

conceptions or suggestions are made so that the inventors work together to the common end of completing a single invention. *Worlden v. Fisher*, 11 Fed. 505; *Gottfried v. Best*, 5 Bann & Ard. 4, Fed. Cas. No. 5,633; 17 O. G. 675; *Chase v. Chase*, 4 O. G. 4; *Thomas v. Weeks*, 2 Paine 92, Fed. Cas. No. 13,914; *Consolidated, etc., Apparatus Co. v. Woerle*, 29 Fed. 449, 38 O. G. 1015; *Sawyer v. Edison*, 25 O. G. 597; *Carter v. Perry*, 8 O. G. 518; *Barrett v. Hall*, 1 Mason 447, Fed. Cas. No. 1,047.

To rebut the presumption that the invention was either sole or joint, as indicated on the face of the patent, there must be clear and convincing evidence. *Royer v. Coupe*, 29 Fed. 358 and *Welsbach v. Cosmopolitan*, 100 Fed. 648, cited in *Eastern Paper Bag Co. v. Continental*, 142 Fed. 479,500.

In *Quincey Mining Co. v. Krause*, 151 Fed. 1012, 1017, 81 C. C. A. 290, it was said that if a claim covered but a single idea it would be difficult to conceive how it could be patented by two; but when a claim covers a series of steps or a number of elements in a combination, the invention may well be joint, though some of the steps or some of the elements may have come as the thought of but one.

In *Sieber Mfg. Co. v. Chicago Co.*, 177 Fed. 439, it was said that the defense of improper joinder of applicants is a purely technical one and should not be favored especially after the patent has been assigned.

In *American Patent Co. v. Wood*, 189 Fed. 391, 395, it was said that the fact that one of two joint patentees alone invented certain of the elements of the patented combination does not invalidate the patent.

For details of procedure by executors and administrators applying for patent, see order No. 1792 of January 20, 1909, 138 O. G. 970, as modified by order No. 1827 of October 22, 1909, 148 O. G. 837, and order No. 1838, 151 O. G. 453. See also *Pilgrim Paper Co.*, 125 O. G. 993; *Ex parte Rogers*, 125 O. G. 2766; *Ex parte Niefenfuhr*, 130 O. G. 981.

It should be observed that joint patentees need not be joint *inventors* for the inventor may join the assignee as a "patentee," that term referring only to the parties in whose name the patent is issued, and who are, *prima facie*, the owners. A joint patent on a joint application where the invention is sole being void, and vice versa, as indicated by the cases excerpted, it is important to carefully consider the question before filing.

This is indicated also by the case of *Mills v. Darlington v. Elliott*, 178 O. G. 321, 38 App. Cas. D. C. 95, that the burden of proof is upon the junior party to an interference and where such junior party consists of joint applicants, the burden is upon them to establish that they jointly conceived the invention at or about the time alleged in their preliminary statement.]

## PART IV.

### THE PATENT OFFICE—ITS ORGANIZATION AND FUNCTIONS.

#### 263. ESTABLISHMENT OF THE PATENT OFFICE.

Sec. 475. There shall be in the Department of the Interior an office known as the Patent Office, where all records, books, models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved. Sec. 476. [Creating Commissioner, Assistant Commissioner, three Examiners-in-Chief, and other employes.] Sec. 477. [Salaries.] Sec. 440. [Detailing what employes of the Department of Interior shall serve in the Patent Office.]

#### 264. DUTIES OF SECRETARY.

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

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### FIFTH, PATENTS FOR INVENTIONS.

Sec. 478. [Seal.] Sec. 479. [Bonds of Commissioner and Chief Clerk.]

#### 265. RESTRICTIONS UPON OFFICERS AND EMPLOYES.

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

#### 266. DUTIES OF COMMISSIONER. *Ibid.*, s. 7, p. 199.

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

#### 267. DUTIES OF EXAMINERS-IN-CHIEF.



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

#### 268. ESTABLISHMENT OF REGULATIONS.

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

Sec. 484. [Arrangement of exhibits and models, etc.] Sec. 485. [Disposal of models of rejected applications.] Sec. 486. [Library.]

#### 269. PATENT-AGENTS MAY BE REFUSED RECOGNITION.

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

Sec. 488. [Commissioner may require papers to be printed.] Sec. 489. [Printing copies of claims, laws, decisions, etc.] Sec. 490. [Printing specification and drawings.] Sec. 491. [Additional specifications and drawings.] Sec. 492. [Lithographing and engraving.] Sec. 12. [Volumes of drawings, etc., furnished departments; also Patent Office printing and patents issued; also Official Gazette and Commissioner's Report: also monthly volume of patents issued; also rules of practice, decisions, indexes; also lithography.] Sec. 493. [Price of copies of specifications and drawings.] Sec. 494. [Annual report of the Commissioner.] Sec. 496. [Disbursements for Patent Office.] Sec. 7, Act of March 3, 1897. [Requests by heads of department to make applications special.] Sec. 892. [Copies of records, etc., to be certified by Commissioner or Acting Commissioner. (See Part XVI.)] Sec. 4893. [To cause examination and issue patent. (See Part VI.)] Sec. 4894. [Commissioner to decide when delay in prosecuting of application unavoidable. (See Part VI.)] Sec. 4903. [Commissioner to notify applicant of rejection. (See Part VI.)] Sec. 4905. [Commissioner to establish rules for taking affidavits and depositions. (See Part X.)] Sec. 4910. [To hear appeals from the Examiners-in-Chief. (See Part VI.)]

270. BUTTERWORTH, COMR., ETC., v. UNITED STATES EX REL. HOE, 112 U. S. 50, 28 L. ed. 656, 5 Sup. Ct. 25 (1884).

Matthews, J.:

[In an interference contest between Scott and R. Hoe & Co., as assignees of Gill, the Secretary of the Interior had reversed on appeal the decision of the Commissioner of Patents.

Until 1881 it had been held, in pursuance of decisions and opinions of the Attorney General, that the Secretary of the Interior had no legal authority to review the judicial opinions and decisions of the Commissioner of Patents. In an opinion of August 20, 1881, however, the Attorney General had reversed these opinions, reaching the conclusion that the final discretion in all matters relating to the grant of patents was lodged in the Secretary of the Interior. The then Secretary (Kirkwood) concurred in that opinion and from time to time appeals from the Commissioner of Patents were heard by the Secretary. In this instance Commissioner Butterworth refused to issue the patent to the party adjudged by the Secretary to be the prior inventor and this case therefore arose as a writ of error prosecuted for the purpose of reviewing and reversing the judgment of the Supreme Court of the District of Columbia, awarding a peremptory mandamus commanding the plaintiff in error, the Commissioner of Patents, to receive the final fee tendered by the relators, that is, by the assignees of the party to whom the Secretary had awarded priority.

The Supreme Court states the grounds upon which the Secretary of the Interior had based his authority and power as under sections of the statutes, 441, 483, 487 and 4883, and upon the analogy of other departments in which the Secretary is supreme. The Supreme Court said that this argument would be apt to be misleading, unless particular regard is had to the nature of the duties intrusted to the several bureaus, and critical attention is given to the language of the statutes defining the jurisdiction of the chief and his subordinates, and the special relation of subordination between them respectively.

The court then proceeds:]

We are led, therefore, immediately to inquire whether such a construction of phrases, employed in establishing the organization of the patent-office as a bureau in the department of the interior, is justified by a view of the whole legislation *in pari materia*, and consistent with the integrity of the system of the statutes in relation to letters patent for new and useful inventions. The general object of that system is to execute the intention of that clause of the constitution, art. 1, § 8, which confers upon congress the power "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." The legislation based on this



provision regards the right of property in the inventor as the medium of the public advantage derived from his invention; so that in every grant of the limited monopoly two interests are involved: that of the public, who are the grantors, and that of the patentee. There are thus two parties to every application for a patent, and more, when, as in case of interfering claims or patents, other private interests compete for preference. The questions of fact arising in this field find their answers in every department of physical science, in every branch of mechanical art. The questions of law necessary to be applied in the settlement of this class of public and private rights have founded a special branch of technical jurisprudence. The investigation of every claim presented involves the adjudication of disputed questions of fact, upon scientific or legal principles, and is, therefore, essentially judicial in its character, and requires the intelligent judgment of a trained body of skilled officials, expert in the various branches of science and art, learned in the history of invention, and proceeding by fixed rules to systematic conclusions.

[The Supreme Court then recites the course of examination of an application and the line of appeals.]

Congress has thus provided four tribunals for hearing applications for patents, with three successive appeals, in which the Secretary of the Interior is not included, giving jurisdiction, in appeals from the commissioner, to a judicial body, independent of the department, as though he were the highest authority on the subject within it. And to say that, under the name of direction and superintendence, the secretary may annul the decision of the Supreme Court of the district, sitting on appeal from the commissioner, by directing the latter to disregard it, is to construe a statute so as to make one part repeal another, when it is evident both were intended to co-exist without conflict. The inference is that an appeal is allowed from the decision of the commissioner refusing a patent, not for the purpose of withdrawing that decision from the review of the secretary, under his power to direct and superintend, but because, without that appeal, it was intended that the decision of the commissioner should stand as the final judgment of the patent office, and of the executive department, of which it is a part. As already stated, the case of interferences is expressly excepted by section 4911 from the appeals allowed to the Supreme Court of the district. Further provision, covering such and also all other cases in which an application for a patent has been refused, either by the Commissioner of Patents or by the Supreme Court of the district, is found in Revised Statutes, § 4915. It is thereby provided that the applicant may have remedy by bill in equity. This means a proceeding in a court of the United States having original equity jurisdiction under the patent laws, according to the ordinary course of

equity practice and procedure. It is not a technical appeal from the patent-office, like that authorized in section 4911, confined to the case as made in the record of that office, but is prepared and heard upon all competent evidence adduced, and upon the whole merits. Such has been the uniform and correct practice in the circuit courts. *Whipple v. Miner*, 15 Fed. Rep. 117; *Ex parte Squire*, 3 Ban. & A. 133; *Butler v. Shaw*, 21 Fed. Rep. 321. It is provided that the court, having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear.

[After reviewing the course of the statutes, the court said:]

It thus appears that, as, in cases of other applications for a patent refused by the commissioner, the judgment, on a direct appeal, of the Supreme Court of the district is substituted for, and becomes the decision of, the patent-office, so here, in cases of interference, where the commissioner has rejected an application for a patent, the decree of the Circuit Court of the United States governs the action of the commissioner, and requires him, in case the adjudication is in favor of the complainant, to issue the patent as decreed to him. It certainly cannot be successfully claimed that, to a writ of mandamus issued out of a court of competent jurisdiction, commanding the commissioner of patents to record and execute the judgment of the Supreme Court of the district, reversing on an appeal his decision refusing a patent in any case other than an interference, or the decree of a Circuit Court of the United States in any case under section 4915, Rev. Stat., requiring a patent to be issued to the claimant, it would be a sufficient answer that he had been directed by the Secretary of the Interior not to do so. If not, it must be and is because the decision of the commissioner, as originally rendered, or that correction of it, required by the judicial proceedings, specified in the two sections of the statutes referred to, is final and conclusive upon the department. This conclusion is strengthened by the provisions of section 4918, Rev. Stat. It is there enacted that in case a patent is actually, though erroneously, issued, interfering with another, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative or invalid, in any particular part of the United States, according to the interest of the parties in the patent or the invention patented; of course, without prejudice to the rights of



any person, except the parties to the suit, and those deriving title under them, subsequent to the rendition of the judgment. Thus, every case is fully provided for, both when the commissioner wrongfully refuses to issue a patent, and when, in case of interference, he erroneously issues one; and that, by means of judicial proceedings, through tribunals distinct from and independent of the patent-office, the integrity and force of whose judgments would be annulled, if not regarded as conclusive upon the commissioner, notwithstanding any power of direction and superintendence on the part of the secretary, which is therefore necessarily excluded.

The law gives express appeals from the decision of the commissioner, or, in cases where technical appeals are not given, other modes of review by judicial process. It gives no such appeal from him to the secretary. If it exists, it is admitted it is only by an implication which discovers an appeal in the power of direction and superintendence. That power does not necessarily, *ex vi termini*, include a technical appeal; and the principle applies that where a special proceeding is expressly ordained for a particular purpose it is presumably exclusive. It is clear that when the appeal is expressly authorized from the commissioner to the court, either directly or by means of an original suit in equity, another appeal to the secretary on the same matter is excluded: and no reason can be assigned for allowing an appeal from the commissioner to the secretary in cases in which he is by law required to exercise his judgment on disputed questions of law and fact, and in which no appeal is allowed to the courts that would not equally extend it to those in which such appeals are provided, for all are equally embraced in the general authority of direction and superintendence. That includes all, or does not extend to any. The true conclusion, therefore, is that in matters of this description, in which the action of the commissioner is quasi judicial, the fact that no appeal is expressly given to the secretary is conclusive that none is to be implied.

The conclusion is confirmed by a review of the history of legislation on the point.

[In summing up the court said:]

“It thus appears, not only that the discretion and judgment of the commissioner, as the head of the patent office, is substituted for that of the head of the department, but also that that discretion and judgment are not arbitrary, but are governed by fixed rules of right, according to which the title of the claimant appears from an investigation, for the conduct of which, ample and elaborate provision is made and that his discretion and judgment, exercised upon the material thus provided, are subject to a review by judicial tribunals whose jurisdiction is defined by the same statute. In no event could the direction of the Secretary of the Interior extend

beyond the terms in which it is vested, that is, to the duties to be performed under the law by the commissioner. The supervision of the secretary cannot change those duties nor require them to be performed by another, nor does it authorize him to substitute his discretion and judgment for that of the commissioner, when, by law, the commissioner is required to exercise his own, and when that judgment, unless reversed in the special mode pointed out by judicial process, is, by law, the condition on which the right of the claimant is declared to depend. The conclusion cannot be resisted that, to whatever else supervision and direction on the part of the head of the department may extend, in respect to matters purely administrative and executive, they do not extend to a review of the action of the Commissioner of Patents in those cases in which, by law, he is appointed to exercise his discretion judicially. It is not consistent with the idea of judicial action that it should be subject to the direction of a superior, in the sense in which that authority is conferred upon the head of an executive department in reference to his subordinates. Such a subjection takes from it the quality of a judicial act. That it was intended that the Commissioner of Patents, in issuing or withholding patents, in re-issues, interferences and extensions, should exercise quasi judicial functions, is apparent from the nature of the examinations and decisions he is required to make, and the modes provided by law, according to which, exclusively, they may be reviewed.

“Such has been the uniform construction placed by the department itself upon the laws defining the relation of its executive head to the Commissioner of Patents. No instance has been cited in which the right of the secretary to reverse such action of the commissioner in granting or withholding a patent has been claimed or exercised prior to that based upon the opinion of Attorney General MacVeagh in 1881. The jurisdiction had been previously expressly disclaimed, in 1876, by Secretary Chandler, 9 O. G., 403, and by his immediate successor, Mr. Schurz, in 1877, 1878 and 1879; 12 O. G., 475; 13 O. G., 771; 16 O. G., 220.”

#### 270a.

[Note.—Since the decision of *Butterworth v. U. S.* there have been many cases before the Secretary of the Interior asking for a review of the acts of the Commissioner of Patents. The distinction has been made between those acts of the Commissioner which are judicial or quasi-judicial and those which are ministerial. For definition and distinction see *Houston v. Banker v. Bannister v. Eastman*, 44 O. G. 697, quoted in opinion of Assistant Attorney General Hall in *Ex Parte Cote Co.*, 65 O. G. 1915.

That the Commissioner, with reference to recording assignments, is a ministerial officer, see *Ex Parte Church*, 82 O. G. 1987.



The relations between the Primary Examiners and the Commissioner of Patents are, perhaps, *sui generis*. The Primary Examiner passes first upon the patentability of an invention and the rule of the office makes his decision in favor of patentability final. See in Part X, *Newcomb v. U. S. ex rel. Commissioner*. Many decisions (see *Underwood's Digest*) illustrate the supervisory authority of the Commissioner in the ordinary course of procedure in the office. The different views which have hitherto obtained as to the force and effect to be given a decision of the Primary Examiner are well illustrated in two decisions published within one week of each other, namely,—*Fowler v. Dodge*, 85 O. G. 1584 by the Assistant Commissioner, the other *Bender v. Hoffman*, 85 O. G. 1737, by the Commissioner. The first maintains it to be the best policy to sustain a favorable decision of the Primary Examiner. The second directs the Examiner in the particular case to reject the claim.

The Assistant Commissioner in his judicial opinion and decision is the Commissioner or Acting Commissioner.

Formerly in the absence of both the Commissioner and the Assistant Commissioner, the Chief Clerk (who is the "business" officer) became the acting Commissioner but the opinion of the Assistant Attorney General of June 4, 1890 holds that in such case the "Chief Clerk has no authority to act as Commissioner, but that the President must designate some officer whose appointment is vested in him by and with the advice and consent of the senate, to perform the duties of the vacant office."

The duties of the Examiners-in-Chief are sufficiently set forth in the Statute, Sec. 482.

As has been indicated, the Primary Examiner in, in effect, a lower tribunal and ordinarily his judicial actions cannot be reviewed by the Commissioner except on appeal. It is, however, a theory of the statute that the Commissioner examines all applications and that, in the exercise of his supervisory authority, while he may not direct a particular opinion or decision, he may refuse to grant a patent though the application may have been allowed by the Primary Examiner or the Examiners-in-Chief.

R. S. Sec. 4893; *Stone v. Greaves*, 17 O. G. 397; *Hull v. Commissioner*, 9 O. G. 1339. This does not qualify the judicial independence of the Examiner-in-Chief nor the practical freedom of action and judgment of the primary examiners.

The duty of the Examiner of Interferences is to hear and try contests of priority, that is, interferences and accompanying motions, but not such as relate to the patentability of the issue or the right to make a claim, which first must go to the Primary Examiner, though they afterwards may proceed through the Examiner of Interferences and the full line of appeals upon testimony taken in the case.]

[For further discussion of the relations between the primary examiners and the commissioner and the authority of the commissioner. See *United States ex rel. Steinmetz v. Allen*, 192 U. S. 543, 48 L. ed. 555, 24 Sup. Ct. 416; *United States ex rel. Lowry v. Allen*, 203 U. S. 476, 51 L. ed. 281, 27 Sup. Ct. 141; *United States ex rel. Newcomb Motor Co. v. Moore*, 30 App. Cas. D. C., 464; writ of error dismissed by Supreme Court for want of jurisdiction, 54 L. ed. 636.]



## PART V.

### THE APPLICATION—PROCEEDINGS IN THE PATENT OFFICE ON APPEAL THEREFROM.

General Requisites—Drawings—Models—Specimens, etc.—Specification—Claims—Oath—Examination—Division—Meeting an Objection or Rejection—Amendments and Actions by Applicant—Rule 70—“New Matter”—Rule 75—Overcoming a Disclosure—Appeals and Petitions—Bill in Equity Under R. S., U. S., Sec. 4915, Issue, Forfeiture and Renewals—Abandonment—Date and Form of Grant—Delivery—Assignments, Assignees and Assignors.

#### 271. REQUISITES OF APPLICATION, DESCRIPTION, SPECIFICATION, AND CLAIM.

Sec. 4888. Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the patent office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor and attested by two witnesses.

#### 272. DRAWINGS, WHEN REQUISITE.

Sec. 4889. When the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact, and attested by two witnesses, which shall be filed in the patent office; and a copy of the drawing, to be furnished by the patent office, shall be attached to the patent as a part of the specification.

**273. SPECIMENS, OF INGREDIENTS, ETC.**

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

**274. MODEL, WHEN REQUISITE.**

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

**275. OATH REQUIRED FROM APPLICANT.**

Sec. 4892. The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, charge 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 certificate of a diplomatic or consular officer of the United States.

**276. EXAMINATION AND ISSUING PATENT.**

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

**277. LIMITATION UPON TIME OF COMPLETING APPLICATION.**

Sec. 4894. All applications for patents shall be completed and prepared for examination within one year after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within one year after any action therein, of which notice shall have been given to the applicant, they shall be



regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.

**278. NOTICE OF REJECTION OF CLAIM FOR PATENT TO BE GIVEN TO APPLICANT.**

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

**279. APPEALS FROM PRIMARY EXAMINERS-IN-CHIEF.**

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

**280. FROM EXAMINERS-IN-CHIEF TO COMMISSIONER.**

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

**281. FROM THE COMMISSIONER TO THE COURT OF APPEALS, D. C.**

Sec. 4911. If such party, except a party to an interference, is dissatisfied with the decision of the commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc. [See sec. 9, act of February 9, 1893, Part V, giving this jurisdiction to the Court of Appeals of the District of Columbia. This applies also to the next three sections.]

**282. NOTICE OF SUCH APPEAL.**

Sec. 4912. When an appeal is taken to the Supreme Court of the District of Columbia, the appellant shall give notice thereof to the commissioner, and file in the patent office within such time as the commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

**283. PROCEEDINGS ON APPEAL TO COURT.**

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

**284. DETERMINATION OF SUCH APPEAL AND ITS EFFECT.**

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

**285. PATENTS OBTAINABLE BY BILL IN EQUITY.**

Sec. 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia [Court of Appeals of the District of Columbia] upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the patent office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the commissioner; and all the expenses of the proceeding shall be paid by the appli-



cant, whether the final decision is in his favor or not. [See § 629, ¶ 9.]

[The act of February 9, 1893, as previously indicated, established a Court of Appeals of the District of Columbia and gave to that court the appellate jurisdiction which had formerly been had by the Supreme Court. The Judicial Code, as indicated in Part V, has modified the provisions for appeals from that court to the Supreme Court of the United States so that there is no longer, in any patent case, an appeal to the Supreme Court of the United States. There remains, however, the provision for writ of certiorari.]

#### **286. REQUESTS BY HEADS OF DEPARTMENTS TO MAKE APPLICATIONS SPECIAL.**

Sec. 7, Act of March 3, 1897. That in every case where the head of any department of the government shall request the Commissioner of Patents to expedite the consideration of an application for a patent it shall be the duty of such head of a department to be represented before the commissioner in order to prevent the improper issue of a patent.

#### **287. RULES OF PATENT OFFICE PRACTICE.**

[Rules 1-13 relate to correspondence; 14-16, to information to correspondents; 17-23, to attorneys; 24-29, to applicants (and are covered in Parts II and III); 30-32, to the formal preliminary requirements of an application; 33-40, to the petition and specification.]

#### **288. JOINDER OF INVENTIONS.**

41. 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.

#### **289. DIVISION OF APPLICATION.**

42. 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.



**290. CROSS-REFERENCES IN CASES RELATING TO SAME SUBJECT.**

43. 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.

**291. RESERVATION CLAUSES NOT PERMITTED.**

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.

[Rule 45. Legible writing required. Based on R. S., sec. 4888.]

**292. OATH OF APPLICANT.**

[Compare Statute Sec. 4892.],

46. 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 before known or used, 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 the invention has not been patented to himself or to others with his knowledge or consent in this or any foreign country for more than two years prior to his application, or on an application for a patent filed in any foreign country by himself or his legal representatives or assigns more than twelve months prior to his application. 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; that to the best of his knowledge and belief the invention has not been in public use or on sale in the United States, nor described in any printed publication or patent in this or in any foreign country, for more than two years prior to his application in this country. This oath must be subscribed to by the affiant.

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.

**293. OATH BY EXECUTOR OR GUARDIAN. OFFICERS AUTHORIZED TO ADMINISTER OATHS.**

47. 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 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, 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 countries, by the proper official seal of the officer before whom the oath or affirmation is made, except that no acknowledgment may be taken by any attorney appearing in the case. 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.

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, or, if he is not provided with a seal, then each sheet must be initialed by him.

**294. SUPPLEMENTAL OATH FOR MATTER NOT ORIGINALLY CLAIMED.**

48. 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 will 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 to himself or to others with his knowledge or consent in this or any foreign country on an application filed 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 applica-



tion, and has not been abandoned. Such supplemental oath must be attached to and properly identify the proposed amendment.

[Rules 49-55 relate to requirements for drawings based on R. S., Secs. 4889, 4895; 56-62, to models and specimens based on R. S., Secs. 4891, 4895 and 4896; 63-64, to order to examination and to the procedure, rule 64 requiring the merits to be treated throughout and matters of form to be insisted upon only at the conclusion; 65-66, require the examiner to give notice of rejection with information and references, to re-examine the case and upon rejection for want of novelty to cite the best references previously cited, and in some cases to file an affidavit to facts within the personal knowledge of an employe; 67 provides for reconsideration in case of adverse decisions in ex parte cases; 68-69 provide for the right of amendment by the applicant, the requisites of certainty and reasons for the amendment, for amendment after claims are ready for appeal to put the case in better form, and request for reconsideration.]

#### **295. AMENDMENTS TO CORRESPOND TO ORIGINAL MODEL, DRAWING, OR SPECIFICATION.**

70. In original applications which are capable of illustration by drawing or model all amendments of the model, 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 be shown or claimed only in a separate application.

[Rules 71-74 provide for amendment to cure inaccuracies or prolixity; that a change in the drawings may be made only on permission and after the filing of a photograph of the drawings; that the specification is not to be returned in any case; that either the model or drawing, but not both at the same time, may be withdrawn for correction under certain restrictions; that amendments must be specific, and that to secure clear statement an amendment may be required to be rewritten.]

#### **296. PATENTS SHOWING BUT NOT CLAIMING INVENTION.**

75. 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 will not bar the grant of a patent to the applicant, unless the date of such patent or printed publication is more than two years prior to the date on which application was filed in this country.

**297. APPLICATION REJECTED ON REFERENCES SHOWING BUT NOT CLAIMING INVENTION—AFFIDAVITS.**

76. 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 employe of the office, set forth in an affidavit (when requested) of such employe (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 141.)

[Rule 77 provides for abandonment of an application under Sec. 4894 if an applicant neglect to prosecute his application for one year after the date when the last official notice of any action was mailed to him, and for the suspension of an application for a specified term under certain conditions.]

**298. AMENDMENT AND JURISDICTION AFTER NOTICE OF ALLOWANCE.**

78. Amendments will not be permitted after the notice of allowance of an application, and the examiner will exercise jurisdiction over such an application only by special authority from the commissioner.

**299. AMENDMENT WITHOUT WITHDRAWAL FROM ISSUE.**

Amendments may be made after the allowance of an application, and after payment of the final fee, if the specification has not been printed, on the recommendation of the primary examiner, approved by the commissioner, without withdrawing the case from issue. (See Rule 135.)

[Rules 79-84, Designs are practically paraphrases of the Revised Sections given in Part VII; rules 85-92 relate to reissues. See Part X; Rules 93-132 relate to interferences. See Part VIII.]



**300. APPEAL TO EXAMINERS-IN-CHIEF.**

133. 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 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.

**301. PREREQUISITES**

134. 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.

**302. EXAMINER'S STATEMENT OF GROUNDS OF DECISION.**

135. Upon the filing of the appeal the same shall be submitted to the primary examiner, who, if he find it to be regular in form, and to relate to an appealable action, shall, within five days from the filing thereof, furnish the examiners-in-chief with a written statement of the grounds of his decision on all the points involved in the appeal, with copies of the rejected claims and with references applicable thereto. 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 145.

[Rules 136-138 relate to the brief, the oral hearing and the order of the argument.]

**303. DECISION OF EXAMINERS-IN-CHIEF—DISCOVERY OF GROUND—APPEAL—AMENDMENT.**

139. (a) 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 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 will annex to their decision a statement to that effect, with such recommendation as they shall deem proper.

(b) From an adverse judgment of the primary examiner on points embraced in the recommendation annexed to the decision, appeal may be taken on questions involving the merits to the board of examiners-in-chief and on other questions to the commissioner as in other cases.

(c) The commissioner may, when an appeal from the decision of the examiners-in-chief is taken to him, remand the case to the primary examiner, either before or after final judgment, for consideration of any amendment or action which may be based on the recommendation annexed to the decision of the examiners-in-chief.

(d) If the commissioner, in reviewing the decision of the examiners-in-chief, discovers any apparent grounds for granting or refusing letters patent not involved in the appeal, he will, before or after final judgment, and whenever in his opinion substantial justice shall require it, give reasonable notice thereof to the parties; and if any amendment or action based thereon be proposed, he will remand the case to the primary examiner for consideration.

(e) From the 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.

[Rules 140-141 relate to appeals to the commissioner and the examiners-in-chief and the remanding of an application to the primary examiner for reconsideration.]

**304. REHEARINGS.**

142. 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 examiner-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.)



**305. JURISDICTION.**

143. 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.

Ex parte cases decided by an appellate tribunal will, after decision, 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.

[Rule 144 restricts reconsideration of cases decided by former commissioner to basis of new trial.]

**306. PETITION TO COMMISSIONER WITHOUT FEE.**

145. 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 fixing a time for hearing such petition by the Commissioner, and directing the examiner to furnish a written statement of the grounds of his decision upon the matters averred in such petition within five days after being notified of the order fixing the day of hearing. 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.

[Rules 146-148 relate to appeals to the various tribunals in interference cases as in ex parte cases; to briefs in appeal cases and to appeal to the Court of Appeals according to the rules of that court.]

**307. NOTICE TO COMMISSIONER OF APPEAL TO COURT.**

149. When an appeal is taken to the court of appeals of the District of Columbia, the appellant will 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.

[Rule 150 forbids pro forma proceedings for the purpose of securing an appeal; 151-153 relate to hearings, interviews and notice of motion, proof of service, etc.; 154-163 to testimony in interferences and other contested cases, and to requirements of printing (thirty-one copies that enough may be supplied in case of an appeal to the Court of Appeals), briefs, size and time of filing, etc.; 164-

159, to issue, date, duration and form of patents, following substantially Rev. Stat. 4885, 4893, 4897, and 4935; 170, to correction of mistakes incurred through the fault of the office and to reissues. (There is no specific statutory foundation for this provision); 171-174, to abandoned, forfeited and revived applications, following substantially the provisions of Rev. Stat., Sec. 4894.]

**308. NEW APPLICATION AFTER NON-PAYMENT OF FINAL FEE.**

175. 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 such patent was ordered to issue may file a renewal of the 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.

**309. RENEWAL. OLD APPLICATION PAPERS MAY BE USED.**

176. 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 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.

[Rules 177-179 provide that forfeited and abandoned application shall not be cited as references, that no notice of the filing of subsequent applications will be given to applicant while the case remains forfeited and to conditions under which copies may be obtained of the files of forfeited and abandoned applications; 180 relates to extensions of patents which can be only by act of Congress under R. S., Sec. 4924; 181, to disclaimers under the provision of R. S., Sec. 4917, 4922; 182, calls attention to the distinction between the form of disclaimers referred to by the statute and the form of disclaimer used to abandon to another some part of an application to avoid the continuance of an interference; 183-194, relate to caveats which are now obsolete, the law having been repealed by the law of July 1, 1910; 195-201 relate to assignments. (See Part XII); 202-207, to office fees and provision for orders for copies and for the weekly issue of patents; 208, to the repayment of money paid by mistake; 209-210, to publications and library regulations; 211, to amendments of rules; 212 puts all cases not specifically defined and provided for in these rules under the authority of the commissioner; 213 provides that questions arising in applications filed prior to January 1, 1898, shall be governed by the rules of



June 18, 1897. This is because the act of March 3, 1893, provided that it should not take effect until January 1, 1898.]

[The following cases are confined to special features of practice. The opening cases treat of claims from the Patent Office standpoint. A fuller consideration of claims runs through many cases, especially in Parts II and IX, and the Introduction.]

310. EX PARTE KNUDSEN, 72 O. G. 589, 1895 C. D. 29.

Fisher, Acting Commissioner:

This is a petition "that the examiner in charge of said application be advised that the said claim is in proper form for consideration on its merits and directed to proceed to examine said application upon its merits."

The claim in question is as follows:

"1. The combination, with a suitable valve for controlling passage of fluid under pressure, of differential spring mechanism for said valve, said spring mechanism being arranged to exert a materially greater pressure in resisting the initial movement of said valve from its normal position than said spring mechanism exerts in the initial return movement of said valve toward its normal position after it has been forced to a considerable distance from said normal position, whereby when said valve has been moved to a considerable distance from its normal position by fluid pressure it will remain in the position to which it has been so moved until said fluid pressure has materially decreased below the amount of pressure necessary to effect the initial movement from its normal position, substantially as described."

On May 8, 1894, this claim was rejected by the examiner on the ground that it set forth "merely the function or mode of operation of applicant's device," and on May 23, 1894, it was again rejected as covering "merely the function of the device."

In the examiner's statement *Ex parte McClellan*, 59 O. G., 1763, is cited as authority for this rejection.

Strictly speaking, the examiner's action being a rejection ought not to be reviewed at the present time by me; but on account of the many petitions that have recently been brought involving functional claims and those indefinite through functional phraseology it is deemed desirable to consider such claims somewhat in detail, and the present case offers an opportunity for such a discussion.

Claims of this character may be divided into four classes: first, those covering a function or a result or effect, (excepting when such result is a product or composition of matter,) and nothing more; second, those covering the function of a machine or apparatus; third, those which are indefinite, in that they recite the functions of certain elements named in the claim to the exclusion of

proper structural definition, and, fourth, those which cover sets of mechanism by setting forth the results which such sets of mechanism severally produce.

Claims of the first class are usually participial in form. They are not for substantive mechanism, but for the result which such mechanism produces. Examples of this class are given in *Ex parte Simonds*, C. D., 1870, 23, where the claim was—

“producing in cutting-presses a successive change in the point of contact of the cutting-block with the cutting-die—”

and in *Ex parte Hahn*, C. D., 1875, 107. These, with many other decisions, both of the patent office and courts, (see the cases cited in connection with section 518 of *Robinson on Patents*, vol. 2.) have held such claims to be invalid. As the ground of these decisions is that the claims are for a function or for an effect, and that they are therefore not patentable, the action pertains to the merits, and the examiner's action should be a rejection.

Claims of the second class, for the function of a machine, are expressed in the form of a method or process or else in such terms that they may be construed to cover a method or process. These claims are also invalid. (See *Corning v. Burden*, 15 How., 252, and the cases cited in connection with section 529, *Robinson on Patents*, vol. 2.) As the action in this class goes to the merits, these claims should be rejected.

Claims of the third class, that are indefinite in that they define the construction sought to be covered by the use of such terms as “means,” “mechanism,” and “devices,” for effecting certain results, as set forth in *ex parte Pacholder*, 51 O. G., 295, or that recite the functions of certain named elements of a combination or of the device as a whole, to the exclusion of proper structural definition, are the claims which cause the most trouble, as frequently it is a matter of great difficulty to decide whether such claims are subject to objection or to rejection or to both. The difficulty, too, is often increased by the fact that a broader construction ought to be given the claim, if it covers a new departure in the art, (*Morley Sewing Machine Co. et al. v. Lancaster*, C. D., 1839, 380; 47 O. G., 267,) than if it is for an invention in an already developed art.

The use of the above-noted phraseology does not of necessity render a claim objectionable, for where the idea is clearly stated and the combination or relation of parts to produce a desired end is plainly expressed the breadth of the statement of the claim is no reason for objecting to it. It is only necessary that these expressions shall clearly distinguish what is new from what is old in the art or from fair equivalents thereof. If they do this, the question is then one of patentable novelty—that is to say, claims of this order are not objectionable in form on the ground that they are too broad, but only because they are vague or indefinite. (*Ex parte*



Halfpenny, 53 MS. Dec., 489.) When indefinite, they should be objected to; but they can only be rejected on references when these disclose both the complete combination and the functional qualifications covered by the claim.

In the present case the examiner states that the invention covered is in a highly developed art, and that while he has at his command references which show the combination he is unable to find a reference which shows the combination having the functional qualifications mentioned in the claim under consideration. Such being the case he was wrong in rejecting the claim, since breadth is not, generally speaking, a proper ground for rejection in the absence of references except in unusual cases—as, for instance, when a claim is broader than the invention, as was the claim considered in *Ex parte Opdyke*, C. D., 1890, 39; 50 O. G., 1293. Furthermore, the reason given by the examiner—that the claim covers the “function of the machine”—is not thought to be correct. The claim is not a process claim, nor can it be fairly construed to cover a process. It is clearly for a combination of two elements, one of which is expressed by the term “differential spring mechanism,” followed by a description of the arrangement of said mechanism. It is not for controlling a fluid-pressure valve by differential spring mechanism, etc., and is neither functional nor for the function of the machine. It is the evident intention of the claim to cover not only the specific subordinate means for producing certain motions of the valve, but to cover certain devices without regard to the special means by which they produce these motions. The language of the claim seems to me to be definite, and the only objection to be urged against it is that it is too broad in view of the art. Rejection of claims of this class should always be accompanied by citation of references and such citations should be made at the time of the first office action.

Claims of the fourth class set forth sets of mechanism by stating the results which they severally produce. A good example of such claims is given in *Smith & Egge Manufacturing Co. v. Bridgeport Chain Co.*, C. D., 1891, 486; 56 O. G., 1449. Such claims are in bad form and should therefore be objected to by the examiner; but such action should also be accompanied, where possible, by the citation of references and rejection on merits.

The petition is granted.

**§11. EX PARTE HALFPENNY, 73 O. G. 1135, 1895 C. D. 91.**

Fisher, Assistant Commissioner:

This is a petition from the action of the primary examiner objecting to claims 1 to 7, inclusive, 29, and 33 as being indefinite and vague.

Claim 3, which may be taken as an example of the claims objected to, is as follows:

“3. The combination of bobbin-feeding, bobbin-separating, and stick-filling mechanisms co-operating to feed and separate bobbins and fill bobbin-sticks therewith, substantially as and for the purpose specified.”

It will be noted that this claim is for a combination of bobbin-feeding, bobbin-separating, and stick-filling mechanism.

The examiner states that —

“such an aggroupment of mechanism does not picture to the human mind anything whatever, but leaves it with the indefinite, indistinct, and unsatisfactory impression that when a certain operation is performed upon bobbins this claim may possibly cover it. It is, in effect, a claim which, though really and legally covering only a well-defined structure, ‘will apparently and *ex impudentia* cover all mechanism now known or hereafter invented that will accomplish substantially the same result.’”

It is the well-settled policy of this office to allow inventors to claim their inventions as broadly as possible in view of the state of the art. At the same time the statute requires that the—

“applicant shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.”

If the above claim is vague or indefinite, it is because of the use of the term “mechanism,” limited only by the functions which such mechanism performs, to designate the specific devices and equivalents thereof which the applicant has grouped together as the elements of his combination; but similar claims have of late been uniformly held to be in proper form, so far as I am aware, unless the only novelty in the invention was in the specific mechanism, in which case it has been held that the applicant should be required to specify the novel features and not depend on the phrase “substantially as described” to save his claim. (Ex parte Pacholder, C. D., 1890, 55, and decisions therein cited; Ex parte Ambler, 41 MS. Dec., 209; Ex parte Pearson, 50 MS. Dec., 25.)

Now, whether or not the only novelty in the claim resides in the specific mechanism can only be determined by reference to the state of the art. The question therefore resolves itself into one of novelty upon which the applicant is entitled to an appeal to the board of examiners-in-chief. The objection of “indefiniteness” or “vagueness” commonly urged against claims, when such objection is based on the fact that the claims include as elements “means” or “mechanism,” limited only by the function which such means or mechanism performs, is inaccurate. Those terms do not, under such circumstances, render the claims indefinite or vague. It would be more accurate to say of those terms, when only limited in the man-



ner above stated, that they render the claims too broad—an objection which goes to the merits of the claims and which calls for a rejection. (*Ex parte Opdyke*, C. D., 1890, 39.)

In accordance with the above conclusion, this petition should be, and it is hereby, dismissed and the case remanded to the primary examiner, who, if he thinks the claims for the reason above discussed are too broad, will reject them on that account, at the same time assigning all other reasons that he may have for rejection, and thus lay a basis for an appeal to the examiners-in-chief.

312. *HULETT v. LONG*, 15 App. Cas. D. C. 284, 89 O. G. 1141, 1899 C. D. 446.

Alvey, J.: \* \* \*

The amendments objected to, related to some of the details of the machine and the mode of the operation thereof.

This question was substantially involved in the motion to dissolve the interference, for it being alleged as one of the grounds of the motion that there was, in fact, no interference and that Long had no right to make the claim involved in the interference as declared the question was disposed of in denying the motion to dissolve the interference; but we think there is no substantial ground for the contention of the appellant, and especially not on this appeal. The amendments allowed did not disclose a wholly different invention from that claimed in the original application nor change the construction and operation of an invention that had been fully described and shown, nor did the amendments allowed to be made present a different or preferable form of invention from that originally presented, and while an applicant will not under the form or guise of amendment be allowed to introduce into his application a new and different claim to an invention from that originally made nor to change the construction and operation of an invention which has been fully described and explained in his original application and specification, yet it is a well-settled and long-established practice in the patent office to allow amendments to be made under proper circumstances to supply omissions and defects in the original specification and claims as filed which have occurred by mistake, oversight, or inadvertence, or even in the want of the requisite skill in the preparation and presentation of the case to the office, and the making of such amendments should not be allowed to operate to the prejudice of the claim or claims of the applicant if made in due and reasonable time and in good faith. In many cases the necessity for amendments to supply omissions and defects is not discovered until the application and specification have been subjected to the critical examinations of the experts of the office, and both the statute law and the Rules of Practice contem-

plate the making of all necessary amendments and alterations to supply defects and omissions in the presentation of the case, and where amendments have been allowed it should be presumed that they were properly allowed and upon satisfactory showing to the office that it was by mistake, oversight, inadvertence, or want of sufficient skill in the preparation of the application that the omission or defects had occurred and not by design to present a new and essentially different claim to invention from that described in the original application made for the purpose of overreaching and defeating a rival invention.

The subject of amendment, with its proper limitations, is treated in very clear terms in the case of *Ex parte Snyder*, 22 O. G., 1975, 1882.

