty required by law, and other due proceedings had, as in other cases of invention or discoveries.

79. Patents for designs are granted for the term of three and

one-half years, or for seven years, or for fourteen years, as the applicant may, in his application, elect.

80. The proceedings in application for patents for designs are substantially the same as in application for other patents. The specification must distinctly point out the characteristic features of the design, and carefully distinguish between what is old and what is believed to be new. The claims also, when the design admits of it, should be as distinct and specific as in the case of other patents. The following order of arrangement should be observed, when convenient, in framing the specification:

(1.) Preamble showing name and residence of the applicant, title of the design, and the name of the article for which the design has been invented.

(2.) Detailed description of the design as it appears in the drawing or photograph, letters or figures of reference being used.

(3.) Claim or claims.

(4.) Signature of inventor.

(5.) Signatures of two witnesses.

81. When the design can be sufficiently represented by drawings or photographs a model will not be required.

82. Whenever a photograph or an engraving is employed to illustrate the design it must be mounted upon Bristol-board, 10 by 15 inches in size, and properly signed and witnessed. The applicant will be required to furnish ten extra copies of such photograph or engraving (not mounted), of a size not exceeding 7½ inches by 11. Negatives are not required.

83. Whenever the design is represented by a drawing made to conform to the rules laid down for drawings of mechanical inventions but one copy need be furnished. Additional copies will be supplied by the photo-lithographic process at the expense of the patent office. (For Forms to be used in Application for Design Patents see Appendix, Forms 9 and 15.)

REISSUES

84. A reissue is granted to the original patentee, his legal representatives, or the assignees of the entire interest, when, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his invention or discovery more than he had a right to claim as new, the original patent is inoperative or invalid, provided the error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. In the cases of patents issued and assigned prior to July 8, 1870, the applications for reissue may be made by the assignees; but, in the cases of patents issued or assigned since that date, the applications must be made and the specification sworn to by the inventors, if they be living.

85. The petition for a reissue must be accompanied with a certified copy of the abstract of title, giving the names of all assignees owning any undivided interest in the patent; and in case the application is made by the inventor, it must be accompanied with the written assent of such assignees. If the reissue shall be granted the cost of the abstract of title will be refunded.

86. A reissue will not be granted until the existence of the conditions prescribed therefor by law shall have been duly shown. The affidavit of the applicant will be prima facie evidence as to inadvertence, accident, mistake, fraud, and deceptive intent, subject

to contradiction or confirmation by the records of the office, by the affidavits of employes of the office having personal knowledge of the facts, or by such other affidavits as the commissioner shall, without disclosing the pendency of the application, admit as evidence in the case.*

87. No new matter shall be introduced into the reissue specification, nor in case of a machine shall the model or drawings be amended except each by the other; but, when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake.

88. The commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for each division of such reissued letters patent. Each division of a reissue constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division; and the drawing may represent only such part or parts subject to the provisions of Rule 49. Unless it shall be otherwise ordered by the commissioner all the divisions of a reissue will issue simultaneously; if there be controversy as to one, the others will be withheld from issue until the controversy is ended unless he shall otherwise order.

89. In cases of applications for reissue, an original claim, if reproduced in the amended specification, is subject to reexamination, and the entire application will be revised and restricted in the same manner as original applications.

90. The application for a reissue must be accompanied by a surrender of the original patent, or, if that is lost, by an affidavit to that effect and a certified copy of the patent; but if a reissue be refused, the original patent will, upon request, be returned to the applicant.

91. Matter which is shown and described, and might have been lawfully claimed, in an unexpired patent, but was not claimed by reason of a defect or insufficiency in the specification, arising from inadvertence, accident, or mistake, and without fraud or deceptive intent, can not be subsequently claimed by the patentee in a separate patent, but only in a reissue of the original patent.

INTERFERENCES

92. An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention. The fact that one of the parties has already obtained a patent will not prevent an interference; for, although the commissioner has no power to cancel a patent, he may grant a patent for the same invention to another person who proves to be the prior inventor.

93. Interferences will be declared in the following cases, when all the parties claim substantially the same patentable invention:

(1.) Between two or more original applications.

(2.) Between an original application and an unexpired patent, when the applicant, having been rejected on the patent, shall file

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*Note.—As to drawings in reissue applications, see Rule 52.

an affidavit showing that he made the invention before the patentee's application was filed.

(3.) Between an original application and an application for the reissue of a patent granted during the pendency of such original application.

(4.) Between an original application and a reissue application when the original applicant shall file an affidavit showing that he made the invention before the patentee's original application was filed.

(5.) Between two or more applications for the reissue of patents granted on applications pending at the same time.

(6.) Between two or more applications for the reissue of patents granted on application not pending at the same time, when the applicant for reissue of the later patent shall file an affidavit showing that he made the invention before the application on which the earlier patent was granted was filed.

(7.) Between a reissue application and an unexpired patent, if the original applications were pending at the same time, and the reissue applicant shall file an affidavit showing that he made the invention before the original application of the other patentee was filed.

(8.) Between an application for reissue of a later unexpired patent and an earlier unexpired patent granted before the original application of the later patent was filed, if the reissue applicant shall file an affidavit showing that he made the invention before the original application of the earlier patent was filed.

94. The notices provided for in Rules 97 and 102 will be sent to all applicants having pending applications showing but not claiming the invention, and if such applicants shall, within the time fixed for filing the statements provided for in Rules 101 and 105, file such statements, together with amendments of their applications duly claiming the invention, they shall be made parties to the interference, but otherwise shall be excluded therefrom.

The notice provided for in Rules 97 and 102 will be sent to all grantees of unexpired patents showing, but not claiming, the invention, and if such patentees shall, within the time limited for filing the statements provided for in Rules 101 and 105, file such statements, together with reissue applications duly claiming the invention, they shall be made parties to the interference; but otherwise they shall be excluded therefrom without prejudice to their right of reissue. (See Rule 74.)

95. Before the declaration of interference all preliminary questions must be settled by the principal examiner, and the issue must be clearly defined; the invention which is to form the subject of the controversy must be decided to be patentable, and the claims of the respective parties must be put in such condition that they will not require alteration after the interference shall have been finally decided, unless the testimony adduced upon the trial shall necessitate or justify such change.

