

ANNOTATED

RULES OF PRACTICE

IN THE

UNITED STATES PATENT OFFICE

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PREFACE

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

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

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

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

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

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

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

E. J. STODDARD.

May 1, 1920.

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

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

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

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

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

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

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ANNOTATED RULES OF PRACTICE IN THE UNITED STATES PATENT OFFICE

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

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

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

THOMAS EWING,
Commissioner of Patents.

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

PAPERS PREPARED BY THE EXAMINING CORPS.

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

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

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

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

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

REPORT OF THE COMMISSIONER OF PATENTS FOR 1916.

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

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

HISTORY.

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

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

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

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

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

Lowery's Annotated Interference Rules.

1907 Note as to Changes in Rules.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Twelfth revised edition, July 1, 1891, under which Rules 17, 51, 52, 33, 84, and 218 were amended, and Form 36 changed.

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

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

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

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

| No. in edition of April 1, 1892 | No. in edition of June 18, 1897 | No. in edition of April 1, 1892 | No. in edition of June 18, 1897 | No. in edition of April 1, 1892 | No. in edition of June 18, 1897 |
|---------------------------------|---------------------------------|---------------------------------|---------------------------------|---------------------------------|---------------------------------|
| 195 | 181 | 206 | 192 | 217 | 203 |
| 196 | 182 | 207 | 193 | 218 | 204 |
| 197 | 183 | 208 | 194 | 219 | 205 |
| 198 | 184 | 209 | 195 | 220 | 206 |
| 199 | 185 | 210 | 196 | 221 | 207 |
| 200 | 186 | 211 | 197 | 222 | 208 |
| 201 | 187 | 212 | 198 | 224 | 209 |
| 202 | 188 | 213 | 199 | 225 | 210 |
| 203 | 189 | 214 | 200 | 226 | 211 |
| 204 | 190 | 215 | 201 | 227 | 212 |
| 205 | 191 | 216 | 202 | 229 | 213 |

Fifteenth revised edition, June 18, 1897 (second edition, December 1, 1897), contains an appendix with amendments to Rules 24 (first paragraph), 29, 31 (last paragraph), 39 (section 1), 46 (first paragraph), 63 (second paragraph), 75, 77 (first and second paragraphs), 94, 166, 168, 171 (first paragraph), and 198.

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

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

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

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

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

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

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

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

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

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

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

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

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

Lowery's Annotated Interference Rules.

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

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

CONSTRUCTIONS.

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

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

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

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

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

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

Pender, 123 O. G. 2975.

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

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

Change of practice not retroactive.

Naef, 115 O. G. 2135.

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

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

Murray, 111 O. G. 2491.

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

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

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

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

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

Balzer, 101 O. G. 2824.

The following case relates to this subject:

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

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

Farquhar, 89 O. G. 706; Hawkes, 69 O. C. D. 37. See, however, the case of Stone v. Greaves, 1380 C. D. 70.

The action of the German Patent Office considered.

Bedford et al. v. Duell, Com., 1599 C. D. 357, 87 O. G. 1611.

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

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

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

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

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

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

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

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

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

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

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

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

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

U. S. v. Marble Com., etc., 22 O. G. 1365; Dec. of Sec.

Ex parte Pfandler, 23 O. G. 629.

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

Smoot, 1877 C. D. 51.

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

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

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

Cases passing on the subject matter of this rule.

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

Appeal to Secretary of the Interior.

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

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

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

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

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

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

None from refusal to admit amended preliminary statement.

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

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

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

Citing this rule.

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

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

CORRESPONDENCE AND INTERVIEWS.

Rule 1. Business to be Transacted in Writing.

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

CONSTRUCTIONS.

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

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

Postal Authorities are not agents of the Patent Office.

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

P. O. agent of applicant.

O'Brien, 181 O. G. 1073.

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

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

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

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

Rule 3. All Charges to be Prepaid.

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

Rule 4. Personal Attendance of Applicants Unnecessary.

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

Rule 5. Correspondence with Assignees.

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

CONSTRUCTIONS.

See Rules 6, 26, 183.

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

Hill and Hill, 206 O. G. 1437.

The Patent Office will not consider disputes.

Patridge, 183 O. G. 781.

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

Newman, 183 O. G. 220.

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

Steinfeld, 138 O. G. 527.

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

Adams, 129 O. G. 1612.

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

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

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

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

Cummings, 114 O. G. 2090.

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

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

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

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

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

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

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

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

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

Ackerman, 1880 C. D. 131.

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

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

Cases passing on the subject-matter of this rule.

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

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

Rule 6. Correspondence with Inventor and Assignee.

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

CONSTRUCTIONS.

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

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

Dudley, 187 O. G. 829.

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

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

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

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

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

Fitzhugh, 120 O. G. 660.

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

Sandstrom, 113 O. G. 850.

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

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

Affidavits alone not sufficient to establish the fact of assignment.

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

A licensee is not entitled to access to papers.

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

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

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

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

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

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

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

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

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

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

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

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

Hunter, 1891 C. D. 122.

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

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

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

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

The commissioner has no equitable jurisdiction over the

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

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

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

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

See Graham, 112 O. G. 1752.

See note to Rule 26.

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

See note to Rule 20.

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

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

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

Rule 7. Correspondence with Attorney.

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

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

CONSTRUCTIONS.

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

Order No. 2047, April 30, 1913.

Where perpetual motion is involved.

Notice of January 30, 1918.

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

Eggan, 172 O. G. 1091.

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

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

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

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

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

Double correspondence with principal and associate attorneys not allowed.

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

Rule 8. Separate Letters.

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

Papers sent in violation of this rule will be returned.

Rule 9. Letters Relating to Applications.

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

CONSTRUCTIONS.

Applies to oaths. They should properly identify the application.

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

Rule 10. Letters Relating to Patents.

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

Rule 11. Protests.

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

CONSTRUCTIONS.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

See Wilder, 128 O. G. 455.

Rule 12. Mail.

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

Special-delivery letters and other papers may be

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

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

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

Rule 13. Interviews with Examiners.

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

INFORMATION TO CORRESPONDENTS.

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

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

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

Examiners' digests are not open to public inspection.

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

Rule 15. Pending Applications Kept in Secrecy.

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

CONSTRUCTIONS.

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

Amendment, 247 O. G. 249.

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

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

Since the prior application is a part of the office records

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

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

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

Deeré v. Mariser Co., 176 O. G. 273.

Rule not inconsistent with Rule 43.

Summers, 160 O. G. 1039.

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

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

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

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

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

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

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

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

Kellogg, 120 O. G. 2754.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Patterson, 109 O. G. 1070.

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

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

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

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

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

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

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

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

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

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

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

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

Copies of papers furnished equitable owners in an interference proceeding.

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

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

Stockton, 1897 C. D. 24.

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

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

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

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

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

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

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

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

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

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

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

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

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

Rule 16. Records and Copies in Patented Cases.

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

See notes to Rule 179.

ATTORNEYS.

Rule 17. Register of Attorneys.

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

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

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

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

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

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

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

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

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

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

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

CONSTRUCTIONS.

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

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

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

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

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

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

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

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

Bloch, 128 O. G. 457.

Inadvertence of attorney may be remedied by reissue.

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

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

Negligence of the attorney is negligence of the principle.

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

The assignment must definitely identify the application.

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

The power of attorney given by the assignees ($\frac{1}{2}$ interest) may be recognized as giving the attorneys the right to inspect

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

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

Attorneys have power to make proper amendments to the drawing.

Wilcox, 101 O. G. 1829.

May not sign a drawing in addition to inventor.

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

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

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

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

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

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

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

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

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

Attorneys, original and substitute, have liens on papers.

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

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

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

May not eliminate an essential feature of the invention.

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

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

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

May sometimes sign petition.

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

Rule 18. Power of Attorney.

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

CONSTRUCTIONS.

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

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

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

Rogers, 125 O. G. 2766.

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

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

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

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

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

Reim, 103 O. G. 2173.

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

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

Papers signed *nunc pro tunc*.

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

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

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

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

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

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

Rule 19. Substitution and Association.

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

CONSTRUCTIONS.

No appeal from the Commissioner refusing to ignore an assignment.

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

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

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

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

Rule 19 seems specific on this subject.

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

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

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

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

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

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

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

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

Rule 20. Revocation.

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

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

CONSTRUCTIONS.

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

Rosell, 197 O. G. 535.

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

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

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

Stanford, 138 O. G. 527.

A collateral attack on validity of rule not considered.

Adams, 129 O. G. 1612.

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

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

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

Wick, 117 O. G. 902.

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

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

Death of inventor revokes power of attorney.

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

An equitable assignee of the entire interest refused recognition.

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

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

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

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

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

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

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

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

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

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

Death of an inventor revokes power of attorney.

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

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

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

Cases passing on the subject matter.

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

Rule 21. Attorneys' Room.

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

Rule 22. Decorum and Courtesy in Business.

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

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

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

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

CONSTRUCTIONS.

Rev. Stat., sec. 487.

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

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

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

205 O. G. 308.

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

Eggan, 172 O. G. 1091.

Complaint ordered expunged from petition and brief.

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

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

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

An elaborate discussion of misconduct of attorneys.

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

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

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

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

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

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

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

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

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

Chambers, 1873 C. D. 56.

Rule 23. Services of Senators or Representatives.

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

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

APPLICANTS.

Rule 24. Who is Entitled to a Patent.

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

CONSTRUCTIONS.

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

Rev. Stat., secs. 4886, 4887.

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

Lambert, 119 O. G. 1925.

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

Knothe, 102 O. G. 1294.

Process, lacking in novelty.

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

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

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

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

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

Bar of public use not avoided by caveat.

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

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

Floyd, 1874 C. D. 104.

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

Stone, 1873 C. D. 105.

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

Campbell, 1872 C. D. 228.

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

Sellers, 1872 C. D. 197.

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

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

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

Cottrell, 1872 C. D. 93.

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

Wattles, 1873 C. D. 50.

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

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

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

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

Weinberg, 1871 C. D. 244.

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

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

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

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

Rule 25. Executors and Administrators.

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

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

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

CONSTRUCTIONS.

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

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

Niedenführ, 130 O. G. 981.

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

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

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

Niedenführ, 130 O. G. 981.

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

Rogers, 125 O. G. 2766.

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

Pilgrim Paper Company, 125 O. G. 993.

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

Wurtz, 123 O. G. 320.

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

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

Jones, 103 O. G. 228.

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

Lewis, 93 O. G. 1311.

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

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

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

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

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

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

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

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

Cases passing on the subject matter of this rule.

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

Rule 26. Patents to Assignees.

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

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

CONSTRUCTIONS.

See Rules 5, 6 and 183.

Rev. Stat., sec. 4895.

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

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

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

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

Ryle, 193 O. G. 753.

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

Dudley, 187 O. G. 831.

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

Hubert, 171 O. G. 745.

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

Hubert, 171 O. G. 745.

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

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

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

Stanford, 138 O. G. 527.

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

second application and rejected the first application on said patent.

Affirmed by Court of Appeals.

In re Pearsall, 135 O. G. 221.

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

Pilgrim Paper Company, 125 O. G. 994.

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

McCormick, 116 O. G. 1183.

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

Rowand, 114 O. G. 2091.

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

Hertford, 113 O. G. 851.

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

Graham, 112 O. G. 1752.

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

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

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

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

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

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

Questions under this rule to be determined by record exclu-

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

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

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

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

McTammany, 93 O. G. 751.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Rule 27. Inventor Believing Himself to be First Inventor.

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

Rev. Stat., sec. 4923.

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

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

Rule 28. Joint Inventors.

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

CONSTRUCTIONS.

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

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

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

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

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

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

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

Barrett and Aller, 127 O. G. 847.

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

Barrett and Alter, 127 O. G. 847.

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

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

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

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

Illustration of what are joint inventors.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Rule 29. Foreign Patents.

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

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

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

Rev. Stat., sec. 4887.

CONSTRUCTIONS.

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

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

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

Hayes, 209 O. G. 1317.

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

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

A certified copy of original application necessary under the convention.

Barthels, 179 O. G. 574.

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

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

Statute is not retroactive.

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

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

Kauermann, 157 O. G. 207.

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

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

First day excluded in computing the 12 months.

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

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

McElray, 140 O. G. 1207.

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

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

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

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

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

Meier, 136 O. G. 657.

The Commissioner has no authority to extend the time.

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

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

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

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

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

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

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

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

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

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

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

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

But it does not relieve against abandonment.

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

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

Klingelfuss, 104 O. G. 2149.

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

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

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

In re Swinburne, 99 O. G. 1625.

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

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

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

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

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

Unsworth, 1879 C. D. 69.

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

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

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

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

Relates to matter claimed, only in the foreign application.

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

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

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

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

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

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

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

*THE APPLICATION.***Rule 30. Requisites of Application.**

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

Rev. Stat., secs. 4888 to 4892.

CONSTRUCTIONS.

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

(1) Date of Filing.

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

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

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

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

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

Mygatt, 160 O. G. 773.

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

Pruse, 157 O. G. 208.

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

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

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

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

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

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

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

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

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

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

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

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

Order, 120 O. G. 1001.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Kozminski, 103 O. G. 92.

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

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

All ink to be subjected to a chemical test.

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

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

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

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

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

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

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

(2) *Process.*

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

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

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

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

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

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

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

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

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

An application is a reduction to practice, if allowable.

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

Oath must identify the applications to which it relates.

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

An application is a constructive reduction to practice.

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

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

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

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

Sworn to in blank.

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

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

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

The application is not reduction to practice.

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

(4) *Additional Cases.*

Cases passing on the subject matter of this rule.

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

Rule 31. Incomplete Application not Filed.

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

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

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

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

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

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

CONSTRUCTIONS.

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

Kurz, 119 O. G. 961.

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

Force v. Sawyer-Boss Mfg. Co. et al., 111 F. R. 902.

Siemens Halske Electric Co. v. Duncan Electric Mfg. Co. et al., 142 F. R. 157.

Mathews Gravity Carrier Co. v. Lister et al., 154 F. R. 490.

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

Shaver, 131 O. G. 2422.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

The Petition.

Rule 33. Petition.

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

Rev. Stat., sec. 4888.

CONSTRUCTIONS.

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

Official Notice, 225 O. G. 375.

SPECIFICATION.

Rule 34. Written Description.

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

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

Rev. Stat., sec. 4888.

CONSTRUCTIONS.

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

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

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

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

The suggestion of equivalents used in construing the claims.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Williams, 183 O. G. 503-4.

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

Electric Co., 182 F. R. 998.

Purely laudatory statements have no place in a specification.

Gregg, 181 O. G. 266.

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

Jennings, 178 O. G. 1151.

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

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

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

Ellis, 167 O. G. 982.

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

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

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

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

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

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

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

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

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

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

White, 136 O. G. 1771.

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

White, 134 O. G. 2027.

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

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

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

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

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

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

Sassin, 122 O. G. 2064.

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

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

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

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

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

Sjungstrom, 119 O. G. 2235.

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

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

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

Welch, 115 O. G. 1850.

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

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

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

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

Theoretical discussion suitable for an advertising circular should be excluded.

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

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

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

Lewis & Unger, 106 O. G. 543.

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

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

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

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

Private identifying mark must be removed from the specification.

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

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

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

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

Blackman, 98 O. G. 791.

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

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

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

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

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

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

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

95 O. G. 1054.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

The word apparatus is static, machine dynamic.

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

Modifications should be illustrated and described.

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

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

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

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

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

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

Schoonmaker, 1878 C. D. 40, 13 O. G. 595.

The drawing model and specification should correspond.

Schoonmaker, 1878 C. D. 40, 13 O. G. 595.

"In a reissue patent, as compared with the original, there is not the same reason for indulgence in the use of vague language, because the reissue is taken after the working of the machine may be supposed to be understood, and broad claims are inserted for the very purpose of being construed broadly."

Hatch v. Moffitt, 15 F. R. 252.

It is unnecessary to specifically describe a process, well known to those skilled in the art, that is used in the embodiment of an applicant's invention.

Floyd, 1874 C. D. 104, 6 O. G. 451.

A reference to a caveat concerns the history and not the description of an invention and is not therefore admissible in a specification.

Chubb, 1872 C. D. 224, 2 O. G. 519.

In applications for patents the Examiner should interfere as little as possible with the language chosen by the applicant in describing his invention.

In applications for reissues the applicant should be held rigidly to the language adopted in his patent. The rule should be liberality with original applications; strict construction with applications for reissues.

Underwood, 18782 C. D. 118, 1 O. G. 549.

A discussion of the merits, or demerits, of other patents, or inventions, in the body of the specification is improper.

Williams, 1872 C. D. 46, 1 O. G. 225.

Rule 35. Detailed Description.

The specification must set forth the precise invention for which a patent is solicited, and explain the

principle thereof, and the best mode in which the applicant has contemplated applying that principle, in such manner as to distinguish it from other inventions.

Rev. Stat., sec. 4888.
See notes to Rule 34.

Rule 36. Improvements.

In case of a mere improvement, the specification must particularly point out the parts to which the improvement relates, and must by explicit language distinguish between what is old and what is claimed as new; and the description and the drawings, as well as the claims, should be confined to the specific improvement and such parts as necessarily cooperate with it.

See notes to Rule 34.

Rule 37. Claims.

The specification must conclude with a specific and distinct claim or claims of the part, improvement, or combination which the applicant regards as his invention or discovery.

R. S. 4888.

HISTORY.

The character and facilities of the courts should make their decisions particularly enlightening on subjects relating to use of the English language. I have, for this reason and because of the importance of the subject, digested some of the recent Federal cases. Of course, this is not intended to take the place of the Text Books and General Digests.

Papers read before the Examining Corp of the U. S. Patent Office are:

History and Purpose of Claims in U. S. Patent Law, by
N. J. Brumbaugh, Feb. 11, 1915.

Multiplicity of Claims, by Wm. R. Pratt, Nov. 16, 1916.

CONSTRUCTIONS.

- (1) IN GENERAL.
- (2) PROCEDURE.
- (3) WORDS AND PHRASES.
- (4) FORM OF CLAIM.
- (5) CONSTRUCTION OF CLAIM.
- (6) REFERENCE TO THE SPECIFICATION.
- (7) GENERIC AND SPECIFIC.
- (8) COMBINATION.
- (9) ELEMENTS.
- (10) REFERENCE LETTERS.
- (11) MULTIPLICITY OF CLAIMS.
- (12) MEANS, MECHANISM, ETC.
- (13) PROCESS—FUNCTION OF A MACHINE.
- (14) DIFFERENCE IN CLAIMS.
- (15) INDEFINITENESS, VAGUENESS.
- (16) ALTERNATIVE—MODIFICATIONS—EQUIVALENTS.
- (17) ARTICLES OF MANUFACTURE.
- (18) PROCESS—SUB-PROCESS.
- (19) PRINTED MATTER.
- (20) INTRODUCTORY CLAUSE.
- (21) EXPRESSION OF DEGREE IN CLAIMS.
- (22) PROCESS, PROCESS AND ARTICLE CLAIMS.
- (23) POSITIVE INCLUSION OF ELEMENTS OF CLAIMS.
- (24) READING WORDS, ETC., INTO.
- (25) "WHEREBY" CLAUSE IN CLAIMS AND OPERATIVE ENVIRONMENT.
- (26) CONCLUDING CLAUSE IN CLAIM.
- (27) ANALYSIS OF CLAIMS.

(1) *In General.*

Claims. A definition can not be given except after the most perfect conception of the subject of the definition. The truth is, no word can be truly defined until the exact idea is clearly understood in *all its relations* which the word is designed to represent.

Quoted from Matthews' "Words, Their Use and Abuse,"
by Andrews' American Law, p. 96.

Remark by U. S. Supreme Court. The use of ill-defined abstract phraseology is the frequent source of error. It requires no great ingenuity to mystify a subject by the use of abstract terms of indefinite or equivocal meaning.

Boyden Power-Brake Co. v. Westinghouse, 170 U. S. 537.

It appears to me clear that the crying abuse of superfluous and obscure claims is due to the failure on the part of both

the Examiners and the attorneys to see to it that each claim has a definite point in view, is concise, and that the claims of a set are self-distinguishing and self-classifying. It is quite possible that the profession has made a fetish of form.

Completeness of wording is very different from completeness of sense.

Assistant Com. Clay *ex parte* Brown, 235 O. G. 1335.

Previous to the Patent Act of 1836, which established a Board or Bureau composed of competent examiners, patents had frequently been adjudged invalid from the insufficiency of the specification. Few inventors, or even learned lawyers, were capable of correcting and clearly setting forth in a specification the proper limits of the just claim of the invention.

Burr v. Duryee, 1 Wall. 175.

These "separately are termed" subordinate integers of the combination, referring to the elements of a combination.

Roberts' British Patents.

"The meticulous American claim."

British Comptroller of Patents.

To define a new thing accurately so that it may all be embraced within the description, but nothing included which is not essential, is an art of itself, and as Justice Brown indicated, a difficult art, one requiring long and careful training and in the practice of which oversights and mistakes of judgment are bound to occur.

Com. Ewing in *Litle Jr. v. Armstrong*, 232 O. G. 935.

As stated by the court (*Morgan*, 179 O. G. 242), certain devices are common to all arts as a whole because they are adapted for use in many situations.

Fisher, 229 O. G. 1255.

The claims are therefore rejected on the ground that they are broader than applicant's conception and are presented for the purpose of covering something different from the essential elements of his idea of means, the production of which, moreover, has involved inventive work of a very high order.

Foutts, 227 O. G. 741; see *United Wireless Tel. Co. v.*

National Elec. Signally Co., 198 F. R. 386.

It is not the legitimate office of a patent claim to state merely a mechanical problem or function. It must also clearly indicate the mechanical means for its solution or accomplishment.

Union Special Mach. Co. v. Singer Mfg. Co., 215 F. R. 598-602.

Each claim should be directed at some function, step, or

advantage to give it individuality; it should have a characterizing thought or point by which it can be identified; and if the court which is to construe the claim can find this dominant thought, its task will be simplified.

Denison, J., in *Scaife & Sons Co. v. Falls City Woolen Mills*, 209 F. R. 210-213.

It has always been the policy of the Office to allow some latitude to applicants in drawing their claims—provided, of course, the claims are clear of the prior art and are clear in their meaning.

Pease, 202 O. G. 631.

The patent statutes require the patentee himself to claim and define his invention, so that the public may know its rights, and so that there shall not be imposed upon the courts the burden of constructing upon a hearing new claims from the interpretation that experts may place upon language of the most sweeping and general character. Quoted from the Bell Tel. cases in

United Wireless Telegraph Co. v. National E. S. Co., 198 Fed. R. 395.

There is only one claim in the English patent. But that claim, under the English patent system, entitled the patentees to their entire invention, and is at least as broad and comprehensive as all four claims of the American patent.

Commercial Acetylene Co. v. Searchlight Gas Co., 197 F. R. 912.

See remarks as to assignment of error in

Lord Baltimore Press., Inc., v. Labombarde, 197 Fed. R. 739.

A pipe with an outer coating composed of an inner layer of copper and an outer layer of zinc. It was urged that the copper being electrically deposited was superior to the article. Cited as a reference.

This did not appear in the claims, however, unless by saying that the outer coating was of uniform density, purity and thickness, and this was alleged of the reference and the court would not reverse the experts of the Office.

Hodkinson, 182 O. G. 251.

The fact, however, that the defendant's device may be within the language of the claim does not of itself prove that it is an infringement. Infringement is not a mere matter of words. Authorities cited and commented upon.

General Electric Co. v. Allis-Chalmers Co., 171 F. 669.

See this case in Court of Appeals, 178 F. 273. See *Curtain Supply Co. v. National Lock Washer Co.*, 178

F. R. 95. These claims were, however, drawn to cover claims in a patent.

I am inclined to think he did discover them, without himself knowing it, but that he never fully understood or claimed them, and that his discovery has become public property.

General Const. Co. v. Nelther, 167 F. R. 554.

A claim may be so prolix as not to comply with the requirement of the statute.

Lagan, 162 O. G. 538.

By an ingenious and acute process of analysis nearly everything may be resolved into elements which are old.

Electric Candy Machine Co. v. Morris, 156 F. R. 976.

The purpose of this requirement is not only to secure to the inventor the benefit of his invention, but also that the public may know what they are prevented from doing during the existence of the monopoly. (Brooks v. Fiske, 15 How. 211, 214; O'Reilly v. Morse, 15 How. 62-119.)

In re Gardner, 140 O. G. 258.

The courts recognizing the fact that the ordinary inventor is not usually skilled in technical rules of construction and is apt to suppose that his claims protect him in the essential elements mentioned in them and that these claims and specifications are usually drawn by men who are strangers to and ignorant of the art within which they lie, and that even skilled solicitors are not infallible in framing technical documents, have sanctioned reissues which permit the framing of claims adequate to secure the full benefits of the inventions designed to be protected by the patent laws.

Crown Cork & Seal Co. v. Aluminum Stopper Co., 96 O. G. 2573.

The fact that in its progress through the Patent Office the specification and claims of the patent in suit were made more clear and accurate so as to express the patentee's actual invention, affords no reason for casting doubt upon the validity of the patent.

Pullman Co. v. Boston & Albany, 90 C. D. 533.

Uniformity is necessary to the proper conduct of the affairs of the Patent Office.

Buffalo-Pitts Co., 89 O. G. 2069.

(2) Procedure.

The Examiner should not attempt to compel the applicant to insert elements in his claim which he does not desire to have there.

Compos, 182 O. G. 719.

The complainant having canceled all his original claims is now estopped to claim the benefit of them, or such a construction of his present claim as would be equivalent thereto.

Langan v. Warren Axe & Tool Co., 181 F. R. 146.

The fact that a new claim was inserted in the application by the attorney without any new oath does not render the patent invalid as to such claim where it was within the invention described in the specification.

Cutler-Hammer Mfg. Co. v. Union Electric Mfg. Co., 147 F. R. 266.

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

Mr. Farland v. Walson and Walson, 146 O. G. 257.

Had the applicant insisted that he was the first to apply this device as an aid to the starter, he would no doubt have secured the allowance of his claim as first made, without any restriction as to manner of pivoting nor as to location of gate, whether between, ahead of, or behind the supports. But he elected to make the change and must abide the consequence.

Ryan v. Metropolitan Jockey Club, 139 F. R. 579.

Where an applicant before the Patent Office acquiesces in the ruling that his claim is not patentable without amendment, he can not be heard to question whether it is right or wrong.

Computing Scale Co. of America v. The Automatic Scale Co., 1905 C. D. 704, 119 O. G. 1586.

The proceedings in this office leading to the grant of a patent are regarded by the courts as having an important bearing upon the validity and scope of the claims. (Shepard v. Corrigan, 1886 C. D. 116, 34 O. G. 1157; 116 U. S. 593; McCormack v. Graham, 129 U. S. 1; Roemer v. Peddie, 1889 C. D. 682, 49 O. G. 2151, 132 U. S. 313.)

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

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

Lewis & Auger, 1903 C. D. 303, 106 O. G. 543.

The Office should not permit claims of doubtful propriety, even if the courts have saved the validity of patents having such claims by a forced construction.

McLellan, 1872 C. D. 152; Simonds, 1870 C. D. 22.

Cornell, 1872 C. D. 120, 1 O. G. 573; Shepler, 1903 C. D. 17, 102 O. G. 468.

The action of one Examiner should be at least extremely persuasive upon his successor.

Ealin, 1897 C. D. 174.

Applicant should present his whole case at one time by both broad and narrow claims.

Miller, 1900 C. D. 65, 91 O. G. 1034.

An applicant should present his whole case at one time by both broad and narrow claims.

Snow, 1897 C. D. 48, 80 O. G. 1271.

If the claims granted are inconsistent with former expressions of the Office and admissions of the patentee, the logical inference is that further examination led to a change of views.

Sugar Apparatus Manufacturing Co. v. Garyon Mfg. Co., 53 O. G. 920.

The Patent Office, in cases where the prior art admits of such a course, should grant to the applicant a claim or claims which will enable him to cover his invention, even when an infringer interchanges or reverses some of the elements.

Tobie, 1890 C. D. 28, 50 O. G. 992.

Cancellation of the claims is an abandonment of the application.

Lascell, 1884 C. D. 42, 28 O. G. 1274. This is not free from doubt.

Lascell, 1884 C. D. 66, 29 O. G. 861.

No more than a single device, or combination, should form the subject of a single claim.

Bland, 1897 C. D. 40, 15 O. G. 828.

A claim for substantially a new method of doing business is not patentable.

Sheldon, 1878 C. D. 44, 13 O. G. 817.

I do not think it proper to say that the recognized practice of the Office discountenances any particular form of claim. The mere form itself is of little or no consequence; and it is impossible to decide that because the form is bad in one case, it will be bad in every other.

It is the uniform practice of the Office to discountenance in a particular case any form of claim which does not set forth clearly the nature of the invention, but leaves in uncertainty the thing which is to be patented.

Acting Com. Spear in Dahne, 1875 C. D. 66, 7 O. G. 1095. See also, Haasz, 1873 C. D. 170, 4 O. G. 610; The Collins Company, 1872 C. D. 251, 2 O. G. 617; Designolle, 1878 C. D. 10, 13 O. G. 227.

The Office has uniformly allowed some latitude to applicants in stating in different forms, claims for substantially the same invention:

Martin v. Boyle, Runyan & Patric, 1877 C. D. 106, 12 O. G. 625.

It is admissible, under proper restrictions, for parties to put their claims in different forms to prevent misconstruction of them by the public or by the courts.

Shippen, 1875 C. D. 126, 8 O. G. 727; Hahn, 1875 C. D. 107, 8 O. G. 597.

(3) *Words and Phrases.*

The words "closed or nearly closed" applied to a magnetic circuit is a claim.

Kuhlman Electric Co. v. General Elec. Co., 147 F. R. 709. See Dorsey, 1870 C. D. 17.

Means *between* certain pumps and their driving means. "Between" is not limited to a geometrical location, "the unforced meaning of the language used is that the compensating means accomplishes its effect in the action of the driving means upon the pumps."

Lemp v. Randall & Bates, 1906 C. D. 240, 123 O. G. 319.

A claim for "lumber partially saturated with sulfuric acid" objectionable, the words "partially saturated" being inapt.

Chapman, 1906 C. D. 79, 120 O. G. 2446.

"Outlet" is not objectionable in all cases as referring to something intangible.

Ljungstrom, 1905 C. D. 541, 119 O. G. 2235.

The terms of description used in the claims should accurately describe the construction disclosed in the application.

The word "keyed" does not accurately describe a washer upon a squared shaft.

Mueller & Braunsdorf, 1905 C. D. 336, 118 O. G. 5270.

A party will not be permitted to attempt to distinguish claims by the words "substantially as described" since they impart no definite limitations into the claims and since it is the duty of the Office to require that the limitations intended to be included in a claim be clearly and definitely stated therein.

Shepler, 1902 C. D. 17, 102 O. G. 468.

A hole is an intangible thing and may not be an element of a combination. There is no objection to describe the element as provided with a hold.

Davin, 1902 C. D. 251, 100 O. G. 453.

Under the court decisions the introductory phrase is not an element of the combination and does not limit the claim to such apparatus.

Casler, 1899 C. D. 5, 90 O. G. 446.

If the term binary substance has a fixed meaning in chemistry, indicating a chemical combination of two elements, and if it be true that no chemical combination takes place in the mixture, the term is objectional, if "binary compound" has such meaning "binary substance" will not be objectionable because of its similarity to binary compound.

Du Motay, 1879 C. D. 195, 16 O. G. 499.

(4) *Form of Claim.*

Claims 2 and 3, each of which comprises a reference to the preceding claim, with a statement of the structural features distinguishing it therefrom. Held to meet the requirements of the law, and in this case to clearly point out the invention.

Brown, 235 O. G. 1355.

The theory of the claim is that the ray of light which effects the sensitized paper is a recording medium projected against the strip. This is not accurate. The light is no part of applicant's record, it being only utilized to change the material of the strip.

Fritts, 227 O. G. 737. Illustrative example.

Of course, as is well known, an applicant for a patent will use varying phraseology in his claim in order to obtain as comprehensive a patent as possible or and by such use, to avoid the pitfalls of language, so that if later one claim is inaptly worded, some other claim will stand the test of attack.

Vacuum Cleaner Co. v. Am. Rotary Valve Co., 219 O. G. 587.

While the use of the term "for example" is somewhat misleading, we are of the opinion that the specification is ample to establish the fact that the patentee claimed specifically the device shown in the drawings and specification, i. e., a structure erected in the particular manner shown in the drawings, even though not described in terms in the specification, thus covering the advantages of reduced power and wide rotation.

Jones v. Evans, 215 F. R. 588. The device was claimed generally but was only new as applied to a greenhouse window.

When we say a thing is substantially the same, we mean it is the same in all important particulars. It must be of the same material, when the material is important; it must be of the same thickness, when thickness is important.

Valoma Marchiony Co. v. Perella, 207 F. R. 379.

The complainant advances the ingenious argument that the defendant's barrel is mounted upon the frame, because the

bolt carrier upon which it is actually mounted, is slidingly mounted on the frame. Disapproved.

Colts' Patent Firearms Mfg. Co. v. New York S. G. Co.,
190 F. R. 562.

It is asserted that there is error in the statement that complainant "is making claims which are broader than the use of any particular device, when he attempts to patent as a combination the use of the wickless burner and any increased supply of oil, whether supplied by old device or not." The authority referred to, *Expanded Metal Co. v. Bradford*, 214 W. S. 366, involved a process patent. The trial judge (168 F. 712) correctly characterized the claims.

Central Oil & Gas Stove Co. v. Silver & Co., 184 F. R. 457-8.

We think it may be affirmed as a rule resting upon the fundamental principles of patent law that, where the essence of the invention is the location, form, size, or any other characteristic of the means employed, the patentee must distinctly specify the peculiarities in which the invention is to be found.

American Lava Co. v. Steward, 155 F. R. 936; cites
Germer Stove Co. v. Art Stove Co., 150 F. R. 147;
Bullock Electric Co. v. General Electric Co., 149 F. R. 409.

This being a comparatively new art, and it not appearing that the term "wheel" as applied to it has obtained a fixed and definite meaning, we see no reason why each series of units is not entitled to be called a wheel in construing the claims of the issue.

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

The word "then" introducing a clause in a process claim construed.

Kahn v. Starrells, 131 F. R. 464.

"A pounder attached to the arm of said lever which projects laterally within the tub from its pivotal support." No pivotal support is previously recited in the claim. If the pivotal support is to be referred to in locating the parts, it should be made a positive element of the claim.

Dodge, 1906 C. D. 439, 125 O. G. 665.

Patentability of claims can not properly be predicated on alleged differences of construction which are not specified therein.

McNeil and Sturtevant, 1906 C. D. 383, 124 O. G. 2177.

The claims to the mechanism are not proper to define, a novel arrangement of the work in connection with such mechanism.

McNeil & Sturtevant, 1906 C. D. 383, 124 O. G. 2177.

The claims should distinguish the invention by words and not require construction to this end.

Cutler, 1906 C. D. 247, 123 O. G. 655.

Claims which purport to cover a process, but which describe the operation of an apparatus, the putting together of an apparatus, and perhaps the apparatus itself, held objectionable.

Dixon, 1906 C. D. 242, 123 O. G. 653.

Where the claim read in the light of the specification of one party means one thing and the same claim read in the light of the specification of another party means another thing, held that the same phraseology should not be employed.

Podlesak & Podlesak v. McInnerney, 1906 C. D. 558, 120 O. G. 2127.