In that case it was said by Mr. Commissioner Marble that—  
“the applicant will not be permitted, under the guise of an amendment, to introduce into his application a wholly different invention, nor to change the construction and operation of an invention which has been fully described and shown, nor to present a different or preferable form of his invention. He may be permitted, upon proper occasion, to supply suitable connections, to add a spring to a pawl, a handle to a crank, a belt to a pulley, teeth to a wheel, an outlet to a closed receptacle, or other manifest defects or omissions in features essential to the operation of the invention or to the completeness of the disclosure and which were caused by a clerical error of the draftsman or the unfamiliarity of the inventor with official forms. These amendments, supplemental in their nature, may be made as completing the invention imperfectly shown and described. They add to the invention disclosed some part or feature which agrees with the construction and operation already presented.”

See also *Railway Co. v. Sayles*, 97 U. S. 563.

The amendments allowed in the present case would seem to be clearly embraced within the principle and illustrations furnished by the case from which we have quoted. Such amendments as were allowed in this case did not present the case of new and essentially independent claims to invention, such as were inadmissible under the general power of amendment. \* \* \*

[See also, for example, *In re Dilg*, 25 App. Cas. D. C. 9, 115 O. G. 1067, 1905 C. D. 620.]

[For interesting discussion of power of commissioner and that a requirement of division is action on the merits and reviewable through regular line of appeals. See *United States ex rel. Steinmetz v. Allen*, 192 U. S. 543, 48 L. ed. 555, 24 Sup. Ct. 416; and for interesting history of the renewal statutes and reversal of long continued practice limiting to one renewal and providing that there may be any number if all within two years, see *Ex parte Lambert*, 135 O. G. 1581, 1908 C. D. 187, and *In re Lambert*, 135 O. G. 1584, 1908 C. D. 303.]



**813. SNIDER v. BUNNELL, 101 O. G. 2572, 1902 C. D. 460.**

Allen, Commissioner:

When this case came on to be heard upon an appeal from the decision of the Examiners-in-Chief on the question of priority of invention, it was found that attention had been called by them to the fact that in their opinion:

1. Snider has no right to make the claim in issue;
2. There is no interference in fact, and
3. There was irregularity in the declaration of interference.

There are preliminary questions which should be determined before proceeding to decide the question of priority of invention. *Oliver v. Felbel*, 100 O. G. 2384.

In addition to the above questions, counsel for Bunnell have raised the question whether Snider's application was altered after being sworn to, in violation of Rule 31, and have asked that this matter be referred to the Primary Examiner for consideration. Snider is the junior party to the interference, and since no decision on priority in his favor can be based upon his filing date, but only upon evidence of prior invention by him, the question whether his application was altered is an *ex parte* one, which can affect only his rights. He may be the prior inventor and entitled to receive a patent upon a formal application, even if his present application is informal. In other words, the objection does not go to the merits of the interference or of Snider's claim.

The question of striking Snider's application from the files because altered after being sworn to is furthermore not a matter for action by the Primary Examiner, but is exclusively within the jurisdiction of the Commissioner. If the interference proceeds and he is found to be the prior inventor, the question whether or not it will be necessary for him to file a new application to secure the claims will be considered.

Proceedings are suspended, and the interference is remanded to the Primary Examiner, under Rule 126, to consider the matters to which attention has been called by the Examiners-in-Chief.

[The following under this heading are brief extracts to complete the discussion.]

**314. DOBSON v. LEES, 137 U. S. 258, 34 L. ed. 652, 11 Sup. Ct. 71.**

The court could not distinguish between the patentee and his counsel as to what occurred during the pendency of the application for the patent, and, as to the acceptance by the latter, the patentee must be regarded as bound by the acts of his counsel.

**315. EASTMAN v. NEW YORK, 134 Fed. 844, 69 C. C. A. 628.**

It will hardly be contended that the mistaken advice of a patent solicitor can override a statute of the United States.

**316. BOYDEN v. BURKE**, 14 How. (U. S.) 575, 14 L. ed. 548.

The defendant [Commissioner of Patents] was not justified in refusing this demand on account of the former misconduct of the plaintiff or to enforce an apology by withholding rights. Ill manners or bad temper do not work a forfeiture of men's civil rights.

**317. JENNER v. BOWEN**, 139 Fed. 556, 71 C. C. A. 540.

[In December, 1893, the inventor became insane.] At this crisis there remained three months' time during which an application might have been filed, if there had been any one legally capable of making an application. The trouble was that there was then no law authorizing the guardian to file an application for a patent upon an invention made by an insane person. The law which for the first time took cognizance of such a situation was passed Feb. 28, 1899, c. 227, 30 Stat. 915. \* \* \* The act of that date amended section 4896, Rev. St., which authorizes the administrator or executor of a deceased inventor to file an application for an invention, made by his intestate or testator, by providing that the guardian of an insane person might file an application upon an invention made by such person before his insanity. The last clause of that act provides that it "is to cover all applications now on file in the Patent Office or which may be hereafter made." Jenner, as guardian, at date of this act had on file an application for a patent upon Biedinger's invention. \* \* \* There was no authority of law for its filing at the time it was filed, but that trouble, we shall assume, was cured by the retroactive effect of the act of 1899. But as the date of that application was November 20, 1895, we are confronted with the fact that at that date the invention of Biedinger had been in public use for more than three years. \* \* \* Congress having created the monopoly, may put such restrictions upon it as it pleases. Having made no exception in favor of an insane person, we can make none.

**318. KIRCHBERGER v. AMERICAN, ETC., BURNER CO.**, 128 Fed. 599, 64 C. C. A. 107.

(1) The amendment was filed within three months after the filing of the original specifications, and before, so far as appears, other inventors whose rights had been prejudiced had entered the field. *Railway v. Sayles*, 97 U. S. 554, 24 L. ed. 1053. (2) The original drawings and specification sufficiently show and suggest the claims finally made, or at least are not inconsistent therewith. *Hobbs v. Beach*, 180 U. S. 383, 45 L. ed. 586. (3) Subject to the foregoing rules, an inventor may amend his specification so as to include therein all of the advantages within the scope of his invention. *Singer Mfg. Co. v. Cramer*, 109 Fed. 652, 658, 48 C. C. A. 588.



**319. EAGLETON MFG. v. WEST, ETC., MFG. CO.**, 111 U. S. 490, 28 L. ed. 493, 4 Sup. Ct. 593.

In view of the entire change in the specification, as to the invention described, the patent, to be valid, should have been granted on an application made and sworn to by the administratrix. \* \* \* The specification, as issued, bears the signature of Eagleton and not of the administratrix, and it is sufficiently shown that the patent was granted on the application and oath of Eagleton, and for an invention which he never made.

**320. AMERICAN LAVA CO. v. STEWARD**, 155 Fed. 731, 84 C. C. A. 157.

The changes made in the application were manifestly to develop the newly conceived theory of the mode of operation, and to add claims for the process. If this was to be accomplished and the theory were to be embodied in practical means, the specifications should have been made to distinctly point out such means, as we have already pointed out. But in that regard the former specifications were retained. If the application as amended were to be construed as embodying such an invention as is now claimed, it was another and different invention from that for which the patent was originally sought, and, if an amendment having that consequence were permissible it should have been verified by the oath of the inventor.

**321. HILL v. WOOSTER**, 132 U. S. 693, 33 L. ed. 502, 10 Sup. Ct. 228.

The provision of section 4915 is that the circuit court may adjudge that the applicant "is entitled according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear;" and that, if the adjudication is in favor of the right of the applicant, it shall authorize the commissioner to issue the patent. It necessarily follows that no adjudication can be made in favor of the applicant, unless the alleged invention for which a patent is sought is a patentable invention. The litigation between the parties on this bill cannot be concluded by solely determining an issue as to which of them in fact first made a cabinet creamery. A determination of that issue alone, in favor of the applicant, carrying with it, as it does, authority to the commissioner to issue a patent to him for the claims in interference would necessarily give the sanction of the court to the patentability of the invention involved.

**322. WESTERN ELECTRIC CO. v. NORTH ELECTRIC CO.**, 135 Fed. 79, 67 C. C. A. 553.

The full six months are allowed by the statute to the applicant, and it can hardly be supposed that Congress intended that this

period could be cut short by the exigencies of the Patent Office.  
\* \* \* Again, the statute declares that, if the final fee is not paid within the six months, the patent shall be withheld, but it does not declare that, if not dated as directed, the patent shall not issue, or, if issued, shall be void. [See Part IX.]

**323.** KENNEDY v. HAZELTON, 128 U. S. 667, 32 L. ed. 576, 9 Sup. Ct. 202.

The patent law makes it essential to the validity of a patent that it shall be granted on the application, supported by the oath of the original and first inventor (or of his executor or administrator) whether the patent is issued to him or to his assignee. A patent which is not supported by the oath of the inventor, but applied for by one who is not the inventor, is unauthorized by law, and void, and whether taken out in the name of the applicant or of any assignee of his, confers no rights as against the public.

**324.** ECONOMY, ETC., HEATER CO. v. LAMPREY BOILER, ETC., CO., 65 Fed. Rep. 1000, 13 C. C. A. 271.

The final fee for a patent must be paid as prescribed by R. S. sec. 4897 within six calendar months.

[Upon the many points of practice in the Patent Office see Underwood's Digest. In the majority of cases the Rules of Practice themselves set forth the broad lines of procedure. A few cases which have been excerpted cover some of the broad principles of construction which have guided the Patent Office.

It will be observed that the office deals with the inventor, except where there has been an assignment of the entire interest or an assignment of an undivided part.

The rules specifically provide for the procedure in case of the death of the inventor or applicant and for the issuance of a patent to an assignee or to the heirs or representatives of an applicant.

All applications are kept in secrecy under the Rules of Practice (15). Provision, however, has been made for access to such applications upon a reasonable suggestion of necessity, but the general rule is that the Commissioner is not obliged to disclose the secret of a pending application.

Upon the matter of division there has been a wide range of procedure, the present practice resting almost solely upon the classification of claims. Since *Steinmetz v. Allen*, supra, however, the requirement of division has been considered an action upon the merits upon which appeal may be taken.

In recent works on patents the authors have stated that the Patent provides for the admission of new matter into an application supported by supplemental oath. Nothing could be further the mark. It is an important feature of the Patent



Office practice that no new matter is permitted to be inserted in the application and that even claims for subject-matter clearly shown and described must, if they are upon a different line from the claims originally filed, be supported by a supplementary oath.

The kind of amendment which is within the rule was well stated by Commissioner Marble in *Ex parte Snyder*, 22 O. G. 1975, 1882 C. D. 22, as follows:

"The applicant will not be permitted under the guise of an amendment to introduce into his application a wholly different invention, nor to change the construction and operation of an invention which has been fully described and shown, nor to present a different or preferable form of his invention. He may be permitted, upon proper occasions, to supply suitable connections, to add a spring to a pawl, a handle to a crank, a belt to a pulley, teeth to a wheel, an outlet to a closed receptacle, or other manifest defects or omissions in features essential to the operation of the invention or to the completeness of the disclosure, and which were caused by a clerical error of the draughtsman or the unfamiliarity of the inventor with official forms."

Under Rule 75 has grown up a specific practice by which references showing and describing but not claiming an invention may be overcome by a verified showing. Some of the older decisions cover this matter clearly.

"It will be noted that this rule calls not for opinions, but for a showing of facts. If an applicant made sketches during invention or prior to the date purposed to be overcome, he should so state and produce and describe them; if the sketches were made and lost, and their contents remembered, they should be reproduced and furnished in place of the original. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures sufficiently clear to indicate definite conception of the invention were made, the witness should state as nearly as possible the language used by the inventor in imparting knowledge of the invention to others. *Ex parte Donovan*, 52 O. G. 309, citing *Gasser*, 1880 C. D. 94; *Saunders*, 1883 C. D. 23; and *Hunter*, 1889 C. D. 218. See also *Hurlbut*, 52 O. G. 1062; and for special points, *Boyer*, 49 O. G. 1895; *Eddleblute*, 52 O. G. 751; *Bonna*, 52 O. G. 751; *Reed v. Landman*, 55 O. G. 1275; *Keller*, 61 O. G. 1790.

The object of this rule is to be distinguished from that of rule 94 (2), which requires that an applicant rejected on a patent claiming the same invention shall file an affidavit that he made the invention before the patentee's application was filed. Such affidavit is preliminary to a contest of priority and therefore need not be an oath to facts. Under rule 75 there is no contest. The application claiming the invention is examined *ex parte*, and the showing is therefore

required in the only form feasible, that of an affidavit offering evidence that the applicant invented the subject-matter of the claims prior to the date of the publication or the disclosure of the invention to the office. While the decisions are exacting in requiring the best evidence, it is not necessary to prove actual "reduction to practice." The filing of an allowable application is a constructive reduction to practice, and an applicant may, in the oath required by rule 75, show that he had "completed" the invention; that is, that he reduced it to practice, or had such drawings, sketches, description, etc., of the invention as would constitute a full and clear disclosure of the completed invention, or had conceived and disclosed the invention and been reasonably diligent in perfecting it by filing his application."

For many years the rules permitting the Commissioner of Patents to revive abandoned applications upon a showing of unavoidable delay has been thought to be a matter of discretion wholly within the power of the Commissioner. In the case of *In re Mattullath*, 38 App. Cas. D. C. 497, 179 O. G. 853 (1902), however the Court of Appeals of the District of Columbia, have held that the action of the Commissioner was in effect a rejection and was reviewable by the court.]



## PART VI.

### COURT OF APPEALS, D. C.

**325. APPEALS FROM COMMISSIONER OF PATENTS. R. S. D. C., § 780 (R. S. U. S. Sup., Vol. 2 C. 74, Feb. 9, 1893).**

Sec. 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the supreme court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United 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 Commissioner of Patents in any interference case may appeal therefrom to said court of appeals. [For procedure see Secs. 4911-4914, Part VI.]

Sec. 250, Judicial Code. Any final judgment or decree of the court of appeals of the District of Columbia may be re-examined and affirmed, reversed, or modified by the Supreme Court of the United States, upon writ of error or appeal, in the following cases:

First. In cases in which the jurisdiction of the trial court is in issue; but when any such case is not otherwise reviewable in said Supreme Court, then the question of jurisdiction alone shall be certified to said Supreme Court for decision.

Second. In prize cases.

Third. In cases involving the construction or application of the Constitution of the United States, or the constitutionality of any law of the United States, or the validity or construction of any treaty made under its authority.

Fourth. In cases in which the constitution, or any law of a State, is claimed to be in contravention of the constitution of the United States.

Fifth. In cases in which the validity of any authority exercised under the United States, or the existence or scope of any power or duty of an officer of the United States is drawn in question.

Sixth. In cases in which the construction of any law of the United States is drawn in question by the defendant.

*Except as provided in the next succeeding section, the judgments and decrees of said court of appeals shall be final in all cases arising under the patent laws, the copyright laws, the revenue laws, the criminal laws, and in admiralty cases; and, except as provided in the next succeeding section, the judgments and decrees of said court of*

appeals shall be final in all cases not reviewable as hereinbefore provided.

Writs of error and appeals shall be taken within the same time, in the same manner, and under the same regulations as writs of error and appeals are taken from the circuit courts of appeals to the Supreme Court of the United States. [Succeeding section provides for writ of certiorari.]

326. IN RE HIEN, 166 U. S. 432, 41 L. ed. 1066, 17 Sup. Ct. 624. (1897)

Mr. Chief Justice Fuller delivered the opinion of the Court.

The Commissioner of Patents, in an interference proceeding between Philip Hien and one William A. Pungs, awarded priority of the invention in controversy to Pungs, June 9, 1894. Hien gave notice to the Commissioner, March 12, 1896, of an appeal from his decision, under section 4912 of the Revised Statutes, to the Court of Appeals for the District of Columbia, and filed his petition of appeal in that court, June 2, 1896, which was dismissed on the third day of the following December because the appeal was not taken within the time prescribed by the rules of the court. 77 O. G. 1600, 24 Wash. L. Rep. 827. December 12, 1896, Hien moved that his appeal be reinstated on the ground that the Court of Appeals had no authority to make the rules in question, which was denied. 78 O. G. 484, 25 Wash. L. Rep. 8. Hien then applied to this Court for leave to file a petition for a writ of mandamus; leave was granted; the petition filed; and a rule to show cause entered, to which return was duly made.

Section 780 of the Revised Statutes of the District of Columbia, approved June 22, 1874, reads:

“Sec. 780. The Supreme Court, sitting *in banc*, shall have jurisdiction of and shall hear and determine all appeals from the decisions of the Commissioner of Patents, in accordance with the provisions of sections forty-nine hundred and eleven to section forty-nine hundred and fifteen, inclusive, of chapter one. Title LX, of the Revised Statutes, “Patents, Trade-Marks, and Copyrights.”

The sections of the Revised Statutes thus referred to are as follows: \* \* \* [Recited Secs. 4911-4915. See Part V.]

Sections 6 and 9 of the act to establish the Court of Appeals for the District of Columbia, approved February 9, 1893 (26 Stat. 434, c. 74), provided:

“Sec. 6. That the said Court of Appeals shall establish a term of the court during each and every month in each year excepting the months of July and August, and it shall make such rules and regulations as may be necessary and proper for the transaction of the business to be brought before it, and for the time and method of the entry of appeals and for giving notice of appeals thereto from the Supreme



Court of the District of Columbia, and such other rules and regulations as may be necessary and proper in the premises.

"Sec. 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United 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 Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals."

By the act of July 30, 1894, 28 Stat. 160, c. 172, section 6 was amended so as to read as follows:

Sec. 6. That said Court of Appeals shall establish by rule of court such terms of the court in each year as to it may seem necessary: Provided, however, That there shall be at least three terms in each year, and it shall make such rules and regulations as may be necessary and proper for the transaction of its business and the taking of appeals to said court. \* \* \*

The Court of Appeals, June 5, 1893, promulgated a set of rules, among which were these:

"Rule IX.—1. No order, judgment, or decree of the Supreme Court of the District of Columbia, or of any justice thereof, shall be reviewed by the Court of Appeals, unless the appeal shall be taken within twenty days, Sundays excluded, after the order, judgment, or decree complained of shall have been made or pronounced.

"Rule XIX.—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."

The Commissioner of Patents issued an order May 16, 1894, that—

"all Examiners are hereby directed to withhold from issue the application of the prevailing party in interference cases for thirty days from the date of final issue in order that an appeal may be taken to the Court of Appeals of the District of Columbia, if desired."

This order was published in The Official Gazette of June 5, 1894 (67 O. G. 1195.)

The Court of Appeals promulgated a new set of rules September 29, 1894, of which Rule XX related to appeals from the Commissioner of Patents, the second subdivision reading thus:

"XX.—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 afterward."

The order of May 6, 1894, was modified by the Commissioner, April 27, 1896, so as to direct the Examiners to withhold from issue the application of the prevailing party in interference cases for forty-five days from the date of the final decision.

The contention is that the Court of Appeals of the District of Columbia was without authority to promulgate a rule limiting the time of taking appeals from the decisions of the Commissioner of Patents; and that, by analogy, two years were allowed therefor in view of section 4894 of the Revised Statutes.

The general rule undoubtedly is that courts of justice possess the inherent power to make and frame reasonable rules not conflicting with express statute; but apart from that we think it clear that the Court of Appeals was duly authorized by section 6 of the act creating the court, as well as by section 6 as amended by the act of July 30, 1894, to make rules limiting the time of taking appeals to the court from the decisions of the Commissioner of Patents. Since by section 9 the Court of Appeals was vested with authority to review such decisions, we do not think it can properly be held that under the original act the authority in respect of appeals was limited only to appeals from the Supreme Court of the District of Columbia, or to the conduct of appeals after they had come before the appellate court.

Of the rules of June 5, 1893, Rule XIX is to be read with Rule IX, as limiting the time of appeals to the court from the decisions of the Commissioner to twenty days, exclusive of Sundays, which time was enlarged to forty days by Rule XX, promulgated September 29, 1894, the rule specifically declaring that such appeals could not be taken after the expiration of the time prescribed.

And if the original act were not so comprehensive as above indicated, the result would be the same under the amendatory act, in respect of the power imparted by which there can be no question. The petitioner complied neither with the rule of June 5, 1893, nor with the rule of September 29, 1894, and if not governed by the former was certainly subject to the latter, for although this was promulgated after the decision of the Commissioner of Patents in the case, the Court of Appeals was quite right in holding that—  
"the right of appeal is not a vested right that may not be altered by statute, or by rule of court made in pursuance of statutory authority to enact such rules."

In compliance with section 4912 of the Revised Statutes, Hien gave notice to the Commissioner of Patents, under date May 12,



1896, of an appeal from his decision to the Court of Appeals, and filed his petition, under the rule, on June 2. These proceedings, if they had been in time, amounted to the taking of an appeal, but as they were not initiated and prosecuted within the time limited, they were ineffectual. We have no doubt that the Court of Appeals had authority, in regulating the taking of appeals, to limit the time in which the conditions of such taking had to be performed; and that there was no restriction thereon by reason of section 4894 of the Revised Statutes as contended.

That section is as follows:

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

This has no relation to the limitation on appeals under section 4911, but has reference solely to the abandonment of an application by failure to prosecute it.

In *Gandy v. Marble*, 39 O. G. 1423, 122 U. S. 432, which was a bill in equity under section 4915 of the Revised Statutes, to obtain an adjudication in favor of the granting of a patent, we held that while such a proceeding was a suit according to the ordinary course of equity practice and procedure, and not a technical appeal from the Patent Office, confined to the case as made in the record of that office, yet that the requirement of section 4894 that the application should be regarded as abandoned if the applicant failed to prosecute the same within two years after any action therein, of which notice should have been given him, unless it were—

“shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable—”

was applicable, and that the Court could not adjudge that the applicant was entitled, “according to law, to receive a patent,” unless he showed to the satisfaction of the Court that the delay of two years “was unavoidable, under an allegation to that effect in the bill.” It was held that the bill in equity was *sub modo* a branch of the application for the patent, and was governed by the rule as to laches and delay declared by section 4894. But this had nothing to do with the time within which an appeal from the Commissioner of Patents must be taken, but merely decided that a bill in equity under section 4915 would be defeated where the application had been abandoned in the Patent Office under section 4894.

The bill in equity provided for by section 4915 is wholly different from the proceeding by appeal from the decision of the Commissioner

under consideration in this case. The one is in the exercise of original, the other, of appellate, jurisdiction.

The court under section 4914, on petition, is to hear and determine the appeal and to revise the decision appealed from in a summary way—

“upon the evidence produced before the Commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal.”

Section 4915 provides, as to the remedy by bill in equity, that—  
“the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention as specified in his claim, or for any part thereof, as the facts in the case may appear.”

In *Butterworth v. Hoe*, 29 O. G. 615, 112 U. S. 150, 161, this court distinguished the proceeding by bill in equity under section 4915 from an appeal under section 4911, and said:

“This means a proceeding in a court of the United States having original equity jurisdiction under the patent laws, according to the ordinary course of equity practice and procedure. It is not a technical appeal from the Patent Office, like that authorized in section 4911, confined to the case as made in the record of that office, but is prepared and heard upon all competent evidence adduced and upon the whole merits.”

This being so, section 4894 was inapplicable, and the power of the Court of Appeals to limit the time of appeal was not affected thereby.

Writ denied.



## PART VII.

### DESIGNS.

Statutes and Rules of Practice—Comparison of Statutes—General Definitions, etc.

#### STATUTES.

#### 327. PATENTS FOR DESIGNS AUTHORIZED.

Sec. 4929. 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 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, may, upon payment of the fees required by law and other due proceedings had, the same as in cases of invention or discoveries covered by section forty-eight hundred and eighty-six, obtain a patent therefor.

#### 328. MODELS OF DESIGNS.

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

#### 329. DURATION OF PATENTS FOR DESIGNS.

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

[Sec. 4932 provides for extension of design patents prior to March 2, 1861.]

#### 330. PATENTS FOR DESIGNS SUBJECT TO GENERAL RULES OF PATENT LAW.

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

**331. UNAUTHORIZED USE OF PATENTED DESIGN UNLAWFUL—PENALTY—SUITS.**

Chap. 105.—An act to amend the law relating to patents, trademarks, and copyrights. Act Feb. 4, 1887, U. S. Stat., XXIV, pp. 387, 388.

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

**332. REMEDY BY EXISTING LAW NOT IMPAIRED.**

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

**RULES OF PRACTICE.**

[Rules 79-84 substantially follow the statutes with suggestions similar to the procedure for mechanical applications.]

**333. SMITH v. WHITMAN SADDLE CO., 148 U. S. 674, 37 L. ed. 606, 13 Sup. Ct. 768 (1893, Design Patent No. 10,844).**

Mr. Chief Justice Fuller, after stating the facts, delivered the opinion of the court: \* \* \*

The first three of these classes [recited in the statute] plainly refer to ornament, or to ornament and utility, and the last to new shapes or forms of manufactured articles; and it is under the latter clause that this patent was granted.



In *Gorham Manufacturing Co. v. White*, 14 Wall. 511, 524, it was said by this court, speaking through Mr. Justice Strong, that the acts of congress authorizing the granting of patents for designs contemplated "not so much utility as appearance, and that, not an abstract impression or picture, but an aspect given to those objects mentioned in the acts. \* \* \* And the thing invented or produced, for which a patent is given, is that which gives a peculiar or distinctive appearance to the manufacture or articles to which it may be applied, or to which it gives form. The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public. It therefore proposes to secure for a limited time to the ingenious producer of those appearances the advantages flowing from them. Manifestly the mode in which those appearances are produced has very little, if anything, to do with giving increased salableness to the article. It is the appearance itself which attracts attention, and calls out favor or dislike. It is the appearance itself, therefore, no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense." This language was used in reference to ornamentation merely, and, moreover, the word "useful," which is in section 4929, was not contained in the act of 1842, under which the patent in *Gorham Mfg. Co. v. White* was granted; so that now where a new and original shape or configuration of an article of manufacture is claimed, its utility may be also an element for consideration. *Lehnbeuter v. Holthaus*, 105 U. S. 94.

But, as remarked by Mr. Justice Brown, then district judge for the eastern district of Michigan, in *Northrup v. Adams*, 12 O. G. 430, 2 Ban. & A. 567, which was a bill for the infringement of a design patent for a cheese safe, the law applicable to design patents "does not materially differ from that in cases of mechanical patents, and 'all the regulations and provisions which apply to the obtaining or protection of patents for inventions or discoveries \* \* \* shall apply to patents for designs.' Section 4933." And he added: "To entitle a party to the benefit of the act, in either case there must be originality, and the exercise of the inventive faculty. In the one there must be novelty and utility; in the other, originality and beauty. Mere mechanical skill is insufficient. There must be something akin to genius,—an effort of the brain as well as the hand. The adaptation of old devices or forms to new purposes, however convenient, useful, or beautiful they may be in their new role, is not invention." Many illustrations are referred to,—as, for instance, the use of a model of the Centennial building for paper weights and ink stands: the thrusting of a gas pipe through the leg and arm of the statue of a shepherd boy, for the purpose of a drop light; the painting upon

a familiar vase of a copy of Stuart's portrait of Washington,—none of which were patentable, because the elements of the combination were old. The shape produced must be the result of industry, effort, genius, or expense, and new and original as applied to articles of manufacture. *Foster v. Crossin*, 44 Fed. Rep. 62. The exercise of the inventive or originative faculty is required, and a person cannot be permitted to select an existing form, and simply put it to a new use, any more than he can be permitted to take a patent for the mere double use of a machine. If, however, the selection and adaptation of an existing form is more than the exercise of the imitative faculty, and the result is in effect a new creation, the design may be patentable.

In *Jennings v. Kibbe*, 10 Fed. Rep. 669, 20 Blatchf. 353, Mr. Justice Blatchford, when circuit judge, applied the rule laid down in *Gorham Mfg. Co. v. White*, supra, stating it thus: That "the true test of identity of design is sameness of appearance,—in other words, sameness of effect upon the eye; that it is not necessary that the appearance should be the same to the eye of an expert, and that the test is the eye of an ordinary observer, the eyes of men generally, of observers of ordinary acuteness, bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give." *Ripley v. Glass Co.*, 49 Fed. Rep. 927.

In this case it appeared from the evidence that among other trees and saddles that were old in the prior art was one called the "Granger" tree, which had a cut-back pommel, and a low, broad cantle, and was well known; and another called the "Jenifer tree," or "Jenifer-McClellan" saddle, which was also well known, and had a high, prominent pommel, and a high-backed cantle, or hind protuberance, in the shape of a duck's tail.

The exhibits embrace, among others, a slotted Granger saddle, the Jenifer-McClellan, the Sullivan-Black-Granger tree, and the saddle sold by defendants; the latter being substantially the Granger saddle with the Jenifer cantle.

The saddle design described in the specification differs from the Granger saddle in the substitution of the Jenifer cantle for the low, broad cantle of the Granger tree. In other words, the front half of the Granger and the rear half of the Jenifer, or Jenifer-McClellan, make up the saddle in question, though it differs also from the Granger saddle in that it has a nearly perpendicular drop of some inches at the rear of the pommel, that is, distinctly more of a drop than the Granger saddle had.

The experienced judge by whom this case was decided conceded that the design of the patent in question did show prominent features of the Granger and Jenifer saddles, and united two halves of old trees, but he said: "A mechanic may take the legs of one stove,



and the cap of another, and the door of another, and make a new design which has no element of invention; but it does not follow that the result of the thought of a mechanic who has fused together two diverse shapes, which were made upon different principles, so that new lines and curves and a harmonious and novel whole are produced, which possesses a new grace, and which has a utility resultant from the new shape, exhibits no invention." And he held that this was effected by the patentee, and that the shape that he produced was, therefore, patentable. But we cannot concur in this view.

The evidence established that there were several hundred styles of saddles or saddletrees belonging to the prior art, and that it was customary for saddlers to vary the shape and appearance of saddletrees in numerous ways, according to the taste and fancy of the purchaser. And there was evidence tending to show that the Granger tree was sometimes made up with an open slot and sometimes without, and sometimes with the slot covered and padded at the top and sometimes covered with plain leather; while it clearly appeared that the Jenifer cantle was used upon a variety of saddles, as was the open slot. Nothing more was done in this instance (except as hereafter noted) than to put the two halves of these saddles together in the exercise of the ordinary skill of workmen of the trade, and in the way and manner ordinarily done. The presence or the absence of the central open slot was not material, and we do not think that the addition of a known cantle to a known saddle, in view of the fact that such use of the cantle was common, in itself involved genius or invention, or produced a patentable design. There was, however, a difference between the pommel of this saddle and the pommel of the Granger saddle, namely, the drop at the rear of the pommel, which is thus described in the specification: "The pommel, on its rear side, falls nearly perpendicularly for some inches, when it is joined by the line forming the profile of the seat. The straight inner side of the pommel (marked b) is joined at c by the line, C, of the seat." The specification further states: "The line from the front of the pommel, B, includes outward for some distance in a nearly straight line, m, before being rounded toward the rear to join the line, h, at the point where the stirrup strap is attached, to thus define the bottom line of the saddle, the outline given by line, m, from the pommel being the general form of the English saddletree known as the 'cut back.'"

The shape of the front end being old, the sharp drop of the pommel at the rear seems to constitute what was new and to be material. Now, the saddles of the defendants, while they have the slight curve drop at the rear of the pommel, similar to the Granger saddle, do not have the accentuated drop of the patent, which "falls nearly perpendicularly several inches," and has a "straight inner side." If, therefore, this drop were material to

the design, and rendered it patentable as a complete and integral whole, there was no infringement. As before said, the design of the patent had two features of difference as compared with the Granger saddle,—one the cantle, the other the drop; and unless there was infringement as to the latter there was none at all, since the saddle design of the patent does not otherwise differ from the old saddle with the old cantle added,—an addition frequently made. Moreover, that difference was so marked that in our judgment the defendants' saddle could not be mistaken for the saddle of the complainant.

There being no infringement, the decree must be reversed, and the cause remanded with a direction to dismiss the bill, and it is so ordered.

**334. ROWE v. BLODGETT, ETC., CO.,** 112 Fed. 61, 50 C. C. A. 120, (1901, Design Patent No. 26,587).

[Horse-shoe calk.]

\* \* \* Before Wallace and Lacombe, Circuit Judges.

Per Curiam. Several defenses were urged, but Judge Townsend at circuit held as follows:

"I decide this case upon the broader ground that patents for designs are intended to apply to matters of ornament, in which the utility depends upon the pleasing effect imparted to the eye, and not upon any new function. The advantage claimed by complainant for the increased flat surface afforded by the curved line, which is the essential feature of his patent, is to enhance the mechanical utility of the calk by thus making a stouter shoulder, which would not so readily become bruised out of shape, and which, therefore, could be more easily removed with a wrench, when worn, from the shoe. It is significant, in this connection, that the patentee first applied for this essential feature of downward projecting curved lines on the sides of the base, as a mechanical invention, which application was rejected, and that he then attempted to cover the same feature by a design patent. Design patents refer to appearance, not utility. Their object is to encourage works of art and decoration which appeal to the eye, to the aesthetic emotions, to the beautiful. A horseshoe calk is a mere bit of iron or steel, not intended for display, but for an obscure use, and adapted to be applied to the shoe of a horse for use in snow, ice, and mud. The question an examiner asks himself while investigating a device for a design patent is not 'What will it do?' but 'How does it look?' 'What new effect does it produce upon the eye?' The term 'useful,' in relation to designs, means adaptation to producing pleasant emotions. There must be 'originality and beauty. Mere mechanical skill is not sufficient.' *Northrup v. Adams*, 2 Ban. & A. 567, Fed.



Cas. No. 10,328, approved in *Smith v. Saddle Co.*, 148 U. S. 679, 13 Sup. Ct. 768, 37 L. ed. 606; *Ex parte Parkinson*, (1871) Dec. Com. Pat. 251."

We prefer to rest our affirmance on concurrence with these views. The practice of the patent office in issuing design patents seems not to have been uniform. Prior to 1871 it was "not only liberal, but lax," until, in a carefully considered opinion, Commissioner Leggett (*Ex parte Parkinson* [1871] Dec. Com. Pat. 251) conformed it to a construction of the law which subsequently found approval in the cases above cited. In another case, in 1873 (*In re Seaman*, 4 O. G. 691), the same commissioner indicated the test to be applied by examiners when an article of manufacture is presented with request for a design patent:

"Is its form, without reference to the function of the article, intended to be ornamental, and is the article itself a thing which may, for any practical purpose, have a merely ornamental, configuration, and therefore have, in that sense, sufficient utility to warrant the grant of a patent?"

It would seem from the patent in suit that this test is no longer applied, and that the practice of the office has again become "not only liberal, but lax."

There is nothing in the record to indicate that there is anything attractive about the appearance of the complainant's calk, or that the downward projecting curved lines appeal in any way to the eye, or serve to commend the article to purchasers, except for the suggestion that, seeing those lines, they will know the calk on which they appear is the product of the patentee, and not of some other maker. But the designers of articles of manufacture not otherwise entitled to receive design patents cannot justify the issuance of such patents on any theory that the design is a trade-mark.

The decree of the circuit court is affirmed, with costs.

335. *ROBERTS v. BENNETT*, 136 Fed. 193, 69 C. C. A. 533 (1905, Design Patent No. 25,927).

\* \* \*

Before Wallace, Lacombe, and Townsend, Circuit Judges.

Townsend, Circuit Judge. The decisive question herein was raised by defendant's exception to the denial of his request to instruct the jury to render a verdict for defendant upon the ground, inter alia, that the patent in suit showed no such invention as is requisite to sustain a design patent, and was not ornamental. \* \* \*

The patent is invalid for the following reasons:

1. Plaintiff's prior patent, No. 541,805, described, claimed and illustrated a metal basket, which, he says:

"Is designed to form a desirable substitute for the ordinary willow basket now used, \* \* \* adapted to contain about one bushel,

\* \* \* with a curved, upwardly extending bottom, \* \* \* with an annular exterior flange (at) the extreme upper end of the receptacle. \* \* \* Large handles may be secured by rivets or other means to the receptacle near the upper end thereof. The object of the invention is to provide a new and improved basket, which combines durability and strength with lightness," etc.

The drawings show a basket almost identical in shape, barring some negligible corrugations, with that shown in the design patent. If the plaintiff was entitled to any patent for the advantages claimed for such a construction, they were covered by the prior mechanical patent. "Functional utility entitled the patentee to the mechanical patent already discussed, but mere functional utility did not entitle him to a design patent for the same article." *Christopher C. Bradley v. Richard Eccles*, 126 Fed. 945, 61 C. C. A. 669; *Royal Metal Mfg. Co. v. Art Metal Works (C. C.)* 121 Fed. 128; *Id. (C. C. A.)* 130 Fed. 778.

2. There is nothing in the shape or construction of the basket of the patent in suit which "appeals in any way to the eye, or serves to commend it to purchasers and users as a thing of beauty." *Bradley v. Eccles*, supra. It is not useful as a design. "The term 'useful' in relation to designs means adaptation to producing pleasant emotions. There must be originality and beauty. Mere mechanical skill is not sufficient." *Rowe v. Blodgett & Clapp Co. (C.C.)* 103 Fed. 873, 874; *Bevin Bros. Mfg. Co. v. Starr (C. C.)* 114 Fed. 362; *Eaton v. Lewis (C. C.)* 115 Fed. 635, affirmed 127 Fed. 1018, 61 C. C. A. 562.

3. Irrespective of the fact that prior metal baskets of the same general shape shown were introduced at the trial, the court may take judicial notice of the conventional bushel basket, which the design patent is evidently intended to simulate in general shape, inwardly curved bottom, and handles. *Black Diamond Coal Mining Co. v. Excelsior Coal Co.*, 156 U. S. 611, 616, 15 Sup. Ct. 482, 39 L. ed. 553, and cases cited. In these circumstances it is unnecessary to discuss plaintiff's contention that the questions of novelty and patentability are not open for review in this court. Where the patent is void upon its face, or is shown to have been anticipated by prior patents, or when the presumption of novelty arising from the grant is overcome by proof of the prior art, and, as in this case, by facts of which the court may take judicial notice, it is the duty of the court to instruct the jury to that effect. *Black Diamond Coal Mining Co. v. Excelsior Coal Co.*, supra; *Market Street Cable Railway Co. v. Rowley*, 155 U. S. 621, 15 Sup. Ct. 224, 39 L. ed. 284, and cases cited.

The judgment is reversed, with costs.



**336. WILLIAMS CALK CO. v. KEMMERER ET AL.**, 145 Fed. 928, 76 C. C. A. 466 (1906, Design Patent No. 29,793 and Patent No. 666,583).

Before Dallas and Gray, Circuit Judges, and Cross, District Judge:

Cross, District Judge: On December 13, 1898, design letters patent No. 29,793, were issued to one John R. Williams for a new, useful, and original shape or configuration of a horseshoe calk, and on January 22, 1901, letters patent No. 666,583 were granted to said Williams for certain new and useful improvements in horseshoe calks, both of which patents were subsequently assigned to the complainant. The complainant has filed a bill alleging infringement of both of these patents, and asking the usual relief in such cases. The Circuit Court, on final hearing, dismissed the bill, with costs, both on the ground of the invalidity of the patents and because they had not been infringed.

We think the design patent is invalid. Section 4922 of the Revised Statutes [U. S. Comp. St. 1901, p. 3396] was not intended to embrace a patent for such a design as is set forth in the design letters patent under consideration. It was intended, in order that a design might be patentable, that it should of itself, as an artistic configuration, present something new and useful from an aesthetic point of view. Within the meaning of the act, there is nothing artistic, ornamental, or decorative in the design of a horseshoe calk; it is essentially a mechanical, and not an aesthetic, device. It is impossible to suppose that it should be bought or used because of its aesthetic features. Its success as a calk would depend upon its useful, and not its artistic, character. As was well said in *Rowe v. Blodgett & Clapp Co.* (C. C.) 103 Fed. 873:

“Design patents refer to appearance, not utility. \* \* \* [See No. 334. There must be ‘originality and beauty. Mere mechanical skill is not sufficient’.”

The views thus expressed by Judge Townsend were affirmed by the Circuit Court of Appeals for the Second Circuit in 112 Fed. 61, 50 C. C. A. 120, and fully express our own as to this patent. \* \* \*

**337. CALDWELL v. POWELL**, 73 Fed. 488, 19 C. C. A. 592 (1896).

Before Acheson, Circuit Judge, and Wales and Green District Judges.

Green, District Judge: This bill was filed to restrain the defendant from infringing a patented design. The design itself is for a badge or pin, and is of gold (or other metal) and enamel, triangular in shape, like a guidon, having upon the face a combination of red and blue colors, in two horizontal stripes or bars, and bearing the letters “U. P.” embossed thereon. This badge or pin was intended

mainly for the students in attendance at the University of Pennsylvania, and the colors on the badge are the well-known colors of that university. There is no question made as to the infringement of the design by the defendant. It is admitted.

The bill of complainant is in the usual form of such bills. \* \* \* The bill concludes with the usual prayer for injunction and other relief. To this bill the defendant has interposed a general demurrer; and, for causes of demurrer; the want of invention and of novelty in the conception and production of the design were assigned. On the argument of the cause in the court below, the demurrer was sustained, and the bill dismissed. From that decree this appeal is taken.

It is a general principle of equity pleading that, as a demurrer proceeds upon the ground that, admitting the facts stated in the bill to be true, the complainant is not entitled to the relief he seeks, all matters of fact which are stated in the bill are admitted by the demurrer, and can not be disputed in arguing the question whether the defense thereby made be good or not, and such admission extends to the whole manner and form in which it is here stated; or, to state the principle more concisely, every charge in the bill, well pleaded, is absolutely admitted by the demurrer. Treating the issue raised by the bill and demurrer simply as one of pleading, it would be difficult indeed to find the slightest ground for the justification of the demurrer. The bill is full, complete, and orderly in its statements of facts upon which the prayer for relief is based. It is not necessary to repeat again the averments and allegations, which have been already quoted at some length. The effect of the demurrer is to admit their truth. If so, stronger reasons for equitable relief could hardly be advanced.

