

operative for some purposes which the inventor was entitled to cover by his claims. Reissue proper.

Beach v. American Box Machine Co., Horace Inman et al., 69 O. G. 1067.

The drawing should not be changed unless and until the question of new matter in the amendment has been determined in favor of the applicant.

Tuber, 1894 C. D. 47, 67 O. G. 529.

A drawing filed in one application can not be transferred to an application filed in place thereof.

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

If a new attorney appears in the case, or it is necessary to have different witnesses from the original ones, such a change would be a departure from the original record and can not be permitted. The only remedy in such a case is to file a new sheet of drawing.

Arder, 48 O. G. 119; Zacharias, 1902 C. D. 80.

Rule 51. Two Editions of Drawings.

Two editions of patent drawings are printed and published—one for office use, certified copies, etc., of the size and character of those attached to patents, the work being about 6 by 9½ inches; and one reduction of a selected portion of each drawing for the Official Gazette.

Rule 52. Uniform Standard.

This work is done by the photolithographic process, and therefore the character of each original drawing must be brought as nearly as possible to a uniform standard of excellence, suited to the requirements of the process, to give the best results, in the interests of inventors, of the office, and of the public. The following rules will therefore be rigidly enforced, and any departure from them will be certain to cause delay in the examination of an application for letters patent:

(a) Drawings must be made upon pure white paper

of a thickness corresponding to two-sheet or three-sheet Bristol board. The surface of the paper must be calendered and smooth. India ink alone must be used, to secure perfectly black and solid lines.

(*b*) The size of a sheet on which a drawing is made must be exactly 10 by 15 inches. One inch from its edges a single marginal line is to be drawn, leaving the "sight" precisely 8 by 13 inches. Within this margin all work and signatures must be included. One of the shorter sides of the sheet is regarded as its top, and, measuring downwardly from the marginal line, a space of not less than $1\frac{1}{4}$ inches is to be left blank for the heading of title, name, number, and date.

(*c*) All drawings must be made with the pen only. Every line and letter (signatures included) must be absolutely black. This direction applies to all lines, however fine, to shading, and to lines representing cut surfaces in sectional views. All lines must be clean, sharp, and solid, and they must not be too fine or crowded. Surface shading, when used, should be open. Sectional shading should be made by oblique parallel lines, which may be about one-twentieth of an inch apart. Solid black should not be used for sectional or surface shading. Free-hand work should be avoided wherever it is possible to do so.

(*d*) Drawings should be made with the fewest lines possible consistent with clearness. By the observance of this rule the effectiveness of the work after reduction will be much increased. Shading (except on sectional views) should be used only on convex and concave surfaces, where it should be used sparingly, and may even there be dispensed with if the drawing be otherwise well executed. The plane upon which a sectional view is taken should be indicated on the

general view by a broken or dotted line, which should be designated by numerals corresponding to the number of the sectional view. Heavy lines on the shade sides of objects should be used, except where they tend to thicken the work and obscure letters of reference. The light is always supposed to come from the upper left-hand corner at an angle of 45° .

(*e*) The scale to which a drawing is made ought to be large enough to show the mechanism without crowding, and two or more sheets should be used if one does not give sufficient room to accomplish this end; but the number of sheets must be more than is absolutely necessary.

(*f*) The different views should be consecutively numbered. Letters and figures of reference must be carefully formed. They should, if possible, measure at least one-eighth of an inch in height, so that they may bear reduction to one twenty-fourth of an inch; and they may be much larger when there is sufficient room. They must be so placed in the close and complex parts of drawings as not to interfere with a thorough comprehension of the same, and therefore should rarely cross or mingle with the lines. When necessarily grouped around a certain part they should be placed at a little distance, where there is available space, and connected by lines with the parts to which they refer. They should not be placed upon shaded surfaces, but when it is difficult to avoid this, a blank space must be left in the shading where the letter occurs, so that it shall appear perfectly distinct and separate from the work. If the same part of an invention appear in more than one view of the drawing it must always be represented by the same character, and the same character must never be used to designate different parts.

(g) The signature of the applicant should be placed at the lower right-hand corner of each sheet, and the signatures of the witnesses, if any, at the lower left-hand corner, all within the marginal line, but in no instance should they trespass upon the drawings. (See specimen drawing, appendix.) The title should be written with pencil on the back of the sheet. The permanent names and title constituting the heading will be applied subsequently by the office in uniform style.

(h) All views on the same sheet must stand in the same direction and must if possible stand so that they can be read with the sheet held in an upright position. If views longer than the width of the sheet are necessary for the proper illustration of the invention the sheet may be turned on its side. The space for heading must then be reserved at the right and the signatures placed at the left, occupying the same space and position as in the upright views and being horizontal when the sheet is held in an upright position. One figure must not be placed upon another or within the outline of another.

(i) As a rule, one view only of each invention can be shown in the Gazette illustrations. The selection of that portion of a drawing best calculated to explain the nature of the specific improvement would be facilitated and the final result improved by the judicious execution of a figure with express reference to the Gazette, but which must at the same time serve as one of the figures referred to in the specification. For this purpose the figure may be a plan, elevation, section, or perspective view, according to the judgment of the draftsman. All its parts should be especially open and distinct, with very little or no shading, and it must illustrate the invention claimed only, to the

exclusion of all other details. (See specimen drawing.) When well executed, it will be used without curtailment or change, but any excessive fineness, or crowding, or unnecessary elaborateness of detail will necessitate its exclusion from the Gazette.

(j) Drawings transmitted to the office should be sent flat, protected by a sheet of heavy binder's board; or should be rolled for transmission in a suitable mailing tube, but should never be folded.

(k) An agent's or attorney's stamp, or advertisement, or written address will not be permitted upon the face of a drawing, within or without the marginal line.

CONSTRUCTIONS.

See notes under Rules, 49, 50.

The chart for draftsmen should be followed as to insulation.

Whitney, 110 O. G. 603.

Sectional surfaces of such thinness that they may be represented by a single line do not come within the prohibition of the last clause.

Millin and Reed, 160 O. G. 1037.

See note to Rule 38.

The same reference letter may not be used to designate parts claimed to be equivalents but differing in structure. In such cases a part may be designated by a letter and the modified form by the same letter with an appended figure.

Cook, 1890 C. D. 81, 51 O. G. 1620.

The lettering of the drawings should correspond to the references contained in the descriptive portion of the specification.

Borgfeldt, 1889 C. D. 199, 49 O. G. 132.

The illustration of the invention in Figure 3 is not clear. This due partly to the fact that many of the reference letters are too small to be easily discernible.

Hodges, 105 O. G. 1534.

It is suggested that letters or numerals be used without exponents.

120 O. G. 907.

The above is a notice published in the Official Gazette under a quotation from Rule 52.

Wherever possible the reference letters must be so placed so as to be read with the sheet in an upright position.

Notice, 172 O. G. 835.

In defense of a suit it was alleged that one of the witnesses signed inventor's and attorney's name.

This court holds that such irregularities in the signing of the drawings, conceding them to exist, are not a defense to this action. Should an action be brought to set aside the patent, a different question would be presented.

Hallock v. Babcock Mfg. Co., 124 F. R. 226.

Where an application executed by the inventor is filed after his death and the drawing is signed by the attorney appointed by the inventor, held that it is to be presumed that the drawing was signed before the death of the inventor and while the attorney had power to act.

Jones, 1903 C. D. 81, 103 O. G. 228.

If the attorney add his signature after it has been signed and duly executed by the inventor, it is objectionable under this clause.

McDonald, 101 O. G. 182.

Figures 1 to 4 of the drawings illustrate clearly all the features of construction covered by the claims. Figure 5 shows the same device only on a smaller scale and in addition it shows other parts of the harness all in position on the animal. Fig. 5 requires to be canceled.

Phillips, 105 O. G. 1779.

When the signature appears on a sheet of drawing in the wrong place, upon filing a blue-print of the original sheet, the signatures may be erased and written correctly thereon by the identical people if the same be done without mutilating the sheet or removing it from the Office.

If the signatures must be changed the only remedy is to file a new sheet. (Order 480-33 O. G. 119.)

Zacharais, 98 O. G. 2171.

Drawings must be signed. Stamped signatures not sufficient.

Krause, 1891 C. D. 164.

A member of the firm of applicant's attorneys who signs the firm name to the drawing is not also a competent witness to the signature of the firm.

Kyle, 1890 C. D. 84, 51 O. G. 1621.

Views if possible must be placed so that the sheet will not have to be placed on its side to read them.

Com. Order, 172 O. G. 71.

Rule 53. Drawings for Reissue Applications.

All reissue applications must be accompanied by new drawings, of the character required in original applications, and the inventor's name must appear upon the same in all cases; and such drawings shall be made upon the same scale as the original drawing, or upon a larger scale, unless a reduction of scale shall be authorized by the Commissioner.

The foregoing rules relating to drawings will be rigidly enforced. A drawing not executed in conformity thereto may be admitted for purposes of examination if it sufficiently illustrate the invention, but in such case the drawing must be corrected or a new one furnished before the application will be allowed. The necessary corrections will be made by the office, upon applicant's request and at his expense. (See Rule 72.)

Rev. Stat., sec. 4895.

Rule 54. Defective Drawings.

The foregoing rules relating to drawings will be rigidly enforced. A drawing not executed in conformity thereto may be admitted for purposes of examination if it sufficiently illustrate the invention, but in such case the drawing must be corrected or a new one furnished before the application will be allowed. The necessary corrections will be made by the office, upon applicant's request and at his expense. (See Rule 72.)

Sheets are broken at one or more points and eventually by reason of handling thereof they will undoubtedly separate on the broken lines. The well settled practice in the Office of refusing to accept mutilated drawings is founded upon the necessity of preserving the records of the Office for an indefinite period and must be enforced.

Frankman, 136 O. G. 1999.

Rule 55. Drawings Furnished by Office.

Applicants are advised to employ competent draftsmen to make their drawings.

The office will furnish the drawings at cost, as promptly as its draftsmen can make them, for applicants who can not otherwise conveniently procure them.

In the absence of explicit and definite instructions, the Office will not remake a drawing at its own expense.

Rosenheim & Moombil, 122 O. G. 1722.

*THE MODEL.***Rule 56. When Models are Required.**

A model will be required or admitted as a part of the application only when on examination of the case in its regular order the primary examiner shall find it to be necessary or useful. In such case, if a model have not been furnished, the examiner shall notify the applicant of such requirement, which will constitute an official action in the case. When a model has been received in compliance with the official requirement, the date of its filing shall be entered on the file wrapper. Models not required nor admitted will be returned to the applicants. When a model is required, the examination may be suspended until it shall have been filed.

Rev. Stat., sec. 4891.

CONSTRUCTIONS.

At the present time the black photographic prints which are required to be furnished before any modification of the drawing can be made are of a permanent character and can be easily photographed. Under these circumstances it does not seem that Order 55 should be so construed as to prohibit the removal of an original figure.

Bishop & Bishop, 186 O. G. 560.

Models filed during the prosecution of an application for a patent but not entered as part of the record thereof.

Stratton et al., 157 O. G. 755.

Beath, 111 O. G. 2220.

If the description is such that the invention can not be understood without a model, a model must be furnished. The Examiner can not be permitted to leave his work on other applications to give his exclusive time to one until he can go to Woonsocket, R. I., to examine the full sized machine.

E. P. McTammany and Wright, 103 O. G. 661.

The Office required a model, which applicant furnished, clearly indicating, however, at that time and subsequently that he wished the model returned. The Office did not, in response to applicant, insist upon the permanent filing of a model, nor were the receipt and application of the model to the case under consideration entered on the file wrapper. On renewed request the model should be returned.

Hunter, 1892 C. D. 192, 60 O. G. 1477.

A model should not be endorsed upon the file wrapper and be considered a part of the application unless the applicant has been required by the Office to furnish one.

Beaumel, 1891 C. D. 137, 56 O. G. 1203.

The specification drawing and model must correspond.

Schoonmaker, 1878 C. D. 40; Crandall, 1886 C. D. 5, 35 O. G. 626.

Definite reasons why a model is required must be given by the Examiner in his answer to an appeal from such requirement.

Jove, 1880 C. D. 122, 17 O. G. 801.

The policy of the Office now is to require drawings to be made so full and clear that in all simple easily understood cases models may be dispensed with.

Jove, 1880 C. D. 122, 17 O. G. 801.

In case an application is divided one model may serve for both applications.

Morse, 1873 C. D. 81, 3 O. G. 467.

A model required if the case admits of it even if not necessary to the understanding of the invention. (Old practice.)

Murdock, 1874 C. D. 103.

Rule 57. Requisites of Model.

The model must clearly exhibit every feature of the machine which forms the subject of a claim of invention, but should not include other matter than that covered by the actual invention or improvement, unless it be necessary to the exhibition of the invention in a working model.

Rule 58. Material.

The model must be neatly and substantially made of durable material, metal being deemed preferable; but when the material forms an essential feature of the invention, the model should be constructed of that material.

Rule 59. Working Models.

A working model may be required if necessary to enable the office fully and readily to understand the precise operation of the machine.

Rule 60. Models in Rejected and Abandoned Cases.

In all applications which have become abandoned, the model, unless it be deemed necessary that it be preserved in the office, may be returned to the applicant upon demand and at his expense; and the model in any pending case of less than one year's standing may be returned to the applicant upon the filing of a formal abandonment of the application, signed by the applicant in person and any assignee. (See Rule 171.)

Models belonging to patented cases shall not be taken from the office except in the custody of some sworn employee of the office specially authorized by the Commissioner.

Rev. Stat., sec. 485.

Rule 61. Models Filed as Exhibits.

Models filed as exhibits in contested cases may be returned to the parties at their expense. If not claimed within a reasonable time, they may be disposed of at the discretion of the Commissioner.

*SPECIMENS.***Rule 62. Specimens of the Composition.**

When the invention or discovery is a composition of matter, the applicant, if required by the Commissioner, shall furnish specimens of the composition, and of its ingredients, sufficient in quantity for the purpose of experiment. In all cases where the article is not perishable, a specimen of the composition claimed, put up in proper form to be preserved by the office, must be furnished. (Rules 56, 60, and 61 apply to specimens also.)

Rev. Stat., sec. 4890.

*THE EXAMINATION.**Introduction to Rules on the Examination.*

“This, I believe, we owe in large measure to the civil service rules which were first put into effect during General Grant’s administration, by that great Commissioner, Samuel S. Fisher. As a result of his wise action the standard has been set so high that the whole examining corps is made up of professional men with the stability of character and high ideals which the study of any great profession helps to develop. No one can find in the history of the Office any basis for objection to trusting its integrity in any way that the disposition of its business demands.”

Com. Thomas Ewing, address Annual Banquet, American Patent Law Association; Washington, Feb. 28, 1916.

I think that every attorney before being admitted to the practice should be required to serve as Commissioner for at least six months. But since this is not practicable, let me give you this general suggestion by way of warning: Don’t teach the Office bad tricks; don’t do sloppy work; don’t make dilatory actions; don’t try to stop someone else who is entitled to it from getting a patent. In a word, don’t do all the things you complain of when the Office does them.

Com. Thomas Ewing, address Annual Banquet, American Patent Law Association, Washington, Feb. 28, 1916.

Rule 63. Order of Examination.

Applications filed in the Patent Office are classified according to the various arts, and are taken up for examination in regular order of filing, those in the same class of invention being examined and disposed of, so far as practicable, in the order in which the respective applications have been completed.

Applications which have been put into condition for further action by the examiner shall be entitled to precedence over new applications in the same class of invention.

The following cases have preference over all other cases at every period of their examination in the order enumerated:

(*a*) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service, and when for that reason the head of some department of the Government requests immediate action and the Commissioner so orders; but in this case it shall be the duty of the head of that department to be represented before the Commissioner in order to prevent the improper issue of a patent.

(*b*) Applications for reissues.

(*c*) Cases remanded by an appellate tribunal for further action, and statements of grounds of decisions provided for in Rules 135 and 142.

(*d*) Applications which appear to interfere with other applications previously considered and found to be allowable, or which it is demanded shall be placed in interference with an unexpired patent or patents.

(*e*) Applications which have been renewed or revived, but the subject matter not changed.

(*f*) Applications filed more than twelve months

after the filing of an application for the same invention in a foreign country.

Applications will not be advanced for examination excepting upon order of the Commissioner either to expedite the business of the office or upon a verified showing that delay will probably cause the applicant serious and irreparable injury.

CONSTRUCTIONS.

Applications will not be given precedence over other cases in the order of examination merely because the applicant asks for an interference with a patent, but only in those cases where it appears that there is proper foundation for the request.

Lux, 116 O. G. 2011.

The question of classification rests entirely with the Office and is within the discretion of the Chief of the classification division to whom the Examiner refers the case if he has any doubt as to its classification. Petition to transfer the application refused.

Stevenot, 1904 C. D. 337, 111 O. G. 1939.

The Office can not take up cases in the order of their importance to the applicant, but must be governed by the rules.

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

An application will not be transferred from one division to another on the ground that it is not receiving proper treatment by the Examiner in charge of it. Other relief will be applied when it is clear that the Examiner is not performing his duties as he should.

Weaver, 1897 C. D. 165, 81 O. G. 967.

The classification of the Office is not arbitrary. It is the natural work of those who create and develop the arts by invention and otherwise. The Office simply recognizes those relations and classes which exist in the nature of things.