96. Where, however, a party who is required to put his case in a condition proper for an interference fails to do so within a reasonable time specified, the declaration of interference will not be delayed. After final judgment of priority the application of such party will be held for revision and restriction, subject to interference with other applications or new references. (See Rule 93.)

97. When an interference is found to exist and the applications

are prepared therefor, the principal examiner will forward to the examiner of interferences notices of interference for all the parties as specified in Rule 102, which will disclose the name and residence of each party, and that of his attorney, the date of the filing of his application, and, if his case be a patent, its date and number, the date of its application, the ordinals of conflicting claims, and the invention claimed, which shall be clearly and concisely defined, in so many counts or branches as may be necessary in order to include all interfering claims.

98. Upon receipt of the notices of interference, the examiner of interferences will make an examination thereof in order to ascertain whether the issue between the parties has been clearly defined, and whether it is otherwise correct. If he be of the opinion, upon such examination, that the notices are ambiguous in this particular, or are imperfect in any material point, he will transmit his objections to the principal examiner, who will promptly notify him of his decision to amend or not to amend them.

99. In case of a material disagreement between the examiner of interferences and the principal examiner, they shall refer the points of difference to the commissioner for decision.

100. The principal examiner will retain jurisdiction of the case until the declaration of interference is made.

101. When the notices of interference have been settled, the examiner of interferences will add thereto a designation of the time within which the statements required by Rule 105 must be filed, and will institute and declare the interference by forwarding the notices to the several parties to the interference.

102. Notice of interference will be forwarded, by the examiner of interferences, to all the parties, or to their attorneys, or, in case the application or patent in interference has been assigned, to the assignees. When one of the parties has received a patent, a notice will be sent to the patentee and to his attorney of record. When one of the parties resides abroad and has no known agent in the United States, notice, in addition to that sent by mail, may be given by publication in the Official Gazette for such period of time as the commissioner may direct. Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney, the examiner in charge will notify each of said principal parties, and also the attorney, of this fact.

103. Upon the institution and declaration of the interference, as provided in Rule 101, the examiner of interferences will take jurisdiction of the same, which will thereupon become a contested case; but the primary examiners will determine the motions mentioned in Rule 116, as therein provided.

104. An applicant involved in an interference may, before the date fixed for the filing of his statement (see Rule 105), in order to avoid the continuance of the interference, disclaim, over his own signature, attested by two witnesses, the invention of the particular matter in issue, and upon such disclaimer, and the cancellation of any claims involving such interfering matter, judgment shall be rendered against him, and the disclaimer shall be embodied in and form part of his specification. (See Rules 187, 188.)

105. Each party to the interference will be required to file a concise statement, under oath, showing the date of his original conception of the invention, of its illustration by drawing or model,

of its disclosure to others, of its completion, and of the extent of its use. The parties will be strictly held in their proof to the dates set up in their statements. The statement must be sealed up before filing (to be opened only by the examiner of interferences), and the name of the party filing it, the title of the case, and the subject of the invention indicated on the envelope. The statements shall not be open to the inspection of the opposing parties until both shall have been filed, or the time for filing both with any extension thereof shall have expired, nor then, unless they have been examined by the proper officer and found to be satisfactory.

106. If, on such examination, a statement is found to be defective in any particular, the party shall be notified of the defect, and a time assigned within which he must cure such defect by an amended statement; but in no case will any original or amended statement be returned after it has been once filed.

107. If either party to an interference fail to file a statement, or if the statement of either party fail to overcome the *prima facie* case made by the respective dates of application, the other may demand an immediate adjudication of the case upon the record. Where there are more than two parties to the interference, and any of them fail to file their statements, judgment may be rendered upon the record as to such parties, and the interference will proceed between the remaining parties.

108. If any party to an interference fail to file a statement, no testimony will subsequently be received from him to prove that he made the invention at a date prior to his application. The statement can in no case be used as evidence in behalf of the party making it.

109. If either party require a postponement of the time for filing the statements, he will present his motion duly served on the other parties, with his reasons therefor, supported by affidavit, prior to the day previously fixed upon. But the examiner of interferences may, in his discretion, dispense with services of notice of such motion.

110. In case of material error in the statement, arising through inadvertence or mistake, it may be corrected on motion (see Rule 149), upon showing to the satisfaction of the commissioner that its correction is essential to the ends of justice. The motion to correct the statement must be made, if possible, before the taking of any testimony, and as soon as practicable after the discovery of the error.

111. In original proceedings in cases of interference the several parties will be presumed to have made the invention in the chronological order in which they filed so much of their respective applications for patents as clearly illustrates and describes the invention; and the burden of proof will rest upon those who shall seek to establish a different state of facts.

112. A time will be assigned in which the junior applicant shall complete his testimony in chief, and a further time in which the other party shall complete the testimony on his side, and a further time in which the junior applicant may take rebutting testimony, but shall take no other. If there be more than two parties, either patentees or applicants, the time for taking testimony will be so arranged that each shall have an opportunity to prove his case against prior applicants and to rebut their evidence, and also to meet the evidence of junior applicants.

113. If either party fail to take his testimony within the time assigned to him, all junior applicants having duly taken theirs, the case may, on motion duly made and served on such party, be set for hearing at any time not less than ten days after the hearing of the motion.

114. If either party desire to have the hearing postponed, he will make application for such postponement by motion (see Rule 149), and will show sufficient reason therefor by affidavit.

115. If either party desire an enlargement of the time assigned to him for taking testimony, he will make application therefor as provided for in Rule 150 (5).

116. Motions to dissolve an interference which deny the patentability of an applicant's claim, or his right to make the claim, will be submitted to the examiner of interferences before the day fixed for filing the statements provided for in Rules 97 and 102, and will be transmitted by him, with the files and papers, to the primary examiner, who will take jurisdiction of the case for the determination of such motions, and will return the files and papers to the examiner of interferences, with his decision, at the expiration of the time limited for appeal, if no appeal shall have been taken, or sooner if the party entitled to appeal shall file a waiver in writing of his right to appeal; and such decision will be binding on the examiner of interferences unless reversed or modified on appeal. From a decision of the primary examiner on such motion denying the patentability of a claim or the right of an applicant to make it an appeal may be taken ex parte to the examiners-in-chief; but from his decision affirming its patentability or the applicant's right no appeal can be taken.