But the defendant claims that the design itself, as described in the patent, shows absolutely no invention whatever. His insistence is that the badge or pin in question is in shape, or form, or general appearance, a mere copy of a well-known style of flag, commonly called a "guidon," and that the court will take judicial notice of this fact; and, (having such knowledge, it can not grant to the complainants any relief, for they utterly fail to show any cause for the interference of a court of equity. But can it be said by this court, upon demurrer, if it should find that a flag of the shape of a guidon is common and well known, that a badge or a pin, molded into a similar shape, bearing upon it, in combination, certain colors and letters, is not novel, and does not show invention? The statute which protects inventors requires the production of a new and pleasing design. The invention demanded consists in the conception and production of a design which can be so characterized. The design in this case is not to be found alone in the triangular shape, but rather in a conception which combines shape, colors, and letters. As



was pertinently said by Mr. Justice Bradley in *New York Belting & Packing Co. v. New Jersey Car Spring & Rubber Co.*, 137 U. S. 446-450, 11 Sup. Ct. 193:

“Whether or not the design is new, is a question of fact, which, whatever our impressions may be, we do not think it proper to determine, by taking judicial notice of the various designs which may have come under our observation. It is a question which may and should be raised by answer, and settled by proper proofs.”

We think, under the circumstances, the defendant should have been put to his answer in this case, and hence the decree below is reversed.

338. *BRITTON v. WHITE*, 61 Fed. 93, (1894, C. C. Conn. Design Patent No. 20670).

Townsend, District Judge. The bill in equity herein is brought for the infringement of design letters patent No. 20,670 granted April 14, 1891, to the complainants, for a design for a carriage lamp. The defenses are want of novelty, lack of patentable invention, and denial of infringement. The specification states that the invention relates to a design to be imparted to lamps, and consists of a novel shape and configuration. The complete lamp represents a tulip; the sides of the body part being so shaped as to represent the petals, the lower portion the calyx, and the downwardly extending portion the stem, of the flower. The cover of the lamp, by upwardly and outwardly extending projections, surmounted by a central spherical form, represents the pistil of the flower, or, taken alone, represents the tulip after its leaves have fallen; the projections resembling the calyx, and the spherical form the pistil. The claims of the patent are as follows:

(1) The design for lamps, consisting of the body part, A, substantially as shown. (2) The design for lamps, consisting of the upper part or cover, D, substantially as shown. (3) The design for lamps, consisting of the body part, A, and the upper part or cover, D, substantially as shown.

Complainants' lamp fitly embodies the design of a tulip. It consists of two parts, which represent a graceful, harmonious whole. That it found great favor in the eyes of the public, and had a large sale, is abundantly proved. The question is, has it the degree of novelty required to protect a patent for a design?

The file wrapper shows that the patent office rejected four of the original five claims, on the ground that an inventor could only have a claim for a unitary design, and subordinate claims for segregable and distinctive features; and that counsel for complainants amended the claims, and requested their allowance in the present shape, on the ground that the public would be readily deceived, either by a design consisting of the exact cover and a body slightly resem-

bling the body of the patented design, or by an exact copy of said body combined with a different cover. Defendant claims that these statements limit the second claim of the patent to a construction containing both features exactly, or the exact body and any style of cover, or the exact cover and a somewhat similar body. The patent office has allowed the separate claims. It does not seem that a mere statement by counsel of a reason why it was desirable to include them in a single patent should estop the patentee to claim what was clearly granted him under said patent. Separate claims for the entire design and for its separate parts were properly allowed. *Dobson v. Carpet Co.*, 114 U. S. 439, 446, 5 Sup. Ct. 945.

Defendant further claims that, admitting the novelty of the complete design, the state of the art shown by certain exhibits limits the construction of the patent to a claim for the design as an entirety. Defendant's exhibit, "L'Ecluse Lamp," shows a glass body of the exact shape covered by the first claim of the patent in suit, but without the metal calyxes at the base, and with downwardly extending ornaments not found in the patented design. This drawing is not accompanied by any printed description, but is contained in a pamphlet, which appears to be a mere trade circular of "Ch. De L'Ecluse, Paris." and which had been in the possession of one of defendant's witnesses since November, 1888. There is no evidence that it was ever actually published or intended for general use, or accessible to the public. Complainants objected to its introduction, on the ground that it was not such a printed publication as would anticipate a patent. The objection is well taken. *Rob. Pat.* §§ 325, 326; *Reeves v. Bridge Co.*, 5 Fish. Pat. Cas. 467, 468; *Fermentation Co. v. Koch*, 21 Fed. 587; *Parsons v. Colgate*, 15 Fed. 600; *In re Atterbury*, 9 O. G. 640.

Defendant's exhibit, "Saladee Lamp," is a rough wood cut of a carriage lamp, having the outlines of, and bearing a general resemblance to, a tulip, and having curved engraved lines at its base, printed in a bound volume entitled "The Coachmaker's Monthly Magazine. C. W. Saladee, Proprietor. New York, April, 1855," which had been in the possession of one of defendant's witnesses since 1873. The complainants objected to this exhibit also, on the ground that it was not a printed publication; and, furthermore, because it was not set up in the answer. I think the Saladee Coachmaker's Monthly Magazine is admissible as a printed publication, to show the state of the art. The number containing this lamp in question has printed on it, "New York, April, 1855," is bound up with other numbers for the years 1855 and 1856, and refers to its advertisements and gives terms therefor. It purports to be printed for general circulation, and is characterized as a publication by the witnesses for defendant. These circumstances furnish sufficient prima facie evidence of publication. *Rob. Pat.* § 328; *Reeves v.*



Bridge Co., *supra*; *In re Atterbury*, *supra*. While, therefore, the defendant could not derive any advantage from this evidence in support of a claim of lack of patentable novelty, the court may, in the light of said evidence, determine what, in the state of the art, was open to the patentee, and what his patent must, therefore, be construed to claim. *Rob. Pat.* § 1006; *Grier v. Wilt*, 120 U. S. 412, 429, 7 Sup. Ct. 718; *Seymour v. Osborne*, 11 Wall. (U. S.) 539; *Railroad v. Dubois*, 12 Wall. (U. S.) 47, 65; *Eachus v. Broomall*, 115 U. S. 429, 434, 6 Sup. Ct. 229.

Defendant's "Exhibit Beitschrift" shows a top whose general outlines suggest the top of the patent in suit. It does not embody either calyx or pistil, and is only material, if at all, upon the question of the novelty of the second claim.

It is unnecessary to consider the other exhibits introduced by defendant, except to say that those not excluded under the objections already considered show that upwardly extending covers of carriage lamps, and bodies resembling in outline the general shape of complainants' body, but not embodying the specific design, were known to the art prior to said patent. The indefinite, unsubstantiated evidence of prior use is insufficient to affect the validity of the patent. *Zane v. Peck*, 9 Fed. 101; *Lalance & G. Manuf'g Co. v. Habermann Manuf'g Co.*, 53 Fed. 375.

The objection to certain of defendant's exhibits that they are merely drawings, unaccompanied by a written description, and therefore not relevant upon the question of anticipation, is not well taken. The objection affects the weight of the evidence, not its admissibility. The decisions referred to by complainants were not rendered in cases of patents for designs. In the latter cases, the effect upon the eye being the chief thing to be considered, there is no reason why a mere drawing, in a proper case, should not be sufficient. *Ex parte Crouch*, 57 O. G. 845; *Dobson v. Dornan*, 118 U. S. 10, 6 Sup. Ct. 946. In the case of *Untermeyer v. Freund* (decided by the circuit court of appeals for the second circuit, October 17, 1893) 7 C. C. A. 183, 58 Fed. 205, the drawings considered by the court in determining the question of patentable invention were not accompanied by any description.

The idea of a flower, conventionalized so as to be symbolized in a lamp, was new, so far as appears from the state of the art shown to the court. Other designs were shown which were graceful, approaching in certain respects some single part of complainants' design, and some resembling the general outlines of complainants' lamp, but none which embodies the complete design covered by the patent. And, admitting over every objection, all designs, enlarged, improved, modified, and with one part of one lamp combined with a different part of another, there is nowhere to be found, in letterpress or cut, a suggestion of a flower, or of such a tulip design, as a

harmonious whole. The wood cut of the Saladee lamp is unaccompanied by letterpress description, and is so roughly and incompletely drawn as to leave it uncertain whether it was intended to imitate a tulip or to merely select a graceful design, such as is shown in the lamp in defendant's Art Journal Illustrated Catalogue.

A further consideration in support of the novelty and originality of this design has forcibly impressed my mind. The court, taking judicial notice of matters of common observation and knowledge finds that a tulip has no calyx. The outlines at the base of top and body of the patented design are not found in nature, but seem to have been the fanciful creation of the patentee. This circumstance seems to me to furnish strong intrinsic evidence in favor of his claim of an original combination or contribution of creative thought. It has been well said that in designs "it is the new and original appearance which constitutes mainly the contribution to the public which the law deems worthy of recompense." We are educated, in these later days, to admire, not the mere forms of the carpenter or molder, but the conventionalized forms which suggest the natural objects which they represent. *Gorham v. White*, 14 Wall. (U. S.) 511. The statement of Judge Robinson in his work on Patents (section 206) seems peculiarly appropriate to this case. He says: "The essence of a design resides in the idea of that configuration or ornamentation which constitutes the new appearance given."

The conclusion reached from these considerations is that the patented design is a meritorious one; that it is not limited by the prior state of the art, as shown; and that the claims for the separate top and body, as well as for the entire design, are valid, and should be sustained.

The defendant has manufactured two differently constructed lamps, which complainants claim infringe said patent. It does not seem necessary to discuss the claim that the top of the second lamp of defendant infringes the second claim of complainants' patent. The claim covers a central spherical form, surrounded by upwardly projecting curved representations of a calyx. Defendant's lamp has a flat cap, surrounded by a downwardly projecting circular rim, which separates it from upwardly projecting semi-circular grooves. There is no resemblance between the two, and no one would be likely to be deceived. The correspondence between the parties prior to the suit shows that complainants claimed that the top of both lamps manufactured by defendant infringed the patent in suit, and that the defendant admitted that the head or top of the first lamp "did conflict with their patent," and ceased from making them. It denied infringement as to the second lamp, but dropped it from its price list. Complainants insisted upon payment of the statutory penalty of \$250, and defendant declined to pay it, whereupon this suit was brought. Defendant's secretary, Wilmot, in his testimony, quali-



fied said admission by saying that he should have said that said top "seemed to conflict" with the patent in suit. I do not consider either admission as material, because, under the test applied to design patents, that which seems to conflict would ordinarily be an infringement; and, further, because a comparison of the two heads shows that the top of the defendant's first lamp seems to be a copy of the top part of complainants' lamp.

The vital question in the case is whether the defendant, by the manufacture of its first lamp, has infringed the patent in suit. Three witnesses for defendant—Boudren, Galle, and Fest—testify on this point. Boudren says, "There is so little similarity that nobody not an idiot could make a mistake." Galle says the designs do not resemble each other. Fest says, "I should think, in my experience, a purchaser could easily tell the difference." But Boudren is a lamp designer, a large stockholder in, and the superintendent of the defendant corporation. The other two witnesses are carriage or lamp designers, one of them being in the employ of a rival manufacturer. It does not appear that either of them ever sold a carriage or lamp to any one. It does not appear that Boudren ever had any experience to qualify him to testify on this point, other than from making sales of lamps on behalf of defendant corporation to trade buyers. Apart from other objections, this kind of evidence seems to be peculiarly within the class of expert testimony which has not found favor with the courts on the question of infringement of designs. It is not based upon experience in dealings with the ordinary purchaser, giving only such attention as such persons ordinarily give. It is based upon a theory emphasized, and liable to be biased, by the trained observation of the specialist. *Gorham v. White*, 14 Wall. (U. S.) 528. Inasmuch as the test of sameness is determined by the eye of the ordinary observer, I do not regard such testimony, from such expert designers, as of much importance. Six witnesses for complainants testify that the ordinary purchaser would be misled by said lamp, and would purchase it as one embodying complainants' design. Four of these witnesses were apparently disinterested persons, and neither they nor the two other interested witnesses were expert designers. They were experts only in the sense that they were constantly engaged in selling carriages to the ordinary public, whose testimony, founded upon their judgment and experience in such matters, might be of great assistance.

Apart from the effect of said testimony, the first impression received upon examination and comparison of the exhibits by the side of each other, was favorable to the defendant's claim that the ordinary purchaser would not be deceived. The complainants' exhibit, in all its details of construction, is more artistically constructed and finished. The defendant's exhibit has certain features—notably the extra downwardly projecting top, and the circular

ornaments at the bottom—not found in complainants' exhibit. The plain, spherical top of complainants' exhibit is flattened and ornamented in defendant's exhibit. The calyxes of the top are relatively larger in complainants' than in defendant's lamp. The plated divisions between the glass sections of complainants' lamp are more conspicuous than in defendant's lamp. Complainants' lamp has metal calyxes covering the bottom of the glass sides. Defendant's lamp has curved glass bottoms, filled out by the metal base. The bodies are dissimilar in shape. But the construction set forth in the specification and covered by the claims is not confined by such details of size, proportion, and ornament. It "consists of the novel shape and configuration." The test of infringement is whether ordinary purchasers would be likely to mistake the one design for the other, giving such attention as such a purchaser usually gives. *Gorham v. White*, supra; *Monroe v. Anderson*, 7 C. C. A. 272, 58 Fed. 398. I have already critically discussed the expert evidence, because it seems to me that the decision of the case may depend upon the definition of the "ordinary purchaser." If thereby is meant the trade purchaser of lamps, the claim is not infringed. He would not be deceived. I have treated this term as applicable to the general purchasing public, who buy a carriage with lamps under the ordinary condition under which such purchases are ordinarily made. In applying this test, the court should endeavor to place itself in the position of such purchaser, and to consider the accompanying conditions. The ordinary purchaser, in such a case, is not the dealer, who is presumably informed as to the various designs and their resemblances and differences. The ordinary purchaser sees the patented tulip lamp upon a carriage in the street, or among the complainants' stock of carriages. He examines other carriages in other warehouses and elsewhere, and sees defendant's lamp mounted above his head on the carriage. It has the pistil, the upper calyxes, the curved lines, corresponding to the lower calyxes, and an outwardly extending body. Every element is imitated, except the double curves of the glass. His eyes and attention, distracted by divers other considerations, are not critically directed to details of construction.

The manifest infringement of the upper part, substantially admitted by defendant; the only difference of construction therein—the flattened sphere—being one which would not be noticed from the point of view of the ordinary observer; the allegation that the infringing design was copied from that of complainants, undenied; the appropriation of the name "Tulip" by defendant for its second lamp; the apparent imitation of certain important details; the introduction of unessential variations; the adoption of curved lines simulating calyxes and petals,—these, together with the other circumstances, and the testimony, already considered, indicate that



the defendant intended so to imitate the patented design as to lead the ordinary purchaser to believe that he was getting complainants' lamp and that the suggested differences are colorable and not substantial.

The peculiar merit of the novel idea of thus symbolizing a flower, and its admitted popularity and utility, seem to entitle this design to a more liberal construction than would be applied where old and familiar devices for configuration and ornamentation are merely rearranged in new relations. This view is enforced by the above considerations as to the infringing design. The first claim, for the body part alone, is not infringed. The second claim, for the cover alone, is infringed by defendant's first lamp. If it were necessary to decide the point, I am inclined to adopt the views of the witnesses for complainants, and to hold that there is sufficient similarity between the body of defendant's first lamp and the body of the patented design, so that, when used in connection with the infringing cover, the third claim is infringed; although said body, without said cover, would not infringe. In view of the conclusions reached, an injunction against the infringement of the second claim will sufficiently protect the complainants in this case.

Let a decree be entered accordingly.

**339.** GIMBEL ET AL. v. HOGG, 97 Fed. 791, 38 C. C. A. 419. (1899, Design Patent No. 25,907).

Before Acheson, Dallas, and Gray, Circuit Judges.

Acheson, Circuit Judge: The bill charged the defendants below (here the appellants) with infringement of letters patent No. 25,907, issued on August 4, 1896, to Frederic M. Parker, assignor to William James Hogg (the complainant), for a design for carpets. The case was heard on bill and answer, and the Circuit Court, being "of opinion that a decree must be entered imposing the statutory penalty of \$250, under Act Feb. 4, 1887 (24 Stat. 387; Supp. Rev. Stat. 533), for each of the two acts of infringement," decrees accordingly. (C. C.) 94 Fed. 518. By the "two acts of infringement" is meant the infringement of the first and second claims of the patent.

The first section of the act of February 4, 1887, provides that, during the term of letters patent for a design, it shall be unlawful for any person, other than the owner of the letters patent, "without the license of such owner, to apply the design secured by such letters patent, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or to sell or expose for sale any article of manufacture to which such design or colorable imitation shall, without the license of the owner, have been applied, knowing that the same has been so applied;" and that any person "violating the provisions, or either of them, of this section, shall be liable in the amount of \$250;" and, in case his total profits from

such infringing manufacture or sale shall exceed that sum, he shall be further liable for the excess of such profit over and above the sum of \$250. And the second section provides that nothing contained in the act shall prevent, lessen, impair, or avoid any remedy, at law or in equity, which the owner of a design patent aggrieved by infringement might have had if this act had not been passed, but such owner shall not twice recover the profit made from the infringement.

In response to the allegations of the bill, the answer of the defendants explicitly denied that they ever applied the complainant's said design to carpeting, denied that they manufactured the carpeting complained of in the bill, and denied that the defendants ever exposed for sale or sold any carpeting knowing that the design thereof had been applied thereto without the license of the complainant, or with knowledge that in design or in any other respect it infringed upon any right of the complainant possessed by him under letters patent or otherwise. In respect to the transaction complained of, the answer sets forth that the defendants were not manufacturers of carpets, but dealers therein, as merchants, and buying from manufacturers or owners; that, having procured from the treasury department of the United States a contract to supply it with Brussels carpet for the fiscal year ending June 1, 1898, they obtained bids from various manufacturers to supply them with the carpets needed, and the lowest bidder was James W. Barker, of Norristown, Pa.; that the defendants accepted his bid, and on or about September 1, 1897, gave him an order for the carpets needed, and asked for samples, which he furnished, and which the defendants submitted to the government officials; that among these samples was one containing the design here in question, and which design, among others, the government officials accepted, and directed the defendants to furnish the government about 1,500 yards of carpet, and about 200 yards of border, embodying said design; that thereupon the defendants instructed Barker, under his contract with them, to make and ship to Washington about 1,500 yards of carpet and 200 yards of border of said design; and that accordingly Barker furnished a portion of the carpet and border thus ordered, but, by reason of his business failure in December, 1897, did not complete the delivery. The answer avers that in giving this order to Barker the defendants "acted in entire ignorance of the fact that the carpet and border infringed upon the complainant's right in any way," and that they "were ignorant of any patent, or claim to patent, upon such design held by complainant." And, further answering the bill, the defendants averred as follows: "The carpeting and border sold by us of which complaint is made was not manufactured by us. It was sold by us in absolute ignorance that it infringed in any way upon any design owned by the complainant, or by any



other person. It was sold by us in entire good faith, after having received the same from the manufacturer by whom it was manufactured without any knowledge or information by us as to the source of its design or the method of its manufacture." The answer also denies that any damages accrued to the complainant by reason of what was done, or that the defendants derived any profit whatever from the use of his design. All the above-recited denials and averments made by the defendants are responsive to the bill, and are to be accepted as true, in the absence of evidence to the contrary. There is none here. The complainant set the case down for hearing on bill and answer.

Under the act of February 4, 1887, the fixed sum of \$250 is in the nature of a penalty. Now if, upon the facts of the case, the defendants are amenable to the penal provisions of this act, one penalty only, we think, is recoverable here. The patent is for a single design. It is true that, in order to protect the patentee from any form of infringement, the patent has three claims,—the first claim covering the design as applied to the body of the carpet, the second claim covering the design as applied to the border, and the third claim reading thus: "The design for carpets, consisting of the body, A; and the border, B, substantially as shown." Here there was infringement of the third claim. As is usual in the purchase of carpeting, the order and sale in question embraced the body of the carpet and its border. There was, however, only one order and sale. It was a single transaction. In no view, then, that can be taken of the case, are the defendants to be subjected to two penalties.

But are the defendants amenable at all to the penal provisions of the statute? They were not manufacturers of this carpeting. They did not apply the patented design thereto. Barker, who was a manufacturer of carpets generally, made this particular carpeting, and applied to it the complainant's design. Undoubtedly, he incurred the pecuniary penalty imposed by the act. He was the sole manufacturer, and the defendants were his vendees, and nothing more. There is no basis for the argument that the defendant and Barker stood to each other in the relation of principal and agent. Under the circumstances, the defendants are not responsible for Barker's unlicensed act in applying the complainant's design, by reason of their having given the order to him to make and ship 1,700 yards of carpeting according to the pattern the government officials had chosen out of the samples Barker had submitted. The case is the same as if the carpeting had already been made and was in stock when ordered. In law and in fact, the defendants were simply purchasers from the manufacturer and sellers to the government. In making the sale, the defendants acted in perfect good faith, in utter ignorance of any infringement of any patent

rights, and without any knowledge whatever that the manufacturer had applied to the carpeting the complainant's design without license. We are, then, of opinion that the defendants are not chargeable with any penalty, under the act of February 4, 1887.

By the plain terms of the statute, the penalty is incurred by the seller of an article to which a patented design has been applied without license, only where he sells "knowing that the same has been so applied." The statutory punishment is for infringing knowingly. Clearly, it was not intended to subject to a penalty a vendor acting in good faith, and selling in entire ignorance of any infringement perpetrated by the manufacturer. For the infliction of the penalty, the statute contemplates and requires knowledge by the seller of the unauthorized use of the design by the manufacturer. Such knowledge is not to be imputed to the seller from the "notice to the public" by the marking required of the patentee by section 4900, Rev. Stat. It may be reasonable enough to hold such constructive notice sufficient as against the manufacturer who applied the design; for, if he did so without license, he must have known the fact. *Pirkl v. Smith*, (C. C.) 42 Fed. 410, 411. But the public notice by marking, under section 4900, gives no information whatever to a seller of an infringement committed by the manufacturer, and that section has no such purpose. Certain cases to which our attention has been called, namely, *Dunlap v. Schofield*, 152 U. S. 244, 14 Sup. Ct. 576, *Smith v. Stewart*, (C. C.) 55 Fed. 481, and *Stewart v. Smith*, 7 C. C. A. 380, 58 Fed. 580, 17 U. S. App. 217, were suits against manufacturers. We find nothing decided or declared in those cases to justify a decree for a penalty, under the act of February 4, 1887, against the defendants in this bill, upon the undisputed facts.

The decree of the court below is reversed, with costs of the appeal to the appellants; and the case is remanded to the Circuit Court, with directions to enter a decree against the defendants for an injunction and nominal damages, with costs of the suit in the court below.

**340. GENERAL GASLIGHT CO v. MATCHLESS MFG. CO., 129 Fed. 137 (1904, C. C. N. Y. Design Patent No. 35,481).**

Hazel, District Judge. This is a bill for an alleged infringement of design patent No. 35,481, dated December 24, 1901, issued to Alfred H. Humphrey, and by him assigned to the complainant corporation. The specifications state that the invention relates to a design for gas lamps known as "cluster lights." The defenses chiefly relied upon are want of novelty and noninfringement. It is not seriously controverted that the design embodies features familiarly known, nearly all of which may in some form be found in pre-existing lamps. The proofs do not disclose the prior use of an



ornamental lamp similar in design to that described in the specifications. On the contrary, the evidence establishes that no lamp having the shape, configuration, or ornamentation of the lamp design in suit was previously known to the trade. The design patent in question is not for an ornament, pure and simple. The shape and configuration of the lamp also permit its classification as a useful article of manufacture. According to section 4929 of the Revised Statutes [U. S. Comp. Stat. 1901, p. 3398], the design must be a new and original invention produced by the industry, genius, effort, and expense of the inventor. Whether the design possesses the characteristics of originality and newness must largely, if not altogether, be determined by the visual impressions resulting from its appearance. *Matthews & Willard Mfg. Co. v. American Lamp & Brass Co.* (C. C.) 103 Fed. 634; *Pelouze Scale & Mfg. Co. v. American Cutlery Co.*, 102 Fed. 916, 43 C. C. A. 52; *Smith v. Stewart* (C. C.) 55 Fed. 481; *Untermeyer v. Freund* (C. C.) 37 Fed. 342. The shape and configuration of the lamp, in its entirety: the collocation of its mechanical features; the arrangement of the cluster lights and mantels; the contour and proportions of the bulbous globe; the two metal hands, with their twisted, plaited, and filigree ornamentation—contribute to the creation of a symmetrical form and pleasing appearance. The defendant contends that the prior art discloses substantially similar designs. It is also asserted that any additional elements or substituted features constituting complainant's patent accomplish an artistic result due solely to an assembling of parts obvious to any skilled designer, and not entitled to the dignity of invention. This contention is entitled to careful consideration. It is quite well settled, upon the authority of *Smith v. Whitman Saddle Co.*, 148 U. S. 674, 13 Sup. Ct. 768, 37 L. ed. 606, that the law which applies to a mechanical patent does not differ materially from that applicable to design patents. Hence originality and the exercise of the inventive faculty must be present in both instances. The mere adaptation of that which was old and familiarly known to new purposes is not invention, nor would the mere aggregation of known parts of other substantially similar designs to produce that under consideration constitute patentability. *Perry v. Starrett*, 3 B. & A. 485; *Simpson v. Davis* (C. C.) 12 Fed. 144, 20 Blatchf. 413; *Gorham Co. v. White*, 14 Wall. 511, 20 L. ed. 731. It is quite true that the record shows many lamps of ornamental and graceful appearance, which were known prior to the conception of the design lamp in suit. Furthermore the collocation of different parts of such designs is frequently used to enhance their appearance and salability. The caprice of fashion constantly demands something novel in the art under consideration. However that may be, the principle, as applied to design patents, is unassailable, that whenever ingenuity is displayed in producing something new, which imparts to the eye a

pleasing impression, even though it be the result of uniting old forms and parts, such production is a meritorious invention and entitled to protection. The evidence establishes beyond doubt that the lamp under consideration met with immediate favor from the public on account of its artistic construction. It appears from the evidence of the patentee that his object was to design a lamp peculiarly appropriate for a gas arc lamp of ornate appearance, which would resemble an electric lamp. He began his design in August, 1900, completing the same in October of that year. No other similar lamp, which when lighted appeared like an electric light, was then known. A number of witnesses familiar with gas lighting and the sale of gas lamps testified that there were no lamps on the market resembling the Humphrey design, which insures the illumination of large areas, while its ornate appearance and novel shape quickly achieved popularity. I have looked in vain through the illustrated catalogues submitted in evidence for lamps like that in suit. The prior art does not disclose a lamp in its entirety (and that must be the test of anticipation) which justifies declaring void the Humphrey patent, and thus negating the presumption of patentability secured to the inventor by the issuance of the patent. Every part used in the Humphrey design is trimmed and united in its construction with the sole object of forming a symmetrical and harmonious whole. This object was achieved as a result of effort, study, and skill, and it is therefore entitled to the dignity of invention.

The question of infringement: The defendant's lamp is apparently identical with that of complainant. There are a few minor differences in detail, but such differences are thought to be immaterial. *Gorham Mfg. Co. v. Watson* (C. C.) 74 Fed. 418; *Whittall v. Lowell Mfg. Co.* (C. C.) 79 Fed. 787; *Sagendorph v. Hughes* (C. C.) 95 Fed. 478; *Hutter v. Broome* (C. C.) 114 Fed. 655. The configuration, shape, and outline are the same, and only the closest inspection will disclose the slight difference of construction pointed out by the defendant at the argument.

Let a decree be entered for an injunction and accounting as prayed for in the complaint, with costs.

**341. CHARLES BOLDT CO. v. NIVISON-WEISKOPF CO.,** 194 Fed. 871 (C. C. A.) (1912).

Before Warrington and Knappen, Circuit Judges, and Sater, District Judge.

Slater, J.:

\* \* \* His claim is for the ornamental design for a bottle shown by the two figures appearing in his patent. The description and claim are sufficient. The purport of the description is that



what the drawings represent as a whole is the invention, and it is that which is claimed when applied to bottles. *Dobson v. Dornan*, 118 U. S. 10, 14, 6 Sup. Ct. 946, 30 L. ed. 63. \* \* \*

[1] This court, in *Soehner v. Favorite Stove & Range Co.*, 84 Fed. 182, 28 C. C. A. 317, and *Westinghouse v. Triumph Electric Co.*, 97 Fed. 99, 38 C. C. A. 65, assented to the doctrine that both novelty and the exercise of the inventive faculties are essential to the patentability of a design. The insistence, however, is that designs, excepting such as exhibit merely the imitative faculty or obtain a mechanical result and are therefore wanting in patentability, are patentable, if they are new and pleasing and increase the salability of the articles to which they respectively relate. A classification of decisions is attempted to show that this theory has prevailed excepting from about 1893 to 1900. During the excepted period the reported cases confessedly exact substantially as high an order of inventive genius for design patents as is required in mechanical patents. Numerous cases are cited, some of which tend to sustain complainant's theory. Others adopt the view that, in addition to novelty, pleasing effect, and increased salability, invention is prerequisite to patentability. Whatever confusion may have existed in the judicial minds of the lower courts as to the degree of invention essential to a valid design patent, *Smith v. Whitman Saddle Co.*, 148 U. S. 674, 679, 13 Sup. Ct. 768, 770, 37 L. ed. 606, forever put at rest all controversy on that subject by declaring that:

"The law applicable to design patents does not materially differ from that in cases of mechanical patents, and all the regulations and provisions which apply to the obtaining or protection of patents for inventions or discoveries \* \* \* shall apply to patents for designs. \* \* \* To entitle a party to the benefit of the act, in either case, there must be originality, and the exercise of the inventive faculty. In the one, there must be novelty and utility; in the other, 'originality and beauty. Mere mechanical skill is insufficient.' There must be something akin to genius—an effort of the brain as well as the hand. The adaptation of old devices or forms to new purposes, however convenient, useful, or beautiful they may be in their new role, is not invention."

[2] The issuance of a patent gives rise to the presumption that it involves both novelty and invention. The dismissal of the bill denied to the complainant the right to produce evidence to support that presumption. The question of want of novelty and invention, as disclosed by the specifications of a patent, may be raised, however, by demurrer by a defendant who is charged with infringing the alleged invention (*Richards v. Chase Elevator Co.*, 158 U. S. 299, 15 Sup. Ct. 831, 39 L. ed. 991; *Risdon Iron & Locomotive Works v. Medart*, 158 U. S. 68, 15 Sup. Ct. 745, 39 L. ed. 899; *American Fibre-Chamois Co. v. Buckskin-Fibre Co.* [C. C. A. 6])

72 Fed. 508, 18 C. C. A. 662), and in a clear case a court may dismiss the bill to establish the patent and enforce a remedy for its infringement (*Milner Seating Co. v. Yesbera* [C. C. A. 6] 111 Fed. 386, 49 C. C. A. 397; *Northwood v. Dalzell, Gilmore & Leighton Co.* [C. C. A. 6] 100 Fed. 98, 40 C. C. A. 295), and thus save the parties the expense and delay incident to litigation (*Strom v. Weir* [C. C. A. 6] 83 Fed. 170, 27 C. C. A. 502). Indeed, if the court can see that a patent is void on its face for want of invention, it need not look beyond it and may sua sponte adjudge it invalid, whether the defense of nonpatentability is made or not. *Slawson v. Grand Street, etc., R. R. Co.*, 107 U. S. 649, 2 Sup. Ct. 663, 27 L. ed. 576; *Brown v. Piper*, 91 U. S. 44, 23 L. ed. 200. But to justify sustaining a demurrer to an infringement bill, adopting the language of Judge Taft, speaking for this court in *American Fibre-Chamois Co. v. Buckskin-Fibre Co.*:

“The court must be able, from the statements on the face of the patent, and from the common and general knowledge already referred to, to say that the want of novelty and invention is so palpable that it is impossible that evidence of any kind could show the fact to be otherwise. Hence it must follow that, if the court has any doubt whatever with reference to the novelty or invention of that which is patented, it must overrule the demurrer, and give the complainant an opportunity, by proof, to support and justify the action of the patent office. This is the view which has been taken by the Supreme Court, and the most experienced patent judges upon the circuit.” \* \* \*

[3] The demurrer admits the well-pleaded averments of the bill, and therefore admits that complainant's bottle has gone into extensive use. It is earnestly argued that its salability creates a presumption of patentable novelty. Extensive or general use of the bottle is evidence of its utility, but it is not conclusive evidence in that respect, much less of its patentable novelty. Where there is no invention, the extent of the use is not a matter of moment. *McClain v. Ortmyer*, 141 U. S. 419, 12 Sup. Ct. 76, 35 L. ed. 800; *Adams v. Bellaire Stamping Co.*, 141 U. S. 539, 12 Sup. Ct. 66, 35 L. ed. 849; *Drake Castle Pressed Steel Lug Co. v. Brownell & Co.*, (C. C. A. 6) 123 Fed. 86, 89, 90, 59 C. C. A. 216. \* \* \*

**342. PHOENIX KNITTING WORKS v. HYGIENIC FLEECE UNDER-WEAR CO.**, 194 Fed. 696, (C. C. A.) (1912, Third Circuit Design Patent No. 39,347).

Before Gray, Buffington and Lanning, Circuit Judges.

Gray, J.:

\* \* \* Under the statute, as thus amended the patent sued on was issued, and its validity must be tested by the spirit and meaning of the legislative language. Whether the plain requirement of



the statute has been complied with, that the design should be new, original and ornamental, in order to be patentable, must be considered at the threshold of this case, as in every other. \* \* \*

In this connection, it should not pass unnoticed that section 4929 of the Revised Statutes (U. S. Comp Stat. 1901, p. 3398), before the amendment of May, 1902, spoke of any person who invented a "new and original design for a manufacture," the word "ornamental" being absent. It also included, as patentable, "any new, useful and original shape or configuration of any article of manufacture." It is apparent, therefore, that the language of the section, as amended, has restricted the scope of design patents as to shape and configuration, and it is not entirely clear what part, if any, shape and configuration may play as the basis for a design patent. However this may be, we have no difficulty in deciding, apart from the restrictions of the amended act, that, under the facts peculiar to this case, the design for which a patent was granted is confined to the surface ornamentation in the scarf proper, and does not extend to the configuration, including the narrow neck band, which is never visible when the scarf is in the position for which it was intended. \* \* \*

### 343.

[The patent referred to in the above case, No. 342, it should be observed, was held valid and infringed on motion for a preliminary injunction in *Phoenix Knitting Works v. Louer Bros.*, 194 Fed. 700 (C. C. N. D. Ill. 1910) and *Phoenix Knitting Works v. Hygienic Fleeced Underwear Co.*, 194 Fed. 702, (C. C. E. D. Penn. 1911); void for lack of invention and novelty in the above case (No. 342) and void for anticipation in *Phoenix Knitting Works v. Hygienic Fleeced Underwear Co.*, 194 Fed. 703, (C. C. E. D. Penn., 1911) and *Phoenix Knitting Works v. Rich et al.*, 194 Fed. 708, (C. C. N. D. Ohio, E. D., 1911)].

### 344. EX PARTE BETTENDORF, 127 O. G. 848, 1907 C. D. 79.

[Application for design for side frame for car-trucks, in which numerous distinctive features were present.]

"We are of opinion that its attractiveness to such men lies wholly in the apprehension of its utility, in its superior adaptation of its shapes to utilitarian ends. They see that the design is compact lengthwise by reason of the location of the journal-boxes against the end of the frame. They see that it is lowered by making the inverted-arch tires farther down from the bearings than the upper tires are distant from those bearings. So made the side bar is not only lower but is stronger. They see that a minimum of weight is attained by skeletonizing the side bar by two openings

near its ends and they see that in doing that the old upper truss and lower truss and the old guides are made with edge flanges which, as is well known, add strength to them. They also see here and there cross-webs, which, they well know, also add to the strength of the parts on which they are made and with which their ends are connected. All this makes the design attractive to them as practical men in the art.

“But we are of opinion that this utilitarian attractiveness is far from ornamentation. We find nothing beautiful or esthetic in the structure.”

This statement of the examiners-in-chief is entirely in accordance with my views. 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.

The principle stated in my decision in *Ex parte Knothe*, 1903, C. D. 42, 102 O. G. 1294, and reiterated in *Ex parte Nickel and Crane*, 1904, C. D. 135, 109 O. G. 2441, applies to this case. \* \* \* [See No. 344.]

I find nothing in the appearance of the design claimed by the appellant which commends itself to the eye or even suggests the beautiful.

[The following under this heading are brief extracts to complete the discussion.]

#### 345. EX PARTE KNOTHE, 102 O. G. 1294, 1903 C. D. 42.

[Citing many cases and refusing a patent on a design for a buckle having the corners of the frame and tongue made with sharp instead of rounded edges.]

A new and ornamental design will be found in an article of manufacture when there can be found in such article a new appearance created by inventive process and serving the purpose of embellishment. Such new appearance may be superficially applied or it may rest more or less deeply in the structure of the parts, but it must be a creation of inventive genius, accomplishing the purpose of ornament and not used for its functional value. It will be found, weighed and valued by the test of ornament. It will not be found in those articles whose visible forms are only modeled to develop function.

\* \* \*

This section was intended to afford protection to the inventors of new ornamental effects produced in articles of manufacture. The selection of the design for this purpose is a choice from considerations of appearance and will be determined by the taste of the inventor seeking new and attractive appearances. This does not concern



itself with the functional value of the elements which may be in sight. Most mechanical constructions have their elements in sight, and it is not the exhibition of elements contributing to functions, however new, which was intended to be protected as a design.

**346.** EX PARTE SHERMAN, 147 O. G. 237, 1909 C. D. 170.

[Design for a nail having a particular shaped head. The applicant referred to certain advantages to be derived from the presence of a central protuberance such, for example, as protecting a skirt from injury and preventing distortion of the head when the nail is driven. These mechanical advantages were held not to confer patentability upon this design.

Affirmed in 35 App. Cas. D. C. 100, 154 O. G. 839, 1910 C. D. 382, the court saying inter alia:]

The right to a design patent under section 4929, Revised Statutes, depends upon whether the person applying 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, etc.

Prior to May 9th, 1902, when said section was amended, the invention must have comprised a new, useful and original shape or configuration of any article of manufacture.

It will be observed that in the statute as amended the word "useful" is omitted and the word "ornamental" is inserted. It would seem that the purpose of this change was to more carefully differentiate design patents from mechanical patents. While in a close case utility may be given some consideration, the real question is whether there is such originality shown as to call for the exercise of the inventive faculty. *Smith v. Whitman Saddle Co.*, C. D. 1893, 324, 63 O. G. 912, 148 U. S. 674, 37 L. ed. 606, 13 Sup. Ct. 768; *In re Tournier*, C. D. 1901, 306, 94 O. G. 2166, 17 App. Cas. D. C. 481.

**347.**

[For examples of design patents held invalid, see *Bradley v. Eccles*, 126 Fed. 945, 61 C. C. A. 669; *Perry v. Hoskins*, 111 Fed. 1002, ("another instance of the 'liberal' if not lax practice"); *Marvel Co. v. Pearl*, 114 Fed. 946 ("another instance of a perversion of the statute"); *Weisgerber v. Clowney*, 131 Fed. 477; *Lane Bros. v. Wilcox Mfg. Co.*, 141 Fed. 1000; *Clark et al. v. Harmon Hollow Concrete Bldg. Block Co.*, 149 Fed. 1001, 79 C. C. A. 511; *Mygatt v. M. Schaffer-Flaim Co.*, 191 Fed. 836, 112 C. C. A. 350; *Ex parte Steck*, 98 O. G. 228, 1902 C. D. 9; *Ex parte Hartshorn*, 104 O. G. 1395, 1903 C. D. 170; *Ex parte Kern*, 105 O. G. 2061, 1903 C. D. 292; *Charles A. Seaman*, 4 O. G. 691.

For incidental discussions see *Ex parte Schulze-Berge*, 42 O. G. 293, 1888 C. D. 4; *McArthur v. Gilbert*, 110 O. G. 2509, 1904 C. D. 245; *Ex parte Colton*, 104 O. G. 1119, 1903 C. D. 156; *Ex parte Tucker*, 97 O. G. 187, 1901 C. D. 140.

For examples of design held patentable, see *Mygatt v. Zalinski*, 138 Fed. 88; *West Disinfecting Co. v. Frank*, 146 Fed. 388; *Ex parte Smith*, 130 O. G. 1688; *H. S. Earle Mfg. Co. v. Clark & Parsons Co.*, 154 Fed. 851; *Ex parte Norton*, 22 O. G. 1205, 1882 C. D. 14; *Ex parte Gray*, 114 O. G. 543, 1905 C. D. 21; *New York Belting, etc., Co. v. New Jersey Car Spring, etc., Co.*, 137 U. S. 445. 34 L. ed. 741, 11 Sup. Ct. 193.]

**348. DOBSON v. HARTFORD CARPET CO.**, 114 U. S. 439, 29 L. ed 177, 5 Sup. Ct. 945.

As to No. 1, though the bill was taken as confessed, the defendants take the point that the patent is void on its face because it has nineteen claims. It has a claim for an entire pattern, and then a separate claim for each of the eighteen component parts making up the whole. The bill alleges infringement by the making and selling of the "invention" and of carpets containing the "invention." Even if the defendants can raise this point after a decree pro confesso (see *Thompson v. Wooster*, 114 U. S. 104, 29 L. ed. 105, 5 Sup. Ct. 788), the patent must be held valid at least for the purposes of this case.

**349. NEW YORK BELTING, ETC., CO. v. NEW JERSEY CAR SPRING, ETC., CO.**, 53 Fed. 810, 4 C. C. A. 21.

The patent contains no separate claim for the border, as in *Dobson v. Hartford Carpet Co.*, 114 U. S. 439, 29 L. ed. 177, 5 Sup. Ct. 945, and the defendant's combination of his central panel with the complainant's border cannot be held to be an infringement unless complainant first produced such combination, and exhibited it in his patent so clearly and fully that one skilled in the art would understand that it was that specific combination which the patentee claimed. As none of the defendant's mats infringe the only specific design exhibited in the patent and shown in the drawing, the decree of the Circuit Court should be reversed.