A claim for certain printed matter including among other features properly set forth "another form" located at a certain place with respect to other features is not objectionable as being indefinite, the language involving a question as to the scope of the claim rather than its form. Examples of functional claim.

McClain, 1905 C. D. 519, 119 O. G. 1585.

The essential feature upon which an invention rests should not be left to conjecture and inference.

B. v. P. P. Wks., 107 F. R. 475.

Similarities and differences in machines, process or product do not depend upon mere names of things, words used to describe them, or immaterial matters by which they may be distinguished.

Palmer Co. v. Lozier, 84 F. R. 669. Citing, Glue Co. v.

Upton, 97 U. S. 3 and Bates v. Coe, 98 U. S. 31-42.

In order to face toward opposite ends of the press, the folders must clearly be between those ends.

Annand v. Spalekavor, 1901 C. D. 212, 97 O. G. 2083.

If in a claim one or more articles may constitute a single element it is sufficient to mention one only as more than one includes one.

Thorsen, 1893 C. D. 75, 63 O. G. 1688, see also Hulbert, 1893 C. D. 74, 63 O. G. 1687.

While an applicant will generally be allowed all possible latitude in framing his claims, parenthetical clauses which do not contribute to clearness or exactness in stating applicant's invention, but which at least are only superfluous, will not be allowed.

Cahill, 1893 C. D. 78, 63 O. G. 1815.

A claim containing words of limitations which are depend-

ent upon the location or operation of mechanism that forms no part of the invention claimed and is neither shown or described, is objectionable.

Baackes, 1893 C. D. 70, 63 O. G. 909.

An article of manufacture should not as a rule be defined in a claim by reference to the process of producing it, but when it can not be otherwise defined an exception to the rule is presented.

Painter, 1891 C. D. 200, 57 O. G. 999.

A product of nature rendered usable by a certain process covered by a process and not by a product claim.

Latimer, 1889 C. D. 123, 46 O. G. 1638.

A combination of elements arranged in a certain position as to each other, which certain position is fixed and restricted by the terms of the specification and claim, is a proper claim.

Rernolds, 1876 C. D. 88, 9 O. G. 744.

Every claim must be so drawn as to plainly indicate what kind of invention is sought to be covered, whether an improvement in an art or in a manufacture, whether a process or product. A claim for the use of a thing is ambiguous.

Mayall, 1873 C. D. 134, 4 O. G. 210; Brownlie, 1872 C. D. 208, 3 O. G. 212; Hooper, 1872 C. D. 150, 2 O. G. 4, 1872.

A claim for a result or effect is bad. The whole genus of claims in the present participle form are bad.

Simonds, 1870 C. D. 23; Arkell, 1871 C. D. 263; Beavis, 1879 C. D. 331, 16 O. G. 1233; Hobson, 1872 C. D. 20, 1 O. G. 141.

Every claim must be so drawn as to plainly indicate what kind of invention is sought to be covered, whether an improvement in an art or in a manufacture, whether a process or product.

A claim for the use of a thing is ambiguous.

Mayall, 1873 C. D. 134; Brownlee, 1872 C. D. 208; Hooper, 1872 C. D. 150.

Each claim must be to a complete and operative combination in the direction of the invention.

Holt, 1884 C. D. 43, 29 O. G. 171.

A claim for an "arrangement" disapproved a claim for a combination is better.

Eynon, 1871 C. D. 239; see Martz, 1870 C. D. 16.

(5) *Construction of Claim.*

See "Construction of Issue" under Rule 95.

The patent of Hug 1154314, granted September 21, 1915,

has as its first claim simply the one word "polihydrocolchicin." This claim is proper notwithstanding it leaves the reader without any knowledge of the invention patented unless he has read the specification and is able to bear it in mind.

Assistant Com. Clay in *ex parte* Brown, 235 O. G. 1355.

A claim may be limited beyond its terms by reference to the specification. A very good case with authorities, Fowler & Wolfe Mfg. Co. v. McCrum Howell Co., 215 F. 905. Com. Ewing cites this case as holding—If an infringer's use includes a specific feature which is essential to patentable novelty and is not recited in the claim, the defect is sometimes cured by construction.

See Feud v. Miggett, 223 O. G. 649.

A claim should be given the broadest interpretation its terms will permit. Miland, 135 O. G. 1122; Pratt v. De Ferranti and Hamilton, 148 O. G. 568. Nevertheless it can not be enlarged beyond the plain import thereof as set forth in the specification on which the claim is based. Sinclair v. Engel, 147 O. G. 769.

It is in the specification of a patent that the invention, if there be one, must be discovered. References to prior art are useful to clear up obscurities (Hall Borchert, etc., Co. v. Ellaman, etc., Co., 213 F. R. 341).

Barrett Company & Schulte v. Ewing, Com., 228 O. G. 761.

But, even if F's apparatus shows the continuous application of the received energy, he is not for that reason entitled to claim an unbroken current under this patent. F's conception was no broader than the essential elements of his idea of means, and this was not broadly current operation, but specifically current operation on the galvanometer principle. (Quoted from 198 F. 386.)

Fritts, 227 O. G. 741.

Since he made this general suggestion as to supporting the candy, and since he was a pioneer in providing the "figured" motion, a meritorious improvement in the art, infringement of his patent might be found.

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

The only feature of the claim for which there can be any color of novelty is in raising the center sills above the bolsters into the floor stringer space. But even this feature is anticipated in 615, 118.

Guaranty Trust Co. v. Beltendorf Axle Co., 223 F. R. 542.

When the language of a claim is clear and distinct the patentee is bound by it. If elements are omitted there is no infringement.

Evans v. Hall Printing Press Co., 223 F. R. 539.

Therefore claim 23 may be disregarded at once; because where so many claims are put into a patent each element in a given claim must be supposed to be especially necessary to the combination.

Victor T. M. Co. v. T. A. Edison, 221 O. G. 351.

Construction of claims in view of the previous art.

Victor Talking Machine Co. v. Thomas A. Edison, Incorporated, 221 O. G. 357.

While the ultimate disposition of the case must depend upon the construction of the claim in respect to an express limitation found therein, this in turn depends in part upon the advance which Rowley made over existing knowledge; and the inquiry may well be approached along the road adopted in 217 F. 775. This is to inquire: First, what was R's real advanced step or new concept? Second, is defendant's structure within the limits of such advance? And, third, if so, do the terms of the claim, when fairly read, require such an interpretation as to sanction defendant's appropriation of Rowley's idea.

Dennison J. Rowley Co. v. Columbus, etc., 220 Fed. R. 128.

The prior art contains nothing which should require it to be narrowly construed.

Autopiano Co. v. American Player Action Co., 217 O. G. 1055.

Claims so functional in character and form as those in suit must be read in the light of the drawings and description of the patent and be closely limited to what is there shown and described.

Union Special Mach. Co. v. Singer Mfg. Co., 215 F. R. 598-602.

The court will remember that the specification and claims are often unskillfully drawn and that the claim shall be construed, if possible, to sustain the patentee's right to all that he has invented.

Benjamin Memo Card Co. v. Rand, M'Nally & Co., 210 F. R. 287.

A patent claim is a formal instrument, and its meaning depends upon its words and not on the mind of the inventor.

National Elec. S. Co. v. Telefunken Wireless T. Co., 209 F. R. 865.

Where a patent contains both a broad and a narrow claim and a suit is brought on the broad claim, we can not construe into it a limitation not therein expressed, but which is expressed in the narrower claim and by which alone one is distinguished from the other.

National Tube Co. v. Mark, 209 O. G. 335-6.

It is only applying to a patent the ordinary rules of construction applied to other grants, to say that, in determining whether a given element should be considered as present with a limiting effect in a claim in that respect ambiguous, we should observe the occasion or the necessity for its introduction by the claim draftsman. If its presence was necessary to distinguish the claim in point of patentability from the prior art or in point of effect from the other claims, it should be implied, but if it can be of no use in either of these particulars, it should not operate as a limitation.

Scaife & Sons Co. v. Falls City Woolen Mills, 209 F. R. 216.

In practice, however, the claim elements often can not be effectively labeled "generic" or "specific;" terms are used capable of either construction; and here is the interpretative usefulness of claim differentiation.

Scaife Sons Co. v. Falls City Woolen Mills, 209 F. R. 214.

The defendant claims that the language in the claim said "indented mold" restricts it to a particular form which it does not use.

The defendants' variation does not effect the functional action, and therefore is not an avoidance of the claim.

Valoma Marchiony Co. v. Marchiony, 207 F. R. 383.

Unless a patentee has especially limited himself to a specific form of construction, or such limitation is imposed by the state of the prior art, or such limitation was imposed by the action of the Patent Office in rejecting a broad claim, applicant is entitled to a broad construction of his claims in accordance with the language thereof.

Ryder v. Lacey, 200 Fed. Rep. 971.

The claim of a patent is a statutory requirement prescribed for the very purpose of making the patentee define precisely what his invention is, and it is unjust to the public, as well as an invasion of the law, to construe it in a manner different from the plain import of its terms.

Lorraine Development Co. v. General Electric Co., 198 F. R. 115.

If even common words have a special, extended, or restricted

meaning when used in that art, courts are bound to give them that meaning.

Lorraine Development Co. v. General Electric Co., 198 F. R. 115.

There are such fundamental difference between the two inventions by which the battery plates are produced that a broad construction of claim 2, such as its literal wording would seem to imply, should not be accorded to it.

Electric Storage Battery Co. v. Gould Storage Battery Co., 197 Fed. R. 749.

Where the language of a claim is plain in its meaning, when read in connection with the subject matter, and when so read describes a valid, patentable combination, it should not be interpreted according to other possible meanings of the terms used, by which not only would the claim be rendered invalid, but by which other patentable combinations would be made apparent infringements and would then in turn have to be relieved from the consequences of such infringement by a return to the conclusion that the construction of the claim rendered it invalid.

Hall v. Frank, 195 Fed. R. 951-952.

Elements in claims should be read with reference both to the structure and the function given in the description of invention.

Lowden Machinery Co. v. Strickler, 195 Fed. R. 756.

Whether or not there is any force to these criticisms of the specifications and claims (misleading, confusing, multifarious claims) can be determined only when the court is advised as to the state of the art when the patent was granted.

Marconi Wireless Tel. Co. v. New England Nat. Co., 191 F. R. 194.

Wording of claim just the reverse of that intended.

Crown Cork & Seal Co. v. Brooklyn Bottle Stopper Co., 190 F. R. 327.

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

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

It is urged that the decision of the Court of Appeals in Tyden v. Ohio Table Co., 152 F. R. 183, holds that a claim generally to “means” is functional and invalid. I do not so understand Judge Lurton’s opinion. In that case the means

shown were so ordinary and common, and the device so lacking in invention, except possibly in the result or function disclosed, as to compel the conclusion that the patentee intended to claim the result by whatever means accomplished.

Mershon & Co. v. Bay City Box & Lumber Co., 189 F. R. 749.

But applicant has specified a large number of substances containing the common quality which fits them for use in his invention, in the absence of evidence to the contrary, we believe that the doubt should be resolved in his favor.

Ellis, 167 O. G. 983.

The entire structure of the claim comprehends new elements applied to a structure of an old type. If in this claim the inventor, by including the words "retorts therein" has limited himself to a claim for his invention when applied to use in a structure of special type, it would be a harsh and unusual construction of his claim to say that, because he had unnecessarily limited himself to the use of his invention for the purpose of heating retorts, he should lose it altogether.

Combustion Utilities Corporation v. Wereslor Gaslight Co., 190 F. R. 161. Also what follows above quotation.

See *Langan v. Warren Axe & Tool Co.*, 166 O. G. 986-987.

To single out as the actual and dominant factor in maintaining a low temperature the heat absorption which results from CO introduced in the draft current seems to give a fallacious emphasis to a part of what occurs above the grate.

Combustion Utilities Corp. v. Worcester Gaslight Co., 190 F. R. 160.

The invention stands as it was asserted and accepted at the close of the proceedings regardless of what had passed previously. Said in a case where claims had been withdrawn and again reasserted.

Dodge Needle Co. v. Jones, 153 F. R. 190.

It is well settled that where a party copies the claim of a patent for the purpose of interference, such claim must be read in the light of the disclosure of the patent.

Chirney v. Clause, 116 O. G. 597; *Brown v. Hill*, 123 O. G. 1284; *Sobey v. Holsclaw*, 126 O. G. 304; *Sinclair v. Engel*, 147 O. G. 769.

Claims are to be constructed by the specification as amended.

Wenberth v. Lizotte, 141 O. G. 1102.

A claim will be given the broadest interpretation of which its terms are capable.

Milans, 135 O. G. 1122.

As to interpretation of claims.

Leonard v. Horton, 189 O. G. 781; Jund v. Harrington, 131 O. G. 691.

A claim should be given the broadest interpretation which it will support, and limitations should not be imported into the claim from the specification to meet the exigencies of the particular situation in which the claim may stand at a given time.

Miel v. Young, 128 O. G. 2532.

The function is not inherent in the mechanism shown for the reason that the function does not flow from the mechanism as shown and described, but from that mechanism minus one of its parts.

Scott v. Southgate, 125 O. G. 1203.

There is not a word in the claims limiting them to a current double the old capacity and we are unable to perceive any reason why the claims should be eviscerated by importing into them the statements of a formula intended only as an illustration.

Electric Smelting & Aluminum Co. v. Pittsburg Reduction Co., 125 F. R. 926-938.

Reference may be had to the French patent for the purpose of discovering the scope of the patent in suit.

Central Lighting Co. v. Northern Light Co., 137 F. R. 427.

A device not within the wording of the claim, but within its spirit held to infringe. See also Schoeder v. Brammer, 98 F. R. 880 and 106 F. R. 918.

Benbow-Brammer Mfg. Co. v. Simpson Mfg. Co., 132 F. R. 315.

No better method of construing claims is perceived than to give them in each case the broadest interpretation which they will support without straining the language in which they are couched.

Podlesak & Podlesak v. McInnerney, 1906 C. D. 265, 123 O. G. 1989.

In reading a claim to construe it heed must not only be paid to the specification proper, and to the drawings, but also to the other claims of the patent. (Ryder v. Schlichter, 126 F. R. 487.)

Andrews v. Wilson, 1906 C. D. 717, 123 O. G. 1667.

Whether two patents having claims with the same wording ought ever to issue.

Allfree v. Sarver, 1906 C. D. 214, 122 O. G. 2391.

The meaning given to the counts of an interference is that

of the party first making the claim. (Tracy v. Leslie, 14 App. D. C. 126; Puete v. Elwell, 15 App. D. C. 21.)

Podlesak & Podlesak v. McInnerney, 1906 C. D. 558, 120 O. G. 2127.

In a case of doubt the intent of the applicant in using a term in a claim and the understanding of the Office in allowing the claim have a material bearing upon its meaning and scope, and therefore the applicant should not be required to cancel statements where such cancellation may result in a more limited construction of the claim than is necessary.

Jansson, 1906 C. D. 62, 120 O. G. 2126.

All the words of a claim will be given force and effect when this can be done without contradiction or inconsistency.

Reese, 1904 C. D. 484, 113 O. G. 849.

A limitation that a fuse is "within the casing" means anywhere within the casing as imbedded in its walls. In the absence of express words, it should not be limited to a fuse within the cavity of the casing.

A fuse covered by the outer wrapper of a casing is within the issue and is reduction to practice.

Sachs v. Hundhausen, 1903 C. D. 625, 105 O. G. 1534 et seq.

Nothing beyond this was described in the patent as a function of the invention, and nothing more can now be successfully maintained.

Consolidated Car Heating Co. v. An Elec. H. Corp., 82 F. R. 995.

He must, indeed, make such disclosure and description of his invention that it may be put into practice. In this he must be clear. It is no concern of the world whether the principle upon which the new construction acts be obvious or obscure, so that it inheres in the new construction.

Diamond Rubber Co. v. Consolidated Rubber Tire Co., 31 Supreme Court Reporter 448.

Words are to be explained by their context.

O. Greenough v. Drummond, 1879 C. D. 213; Greenough v. Drummond, 1879 C. D. 269, rehearing.

(6) *Reference to the Specification.*

It is clear that neither the language employed nor the state of the art requires this limitation, and that its presence is almost necessarily negatived by comparison with claim 4, which is differentiated alone by the inclusion of this feature.

Knoley Co. v. Columbus Co., 220 Fed. R. 133.

The claims are a part of the description required by the statute, and in them, and in that part of the description

which is now commonly called "specification," is the proper place in which to define the breadth of the invention.

National Tube Co. v. Marks, 216 Fed. R. 507.

General language in a claim which points to an element or device more fully described in the specification is limited to such an element as is there described.

Attunwa Box Car Loader Co. v. Christy Box Car Loader Co., 209 O. G. 688.

The construction of the third claim of the patent is made the more evident, when the language of this claim is contrasted with that of the first claim of the D'Arcy patent, which, although itself not directly involved under this appeal, may, under the general rule that a patent as any other written instrument, is to be construed as a whole and due effect given to all its parts, be looked to for the purpose of aiding in the proper construction of the third claim. (53 F. 367, 370, 108 F. 379, 383, 123 F. 416-419.)

Sheffield Car Co. v. D'Arcy, 194 F. R. 690.

A claim of a patent depending for its validity upon a feature not disclosed by specification or drawing is invalid.

Herman v. Youngstown Car Mfg. Co., 191 F. R. 579.

Each claim of the process patent is expressly limited by the expression "the herein before-described process" and when read in connection with the specification is intelligible though claims 10 and 13 of the process patent are not clearly expressed.

Combustion Utilities Corp. v. Worcester Gaslight Co., 190 O. G. 164.

In a large sense every operation by electricity is by current; but the patentee does not leave us to this general use of the word "current." He does not leave us in any doubts as to what he means by "current-operated." He makes his meaning clear in the specification, wherein he clearly draws the distinction between the coherer, the imperfect electrical contact of the previous art, and his method of operating by a constantly flowing current.

National Electric S. Co. v. United Wireless Tel. Co., 189 F. R. 733.

Whether a claim is valid the advantages of the device defined not being pointed out in the specification.

Morgan Engineering Co. v. Alliance Machine Co., 157 O. G. 1244-1246.

If the crane can not be constructed without securing such advantage, this is alone sufficient.

Cases cited, 72 F. R. 67-73 to 75, 115 F. R. 886-895, 117 F. R. 410-415.

It is possible that in Forster's device the water, to some extent, impinges upon the inside of the "tubular body" though he does not suggest it. But he would be entitled to claim that feature, if it in fact existed. (Goshen S., 72 F. R. 67, 116 F. R. 363, 117 F. R. 410-415, 123 F. R. 67-71. Indeed, the Supreme Court has decided that novelty is negatived by a prior patent which shows the device in its drawings and describes it in the specifications, but does not clearly state its use. Walker's Patents, sec. 55.)

Forest City Foundry & Mfg. Co. v. Barnard, 157 O. G. 756.

In the construction of a patent, the omission of the patentee to point out or refer in his specification or claims to a special feature, which he subsequently maintains is the most important part of his invention is very significant, and should be carefully scrutinized.

Stirling Co. v. Rust Boiler Co., 144 F. R. 849.

Limitation by description.

Continental Paper Bag Co. v. Eastern Paper Bag Co., 136 O. G. 1297.

In other words reference may be made to the specification to explain but not to extend or limit the claims. The words "to operate substantially as described" mean "substantially as described in regard to the combination which is the subject of the claim.

General Electric Co. v. International Specialty Co., 126 F. R. 759.

It is, no doubt, true that an element not stated in a claim can not be brought forward from the specification and imported into it. McCarty v. Railway, 160 W. S. 110-16, Sep. Ct. 240, 40 L. Ed. 358. But that is by no means to say that the specification which precede do not limit it, or that they are not to be resorted to, as they always are, to explain it and give it character.

National Meter Co. v. Neptune Meter Co., 122 F. R. 75.

The claim of a patent must always be explained by and read in connection with the specification and as this claim clearly includes metal taken from the blast-furnaces, the question whether it includes every molten metal is as much eliminated from our consideration in this case as if it were sought to show that the word "metal" might include other metals than iron.

Podlesak & Podlesak v. McInnerney, 1906 C. D. 558, 120 O. G. 2127.

The specification may be referred to for ascertaining the meaning of the claims.

Holley v. Vergennes Machine Co., 1880 C. D. 659, 18 O. G. 1177; Jansson, 1905 C. D. 62, 120 O. G. 2126.

Features described as preferable in the specification do not constitute a limitation of the claim.

Krajewski v. Pharr, 105 Fed. Rep. 518.

The point is made that in the original application for a patent, filed in May, 1882, the defendant in error designated his invention a mechanism to form a "noiseless, self-adjusting treadle," and that he made no allusion to the feature thereof which is now deemed of prime importance until his specification was subsequently so amended by his attorneys as to contain the declaration that his invention had for one of its objects to provide means "to keep the treadle bearing in line and at a fixed distance apart to avoid friction." It is argued from this circumstance that the court must hold the invention of the defendant in error to be a mechanism to secure a noiseless, self-adjusting treadle and nothing more. We are unable to assent to the doctrine that an inventor is thus circumscribed by the words which he may first use to describe the advantages of his invention and that he may not afterward, on further consideration, either upon his own suggestion or that of his counsel, amend his specification so as to assert and maintain all the advantages which his device possesses.

The claim throughout was substantially the same.

Singer Mfg. Co. v. Cramer, 97 O. G. 555.

It is earnestly contended that inasmuch as the claim of the Cramer patent calls for a "treadle provided with trimmers," the trimmers are made an essential feature of the construction of the treadle and that there can be no infringement by the use of a treadle which has no trimmers. We do not think, however, that the court should have taken the case from the jury upon that ground.

If the patentee was entitled to the doctrine of mechanical equivalents, his right certainly is not affected or diminished by the use of the words "provided with trimmers" as found in his claim.

Singer Mfg. Co. v. Cramer, 1901 C. D. 492, 97 O. G. 552.

The particular expressions used in the claims are not clear as they have not been defined and explained in the specifications.

To merely state in the claim the function or result without first including therein the structure by means of which the

function or result is obtained renders a claim vague and indefinite.

Kotler, 1901 C. D. 12, 95 O. G. 2684.

If any particular kind of gripping device was specified it might, to that extent, perhaps, be saved; but as it depends upon the general combination of the elements brought together, it is of no novelty.

Thompson Scenic Ry. Co. v. Chestnut Hill Casino Co.,
119 F. R. 362.

Where expressions used in the claims have not been specially defined or explained in the specification so that their meaning can be understood. Held that the claims are objectionable as not being so clear and concise as required in the statutes and rules.

Kotler, 1901 C. D. 62, 95 O. G. 2684.

Where the claims of a patent are not supported by a description in the patent, such claims are of no validity.

Pacific Cable Co. v. Buette City R. R., 94 O. G. 205.

Where claims in a patent are not supported by a description in the patent such claims are of no validity.

Pacific Cable Railway Co. v. Butte City Street R. R.
Co., 1894 C. D. 205, 66 O. G. 1758.

Claim and operative method must correspond.

Barney, 1890 C. D. 171, 53 O. G. 1569.

It is the province of claims to relegate to the specification the enumeration of such details of construction as shall be found upon examination to be immaterial to the true scope of the actual invention.

Laskey, 1889 C. D. 181, 48 O. G. 539.

On referring to the specification we find it there expressly declared that the invention consists "in the construction and combination of parts hereinafter fully described and claimed, reference being had to the accompanying drawing."

This seems to have been construed as limiting the claims.

Singer Mfg. Co. v. Cramer, 24 S. C. R. 299.

Claim—"The hereinbefore described compound, or composition of matter, consisting of the ingredients mentioned, prepared in the manner and proportion substantially as described, for the purposes set forth."

This is clearly improper, and distinguishable from the case of Tweddle, 1876 C. D. 221. The ingredients are well known and should be specified in the claim. A general reference to the specification is not specifically pointing out the invention claimed.

Williams, 1876 C. D. 227, 10 O. G. 748.

A mere reference to the specification by the terms "Substantially in the manner described" is not "particularly" pointing out and "distinctly" claiming the alleged invention.

Rice, 5 O. G. 552; Shepler, 1903 C. D. 17, 102 O. G. 468; Williams, 1876 C. D. 227, 10 O. G. 748.

The claim "the combination of the window sash and the rubber strips arranged as described" is not ambiguous and is unobjectionable.

McIntire, 1876 C. D. 34, 9 O. G. 300.

Claim "As a new article of manufacture, the petroleum product hereinbefore specified, and having the characteristics described."

This claim is proper because this is one of those anomalous cases in which the nature of the product described does not admit of a more distinct mention in the claim without repeating therein the greater part of the specification. Opinion of General Chemical Examiner.

Tweddle, 1876 C. D. 221, citing 2 Wallace Jr. 365; Moule & Bannehr, 1871 C. D. 87; Arkell, 1871 C. D. 263; Shepler, 1902 C. D. 17, 102 O. G. 468.

A claim for a rake "to gather" or "discharge" the grain construed to be for a rake that would do both in view of the specification which describes such a rake.

Dorsey, 1870 C. D. 17.

It should be remembered that the question is not now before the Office how the specification should be drawn. In that case it might properly be required that all ambiguity should be eliminated.

Dorsey, 1870 C. D. 17.

The practice of allowing claims for inventions which can only be distinguished from those previously invented, or patented by the construction given to such words as "substantially as described," "as herein set forth," etc., can not be too strongly condemned. They are, at best, ambiguous and dangerous phrases and however else they may be used, they must not be employed in the granting of letters patent to make a claim good that without them would be bad and unpatentable.

Rubens & Co., 1869 C. D. 104; Waterman, 1870 C. D. 107; Moule & Bannehr, 1871 C. D. 87.

(7) *Generic and Specific.*

Suppose that elements A, B, and C are each old in several specific forms, but are operative only in the combination A, B, C. An inventor perfects new and useful specific forms of

each *a*, *b*, *c*. The most desirable form of his invention is the combination *a*, *b*, *c*, and this the inventor considers his perfect work; but he may use and is entitled to monopolize one or two of the old forms in combination with two or one of his new forms. He may have, and the proper drafting of his patent will secure for him, a series of combination claims like this (capitals representing generic, lower case, his new specific forms): (1) *a*, *b*, *c*; (2) *a*, *b*, *C*; (3) *a*, *B*, *c*; (4) *a*, *B*, *C*; (5) *A*, *b*, *c*; (6) *A*, *B*, *c*; (7) *A*, *b*, *C*.

Scaife & Sons Co. v. Falls City Woolen Mills, 209 F. R. 214.

The same invention may be generic to the individuals of its own genus, and specific in its relation to some wider invention representing the group to which itself belongs.

Sec. 535, Robinson on Patents, Vol. 2, p. 151.

The same invention may be generic to the individual of its genus, and specific in relation to some wider invention representing the group to which it belongs.

Rosell v. Allen, 1900 C. D. 333, 92 O. G. 1036.

It is a familiar rule that a generalization or a definition that is too broad can not be made good by making an arbitrary exception of each case that comes within its terms, but should not have been included. A single contrary example destroys the generalization. (Noted from Bell Tel. case.)

A generalization so broad as to cover the prior art must be withdrawn, and a new one made that is narrower and is limited by the point of difference.

United Wireless Tel. Co. v. National E. S. Co., 198 Fed. R. 396.

Where a composition was claimed enumerating a number of constituents, and a large number of equivalents coming under one generic chemical class were mentioned, a generic term might be employed including all such equivalents. *In re Ellis*, 167 O. G. 981. Where only one was mentioned and there was no evidence that the invention was broader the generic term was inadmissible.

Dosselman & Neymann, 167 O. G. 983. See 159 U. S. 465 and 78 F. 910.

Of course, the more logical way would have been to include the genus and its various species in a single patent, avoiding thus what seems to be an unnecessary multiplication of patents. But the rules of the Patent Office do not allow of any such simplification permitting in a single application only a generic and one specific claim. It would be a failure of justice if a meritorious invention should be deprived of the fruits of

his labors because an arbitrary rule of the Patent Office has brought about complications not contemplated if authority can be found for securing it to him. Such authority is not wanting in this circuit. (52 F. 137; 71 F. 396; 82 F. 461.)

Badische Anilin & Soda Fabrik v. A. Klepstein & Co.,
125 O. G. 554.

Where a set of claims can be based upon one specific product, there is no reason why they should not be permitted to remain in the same application. Chemical claims. Good example of a generic, sub-generic and specified claims.

Gaessmann, 1900 C. D. 20, 90 O. G. 959.

Doubted if the doctrine of genus and species as affecting articles of manufacture can properly be applied to combinations and sub-combinations growing out of the general structure.

Freese, 1880 C. D. 133, 17 O. G. 1095.

A genus is defined as "A precisely defined and exactly divided class" and as "An assemblage of species possessing in certain characters in common."

Kent, 1880 C. D. 115, 17 O. G. 686.

In a claim for a genus the characteristics common to the species of that genus must be pointed out.

Kent, 1880 C. D. 115, 17 O. G. 686.

When the different forms are such that the substitution of one for the other involves invention, the differences are patentable, and the several forms constitute different species of the genus. When the substitution of one for the other involves no invention, but only mechanical skill, the differences are not patentable, and the forms are all modifications of a single species.

Kook, 1879 C. D. 202, 16 O. G. 543; *Cowper*, 1879 C. D. 194, 16 O. G. 499; *Morrison*, 1879 C. D. 169, 16 O. G. 359.

A generic claim and one specific claim may be had in one application, but no more than one specific claim.

Cowper, 1879 C. D. 194, 16 O. G. 499; *Morrison*, 1879 C. D. 169, 16 O. G. 359; *Heaton*, 1879 C. D. 95, 15 O. G. 1054; *Smith*, 1879 C. D. 137; *Eagle*, 1870 C. D. 137.

A so-called mechanical process—that is to say a process which depends upon some mechanism in the practice of it—must amount to a new way of using an old machine, to be patentable.

Dailey, 1878 C. D. 3, 13 O. G. 228.

In addition to a generic claim, one who has invented the

genus way, under the established practice of the Office, claim one particular species illustrative, or typical, of the genus.

Kent, 1880 C. D. 115, 17 O. G. 686; Walsh v. Shinn, 1879 C. D. 279, 16 O. G. 1006; Cowper, 1879 C. D. 194, 16 O. G. 499; Ewart, 1880 C. D. 78, 9 O. G. 1038.

A generic claim and one specific claim may be had in one application, but no more than one specific claim.

Smith, 1879 C. D. 216, 16 O. G. 630; Eagle, 1870 C. D. 137; Cowper, 1879 C. D. 194, 16 O. G. 499; Morrison, 1879 C. D. 169, 16 O. G. 359; Heaton, 1879 C. D. 95, 15 O. G. 1054.

A specific claim is a bar to the grant of a generic claim for the same subject matter in a subsequent patent.

Atwood, 1869 C. D. 98; Lowe, 1870 C. D. 39; Hyde, 1871 C. D. 109; Holt, 1884 C. D. 43, 29 O. G. 177.

(8) *Combination.*

Invention of a combination does not lie in gathering up the elements that are employed, but consists in first perceiving that a new and desirable result might be attained by bringing about a relationship of elements which no one has before perceived and then going forth to find the things that may be utilized in the new required relationship.

Railroad Supply Co. v. Hart Steel Co., 217 O. G. 704.

We are not impressed with applicant's claims of aggregation as applied to claims 14 and 17; in our judgment the parts co-operate to produce an improved furnace and are therefore properly treated as a combination.

Masonic Fraternity Temple Ass'n v. Murphy Iron Works, 215 F. R. 590-594.

The record satisfies us that the combination in the exact form described in the patent would throw the coal to the ends of the cars, was practical and useful, and that the utility and success of the commercial combination is attributable to C's discovery or invention of the mode of operation and combination, and not to the slight change in form of the top of his carrier to which he was not limited by his specification or claims.

Ottumwa Box Car Loader Co. v. Christy Box Car Loader Co., 209 O. G. 683.

Obviously if the new element coacts with the other elements in a different manner from the corresponding elements of the old combination, and a new result is obtained thereby, a new and patentable combination may be made.

Mumford, 206 O. G. 878.

The word is used in two senses, one involving a consideration of the previous art (cases) another ("which in the interest of accurate terminology, might well be taken as the exclusive sense") aggregation means that the claims, in and of themselves, independently of the prior art, show the elements are incapable of coacting to produce a unitary result.

Krell Auto Grand Piano Co., etc., v. Story & Clark Co.,
206 O. G. 313.

An aggregation (independent of the Act) is proper where there is no direct coaction between the elements, and where the only coaction comes through the mediation of the operator (or what seems to us the same, the mediation of the thing or material operated upon).

Krell Auto Grand Piano Co., etc., v. Story & Clark Co.,
206 O. G. 313.

The color is non-functional.

Coca Cola Co. v. Goy Ala Co., 200 F. R. 724.

Two of the elements seem to have been merged into one, with an omission of the function upon which patentability depended. No infringement.

Star Bucket Paint Co. v. Butler Mfg. Co., 198 Fed. R.
857.

No new or novel means for making paper are claimed. The old means are employed; but the arrangement of these means while paper making is going on is different, not with relation to each other, but with relation to the "stock" discharged on the screen, and then the speed of the screen with relation to the speed of flow of the stock is regulated.

Eibel Process Co. v. Remington Martin Co., 197 F. R.
762.

It must be conceded that in the last analysis the patent does not do much more than move signals from one place to another without changing their function, but in doing this a real contribution has been made to the art, and a contribution I think of considerable value, each part has been made more effective to accomplish the common object, and in which the increased efficiency is due to the new relation. Proper combination.

Burdett-Rowntree Mfg. Co. v. Standard Plunger Elevator Co., 196 F. R. 43.

It is true that the two devices do not act simultaneously, but they co-operate with respect to the work to be done, and in furtherance of it.

Westinghouse Electric & Mfg. Co. v. Condit E. Mfg. Co.,
194 F. R. 438.

Claims 3, 4 and 5 are also void, because they cover only aggregations of machines operating successively and independently, and do not embody patentable combinations.

Loggiet Puget Sound Mills, 194 F. R. 164.

Apparently conceded that the material acted upon could not be an element of a combination.

Union Paper Bag Mach. Co. v. Advance Bag Co., 194 F. R. 139.

It was finally held on appeal that, as an apparatus for storing and distributing acetylene gas, the solvent, with super-saturated solution of acetylene, might constitute an element of the combination, and a claim was suggested by the board, which is claim of the patent in suit.

Acme Acetylene Appliance Co. v. Commercial Acetylene Co., 192 F. R. 321.

S's device was novel and patentable, for while the desirability of insulating the inside of a socket was recognized, while the use of insulating material retained in place by its yielding nature in other portions of a socket was common, and while it was known in the bottle-stopping art that a yielding lining material could be sprung into the interior of a stopper and there retained, yet the existence of these elements in severalty suggested to no one their combined use to fill a recognized want in electric lighting.

Freeman Electric Co. v. General Electric Co., 191 F. R. 168-169.

The fact that there is novelty in one of the elements, as in the present case in the change in the plane of the nozzle pivot, does not justify a claim to the combination of the elements, unless there is coaction between them to produce a new result.

Pelton Water Wheel Co. v. Doble, 190 F. R. 765.

It is generally sufficient if there be such coaction that a result is produced which is new, and the result is new and substantially a better result than has been accomplished by other combinations. (Loom Co. v. Higgins, 105 W. S. 580.)

Pelton Water Wheel Co. v. Doble, 190 F. R. 760.

The inventive act in a combination patent is the making of the component parts, capable of combination, and fit to be united to constitute the combination. The physical putting together of the two parts is no part of the invention.