117. Motions to dissolve an interference upon the ground that no interference in fact exists, or that there has been such irregularity in declaring the same as will preclude the proper determination of the question of priority between the parties, and all other lawful motions except those mentioned in Rule 116, will be made before the tribunal having jurisdiction at the time. Such motions should, if practicable, be made before the taking of testimony, and it must always appear that they are made in good faith, and immediately after the discovery of the grounds on which they are based. If grounds for such a motion are discovered at a time when it cannot be properly made, they may on due notice be urged at the hearing before, and will be disposed of by, the tribunal considering the case, as provided in Rule 120.

118. Appeal may be taken directly to the commissioner from decisions on all motions, except motions to dissolve interferences, denying the patentability of applicants' claims, or their right to make the claims, and other lawful motions involving the merits of the case, which, when appealable, may be appealed to the board of examiners-in-chief. (See Rule 116.)

119. After the interference is finally declared, it will not be determined without judgment of priority, founded upon the testimony, except as otherwise herein provided for.

120. In their decision of the question of priority, or before such decision, the examiner of interferences and the examiners-in-chief will direct the attention of the commissioner to any fact not relating to priority which may have been brought to their notice (by motion or otherwise), and which, in their opinion, amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference. The commissioner may, be-

fore judgment on the question of priority of invention, suspend the interference, and remand the case to the primary examiner for the consideration of the statutory bar so suggested, subject to appeal to the examiners-in-chief, as in other cases. If the case shall not be so remanded the primary examiner will, after judgment, consider and determine the same, unless it shall have been previously disposed of by the commissioner.

121. A second interference will not be declared upon a new application on the same invention filed by either party, nor will a decision be set aside after judgment, except in accordance with the principles governing the granting of new trials.

122. If at any time during the pendency of an interference the primary examiner discover new references, he may request a suspension of the interference for their consideration *ex parte* until their pertinency shall be determined, when the files and papers will be returned to the examiner of interferences and the interferences dissolved or reinstated in accordance with such determination.

123. The primary examiner may request a suspension of an interference for the purpose of adding new parties; but no new parties will be added after the taking of testimony without the special order of the commissioner.

124. No amendments to the specifications will be received during the pendency of an interference, except as provided in Rule 104.

125. When a part only of the claims of an application are involved in an interference, the applicant may withdraw from his application the claims adjudged not to interfere, and file a new application therefor, if the application can be legitimately divided, and if no more of the devices claimed in one is shown or described in the other than is necessary to an intelligent understanding of the invention claimed in the latter: *Provided*, That no claim shall be made in the second application broad enough to include matter claimed in the first application as amended. (See Rule 42.)

126. When applications are declared to be in interference, the interfering parties will be permitted to see or obtain copies of the interfering claims, and of so much of the specifications as relate thereto.

127. When it shall appear, on motion duly made, and upon satisfactory proof, that by reason of the inability or refusal of the inventor to prosecute or defend an interference, or from other cause, the ends of justice shall require that an assignee of an undivided interest in the invention be permitted to prosecute or defend the same, the commissioner may so order.

APPEALS.

128. Every applicant for a patent or the reissue of a patent, any of the claims of whose application have been twice rejected upon grounds involving the merits of the invention, such as lack of novelty or utility, abandonment, public use, or want of identity of invention either in amended or in reissue applications, may appeal from the decision of the primary examiner to the board of examiners-in-chief, having once paid a fee of ten dollars. The appeal must be made in writing, signed by the party, or his duly authorized agent or attorney, setting forth the points of the decision upon which the appeal is taken and duly filed.

129. There must be two rejections of the claims as originally

filed, or, if amended in matter of substance, of the amended claims, and all the claims must be passed upon, and all preliminary and intermediate questions relating to matters not affecting the merits of the invention settled, before the case is appealed to the examiners-in-chief.

130. Upon the filing of the appeal the same shall be submitted to the primary examiner, who, if he find the appeal to be regular in form, shall furnish the examiners-in-chief with a written statement of the grounds of his decision on all the points involved in the appeal, with copies of the rejected claims, and with the references applicable thereto. If the primary examiner shall decide that the appeal is not regular in form, an appeal from such decision may be taken directly to the commissioner as provided in Rule 140.

131. The appellant shall, before the day of hearing, file a brief of the authorities and arguments on which he will rely to maintain his appeal.

132. If the appellant desire to be heard orally before the examiners-in-chief, he will so indicate when he files his appeal: a day of hearing will then be fixed, and due notice of the same given him.

133. In contested cases the appellant shall have the right to make the opening and closing arguments unless it shall be otherwise ordered by the tribunal having jurisdiction of the case.

134. The examiners-in-chief in their decision will affirm or reverse the decision of the primary examiner only on the points on which appeal shall have been taken. (See Rule 128.) If they shall 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 will annex to their decision a statement to that effect, with such recommendation as they shall deem proper. If an appeal shall not be taken from their decision to the commissioner, the primary examiner will, at the expiration of the limit of appeal, resume jurisdiction of the case and proceed therewith in accordance with such decision.

From any judgment of the primary examiner, on points embraced in the recommendation annexed to the decision adverse to the appliant, appeal may be taken on question involving the merits to the board of examiners-in-chief and on other questions to the commissioners, as in other cases.

If an appeal shall be taken from the decision of the examiners-in-chief to the commissioner the commissioner, whenever, in his opinion, substantial justice shall require it, may, either before or after final judgment, remand the case to the primary examiner for consideration of any amendment or action based upon the recommendation annexed to the decision of the examiners-in-chief.

If the commissioner, in revising the decision of the examiners-in-chief, shall discover any apparent grounds for granting or refusing letters patent not involved in the appeal, he will, before or after final judgment, whenever, in his opinion, substantial justice shall require it, give reasonable notice thereof to the parties; and if any amendment or action based thereon shall be proposed, he will remand the case to the primary examiner for consideration.

From decisions of the primary examiner, in cases remanded, as herein provided, appeal will lie to the board of examiners-in-chief, or directly to the commissioner, as in other cases.

135. If affidavits be received, under Rule 75, after the case has been appealed, the application will be remanded to the primary examiner for reconsideration.