**350.** [See *Graff et al. v. Webster, et al.* 195 Fed. 522, (C. C. A. Second Circuit, 1912) in which the Graff design patents No. 39,992 for a dish and No. 40,009 for a detail of a border section of a dish were held valid and infringed, affirming the lower court.]

**351.** [See *Tilden-Thurber Co. v. Foster Co.*, 195 Fed. 538, (D. C. R. I. 1912) in which design patent No. 40,789 for a clothes brush, known in the trade as the "thin model" brush, was held to disclose novelty and a patentable degree of artistic invention, and infringed.]



**352.** [See *Hall v. Frank et al.*, 195 Fed. 946, (D. C. E. D. N. Y. 1912) which is an example of the citation of a design patent, No. 28,476, in a case involving a bedstead patent and in the same manner in which a mechanical patent might have been cited.]

**353.** *DOBSON v. DORNAN*, 118 U. S. 10, 30 L. ed. 63, 6 Sup. Ct. 946.

In *Dobson v. Buglow*, 114 U. S. 439, 446, the claim of the design patent was "the design of a carpet substantially as shown." Objection was taken to the form of the claim. But this court said it saw no good objection to the form, and that the claim referred to the description as well as the drawing, in using the word "shown."  
\* \* \* Undoubtedly the claim in this case covers the design as a whole and not any part of it as a part; and it is to be tested as a whole as to novelty and infringement.

**354.** *UNTERMEYER v. FREUND*, 58 Fed. 205, 7 C. C. A. 183.

The statute of 1887 was passed in consequence of this decision [*Dobson v. Carpet Co.*, 114 U. S. 439]. The manifest purpose of Congress was to enlarge the remedy against infringers of design patents and to declare that the measure of profits recoverable on account of the infringement should be considered to be the total net profits upon the whole article. A construction which should limit a recovery above \$250.00 to the amount which the complainant could clearly establish to be the value which the design had contributed to the infringing carpets would be at variance, not only with the apparent legislative intent but with the language of the statute. The rule which Congress declared for the computation of profits was the total profit from the manufacture or sale of the article to which the design was applied, as distinguished from the pre-existing rule of the profit which could be proved to be attributable to the design.

**355.** *BYRAM v. FRIEDBERGER*, 100 Fed. 963, 41 C. C. A. 121.

It has been said that in matters of design patents, infringement must be determined by the similarity of appearance evident to the eyes of an ordinary observer, and that an ordinary observer is an intending purchaser of the article in question, familiar with the various designs of the article sought to be purchased, and who seeks to purchase them for the uses to which they are generally adapted. The eye of the court is also that of a judge competent to pass upon the question of similarity.

## PART VIII.

### INTERFERENCES.

Conditions Precedent—"Interference in Fact"—Divisional Application—Avoiding an Interference—Amendment to Include Matter Shown But Not Claimed—Preliminary Statements—Rights and Relations of Parties—Motions to Dissolve—Judgment on the Record—Hearing, Decision and Course of Appeals—Priority of Invention—Evidence—Burden of Proof—Public Use and Other Statutory Bars—Conception and Disclosure—Reduction to Practice—Diligence—Originality—Employer and Employee—Taking Testimony, etc.—Bill in Equity (see 4915)—Interfering Patents.

### STATUTES.

#### 356. INTERFERENCES.

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

#### 357. AFFIDAVITS AND DEPOSITIONS.

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

#### 358. PATENTS OBTAINABLE BY BILL IN EQUITY.

Sec. 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the appli-



cant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the patent office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. [See § 629, ¶ 9.]

### 359. SUITS TOUCHING INTERFERING PATENTS.

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

[Sec. 4920 recites the special matters which may be pleaded in an action for infringement.]

\* \* \*

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

\* \* \*

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

[For provisions relating to subpoenas, to witnesses, to witness fees and to penalty for failing to attend or refusing to testify, see R. S. U. S., Secs. 4906, 4907, 4908, under Part XIV.]

## RULES OF PRACTICE.

**360. INTERFERENCE DEFINED.** Rev. Stat., § 4904.

93. 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 another patent for the same invention to a person who proves to be the prior inventor.

**361. WHEN DECLARED.**

94. 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 containing conflicting claims.

(2) Between an original application and an unexpired patent containing conflicting claims, when the applicant, having been rejected on the patent, shall file an affidavit 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 applications 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 was filed on which the earlier patent was granted.

(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.



(9) An interference will not be declared between an original application filed subsequently to December 31, 1897, and a patent issued more than two years prior to the date of filing such application or an application for a reissue of such a patent.

### **362. PREPARATION FOR INTERFERENCE.**

95. 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 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.

### **363. FAILURE TO PREPARE FOR INTERFERENCE.**

96. Whenever the claims of two or more applications differ in phraseology, but cover substantially the same patentable subject-matter, the examiner, when one of the applications is ready for allowance, will suggest to the parties such claims as are necessary to cover the common invention in substantially the same language. The examiner will 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 such 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 such party will be held for revision and restriction, subject to interference with other applications.

[97 relates to the preparation of the notices of the interference, and to notices to conflicting parties having the same counsel, 98 to revision of notices by examiner of interferences; 99 for reference to the commissioner in case of disagreement between the examiner of interferences and the primary examiner.]

**364. PRIMARY EXAMINER RETAINS JURISDICTION.**

100. The primary examiner will retain jurisdiction of the case until the declaration of interference is made.

**365. JURISDICTION OF EXAMINER OF INTERFERENCES.**

101. Upon the institution and declaration of the interference, as provided in Rule 102, the examiner of interferences will take jurisdiction of the same, which will then become a contested case; but the primary examiner will determine the motions mentioned in Rule 122, as therein provided.

[102 provides for a formal declaration by the examiner of interferences; 103 relates to notices to the parties and upon necessity for publication in the Official Gazette; 104, to motion for postponement of time for filing preliminary statements; 105, to use of certified copies where only a part of an application is in interference; 106, to new application for claims not in interference, it being provided that no claim shall be made in either application broad enough to include matter claimed in the other.]

**366. DISCLAIMER TO AVOID INTERFERENCE—SIGNATURE TO.**

107. 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, 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 a copy of the disclaimer shall be embodied in and form part of his specification. (See Rule 182.)

[108 provides for inspection of the claims of opposing parties after the preliminary statements have been received and approved; and 109 provides for claiming, on motion duly made, an invention shown but not claimed in an application in interference.]

**367. PRELIMINARY STATEMENTS—REQUIREMENTS OF.**

110. 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:

(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 the invention was first disclosed to others.

(4) The date of the reduction to practice of the invention.

(5) A statement showing the extent of use of the invention.

(6) 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 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 the applicant made the invention set forth in the declaration of interference.

(2) Whether or not the invention was ever patented; if so, when and where, giving the date and number of each patent, the date of publication, and the date of sealing thereof.

(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) 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.

[111 places restriction upon the opening for inspection of preliminary statements and provides for forbidding access to the papers of any party in default; 112 relates to a notice to amend a defective statement, and to removing without inspection of opposing parties any unopened statements; 113, to amending upon motion and satisfactory showing.]

#### **368. FAILURE TO FILE PRELIMINARY STATEMENT; FAILURE TO OVERCOME PRIMA FACIE CASE.**

114. If the junior party to an interference, or if any party thereto other than the senior party, fails to file a statement, or if

his statement fails to overcome the prima facie case made by the respective dates of application, such party will 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 is 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.

**369. FAILURE TO FILE TESTIMONY EXCLUDED SETTING UP INVENTION PRIOR TO APPLICATION DATE.**

115. 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.

**370. PRESUMPTION AS TO ORDER OF INVENTION.**

116. In original proceedings in cases of interference the several parties will be presumed to have made the invention in the chronological order in which they filed their completed applications for patents clearly illustrating and describing the invention; and the burden of proof will rest upon the party who shall seek to establish a different state of facts.

**371. STATEMENT NOT EVIDENCE.**

117. The preliminary statement can in no case be used as evidence in behalf of the party making it.

[118 relates to times for taking testimony; 119, to an entry of judgment against party in default for not taking testimony; 120, to the postponement of hearing upon motion; 121, to enlargement of time for taking testimony upon motion.]

**372. MOTION TO DISSOLVE FOR IRREGULARITY, NON-PATENTABILITY, ETC.**

122. 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 charac-



ter, should be accompanied by a motion to transmit the same to the primary examiner, and such motion to transmit should be notice 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.

[123 relates to motions to effect stay of proceedings.]

### **373. MOTION FOR DISSOLUTION—APPEALS.**

124. 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.

[125 provides for termination of interferences only by written concession of priority; 126 provides for the suggestion of a statutory bar by any of the tribunals and that the case may be remanded to the primary examiner by the commissioner for the determination of such suggestion; 127 forbids a second interference upon the

same application by the same party; 128 for the suspension of an interference for the consideration of new references; 129 for the addition of new parties.]

#### 374. NON-PATENTABILITY AT FINAL HEARING.

130. 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 non-patentability of the claim to his opponent at final hearing before the examiner of interferences as a basis for the decision upon priority of invention, and upon appeals from such decision. A party shall not be entitled to take such step, however, unless he has duly presented and prosecuted a motion under Rule 122 for dissolution upon the ground in question, or shows good reason why such a motion was not presented and prosecuted.

[131 provides for the prosecution or defense by an assignee.]

132. 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.

[153 relates to motions; 154-163, to testimony in interference and other contested cases; to the printing of the testimony and briefs; to taking testimony in foreign countries, and formal matters relating to the testimony.]

#### 375. CHRISTIE v. SEYBOLD, 55 Fed. 69, 5 C. C. A. 33 (1893).

Before Jackson and Taft, Circuit Judges, and Hammond, District Judge.

Taft, Circuit Judge (after stating the facts.) The questions arising in this case, covered by the assignments in error, are two: First, does Christie's invention or device show, "in a power press, a platen detachably connected with the power-driving mechanism and provided with a counterbalancing weight?" and second, if it does, which one of the two Seybold or Christie, was the first or true inventor, within the meaning of the patent laws?

It is contended by appellant that it was too late for the complainant to raise the question, in the court below, whether Christie's device includes "a platen detachably connected with the power-



driving mechanism," because it was not raised in the interference proceeding in the patent office. It is said he is thereby estopped to make it. We do not concur in this view. The interference issue is drawn up by the patent office examiners, and the interference is declared, before either party has access to the specifications of the other, and the claims made with respect to the issue are submitted before the specifications are disclosed. Subsequently, perhaps, the question might be raised, but we do not think that a failure to raise it in the patent office prevents its being brought to the attention of the court in a proceeding like this by independent bill.

The fact, if it be a fact, that the invention of one of the parties does not include the issue declared in the interference, is apparent on the record. In one of the two cases considered by the Supreme Court under this section it was held that the court of its own motion must declare that the issuable device in the interference proceeding was not patentable for want of invention, and could therefore dismiss the bill, although the question had not been raised either in the patent office or by the parties in the court below or in the Supreme Court. *Hill v. Wooster*, 132 U. S. 693, 10 Sup. Ct. 228. We do not see why the court has not the same power with reference to the present question. The fact, if it be a fact, that Seybold did not raise it in the patent office, may, of course, affect the weight of his present objection, but it has no force as an estoppel.

Coming now to the question whether the Christie device embodies that which is described by the issue framed in the interference proceedings, we find that the issue was adopted by the patent office from the language of the first claim of Christie's patent, and the question presented is really whether Christie's specifications entitle him to his first claim. \* \* \*

Then follow the claims, the first of which is:

"In a power press, the platen, 5, detachably connected with the power-driving mechanism and counterbalanced by the weight, to hold the same in any adjusted position, substantially as specified."

The court below held that the power-driving mechanism consisted of the lever, the pawls, the ratchet wheels, the pinion, and the rack bar; and that as the ratchet wheel and pinion were fixed in their relation to the rack bar, and the rack bar was fixed to the platen, the power-driving mechanism was not detachably connected with the platen.

We think this construction too narrow. The expert for the complainant below testified that he had never heard the expression "detachably connected with," but that in this view it must mean that all the mechanism used to transmit the pressure to the platen should be capable of being detached from the platen. The patent office took the expression from the specifications and claim of

Christie, and it is only fair, therefore, in construing the meaning of the term, if ambiguous, to look into Christie's specifications to see what, in fact, is meant by the term "detachably connected with the power-driving mechanism." Of course Christie's specifications cannot be used for this purpose, if by so doing we are taken out of the Seybold invention, but if the issue framed by the patent office, by a fair construction, will include a feature present in both inventions, then it is the duty of the court to lean to that construction rather than to give it a strict and narrow one which will describe something present only in one. We are very clear that the two inventions have a common feature, viz., the easy elevation and lowering of the platen, secured by a counterbalancing weight and a device for the disengagement of the platen from the power-pressure mechanism and consequent independence thereof.

The amount of power required to compress the bundle makes necessary a somewhat cumbersome and slow action in the power-pressure mechanism. The object of both inventions is to temporarily free the platen from connection with the slowly-acting mechanism while the bundle is being put in the press. A device which unships the machinery conveying the great pressure power to the platen, so as to permit a free movement of the platen unrestrained by its connection with that machinery, makes the connection between the platen and the power-driving mechanism "detachable," within the meaning of Christie's specifications and the issue framed in this case by the patent office. It may be true that in a certain sense the pinion and the ratchet wheels and the rack bar are part of the power-driving mechanism when in action, though our impression is that, as the power is applied first on the lever, the machinery conveying the power to the platen beyond the lever is power-transmitting mechanism, and that the lever and pawl only may be properly called the "power-driving mechanism." But, whichever is the correct view, it is certain that, as soon as the pawls and lever which communicate the power to the ratchet wheels are unshipped, the ratchet wheels and the pinion are free to move without opposing any obstruction whatever to the easy up and down movement of the platen. When thus detached they are certainly no part of the power-driving mechanism. The result is exactly the same as if they were removed from their connection with the rack bar, because they make no resistance to the movement of the rack bar and platen. The specifications do not limit Christie to this one mode of applying the power, but the lever, pawl, and ratchet are described by him as the preferable mode. There are many well-known equivalents, and were at the time of this invention, of this power-driving mechanism, notably the screw described in Seybold's invention. For these reasons we are unable to agree with the learned judge below in respect to the ground



upon which he placed his decision. We are therefore brought to consider the question which, in the view he took of the case, he did not find it necessary to pass upon,—that is, who was the first and true inventor of that feature which we have found to be common to the two devices, and which is here the subject of controversy?

The patent statutes have always required such particularity of description in the applications for a patent as to leave no doubt that in the eye of the law he is the first and true inventor who first reduces the conception of a new invention or discovery to practical and operative form. In *Bedford v. Hunt*, 1 Mason (U. S.) 302-304, Mr. Justice Story said:

“The first inventor who has put the invention into practice, and he only is entitled to a patent.”

And again, on page 305, he says:

“The intent of the statute was to guard against defeating patents by the setting up of a prior invention which had never been reduced to practice. If it were the mere speculation of a philosopher or a mechanic, which had never been tried by the test of experience, and never put into actual operation by him, the law would not deprive a subsequent inventor, who had employed his labors and his talents in putting it into practice, of the reward due to his ingenuity and enterprise.”

So in *Agawan Co. v. Jordan*, 7 Wall. (U. S.) 583, Mr. Justice Clifford states the rule as follows:

“The settled rule of law is that whoever first perfects a machine is entitled to a patent, and is the real inventor, although others may have previously had the idea, and made some experiments towards putting it in practice. He is the inventor, and is entitled to the patent, who first brought the machine to perfection, and made it capable of useful operation.

So in *Whitely v. Swayne*, 7 Wall. (U. S.) 685, 687, Mr. Justice Nelson said:

“He is the first inventor and entitled to the patent who, being an original discoverer, has first perfected and adapted the invention to actual use.”

This is the general rule, and had no exception under the statutes in force down to the act of July 4, 1836 (5 Stat., p. 117). The fifteenth section of that act, in specifying the defenses which a defendant might set up in an action for infringement, permitted him to plead that the patentee “had surreptitiously and unjustly obtained the patent for that which was in fact invented or discovered by another who was using reasonable diligence in adapting and perfecting the same.” The effect of the change made by the act of 1836 was considered by Mr. Justice Story in the case

of *Reed v. Cutter*, 1 Story 590, where, referring to the words "was using reasonable diligence in adapting and perfecting his invention," he said:

"These latter words were copied from the fifteenth section of the act of 1836, c. 357, and constitute a qualification of the preceding language of that section; so that an inventor who has first actually perfected his invention will not be deemed to have surreptitiously or unjustly obtained a patent for that which was in fact first invented by another, unless the latter was at that time using reasonable diligence in adapting and perfecting the same. And this I take to be clearly the law; for he is the first inventor in the sense of the act, and entitled to a patent for his invention, who has first adapted and perfected the same to use; and until the invention is so perfected and adapted for use it is not patentable. An imperfect and incomplete invention, existing in mere theory or in intellectual notion, or in uncertain experiments, and not actually reduced to practice, and embodied in some distinct machinery, apparatus, manufacture, or composition of matter, is not, and indeed cannot be, patentable under our patent acts, since it is utterly impossible, under such circumstances, to comply with the fundamental requisites of those acts. In a race of diligence between two independent inventors, he who first reduces his invention to a fixed, positive, and practical form would seem to be entitled to a priority of right to a patent therefor. *Woodcock v. Parker*, 1 Gall. 438. The clause now under consideration seems to qualify that right by providing that in such case he who invents first shall have the prior right, if he is using reasonable diligence in adapting and perfecting the same, although the second inventor has, in fact, first perfected the same, and reduced the same to practice in a positive form. It thus gives full effect to the well-known maxim that he has the better right who is prior in point of time, namely, in making the discovery or invention."

*Reed v. Cutter* is a leading case, and has been followed by Mr. Justice Clifford in *White v. Allen*, 2 Cliff. 224, 2 Fish. Pat. Cas. 440, and in later cases.

It is obvious from the foregoing that the man who first reduces an invention to practice is *prima facie* the first and true inventor, but that the man who first conceives, and, in a mental sense, first invents, a machine, art, or composition of matter, may date his patentable invention back to the time of its conception, if he connects the conception with its reduction to practice by reasonable diligence on his part, so that they are substantially one continuous act. The burden is on the second reducer to practice to show the prior conception, and to establish the connection between that conception and his reduction to practice by proof of due diligence. It has sometimes been held, in the decisions in 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, cannot be supported on principle. The diligence of the first reducer to practice is necessarily immaterial. It is not a race of diligence between the two inventors in the sense that the right to the patent is to be determined by comparing the diligence of the two, because the first reducer to practice, no matter what his diligence or want of it, is prior in right unless the first conceiver was using reasonable diligence at the time of the second conception and the first reduction to practice. The language of the statute (section 4920), in the use of the imperfect tense, "was using reasonable diligence," shows the legislative intent to confer a prior right on a first conceiver in a case where, after his mental act of invention, and pending his diligent reduction to practice, another inventor enters the field and perfects the invention before his rival. The reasonable diligence of the first conceiver must be pending at the time of the second conception, and must therefore be prior to it. Reasonable diligence by the first conceiver, beginning when his rival enters the field, could only carry his invention back to the date of the second conception, and in the race from that time, the second conceiver must win because of his first reduction to practice. See *Rob. Pat.* §§ 384-386; *Millward v. Barnes* 11 O. G. 1060. The elaborate opinion of the commissioner of patents, Mr. Mitchell, in the interference proceeding between Christie and Seybold, reported in 54 O. G. 957, cites all the authorities, and is quite convincing on this point. We fully concur therein. As Christie reduced the invention to practice nearly a year before Seybold's press was made, the burden is on Seybold to show that from the time of his original conception, which antedated that of Christie, he was using reasonable diligence in adapting and perfecting his idea to practical use. Has he sustained that burden? It is quite clear to us that he has not. The question of reasonable diligence in any case depends, of course, upon all the circumstances. A complicated invention, requiring many experiments and much study to give it practical form, would reasonably delay a reduction to practice after the first conception for a greater length of time than where the idea and the machine embodying it were of a simple character. *Bradford v. Corbin*, 6 O. G. 223. Then, too, the sickness of the inventor, his poverty, and his engagement in other inventions of a similar kind are all circumstances which may affect the question of reasonable diligence. See *Webster v. Carpet Co.*, 5 O. G. 522; *Cox v. Griggs*, 1 Biss. 362, 2 Fish. Pat. Cas. 174; *Munger v. Connell*, 1 O. G. 491; *Proctor v. Ackroyd*, 6 O. G. 603; *Cushman v. Parham*, 9 O. G. 1108.

In this case, Seybold's first conception was in October, 1885, and he did not reduce his machine to practical form until April, 1889, three years and a half later. He made a rough sketch in January, 1886, which he subsequently lost. In October, 1888,

three years after his first conception, he had working drawings made, and six months later a press was manufactured. His excuse for his delay is that until the spring of 1889 he could not afford to buy the necessary tools for the manufacture of the press, and, if he had been able to do so, his shop was not large enough to permit the use of them. He does not say, however, that he had not the means to have the press made at some other shop, where the proper tools were to be had, but, on the contrary, intimates that he might have done so, but for the fact that there would have been no profit for him to sell machines made by others according to his invention. Now, we do not think this a good excuse for failing to make at least one machine, in accordance with his conception: It is as much as to say that in his view his new conception, when reduced to practice, would not have sufficient value and utility to bring him any return commensurate with the outlay required to reduce it to practice, and in consequence he indefinitely postponed putting it into practical form until circumstances should change. This is a temporary abandonment of the idea (*White v. Allen*, 2 Cliff. 224), and is not the due diligence which entitles him to the favor of the public, for whose benefit, primarily, the patent laws were enacted (*Wright v. Postel*, 44 Fed. Rep. 352).

It can hardly be claimed that the rough sketch made by Seybold of his proposed press in January, 1886, was a reduction to practice. It has been held in many cases that drawings, much more complete than the one here testified to, are not reductions to practice, as against a subsequent conceiver who first made an actual, operative machine. *Reeves v. Bridge Co.*, 5 Fish. Pat. Cas. 456; *Lubricator Manuf'g Co. v. Renchard*, 9 Fed. 293 (opinion by Mr. Justice Matthews); *Drill Co. v. Simpson*, 29 Fed. 288; *Ellithorpe v. Robertson*, 4 Blatchf. 307; *Draper v. Mills Corp.*, 13 O. G. 276; *Odell v. Stout*, 22 Fed. 159.

Further objection to reversing the decree is made on behalf of appellee on the ground that Christie was not the true inventor of the machine for which he obtained the patent. It is said that Christian Keck, who was in his employ, was the real inventor. We do not see how this is a subject which can be here investigated. The question here (section 4915, Rev. Stat.) is only whether Seybold was the first and true inventor. It is certain that some one reduced the invention to practice before Seybold did, and, if that is so, Seybold is not the first and true inventor, unless he was using reasonable, diligence to adapt and perfect his conception; and we have found that he was not doing this. If Christie's patent is void because he was not the first and true inventor, and Keck was, that would not entitle Seybold to a pat-



ent. The commissioner of patents did not consider the question, and we think he acted rightly in this respect.

On the whole case we find, therefore, that Seybold is not the true and first inventor. The decree of the court below is reversed, with instructions to dismiss the bill at the costs of the complainant.

**376. MERGENTHALER v. SCUDDER**, 11 App. Cas. D. C. 264, 81 O. G. 1417, 1897 C. D. 724.

Alvey, J.: \* \* \*

A complete conception as defined in an issue of priority of invention is matter of fact and must be clearly established by proof. The conception of the invention consists in the complete performance of the mental part of the inventive act. All that remains to be accomplished in order to perfect the act or instrument belongs to the department of construction, not invention. It is therefore the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice that constitutes an available conception within the meaning of the patent law. 1 Rob. on Pats., sec. 375.

“He who first conceives and gives expression to the idea of an invention in such clear and intelligible manner that a person skilled in the business could construct the thing is entitled to a patent, provided he uses reasonable diligence in perfecting it. *Machine Co. v. Harvester Works*, 42 Fed. 152, 157.”

Or, as said by Mr. Commissioner Leggett in *Champan v. Candee*, 2 O. G. 245:

“It is for him (the party upon whom the onus rests) to prove priority of invention, and he may do it by establishing either that he was the first to conceive the idea and the mode of putting it into practice, and used reasonable diligence in adapting and perfecting it, or that he actually perfected and reduced the invention to practice prior to the date of the application of the opposing party to the issue.”

Or, as more fully stated by the same learned Commissioner, in the case of *Cameron & Everett v. I. R. Brick*, C. D., 1871, 89:

“The point of time at which invention, in such sense as to merit the protection of law, dates is neither when the first thought of it is conceived nor when the practical working machine is completed, but it is when the thought or conception is practically complete; when it has assumed such shape in the mind that it can be described and illustrated; when the inventor is ready to instruct the mechanic in relation to putting it in working form; when the ‘embryo’ has taken some definite form in the mind and seeks deliverance, and when this is evidenced

by such description or illustration as to demonstrate its completeness. \* \* \* The true date of invention is at the point where the work of the inventor ceases and the work of the mechanic begins. Up to that point he was inventing, but had not invented, and he must have invented before the law will come to his protection."

In the case of *Voelker v. Gray*, 30 O. G., 1091, Mr. Commissioner Butterworth in defining what will constitute complete conception within the meaning of the patent law says that the party claiming "must have been first to conceive the thing in controversy; not merely to conceive it possible to construct a device which would produce the result sought. \* \* \* The conception must not be the result to be obtained, but the means (which is the patentable thing) to produce that result. As long as there is a missing ingredient, in the absence of which the means utilized is a failure, the desired result unattainable, the invention is incomplete. \* \* \* That of which the law takes notice is not the maturing, but the matured conception which can materialize in an operative device; but it very frequently occurs that the inventor confounds his original device and later conception and gives the latter the date of the former, and does it innocently."

It follows from the principles thus enunciated that the date of the conception is the date when the idea of means, including all the essential attributes of the invention, becomes so clearly defined in the mind of the inventor as to be capable of exterior expression (1 Rob. on Pats., sec. 380), and it is settled both by practice and express decision that such exterior expression of the mind of the inventor when relating to machinery may be by exhibits either in the form of drawings or by model, so as to lay the foundation of a claim to priority, if thereby the invention be made sufficiently plain to enable those skilled in the art to understand it. *Webster Loom Co. v. Higgins*, 105 U. S., 580, 594, 21 O. G., 2031.

Now upon the application of these well settled general principles, the onus of proof being upon Scudder, the question is whether upon the facts of the case the prima facie effect of the applications filed by Mergenthaler has been overcome and the priority of invention, as matter of fact, has been shown by Scudder in plain, definite, and comprehensive terms.

The fact of conception by an inventor, for the purpose of establishing priority, cannot be proved by his mere allegation nor by his unsupported testimony where there has been no disclosure to others or embodiment of the invention in some clearly-perceptible form, such as drawings or model, with sufficient proof of identity in point of time, for otherwise such facile means of establishing priority of invention would in many cases offer



great temptation to perjury and would have the effect of virtually precluding the adverse party from the possibility of rebutting such evidence. Hence it has been ruled in many cases that the mere unsupported evidence of the alleged inventor on an issue of priority as to the fact of conception and the time thereof cannot be received as sufficient proof of the fact of prior conception, *Hisey v. Peters*, 6 App. Cas. D. C., 73, 71 O. G., 892; *Stevens v. Putnam*, 18 O. G., 520; *Farmer v. Brush*, 17 O. G., 150; *Brungger v. Smith*, 62 O. G., 1511; but any full and accurate description of the invention, either in words or drawings or by model, if it be of a machine, or even an unsuccessful effort to embody the conception, when the effort discloses that the idea was complete, will suffice, although the attempt to represent it may have failed. In the absence of all other proof the date of the application for a patent, if containing a complete description, is taken as the date of the conception. 1 Rob. on Pats., sec. 380. But if drawings be exhibited and relied on as evidence of the conception of the invention they must show a complete conception, free from ambiguity or doubt, and such as would enable the inventor or others skilled in the art to reduce the conception to practice without any further exercise of inventive skill. (Ib.)

\* \* \*

[An apt illustration of the rule of this case applied to process is found, for example, in *McKnight v. Pohle Croasdale*, 22 App. Cas. D. C. 219, 105 O. G. 977, 1903 C. D. 619.]

**377.** *PETRIE v. DESCHWEINITZ*, 19 App. Cas. D. C. 386, 99 O. G. 1387, 1902 C. D. 534.

\* \* \* That the unsupported evidence of a party will not be accepted or acted upon as sufficient proof of the conception of an invention, is a well-settled principle, the reasons for which apply with equal force to its reduction to practice. *Mergenthaler v. Scudder*, C. D. 1897, 724, 81 O. G. 1417, 11 App. D. C. 264, 278; *Winslow v. Austin*, C. D. 1899, 301, 86 O. G. 2171, 14 App. D. C. 137, 141; *De Wallace v. Scott*, C. D. 1899, 416, 88 O. G. 1704, 15 App. D. C. 157, 162; *Tyler v. St. Amand*, C. D. 1901, 301, 94 O. G. 1969, 17 App. D. C. 464, 467; *Young v. Donnelly*, C. D. 1898, 20, 82 O. G. 1417. \* \* \*

**378.** *AUTOMATIC WEIGHING MACH. CO. v. PNEUMATIC SCALE CO.*, 166 Fed. 288, 92 C. C. A., 206. (1909, Patent No. 766,004).

. Before Colt and Lowell, Circuit Judges, and Aldrich, District Judge.

Colt, Circuit Judge:

This is a bill in equity brought under section 4920 of the Revised Statutes (U. S. Comp. Stat. 1901, p. 3394) for infringe-

ment of the first seven claims of the Thomas patent, No. 766,004, for improvements in automatic weighing machines. The invention consists, broadly speaking, in the addition of a second hopper with a time valve to the previous single-hopper weighing machine of the Doble and Watson patent, No. 556,258.

The only defense is priority of invention by Thomas W. Watson, to whom a patent was issued for the same invention. It is admitted that both Thomas and Watson were independent inventors of this improvement.

Section 4920 provides as follows:

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

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

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

"And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement."

Under these provisions, the defendant contends, first, that Watson was the original and first inventor of the thing patented, and, second, that Thomas unjustly obtained his patent for that which was in fact invented by Watson, who was using reasonable diligence in adapting and perfecting the same. The first defense turns upon the respective dates of the Thomas and Watson inventions, and the second defense raises a question of fact as to Watson's diligence in adapting and perfecting his invention.

Thomas filed his application December 17, 1896, and his patent issued July 26, 1904.

Watson conceived his invention, illustrated it by a drawing, and disclosed it to others, as early as January 10, 1896. He reduced his invention to practice by the building of a machine in April, 1897. He filed his application March 11, 1898, and his patent issued September 26, 1899.

It may be noted, first, that Thomas' application antedates Watson's reduction to practice by 4 months, and Watson's application by 15 months; and, second, that Watson's conception antedates Thomas' application by 11 months.

The main controversy with respect to the Thomas invention is whether the date of his invention is the date of his application, December 17, 1896, and the main controversy with respect to the Watson invention is whether the date of his invention is the date of his conception, January 10, 1896.



On April 24, 1901, the Patent Office declared an interference between the Thomas application and the Watson patent, under section 4904 of the Revised statutes (U. S. Comp. Stat. 1901, p. 3389):

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

Under a rule of the Patent Office, the filing of an allowable application is a constructive reduction to practice. In accordance with this rule, the date of the Thomas invention was fixed as of December 17, 1896, the date of his application; and the burden of proof was thrown upon Watson to establish the fact of reasonable diligence from the date of his prior conception, January 10, 1896, to the time Thomas filed his application. Upon this issue of diligence on the part of Watson, the Examiner of Interferences and the Commissioner of Patents, two of the three Patent Office tribunals which passed upon the question, and the Court of Appeals of the District of Columbia, found against Watson, and adjudged Thomas to be the prior inventor; and accordingly a patent was issued to Thomas under section 4904. As a result of the interference proceedings, there are two outstanding patents for the same invention issued to independent inventors.

The decision in interference proceedings is not conclusive on the question of priority of invention. The same question may arise in subsequent suits instituted under sections 4915, 4918, and 4920 of the Revised Statutes (U. S. Comp. Stat. 1901, pp. 3392, 3394).

Section 4915 provides that the unsuccessful applicant may bring a bill in equity, for the purpose of determining his right to receive a patent for his invention. The remedy under this section is in effect an appeal from the decision of the Patent office tribunals.

Section 4918 provides that where there are interfering patents any person interested in any one of them may bring a bill in equity against the interfering patentee, and the court may declare either of the patents void in whole or in part.

Section 4920 provides that the defendant in a suit for infringement may prove any of the special matters of defense therein enumerated.

In the present suit, as we have seen, the question of priority of invention is raised under paragraphs 2 and 4 of section 4920. In order to determine the question of priority under these paragraphs, we must, as already pointed out, ascertain the respective dates of the Thomas and Watson inventions. If we find the date of the Thomas invention is prior to the date of the Watson invention, then Thomas is the original and first inventor, unless Watson was using reasonable diligence in adapting and perfecting his invention from the time of his conception. On the other hand, if we find that the date of the Watson invention is prior to the date of the Thomas invention, then Watson is the original and first inventor. No question of diligence arises regarding the Thomas invention, because the complainant does not undertake to carry the date of the Thomas invention back of his application, while in the case of Watson it is sought to carry the date of his invention back to his conception.

In patented inventions there are several distinct stages of the invention. Some patented inventions comprise only three stages, namely, conception (evidenced by drawings, disclosures, or models), application, patent; while other patented inventions comprise four stages, namely, conception, reduction to practice, application, patent.

The date of the first class of patented inventions must be either (1) the date of the patent, or (2) the date of the application, or (3) the date of the conception; while the date of the second class must be either (1) the date of the patent, or (2) the date of the application, or (3) the date of the reduction to practice, or (4) the date of the conception.

When two patents for the same invention have been issued to independent inventors, we understand the rule to be that the dates of their respective inventions are, first, the dates of the patents; second, the dates of the applications, provided the application sufficiently describes the invention; third, the dates of actual reduction to practice; fourth, the dates of conception; with this qualification, that, if either patentee seeks to carry the date of his invention back to the date of his conception, he must show reasonable diligence in adapting and perfecting his invention, either by actual reduction to practice or by filing his application.

Applying this rule to the present case, we find that the date of the Thomas patent is July 26, 1904, and the date of his application is December 17, 1896. We also find that the date of the



Watson patent is September 26, 1899, the date of his application is March 11, 1898, the date of his actual reduction to practice is April, 1897, and the date of his conception is January 10, 1896.

Upon a comparison of these dates, it appears that Thomas' application of December 17, 1896, carries the date of his invention back of Watson's application, March 11, 1898, and back of Watson's actual reduction to practice, April, 1897, but not back of Watson's conception, January 10, 1896. It follows, therefore, that Watson, in order to establish an earlier date than Thomas, must show that between the date of his conception, January 10, 1896, and the date of his actual reduction to practice, April, 1897, he was "using reasonable diligence in adapting and perfecting" his invention.

The defendant contends that the courts have adopted another and a different rule for determining the dates of inventions under the patent laws, and that the rule is as follows: Inventions are divided into two classes, simple and complicated. Simple inventions may be completed by drawings or disclosure which sufficiently describe the invention, while complicated inventions require for their completion actual reduction to practice. Under this rule the date of an invention depends upon the character of the invention. If the invention is a simple one, the date may be (1) the date of the patent, (2) the date of the application, (3) the date of actual reduction to practice, (4) the date of the conception. On the other hand, if the invention is a complicated one, the date may be either (1) the date of the patent, or (2) the date of actual reduction to practice.

Applying this rule to the present case, the defendant's position is as follows: If the court finds the invention in question is a simple one, then the date of the Thomas invention is the date of his application, December 17, 1896, and the date of the Watson invention is the date of his conception, January 10, 1896. On the other hand, if the court finds the invention is a complicated one, then the date of the Thomas invention is the date of his patent, July 24, 1904, and the date of the Watson invention is the date of his actual reduction to practice in April, 1897.

Upon this theory of the patent law it is apparent that Watson is the original and first inventor, for, if the invention is of a simple character, then Watson's invention was completed by his drawing and disclosure on January 10, 1896, while if the invention is of a complicated character, then Watson's invention was completed by actual reduction to practice in April, 1897.

With respect to this theory of the defendant, it is sufficient to say that it is novel and plainly unsound. No such distinction between inventions is found in the statutes, or has ever been recognized by the courts in any adjudicated cases. It may be

further observed that any such artificial distinction would lead to hopeless confusion and great injustice.

In the present case the question of priority of invention involves two fundamental inquiries: First, is the date of a patented invention as early as the date of the application? In other words, can Thomas carry back the date of his invention to the date of his application? Section, is the date of a patented invention as early as the date of the conception? In other words, can Watson carry back the date of his invention to the date of his drawing and disclosure?

First. With respect to the first proposition it may be said that the law is well settled that the date of a patented invention is at least as early as the date of the application, provided it sufficiently describes the invention to enable those skilled in the art to understand it; and we have found no decision in which this rule is questioned. "Patented inventions always date at least as early as the dates of the execution of the original applications therefor, provided the original applications exhibit the inventions with the above-mentioned extent of sufficiency. Walker on Patents (4th Ed.) § 70.

In *Kearney v. Railroad Company*, (C. C.) 32 Fed. 320, 322, Mr. Justice Bradley said:

"The relative priority of inventions is determined, first, by the dates of the respective patents therefor. But this is not conclusive. Evidence outside of the patents may be given to prove priority. The date of the application, if it describes the invention sufficiently, is conclusive evidence that the invention was made prior to such date."

The same rule was enforced by Mr. Justice Bradley in *National Machine Company v. Brown*, (C. C.) 36 Fed. 317, 321. In the recent case of *Prindle v. Brown*, 155 Fed. 531, 534, 84 C. C. A. 45, 48, this court said:

"An application of the character which we have described is of itself a positive and absolute exhibition of everything which the statute requires to constitute an invention."

In *Bates v. Coe*, 98 U. S. 31, 34, 25 L. ed. 68, Mr. Justice Clifford, speaking for the court, said:

"The presumption in respect to the invention described in the patent in suit, if it is accompanied by application for the same, is that it was made at the time the application was filed; and the complainant or plaintiff may, if he can, introduce proof to show that it was made at a much earlier date."

In *Barnes Automatic Sprinkler Co. v. Walworth Manufacturing Co.*, (C. C.) 51 Fed. 88, 91, Judge Blodgett said:

"I am therefore very clear that the Talcott patent of January 31, 1882, which relates back to the time it was applied for in



April, 1879, clearly anticipates the fourth and fifth claims of the complainant's patent."

This case was affirmed on appeal, 60 Fed. 605, 9 C. C. A. 154.

In the *Barbed-Wire Patent Case*, 143 U. S. 275, 12 Sup. Ct. 443, 36 L. ed. 154, the court, in considering the evidence on the question of priority of invention, assumed that the date of the application of the patent in suit was the date of the invention; and the same assumption was made in *Miller v. Eagle Manufacturing Company*, 151 U. S. 186, 14 Sup. Ct. 310, 38 L. ed. 121. See, also, *Westinghouse v. Chartiers Val. Gas Co.*, (C. C.) 43 Fed. 582.

The rule of the Patent Office that the filing of an allowable application is constructive reduction to practice is only the expression in another form of the rule that the application of a patented invention, if it sufficiently describes the invention, is conclusive evidence that the invention was made at least as early as that date.

In *Lorraine v. Thurmond*, 51 O. G. 1781, 1782, Commissioner Mitchell, in his opinion, said, respecting this rule:

"Completed and allowed applications evidence completion of invention, and in suits brought upon patents granted thereon that stage of invention which is usually evidenced by reduction to practice is conclusively assumed to have been reached. Hence the doctrine of 'constructive reduction to practice.'"

The Commissioner further said:

"If, as held in *Seymour v. Osborne*, 11 Wall. (U. S.) 516, 20 L. ed. 33, an invention is not patentable under the patent laws until it be perfected and adapted to use, and if, as held in the *Telephone Cases*, *supra*, and other cases cited, reduction to practice is not essential in order to obtain a patent, it follows that actual reduction to practice is not the only competent evidence of perfection and adaptation to use, but that the inventor's act in filing an allowable application is to be regarded in law as such an efficient and crowning step as to give it the standing of an invention so perfected and adapted. Interferences are declared after the applications involved are pronounced to be allowable by the experts of the office. In determining whether the application is allowable, the question of operativeness is one of the primary considerations. (Rule 133.) It hardly need be added that approved applications stand upon an entirely different basis from those which have been rejected by the office or abandoned by the applicant. *Webster v. Sanford*, 44 O. G. 567; *Beach v. Fowler*, 48 O. G. 821."

The rule of the federal courts respecting an application which has resulted in a patent, and the rule of the Patent Office respecting an allowable application, simply mean that such appli-

cations are conclusive evidence of the completeness of the invention. In other words, they are conclusive evidence that the stage of the invention has been reached which is evidenced by reduction to practice.

This rule of the Patent Office, as pointed out by Commissioner Mitchell in *Lorraine v. Thurmond*, *supra*, is based upon two well-established principles of the patent law:

(1) We have, in the first place, the principle that a statutory invention (except as modified by the doctrine of "diligence in adapting and perfecting") is a completed invention; that is, an invention which is perfected and adapted to use, or, as otherwise expressed, reduced to practice; and an inventor is not entitled to a patent—in other words, has not made an invention in the legal sense—until he has reduced his invention to practice.

In *Agawam Company v. Jordan*, 7 Wall. (U. S.) 583, 602, 19 L. ed. 177, the Supreme Court said:

"The settled rule of law is that whoever first perfects a machine is entitled to the patent and is the real inventor, although others may have previously had the idea and made some experiments towards putting it in practice. He is the inventor and is entitled to the patent who first brought the machine to perfection and made it capable of useful operation."