Her, 41 O. G. 463; Wilcox & Borton, 45 O. G. 455;

Combs, 1871 C. D. 209; Sartell, 42 O. G. 295.

Cases which have been appealed and returned to the Examiner should take precedence for action over all other applications awaiting action except other similar cases.

Bigelow, 1878 C. D. 114, 14 O. G. 821.

There is a special propriety, when a patent has only a short time to run, in endeavoring to facilitate the determina-

tion of the issue which may arise in the application for a reissue.

Evarts, 1874 C. D. 39.

Rule 64. Merits Treated Throughout. At Last Form Insisted Upon.

Where the specification and claims are such that the invention may be readily understood, the examination of a complete application and the action thereon will be directed throughout to the merits; but in each letter the examiner shall state or refer to all his objections.

Only in applications found by the examiner to present patentable subject matter and in applications on which appeal is taken to the examiners in chief will requirements in matters of form be insisted on. (See Rules 95 and 134.)

HISTORY.

Rule 29 of 1873 reads in part as follows:

“The first step in the examination of an application will be to determine whether it is in all respects in proper form. If, however, an objection as to form is not vital, the Examiner may proceed to the consideration of the application on its merits; but in such case he must, in his first letter to applicant, state all his objections, whether formal or otherwise.”

1879. Rule 63 adds to above matter: “And until the formal objections are disposed of no further action will be taken upon its merits without the order of the Commissioner,” and inserts “if possible” after “must” in the last clause.

Present rule inserted in the edition of February 9, 1897.

See notes to Rule 67.

CONSTRUCTIONS.

If any patentable subject matter has been found, the formal requirements must be complied with.

Daum, 267 O. G. 183.

Not only does no reference cited anticipate appellant claim, but no combination of the references can be devised which will accomplish this end.

Heath, 230 O. G. 335-6.

The claims are therefore rejected on the ground that they are broader than applicant's conception.

Frietts, 227 O. G. 741.

In the absence of proof of mechanical skill only, and where the question of patentability is close, the doubt should be resolved in favor of applicant.

Heath, 230 O. G. 335-6.

The mere fact that one element of a structure forms part of each of two means which are set up as forming a combination of elements whereby certain functions may be accomplished is not of itself sufficient ground for holding the claim indefinite.

Isherman, 188 O. G. 807.

The objection that applicant has not shown "dual means, etc.," as specified in claims, should have been a rejection.

Iserman, 188 O. G. 807.

It is therefore seen that the application has been found by the Examiner to "present patentable subject matter" and consequently he is justified if the conditions of the case warrant in insisting upon his requirements for amendment in matters of form.

Fritsch, 173 O. G. 864.

The rule contemplates that all formal objections should be made in the first action. But they may, if necessary, be made afterward.

Fritsch, 173 O. G. 864.

If the invention may be understood the fact that additional drawings are required does not warrant postponing action on the merits.

Perkins, 142 O. G. 855.

Bitner, 140 O. G. 256. (See notes to Rules 65-66.)

The question of main interest is the merits and the postponement of formal matters is for the purpose of preventing delay in reaching a conclusion upon that question.

Severy, 97 O. G. 2745; Green, 130 O. G. 299.

Where the applicant states in his specification that he does not regard his invention as limited to the exact details of construction and it appears that his claims are not so limited, held that he should not be required to cancel the statement

as superfluous. (Ex parte Champ, 114 O. G. 1827, distinguished.)

Jansson, 120 O. G. 2127.

Where an applicant in good faith by amendment attempts to cure formal objections, if the amendments are not satisfactory the Examiner should so state in specific language.

Sjungstrom, 119 O. G. 2235.

The question of superfluous illustration should be finally raised only after the application has been restricted to allowable claims.

Metler, 119 O. G. 1259.

After several objections on the ground of insufficiency of disclosure, the claims should be rejecttd.

Stevens, 119 O. G. 1258.

The requirement of a supplemental oath (Matthes, 101 O. G. 3108) should be disposed of before an appeal is forwarded.

Teller, 113 O. G. 548-549.

The outlet to the atmosphere from the three-way valves 12, 12 should be shown in figure 1 before final action, but their appearance upon the drawing is not essential to an understanding of the invention and does not warrant suspension of action upon the merits of the invention.

Clark, 1904 C. D. 573, 109 O. G. 2169.

In case of alleged duplicate claims an action on the merits should be given and formal objection made at the same time to the multiplicity of the claims. Under no conditions, however, is refusing an action on the merits justifiable (as was said in Laperle and Baulard, 67 M. S. Dec. 9429).

Under this rule the Examiner was required to act upon the merits of the application without regard to the action upon mere reason for suspending action upon merits.

Segelhorst, 1904 C. D. 125, 109 O. G. 1887.

As to final rejection before formal matters disposed of.

Marks, 1904 C. D. 115, 109 O. G. 1608.

It is as essential that the formal question on which petitions are taken should be twice acted upon as it is that questions involving the merits should be twice acted upon. (Sec. 4909 R. S.) before appeals from the decisions of the Primary Examiners are taken to the Examiners-in-Chief.

Shone, 1902 C. D. 155, 99 O. G. 863.

The invention is a complicated one and can not of course be readily understood upon a mere inspection of the drawing. The drawing, however, is clear when read in connection with the specification, and the invention can be understood.

The condition of this application warrants an action throughout on the merits.

Springborn, 1902 C. D. 142, 99 O. G. 667.

If a part of an amendment is inadmissible the whole should be refused admission.

Pugh, 1901 C. D. 78, 96 O. G. 841.

The Examiner's action in making formal requirements after the case had been decided by the Examiners-in-Chief and the Commissioner on appeal was regular.

Olan, 1897 C. D. 24, 79 O. G. 861.

If the title given by the applicant is not satisfactory to the Examiner, objection should be made, but the Examiner himself should not arbitrarily select such title.

Becker, 1893 C. D. 95, 64 O. G. 559.

Final rejection should not be given until all matters of form are settled.

Where a claim was finally rejected and at the same time the statement of invention was criticised as being too broad, the final rejection was premature and an amendment touching the merits may properly be admitted thereafter.

Klaus, 1893 C. D. 87, 64 O. G. 299.

The course prescribed by this rule was not followed and on this account serious embarrassment has arisen in its prosecution.

Rogers, 1890 C. D. 121, 52 O. G. 460.

Where the Examiner had objected to a claim because of its undue breadth only and declined to further consider it upon the merits until it had been restricted in form, held that the reason given was a reason why the claim should be rejected and not why an examination should be refused.

Opdyke, 1890 C. D. 39, 50 O. G. 1293.

No requirement of amendment insisted upon as a condition precedent to future examination can be either legal or permissible which tends in the minutest degree to prevent the applicant from obtaining a full investigation of his rights on appeal.

Rogers, 1889 C. D. 227, 49 O. G. 1361.

Where two office letters were written, one containing formal objections and objections to the merits, and the second repeating the former objections to the merits, it was held two rejections warranting an appeal.

Mill, 1887 C. D. 92, 40 O. G. 918.

If the formal objections are vital no further action than to object on account of said formal defects should be taken until they are removed.

Mill, 1887 C. D. 92, 40 O. G. 918; Silltiman, 1886 C. D. 1, 34 O. G. 1389.

It is not until the Examiner signs the file wrapper and forwards the case to the issue division that he can be considered as having rendered a favorable judgment upon it.

Fredericks and Burns, 40 O. G. 591; Buell, 26 O. G. 437; Starr, 1879 C. D. 91.

An Examiner has jurisdiction until the case is allowed and passed to issue.

Fredericks and Burns, 40 O. G. 691; Starr, 1879 C. D. 91; Buell, 26 O. G. 437.

The office of Primary Examiner in the Patent Office is a continuing one, and does not change with the person of the incumbent.

Fredericks & Burns, 1887 C. D. 66, 40 O. G. 691.

If formal objections are not vital, all objections should be stated in the first letter, but the claims should not be rejected until the formal defects are removed.

Silltman, 1886 C. D. 1, 34 O. G. 1389.

Applicants should be told distinctly and definitely what the objections are to their applications, reference to pencil marks on the specification is not sufficient.

Wilkins, 1883 C. D. 65, 24 O. G. 1271.

The practice of multiplying actions on cases on questions of mere form without at the same time touching the merits of the case, condemned as in violation of the spirit of Rule 63.

Kitson, 1881 C. D. 49, 20 O. G. 1750.

The matter of form referred to and contemplated in Rule 63 are such as relate to putting the case in condition to go to the Examiner; such as are required to remedy and utter absence of compliance with the prerequisites of an application under the law.

Kitson, 1891 C. D. 49, 20 O. G. 1750.

An Examiner can not submit a question to the Board of Examiners-in-Chief without expressing an opinion.

Coleman, 1880 C. D. 205, 18 O. G. 1051.

Upon a decision and notice that all formal objections have been removed, followed by a consideration of the case upon its merits, neither the same formal objections nor any other ought to be insisted on by the Examiner without the authority of the Commissioner.

Starr, 1879 C. D. 91, 15 O. G. 1053.

I do not think it reasonable after eighteen months spent on the merits of the case to insist upon such formal objections.

Bate, 1879 C. D. 84, 15 O. G. 1012.

*REJECTIONS AND REFERENCES.***Rule 65. Notice of Rejection, with Information and References.**

Whenever, on examination, any claim of an application is rejected for any reason whatever, the applicant will be notified thereof. The reasons for the rejection will be fully and precisely stated, and such information and references will be given as may be useful in aiding the applicant to judge of the propriety of prosecuting his application or of altering his specification, and if, after receiving this notice, he shall persist in his claim, with or without altering his specification, the application will be reexamined. If upon reexamination the claim shall be again rejected, the reasons therefor will be fully and precisely stated.

Rev. Stat., sec. 4903.

HISTORY.

Rule 33 of 1870 reads as follows:

“Whenever, on examination, any claim for a patent is rejected for any reason whatever, the applicant will be notified thereof, and the reasons for such rejection will be given, together with such information and references as may be useful in judging of the propriety of renewing the application or of altering his specification; and if, after receiving such notice, he shall persist in his claim for a patent, with or without altering his specification, the case will be reexamined.”

The present rule is substantially the same as Rule 64 of June 18, 1897.

(For matter relating to abandonment and time limit, see Rules 77, 171, and 172.)

(See also notes to Rule 68.)

CONSTRUCTIONS.

The Examiner should follow the decision of the higher tribunal whether he agrees with it or not. It would not, however, be proper for the Commissioner to instruct the Examiner that the claims of a particular application should be

allowed in view of a prior decision. The Examiner thinks the prior decision is not pertinent if he is in error an appeal should be taken to the Board in the first instance.

Konald, 133 O. G. 279.

While it is not incumbent upon the Office to answer all the arguments presented by counsel, yet the prosecution of the case should be so conducted as to permit a fair chance for the amendment of the claims after the decision of the Office is made clear.

Herbst, 131 O. G. 361.

It does not appear that the Examiner has answered the contention of the applicant as to the reasons why he regards the patent cited as belonging to the same art so as to justify its citation in this case. It is quite clear that if an appeal should be taken from the final rejection it would be necessary for the Examiner to touch upon the subject. It is believed that the Examiner should do so before an appeal is made necessary.

Burge, 129 O. G. 1611.

Where several claims are rejected it should appear in the Examiner's letter whether all the references are cited against each claim, or whether they are cited distributively against the various claims. In the latter event it should be made clear in connection with each claim, which references are relied upon in the rejection thereof. Where several references are cited against a claim it should be made clear whether each reference is regarded as sufficient in itself to defeat the claims or whether the references are to be taken jointly. If to be taken jointly the theory upon which they are combined must be pointed out.

Lincoln, 127 O. G. 3216.

The common impression, however, the Examiner should ordinarily apply the references to the claims, element for element is unwarranted.

Lincoln, 127 O. G. 3216.

The Examiner should not be required to instruct the applicant upon the general principles or definitions of the patent law. The specific application of the law to this case as understood by the Examiner seems to have been sufficiently set forth by him.

Wainright, 1906 C. D. 495, 125 O. G. 2047.

When an applicant for a design patent presents a claim and the Patent Office says you can not have that claim, and you can have no claim but the one we suggest, such ruling is in effect a rejection of the claim presented and if the appli-

cant persists in his demand he is entitled to an appeal to the Examiners-in-Chief.

Delavoye, 1906 C. D. 320, 124 O. G. 626.

The Examiner stated that certain claims were so broad that they were "manifestly" impertinent in view of the prior art. Such a general statement without some reference to the disclosure in the prior art would not have been proper, but it appears that Examiner subsequently cited a reference and rejected the claims. It does not appear that he had cast a cloud upon or expressed a doubt as to the validity of claims allowed by him.

Holzer, 1906 C. D. 110, 121 O. G. 1011.

If two or more claims are met in a single reference or if the same ground of rejection apply to them, a single statement to that effect makes his position just as clear as would a repetition of the statement for each separate claim.

Murray, 1904 C. D. 358, 111 O. G. 2491.

It is not necessary that the Examiner shall meet every argument advanced by an applicant. It is necessary only that the Examiner's position be made plain on the record.

Stier, 1904 C. D. 156, 110 O. G. 559-600.

The Examiner's action was as full and complete as could be required of him. There was simply a disagreement between the applicant and the Examiner as to the "case" patent after discussion.

Leilich, 1904 C. D. 21, 108 O. G. 561.

It is a well recognized principle of law that doubts as to the patentability of a claim may be waived in favor of the applicant; but this should be a mental process and should not be formally expressed in the record.

Overstrom, 1903 C. D. 263, 105 O. G. 1531.

It is not fair to the applicant to throw a cloud upon his claims by a suggested doubt to their validity without rejecting any claim. The statement will be made specific but not expunged from the record.

Jangerfeld, 1903 C. D. 175, 104 O. G. 1655.

When applicant asks that certain features which he is unable to find in the references be pointed out ordinarily the Examiner should comply.

Miller, 1903 C. D. 147, 104 O. G. 309.

No statement in the Office letter that certain claims are novel can be held to be binding upon the Office to the extent that the claims of necessity must be subsequently allowed.

Fowler, 1902 C. D. 465, 101 O. G. 2822.

It is one of the best settled principles of practice that an

applicant shall be fully informed of the reasons for rejection and shall have ample opportunity to meet them.

Morely, 1902 C. D. 114, 99 O. G. 668.

The objection of inoperativeness should be made only when supported by a statement of the reason therefor and not dogmatically. The applicant obviously can not know what argument to make in the effort to convince the Examiner until he know what position the Examiner takes.

Gibon, 1902 C. D. 117, 99 O. G. 227.

The application as a whole should not be rejected, but only the claims thereof, and the rejection should be plain, unmistakable terms and the word "rejected" should be used.

Byrnes, 191 C. D. 152, 97 O. G. 191; Gammonds, 1902 C. D. 78, 98 O. G. 2171; Kendall, 1900 C. D. 174, 93 O. G. 754; Eastman, 1891 C. D. 178, 57 O. G. 410.

All references should be cited on first action, but it is sometimes impossible.

Waters, 1901 C. D. 243, 97 O. G. 2744.

To what degree it is necessary to point out such pertinence depends upon the circumstances of the case.

Sandman, 1900 C. D. 229, 97 O. G. 2532.

The purpose of requiring an explanation by the Examiner is not arbitrary, but is to enable the applicant to properly understand his position, and therefore the extent and scope of the explanation necessary must depend upon the circumstances of the particular case. Some formal defects are so plain that the mere mention of them is sufficient.

Schweitzer, 1901 C. D. 179, 97 O. G. 1371.

Where no objections to a claim are made it is to be concluded that there are no objections.

Albert, 1901 C. D. 66, 96 O. G. 426.

The Examiner must refer to the Office letter to which his action is a reply.

Official Order, 94 O. G. 1189.

This rule must be complied with no matter how well known the old way or device it.

Garms, 1900 C. D. 160, 93 O. G. 190.

The Examiner is only required to comply with applicant's request for fuller explanation when applicant points out on what specific points he is in doubt. Henderson, 91 O. G. 228, 97 C. D. 1599. But when he points out the specific points, and asks to have explained the applicability of the references to them the Examiner should comply.

Kroeninger, 1900 C. D. 84, 91 O. G. 2002.

A general statement by the Examiner that the drawing was

unsatisfactory because the parts were not shown assembled, was held to be sufficiently specific.

Tuttle, 1900 C. D. 25, 90 O. G. 1365.

The Examiner should definitely define his position and point out the part of the devices referred to which he regards as anticipating applicant's claim.

Perkins, 1899 C. D. 141, 88 O. G. 548.

Applicant is entitled, before the case is closed before the Examiner, to an explanation of the references and their bearing on the claims rejected as full and clear as any explanation that would be considered necessary at any subsequent stage in the progress of the case.

Barnes, 1897 C. D. 76, 80 O. G. 2038.

Where on a question of division applicant alleges that his article can not be produced except by his process, and the Examiner says it can, without pointing out the mode, the Examiner's position is not tenable.

Hines, 1892 C. D. 164, 60 O. G. 576.

Applicant is entitled to have his claims allowed or to have them rejected in such language as to make it unmistakable that action has been had under R. S. 4909.

Wiard, 1890 C. D. 52, 51 O. G. 155.

The Examiner should assign all grounds that exist for rejection, in order that the whole case may be carried up on one appeal to the Examiners-in-Chief.