136. From the adverse decision of the board of examiners-in-chief appeal may be taken to the commissioner in person, upon payment of the fee of twenty dollars required by law.

137. Cases which have been heard and decided by the commissioner on appeal will not be reopened except by the commissioner; and cases which have been decided by the examiners-in-chief will not be reheard by them, when no longer pending before them, without the written authority of the commissioner.

138. Cases will be regarded as pending before a tribunal until appeal has been taken from its decision, or until the limit of appeal which must be fixed in each case has expired.

139. Cases which have been deliberately decided by one commissioner will not be reconsidered by his successor except in accordance with the principles which govern the granting of new trials.

140. Decisions of examiners upon preliminary or intermediate questions, not involving the merits of the case, once repeated, will be reexamined by the commissioner upon written statements of the points of appeal, and of the grounds of the examiners' decisions, as in other appeals. For appeals of this class no fee is required.

141. In cases of interference parties have the same remedy by appeal to the examiners-in-chief and to the commission as in *ex parte cases;* but no appeal lies in such cases from the decision of the commissioner.

142. Appeals in interference cases must be accompanied with brief statements of the reasons therefor; and both parties will be required to file briefs of their arguments before the day of hearing. Printed briefs are in all cases preferred.

143. From the adverse decision of the commissioner upon the claims of an application an appeal may be taken to the supreme court of the District of Columbia sitting *in banc.* On taking such appeal, the applicant is required, under the rules of the court, to pay to the clerk of the court a docket-fee of ten dollars, and he is also required by law to lay before the court certified copies of all the original papers and evidence in the case. The petition should be filed and the fee paid at least ten days before the commencement of the term of court at which the appeal is to be heard.

144. Immediately upon taking an appeal the appellant must give notice thereof to the commissioner of patents, and file in the patent office his reasons of appeal, specifically set forth in writing.

145. The docket for the trial of cases appealed from the decision of the commissioner of patents will be called on the first day of each session of the supreme court of the District of Columbia in general term. These sessions are held three in each year, and begin, respectively, on the first Monday in January, the third Monday in April, and the fourth Monday in September. (For Forms of Appeals and Rules of the Supreme Court of the District of Columbia respecting Appeals, see Appendix, Forms 29-36.)

HEARINGS AND INTERVIEWS

146. Hearings will be had by the commissioner at 10 o'clock a. m., and by the board of examiners-in-chief and the examiner of interferences at 1 o'clock p. m., on the day appointed, unless some other hour be specially designated. If either party in a contested case, or the appellant in an *ex parte* case, appear at the proper time, he will be heard by the examiner of interferences or

the examiners-in-chief; but a contested case will not be taken up for oral argument after the day of hearing, except by consent of both parties. If the engagements of the tribunal having jurisdiction of the case be such as to prevent it from being taken up on the day of hearing, a new assignment will be made, or the case will be continued from day to day until heard. Unless it shall be otherwise ordered before the hearing begins, oral arguments will be limited to one hour for each party. After a contested case has been argued, nothing further relating thereto will be heard unless upon request of the tribunal having jurisdiction of the case; and all interviews for this purpose with parties in interest or their attorneys will be invariably denied.

147. Interviews with examiners concerning applications and other matters pending before the office must be had at such times, within office hours, as the respective examiners may designate, in the examiners' rooms, with the principal examiners, or, in their absence, with the assistants in charge; they will not be had at any other time or place without the written authority of the commissioner.

148. Interviews for the discussion of pending applications will not be had prior to the first official action thereon.

MOTIONS

149. In contested cases reasonable notice of all motions, and copies of motion-papers and affidavits, must be served as provided for in Rule 150 (2). Proof of such service must be made before the motion will be entertained by the office; and motions will not be heard in the absence of either party except upon default after due notice. Motions will be heard in the first instance by the officer or tribunal before whom the particular case may be pending; but an appeal from the decision rendered may be taken on questions involving the merits of the case to the board of examiners-in-chief; on other questions, directly to the commissioner. In original hearings, on motions, the moving parties shall have the right to make the opening and closing arguments. In contested cases the practice on points to which the rules shall not be applicable will conform, as nearly as possible, to that of the United States courts in equity proceedings.

TAKING AND TRANSMITTING TESTIMONY

150. The following rules have been established for taking and transmitting testimony in extensions, interferences, and other contested cases:

(1.) Before the depositions of witnesses are taken by either party due notice shall be given to the opposite party, as hereinafter provided, of the time and place when and where the depositions will be taken, of the cause or matter in which they are to be used, and of the names and residences of the witnesses to be examined, so that the opposite party shall have full opportunity, either in person or by attorney, to cross-examine the witness. If the opposite party shall attend the examination of witnesses not named in the notice, and shall either cross-examine such witnesses or fail to object to their examination, he shall be deemed to have waived any objection to their examination based on want of notice thereof. Neither party shall take testimony in more than one place at the

same time, or so nearly at the same time as not to allow reasonable time to travel from one place of examination to the other.

(2.) *The notice for taking testimony or for motions must be* served (unless otherwise stipulated in an instrument in writing filed in the case) upon the attorney of record, if there be one, or, if there be no attorney of record, then upon the adverse party, and it must give the opposite party reasonable time to reach the place of examination. Such service may be made by delivering a copy of the notice to the adverse party or attorney, by leaving a copy at the usual place of business of the party or attorney with some one in the employment of such party or attorney, or by leaving a copy at the party's usual place of residence with a member of his family, or by transmission by registered letter, or by express, or when it shall be shown, to the satisfaction of the commissioner, that neither of the other modes of service herein prescribed is practicable, by publication in the Official Gazette; and such notice shall, with sworn proof of the fact, time, and mode of service thereof, be attached to the deposition or depositions, whether the opposing party shall have cross-examined or not.