In *Seymour v. Osborne*, 11 Wall. (U. S.) 516, 552, 20 L. ed. 33, the Supreme Court said:

"He is the first inventor in the sense of the patent law, and entitled to a patent for his invention, who first perfected and adapted the same to use, and it is well settled that until the invention is so perfected and adapted to use it is not patentable under the patent laws."

In *Clark Thread Company v. Willimantic Linen Company*, 140 U. S. 481, 489, 11 Sup. Ct. 846, 849, 35 L. ed. 521, the court, in an opinion by Mr. Justice Bradley, said, when speaking of the invention covered by the patent in suit:

"It is evident that the invention was not completed until the construction of the machine. A conception of the mind is not an invention until represented in some physical form, and unsuccessful experiments or projects, abandoned by the inventor, are equally destitute of that character. These propositions have been so often reiterated as to be elementary."

In *Woodcock v. Parker*, 30 Fed. Cas. 491, 492 (1813), Mr. Justice Story said:

"The first inventor is entitled to the benefit of his invention if he reduces it to practice and obtains a patent therefor, and a subsequent inventor cannot, by obtaining a patent therefor, oust the first inventor of his right, or maintain an action against him for the use of his own invention."



In *Bedford v. Hunt*, 3 Fed. Cas. 37 (1817), Mr. Justice Story said:

“The first inventor who has put the invention in practice, and he only, is entitled to the patent. Every subsequent patentee, although an original inventor, may be defeated of his patent right upon proof of such prior invention being put into use.”

In the leading case of *Reed v. Cutter*, 1 Story 590, 599, Fed. Cas. No. 11645, Mr. Justice Story said:

“For he is the first inventor in the sense of the act, and entitled to a patent for his invention, who has first adapted and perfected the same to use; and until the invention is so perfected and adapted to use, it is not patentable.”

In *Washburn v. Gould*, 3 Story, 122, 133, Fed. Cas. No. 17,214, Mr. Justice Story said:

“The law is that whoever first perfects a machine is entitled to the patent, and is the real inventor, although others may previously have had the idea, and made some experiments toward putting it in practice. \* \* \* He is the inventor, and is entitled to the patent, who first brought the machine to perfection, and made it capable of useful operation.”

In *White v. Allen*, 2 Fish. 440, 446, Fed. Cas. No. 17,535, Mr. Justice Clifford said:

“In order to constitute an invention, in the sense in which that word is employed in the patent act, the party alleged to have produced it must have proceeded so far as to have reduced his idea to practice, and embodied it in some distinct form. *Gayler v. Wilder*, 10 How. (U. S.) 498, 13 L. ed. 504; *Parkhurst v. Kinsman*, 1 Blatchf. 494, Fed. Cas. No. 10,757; *Curtis on Pat.*, § 43. Mere discovery of an improvement does not constitute it the subject-matter of a patent, although the ideas which it involves may be new; but the new set of ideas, in order to become patentable, must be embodied into working machinery, and adapted to practical use. *Sickles v. Borden*, 3 Blatchf. 535, Fed. Cas. No. 12,832.”

In *Winans v. New York & H. R. Co.*, Fed. Cas. No. 17,864, Mr. Justice Nelson said:

“It is not the person who has only produced the idea that is entitled to protection as an inventor, but the person who has embodied the idea into a practical machine and reduced it to practical use. He who has first done that is the inventor who is entitled to protection.”

(2) At the same time we have the equally well settled rule that an invention need not be perfected and adapted to use, or reduced to practice, in order to obtain a valid patent, since no such condition is contained in the statutes.

This question of reduction to practice arose in the case of *Wheeler v. Clipper Mower & Reaper Company*, 6 Fish. 1, 16,

Fed. Cas. No. 17,493. In the opinion in that case Judge Woodruff said:

“On the argument it was insisted that the patent is void if the patentee did not reduce the invention to practical use before the patent was obtained.

“This proposition is wholly unsound. No such condition is required by the act of Congress; and if it were true that a patent would be void on that ground, no patent could properly be granted unless proof was furnished that the invention claimed had gone into practical use, which is not, and cannot, under the statute, be made a condition of granting the patent. It is enough that the inventor has perfected his invention, and is able to furnish to the Patent Office such specifications and model as the law requires. Having done this, the patent, in so far as prerequisites to its validity, either by way of experiment or use, are material, is valid.”

If any doubt ever existed, however, upon this point, it was conclusively settled by the Supreme Court in the Telephone Cases, 126 U. S. 535, 8 Sup. Ct. 778, 782, 783, 31 L. ed. 863. In that case, Mr. Chief Justice Waite, speaking for the court, said:

“But it is insisted that the claim cannot be sustained, because when the patent was issued Bell had not in fact completed his discovery. While it is conceded that he was acting on the right principle and had adopted the true theory, it is claimed that the discovery lacked that practical development which was necessary to make it practicable. In the language of counsel, there was still work to be done, and work calling for the exercise of the utmost ingenuity, and calling for the very highest degree of practical invention.

“It is quite true that when Bell applied for his patent he had never actually transmitted telegraphically-spoken words so that they could be distinctly heard and understood at the receiving end of his line, but in his specification he did describe accurately and with admirable clearness his process—that is to say, the exact electrical condition that must be created to accomplish his purpose; and he also described, with sufficient precision to enable one of ordinary skill in such matters to make it, a form of apparatus which, if used in the way pointed out, would produce the required effect, receive the words, and carry them to and deliver them at the appointed place. \* \* \*

“The law does not require that a discoverer or inventor, in order to get a patent for a process, must have succeeded in bringing his art to the highest degree of perfection. It is enough if he describes his method with sufficient clearness and precision to enable those skilled in the matter to understand what the process is, and if he points out some practicable way of putting it into operation.”



From these established and seemingly contradictory principles of the patent law, first, that an invention in order to be patentable must be reduced to practice, and, second, that, under the statutes, reduction to practice is not essential either before or after the grant of a patent, it follows that there must be some stage of an invention when it must be presumed as a matter of law that the inventor has reduced his invention to practice; and that stage is presumed to have been reached when he has done all that he is required to do to obtain a valid patent, namely, when he has filed a complete and allowable application; and hence the Patent Office has adopted the rule that the filing of such an application is constructive reduction to practice, and the federal courts have adopted the rule that such an application is conclusive evidence that the patentee made his invention—that is, reduced his invention to practice—at least as early as that date.

The cases which hold that a rejected application is not sufficient to establish priority of invention under the statutes have no bearing on the question of the legal effect of a complete and allowable application which will result or has resulted in the granting of a patent. These cases simply enforce the rule that an invention must be perfected and adapted to use in order to prove prior invention or prior use. *The Corn-Planter Patent*, 23 Wall. (U. S.) 181, 23 L. ed. 161; *Lyman Ventilating & Refrigerator Company v. Lalor*, 1 Ban. & Ard. 403, Fed. Cas. No. 8,632; *Northwestern Fire Extinguisher Company v. Philadelphia Fire Extinguisher Company*, 1 Ban. & Ard. 177, Fed. Cas. No. 10,337.

The further argument is advanced that an application is only evidence of a disclosure of a somewhat stronger character than a conception proved by drawing and disclosure. The answer to this argument is that the courts have uniformly held that an application which eventuates in a patent, and which sufficiently describes the invention, is conclusive evidence that the invention was made at the time the application was filed.

While the defendant insists that the filing of an allowable application is not the equivalent of reduction to practice, it admits that the issue of a patent is the "equivalent in effect in the art to reduction to practice by the completion of a machine." We cannot see the force or reasonableness of this position. The issuance of the patent is an act of government, with which the inventor has nothing to do except to pay the final fee, while in the filing of a complete and allowable application the inventor has performed all the acts required of him under the statute for the grant of a valid patent.

To limit a patentee who has never reduced his invention to practice, and who is not required to do so under the statutes, to

fixing the earliest date of his invention as the date of his patent, is unsupported by authority, and would result in manifest injustice. For example, the Thomas patent was not issued until July 26, 1904, seven years and a half after he filed his application. If the earliest date that can be assigned for the Thomas invention is the date of his patent, any rival inventor who may have reduced his invention to actual practice during this seven and a half years would become the prior inventor, although Thomas may have done all that the law requires to entitle him to a valid patent.

For these reasons we must hold that the date of the Thomas invention is December 17, 1896, the date of his application.

Second. We have now to consider the question whether Watson can carry the date of his invention back to the time of his conception, January 10, 1896. This question must be viewed from two standpoints: First, can it be said that Watson's conception, drawing, and disclosure to others, of themselves, or without regard to his subsequent acts, constitute a complete invention within the meaning of the patent laws? Second, can Watson as a patentee carry back the date of his invention to the time of his conception?

(1) The law appears to be well established that a conception evidenced by disclosure, drawings, and even a model, confers no rights upon an inventor unless followed by some other act, such as actual reduction to practice, or filing an application for a patent. A conception of this character is not a complete invention under the patent laws. It may constitute an invention in a popular sense, but it does not make the inventor the "original and first inventor" under the statutes. If it did constitute an invention under the statutes, then an inventor might stop with his drawings and disclosure, and hold the field for all time against a subsequent inventor who has reduced his invention to practice, or who has obtained a patent. The law will not permit this. An inventor must not stop with this stage of his invention, but he must proceed with reasonable diligence to perfect his invention, either by actual reduction to practice, or by filing his application for a patent.

This rule of the patent law is both reasonable and just. It secures to the first conceiver the right to his invention. It is not uncommon for two persons to conceive an improvement in an existing device about the same time, and all the law exacts of the first conceiver in order to protect him in his right to the invention is that he shall proceed with reasonable diligence to reduce the invention to practice, or to file an application for a patent in conformity with the statutes.



The authorities seem to be conclusive upon the point that a conception evidenced by disclosure and drawings does not constitute an invention under the patent laws.

*Detroit Lubricator Manufacturing Co. v. Renchard* (C. C.) 9 Fed. 293, 297, was a suit for infringement, in which one of the issues raised was priority of invention as between the patentee of the patent in suit and the defendant. In the opinion in that case Mr. Justice Matthews said:

"The defendants exhibit a drawing made by J. V. Renchard which bears date August 10, 1876, and which, it is testified by him, was made on that day, and by others, that he showed it to them about that time. This antedates Parshall's application, but it fails to supersede his patent for the reason that it seems well established in evidence that Renchard did not at that time prosecute the matter beyond the mere drawing. The drawing seems to exhibit a perfect machine in all its parts, and sufficiently to show the combination forming the subject of the present controversy, particularly the metallic oil cup, the siphon tube carrying the condensed water into the glass indicator, and the two chambers, condensing and oil, closely and directly united. Nevertheless, it is clearly proven that the defendants did not, in fact, construct an indicator in this form, and reduce it to actual use, until after it had been successfully accomplished by Parshall, nor until after the date of his patent. This mere drawing, therefore, can not be allowed to have the effect of depriving Parshall of his title of being the first and original inventor."

*Reeves v. Keystone Bridge Company*, 5 Fish. 456, 462, 463, Fed. Cas. No. 11,660, was also a suit for infringement of a patent, and the issue was whether the complainant or the defendant was the first and original inventor. Although the date of the defendant's patent was subsequent to that of the patent in suit, they contended that the invention was actually made by them some time before. In support of this contention they relied upon certain drawings and sketches. In the opinion in that case, Judge McKennan said: "Can an invention be considered as 'perfected and adapted' which has reached only the maturity of an illustration on paper?" After considering various cases, the court states the rule of law in the following language:

"It must, therefore, be considered as an established rule that illustrative drawings of conceived ideas do not constitute an invention, and that, unless they are followed up by a seasonable observance of the requirements of the patent laws, they can have no effect upon a subsequently granted patent to another."

*Pennsylvania Diamond Drill Company v. Simpson* (C. C.) 29 Fed. 288, 290, was another suit for infringement, in which the principal issue was priority of invention. In that case, in order

to avoid anticipation shown by the Ball and Case patents, the patentee of the patent in suit attempted to fix the date of his invention as the time of his conception and drawings. In the opinion by Judge Acheson the law is stated as follows:

"Here, Allison, it would seem, was the first to conceive the invention; but mere conception, which is not seasonably followed by some practical step, counts for nothing as against a subsequent independent inventor, who, having complied with the patent laws, has obtained the patent. It would indeed be a strange perversion of the purpose of the patent laws if one who had conceived of a new device, and proceeded so far as to embody it in rough sketches, or even in finished drawings, could there stop, and yet hold that field of invention against all comers for a period of 12 years. The law does not so reward supineness. Hence, in *Reeves v. Keystone Bridge Co.*, 5 Fish. 456, 463, Fed. Cas. No. 11,660, Judge McKennan declared the established rule to be 'that illustrative drawings of conceived ideas do not constitute an invention, and that, unless they are followed up by a seasonable observance of the requirements of the patent laws, they can have no effect upon a subsequently granted patent to another.' And this principle was enforced by Mr. Justice Matthews in the more recent case of *Detroit Lubricator Mfg. Co. v. Renchard* (C. C.) 9 Fed. 293, although the antedating drawing there exhibited a perfect machine in all its parts."

In *Winans v. New York & H. R. Co.*, Fed. Cas. No. 17,864, which was an action at law for infringement, in which the principal question was whether the plaintiff was the first inventor of the railroad car claimed in his patent, Mr. Justice Nelson, in charging the jury said:

"Now the circumstance that a person has had an idea of an improvement in his head, or has sketched it upon paper, has drawn it and then gives it up—neglects it—does not, in judgment of law, constitute or have the effect to constitute him a first and original inventor. It is not the person who has only produced the idea that is entitled to protection as an inventor, but the person who has embodied the idea into a practical machine and reduced it to practical use. He who has first done that is the inventor who is entitled to protection."

*Electric Railroad Signal Co. v. Hall Railroad Signal Co.* (C. C.) 6 Fed. 603, 605, was a suit for infringement in which the main defense was that the patentee was not the first inventor. The law is stated by Judge Shipman in that case as follows:

"The patent having been granted to Pope, and now being attacked on the ground that the patentee was not the first inventor, it is not enough for the defendant to show that Hall had conceived the same idea, and had made drawings or models, and experiments with his models, but the defendant must establish



that Hall reduced what he conceived to practice in the form of an operative machine, and embodied it in some practical and useful form before Pope made his application, it being a fact in the case that Pope had not reduced his idea to practice before his application. *Ellithorp v. Robertson*, 2 Fish. 85, Fed. Cas. No. 4,408; *Union Sugar Refinery v. Matthiesson*, 3 Cliff. 639, Fed. Cas. No. 14,399. The law on the subject of priority of right between two independent inventors is substantially as it was laid down by Judge Story in *Reed v. Cutter*, 1 Story, 590, Fed. Cas. No. 11,645: 'In a race between two independent inventors, he who first reduces his invention to a fixed, positive, and practical form would seem to be entitled to a priority of right to a patent therefor. The clause of the fifteenth section of the act of 1836, now under consideration, seems to qualify that right by providing that in such cases he who invents first shall have the prior right, if he is using reasonable diligence in adapting and perfecting the same, although the second inventor has, in fact, first perfected the same and reduced the same to practice in a positive form.' *White v. Allen*, 2 Fish. 440, Fed. Cas. No. 17,535; *Reeves v. Keystone Bridge Co.*, 5 Fish. 456, Fed. Cas. No. 11,660; *Agawam Co. v. Jordan*, 7 Wall. 583, 19 L. Ed. 177."

*Draper v. Potomska Mills Corporation*, Fed. Cas. No. 4,072, was a suit for infringement, and one of the defenses was that the patentee was not the original and first inventor. In that case Judge Shepley said:

"Illustrated drawings of conceived ideas do not constitute an invention, and, unless they are followed up by a seasonable observance of the requirements of the patent laws, they can have no effect upon a subsequently granted patent to another. But a patentee whose patent is assailed upon the ground of want of novelty may show by sketches and drawings the date of his inventive invention, and, if he has exercised reasonable diligence in perfecting and adapting it, and in applying for his patent, its protection will be carried back to such date."

In *Ellithorp v. Robertson*, Fed. Cas. No. 4,408, which was a bill in equity brought to have a patent already issued declared void, and the complainant decreed to be the first and original inventor, and entitled to a patent, the court said:

"To constitute such a prior invention as will avoid a patent that has been granted, it must be made to appear that some one before the patentee not only conceived the idea of doing what the patentee has done, but also reduced his idea to practice and embodied it in some practical and useful form. The idea must have been carried into practical operation. The making of drawings of conceived ideas is not such an embodiment of such conceived ideas in a practical and useful form as will defeat a patent which has been granted."

(2) The next question we have to consider is whether Watson as a patentee can carry back the date of his invention to the date of his conception; that is, to his drawing and disclosure of January 10, 1896. It is conceded that a patentee who has used "reasonable diligence in adapting and perfecting" his invention can carry the date back to his drawings and disclosure; and the only question which arises is whether the law will permit him to do this in the absence of such reasonable diligence. In other words, can a patentee stop with his drawings and disclosure for an unreasonable time, and then, by virtue of his subsequently obtaining a patent, hold this field of invention against a rival inventor whose conception of the same invention was later, and who proceeded with diligence to build a practical machine, or to file an application for a patent? In our opinion, he can not do this under the patent laws.

We understand the true rule to be that a patentee who undertakes to carry back the date of his invention to his drawings and disclosure must show reasonable diligence in adapting and perfecting his invention, either by actual reduction to practice or by filing his application. This rule is supported by the great weight of authority, and we have found no cases which directly hold that this is not the law, although there are some cases in which a patentee has been permitted to carry back his invention to his drawings and disclosure, where the question of diligence was not raised or passed upon. *Loom Co. v Higgins*, 105 U. S. 580, 594, 26 L. Ed. 1177; *Dodge v. Porter* (C. C.) 98 Fed. 624, 625; *Westinghouse Electric & Mfg. Co. v. Stanley Instrument Co.*, 133 Fed. 167, 68 C. C. A. 523.

No sound reason has been advanced why the doctrine of diligence should not apply to a patentee as well as to an inventor who has not secured a patent. On the other hand, any such distinction in favor of patentees is not in harmony with the patent laws. We have seen that an invention in the sense of the patent law signifies a completed invention, and that the earliest date of an invention is the time of its completion. We have also seen that an invention may be completed either by actual reduction to practice or by filing a complete and allowable application in conformity with the statutes.

This general principle, however, is subject to this qualification:

By section 15 of the act of July 4, 1836, c. 357, 5 Stat. 123, it is provided that a defendant in an action upon a patent may set up in defense that the plaintiff had "surreptitiously or unjustly obtained his patent for that which was in fact invented by another who was using reasonable diligence in adapting and perfecting the same."



Section 6 of the act of Feb. 21, 1793, c. 11, 1 Stat. 322, provided that a defendant in an action upon a patent may set up that the plaintiff "had surreptitiously obtained a patent for the discovery of another person," and section 15 of the act of 1836 amended this section by adding the words "or unjustly," and the words "for that which was in fact invented by another who was using reasonable diligence in adapting and perfecting the same."

This amendment introduced a new and just principle into the patent law, inasmuch as it protected the first conceiver of the invention by permitting him to carry back the date of his invention to the time of his drawings and disclosure, provided he was using reasonable diligence in adapting and perfecting his invention. This amendment was fully considered by Mr. Justice Story in *Reed v. Cutter*, *supra*. In that case Mr. Justice Story said:

"The patent act of July 4, 1836, c. 357, §§ 7, 8, 13, 15, 16, 5 Stat. 322, expressly declares that the applicant for a patent must be the first, as well as an original, inventor. The passage cited from Mr. Phillips' work on Patents (page 395), in the sense in which I understand it, is perfectly accurate. He there expressly states that the party claiming the patent must be the original and first inventor; and that his right to a patent will not be defeated by proof, that another person had anticipated him in making the invention, unless such person 'was using reasonable diligence in adapting and perfecting the same.' These latter words are copied from the fifteenth section of the act of 1836 (chapter 357), and constitute a qualification of the preceding language of that section; so that an inventor who has first actually perfected his invention will not be deemed to have surreptitiously or unjustly obtained a patent for that which was in fact first invented by another, unless the latter was at that time using reasonable diligence in adapting and perfecting the same. And this I take to be clearly law; for he is the first inventor in the sense of the act, and entitled to a patent for his invention, who has first perfected and adapted the same to use; and until the invention is so perfected and adapted to use it is not patentable. An imperfect and incomplete invention, resting in mere theory or in intellectual notion, or in uncertain experiments, and not actually reduced to practice, and embodied in some distinct machinery, apparatus, manufacture, or composition of matter, is not, and indeed can not be, patentable under our patent acts, since it is utterly impossible, under such circumstances, to comply with the fundamental requisites of those acts. In a race of diligence between two independent inventors, he who first reduces his invention to a fixed, positive, and practical form would seem to be entitled to a priority of right to a patent therefor. *Woodcock v.*

Parker, Fed. Cas. No. 17,971. The clause of the fifteenth section, now under consideration, seems to qualify that right, by providing that, in such cases, he who invents first shall have the prior right, if he is using reasonable diligence in adapting and perfecting the same, although the second inventor has, in fact, first perfected the same, and reduced the same to practice in a positive form. It thus gives full effect to the well-known maxim that he has the better right who is prior in point of time, namely, in making the discovery or invention."

This decision has been followed in many cases, and we are not aware that it has ever been questioned. According to *Reed v. Cutter*, Fed. Cas. No. 11,645, section 15 of the act of 1836 secures to the first inventor the prior right, provided he uses reasonable diligence in adapting and perfecting his invention, and this rule applies to all inventors, whether patentees or otherwise.

The defendant relies largely upon the language of the court in *Loom Company v. Higgins*, 105 U. S. 580, 594, 26 L. Ed. 1177. In that case the court said:

"Webster had invented it before that time, and had made a drawing of it, which in March, 1868, he exhibited and explained to Davis. An invention relating to machinery may be exhibited either in a drawing or in a model, so as to lay the foundation of the claim to priority if it be sufficiently plain to enable those skilled in the art to understand it. There is no doubt that Davis understood Webster's drawing, and he did not then claim that the invention belonged to himself."

It will be observed that the court does not consider or pass upon any question of diligence, and that the language is simply to the effect that a drawing or a model may "lay the foundation of the claim to priority." Further, an examination of the facts in *Loom Company v. Higgins* shows that Webster was clearly the prior inventor, since he filed his application for a patent before Davis (who never applied for a patent) reduced the invention to practice. Again, to interpret broadly, the language used in *Loom Company v. Higgins* as meaning that a completed invention under the patent laws "may be exhibited in a drawing or in a model," is inconsistent with the rule laid down by the Supreme Court and the Circuit Court in the cases already cited. In this connection we need only refer to the later case of *Clark Thread Company v. Willimantic Linen Company*, supra, where Mr. Justice Bradley (who wrote the opinion in *Loom Company v. Higgins*) said, in the opinion of the court, that the invention covered by the patent sued upon "was not completed until the construction of the machine."

In *Odell v. Stout* (C. C.) 22 Fed. 159, 164, the patentee attempted to carry back the date of his invention by means of



drawings. This case was heard by Mr. Justice Matthews and Judge Sage. Mr. Justice Matthews was a member of the court which decided *Loom Company v. Higgins*. In the opinion by Judge Sage it was said:

"It is settled that 'an invention relating to machinery may be exhibited either in a drawing or in a model, so as to lay the foundation of a claim to priority, if it be sufficiently plain to enable those skilled in the art to understand it.' *Loom Co. v. Higgins*, 105 U. S. 594, 26 L. Ed. 1177. But this rule is to be taken with proper qualifications. Drawings may carry date of invention back if reasonable diligence is shown. *Kneeland v. Sheriff*, 18 O. G. 242. Making drawings of an idea is not invention, and is of no effect unless followed up. *Draper v. Potomska Mills*, 13 O. G. 276. Merely making drawings is not such an embodiment of invention as will defeat a subsequent patent. *Ellithorp v. Robertson*, 4 Blatchf. (U. S.) 307, Fed. Cas. No. 4,408. The reasons for this qualification of the rule are well stated in section 61, *Walker on Patents*."

We think this opinion states the true rule, and that the language of the court in *Loom Company v. Higgins* must be understood with the qualification respecting reasonable diligence in perfecting the invention.

In *Reeves v. Keystone Bridge Company*, supra, the court said:

"A patentee whose patent is assailed upon the ground of want of novelty may show by sketches and drawings the date of his inceptive invention, and if he has exercised reasonable diligence in 'perfecting and adapting' it, and in applying for his patent, its protection will be carried back to such date. \* \* \* Reasonable diligence in 'perfecting and adapting' the invention is essential to the efficacy of such a claim."

In *Christie v. Seybold*, 55 Fed. 69, 76, 5 C. C. A. 33, 40, the court, after citing with approval Judge Story's language in *Reed v. Cutter*, said:

"It is obvious from the foregoing that the man who first reduces an invention to practice is prima facie the first and true inventor, but that the man who first conceives, and, in a mental sense, first invents a machine, art, or composition of matter, may date his patentable invention back to the time of its conception, if he connects the conception with its reduction to practice by reasonable diligence on his part, so that they are substantially one continuous act."

In *Merrow v. Shoemaker* (C. C.) 59 Fed. 120, 122, where the inventor undertook to carry back the date of his invention to his drawings and disclosure, Judge Dallas said in his opinion:

"If so, he has established his date of invention as not later than that day, and the question of anticipation must be solved

with reference thereto, provided that he was duly diligent in filing his application for a patent and in constructing his machine."

See, also, *Detroit Lubricator Manufacturing Company v. Renchard*, supra; *Pennsylvania Diamond Drill Company v. Simpson*, supra; *Electric Railroad Signal Company v. Hall Railroad Signal Company*, supra; *Draper v. Potomska Mills Corporation*, supra.

We come now to the remaining question, whether Watson was reasonably diligent in adapting and perfecting his invention.

Upon this question of fact the decision of the Patent Office tribunals and the Court of Appeals of the District of Columbia is entitled to great weight, if it is not absolutely controlling.

In *Morgan v. Daniels*, 153 U. S. 120, 125, 14 Sup. Ct. 772, 773, 38 L. ed. 657, a suit was brought under § 4915 of the Revised Statutes by the party who was refused a patent in interference proceedings, to determine the question whether he should not be adjudged entitled to a patent. In that case the court used the following language:

"Upon principle and authority, therefore, it must be laid down as a rule that, where the question decided in the Patent Office is one between contesting parties as to priority of invention, the decision there made must be accepted as controlling upon that question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction."

There are four admitted facts with respect to Watson's diligence: (1) Watson conceived the invention, illustrated it by a drawing, and disclosed it to Doble as early as January 10, 1896; (2) he made working drawings some time between January 10, 1896, and the early part of January, 1897, when the exhibit blue print which was taken from the working drawings was handed to the patternmaker, Frazer; (3) he completed the building of a machine in April, 1897; (4) the main reason for the delay was business considerations arising from the fact that John F. Cushing had made a contract with the Electric Scale Company to build 10 single-hopper machines under the Doble and Watson patent.

Watson assigned his application to the Electric Scale Company, and the patent issued to that company as assignee. W. H. Doble was the manager of the Electric Scale Company. The Cushing contract with the Electric Scale Company was made January 28, 1896. The additional evidence taken in this case relates to the time during 1896 when these working drawings were made. In our opinion this is immaterial; and it may be assumed, as stated by Watson, and now testified to by Doble, that these drawings were made in the fall of 1896.



The main point against Watson on the question of diligence is that for business reasons nothing was done with respect to his invention between January, 1896, and January, 1897, except to make working drawings, or, upon the evidence as it now stands, nothing was done until September, 1896, when Watson began on the working drawings. As to the reason for this delay, Mr. Doble testified in the interference proceedings as follows:

"As he [Cushing] guaranteed the speed and accuracy, and was the responsible party, I did not care whether he accomplished this one hopper or a dozen."

"Before January, 1897, they had done nothing except complete the drawings. This contract with John P. Cushing which practically gave, if carried out, all the results that could be accomplished under the double hopper, kept them from acting during the early part of the year, and the fact that they were held to Cushing by this contract kept them from acting later. I would say that I was practically the only one in the company who knew just what was going on and took an active part in the affairs of the company. In January, we had the patterns made for the double hopper and the casting made from same on 1st of February."

"After receiving the drawings from Mr. Watson, in 1896, nothing was done in an active way, as I was trying to induce Mr. Cushing to put the double hopper onto the machines he had constructed, and which failed to do the work for which they were designed. Individually, I had no money to manufacture with myself, and the company had but a limited amount, and were practically bound to Mr. Cushing by his contract until such time as he threw up the same."

Mr. Watson also testified as follows:

"In the late summer of 1896, Mr. Cushing had proceeded with his contract until a part of the machines had been finished, and he was experimenting at that time with devices which he was called upon to furnish under his contract for the remaining machines. At the same time he had told me that it was his intention to discontinue his business at the close of the year 1896, and had so told me that I might be on the lookout for other employment. At that time I mentioned to Mr. Cushing the idea of the double hopper, and suggested to him that such an arrangement would assist him in fulfilling his contract in the completion of the remaining machines. As the result of my interview with Mr. Cushing, I thought that he was favorably impressed with the idea that the double hopper would be of use to him in completing the remaining machines; and with the idea that he thought such an arrangement would be useful to him I went to work making drawings of the additional hopper and its mechanism, so that it might be applied to the machines that he

was building. A portion of this time so spent was while actively employed on Mr. Cushing's work, and a portion of it on outside time. I consulted with Mr. Cushing and showed him some of these drawings, but he finally concluded that it would not be necessary for him to use the idea in the completion of his contract."

Upon the state of facts presented in the interference proceedings and in this record, we agree with the conclusion of the Patent Office tribunals and the Court of Appeals of the District of Columbia that Watson failed to use such diligence as the law requires.

In its decision the Court of Appeals said:

"The determination of the question depends upon the action or inaction of Watson during the period intermediate between the date of his conception of the invention, January 10, 1896, and the filing date of Thomas' application, December 17, 1896. But during all this period we find no evidence whatever of action on the part of Watson to reduce his conception to practice, beyond the making of some working drawings and a blue print taken from them, if indeed these were made during that interval; for their date is left in extreme doubt by the testimony, and it is not at all certain that they were made before January of 1897. Even if they had been made before the filing of Thomas' application, they could scarcely be held to have been a manifestation of due diligence on the part of Watson. During the whole of the year 1896 he was busy with the single-hopper machine; and during the year he took out a patent for that machine. If he had the device of the double hopper perfected in his own mind, no reason is shown why it could not have been reduced to practice; nor is there any reason shown why he could not have applied for a patent." *Watson v. Thomas*, 23 App. Cas. D. C. 65, 68.

Since infringement is not denied as to the defendant's machine complained of, it follows that a decree should be entered for the complainant for an injunction and an account, as prayed for in its bill.

The decree of the Circuit Court is reversed, and the case is remanded to that court for proceedings in accordance with this opinion, and the appellant recovers its cost of appeal.

379. PAUL v. HESS, 24 App. Cas. D. C. 462, 115 O. G. 251, 1905 C. D. 610.  
Shepard, J.: \* \* \*

The case of the appellee, Hess, stands, both for conception and reduction to practice, upon an application disclosing the invention which was filed April 26, 1901. This application ripened into a patent, but no benefit accrued to him therefrom, in respect



of the burden of proof imposed upon his adversary, the appellant Paul, because the latter's application was pending at the time of the issue. That application having been filed later, the burden was imposed upon Paul to show a reduction to practice preceding Hess's date, or else an earlier conception followed up with due diligence to reduction to practice, either actual or constructive.

The tribunals of the Patent Office agreed on the sufficiency of Paul's proof to show a conception of the invention about August 1, 1899; but, all concurring, denied his reduction to practice as well as diligence in reduction thereafter.

From the final decision of the Commissioner awarding priority to Hess, Paul has prosecuted this appeal.

The claim of actual reduction to practice is founded on a model constructed October 18, 1899, which has been made an exhibit in the case.

This model is a type-writing machine, having in it six bars answering the description of the issue. Paul testified that he manipulated these bars and thereby satisfied himself of the practical mechanism of his invention. No piece of paper was used in making his test, and it is apparent that his satisfaction was derived from the operation of the bars singly when struck with the finger. We agree with the tribunals of the Patent Office that this is not sufficient to show an actual reduction to practice.

It is true, as we have heretofore held in several cases, that some devices may be so simple and their efficacy so obvious upon mere inspection, that the construction of one of a size and form capable of practical use may well be deemed a sufficient reduction to practice without actual use or test to demonstrate its complete success and probable commercial value. (*Mason v. Hepburn*, 13 App. D. C., 86, 89, case of clip for gun; *Lindemeyer v. Hoffman*, 18 App. D. C., 1, cap for bottles; *Loomis v. Hauser*, 19 App. D. C., 401, paper-ticket holder; *Couch v. Barnett*, 23 App. D. C., 446, horse-collar.)

Bearing in mind the intended purpose and use of the new type-bar under consideration, it is not of the simple character of the inventions above mentioned. It constitutes one of the essential parts of a type-writing machine, upon the successful operation of which, entirely supplied with the new bars, the demonstration of its efficacy depends. This called for the application of another and different rule. (*McDonald v. Edison*, 21 App. D. C. 527, 529.) And it was therefore necessary for the inventor to show that a type-writing machine supplied with the new bars had been constructed and tested sufficiently to show that it was capable of successfully performing the work for which it was intended. As was well said by the Examiners-in-Chief:

“In a case where the new devices are of an old type and their novelty consists in specific construction 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 devices is a new type. A type-bar-actuating mechanism of a new type, in order to be in practical form, must be one which can be operated with a light touch and one which must act with practical promptness and certainty and with uniform and adequate force. When it is of a new type there is need for demonstration of its practical utility, of a use of it under the conditions of industrial use, and evidence that that use demonstrated its practical operation.

Notwithstanding Paul's statement that he was satisfied with the practical success of the new bar, his action thereafter, and that of the company with which he was engaged, point to a different conclusion. He says that he submitted it to the company, but it was not accepted and adopted. On the other hand, the company adopted another machine called the “Improved Daugherty.” This not giving satisfaction was withdrawn and another, not of the type of Paul's model, was substituted and put on the market. Regarding these facts as negating the claim that the exhibit represented a complete and practical invention at the time, the Commissioner proceeds to say:

“Either Paul or the company could have filed an application in the Patent Office on this machine, had they so desired at any time after its alleged completion in October, 1899, whereas none of the five modifications of the application in interference shows the pin-and-slot connection used in the embodiment of the issue in “Paul's first machine,” and no application based on the specific structure of this machine was filed until November 1, 1901. Paul states that applications for patents based on “Paul's first machine.” and the “Improved Daugherty” machine were prepared for the company in March, 1900. The application on the “Improved Daugherty” machine, it is stated, was filed in the Patent Office in May, 1901, but the applications on “Paul's first machine” were not filed. This indicates an abandonment of “Paul's first machine” in favor of the “Improved Daugherty” rather than a knowledge of its practicability at that time, as argued by Paul. Paul's unsupported statement that the applications on his machine were not filed because he and the company could not come to terms upon this invention is of little weight. That an application based on “Paul's first machine” was eventually filed November (June 25?) 1, 1901, is of little significance, as the prior Paul-Hess interference had then been declared, and the importance of establishing this machine had become evident.

Long delay in making use of an invention claimed to have been reduced to practice, or in applying for a patent, have al-



ways been regarded as potent circumstances tending to show that the alleged reduction to practice was nothing more than an unsatisfactory or abandoned experiment. (Traver v. Brown, 14 App. D. C., 34, 41; Reichenbach v. Kelley, 17 App. D. C., 333, 344; Latham v. Armat, *idem*, 333, 353.) And this is specially the case where, in the meantime, the inventor has been engaged in the prosecution of similar inventions, (Fefel v. Stocker, 17 App. D. C., 317, 321), or others, without reasonable explanation, have been adopted for manufacturing and commercial use.

Having the benefit of conception only by the construction of his device in October, 1899, Paul was not exercising diligence when his rival entered the field. While nothing was being done to complete this invention by reduction to practice, two other type-writing machines had been adopted and put on sale by the company.

Concurring with the Patent Office tribunals in this conclusion also, we approve and adopt the following extract from the opinion of the Commissioner:

“Aside from business reasons, Paul could undoubtedly have caused the company to file the Pattison applications, or else have had prepared and filed an application on his own account at that time. The application on Paul's Daugherty improvement was filed during the period of delay. Paul urges in excuse of delay that he could not come to terms with the company upon this invention and that as their employee, constructing the model and machine at their expense, it was only proper that he should refrain from applying for patents on his own account until finally convinced of the impossibility of agreement. This excuse does not attempt to explain why an understanding with the company could not have been reached sooner either that they file the Pattison applications or let Paul protect the invention himself. Moreover, it rests upon the bare assertion of Paul entirely unsupported by evidence. Even if properly supported and covering the entire period of delay, this excuse would be insufficient as not of the character required. It involves mere business consideration and not circumstances of a compelling nature. Diligence will not wait on business arrangements. (Kassan v. Hetherington, 88 O. G., 1157.)”

Without further discussion, the decision appealed from will be affirmed. It is so ordered. The clerk will certify this decision to the Commissioner of Patents as required by law. Affirmed.

880. SYDEMAN v. THOMA, 32 App. Cas. D. C. 362, 141 O. G. 866, 1909 C. D. 340.

Shepard, J.: \* \* \*

All of the tribunals of the Patent Office concurred in holding that upon this state of facts, there was no reduction to prac-

tice in May, 1904; and that there was no diligence being exercised by the inventors in the matter of reduction to practice when Thoma entered the field. Whether certain acts done, show reduction to practice depends upon the special facts and circumstances of each particular case. As was said in a former case:

“In considering the question we apprehend that the same act or set of acts may or may not constitute reduction to practice, modified, as they may be, by the special circumstances of the particular case. We do not think that the size of a device is necessarily controlling in determining the question of reduction to practice. In the *Cornplanter Patent*, 23 Wall. 181, a half-sized device was held to be the equivalent of a reduction to practice, but that device was actually used in planting corn, and completely demonstrated the utility and practicability of the device. Nor do we think mechanical perfection, or that, as has been well stated, there are “possibilities of greater excellence in shape, location, arrangement, material, or adjustment,” essential to a reduction to practice. Tested by any such requirements, nearly every pioneer invention, as put upon the market, would have failed to support the patent granted to it. Nevertheless, it is essential that a device to constitute a reduction to practice must show that ‘the work of the inventor must be finished, physically as well as mentally.’ Nothing must be left to the inventive genius of the public. *Gallagher v. Hien*, 25 App. D. C., 77, 81, 82.”

The device in that case was a frictional spring for use in railway-couplings. Gallagher was the first to conceive the invention, and relied upon a test as actual reduction to practice. He made a spring the exterior rings of which were something over three inches in diameter, and about an inch wide. It was first tested by pressure in a vise. It was then taken to the shops and the springs tempered; after which, it was put in a vise on the anvil of a very powerful steam-hammer. It made a good showing of its action, but finally broke under a very hard blow. This was held not to constitute reduction to practice, and priority was awarded to Hien who conceived the invention later, but made a satisfactory reduction to practice. As appears from the opinion quoted above, the difficulty does not lie in the fact that the spring was small. The invention was declared a simple one, but it was said that it—

“Undoubtedly belongs to that class which requires either actual use or thorough tests to demonstrate its practical utility, and therefore there can be no actual reduction to practice until one or the other thing takes place and is proven.”

Decisions involving this often-litigated question of actual reduction to practice may be divided into three general classes. The first class includes devices so simple and of such obvious efficacy that the complete construction of one of a size and form



intended for and capable of practical use, is held sufficient without test in actual use. *Mason v. Hepburn*, 13 App. D. C., 86, 89; *Lindemeyer v. Hoffman*, 18 App. D. C., 1, 5; *Loomis v. Hauser*, 19 App. D. C., 401, 404; *Couch v. Barnett*, 23 App. D. C., 446, 449; *Rolfe v. Hoffman*, 26 App. D. C., 336, 342. The second class consists of those where a machine embodying every essential element of the invention, having been tested and its practical utility for the intended purpose demonstrated to reasonable satisfaction, has been held to have been reduced to practice notwithstanding it may not be a mechanically-perfect machine. In other words it is sufficient reduction to practice although a more desirable commercial result may be attained by some simple and obvious mechanical improvement, or by substituting another well-known material for the one used in the original construction, as for example, metal for wood, cast metal for sheet metal, and the like. *Coffee v. Guerant*, 3 App. D. C., 497, 499; *Norden v. Spaulding*, 24 App. D. C., 286, 290; *Smith v. Brooks*, 24 App. D. C., 75, 80; *Andrews v. Nilson*, 27 App. D. C., 451, 457; *Lowrie v. Taylor*, 27 App. D. C., 522, 526; *Burson v. Vogel*, 29 App. D. C., 388, 394; *Howard v. Bowes*, 31 App. D. C., 619, 622. The third class includes those where the machine is of such a character that the particular use for which it is intended must be given special consideration, and requires satisfactory operation in the actual execution of the object. *McDonald v. Edison*, 21 App. D. C., 527, 529; *McKenzie v. Cummings*, 24 App. D. C., 462, 467; *Gallagher v. Hien*, 25 App. D. C., 77, 82; *Ocuppaugh v. Norton*, 25 App. D. C., 90, 93, 94; *Sherwood v. Drewson*, 29 App. D. C., 161, 173.

In cases falling within the second and third classes described, long delay in putting the machine in actual use for the intended purpose, has always been regarded as a potent circumstance in determining whether the test was successful or only an abandoned experiment.

Notwithstanding the failure of Sydemann and Meade to attempt to introduce the machine of 1904 into commercial use, when it was of such great importance to do so, and their negligence in constructing the new and improved machine of 1905, which they regarded as showing such patentable novelty as to entitle the improver, Gallagher, to claim a part of the invention, it is earnestly contended that the evidence in regard to the construction and test of the 1904 machine brings it within the principle of the second class of cases above mentioned. We can not concur in this view. As before said, it was known that the coated duck could be moistened and heated so that it would adhere effectually to the leather insole of the shoe. The purpose in view was to construct a machine that would operate so as to perform this moistening and heating in a practically useful man-

ner commercially. The purpose of the parties was to produce a machine for "rapidly and efficiently" treating the coated fabric so that it would become sufficiently soft and tacky, as it emerged continuously from the machine, to be effectually applied to the leather innersoles. Without this capacity the machine was of no practical utility, and valueless to the manufacturer of shoes on the one hand, and the manufacturers of the fabric on the other. Becoming satisfied that the machine was too slow, that is to say, in our opinion, that it would not efficiently as well as rapidly dry and heat the wet fabric, the parties laid it aside, and did not go actively to work to improve upon it until they had heard of the apparent success of Thoma's machine and process. We are constrained to hold that there was not a reduction to practice, as claimed, in 1904. To hold otherwise would establish a dangerous precedent.