Roberts, 1890 C. D. 51, 51 O. G. 155; Wiard, 1890 C. D. 52, 51 O. G. 155.

It should never be considered a work of supererogation to give an applicant such full and complete information as will enable him to judge of the propriety of complying with the demands of the Examiner or of taking a petition or an appeal.

Burt, 1889 C. D. 251, 49 O. G. 1986.

The applicant has a right to have his applications examined as it stands until reasons of the Examiner for requiring an amendment are given.

Templeton, 1880 C. D. 128, 17 O. G. 910.

It is not worth while to make suggestions of claims. The applicant's attorney is entitled to present the case in his own way in the first instance, and to exercise his own judgment as to what course he will pursue to protect the applicant's interest when he is informed of it.

Evarts, 1874 C. D. 39, 5 O. G. 429.

Reasons must be definite, such as will allow of an issue being formed.

Evarts, 1874 C. D. 39, 5 O. G. 429.

Disparaging remarks as to the character of the invention of doubtful propriety.

Cheesebrough, 1869 C. D. 18.

Rule 66. On Rejection for Want of Novelty best References to be Cited.

Upon taking up an application for action on the merits the examiner shall make a thorough investigation of the prior art with respect to the invention sought to be protected in the application. Upon the rejection of an application for want of novelty, the examiner must cite the best references at his command. When the reference shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of the reference, if not obvious, must be clearly explained and the anticipated claim specified.

If domestic patents be cited, their dates and numbers, the names of the patentees, and the classes of invention must be stated. If foreign patents be cited, their dates and numbers, the names of the patentees, and the classes of inventions must be stated, and such other data must be furnished as may be necessary to enable the applicant to identify the patents cited. In citing foreign patents the number of sheets of drawing involving the parts relied upon for anticipation must be specified, and in case part only of the patent be involved, the particular sheets of the drawing containing the parts relied upon must be identified by number, or by stating the numbers of the figures involved. If printed publications be cited, the title, date, page or plate, author, and place of publication, or place where a copy can be found, shall be given.

When reference is made to facts within the personal knowledge of an employee of the office, the data shall be as specific as possible, and the reference must be supported, when called for, by the affidavit of such employee (Rule 76); such affidavit shall be subject to contradiction, explanation, or corroboration by the affidavits of the applicant and other persons. If the patent, printed matter, plates, or drawings so referred to are in the possession of the office, copies will be furnished at the rate specified in Rule 191, upon the order of the applicant.

HISTORY.

Rule 37 of 1869 reads as follows:

“Upon the rejection of an application for want of novelty, the applicant will be furnished with a specific reference (by name, date, and class) to the article or articles by which it is anticipated, so that he may be enabled to judge of the propriety of renewing his application, or of amending his specification to embrace only that part of the invention which is new. If he desires a copy of the cases so referred to, or of the plates or drawings connected with them, they will be forwarded to him, if in possession of the Office, on payment of the cost of making such copies.”

The 35th to the 65th words, both inclusive, were omitted in 1870 and in 1871, omit all after “will” first occurrence, to end of bracketed clause and substitute therefore “if he demands it, be entitled to a specific reference (by name, date, and class, or the equivalent thereof.)”

1873. After “novelty,” insert “the Examiner must cite the best references at his command.”

The next change was to Rule 65 of 1879.

Rule 66 of 1888 reads as follows:

Upon the rejection of an application for want of novelty the Examiner must cite the best references at his command. When the reference shows or describes inventions other than that claimed by the applicant, the particular part relied on will be designated as nearly as practicable. The pertinence of the reference, if not obvious, must be clearly explained and the anticipated claim specified.

If domestic patents be cited, their dates and numbers, the names of the patentees, and the classes of inventions must be

stated. If foreign patents be cited, their dates and numbers must be stated and such other data must be furnished as will enable the applicant to identify the patents cited. If printed publications be cited, the title, date, page, or plate, and place of publication, or place where a copy may be found, will be given. When reference is made to facts within the personal knowledge of an employe of the office, the data will be as specific as possible, and the reference must be supported, when called for, by the affidavit of such employe (Rule 76); such affidavit shall be subject to contradiction, explanation, or corroboration by the affidavits of the applicant and other persons. If the patent, printed matter, plates, or drawings so referred to are in the possession of the Office, copies will be furnished at cost upon the order of the applicant.

In 1892 the words "at the rate specified in Rule 218" were inserted instead of "at cost," last line.

June 18, 1897, the requirement relative to foreign patent that "the names of the patentees, titles of the inventions, and classes of inventions must be stated" was inserted and with reference to publications that the "author" must be given.

See Rules 68, 69 and 77.

CONSTRUCTIONS.

- (1) GROUNDS OF REJECTION IN GENERAL.
- (2) PROPRIETY OF REFERENCES.
- (3) ACTION BY THE OFFICE.
- (4) ACTION BY THE OFFICE AS CONSTITUTING A PROPER FINAL REJECTION OF REOPENING THE CASE.
- (5) NEW MATTER.
- (6) REJECTION ON APPLICANT'S OWN PATENT OR APPLICATION.
- (7) ACTION OF OFFICE AS TO UNITY OR DIVERSITY OF INVENTION.
- (8) ADDITIONAL CASES.

(1) *Grounds of Rejection in General.*

If the Examiner knows of, or can find any art bearing upon the disclosure of the application he should cite it without reference to the wording of claims. Said of a delayed application for a reissue.

Altman, 220 O. G. 1373.

The Examiner ruled that he could not suggest a claim.

Vesey, 195 O. G. 273.

When the pertinency of the references is obvious as where the invention is simple or includes only the invention of the

applicant a detailed application of the references is unnecessary (133 O. G. 1188; 152 O. G. 229; 154 O. G. 1411).

Inman, 160 O. G. 1038.

The fact that a new claim was inserted in an application for a patent by the attorney for the applicant without any new oath does not render the patent invalid as to such claim, where it was within the invention described in the specification.

For cases in point, see Vol. 38, Cent. Dig. Patents, section 40?

Cutler-Hammer Mfg. Co. v. Union Electric Mfg. Co., 147 F. R. 266.

In the absence of proof of mechanical skill only, and where the question of patentability is close the doubt should be resolved in favor of the applicant.

Hiath, 230 O. G. 335-6.

The claims are therefore rejected on the ground that they are broader than applicant's conception.

Fritts, 227 O. G. 741.

Where an application is a continuation of one of prior date to the reference cited against common subject matter, the reference should not be insisted upon.

Allport, 220 O. G. 1374.

The piecemeal presentation of the art was of course annoying to the applicant and is not consistent with the attempt to hold the applicant strictly to the rule of prompt prosecution.

Levy, 220 O. G. 1043.

It is the policy of the Office closely to scrutinize claims after they have been pending in the Office an unusual length of time.

Cases, Fritts, 227 O. G. 737, distinguished from Goodwin Film Co. v. Eastman Kodak Co., 213 F. 231.

In view of the facts shown, no good reason is seen why the Examiner should be required to repeat in each letter an explanation of the reference once given.

Shillabarger, 200 O. G. 855.

When a patent has inadvertently been granted, an application should not be rejected unless in a very clear case.

Both v. Burr, 200 O. G. 582.

Examiner required to identify figure of drawing of foreign patents referred to and, if only one sheet, that fact shall be stated.

Order No. 2,096, 199 O. G. 311.

When the applicant canceled two claims that were held

objectionable and immediately reinserted one a statement to that effect was held sufficiently explicit.

Ehrlich and Berthem, 191 O. G. 1068.

An action by the German Office cited—considered, but not followed.

Maas, 180 O. G. 1138.

Complete actions on the part of the Office are as important as the avoidance of piecemeal prosecution on the part of the applicant.

Garrett, 158 O. G. 701.

The requirement by the Examiner that a statement be made pointing out the parts or elements of his claims, approved.

Hoch v. McCaskey v. Hopkins, 141 O. G. 1161.

In all cases where Examiner holds a claim otherwise clear and intelligible to be functional, that is for a function merely or because it fails to include sufficient mechanical elements to effect the function expressed in the claim, the action of the Examiner shall be a rejection of the claim upon the ground that the claim does not point out the invention with sufficient particularity and distinctness to meet the requirements of section 4888, Revised Statutes. The rejection shall at the same time include all of the grounds enumerated in Rule 133 that the Examiner thinks applicable. Applicant's remedy from such action is by way of appeal successively to the Examiners-in-Chief, the Commissioner and the Court of Appeals of the District of Columbia. Second, that only where claims are indefinite, in the sense that they are ambiguous, equivocal, lacking in clearness, or unintelligible shall the Examiner's action be in the form of an objection. The remedy from this action is by petition to the Commissioner in person.

Bitner, 140 O. G. 256.

The Examiner finally rejected claims on a request for explanation. The Examiner did not refuse the request on the ground that the pertinency had been fully explained; but by coupling his explanation with a final rejection he rendered the information of no avail except through petition.

Walker, 129 O. G. 481; Andrews, 172 O. G. 1089.

As a general rule the Office may take judicial notice of its own records; but it should not in violation of the rule of secrecy refer to these records in communications which go to strangers to the cause except for imperative reason.

Robinson v. Copeland, 102 O. G. 467-6; Morley, 1902

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

Substantially the same claim as that herein presented was

found to be patentable in the earlier application. Upon renewal of that application after forfeiture it was subject to a new examination (Rule 176) and was again adjudged to be patentable. Under these circumstances any doubt as to the patentability of the claim in the new application should have been resolved in the applicant's favor. Petition to direct the Examiner to withdraw his rejection granted. The decision of a former Examiner should be very persuasive on his successor. (Slarr, 15 O. G. 1053; Neelson, 81 O. G. 1787; Fowler, 101 O. G. 1833.)

Hay, 139 O. G. 197.

A claim will be given the broadest interpretation of which its terms are capable.

Milans, 135 O. G. 1122.

The Examiner should follow the decision of the higher tribunal whether he agrees with it or not. It would not, however, be proper for the Commissioner to instruct the Examiner that the claims of a particular application should be allowed in view of a prior decision. The Examiner thinks the prior decision is not pertinent if he is in error an appeal should be taken to the Board in the first instance.

Konold, 133 O. G. 2179.

Where the specification of a patent cited as an anticipation does not state of what material the article is composed it can not ordinarily be assumed to be of any particular material.

Walters, 130 O. G. 1483.

After previous claims—"What remains would appear to be a mere carrying out of the purpose of the original invention."

Wickers and Farlong, 129 O. G. 2074.

It does not appear that the Examiner has answered the contention of the applicant as to the reasons why he regards the patent cited as belonging to the same art so as to justify its citation in this case. It is quite clear that if an appeal should be taken from the final rejection it would be necessary for the Examiner to touch upon the subject. It is believed that the Examiner should do so before an appeal is made necessary.

Burge, 129 O. G. 1611.

No absolute right is conferred by the grant of the patent. The patentee is merely put in position to assert his *prima facie* right in case of infringement and have the same adjudicated in a court where extrinsic evidence, if important, may be heard and not confined as in this court, to a review of the decisions of the Patent Office upon the record as made up

therein. (In re Thomson, 26 App. D. C. 426-429; Seymour v. Osborne, 11 Wall 516-544; Parker & Whipple Co. v. Yale Clock Co., 1887 C. D. 584, 41 O. G. 811.)

Heroult, 127 O. G. 3217.

Where several claims are rejected, it should appear in the Examiner's letter whether all the references are cited against each claim, or whether they are cited distributively against the various claims. In the latter event it should be made clear in connection with each claim which references are relied upon in the rejection thereof. Where several references are cited against a claim it should be made clear whether each reference is regarded as sufficient in itself to defeat the claims or whether the references are to be taken jointly. If to be taken jointly, the theory upon which they are combined must be pointed out.

Lincoln, 127 O. G. 3216.

The common impression, however, that the Examiner should ordinarily apply the references to the claims element for element is unwarranted.

Wickers and Furlong, 127 O. G. 2074.

Because we are of the opinion that the claims 6 and 7 do meet such requirements and to that extent mark an advance over the prior art, we decide that such claims should have been allowed by the Commissioner of Patents.

Hill, 1906 C. D. 572, 121 O. G. 340.

It is only when the question of novelty is in doubt that the fact that the device has gone into commercial use, displacing others employed for the same purpose or supplying the place of others whose intrinsic defects have prevented their general adoption and use, is sufficient to turn the scale in favor of invention. (Potts v. Creager, 155 U. S. 597, 699.)

Thomson, 1906 C. D. 566, 120 O. G. 2756.

In examining an application the office should consider that by the grant of a patent a patentee is merely put in a position to assert his *prima facie* right against infringers who may in their defense raise the question of the validity of the patent and have the same finally adjudicated in the light of a full presentation and consideration of all the evidence attainable in respect of anticipation, prior knowledge, use and the like.

Thomson, 1906 C. D. 566, 120 O. G. 2756.

Where there was doubt as to the sufficiency of the references and the applicant demonstrated that he had produced an apparatus of great utility, held that the doubt should be resolved in favor of the applicant's claim.

Thomson, 1906 C. D. 566, 120 O. G. 2756.

It is the duty of the Patent Office to require applicants to make their claims clear and definite and therefore it will not read limitations into claims pending before it to avoid references, but will require applicant to include them clearly and definitely.

Seely v. Baldwin, 1905 C. D. 316, 117 O. G. 2633.

One who accomplishes a result by a process which is only partially or not at all understood by him has invented nothing, and can not deprive another, who afterwards discovers and proclaims the true principle of the operation, of the rights of an inventor.

Judge Gray's dissenting opinion in *Johnson v. Chisholm*, 115 F. R. 633.

Reference in analogous art.

115 F. R. 324.

The object of the provision of this rule is to enable the applicant to understand clearly the position taken by the Examiner.

Fletcher, 1905 C. D. 26, 114 O. G. 545.

In general, when the claims are rejected, all grounds of rejection should be given in order that the case may be disposed of upon a single appeal. When, however, claims are made to a machine or device the alleged operation of which is based on principles in direct conflict with the fundamental laws of science and mechanics, it is thought a case is presented which should be made an exception.

Payne, 1904 C. D. 42, 108 O. G. 1049 (see *Gibon*, 99 O. G. 227).

The first action should be careful and complete and new requirements or references should not be necessary except when rendered so by applicant's amendments.

Lewis, 1904 C. D. 16, 108 O. G. 559.

While a favorable action by an Examiner should be very persuasive, it is not binding upon his successor when called upon to pass a claim previously acted upon.

Fowler, 1902 C. D. 420, 101 O. G. 1833-4.

When two claims substantially the same are presented they should be rejected and no objection is seen to referring to the fact that claims to the real invention have been allowed in the case.

Riley, 1902 C. D. 416, 101 O. G. 1832.

The reasons why the Examiner thinks the subject matter inoperative must be given.

Gibon, 1902 C. D. 117, 99 O. G. 227.

It is the purpose of Rules 65 and 66 to lay down a course

of procedure which will facilitate the speedy prosecution of applications and not to permit the applicants to delay such prosecutions by insisting on a compliance with the rules on the part of the Office without a like compliance on their own part.

Sandman, 1901 C. D. 229, 97 O. G. 2532.

There is no interference in fact between the constructions covered in counts for the reason that these counts, though identical in language, cover in fact mechanisms which differ materially in construction and operation.

Goss v. Scott, 1901 C. D. 80, 96 O. G. 842.

Rule must be read as whole.

Buck, 1900 C. D. 5, 94 O. G. 222.

The Examiner rejected the application upon his knowledge of public use. On appeal Examiner reversed. Affidavit filed by direction of Examiner and application rejected upon the affidavit. Return of appeal fee refused because no request for affidavit was made by applicant.

Van Ausdal, 1900 C. D. 74, 91 O. G. 1617.

Similarities and differences in a machine, process or product do not depend upon mere names of things, words used to describe them or immaterial matter by which they may be distinguished.

Palmer Co. v. Lozier, 84 Fed. 669; citing Glue Co. v. Upton, 97 U. S. and Bates v. Coe, 98 U. S. 31-42; Edgecombe v. Eastman & Houston, 1899 C. D. 207, 89 O. G. 707.

While a claim deemed allowable by one Examiner is always subject to rejection by his successor upon references or reasons not before considered and it may be, in exceptional cases, on the references previously considered, the spirit of Rule 144 would seem to indicate that the favorable action of an Examiner should be at least extremely persuasive upon his successor.

Nealon, 1897 C. D. 174, 81 O. G. 1787.

There being no doubt as to lack of invention in this case, there is no room for consideration of the doctrine, which the appellant enunciates, that in case of doubt, that doubt should be resolved in favor of the applicant.

Snider, 1894 C. D. 23, 66 O. G. 1309.

Where a claim was finally rejected and at the same time the statement of invention was criticised as being too broad, the final rejection was premature and an amendment touching the merits may properly be admitted thereafter.

Klaus, 1893 C. D. 87, 64 O. G. 299.

A rejection for "lack of invention" is in effect a rejection for "want of novelty" and the Examiner must cite references under Rule 66.

Clifford, 1893 C. D. 9, 62 O. G. 316.

Practice in the examination of an application prescribed.

Eastman, 1891 C. D. 178, 57 O. G. 410.

The matter of examinations and the function of the Examiner treated at length by Commissioner Mitchell.

Rogers, 1889 C. D. 227, 49 O. G. 1361.

Where two Office letters were written, one containing formal objections and objections to the merits, and the second repealing the former objections to the merits, it was held two objections warranting an appeal.