Kreplik v. Couch Patents Co., 190 F. R. 567-568.

The defendant apparently has in its machine at all times a pair of upper pressers. It sometimes uses three upper

pressers, but when it uses three, of course, it uses a pair as part of the three.

Labombarde v. Lord Baltimore Press, 190 F. R. 187.

If the plaintiff were the first to put them together to produce a useful result, and his putting them together involved invention, no one else has the right to put the old things together in plaintiff's way to do plaintiff's work. If he can do such work without using some one of the elements which go to make up plaintiff's combination, plaintiff can not complain.

Labombard v. Lord Baltimore Press, 190 F. R. 186.

It is so generally the practice of patent solicitors to draw claims for an invention as applied to its most important use, and to file combination claims which cover the invention in a special field of application, that the doctrine of "aggregation" should not be applied to defeat this claim merely because it includes a gas product and a gas bench, with retorts heated by the combustion of a gas generated by the producer, as well as Doherty's new regulating means, whereby the producer gas is generated more economically, and thus the illuminating gas is more cheaply generated from the retorts.

Combustion Utilities Corp. v. Worcester Gaslight Co., 190 F. R. 161-162.

He did not invent the combination. He invented, if he invented anything, an improved grab-hook.

The combination claim is not good because one of its elements is an invention in itself.

Langans v. Warren Axe & Tool Co., 166 O. G. 986.

See 190 F. R. 161-162.

Where a combination of elements is old, claims to that combination should not be allowed, whether they state the elements of the combination broadly or specifically, unless the specific form of the elements themselves enter into the combination to produce a new result.

Baker, 183 O. G. 505.

The patentee is not confined to his combination claims unless all of the elements are old. If any of the elements are new and useful, and show invention, these may be claimed and patented. This may be done in a separate or by separate and distinct claims in the patent covering the combination, even though such parts are without utility save in combination with the other parts of the device. (Quotes authorities.)

The purchaser has the right to the full enjoyment of his purchase, and an implied license to make repairs even to re-

storing a part unless such part is made the subject of a patented change (authorities).

National M. Casting Co. v. Amer. Steel Foundries, 182 F. R. 639-640.

The law is well settled that every part of the combination claimed is conclusively presumed to be material to the combination. No evidence to the contrary is admissible. (Walker, § 349; Hubbell v. U. S., 179 W. S. 82, 21 Sup. Ct. 24; 7 L. L. Ed. 98.)

Automatic Switch Co. v. Monitor Mfg. Co., 180 F. R. 988.

While there is not a new mode of operation, except the feature of the dash-pot, nor a new result, yet the old result is attained in a more beneficial and efficient way.

Toledo Computing Scale Co. v. Moneyweight S. Co., 178 F. R. 563.

While it is true that in the invention defined by the appealed claim the appellant has used features of construction which are independently old, as shown in the three patents cited, yet it is apparent that the appellant has brought these elements together in one practical device, so that they are made to cooperate one with another to produce a new and useful result patentable.

Armstrong, 172 O. G. 259.

A combination claim may not be construed as a good claim to one of its elements.

Langan v. Warren Axe & Tool Co., 166 O. G. 986.

A number of the elements of this combination are undoubtedly old, but by means of its compact unitary structure and easy accessibility for purposes of inspection and repair and other advantages, it has achieved a result which entitled it to be characterized as an advance in the art for which patentability was properly claimed.

Lasher v. Barrett, 166 O. G. 751.

He is not entitled to a new combination merely because he has improved a single element of that combination. (In re McNeil, 20 App. D. C. 294.) He has improved an element of but has not made a new combination.

Ratican, 162 O. G. 540-541.

Though the combination of old elements in appellants' structure is undoubtedly an improvement over the prior art, and probably has resulted in the production of a stronger and more durable locker, and one of easier construction than before existed, it is well settled that mere aggregation, when the

result is but a combination of the known functions of the various parts, is not invention.

Hailes v. Van Warmer, 20 Wall 353; *James Spear Stove & Heating Co. v. Kelsey Heating Co.*, 158 Fed. R. 622; *In re Davenport*, 23 App. D. C. 370.

The contention that the patent calls for an aggregation of elements can not be sustained. The rule has been much modified in later years, and it is no longer held that in order to constitute a valid combination patent, each element must directly coact upon each of the others to produce the result. Where all are necessary to produce the desired end, a combination may be implied. (Cases) 53 F. R. 367-371; 63 F. R. 582; *Walker on Patents*, S. 32.

Dayton Malleable Iron Co. v. Forster, Waterbury Co., 153 F. R. 201.

Taking the whole pin-setter into consideration, I am of the opinion that it was possessed of patentable novelty of a low order, to be sure, but appreciable—and that such novelty could not be and was not in any way to be found in the mere form of apparatus for standing the pins upright in the openings of the pin-setting rack at any time.

Brunswick-Balke-Collender Co. v. Backus Automatic Pin Setter Co., 153 F. R. 288. See *per contra Wells v. Scranton Cold Storage & Warehouse Co.*, 153 O. G. 181.

A combination of three wheels, one of which is entirely dispensable, is not an infringement of a patent on a three-wheeled combination, no one of which can be dispensed with.

Columbia Wire Co. v. Kokomo Steel & Wire Co., 139 F. R. 578.

There is no cooperation between the alarm and the specific form of the means employed to actuate the engine-stopping mechanism.

Adams, 111 O. G. 1623.

It is not necessary in a new combination of old elements that each element should modify or change the mode of operation of all the others, but only that the combination should produce a new and useful result as a product of the combination. (Indicator & Casing.)

McCormick v. Robinson, 1906 C. D. 416, 124 O. G. 2903.

A new part does not confer patentability upon an alleged combination claim, in which it appears as an element when such part acts in its own appointed way, performing its function in the combination irrespective of the other. (*In re McNeill*, 20 App. D. C. 294-297.)

In re Hawley, 1906 C. D. 576, 121 O. G. 691.

In a time-lock safe doors a combination which makes no provision for automatically locking the door when closed, is inoperative.

Sargent v. Burge, 1877 C. D. 62, 11 O. G. 1055.

A claim for a machine or for a combination of mechanical devices is not invalid or insufficient because it fails to include mechanical devices for uniting or operating the machine or combination which readily suggest themselves to a mechanic skilled in the art, or which are pointed out in the specification and drawings as means for the purpose.

Bramer v. Schroeder, 106 F. R. 918.

All ingredients specified in a claim to composition are thereby made essential in analogy to combination claims.

Ct. of Apps. D. of C. Lane v. Levi, 1903 C. D. 601, 104 O. G. 1898.

A combination claim seems to have been held to be infringed by a device which omitted one of the specific elements but retained the function thereof.

McSherry Mfg. Co. v. Dowagiac Mfg. Co., 101 F. R. 716.

A claim having an "oscillating tub" as an element is substantially different from one having a "tub" without limitation.

Casler, 1902 C. D. 292, 100 O. G. 1330.

In an electric elevator system, the combination with a motor-supply circuit and contact blades and terminals for closing and opening the same of an armature-circuit arranged to remain closed until after said contact-blades have been brought to and past the stop position.

Claim not found objectionable, but limited to locality and not time by the history of the case.

Automatic Switch Co. v. Monitor Mfg. Co., 80 F. R. 988.

The coiling device being merely an element of a combination and not claimed as new *per se*, it may properly be presented in terms broad enough to cover all forms of coiling device shown and described and all other known devices for performing the same function.

Baackes, 1893 C. D. 70, 63 O. G. 909.

Where there are claims which severally cover substantially the whole mechanism comprised in the invention, or a combination of several partially independent but co-operating parts of the same, and other claims, each covering a part or sub-mechanism, division will not be required unless the particular part or sub-mechanism in question is capable of

use in other relations and has acquired a distinct status in the arts.

Hine, 1892 C. D. 11, 58 O. G. 385.

It is well settled that it is not necessary to include in a claim for a combination, as elements thereof, all parts of the machine which are necessary to its action, save as they may be understood as entering into the method of combining and arranging the elements of the combination.

Kitson, 1881 C. D. 49, 20 O. G. 1750; Skinner, 1881 C. D. 12, 19 O. G. 662.

No element will be "read in" to a claim in order to limit its scope.

Holley v. Vergennes Machine Co., 1880 C. D. 659, 18 O. G. 1177; National Car Brake Shoe Co. v. Lake Shore R. R., 1880 C. D. 664, 18 O. G. 1179.

The absence of the operating device is not fatal to any combination. A combination is patentable when it takes up a result, or effect, produced by any other part of the mechanism and impresses upon that result a new character, or form, or adds to it a new result.

Banks v. Snediker, 1880 C. D. 95, 17 O. G. 508; Kent, 1871 C. D. 301; Barcellos, 1880 C. D. 4, 17 O. G. 110; Franklin, 1873 C. D. 116, 4 O. G. 105; McMurray, 1875 C. D. 134, 8 O. G. 943; Wilder, 1871 C. D. 125.

A combination of five elements will anticipate a combination of six including the five and producing the same effect, but the reverse is not true.

Banks v. Snediker, 1880 C. D. 95, 17 O. G. 508.

What is auxiliary and may be dispensed with can not be claimed.

Wheat, 1879 C. D. 170, 16 O. G. 360.

It is no objection to a combination claim that the parts are all cast together.

Bland, 1879 C. D. 40, 15 O. G. 828.

In a combination, the elements composing the same should cooperate to produce a common result.

Lee, 1879 C. D. 12, 15 O. G. 512.

A combination of distinct organisms is patentable.

Scott v. Ford, 1878 C. D. 106, 14 O. G. 413.

If the parts do not cooperate it is an aggregation and not patentable.

Flagg, 1870 C. D. 104; Wagenen, 1872 C. D. 15; Campbell, 1878 C. D. 88.

A combination claim for "A combined instrument which

use certain parts in common," is proper.

Sherman, 1875 C. D. 60, 7 O. G. 1054; Lehman, 1870 C. D. 70.

No ambiguity arises by the omission of an element from specific mention in a claim, which element may be omitted from the combination, and such a claim is not inoperative.

McMurray, 1875 C. D. 134, 8 O. G. 943; Farrow, 1872 C. D. 148, 2 O. G. 57; Rheutan, 1874 C. D. 51, 5 O. G. 521.

A claim may be sometimes made in the collection of machines, or devices, which do not in any sense cooperate in what may be strictly called their action.

Sherman, 1875 C. D. 60, 7 O. G. 1054.

The result or effect is the proper test of the validity of a combination. If the parts do not coact in producing a result it is not a proper combination.

Lenes Vernon and Holden, 1873 C. D. 165, 4 O. G. 582; Hooper, 1874 C. D. 91, 6 O. G. 360.

Where the elements cooperate to form a locking device a combination claim is proper.

Farrow, 1872 C. D. 148, 2 O. G. 57.

A legitimate combination claim which has only recently been recognized is where several devices are brought together but produce no new operation by that means, yet the combination embraces some element which is new in itself and gives the whole a new effect, and is thereby rendered patentable.

Baker, 1873 C. D. 127.

To form a proper combination it is only necessary that each device shall fill a necessary office, and act a necessary part in producing the result. They may act simultaneously or successively. Neither is it necessary that the parts of the combination shall be connected together by operating mechanism.

Eynon, 1871 C. D. 239; Lynch & Raff v. Dryden & Underwood, 1873 C. D. 73, 3 O. G. 407; Sol Kuh, 1876 C. D. 190.

The claim should specify by some form of language the elements entering into the actual combination.

Duckworth, 1870 C. D. 150.

An arithmetical combination is not necessarily a combination within the meaning of the patent law.

Underwood, 1870 C. D. 52; Webster, 1869 C. D. 9; Smith, 1874 C. D. 99, 6 O. G. 470.

There is a class of combinations into which patented improvements may enter as elements and of which they may form legitimate members. Such cases are those in which the patented device is itself improved, or made more effective by

the combination, or in which a new whole is produced by the union, or in which the combination does not lie in the legitimate and ordinary use of the patented improvement, but is so far out of the track of it as not to be obviously suggested by it, or in which the additional element is itself new, and could not have been in the contemplation of the patentee, among the modes of using, or applying his improvement.

Rubens & Co., Assignees, 1870 C. D. 49.

The words "connecting mechanism" required to be inserted in a combination claim.

Thorne, 1869 C. D. 76.

The correct rule as regards combinations would seem to be that the parts must necessarily be specified only up to that point beyond which the presence of the parts not named will be presumed as a matter of course, by reason of the known state of the art, or from the very necessities of the case.

Wilder, 1871 C. D. 125; Kent, 1871 C. D. 301. See also cases of McMurray, 1875 C. D. 134, 8 O. G. 943; Farrow, 1872 C. D. 148, 2 O. G. 57; Thorne, 1869 C. D. 76.

In re Thomson; 1906 C. D. 566, 120 O. G. 2756.

A legitimate combination may be claimed which includes an element not shown or specifically described in the specification and drawings.

Rubens & Co., Assignees, etc., 1870 C. D. 49.

(7) *Elements.*

The Office is no more competent than the courts to say that an element which an applicant has placed in his claims is an immaterial one. (Streta v. Freckleton, 87 O. G. 695.)

Collom v. Thurman, 131 O. G. 359.

No valid reason is apparent why the actuating connection and one of its elements should not be independently recited in the claim. The function of said element is distinct from that of the actuating mechanism.

Duncan, Prichard and Macauley, 1906 C. D. 348, 124 O. G. 1207.

A description of an element that necessarily confines it to a certain locality, limits the claim to elements having that location seemingly.

Annand v. Spalckhaver, 1901 C. D. 212, 97 O. G. 2083.

The man skilled in the art would not have found in that art anything which would have told him precisely what that length of wire should be. The claims does not give any formula for determining what it should be, and if the specifi-

cation were equally silent there might be some question as to whether Stanley had really contributed anything of importance to the art, certainly it would yet remain for others to inform the art just how to find out a length which would operate as indicated in the claim. But when the patentee enumerates in his claim as one element of his combination a wire. It is not believed to be proper practice for the Office to give its sanction to a statement in the claims intended merely to define its scope..

Schwietzer, 1901 C. D. 179, 97 O. G. 1372.

Combination element.

Porter v. Loreden, 1895 C. D. 707, 73 O. G. 1551.

A combination claim including the subject operated upon with the machine operating upon it is inappropriate as is also a combination including the operating mechanism, the machinery operating, and the subject operated upon.

Franklin, 1873 C. D. 116, 4 O. G. 105.

(10) *Reference Letters.*

The claims are lettered, and while such claims do not necessarily, and in all cases, prevent an invocation and application of the doctrine of equivalents, still as a general rule they are deemed restrictive. It depends upon the state of the art.

Washburn v. Consolidated Safety Pin Co., 197 Fed. R. 556.

A claim including as an element "a tooth 5" construed to be limited to a tooth located on a rib as the tooth 5 was.

The claim could not have been sustained unless the rib was included.

Irvington Mfg. Co. v. Utica Drop Forge & Tool Co., 191 F. R. 169.

The use of reference letters does not necessarily confine a claim to a part having all the characteristics of the part, in the drawings, as indicated by that letter or numeral, because a claim which expressly covers a particular device impliedly covers any equivalent of that device. Walker on Patents (4th Ed.) pp. 101-102. The breadth or narrowness of a claim as the case may be, does not depend upon any artificial rule of interpretation, and to narrow a broad invention by reference letters or numerals alone, would be to frame and enforce such a rule. Walker on Patents, 117, and cases there cited.

Electric Candy Machine Co. v. Morris, 156 F. R. 974.

The use of reference letters in the claim does not necessarily limit the inventor to the exact form or configuration of parts which is thus portrayed and described, without re-

gard to possible equivalents thereto. It may, or it may not, according to circumstances, as the authorities abundantly show. *Reed v. Chase*, 25 F. R. 94; *Delemator v. Heath*, 58 F. R. 414; *Campbell Printing Press v. Marden*, 64 F. R. 782; *McCormick Harvesting Machine Co. v. Aultman*, 69 F. R. 371-393; *Muller v. Tool Co.*, 77 F. R. 621; *Kelsey Heating Co. v. Spear Stove Co.*, 155 F. R. 980; *Sprinkler Co. v. Koehler*, 82 F. R. 428-431; *Ross Mfg. Co. v. Randall*, 104 Fed. R. 355; *National Brake Beam Co. v. Interchangeable Brake Beam Co.*, 106 Fed. R. 715. Nor are the cases which are sometimes cited to the contrary (*Weir v. Morden*, 125 U. S. 98; *Hendy v. Miners Iron Works*, 127 U. S. 370; *Lehigh Valley R. R. v. Kearney*, 58 U. S. 461) to be differently understood. It is after all a matter of construction, in which while a reference by letters to the drawings and specifications may be regarded as a rule, as involving a greater particularity of description than without them the real scope of the invention is nevertheless to be considered and given due weight. No doubt there are cases where, by reasons of the limitations imposed by the prior art, it is necessary, in order to distinguish and save the invention, to confine it to a certain form or arrangement of parts, which the use of reference letters may effectively serve to do. But where no such necessity exists, the patent is to be taken as a whole in which the reference to the drawings merely goes in with the rest.

Kelsey Heating Co. v. James Spear Stove & H. Co., 155 F. R. 980-981.

If a patentee acquiesces in the limitations suggested by the Patent Office, and the essential elements of the claim are alluded to by reference letters indicating that the Patent Office intended to restrict the claim to the particular device described, a claim to a broader scope can not be maintained.

Good Form Mfg. Co. v. White, 153 F. R. 759.

Letters of reference do not restrict claim to the specific form.

Hall, Hollow Brake Beam Co. v. Interchangeable Brake Beam Co., 1897 C. D. 739, 106 O. G. 693.

Reference letters in claims.

Ross-Moyer Mfg. Co. v. Randall, 104 F. R. 355.

Reference letters used in claim.

McCormick Harvesting Machine Co. v. Aultman & Co., 1895 C. D. 754, 73 O. G. 1999; *Perrin v. Manhattan R. R.*, 1893 C. D. 212, 62 O. G. 1209; *Parry Co. v. Hitchcock Co.*, 1893 C. D. 463, 64 O. G. 860.

It is difficult to see how the applicant could have been more explicit without specifying all the parts by letters.

Shippen, 1895 C. D. 126, 80 O. G. 727.

The substitution of letters of reference for the proper verbal description may tend to render a claim ambiguous, never more exact, while with the proper description in words their use becomes altogether unnecessary.

Parker, 1871 C. D. 293.

A claim relying on the use of reference letters to indicate structure is vague, indefinite, and does not convey an intelligible idea.

Thomas, 15 Gourick's Digest 38-18, May, 1903.

A claim relying on the use of reference letters to indicate structure is vague, indefinite, and does not convey an intelligible idea.

Thomas, 15 Gourick's Digest 38-18, May, 1903.

(11) *Multiplicity of Claims.*

See paper upon this subject read before the Examining Corps of the U. S. Patent Office, Nov. 16, 1916, by William R. Pratt.

Applicant can not be permitted to multiply his claims by presenting alleged combinations which distinguish from the real invention only by including elements which are old in the art and perform no new function.

Whitelaw, 219 O. G. 1237.

Scale case, see Standard Typewriter Co. v. Standard Folding, etc., 219 O. G. 269.

"Means for maintaining said carrier and pattern in parallelism with themselves." The defendants have no such means. Their machine is equipped with the pegs or dowel pins of the old art, instead of the V-shaped guide bars which constitute the complainant's means for maintaining the parallelism referred to and these pegs or pins do not prevent tilting of the plate as it is drawn, no infringement."

Tabor Mfg. Co. v. Mumford Co., 191 F. R. 160.

The consideration of the merits of the applicant's alleged novel combination was embarrassed, and possibly prejudiced, by the great number of claims presented and insisted upon throughout the proceedings in the Patent Office.

Thomson, 1906 C. D. 566, 120 O. G. 2756.

Multiplication of claims not permitted as it imposes a needless burden upon the Office and may lead to a strict construction of the patent.

Chapman, 1906 C. D. 79, 120 O. G. 2446.

It is clearly the duty of this Office to see that patents do not issue with claims so multiplied as to embarrass and confuse the public. It should allow sufficient claims to amply protect the real invention, but should not permit needless repetition.

Both, 182 O. G. 974; Chapman, 120 O. G. 446.

But the only valid objection to a multiplication of claims is when it appears that the applicant is trying deceitfully to go beyond the fair scope of his invention.

There is nothing improper so far as I can see, in first putting your claims as broadly in good faith as you can, and then *ex abundante Cauteli*, following them with narrower claims designed to protect you against possible anticipations of which you are not aware.

No one can know in advance how far anticipation will go or how little in the end his patent will cover.

Parke-Davis & Co. v. H. K. Mulford Co., 189 F. R. 102.

It must differ from each of the rejected claims in other respects than in form since if there is no difference in substance there is no justification for retaining both claims.

Said of a claim presented for appeal under Rule 68.

Wirt, 1905 C. D. 247, 117 O. G. 599-600.

The practice of unduly multiplying claims is to be condemned; but on the other hand, an applicant should be given a reasonable latitude in presenting claims in order that he may not be deprived of his right to adequately cover his invention.

Massie, 1904 C. D. 567, 113 O. G. 2505.

The claims should not be unnecessarily multiplied.

Carpenter, 1904 C. D. 669, 112 O. G. 503.

If claims are needlessly multiplied the Office should reject all except those necessary to define the subject matter.

Johnson, 1891 C. D. 16, 54 O. G. 505.

A repetition of a claim is proper in cases which are difficult of definition, and where one set or form of words would be inadequate to clearly cover the invention and prevent misconstruction, or where the applicant can not set forth in a single claim the device broadly, so that it will cover all other devices which are equivalents at the same time the specific device he has invented and described.

Woodruff, 1880 C. D. 90, 17 O. G. 453.

Repetition of claims.

See Bland, 1879 C. D. 40, 15 O. G. 828.

(12) *Means, Mechanism, Etc.*

Its definition has been settled by this court in the case of *Lecoroix v. Tyberg*, 33 App. D. C. 586, 150 O. G. 267.

Johnson v. Martin, 201 O. G. 267.

He described and claims means; but this did not exclude others from devising and obtaining a patent for means to accomplish the same result, keeping the light-emitting part of an arc-lamp globe clean and clear of deposits, provided they devised different means, however much simplified, not within the range of equivalents for those described and claimed.

Loraine Development Co. v. General Electric Co., 198 F. R. 115.

The unqualified terms "cutters" "means for reciprocating one of said parts with respect to the other" and a "mechanism for finding" said cutters, elements of claim 2, are limited to cutters which reciprocate in their operation on a lead blank as distinguished from a constant relation of the cutters in the same direction, and to a feeding mechanism consisting of a feed screw for moving cutters toward each other.

Electric Storage Battery Co. v. Gould Storage Battery Co., 197 Fed. R. 750.

It is well settled that means accompanied by a statement of function is a proper way to cover one element of a combination.

Williams, 183 O. G. 504.

In view of the fact that the Priest patent ties the patent down to means for automatically supporting the latch, and as the defendants have ignored the means of the other patent and means working on a different principle and adopted other radically different means, I think the defendants do not infringe.

General Electric Co. v. Altes Chambers Co., 171 O. G. 620. See case in Court of Appeals, 178 F. R. 273.

A device using substantially a different means held not infringing.

General Electric Co. v. Allis-Chalmers Co., 178 F. R. 273. See also, *Curtain Supply Co. v. National Lock Washer Co.*, 178 F. R. 95.

It may be permissible at times to claim, as an element of a combination "means" otherwise unspecified, for effecting a certain mechanical result, this being particularly the case in inventions of a broad and primary character. But without undertaking to decide just when it may and may not be employed, it is enough to say that, for the reasons given, it is not a sufficient assignation here.

Eastern Dynamite Co. v. Keystone Powder Mfg. Co., 164 F. R. 59.

Claims. Means, etc.

Lacroix v. Tyberg, 150 O. G. 266.

The distinction between a practically operative mechanism and its function is said to be difficult to define. (Rob. Pat's, see 144 et seq.) It becomes more difficult when a definition is attempted of a function of an element of a combination which are the means by which other elements are connected and by which they coact and make complete and efficient the invention. But abstractions need not engage us. The claim is not for a function, but for mechanical means to bring into working relation the folding-plate and the cylinder. This relation is the very essence of the invention, and marks the advance upon the prior art. It is the thing which has never been done before.

Continental Paper Bag Co. v. Eastern Paper Bag Co.,
136 O. G. 1297.

The use of the word *Means* limited by a statement of function has long been recognized as a proper method of stating an element of a combination claim (Cases cited).

Young v. Eick, 1904 C. D. 465, 113 O. G. 547.

An example of a claim limited by mechanical construction that seems to me only expressible properly by its function.

Macdonald v. Eeison, 1902 C. D. 243, 105 O. G. 973.

Claims containing the term "mechanism" limited only by the functions which such mechanism performs, to designate the specific device and equivalents thereof which the applicant has grouped together as the elements of his combination, have of late been uniformly held to be in proper form.

Halfpenny, 1895 C. D. 91, 73 O. G. 1135.

Claims which define the construction as "means," "mechanism" or "devices" for effecting certain results or define certain named elements or the device by statement of function instead of structure should be objected to if vague or indefinite or rejected on references disclosing the combination and the functional qualifications of both.

Knudsen, 1895 C. D. 29, 72 O. G. 589.

Where the words "means" was employed to set forth functions and contained no limitation with respect to the construction or mode of operation as distinguished from the result, and it designated that portion of the claim in which the novelty resided, held that such claim was vague and indefinite.

Pacholder, 1890 C. D. 55, 51 O. G. 295.

Where in a claim the language following the words "means" and "mechanism" was employed to set forth function, but contained limiting or qualifying words other than those which set forth the result accomplished. Held that such claim was not vague and indefinite.

Pacholder, 1890 C. D. 55, 51 O. G. 295.

The expression "Means for effecting operating functions in the embroidering machine," the claims containing this expression (operating function) can not be readily understood. If the intention was to limit the claims by the expressions in question merely to an operating element of an embroidering machine, such result should be effected unmistakably by the use of this or equivalent language, but if the intention was that the claims should be limited to a specific element or to an element belonging to a particular class of elements in such machines this intention should likewise be carried out with certainty by the use of unmistakable language.

Gröeble, 1905 C. D. 453, 118 O. G. 2537.

An applicant should be allowed to claim his invention as broadly as possible in view of the state of the art. The use of the term "means" with the proper qualifying words, is not prohibited by any decision of the Office or courts.

Weaver, 1897 C. D. 165, 81 O. G. 967.

"Means" followed by a statement of function is properly readable, on a structure in which such means consists of more than one element.

Lacroix v. Tybug, 148 O. G. 831.

(13) *Process—Function of a Machine.*

The function of a machine, or the result produced by its operation, is not patentable.

National Hollow Brake Beam Co. v. Interchangeable Brake Beam Co., 1897 C. D. 739, 81 O. G. 1423.

Where the word "Adapted" is used it does not necessarily imply a combination with an element to which the word adapted refers.

Kertey v. Clements, 216 O. G. 1319.

It has long been settled law with respect to machine patents that no patent can validly issue for the mere function or abstract effect of a machine, but only for the mechanism which performs or produces it.

Union Special Mach. Co. v. Singer Mfg. Co., 215 F. R. 598-602.

The patentee could not obtain a valid patent for the mere statement in language of the physical phenomena observable

by the operation and use of the different parts of the device. (Marchane v. Emken, 132 U. S. 195.)

Lovell-M'Connell Mfg. Co. v. Automobile Supply Co.,
212 F. R. 204.

It was not necessary that he should have claimed it in specific terms if the device itself disclosed it in Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 W. S. 428, the S. C. said . . . It is no concern of the world whether the principle upon which the new construction acts be obvious or obscure, so that it inheres in the construction.

Horton Mfg. Co. v. White Lily Mfg. Co., 208 O. G. 655.

Although the word "Combustible" has no functional significance still as it tends to more definitely define the invention it is within the discretion of applicant to use it.

Pease, 202 O. G. 631.

3. In a spring-cushion structure, the combination of an upright vertically coiled spring; a strip of sheet metal with inturned opposite edges folded onto and embracing the opposite sides of the bottom coil of said spring, whereby said spring is supported and retained in position.

This does not cover the devices as to its function of acting as a beam to support the spring from vertical movement.

Sheffield Car Co. v. D'Arcy, 194 F. R. 690.

The heater and cooler had been made the subject of an application for a patent. The application for the process was later. No patent shown to have issued on first; but the fact that the applicant claimed the apparatus as an invention is sufficient of itself to eliminate the function or operation of that apparatus from the claim of invention for the process.

W. S. Consol. Raisins Co. v. Selma Fruit Co., 194 F. R.
269-270.

The invention or discovery of a process or method involving mechanical operations and producing a new and useful result may be within the Federal Statutes and entitle the inventor to a patent for his discovery. (Supreme Court of the U. S.)

Expanded Metal Co. v. Bradford and The General Fire-proofing Co. v. The Expanded Metal Co., 143 O. G.
863.

One can not describe a machine which will perform a certain function and then claim the function itself, and all other machines that may be invented by others to perform the same function.

Gardner, 140 O. G. 258.

Claim 2—"In a machine for the manufacture of crayons, carpenters' chalk or other like articles, the combination of two

sectional mold plates together forming a complete mold, said mold being open at one end, said mold plates adjustable relative to each other in line with the length of the mold."

The movement of a machine irrespective of the mechanism which causes it can not be patented, it would be virtually giving a patent for the result, regardless of how reached. (The doctrine of equivalents was, however, applied and infringement of other claims was found.)

American Crayon Co. v. Sexton, 139 F. R. 564.

It would seem that a claim that recites a function and some structure, but not enough to support the function, stands on the same footing as a functional claim and should be rejected.

Bitner, 140 O. G. 256.

It is competent, when the circumstances of the case permit of it, for an inventor in describing a machine or apparatus which he has devised to make a claim for a process which his patented device is capable of carrying out. But to entitle him to do this, the process must be one capable of being carried out by other means than by the operation of his patented machine, and unless such other means are known or within the reach of ordinary skill and judgment, the patentee is bound to point out, for unless the public are informed by what other means the process can be carried out, the process is to them nothing else than the operation of the machine, in other words the exercise of its function. The function of a machine is not patentable.

White, 136 O. G. 1771..

Functional claims, that is, claims for a function merely or which fails to include sufficient mechanical elements to effect the function expressed in the claim, are open to objection, and from objection made on such ground petition may be taken to the Commissioner.

On the other hand, claims which while including sufficient mechanical elements to effect a function stated therein, depends upon that statement of function to distinguish them from what is old in the prior art are not to be objected to as functional, but are open to rejection if in the opinion of the Examiner the statement of function is insufficient, the question being a question of merits and not of form.

Plumb, 131 O. G. 1165; citing McMullen, 84 O. C. 507.

The mere function of a machine is not patentable.

Steinmetz, 1905 C. D. 249, 117 O. G. 901; Frasch, 1905 C. D. 264, 117 O. G. 1167.

To merely state in a claim the function or the result without first including therein the structure by means of which the

function or result is obtained renders a claim vague and indefinite.

Kotler, 1901 C. D. 62, 95 O. G. 2684.

Functional claims are: First, those covering a function, result or effect not a product or composition of matter; second, those covering the function of a machine or apparatus; third, those reciting the functions of elements and not their structure; and fourth, those defining sets of mechanism by statements of the results produced. 1st. Should be rejected. 2d. Should be rejected. 3d. Should be objected to if vague or indefinite, otherwise receive action on their merits. 4th. Are bad in form and should be objected to, but should also receive action on their merits.

Knudsen, 1895 C. D. 29, 72 O. G. 589.

A description of the function which a feature performs and the manner of its construction does not render a claim objectionable as being functional.

National Car Brake Shoe Co. v. Lake Shore & Mich. Southern R. R. Co., 1880 C. D. 664, 18 O. G. 1179; Keith, 1876 C. D. 93, 9 O. G. 744; Hahn, 1875 C. D. 1078, 8 O. G. 597; Gray, 1877 C. D. 18, 11 O. G. 329; Shippen, 1875 C. D. 126, 8 O. G. 727. See, however, Ives, 1878 C. D. 134, 15 O. G. 385; Scott v. Ford, 1878 C. D. 106, 14 O. G. 413. Claims of this description involved in Sargent v. Hall, etc., Co., 15 A. E. 573; Holley v. Vergennes Co., 1880 C. D. 661, 18 O. G. 1177.

That a claim is purely functional is always a proper objection to it.

Shippen, 1875 C. D. 126, 8 O. G. 727; Harrison, 1876 C. D. 170, 10 O. G. 373; Hicks, 1879 C. D. 200, 16 O. G. 546.

A claim fairly susceptible of an interpretation which renders it functional is inadmissible.

Ives, 1878 C. D. 134, 15 O. G. 385.

A claim to a mechanism having certain capabilities without reference to the mechanism, or instrumentalities whereby those capabilities, or functions, are obtained is bad, unless it be construed to mean the combination of instrumentalities whereby the recited effects or functions, are produced. Good practice requires that the specification and claims in a patent shall mean just what they seem to mean.

Anders v. Gilliland, 1880 C. D. 1, 19 O. G. 177; Arkell, 1871 C. D. 263; Ives, 1878 C. D. 134, 15 O. G. 385.

A claim reciting definitely the article invented, and quali-

ifying its structure by describing the function performed is not functional, but an approved form.

Gray, 1877 C. D. 18, 11 O. G. 329; Keith, 1876 C. D. 93, 9 O. G. 744.

The function of a machine is that operation, which when set in motion it inevitable performs.

Shippen, 1875 C. D. 126, 8 O. G. 727.

(14) *Difference in Claims.*

The claims may be to the same thing though this thing was used in quite different devices.

Walker v. Brunhoff, 1905 C. D. 454, 118 O. G. 2537.

A claim stating that a reagent is added during the manufacture of a compound is not a duplicate of a claim in which "during the manufacture of the compound" is omitted.

Reese, 1904 C. D. 484, 113 O. G. 849.

If two claims are only distinguished by the words "substantially as described" one must be cancelled.

Shepler, 1902 C. D. 17, 102 O. G. 468.

Two claims in the same application which differ only in reference letters are so similar as not to be both allowable.

Ex parte Osborn, 1900 C. D. 137, 92 O. G. 1797.

The Office is more liberal in construing the difference between claims in one application than if they were in separate application, both as to the materiality and patentability of those differences.

The tests of patentability are the same in kind but are not so rigidly applied as if the claims were in different applications.

Griffith, 1898 C. D. 233, 85 O. G. 936.

Two claims are not, as a matter of form, substantially alike when corresponding elements are set forth broadly in one and specifically in the other, and when one includes an element neither actually nor impliedly included in the other.

Baackes, 1893 C. D. 70, 63 O. G. 909.

(15) *Indefiniteness, Vagueness.*

Claims for an apparatus which includes among other elements an "arrester," a "mechanical separator," and a "chemical separator," are not vague and indefinite on account of their failure to state the specific characteristics of such elements where the description fully and clearly describes the construction referred to by such terms, the objection going to the breadth or scope of the claims rather than to their form.

Donk, 1905 C. D. 498, 119 O. G. 965.

It is not alleged that the invention can not be fully and readily understood from the present specification, nor does it appear that the claims are rendered indefinite or ambiguous by the word "stretcher" or that the applicant's use of the word is absurd or clearly erroneous. Objection to use of word overruled.

Welch, 1905 C. D. 136, 115 O. G. 1850.

As to indefiniteness of claims, see,

Scott v. Ford, 1878 C. D. 106, 14 O. G. 413.