(3.) Each witness before testifying shall be duly sworn according to law by the officer before whom his deposition shall be taken. The depositions shall be carefully read over by the witness, or by the officer in his hearing, and shall then be subscribed by the witness, in the presence of the officer. The officer shall annex to the deposition his certificate showing (1) the due administration of the oath by the officer to the witness before the commencement of his testimony; (2) the name of the person by whom the testimony was written out, and the fact that, if not written by the officer, it was written in his presence; (3) the presence or absence of the adverse party; (4) the place, day and hour of commencing and taking the depositions; and (5) the fact that the officer was not connected, by blood or marriage, with either of the parties, nor interested directly or indirectly in the matter in controversy. The officer shall sign the certificate and affix thereto his seal of office, if he have such seal. He shall then, without delay, securely seal up all the evidence, notices, and paper exhibits, inscribe upon the envelope a certificate, giving the title of the case, the name of each witness and the date of sealing, address the package, and forward the same to the commissioner of patents. If the weight or bulk of an exhibit shall exclude it from the envelope, it shall be authenticated by the officer and transmitted in a separate package, marked and addressed as above provided.

(4.) In cases of extension, where no opposition shall be made, *ex parte* testimony will be received from the applicant; and such testimony as may have been taken by the applicant prior to notice of opposition will be received, unless taken within thirty days after filing the petition for the extension. But upon receiving notice of opposition, the applicant shall immediately give notice to the opposing party or parties of the names and residences of the witnesses whose testimony shall have been thus taken.

(5.) If either party shall be unable to procure the testimony of a witness within the time limited, any motion which he may make for an extension of his time must be accompanied by a statement, under oath, of the cause of such inability, the name of such witness, the facts expected to be proved by him, the steps which have been taken to procure said testimony, and the dates at which efforts have been made to procure it. (See Rule 149.)

(6.) When a party relies upon a caveat to establish the date of his invention, the caveat itself, or a certified copy thereof, must be filed in evidence, with due notice to the opposite party.

(7.) Upon notice given to the opposite party before the closing of the testimony, any official record, and any special matter contained in a printed publication, if competent evidence and pertinent to the issue, may be used as evidence at the hearing.

151. The pages of each deposition must be numbered consecutively and the name of the witness plainly and conspicuously written at the top of each page. The testimony must be taken upon legal-cap or foolscap paper, with a wide margin on the left-hand side of the page, and with the writing on one side only of the sheet.

152. The testimony will be taken in answer to interrogatories, with the questions and answers committed to writing in their regular order by the officer, or, in his presence, by some person not interested in the case, either as a party thereto or as attorney. But, with the written consent of the parties, the depositions may be written out by other persons in the presence of the officer. No officer who is connected by blood or marriage with either of the parties, or interested, directly or indirectly, in the matter in controversy, either as counsel, attorney, agent, or otherwise, is competent to take depositions, unless with the written consent of all the parties.

153. By leave of the commissioner, first obtained, testimony may be taken in foreign countries:

(1.) Such permission will be granted only upon motion duly made. (See Rule 149.)

The motion must designate a place for the examination of the witnesses at which an officer duly qualified to take testimony under the laws of the United States in a foreign country shall reside, and it must be accompanied by a statement, under oath, that the motion is made in good faith, and not for purposes of delay or of vexing or harassing any party to the case; it must also set forth the names of the witnesses, the particular facts to which it is expected each will testify, and the grounds on which is based the belief that each will so testify.

(2.) It must appear that the testimony desired is material and competent, and that it cannot be taken in this country at all, or cannot be taken here without hardship and injury to the moving party greatly exceeding that to which the opposite party will be exposed by the taking of such testimony abroad.

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

(4.) As soon as the interrogatories and cross-interrogatories are decided to be in proper form, the commissioner will cause them to be forwarded to the proper officer, with the request that, upon payment of, or satisfactory security for, his official fees, he notify the witnesses named to appear before him within a designated time and make answer thereto under oath; and that he reduce their answers in writing, and transmit the same, under his official

seal and signature, to the commissioner of patents, with the certificate prescribed in Rule 150 (3).

(5.) By stipulation of the parties the requirements of paragraph (3) as to written interrogatories and cross-interrogatories may be dispensed with, and the testimony may be taken before the proper officer upon oral interrogatories by the parties or their agents.

(6.) Unless false swearing in the giving of such testimony before the officer taking it shall be punishable as perjury, under the laws of the foreign state where it shall be taken, it will not stand on the same footing, in the patent office, as testimony duly taken in the United States; but its weight in each case will be determined by the tribunal having jurisdiction of such case.

154. No evidence touching the matter at issue will be considered on the hearing which shall not have been taken and filed in compliance with these rules. But no notice will be taken of any merely formal or technical objection which shall not appear to have wrought a substantial injury to the party raising it: and in case of such injury it must be made to appear that, as soon as the party became aware of the ground of objection, he gave notice thereof to the office, and also to the opposite party, informing him at the same time that, unless it should be removed, he should urge his objection at the hearing.

This rule is not to be so construed as to modify established rules of evidence, which will be applied strictly in all practice before the office.

155. The law requires the clerks of the various courts of the United States to issue subpoenas to secure the attendance of witnesses whose depositions are desired as evidence in contested cases in the patent office.

156. After testimony is filed in the office it may be inspected by any party to the case, but it cannot be withdrawn for the purpose of printing. It may be printed by some one specially designated by the office for that purpose, under proper restrictions.

157. Six or more printed copies of the testimony must be furnished—five for the use of the office, and one for the use of each of the opposing parties. These copies must be filed not less than one week before the day of hearing. They will have wide margins, with the names of the witnesses at the top of the pages over their testimony, and will contain indexes with the names of all witnesses, and references to the pages where their testimony may be found, and also to the pages where copies of papers and documents introduced as exhibits are shown. Printing can only be dispensed with on special application based upon satisfactory reasons, in which case manuscript copies must be furnished—one for the office and one for each adverse party.

158. It is desirable that arguments and briefs in all contested cases should be submitted in printed form, and filed before the hearing. If either party fail to comply with this regulation no extension of time will be granted for the purpose, except upon consent of the adverse parties.

ISSUE

159. If on examination, it shall appear that the applicant is justly entitled to a patent under the law, a notice of allowance will be sent him, calling for the payment of the final fee, upon the

receipt of which, within the time fixed by law, the patent will be prepared for issue. (See Rules 212, 213.)

160. After notice of the allowance of an application is given the case will not be withdrawn from issue except by approval of the commissioner, and if withdrawn for further action on the part of the office, a new notice of allowance will be given. (See Rule 77.)