It is evident, from what has been said regarding the delay of the parties between May, 1904, and May 19, 1905, that they were not exercising the requisite diligence when Thoma entered the field.

These conclusions render it unnecessary to consider the question raised as to the credibility of the evidence relating to the alleged reduction to practice in 1904.

The decision in favor of Thoma will be affirmed. It is so ordered; and that the clerk certify this decision to the Commissioner of Patents.

381. GRIFFIN v. SWENSON, 15 App. Cas. D. C. 135, 89 O. G. 919, 1899 C. D. 440.

Morris, J.:

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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 patents for crude and incomplete devices, *Yates v. Huson*, 8 D. C. App. 93, and we have also said that the law fosters diligence for the reason that an inventor is always bound to anticipate that a rival may appear upon the field at any time, *Platt v. Shipley*, 11 D. C. App., 576; but neither the delay that is proper in the one case nor the diligence that is due in the other can in the absence of any statutory limitation of time in this regard be measured by any arbitrary standard. It has been repeatedly held that the question of due diligence is one to be determined in each case by its own circumstances, *Bradford v. Corbin*, 6 O. G., 223; *Hunter v. Miller*, 50 O. G., 1765; *McCormick Harvesting Machine Company v. Minneapolis Harvester Works*, 51 O. G., 1130, and while less



harm is done and the policy of the law better promoted by a rigid insistence upon the requirement of diligence than by laxity in the encouragement of delay it does not seem that the rule of diligence should be pushed to a harsh and unreasonable extent. A shorter delay even than one of four months if consumed in inaction might suffice to sustain a charge of laches; but a period of four months expended in reasonable activity—and what the law requires is reasonable, not extraordinary, activity—is not an unusual time to expend in preparation for an application to the Patent Office. Although there is no question here as to a race of diligence between the parties, the appellee himself waited for eight months without any apparent cause before filing his application, if we are to regard as correct the statement that he conceived and disclosed the invention in question as early as February, 1895. For one placed in the position of the appellant we can not consider that any laches are to be attributed to him for his course between September, 1895, and the date of his application for a patent. We think that the tribunals of the Patent Office were led into error by commingling and practically confounding the two causes and charging the appellant in both cases with the delays which it was proper to charge to him only in one of the cases.

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382. CROSKY v. ATTERBURY, 9 App. Cas. D. C. 207, 76 O. G. 163, 1896 C. D. 437.

Cole, J.:

This is an appeal from the decision of the Commissioner of Patents in an interference proceeding in his office awarding priority of invention to the appellee for an improvement in the process of manufacturing hollow glassware. The Examiner of Interferences, the Board of Examiners-in-Chief, and the Commissioner of patents, the three tribunals of the Patent Office authorized by the rules thereof to determine questions arising upon interferences, upon successive appeals pronounced in favor of the appellee as to both of the issues involved in the interference. Those issues are as follows:

“1. The process of forming hollow articles of glassware consisting in pressing into a mold from a mass of glass in a font and over and around a plug sustained in the mold, sufficient glass to fill the mold and finishing a definite portion of the article by such pressure, separating the partially-finished blank from the mass of glass in the font and finally blowing the unfinished portion to the desired shape.

“2. The process of forming several articles of glassware simultaneously which consists in forcing a mass of molten glass

from a font around a series of two or more cores each arranged in a suitable mold-cavity, separating the blanks thus formed from the glass in the font and then simultaneously blowing the bodies of the several blanks to the desired shape."

The appellee filed his application involved in this interference in the Patent Office on the 1st day of October, 1892, and the appellant filed his on the 28th day of December, 1893. In his preliminary statement the appellant claims conception of the invention and the making of drawings in the month of August, 1889, and the making of other drawings from time to time from that date until January, 1893, and disclosure to others about July, 1890, and actual reduction of the invention to practice in or about the month of October, 1892. The Commissioner finds the earliest date of drawings and disclosure to others by appellant to be December 15, 1890. In the view we take it becomes immaterial to determine whether appellant is entitled to an earlier date for drawings and disclosure than that accorded to him by the Commissioner. The Commissioner also finds that appellant completed a mold for the purpose of practicing the invention on the first day of October, 1892, and that he actually practiced the invention of the first issue by making articles of glassware in accordance therewith on the 3d day of October, 1892; and the correctness of these findings is acquiesced in by both parties to this appeal.

The appellee in his preliminary statement claims conception of the said invention about the middle of June, 1892, drawings and disclosure to others about July 6, 1892, and actual reduction to practice about the 1st of October, 1892. It was conceded at the argument, however, that appellee's first actual reduction to practice did not occur until about the 22d day of October, 1892. The other dates claimed by appellee were adopted as correct by the Commissioner, and the accuracy thereof is not seriously questioned by appellant if appellee is to be considered an original inventor at all. \* \* \*

Second. Was appellant's completed mold actual reduction to practice? Actual reduction of an invention to practice, as the words themselves indicate, is the actual application of the invention to the accomplishment of the purpose for which it is intended. If the subject of the invention be machinery or an improvement therein, then the construction of a machine according to the invention is actual reduction to practice; but the making of a model by which the machine may be constructed is not. *Porter v. Loudon*, 23 Wash. L. R. 689. It follows that where the invention is a process, as in this case, the process must be performed in order to make actual reduction to practice. The Commissioner in his opinion in this case states the principle accurately in the following language:



"It is strenuously urged by Crosky that inasmuch as his mold was finished by October 1, 1892, he should have that date for his reduction to practice. He reaches that date by reasoning that as the mold was actually tried on October 3, 1892, which was Monday, this mold must have been finished on Saturday or probably before, because Saturday was a half-holiday. The invention in this case, however, is not a mold, but a process or series of acts, and I think that as a general rule it may be said that to reduce a method or process to practice the series of acts must be actually performed.

"It is true that in many cases the inventor is obliged to produce a new machine or apparatus to successfully work his process. It is possible that a case might arise in which the new method would be so clearly shown by an inspection of the new machine or apparatus that it would seem like straining a point to insist that the machine or apparatus must actually be used to effect a reduction to practice of the process. That is not the usual case, and clearly it is not the case now in question. This interference covers a process which is not apparent from an inspection of the mold and which is not in fact carried out by the mold acting automatically, but which requires other apparatus in connection with this mold for its successful operation."

Actual reduction to practice is also similarly defined in the case of *Lorraine v. Thurmond*, 51 O. G., 1781. It is also worthy of comment that counsel for appellant in their third reason for appeal from the Examiner of Interferences to the Board of Examiners-in-Chief and in their fourth reason of appeal from the latter to the Commissioner expressly claim that the earliest actual reduction of the process to practice was by appellant on the 3d of October, 1892, when he actually made articles of glassware in accordance with it. It must therefore be held that appellant's earliest actual reduction to practice was at the last-named date.

Third. Was appellee's application filed on the 1st day of October, 1892, constructive reduction to practice of the invention in interference, and, if so, has that the same effect in this contest as actual reduction to practice?

In a contest upon the question of priority of invention, if the first to conceive is guilty of laches in completing and reducing his conception to practice, and in the meantime, and while he is not in the exercise of due diligence, another conceive the same invention, then he who first reduces the invention to practice is, in law, the first inventor, and the filing of a completed allowable application for a patent for the invention is a constructive reduction to practice and is as effectual in a contest of priority as actual reduction to practice. *Porter v. Loudon*, 23 Wash. L. R., 689; *Yates v. Huson*, 24 Wash. L. R., 214, and the

cases and authorities referred to in the opinions in those cases. Appellant's counsel impliedly admit the correctness of this rule, but contend that appellee's application should not be considered constructive reduction to practice in this case, because they allege that it was not an allowable application at the time it was filed and did not become such until it was amended May 18, 1893, by inserting the claims in interference and the words "or in any suitable or known manner" in the original application, and refer to Rule 116 of the Rules of Practice of the Patent Office and the case of Edison v. Ball, 71 O. G., 1313, and other like cases construing said rule. The rule referred to is in the following language:

"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 claim the same in their completed applications for patents clearly illustrating and describing the invention; and the burden of proof will rest upon the party who shall seek to establish a different state of facts."

This rule and the cases construing it refer only to the question of the burden of proof and have no application whatever to the subject of a completed and allowable application. Under the statutes and Rules of Practice of the Patent Office a completed and allowable application is one which, with the specifications, drawings, and model, if any, required to be filed therewith, describes a patentable invention in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it relates to make and use the same. R. S. U. S., § 4888; Patent Office Rule No. 30.

Either the specifications, drawings, models, or claims may be amended at any time, so as to make each correspond with the other; but nothing involving a departure from the original invention can be introduced by amendment. Such an amendment forms no basis for an argument that the application was not an allowable one when filed. (Patent Office Rules from 68 to 78, inclusive, especially Rule 71.) And these rules only state in positive terms the principles which would govern in the absence of such rules. They are the principles which apply to the amendments of pleadings and proceedings in courts. Applying them to the application of the appellee as it was when filed and when placed in interference it is clear that none of them were violated in allowing the amendments to be made, even if that question be now open to the appellant, which may be doubted. The invention in interference was clearly set forth and described in the specifications filed with appellee's original application, and the only object of the amendment was to make the claims conform thereto, nothing new having been introduced thereby. Such an amendment is provided for by Rule 109 even after an inter-



ference has been declared. That the authorities of the Patent Office understood that no new matter was introduced by these amendments is apparent from the fact that no new or additional oath was required to the amendments when one would have been requisite by Rule 48 if anything not disclosed in the original application had been claimed. That counsel for appellant so understood it may be inferred from their failure to make a motion to dissolve the interference, which might have been successfully done under Rule 122 if their present contention be correct. Their failure to make such motion is an acquiescence in the correctness of the action of the Patent Office in declaring the interference and in all preliminary steps essential thereto. *Lorraine v. Thurmond*, 51 O. G. 1781; *Hunter v. Jenkins*, 56 O. G. 1706. The application of appellee filed October 1, 1892, must be held to be an allowable one and a constructive reduction to practice and to entitle him to the award of prior invention unless at the time of his conception appellant was in the exercise of due diligence and so continued down to the date of his application. And that brings us to the consideration of the fourth question.

Fourth. Was appellant in the exercise of due diligence in completing and adapting his conception at the time appellee conceived the invention, and did such diligence continue until he made his application?

There is no general rule of what constitutes due diligence applicable to all cases. Due diligence is reasonable diligence, and that is to be determined by the particular facts of each case *Yates v. Huson*, supra.

In that case the correct doctrine is stated to be that the prior inventor must—

“have begun and prosecuted with diligence the work of adapting and perfecting his invention before the date of his rival’s conception. \* \* \* To show that his diligence only began with that date would not be sufficient;”

and that the prior negligent inventor loses—

“his inchoate right in favor of a subsequent and bona fide inventor who, having entered the unoccupied field, shall have reduced his conception to practice.”

And it was also said in the case of *Porter v. Loudon*, supra, that—

“a party who conceives a new device or invention and proceeds only so far as to embody it in rough sketches or drawings or even experimental or working models, cannot stop there, and still be able to hold the field of invention against all other inventors for an indefinite period.”

Tested by these rules the appellant was not in the exercise of due diligence at the time of appellee’s conception. He had not

at that time performed all the acts recited in the above quotation from *Porter v. Loudon*, and which were held in that case to fall below the requirements of due diligence, although nearly three years had elapsed from the date of his conception, as claimed by him, and about eighteen months from the date of his disclosure as found by the Commissioner. Such inaction is clearly laches, unless excused upon some controlling ground. Especially is it so in the light of the evidence showing that appellant was less than one month constructing the mold and reducing the invention to actual practice, when he once set himself about it in September, 1892, which seems to have been his first effort to perform acts amounting to diligence, several months after appellee's conception. Nor was there any greater degree of diligence on the part of appellant after than before the conception of appellee. He made but few articles on or about the 3d of October, 1892, and did nothing subsequently until the filing of his application December 28, 1893. Such negligence cannot prevail over the prompt action of appellee, who first reduced the invention to constructive practice by filing an allowable application in about three months after his conception and by immediately following it with actual reduction to practice by manufacturing extensively in accordance with the said process. There is a feeble attempt to explain this unreasonable delay of appellant on the alleged ground of his poverty and lack of opportunity to make or have constructed a mold; but his answers to questions on cross-examination show that neither poverty nor lack of opportunity were controlling conditions in the way of earlier action on his part. Appellant also gave evidence tending to show that he was delayed by efforts to make other similar inventions; but time spent upon other inventions does not excuse delay otherwise unreasonable. *Telephone Cases*, 126 U. S. 1.

Appellant, though the first to conceive, by his laches lost his inchoate right in the invention in favor of appellee, who conceived later, while appellant was lacking in due diligence, and promptly reduced his conception to practice before appellant did.

Fifth. Is appellee also entitled to the award of priority upon the second issue?

The second issue of interference is also described in appellee's application. Besides, this issue contains nothing patentable not contained in the first one. It contemplates only the making of several articles of glassware at one time by the same method or process described in the first issue. Any skilled workman in the art would readily apply the process of the first issue as suggested in the second. To pass from the first to the second would not be invention. Whoever, therefore, is the prior inventor of the first issue is of the second also. This is



aptly stated in the opinion of the Examiners-in-Chief as follows:

“Probably the matter of issue No. 2 was allowed as a follower of issue No. 1 and as containing the same process and doing no harm when following its leader in a patent. It cannot be inferred from its allowance in that connection that it had been held to be patentable by itself as containing an invention sustainable in a patent when issue No. 1 stands as a claim in another patent.

“Whoever is the inventor of issue No. 1 is the inventor of issue No. 2, whether or not he makes any mention of working his process simultaneously on more than one mass of glass.”

For the reasons given we shall therefore affirm the decision of the Commissioner of Patents and direct that a certificate of the proceedings and decision of the case in this court be certified to the Commissioner of Patents, to be entered of record in the Patent Office, as directed by statute, and it is so ordered.

[See also for application of rule of reduction to practice to processes, *Stevens v. Seher*, 11 App. Cas. D. C. 245, 81 O. G. 1932, 1897 C. D. 761; *Appert v. Schmertz*, 13 App. Cas. D. C. 117, 84 O. G. 508, 1898 C. D. 524; *Rosell v. Allen*, 16 App. Cas. D. C. 559 92 O. G. 1036, 1900 C. D. 333.

Of the many additional cases applying the general rule and from which the summaries of the court were finally obtained see, for example, *Kelly v. Fynn*, 16 App. Cas. D. C. 573, 92 O. G. 1237, 1900 C. D. 339; *Dashiell v. Tasker*, 21 App. Cas. D. C. 64, 103 O. G. 2174, 1908 C. D. 551; *Macdonald v. Edison*, 21 App. Cas. D. C. 527, 105 O. G. 1263, 1903 C. D. 622.

The rule of diligence is also stated by the Court of Appeals in *DeWallace v. Scott*, 15 App. Cas. D. C. 157, 88 O. G. 1704, 1899 C. D. 416; and in *Silverman v. Hendrickson*, 19 App. Cas. D. C. 381 99 O. G. 1171, 1902 C. D. 527. In that case the court says:]

“For, as we have repeatedly held, it is the fact of reduction to practice, actual or constructive, or the exercise of due diligence to reach that result, that must determine the right of the inventor; and prior conception, without reduction to practice, unless there has been diligence in the elaboration of the idea looking toward reduction to practice, will not avail. *Soley v. Hebbard*, C. D. 1895 182, 70 O. G. 921, 5 App. D. C. 99; *Porter v. Loudon*, C. D. 1895 707, 73 O. G. 1551, 7 App. D. C. 64; *Arnold v. Tyler*, C. D. 1897 349, 79 O. G. 156, 10 App. D. C. 175; *Carty v. Kellogg*, C. D. 1896 188, 74 O. G. 657, 7 App. D. C. 542; *Marvel v. Decker*, C. D. 1899, 271, 86 O. G. 348, 13 App. D. C. 562; *Platt v. Shipley*, C. D. 1898, 307, 82 O. G. 461, 11 App. D. C. 576.”

[See also *Fefel v. Stocker*, 17 App. Cas. D. C. 317, 94 O. G. 433, 1901 C. D. 269; *Sendelbach v. Gillette*, 22 App. Cas. D. C. 168, 109 O. G. 276, 1904 C. D. 597; *Kasson v. Hetherington*, 88 O. G. 1157, 1899 C. D. 143; *Dodge v. Fowler*, 11 App. Cas. D. C. 592, 82 O. G. 595, 1898 C. D. 320; *Watson v. Thomas*, 23 App. Cas. D. C. 65, 108 O. G. 1590, 1904 C. D. 587.]

383. *AGAWAM COMPANY v. JORDAN*, 71 U. S. 583, 19 L. ed. 177 (1869).  
Clifford, J.: \* \* \*

No one is entitled to a patent for that which he did not invent unless he can show a legal title to the same from the inventor or by operation of law; but where a person has discovered an improved principle in a machine, manufacture, or composition of matter, and employs other persons to assist him in carrying out that principle, and they in the course of experiments arising from that employment, make valuable discoveries ancillary to the plan and preconceived design of the employer, such suggested improvements are in general to be regarded as the property of the party who discovered the original improved principle, and may be embodied in his patent as a part of his invention.

Suggestions from another, made during the progress of such experiments, in order that they may be sufficient to defeat a patent subsequently issued, must have embraced the plan of the improvement, and must have furnished such information to the person to whom the communication was made that it would have enabled an ordinary mechanic, without the exercise of any ingenuity and special skill on his part, to construct and put the improvement in successful operation.

Persons employed, as much as employers, are entitled to their own independent inventions, but where the employer has conceived the plan of an invention and is engaged in experiments to perfect it, no suggestions from an employee, not amounting to a new method or arrangement, which, in itself is a complete invention, is sufficient to deprive the employer of the exclusive property in the perfected improvement. But where the suggestions go to make up a complete and perfect machine, embracing the substance of all that is embodied in the patent subsequently issued to the party to whom the suggestions were made, the patent is invalid, because the real invention or discovery belonged to another. *Pitts v. Hall*, 2 Blatchford, 234; *Allen v. Rawson*, 1 Manning, Granger & Scott, 574; *Alden v. Dewey*, 1 Story, 338; 1 Webster's Patent Cases, 132, note c; *Curtis on Patents*, 3d ed. 99; *Reed v. Cutter*, 1 Story, 599.

Guided by these well-established principles, the first inquiry is, what was actually done by the person who, as alleged by the



respondents, was the real inventor of what is described in the reissued letters patent? They do not pretend that he invented or even suggested the entire invention, nor all of the several elements embraced in any one of the separate combinations, as expressed in the claims of the patent; and if they did, it could not for a moment be sustained, as it finds no support whatever in the evidence. None of the devices described in the specifications are new, but the claims of the patent are for the several combinations of the described elements arranged in the manner set forth, and for the purpose of working out the described results.

Regarded in that light, it is clear that the concession that the person named did not invent nor suggest the entire invention, nor any one of the separate combinations, is equivalent to an abandonment of the proposition under consideration, as it is clear to a demonstration that nothing short of that averment can be a valid defense. Respondents do not allege in the answer that the person named was a joint inventor with the original patentee, but the allegation is that he made the invention, and they deny that the assignor of the complainant ever bestowed any ingenuity upon what is described in the letters patent as his improvement. Such a defense cannot be successful unless it is proved, as common justice would forbid that any partial aid rendered under such circumstances, during the progress of experiments in perfecting the improvement, should enable the person rendering the aid to appropriate to himself the entire result of the ingenuity and toil of the originator, or put it in the power of any subsequent infringer to defeat the patent under the plea that the invention was made by the assistant and not by the originator of the plan.

The evidence shows that the original patentee was born in 1793, and that he commenced working on machinery in his youth, while he was with his father, and that, as early as the year 1812, he went into the employment of certain machinists, residing at Worcester, Massachusetts, who were engaged in constructing machinery for the manufacture of wool and cotton. While in their employment, he began experiments in woolen machinery. Those experiments were directed to the object of improving the billy, for the purpose of drawing out the carriage more accurately, and thereby making better work. Several years were spent in that business, but, in 1820, he went to Halifax, in that State, and, while there, he made numerous experiments to get rid of the billy entirely, and to dispense with short rolls, and substitute long rolls in their place. He remained there three years, and, during that time, he was constantly engaged in experiments to accomplish those objects. In the spring of 1823 he moved to Dedham, in the same State, and there hired a mill, and engaged in the manufacture of broadcloth, and also carried

on the machine business, and the witness also states that he then prosecuted his experiments on a large scale.

Cans were used as a receptacle for the rovings, delivered from the doffers, before the drawing-off and winding apparatus, described in the patent, was invented. Rovings, before that invention, were spun from cans, instead of being wound upon, and spun from, spools or bobbins. Considerable importance is attached to the new method, as it was largely by that means that the use of the endless roving was made practical, and that the difficulty produced by the kinking of the roving, incident to the use of the cans, was overcome.

Theory of the respondents is, that the new method of accomplishing that function was invented by Edward Winslow, but their witness, John D. Cooper, only testifies that he made or suggested the spool and drum, which are not the only elements of that apparatus. Unaccompanied by the traverser, they would perhaps, be better than the cans, but it is clear that the apparatus would be incomplete without that device, as it is by that means that the bobbins are evenly wound with the roving.

Testimony of that witness is, that he first suggested to Winslow that the roving must be wound on a spool, else they never could make good yarn, and he proceeds to state that they procured some pasteboard, and that Winslow made a pattern for a spool and drum from that material. Explanations, in detail, are given by the witness, of the several steps taken by them in accomplishing the change in the apparatus, and the witness states that the original patentee never saw the spool and drum until he came into the mill and saw those devices in the machine. Argument for the respondents is, that the spool and drum were invented by that party while he was in the employment of the original patentee, but the complainant denies the theory of fact involved in the proposition, and insists that the statements of the witnesses are untrue, and that he is not entitled to credit. Further statement of the witness is, that the improvement, as soon as it was perfected, was applied to all the carding and spinning machines in the mill, and that the mills, so adjusted as to embrace that improvement, were put in successful operation during the summer and autumn of that year.

Two answers are made by the complainant to the defense founded on that testimony, both of which are sustained by the court. 1. Suppose the testimony of the witness to be all true, the complainant contends that it is not sufficiently comprehensive to support the allegations of the answer, nor even to support the proposition presented in the brief of the respondents. Taken in the strongest view for the respondents, the testimony merely shows that Winslow, or the witness Cooper, or both together, after the originator of the plan had nearly completed his



great and valuable improvement, and while he was still prosecuting his experiments with the utmost diligence, suggested the spool and drum as substitutes for the cans, and that Winslow actually made those devices, and, with the aid of witness, put them into one of the machines as an experiment. When their employer first examined the arrangement, rude as it was, he expressed great satisfaction with it, but upon seeing it tried he pronounced it of no value. Neither of those opinions, however, turned out to be quite correct, as, upon further trial, when better adjusted, and by adding the traverser, so that the contrivance would wind the roving evenly on the spool, it proved to be a useful auxiliary part of the invention.

Valuable though it was and is, as aiding in the accomplishment of the desired result, it is nevertheless a great error to regard it as the invention described in the subsequent patent, or as such a material part of the same that it confers any right upon the party who made the suggestion to claim to be the inventor, or a joint inventor, of the improvement, or to suppose that the proof of what was done by that party can constitute any defense, as against the owner of the patent, to the charge of infringement.

Second answer to the defense founded on that testimony is, that the testimony is unreliable, because the witness is not entitled to credit. Hundreds of pages of transcript are filled with proof, introduced either to assail or support the credit of that witness; but the court is of the opinion that it is not necessary to enter into those details, as the decision must be in favor of the appellee, even if every word stated by that witness is taken to be true. Entirely satisfied with our conclusion upon the merits, we are the less inclined to enter into those details, as a full analysis of the proofs within reasonable limits would be impracticable; but it is proper to say that the proofs have been carefully examined, and it is the opinion of the court that the letters patent in this case cannot be held to be invalid upon such testimony.\* \* \*

384. MASON v. HEPBURN, 13 App. Cas. D. C. 86, 84 O. G. 147, 1898 C. D. 510.

Shepard, J.:

First. This is an appeal from the decision of the Commissioner of Patents in the interference proceeding with the following issue:

"In a magazine-firearm, the detachable end piece closing the outer end of the magazine provided with upwardly-projecting curved arms to clasp the sides of the barrel, substantially as described."

The device is a clip made in one piece instead of two, as formerly one end of which is made to fit closely in the upper end of the magazine. The other is split or divided into two curved arms, which are elastic and clasp each side of the gun-barrel far enough around to hold securely without meeting each other. A side screw at the junction of magazine and barrel holds tight the clasp or releases it, as desired.

Hepburn received a patent for this invention September 11, 1894. Having taken no testimony, his date of invention must be confined to that of his application, filed April 3, 1894.

Mason's application was filed December 31, 1894. Mason offered testimony tending to show that he conceived the invention about June 28, 1887, on which date he made a complete drawing showing the device; that a working drawing was traced from that in July, 1887, and the clip made in the shops of the Winchester Repeating Arms Company; that during the same month a new "take-down" shotgun was made with this clip attached, which was tested, probably, in the shooting-gallery. This gun was stored in the model-room of the same company until produced in the course of the trial of this controversy. No clips of the kind were manufactured for any other purpose and no similar gun was made. No exhibition of the gun and clip was made to the public, and no one saw it besides the inventor and one or two other employees of the Winchester Company.

It appears that Mason filed an application for a detachable or "take-down" gun April 4, 1892, and the same was issued to him December 6, 1892. In this no mention is made of the device for clipping the upper end of the magazine to the barrel. On the same day, however, he received a patent for a clip, for which he applied August 1, 1892. This is made with projecting curved arms, as in the device of the controversy, to clasp the gun-barrel; but at the other end it has a hole made to receive the end of a pin on a separate piece that closes the end of the magazine.

Second. The testimony is sufficient to warrant the conclusion, in which all of the tribunals of the Patent Office have concurred, that Mason conceived the idea of this invention at the time claimed and that the gun, with the device attached, was actually completed and ready for use in July, 1887. They have not agreed, however, in respect of the sufficiency of the evidence to show with the required certainty that the gun, when constructed, was actually tested by firing in a manner that demonstrated the completeness and practical utility of the device of the controversy.

What is successful construction—that is to say, the embodiment of the inventor's conception in a substantial form which demonstrates at once its practical utility, constituting reductio to practice or use in the sense of the patent law—is a mat-



ter the determination of which must largely depend upon the nature and purpose of the machine or device in the particular case, as well as upon the special circumstances surrounding the alleged construction and use.

It is settled beyond all question that a drawing of even the simplest machine or device, perfect in every detail and plainly demonstrating the principle, efficacy, and practical utility of the invention, will not constitute reduction to practice. Nor will the requirements of reduction to practice or use be satisfied by a construction clearly designed and intended as a model and nothing more. They are but evidence of conception, furnishing the foundation of an award of priority when accompanied by proof of subsequent diligence in the matter of actual reduction to practice. *Porter v. Loudon*, 73 O. G. 1551, 7 App. D. C. 64, 74. At the same time some devices are so simple and their purpose and efficacy so obvious that the complete construction of one of a size and form intended for and capable of practical use might well be regarded as a sufficient reduction to practice without actual use or test in an effort to demonstrate their complete success or probable commercial value. This doctrine is maintained in the following cases: *Stitt v. Eastern R. R. Co.*, 22 Fed. 649; *Sayles v. C. & N. W. R. Co.*, 4 Fish. 584; *Parker v. Ferguson*, 1 Blatchf. 407; *Pitts v. Wemple*, 2 Fish. 10, 15.

In such instances, however, the fact that the construction of the device had not been followed within a reasonable time by practical or commercial use or application for patent would afford a strong inference that what had been done was regarded by the inventor as experimental only and not completion of invention, and this would be materially reinforced if in the meantime the machine had been dismantled or destroyed. It appears in this case that the Winchester Repeating Arms Company, which is the assignee of Mason, did not make or use another of these clips. The gun was laid away, and no application for a patent was made until three months after the patent to Hepburn had issued. Five years after its completion a patent for the detachable gun or one nearly resembling it was applied for without mention of the clip as a part of the combination, and then, some months later still, a patent was applied for and obtained for a clip working in the same general way, but made in two pieces.

All of the Board of Examiners-in-Chief agreed on reversing the decision of the Examiner of Interferences, because they were not satisfied with the evidence of reduction to practice. They said:

"The clip evidently performs its expected office. Whether in use with no other means for holding it to the barrel and magazine than the clips and the sockets the construction as adapted

to practical use has not been proven, and cannot be decided by us on a mere inspection of the gun. It has not been certainly established that this clip was ever proven to be perfected and adapted to practical use."

In reaching this conclusion they laid great stress upon the subsequent inaction of the inventor, and from their point of view rightly so.

In reaching our own conclusion we regard the examination of the evidence in respect of the actual firing test of the gun as immaterial, because, in our opinion, the reduction to practice of the clip was accomplished by its perfect construction and attachment to a gun apparently completely finished and ready for sale and use. It was demonstrably capable of producing the result sought to be accomplished—namely, that of closing the magazine and clipping it to the barrel. As admitted by the Examiners—

"the clip evidently performs its expected office."

Actual test of the restraining power under the strain of repeated firing of the gun might be of importance in demonstrating the value of the clip, but was not necessary to the completion of the inventive act. *Hall v. MacNeale*, 23 O. G. 937, 107 U. S. 90, 97.

Third. Although the construction and adaptation to use of the clip were within the knowledge of several persons, these were all, with Mason himself, employees of the Winchester Repeating Arms Company, for whose benefit the invention was made. They had either been called on to aid in the construction and use or by the nature of their employment were necessarily cognizant of it. The invention was therefore as much secreted from the public as if it had been confined to the knowledge of Mason alone. *Pennock v. Dialogue*, 1 Pet., 1, 19; *Kendall v. Winsor*, 21 How., 322, 330.

The public did not and was not intended to receive any benefit from it during the seven years that intervened between the construction and the application for the patent. Not having been given or abandoned to public use there was nothing in the mere lapse of time to prevent Mason receiving a patent. *Bates v. Coe*, 15 O. G., 337; 98 U. S. 31, 46.

It seems that Mason attached no importance to the invention, for there is not a fact in evidence to account otherwise for his long inaction. Besides, as we have seen, he had in the meantime procured a patent for a gun, and on the same date another for a different clip to secure the magazine to the barrel. Apparently the invention as a thing of value had passed out of his mind, to which it was recalled by seeing the publication of the patent to Hepburn in the Official Gazette.



It is unquestioned that Hepburn's invention was an independent act; that he had no knowledge whatever of the work done by Mason, and that when he applied for and received his patent he in good faith believed himself to be the original and only inventor.

In this state of the case it remains to be considered whether the Commissioner, maintaining the view expressed in a separate opinion of one of the Examiners-in-Chief, was right in awarding priority to Hepburn on account of this conduct of Mason in purposely withholding his invention from the public without excuse for the period of more than seven years.

First. In our opinion the decision can not be upheld on the ground that the invention by reason either of secretion or forgetfulness on the part of Mason had become, as it were, a lost art. It is true that to entitle one to a patent for the discovery of a lost art it does not seem to be necessary that it shall have been buried and unknown for ages or even for any great length of time. *Gayler v. Wilder*, 10 How., 477, 497, 498; *Hall v. Bird*, 6 Blatchf., 438; *Taylor v. Wood*, 8 O. G., 90; 12 Blatchf., 110, 121; *Converse v. Mathews*, 58 Fed. Rep., 246, 249; 1 Rob. on Pats., § 323.

But it is necessary that the knowledge of the art or the improvement therein shall have completely disappeared. It must at least have been so far forgotten that its inventor, if living, or others who may have witnessed its use would not be able to recall it to memory and reproduce it without the assistance of the description made of the subsequent discovery. *Rich v. Lippincott*, 2 Fish., 1, 8.

Now if this device had been lost or destroyed by Mason, that fact, coupled with his subsequent invention and patent of another and different one to accomplish the same purpose, might be sufficient to uphold the patent to Hepburn as the inventor of a new and useful manufacture or improvement "not known or used by others" before his discovery, as those words are used in the law. Rev. Stat., § 4886; *Gayler v. Wilder*, 10 How., 477, 498. In this case, where it was made to appear that a safe similar in construction to the patentee's had been made and used some years before by one Conner, the Court, construing the like words in the act of 1836, said:

"The court put it to the jury to say whether this safe had been finally forgotten and abandoned before Fitzgerald's invention, and whether he was the original inventor of the safe for which he obtained the patent; directing them, if they found these two facts, that their verdict must be for the plaintiff. We think there was no error in this instruction. For if the Conner safe had passed away from the memory of Conner himself, and of those who had seen it, and the safe itself had disappeared, the

knowledge of the improvement was as completely lost as if it had never been discovered. The public could derive no benefit from it until it was discovered by another inventor. And if Fitzgerald made his discovery by his own effort, without any knowledge of Conner's, he invented an improvement that was then new, and at that time unknown; and it was not the less new and unknown because Conner's safe was recalled to his memory by the success of Fitzgerald's."

The facts of this case, however, are quite different. The clip had not been lost or destroyed or even removed from the gun. It was where the inventor could readily put his hand upon it. Reminded simply of its existence or possible value by the publication of the patent to Hepburn he required no assistance from the specification of that patent to aid him in again making or using it. He may have forgotten that he had made it and been reminded of it by the grant of Hepburn's patent, but it can not be said to have been so far forgotten as to have become what is called a lost art.

Second. The remaining question is, can the decision be upheld upon the ground that Mason's right to claim of priority has become barred by his designed or negligent concealment of his invention from the public and the subsequent entry of his rival in the apparently unoccupied field?

We concur with the Commissioner in the answer to this question, that under the circumstances Hepburn must be held to be the first inventor in the sense of the law regulating the grant of patents. Rev. Stat., § 4885.

A liberal interpretation of the words of the statute is demanded in the interest of the public, for the advancement of which the patent laws were enacted. *Kendall v. Winsor*, 21 How., 322, 327, 328. In the opinion in that case it was said:

"The true policy and ends of the patent laws enacted under this Government are disclosed in that article of the Constitution, the source of all these laws, viz., 'to promote the progress of science and the useful arts,' contemplating and necessarily implying their extension and increasing adaptation to the uses of society. *Vide* Constitution of the United States, Art 1, § 8, clause 8. By correct induction from these truths it follows that the inventor who, designedly, and with a view of applying it indefinitely and exclusively for his own profit, withholds his invention from the public, comes not within the policy or objects of the Constitution or acts of Congress. He does not promote and, if aided in his design, would impede the progress of science and the useful arts; and with a very bad grace could he apply for favor or protection to that society which, if he had not injured, he certainly had neither benefited nor intended to benefit. Hence, if during such a concealment an invention similar



to or identical with his own should be made and patented or brought into use without a patent, the latter could not be inhibited nor restricted upon proof of its identity with a machine previously invented and withheld and concealed by the inventor from the public. The rights and interests, whether of the public or individuals, can never be made to yield to schemes of selfishness or cupidity; moreover, that which is once given to or is invested in the public cannot be recalled nor taken from them."

That case was, it is true, an action for infringement by a patentee against one who before the application for the patent had made use of his invention without claim, himself, of discovery. The right was claimed in the patentee, on the one hand, as against the right of the public on the other. Nevertheless we think that our conclusion is in strict conformity with the principles which it announces, and there is nothing in it inconsistent with the spirit of indulgence that has always been manifested toward those who, in good faith, delay application for patent while engaged in a diligent effort to perfect their inventions. *Idem*, p. 329; *Agawam Co. v. Jordan*, 7 Wall., 583, 607; *Yates v. Huson*, 74 O. G., 1732; 8 App. D. C., 93, 98.

Considering, then, this paramount interest of the public in its bearing upon the question as presented here, we think it imperatively demands that a subsequent inventor of a new and useful manufacture or improvement who has diligently pursued his labors to the procurement of a patent in good faith and without any knowledge of the preceding discoveries of another shall, as against that other, who has deliberately concealed the knowledge of his invention from the public, be regarded as the real inventor and as such entitled to his reward.

This right of second discoverer has been recognized with considerable uniformity for a number of years in the administration of the Patent Office. Duncan, Acting Commissioner, in *Monce v. Adams*, 1 O. G. 1; Paine, Commissioner, in *Mallett v. Cogger*, 16 O. G. 45, and *Farmer v. Brush*, 17 O. G. 150; Marble, Commissioner, in *Sheridan v. Latus*, 25 O. G. 501. And again recently by Commissioner Duell, in whose decision the authorities are extensively reviewed. *Mower v. Crisp & Copeland*, 83 O. G., 155.

It has the sanction also of the following judicial decisions: *Rowley v. Mason*, 2 Am. Law Times Rep., 106; *Consolidated Fruit Jar Co. v. Wright*, 6 O. G., 327; 12 Blatch., 149; *U. S. Rifle and Cartridge Co. v. Whitney Arms Co.*, 11 O. G., 373; 14 Blatchf., 94, 101; *Boyd v. Cherry*, 4 McCreery, 70, 77; *Cahoon v. Ring*, 1 Cliff., 610; *White v. Allen*, 2 Fish., 440, 454.

In *Bates v. Coe*, 15 O. G., 337; 98 U. S., 31, 46, the point was not directly involved; but Mr. Justice Clifford in affirming the

right of the inventor to keep his invention secret for any length of time without modifying his right to a patent coupled it with the following exception, as if one of unquestioned application, namely:

“Unless another in the meantime has made the same invention, and secured by patent the exclusive right to make, use and vend the patented improvement. Within that rule and subject to that exception, inventors may delay to apply for a patent.”

See also 1 Robinson on Patents, § 390.

In some of the decisions the first inventor is regarded as having abandoned the field to other inventors, while in others he is held to have lost his right by sleeping too long upon it.

Strictly speaking, abandonment after the completion of an inventive act applies in a case where the right of the public to the use is involved and not in one where the contention is between rival claimants merely of the monopoly.

The true ground of the doctrine, we apprehend, lies in the spirit and policy of the patent laws and in the nature of the equity that arises in favor of him who gives the public the benefit of the knowledge of his invention, who expends his time, labor, and money in discovering, perfecting and patenting in perfect good faith that which he and all others have been led to believe has never been discovered by reason of the indifference, supineness or willful act of one who may, in fact, have discovered it long before.

It follows that the decision of the Commissioner must be affirmed. It is so ordered, and this decision will be certified to the Commissioner of Patents, in accordance with the law.

385. *MATTHES v. BURT*, 24 App. Cas. D. C. 265, 114 O. G. 764, 1905 C. D. 574.

Shepard, J.:

This is an interference case having the following issue:

“1. A mold comprising a tubular body open at both ends for the entrance of dies, and provided between its ends with transversely-movable plugs having ends adapted to extend into the bore of the tubular body and to engage a mass of plastic compressible material and retain the same therein. \* \* \* [2, 3, 4.]

The Examiner of Interferences decided in favor of Julius H. Matthes. His decision was reversed by the Examiners-in-Chief—one member dissenting. From the final decision of the Commissioner in favor of Alonzo L. Burt, Matthes has prosecuted this appeal.

Burt's application was filed December 5, 1901, and that of Matthes on February 19, 1902.



Under a preliminary statement alleging the making of sketches on or about June 1, 1899, and reduction to practice by making a full-sized operative die or mold between the first and the middle of June, 1899, Matthes's evidence tended to show that he had made the mold in June, 1896, and manufactured several dozen of pool-balls therewith immediately after this construction.

The mold produced as the one then constructed is cracked and no longer serviceable, but shows the invention of the issue.

Each of the tribunals of the Patent Office has accepted this mold as a reduction to practice, and awarded credibility to the evidence tending to show its construction and experimental use in the manufacture of pool-balls in June, 1898. By reason of the date alleged in the preliminary statement the benefit of this reduction to practice has been limited to June, 1899. This is unimportant, however, as it antedates Burt's reduction to practice.

Notwithstanding these conclusions, we are constrained to say that Matthes's explanation of his mistake in the allegation of the date of this construction is not in every respect satisfactory. In view, however, of the ground upon which the final decision in favor of Burt has been rested, it is unimportant to review the evidence on this point, or to consider it along with other circumstances on which it is contended, on behalf of Burt, that this early experimental construction and use failed to demonstrate the efficiency of the model and the utility of the invention, whereupon it was laid aside and abandoned until information of Burt's successful exploitation of a similar invention caused it to be taken up again.

We will assume, therefore, as found by the Commissioner and other tribunals, that Matthes made a full-size, operative model and tested it in June, 1898, to his own complete satisfaction, as well as that of the officers of the Brunswick, Balke, Colender Co., by whom he was employed.

The mold thus made and tested was kept in the factory where it was concealed from the public, and known only to two or three employees who had helped to operate it. Some of the balls of this experimental manufacture were sold with the general stock, but it was admitted that there was nothing in their appearance to distinguish them from balls made in the old way; and no record of them was kept and no attempt made to determine how they might bear the strain of common use in comparison with the other balls, which was a thing that Matthes seems to have regarded as uncertain. Instead of proceeding to make balls for the trade with the newly-invented mold, it was laid aside and the manufacture was continued in the old way. Notwithstanding he had caused search to be made in the Patent

Office in 1899 and discovered that there was, apparently, nothing in the way of securing a patent for his invention, Matthes filed no application until February 19, 1902—some time after he had acquired knowledge that Burt was manufacturing and selling to the trade balls made with a similar device. During this interval of more than three and one-half years the public had no means of acquiring knowledge of his invention.