Mill, 1887 C. D. 92.

Applicants should be told distinctly and definitely what the objections are to their applications, reference to the pencil marks on the specification is not sufficient.

Wilkins, 1883 C. D. 65, 24 O. G. 1271.

A reference relied on to anticipate the novelty of the invention must contain the devices claimed, either in a drawing or description; and in either case the invention must be so distinctly shown or described as to be a matter of certainty, not of inference.

Herron, 1872 C. D. 135, 1 O. G. 608.

Irregularities in practice pointed out. References cited as to one claim, and no objections made as to the other in first letter; more particular specification as to invention in one of the claims required in the second letter; in the third letter first and second claims rejected upon references, additional references cited as to first claim, then an appeal to the Board taken, then an amendment submitted withdrawing the second claim, and first claim rejected.

Buxton, 72 C. D. 226.

Such matters and such only as are in point should be brought into the case. It is vexatious to all concerned to cite a number of random references, all different from each other and for that reason impossible to apply to meet a specific claim.

Brownlee, 1872 C. D. 208, 3 O. G. 212.

There are almost as many different rules of practice in finding references and making rejections as there are different examiners in the Office.

Moore, 1871 C. D. 250.

(2) *Propriety of References.*

Not only does no reference cited anticipate applicant's claim, but no combination of the references can be devised which will accomplish this end.

Hiath, 230 O. G. 335-6.

Patents filed before, but granted after the application was filed, are properly cited.

Bryder, 178 O. G. 886 (cases); see also Lemley v. Dobson-Evans Co., 243 F. R. 391; Jackson Cushion Spring Co. v. Adler, 243 F. R. 386; Gressling Box Co. v. Gumb, 243 O. G. 241.

Affidavits as to utility and state of the art. In the case of Eastwood, 144 O. G. 819, 33 App. D. C. 291 and *In re Moore*, 172 O. G. 891, 38 App. D. C. 276, affidavits of this character were considered by the Court of Appeals and the court reversed the Office largely in the case made in said affidavits. Asst. Com. Mss. Dec.

See paper by Mark L. Whitney, read before the Examining Corp of U. S. Patent Office, Feb. 15, 1917.

See notes to Rule 76.

When requested so to do in good faith the Examiner should apply the references. Cases collected.

Andrews, 172 A. O. G. 1889.

A design patent may anticipate a mechanical patent.

Williams Bulk Co. v. Nevership Mfg. Co., 136 Fed. 210.

In order to constitute a bar the printed and published description must exhibit the invention in such full and intelligible manner as to enable persons skilled in the art to understand the operation of the invention and to carry it into practice (cases).

Marconi v. Shoemaker, 131 O. G. 1941.

Applicant's own patent for a process granted less than two years previous to this for the apparatus is not a good reference.

Isaacs & Speed, 130 O. G. 2717.

Where the specification of a patent cited as an anticipation does not state of what material the article is composed it can not ordinarily be assumed to be of any particular material.

Walters, 130 O. G. 1483.

The patent to which attention was called is in a remote art, and the Examiner, it is understood, has held the claims in issue patentable there over. No such unusual circumstances as will justify the exercise of supervisory authority exists.

Dagett v. Kaufmann, 127 O. G. 3641.

"They" (the elements) are all perfectly well known, and if not known in the combination described, they are known in combinations so analogous that the court is at liberty to judge for itself whether there be any invention in using them in the exact combination claimed.

Hill, 1906 C. D. 572, 121 O. G. 340.

Considering the references and the general state of the art, we fully agree with the Commissioner, that the record made shows nothing more than the work of a skilled mechanic.

Baker, 1906 C. D. 594, 121 O. G. 1352.

When a prior combination cited against the combination claimed included elements in addition to those used by the applicant which result in differences in operation undesirable for the purpose of the applicant's device and one of the elements of the prior combination is different from the corresponding element of the applicant's combination, held that a patent should not necessarily be refused on account of the prior combination.

Thomson, 1906 C. D. 566, 120 O. G. 2756.

Separate features may be found in different references.

Sindingchristensen, 1906 C. D. 88, 120 O. G. 2755.

A foreign patent is *prima facie* published at the date it indicates. The burden is upon applicant to show to the contrary.

Beck, 1903 C. D. 277, 105 O. G. 1781.

An apparatus is not an anticipation of the process of using the same.

Wagner (Ct. of Ap. D. C.), 1903 C. D. 629, 105 O. G. 1783.

"Indeed, while there are expressions in the opinion of the Commissioner of Patents which imply that all which the applicant invented was an apparatus and the function of that apparatus, yet it is conceded that the apparatus was only one of the various modes for giving effect to the process."

Wagner, 1903 C. D. 629, 105 O. G. 1783.

In designs the doctrine of double use is not limited to the selection of devices in the same or analogous mechanical arts.

Knothe, 1903 C. D. 42, 102 O. G. 1294.

Where the Examiner rejects a claim because he thinks its subject matter old he should either recite a specific reference showing the prior art or make the affidavit called for by Rule 66. Where the Examiner referred to an accessible device as illustrating an alleged common practice, no oath required.

Walker, 1903 C. D. 12, 102 O. G. 465-6.

To anticipate a process patent, it is necessary not only to

show that the prior patent might have been used to carry out the process, but that such use was contemplated, or at least that it would have occurred to any mechanic. It is now too late to insist that it would have been suggested to any mechanic of ordinary skill and intelligence.

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

It is true that the Jones patent is a simple one and in light of present experience it seems strange that none of the expert steel makers, who approached so near the consummation of their desires, should have failed to take the final step which was needed to convert their experiments into an assured success. This, however, is but the common history of important inventions, the simplicity of which seem to the ordinary observer to preclude the possibility of their involving the exercise of the inventive faculty.

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

Some of the expressions, taken by themselves, seem to foreshadow the Jones idea; but there was nothing in any of these discussions that filled the requirement of the law. (R. S., sec. 4886) of a description in a publication sufficient to anticipate the patent.

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

A process can only be anticipated by a similar process. It is not sufficient to show a piece of mechanism by which the process might have been performed.

The Carnegie Steel Co., Limited, v. The Cambria Iron Co. Works, 1902 C. D. 592.

Rejection upon two references. An ozone producer consisting of a high frequency apparatus and an ozonizer is anticipated by the same high frequency apparatus and the same ozonizer, separately.

Varley, 1902 C. D. 172, 99 O. G. 1621.

That which infringes if later anticipates if earlier. See Miller v. Eagle Mfg. Co., 95 C. D. 161, 80 O. G. 661, and numerous authorities cited.

Steck, 1902 C. D. 9, 98 O. G. 228.

Where differences in degree cause a different mode of operation.

Potts v. Creager, 1900 C. D. 39, 90 O. G. 2134; and McBeiry v. Cook, 1900 C. D. 248, 90 O. G. 2295.

When a foreign patent is cited the burden of proof is upon applicant to show that it bears a wrong date.

Hummel v. Tingley, 1900 C. D. 22, 90 O. G. 959-960.

Combination held to be old, if it is clear that by assembling these elements in one structure no new effect which is different or more than the sum of the effects of the separate elements is secured.

Perkins, 1899 C. D. 141, 88 O. G. 548.

Complete anticipation is rare and to reject a claim on the ground that it is substantially met by a reference is practically the same as to reject it on the ground of lack of invention in view of the reference, such difference as remains not involving invention.

Ferguson, 1894 C. D. 6, 66 O. G. 651.

Novelty is not negatived by any prior patent or printed publication, unless the information contained is full enough and precise enough to enable any person skilled in the art to which it relates to perform the process or make the thing covered by the patent sought to be anticipated. Foreign patent as reference.

Deprez & Carpenter v. Bernstein v. Hunter, Gaulard and Gibbs, 1891 C. D. 53, 54 O. G. 1711.

After a patent is granted for an article described as made by causing it to pass through a certain method of operation to produce it the inventor can not afterwards on independent application secure a patent for the method or process of cutting away the metal and then binding it, so as to produce the identical article covered by the previous patent, which article was described in that patent as produced by the method or process sought to be covered by taking out the second patent.

The Mosler Safe & Lock Co. v. Mosler B. & Co., 1888 C. D. 420, 43 O. G. 1115.

An English provisional specification should be referred to as a publication and not a patent.

Maynard, 1870 C. D. 54; Cochran, 1869 C. D. 60; Lauder v. Crosswell, 1879 C. D. 177; 16 O. G. 405; Lowry, 1869 C. D. 85.

A combination is not anticipated by its elements separately.

Stone, 1873 C. D. 105, 4 O. G. 54.

When a new use of a thing produces an important effect never before produced or develops or makes practical some new property of matter not previously known, the new use is not analogous to the former uses, and therefore, the novelty of the mere agent is immaterial.

Hawes, 1871 C. D. 225.

A patent should not be granted with broad claims after

one for the same invention with narrow claims has been issued to the same applicant.

Edison, 1 O. G. 263.

An Examiner is not limited in his inquiry into the novelty of an invention on which a patent is asked, to investigation in the particular subdivision of inventions of which he has charge.

Burnham, 1872 C. D. 26, 1 O. G. 164.

References should be limited to things of a kindred nature and there should be some analogy between the use and the result of the device in question and the reference upon which it is rejected.

Hawes, 1871 C. D. 255; Moore, 1871 C. D. 249; for example, see Lesnew, 1871 C. D. 204; Hillard, 1871 C. D. 179; Williams, 1871 C. D. 177.

(3) *Action by the Office.*

A rejection of the claims as anticipated by references is not objectionable as throwing a cloud on the title.

McPherson, 196 O. G. 1051-1052.

When a clear issue has been reached and it is evident that applicant understands the application of the references, no further explanation of the references is necessary.

Kelley, 183 O. G. 220.

A reference to a decision of the Commissioner held sufficiently definite.

Patterson, 178 O. G. 885.

An acting by the German Office cited, considered, but not followed.

Maas, 180 O. G. 1138.

In case of ordinary doubt, the policy of the patent system, as customarily maintained in the Patent Office, has been to give the applicant the benefit thereof because no absolute right of property is conferred by the grant of a patent. (Thomson, 26 D. C. 419-425.)

Moore, 178 O. G. 891; see 177 O. G. 772.

When the Examiner required applicant to diminish the number of claims and grouped the same in accordance with the practice in *Ex parte Kadow*, 154 O. G. 1412, and *Ex parte Chapman*, 120 O. G. 446, held that he should have also acted upon the merits of each group of claims.

Both, 182 O. G. 974.

The Examiner should reject the claim if he thinks the structure recited is insufficient to sustain the whereby clause.

Hoge, 173 O. G. 1081.

If the Commissioner recommends certain claims, only these claims should be considered.

Selden, 154 O. G. 741, 36 App. D. C. 428; 173 O. G. 1080.

Claims should not be allowed merely because they present a multitude of elements all of which do not appear in one or two or even more references.

Fagan, 162 O. G. 538-539.

It is the duty of the Examiner to consider not only the claims but the invention disclosed. If he is of the opinion that an application discloses no invention over the references, it is perfectly proper for him to so state.

Fox, 157 O. G. 485.

When Hall applied for his patent he neither conceived nor disclosed any such retardant action of clay, or indeed made clay an element in any claim and that the subsequent introduction thereof into the patent was suggested as a mere theory to overcome valid objections to the grant of the patent. We are satisfied that this theory was neither based on previous experience or proved by subsequent developments. Rejection was right.

Casem Co. v. Collins Co., 155 O. G. 554.

The Examiners-in-Chief on appeal made a recommendation that one claim be rejected upon a reference not cited by the Primary Examiner. The Primary Examiner adopted such suggestion but refused to receive a general amendment to the case approved. "If, however, the applicant will present an amendment either amending claim 6 or presenting a claim or claims limited to the subject matter covered by that claim, the same may be entered and considered.

Dietrich, 142 O. G. 568; 157 O. G. 1244; 170 O. G. 482.

The issue being strictly formed and the amendment to claims not being substantial, the request at the end of applicant's argument that if a favorable decision could not be given there should be a final rejection, should be complied with.

Marshall, 139 O. G. 198.

Where an Examiner finds it necessary to give reasons explaining the application of a reference, a final rejection should not be entered in the same letter where the reasons have been cited for the first time.

Jackson, 132 O. G. 1324.

It is a liberal practice that permits a party to extend the prosecution of a case and increase the work of the Office to

the detriment of other applicants by presenting new claims after action by the Office, which are not responsive to the Office action, without showing why they were not earlier presented. There are good reasons why this practice should be continued, but when amendments of this character are made applicant should assist the Office by presenting the reasons why they believe the new claims allowable.

Richards, 124 O. G. 2534.

Final action on a case marks the close, not merely of the consideration of the particular claims before the Office, but the close of the consideration of any claims in that application.

Casselman, 116 O. G. 2012.

Applicant should not be cut off from the right of amendment in such a summary way in a complicated case like this, as it is the policy of the Office to give applicants every reasonable opportunity.

Stuart, 109 O. G. 1069.

The Office action is not complete until proper data is given to enable applicant to judge of the propriety of the action.

Stead, 107 O. G. 834.

A final rejection requiring a showing under this rule may be made before all formal matters are disposed of.

Severy, 97 O. G. 2745.

It is the fact of a second rejection and not the language of the letter of rejection that closes the case. However, the Examiners are directed hereafter to definitely state that the claim is finally rejected.

Kendall, 1900 C. D. 174, 93 O. G. 754.

Where the case is simple in its nature, where the applicant has an attorney of skill and experience, where the Examiner clearly rejects all the claims upon certain patents cited, and applicant "clearly understands that the Examiner in charge considers that the entire case lacks invention and such ground of rejection is accepted fully," a basis does not exist for further action under Rule 66.

McGarrell, 1892 C. D. 45, 58 O. G. 1256.

Material amendments in matter of substance made in good faith can not lawfully be refused consideration by the Office at any time before the issuance of the patent.

Winchester, 80 C. D. 92; see, however, Thurmond, 1886 C. D. 30, 37 O. G. 217.

No more than two rejections can be had for the same reason.

Evarts, 1874 C. D. 39.

In entering a final rejection there is no impropriety in

arguing the applicability of the references of record anew provided the new grounds of rejection are cited. In this case, however, the rejection set forth for the first time the exact grounds upon which the claims were held unpatentable. Examination not closed.

Mygatt, 184 O. G. 801.

(4) *Action by the Office as Constituting a Proper Final Rejection or Reopening the Case.*

See Rules 77 and 171.

Although there were but two actions it is clear that an issue has been reached between the Examiner and the applicant. No further action necessary.

McPherson, 196 O. G. 1051-1052.

Stating his reasons for rejection more fully does not reopen a case.

Movley, Jr., 185 O. G. 1379.

If the letter ends, the applicant may consider this action final if he wishes. This does not close the case and the applicant is entitled to further amend.

Mygatt, 185 O. G. 828.

As a general rule a final rejection should not be given on the second action on the merits.

Mygatt, 185 O. G. 828.

The response made to the final rejection was clearly a sufficient response to a rejection upon new grounds. The Examiner is therefore directed to consider the application on its merits in view of the argument.

Mygatt, 184 O. G. 802.

Rule is applicable to design applications.

Beltendorf, 184 O. G. 801.

Examiner required an explanation, which being given under head of remarks, was required to be inserted in specification. A final rejection proper when this was not done.

Dean, 177 O. G. 1295.

August 12, 1910, Examiner held that claims 5 and 6 were allowable after correction and finally rejected other claims.

January 3, 1911, amendment cancelling the finally rejected claims and adding three new ones.

Entry refused.

August 21, amendment cancelling claims offered, case abandoned.

After the case was finally rejected applicant should, within one year from the date thereof, either have cancelled

the claims, taken an appeal, or taken steps which resulted in having that final rejection set aside as premature.

Dietricks, 174 O. G. 829.

Whether the action of the Office was such as to confer the right to amend is one that may not be controlled by mandamus.

Lang v. Moore, Com., 172 O. G. 834.

A criticism of the theory of operation of the device that does not amount to holding it inoperative does not reopen a case.

Hardy, Jr., 161 O. G. 268.

However, if it is pointed out that the claims do not contain the matter relied on and if they did they would be anticipated by a reference of record, this does not constitute the citation of a new reference.

Scott, 166 O. G. 985.

After a case is ready for appeal if a new reference is cited the applicant may continue his appeal in view of such amendment or to further prosecute the case before the Primary Examiner. (Mevey, 56 O. G. 805.)

Scott, 166 O. G. 85.

Two claims rejected on three references, one claim withdrawn, the other claim rejected in view of said references. Good final rejection.

Gentry, 162 O. G. 537.

Applicant was entitled to have the claims considered and the reasons of rejection fully stated, and such action should now be taken.

Pledger, Jr., & Campbell, 157 O. G. 486.

After final rejection no affidavit under Rule 75 will be received. (Berg, 120 O. G. 903.)

Romunder, 157 O. G. 209.

Following the interference certain previously allowed claims were rejected because applicant was not the first inventor thereof, as disclosed by the interference proceeding. Such rejection is based upon a new ground and is a new reason for rejection, in view of which applicant has the right to amend under Rules 65 and 68 and section 4903 of the Revised Statutes.

Klepelko, 126 O. G. 387.

Where the Examiner acts on formal objections after the final rejection of the claims, the applicant is entitled to a year from the Examiner's action in which to cure the objections and in the absence of any rule or practice to the contrary he should likewise be allowed this year in which to

appeal to the Examiners-in-Chief or to cancel the rejected claims.