DATE, DURATION, AND FORM OF PATENTS

161. Every patent will bear date as of a day not later than six months from the time at which the application was passed and allowed and notice thereof was mailed to the applicant or his agent, if within that period the final fee be paid to the commissioner of patents, or if it be paid to the treasurer, or any of the assistant treasurers or designated depositaries of the United States and the certificate promptly forwarded to the commissioner of patents; and if the final fee be not paid within that period the patent will be withheld. (See Rule 169.)

A patent will not be antedated.

162. Every patent will contain a short title of the invention or discovery, indicating its nature and object, and a grant to the patentee, his heirs and assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery throughout the United States and the Territories thereof. But if the invention shall have been previously patented abroad, the term of the patent will expire with the term of the foreign patent. The duration of a design patent may be for the term of three and a half, seven, or fourteen years, as provided in Rule 79. A copy of the specification and drawings will be annexed to the patent and form part thereof.

DELIVERY

163. 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 the patentee, as the attorney may request; but it will not, without a special request to that effect, be delivered to an associate or substitute attorney.

CORRECTION OF ERRORS IN LETTERS PATENT

164. Where a mistake, incurred through the fault of the office, is clearly disclosed by the records or files of the office, a certificate, showing the fact and nature of such mistake, signed by the secretary of the interior, countersigned by the commissioner of patents, and sealed with the seal of the patent office, will, at the request of the patentee or his assignee, be indorsed without charge upon the letters patent, and recorded in the records of patents, and a printed copy thereof attached to each printed copy of the specification and drawings.

Where a mistake, incurred through the fault of the office, constitutes a sufficient legal ground for a reissue, such reissue will be made, for the correction of such mistake only, without charge of office fees, at the request of the patentee.

Mistakes not incurred through the fault of the office and not

affording legal grounds for reissues, will not be corrected after the delivery of the letters patent to the patentee or his agent.

No changes or corrections will be made in letters patent after the delivery thereof to the patentee or his agent, except as above provided.

ABANDONED, FORFEITED, AND RENEWED APPLICATIONS

165. An abandoned application is one which has not been completed and prepared for examination within two years after the filing of the petition, or which the applicant has failed to prosecute within two years after any action therein, of which notice has been duly given (see Rules 31 and 76), of which the applicant has expressly abandoned by filing, in the office, a written declaration of abandonment, signed by himself, identifying his application by title of invention and date of filing. (See Rule 59.)

Prosecution of an application, to save it from abandonment, must include such proper action as the condition of the case may require.

166. Before an application abandoned by failure to complete or prosecute can be renewed, it must be shown to the satisfaction of the commissioner that the delay in the prosecution of the same was unavoidable.

167. When a new application is filed in place of an abandoned or rejected application, a new specification, oath, drawing, and fee will be required, but the old model, if suitable, may be used.

168. A forfeited application is one upon which a patent has been withheld for failure to pay the final fee within the prescribed time. (See Rule 161.)

169. Where the patent has been withheld by reason of non-payment of the final fee, any person, whether inventor or assignee, who has an interest in the invention for which such patent was ordered to issue, may file a new application for the same invention; but such second application must be made within two years after the allowance of the original application. Upon the hearing of such new application abandonment will be considered as a question of fact.

170. In such renewal the oath, petition, specification, drawing, and model of the original application may be used for the second application, but a new fee will be required. The second application will not be regarded as a continuation of the original one, but will bear date from the time of renewal, and be subject to examination like an original application.

171. Forfeited and abandoned applications will not be cited as references. But when an applicant makes claim to an invention previously claimed by and allowed to another, whose application has become forfeited by reason of the non-payment of the final fee within six months from the date of the letter of allowance, he will be notified that unless he shall file an affidavit, showing that he made the invention before such previously allowed application was filed, his own application will not be passed to issue.

Where more than one such subsequent applicant claims the invention thus previously allowed, each will be required to file the affidavit above mentioned within a reasonable specified time, before an interference can be declared between such later applications.

No notice will be given to applicants, while their cases remain

forfeited, of the filing of subsequent applications. Certified copies of the file in cases of rejected and abandoned applications may be furnished to applicants or to other persons when specifically ordered, but no inspection of such file, except by the applicants or their duly authorized attorneys, will be permitted.

EXTENSIONS

172. No patent granted since March 2, 1861, can be extended except by act of congress.

173. When a patent has been so extended, subject to the further decision of the commissioner, the subsequent proceedings will be conducted in accordance with the following rules.

174. Any person may oppose an application for extension, but must give notice of such opposition to the applicant or his attorney of record within the time hereinafter named, and furnish him with a statement of his reasons of opposition. After such notice he will be regarded as a party in the case, and will be entitled to notice of the time and place of taking testimony, to a list of the names and residences of the witnesses whose testimony may have been taken before service of his notice of opposition, and to a copy of the application and of any other papers on file, upon payment of the cost thereof. He must also immediately file a copy of such notice and reasons of opposition, with proof of service of the same, in the patent office.

175. If the extension is opposed on the ground of lack of novelty in the invention, the reasons of opposition must contain a specific statement of any and all matter relied upon for this purpose.

176. The applicant for an extension must furnish to the office a statement in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures on account thereof, both in this and in foreign countries. This statement must be detailed and particular, unless sufficient reasons are shown for a failure to make it so. It must in all cases be filed with the petition.

177. Such statement must also be accompanied with a certified abstract of title and a declaration under oath, setting forth the extent of the applicant's interest in the extension sought.

178. The questions which arise on each application for an extension are:

(1.) Was the invention new and useful when patented?

(2.) Is it valuable and important to the public, and to what extent?

(3.) Has the inventor been reasonably remunerated for the time, ingenuity, and expense bestowed upon the invention, and upon its introduction into use? If not, has his failure to be so remunerated arisen from neglect or fault on his part?

(4.) What will be the effect of the proposed extension upon the public interests?

179. No proof will be required from the applicant upon the first question unless the invention is assailed upon those points by opponents.

180. To enable the commissioner to come to a correct conclusion in regard to the second point of inquiry, the applicant must, if possible, present the testimony of disinterested persons taken under oath. This testimony must distinguish carefully between the

specific devices covered by the claims of the patent and the general machine in which those devices may be incorporated.

181. Upon the third point of inquiry the applicant, having by his own oath shown his receipts and expenditures on account of the invention, must also show, by testimony under oath, that he has taken all reasonable measures to introduce his invention into general use; and that without neglect or fault on his part, he has failed to obtain from the use and sale of the invention a reasonable remuneration for the time, ingenuity, and expense bestowed on the same, and on its introduction into use.