A claim is improper that refers to a substance as a gas, after it has been liquified, and that makes the process of liquification a part of the process of making the gas. The claim "as an article of manufacture and sale, liquified chloromethyl sulphurous gas in a receiver, substantially as described" is indefinite, as it may mean either the receiver and its contents, or its contents alone.

Du Motay, 1879 C. D. 269, 12 O. G. 1002.

The constructing, etc., is ambiguous.

Cornell, 1872 C. D. 120, 1 O. G. 573.

(16) *Alternative—Modifications—Equivalents.*

If part of a combination is stated to be a square table on four legs, and neither the shape of the table nor the number of legs is a matter of any importance, so long as the table is large enough and is maintained in a horizontal position, a triangular table on 3 legs would be an equivalent of the element specified.

Autopiano Co. v. American Player Action Co., 217 O. G. 1055-6.

The equivalency of other metals with iron is to be found not in their chemical structure, but in their functional efficiency when combined with cerium in a metallic alloy (cases distinguished). If in the claimed scope there is an element not having the function the claim is too broad, etc.

Treibacher v. The Roessteret, 209 O. G. 1689.

Yielding means for forcing rolls together infringed by rolls having yielding surfaces.

Palmer v. Jordan, 192 F. R. 42.

The words "or equivalents" objectionable in claims.

Phillips, 135 O. G. 1801.

Where an applicant employes two terms to designate a particular element, both of which terms describe the element correctly, the claim has been held to be unobjectionable since

the applicants alternativeness is of language rather than of structure (cites Holder, 107 O. G. 833).

Phillips v. Sensenich, 132 O. G. 677.

The range of equivalents depends upon the extent and nature of the invention. If the invention is broad and primary in its character, the range of equivalents will be correspondingly broad under the liberal construction which the courts give to such inventions.

Continental Paper Bag Co. v. Eastern Paper Bag Co.,
136 O. G. 1297.

There seems to be no good reason, therefore, why the applicants should not in their claims identify the substance used by a statement of the characteristics necessary. The words "brick or the like" are not a broad statement of the characteristics, but are alternative in form and indefinite in substance.

Caldwell and Barr, 1905 C. D. 58, 120 O. G. 2125.

A mechanical equivalent must be adapted to use as a substitute for something else, and competent to perform the function of a particular device for which it may be substituted. The word "equivalent" means equal in force or effect. 11 Am. & Eng. Enc. Law (2d Ed.) 252.

Alacka Parkers Assn. v. Telson, 119 F. R. 611.

The maxim "*innumeratio unius exclusio alterius*," by reason of the doctrine of equivalents does not apply as fully to patents as to instruments in general.

Reece Button-Hole Machine Company v. Globe Button-Hole Machine Company, 1894 C. D. 360, 67 O. G. 1720.

In the present case if the applicant desires nothing more than the benefit of the law of equivalents, the expression "or equivalent cleaning device" is surplusage. If he desires some advantage beyond that which the law of equivalents gives him, he is seeking more than can properly be accorded him.

Cook, 1890 C. D. 81, 51 O. G. 1620.

Modification can not be claimed.

Bogart, 1876 C. D. 163, 10 O. G. 113.

A claim having the phrase "one or more" is alternative in form, if the elements covered by such phrase are not duplicates.

Hulbert, 1893 C. D. 74, 63 O. G. 1687; Thorsen, 1893 C. D. 75, 63 O. G. 1688.

Alternative claims and claims for modifications have been repeatedly condemned, the former for uncertainty, the latter for the reason that if the alleged modifications are in fact the same invention, a claim to one obviously covers the other, and

if they are for different inventions they are not allowable in one application.

McDougall, 1880 C. D. 147, 18 O. G. 130; Ried, 1879 C. D. 70, 15 O. G. 882. See Walker on Patents, sec. 176, p. 126.

The word "equivalents" in a claim should be very carefully scrutinized, especially in reissue applications, but it might be admitted if it did not render the claim ambiguous.

Haase, 1873 C. D. 170, 4 O. G. 610.

The words "or their equivalents," when they refer to well defined devices, are not objectionable.

McLelland, 1872 C. D. 152; Continental Windmill Co., 1870 C. D. 74.

(17) *Article of Manufacture.*

A sound record made from a cut laterally undulatory groove diverging from the bottom of the same to the surface of the record tablet.

Victor Talking Machine Co. v. American Graphophone Co., 189 Fed. R. 359-366.

Of course, claims for a product not defined as the product of a process must contain in themselves adequate differentia, or they will not be good.

Parke-Davis & Co. v. H. K. Mulford Co., 189 F. R. 95-102.

As a new product, crystalline calcium carbide existing as masses of aggregated crystals substantially as described. Sustained. But said to be limited to an aggregated crystals. Patentable novelty in a case like the present, may be founded upon superior efficiency; upon superior durability, including the ability to retain a permanent form when exposed to the atmosphere; upon a lesser tendency to breakage and loss; upon purity and in connection with other things, upon comparative cheapness. Commercial success may properly be compared with mere laboratory experiments.

Union Carbide Co. v. American Carbide Co., 160 O. G. 493:

Seems to and does recognize claims for articles defined by the method of making them.

Mosler Safe Co. v. Mosler, 127 U. S. 354.

"The process may be referred to in defining the article only when it can not be otherwise defined." (Apparently *dictum*.)

"The structure of the article when finished does not reveal the particular procedure specified in the claim." Therefore, the claim is improper.

Scheckner, 106 O. G. 765.

If an article of manufacture is a new thing, a useful thing,

and embodies invention, and that article can not be properly defined and discriminated from the prior art otherwise than by reference to the process of producing it, a case is presented which constitutes a proper exception to the rule.

Refers to *Globe Nail Co. v. W. S. Horse Nail Co.*, 19 F. R. 819; *Painter*, 57 O. G. 999 (approved 106 O. G. 765).

Dental plate made of hard rubber. The material made it possible to make a satisfactory plate as well as contributing by its characteristics to make the completed plate successful.

Smith v. Goodyear, 93 U. S. 486.

A claim for an article defined by the process of making it was rejected for this reason and the rejection affirmed by the Board and the Commissioner returned it to the Primary Examiner for consideration on the merits.

Rogers, 1890 C. D. 121, 52 O. G. 460.

After a patent is granted for an article described as made by causing it to pass through a certain method of operation to produce it, the inventor can not afterwards, on an independent application, secure a patent for the method or process.

Cited from *Trevette*, 97 O. G. 1174; *Mosler Safe & Lock Co. v. Mosler, Bohmann & Co.*, 43 O. G. 1115.

Risdon Iron & Locomotive Works v. Medart et al., 71 O. G. 751.

A plate or dish cut or scooped from a block of wood in concavo-convex form. Good.

Oval Wood Dish Co. v. Sandy Creek Wood Mfg. Co., 60 F. R. 285.

Said not to be an authority to the effect that an article may never be defined by the process of making it.

Painter, 57 O. G. 1000; *Rumford Chemical Works v. Sauer*, 10 Blatch 162.

Type-block with letters, figures or characters produced thereon in the manner substantially as described. The article was old, the novelty was in the process entirely. Said not to sustain the proposition that a claim to an article may never be defined and limited by the process of making the article.

Painlir, 57 O. G. 1000; *Draper v. Hudson*, 6 Fish. 327, 3 O. G. 354.

“Artificial alizarine produced from anthracine or its derivatives by either of the methods herein described, or by any other method which will produce a like result.”

If this product is the same as the alizarine obtained from matter it is old; if it is different and is only the product pro-

duced by the process described, it is not shown that defendant has infringed.

Every patent for a product or composition of matter must identify it so that it can be recognized aside from the description of the process of making it, or else nothing can be held to infringe the patent which is not made by that process. Page 817.

Cochrane v. Badische Anilin Co., 27 O. G. 813, 111 U. S. 293-313.

A difference in the physical characteristics of the pulp made by the process was alleged.

It seems to be assumed that if the facts were so, the product of that process would be patentable, but it is said that this was not the fact.

The Wood Paper Patent, 23 Wall. 566.

A nail made by punching or cutting from hot-rolled ribbed bars of metal a headed blank, substantially as described, and by elongating, hardening, and compressing the shanks of such blanks by cold-rolling from the head to the point, thereby giving to all parts of the nail so produced the peculiar qualities specified. Good claim, see *Painlir infra*.

Globe Nail Co. v. W. S. Horse Nail Co., 19 F. R. 819.

A valve-cup constructed of or from horn.

"The claim is to be for an article of manufacture; and it will cover the same article whether manufactured by the process described or otherwise."

Shalters, 1879 C. D. 79, 15 O. G. 970.

"Molded in the manner and for the purpose" may mean that a certain process is pursued, or that the artificial charcoal, when completed, is possessed of certain distinguishing characteristics.

In the first case it has nothing to do with the finished product, in the second resort, must be had to the specification and the claims must express their own meaning.

Designolli, 1878 C. D. 10.

An inodorous and waterproof straw plastering board made in continuous lengths and wound in rolls. Reference to process improper.

Judd M. Cobb, 1874 C. D. 60.

The fact that an article is only useful in connection with some other thing does not necessarily make it unpatentable, as incomplete and inoperative. It is patentable if it is capable of separate manufacture and sale.

Johnson, 1880 C. D. 207, 18 O. G. 1052; Blanchard, 1870 C. D. 59.

A stovepipe elbow made from a blank of sheet iron, having a single longitudinal seam and formed without crimping and cutting, this presenting a smooth surface of uniform thickness throughout when finished.

Proper. "The stovepipe elbow in question is to be contemplated independent of any process."

Lupton, 1874 C. D. 40.

Packing composed of canvass strips, preliminarily treated with bees-wax or other lubricant, followed by rubber solution, as described, and then wound spirally in successive, separate, concentric layers on a suitable mandrel or form.

It indirectly indicates its nature by reference to the method or methods employed in its construction, instead of directly setting out the characteristics of the packing itself. This is objectionable because a claim for a manufacture must rest upon the novelty of the product without reference to the "art" employed in its construction.

Mayall, 1873 C. D. 134.

Reference to the process of manufacture in a claim for an article of manufacture is improper.

Sellers, 1872 C. D. 197, 2 O. G. 246; Ackerson, 1869 C. D. 74; Truesdell, 1870 C. D. 123; Designolle, 1878 C. D. 10, 13 O. G. 227; Cobb, 1874 C. D. 60, 5 O. G. 751; Lupton, 1874 C. D. 40, 5 O. G. 751; Shalters, 1879 C. D. 79, 15 O. G. 970. But see Oval Wood Dish Co. v. Sandy Creek Mfg. Co., 60 F. R. 285.

A claim for an article put up for sale is a more convenient form sustained.

Horlick, 1875 C. D. 57; Heide & Wirtz, 1875 C. D. 135, 8 O. G. 817.

An applicant for an article of manufacture is not confined to one claim.

Sumner, 1871 C. D. 180, 3 O. G. 19; Adams, 1873 C. D. 18, 3 O. G. 150.

If an article is capable of use only in connection with a certain machine, if in other words, it is a mere fraction of a machine, it can not be claimed separately as an article of manufacture.

Blanchard, 1870 C. D. 59.

A rolled out column. The process of making did not confer patentability.

Sellers, 1872 C. D. 197.

As the claim is for a car wheel the process of making it, that is, the mode of putting the parts together, can not enter

as an element to qualify the character of the manufactured article.

The distinguishing feature of the article seems to have been anticipated.

Truesdell, 1870 C. D. 123.

(18) *Process—Sub-Process.*

“The three steps to be taken are the ‘blowing off,’ the ‘washing’ and ‘refilling’ processes. Of course, these may be regarded as successive. A structure may have for its purpose the accomplishment of either one alone. But the broad purpose sought to be accomplished does not place any limitation upon the endeavors to incorporate the so-called units into a single structure, seeking thereby to discharge the various functions successively and cooperatively.”

Wenstow Co. v. National Boiler, etc., 226 F. R. 954.

The definitive part of claim 5 refers only to an alleged method of producing mechanical motion. It is not contended that this method of producing mechanical motion is novel in and of itself and the patentability of the method could accordingly rest, if at all, only upon the steps by which the mechanical motion is utilized for regulating the generator, which steps are not set forth in this claim.

In re Creveling, 117 O. G. 1167.

The alleged process claims in this case are not patentable in view of a prior patent to the same applicant upon the apparatus disclosed under the particular circumstances of the case.

In re Creveling, 117 O. G. 1167.

Where an alleged process claim includes the step of rotating an armature and concludes “and by said motion in one direction increasing the output of the generator and in the other direction decreasing the said output,” but it appears that the result stated is not accomplished by the mere motion of the armature, but by the interposition of a rheostat, held that the claim is not patentable since it does not include all of the steps necessary to effect the result stated or any useful result.

In re Creveling, 1905 C. D. 684, 117 O. G. 1167.

The mere function of a machine is not patentable and claims to it should be rejected; but there seems to be no good reason for requiring division between a machine and the mere function of that machine. Such a relation argues unity rather than diversity of invention.

Steinmetz, 1905 C. D. 249, 117 O. G. 901; Frasch, 1905 C. D. 264, 117 O. G. 1167.

2. The process of preparing oryphenyltartronic acids which

consists in introducing a condensation product of phenol and alloxan into alkali solution and heating the whole.

3. The process of preparing cryphenyltartronic acids which consists in introducing a condensation product of phenol and alloxan into alkali solution and heating and stirring the whole over a water-bath.

If the only difference between the pair of claims was the mere act of stirring it would not be a substantial one. Heating at a moderate temperature, i. e., over a water bath is, however, a substantial difference and both claims may remain.

Ex parte Ach, 1901 C. D. 140, 96 O. G. 2411.

An applicant may properly in one case have claims covering the principal or essential steps of his process and other claims including those steps together with other specific steps which are not absolutely necessary to the performance of the process, but which add to its efficiency or make its operation more perfect.

Axnard & Baur, 88 O. G. 1527.

Claim 1 of the method patent is for a combination and describes the operation.

Edison v. Allis-Chalmers, 191 Fed. R. 841.

The process is patentable and not the mere function of a machine, although but one apparatus is known or suggested for carrying the process out.

Holt, 1894 C. D. 82, 68 O. G. 536.

Passing upward through falling impurities and flour commingled, a current of air purified by centrifugal action, then subjecting the dust-laden air to centrifugal action, and finally passing the air so purified back to be used again in the same series of steps, all in closed chambers and conducts, constitute a true process.

Holt, 1894 C. D. 82, 68 O. G. 536.

Where the separate steps in the process are found separately in different patents, but taken with a different effect and in necessary relations with another set of operations and in none of them as a complete process, these steps, when brought together, bear the same relation to one another and to the prior art that the few and simple elements of an improved machine bear to the many and complicated elements of its precursor.

Rudd, 1894 C. D. 79, 68 O. G. 535.

Process. Functional claim.

Williams, 1892 C. D. 213, 61 O. G. 423.

A mechanical process that is not patentable.

Jaeger, 1889 C. D. 121, 46 O. G. 1637.

Claim to a mechanical process.

Young, 1889 C. D. 116, 46 O. G. 1635. (See 1892 C. D. 214, 1890 C. D. 165-166.)

To sustain a claim to a mechanical process the steps taken must be novel, and some means must be described by which the process can be carried on.

Tyne, 1880 C. D. 2, 17 O. G. 56.

The question whether a complete process, chemical or mechanical, can be subdivided in an application, and whether, when it is so subdivided, a claim for one of the subdivisions can be joined with a claim for another, or with a claim for the complete process, turns on the question whether such subdivision constitute subprocesses, effecting themselves distinct results subsidiary to the general result of the entire process.

Smith, 16 O. G. 630; McDougall, 1880 C. D. 1407; Dailey, 1878 C. D. 3, 13 O. G. 228; Wheat, 16 O. G. 360; Leoser, 76 C. D. 104, 9 O. G. 837.

Where the operation of a machine, or series of machines, is supplemented by some new method of operation not contemplated in the construction of the machine, and not the inevitable result of its operation, it may amount to a patentable process, even though the operation depends necessarily upon the machinery.

Shippen, 1875 C. D. 126, 8 O. G. 727. See Harrison, 1876 C. D. 170, 10 O. G. 373; Hichs, 1879 C. D. 200, 16 O. G. 546.

Claims for what are called mechanical processes are, in the majority of instances, objectionable, as they are for the function of the machine.

Case v. Hastings, 1875 C. D. 37, 7 O. G. 557.

(19) *Printed Matter.*

A contract unconnected with any tangible device is not a patentable invention.

In re Moeser, 1906 C. D. 685, 123 O. G. 655.

The duplication of closures is not patentable.

Seabury, 1903 C. D. 222, 110 O. G. 2013.

Claims for new arrangements of printed matter on tickets, circulars, pads, books, etc., are generally arbitrary in their nature, and due entirely to mere fancy, or simple mechanical skill, and are not proper subjects for patents.

Gerson, 1877 C. D. 19, 11 O. G. 244.

(20) *Introductory Clause.*

The real question here is whether it conduces to a clear and distinct pointing out of the invention, if the "supporting

structure be specified in the form of a preamble sharply separated and distinguished from what is the description of the real invention.

Assistant Commissioner Clay in *Ex parte Jepson*, 243 O. G. 525.

Forsyth v. Garlock, 142 Fed. Rep. 461, although it was a case unlike the case at bar in that the preamble stated a use and not a supporting structure, yet shows how the preamble of a claim is very properly a part of it for the purpose of stating the use which is part of the invention, even though it does not import any structure into the claim.

Assistant Commissioner Clay in *Ex parte Jepson*, 243 O. G. 525.

The preamble may be an actual limitation if the real invention can not exist apart from it, whereas if the real invention does not at all depend upon it, then the preamble is a mere explanatory name and title. (A discussion of the whole matter with cases bearing thereon.)

Jepson, 243 O. G. 525-528.

While these words have as a matter of law no real effect at all upon the claim, still they sometimes signify the draughtsman's sense that his terms, while very broad, are to be read upon the actual disclosure.

National Elec. S. Co. v. Tellefunken W. T. Co., 209 F. R. 857.

The introductory clause disregarded and a device held to infringe notwithstanding it did not come within this clause.

Western Electric Co. v. La Rue, 139 U. S. 601.

The preamble to a claim does not render it patentable.

Colts Patent Firearms Mfg. Co. v. Wission, 122 F. R. 95.

The introductory phrase is not an element of the combination and does not limit the claim to such apparatus.

Casler, 1899 C. D. 5, 90 O. G. 448. See also *Stearns v. Russell*, 85 F. R. 218; *Colts Patent Firearm Co. v. Wesson*, 122 F. R. 90-94.

Where a claim is drawn to cover a mechanical movement and that claim is amended by inserting at the beginning of the same a descriptive phrase indicating the nature of the machine in which the invention is used. Held that the status of the claim is not changed by such an amendment.

Gally, 1903 C. D. 480, 107 O. G. 1660.

The introductory phrase is not an element of the claim.

Casler, 1899 C. D. 5, 90 O. G. 446.

Where a claim is drawn to cover a mechanical movement and that claim is amended by inserting at the beginning of

the same a descriptive phrase indicating the nature of the machine in which the invention is used. Held that the status of the claim is not changed by such an amendment.

Gally, 1902 C. D. 480, 107 O. G. 1660.

(21) *Expression of Degree in Claims.*

It is not possible when dealing with fractional niceties to use any safer language else the risk is run of escape from the patent by some technical scientific variations.

Vacuum Cleaner Co. v. Am. Rty. Valve Co., 219 O. G. 587. See also Woerheide v. Johns-Manville, 215 F. R. 604; 220 F. R. 674.

It is contended that such expressions as "sufficient abruptness" and "arched transversely" are vague and do not give that information to which the public are entitled.

I can not agree with this contention. It is difficult, if not impossible task, to express "sufficient abruptness" and "arched transversely" in terms of mathematical accuracy.

Woerheide v. H. W. Johns-Manville Co., 215 F. R. 606.

Besides being made of this material the shell is to be relatively to the core inclosed "of such thickness as to give it the required rigidity."

Haskell Golf Ball Co. v. Sporting Goods Sales Co., 210 O. G. 625.

The claims in issue require that the gutter be resilient to a degree such that the resilience performs some useful function in practical use.

Kawner Mfg. Co. v. Ventwill Store Front Co., 210 Fed. R. 459-461. This was said of claims in which the degree was not referred to.

"As a new article of manufacture, a detachable razor blade of such thinness and flexibility as to require external support." This seems to be a good claim.

Clark Blade & Razor Co. v. Gillette Safety Razor Co., 194 Fed. R. 421.

The combination, with a water meter having its chamber-forming case made relatively strong of an inclosing head therefore made relatively weak, whereby to form a yielding part against undue interior pressure. Sustained.

National Meter Co. v. Neptune Meter Co., 122 F. R. 75.

Of a length which will accomplish the result sought to be achieved, and his patent discloses a method for determining that length with mathematical exactness, his claim may fairly be sustained for the length thus shown, although it might be

that some other length covered by the language of the claim, but not of the rule, would fall outside the claim.

Westinghouse Electric & Mfg. Co. v. Orange County Gas & Electric Co., 119 F. R. 365; Vid. 113 F. R. 884.

"Equidistant" and "approximately" read into the claim in view of the function of the machine.

Krajewski v. Pharr, 105 Fed. Rep. 519.

"More or less" in claim approved.

Krajewski v. Pharr, 105 Fed. Rep. 518.

(22) *Process, Combination and Article Claims.*

The claims are all limited to the location of the lower reservoir in a deep pit, it adds nothing to their patentability for it is purely a structural idea and not a process idea. The cycle of operations and the relation of cause and effect in the various steps of the process are exactly the same, whatever the nature of the supports for the water tanks and whatever their location relative to a selected part of the earth's surface. (Court of Appeals quoting the Commissioner.)

In re Fessenden, 226 O. G. 1081.

S. C. U. S.—Fireball Gas Tank & Ill. Co. et al. v. Commercial Acety. Co. et al., 221 O. G. 1039.

"Applicants' invention is of that nature where it is difficult to express the entire invention by the article and it is difficult to express the exact invention by the process."

In such case both forms of claims should be allowed.

Kilbourn, Smith and Kilbourn, 221 O. G. 737.

Whether the invention lies in the apparatus or process is a difficult question from which the applicant should not suffer because of a wrong conclusion.

Edison, 220 O. G. 1373.

The new process clearly does not make new that which was old.

McNeil Ct. of App., 200 O. G. 583.

While it is true that a combination of old steps to produce a new result amounts to invention, yet in this case, so far as we are advised by the record the various steps of the process produce but a combination of known results. This is a mere aggregation.

In re Merrill, 199 O. G. 620.

A claim a decaffinized coffee, the caffein having been removed after the coffee was roasted, anticipated by coffee from which the caffein had been removed before roasting.

The process was patentable but the product was the same thing.

Roselius, 162 O. G. 272.

He did three things, which differentiate his method and the product of it, in three steps which are sequential, the order of which is essential, and all so dependent on each other that none may be omitted without destroying or at least failing to obtain the resultant product.

Farmers Mfg. Co. v. Spruks Mfg. Co., 119 F. R. 597.

Process and product identical in scope. Cases cited and distinguished.

Trevette, 97 O. G. 1174.

If the claims contain limitations, whether proper or improper, which make the alleged process claims indivisible from the apparatus claims division can not be required. A mere mode of operating apparatus can not be regarded as so unrelated to the apparatus itself that division can be required between claims to processes which amount to a mere statement of the former and claims to the latter.

Frasch, 117 O. G. 1166.

The authority and propriety of the practice of requiring division between inventions found to be independent is too well settled to require rediscussion here. It is sufficient to state that nothing is found in Steinmetz v. Allen, etc., 109 O. G. 549, to make process and apparatus any exception to this practice.

Frasch, 117 O. G. 1166.

Where the article may be made by other methods than the process claims should undoubtedly be allowed.

Kilbourn, Smith, and Kilbourn, 24 O. G. 737.

(23) *Positive Inclusion of Elements of Claims.*

These two elements being separately called for in the claims, can not be the same thing, and the drawing-rolls in defendant's machine being in practically the same form as in the patented machine can not be both the central lower gripper and the mechanism for drawing a fold away from it.

Union Paper Bag Mach. Co. v. Advance Bag Co., 194 F. R. 138.

No valid reason is apparent why the actuating mechanism and one of its elements may not be independently recited.

Duncan, Prichard and Macauley, 124 O. G. 1207-8.

Also Iserman, 188 O. G. 807.

Where claims are clear as to the elements intended to be covered thereby, and the structure is such that it can only be described with clearness by referring to other parts of the

device, there is no objection to wording the claims in this way. Without including such other parts.

Compos, 182 O. G. 719.

The rack is itself the second element of the claim, and can not therefore be the means of the fourth element.

General Electric Co. v. Allis-Chalmers Co., 171 F. R. 668.

It is well settled that where it is necessary to refer to certain elements of an invention in order to locate or define other elements they should be positively included in the claim. (125 O. G. 665.)

Stimpson, 160 O. G. 1271.

(24) *Reading Words, Etc., Into.*

Only when necessary to make the claims operative or in case of ambiguity apparent on the face of the claims, or induced by their study in connection with the specification and prior art, is a court permitted to read in an element not expressly named therein, in order to narrow a claim, so as to make valid one otherwise invalid.

Crown Cork & Seal Co., etc., v. Sterling Cork Co., 218 O. G. 875. Examples and cases—When the claim contained some general term of reference which was capable of being so narrowed by interpretation without importing an element distinctly foreign. 218 O. G. 877.

The intermittency is expressly claimed in most of the claims of the patent, and must be read into the others from the specification, in order to sustain such claims.

American Steel & Wire Co. v. Denning Wire & Fence Co., 194 F. R. 119.

Apparently an element read into a claim from the description of the patent and a device held not to infringe, because it did not include such element.

No disclosure of a device not having this element in the specification.

Edison General Electric Co. v. Crouse-Hinds Electric Co., 152 F. R. 437.

(25) *"Whereby Clause" in Claims and Operative Environment.*

The mounting has nothing to do with the essential invention of the claim, except to provide *an operative environment* and the defendants mounting accomplished the same result. Either one is "suitable."

German v. Youngstown Car Mfg. Co., 191 F. R. 583.

That this "whereby clause" adds nothing to the claim is fundamental. It is a statement of asserted result, not of method or means of reaching it; and in this instance it is but a repetition of the stated "object of the invention" with which the application begins, a sort of a Q. E. D. triumphantly affixed to the asserted solution of the problem.

Electro-Dynamic Co. v. Westinghouse E. & Mfg. Co.,
191 F. R. 508.

In the present case the "whereby" clause is so worded that it is uncertain whether applicant is depending for the patentability of the claim upon the structure of the relay as set out therein or upon the characteristics of the circuits in which the relay is to be placed. To this extent the claim is indefinite.

Hoge, 173 O. G. 1081.

(26) *Concluding Clause in Claim.*

A very full discussion of the meaning of these words in a claim.

National Tube Co. v. Marks, 209 O. G. 329.

Where the claims of a patent specify the elements of a combination, but do not specify the means whereby those elements perform their functions, but call for means generally, and close with the words substantially and as for the purpose described or specified, or set forth, such words impart into the claims the specific means described in the specification and the claims are limited accordingly.

Star Bucket Pump Co. v. Butler Mfg. Co., 198 F. R. 861. See also Union Match Co. v. Diamond Match Co., 162 F. R. 148.

To make the claims valid, in view of the statement of the nature and scope of the invention in the specification and particularly in view of the prior art, the words "substantially as described" must be taken to limit the claims to a structure which will accomplish the stated object of the invention in substantially the manner described in the invention.

American Air Co. v. General Compressed A., etc., Co.,
195 Fed. R. 751.

"The words 'substantially as specified' means substantially as specified in regard to the combination which is the subject of the claim." Quoted from Lake Shore, etc., R. R. Co. v. Car Brake Shoe Co., 110 W. S. 235 by the court in Commercial Acetylene Co. v. Searchlight Gas Co., 197 Fed. R. 914.

The words "as set forth" at the end of the claims, necessitates reference to the description to ascertain their scope.

Ellis v. Rochester Egg Carrier Co., 197 Fed. R. 765.

These words have the effect of imparting into the claims the particulars of the specification relating to the process to illustrate its operation, but not the function or operation of the mechanism there described. The specification does not add to or detract from the claims. The patent can not be extended beyond the claims. (Cases.)

U. S. Consol. S. Raisin Co. v. Selma Fruit Co., 194 F. R. 269.

The claims it will be observed all terminate with the statement "substantially as set forth." Although the language of some of them might be construed as covering a wider range of devices, it is deemed proper in view of the condition of the prior art, to limit the invention to the disclosure of the specification and drawing.

Friestedt v. National Interlocking Steel Sheeting Co., 182 O. G. 837.

Taking the description as given in the claim, it is not at all clear what is meant by a "consolidated return curved track crossing itself" and standing alone, it is a question how far it would be good. But the added words "substantially as described for the purpose set forth" carry us back to the specification. The inventor has thus committed himself to an elliptical form of track.

Thompson Scenic Ry. Co. v. Chestnut Hill Co., 119 F. R. 362.

Herein described.

Simonds R. M. Co. v. Hathorn Mfg. Co., 90 F. R. 201 et seq.

(27) *An Analysis of Claims.*

A claim may be diagrammed by placing its elements in separate numbered paragraphs with the qualifying clauses adjacent to and indented with reference to that which they qualify, thus, claim 1 of Form No. 14 might be diagrammed as follows:

The combination, in a meat-chopping machine, of

- (1) A rotary chopping block
 - (a) having an annular rib, with
- (2) a table
 - (b) having an annular recess
 - (c) to receive said rib, and

(3) a pocket

(d) communicating with the said recess,
all substantially as set forth.

Some courts have treated the qualifying clauses as elements, and these qualifying clauses have been lettered.

“Some of the elements of these claims are Miehle’s: such of them as indicate H’s improvement we have italicised.”

Miehle P. P. Co. v. Whitlock P. P. & M. Co., 223 F. R. 684.

Claim.

- 3. In a reversing mechanism a reciprocating member, relatively movable shoes carried thereby to form a guideway, a reversing member movable in a circular path and having *parallel plane bearing-faces*, to enter said guideway intermittently and cooperate with the shoes, *means to position the bearing-faces* of said reversing member to enter the guideway and means to effect relative movement of the shoes to permit the entrance to and departure of the reversing member from the guideway.

A functional qualification as “Adapted to, etc., treated as an element.”

Evans v. Hall Printing P. Co., 223 O. G. 539-541.

“These thirteen claims may be divided into two groups, one relating to the prevention of the shift or change from zigzag to straightaway or from straightaway to zigzag stitching when the needle is at the wrong stitch, and the other to the prevention of the shift from zigzag to straightaway stitching, or conversely, when the needle is in the work or material to be sewed.

Union Special Mach. Co. v. Singer Mfg. Co., 215 F. R. 598-608.

(1) A rotary member having (a) numerous elongated blades, (b) arranged lengthwise in approximately axial direction, and (c) in substantially drum form, (d) so as to enclose within them a relatively large and *practically* unobstructed intake-chambers, and (e) in transverse section arranged relatively to the axis and direction of rotation to carry with them rotatively and discharge it tangentially; and (2) a means for so mounting said rotary member as to permit tangential escape of the fluid discharged from the vanes.

Sirocco Engineering Co. v. B. T. Sturtevant Co., 208 F. R. 151.

Analysis of Claims.

Conley v. Thomas, 204 Fed. R. 93.

Analysis of claim.

Swindell v. Hagen, 198 F. R. 490.

Claims. Analysis of.

See Equitable Asphalt M. Co. v. Parker Washington Co., 197 Fed. 922-923.

The requisite elements are: (1) Opposing blades or bars; (2) Having cooperating serrated edges; (3) Means for vibrating one or more of the blades or bars to produce the feeding action.

Steiger v. Waite Grass Carpet Co., 194 F. R. 884.

Rule 38. Reference to Drawings.

When there are drawings the description shall refer to the different views by figures and to the different parts by letters or numerals (preferably the latter).

CONSTRUCTIONS.

The expressed preference for figures was inserted in 1885. If figures are used it is a little confusing to indicate section lines by the same kind of figures. Roman figures have been used for this latter purpose and the number selected that shall indicate the figure, the section of which is indicated thus: Fig. 4 is a section on the line IV—IV figure 1.

If small letters are used the "caps" may indicate the section lines and that "cap" selected which has a position in the alphabet corresponding to the figure the section locus of which it indicates. Thus, "Fig. 4 is a section on the line D—D, figure 1. Exponents should not be used, but it is sometimes convenient to indicate a part as a whole by a letter and its constituent parts by the same letter followed by a figure, thus a and a², a³, etc. Corresponding parts in modified forms may be indicated in this way.

A part shown only in dotted lines is sometimes indicated by a reference character surrounded by a dotted line.

If the German rule is followed the drawings can generally be reproduced photographically for foreign applications.

The German Rule.

Für die Bezugszeichen sind die kleinen lateinischen Buchstaben (a, b, c) in einfacher lesbarer Schrift zu verwenden. Sind mehr als 25 Zeichen nötig, so sind arabische Ziffern zu verwenden. Zur Bezeichnung von Schnittlinien dienen die grossen lateinischen Buchstaben. Winkel sind mit kleinen griechischen Buchstaben (α , β , γ) zu bezeichnen.

The French Rules.

8. Les lettres de référence et le mot Fig. placé avant le numéro de chaque figure, devront être du type des caractères latins d'imprimerie. Les mêmes pièces seront désignées par les mêmes lettres ou chiffres dans toutes les figures. Une même lettre ou un même chiffre ne pourra pas désigner des pièces différentes.

11. Les dessins ne contiendront aucune légende ou indication, timbre, signature ou mention d'aucune sorte autre que le numéro des figures et les lettres ou chiffres de référence, dont la hauteur sera de 3 à 8 millimètres. On ne devra employer que des caractères latins. Les Lettres ou chiffres de référence, qui devront être de dimensions uniformes et très correctement dessinés (1) pourront être pourvus d'un exposant, dans des cas exceptionnels. Ils seront rejetés en dehors des figures et des lignes, auxquelles on les raccordera par des attaches. Les lignes de coupe et de raccordement seront indiquées par des lettres ou chiffres semblables :

A A. B B. a a. b b. 1 1. 2 2.

Les caractères grecs pourront être employés pour désigner des angles

The British Rule.

"Reference letters and figures and index numerals used in conjunction therewith, must be bold, distinct and not less than one-eighth of an inch in height. The same letters should be used in different views of the same parts. Where reference letters are shown outside the figure, they must be connected with the parts referred to by fine lines." (Part of Rule 22).

Rule 39. Arrangement of Specification.

The following order of arrangement should be observed in framing the specification:

(a) Preamble stating the name and residence of the applicant and the title of the invention.

(b) General statement of the object and nature of the invention.

(c) Brief description of the several views of the drawings (if the invention admit of such illustration).

- (d) Detailed description.
- (e) Claim or claims.
- (f) Signature of applicant.

CONSTRUCTIONS.

212 O. G. 1063.

(f) As Frank is a common Christian name, an affidavit that it is a complete name should not be required.

Moehn, 106 O. G. 995.

(f) Middle name may be abbreviated, but first name should be written in full.

Gentry, 1888 C. D. 115.

See also Smith & Kimble, 97 O. G. 2533.

(a) While an applicant will be allowed within reasonable limits to say what the title of his patent shall be, he has not an absolute right in this or any similar matter of detail and it is the province of this Office to determine whether any title given to an invention is one which satisfies section 4884 of the Revised Statutes.

Nickola, 1891 C. D. 215, 57 O. G. 1425.