In the meantime Burt, without knowledge of Matthes's discovery, was at work. He claims to have conceived the idea in 1896, but is limited by the allegations of his statement to its disclosure in 1899. Without inquiry into his evidence, it is sufficient to say that he made disclosure of his invention early in 1901 and that a mold in accordance therewith was made in the factory where he was then employed in Milburn, N. J. As early as August, 1901, the new mold was in operation turning out balls for sale to the trade, and between that date and the time of filing his application, December 5, 1901, a great number (probably thousands) of the new balls were manufactured and sold.

It is clear that early in December, 1901, Matthes received full knowledge, through men lately employed in the Burt factory, concerning the successful use of Burt's construction and the sale of its product. The circumstances relating to the employment of these men by the Brunswick, Balke, Collender Co., of Chicago, where Matthes was at work, need not be considered. The only fact of importance is the information which they gave to Matthes.

For reasons that have been sufficiently stated in the decisions of the Examiners-in-Chief and the Commissioner, the evidence of Matthes tending to show an intention to apply for a patent in 1899, and the failure to carry it into execution, through the neglect of his solicitor, is unsatisfactory and not entitled to any weight. In the light of the surrounding circumstances and conditions, Matthes's attempt to excuse his failure to utilize his invention, on the ground of the waste of material involved in the use of the improved mold, is also entitled to no serious consideration. Having, then, completed the invention and satisfied himself of its utility, as claimed, Matthes deliberately concealed it, suppressing its use and withholding it from the public. How long he might have pursued this policy with no rival in the field is of course conjectural; but it is certain that he showed no substantial intention of change of policy until he had obtained definite knowledge of Burt's exploitation of the same invention. On the other hand, Burt, having no knowledge of Matthes's discovery, and encouraged and induced by the apparently unoccupied field, went diligently to work to perfect his invention and to put



its product upon the market. He not only sold this product to the trade in large quantities, but promptly applied for a patent. On this state of facts, the Commissioner held that Matthes's right had become subordinate to that of Burt who was the first to invent in accordance with "the true policy and ends of the patent laws" as declared by the Supreme Court of the United States in *Kendall v. Winsor*, 21 How., 322, 327 328.

His decision we think was correct. The facts bring the case within the principle of decisions heretofore given by this court on appeal from the Commissioner of Patents. *Mason v. Hepburn*, 13 App. D. C., 86; 84 O. G., 147; *Warner v. Smith*, 13 App. D. C., 111, 115; 84 O. G., 311; *in re Mower*, 15 App. D. C., 144, 154; 88 O. G., 991; *Thompson v. Weston*, 19 App. D. C., 373, 379; 99 O. G., 864.

They present no question of diligence in respect of adapting and perfecting the invention as between rival claimants; or of reasonable excuse for delay on other grounds relieving that delay of the imputation of deliberate concealment; or where delay is a potent circumstance in determining whether the tests made at a remote period amounted to a complete reduction to practice. For these reasons the decisions cited on the brief of the appellant are not applicable. Among these, see *Yates v. Huson*, 8 App. D. C., 93; *Christy v. Seybold*, 55 Fed. 69; *Esty v. Newton*, 14 App. D. C., 50, 53; *Christensen v. Noyes*, 15 *idem*, 94; *McBerty v. Cook*, 16 *idem*, 133, 139; *Brown v. Blood*, 22 *idem*, 216; *Oliver v. Felbel*, 20 *idem*, 255, 261; *Roe v. Hanson*, 19 *idem*, 559, 564; *Reichenbach v. Kelley*, 17 *idem*, 333, 344.

That Burt's application had not ripened into a patent before Matthes filed his, does not substantially affect the application of the cases of *Mason v. Hepburn* and others *supra*. Whilst the possession of a patent makes, ordinarily, a stronger case in favor of the holder, the doctrine in respect of concealment by one earlier to invent does not necessarily depend upon that fact. In *Warner v. Smith*, *supra*, in which the reasons for that doctrine are explained at length, the later inventor had not received a patent.

For the reasons given the decision of the Commissioner of Patents will be affirmed, and the proceedings in this court certified to him, as required by the law. It is so ordered.

[For line of interesting cases following *Mason v. Hepburn* and *Matthes v. Burt*, see *Underwood's Digest*, or any digest of C. A. D. C. cases.]

886. *IN RE FULLAGAR*, 32 App. Cas. D. C. 222, 138 O. G. 259, 1909 C. D. 270.

Shepard, C. J.:

While separately docketed, these cases were heard together in the Patent Office as involving substantially the same questions. They have been brought up in one transcript of the record and are to be heard thereon, at the same time, in this court.

W. L. R. Emmet, who was a party to each interference with Fullagar, has filed two motions. The first is to change the docket entry so as to read, Hugh Francis Fullagar, appellant, v. W. L. R. Emmet, appellee, and to permit him to be recognized as a party. The second is to dismiss the appeals.

The complicated history of the proceedings in the Patent Office, culminating in the decisions appealed from, is set forth in the Commissioner's decision as follows:

"This interference together with a companion interference number 27,622 is before me upon appeal from a decision of the Examiners-in-Chief affirming the action of the Primary Examiner dissolving these interferences upon the ground that Fullagar has no right to reissue his former patents upon the applications involved in these interferences.

"The record of the applications involved in this interference shows that on February 24, 1902, Emmet filed the application involved in this interference. On April 18, 1901, Fullagar filed an application No. 56,462, which became a patent No. 696,867, April 1, 1902. On November 8, 1904, he filed a reissue application upon which Reissue Patent No. 12,317 was granted February 14, 1905. On October 31, 1906, Fullagar filed the application involved in this interference which is for the reissue of his Reissue Patent No. 12,317, or, in other words, is for a second reissue of his original Patent No. 696,867.

"On September 16, 1901, Fullagar filed an application No. 75,651, upon which Patent No. 746,061, was granted December 8, 1903. On January 7, 1907, he filed an application No. 351,258, for the reissue of this patent, which application is involved in the companion interference.

"The record shows that on May 12, 1903, an interference No. 22,666 was declared between the original application of Fullagar No. 75,651, and the application of Emmet involved in the present interference. That interference was subsequently dissolved upon the ground that the claim in issue was not readable on Fullagar's disclosure. In view of the fact that the parties at this time did not make claims to the same invention, Patent No. 746,061 was granted to Fullagar. Emmet then inserted in his application a claim corresponding to claim 16 of the Fullagar patent and interference No. 23,802 was declared May 31, 1904.



Testimony was taken in this interference and a decision was rendered by the Examiner of Interferences awarding priority to Fullagar. This decision was reversed by the Examiners-in-Chief on appeal and priority of invention was awarded to Emmet. Appeal was taken to the Commissioner of Patents who, in a decision affirming the decision of the Examiners-in-Chief, rendered July 21, 1906, stated that:

“It is found that Fullagar's original application did not disclose the complete invention of the issue and therefore Fullagar has no right to the claim forming the issue of this interference. For this reason Emmet is entitled to the award of priority.”

“Soon after the decision of the Commissioner, Fullagar filed application Serial No. 341,509, for the release of his first patent No. 696,867, and inserted therein the claims forming the complete subject-matter of the two interferences now before me. Fullagar's claim of this application corresponding to count 4 was subsequently incorporated in his other release application Serial No. 351,285, and interference No. 27,362 was declared May 23, 1907, embodying this claim, and including both of Fullagar's reissue applications.

“Motions to dissolve were brought by Emmet in both interferences upon several grounds, including, first, the insufficiency of Fullagar's oath to excuse the delay between the grant of his original patents and the date upon which he filed the respective reissue applications; second, that intervening rights had accrued against a grant of a reissue of the patents to Emmet; and, third, that Fullagar had no right to make the claim corresponding to count 4 of this interference in his original application because the invention defined is indivisible from the invention claimed in his Patent No. 696,867. The Primary Examiner granted the motion as to the first and second grounds, but denied it as to the third. Upon appeal the Examiners-in-Chief affirmed the action of the Examiner in respect to the first ground, holding that the specification of errors in the Fullagar oaths did not justify the allowance of the appealed claims to him ‘either as establishing “inadvertence, accident or mistake.” or excusing his delay.’ They, however, reversed the decision of the Examiner as to the ground of intervening rights. Fullagar has appealed from the decision of the Examiners-in-Chief affirming the decision of the Primary Examiner and Emmet has also filed an appeal from the decision of the Examiners-in-Chief holding that no intervening rights had accrued which would bar the grant of the reissue patents to Fullagar.

“Emmet's appeal has no standing, whether it be considered an appeal from a favorable decision or an appeal from the reasons which are the basis of a decision in his favor, even though

such reasons in part are adverse to him. (Rule 124.) *Breul v. Smith*, 84 O. G., 809. Emmet's appeal is therefore dismissed.

"In respect to Fullagar's appeal the only question before me is as to the sufficiency of the Fullagar oaths to warrant the granting to him of reissue patents containing the claims in controversy."

After stating this single issue, the Commissioner proceeded to consider whether Fullagar's applications for reissue, founded on inadvertence, accident, or mistake, had been filed within a reasonable time.\* \* \*

"I therefore fully concur with the reasons and the conclusion ably stated by the Examiners-in-Chief that the verified showing made in support of Fullagar's reissue applications is insufficient to warrant the granting of reissue patents to him and that these interferences should be dissolved upon the ground that Fullagar has no right to the claims in issue.

"The decision of the Examiners-in-Chief is affirmed."

It is from this decision that the appeal has been prosecuted by Fullagar, who caused it to be docketed as an *ex parte* appeal. Under the practice of this court the Commissioner is permitted to appear by counsel in *ex parte* appeals. His counsel concurs in the motion of Emmet to change the docket entry, and to be recognized as appellee, contending that he is a proper party to the appeal.

The jurisdiction of this court to entertain appeals from decisions of the Commissioner of Patents, in proceedings relating to patents, is limited to two classes of cases. The first is where the claims of an applicant for a patent, or the reissue of a patent, after having been twice rejected, have been finally rejected on an appeal to the Commissioner in due course of procedure. The second is where on an appeal to the Commissioner in an interference proceeding there has been a final decision of priority in favor of one of the parties thereto. R. S. §§ 4909, 4910, 4911; *Westinghouse v. Duncan*, 2 App. D. C., 131, 132; *Allen v. Lowrie*, 26 App. D. C., 8, 17, 26; *Union Distilling Co. v. Schneider*, 29 App. D. C., 1. The case last cited arose under § 9 of the Trade-Mark Act, approved February 20, 1905, in an interference case between applicants for the registration of trade-marks, the procedure in which is similar to patent interferences.

The question for determination on this motion is whether these appeals come within either of the above-named classes.

The recitals of the Commissioner's decisions show that interferences were declared between reissue application of Fullagar and original applications of Emmet, in which motions to dissolve were made by each party. Fullagar's motions were denied



by the Primary Examiner to whom they were referred, and Emmet's were sustained on two grounds. Fullagar appealed to the Examiners-in-Chief who differed with the Primary Examiner on all points save one, but affirmed his decision on the ground that Fullagar's showing of inadvertence, accident or mistake was insufficient, and failed to excuse his long delay of more than two years in each case. On appeal by both parties to the Commissioner, as shown by his decision, he dismissed Emmet's appeal as without foundation, and affirmed the decision of the Examiners-in-Chief as to Fullagar. He also stated, it is true, that Fullagar had no right to make the claims; but this remark is evidently as a result of the conclusion that Fullagar had failed to show that he had come within the requirements for reissue. Had he held that Fullagar had made a sufficient showing for reissue, and then decided that he had no right to make the claims of the interference, because not disclosed in his application, he would necessarily have awarded priority to Emmet. *Newcomb Motor Co. v. Moore*, 30 App. D. C., 464. The latter's application having been allowed, and Fullagar having been put out of the case, there would remain nothing else to do.

It is now settled that the right of either party to make the claim of the interference issue may be urged, and brought up as an ancillary question necessarily involved in that of priority. *Podlesak v. McInerney*, 26 App. D. C., 399, 405. In that case it was said by Mr. Justice Duell:

"The question of the right of a party to make a claim goes to the very foundation of an interference, for, if a party has not such right, the interference falls. If it be incorrectly held that such party has the 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. We therefore take jurisdiction to determine that question in this case as an ancillary question to be determined in awarding priority of invention."

If the Commissioner had decided that Fullagar was not entitled to make the claim under his application, and had, in consequence, awarded priority to Emmet, Fullagar would have the right to appeal, bringing Emmet up for a final adjudication of the question of priority in this court. Instead of so deciding, the effect of his decision was to set aside the allowance of Fullagar's application as an entirety, and dissolve the interference. No award of priority was made in favor of Emmet. He was not declared entitled to the patent, nor was his application rejected.

He had nothing from which he could appeal. All that was left to him was to renew his demand for a patent, *ex parte*, which will be ultimately allowed, there being no ground for further declaration of interference with Fullagar, unless some additional reference be found to bar his right. As there was no final decision in Emmet's favor, it follows that Fullagar could not bring him before this court by an appeal. If Fullagar has any right to appeal at all it is by way of an *ex parte* appeal under § 4911, Revised Statutes, on the ground that the decision is in fact the final rejection of his application.

We are clearly of the opinion that Emmet, then, has no standing in this court as a party to the appeal, and his motion to appear and have the docket entry changed must be denied. It follows, therefore, that he has no right to move to dismiss Fullagar's appeal.

But Fullagar's right to appeal *ex parte* from the Commissioner's decision involves a question of jurisdiction which the court must consider of its own motion.

It is not pretended that this is a regular *ex parte* proceeding upon an application for a patent that has been rejected. Instead of being rejected it was allowed by the Primary Examiner, and might have proceeded to issue had there been no interference with another allowed application. It came before the Commissioner in that interference, and the right to appeal is founded on the character and effect of his decision therein. But we can not recognize the right of the Commissioner, if he so intended, to convert an interference case into an ordinary proceeding by one party upon an application for a patent, which he concludes to reject without an award of priority to the other party. The statute prescribes the procedure in the case of an application for a patent and for the reissue of a patent. If the application be rejected by the Primary Examiner, he must give notice of the same, with the grounds of his rejection, to the applicant, who has the right to answer the objections, or obviate them if possible, and to persist in his application. In that event he is entitled to a re-examination of his application. (R. S. § 4903.) He has no right to appeal from the first rejection, but must await the re-examination and a second rejection thereafter. Of course, no interference can be declared in such a case until there has been an allowance.

After the second rejection he can appeal to the Examiners-in-Chief and in succession to the Commissioner and to this court. (R. S., §§ 4909, 4910, 4911.) The conditions of the statute conferring the right of appeal must be observed, and the procedure it prescribes must govern the proceedings throughout.



As the proceedings in this case are not in compliance with the statute, we are constrained to hold that this court has no jurisdiction of the appeal.

Upon the return of the case to the Patent Office, Fullagar will be entitled to have his application remanded for re-examination; and if again rejected, he will be entitled to his successive appeals, in due course, if it should become necessary to resort thereto.

In accordance with these views, the appeals will be dismissed. It is so ordered, and that this decision be certified to the Commissioner of Patents as the statute requires.

387. JOHNSON v. MUESER, 29 App. Cas. D. C. 61, 145 O. G. 764, 1909 C. D. 437.

(Writ of error dismissed. Certiorari denied. S. C., 212 U. S. 283, 53 L. ed' 514.)

Shepard, C. J.: \* \* \*

The first contention of the appellant is that the decision be reversed on the ground urged in his motion to dissolve the interference, namely, that the invention of the issue is not patentable.

The attitude of the appellant is a peculiar one. He holds a patent issued in 1899 which, among other references, he claims to be an anticipation of this invention. His present application was held by the Office to cover the claims of the issue, which when suggested to him were immediately accepted. Had no interference been declared, he would have received a patent for them. In a case presenting a similar state of facts, this court, speaking through Chief Justice Alvey, said:

"The question of patentability of the claim for invention was referred to and passed upon by the Primary Examiner in the Patent Office, who is the expert as to the state of the art involved, and it was not until that examination was had and favorably reported, that the interference was or could be declared. The appellant making claim for an alleged patentable invention, is not to be heard to urge non-patentability of his claim after it had been placed in interference with another claim. He is effectually estopped on that question by reason of his own affirmative assertion that his claim is patentable; and if his own claim is patentable that with which it would interfere may be equally so, if priority of invention be shown. *Hisey v. Peters*, 6 App. D. C., 68, 71."

The effect of this estoppel is sought to be avoided on the ground that the question of patentability is jurisdictional. The argument is that patentability is not a mere—

“collateral question aside from the main question of the interference”

but the essential foundation of the interference, without which it can not be carried on; in other words, it is a jurisdictional fact which the court must find before it can proceed to adjudge priority. If this be true the appellant is not estopped to raise the question, for his express consent could not confer jurisdiction. The same argument was met by the court in the opinion above quoted from, in these words following immediately thereafter:

“Moreover, the rights 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 and the latter does not involve the former. This is clearly indicated in the Revised Statutes of the United States (§ 4911) and in § 9 of the act of Congress of February 9, 1893, providing for the organization of this court. See, also, *Doyle v. McRoberts*, 10 App. D. C., 445.”

In some cases since decided it has been intimated that under extraordinary circumstances, the question of patentability might be considered in an interference case to prevent palpable injustice. But these expressions were not necessary to the determination of the case; and in none since the organization of this court has the decision of the Commissioner been reversed upon any such ground.

In the latest case in which this question was discussed, it was said:

“The decision that the issue is a patentable one, having been made in the office and a patent issued thereon to Geen, (one of the parties in interference), although it is confessed by the Examiner of Interferences that ‘the invention is an exceedingly limited one,’ is binding upon us on this appeal. Assuming, as we must, for the purposes of this case, that the original conclusion, arrived at, it appears, with considerable difficulty in the office in passing upon Geen’s application to patent, was a sound one, the single question for our determination is the disputed claim of priority between the patentee and the later applicant. *Kreag v. Geen*, present term, 28 App. D. C. 437; 127 O. G. 1581.”

In many other cases of doubtful patentability, in our unexpressed opinion, we have felt constrained to confine our consideration to the question of priority alone, for the reason that the statute does not give an appeal to this court from the decision of the Patent Commissioner affirming the patentability of a claimed invention. As was said by Mr. Justice Duell, in the recent case of *Sobey v. Holsclaw*, 28 App. D. C.:



"In interferences we do not determine whether either party shall receive a patent. The question presented to us is, considering that there is a patentable invention, which party was the first to invent or discover the same? When an interference is returned to the Patent Office after we have decided the question of priority, it is within the power of the Commissioner of Patents to withhold a patent from the successful interferant. In such case, by an orderly system of appeals provided by the statute, the action of the Commissioner of Patents may be reviewed on an *ex parte* appeal. It is only on such appeals that we can decide that a patent shall or shall not issue. Appeals frequently come to this court in *ex parte* cases where some claims have been allowed and others refused. The appeal is only before us to consider the correctness of the Commissioner's decision in disallowing the appealed claims. We may doubt the patentability of the allowed claims, but are without power to act. So, in interferences we may doubt the patentability of the issues; but we find no provision in the statute warranting us in overruling the deliberate decision of the Patent Office because of any such mere doubt. Authority to grant patents is vested in the Commissioner of Patents. If he errs and grants an invalid patent, his error can be corrected by the court whenever the validity of the patent is questioned."

Without reciting the rules of the Patent Office regulating the procedure in interferences, which are set out in the brief for the appellant, and assuming, for the purposes of the argument, that they are binding upon this court, we see nothing in them negating the views expressed. They have never been so interpreted in the Patent Office. The question of patentability is passed upon by the Primary Examiner of the particular department in the first instance. Then only can an interference be declared with another allowed application for the same invention. When declared, the question of priority goes to the Examiner of Interferences, and thence to the Examiners-in-Chief, the Commissioner, and finally to this court. If the question of patentability is raised by a motion to dissolve the interference, it is at once referred to the Primary Examiner who gives a hearing and renders his decision. His decision is not appealable to the tribunals sitting in interference cases, but to the Commissioner in person. If the issue is held patentable the interference proceeds in the regular course on the issue of priority alone. This practice has been approved. *Allen v. U. S., ex rel. Lowry*, 26 App. D. C. 8, 25; *U. S., ex rel. Lowry v. Allen*, Sup. Ct. U. S. Dec. 10, 1906; 203 U. S., 476, 125 O. G. 2365.

If it were true, then, that the patentability of the issue is a jurisdictional fact without which there can be no determination

of priority of claim, the procedure above described could not reasonably have been upheld; and this court, moreover, would be compelled to pass upon the patentability of the issue, as a preliminary question, in every interference case, whether directly raised by the parties or not. To do this would be to exercise a general supervisory power over the administration of the Patent Office, not contemplated in the act creating this court and conferring upon it a limited appellate jurisdiction in certain cases. It must be borne in mind that the final judgment of this court entitling a claimant to a patent in either an *ex parte*, or an interference proceeding is not conclusive of either patentability or priority. The patent, when issued, may be attacked in the courts by parties whose interests may be affected by the monopoly claimed thereunder; and the defeated party has another remedy by proceeding in a court of equity as provided in section 4915, Revised Statutes.

It has become so much the practice, of late, to raise this question of patentability in interference cases, that we think it advisable to set it at rest, so far as this court may; trusting that if our judgment is erroneous it may be corrected by the court of last resort through some appropriate proceeding.

As regards the issue of priority, the burden upon the appellant, as the junior party, has been heavily increased by the unanimous decisions of the Patent Office tribunals. \* \* \*

§§. GOLD v. GOLD, 34 App. Cas. D. C. 229, 150 O. G. 570, 1910 C. D. 269.

Shepard, J.:

\* \* \*

1. It is the settled doctrine of this court that the allowance of a claim in the Patent Office is conclusive of the question of patentability in an interference proceeding, because the appellate jurisdiction in respect of patentability is limited to cases where claims have been rejected on that ground. *Johnson v. Mueser*, 29 App. D. C. 61-64, and cases cited; *Dunbar v. Schellinger*, *idem.*, 129-140. But whether a former adjudication against the patentability of claims, made on motion of one of the parties in interference to dissolve on that ground, is conclusive of the right to reconsider the question of patentability of the several applications, *ex parte*, and then to renew the interference, formerly dissolved, is a question that has not been decided.

As we have seen, the first motion to dissolve, from the decision on which no appeal was taken, was granted on the ground that the claims in the issue of the interference were not patentable at all in view of the prior art. Two claims of the issue were not included in that adjudication, as they were not embraced in the motion. As the result of the order of dissolution, each appli-



cant was referred back to the Primary Examiner for separate action. The ordinary result of this would be the final rejection of the claims of both parties which had been held unpatentable. Edward E. Gold amended his claims and demanded reconsideration. The Examiner rejected them but on appeal to the Examiners-in-Chief they were allowed. Egbert H. Gold's application was also reconsidered and the interference was redeclared. Notwithstanding the amendments referred to the new claims are not essentially different from the old ones.

It is also settled that where an application has been finally rejected by the Commissioner in an *ex parte* proceeding, that adjudication may be relied on by him as conclusive on a second application for the same invention. In *re* Barratt's Appeal, 14 App. D. C. 255-261; in *re* Fay, 15 App. D. C. 517; in *re* Edison, 30 App. D. C. 321-323. A qualification of this doctrine was indicated by the following language in the opinion by Justice Morris in Barratt's case:

"In what we have said we do not desire to be understood that the Patent Office may not, if it thinks proper so to do, entertain and adjudicate a second application for a second patent after the first application has been rejected. What we decide is, that it is not incumbent upon the Office as a duty, to entertain such applications, and that, if it refuses to entertain them, it has a perfect legal right so to do. An applicant is not legally aggrieved by such refusal."

Therefore, in so far, as the public interest, of which the Commissioner is the representative, was concerned, it seems that he had the power to permit this reconsideration and allowance. The doctrine of *res adjudicata* necessarily applies in favor of the successful party to an interference to whom an award of priority has been made, against his opponent's attempt to renew the interference upon a new application with claims for the same invention although in different or broader form. *Blackford v. Wilder*, 28 App. D. C. 535-545; *Horine v. Wende*, 29 App. D. C. 415-428; *Carroll v. Hallwood*, 31 App. D. C. 165-172.

While the question of the patentability of the issue will not be entertained on appeal from an award of priority, the right of one of the parties to make the claims under the disclosures of his application will be entertained as an ancillary question for the reason that—

"If it be incorrectly held that such party has the right to make the claim, priority may be awarded to him, and his adversary 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. *Podlesak v. McInnerney*, 26 App. D. C. 399-405."

As a consequence of the doctrine established by that case, it has been held that where an interference has been dissolved on that ground, without appeal from the decision, this right to make the claim, must be considered *res adjudicata* in a later interference between the parties on the same application. U. S., *ex rel. Newcomb Motor Co., v. Moore*, 30 App. D. C. 464-476. In that case Newcomb had received a patent but before its issue Thompson and others had applications pending in the Office, the claims of which did not conflict with Newcomb's. Hence no interference had been declared. When the parties saw Newcomb's patent they amended by copying every one of its claims. Interferences having been declared between the amended applications and the patent, Newcomb moved to dissolve on the ground that his opponents had no right to make those claims under the disclosures of their applications. The motion was sustained by the Examiner, and the opponents took an appeal to the Commissioner, which they thereafter abandoned. After withdrawing their appeals they proceeded *ex parte* and secured another allowance of their claims as being within the disclosures. The interference was then again declared. Newcomb moved to dissolve on the ground that the question of his opponents' rights to make the claims was concluded by the judgment on his first motion. This contention was sustained on a petition for mandamus to the Commissioner to compel him to give effect to the former judgment and vacate the later proceedings for interference. That case is relied on by appellant as governing the question under present consideration. We cannot agree with the contention. The question of the right of one of the parties to make claims, is inseparably connected with that of priority. When adjudged that one of the parties had no right to make the claims, in other words, that his description fails to show a conception of the invention of the issue, the other, who thereby appeared to be the sole inventor, was necessarily entitled to the award and to his patent. The effect of the decision is to establish his right of property in the invention, and he is entitled to the benefit without further impeachment of that right by his adversary in renewed litigation in the Patent Office. If the losing party can go back to the Examiner, and proceeding *ex parte*, secure an allowance of his right to make the claims and then renew the litigation with his adversary, there might be no end to it. It is to meet conditions of the kind that the salutary doctrine in respect of the conclusiveness of former judgments had been applied in proceedings in the Patent Office. On the other hand the patentability of a described invention is a question that arises on each application when presented, and is necessarily determined *ex parte*. It is only when patentability has been allowed



in the *ex parte* proceeding that an interference with a like application of another can be declared. This allowance is not appealable. It is true that the patentability of the claims of an issue in interference may be questioned in a motion to dissolve. (Patent Office Rule 122.) Why this is permitted by the rule we do not understand, unless it be to enable the Commissioner to reexamine the question in the light of argument and put an end to useless litigation if he find that an allowance of patentability ought not to have been made in the first instance. So finding he acts for the protection of the public from an unauthorized monopoly and dissolves the interference so that each application may be rejected. The decision determines no right between the two opponents, but one between them both, on one side, and the public on the other. If either desire to appeal from the final order of rejection, he must do so, *ex parte* in regular course of procedure. *In re Fullagar*, 32 App. D. C. 222-229; *Sobey v. Holsclaw*, 28 App. D. C. 65-82. That the question is to be considered as one between the public and the parties, and not between the latter, is also evidenced by the provisions of Rule 126 which authorizes the Examiner of Interferences, and the Examiners-in-Chief to direct the attention of the Commissioner to matters not relating to priority. Moreover the Commissioner may, with or without such direction or attention, raise the question of patentability of his own motion, and send the application back for rejection without deciding the question of priority, or he may, after the question of priority has been determined, reject the application of the successful interferant, and put him upon an *ex parte* appeal. *Sobey v. Holsclaw*, 28 App. D. C. 65-82; *Seymour v. Brodie*, 10 App. D. C. 507. We must hold that the question of patentability was not concluded by the decision of the original motion to dissolve the interference on that ground.

2. The remaining question is whether the subject-matter of the issue is disclosed in Patent No. 771,628, for if it is, Egbert H. Gold is entitled to the filing date of the application for that patent for constructive reduction to practice, and consequently to the award of priority, as it has been found that he was the first to conceive the invention.

The point has been fully and ably considered in the decisions of the several tribunals of the Office, and we find no occasion for adding to the discussion. When all of these expert tribunals have concurred in holding, especially in a case involving somewhat complicated mechanical means, that the invention claimed is not disclosed in the description of a party's invention, error must be very clearly shown in their conclusions to justify a reversal of the same. *Seeberger v. Dodge*, 24 App. D. C. 476-481;

Kilbourne v. Hirner, 29 App. D. C. 54-57; Stone v. Pupin, 19 App. D. C. 396-400.

It is sufficient to say that no such error has been shown. The decision will, therefore, be affirmed. It is so ordered, and that this decision be certified to the Commissioner of Patents as required by law.

889. BLACKFORD v. WILDER, 28 App. Cas. D. C. 535, 127 O. G. 1255, 1907 C. D. 491.

Shepard, J.: \* \* \*

The doctrine of *res adjudicata*, or estoppel by former judgment, has been thus declared by the Supreme Court of the United States:

“When the second suit is upon the same cause of action, and between the same parties as the first, the judgment in the former is conclusive in the latter as to every question which was or might have been presented and determined in the first action; but when the second suit is upon a different cause of action, though between the same parties, the judgment in the former action operates as an estoppel only as to the point or question actually litigated and determined, and not as to other matters which might have been litigated and determined.”

Nesbit v. Riverside Independent District, 144 U. S. 610, 618; New Orleans v. Citizens Bank, 167 U. S. 371, 386; S. P. R. R. v. U. S., 168 U. S. 1, 48.

The same rule applies to adjudications made in the Patent Office. In *re Barratt's appeal*, C. D. 1899, 320, 87 O. G. 1075, 14 App. D. C. 255, 257; in *re Fay*, C. D., 1900, 232, 90 O. G. 1157, 15 App. D. C. 515, 517. It is also declared in Patent Office Rule 127, that—

“a second interference will not be declared upon a new application for the same invention filed by either party.”

It is further provided in Rule 132, that whenever an award of priority has been rendered in an interference proceeding by any tribunal, and the limit of appeal therefrom has expired, the Primary Examiner shall advise the defeated party that the claims so involved in the issue stand finally rejected. In interpreting this rule (A. D. 1891) Mr. Commissioner Mitchell held that the Examiner, after rejecting all claims which are or could be made by the prevailing party, may properly allow to the defeated party such other claims as are held to be patentable and which could not be made by the prevailing party; and that no claim should be allowed to the defeated party which could by any latitude of construction be held to embrace matter common to the structure of both parties to the interference. C. D. 1891, 141, 56 O. G. 141.



In *Corry & Barker v. Trout*, C. D. 1904, 144, 110 O. G. 306, Mr. Commissioner Allen reversed a decision of the Primary Examiner refusing dissolution of a second interference between the same parties. In doing so he said:

"The prior interference included the application now involved and the claim in controversy was drawn upon the same structure as that now claimed. Corry and Barker contend that the present issue is not substantially different from that in the first interference, and Trout admits that they differ merely in scope. Trout, however, argues that the present issue being broader than the first cannot be regarded as substantially the same and that it cannot be assumed that he will be unable to prove priority of invention on this issue merely because he failed on the specific issue. The declaration of a second interference between the same applications should be necessary only in rare cases and under very exceptional circumstances. It should not ordinarily be upon claims to the same device and differing from the first issue merely in scope. If a mere change in the scope of claims were considered good ground for a second interference, the number of successive interferences between the same parties would be practically unlimited and the interference procedure would become an intolerable burden to applicants. The Office is justified in taking the decision as to priority of invention as *prima facie* evidence that the successful party was the first inventor not merely of the particular issue in controversy, but of the invention common to the two cases, whether more broadly or more specifically stated. The burden is upon the defeated party to show special circumstances of the particular case which make it improper to apply the decision to the other claims presented. It is not sufficient that the claims differ and that it is theoretically possible for one party to be prior inventor as to the first, and the other party prior inventor as to the second, for this would apply in all cases where the claims are not identical. To justify a second interference, there must be some exceptional circumstances, such as were presented in *Sarfert v. Myer* (76 MS. Dec. 410), where the decision in the first interference was in favor of Sarfert upon the specific issue; but it appeared from the findings of fact that Myer was the first inventor of the broad invention common to the two cases."

See also *Phelps v. Wormley*, 118 O. G. 1069, 1070; *ex parte Neischwanger*, C. D. 1890, 37, 38, 50 O. G. 1132.

The foregoing decision is in substantial accord with the long-established doctrine of the Patent Office, that an interference in fact depends chiefly upon the subject-matter disclosed and not merely upon the language of the respective claims. Drawbaugh

v. Blake, C. D. 1885, 7, 11, 30 O. G. 259. In that case Mr. Commissioner Butterworth said:

"I have no doubt about the correctness of the rule laid down in *ex parte Upton*, C. D. 1884, 26, 27 O. G. 99. It is the substance of things and not the shadow with which we deal. \* \* \*"

*Gray v. Robertson*, C. D. 1885, 1, 50 O. G. 165; *Bissell v. Roberts*, C. D. 1885, 77, 51 O. G. 1618. See also *Miller v. Eagle Mfg. Co.*, C. D. 1894, 147, 66 O. G. 845, 151 U. S. 186, 198.

In that case the question was as to the validity of two patents to the same party. The drawings in each patent were identical, and the specifications in each substantially the same, but the first patent covered both the lifting and depressing actions of the machine, while the second was limited to the lifting effect only. The second patent was held to be void. Mr. Justice Jackson, who delivered the opinion of the Court, said:

"The result of the foregoing and other authorities is that no patent can issue for an invention actually covered by a former patent, especially to the same patentee, although the terms of the claims may differ; that the second patent, although containing a broader claim, more general in its character than the specific claims contained in the prior patent, is also void; but that where the second patent covers matter described in the prior patent, essentially distinct and separable from the invention covered thereby and claims made thereunder, its validity may be sustained. \* \* \* It is settled also that an inventor may make a new improvement on his own invention of a patentable character, for which he may obtain a separate patent, and the cases cited by the appellee come to this point, and to this point only, that a later patent may be granted where the invention is clearly distinct from, and independent of, one previously patented."

*Porter v. Loudon*, C. D. 1895, 707, 73 O. G. 1551, 7 App. D. C. 64, 69.

It remains to apply the foregoing principles to the facts of this case which are substantially these: The applications of the two interferences are the same: The issue of each reads on Wilder's original Exhibit E, and Blackford's Exhibit D. It was on Exhibit E, and the evidence relating to its several parts, time of construction and operation that Wilder's right to priority was founded and determined in each case. That exhibit when produced before the Examiners-in-Chief, the Commissioner, and this court, in the hearing of the first interference, did not show the wick of the issue therein involved, and Wilder was denied the right to introduce additional evidence tending to show that the wick was in the device when constructed, and when offered for inspection in the Patent Office. He was confined to the evidence contained in the record. When the decision awarding



priority to Blackford was certified to the Commissioner, Wilder presented the broader claims, and secured the declaration of a second interference with Blackford, supporting his claim to priority with his same Exhibit E and some additional evidence tending to show that the wick of the former issue was contained in it when constructed. The decisions of the several tribunals of the Patent Office in favor of Wilder were founded upon this exhibit and evidence. \* \* \*

To sum up—the parties are the same. The applications are the same and disclose the invention of each issue. The constructions relied on, respectively, as evidencing conception and reduction to practice of the invention of both issues are the same. The fundamental facts of both cases are the same. Applying the well-settled principle of estoppel by judgment, before stated, it follows inevitably that the final decision in the first interference is conclusive, unless it can be made to appear that the question upon which the determination of the second case rests is one that neither was, nor could have been presented and determined in the first case.

The contention is that this essential difference between the two cases lies in the fact that the claims of the second interference are broader in scope than those of the first, and cover an essentially separate and distinct invention. We are unable to concur in the decisions of the Patent Office tribunals maintaining this view. As pointed out in the cases heretofore cited, in declaring interferences in the Patent Office, identity of subject-matter is not determinable merely by the language of the claims preferred by the respective applicants. By the several decisions under review on this appeal it is shown that the later claims of Wilder might have been presented in the first instance, if so advised, and Blackford brought into interference with him then as he has been since; for, as they expressly hold, Blackford's Exhibit D, being an oil-bowl, necessarily contained the issue of the second interference. Instead, Wilder preferred to adopt the more specific claims of the first issue drawn as the present ones were upon the structure shown in his Exhibit E, and reading as well on Blackford's Exhibit D. That issue having been decided in favor of Blackford, Wilder has been permitted to make the new claims and has been awarded priority of invention over the claim of Blackford founded on the structures proved in the first case, on additional evidence to that introduced on the first trial tending to show that his Exhibit E did, in fact, have in it the wick of the first issue, notwithstanding that had been one of the questions expressly decided in the former case. Having had the right to make the broader claims in the earlier stages of the proceedings in the Patent Office, as well as the opportunity, it

the first proceeding, to introduce all of his evidence relating to the construction and operation of his Exhibit E structure, his right, in both respects, terminated with that litigation.

Whether the former decision was right or wrong, or was induced by the want of the particular evidence that was offered in the present case, is not the question. However that might be it was final and put an end to the litigation in the first interference. It must be held, therefore, as conclusive of every question that not only was, but also might have been presented and determined in that case.

The motion to dissolve the second interference ought to have been sustained, and Wilder's claims finally rejected as provided in Rule 132.

The decision appealed from will therefore be reversed. It is so ordered; and that this decision be certified to the Commissioner of Patents as required by law. Reversed.

390. MORGAN v. DANIELS, 153 U. S. 120, 38 L. ed. 657, 14 Sup. Ct. 772 (1894).

Brewer, J.: \* \* \*

#### Statement of the Case.

On October 30, 1889, the appellee, Fred H. Daniels, commenced suit against the defendant in the Circuit Court of the United States for the District of Massachusetts. In his bill he alleged that he was the original, sole, and first inventor of an improvement in machines for coiling wire or wire rods; that on June 26, 1886, he filed in the United States Patent Office an application in due form for a patent; that on September 4, 1886, the Commissioner of Patents declared an interference between his application and one filed by the defendant on June 24, 1886; that thereafter testimony was taken on such interference, and a decision rendered on March 22, 1889, adversely to his claim of a priority in invention; that a rehearing was had, which rehearing resulted, on October 28, in affirming the original decision. The bill further averred that the defendant was not, as decided by the Commissioner of Patents, the first inventor or discoverer, and prayed for a decree that he, plaintiff, be entitled to receive a patent for his invention, as specified in his claims, and that defendant be enjoined from taking any steps to use or dispose of Letters Patent for said invention, or any part thereof.

This suit was brought under the authority of section 4915, Revised Statutes, which is as follows:

"Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the ap-



plicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not."

To this bill, on January 10, 1890, the defendant filed an answer, denying that plaintiff was the inventor, as alleged. The case was submitted to the circuit court upon the testimony used in the interference proceedings, and upon such testimony a decree was entered, finding that plaintiff was the original inventor and entitled to receive a patent for the invention. From such decree the defendant brings this appeal. \* \* \*

Mr. Justice Brewer delivered the opinion of the Court.

It is worthy of notice that hitherto in the progress of this litigation upon the same testimony different persons have reached different conclusions. Thus, in the opinion filed June 5, 1888, by the Examiner of Interferences and Assistant Examiner, it was found that the defendant was the original inventor. On an appeal from that decision the Examiners-in-Chief (two members being present) came to a different conclusion, and awarded priority to the plaintiff. On a further appeal the Commissioner of Patents on March 22, 1889, reversed the judgment of the Examiners-in-Chief, and sustained that of the original Examiners. A motion for rehearing was brought before a succeeding Commissioner and overruled. When this case was submitted, without any additional testimony, to the circuit court the conclusion finally reached in the Patent Office was dissented from, and it was found that the plaintiff was the original inventor. An examination of the opinions filed by these different officers indicates that by each of them the matter was carefully considered. Evidently, therefore, the question as to which was the prior inventor is not free from doubt. What, then, is the rule which should control the Court in the determination of this case? It is insisted by the appellant that the decision of the Patent Office should stand unless the testimony shows beyond any reasonable doubt that the plaintiff was the first inventor, and, in support of their contention, cite the cases of *Coffin v. Ogden*, 18 Wall. (U. S.) 120, 124, and *Cantrell v. Wallick*, 35 O. G. 871, 117 U. S. 689, 695. In the

first of these cases, which was a suit for infringement, the defense was a prior invention, and in respect to this defense the Court observed:

"The invention or discovery relied upon as a defense must have been complete, and capable of producing the result sought to be accomplished; and this must be shown by the defendant. The burden of proof rests upon him, and every reasonable doubt should be resolved against him."

In the other case the same defense in a suit for infringement was set up, and there the Court thus stated the rule:

"The burden of proof is upon the defendants to establish this defense. For the grant of Letters Patent is prima facie evidence that the patentee is the first inventor of the device described in the Letters Patent and of its novelty. *Smith v. Goodyear Dental Vulcanite Co.*, 11 O. G. 246, 93 U. S. 486; *Lehnbeuter v. Holt-haus*, 21 O. G. 1783, 105 U. S. 94. Not only is the burden of proof to make good this defense upon the party setting it up, but it has been held that 'every reasonable doubt should be resolved against him'."

These two cases are closely in point. The plaintiff in this case, like the defendant in those cases, is challenging the priority awarded by the Patent Office, and should, we think, be held to as strict proof. In the opinion of the court below the rule is stated in these words:

"The complainant, on the issue here tendered, assumes the burden of proof, and must, I think, as the evidence stands, maintain by a clear and undoubted preponderance of proof that he is the sole author of that drawing. 42 Fed. 451."

This language is not quite as strong as that just quoted. The case as presented to the circuit court was not that of a mere appeal from a decision of the Patent Office, nor subject to the rule which controls a chancellor in examining a report of a master, or an appellate court in reviewing findings of fact made by the trial court. There is always a presumption in favor of that which has once been decided, and that presumption is often relied upon to justify an appellate court in sustaining the decision below. Thus, in *Crawford v. Neal*, 144 U. S. 585, 596, it was said:

"The cause was referred to a master to take testimony therein, 'and to report to this court his findings of fact and his conclusions of law thereon.' This he did, and the court, after a review of the evidence, concurred in his findings and conclusions. Clearly, then, they are to be taken as presumptively correct, and unless some obvious error has intervened in the application of the law, or some serious or important mistake has been made in the consideration of the evidence, the decree should be permitted to stand."