182. In case of opposition to the extension of a patent both parties may take testimony, each giving reasonable notice to the other of the time and place of taking the same. The testimony will be taken according to the rules hereinafter prescribed.

183. Any person desiring to oppose an extension must serve his notice of opposition, and file his reasons therefor, at least ten days before the day fixed for the closing of the testimony; but parties who have not entered formal opposition in time to put in testimony may, at the discretion of the commissioner, be permitted to appear on the day of hearing, and make argument upon the record in opposition to the grant of the extension. In such case good cause for the neglect to make formal opposition must be shown.

184. In contested cases no testimony will be received, unless by consent, which has been taken within thirty days next after the filing of the petition for the extension.

185. Service of notice to take testimony must be made as provided for in Rule 150 (2). Where notice to take testimony has already been given to an opponent, and a new opponent subsequently gives notice of his intention to oppose, the examination need not be postponed, but notice thereof may be given to such subsequent opponent by mail or by telegraph. But this rule does not apply to *ex parte* examinations, nor to those of which no notice is given before service of notice of opposition.

186. In the notice of application for extension a day will be fixed for the closing of testimony, and the day of hearing will also be named. Applications for postponement of the day of hearing, or for further time for taking testimony, must be made and supported in accordance with the rules to be observed in other contested cases; but no postponement will be granted whereby any risk of delaying the decision until the expiration of the patent may be incurred. Upon the closing of the testimony the application will be referred without delay to the examiner in charge of the class to which the invention belongs for the report required by law; and such report shall be made not less than five days before the day of hearing. As this report is intended for the information of the commissioner, neither the parties nor their attorneys will be permitted to make oral arguments before the examiner. In contested cases briefs are deemed desirable, and these should always be filed at least five days before the day of hearing.

DISCLAIMERS

187. Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material

or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he or they shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the patent office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of filing the same, except as to the question of unreasonable neglect or delay in filing it.

188. Such disclaimers must be distinguished from those which are embodied in original or reissue applications, as at first filed or subsequently amended, referring to matter shown or described, but to which the disclaimant does not choose to claim title, and also from those made to avoid the continuance of interferences, which require no fee, but must, like all other disclaimers, be signed by the applicants in person and duly witnessed. (See Rule 104. For Forms of Disclaimers see Appendix Forms 27, 28.)

CAVEATS

189. A caveat, under the patent law, is a notice given to the office of the caveator's claim as inventor, in order to prevent the grant of a patent to another for the same alleged invention upon an application filed during the life of the caveat without notice to the caveator.

190. Any citizen of the United States who has made a new invention or discovery and desires further time to mature the same, may, on payment of a fee of ten dollars, file in the patent office a caveat setting forth the object and the distinguishing characteristics of the invention, and praying protection of his right until he shall have matured his invention. Such caveat shall be filed in the confidential archives of the office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof.

191. An alien has the same privilege, if he has resided in the United States one year next preceding the filing of his caveat, and has made oath of his intention to become a citizen.

192. The caveat must comprise a specification, oath, and, when the nature of the case admits of it, a drawing, and, like the application, must be limited to a single invention or improvement.

193. The same particularity of description is not required in a caveat as in an application for a patent; but the caveat must set forth the object of the invention and the distinguishing characteristics thereof, and it should be sufficiently precise to enable the office to judge whether there is a probable interference when a subsequent application is filed. If upon examination a caveat be found defective in this respect amendment will be required. Without compliance with Rules 190, 192, 193 and 195 the caveator will not be entitled to the notice provided for in Rule 196.

194. The oath of the caveator must set forth that he is a citizen of the United States, or, if he be an alien, that he has resided for one year last past within the United States, and has

made oath of his intention to become a citizen thereof, and that he believes himself the original and first inventor of the art, machine, or improvement set forth in his caveat.

195. When practicable, the caveat should be accompanied by full and accurate drawings, separate from the specification, well executed on tracing muslin or paper that may be folded. (See Rule 50.)

196. If at any time within one year after the filing or renewal of a caveat another person shall file an application with which such caveat would in any manner interfere, and if, within the year, the application shall be found patentable, then such application will be suspended, and notice thereof will be sent to the person filing the caveat, who, if he shall file a complete application within the prescribed time, will be entitled to an interference with the previous application, for the purpose of proving priority of invention, and obtaining the patent, if he be adjudged the prior inventor. The caveator, if he would avail himself of his caveat, must file his application within three months from the expiration of the time regularly required for the transmission to him of the notice deposited in the post-office at Washington; and the day when the time for filing expires will be mentioned in the notice or indorsed thereon.

197. The caveator will not be entitled to notice of any application pending at the time of filing his caveat, nor of any application filed after the expiration of one year from the date of the filing or renewal thereof. The caveat may be renewed by the payment of a second caveat fee of ten dollars, and it will continue in force for one year from the date of the payment of such second fee, and so on from year to year for not more than two years. If a caveat be not renewed, it will still be preserved in the secret archives of the office.

198. A caveat confers no rights and affords no protection except as to notice of an interfering application filed during its life, giving the caveator the opportunity of proving priority of invention if he so desires. It may be used as evidence in contests, as provided in Rule 150 (6).

199. There is no provision of law making the caveat assignable, although the alleged invention therein set forth is assignable, and the caveat may be used as means of identifying the invention transferred in an assignment.

200. Caveat papers cannot be withdrawn from the office after they have once been filed; but copies of the papers may be obtained at the usual rates by the caveator or any person duly authorized by him. Additional papers, if containing new matter, must be filed as a separate caveat with another fee. (For Caveat Forms see Appendix, Forms 10, 16.)

ASSIGNMENTS

201. Every patent or any interest therein shall be assignable in law by an instrument in writing; and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under his patent to the whole or any specified part of the United States.

202. Interests in patents may be vested in assignees, in grantees of exclusive sectional rights and mortgagees, and in licenses.

(1.) An assignee is a transferee of the whole interest of the

original patent, or of an undivided part of such whole interest, extending to every portion of the United States. The assignment must be written or printed and duly signed.