(b) The law and rules contemplate that an applicant shall point out at the outset of the specification the particular part, machine, article or composition of matter to which his invention relates, so that the remainder of the specification may be read with reference to some object clearly had in view. But that at the outset the applicant shall state the exact scope of his invention as he intends to claim it is nowhere required, and is inconsistent with law which declares this to be the object of the claim alone.

Thompson, 79 C. D. 212, 16 O. G. 588.

(b) It might not be improper for the Examiner to insist upon this statement at the outset, but after the expiration of eighteen months spent on the merits of the case, it is unreasonable to insist upon such formal objection.

Bate, 1879 C. D. 84, 15 O. G. 1012.

(b) A statement that "The invention consists of the several parts shown in the drawing" seems to be improper.

Gould, 1876 C. D. 164.

See also Bate, 1879 C. D. 84, 15 O. G. 1012.

It is not a presumption of law that a subscribing witness has a knowledge of the contents of the document to which he attaches his name; he merely attests the signature of the party, or execution of the deed.

Cushman v. Parham, 76 C. D. 130, 9 O. G. 1108.

Doubtless if the patent were actually issued, with but a single witness to the specification, or without a petition or the payment of fees, these formalities would not avoid the patent.

Atwood, 1869 C. D. 98.

Sec. 51-6.

"The requirement for two witnesses to the drawing and specification was canceled by Act of Congress, March 9, 1915.

Sec. 212 O. G. 1063.

(a) Applicant's address at which he customarily receives his mail. Care of attorney not sufficient. Object to communicate with applicant direct. Official Notice.

225 O. G. 375.

An applicant should be permitted to retain the title he thinks appropriate unless there are substantial reasons to the contrary.

Wiland, 152 O. G. 957.

Omission of address is not such a vital mistake as will warrant a refusal to consider application.

Becker, 1901 C. D. 198, 97 O. G. 1597.

Rule 40. Signature to Specification.

The specification must be signed by the inventor or one of the persons indicated in Rule 25. Full names must be given, and all names must be legibly written.

Rev. Stat., sec. 4888.

See notes to Rule 39(f).

CONSTRUCTIONS.

An application can not be received where only one of two joint inventors has signed the specification, even where the other refuses to sign.

In re Crane, 106 O. G. 999.

The words "and attested by two witnesses" struck out of the statute by amendment approved March 3, 1915.

212 O. G. 1063.

And of course the rule was amended to conform to the statute.

No affidavit required that "Ray" was applicant's full first name.

If an application is returned from the Issue Division for correction of alleged informality a ruling by the Primary Examiner on the point is conclusive.

Faulkner, 128 O. G. 886.

Where different forms of the applicant's name appear in the preamble and signature to the specification, one of them presumably a corruption or nickname, an affidavit should be required stating which is the correct form. Where the incorrect form appears in the preamble correction should be made by amendment. Where the abbreviated form or nickname appears in the signature, the patent may issue after the filing of the affidavit above referred to.

Clark, 124 O. G. 910. Cases reviewed.

The signature of the applicant by his attorney may be admitted.

Heginbotham, 1875 C. D. 93; Voelter, 1870 C. D. 84.

There are numerous decisions (Am. & Eng. Encycl. of Law, Vol. 21, p. 309) to the effect that the courts will take judicial notice of ordinary and commonly used abbreviations and equivalents of Christian names. As was stated, however, in *Ex parte Boston Fountain Pen Company, Supra*, the cases referred to show that where names have been differently written questions have arisen requiring judicial decision and it is one of the functions of this Office to prevent such uncertainty in connection with instruments which the law authorizes it to issue.

Clark, 124 O. G. 910; Gentry, 1888 C. D. 115; Smith and Kimble, 97 O. G. 2533; Boston Fountain Pen Co., 116 O. G. 2531.

In Gentry, 1888 C. D. 115, it was held on the authority of *Gaines et al. v. Stiles*, 14 Peters 322, that the insertion or omission of the middle name or initial was immaterial and that the full first given name and surname were necessary to constitute compliance with the law.

Clark, 124 O. G. 910.

"Marie, Princess of Jsenburg" informal but full name may be supplied by amendment in substitute paper.

108 O. G. 2145.

The name of the applicant must be signed. Charles Prince de Lowenstein, is not sufficient.

In re Charles, Prince de Lowenstein, 108 O. G. 562.

A signature by another person is not sufficient.

Taylor, 107 O. G. 1098.

If first name appears to be an abbreviation an affidavit to the contrary must be filed.

Smith & Kimble, 1901 C. D. 231, 97 O. G. 2533.

The application may not be passed to issue until the full first name of applicant is supplied.

Cerdes, 93 O. G. 193.

An application must not be passed to issue until the specification is signed with the full name of applicant.

(Order of Commissioner), 92 O. G. 1441.

A specification and petition signed by both inventor and assignee is fatally defective and should not be sent to the Primary Examiner.

Henze, 1899 C. D. 253, 90 O. G. 2507.

Attestation by two witnesses imperative.

Ackroyd, 1893 C. D. 58, 63 O. G. 466.

A clean draft of a specification may not be substituted for one altered as to the description and signed and sworn to by the applicant. Such an application should be stricken from the files.

Sheridan v. Latus, 1883 C. D. 76, 25 O. G. 501.

A patent granted upon a specification sworn to in blank and subsequently filled out without the inventor having a chance to examine it, is void *ab initio*.

Benton, 1882 C. D. 3, 23 O. G. 341.

It is not a presumption of law that a subscribing witness has a knowledge of the contents of the document to which he attaches his name, he merely attests the signature, or execution of the deed.

Cushman v. Parham, 1876 C. D. 130, 9 O. G. 1108.

Doubtless, if the patent were actually issued, with but a single witness to the specification, or without a petition or the payment of fees these informalities would not avoid the patent.

Atwood, 1869 C. D. 98.

Order No. 600 modified so that if an abbreviation is also a first name, like "Fred," an affidavit need not be furnished.

Bowen, 247 O. G. 245.

DIVISION OF APPLICATION.

Rule 41. Joinder of Inventions.

Two or more independent inventions can not be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application.

HISTORY.

Rule 41, of July 18, 1899, added to the wording of the present rule the following paragraph:

“A machine, a process and a product are separate and independent inventions, and claims for each must be presented in a separate application.”

By request, the *Patent Law Association of Washington* carefully considered this rule, with the above quoted clause therein and reported their opinion, with the reasons therefor, to the Commissioner.

Most of our notes are omitted up to 1900, and instead thereof is quoted a part of the report as follows:

Report of the
PATENT LAW ASSOCIATION
of Washington

On the subject of Rule 41 of July 18, 1899.

Appendix to Report

The report notes that *Ex parte Boucher*, 88 O. G. 545, and preceding that, *Ex parte Blythe*, 30 O. G. 1321, and *Ex parte Horr*, 41 O. G. 463, assume that Congress, in the statute, section 4886 of the Revised Statutes, has recognized a *natural* classification of inventions in *four great divisions*, and, after fully giving reasons for a contrary opinion, conclude:

“We are of the opinion that ‘statutory classification’ does not exist.”

The report then continues as follows:

V. The Court Opinions and Decisions.

(Note.—It should be remembered in the discussion of the court cases that the Supreme Court has held that a statutory bar may be applied and a patent held invalid, whether the bar be formally set up as a defense or not. See, for example, *Hill v. Wooster*, 132 U. S. 693-701, citing numerous cases where the principle was applied.)

We think that in the light of the court decisions the question is always one of fact, and that, as a general rule, the claims should follow the disclosure—that is, when the disclos-

ure of one invention involves or compels the disclosure of another, and claims are made for both, they should ordinarily be embraced in one application.

1. The new section of the rule is objectionable because it undertakes to convert a supposed rule of law into a rule of practice. If the rule is correct as a matter of law, it is wholly superfluous, since no rule of practice is necessary to enable a rule of law to be enforced.

2. The rule is objectionable because it casts a cloud upon thousands of existing patents which contain claims on a plurality of the subjects matter mentioned. The practice and adjudications of the Patent Office have an influence upon the courts, it sufficing in this connection to cite

Hogg v. Emerson, 6 Howard 437; *Huber v. Nelson*, 148 U. S. 270.

The statement of the rule, if permitted to stand, will unquestionably be used to fortify contentions against the validity of patents, and perhaps with success. Patents, in contravention of the principle of the rule, have been granted for over a hundred years, and none has been declared invalid for this reason.

3. Although, as just stated, numerous patents obnoxious to the principle of the rule have been adjudicated, we have been unable to find a single instance of a patent being declared invalid for that reason. As late, at least, as 1892, the Supreme Court has sustained a patent containing claims for method and apparatus.

Hoyt v. Horne, 145 U. S. 302.

To illustrate the fact that no such rule is recognized by the courts or known to the legal profession, let us refer to the Bell patent for the telephone (126 U. S.). No patent has ever been so sharply criticised and so keenly contested by individuals and powerful combinations, including the Government. Reference is usually made to the fifth claim only, this claim was held to be a method or process. But the patent has a claim for "a system of telegraphy, one for a combination of mechanical parts, two for methods for producing undulations in a continuous voltaic current," in two somewhat different ways, while, as stated, the fifth claim is for "the method of and apparatus for," etc.

We have the statement of the president of the association, who was of counsel for the defense, that the question of misjoinder was considered in preparing the attack upon the patent, and yet the point was never even raised or suggested in

court. Though millions of dollars would have freely been given to avoid the patent, it stood.

Had any such rule of law existed it would not have escaped the attention of bar and bench for a hundred years.

4. The statement of the rule is not in accordance with the opinions and decisions of the Supreme Court.

In *Powder Co. v. Powder Works*, 98 U. S. 126-137, the Supreme Court discussed two classes of cases. In the case before the court the processes described in the original patent had no connection with the compounds claimed in the reissued patent. The compounds were not made by the process, the invention of one did not involve the invention of the other, and the two inventions might have been made by different persons and at different times, as the court states. In the discussion of this matter the court read with approval, as applying to the other class, the rule announced by Mr. Justice Grier in *Goodyear v. R. R. Co.*, 2 Wall., Jr., 356, and said: "The product in Goodyear's invention was the direct result of the process. They were parts of one invention and, except in imagination, could no more be separated from each other than the two sides of a sheet of paper or than a shadow from the body that produces it."

It is hence clear that at least a process and the product may constitute one invention, and therefore that whether they do constitute one invention or two is a question of fact and not of law. The rule is hence objectionable because attempting to lay down a rule of law (which is erroneous) instead of specifying the character of the facts which must be present in order, as a matter of office policy, to justify the requirement of separate applications for such always intimately connected subjects matter.

We have carefully examined what we believe to be all of the authorities and find none which overrule *Powder Co. v. Powder Works* (*ubi supra*) or which are inconsistent therewith.

In the appendix will be found a list of the pertinent Supreme Court cases.

In these cases the Supreme Court, with substantial uniformity treated the question as one of fact and not of law. This may be aptly shown by a comparison of *Rubber Co. v. Goodyear*, 9 Wallace 788, with *Mosler Safe Co. v. Mosler & Co.*, 127 U. S. 354. In the earlier case the original Goodyear patent had been reissued in two divisions, one of which claimed the process and the other the product of that process. The court below had held the process reissue to be invalid, and no appeal from this finding had been taken. It was con-

tended before the Supreme Court that the product reissue was also invalid because the product was the result of the invalid process. In disposing of this contention, the court said: "A machine may be new, and the product or manufacture proceeding from it may be old. In that case the former would be patentable and the latter not. The machine may be substantially old and the product new. In that event the latter, and not the former, would be patentable; both may be new, or both may be old. In the former case, both would be patentable; in the latter neither.

"The same remarks apply to processes and their results. Patentability may exist as to either, neither, or both, according to the fact of novelty, or the opposite. The patentability, or the issuing of a patent as to one, in nowise affects the rights of the inventor or discoverer in respect to the other. They are wholly disconnected and independent facts. Such is the sound and necessary construction of the statute."

It is thus plain, in view of the point which was raised for decision, that the patentability of the process and that of the product were treated as independent facts, and it was the question of fact which was decided.

In the Mosler case two patents (amongst others) were involved, one for an article or product and the other for a method or process. The article patent was granted July 17, 1883, on an application filed December 27, 1881. The method patent was granted August 14, 1883, on an application filed December 11, 1882. In declaring the second patent, for the method, invalid, the Supreme Court said: "After a patent is granted for an article described as made by causing it to pass through a certain method of operation to produce it, as, in this case, cutting away the metal and then bending it so as to produce the identical article covered by the previous patent, which article was described in that patent as produced by the method or process sought to be covered by taking out the second patent."

If there be any inconsistency between these two cases, the Mosler case, being the later, must control. Regarding the questions involved in the two cases as questions of fact, the two cases are harmonious. In both cases the questions are treated as questions of fact, and in one case the contention that the two patents were invalid because granted for the same invention was dismissed because contrary to the facts; in the second case the later method patent (although concurrently pending) was declared invalid because for the same invention as the earlier article patent.

The present rule is objectionable because it undertakes to lay down an incorrect rule of law which compels separate applications, although the facts may be such as to require the different subjects matter to be embraced in a single patent. The present rule would require an inventor, under the circumstances involved in the Mosler case, to take out separate patents, one of which would necessarily be declared invalid by the courts in view of the decision of the Supreme Court in the Mosler case.

The only language which might be thought at first to support the rule, so far as we know, in the decisions of the Supreme Court, is in the extract above quoted from the case of Rubber Co. v. Goodyear. At best, however, this is but a dictum, because the court did not there decide that a single patent was void because containing different subjects matter, but on the contrary, sustained the propriety of reissuing a single original patent in two divisions for allied subjects matter where the facts showed the subjects matter to be separable. This case did not attempt to lay down a rule of law, and if it did it is inconsistent with the later cases of Powder Co. v. Powder Works, 98 U. S. 126, and Mosler Co. v. Mosler & Co., 127 U. S. 154, and the latter must control.

In other words, the courts have never held a patent invalid on the ground of misjoinder, while they have held one of two patents invalid where the same disclosure formed the basis of both.

The following citation is strongly suggestive and practically presents the attitude of the court on joinder of inventions, whether this question has arisen directly or indirectly.

Merrill v. Yeomans, 94 U. S. 568: "There is no question here but that the patent is good for the second claim, for the superheating coil with its steampipe, etc.; and we are all of the opinion that it is good for the process of distillation described in the specifications, by which the heavy hydrocarbon oils are decolorized. It is therefore a valid patent for two important matters well set forth and described."

5. There are a number of cases which at different times have been applied as supporting, indirectly, the separation of method and apparatus. For example, in *Ex parte Blythe*, *Corning v. Burden*, *McKay v. Dibert*, *Dederick v. Cassell*, *James v. Campbell*, and *Piper v. Brown*.

We believe that a critical examination of these citations will not only make it apparent that they are not applicable, but, furthermore, that they are against the argument of the decision. For example, in reference to *James v. Campbell*, 21 O.

G. 337, no one disputes that machine and process may be independent and distinct, nor is it questioned that a supposed process may be but the functional operation of the machine. In *Tilghman v. Proctor*, 19 O. G. 859, the court recognizes what no one disputes, that a process may be the subject of invention and patent, and that some means for carrying out the process should be set forth, so that the public can practice it. In *Piper v. Brown*, 4 Fisher 175, two patents for different inventions of different dates were before the court; and under *Corning v. Burden*, 15 How. 267, it is, of course, apparent that A may invent a process, and B an apparatus for carrying it out. No one wants them to put both their claims in the same patent.

Because *O'Reilly v. Morse*, 15 How. 62, is supposed to indicate that a patent can issue for but one means of effecting a result, it is not in point. No one is contending for alternative means in the same application.

A curious citation is that of *McKay v. Dibert*, 19 O. G. 1351. In that case a patent was issued for the machine, and afterwards one for the process and one for the product. The patent for the machine expired and the patents for the process and the product were declared valid, and a restraining order given against the use of the machine. If this case illustrates anything it illustrates an evil that may flow from division. Another curious citation is that of *Dederick v. Cassell*, 20 O. G. 1233. In that case several patents to the same individual were before the court, in one of which a claim for a process was allowed to stand with mechanical claims, and in others they were stricken out as being merely functional or old.

Whatever view may be held of the conclusions in *Ex parte Blythe*, we think a careful reading of the authorities there cited will discover the unfortunate nature of the selection.

After a study of those "authorities" we think it is proper to say that the conclusion of *Ex parte Blythe* becomes nothing but a mere assertion. That conclusion is in these words: "I am compelled to hold that the plain provisions of the statute, as well as the weight of judicial opinion and the dictates of what seems to me common sense, require that arts (or 'processes'), machines (including apparatus), manufactures and compositions of matter should be made the subject of separate and independent patents, except as above indicated."

We have touched upon the first two reasons. In the matter of "common sense" the jury sees it otherwise, and happily the exception kills the rule.

6. The reissue decisions have been used, though not at the present juncture, to support the separation of method and apparatus. All those decisions discuss the question of whether or not the reissue is for the same invention as the original, and whether or not the additions were within the purpose and meaning of the original description. So far as they are in point they are directly against division, for they recognize the necessity of determining as a question of fact whether or not the added invention was covered by the original description. They do not hold it as a fixed rule of law that the mere fact that one claim is for a method and the other for an apparatus, for example, is sufficient in itself to render the patent invalid.

7. The question of joinder of inventions was directly raised in the Fire Extinguisher Case, 21 F. R. 90, and in the case of Wilkins Shoe Button Fastener Co. v. Webb et al., 89 F. R. 982.

In the first case method and apparatus were included in one patent and the defense that they were not properly joined was held not a good defense.

In the latter case Judge Hammond elaborately reviews the authorities, and at page 984, says:

“I dwell upon these cases because they represent the law of the Supreme Court on this important point, as it was declared more than 50 years ago, and seemingly has scarcely been touched upon since by that tribunal, certainly not departed from or modified, so far as I can discover from the cases, subsequently. But, incidentally noticing the point, I should say, from this reading of them, that to make a patent invalid because of duplicity or double invention, the two things patented should be not only independent in form or substance, physically and structurally, but likewise independent in objective results—one to spin cotton and another to make paper, as these opinions illustrate the matter. There must be a total disconnection between the two, subjectively and objectively, if it may be so expressed.”

8. The danger of separate patents for the same invention is illustrated, for example, in the well-known cases of Miller v. Eagle, 151 U. S. 186, and Underwood v. Gerber, 149 U. S. 224.

The following quotations present the views of two of the ablest judges on the bench:

“The result of this subdivision of the main invention, the alteration of specifications, and the grant of divisional patents at different dates, was to make an entangled mass of patents,

which are to some extent intertwined with each other—a confusion which has caused perplexity to experts, counsel, and judges, and which has endangered the strength and the validity of the patents themselves.”—Judges Lacombe and Shipman (C. C. A.) in *Electrical Accumulator Co. et al. v. Brush Electric Co.*, 52 F. R. 130, 137.

“For some unexplained reason (probably because of some arbitrary rule of the Patent Office), instead of allowing a reissue with appropriate claims, the Office on the same day allowed two separate reissues—the one above quoted, and another, numbered 10375, which purports to cover practically the same invention, only not restricted as to the composition of the nonconducting sheets. This practice of so-called ‘divisional issue’ has been most unfortunate for patentees. Witness the result in *Underwood v. Gerber*, 149 U. S. 224; 13 Sup. Ct. 854. And, as was to be expected, the defendants contend that No. 10376 is anticipated by No. 10375. Fortunately, in the case at bar it will not be necessary to deprive the inventor wholly of his patent because the Patent Office saw fit to split it into two.” Judge Lacombe in *H. W. Johns Mfg. Co. v. Robertson et al.*, 89 F. R. 504, 506.

It has been suggested that a new statute might be provided which would protect prior patents and at the same time provide for the future separation of machine, process and product. We believe it to be doubtful if Congress could justly validate an invalid patent, and we believe it to be inexpedient and impolitic to put in the statute such a law. We think it too strongly suggestive of other bills having in view the interpretation of patents, and inflexibility where the opposite is desirable. In any event, the passage of the law is yet to be accomplished, and after a careful consideration we are of the opinion that it would be the duty of this association to oppose to the utmost such a bill.

9. We do not go beyond the court opinions and decisions. We do not take the “popular” or “layman” view of joinder of inventions. We appreciate the practical advantages of the separation of divisions of a machine, and yet we find in certain expressions of the legislators a reason for caution in pressing too strongly upon the public academic or arbitrary rules. For example, Senator Windom, in a speech delivered in Congress, December 18, 1878 (see *Cong. Rec.*, 45th Cong., vol. 214, p. 269), said: “The object of this amendment is to prevent the oppression and great injustice that is being perpetrated upon hundreds of thousands of innocent people by means of the patent law. A common coal stove, I am in-

formed, is covered by at least twenty patents, almost every part of it, and your laws encourage the issue of the largest possible number of patents. If, for instance, an applicant thinks he has devised a new and useful kind of a stove, and that device includes a dozen different contrivances, instead of taking a single patent for the whole and getting a patent for that kind of a stove, your laws, and this bill, I believe, expressly provides that he may divide his application into different patents, giving him the opportunity after they are subdivided, to assign one to A, another to B, another to C; and then for a single coal stove, which the poor man uses upon the prairies to keep his family from freezing, a dozen men may sue him for a dozen different royalties."

The typical argument and illustration of the effect of a free rule of joinder is found in the exceptional case of *Sessions v. Romadka*, 28 O. G. 721. In that, four articles of general applicability were claimed in one patent, showing them applied to a trunk. The court evidently did not think them "connected in design and operation," and yet did not hold the patent void. This case, an extreme one, is in point only as against the joinder of separate machines or articles of manufacture when they do not "mutually contribute to produce a simple result." It is therefore not quoted in the decisions separating method and apparatus, or method, apparatus and process.

10. How are machine patents interpreted? As the Supreme Court says, in *Machine Company v. Murphy*, 97 U. S. 120, 125, "in the light of what they do, or what office or function they perform, and how they perform it." So the disclosure should read to cover the function, and must in many cases read to cover the process, and conversely in many cases a description of the process must include a description of the machine.

This is always true of process and product. Rarely is one separated from the other where the two inventions were made by the inventor at the same time. In that class of invention the disclosure of one compels the disclosure of the other.

11. It is universally accepted that patents for a genus and a species are valid, and that the separate claims of a patent may, in fact must, cover different inventions.

What difference in effect can there be between a single patent covering a process and an apparatus for working that process, and a patent having generic and specific claims? And do not process and product bear an even closer relation in general than generic and specific claims?

There can be no doubt that the generic claim gains strength from the specific claim, and so does a process gain strength by the disclosure and claiming of the machine, and above all does a process gain strength by the disclosure and claiming of its alter ego, its products, and vice versa.

And what is the relation between broad, narrow, and improvement claims?

And what is the relation between the separate claims of some elaborate machine such as a printing press, a typographic machine, a voting machine, etc.?

12. It has been said by the courts, for example, in *Bennet v. Fowler*, that joinder of inventions is in a measure within the discretion of the Commissioner. It is true that this was said with reference to different machines; but if this be a matter of discretion with the Commissioner, then he should not frame a rule of law. The rule as it stood permitted the proper exercise of the discretion of the Commissioner; but we do not think the statutes or the courts contemplated an inflexible rule like the one now in force, made by the officer whose duty it is, in our opinion, to exercise that discretion in view of the facts of each particular case.

13. It seems clear, therefore, to us that the rule is untenable as it now stands. We are unable to see that any reason of policy exists at the present time which should require any rule at all upon the subject. It seems to us that each particular application should stand on its own basis, and its disposition should be determined by the particular facts.

Without undertaking to lay down an absolute criterion, which is impossible, as the peculiarities of all possible cases can not be borne in mind, it seems to us that a safe guide to follow generally would be to let the question of separation depend upon the character of disclosure.

Assuming novelty and patentability in each instance, if the disclosure of one subject matter involves or compels the disclosure of another subject matter, then such subjects matter should be embraced in the same application. For example, if a new product has been invented, the statute obliges the inventor to disclose in full how the product is made. If the inventor in so doing discloses a new process, he should be permitted to claim it in the same application.

In other words, the protection should be commensurate with the disclosure. If the inventor, in disclosing his new product, is obliged at the same time to disclose a new process, there is no consideration which he can offer in exchange for two

grants. The public gets all it is entitled to from the single disclosure and obtains no benefit from a second grant.

14. In our opinion, the court opinions and decisions and the illustrations they furnish are against the rule.

VI. Office Classification.

In the appendix to this report we have placed a digest of the Commissioners' decisions. Those decisions evidence that the great majority of the Commissioners treated division as a question of fact, especially where method, apparatus, and product were in question.

1. The average view is expressed in the first division of the present rule (41) and, for example, in the following quotation from *Ex parte Dailey*, 1878 C. D. 3:

"The Examiner, in refusing to consider these claims (mode, machine and product), followed the letter of the decision referred to (*Murray v. Wuterich*, 1873 C. D. 96), and felt bound by that decision; but I think that it has not been the practice of the office to adhere so closely to that decision as to make it apply indiscriminately to all cases in which processes or machines were involved; and I am of the opinion that the ends of justice are better subserved by allowing in one patent the claims for machines or processes and products, wherever their relation is such to each other as not to make it plain that they are independent inventions."

In answer to the practical difficulties, Commissioner R. H. Duell, in *Ex parte Clinton and Knowlton*, 1876 C. D. 30, said:

"The great inconvenience and confusion which the Examiner apprehends will arise from this decision may be obviated, in cases like the present one, by the Examiners furnishing to other classes duplicate drawings of those parts, which, if made the subjects of separate applications, would properly belong to such other classes."

In the report of the Examiners-in-Chief to Commissioner Montgomery, hereinbefore referred to, they say:

"Is it any relief to the work of the Office to have two cases instead of one, to receive, and enter of record, and inspect, and jacket, and stamp, and assign, and enter in the Examiner's minutes, and examine, and conduct the correspondence, and go through with all the necessary steps and proceedings up to final allowance, and to prepare, and sign, and seal, and record, and deliver the patents, and make briefs and copies of claims for publication, and print, and publish the same? If this duplication of the work of the Office be not a saving of labor,

what shall we say when, as is frequently the case, a single application is divided into a dozen or more?"

2. We do not believe the classification of the Office will be benefited by a continuance of the rule.

The classification of patents should, we think, be in accordance with disclosure and not claims. In classifying patents the Office should ignore the claims altogether and be guided solely by the disclosure made. The practical defects of the present classification are mainly due to the fact that the claims of a patent control its classification, and its specification is largely ignored. In the rare cases where a search through a single folio reveals a complete anticipation, the same end can be reached by a proper cross-reference. Except in the few cases of interferences and reissues, after a patent has been issued the Patent Office has no further interest in the claims, but it has a very great interest in the disclosures made. Bearing this in mind, it will be seen that the application of the new rule will be of no benefit to the Office classification. If a patent for a product necessarily discloses a new process, or if a patent on a new apparatus necessarily discloses a new process and a new product, these disclosures, in addition to what is claimed, must be recognized in the Office classification if it is to be of any value. There is no way of compelling an inventor to take out different patents for these allied subjects matter, and he might not be able to afford it, even if he should desire to do so, and consequently his single patent must be put into as many different classes as its disclosures warrant, provided the classification is to be accurate. The question of Office classification is thus wholly outside of the character of the claims in the patents, and the convenience of Office classification is not, in our opinion, a sufficient ground for the rule.

VII. The Fiscal Argument.

We think that the fiscal argument should not be advanced directly against the inventor, nor do we think that the larger view at present compels this argument.

Unfortunately, Congress has not correlated revenues and appropriations. If the expenses of the Patent Office exceeded its receipts, the matter of securing additional fees might be of importance, and the reason of the rule might be justified, providing it were surely effective and no better way of increasing the receipts of the Office could be devised.

But this condition of affairs does not exist. On the contrary, the Patent Office is a source of profit to the Government.

There is a large annual surplus, and a total surplus of about \$5,000,000. If the 6,000 or 7,000 patents, including method or apparatus, etc., had been divided, this surplus might have been increased by from \$40,00 to \$60,000. Instead, therefore, of being solicitous to increase its fees, the aim of the Office should be to either diminish the burden upon inventors or to increase its facilities and the boundaries of an application.

Quoting again from the report of the Examiners-in-Chief:

“But is it right to rob the inventor merely to get the fees, and compel him to take two or more patents where one would give him all the evidence of title to the exclusive use of his invention contemplated by the constitution and promised him by the law? . . . And often from poverty the inventor is forced to submit to be shorn of his rights and go before the world with a patent which covers only a fraction of his inventive work, and giving him only questionable protection for what it has been allowed to embrace.”

The report then goes on to discuss the practical dangers to the public.

VIII. The Rule as a Finality.

In *Ex parte Boucher* the Commissioner, in closing, says:

“In addition to all the reasons that have been and might be adduced in favor of the requirement of division between process and apparatus claims, it is self-evident that this question is always going to be an unsettled one unless it is disposed of by rule.”

Then why not abolish Rule 41?

Or would not the arbitrary rule of not requiring division between method, apparatus, and product be as efficient to this end?

But might not the rule rest on the disclosure, thereby following the courts, the opinion of the bar, the wishes of the applicant, and the natural suggestion of the facts? This would at the same time provide the proper safeguard to the public of putting in one grant one invention or connected inventions, making the claims commensurate with the necessary disclosure?

Can the Commissioner expect to settle this by rule? See the varying rules in the appendix. It is a matter of recent history that one Commissioner prepared and published a whole new set of rules, and that the next Commissioner canceled the whole edition and replaced the preceding rules, all within five months.

It has been suggested that this rule could be given the force of law, at the same time protecting previous grants.

We have very carefully considered this proposal. We are doubtful if the validity of prior grants could justly be the subject of a statute, and we think it inexpedient to file a bill of this sort while we are so strenuously opposing many interpreting bills before Congress. In addition to this, we believe that such a law would be hurtful for the reasons we have fully set forth; and upon the consideration of the whole matter we should deem it our duty to use our utmost endeavor against such a bill.

In the meantime, however, the rule still stands, and even if such a law were desirable it might be neither politic nor possible to secure its passage.

IX. Practical Objections.

There are many practical reasons which, in our opinion, far outweigh the supposed advantages and "convenience" of the present rule.

1. It seems manifest that the rigid application of the substance of the rule would work great hardship upon inventors. It would in many instances compel the inventor desiring to claim the protection he considered himself entitled to, to take out different patents, some of which might be declared invalid in the courts, following the decision of the Supreme Court in the Mosler case.

2. In many cases an inventor could not afford to make more than one application, and in such event the rule would restrict him to a claim for one subject matter, although in disclosing it he would be obliged to disclose other novel subject matter. In such case the inventor is obliged to select that particular subject matter which for the time being he regards as the most important to claim. The rule obliges him to disclose the remainder of his invention without corresponding protection except at onerous additional cost. The inventor must either sacrifice a portion of what he is entitled to, or at grievous burden to himself, pay out additional fees to increase the idle surplus funds of the Patent Office.

3. The present rule opens up opportunities for fraud. It compels an inventor who has invented a new product, made by a new process, which may be the only process by which the

product can be made, to file separate applications. The patent granted on either of these applications may be sufficient to monopolize the industry built upon the invention. The fact that separate applications are on file, each sufficient to support the monopoly, would enable the inventor to dispose of both applications to different people, since when the patents were granted each assignee would be wholly unable to proceed without the other.

4. The new rule also opens the door to the grant of patents to different inventors on the same invention. For example, two inventors may have invented the same new product made by the same new process. Neither may be able to afford to file independent applications. One in his application may claim the process only, while the other may claim the product only, although each may disclose the entire subject matter. In such event the patents would be granted to both on the same disclosure; the Government would have given two grants for a single disclosure; the question of priority would—in contravention of the statute—not be determined, and the public would, perhaps, be deprived of the use of the invention for seventeen years, because neither patentee could proceed without the consent of the other.

The same is true of apparatus and process, which are frequently difficult to distinguish.

5. We quote from one of the printed briefs referred to hereinbefore:

“There are several important advantages to the public in making the claims to a process and to a machine for carrying out the process in the same patent, when the two are so inseparably connected that the use of one involves the use of the other; when the practice of the process involves the use of the machine and the use of the machine involves the practice of the process.

“First. The inventions will necessarily be patented at the same time, and both inventions will become public property at the same time. If separate patents are granted, this will not necessarily be the case.

“Second. The inventions can not become the property of different owners, and the public subjected to the claims of different parties.

“Third. Infringers can not be subjected to different suits either by the same or by different plaintiffs, as they may be if separate patents are issued.

“Fourth. In case the separate patents were the property of different owners, each would be entitled to claim of an infringer damages or profits for the infringement of his own patent, and thus the party would become liable to two parties for the acts which constituted the infringement.

“Fifth. Each owner of one of the patents could be prevented by the other patent from using the invention.

“Sixth. The owner of the machine patent could not sell a machine with the right to practice the process, and the owner of the process patent could not grant a right to use the process with the right to use the machine, without which the process could not be practiced.

“Seventh. The issue of two patents gives to unscrupulous parties an opportunity to speculate upon the community, by offering them for sale separately and with the assurance that each guaranteed the right to use the invention without the interference of others.

“Eighth. If the inventions are to be embraced in separate patents, they may be sold to different parties before the applications are made, and each assignee will have the right to adopt such course as he may judge to be for his interest, independently of the other. One may file his application at once; the other may have justifiable reasons for delaying as long as the law allows. They may both be put into interference with other parties, and each be entitled to take evidence and be heard. Increased expense and delay will arise from this duplication of the parties, and additional labor to the Office.

“Ninth. Even if the two patents were allowed on the same day, the final fee for one might be paid at once and the party would be entitled to the issue of the patent. The party entitled to the other patent might, for the purpose of securing foreign patents, or for other reasons, delay the payment of the final fee to the end of the limit allowed by law. The Office could not justly delay the issue of one patent or hasten the issue of the other.

“Tenth. After the issue of one of the patents, the public, having no knowledge of the pendency of the other, might acquire rights under it by the purchase of machines, for instance, which they would have no right to use after the other patent was issued to another party.”

All that has been thus stated applies with even greater force to process and product.

APPENDIX TO REPORT.

A.

*DIVISIONAL APPLICATIONS.**Patent Office Rules.*

Prior to 1855 there appears to have been no specific Patent Office rule governing divisional applications. Applicants were allowed to claim as many different inventions as they pleased under one patent, and such patents were sustained by the courts.

Evans v. Eaton, 1 Robb. 68; Evans v. Jordon, 3 Wheaton 454.

were cases relating to a patent granted prior to 1836, covering claims to several distinct machines relating to the art of manufacturing flour.

Typical cases subsequent to the act of 1836 were those of

Wyeth v. Stone, 2 Robb. 23, 1840; Hogg v. Emerson, 6

How. 437, 1848; Hogg v. Emerson, 11 How. 587, 1850.

The first provision on the subject of divisional applications is found in the Patent Office rules of 1855, as follows:

“11. Two or more separate machines will not be allowed to be the subject of one patent whatever be the purpose for which used.”

“This is intended to change the practice of the Office in those respects wherein in certain cases all the machines used in the manufacture of one article are allowed to be claimed in one application.”

This rule apparently continued in force until 1859, when it was changed to read as follows:

“11. Two or more separate machines will not be allowed to be the subject of one patent unless connected in their design and operation.”

This apparently implies that a patent would be allowed covering two or more separate machines if connected in design and operation.

In 1863 this rule was changed to read as follows:

“12. Two or more distinct inventions should not be claimed under one application for letters patent.