Thomas, 124 O. G. 623.

The mere fact that the letter closing primary consideration of the case stated the grounds of rejection at greater length than they had been before stated does not present new reasons for rejection. The final rejection was in order and was properly given.

Flindall, 122 O. G. 1396.

A petition to set aside a final rejection dismissed as premature where no request had been made of the Primary Examiner to withdraw that rejection.

Lawton, 122 O. G. 259.

A more extended statement of grounds of decision does not reopen case.

Kinney & Schultz, 121 O. G. 2325.

Application rejected upon two references. Affidavit under Rule 75 filed to overcome one reference. By refusing consideration of the affidavit because the other reference was sufficient in itself, the Examiner does not reopen the case.

Berg, 120 O. G. 903.

The applicant is clearly entitled to be informed which claims previously rejected are the same in substance as those placed under final rejection.

But the giving this information does not relieve the case from final rejection.

Thayer, 118 O. G. 2252.

The withdrawal of a ground of rejection does not reopen a case.

Wagner, 118 O. G. 1684.

While the explanatory matter in the letter of final rejection states more explicitly the grounds for refusing the reissue in the form requested, the original letter nevertheless stated these grounds with such clearness that the applicant could have intelligently planned his course of action. Rejection proper.

Wagner, 118 O. G. 1684.

An applicant should have an opportunity to amend after he understands or has had an opportunity to understand thoroughly the Examiner's position.

Greth, 116 O. G. 2532.

After rejection claims canceled. A requirement of amendment to the specification did not reopen the case to admit new claims.

Casselman, 116 O. G. 2012.

May amend as often as the Examiner presents new references or reasons for rejection against any of the claims.

Booth, 113 O. G. 2216.

It is not sufficient to justify a final rejection that a patent has been cited against other claims; but it must appear that the Examiner and the applicant have clearly reached an issue as to the pertinency of the patent as regards the specific claim said to be anticipated by it.

The pertinency of references if not obvious should be pointed out.

Booth, 113 O. G. 2216.

After final rejection Examiner received and entered an amendment containing an allowable claim. Held that this did not reopen the case for further amendment. The practice should be analogous to that under Rule 78.

Meacham, 113 O. G. 1417.

If the Examiner acts upon a suggestion of the Examiner-in-Chief it is an action on his own motion and restores applicant's right to a reconsideration.

Burrowes, 110 O. G. 599.

A final rejection was proper although a reference cited in the action before the last and not cited in the last action was again cited.

Minich, 107 O. G. 1971.

If the last action finally rejecting the application was informal an amendment is a proper action.

Goldman, 100 O. G. 234.

If it is intended to close the matter the Examiner should use the words "finally rejected."

Gammons, 98 O. G. 2171; Byrnes, 97 O. G. 191. Citation of new references opens case. Gammons, 98 O. G. 2171; Lawton, 97 O. G. 187.

A proposed amendment was offered to a case under final rejection, the Examiner refused to enter it because it did not comply with the second paragraph of the rule, and at the same time cited references alleged to anticipate new claims. Held that by citing new references the Examiner opened the case.

Lawton, 1901 C. D. 142, 97 O. G. 187-188.

Gray, 1889 C. D. 91, 46 O. G. 1277.

After the first rejection the applicant may insist upon his claim as presented. If the Examiner reaffirms his former decision without supporting it with fresh references, the rejection is final as there is no remedy but appeal. But if the Examiner gives new references the applicant has a right to

reply to them, or to amend his application by reason of them if he desires to do so.

Appleton, 1869 C. D. 8.

(5) *New Matter.*

See Rule 70.

If the Examiner is of the opinion that the amendment presents new matter he should reject all claims affected thereby, and applicant may appeal to the Examiners-in-Chief.

Smyth, 114 O. G. 762.

When new matter is introduced the whole application should be examined and the application rejected because of such new matter.

Soley, 1900 C. D. 71, 91 O. G. 1616.

If in the opinion of the Examiner, the proposed amendment to the drawing involves new matter, the changes in the drawing should not be allowed until the question of new matter has been determined, but claims based on this matter should be considered and rejected on the ground of departure and for all other reasons that are applicable, so that all matters may be settled at one appeal.

Ernest, 1896 C. D. 33, 76 O. G. 1417.

If in the opinion of the Examiner the application as amended involves a departure from the original invention such want of identity would furnish ground for rejection.

Bennett, 1886 C. D. 11, 35 O. G. 1003.

(6) *Rejection on Applicant's Own Patent or Application.*

Applicant's own patent for a process granted less than two years previous to this for the apparatus is not a good reference.

Isaacs & Speed, 130 O. G. 2717.

Anticipation by one's own patent and estoppel in previous record.

Newark Spring Mattress Co. v. Ryan, 102 F. R. 693.

It is proper in some cases to reject a claim because of the allowance to the same party of other claims.

Riley, 1902 C. D. 416, 101 O. G. 1832; Leonius, 1903 C. D. 126, 103 O. G. 1164.

It is suggested that there is not proof that the Bundy who filed the earlier application is the same party as the Bundy who filed the later case. There is, however, *prima facie* evidence that they are the same such as will justify placing the burden of proof upon Rumbarger. If they are not the same, Rumbarger may show it by the proofs.

Bundy v. Rumbarger, 1900 C. D. 145, 92 O. G. 2002.

It is well settled that it is proper under certain circumstances to reject the claims in an application on an allowed application filed by the same party.

Osborne, 1900 C. D. 137, 92 O. G. 1797.

References to applicant's previous patent.

Jones v. Larter, 1900 C. D. 111, 92 O. G. 383.

Rejection on patent to same inventor.

Edison, 1891 C. D. 1, 54 O. G. 263.

The formal abandonment of an application should not be required as a condition precedent to the allowance of another application of the same inventor pending concurrently and in condition for allowance, nor should the Examiner require the erasure of any claim which would be allowed if no other application awaited consideration. The true course to be pursued is that pointed out in *Ex parte Gaboury*, 1886 C. D. 28, 37 O. G. 217.

Feister, 1890 C. D. 167, 53 O. G. 1089.

Anticipation by one's own patent.

Woodward, 1890 C. D. 169, 53 O. G. 1090.

Anticipation by one's own patent. Application pending at the same time.

Feister, 1890 C. D. 167, 53 O. G. 1089.

Where the invention described and not claimed in a prior patent to the same inventor which might have been lawfully claimed in the first patent there is a presumption of dedication from the failure to make reservation or to file a concurrent application.

Biggs, 1890 C. D. 32, 50 O. G. 1130.

A claim in an application is not anticipated by a patent to applicant showing but not claiming the invention when such invention could not have been properly claimed in said patent.

Johnston, 1889 C. D. 130, 46 O. G. 1641.

The question we have to decide is whether the description of another invention in a prior patent by the same inventor forfeits his rights to take out a subsequent patent for such invention. I do not understand that the Supreme Court has held that such prior description is a dedication to the public of the second invention. Judge Colt in

Eastern Paper Bag Co. v. Standard Paper Bag Co., 1887 C. D. 537, 41 O. G. 231, and cases cited.

A patent for either a machine or process will not bar a patent for the one of said inventions not patented provided the statutory forfeiture of two years use has not been.

Eastern Paper Bag Co. v. Standard Paper Bag Co., 1887 C. D. 537, 41 O. G. 231.

A failure to file a disclaimer under Rule 42 does not make the patent issued upon one application a bar to the other.

Roberts, 1887 C. D. 61, 40 O. G. 573.

It is undoubtedly true that when a patent issued for an invention, all of which is shown but only part of which is claimed, there is a dedication to the public of that part which is unclaimed.

Roberts, 1887 C. D. 61, 40 O. G. 573.

A patent should not issue upon an application which is not properly a division of the subject matter of a patent to the same party, even though the application upon which the patent was granted was concurrent.

Lowe, 1870 C. D. 39, 20 O. G. 176; Ransom, 1887 C. D. 22, 39 O. G. 119; Roberts, 1887 C. D. 613, 40 O. G. 573; Holt, 1884 C. D. 43, 29 O. G. 171.

The fact that an applicant has two applications pending for the same thing is no reason for the rejection of the second application unless the first has been passed to issue or a patent granted upon it.

Gaboury, 1886 C. D. 28, 37 O. G. 217.

If two applications are pending at the same time a patent granted upon the first, which shows but does not claim the subject matter of the second, will not bar a patent upon said second application.

Emerson, 1880 C. D. 143, 17 O. G. 1451; Roberts, 1887 C. D. 61, 40 O. G. 573; Derby, 1884 C. D. 21, 26 O. G. 1208; Holt, 1884 C. D. 43, 29 O. G. 171.

If two applications are not pending at the same time, a patent granted upon the first showing but not claiming the subject matter of the second, will not bar a patent upon second application if a reservation clause as to such matter is inserted in the application upon which the patent is granted.

Atwood, 1869 C. D. 98; Derby, 1884 C. D. 21, 26 O. G. 1208; Contra Rohm, 1883 C. D. 106, 25 O. G. 1190; Long, 1883 C. D. 104, 25 O. G. 1189.

“A question is made by the defendants whether an inventor is not to be presumed to abandon his design when he exhibits it in the drawings of a mechanical patent. I do not see why this consequence should follow until the design has been in use for two years, but I do not decide this point . . .”

Burton v. Greenville, 1880 C. D. 602.

When two applications by the same applicant are pending at the same time, and a patent is issued upon the application last filed, the claims which might have been inserted in either application when both were pending can not be inserted in the

application first filed, but must be inserted, if at all, in the reissue of the patent. Or, if the applications are not pending at the same time.

Loring v. Hall, 1879 C. D. 8, 15 O. G. 471; Emerson, 1879 C. D. 330, 12 O. G. 1232; Arkell, 1877 C. D. 73, 11 O. G. 1111; Stempel, 1879 C. D. 161, 16 O. G. 316.

I am much inclined to think that the mere fact that a new article is shown in the drawing of a patent for a machine would not of itself be an abandonment of the new article which would properly be the subject of a different patent, until the statutory forfeiture of use for two years had been incurred.

Hatch v. Moffitt, 15 F. R. 255.

(7) *Action of Office as to Unity or Diversity of Invention.*

See Rule 42.

Final rejections are given in cases where division is required without closing the case to amendment.

Sanders v. Howthorne v. Hoyt, 1906 C. D. 467, 125 O. G. 1347.

Applicant must comply with the requirement for division or appeal to the Examiners-in-Chief.

Wallace, 1906 C. D. 461, 125 O. G. 992.

"They" "(the courts)" do not look with favor upon the refinements of division which lead to many patents being issued for various improvements incorporated upon a single device.

Briede, 1906 C. D. 677, 123 O. G. 322-324.

The facts of each case must be considered, with the burden upon the applicant who asserts that two statutory inventions are one unitary invention. We are confirmed in this conclusion by the utterances of the court in the Steinmetz case.

Frasch, 1906 C. D. 648, 122 O. G. 1048.

A requirement for division is to be treated something like a demurrer upon which the allegations of fact are assumed to be true. The things claimed are assumed to be inventions for the purpose under consideration and the only question is whether these things are so closely related as to warrant their inclusion in one application. The assumption of course is not to be continued after the question of division is settled and the question of patentability of the several claims is taken up.

Steinmetz, 117 O. G. 901.

Before refusing to examine a new claim because of alleged new matter the question of division should be settled.

Lawley, 1904 C. D. 539, 113 O. G. 1967.

The Examiner will not be directed to select the invention to be retained.

This is left to applicant except where an amendment is presented which necessitates a requirement of division. In this case applicant is required to cancel claims upon which an examination has not been made. (Sille, 110 O. G. 1728.)

Tuttle, 1904 C. D. 537, 113 O. G. 1967.

An amendment which in the opinion of the Examiner would require division if offered, should nevertheless be entered, since the appeal is now to the Examiners-in-Chief.

Deane, 1904 C. D. 330, 111 O. G. 1937.

The practice of refusing to enter amendments necessitating division was based upon the practice of considering the matter upon interlocutory petition, and it has no application now, since the question of division is appealable.

Selle, 1904 C. D. 221, 110 O. G. 1728.

Good practice requires that a requirement for division be made at the earliest date upon which it appears that division is necessary.

Lewis, 1904 C. D. 16, 108 O. G. 550; Baer, 1904 C. D. 117, 109 O. G. 1609.

An amendment which if entered would require division should be refused notwithstanding the fact that it was presented before action by the Office.

Dubern, 1904 C. D. 61, 108 O. G. 1588.

An amendment that would require division should not be entered.

Murmann, 1900 C. D. 183, 93 O. G. 1721; Mitzger, 1902 C. D. 407, 101 O. G. 1612; Osborne, 1902 C. D. 100, 98 O. G. 2365; Gally, 1903 C. D. 480, 107 O. G. 1660.

Applicant given the benefit of a doubt while separate applications for these distinct inventions may be warranted by the classification, it does not of itself preclude the prosecution of claims for these distinct inventions in the same application.

Uhlig, 1903 C. D. 300, 106 O. G. 541.

The suggestion that an amendment should not be entered because it would immediately necessitate the requirement for division is not applicable for the reason that the rejection of the claims called for an amendment to them. The amendment has reference solely to the rejection.

Beck, 105 O. G. 1782.

The question of division is one of form and not of merits, and according to the provisions of Rule 42, should ordinarily be settled before action on the merits.

Collamore & Kerst, 1903 C. D. 241, 105 O. G. 746.

The action in this case rejecting certain claims which the Examiner regarded as covering one form of the invention on references and then rejecting other claims on the ground merely that they cover a modification is thought to be erroneous.

Collamore & Kerst, 1903 C. D. 241, 105 O. G. 746.

An action on the merits with a requirement of division prohibited by Rule 42.

MacKaye, 1903 C. D. 112, 103 O. G. 888-9.

The order 83 O. G. 301, requiring a cursory examination, approved. This is not an action on the merits. This is not applicant's right, but a courtesy extended by the Office.

MacKaye, 1903 C. D. 112, 103 O. G. 888-9.

The Examiner is required to give his reasons. Question of division.

Tyson, 1902 C. D. 476, 101 O. G. 3106.

A requirement of division is not an action on the merits.

Frasch, 1902 C. D. 560, 100 O. G. 1977.

In requiring that the Examiner should cite references against both inventions means such references as he has in mind. If he cites none it is to be supposed that he has none in mind.

Albert, 1901 C. D. 66, 96 O. G. 426.

Where a division is required the Examiner should cite such references as are in his mind. (83 O. G. 301) but applicant is not authorized to rely on such action.

Randall & Luck, 1901 C. D. 47, 95 O. G. 2063.

Where a division is required the Examiner (apparently) should cite the state of the art in reference to both inventions.

Thurman, 1901 C. D. 30, 93 O. G. 1721.

An objection to a claim for a design that it is not single, but on the contrary, calls for three separate articles aggregated, is one pertaining to the merits and should therefore have been a rejection.

Myres, 1893 C. D. 103, 64 O. G. 859.

If the Examiner is of the opinion that there is a want of divisibility of invention between the claims of an application and the claims of a patent to the same applicant, both applications having been pending concurrently, he should reject the claim for that reason.

Appeal is to Examiners-in-Chief.

Feisler, 1892 C. D. 203, 61 O. G. 152.

A second invention can not be introduced as a modification of the first.

Bogart, 1876 C. D. 162, 10 O. G. 113.

Where an application is amended so as to eliminate one invention there would seem to be no objection to retaining all the figures of the drawing, and the description thereof in the body of the specification, unless other applications are to be made on this subject matter.

Shepard, 1872 C. D. 244, 3 O. G. 522.

The Examiner should require a division before an examination is made.

Rice, 1874 C. D. 44, 5 O. G. 522; Pastor Perez de la Sala, 1888 C. D. 3, 42 O. G. 95.

(8) *Additional Cases.*

Hallowell, 1903 C. D. 268, 105 O. G. 1533-34; Scriven, *Ex parte*, 1891 C. D. 204, 57 O. G. 1127-28; Opdyke, 1890 C. D. 39, 50 O. G. 1293 (see note to Rule 67); Luber, 1894 C. D. 47, 67 O. G. 529 (see Rule 70); Knudsen, 1895 C. D. 29, 72 O. G. 589 (see note to Rule 37); Cahill, 1893 C. D. 78, 63 O. G. 1815 (see note to Rule 37); Miller, 139 O. G. 730; White, 134 O. G. 2027 (see note to Rule 34).

Rule 67. Adverse Decisions on Preliminary Questions in Ex Parte Cases.

Whenever, in the treatment of an *ex parte* application, an adverse decision is made upon any preliminary or intermediate question, without the rejection of any claim, notice thereof, together with the reasons therefor, will be given to the applicant, in order that he may judge of the propriety of the action. If, after receiving this notice, he traverse the propriety of the action, the matter will be reconsidered.

HISTORY.

This rule introduced in 1879.

See notes to Rule 64.

CONSTRUCTIONS.

Where an applicant in good faith, by amendment, attempts to cure formal objections, if the amendments are not satisfactory, the Examiner should so state in specific language.

Lungstrom, 1905 C. D. 541, 119 O. G. 2235.

After several objections on the ground of insufficiency of disclosure, the claims should be rejected.

Stevens, 1905 C. D. 502, 119 O. G. 1258.