See also *Camden v. Stuart* 144 U. S. 104, and *Furrer v. Ferris*, 145 U. S. 132.

But this is something more than a mere appeal. It is an application to the Court to set aside the action of one of the Executive Departments of the Government. The one charged with the administration of the patent system had finished its investigations and made its determination with respect to the question of priority of invention. That determination gave to the defendant the exclusive rights of a patentee. A new proceeding is instituted in the courts—a proceeding to set aside the conclusions reached by the administrative department, and to give to the plaintiff the rights there awarded to the defendant. It is something in the nature of a suit to set aside a judgment, and as such is not to be sustained by a mere preponderance of evidence. *Butler v. Shaw*, 21 Fed. 321, 327. It is a controversy between two individuals over a question of fact which has once been settled by a special tribunal, intrusted with full power in the premises. As such it might be well argued, were it not for the terms of this statute, that the decision of the Patent Office was a finality upon every matter of fact.

In *Johnson v. Towsley*, 13 Wall. (U. S.) 72, 86, a case involving a contest between two claimants for land patented by the United States to one of them, it was said:

“It is fully conceded that when those officers (the local land officers) decide controverted questions of fact, in the absence of fraud, or impositions, or mistake, their decision on those questions is final, except as they may be reversed on appeal in that Department.”

Upon principle and authority, therefore, it must be laid down as a rule that where the question decided in the Patent Office is one between contesting parties as to priority of invention, the decision there made must be accepted as controlling upon that question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction. Tested by that rule the solution of this controversy is not difficult. Indeed, the variety of opinion expressed by the different officers who have examined this testimony is persuasive that the question of priority is doubtful, and if doubtful the decision of the Patent Office must control.

What was the invention which the parties each claim to have made and in respect to which an interference was ordered in the Patent Office? It was thus stated by the Examiner:

“In a device for coiling wire or wire rods, the combination, with a rotating coiling receptacle or reel for receiving and laying in coils the rod as it is delivered from the rolls, of a spider or plat-

form for supporting the coil mounted on a vertical shaft concentric with the reel-supporting shaft, and means for elevating the platform-shaft independently of the other."

Plaintiff claims to have conceived the idea of this combination in July, 1878, and to have made in that and the succeeding year sketches and drawings which fully disclosed it. It is conceded that a machine embodying the invention was first constructed and put into successful operation in the spring of 1886, and that this was done under the direction and superintendence of defendant.

During the years 1878 and 1879, the defendant, a man about forty-seven years of age, was, as he had been since 1864, the general superintendent of the Washburn & Moen Manufacturing Company, a corporation engaged in the manufacture of iron and steel wire, while the plaintiff, twenty-four years of age, was in the employ of the same company as a draftsman, working under the direction of the defendant. The business of the company had, during the years of defendant's superintendency, grown to be enormous. In the actual work of the mill, as the finished wire came from the rolls it was coiled on reels. At first this was done through the agency of an attendant seizing the wire by a pair of tongs and engaging it with the reel, but this operation was attended with both danger and delay. To obviate this, the parties interested in this manufacture sought the invention of machinery which should seize the finished wire and engage it with the reel, and thereafter dislodge the completed coil therefrom.

The defendant locates the time of his conception of the idea embodied in this combination in October, 1878, and that which enables him to locate it is a transaction with Daniel C. Stover. It appears that in October, 1878, Stover (who was a manufacturer and inventor) came to Worcester, Mass., and while engaged in examining the machinery in the mill had his attention directed to the way in which the wire was coiled on the reels, and thought that some device could be invented for picking up the wire immediately after its leaving the rolls. After some reflection he conceived the idea which he subsequently embodied in Patent No. 219,124. He suggested his idea to the defendant, who replied that it was not new, and that others were working at it. He prepared a model which showed not only a device for picking up the wire, but also one for discharging the completed coil, and showed it to defendant, who, on his part, showed Stover a model which he had prepared. It is not pretended that either the model of Stover or that of defendant disclosed the exact combination for which a patent was claimed in this case. Nor is it important to notice all the details of the transactions at the time between Stover and the Washburn & Moen Company. It appears that



Stover sold and assigned a one-half interest in his invention to the Washburn & Moen Company. The time of Stover's visit is established by the date of that assignment and the application which he made for a patent, and by other writings. There is significance in the fact that although the plaintiff was present when Stover's model was shown, it does not appear that he made any suggestion that he had invented anything of a similar character; and yet, if his present claim is true, he had for months been considering the matter, and had at least three months before conceived the very idea of the combination now in dispute. But it is enough to say in respect to this branch of the case that the story of the invention by defendant at the time stated is reasonable, probable, and to a certain extent supported by the testimony of Stover.

As against this the plaintiff claims to have conceived the idea of this combination in July, 1878, and relies mainly on the testimony of two witnesses, Lambert and Fowler. Though he was a draftsman he presented no sketch or drawing made prior to November, 1878, which in any such manner pictures his invention. It is true he testifies to having made sketches prior thereto, but none have been preserved. One of them he claims to have shown to Lambert in July, 1878, and Lambert was called as a witness to support this statement; but Lambert's testimony does not, it seems to us, carry the weight which is claimed for it. He was a tinsmith by occupation, employed at times by the manufacturing company, and testifies that in July, 1878, or about that time, very soon after Daniels' return from Europe, he came to his shop and showed him a sketch, and asked him to make a model of it. He declined, saying that he was too busy. Nothing more took place at that time, but in the fall of 1886, at Daniels' request, he made a model of the machine which, as he says, was disclosed by that sketch. This model was in evidence. Now, it is possible that one seeing for a few minutes a sketch of a complicated machine can eight years thereafter remember the details of that sketch so clearly as to make an accurate model. But, if it is possible, it surely is not probable. If the invention embraced in the sketch impressed either Daniels or Lambert as something of great value, and therefore, fixed itself firmly in the mind, it is strange that neither seemed anxious to impress it upon the attention of others, carry it into actual use, or derive profit from it. On the other hand, if it was one which did not impress either as of any special value, it seems almost morally certain that the details of the sketch and the precise character of the invention would not have been accurately remembered through all those eight years. We must not be understood as imputing to Lambert intentional falsehood. He was familiar with the machinery

actually in use in the wire mill. He saw in the course of his acquaintance with that machinery many models and many machines, and the machine embodying this invention, as perfected, had been in actual use in the mill several months before he made this model. He may well have gotten some of these matters confused in his mind, and introduced into this model elements and parts which were not seen by him in the sketch displayed in 1878, and which were in fact taken from other sketches and drawings, or from models, or machines. At any rate, when there was nothing to specially arrest the attention, it taxes credulity for one to claim that he bears in mind for over eight years the details of a sketch of a complicated machine which is casually shown to him and which he sees but for a short time, and is enabled to thereafter reproduce the details of that sketch in a model.

Equally unreasonable is the testimony of Fowler, which is to the effect that on July 20, 1878 (the date being fixed by a memorandum in his diary), Daniels came to visit him. This diary notes the facts simply of the visit of Daniels, but contains nothing in respect to the matters involved in this case. His testimony as to this was in these words:

“He explained by rough sketches an arrangement he had for coiling the wire after it was delivered from the rolls, which was a round box mounted on an upright shaft, and in the bottom of the box was a plate, perhaps I should say a movable plate, which could be lifted for the purpose of raising the coil of wire. That was his method of getting hold of the coil, to get it out of the box.”

None of these rough sketches were preserved. There was apparently nothing to impress the matter upon the mind of Fowler, and his attention was not directed to it until some time in the early part of 1887, nearly nine years thereafter, when Daniels called on him for the purpose of securing his testimony in this case. Doubtless Fowler means to be truthful. There is no reason to impugn his integrity, but his testimony is subject to a criticism similar to that placed upon the testimony of Lambert. As one of the matters which was being considered and discussed by the manufacturing company was how to do the work which is now being done by the machine finally constructed by defendant, it is not at all unlikely that Daniels, one of the employes of that company, spoke of the matter to Fowler at the time named; very likely he may have drawn rough sketches to suggest the ideas which were in his mind; but it is not probable that in the absence of some special reason therefor the memory would carry for eight or nine years the details of the plan or idea suggested by Daniels and illustrated by these



sketches. While, of course, it is possible, yet such testimony is not of a character to carry great weight.

There is other testimony on both sides of this controversy. It is unnecessary to notice it in detail. It is enough to say that the testimony as a whole is not of a character or sufficient to produce a clear conviction that the Patent Office made a mistake in awarding priority of invention to the defendant; and because of that fact, and because of the rule that controls suits of this kind in the courts, we reverse the judgment and remand the case, with instructions to dismiss the bill.

Mr. Justice Jackson did not hear the argument or take part in the decision of this case.

**391. UNITED STATES, EX REL LOWRY, v. ALLEN, COMMISSIONER OF PATENTS, 203 U. S. 476, 51 L. ed. 281, 27 Sup. Ct. 141 (1906).**

Mr. Justice McKenna delivered the opinion of the Court.

This is a petition for mandamus filed in the Supreme Court of the District of Columbia, requiring the Commissioner of Patents to direct the Board of Examiners-in-Chief to reinstate and take jurisdiction of the appeal of petitioners from the decision of the Primary Examiner, refusing to dissolve an interference between a patent granted to him and an application for a patent by one William L. Spoon. The supreme court granted the mandamus. Its judgment was reversed by the court of appeals.

The question in the case is, whether the rule of the Patent Office which denies an appeal from a ruling of a Primary Examiner, upon motion to dissolve an interference, is contrary to the Revised Statutes, and therefore void. Rule 124 provides that "from a decision of a Primary Examiner affirming the patentability of the claim or the applicant's right to make the same, no appeal can be taken."

Plaintiffs in error attack the rule as inconsistent with the sections of the Revised Statutes which provide for interferences. These sections are inserted in the margin. [R. S. Secs. 4894, 4909, 4910, 4911; Sec. 9, Act of February 9, 1893; R. S. Secs. 482, 483—See supra.]

The facts are as follows: Lowry was granted a patent for a bale of fibrous material January 29, 1897. An interference was declared between his patent and application of one William Spoon, to which interference Lowry was made a party. He moved to dissolve the interference upon the ground, among others, that Spoon's press was inoperative. The Primary Examiner granted the motion and Spoon appealed to the Board of Examiners-in-Chief, who confirmed the decision. Upon petition of Spoon the Commissioner of Patents remanded the case to the Primary Examiner for further consideration, and the

latter officer, upon the filing of additional affidavits, decided that Spoon's application disclosed an operative device. From this decision an appeal was taken to the Board of Examiners-in-Chief, which was dismissed by that Board for want of jurisdiction. Thereupon Lowry petitioned the Commissioner to direct the Board to issue an appeal. The petition was denied, the Acting Commissioner remarking:

"The rule prohibiting an appeal from a decision upon a motion holding that a party has the right to make the claim of the issue is in accordance with the practice which has prevailed in this Office for many years and has the support of all decisions of the courts which have been rendered on the subject. There seems to be no reason for regarding it as inconsistent with the statute. It seems very clear that the decision in this case is not a final adverse decision, since it is not a ruling that Lowry is not entitled to his patent. That is a matter which may be determined in the further proceedings, and therefore it is clear that the decision relates to a mere interlocutory matter.

"The petition is denied."

Lowry filed another petition, appealing to the Commissioner "in person," to direct the Board of Examiners-in-Chief to entertain his appeal. The petition was considered and denied. In passing on the petition the Commissioner said:

"Under the express provisions of Rule 124 there is no appeal to the Examiners-in-Chief from such decision rendered on an interlocutory motion. It is believed that there is nothing in that rule inconsistent with law, and that therefore it has the force of law. The right of appeal in interferences given in general terms in the statute is a very different thing from the right of appeal on all motions in the interference. To permit appeals on motions would multiply litigation and extend the proceedings in interferences beyond all reasonable limits. It would work great hardship to parties. The appellate tribunals of this Office are no more required to give cases piecemeal consideration than are the appellate courts. The whole case should be ready for appeal when the appeal provided for by the statute is taken.

\* \* \* \* \*

"It is to be particularly noted that there has been no decision as to the rival claims of the parties to this interference. It has not been decided which party is entitled to the patent. If it should at any time be decided that Spoon is entitled to the patent, Lowry will have the right of appeal, but until such final decision is rendered the statute gives him no right of appeal.

"It would seem upon general principles of law that Lowry could then present for determination by his appeal any question which in his opinion vitally affects the question which party is



entitled to the patent. The only ground upon which he can reasonably claim the right of appeal on this motion is that the question vitally affects his claimed right to a patent, and if it does that, he can raise it at final bearing and contest it before the various appellate tribunals, including the court of appeals.

“The refusal to permit the present appeal on motion is therefore not a denial of an opportunity to have the matter reviewed by the several appellate tribunals mentioned in the statute.”

And further:

“No good reason is seen for changing the provisions in Rule 124 here in controversy, which was adopted and approved by a long line of Commissioners of Patents, among whom have been some of the ablest patent lawyers in the country, and which rule has been acquiesced in by patent attorneys practicing before the Office for the last quarter of a century.”

There is quite a sharp controversy between the parties as to the effect of the ruling of the Commissioner. Plaintiffs in error are apparently convinced that the ruling of the Primary Examiner involves a fundamental right which, if not decided on his appeal, will be forever foreclosed to him for review. A different view is expressed by defendant in error. However this may be, we think the question in the case is in quite narrow compass. The statutes involved are not difficult of interpretation. The determining sections are 482, 483, 4904 and 4909. Plaintiffs in error put special stress upon sections 482 and 4909. Section 482 provides for the appointment of Examiners-in-Chief “whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of Examiners \* \* \* in interference cases.”

Section 4906 provides that—

“every party to an interference may appeal from the decision of the Primary Examiner in such case to the Board of Examiners-in-Chief.” \* \* \*

The contention is that this section gives the right of appeal unreservedly and any limitation of it by a rule is void. Such might not be the result, even if there was no qualification of those sections in other sections. As said by the Commissioner—

“the right of appeal in interferences given in general terms in the statute is a very different thing from the right of appeal on all motions in the interference.”

It certainly could not have been the intention to destroy all distinctions in procedure. But we are not left to inference. The statute is explicit. It limits the declaration of interferences to the question of priority of invention. Section 4904 provides

that in case of conflict of an application for a patent with a pending application or with an unexpired patent (as in the case at bar), the Commissioner shall give notice thereof—

“and shall direct the Primary Examiner to proceed to determine the question of priority of invention.”

And it is provided that the Commissioner shall issue a patent to the party adjudged the prior inventor, unless the adverse party appeals from the decision of the Primary Examiner or Examiners-in-Chief, as the case may be. The history of the sections and the rules are gone into at length by the court of appeals in its opinion. We need not repeat the discussion. It answers the detailed reasoning of plaintiffs in error. We concur with the views expressed, that the statutes provide only for appeals upon the question of priority of invention. Appeals on other questions are left to the regulation of the Patent Office under the grant of power contained in section 483. Judgment affirmed.

Mr. Justice Peckham and Mr. Justice Day dissent.

392. U. S. Ex Rel., THE NEWCOMB MOTOR CO., v. MOORE, COMMISSIONER OF PATENTS, 30 App. Cas. D. C. 464, 133 O. G. 1680, 1908 C. D. 332.

Robb, J.:

This is an appeal from an order of the Supreme Court of the District of Columbia dismissing a petition for a writ of mandamus to compel the Commissioner of Patents to enforce a former decision made in the Patent Office and to vacate certain proceedings thereafter had involving what is claimed to be the same subject-matter.

The facts, about which there is no controversy, are these: On July 15, 1902, two patents were regularly issued to E. C. Newcomb—one for an apparatus for generating steam and the other for the method of generating steam. Both were subsequently assigned to the relator, The Newcomb Motor Company. Newcomb's original application was filed June 7, 1901, and subsequently divided. Prior to this, on August 2, 1897, Elihu Thomson had filed an application for an apparatus for regulating and controlling steam production. No interference was declared between this and Newcomb's applications. After the issue of Newcomb's patents Thomson inserted in his application forty-seven claims copied from Newcomb's method patent and demanded an interference. Thereafter, on November 17, 1902, Thomson filed a divisional application setting up the same method claims and at the same time canceled said claims in his original application. February 28, 1900, Herman Lemp filed an application for automatic regulation of steam-propelled vehicles,



and on November 3, 1902, another for the method of producing steam. Both of these have been assigned to the General Electric Company. December 30, 1902, an interference was declared between Lemp's last application and the Newcomb patent, No. 704,908 (method), involving an issue of fifteen counts. These counts consisted of fifteen claims of the Newcomb patent that were not claimed in Lemp's application as filed, but were added thereto after Newcomb's patent had issued. A second interference was declared January 13, 1903, between Lemp's first application and Newcomb's patent No. 704,907. The twenty-one counts of this issue were claims of the Newcomb patent not claimed by Lemp until after the issue of the Newcomb patent. January 13, 1903, an interference was declared between Thomson's divisional application and Newcomb's patent, the forty-seven counts of the issue constituting the claims taken from Newcomb's patent. Another was declared January 27, 1903, between Thomson's original application and Newcomb's patent No. 704,907. The issue in this contained forty-eight counts embracing forty-eight claims of the Newcomb patent not in Thomson's original application but inserted by him after the issue of the Newcomb patent aforesaid. Thereafter Newcomb filed in each case a motion, under Rule 122, to dissolve the interferences. Several grounds were assigned, the substantial one in each case being that the opposing party had no right under his application to make the claims in interference. The Primary Examiner, to whom the motions were referred under the rule, on January 11, 1904, made a decision in each case that the applicants had no right to make the claims, and thereafter dissolved the interferences. The limit of appeal from each decision was ordered to expire February 4, 1904. Lemp and Thomson filed motions before the Primary Examiner asking him to cancel the limit of appeal as contrary to law, because they were entitled to a second rejection of their claims, that after-proceedings in the interferences be suspended pending the motions, and that they be given thirty days within which to file affidavits regarding the right to make the claims. By stipulation the limit of appeal had been extended sixteen days, namely, to February 20, 1904. On that date the Examiner denied the motions. On the same day Lemp and Thomson entered appeals to the Examiners-in-Chief from the decisions dissolving the interferences, asking that hearings thereof be postponed until a decision by the Commissioner on appeals taken directly to the Commissioner from the decisions of the Examiner refusing to extend the limit of appeal. On March 11, 1904, the Commissioner affirmed the decisions denying the motions to extend the limit of appeal. September 28, 1904, the Commissioner denied motions for rehearing. Pending the above

proceedings on June 3 and 7, 1904, Thomson and Lemp petitioned the Commissioner to remand their applications to the Primary Examiner with instructions to reject or allow the same. This petition was denied. On October 5 and 6, 1904, Thomson and Lemp "in view of the Commissioner's decision" of September 28, 1904, withdrew their several appeals to the Examiners-in-Chief from the decisions of the Primary Examiner dissolving the interferences. After the withdrawal of these appeals, Thomson and Lemp proceeded *ex parte* before the Primary Examiner (Newcomb having no knowledge thereof) and demanded action on the same claims, their right to make which had been denied on the motions to dissolve. November 3, 1904, the claims were rejected. Both parties thereafter asked the reconsideration of their several demands and filed affidavits relating to the construction of the applications and claims. Thomson's application was a second time rejected on May 10, 1905, and he appealed in each case to the Examiners-in-Chief. Lemp pursued the same course, and was a second time rejected, on November 20, 1905, and likewise appealed to the Examiners-in-Chief. On July 13, 1905, on Thomson's *ex parte* appeal the Examiners-in-Chief reversed the Primary Examiner as to all but two of the claims involved. On Lemp's *ex parte* appeal they, on January 25, 1906, reversed the Primary Examiner as to all of the claims involved. After these last two decisions the Examiner of interferences reinstated the former interferences, redeclaring them as before with the exception of the two counts which the Examiners-in-Chief had held were rightly denied. Before noticing this second declaration Newcomb moved to dissolve on the ground that the subject-matter was *res adjudicata*. The Examiner denied the motions and Newcomb appealed to the Commissioner. On this appeal the Commissioner, on April 24, 1906, reversed the decision reinstating the interferences and directing it to be vacated; but also ordered that the Primary Examiner's decision rejecting the claims be considered in full force and effect until the Examiner should be convinced that the same was an error or until the same was overruled by an *inter partes* appeal, and further ordered that the Primary Examiner should fix a date for reconsideration of the rejection *inter partes*, and, if still convinced that the rejection was sound to make the same final and fix a limit of appeal. On May 23, 1906, Thomson and Lemp each asked that a day be set for the rehearing provided in said decision. Hearing was set for July 9, 1906, and notices were sent to Newcomb, but the same was postponed to September 26, 1906. Meantime the Examiner of Interferences had on June 11, 1906, set aside the declarations of interferences in obedience to the opinion of the decision of the Commissioner. On August 15, 1906,



The Newcomb Motor Company filed the petition setting up the proceedings in the Patent Office before stated and averring that the only remedy which Thomson and Lemp had in relation to the decisions of the Primary Examiner dissolving the interferences was by appeal to the Examiners-in-Chief pursuant to the provisions of §§ 4909 and 483, Revised Statutes, and the rules of the Patent Office established in accordance therewith, that having taken and then abandoned appeals therefrom the said decisions of the Primary Examiner had become final and the issues therein are *res adjudicata* between the parties, and that by the refusal of the Commissioner to vacate all of the proceedings connected with and leading to a redeclaration of the interferences, and particularly the *ex parte* actions of the said Thomson and Lemp subsequent to the dissolution of the said interferences and any and all appeals therein, petitioner had been deprived of the legal rights vested in him by the laws relating to the granting of patents and will be without redress unless the writ of *mandamus* prayed for be granted.

It is conceded in the brief of counsel for appellee that—"the judgments of the Primary Examiner, unappealed from, were as final as would have been the judgments of the Examiners-in-Chief, on appeal, or of the Commissioner, on appeal, had appeals been taken to those tribunals"—but, it is contended, that the judgment of the Primary Examiner dissolving the interferences on the ground that neither Thomson nor Lemp had the right to make the claims was an interlocutory and not a final decree, because it did not decide the question of priority. It is true, as contended by appellee, that in several cases, decided by this court prior to *Podlesak v. McInnerney*, 26 App. D. C. 299, it was in effect held that interference cases the right of either party to make the claims of the issue, except under extraordinary circumstances, would not be considered. In the *Podlesak* case, however, upon careful consideration we modified our earlier views and ruled that inasmuch as the right of a party to make a claim goes to the foundation of an interference, a judgment of the Primary Examiner denying that right might be appealed to this court, and that we would take jurisdiction to determine that question "as an ancillary question to be considered in awarding priority of invention." The opinion states:

"If it be incorrectly held that such 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."

Allen v. U. S., ex rel. Lowry, 26 App. D. C., 8, relied upon by appellee, in no way conflicts with the decision in the Podlesak case. \* \* \* [See supra, No. 391.]

It is obvious that the decision of the Primary Examiner in the Lowry case was purely interlocutory, for it eliminated neither party to the interference and deferred final judgment on the question of priority until each party had taken testimony. It was still possible, therefore, for Lowry to prevail on the merits and receive the award of priority. Neither does the case of Distilling Co. v. Schneider, 29 App. D. C. 1, conflict with Podlesak v. McInerney, for the reason that the appeal in that case was taken to this court before the subject-matter in dispute had been awarded to either party.

It is further contended that because § 4904, Revised Statutes, provides that whenever "in the opinion of the Commissioner" an interference exists, notice shall be given the parties, etc., a non-delegable duty is imposed upon the Commissioner. This question was considered in Allen v. Lowry, supra, and it was there held that the Commissioner "for any reason which he considers may be in the interest of the public or the parties" may delegate to the primary Examiner the duty of determining primarily whether an interference in fact exists, and that—"in so doing, he is not thereby depriving any party of any statutory right to have all questions passed upon at final hearing, and on appeals therefrom, which are necessary for a correct determination of the question of priority, which is the sole question for which interferences are declared."

To adopt the view of the appellee would reverse a practice which has prevailed in the Patent Office since the statute was enacted in 1870, and would in effect render the statute nugatory, since it would be a physical impossibility for the Commissioner personally to pass upon all these preliminary questions. He was given assistants for that purpose. Moreover, the Primary Examiner is skilled in the particular art, and, therefore, peculiarly qualified to pass upon a question involving the right of either party to make the claims of the issue. We think the demands of the statute fully met when it is provided that at some stage in the proceedings the personal opinion of the Commissioner may be invoked by either party.

It is next contended by the appellee that the judgment of the Primary Examiner was not a final judgment because, under the provisions of §§ 4909, 4910, and 4911, Revised Statutes, the applicant is entitled to a reconsideration and second rejection of his claims by the Primary Examiner. These sections read as follows:



“§ 4909. Every applicant for a patent or for 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 the fee for such appeal.

“§ 4910. If such party is dissatisfied with the decision of the Examiners-in-Chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person.

“§ 4911. If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting en banc.”

It will be necessary to examine §§ 4903 and 4904, Revised Statutes, in discussing the merits of this contention. These sections read as follows:

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

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

In *Allen v. Lowry*, supra, § 4909 was construed—“as though it read, 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, and every party to an interference may appeal from the decision of the Examiner in charge of interferences in such case, to the Board of Examiners-in-Chief. In other words, to abbreviate and make the sections more succinct, the words ‘may appeal from the decision’ were used but once, but we think that thereby clearness was sacrificed for brevity.”

This interpretation negatives the contention of appellee that the provision giving an applicant the right to have his claim twice rejected applies in inter partes cases. In an ex parte case arising under § 4903 the applicant in the first instance has no knowledge as to the references and reasons of the rejection of the Primary Examiner of his claim, and has no opportunity to be heard before action has been taken by that official. The notice of rejection contains his first information of what has taken place in the Patent Office. The statute, therefore, very properly provides in effect that upon the receipt of such notice the applicant may have an opportunity to meet the objections raised by the Primary Examiner. Under § 4904, however, it is made the duty of the Commissioner to give notice to parties thought to be in interference, and to "direct the Primary Examiner to proceed to determine the question of priority of invention." The statute, therefore, imposes upon the Commissioner the duty of notifying the parties prior to the first hearing before the Primary Examiner so that, when the hearing is had, both parties have a right to be present, and, in the event a motion for dissolution is made, the applicant affected has knowledge of the grounds for the motion and ample opportunity for hearing and argument. No more reason exists for a second hearing than exists for a second hearing in any other case between two parties litigant where due notice has been given and all the forms and requirements of the law have been complied with. The Commissioner in his opinion said:

"I am of the opinion that the proceedings in the Thomson application since the withdrawal of the appeal to the Examiners-in-Chief in the interference were contrary to the evident spirit of the rules, and that to sustain such proceedings would be in opposition to the requirements of good practice and to the interests of applicants generally. If parties can waive their rights of inter partes appeal in the interference and then proceed by ex parte appeals to try the same questions which they could have tried by the inter partes appeals, the provision of Rule 124, that appeals shall be heard inter partes is rendered ineffective. If the inter partes hearing upon appeal is to be escaped, the usefulness of motions for dissolution will be slight except in those cases where parties voluntarily take the inter partes appeal. Why should motions be brought or even permitted if decisions granting them can be set aside upon appeal without opportunity for the moving parties to be heard and presumably to a large extent without consideration of the arguments upon which the conclusions appealed from are based? It is no sufficient answer to say that if the decision of the Primary Examiner is reversed, the motion may be brought again when the interference is reinstated or



redeclared; if reinstated, a new motion brought and granted would presumably be followed by another *ex parte* appeal and another reversal of the decision. There would be no logical conclusion to such proceedings and to permit them would be absurd. The practice of permitting motions for dissolution to be brought is believed to be good. If appeals upon these motions are to be permitted, the prosecution thereof must be *inter partes* to save the whole proceedings upon the motion from becoming farcical. The rules at present do provide for appeals and it is not deemed expedient to change them in this respect at the present time."

We conclude, therefore, that the provisions relating to *ex parte* applications do not apply to *inter partes* actions, and that, when the appeal from the decision of the Primary Examiner was abandoned, his decision became final and binding upon the parties.

But, it is insisted, that *mandamus* is not the proper remedy. When the decision of the Primary Examiner that Thomson and Lemp had no right to make the claims in issue became final and *res adjudicata*, those parties were eliminated from the case, and appellant was entitled to go hence in the full and uninterrupted enjoyment of the patent. Under the statute the jurisdiction of the Commissioner attaches when he directs the declaration of an interference, and he still retains jurisdiction to award priority to the successful party after his adversary has been eliminated. It would indeed be an anomalous situation, if his determination that one party to an interference has no right to make the claims in issue, and, therefore, is not entitled to a judgment of priority, operates to deprive him of jurisdiction to award priority to the other party who has the right to make the claims in issue and who is entitled to an award of priority. The remedy of the defeated party is by way of appeal. He has no right whatever thereafter to prosecute the claims of the issue in an *ex parte* case. It follows, therefore, that when Thomson and Lemp abandoned their appeals from the decision of the Primary Examiner denying their right to make the claims in issue, that decision became final and *res adjudicata* as between the parties to the interference, and that thereafter the Commissioner was without authority to direct the Primary Examiner to readjudicate in Thomson's and Lemp's *ex parte* applications, the question whether they had the right to make the identical claims of the issue in the interference proceeding. If this remedy is denied it appellant will be again compelled to litigate with Thomson and Lemp in the Patent Office the same question which we have held has already been finally determined in its favor. All this will involve expense, delay and loss. The Commissioner, being without authority to direct a re-adjudication of the question involved in the former interference,

has no discretion in the premises, for—"whether the former decision was right or wrong, or was induced by the want of the particular evidence that was offered in the present case, is not the question. However that might be, it was final and put an end to the litigation in the first interference. *Blackford v. Wilder*, 28 App. D. C., 551."

It is no answer to the petition of appellant that the Commissioner deemed himself possessed of the authority he exercised, if no discretion in the premises was committed to him and he was in fact acting beyond his authority and without warrant of law. *Garfield v. U. S., ex rel. Frost*, 35 W. L. R. 771; 30 App. D. C.; *U. S., ex rel. Daly, v. Macfarland*, 28 App. D. C. 552.

*Seymour v. Brodie*, 10 App. D. C. 567, confidently relied upon by appellee to defeat appellant's right to the writ, is not in point. That case like this involved an interference between an application and unexpired patent, but in that case the decision dissolving the interference had been acquiesced in by the junior party, leaving the senior party in full possession and enjoyment of his patent. This court very naturally held that the patentee was not entitled to a writ of mandamus to compel the Commissioner of Patents to reinstate the interference proceeding because he had suffered no legal injury whatever and because he remained "in full possession of all his legal rights to the same extent as before he was summoned to defend those rights."

In the instant case a second attack not authorized by law has been instituted against appellant's patent, and necessarily has impaired that patent. There being no other adequate and speedy remedy, we think appellant entitled to the relief sought.

The judgment of the court below must be reversed with costs, and the cause remanded to that court with directions to issue the writ as prayed.

**393. SIMPLEX RAILWAY APPLIANCE CO. v. WANDS, 115 Fed. 517, 53 C. C. A. 171.**

Before Caldwell, Sanborn and Thayer, Circuit Judges.

Thayer, Circuit Judge, after stating the case as above, delivered the opinion of the court.

Counsel for the respective parties agree upon the following propositions, which are well established by authority, namely: That upon a bill of this character, filed under § 4918 of the Revised Statutes of the United States, the first question to be determined is whether the patents involved are interfering patents, since the right to relief is grounded on the fact of interference; that patents do not interfere, within the meaning of the patent law, unless the claims of the respective patents, or some of them,



cover the same mechanical device or combination; that it is the claim of a patent, and the claim only, when properly construed, which determines the thing patented; and that it may happen that the structure described in one patent will infringe the claims of another patent, although the patents are not interfering patents, within the meaning of the statute. *Gold & Silver Ore Separating Co. v. United States Disintegrating Ore Co.*, 6 Blatchf. 307, 10 Fed. Cas. 539 (No. 5,508); *Manufacturing Co. v. Craig* (C. C.) 49 Fed. 370, and cases there cited.

The important question in the case, and the one concerning which there is a real controversy, is whether a court can or ought to say, as a matter of law, on an inspection of the Marshall, Bauer, and Wands patents, that the claims of these patents, quoted above, do not cover the same invention, and that there is and can be no interference between the patents, although the bill of complaint contains an express averment to the contrary. The invention or combination covered by the claims is to be ascertained, as a matter of course, by a proper construction thereof, and it may be conceded to be the province of the court to construe the claims, giving to each its due scope and effect. But when the court enters upon the discharge of that duty it is not necessarily limited to the language of the claims and specifications, but may take into consideration certain extraneous facts. For example, it may have recourse to the testimony of experts to ascertain the meaning of technical words or phrases, if any such are employed, or to ascertain the difference between or the identity of the devices, or to obtain a better understanding of a drawing or model or the character and operations of the devices; and, generally, a court may avail itself of the testimony of experts to acquire a knowledge of all the facts pertaining to an art to which a given patent belongs, and a full understanding of the progress that had been made therein at the time the patent was issued. *Winans v. Railroad Co.*, 21 How. 88, 100, 101, 16 L. ed. 68. Such testimony frequently has an important influence upon the construction of the claims of a patent, either enlarging or restricting their scope. The adjudged cases afford many illustrations of the fact that proof of the state of the art has an important bearing upon the manner in which the doctrine of mechanical equivalents is applied, and also in determining to what extent, if any, limitations should be placed upon the mere wording of a claim. *McCormick v. Talcott*, 20 How. 402, 405, 15 L. ed. 930; *Machine Co. v. Lancaster*, 129 U. S. 263, 274, 9 Sup. Ct. 299, 32 L. ed. 715; *Miller v. Manufacturing Co.*, 151 U. S. 186, 187, 14 Sup. Ct. 310, 38 L. ed. 121; *National Hollow Brake Beam Co. v. Interchangeable Brake Beam Co.*, 45 C. C. A. 544, 561, 106 Fed. 693; *Railway Co. v. Godehard*, 19 U. S. App. 360, 400, 8 C. C. A.

265, 59 Fed. 776; *McClain v. Ortmyer*, 141 U. S. 419, 12 Sup. Ct. 76, 35 L. ed. 800; *Walk, Pat. (3d Ed.)* § 184.

Moreover, it is a well-known fact that proceedings taken in the patent office, while an application for a patent is under consideration, sometimes have much effect in determining the scope which shall be given to the claims of a patent. *Sutter v. Robinson*, 119 U. S. 530, 7 Sup. Ct. 376, 30 L. ed. 492; *Sargent v. Lock Co.*, 114 U. S. 63, 5 Sup. Ct. 1021, 29 L. ed. 67; *Brill v. Car Co.*, 33 C. C. A. 213, 90 Fed. 666. While it is true, therefore, that it is the function of the court to construe patents as well as all other written instruments, yet it can not be gainsaid that many facts dehors the patent, of which the court can not take judicial notice, may with great propriety be proven to enable it to reach a right conclusion. In the construction of any contract a court is generally entitled to be advised, by testimony, of the situation and the relation of the parties thereto when it was executed, to enable it to decide with more certainty what was the real purpose and intent of the agreement. It is sometimes said that a court should aim to place itself, as nearly as possible, in the situation which the parties to an agreement occupied when it was entered into, and, if this is so as respects the construction of ordinary written instruments, with much greater truth may it be said that, in construing the claims of a patent which deals with mechanical devices with which courts are often unfamiliar, they ought to be very sure, not only that they have a clear comprehension of the language and meaning of the claims and the operation of the patented device, but that they are well advised of the state of the particular art at the time the patent was granted. Evidence which throws any light on this subject ought not to be excluded when the scope to be given to the claims of a patent is the subject for consideration, except in those cases, which may sometimes arise, where the device is very simple and easily comprehended, and the art to which it relates is well understood, so that the introduction of evidence of the kind above indicated would be a work of supererogation. In most cases, therefore, the question whether patents interfere or contain interfering claims is a mixed question of law and fact, because the parties have the right to introduce testimony to enable the court to correctly determine what mechanical device or contrivance is in fact comprehended by the claims, and what are the legal rights thereby granted. \* \* \*

The lower court held that claim 1 of Wands' patent does not conflict with claims 1 and 2 of the Marshall patent, because Marshall expressly limits himself to a flat tension member, which passes, as it nears the ends of the compression member, between the flanges of the latter member, which is made of channel iron,



while Wands does not thus limit his claim. But, if we look carefully at Wands' specification and drawings, it will be seen that his head block has, on the underside, a depression or channel along which the tension member passes, and that this groove or channel holds the tension member in place precisely as the flanges of the compression member hold it in the Marshall structure. Now, it may well be that the state of the art to which this patent appertains, when fully developed, will prove to be such that Wands must be limited to the precise construction indicated in his specifications and drawings, notwithstanding the broad language of his claim, especially as his claim contains the words "substantially as described." And in that event the further inquiry would be pertinent, whether the two combinations claimed and patented, the one by Marshall and the other by Wands, are not substantially the same. It is manifest that Wands, in constructing his car bolster, has merely cut off a section of the compression member and inverted it, and termed it a head block, making a channel for the tension member on the bottom of the head block, instead of utilizing the flanges of the compression member for such a channel.

\* \* \* \* \*

The result is that if Wands' head block, in view of the state of the art and the functions which it performs, be regarded as the mechanical equivalent of Bauer's "strengthening piece," the two claims now under consideration cover substantially the same combination, and hence interfere.

We would not be understood, however, as expressing a definite opinion upon the question whether the claims of the patents in question do in fact interfere. That is a question which does not arise, necessarily, on this appeal, because the case passed off on a demurrer to the bill which expressly alleged interference. Its contention in the court is that by sustaining the demurrer and denying its right to introduce evidence as respects the state of the art and other facts which it deemed material to a correct construction of the claims of the patents the trial court erred. For reasons which have been sufficiently indicated by what has already been said, we feel constrained to concur in that view. The case, in our judgment, does not belong to the class of cases where, notwithstanding an express allegation that certain claims of patents interfere, a trial court can say, on an inspection of the patents, that it is impossible to sustain the allegation by any evidence which can be adduced, and unless such was the case the demurrer should have been overruled. The averment that certain claims of Wands' patent cover substantially the same inventions previously patented to Marshall and Bauer was a statement of an ultimate conclusion of fact, such as is permis-

sible in good pleading, and in the present instance the complainant was entitled to substantiate the charge, if it could, by other evidence besides the patents of which it made profert.

The decree below, dismissing the bill of complaint, is accordingly reversed, and the cause is remanded to the circuit court, with directions to overrule the demurrer to the bill.

[The following under this heading are brief extracts to complete the discussion.] :

**394. ELECTRIC, ETC., CO. v. CARBORUNDUM CO.,** 102 Fed. 618, 42 C. C. A. 537.

No alleged interference, on the merits of which the patent office finally passed and to which the Messrs. Cowles were parties, was declared until after the issuing of the process patent in suit, and can not of itself control the scope, construction or validity of the claims in question. 2 Rob. Pat., § 588. These interference proceedings can at most only serve to disclose the understanding of the patent office and of the parties to such interference at the time as to the validity and scope of those claims. They are not conclusive in any sense upon the rights of the appellant.

**395. LOOM CO. v. HIGGINS,** 105 U. S. 580, 26 L. ed. 1177.

An invention relating to machinery may be exhibited either in a drawing or in a model, so as to lay the foundation of a claim to priority, if it be sufficiently plain to enable those skilled in the art to understand it.

**396. ASHTON VALVE CO. v. COALE, ETC., VALVE CO.,** 52 Fed. 314, 3 C. C. A. 98.

The defendant's patent having been issued before that of the complainant, upon an application filed in advance of the latter's application, the burden of proof is upon the complainant to establish a prior use of the machine by a preponderance of testimony over that of defendant to the contrary.

**397. WHITELEY v. SWAYNE,** 74 U. S. 685, 19 L. ed. 199.

He is the first inventor and entitled to the patent, who, being an original discoverer, has first perfected and adapted the invention to actual use.

**398. TELEPHONE CASES.** 126 U. S. 1, 31 L. ed. 863, 8 Sup. Ct. 778.

We do not doubt that Drawbaugh may have conceived the idea that speech could be transmitted to a distance by means of



electricity and that he was experimenting upon that subject; but to hold that he had discovered the art of doing it before Bell did would be to construe testimony without regard to "the ordinary laws that govern human conduct."

399. *ECAUBERT v. APPLETON*, 67 Fed. 917, 15 C. C. A. 73.

Ecaubert having thus abandoned any attempt to make his idea practically available and to develop his theory, in fact, Hofmann conceived the idea, embodied it in means by which it could be carried out, proceeded to make watch centers, and thereby first perfected it, and is entitled to be recognized as the real inventor.

400. *STANDARD CARTRIDGE CO. v. PETERS CARTRIDGE CO.*, 77 Fed. 630, 23 C. C. A. 367.

[For an elaborate illustration see this case, which states that a subsequent reducer to practice who derives his knowledge from a prior inventor cannot take advantage of the fact that the prior inventor failed to push his invention to completion or file an application at an earlier date.]

401. *HILL v. WOOSTER*, 132 U. S. 693, 33 L. ed. 502, 10 Sup. Ct. 228.

The provision of § 4915 is that the circuit court may adjudge that the applicant "is entitled according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear;" and that, if the adjudication is in favor of the right of the applicant, it shall authorize the commissioner to issue the patent. It necessarily follows that no adjudication can be made in favor of the applicant, unless the alleged invention for which a patent is sought is a patentable invention. The litigation between the parties on this bill can not be concluded by solely determining an issue as to which of them in fact, first made a cabinet creamery. A determination of that issue alone, in favor of the applicant, carrying with it, as it does, authority to the commissioner to issue a patent to him for the claims in interference, would necessarily give the sanction of the court to the patentability of the invention involved.

*Ex 604*  
12/22/23