“No positive rules for guidance can be laid down on this point, but in general where there are several parts or elements of a machine, art, process, manufacture or composition of matter having no necessary or dependent connection with each other, and each susceptible of separate use or application either

by itself or in other connections, all set forth and claimed under one application for letters patent, the Office requires the party to divide the application and confine the claim to whichever invention he may elect."

This was changed in 1866 to read as follows:

"12. Two or more distinct and separate inventions may not be claimed in one application; but where several inventions have a necessary and dependent connection with each other so that all cooperate in attaining the end which is sought, they may be claimed."

"13. If more than one invention is claimed in a single application, and they are found to be such that a single patent may not be issued to cover the whole, the Office requires the inventor to divide the claim and confine the invention to whichever he may elect."

In 1870, Rule 12 was changed as follows:

"12. Two or more distinct and separate inventions may not be claimed in one application; but where several inventions are necessarily connected each with the other they may be so claimed."

In 1871, Rule 12 remained unchanged, save that it became Rule 15, and Rule 13 was changed as follows:

"16. If more than one invention is claimed in a single application, and they are found to be of such a nature that a single patent may not be issued to cover the whole, the Office may require the inventor to confine the description and claim of the pending application to whichever invention he may elect.

"The other inventions may be made the subject of separate applications."

In 1876, Rule 12 was changed as follows:

"15. Two or more separate and independent inventions can not be claimed in one application, but where several distinct inventions are dependent upon each other and mutually contribute to produce the new result, they may be so claimed."

This rule remained unchanged until 1885, except that in the revised edition of 1879 it was numbered 40.

"41. If several inventions claimed in a single application shall be found to be of such a nature that a single patent may not be issued to cover them, the inventor will be required to limit the description and claim of the pending application to whichever invention he may elect; the other inventions may be made the subject of separate applications which must conform to the rules applicable to original applications.

"If the independence of the inventions be clear such limita-

tions will be made before any action upon the merits; otherwise it may be made at any time before final action thereon, in the discretion of the Examiner.

“42. When an applicant make two or more applications relating to the same subject matter of invention, all showing but only one claiming the same thing, those not claiming it must contain disclaimers thereof with references to the application claiming it.”

In 1885 the following addition was made to Rule 40:

“An application should not ordinarily embrace matters belonging to distinct official classes, nor matters belonging to distinct subclasses in cases where a contrary practice has heretofore prevailed among applicants.”

This paragraph was canceled in 1886.

In 1888 the numbers of the above rules were changed to “41, 42 and 43” respectively, and the following rule was added:

“44. A reservation for a future application of subject matter disclosed but not claimed in a pending application, but which subject matter might be claimed therein, will not be permitted in the pending application.”

These rules remained substantially unaltered until 1897, when the following addition was made to Rule 41:

“A machine, a process and a product are separate and independent inventions, and claims for each must be presented in a separate application.”

B.

The following pertinent Supreme Court cases have been particularly considered:

- (1) *Evans v. Eaton*, 3 Wheaton 454; (2) *Hogg v. Emerson*, 6 Howard 437; (3) *Hogg v. Emerson*, 11 Howard 587; (4) *Le Roy v. Tatham*, 14 Howard 156; (5) *O'Reilly v. Morse*, 15 Howard 62; (6) *Corning v. Burden*, 15 Howard 252; (7) *Bennett v. Fowler*, 8 Wallace 445; (8) *Rubber Co. v. Goodyear*, 9 Wallace 788; (9) *Clark v. Bousfield*, 10 Wallace 133; (10) *Du Bois v. Railroad*, 12 Wallace 47; (11) *Mowry v. Whitney*, 14 Wallace 424; (12) *Wood Paper Patent*, 23 Wallace 566; (13) *Merrill v. Yeomans*, 94 U. S. 568; (14) *Cochrane v. Deener*, 94 U. S. 780; (15) *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U. S. 274; (16) *Bates v. Coe*, 98 U. S. 31; (17) *Powder Co. v. Powder Works*, 98 U. S. 126; (18) *Parks v. Booth*, 102 U. S. 96; (19) *Tilghman v. Proctor*, 102 U. S. 707; (20)

James v. Campbell, 104 U. S. 356; (21) Heald v. Rice, 104 U. S. 737; (22) Wing v. Anthony, 106 U. S. 142; (23) Cochrane v. Badische, etc., 111 U. S. 293; (24) Western Electric Co. v. Ansonia Co., 114 U. S. 447; (25) Eachus v. Broomall, 115 U. S. 429; (26) Grier v. Wilt, 120 U. S. 412; (27) New Process Co. v. Maus, 122 U. S. 413; (28) Smith v. Sprague, 123 U. S. 249; (29) Lawther v. Hamilton, 124 U. S. 1; (30) Dryfoos v. Wiese, 124 U. S. 32; (31) Andrews v. Hovey, 124 U. S. 694; (32) The Telephone Cases, 126 U. S. 1; (33) Mosler Safe Co. v. Mosler & Co., 127 U. S. 354; (34) Crescent Brewing Co. v. Gottfried, 128 U. S. 158; (35) Bene v. Jeantet, 129 U. S. 683; (36) Burt v. Ivory, 122 U. S. 349; (37) Commercial Co. v. Canning Co., 136 U. S. 176; (38) Grant v. Walter, 148 U. S. 547; (39) Underwood v. Gerber, 149 U. S. 224; (40) Leggett v. Standard Oil Co., 149 U. S. 287; (41) Brigham v. Coffin, 149 U. S. 557; (42) Miller v. Eagle, 151 U. S. 186; (43) Risdon v. Medart, 158 U. S. 68.

In addition to these cases, see cases cited under heading "The Court Opinions and Decisions" in body of report.

C.

DECISIONS OF THE COMMISSIONER OF PATENTS TOUCHING UPON DIVISION OF APPLICATIONS. 1869-1899.

Collated from a Digest Prepared by Wm. D. Baldwin, Esq.

Between two or more devices or processes.

Between apparatus or machine and process or method.

Between apparatus or machine and product.

Between process or method and product.

Between genus and species.

Between compositions of matter.

Between designs.

Questions of practice.

BETWEEN TWO OR MORE DEVICES OR PROCESSES.

Yale, 1869 C. D. 110.

Cited in numerous cases.

It is within the discretion of the Commissioner whether an application shall be divided.

Two or more inventions which are capable of division, and

belong to different classes, or involve a double labor of examination, or which have no community of operation, should be presented in different applications.

Lehmann, 1870 C. D. 70; Sumner, 1871 C. D. 180; Combs, 1871 C. D. 209; Shepard, 1872 C. D. 244; Adams, 1873 C. D. 18; Stow, 1873 C. D. 30; Franklin, 1873 C. D. 116; Nichols, 1873 C. D. 118; Barker & Mack, 1873 C. D. 123; Lones et al., 1873 C. D. 165; Rice, 1874 C. D. 44; Birun, 1874 C. D. 52; Westenhaven & Adair, 1874 C. D. 58; Tucker, 1874 C. D. 97; Knott, 1875 C. D. 96; Noyes, 1875 C. D. 105.

Where the subject matter of an application consisted of a set of devices for charging cartridge-cases, and the first claim was for a cartridge-shell holder, and the second for a canister. Held that as the devices covered by these claims were in their operation especially adapted to each other, belonged to the same class of inventions, and were used in connection to subserve a common end, they formed an exception to the general rule that separate inventions should form the subject of separate applications.

The third claim was for the combination of the shell-holder, the canister and a ramming device. As these also were especially adapted to each other, all cooperated to produce a certain result, and the use of each was necessary to that result. Held that they constituted a legitimate combination.

Jopling, 1875 C. D. 153; Clinton & Knowlton, 1876 C. D. 30, 9 O. G. 249; Sergeant, 1876 C. D. 101, 9 O. G. 963; Sobinski, 1876 C. D. 161, 10 O. G. 3; Kuh, 1876 C. D. 190, 10 O. G. 587; Gillies, 1876 C. D. 195, 10 O. G. 415; Westcott, 1876 C. D. 206, 10 O. G. 546; Dieterich, 1877 C. D. 14, 11 O. G. 195; Pintsch, 1877 C. D. 43, 11 O. G. 597; Law, 1877 C. D. 119, 12 O. G. 940; Elbers, 1877 C. D. 123; Hamilton, 1878 C. D. 16, 13 O. G. 122; Bigelow, 1878 C. D. 65, 13 O. G. 913; Cardwell, 1878 C. D. 124, 15 O. G. 293; Gokey, 1878 C. D. 144, 15 O. G. 295; Sargent, 1879 C. D. 14, 15 O. G. 512; Andrews, 1879 C. D. 99, 16 O. G. 1056; Smith, 1879 C. D. 216, 16 O. G. 630; David, 1879 C. D. 310, 16 O. G. 1139; Preston, 1880 C. D. 125, 17 O. G. 853; Holub et al., 1880 C. D. 127, 17 O. G. 854; McDougall, 1880 C. D. 147, 18 O. G. 130; Van Matteson, 1883 C. D. 52, 24 O. G. 389; Martin, 1883 C. D. 79, 25 O. G. 502; Mefford, 1883 C. D. 95, 25 O. G. 881; Holt, 1884 C. D. 43, 29 O. G. 174. Leading case, cites many court cases.

Applications for letters patent are to be divided only upon lines drawn between separable and distinct parts of the thing invented. No invention can be divided upon an imaginary line, one determined by a mere difference in words, as by the relative breadth of claims to identical subject matter—that is, upon a distinction of scope, not of substance, of the mind, not of matter. Divisional applications which relate to the same machine or structure and contain claims to the constituent parts thereof which interweave with each other or overlap one another, are improper.

Overruled in *Drawbaugh*, 64 O. G. 155.

Roberts, 1887 C. D. 61, 40 O. G. 573; *Sartell*, 42 O. G. 295, 1888 C. D. 10; *Maxim*, 1888 C. D. 126, 43 O. G. 506; *Simonds*, 1888 C. D. 89, 44 O. G. 449; *Gillette*, 1888 C. D. 107, 44 O. G. 819; *Willcox & Borton*, 1888 C. D. 144, 45 O. G. 455; *Bullard*, 1888 C. D. 169, 45 O. G. 1569; *Coe*, 1889 C. D. 191, 48 O. G. 119; *Ilijinsky*, 1889 C. D. 192, 48 O. G. 1399; *Stearnes*, 1890 C. D. 49, 50 O. G. 1768; *Woodward*, 1890 C. D. 169, 53 O. G. 1090; *Speckbauch*, 1891 C. D. 36, 54 O. G. 1265; *Sawn*, 1891 C. D. 44, 54 O. G. 1561; *Steinhilber*, 1891 C. D. 336, 57 O. G. 1720; *Hine*, 1892 C. D. 11, 58 O. G. 385; *Kerr*, 1892 C. D. 61, 58 O. G. 1553.

“Although it appears that certain claims in an application are for a mechanism capable of use in other relations than that which forms the specific subject matter of the application, division will not be required if these claims have elements in common with the more specific claims of the application.”

Wendell, 1892 C. D. 95, 59 O. G. 530; *Connelly*, 1892 C. D. 102, 59 O. G. 787; *Hunter*, 1892 C. D. 149, 60 O. G. 295; *Learned*, 1893 C. D. 84, 63 O. G. 1962; *Korff*, 1894 C. D. 11, 64 O. G. 653; *Olan*, 1897 C. D. 24, 79 O. G. 861; *Burgess*, 1897 C. D. 64, 80 O. G. 861.

“It does not follow because the courts would not hold a patent invalid that it is the duty of the Patent Office to allow more than one invention to be claimed in the same application. Whether a given invention or improvement shall be embraced in one, two, or more patents is a matter about which some discretion must be left with the head of the Patent Office.

“The time arrived long since when a proper classification in the Patent Office, so as to facilitate examination and prevent mistakes in the granting of patents, requires that improvements on an old machine having a distinct status in the arts

and classified separately in this office should be presented in separate applications."

Williams, 1898 C. D. 76, 83 O. G. 1346.

Division required where two devices are independent and do not mutually contribute to produce a single result, and the action of one does not in any manner change or affect the action of the other.

Lawrence, 1898 C. D. 142, 84 O. G. 1141; Healey, 1898 C. D. 157, 84 O. G. 1281.

Separate parts of a bicycle distinct and independent inventions requiring divisional applications.

Moore, 1898 C. D. 214, 85 O. G. 152; Crowell, 1898 C. D. 219, 85 O. G. 289; Matthews, 1898 C. D. 34, 85 O. G. 1691; Richter, 1898 C. D. 274, 85 O. G. 1908; Rappleye, 1898 C. D. 289, 85 O. G. 2096; Oxnard & Baur, 88 O. G. 1526; Rouse, 88 O. G. 2242.

BETWEEN APPARATUS OR MACHINE AND PROCESS OR METHOD.

Lowe, 1870 C. D. 39.

Shippen, 1875 C. D. 126, 8 O. G. 727.

Each part of this series of machines without the others, or some equivalents of the others, would be absolutely useless, and since the invention lies mainly in the series as a complete set, and not in an improvement upon separate parts of an old set, they ought to be allowed in one application, and in one only.

Elbers, 1877 C. D. 55, 12 O. G. 2; Dailey, 1878 C. D. 3, 13 O. G. 228; Cobb, 1879 C. D. 123, 16 O. G. 175; Holub et al., 1880 C. D. 127, 17 O. G. 854; Holt, 1884 C. D. 43, 29 O. G. 174; Blythe, 1885 C. D. 82, 30 O. G. 1321.

Important Case.

The plain provisions of the statute, as well as the weight of judicial opinion and the dictates of what seems to be common sense, require that "arts" (or processes), "machines" (including apparatus), "manufactures" (articles), and "compositions of matter" should be made the subjects of separate and independent patents, except as indicated.

The exceptions are (1) when the product is entirely new, and hence the process also; (2) when the exercise of the process would produce no other product, and when the product could be produced by no other process.

Young, 1885 C. D. 108, 33 O. G. 1390.

The statute does not forbid the joinder in one patent of claims for method and apparatus.

If an applicant comes to the Office alleging a "unitary invention consisting of the process and the product thereof," which are shown to be novel and useful and are "in their nature and operation connected together," such invention may be and ordinarily should be included in one patent. Overrules *Blythe*, 1885 C. D. 82.

Herr, 1887 C. D. 105, 41 O. G. 463.

Reaffirms *Ex parte Blythe* as to "statutory classes" of invention. The method is wholly and entirely separate and distinct from the machine. This has been settled by the very highest authority.

Simonds, 1888 C. D. 78, 44 O. G. 445; *Tainter*, 1889 C. D. 133, 47 O. G. 135.

Important Case.

"While there is no express provision of the statute limiting or controlling the discretion of the Commissioner in embracing more than one invention in the same letters patent, and the courts would not for that reason declare such a patent void, the statute does prohibit the introduction into reissue patents of new matter or other invention than that covered by the original patent. The Supreme Court has held that under this prohibition no new matter could be introduced; that process and apparatus are separate and distinct inventions, and that when a patent for one has issued, although the other was distinctly shown, a reissue for both could not be maintained. (*Burr v. Duryee*, 1 Wall, 531; *James v. Campbell*, 104 U. S. 356; *Powder Co. v. Powder Works*, 98 U. S. 126; *Heald v. Rice*, 104 U. S. 737.)

"The opposite conclusion has been reached in regard to process and product when both were new and the process could produce no other product and the product could be made by no other process. This conclusion is based upon the premise that such process and product constitute one single invention. It must be deemed settled by the highest authority that such processes and products are not separate and distinct, but unitary inventions, and that the process and product may be regarded and claimed as parts of such invention, much as different elements in a combination may be separately claimed. This conclusion finds satisfactory support in the nature of the invention itself, as well as in the character of legal property residing in it.

"This conclusion excludes all other cases of process and

product, such as when either process or product is not new, or when the product can be made by some other process or the process will produce some other product."

McMahan, 1889 C. D. 169, 48 O. G. 255; Lord, 1890 C. D. 16, 50 O. G. 987.

"Although a process and an apparatus for carrying out the process are separate inventions, they are not necessarily independent inventions within the meaning of Rule 41, and when they are dependent upon each other and mutually contribute to produce a single result they may be joined in one application.

"Rule 41 does not require that in order to authorize a single patent for several distinct inventions which mutually contribute to a single result there must be such intimacy of interconnection and cooperation as to result in a third invention or combination.

"Perhaps a good working rule would be that process and apparatus are presumptively connected in design and operation where the examination of both belongs to the same division of the Office."

Norwood, 1890 C. D. 29, 50 O. G. 1129; Hyde, 1890 C. D. 41, 50 O. G. 1293; Chambers, 1890 C. D. 101, 51 O. G. 1943.

"When an application containing claims for a process and a described apparatus for practicing the process has been divided in compliance with the requirements of the Office, and patent thereafter issues for the apparatus, the Examiner is not warranted in subsequently rejecting the application for the process on the ground that the patent for the apparatus disclosed and covered the process. Such action is in effect a reversal of his decision, requiring division, and if his present action be correct division should not have been required."

Lillie, 1890 C. D. 181, 53 O. G. 2041; Forbes v. Thomson, 1890 C. D. 185, 53 O. G. 2042; Hopkinson, 1891 C. D. 4, 54 O. G. 264; Perkins, 1891 C. D. 63, 55 O. G. 139; Curtis, 1891 C. D. 206, 57 O. G. 1128.

"Division of an application as between claims for apparatus and claims for process is unnecessary where no wider range of search is required for the two than for the one."

Kerr, 1892 C. D. 61, 58 O. G. 1553; Hafely & Rediefson, 1893 C. D. 94, 64 O. G. 559; Tymeson & Borland, 1898 C. D. 48, 83 O. G. 503.

A woven fabric, a process of producing the fabric and winding yarn, an apparatus for winding yarn on the spool, and a yarn spool or bark spool are each separate and independent

inventions and should form the subject of separate applications.

Boucher, 88 O. G. 545.

Leading Case.

Process and apparatus are separate and independent inventions and claims covering both should not be joined in the same application.

Decision based upon the "statutory classification" elaborated in *Ex parte Blythe*; on the recognition by the courts of these different classes of invention; on the increased revenue to the office from separate applications; on the requirements of the examining system; on the belief that the time has come to establish stability of practice on this question.

BETWEEN APPARATUS OR MACHINE AND PRODUCT.

Murray & Wuterich, 1873 C. D. 96.

A claim for a machine and a claim for the product of the machine will not be allowed in the same application. Each must be presented in a separate application for a distinct patent.

Lupton, 1874 C. D. 40; Chamberlin, 1874 C. D. 111; Junker & Wolf, 1877 C. D. 10, 11 O. G. 110; Elbers, 1877 C. D. 55, 12 O. G. 2; Dailey, 1878 C. D. 3, 13 O. G. 228; Cobb, 1879 C. D. 123, 16 O. G. 175; Wintherlich, 1879 C. D. 171, 1 O. G. 404; Wintherlich et al., 1879 C. D. 240, 16 O. G. 808; Tyne, 1880 C. D. 2, 17 O. G. 56; Bancroft & Thorne, 1881 C. D. 55, 20 O. G. 1893; Holt, 1884 C. D. 43, 29 O. G. 174; Hafely & Redlefsen, 1893 C. D. 94, 64 O. G. 559.

BETWEEN PROCESS OR METHOD AND PRODUCT.

Stow, 1873 C. D. 30; Mayall, 1873 C. D. 134; Lupton, 1874 C. D. 40; Elbers, 1877 C. D. 55, 12 O. G. 2; Arkell, 1877 C. D. 73, 11 O. G. 1111; Dailey, 1878 C. D. 3, 13 O. G. 228; Covv, 1879 C. D. 123, 16 O. G. 175; Du Motay et al., 1879 C. D. 269, 16 O. G. 1002; O'Neill, 1879 C. D. 290, 16 O. G. 1049; Holt, 1884 C. D. 43, 29 O. G. 174; Pastor Perez de la Sala, 1888 C. C. 3, 42 O. G. 95; Simonds, 1888 C. D. 78, 44 O. G. 445; Tainter, 1889 C. D. 133, 47 O. G. 135; Fefel, 1891 C. D. 176, 57 O. G. 409; Greenfield, 1892 C. D. 5, 58 O. G. 274; Hines, 1892 C. D. 164, 60 O. G. 576; Hafely & Redlefsen, 1893 C. D. 94, 64 O. G. 559; Demeny, 1893 C. D. 125, 64 O. G. 1649.

“Within the limits of validity of the grant claims for distinct but dependent inventions may be joined in the same application or be made in separate applications, at the option of the applicant. This general rule leaves to the discretion of the Office the requirement of division in those exceptional cases in which the inconvenience resulting from a single application amounts to the necessity to divide, and leaves room, also, for the exercise of that inherent discretion necessarily left on this subject to the Office (*Bennett v. Fowler*, 8 Wall. 445.”

Kny, 1893 C. D. 131, 65 O. G. 1403; *Thomson*, 1894 C. D. 8, 66 O. G. 653.

“Where a process and its product are claimed in one application the Office will not concern itself with the inquiry whether the article might be made by any other process or whether the process will necessarily result in the particular product for the purpose of determining whether division should be ordered between process and product.

“Process and its product concern inventions which are so related that they may, at the option of the applicant, be placed in the same application, he taking all the risks of future difficulties in the courts, and it is generally thought to be the better practice to include them both in one application, since division between process and product may produce confusion in the arts and conflicting interests, as intimated by the court in *McKay v. Dibert* (C. D. 1881, 238; 19 O. G. 1351; 5 Fed. Rep. 587), since no patent has been declared void by reason of the joinder of such claims, while many have been held to be valid, since manifest advantages would follow from one uniform rule as to division, and more important than all else, since division or joinder approaches, if it does not present, a question of right in the applicant to choose between two courses, both of which are open to him, it is broadly announced that division in such cases will not be required.”

Tymeson & Borland, 1898 C. D. 48, 83 O. G. 503.

BETWEEN GENUS AND SPECIES.

Atwood, 1869 C. D. 98.

It belongs to the Commissioner to determine whether a patent shall cover more than one invention or whether all the inventions or parts of an invention described in an application shall be included in one patent or several.

The case of the *Suffolk Co. v. Hayden* in no way controls the practice of the Patent Office.

Every new device described in an application should be patented under it or under a division of it.

Cited in Numerous Cases.

Eagle, 1870 C. D. 138.

Genus and species. Can not claim two species in same application.

Bogart, 1876 C. D. 162; Howland, 1877 C. D. 120; Du Motay et al., 1879 C. D. 269, 16 O. G. 1002; Freese, 1890 C. D. 133, 17 O. G. 1095; Smith, 1888 C. D. 131, 44 O. G. 1183; Neiswanger, 1890 C. D. 37, 50 O. G. 1132; Oxnard & Baur, 88 O. G. 1526.

BETWEEN COMPOSITIONS OF MATTER.

Loeser, 1876 C. D. 104, 9 O. G. 837; Lippincott, 1879 C. D. 212, 16 O. G. 632; Hentz, 1884 C. D. 6, 26 O. G. 437.

BETWEEN DESIGNS.

Brower, 1873 C. D. 151; Tieman, 1877 C. D. 1, 11 O. G. 1; Rogers and Huggins, 1878 C. D. 62, 13 O. G. 596; Beattie, 1879 C. D. 142, 16 O. G. 267; Patitz, 1883 C. D. 101, 25 O. G. 980; Gerard, 1888 C. D. 37, 43 O. G. 1235; Petzold, 1891 C. D. 95, 55 O. G. 1651; Petzold, 1891 C. D. 97, 55 O. G. 1653; Bennett, 1891 C. D. 100, 55 O. G. 1820; Hess & Hess, 1891 C. D. 142, 56 O. G. 1334; Petzold, 1892 C. D. 235, 61 O. G. 1789; Haggard, 1897 C. D. 47, 80 O. G. 1126; Hill & Renner, 1898 C. D. 38, 82 O. G. 1988; Brand, 1898 C. D. 62, 83 O. G. 747; Wiessner, 1898 C. D. 236, 85 O. G. 937; Sherman & Harnis, 89 O. G. 2067.

QUESTIONS OF PRACTICE.

Nichols, 1870 C. D. 71; Bramwell, 1870 C. D. 76; Heginbotham, 1875 C. D. 93; Siemens, 1877 C. D. 75, 11 O. G. 969; Unsworth, 1879 C. D. 69, 15 O. G. 882; Hogan, 1879 C. D. 253, 16 O. G. 907; Emerson, 1880 C. D. 143, 17 O. G. 1451; Wheeler, 1883 C. D. 12, 23 O. G. 1031; Henderson v. Reese, 1883 C. D. 67, 25 O. G. 191; Long, 1883 C. D. 104, 25 O. G. 1189; Rohn, 1883 C. D. 106, 25 O. G. 1190; Finch, 1884 C. D. 1, 26 O. G. 273; Buell, 1884 C. D. 4, 26 O. G. 437; Clarke, 1884 C. D. 16, 26 O. G. 824.

Derby, 1884 C. D. 21, 26 O. G. 1208.

Abandonment of an invention is not to be presumed from

the fact that it is shown and described, though not technically claimed in a patent, if there is coupled with such description and disclaimer a notice and reservation of the right and declaration of the purpose to claim such invention in a subsequent application, which is in fact filed with reasonable diligence.

Ex parte Rohn, 25 O. G. 113, overruled.

Upton, 1884 C. D. 26, 27 O. G. 99; *Gaboury*, 1886 C. D. 28, 37 O. G. 217; *Ransom*, 1887 C. D. 22, 39 O. G. 119; *Roberts*, 1887 C. D. 61, 40 O. G. 573; *Maxim*, 1888 C. D. 26, 43 O. G. 506; *Simonds*, 1888 C. D. 89, 44 O. G. 449; *Gillette*, 1888 C. D. 89, 44 O. G. 819; *Smith*, 1888 C. D. 131, 44 O. G. 1183; *Regan*, 1888 C. D. 161, 45 O. G. 589; *Bullard*, 1888 C. D. 169, 45 O. G. 1569; *Carter*, 1889 C. D. 100, 46 O. G. 1391; *Neiswanger*, 1890 C. D. 37, 50 O. G. 1132; *Forbes v. Thomson*, 1890 C. D. 61, 51 O. G. 297; *Bailey*, 1890 C. D. 123, 52 O. G. 608.

Feister, 1890 C. D. 167, 53 O. G. 1089.

The formal abandonment of an application should not be required as a condition precedent to allowing another application of the same inventor pending concurrently and in condition for allowance to proceed to issue, nor should the Examiner require the erasure of any claims which would be allowed if no other application awaited consideration. The true course to be pursued is that pointed out in *Ex parte Gaboury* (C. D. 1886, 28, 37 O. G. 217).

Forbes v. Thomson, 1890 C. D. 185, 53 O. G. 2042.

Fuller, 1891 C. D. 243, 57 O. G. 1883.

An action of an Examiner that amounts in effect to a holding that an alleged divisional application covers matter that could not be legitimately divided out of the earlier application of which it purports to be a division, is reviewable by the Commissioner on petition and does not involve a question that can be taken to the Examiners-in-Chief by way of appeal.

Hine, 1892 C. D. 11, 58 O. G. 385; *Van Depoele v. Daft*, 1892 C. D. 15, 58 O. G. 520; *Freeman*, 1892 C. D. 20, 58 O. G. 522; *Fuller*, 1892 C. D. 27, 58 O. G. 804; *Sprague v. Hunter*, 1892 C. D. 115, 59 O. G. 1605; *Feister*, 1892 C. D. 203, 61 O. G. 152; *Perkins*, 1892 C. D. 222, 61 O. G. 1015; *Cahill*, 1893 C. D. 1878, 63 O. G. 1815; *Drawbaugh*, 1893 C. D. 85, 64 O. G. 155.
Henry, 1893 C. D. 88, 64 O. G. 290.

A divisional application should only contain matter carved out of the parent case; but if the matter has been fully disclosed in the earlier application, although not reached by any claim or statement of invention, such disclosure should be sufficient to secure to the applicant the benefit of the date of the parent case.

The matter claimed additional to what was claimed in the parent case should always be supported by a proper supplemental oath, or if claimed in the divisional application as first filed the oath prescribed by Rule 46 should be correspondingly changed.

Seymour, 1893 C. D. 127, 65 O. G. 751; Silvers (trademark), 1894 C. D. 54, 67 O. G. 811; Richardson v. Leidgen, 1896 C. D. 63, 77 O. G. 153; Phelps v. Hardy, 1896 C. D. 63, 77 O. G. 631; Hunter v. Wightman, 1897 C. D. 175, 81 O. G. 1788; Barry, 1898 C. D. 9, 82 O. G. 337; Osborne, 1898 C. D. 15, 82 O. G. 894; Keyser, 1898 C. D. 65, 83 O. G. 915.

Videl, 1898 C. D. 122, 84 O. G. 808.

Divisional application takes benefit of the filing date of its original.

Richter, 1898 C. D. 276, 85 O. G. 1908; Bullier, 88 O. G. 1161; Freucht, 88 O. G. 2068; Claussen, 88 O. G. 2242; Farquhar, 89 O. G. 706.

The above report is dated January 19, 1900.

The reprint of the rules of February 28, 1900, replaced the paragraph added July 18, 1899, by the following:

"Claims for a machine and its product must be presented in separate applications.

"Claims for a machine and the process in the performance of which the machine is used must be presented in separate applications.

"Claims for a process and its product may be presented in the same application."

This rule was considered by the Supreme Court of the United States in *United States ex rel., Steinmetz v. Allen, Commissioner, etc.*, 1904 C. D. 703, 109 O. G. 549. The 6th and 7th head notes of this case read as follows:

"6. The provision which compels the separation of claims for a process and claims for its apparatus is invalid, because it precludes the exercise of any judgment, however related or connected they may be.

"7. The statute gives the right to join inventions in one application in cases where the inventions are related, and it can not be denied by a hard and fixed rule which prevents such joinder in all cases."

This additional matter was canceled in 1904, 111 O. G. 584. Upon the subject of division, see further, papers read before the Examining Corps of the U. S. Patent Office.

"Title Practice in Cases Involving Division."

W. H. Whitten, Jr., Dec. 14, 1916, notes to Rule 42.

"Title Practice Relating to Division."

Loren A. Sadler.

Read before the U. S. Examining Corps, U. S. Patent Office, Dec. 17, 1914.

Rule 42. Division of Application.

If several inventions, claimed in a single application, be of such a nature that a single patent may not be issued to cover them, the inventor will be required to limit the description, drawing, and claim of the pending application to whichever invention he may elect. The other inventions may be made the subjects of separate applications, which must conform to the rules applicable to original applications. If the independence of the inventions be clear, such limitation will be made before any action upon the merits; otherwise it may be made at any time before final action thereon, in the discretion of the examiner. A requirement of division will not be repeated without the written approval of a law examiner. After a final requirement of division, the applicant may elect to prosecute one group of claims, retaining the remaining claims in the case with the privilege of appealing from the requirement of division after final action by the examiner on the group of claims prosecuted.

CONSTRUCTIONS.

The requirement of the approval of a Law Examiner in this and some other cases, is an innovation of the present

administration. A part of the Commissioner's Report to Congress relating to this subject is inserted after the notes.

The last clause in the rule had its origin in *Ex parte King*, 190 O. G. 548.

- (1) PROCEDURE.
- (2) FILING DATE.
- (3) AMENDMENT REQUIRING DIVISION.
- (4) COMBINATION, SUBCOMBINATION AND ELEMENTS.
- (5) OFFICE CLASSIFICATION.
- (6) GENERIC AND SPECIFIC.
- (7) ELECTION TO PROSECUTE ONE OF SEVERAL INVENTIONS.
- (8) PROCESS, PRODUCT, APPARATUS, ETC.
- (9) PARTICULAR DEVICES.
- (10) APPEALS.

(1) *Procedure.*

A requirement for division between claims drawn to two variations of an invention does not preclude the rejection of a divisional application containing one set upon a patent issued to applicant upon the other.

Isherwood, 231 O. G. 1211.

An application by two parties can not be a division of an application by three joint parties.

Hortzborg and Wohl, 184 O. G. 805.

Where in requiring an amendment an Examiner chooses to give an action on the merits, the action should extend to all of the claims in order that the applicant may not be misled in selecting the species to be retained. (100 O. G. 234; 156 O. G. 257.)

Burk, 184 O. G. 288.

Pressed by a technical and stubborn examiner, who seems to have been pursuing what has been called the "division fad."

Toledo Computing Scale Co. v. Moneyweight S. Co., 178 F. R. 562.

If after a requirement of division affirmed by the Commissioner, the requirement is complied with the decision of the Commissioner does not preclude the Examiner from requiring a division of one of the divided applications.

McHall, 135 O. G. 1361.

In requiring a division "it is not the duty of the Examiner to make an exhaustive search of the art, but the nearest references readily available should in each case be cited."

Moorehead, 132 O. G. 1586.

The law as we understand it does not favor the multiplica-

tion of applications and of patents for devices so closely related to each other, when they can properly be included in one application and in one patent.

Norden v. Spaulding, 114 O. G. 1829, C. P. D. C.

The question of division must be settled before an examination on the merits is had.

Snyder, 1904 C. D. 242, 110 O. G. 2236; Shaft Bearing.

Where a division has been required the divisional application should not be rejected for want of proper line of division unless the patent would undoubtedly be void if issued.

Davis, 1904 C. D. 85, 109 O. G. 1068.

The Examiner inadvertently made his action final requiring a division. In the petition to review the action of the Examiner the question of division was considered. Swing back car seat.

Pickles, 1904 C. D. 75, 109 O. G. 275.

An application rejected on the ground that the claims were not divisible from those upon which a patent was granted to applicant.

Hallowell, 1903 C. D. 268, 105 O. G. 1533; Pressed Metal Hanger.

For a later application to be a division of a prior application the invention disclosed in the latter application must contain nothing more than what was disclosed in the prior application. Upsetting Tool for Drills.

Hicks, 1903 C. D. 148, 104 O. G. 309.

Process of making and reproducing sound records. It is not intended to hold that the process of casting from a die is not an independent invention from the die and process of making it, but merely that the claims as now presented contain such limitations that it is impossible to draw any proper line of division.

Clay, 1902 C. D. 449, 101 O. G. 2567.

We do not mean to say that there may not be a way in which the power to enact Rule 41 might be brought in question as necessarily involving the denial of a substantial right under the law.

History of the rule S. C. D. C. Frasch, 1902 C. D. 560, 100 O. G. 1977.

The fact that a patent issued with two sets of claims in it is no reason that the error should be repeated.

Cavanagh, 1902 C. D. 113, 98 O. G. 2588-9.

The practice announced in some of the above decisions of rejecting aggregation claims preparatory to requiring division

will not be followed hereafter, but the question of division will first be settled.

Mansfield & Hayes, 98 O. G. 2363.

Only a cursory action should be taken on requiring division.

Reid, 96 O. G. 2060.

If the independence of the inventions is clear it is not necessary to cite references or state reasons for requiring division.

Same, 1901 C. D. 123.

The requirement of a division of an application presupposes that matter exists which might constitute the subject of two or more patents.

Pantsch, 77 C. D. 43, 11 O. G. 597.

(2) *Filing Date.*

The original application having been filed previous to Jan., 1898, the divisional application filed subsequent to that date is subject to the old law limiting the time to amend to two years.

Balzar, 101 O. G. 2824.

The divisional application has the benefit of the filing date of the original case as a date of constructive reduction to practice and under the statute relating to public use.

Waterman, 1902 C. D. 235, 100 O. G. 234.

(3) *Amendment Requiring Division.*

It is no reason for refusing an amendment that it would require the division of the application.