Where an applicant secures a dissolution of an interference upon his allegation that the claims are not patentable, held that he should be required to cancel the claims. To reject the claims implies that there is an open question as to applicant's right, and there is not a question in fact.

Miller, 116 O. G. 2532.

Where an applicant does not desire suspension of his application to await the termination of an interference, proceedings in which another application of the same applicant is involved, the Examiner should reject the claims in the case under consideration on the interference issue.

McCormick, 1904 C. D. 575, 113 O. G. 2508.

The requirement of a supplemental oath (Matthes, 101 O. G. 3108, 1902 C. D. 484) should be disposed of before an appeal is forwarded.

Teller, 1904 C. D. 468, 113 O. G. 548-549.

When applicant fails to make a claim suggested under Rule 96 within the time limited, when the claim is presented, it should be entered and rejected.

Swift, 1904 C. D. 365, 111 O. G. 2495.

If the Examiner is of the opinion that the device is inoperative, he should reject it for this reason. It is irregular to require a model (Stocker, 1902 C. D. 53, 968 O. G. 1705).

Beath, 1904 C. D. 343, 111 O. G. 2220.

Only one species may be prosecuted in one application. The Examiner does not waive his right to object upon such a ground by inadvertently receiving and acting upon claims to two species.

1904 C. D. 170, 110 O. G. 857.

The Examiner is undoubtedly authorized to raise and determine the question of inoperativeness.

Brisband, 1903 C. D. 459, 107 O. G. 1097.

But must give his reasons for such an opinion.

Gibon, 1902 C. D. 117.

If claims are involved in an interference on a separate application action suspended awaiting termination of such interference.

Robinson, 1902 C. D. 433, 101 O. G. 2079.

An applicant should not be required to elect between two claims to the same invention unless those claims are substantially the same. The allegation that they are not patentably different is no ground for the requirement.

Lahue, 1902 C. D. 357, 101 O. G. 448.

The applicant was defeated in an interference proceeding and filed a new application with the same claims in it. The Examiner refused to consider it *res adjudicata*. Applicant contended that admitting his opponent's patent was a part of the prior art, still he was entitled to a patent. It was held that his application should be acted on.

Schüpphaus, 1902 C. D. 339, 100 O. G. 2775.

In case a division is required references are recited cursorily, but this does not constitute an action on the merits generally, but may do so if it is made to appear distinctly.

Goldman, 1902 C. D. 238, 100 O. G. 234.

The Examiner ruled that a heavier-than-air flying machine was necessarily inoperative. The Commissioner said:

"It is the very purpose of invention to do that which had not been done before, and this Office can not consistently allege a reason for refusing a patent the mere fact that no one heretofore has succeeded in accomplishing the result."

Gibson, 1902 C. D. 117, 99 O. G. 227.

When the invention is not properly claimable as a process, it is the duty of the Office tribunals to so hold if they be of that opinion.

Trevette, 1901 C. D. 170, 97 O. G. 1173.

Claims refused admission because they were for aggregations and other reasons.

Brownell, 1901 C. D. 30, 94 O. G. 988.

Claims merely aggregating two independent inventions should be rejected before requiring a division.

Griffith, 1898 C. D. 233, 85 O. G. 936.

The degree of utility of a device is unimportant in determining whether a device be patentable. If the invention is not frivolous or prejudicial and has any degree of usefulness, then within the meaning of the law it is useful and may be patented. The degree of utility is not a question for the Patent Office to arbitrarily determine.

Sanche, 1897 C. D. 32, 80 O. G. 185.

Where the art as claimed omits a step necessary to its lawful practice, such omission is a proper ground of rejection.

Turner, 1894 C. D. 36, 66 O. G. 1595.

It is proper sometimes to stand upon a mere legal opinion, but it is only advisable in the absence of any other ground of adverse action. When there is a reference "a simple dictum" should not be resorted to.

Fairbanks v. Robinson, 1873 C. D. 12, 3 O. G. 65.

It is improper to require the elimination of a claim or

claims because they present illegitimate combinations, the claims should be rejected.

Wiard, 1890 C. D. 52, 51 O. G. 155.

Where the Examiner had objected to a claim because of its undue breadth only and declined to further consider it upon the merits until it had been restricted in form, held that the reason given was a reason why the claim should be rejected and not why an examination should be refused.

Opdyke, 1890 C. D. 39, 50 O. G. 1293.

The Patent Office has jurisdiction to see that the requirements of the statute, as to the specification and claims shall be complied with.

Paigel, 1887 C. D. 71, 40 O. G. 807.

Material amendments in matter of substance made in good faith can not lawfully be refused consideration by the Office at any time before the issuance of the patent. Immaterial amendments should not be received.

Winchester, 1880 C. D. 92, 17 O. G. 453.

AMENDMENTS AND ACTIONS BY APPLICANTS.

Rule 68. Right to Amend.

The applicant has a right to amend before or after the first rejection or action; and he may amend as often as the examiner presents new references or reasons for rejection. In so amending the applicant must clearly point out all the patentable novelty which he thinks the case presents in view of the state of the art disclosed by the references cited or the objections made. He must also show how the amendments avoid such references or objections.

After such action upon an application as will entitle the applicant to an appeal to the examiners in chief (Rule 134), or after appeal has been taken, amendments canceling claims or presenting those rejected in better form for consideration on appeal may be admitted; but the admission of such an amendment or its refusal, and any proceedings relative thereto, shall not operate to relieve the application from its condi-

tion as subject to appeal, or to save it from abandonment under Rule 171. If amendments touching the merits of the application be presented after the case is in condition for appeal, or after appeal has been taken, they may be admitted upon a showing, duly verified, of good and sufficient reasons why they were not earlier presented. From the refusal of the primary examiner to admit an amendment a petition will lie to the Commissioner under Rule 142. No amendment can be made in appealed cases between the filing of the examiner's statement of the grounds of his decision (Rule 135) and the decision of the appellate tribunal. After decision on appeal amendments can only be made as provided in Rule 140, or to carry into effect a recommendation under Rule 139.

HISTORY.

Rule 34 of 1869 was the same as Rule 31 of 1870 except that the last sentence was omitted and instead of the words "Assistant Commissioner" the words "Commissioner in Person" was used.

Rule 31 of 1871 reads: "The applicant has a right to amend after the first rejection; and he may amend as often as the Examiner presents any new references. After a second rejection and at any time before the issue of a patent, special amendments may be made if sufficient reason therefor be shown."

Rules of 1873 inserted "on approval by the Commissioner" after "made," and added, "but such amendments must first be submitted to the tribunal last acting on the case, for recommendation or objection. Affidavits in support of applications will not be received at any stage of the examination unless the Office denies that the device is operative."

In 1878 the clause "and will be subject to revision and restriction the same as original amendments" appears between "objection" and the period before "affidavits."

In 1884, "After an appeal or" was inserted in the revised Rule 67 of 1879 before "After such action the" and the following matter was added: "No amendment can be made between hearing on appeal and decision; and after decision by any appellate tribunal amendments can be made only in

accordance with such decision, except as provided in Rule 137."

Substantially the present rule, omitting the last clause, in 1888.

Following the notes to this rule I have reproduced the paper read by Examiner Wm. A. Kinnan, Jan. 28, 1915, before the Examining Corps of the U. S. Patent Office; another paper relating to the Examination was read by Examiner James H. Colwell, March 25, 1915.

See Rules 66, 69 and 77.

CONSTRUCTIONS.

- (1) PROPRIETY OF APPLICANT'S ACTION.
- (2) APPLICANT'S ACTION AS A FOUNDATION FOR A FINAL REJECTION.
- (3) SHIFTING GROUND.
- (4) ACTION BY THE OFFICE.
- (5) REOPENING AFTER FINAL REJECTION.
- (6) AMENDING AFTER APPEAL.
- (7) AMENDING FOR APPEAL.
- (8) ADDITIONAL CASES.

(1) *Propriety of Applicant's Action.*

A joint application may apparently be amended by eliminating one of the applicants.

In re Roberts, 273 O. G. 410.

If necessary, an amendment may be made during an interference.

Liebman et al. v. Newcomb, 229 O. G. 613.

A broadening of the claims without explanation is improper. If the Examiner objects to the multiplicity of claims this should be replied to.

Creviling, 197 O. G. 779.

Amendment by telegram confirmed by letter is proper.

Wheary, 197 O. G. 534.

Claims can only be taken out of the case by definite instructions of the applicant.

Iddings & Iddings, 197 O. G. 239.

In asking the withdrawal of a final rejection proper action should be taken.

Morley, Jr., 185 O. G. 1379.

The response made to the final rejection was clearly a sufficient response to a rejection upon new grounds. The Examiner is therefore directed to consider the application on its merits in view of the argument.

Mygatt, 184 O. G. 802.

If one has not complied with this rule in pointing out all

the novelty he has no right to assume that he will be allowed a claim under Rule 78.

Goldsmith & Whiting, 184 O. G. 553.

An issue should be reached. A final rejection should not be given upon the second rejection unless an unmistakable issue has been reached.

Bass, 183 O. G. 506.

The action of the Examiner in apparently allowing claim 8 warranted applicant in assuming that in presenting his claims relating to the same subject matter an argument was unnecessary.

Beard, 178 O. G. 319.

Aug. 12, 1910, Examiner held that claims 5 and 6 were allowable after correction, and finally rejected other claims. Jan. 3, 1911, amendment cancelling the finally rejected claims and adding three new ones. Entry refused.

Aug. 21. Amendment cancelling claims offered. Case abandoned. After the case was finally rejected applicant should, within one year from the date thereof, either have cancelled the claims, taken on appeal, or taken steps which resulted in having that final rejection set aside as premature.

Dietrich, 174 O. G. 829.

Where there is a rejection of the ground that no sufficient elements are enumerated to sustain a functional clause, or for want of particularity "it may be urged that if he is obliged to seek his remedy by appeal and the action of the Examiner is affirmed the applicant is precluded from going back to the Examiner and further amending his claims, the obvious answer is that before appealing the claims and before they are finally rejected the applicant should introduce other claims having the structure stated with sufficient particularity to avoid this ground of the Examiner's rejection.

Bitner, 140 O. G. 256; 173 O. G. 1081.

An applicant may not insert a new set of claims after a requirement of division.

Moorehead, 173 O. G. 1079.

The applicant should point out how his device differs from that of the references to entitle him to have the Examiner point out the pertinency of the same.

Levy, 173 O. G. 288.

Claims to the motor allowed. Petition to withdraw from issue to present claims to the combination of the motor with washing machine. Refused for want of showing.

Weber & Swalter, 173 O. G. 288.

If applicant does not consider all the references cited and

point out where in his opinion the references do not apply the action is not responsive and the case is abandoned.

Sachs, 157 O. G. 755.

The Examiner rejected two claims a second time and cited a new reference against other claims, applicant acted on said other claims but said nothing about the first two.

"I am of the opinion that applicant's amendment was as complete as he could have made it without repetition.

"If the applicant has seen fit to present further reasons why the rejected claims should be allowed it was his privilege to do so; but it is presumed that he had no further reasons to present. Having once presented his argument, it was not incumbent upon him to repeat it. Not abandoned."

Newbold, 155 O. G. 553.

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

McFarland v. Watson & Watson, 146 O. G. 257.

The practice of repeatedly filing amendments which can serve no purpose except to prolong the life of the case or which are presented in the hope of wearing the Examiner into allowing a claim upon the ground that because of its specific character it can do no harm, can not be too strongly condemned.

Perry, 140 O. G. 1001; 157 O. G. 1243; 172 O. G. 1089.

It is not sufficient that applicant distinguishes his device from one of the references, it must be from all.

Inman, 160 O. G. 1038; 172 O. G. 1089.

It may be, as the patentee's counsel declares, that the criticisms of the Examiner led to the present form of the claim. But if the Examiner's criticisms were unsound the patentee could have had them reviewed by an appropriate appeal.

Logan v. Warren Axle and Tool Co., 166 O. G. 986.

In *Ex parte Perry* the practice was condemned of repeatedly filing amendments in the hope of wearing the Examiner into allowing a claim upon the ground that because of its specific character it can do no harm.

Pledger, Jr., & Campbell, 157 O. G. 486; 172 O. G. 1089.

The Examiner rejected two claims a second time and cited a new reference against these claims, applicant acted on said other claim but said nothing about the first two.

"I am of the opinion that the applicant's amendment was as complete as he could have made it without repetition." If the applicant had seen fit to present further reasons why the rejected claims should be allowed it was his privilege to do

so. but it is presumed that he had no further reasons to present. Having once presented his argument it was not incumbent upon him to repeat it.

Newbold, 155 O. G. 553.

Amendment embodying the theory of the attorney, patent held void.

Steward v. American Lava Co., etc., 149 O. G. 602.

Where claims were rejected and canceled and broader claims substituted it was necessary that applicant should state why he regarded them as patentable.

Opeland, 149 O. G. 309.

Inserting claims by attorney without new oaths does not invalidate.

Cutler-Hammer Mfg. Co. v. Union Electric Mfg. Co., 147 T. R. 266. See Singer Mfg. Co. v. Cramer, 97 O. G. 555.

Affidavits as to utility and state of the art.

In re Eastwood, 144 O. G. 819.

The Examiner-in-Chief on appeal made a recommendation that one claim be rejected upon a reference not cited by the Primary Examiner. The Primary Examiner adopted such suggestion but refused to receive a general amendment to the case. Approved. "If, however, the applicant will present an amendment either amending claim 6 or presenting a claim or claims limited to the subject matter covered by that claim, the same may be entered and considered."

Dietrich, 142 O. G. 568.

The practice of repeatedly filing amendments which can serve no purpose except to prolong the life of the case or which are presented in the hope of wearing the Examiner into allowing a claim upon the ground that because of its specific character it can do no harm, can not be too strongly condemned.

Perry, 140 O. G. 1001.

The excuse that the files were misplaced seems to have been considered a sufficient excuse for delay beyond the year.

Curtis, 138 O. G. 767.

Piecemeal action is contrary to the spirit and the letter of the rules and the statutes and is not to be permitted.

Schmitt & Tanody, 121 O. G. 689; Sperry, 121 O. G. 687.

Apparently if applicant inserts claims that are not properly included in the case they should be rejected for this reason and the other claims examined on their merits. The inser-

tion of the claims does not seem to warrant the Examiner in refusing to act as the merits of the other claims.

Scott, 100 O. G. 681; Goebly, 133 O. G. 991.

Without such a showing the amendments submitted were not admissible although it would have been proper to cure the informalities by proper amendment (Paige, 108 O. G. 1587). Such an amendment, however, under the provisions of Rule 68 would not relieve the application from its condition as subject to appeal or save it from abandonment.

Green, 130 O. G. 299.

A request for explanation of the Examiner's position should be full and specific and should not be confused with the argument upon the merits of the action.

Knapp and Cade, 128 O. G. 1687.

Applicants should fully present their case upon each action.

Knapp v. Cade, 128 O. G. 1687.

Where an applicant before the Patent Office acquiesces in the ruling that his claim is not patentable, he can not be heard to question the ruling thereafter, and it is immaterial whether it is right or wrong.

Computing Scale Co. of America v. The Automatic Scale Co., 119 O. G. 1586.

An amendment erroneously entitled in one case can not be transferred to another.

"Since the amendment has been placed in the record of one case and replied to therein, it must remain there to preserve the record."

Haultain & Stovel, 119 O. G. 649.

Whether well founded or not the Examiner's action is binding upon the applicant until set aside, and it is incumbent upon him to take steps to have it set aside within the year allowed by law for action.

Read, 119 O. G. 337.

Claims should be amended, not construed, to avoid references and the same course should be followed in all other cases when the meaning of claims is not clearly expressed by their language.

Briggs v. Little v. Cooke v. Jones and Taylor, 116 O. G. 871.

Sound reason requires as much of the applicants a clear and proper explanation of their position as it does of the Examiner.

Murray, 111 O. G. 2491.

Application for method, claims for apparatus and product,

introduced subsequently. These latter claims take date of filing of application so far as bar of public use is concerned.

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

“In an *ex parte* case the applicant has no knowledge what references and reasons for rejection the Examiner may discover and has no opportunity to argue the matter before the Examiner’s decision is rendered.” Applicant is undoubtedly entitled to argue the matter and since he can not do so before the decision, the statute gives him the right to do so after decision.

Newcomb v. Lemp, 110 O. G. 308.

When the claims were twice rejected as involving new matter an amendment not remedying this defect is not responsive and should not be admitted.

Edwards, 109 O. G. 1051.

Where certain formal objections are made and the claims are finally rejected, held that the applicant may amend to avoid the formal objections, but can not make amendments presenting new claims or affecting the merits.

Paige, 108 O. G. 1587.

It is the duty of an applicant not only to prepare the papers required by the Office, but to see that they are received. If he receives no acknowledgment from the Office within a reasonable time after mailing the paper, it is his duty to make inquiries and correct the mistake which apparently exists.

Stuckgold, 1900 C. D. 307, 106 O. G. 544.

If an amendment is made inserting words after “and” in a certain line and “and” occurs twice in that line, a mistake is the fault of the applicant.

Curtiss, 105 O. G. 500.

Definitions and admissions made by an applicant for a patent in the course of the proceedings in the Patent Office, in order to avoid or differentiate his invention from those disclosed considered in the subsequent construction of his patent.

New York Asbestos Mfg. Co. v. Ambler Asbestos Air Cell Covering Co., 103 F. R. 316.