(2.) A grantee acquires by the grant the exclusive right, under the patent, to make and use, and to grant to others the right to make and use, the thing patented, within and throughout some specified part of the United States, excluding the patentee therefrom. The grant must be written or printed and duly signed.

(3.) A mortgage must be written or printed and duly signed.

(4.) A licensee takes an interest less than or different from either of the others. A license may be oral, or written or printed and duly signed.

203. An assignment, grant, or conveyance will be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless recorded in the patent office within three months from the date thereof.

204. No instrument will be recorded which does not, in the judgment of the commissioner, amount to an assignment, grant, mortgage, lien, encumbrance, or license, or affect the title of the patent or invention to which it relates.

205. Assignments which are made conditional on the performance of certain stipulations, as the payment of money, if recorded in the office, are regarded as absolute assignments, until canceled with the written consent of both parties, or by the decree of a competent court. The office has no means of determining whether such conditions have been fulfilled.

206. In every case where it is desired that the patent shall issue to an assignee, the assignment must be recorded in the patent office at a date not later than the day on which the final fee is paid. The date of the record is the date of the receipt of the assignment at the office.

207. The receipt of assignments is not generally acknowledged by the office. They are recorded in regular order as promptly as possible and then transmitted to the persons entitled to them. (For Form of Assignment see Appendix, Forms 37-42.)

OFFICE FEES

208. Nearly all the fees payable to the patent office are positively required by law to be paid in advance—that is, upon making application for any action by the office for which a fee is payable. For the sake of uniformity and convenience, the remaining fees will be required to be paid in the same manner.

209. The following is the schedule of fees:

On filing every application for a design patent	$10.00
On issuing a design patent for three years and six months no further charge.	
On issuing a design patent for seven years	5.00
On issuing a design patent for fourteen years	20.00
On filing every caveat	10.00
On filing every application for a patent for an invention or discovery	15.00
On issuing each original patent for an invention or discovery.	20.00
On filing a disclaimer	10.00
On filing every application for a reissue	30.00
On filing every application for a division of a reissue	30.00

On filing every application for an extension	50.00
On the grant of every extension	50.00
On filing an appeal from a primary examiner to the examiners-in-chief	10.00
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For certified copies of patents or other instruments, except copies of printed patents sold by the office, for every 100 words	10
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For certified copies of drawings, the reasonable cost of making them.	
For recording an assignment of 300 words or less	1.00
For recording an assignment of more than 300 and not more than 1,000 words	2.00
For recording every assignment of more than 1,000 words	3.00
For uncertified copies of the specifications and accompanying drawings of all patents which are in print:	
Single copies	25
Twenty copies or more whether of one or several patents, per copy*	10
For uncertified copies of the specifications and drawings of patents, not in print, the reasonable cost of making the same.	
For copies of matter in any foreign language, per 100 words	20
For translations, per 100 words	50
For assistance to attorneys in examination of records one hour or less	50
Each additional hour	50

210. An order for a copy of an assignment must give the liber and page of the record, as well as the name of the inventor; otherwise an extra charge will be made for the time consumed in making any search for such assignment.

211. No person will be allowed to make copies or tracings from the files or records of the office. Such copies will be furnished, when ordered, at the rates already specified.

212. The money required for office fees may be paid to the commissioner, or to the treasurer, or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the secretary of the treasury for that purpose, who shall give the

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*Note.—For the convenience of the office and of persons desiring printed copies of specifications and drawings, blank orders, or "coupons", have been prepared, which will be sold, on application to the chief clerk, at the rate of 10 cents each, in lots of 20 or more. Stub-books, containing 50 or 100 such orders, can be furnished at the same rate, and the orders printed on postal cards at the same rate plus the cost of the cards.

These orders, whenever presented properly filled up, are good for one copy each of the specification and drawings of any United States patent issue since November 20, 1866, or for a copy of the drawing of any United States patent from the earliest dates. Prior to the date given, the specifications were not printed.

depositor a receipt or certificate of deposit therefor, which shall be transmitted to the patent office. When this cannot be done without much inconvenience, the money may be remitted by mail, and in every such case the letter should state the exact amount inclosed. Letters containing money may be registered. Post-office money-orders now afford a safe and convenient mode of transmitting fees. All such orders should be made payable to the "Commissioner of Patents."

213. The weekly issue will close on Thursday, and the patents of that issue will bear date as of the third Tuesday thereafter. If the final fee in any application is not paid on or before that day, the patent will not go to issue until the following week.

214. All money sent by mail, either to or from the patent office, will be sent at the risk of the sender. In no case should money be sent inclosed with models. All payments to or by the office must be made in specie, treasury notes, national-bank notes, certificates of deposit, or post-office money-orders.

REPAYMENT OF MONEY

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

PUBLICATION

216. The "Official Gazette," a weekly publication which has been issued since 1872, takes the place of the old "Patent-Office Report." It contains the claims of all patents issued, including reissues, with portions of the drawings selected to illustrate the claims, and also lists of designs patents, together with decisions of the courts and of the commissioner, and other special matters of interest to inventors.

The Gazette is furnished to subscribers at the rate of $6 per annum. When it is sent abroad an additional charge of $2 will be made for the payment of postage. But representatives and senators are each entitled to designate eight public libraries to which it will be sent without charge. Single copies are furnished for 15 cents each.

An index is published annually, which is sent to all subscribers and designated libraries without additional cost.

Printed volumes are issued monthly, containing the entire specifications and drawings of all patents issued during the previous month. These are authenticated by the seal of the office and may be used as evidence throughout the United States. One copy is deposited in each State library, and one copy in the custody of the clerk of each United States district court, for general reference.

217. No persons are allowed to enter the alcoves, or take books from the library, except officers of the bureau and members of the examining corps.

All books taken from the library must be entered in a register kept for the purpose, and returned on the call of the librarian.

Any book lost or defaced must be replaced by a copy of the same.

Patentees and others doing business with the office can examine the books only in the library-hall.

Translations will be made only for official use.

Persons will be allowed to make notes or extracts, but not copies or tracings, from works in the library. Such copies will be furnished at the usual rates.

AMENDMENTS OF THE RULES

218. All amendments of the foregoing rules will be published in the Official Gazette.

H. E. PAINE,
Commissioner of Patents.

Approved:

C. SCHURZ,
Secretary of the Interior.

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