Law, 1904 C. D. 292, 111 O. G. 1039; Krause, 1904 C. D. 292, 111 O. G. 1039.

In the case where an applicant asserts claims for the first time by amendment to an independent invention after the Examiner has acted upon the case as originally presented, the Examiner should not require the applicant to elect which set of claims he will retain, but should require him to cancel the new set. Method for producing color photographs.

Selle, 1904 C. D. 221, 110 O. G. 1728.

If a division is required, an amendment which would still require division should not be entered.

Metzger, 1902 C. D. 407, 101 O. G. 1612.

While the rule permits a process and products to be joined, nevertheless in a proper case the Office may require a division between them.

E. P. Erdman, 1900 C. D. 197, 93 O. G. 2531.

It is the settled practice of the Office that an amendment which would require a division should not be entered.

E. P. Murmann, 1900 C. D. 183, 93 O. G. 1721.

If the mechanism for operating a self-playing instrument is a separate invention from the instrument, still a combination of the two may be admissible. Rewinder for music sheets, etc.

Gally, 1903 C. D. 480, 107 O. G. 1660.

(4) *Combination, Subcombination, and Elements.*

Claims to a particular form of propeller should be divided from claims to the general ship construction. Roller Boat.

Belair, 1903 C. D. 426, 107 O. G. 540.

Division should not be required between claims to an apparatus for painting and claims to the same combination, including as an additional element a mixer which adapts the device for use as a cleaner. The structure is unitary and the claims are related as combination and subcombinations. Painting for Cleaning Apparatus.

Vegiard Dit. Labonte, 1903 C. D. 317, 106 O. G. 766.

While the claim, if presented in a separate application, might be properly classified in the class of brush and broom handles, it is nevertheless a subcombination of the combinations covered in claims 1 to 8, inclusive, and it is not shown that it has become an independent subject matter of invention and manufacture from the general invention covered in the preceding claims. Claim 9 may be prosecuted in the same application with claims 1 to 8. Mop.

Davis, 1903 C. D. 280, 105 O. G. 1783.

Though each of these claims states that the subcombinations defined by it is for use in a pump-driving apparatus, the subcombination is a separate and independent invention from the general pump construction in which it is used. Electric Pump.

Hall & Fraser, 1903 C. D. 233, 105 O. G. 743.

The claims bear the relation of combination and subcombination claims. They do not cover separate and independent inventions. As the structure covered by claims 1 and 2 is not adapted for independent use as a buckle, but is peculiarly designed for use in a harness construction, it is held that the requirement for division should not be insisted upon.

Welner, 1902 C. D. 479, 101 O. G. 3106.

Motor vehicle and feeder and condenser required to be divided.

The claim to the latter two being combination claims and not to specific construction should not be required to be separated.

Tyson, 1902 C. D. 476, 101 O. G. 3105.

A copyholder and clamp required to be divided notwithstanding there were claims to combinations of the two. Copyholder.

Williamson, 1902 C. D. 459, 101 C. D. 2571.

Churn, the motor and combination of the paddle therewith should not be divided.

Lemire, 1902 C. D. 396, 101 O. G. 1607.

Motor and washing machine. Each claim covers a motor and none cover anything beyond the frame to be oscillated thereby division not required.

Cramer & Haak, 1902 C. D. 352, 101 O. G. 220.

Claims 1 and 2 are drawn specifically to an umbilical structure; claims 3, 4 and 5 are not so limited; but they nevertheless cover the unitary structure of the invention. Division not required.

Alminana, 1902 C. D. 293, 100 O. G. 1331.

A clutch is a distinct and independent invention from the mechanism in which it is employed. A division should be made.

The introductory words, "in a lawn mower" does not make it a unitary invention.

Adams, 1902 C. D. 252, 100 O. G. 453.

Leveling devices alone for billiard tables are classified separately from the table structure, but when the levelers are made a part of the combination this combination is classified with the table structure and not with the levelers.

In the present case there are not separate claims for the leveler which can be separated from the table structure. Division should not be required.

Burrows, 1902 C. D. 250, 100 O. G. 452.

A divisional application can contain only matter carved out of the original case. A mechanical application can not be carved out of a design.

Goldman, 1902 C. D. 238, 100 O. G. 234.

Claims distinguished from each other by the addition of an element, held not divisible especially if it does not appear that the two have acquired distinct status in the art.

Cushing, 1902 C. D. 256, 100 O. G. 681.

Each of these inventions is capable of separate and independent use. They should not, therefore, be presented in the same application. They are useful otherwise than as elements of combination.

Moriarty, 1902 C. D. 201, 99 O. G. 2549-50.

Division ought not to be required between elements of a

combination. Claims to an alleged combination and claims for one of the elements thereof. Such claims must be considered upon their merits, for there is no warrant for the requirement of division between the claims for the combination and those for the single element.

Kugler, 1902 C. D. 84, 98 O. G. 2173.

Where claims for two elements were presented in a combination the requirement for division was avoided by inserting a claim for the combination of such elements.

Kugler, 1902 C. D. 84, 98 O. G. 2173.

It does not appear that the devices covered by the claims are such separate articles of manufacture as would necessitate a separate application for each. They are not useful in other relations or separately complete machines or articles.

Whitney, 1901 C. D. 218, 97 O. G. 2305.

Division should not be required between claims covering operating mechanism of a locomotive hand car and claims for subcombination of such mechanism where it does not appear that these subcombinations are useful in other relations or they are such as would be separate articles of manufacture.

Henderson, 1901 C. D. 201, 97 O. G. 1699.

Apparently if part of one operation is performed by two mechanisms they should not be divided even if one could have done it all.

Prossor, 1901 C. D. 164, 97 O. G. 958.

While each invention tends to improve the grain drill as a whole it does not follow that they may mutually contribute to a single result.

Pelton, 1901 C. D. 37, 95 O. G. 633.

If the inventions are independent in their actions and differently classified in the Office they may not be joined though forming constituent parts of one structure.

Brownell, 1901 C. D. 31, 94 O. G. 988.

It is not broadly true that in all cases where a party makes and is entitled to a combination claim, he is also entitled in the same case to claim as many subcombinations, i. e., elements in that combination as he desires. The question is whether those elements and subcombinations are useful in other relations and are mere improvements on independent devices which have acquired a distinct status in the art and classification.

Johnston, ex parte, 1900 C. D. 125, 92 O. G. 1235.

Division should not be required between a claim to a combination of elements in a grinding machine and a claim for

an attachment to be used in that machine for grinding curved surfaces, there being no separate classification of the devices.

Bancroft & Thorne, 1900 C. D. 33, 90 O. G. 1539.

Where there are claims for specific structure and combinations of the structures and the structures have acquired a distinct status in the arts, division should be required between the claims for one of the structures and combination of the structures on the one hand and the claims for the other structure on the other hand.

Korff, 1893 C. D. 120, 64 O. G. 1397.

Where certain devices were claimed separately and also in combination, division should not be required unless one or each of such devices could be used in other relations and belonged to a class that had acquired a distinct status in manufacture to trade.

Learned, 1893 C. D. 84, 63 O. G. 1962.

Where applicant's machine was in its entirety a mangle or ironing machine, the Examiner properly required division as to certain claims in the application which related purely to a belt-shifting device.

Wendell, 1892 C. D. 95, 59 O. G. 630.

Although it appears that certain claims in an application are for mechanism capable of use in other relations than that which forms the specific subject matter of the application, division will not be required if these claims have elements in common with the more specific claims of the application.

Kerr, 1892 C. D. 61, 58 O. G. 1553.

In order to necessitate the dividing out of elements, when the combination as a whole is held to be patentable, it must appear *first*, that the elements or parts of the invention which are to be divided out have obtained a definite place in the art and manufacture, and *second*, that they can be used in other relations.

Speckbauch, 1891 C. D. 36, 54 O. G. 1265.

When one particular element of a machine is dependent upon and acts with the other elements thereof to produce a single result, it may be claimed in the same application with them without regard to the office classification.

Coe, 1889 C. D. 191, 48 O. G. 119.

If the devices are so united as to form a combination they may be united in one application.

Herr, 1887 C. D. 105, 41 O. G. 463.

It is not the policy of the Office to require a division where the several parts composing the device are intimately con-

needed and operate in the accomplishment of a specific result.

Freese, 80 C. D. 133, 17 O. G. 1095; Carter & Dwyer v. Perry & Dickey, 75 C. D. 111.

Where elements forming parts of two foreign patents are included in one combination a division should not be required.

Unsworth, 1879 C. D. 69, 15 O. G. 882.

Where an invention lies mainly in a series of devices forming a complete set, the operation of each in a certain order being necessary to accomplish the desired result, a division should not be required.

Gokey, 1878 C. D. 144, 15 O. G. 295; Shippen, 1875 C. D. 126, 8 O. G. 727.

Combinations parts of one machine.

If there is a proper combination presented a division can not be required on the ground that some of the elements are old.

Wenzel, 1880 C. D. 104, 10 O. G. 512.

A single patent will not be granted for a combination of a principal mechanism with a number of different elements when each of said elements in combination with the principal mechanism forms a machine for a distinct and separate purpose.

Shepard, 1872 C. D. 244, 3 O. G. 522.

An article of manufacture may be claimed in the same application with combinations of said article with other elements.

Adams, 1873 C. D. 18, 3 O. G. 150.

(5) *Office Classification.*

If the claims would be classified in the same subclass it does not follow that the requirement for division was improper, for it is well settled that the Office classification is not controlling on the question of division, but is evidential only as to the independence of the inventions.

Strimban, 180 O. G. 323 (cases cited).

As a general rule applicants are required to restrict the claims of their application in accordance with the Office classification. When therefore there are claims so independent that each requires a distinct and independent search, then clearly the applicant should restrict his claims.

When, however, the inventions, though distinct, are dependent upon each other and the field of search for all is the same then ordinarily there is no reason for requiring division. Kalsomine composition and process of producing same.

Adams, 1903 C. D. 299, 106 O. G. 541.

Division should be required between an apparatus for manufacturing roofing paper and the specific structure of the

cooling and drying apparatus which is used in the complete machine. Because the two have attained to distinct places in the art and are separately classified. Apparatus for manufacturing of roofing paper.

Kidde, 1903 C. D. 278, 105 O. G. 1782.

Office classification is not and never has been the absolute test upon the question of division. It is merely evidence.

Davison, 1902 C. D. 392, 101 O. G. 1371.

Two inventions may not be included in one application because they are classified alike.

Davison, 1902 C. D. 392, 101 O. G. 1371.

If the two inventions are recognized by the Office classification and also by inventors as separate inventions, and if they are capable of separate use and sale, the application should be divided. (Vessel, hull and rudder, propelling.)

Bustin, 1902 C. D. 285, 100 O. G. 1111.

They are not separately classified by the Office. It is true that each of the mechanisms is separately constructed and either one of them can be removed from the machine without disturbing the other; nevertheless each one so coacts with the other as to mutually contribute to produce a uniform result, and in view of the further fact that they are not recognized by inventors and manufacturers as having a distinct place in the arts manufactures in that they are not separately manufactured and sold, the requirement of division should not be insisted upon.

Smith, 1902 C. D. 196, 99 O. G. 2547.

Office classification, etc.

Brown, 99 O. G. 2320.

Office classification, etc.

Brill, 1902 C. D. 189, 99 O. G. 2319.

Furthermore these various devices are separate subjects of invention as is shown by the numerous patents contained in the subclasses referred to by the Examiner and it appears that they are to some extent separate subjects of manufacture and sale. Under these circumstances it is well settled that division should be required.

The parts of a typewriter performing its different functions required to be divided.

Berry v. Fitzsimmons, 1902 C. D. 153, 99 O. G. 862.

Office classification is not the sole test of unity of diversity of invention; it is only one test.

Pelton, 1901 C. D. 37, 95 O. G. 633.

Discussion of Office classification as affecting the question of division.

Ex parte Casler, 1900 C. D. 15, 90 O. G. 440.

The matter of subclasses having acquired a distinct place in the arts is in itself no ground for division.

Carr, 1894 C. D. 11, 66 O. G. 653.

Where contrivances which mutually contribute to produce a unitary result are essential in producing the result, it should make no difference whether they belong to one or a dozen classes.

Sol Kuh, 1876 C. D. 190, 10 O. G. 587.

(6) *Generic and Specific.*

Apparently condemns the Patent Office rule requiring a division of specific claims from generic.

"This case is a striking example of the unfortunate result of too close adherence to rule."

Benjamin Electric Mfg. Co. v. Dale Co., 158 F. R. 618; see Weston, 173 O. G. 286; 141 F. R. 286.

Two species may not be claimed. Lubricator.

Brown, 1904 C. D. 50, 108 O. G. 1052.

The substance is no less impervious because at intervals it has been cut away. The word impervious seems to have been confused with the word imperforate. Not two species of the invention. Medicated Plaster.

Nash, 1903 C. D. 181, 104 O. G. 1896.

In view of the fact that claims 1 to 5 can be read on both figures and claims 6 to 10, inclusive, are specific to but one of the figures, it follows that all of the claims may be presented in the same application, and division should not be required. Traveler's Guide.

MacKaye, 1903 C. D. 112, 103 O. G. 888.

One generic and only one specific invention in one application. (Refers to 141 F. R. 989 and 158 F. R. 617.)

Where certain claims are broad to all forms and other claims are specific to one form of the invention, and another set of claims cover a construction which is shown only in connection with one specific form, but can be used as well with both forms. Held that the several claims bear the same relation to each other of combinations and subcombinations, and are not specific to different forms of the same invention. Division should not be required.

Shevill, 1902 C. D. 469, 101 O. G. 2824.

Improvements in the elemental machine which go to perform a certain office in a sewing machine, the mechanism for performing that function being old, must be divided.

Lyons, 1902 C. D. 430, 101 O. G. 2078.

Claim 1 being generic to all forms of the invention, and claims 2 and 3 being specific, a division should not be required even when the first claim is unnecessarily limited by a specific form of one element.

Metzger, 1902 C. D. 407, 101 O. G. 1612.

A spring-holding device is a generic claim covering either one or two springs. The application need not be divided between one and two spring-holding devices.

Plumley, 1902 C. D. 353, 101 O. G. 447.

The requirement that the application shall be limited to one specific claim under the generic claim is equivalent to the requirement of division. Under Rule 42, the divisibility of the application is clear and therefore it is proper to require division before action.

Worden, 1902 C. D. 176, 99 O. G. 1622-1623.

(7) *Election to Prosecute One of Several Inventions.*

No reason is seen for permitting an applicant to nullify an election deliberately made and after the application has been prosecuted to an allowance on one invention present claims for an entirely different invention even for the purpose of interference.

Stimson, 226 O. G. 699.

Ex parte King, 190 O. G. 548, not in conflict with rule; anticipated Stampel, 197 O. G. 907, objections considered.

An election may be made by the original presentation of claims.

Michell, 196 O. G. 525.

The adoption of a claim under Rule 96 does not constitute an election of species.

Burk, 184 O. G. 288.

Two species sought to be included—"While the Examiner's requirement of division is right the applicant should be required to elect which one of the specific inventions he desires to prosecute in this application." Sash Lock.

Butcher, 1904 C. D. 60, 108 O. G. 1587-88.

Having prosecuted to rejection a claim for a process and product an applicant can not shift his ground and insert a claim to the apparatus by which the process is carried out. Construction of cast iron pipes.

Ferrell, 1903 C. D. 316, 106 O. G. 766.

The fact that in the first action references are cited against only one of the inventions does not permit applicant to shift his ground having elected to prosecute the other.

Randall & Luck, 1901 C. D. 47, 95 O. G. 2063.

(8) *Process, Product, Apparatus, Etc.*

A process and an apparatus by which it is performed, are distinct things. They may be found in one patent; they may be made the subject of different patents. So may other dependent and related inventions.

If patented separately, a foreign patent for either would not affect the other. (Quoted from 213 U. S. 301-318.)

Fireball Gas Tank & I. Co. v. Commercial Acetylene Co.,
198 F. 655.

"Normally process and product form two inventions; not one. Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U. S. 301; 29 Sup. Ct. 495 L. Ed. 805."

Adrian Wire Fence Co. v. Jackson Fence Co., 190 F.
R. 195.

An invention is not made different by the mere fact that one is disclosed in a claim for an apparatus and the other in the form of a method or process. Where the one invention is disclosed, but one patent can issue.

Rowe, 192 O. G. 519-520.

An applicant having presented claims for process and article and a requirement for division having been made, can not cancel the process claims, get an action on patentability, and then reinsert process claims.

Scott and Deats, 147 O. G. 520.

Process and apparatus claims may in some cases be so related as to make it proper to include them in one application. A rejection should be based upon the conclusion that the particular process and apparatus are not so related as to warrant including them in one case. Grain Binders for Self-Binding Harvesters.

Ament, 116 O. G. 596.

Process and Apparatus. The process and the apparatus can be included in separate patents only because they are separate inventions, and it is believed that the validity of these patents is not effected by the question whether they are issued on the same day. Regulating Alternating Current. Electromotive Force.

Stuart, 1904 C. D. 485, 113 O. G. 850.

Rule 41 (old) invalid as to process and apparatus.

Frach, 1904 C. D. 716, 109 O. G. 554.

Joinder of invention for machine and process.

Rule is contrary to statute. U. S. S. C. directed mandamus to court to allow appeal from an order requiring division.

Steinmetz v. Allen, 24 Sup. Ct. Rep. 416; 109 O. G.
549; 1904 C. D. 703.

The process of making a matrix and the article cast in it are separate inventions. Art of making matrices for casting relief work.

Jennens, 1904 C. D. 58, 108 O. G. 1587.

It is, of course, true that a process is always a distinct invention from a composition of matter where, however, the process and the composition produced by it are so closely related as in this case, they may properly be regarded as dependent inventions, and it is held they may be retained in one application. Artificial fuel and the process of making same.

Dallas, 1903 C. D. 325, 106 O. G. 996.

Process and article. The facts are such in this case as to warrant the requirement of division. Rubber Foot Covering.

Very, 1903 C. D. 318, 106 O. G. 766.

So far as appears the process claimed necessarily results in the composition claimed, although it is possible that the composition might be produced by other process. Division not required.

Adams, 1903 C. D. 299, 106 O. G. 541.

Division between process and article required when article could be made by different process. "While the requirement of division may be a hardship upon the assignee, this reason is not sufficient to warrant the waiver of the requirement of division." Mop.

Davies, 1903 C. D. 280, 105 O. G. 1783.

Process and article. The latter can be made by a different process. No division required. Access to Abandoned Caveat.

Williams, 1903 C. D. 5, 105 O. G. 1780.

While applicant may be permitted to claim a process and the product which necessarily results therefrom in a single application, he can not be allowed to claim in addition a device or article in which the product merely forms an element. Lightning Arrester.

Bennett, 1903 C. D. 258, 105 O. G. 1262.

Process and product, when latter can be made by some other process, required to be divided.

Christensen, 1903 C. D. 256, 105 O. G. 1261.

It is clear, therefore, that the article covered in claims 3 to 6 can be made by other methods than that covered by claims 1 and 2 and that a disclosure of the article does not necessarily disclose the method. Division required.

Foulis, 1902 C. D. 233, 100 O. G. 232-233.

Insulating compound and process of making it should be

divided from an insulated conductor and process of making it being insulated by above compound.

The Office classification, while not conclusive, is very persuasive.

See Lee, 1902 C. D. 234, 100 O. G. 233.

The permission of the last clause (old Rule 41) does not go so far as to allow the joinder of a process and its product at the will of the applicant. If it appears that the process and product are classified separately. If it is clear that the process does not necessarily result in the product or that the product may be made by some other process. The inventions in such a case are independent and should be claimed in separate applications.

Powell, 1902 C. D. 163, 99 O. G. 1384.

Process and Product.

• Ex parte Parent, 1902 C. D. 74, 98 O. G. 1970-1.

A composition and the process of using it may not be claimed in the same application.

Tschirner, 1901 C. D. 141, 97 O. G. 187.

Process and machine must be divided.

Fish, 1900 C. D. 69, 91 O. G. 1615.

Process and Apparatus.

See Frasch, 1900 C. D. 50, 91 O. G. 459.

The words "mutually contribute to produce a single result" are not confined to the result of the process, but to the ultimate result with a view to which the whole invention was made.

Kny, 1893 C. D. 131, 65 O. G. 1403.

(9) *Particular Devices.*

Centrifugal machines for separating solid matter from liquid.

Sjungstrom, 119 O. G. 2235. See note to Rule 68.

Taper calipers.

Creamer & Knowlton, 1904 C. D. 295, 111 O. G. 1040.

Voting machine—general construction—key locking mechanism and apparatus for irregular votes are three separate inventions. Voting machine.

Benke, 1904 C. D. 63, 108 O. G. 1588-9.

Division required between the telephone switchboard and the rest of the system. Telephone exchange apparatus.

Ford, 1904 C. D. 56, 108 O. G. 1327.

A mixing machine for kneading dough, etc., could be turned into a machine for cleaning currents by the introduction of a screen. Division insisted upon.

Stacey, 1904 C. D. 45, 108 O. G. 1050.

Velocity regulator for fluids in motion. In the first form the governing device is connected directly to a valve in the conduit, while in the second form the governing device is connected to the throttle valve in the steampipe to the engine. Each of the forms nevertheless is capable of accomplishing the same ultimate result. No division required.

Herreshoff, 1903 C. D. 376, 106 O. G. 1779.

An improvement in door frames generally must be regarded as an independent invention from the arrangement of a port over the door in a refrigerator.

E. P. Stevenson, 1903 C. D. 238, 105 O. G. 744.

Bookkeeping and account book.

The process does not result in the article, and the articles have no connection with the process.

Stocking e. p., 1902 C. D. 468, 101 O. G. 2823.

Two different constructions for fastening horse shoes constitute independent inventions though both may be used on one shoe.

Rodenbaugh and Laurentz, 1902 C. D. 412, 101 O. G. 1830.

Device for making coffee.

The fact that claims 2 and 3 include broadly as an element of the combination a device for producing the extract does not make those claims for the same invention as claim 1.

Before the extract can be measured it must of course be produced by some means.

Schofield, 1902 C. D. 412, 101 O. G. 1830-31.

End thrust and lateral bearings required to be divided.

Stuver, 1902 C. D. 381, 101 O. G. 1130.

Gas Engine.

Tyler, 1902 C. D. 320, 100 O. G. 2177.

Gas engine. Division between sparking igniter, governor valve, relief valve and general structure of the engine.

Tyler, 1902 C. D. 269, 100 O. G. 686.

Boiler and furnace separate inventions.

Downie and Messner, 1902 C. D. 240, 100 O. G. 235.

Claims 1 to 14, inclusive, and claims 17 and 18, though drawn to cover several distinct inventions, are held to cover inventions so "dependent upon each other that they" mutually contribute to produce a single result and therefore may, under the provisions of Rule 41, be claimed in one application.

The single result is the construction of a complete railway block system. It is otherwise if the inventions are not mutually dependent, e. g.

Kintner, 1902 C. D. 22, 98 O. G. 581.

The mere fact that the slide rule in this case is adapted by reason of the information conveyed thereby for use in the same general art as the shoemaker's measure does not make the two constitute the same or dependent inventions.

Dwyer, 1901 C. D. 41, 95 O. G. 1247.

Division in motor vehicle. Case—

Roby, 1900 C. D. 118, 92 O. G. 1035.

(10) *Appeals.*

Mandamus requiring Commissioner to direct Primary Examiner to forward appeal on question of division to Examiners-in-Chief. In error to the Court of Appeals of the District of Columbia.

Ex rel. Steinmetz v. Allan, Com., 1904 C. D. 703, 109 O. G. 549.

Questions of division appealable to the Examiners-in-Chief. 178 O. G. 320.

The question whether a design application covers two or more inventions is a question of division which is to be determined on appeal in the first instance by the Examiners-in-Chief. Design for a font of type.

Schraubstadter, 1904 C. D. 229, 110 O. G. 2015.

The fact that questions of division are now appealable to the Examiners-in-Chief is no reason why a divisible application should receive a more extensive examination on the merits. Swing back car seat.

Pickels, 1904 C. D. 126, 109 O. G. 1888.

Petition dismissed as matter is appealable to board in first instance. Production of sound records.

Emerson, 1904 C. D. 118, 109 O. G. 1610.

It appears from the decision, Steinmetz v. Allen, 109 O. G. 549, 1904 C. D. 703, that a requirement for division is to be regarded as a rejection of the application and is appealable to the Examiner-in-Chief and that the applicant is entitled to demand that his appeal be forwarded, notwithstanding the fact that the Commissioner has reviewed the Examiner's decision and affirmed it upon the petition of applicant.

This decision approves the first paragraph of rule. Means for removing incrustation of calcium sulphate from brine heating surfaces.

Frasch, 1904 C. D. 104, 109 O. G. 1338.

Appeal from the Commissioner requiring a division does not lie to the Court of Appeals of the district.

Frasch, 1902 C. D. 560, 100 O. G. 1977.

REPORT OF THE COMMISSIONER OF PATENTS
FOR 1916.

REQUIREMENT OF DIVISION.

During the year the practice of having all requirements of division referred to a law examiner before being made final was continued. A total of 793 applications were passed upon. Of these, 529 were approved wholly or in part and 363 were disapproved. There was a steady decrease in the percentage of disapprovals as the year went on, indicating that the result sought—uniformity of practice—is being approximated in the different divisions.

In addition to applications in which formal memorandum was written, many applications were informally considered prior to first requirement. In a number of applications it has been found necessary to withhold approval until action on forms or merits. Frequently disclosures and claims are found in such condition that it is not possible to draw clear lines, and action on the form and sometimes on merits has been found to be the most speedy and satisfactory manner of preparing the way for a clear line of division or to avoid division.

The disapprovals have been largely of requirements of division, not properly founded, between process and product and combination and subcombination in machines or in compositions.

Where the process and product are mutually dependent as where the process is the necessary and obvious way of making the product or where the process can produce nothing else and the product be made in no other practical way, no reason for division exists. Division in such cases might result in an effectual extension of the monopoly, when the patents are not concurrent, and in commercial disadvantages flowing from separate ownership of related patents.

When the claims of an application to process and product are not clearly distinct in terms, as where, for example, the process claims are defined in part by terms of structure, or product claims by steps taken in making the product, division is not a proper remedy; action upon the merits should be given. Division in some such cases may be required ultimately, if the claims, when cast in correct form, present two distinct subjects matter.

Where, however, the product and process claims present different inventive ideas and the product may be made by other processes, known at the time, it is clear that no mutually dependent relation exists, and there is no reason for

joining the product with any particular one of the various processes usable to produce it. Division in such cases will ordinarily be approved, particularly where the process is capable of making other products and the product claimed is one of a known class or type of developed products.

The questions arising with relation to division between combination and subcombinations are many often difficult to determine. The subcombination, to be divisible, must be capable of use apart from the combination and in other relations, and be of a class of devices which has acquired a distinct position of its own in the art, as the subject of separate manufacture, or invention. This situation is frequently well evidenced by separate office classification and fields of search for the two. The subcombination may be a simple element, as a gear; or a complex organization, as a governor, conveyor, or transfer mechanism. In all cases there should be two distinct inventive ideas embodied in mechanism and it is not believed that in enforcing division the office can disregard the real character of the invention. Many elements as governors, coin-controlled operations, clutches, and gauges are usually or necessarily attached to a machine. An invention may lie in one of these devices and be capable of application to many machines, but it is illustrated with a preferred machine. The naming of the illustrated machine or its broad or conventional statement as an element of a claim (in a case where the invention or improvement is obviously or apparently in the element alone, and where also claims are directed to the element alone) may raise a question of the form of claims, but should not in the preliminary treatment induct a requirement of division; since division should not be required except where the office has formed the opinion that there are two real inventions. Division is not the proper remedy for claims improperly drawn but in fact based on one invention.

The principles governing joinder of combination and subcombination claims to compositions of matter are clearly set forth in *Ex parte Hentz*, 1884 C. D. 6, and are the same as those governing other classes of inventions. As there stated, a composition may contain a certain number of ingredients forming a complete compound, although a lesser number of ingredients may contain the basic and essential part of the invention and contribute most largely to produce the result. The mere fact that one claim names three elements or ingredients and another two or four elements or ingredients is not sufficient reason to require division. The further questions are to be determined whether the claims are to composi-

tions having the same character and purpose, operating in substantially the same manner, and whether the subcombinations are useful in other relations and have a distinct status in the arts.

Division is a requirement with regard to which the Commissioner has a wide discretion. The Office can take care of searches and classification by cross-referencing and where hardship to applicants may result or apparent injustice be done, benefit of doubt should be given to applicants and requirements which may cause injustice be waived.

The effect of reference to a law examiner of second requirements of division, it has been hoped, would be to reduce to some extent the first requirements by eliminating trivial requirements and requirements unwarranted by the practice and not sustainable on reference, since, obviously requirements should not be made at all, unless they are well founded in the fixed policy of the office. This expectation has to some extent been realized. There were first requirements of division made in 1915 in 6,393 cases, or 1 in 11.13 new cases acted on, and in 1916 in 5,662 cases, or 1 in 12.01 cases acted on, a reduction from 8.98 to 8.33 per cent.

The examiners' reports show a wide difference in the number of requirements of division in the first instance in the several examining divisions, in proportion to the total number of cases handled, and also a divergence in the proportion of those sent up for approval compared with those made. Divergence to a considerable degree is to be expected on account of the widely variant character and complexity of applications in different divisions, but it is believed to be larger than should be the case. During the coming year efforts will be directed to the reduction of first requirements to a more uniform basis.

The policy of requiring submission of requirements of division to a single law examiner has been amply justified.

The judicial work of the office as distinguished from the clerical work of handling the applications is conducted under the direction of 43 primary examiners. Each one must study those arts wherein applications are assigned to him for examination so that he may be able to form an intelligent judgment as to whether the assistant has properly cited the art bearing on applications as they are filed and so that he may apply the prior art intelligently in determining questions of patentability.

No one should interfere with this work of the examiner excepting as his conclusions may be reviewed on appeal.

There arise, however, throughout the office a great variety of questions respecting which the practice of the office should be uniform, and such questions should be submitted to some one person in order that they may be passed on in accordance with a definite theory and not according to the individual opinions of 43 different primary examiners. It is physically impossible for the Commissioner to do this work, and frequently the decisions arrived at must be reviewed on appeal or petition. Therefore, he could not properly direct a decision in the first instance.

The law examiners are engaged in supervisory work regarding the inception of interferences, the dissolution of interferences; the prevention of delay in the prosecution of applications; requirements of division; practice in reissuing applications, and as to affidavits under Rule 75. Each one of these subjects requires substantially the entire time of one man. There are other lines of work which can be established with great advantage if the number of law examiners can be increased. I have asked for two additional law examiners, which have so far been denied me.

Rule 43. Cross-References in Cases Relating to Same Subject.

When an applicant files two or more applications relating to the same subject matter of invention, all showing but only one claiming the same thing, the applications not claiming it must contain references to the application claiming it.

CONSTRUCTIONS.

This rule introduced 1879. See rules of that date. This requirement is so that the limit of each application shall be definitely determined.

Drawbaugh v. Blake, 1883 C. D. 17, 23 O. G. 1220.

Rule 42 of 1879 abolished in 1888 and present Rules 43 and 44 substituted.

The cross-reference should include serial number and date of filing.

This rule not inconsistent with Rule 15, Summers, 160 O. G. 1039.

The requirement that a new application shall contain a reference to a prior application is not limited to those cases

in which the two applications are copending and continuous. (Ex parte Lewis and Unger construed.)

There should be a reference in a new application to an abandoned application.

Britt, 116 O. G. 298.

A reference to applicant's forfeited case required.

Taylor, 114 O. G. 1265.

After allowance of claims by the Examiner-in-Chief the application was abandoned and another substituted. Applicant required to insert reference to abandoned application.

Lewis & Unger, 106 O. G. 543.

The statement that the application was a division of another required to be canceled in view of new matter introduced.

Hicks, 104 O. G. 309-310.

See note to Rule 78.

Anderson, 1893 C. D. 51, 63 O. G. 463.

Cross-references must be of such a nature that they will impart a more or less definite conception of their scope. A reference by serial number alone is not sufficient.

Everitt, 1889 C. D. 213, 49 O. G. 564.

A reference in an application for a patent to a contemporaneous pending application or for another patent, for a fuller description is not permissible.

Borgfeldt, 1859 C. D. 149, 49 O. G. 132.

But if a patent is issued on the first application without such disclaimer the patent issued on the first application does not bar the patent on the second application for that reason.

Roberts, 1887 C. D. 61, 40 O. G. 573.

The disclaimers contemplated by this rule are between several applications of the same individual covering either by claiming or showing the same device or invention, and the rule was adopted to prevent the party from procuring a prolongation of the monopoly of his patent by securing two patents for the same thing, and also to prevent an abuse which occasionally might occur of a reissue upon a patent which showed but did not claim the whole invention.

Firm, 1887 C. D. 27, 39 O. G. 1199.

Rule 44. Reservation Clauses not Permitted.

A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application.

HISTORY.

Introduced in 1888. See first note to Rule 43.

Rule 45. Legible Writing Required.

The specification and claims must be plainly written or printed on but one side of the paper. All interlineations and erasures must be clearly referred to in marginal or footnotes on the same sheet of paper. Legal-cap paper with the lines numbered is deemed preferable, and a wide margin must always be reserved upon the left-hand side of the page.

Rev. Stat., sec. 4888.

*The Oath.***Rule 46. Oath of Applicant.**

The applicant, if the inventor, must make oath or affirmation that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever known or used before his invention or discovery thereof, and shall state of what country he is a citizen and where he resides, and whether he is a sole or joint inventor of the invention claimed in his application. In every original application the applicant must distinctly state under oath that to the best of his knowledge and belief the invention has not been in public use or on sale in the United States for more than two years prior to his application, or patented or described in any printed publication in any country before his invention or more than two years prior to his application, or patented in any foreign country on an application filed by himself or his legal representa-

tives or assigns more than twelve months prior to his application in this country. If any application for patent has been filed in any foreign country by the applicant in this country, or by his legal representatives or assigns, prior to his application in this country, he shall state the country or countries in which such application has been filed, giving the date of such application, and shall also state that no application has been filed in any other country or countries than those mentioned, and if no application for patent has been filed in any foreign country, he shall so state. This oath must be subscribed to by the affiant.

If the application be made by an executor or administrator of a deceased person or the guardian, conservator, or representative of an insane person, the oath shall allege the relationship of the affiant to the inventor and, upon information and belief, the facts which the inventor is required by this rule to make oath to.

The Commissioner may require an additional oath in cases where the applications have not been filed in the Patent Office within a reasonable time after the execution of the original oath.

CONSTRUCTIONS.

Rev. Stat., secs. 4887, 4892, 4896.

Amended.

90 O. G. 449 and 89 O. G. 2466.

Notaries in District of Columbia.

215 O. G. 1267.

History as to notary being also the attorney.

Dalton and Magnus, 224 O. G. 741.

An oath will generally be presumed. Its absence from the file wrapper is not conclusive.

Mine & Smelter Supply Co. v. Braeckel Concentrator Co.,
197 F. R. 897.

The statute does not require an applicant for a patent to

state whether he is a sole or joint inventor of the art or machine or improvement for which he solicits a patent. A false statement in this regard is not perjury.

United States of America v. Patterson, 174 O. G. 289.

The informality of lack of a certificate excused in view of the circumstances.

Graham v. Sanghaar, 164 O. G. 740 and 741.

Word "sole" omitted.