Applicant has a right to amend claims that have been rejected after an interference.

Harvey, 102 O. G. 621.

Acquiescence. Estoppel. Construction.

Electric Railway Company of the United States v. Jamaica & Brooklyn Railroad Company, 1894 C. D. 406.

Apparently if applicant inserts claims that are not properly included in the case, they should be rejected for this reason and the other claims examined on their merits. The insertion of the claims does not seem to warrant the Examiner in refusing to act on the merits of the other claims.

Scott, 100 O. G. 681; Greely, 133 O. G. 991.

The Examiner required one of two claims to be eliminated because they were identical; in complying, the applicant limited the scope of his invention by estoppel.

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

Effect of arguments in construing patent.

Swain v. Holyoke Machine Co., 97 O. G. 400.

If a part of an amendment is inadmissible the whole should be refused entry.

A new drawing may not be filed arbitrarily at the option of the applicant, the drawing already in the case being satisfactory.

Pugh, 1901 C. D. 78, 96 O. G. 841-2.

Unwarranted persistency condemned. Letters and amendments may be returned.

Dravo and Miller, 91 O. G. 460-1.

Affidavits under Rule 75 are responsive to the Examiner.

Wright & Stebbins, 1899 C. D. 153, 88 O. G. 1161.

Applicants are not required to make amendments at all unless good reasons therefor are in the first place presented by the Office.

Winchester, 80 C. D. 92.

The burden is upon the applicant to establish by proof that is clear and conclusive, the patentability of the invention as claimed.

Durham v. Com., 1895 C. D. 307, 71 O. G. 601.

An amendment to an application for a patent made to introduce a new theory of the invention, and which contains new claims covering a process based on such theory neither of which were mentioned in the original application, if permissible as within the invention, should be verified by the oath of the inventor. (For cases in point, see Cent. Dig., Vol. 38, Patents 152.) Amendment of application, see note to

Cleveland Foundry Co. v. Detroit Vapor Stove Co., 68 C. C. A. 239.

The most casual inspection of the cases cited in support of the appellant's contention, for example, Topliff v. Topliff (59 O. G. 1257, 1892 C. D. 402), shows that the expression quoted from the opinion referred to differences of construction and

of function so wide as to make the citation inapposite in this case.

Snider, 1894 C. D. 23, 66 O. G. 1309.

A claim was erased to secure an allowance, a petition to withdraw the case from issue in order to reinstate the claim was denied.

Potter, 1890 C. D. 163, 53 O. G. 760.

If an applicant makes an amendment in compliance with the demand of an Examiner as to some particular matter, it is not necessary for the applicant to state his reasons therefor, unless his amendment is of greater scope than the requirement of the Examiner.

Winchester, 1880 C. D. 92.

Material amendments in matter of substance made in good faith can not lawfully be refused consideration by the Office at any time before the issuance of the patent. Immaterial amendments should not be received.

Winchester, 1880 C. D. 92, 17 O. G. 453.

(2) *Applicant's Action as a Foundation for a Final Rejection.*

That the final rejection was a surprise is not a ground for an extension of time for amending claim.

Hartford, 184 O. G. 551.

Final rejection should not be given upon the second official action unless an unmistakable issue is reached to the patentability of the invention claimed.

Bass, 183 O. G. 506; Cook, 231 O. G. 285.

Applicant has canceled claims in view of the references of record and it is not unreasonable to assume that he understands them and their points of similarity and differences.

Inman, 160 O. G. 1038.

If the claims have been broadened or not materially altered a final rejection is in order.

Lasance, 131 O. G. 1421.

The final rejection in response to a request for fuller information as to the pertinence of the reference was not based upon a request for a reconsideration or upon any action by the applicant which would justify reconsideration of the case, and is therefore set aside.

Wainwright, 125 O. G. 2047.

No good reason is seen why an applicant should question the propriety of a final rejection or why the Office should entertain such a question unless the applicant desires to continue the prosecution of the case by a proper action. In such event the applicant should offer the amendment or argu-

ment constituting the desired continued prosecution along with his argument denying the propriety of the final rejection.

Thayer, 122 O. G. 1724.

It is true that the Office desires to afford an applicant ample opportunity for amendment and where the pertinence of the references has not been made clear and explanation thereof is asked the action should not be final. But the pressure of work in the Office requires that the prosecution of a case be closed as soon as possible.

Cox, 122 O. G. 1045.

Rejected for inoperativeness, affidavits filed again, and finally rejected. Proper final rejection.

Schmid, 121 O. G. 1675.

If the Examiner's action was insufficient to enable the applicants to respond intelligently, a request for an explanation would have been a proper action.

Schmitt and Tanody, 121 O. G. 688.

Where a claim for a process is rejected, which claim is qualified by a brief statement of the article produced, and an amendment is filed more specifically defining the structure of the article, held that the process claim is not changed in scope, and a final rejection is in order.

Crecelius, 116 O. G. 2531.

The amendment and argument were within the year, but not filed at the same time. Held sufficient to entitle applicant to a reconsideration.

Weinmer, 115 O. G. 1585.

The mere cancellation of the finally rejected claims does not reopen the case for the prosecution of other claims.

Almy, 115 O. G. 1584-1585.

Where the applicant is proceeding promptly and in apparent good faith to secure further information as to the position of the Office before amending further, he should be given a second opportunity to bring the claims into allowable condition.

Wieser, 110 O. G. 1726.

Applicant requested an explanation of the Office letter and also reconsideration. Final rejection regular.

Silsby, 109 O. G. 1051.

"It is true, as the Examiner states, that the invention is a simple one; but when the applicant has read the references carefully and fails to find therein certain specified features included in his claims and asks that the Examiner point out wherein these features are found in the references the Ex-

aminer should not consider it unduly burdensome to comply with the applicant's request."

"This case is very different from that where an applicant asks merely that the Office explain the references without pointing out wherein he regards them as not pertinent."

Starr, 106 O. G. 263.

A consideration of the claims and the amendment makes it appear that the applicant is not attempting to shift his ground, but is merely attempting to so change and limit the claim as to avoid the rejection and objections made by the Examiner.

Day, 105 O. G. 1782.

The amendment included a new claim which was held to be the same as the old claim 3 and the application finally rejected. The third claim had as an element a "tub," the new claim four "an oscillating tub." Held rejection premature.

Casler 2d case, 100 O. G. 1330.

If the amendment is merely formal a final rejection is proper.

Casler, 1902 C. D. 292-3, 100 O. G. 1330.

Only an argument on the merits was presented.

"The petitioner's action did not call for a further explanation, and therefore the Examiner was justified in finally rejecting the claims."

Sorenson, 1901 C. D. 16, 98 O. G. 415.

The presenting of reasons why the references do not meet the claims is equivalent to a request for further action.

Vose, 1901 C. D. 202, 97 O. G. 1599-1600.

Where claims are amended the amendment may not be held as not involving a matter of substance merely because such amendment does not avoid the references.

Pfeffer, 1894 C. D. 11, 66 O. G. 845.

When an applicant asks a reconsideration he waives any right he might have had to a fuller statement by the Office.

Mahlecke, 1892 C. D. 206, 61 O. G. 285.

An uncalled for and superfluous drawing should not be received and filed.

Shepard, 1892 C. D. 162, 60 O. G. 575.

If, as a matter of language, the amended claim does not present the same idea of invention presented by the previous claim, an amendment has been made in matter of substance and the applicant is entitled to a second rejection upon the amended claim.

Griswold, 1890 C. D. 13, 50 O. G. 838.

If a figure is added to a drawing on file in the Office without permission of the same, the figure must be erased.

Cordrey, 1889 C. D. 171; 1889 C. D. 252.

An applicant must not acquiesce in an erroneous judgment of the principal Examiner.

Hyde, 1871 C. D. 109.

(3) *Shifting Ground.*

Adoption of claims suggested under Rule 96 does not constitute an election of a species.

Burk, 184 O. G. 288.

In re Moore, 173 O. G. 891; Sutin, 170 O. G. 482.

A party can not be permitted to reinstate claims canceled in view of a requirement for division.

Wick, 117 O. G. 902-903.

If applicant voluntarily confines his claims to one of two inventions he can not change and present claims to the other after the claims first presented are rejected.

Barnes, 115 O. G. 247.

After a case has been examined and finally disposed of on one line the applicant can not shift his ground.

Applicant is no more entitled to insert a new claim after appeal than to insert one that has been canceled. The fact that an interference would result from insertion of the claim makes no difference.

Recklinghausen & Potter, 113 O. G. 1146.

An applicant may not change his claims from a process to an article after case is disposed of. It is, however, proper to permit a proper change in form.

Walker, 113 O. G. 284.

Applicant may not change his claims from a process to an apparatus.

Feld, 112 O. G. 252.

Having elected to prosecute one class of claims applicant can not shift his ground and insert another.

Ferrell, 106 O. G. 766.

When an applicant has elected to retain one class of specific claims he can not after rejection insert a different species.

Maddux, 106 O. G. 764.

After making a combination claim which is rejected applicant will not be permitted to shift his ground to make his application for an element of such claim. Such element being a different invention and differently classified from the combination.

Swantusch, 1902 C. D. 377, 101 O. G. 1129.

If one presents an application for a process he can not change it to one for an apparatus, even on recommendation of the Examiner-in-Chief.

Alberli, 1900 C. D. 95, 91 O. G. 2731.

Where an application originally contained claims for a method, a product, and an apparatus for carrying out the method, and upon an Office requirement of division the applicant canceled the claims for the apparatus, and where the disclosure of the apparatus does not make it clearer how the method might be carried out, the drawings and description of the apparatus should be canceled.

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

An applicant having originally presented only claims for a method and having prosecuted them to a final rejection and taken an appeal to the Examiners-in-Chief, has made his election, and he can not be permitted to thereafter substitute claims covering mechanism alleged to be capable of carrying out the method originally believed to be patentable and do not include new matter.

Eschner, 1893 C. D. 68, 63 O. G. 760.

(4) *Action by the Office.*

Even if it were not clear from the amendment that applicant did not understand the objection, if he came in promptly and showed this, the final rejection should be withdrawn.

Huntley, 196 O. G. 863.

Stating his reasons for rejection more fully does not reopen a case.

Morley, Jr., 185 O. G. 1379.

A final rejection is in order notwithstanding the fact that an applicant has failed to respond to an objection of a formal character made by the Examiner.

Sabofish, 183 O. G. 1033.

An issue should be reached. A final rejection should not be given upon the second rejection unless an unmistakable issue has been reached.

Bass, 183 O. G. 506.

When a clear issue has been reached and it is evident that applicant understands the application of the references. No further explanation of the references is necessary.

Kelley, 183 O. G. 220.

In case of ordinary doubt the policy of the patent system, as customarily maintained in the Patent Office, has been to give the applicant the benefit thereof, because no absolute right

of property is conferred by the grant of a patent (Thomson, 26 App. D. C. 419, 425).

Moore, 178 O. G. 891.

A reference to a decision of the Commissioner held sufficiently definite.

Patterson, 178 O. G. 835.

The action of the Examiner in apparently allowing claim warranted applicant in assuming that in presenting his claims relating to the same subject matter an argument was unnecessary.

Beard, 178 O. G. 319.

When requested so to do in good faith the Examiner should apply the references. Cases collected.

Andrews, 172 O. G. 1889.

Whether the action of the Office was such as to confer the rights to amend is one that may not be controlled by mandamus.

Sung v. Moore, Com., 172 O. G. 834.

However, if it is pointed out that the claims do not contain the matter relied on and if they did they would be anticipated by a reference of record, this does not constitute the citation of a new reference.

Cott, 166 O. G. 985.

If the Commissioner recommends certain claims only these claims should be considered.

Silden, 164 O. G. 741.

Claims should not be allowed merely because they represent a multitude of elements all of which do not appear in one or two or even more references.

Quagan, 162 O. G. 538, 539.

A criticism of the theory of operation of the device that does not purport to holding it inoperative, does not reopen a case.

Hardy, Jr., 161 O. G. 268.

It is the duty of the Examiner to consider not only the claims but the invention disclosed. If he is of the opinion that an application discloses no invention over the references, it is perfectly proper for him to so state.

Fox, 157 O. G. 485.

It is the obvious intent of sections 4803-4909 of the R. S., and Rules 65-68, inclusive, to bring about a clear understanding between the Examiner and the applicant before the final rejection of the case is entered from which appeal may be taken (130-302).

Miller, 139 O. G. 731.

The issue being distinctly formed, and the amendment to claims not being substantial, the request at the end of applicant's argument, that if a favorable decision could not be given there should be a final rejection, should be complied with.

Marshall, 139 O. G. 198.

Where an Examiner finds it necessary to give reasons explaining the application of a reference, a final rejection should not be entered in the same letter where those reasons have been stated for the first time.

Jackson, 132 O. G. 1324f.

The Examiner finally rejected claims in reply to a request for explanation at the same time giving the information sought. With a final rejection he rendered the information of no avail except through a petition.

Walker, 129 O. G. 481; 68 Atwood, 162 O. G. 1183.

After final rejection no affidavit under Rule 75 will be received.

Berg, 120 O. G. 903; Romunder, 157 O. G. 209.

(5) *Reopening After Final Rejection.*

That the final rejection was a surprise is not a ground for an extension of time for amending claims.

Hartford, 184 O. G. 551.

Adoption of claims suggested under Rule 96 does not constitute an election of a species.

Burk, 184 O. G. 288.

Without such a showing the amendments submitted were not admissible although it would have been proper to cure the informalities by proper amendment (Paige, 108 O. G. 1587). Such an amendment would not relieve the application from its condition as subject to appeal or save it from abandonment.

Green, 130 O. G. 299.

The statement of the attorney that the subject matter of a proposed amendment filed after final rejection was not earlier called to his attention by the inventor is not a sufficient showing upon which to admit the amendment.

Schrader, 120 O. G. 2127.

The amendment after final rejection being unaccompanied by a showing as to why it was not sooner presented was rejected.

Marks, 109 O. G. 1609.

After final action in a case it is not to be reopened at the request of applicant except for good reasons. The affidavit

simply setting forth that the new claims contained features which had been overlooked is insufficient.

Nettles, 107 O. G. 541.

When an application has been prosecuted to final rejection, it is not just to other applicants to reopen it for consideration of amendments which should have been earlier presented.

Brown, 107 O. G. 269.

That the attorney has got further light upon the subject is not a good reason for admitting additional claims.

Schmidt, 1902 C. D. 327, 100 O. G. 2602.

The showing of facts to excuse delay must be correct in form and sufficient in substance. The fact that applicant did not fully understand the case is not sufficient.

Raymond, 1902 C. D. 170, 99 O. G. 1386.

Where amendment is filed after final rejection it must be accompanied by an affidavit showing good and sufficient reasons why it was not presented before in view of special circumstances amendment ordered entered.

Lansing, 96 O. G. 2063.

A new claim refused admission after testimony taken in an interference.

Potter v. Van Vleeck v. Thomson, 1901 C. D. 53, 95 O. G. 2484.

An affidavit to the effect that applicant did not fully appreciate the value and importance of certain features, and therefore, did not present claims for them, is not sufficient showing to warrant the reopening of the case.

Beckwith, 1901 C. D. 43, 95 O. G. 1451.

An amendment upon the merits after final rejection should be accompanied by a verified showing of good and sufficient reasons why it was not earlier presented.

Peloubet, 1891 C. D. 121, 56 O. G. 928.

Amendment presented nearly two years after case in condition for appeal refused. Reopening case refused. No showing.

Cordrey, 1889 C. D. 171, 98 O. G. 397; c. c. 1889 C. D. 252.

When a certain specific claim was suggested to the applicant (Rule 96), but he refused to insert it, an amendment containing this claim was refused entry after ten years' delay.

Gray, 1889 C. D. 91, 46 O. G. 1277.

An applicant can not reassert a claim after final rejection which he had previously voluntarily erased. In such case he must file a new application.

Johnson, 1887 C. D. 64, 40 O. S. 574.

An amendment can not ordinarily be admitted after two rejections.

Thurmond, 37 O. G. 217.

(6) *Amending After Appeal.*

After a case is ready for appeal if a new reference is cited the applicant may continue his appeal in view of such amendment or elect to further prosecute the case before the Primary Examiner.

Mevey, 56 O. G. 805; Scott, 166 O. G. 985.

Claims admitted after final rejection under that part of Rule 68 requiring a "showing duly verified, of good and sufficient reasons why they were not earlier presented," are for consideration by the Primary Examiner and not for the purpose of appeal only.

Meyer, 148 O. G. 1088.

Cases will not be reopened for amendment after appeal except under very unusual circumstances. The fact that the applicant was surprised by the interpretation put on the claims does not constitute such circumstance.

135 O. G. 1122.

Without such a showing the amendments submitted were not admissible although it would have been proper to cure the informalities by proper amendment (Page, 108 O. G. 1587). Such an amendment, however, under the provisions of Rule 68 would not relieve the application from its condition as subject to appeal or save it from abandonment.

Grien, 130 O. G. 299.

Where a new reference is cited, however, upon appeal in the Patent Office, the practice is to require the applicant to elect whether the case shall be returned to the Primary Examiner for consideration of amendments or whether the appeal shall be continued without amendment, and if he chooses the latter course he is considered to have waived his right to amend.

Millett and Reed, 125 O. G. 2764.