Mygatt, 160 O. G. 773; Cites 150 O. G. 826; 127 O. G. 3642; 125 O. G. 348; 97 O. G. 1597; 124 O. G. 626.

The oath is defective; it refers to the invention claimed in the application, where it should refer to the invention described and claimed. It fails to state that the invention has not been patented or described in any printed publication for more than two years prior to the filing of the application. It fails to state that no application for patent has been filed by applicants' assigns in foreign countries more than twelve months prior to the application in this country.

Dukesmith v. Corrington v. Turner, 125 O. G. 348.

See note to Rule 30.

Sassin, 122 O. G. 2064.

As a reason why a new oath is not filed it is alleged that differences have arisen between the assignee and the inventor, in view of which the inventor refused to execute another oath. This is not a sufficient excuse where when the application was filed there had been a period of nineteen months wherein public use of the invention would bar a patent, which period was not covered by original oath.

Hoschke, 122 O. G. 1045.

It is equally clear, however, that they can not secure that benefit by the mere allegation that they have filed a foreign application which entitled them to claim the benefit, but only by proving the foreign application.

Pauling, 115 O. G. 1848.

If no patent is granted on a foreign application, applicant is not required to state that the application was not filed more than twelve months previous to present application.

Gerardot, 115 O. G. 1584.

Every portion of Rule 46 is material and it can not be held, therefore, that a compliance with some of its requirements is a compliance with all of them.

Levenstein & Naef, 110 O. G. 1726.

It is not sufficient to state that no foreign patent has been filed in any foreign country more than three months before the application.

Thorsten von Zweiberg, 110 O. G. 859.

The statement that the inventor or applicant has declared his intention to become a citizen does not comply with the provision of this rule. He is still a citizen of the foreign country notwithstanding his declaration, until he is admitted to citizenship.

Rhodes, 105 O. G. 1261.

In the case of a joint application the allegations that the inventors are sole inventors is not sufficient.

E. P. Cole, 105 O. G. 744.

The oath in a divisional application must conform to all the requirements as to original applications.

There is no difficulty in the oath to the divisional application in making it appear that the allegation as to two years' public use relates to the date of the original application. This can be done by a mere change in form without omitting any of the essential allegations of the original oath.

Halsey, 102 O. G. 1294.

In the absence of a special showing to excuse further delay three weeks may be taken as the time limit for the original oath.

Branna, 1901 C. D. 232, 97 O. G. 2534; Moehn, 106 O. G. 995; Hicks, 104 O. G. 309, 310.

Five weeks' time, plus time for transmission, not unreasonable. No new oath required.

Heinze, 265 O. G. 145.

The omission of the address is not such a fatal defect as warrants a refusal to accept, as complete, an application otherwise without error.

Becker, 1901 C. D. 198, 97 O. G. 1592.

Known or used in American is not a compliance with this requirement. Neither is belief without knowledge such compliance.

Nicholson, 1901 C. D. 86, 96 O. G. 1035.

Only the inventor may make the oath. Even an assignee of the entire interest when the inventor refuses may not make the oath.

Richards, 1901 C. D. 46, 95 O. G. 1853.

The assignee may not make the additional oath, even when the inventor refuses to do so.

McCoy, 1897 C. D. 74, 80 O. G. 2037.

Where an application, executed in Liverpool, England, was filed forty-eight days later, the delay was not unreasonable and an additional oath should not be required, previously decided cases reviewed.

Wilson, 1893 C. D. 57, 63 O. G. 465.

Instead of the phraseology required by the rules applicant avers that the invention "has not been patented to him nor with his knowledge or consent in any foreign country," the words "to others" being omitted, and the word "foreign" being introduced before "country," the effect of which is to omit from his oath the statement whether or not a patent for the same invention has been issued to others in this country.

Mason, 1888 C. D. 33-34.

This oath that the applicant is the first and original inventor is sufficient to avoid the objection that an English patent was taken out jointly in England by applicant and another.

Siemens, 1877 C. D. 41, 11 O. G. 1107.

A new oath must accompany a divisional application.

Tiegman, Simpson & Collins, 1877 C. D. 1; Livingston, 1881 C. D. 42; Lippincott, 1879 C. D. 212.

This affidavit constitutes prima facie evidence, for the purpose of the ex parte application, of the fact of invention by the applicant. But it constitutes no evidence of any date of the application itself.

Lauder v. Croswell, 1879 C. D. 177, 16 O. G. 405.

Except in comparatively few cases this affidavit furnishes all the proof, which is ever presented to the Office, that the applicant himself made the invention and therefore the provision of this rule must be strictly complied with.

Warnant v. Warnant, 1880 C. D. 36, 17 O. G. 265.

Rule 47. Officers Authorized to Administer Oaths.

The oath or affirmation may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, the oath being attested in all cases in this and other coun-

tries, by the proper official seal of the officer before whom the oath or affirmation is made, except that no oath or affirmation may be administered by any attorney appearing in the case. When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

When the oath is taken before an officer in a country foreign to the United States, all the application papers must be attached together and a ribbon passed one or more times through all the sheets of the application, and the ends of said ribbon brought together under the seal before the latter is affixed and impressed, or each sheet must be impressed with the official seal of the officer before whom the oath was taken.

CONSTRUCTIONS.

History as to the notary being also the attorney.

Dalton and Magnus v. Wilson, 224 O. G. 741.

The purpose of the statute was to require that the authority of the notary public be approved directly by a certificate of a diplomatic or consular officer.

Low, 190 O. G. 549; (citing Rose, 180 O. G. 559).

The oath in question was taken before a notary of one state who affixed his jurat to an affidavit the venue whereof was laid in another. This might have furnished ground for a rejection of the affidavit by the Examiner or Commissioner of Patents, but there is no fraud shown and the recital in the letters patent that the required oath was made is therefore conclusive upon this court.

Empire Cream Separator Co. v. Sears-Roebuck & Co.,
157 F. R. 238.

This being so the amendment required an oath that Dolan might have found it difficult to take and for want of which the patent is void.

Steward v. American Lava Co., 149 O. G. 602 (S. C. U. S.).

The Hall Safe Co. v. Herring, Hall, Marvin Safe Co.,
135 O. G. 1804.

Notary may not be attorney.

Opinion of the Attorney General, 127 O. G. 3642.

A single certificate is not sufficient to cover a number of jurats signed by the same notary in a foreign country.

In re Dieterich & Co., 110 O. G. 309.

This rule was amended to take effect May 1, 1900, in regard to oaths taken in a foreign country. See amendment. The substance of this amendment was contained in 89 O. G. 2071, in *Ex parte Altman*, 80 O. G. 1475.

Hosking, 91 O. G. 1615; Bagot & Dishart, 91 O. G. 1802.

A notary public in and for the Republic of Mexico is not authorized to administer the required oath.

Hirran v. Bolade, 1893 C. D. 80, 63 O. G. 1961.

An application oath administered by an official not named in Rule 47 held to be defective and not to be received as in full compliance with the rule.

Hakansson, 1893 C. D. 76, 63 O. G. 1688.

A notary who is not authorized by the law of his country to administer oaths or take affidavits lacks the requisite authority to administer the oath required by R. S., sec. 4892.

(No name), 1892 C. D. 245, 60 O. G. 1481.

It is not sufficient that the oath was taken before a Belgian Burgomaster, unless he was also a notary public, and in the latter case competent proof of his official character should be furnished.

Warnant v. Warnant, 1880 C. D. 36, 17 O. G. 265.

Rule 48. Supplemental Oath for Matter not Originally Claimed.

When an applicant presents a claim for matter originally shown or described but not substantially embraced in the statement of invention or claim originally presented, he shall file a supplemental oath to the effect that the subject matter of the proposed amendment was part of his invention, was invented before he filed his original application, was not known or used before his invention, was not patented or described in a printed publication in any country more than two years before his application, was not

patented in any foreign country on an application filed by himself or his legal representatives or assigns more than twelve months prior to his application, was not in public use or on sale in this country for more than two years before the date of his application, and has not been abandoned. Such supplemental oath must be attached to and properly identify the proposed amendment.

In proper cases the oath here required may be made by an executor or administrator of a deceased person or a guardian, conservator, or representative of an insane person. (See Rule 46.)

CONSTRUCTIONS.

An applicant for a patent upon a method, a product, and a machine, after striking out the claim for the machine and being defeated upon the other two claims in an interference proceeding can not reinstate the claim to the machine in the same application. Rule introduced in 1871.

Cobb, 1879 C. D. 123, 16 O. G. 175.

Matter within the original disclosure is covered by the original oath.

Mine & S. Supply Co. v. Braeckel Co., 197 F. 900.

The amendment required and oath that Dolan might have found it difficult to take and for want of it the patent is void. Supreme Court.

Steward et al. v. American Lava Co., 149 O. G. 602.

A claim for matter introduced without a supplemental oath, invalid. Cases cited.

American Lava Co. v. Steward, 155 F. R. 737.

The amendment in this instance was within the scope of the original application. In such a case a different rule applies. Neither the applicant nor his administrator in case of his death, is required by the statutes relating to patents to make oath to such an amendment.

De LaVergne Machine Co. v. Featherstone, 147 U. S. 209, 229; Phillips v. Sensenich, 134 O. G. 1806.

The question whether or not a supplemental oath should be required has been uniformly held by this Office to be an ex parte matter upon which the proper determination of priority

is not dependent (Cites 108 O. G. 238; 99 O. G. 445; 84 O. G. 1142; 58 O. G. 1415).

Phillips v. Sensenich, 132 O. G. 677.

An amendment filed in good faith sufficient to prevent abandonment even though it was informal for lack of a supplemental oath.

Gaylord, 117 O. G. 2366.

It is well established that the requirement for a supplemental oath is an ex parte matter not open to argument in interference proceedings. (Auerbach and Gubing v. Wiswell, 108 O. G. 289.)

Schubert v. Munro, 113 O. G. 283-4.

The question whether a supplemental oath should be furnished is an ex parte one not to be argued on an interference.

Auerbach and Gubing v. Wiswell, 108 O. G. 289.

When claims for product were introduced into a process application a supplemental oath was required. Where the requirement would work special hardship or cause irreparable injury it might be waived temporarily, but ordinarily a claim can have no standing in the case until supported by the required oath.

Ex parte Ruckrich and Bode, 106 O. G. 765.

An appeal was taken and the board recommended a certain claim, the Primary Examiner required a supplemental oath, held, under the circumstances a supplementary oath should not be required.

Matthes, 101 O. G. 3108-3109.

Supplying connection in drawing suggested in specification.

Wareham, 97 O. G. 1600.

Only the inventor may make this oath; the assignee of the entire interest can not even when the inventor refuses.

Richards, 1901 C. D. 46, 95 O. G. 1853.

The absence of a supplemental oath, although it may be necessary before allowance, does not furnish a ground for the rejection of the claims, and is an ex parte matter not open to argument by an opponent in an interference proceeding.

Weidemann, 1897 C. D. 194, 81 O. G. 2245.

The matter claimed additional to what was claimed in the parent case should always be supported by a proper supplemental oath, or if claimed in the division application as first filed the oath prescribed by Rule 46 should be correspondingly changed.

Henry, 1893 C. D. 88.

A supplemental oath is required to justify the insertion of a claim through the medium of a divisional application where

it would be required if the claim were to be inserted in the parent application.

Forbes v. Thomson, 1890 C. D. 185; cited, 1893 C. D. 90.

It is not necessary that a supplemental oath specify the serial number and date of filing of the application to which it refers if the proposed amendment is otherwise properly identified.

Cook, 1892 C. D. 232, 61 O. G. 1480.

See note to Rule 70.

Perkins, 1891 C. D. 63, 55 O. G. 139.

There is no rule which excludes a case where apparatus and process are appropriately described and but one of them claimed from being brought within the remedial agency of a supplemental oath.

Lillie, 1890 C. D. 181, 53 O. G. 2041.

A supplemental oath should be required when it is sought to claim anything new. The oath filed with the application covers only what is claimed in said application.

Clarke, 36 O. G. 120; Foster, 33 O. G. 113. See, however, Railway Register Mfg. Co. v. North Hudson Ry. Co., 33 O. G. 355.

Where a division of the application should have been made, but was not required by the Examiner, a claim equivalent to one of the former claims may be inserted by amendment.

Andrews, 1879 C. D. 99, 16 O. G. 1056.

THE DRAWINGS.

Rule 49. Drawings.

The applicant for a patent is required by law to furnish a drawing of his invention whenever the nature of the case admits of it.

Rev. Stat., sec. 4889.

Precautions to be observed in forwarding drawings.

223 O. G. 653.

Rule 50. Requisites of Drawings.

The drawing may be signed by the inventor or one of the persons indicated in Rule 25, or the name of the applicant may be signed on the drawing by his attorney in fact. The drawing must show every feat-

ure of the invention covered by the claims, and the figures should be consecutively numbered, if possible. When the invention consists of an improvement on an old machine the drawing must exhibit, in one or more views, the invention itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

See notes under Rule 49.

HISTORY.

The words "and attested by two witnesses" struck out of the statute by amendment approved March 3, 1915, and of course the rule was amended to conform to the statute, 212 O. G. 1063.

CONSTRUCTIONS.

- (1) IN GENERAL.
- (2) DRAWINGS AS EVIDENCE.
- (3) PRACTICE.
- (4) NO MORE DRAWINGS THAN NECESSARY.
- (5) WHAT SHOULD BE SHOWN.
- (6) HOW ILLUSTRATED.
- (7) AMENDMENTS TO DRAWINGS.

(1) *In General.*

It is also claimed that the patent drawings, if scaled, do not exactly accord with the written description of the claims. But drawings are to be taken as illustrative of the idea of the patent, not as working plans (131 Fed. 77).

American Valve & Meter Co. v. Fairbanks-Morse Co.,
249 Fed. 239.

The drawing with the specifications constitutes a part of the patent when issued.

Phillips v. Sensenich, 134 O. G. 1806.

That Motsinger had such a definition in mind when he drew up his letters patent is evidenced by the fact that his drawings show nothing else and that there is nothing in the description that the drawings are meant to be only a preferable or alternative method.

Motsinger Device Mfg. Co. v. Hendricks Novelty Co.,
149 F. R. 995.

Drawings are a part of the specification of a patent, and for the purpose of ascertaining the sufficiency of the description of the invention must be read with it.

Brammer v. Schroeder, 106 F. R. 918.

An application for a process filed complete except a drawing, and a drawing is not necessary for a full disclosure of the invention, held sufficient to give a date of filing.

Ludington, 1902 C. D. 211, 100 O. G. 236; *Russell*, 1898 C. D. 208, 81 O. G. 2021.

The date at which the drawing is returned properly signed is the date of filing of the application.

Arndt, 1900 C. D. 167, 93 O. G. 751; *Palmer and Thompson v. Bailey*, 1899 C. D. 66, 83 O. G. 1207.

An illustration which amounts to no more than a suggestion is not sufficient warrant for a claim filed nearly two years after the application and nine days after an interfering patent.

Dewey v. Colby, 1896 C. D. 12.

The drawing filed with an application is one of its most important and essential parts. It becomes a permanent record in the Office and no one had authority to change any of its features by erasure or otherwise mutilating the same.

Wharton, 1887 C. D. 88, 40 O. G. 917.

The drawing of a patent are addressed to those skilled in the art and must also be considered in connection with the claims and specification and with each other; and a patent is not invalidated by a clerical mistake in a drawing, which, when so considered, would not mislead one skilled in the art to which it relates.

Cutler Hammer Mfg. Co. v. Union Electric Mfg. Co., 117 F. R. 266.

Drawings are a part of the specification of a patent, and for the purpose of ascertaining the sufficiency of the description of the invention must be read with it.

Emmet v. Fullagar, 124 O. G. 2178. See Rule 173 and note (*Earnham*, 114 O. G. 2090; *Schmedmer*, 115 O. G. 249).

Held to involve new matter, since where the drawings are uncertain they can not be made controlling.

Lindgren, 266 O. G. 137.

(2) *Drawings as Evidence.*

Where Y offered in evidence a drawing said to have been made during a certain time which is fixed by dates written on the drawing and there is only Y's unsupported allegation that

he made the drawing at that time, held that such testimony is insufficient to establish these dates.

Young v. Donnelly, 1898 C. D. 20, 82 O. G. 1417.

A drawing perfect in every detail and plainly demonstrating the principle and practical utility of an invention is not reduction to practice, nor is a model, designed, constructed, and intended merely as a model.

McCormick v. Cleal, 1898 C. D. 492, 83 O. G. 1514.

No statutory drawing having been filed by Palmer & Thompson until after the complete application of Bailey was filed, the burden of proof in the interference is upon Palmer & Thompson.

Palmer & Thompson v. Bailey, 1898 C. D. 66, 83 O. G. 1207.

Drawings or models not sufficient to establish date of reduction to practice.

Kassen v. Hetheringen, 88 O. G. 1157.

Disclosure in a drawing alone if sufficiently plain and clear may be sufficient to show an anticipation of an invention.

Reed v. Duel, Com., 1901 C. D., 96 O. G. 1241.

Relating to machinery, the invention may be exhibited as well in a drawing as in a model, so as to lay the foundation of a claim to priority, if such drawing be sufficiently plain to enable those skilled in the art to understand it.

Christensen v. Noyes, 1900 C. D. 21, 90 O. G. 227.

A drawing offered showing one of the elements of the combination, but vaguely, held that when other evidence is submitted which establishes the fact that the inventor had, at the time he made the original drawing, a complete conception of this vaguely illustrated element, the fact of conception of the invention of the issue is satisfactorily established.

Robinson v. Copeland, 1904 C. D. 237, 111 O. G. 579.

(3) *Practice.*

The conclusions of the chief draftsman as to whether or not the drawings should be accepted will not be disturbed unless there is such palpable abuse of his discretion as would warrant the exercise of the supervisory authority of the Commissioner.

Mealus, 136 O. G. 438.

The drawing should not be changed unless and until the question of new matter in the amendment has been determined in favor of the applicant.

Luber, 1894 C. D. 47, 67 O. G. 529.

The validity of the claim should first be determined before

a petition can be taken from the Examiner's action requiring the cancellation of the figure and the description relating to the same.

Schmidt, 1904 C. D. 165, 110 O. G. 603.

In questions of new matter new drawings should not be entered until decision on appeal.

Furness, 104 O. G. 1655.

(4) *No More Drawings Than Necessary.*

Applicant required to limit his drawings to one sheet.

Hilliker, 183 O. G. 1035.

Figures unnecessary to understanding of case required to be canceled.

Rosenbluth, 176 O. G. 274.

There are two reasons why drawings should be limited to as few sheets as possible, one to save storage, second to save expense of reproducing the drawings for a patent.

In order to decrease the number of sheets of drawings and at the same time obviating the necessity of caring for an additional sheet it is held that Figs. 4 and 5, contained on sheet three, and the descriptions specifically relating thereto, shall be canceled.

Pfautz, 159 O. G. 489.

Superfluous drawings.

Nestler, 119 O. G. 1259.

The entire invention might have been shown on one sheet of drawings, and there is very clearly no necessity for four sheets. It is not believed, however, that the present sheet one can be amended to show all features claimed without considerable trouble, and therefore the applicant will be permitted to retain sheets 1 and 3.

Roadhouse, 111 O. G. 1259.

Where only one sheet of drawings, including one figure, is filed with the application and the specification described four figures, and this discrepancy is not discovered until the case is examined on the merits. Held that the application must be regarded as incomplete until the date when the additional drawings are furnished.

Ehrendricch, 1904 C. D. 75, 109 O. G. 275.

Since the figures on sheet 1 of the drawings show the invention clearly, it is contrary to the letter and the spirit of the above rules to allow further illustration of the device.

Phillips, 105 O. G. 1779.

While an applicant is entitled to all reasonable latitude in illustrating his invention he can not be permitted unneces-

sarily to cumber the records with additional sheets of drawings when a mere statement in the specification will suffice.

Lundes, 103 O. G. 1681.

Appeal from the requirement that the number of sheets of drawings be reduced from ten to six.

Examiner affirmed. The growing custom of multiplying drawing condemned, when the Examiner and draftsman agree, their decision will be taken as correct in a clear case.

Dieschir, 1900 C. D. 166, 93 O. G. 551-552.

A sheet showing a feature not included in the claims is superfluous and should not be permitted to remain in the case.

Griffin, 1899 C. D. 224, 85 O. G. 454.

No more drawings than necessary.

Krause, 1891 C. D. 164, 56 O. G. 1708.

(5) *What Should be Shown.*

All claims should read on one figure if practicable.

Daum, 267 O. G. 183.

Only such matter as is claimed should be illustrated and described.

Parks, 191 O. G. 831.

A feature not appearing in the claims required to be distinctly shown so as to facilitate examination of the case and of the art.

Good, 164 O. G. 739.

If the device is shown sufficiently, it is unnecessary to show a form of its application.

Perkins, 142 O. G. 855.

Whether a figure should be canceled or not depends upon the question whether the state of the art is such as to render it necessary to limit the claims to the form of the device shown in other figures.

Engel, 121 O. G. 1011.

Where certain figures of the drawing show apparatus for making an article and all claims to such apparatus have been divided from the case and these figures do not aid in obtaining an understanding of the article, these figures, and the description of the apparatus illustrated therein, should be canceled.

Crecilius, 115 O. G. 1849.

The drawing and specification should be limited to the invention covered by the claims which have been allowed.

Anderson, 113 O. G. 2504.

It is well settled that an alleged lack of novelty furnishes

no good reason for a failure to illustrate matter which is claimed.

Bowman, 113 O. G. 1703.

A figure illustrating the previous state of the art required to be canceled.

Elliott, 109 O. G. 1337.

A sheet of drawing showing another application of the invented device and showing the details of the machine to which it is applied, should be canceled.

Crisler, 108 O. G. 1869.

Under the established practice of the Office an applicant is permitted to show several species of his invention when the state of the art permits the claim to be presented and allowed which is broad enough to cover all of the species shown and described.

Garland, 107 O. G. 267.

When one figure does not show the device claimed, but does show details of the surroundings in connection with which the device is to be used, held that the figures are objectionable.

Kidd, 105 O. G. 745.

As to figure 2 of the drawings, the Examiner says that it shows a modification covered by the claims, but is unnecessary and should be canceled because the applicant has another application covering that specific form.

The figure retained.

Leonius, 1903 C. D. 126, 103 O. G. 1164.

Where the claim of an application is for leather having certain characteristics used in a gas meter and no claim is made to the form of the gas meter. Held, that the application will be accepted without a drawing, since it is impossible to illustrate the character of the leather.

A drawing may, however, be subsequently required.

Kozminski, 1903 C. D. 92, 103 O. G. 429.

Claim 1 covers the invention shown in all the figures of the drawings. A distinction should be made between the invention disclosed and a specific illustration of said invention.

Mitzger, 1902 C. D. 407, 101 O. G. 1612.

The statute means not merely a drawing, but one showing what is described in the specification if it is capable of illustration.

A part of what is described can not be omitted any more than the whole of it.

The statute does not say that a drawing shall be furnished when the invention can not be understood from description alone.

Edgerton, 101 O. G. 1131.

The drawing must show every feature covered by the claims. This disk is shown in section in one of the views; but a drawing in section when it does not clearly and completely illustrate a structure is not sufficient to show the invention described and claimed.

Alminana, 100 O. G. 1331.

Imitation of graining required where this was an element of the claim.

Davin, 100 O. G. 453.

It is not necessary to retain in the drawing of an application for a patent for an article a figure to illustrate a process or step in its manufacture.

Henry, 1900 C. D. 159, 99 O. G. 1170.

Division required between machine and article made by it. Drawings of the machine required to be eliminated.

King, 1902 C. D. 158, 99 O. G. 1169.

A conventional part shown only to illustrate connection therewith should be shown so as to be recognizable by one skilled in the art.

Morse, 1901 C. D. 260, 97 O. G. 2982.

We do not think, however, that the appellant should be limited in his invention to the use of the angle which appears in the drawing. The specification contains no designation of a specific angle, and it is clear that patentee contemplated that the angle should be such as would successfully overcome the defect which his invention was designed to remedy.

Johnson v. Woodburn, 97 O. G. 403.

If a modified form of the apparatus is described in the specification it must be shown in the drawing.

Peck, 1901 C. D. 136, 96 O. G. 2409.

Where a party wishes to claim the general combination of parts and the specific form of some of the elements, he should include the preferred form of the elements in the figure of the drawings illustrating the combination which he wishes to claim, so that all claims will read upon the device shown in a single figure.

Welch, 1900 C. D. 190, 93 O. G. 2104.

Where the drawings show only detached portions so that they do not show their cooperation, it is impracticable for the Examiner to point out specifically, the necessary amendment.

General objections are sufficient to enable a skilled draftsman to cure the defects.

Tuttle, 1900 C. D. 25, 90 O. G. 1365.

Where an air compressor was an element of the claim, on

changing air compressor to source of compressed air, the requirement that the compressor should be illustrated was overruled.

Rouse, 88 O. G. 2242.

Claims should cover specifically only what is illustrated in the drawings; but since it can not be decided in this case whether the spurs of cleats are properly illustrated, without passing upon the question of new matter involved in some of the claims, this petition is dismissed.

Shearman, 1898 C. D. 190.

Objection to a drawing that an unnecessarily large variety of forms is shown should not be insisted upon when it appears that the several figures relate to and show modifications of the generic invention claimed.

Olan, 1897 C. D. 24, 79 O. G. 861.

An applicant can show and describe as many different forms of his invention as can be covered by a generic claim or claims.

Cook, 51 O. G. 1620.

The drawing must show every feature of the invention.

Crandall, 35 O. G. 625, R. S. 4889.

A drawing must be furnished if the nature of the case admits of it whether necessary or not.

Bennett, 35 O. G. 1003; Crandall, 35 O. G. 625; Chase, 1879 C. D. 245.

Modifications described in the specification should be shown in the drawing.

Witty and Caffrey, 29 O. G. 862; Howe, 25 O. G. 1189.

Every feature claimed must be illustrated if capable of illustration even if a drawing is unnecessary.

Chase, 1879 C. D. 245.

In an application for a process patent every stage, or subprocess distinctly claimed, which is capable of illustration by drawing, must be illustrated, but it is not in general necessary to illustrate by drawings the several steps in each stage of a subprocess claimed.

Carter, 1879 C. D. 243.

A part not claimed must be illustrated if such illustration is necessary to such an understanding of the subject matter as will enable those skilled in the art to practice the invention.

Carter, 1879 C. D. 243, 16 O. G. 809.

Separate views of the parts which are not claimed should be eliminated.

Kemp, 1879 C. D. 41, 15 O. G. 775.

If the invention is a combination it should be illustrated

as a combination, detached views of the parts are not sufficient.

Kemp, 1879 C. D. 41.

Where the operation of the parts is modified, controlled, or unusually affected by the added improvement, the whole machine should be illustrated.

Kemp, 1879 C. D. 41.

The specification and drawing must reveal some means of carrying the invention into effect.

Schoonmaker, 1878 C. D. 40.

The drawing and specification must correspond.

Schoonmaker, 1878 C. D. 40.

One or more modifications of the device claimed may be shown in the drawing.

Schoonmaker, 1878 C. D. 40; Eagle, 1870 C. D. 137.

If the machine is well known or if a description is readily accessible, it is only necessary to show so much of said machine as will illustrate the connection of the improvement claimed with it.

Tracy, 1875 C. D. 80; Kemp, 1879 C. D. 41; Smith, 1871 C. D. 84; Woodbury, 1869 C. D. 86; Gatling, 1870 C. D. 92.

(6) *How Illustrated.*

Stippling in appropriate cases if well executed may be used.

Kohler, 116 O. G. 569. Modified Bryant, 228 O. G. 1457.

If in a trade-mark case the drawing indicates colors, they must be described. If the colors indicated according to the chart are unessential a new drawing omitting this feature should be filed.

Timmerman Co., 127 O. G. 1991.

Must be line drawings. A dotted line drawing not admissible.

Lloyd, 112 O. G. 251-2.

The Office is warranted in requiring that the drawings of applications be presented in such shape as to facilitate an examination of the case.

Wolferperger & Moran, 113 O. G. 1418.

Where applicant showed a bottle without stating of what material it consists he should not be required to indicate that it is of glass according to the chart.

Person, 110 O. G. 1583.

The drawing should be so plain that the invention may be understood by simply inspecting them without the necessity of reading the specification.

Motsinger, 110 O. G. 601; Whitney, 110 O. G. 603.

The insulating material should be indicated as provided in the chart.

Whitney, 110 O. G. 603.

The invention appears to relate to the improvement of engines, tanks and receivers of known construction and their connection by pipes and valves and is probably more clearly illustrated by the present diagrammatic drawing than would be possible by views showing the parts in detail.

Clark, 109 O. G. 2169.

It is a great desideratum of Patent Office drawings that they should tell their story to the eye without making it necessary to go into the specification for explanation, which should be apparent upon inspection.

Sturtevant, 108 O. G. 563.

The fact that one skilled in the art could make the invention from the present disclosure does not overcome the necessity for such representation of the invention in the drawings as will make it intelligible for the purposes of search.

Sturtevant, 108 O. G. 563.

The scale of the drawing should be sufficiently large so that the structure is clear.

Hodges, 105 O. G. 1534.

The art of the mechanical draftsman has improved within recent years to such an extent that a drawing filed as part of an application for a patent should be so clear that the structure which it is intended to illustrate may be easily understood from a mere inspection of the drawings when the art is known to the person who is called upon to read the drawing.

Hodges, 105 O. G. 1534.

It is not necessary that the exact proportions of the parts should be indicated.

Creveling, 1902 C. D. 60, 98 O. G. 1708; Turner, 1902 C. D. 429, 101 O. G. 2078.

A drawing need not be made to scale, but should show all features.

Turner, 101 O. G. 2078.

The drawing should be such that a mechanic could with certainty from it make and use the device which the inventor has in mind.

Witsinger, 1902 C. D. 333, 100 O. G. 2773.

If the grain of wood running in a certain direction is an element of the claim it should be so shown in the drawing.

Davin, 100 O. G. 452.

When possible a drawing should be so complete that the purpose and operation of the invention may be readily understood by one skilled in the art by means of a mere inspection of said drawing.

The necessity of reading the specification in connection with the drawing should be avoided if possible.

The Examiner has suggested adding to the parts of the drawings showing the different connection words indicative of the particular connection. This suggestion is believed to be a good one.

Hartley, 97 O. G. 2746.

Modified forms of construction should be shown, if at all, in separate figures and in full lines and not in dotted lines.

Badger, 97 O. G. 1596-7.

The object of the drawings filed in the Patent Office is attained if they clearly exhibit the principle involved and in a case like this rigid adherence to the dimensions is not required or expected.

Crown Cork & Seal Co. of Baltimore City v. Aluminum Stopper Co. of Baltimore City, 96 O. G. 2575.

The policy of the Office is now to require drawings to be made so full and clear that in all simple easily understood cases models may be dispensed with.

Jove, 1880 C. D. 122, 17 O. G. 122.

Parts concealed by intervening portions of the machine should be represented by dotted lines.

Barcellos, 1880 C. D. 4, 17 O. G. 110.

Every feature claimed must be illustrated if capable of illustration even if a drawing is unnecessary.

Chase, 1879 C. D. 245.

(7) *Amendments to Drawings.*

See Rule 72 and notes.

Where all the figures were canceled from the drawings except some at one end of the sheet, so that the drawing would present peculiar and inartistic appearance in the patent. Held that new drawings should be furnished.

Burscheck, 119 O. G. 1258.

A general statement in the original specification as to a modification of the invention does not warrant an amendment to the drawing showing a species of the invention not originally disclosed.

Mother, 1904 C. D. 500, 113 O. G. 1145.

A drawing may be amended to correspond to a clear description in the drawing.

Zwiebel, 1904 C. D. 198, 110 O. G. 1428.

By the written permission of the Examiner in charge, in a proper case, a drawing may be amended upon filing a blue-print of the original drawing and illustrating either on this print or by means of a sketch the change in the original drawing which it is desired to make.

Zwiebel, 1904 C. D. 198, 110 O. G. 1428.

Where one of the figures of the drawing, showing an unimportant detail, was objected to in the same action in which the claims were rejected on references. Held that a subsequent amendment overcoming this objection and requesting a second action upon the claims places the case in condition for final rejection.

Marks, 1904 C. D. 115, 109 O. G. 1608.

An applicant will not be permitted to illustrate a specific form of the invention not originally disclosed, although it illustrates the generic invention.

Butcher, 1904 C. D. 60, 108 O. G. 1587.

The mere inking of a drawing after it is sworn to is not such an alteration in the application as would warrant striking it from the files.

Hopkins v. Scott, 1903 C. D. 261, 105 O. G. 1263.

Where blue-prints of original drawings have been made a part of the record, it is permissible to make slight changes in the original drawings, but not such changes as practically obliterate the identity of any of the original figures.

Kuhlman & Carpenter, 1903 C. D. 6, 102 O. G. 229.

Permitted to add a figure to drawing by amendment.

Larson, 1902 C. D. 452, 101 O. G. 2568.

A new drawing may not be substituted after allowance to eliminate a modification.

Cooper, 99 O. G. 669.

The right to make proper amendments to drawings is clearly within the authority given to attorneys to prosecute applications.

Wilcox, 1902 C. D. 409, 101 O. G. 1829.

An applicant can not be permitted to erase the lines of his drawing and delineate anew the construction and operation of a part fully shown and described or replace or well-described but inferior arrangement by a preferable form of his invention.

Clay, 1901 C. D. 256, 97 O. G. 2980.

Where in a decision upon appeal the Examiners-in-Chief call attention to imperfections in the drawing and specification. The amendments indicated, only, may be made.

Beck, 1901 C. D. 246, 97 O. G. 2746.

Since applicant indicates in his description that there must be a connection between the bar and the sheet, it is clear that the amendment is not for such new matter as it was proposed to insert in Delbey's (1901 C. D. 103) application.

Wareham, 1901 C. D. 204, 97 O. G. 1600.

New matter may not be introduced into the drawing such as to show a preferable form of the invention.

Baptist, 1901 C. D. 150, 97 O. G. 191; Alman, 1901 C. D. 151, 97 O. G. 191.

Where it appears that the changes sought to be made to the drawing include matter not originally shown and described and are not merely for the correction of clear and unmistakable error of the draftsman. Held that such changes constitute new matter and should not be admitted.

John, 1901 C. D. 118, 96 O. G. 1649; Delbey, 1901 C. D. 103, 96 O. G. 1240.

A new drawing may not be filed arbitrarily at the option of applicant, the office having made no objection to the old drawing.

Pugh, 96 O. G. 841-2.

Reference having been made in the original application to spurs or cleats, they can be shown, so long as the illustration of them does not involve a departure from the original disclosure; but the question as to whether a particular figure of the drawings illustrating them and covered specifically by the claims involves new matter is for the Examiners-in-Chief to decide.

Shearman, 1898 C. D. 190, 84 O. G. 1730.

A tintype not signed by the inventor or his attorney and not attested by two witnesses can not be considered a drawing within the statutes.

Palmer & Thompson v. Bailey, 1899 C. D. 66, 83 O. G. 1207.

The strips should be placed at right angles to their present position. The device as now illustrated is inoperative, and it seems obvious that the defects in the illustration are such as could only have occurred through a clerical error in making the drawing. Amendment permitted.

Bailey, 1898 C. D. 16, 82 O. G. 894.

There was a clear mistake in the original drawings. Though the mistake did not render the patent wholly inoperative, it was of such a character that a machine constructed in accordance with some of the drawings would have been in-