If the Examiners-in-Chief have recommended new claims which are rejected on new references, the applicant may not substitute other claims.

Myers, 122 O. G. 351.

It is contrary to the practice of the Office to reopen cases for amendment after appeal except under unusual circumstances where the interest of justice plainly demands it.

Lesler, 117 O. G. 2631; Auer, 116 O. G. 595.

After appeal to the Examiners-in-Chief an application will

not be reopened for the consideration of claims which require a reexamination merely because the applicant has concluded that he wishes to present such claims.

Merrill, 116 O. G. 1186; East, 116 O. G. 1186.

The proper course to be pursued by an Examiner on discovering a new ground for rejection subsequently to an appeal to the Examiners-in-Chief is to direct the attention to it of both the applicant and the Examiners-in-Chief. The applicant may then elect to continue the prosecution of the appeal or to withdraw it and be heard by the Primary Examiner.

Teller, 113 O. G. 548-549.

Claims allowed in original application and omitted by mistake in reissue application permitted insertion after appeal.

Gilmer, 109 O. G. 1337.

As long as applicant keeps within the law no delay is unreasonable or works a forfeiture of his rights. A failure to manufacture does not work forfeiture.

Osborne v. Holsapillar, 103 O. G. 1296-1297.

Amendments after appeal may be admitted for the purpose of putting the rejected claim in better form for consideration on appeal. Such amendments should not vary the scope of the claim. If they have been admitted and do vary the scope of the claim, the appellate tribunal should not pass upon the merits, but the case should be sent back to the Primary Examiner for action.

Hooper & Clark, 1891 C. D. 123, 56 O. G. 929.

Where an applicant has taken an appeal from the Primary Examiner to the Examiners-in-Chief and obtained their decision, if he sees fit thereafter to go back to the Primary Examiner under proper authority from the Commissioner and amend his case in such a manner as to change its nature or character with reference to the subject matter involved in the appeal, he in effect abandons and waives his right to appeal, and must take his stand upon the new case as he has made it.

Williams & Raidabaugh, 40 O. G. 1337.

The rule precludes all amendment of the claim after it leaves the Examiner, except as provided in the rule for special amendments; in which case the amendment, if admitted, is sent to the Examiner for his action.

Hammond, 1872 C. D. 149.

When an appeal is taken the case is closed before the Primary Examiner, unless it is regularly remanded with leave to amend or with direction for further examination. If it be so remanded the case is reopened below, and can not return to the appellate tribunal until the applicant has re-

sponded to the new examination either by amendment or fresh appeal.

Appleton, 1869 C. D. 8.

(7) *Amending for Appeal.*

Claims can only be taken out of the case by definite instructions of the applicant.

Iddings and Iddings, 197 O. G. 239.

If applicant accompanies his appeal with an improper amendment, the appeal should be forwarded and the amendment refused.

Pillard, 191 O. G. 585.

Rule is applicable to design application.

Bittendorf, 184 O. G. 801.

Structural changes sought to be introduced to put the claims in better form for appeal. Held amendment related to the merits and was inadmissible without a verified showing.

Brown & Sprink, 1801 C. D. 135, 160 O. G. 1039.

Claims differing in scope from those under final rejection can not be admitted without a proper showing.

Kenney, 119 O. G. 2237.

Claims admitted after final rejection under that part of Rule 68 requiring a "showing duly verified, of good and sufficient reasons why they were not earlier presented" are for consideration by the Primary Examiner and not for the purpose of appeal only.

Meyer, 148 O. G. 1088.

Cases will not be reopened for amendment after appeal except under very unusual circumstances. The fact that applicant was surprised by the interpretation put on the claims does not constitute such circumstances.

Milans, 135 O. G. 1122.

Amendments cancelling claims or presenting those rejected in better form for consideration on appeal may be admitted after final rejection without reopening the case for further consideration. For a similar reason amendments to the description presenting the invention more clearly when they do not touch the merits of the application should be entered.

Loppenstein, 122 O. G. 1723.

Descriptive matter relating to constructions involved in claims on which appeal is taken should not be required to be canceled prior to appeal.

Kenney, 119 O. G. 2237.

There is nothing inconsistent in filing an amendment with an appeal.

Bach, 118 O. G. 1363.

If a claim differing in substance from those acted upon is presented ostensibly for appeal with his answer, Examiner should forward the appeal with his answer as to the rejected claims and should call attention to the fact that the additional claim has not been entered or acted upon and is not appealable.

Wirt, 117 O. G. 599-600.

A claim that brings forth no new or unconsidered point, but is simply more specific, is in better form for consideration on appeal.

Marks, 111 O. G. 2492.

Change of claims admissible to put them in better form for appeal must not change them in substance. The latter kind of claim can only be admitted on a proper showing.

Novotny, 108 O. G. 1327.

Where claims are canceled a requirement for division and are presented in a separate application they can not properly be reinstated in the original case and considered on appeal.

Fritts, 105 O. G. 2059.

The drawing may be amended by the attorney without special authorization by inventor.

Wilcox, 1902 C. D. 409, 101 O. G. 1829.

New claims in substance may not be introduced after final rejection for appeal.

Downing, 100 O. G. 2176.

Amending application after filing.

Grinnell v. Bruel, 89 O. G. 1863 Mlf.; Hobbs v. Beach (U. S. S. C.), 94 O. G. 2357.

Amending application after filing.

Bechman v. Wood, 89 O. G. 2459-2462; Chicago & Northwestern R. R. Co. v. Sayles, 97 W. S. 554, 15 O. G. 243, 1879 C. D. 349; Newton v. Furst & Co., 15 O. G. 243, 119 W. S. 373; White v. Dunbar, 26 O. G. 353, 119 W. S. 47; Brown v. Davis, 116 W. S. 237; Mieter v. Brais Co., 216 O. G. 201, 104 W. S. 350; Topliff v. Topliff, 59 O. G. 1257, 146 W. S. 156; Powder Co. v. Powder Works, 186 O. G. 1339, 98 W. S. 126; Halett v. Long, 89 O. G. 1141; Rouse, 88 O. G. 2242.

Amendments cancelling claims or presenting those rejected in better form for consideration on appeal may be admitted either before or after the appeal has been taken without a showing why they were not earlier presented.

The applicant's opinion may properly be consulted as to whether the proposed amendment is in better form than the corresponding claim which has been rejected.

Collins, 1890 C. D. 27, 50 O. G. 992.

(9) Additional Cases.

These cases pass on the subject matter of this rule.

Luten, 170 O. G. 482; Atwood, 162 O. G. 1183; Barrett and Alter, 127 O. G. 847; Rogers, 125 O. G. 2766; Peirce, 121 O. G. 1347; Richmond, 120 O. G. 905; Lefever, 1904 C. D. 205, 110 O. G. 1430; Durafort, 1904 C. D. 234, 110 O. G. 2017; Landis, 1903 C. D. 127, 103 O. G. 1164; Bowles (second paragraph), 1903 C. D. 95, 103 O. G. 429; Grant, 1900 C. D. 199, 93 O. G. 2532; Willer, 1900 C. D. 62, 91 O. G. 1033; Woodward, 1892 C. D. 179, 60 O. G. 1052; Barrett, 1891 C. D. 154, 56 O. G. 1564.

METHODS OF SHORTENING EXAMINATIONS.

A Paper by Examiner Wm. A. Kinnan.

January 28, 1915.

The subject of patent law has been described as covering a very limited portion of the field of general law. While not extensive, it is, gentlemen, as deep as a well.

It is believed to be generally recognized that there is no other branch of the law that requires a greater mentality, a wider knowledge, or greater skill and training.

The Examiner, who with the all too little time for each case, is able to apply this law with reasonable accuracy, to the multitude of different inventions, embraced in applications possessing a multitude of different imperfections and insufficiencies, and adjudicate the enormous number of claims required to mark the limits of the rights involved, must indeed possess a degree of skill, judgment and learning that is, to say the least, unusual. He must be at once judge, jury and counsel. He must determine the law, weigh the evidence, and combat and expose the fallacies in the arguments presented by the too zealous applicant. All this he must do with a maximum of speed, if the work before him is not to hopelessly accumulate.

It is the purpose of this paper to make some suggestions looking to the shortening of the time required to finally adjudicate the application. That every effort to this end is necessary is abundantly evidenced by the fact that steadily the number of applications filed each year has increased, and as steadily the time required to adjudicate each case has also increased, until now, the corps staggers under a load it is well nigh impossible to carry.

It is of little utility, perhaps, to discuss the reasons for this increase. It will be sufficient to merely note, in passing, that they are found in the fact that we are the most inventive people in the world; that our industrial and commercial supremacy is in a considerable measure due to this fact, and the steady increase in our population brings with it the natural increase in the number of applications filed each year. In 1840, there were 765 applications filed; in 1860, over 7,000; in 1880, 23,000; in 1900, 41,000; in 1913, 70,000. The examiners will, in the near future, be facing the stupendous task of examining a hundred thousand new cases a year.

Experience has shown that there is no such thing as an exhausted art.

Even where there are lulls in the advance of some of the arts, these are more than offset by the sudden activity in others, brought about by the invention of some radically new thing.

The invention of the wireless telegraph; of the successful flying machine; of the automobile, have resulted in a flood of applications for inventions in the nature of improvements and refinements, all having their bearing upon the creation of the eventually practical, commercial form of apparatus.

These pioneer inventions also bring about an increased activity in a large number of related arts.

A wireless telegraph station must have its source of high frequency current, its structural towers of great height, its special conductors of high insulation. In fact, these new conditions have brought about an increased activity in almost every branch of the electrical art.

A flying machine and an automobile must each have a gas engine, with its electric igniting means, its gas mixing apparatus, and its multitude of related devices pertaining to many mechanical and metallurgy arts. All these take on special designs and refinements incident to their new use, and bring their multitude of applications to the various divisions of the office having in charge the cases relating to these various arts.

The art that must be searched is increasing by leaps and bounds, and reclassification, imperative as it is, and helpful as it is, can not solve this part of the problem, and is only a partial, though welcome aid.

The complexity of the subject-matter of the applications is ever increasing. The fact that more and more of the complicated manual operations and processes are being accomplished by machinery, and that existing machinery is being more and more refined, made automatic, and made to do things requiring almost a human intelligence, with a minimum of supervision, brings about this result.

There has also grown up a class of people who are desirous of a patent of some sort, of any sort, who keep an application which is fairly anticipated before the Examiner as long as possible, hoping by some argument or shift, or amendment, to find some slight point on which to hang an allowable claim, or to weary or argue the Examiner into allowing some sort of a claim, so that counsel may obtain his fee, or satisfy an uninformed client or a client who is indifferent to the validity of his patent but wishes to mark his device patented merely for the intimidating effect upon would-be rivals.

It is plain enough, therefore, that in the near future the work of the examining corps will not grow less. The situation, as we are all aware, has resulted in the cases awaiting action reaching the somewhat startling number of over 25,000.

There are several very cogent reasons why applications should be speedily brought to a final adjudication.

Applications long pending are a source of scandal and abuse. Often they do not embody the inventions in commercial form; they are kept pending in the office while others, ignorant of them, and therefore obtaining no aid from them, invent and produce successful devices, create a commercial value and status at great expense and risk, only to find that the owner of the long pending application has placed therein a claim dominating all that the later inventors have done, has issued the patent, and by legal process lays tribute upon

the labors and the rewards of the later innocent inventors. Such a proceeding is so repugnant to justice and equity that this office is warranted in doing all it can to prevent such applications from being kept pending during long periods.

Further, by removing the cause, legislation honestly intended to reach this class of cases, but also doing great harm to inventors whose applications are necessarily delayed in the office, will be rendered needless.

The long pendency of a large number of applications before the office, by consuming its time in reconsidering them over and over, renders the period before a new application is reached for the first examination so long that the inventor frequently suffers great loss. The art may pass beyond his invention. He may lose his opportunity to sell. He dare not incur the expense incident to manufacture because of lack of protection. Having no indication of the attitude of the office, his commercial interests, so far as that invention is concerned, are entirely halted.

The foregoing considerations are sufficient to show that the office has reached a condition that may be regarded as almost critical, and one that fully justifies it in adopting any means, not inconsistent with law, and which will not injure the rights of inventors, that will enable the corps to reduce the number of times applications must be reconsidered, the period they may be kept pending, and the number awaiting action.

How is this to be done?

I shall not consider here possible future legislation, but will consider only what can be done with the means at hand.

The standard of work must be maintained. If the examination and adjudication of applications are to be worth while, are to possess any real value justifying the enormous cost involved, the work can not be slighted. Enough patents, more than enough, in spite of the best we can do, are declared invalid in whole or in part.

It is believed there is room for improvement in a conservation of energy.

I am reminded of a youth whom I knew in my younger days, who was wont to contest in foot races. When he was in full action, he had such a habit of waving his arms and moving his body up and down that he had too little energy or time left for making progress forward. He always came in last. It has seemed possible the office sometimes progressed a little like this youth; that it takes too many unnecessary actions, and the following suggestions are made, with a good deal of diffidence, in the hope that some economy of time and effort may be realized.

In the first examination of the application, if the action is to go to the merits, let it be a complete one.

In matters of form all objections should, so far as possible, be embodied in the first office letter, and be kept before the applicant in subsequent letters, if necessary, by simple reference to the first letter. This generally enables them to be all out of the way by the time the matters of merit are determined. I recall a letter received in a division in which I was an assistant many years ago, which read something like this: "The informalities and objections, which seem to increase in number with each reexamination of this case, have, we hope, all been cured."

Just a word here about formal objections. It is a well-recognized fact that a great many are made that are subsequently waived. Bear-

ing in mind the specification and drawing are addressed to those ordinarily skilled in the art, and they should be clear and understandable, yet so few formal objections should be made as is consistent with this ultimate end. Merely because the Examiner would state a matter differently, or could even state it better, were he writing the description, is no reason for requiring revision or change. If the matter is not incorrect, is not misleading, and the meaning of the inventor is plain, objection should, ordinarily, not be made. The Examiner should be sure his formal objections are really necessary. This saves time, argument and friction.

Before making a search for anticipatory art, the application and the invention should be fully understood. It pays to take time to fully and completely comprehend the disclosure every time the case is acted upon. Then the first search should be as nearly complete as it is possible to make it. Not only the broadest and the narrowest claims should be held in mind in searching, but the invention, the thing itself, and its functions should be held in view. Where the invention is simple, and fully comprehended, a second search is rarely necessary. In the more complex and extensive cases, however, second or even third searches are often necessary, it is true, but even here the gain of a complete search is proportionally great, and second searches will be proportionally fewer.

In regard to the search:

It is said all men are equal before the law. Someone has added, "this is true, however, only in theory." The same is true of claims.

A narrow claim limited to the precise embodiment of the invention disclosed is much less likely to be anticipated by anything found outside the class where the case belongs. A search on such a claim, therefore, should seldom be prosecuted beyond rather restricted limits.

Further, a narrow structural claim is seldom sued upon. An alleged infringer almost always adopts a modification and escapes the terms of such a claim. Also courts are very apt to sustain a specific claim where an infringer uses the very same thing on which it is based.

For these reasons, therefore, the narrow structural claim is not so important, is of less value and is much less frequently heard of after being once granted.

It is the broad claim that is important. It is this claim that dominates an art, that spreads over the territory that others may seek to occupy. It is almost always this type of claim that is brought before a court, and by which the plaintiff seeks to restrain an alleged infringer who uses something different.

This type of claim is valuable, if it is good, and is harmful if it is invalid. The inventor should have it, if he is entitled to it, and it should be denied him if it is not rightly his. Such a claim should be more carefully weighed. The chance of anticipating such a claim outside the class where the case belongs is proportionally great. Before searching in any place, however, the Examiner should first weigh the question as to whether, if he found something there, it would be in an analogous art and would be a proper reference.

Where an incomplete search is made, the Examiner takes very nearly as much time to make it and fully as much to adjudicate the claims on the art he finds as if he made a complete search. The attorney, in response, amends his case to define from the art found. The Examiner reviews the case, possibly months later and

after he has forgotten both the case and how faithfully he searched it. He will usually research the ground previously covered as well as the additional ground he originally should have searched. Here is a great loss of time because he covers the same territory twice. The whole status of the case may now be changed. The first action taken in the case as well as the response of the attorney are rendered almost useless, possibly quite so. The application is now just where it should and would have been had a complete search been made at first. The practice of not making a full and complete search in the first instance has resulted in some attorneys making a practice of not attempting to really advance their cases until after the second or even third action by the Office. It is easy to see that time and energy are lost by such proceedings.

The temptation is great, where an Examiner is driven at top speed to get off his cases so as to make the necessary weekly gain, to make an incomplete search, hoping that when the case comes up again he will have more time. But he merely puts off the evil day, and in the end does more work and gives more time in reaching a final adjudication of a given case than he otherwise would. When this case is multiplied by a hundred or even a thousand, the Examiner is, like the youth in the foot race, wasting a great deal of energy and time. When the search has been made and the Examiner comes to apply his references and adjudicate the claims, some of them may be squarely met by some references. Little time need be wasted here. Some claims, however, may require a combination of references. Here it is almost always best to explain, in as few words as possible, just how the combination is made. Even where the invention is simple, this is often advisable. It puts the matter specifically and squarely before the applicant and he can and must either point out why the combination is not proper or amend the claims. Where a reference lacks an element recited in a claim or must be modified in any way, even if ever so slightly, it is well to make an explanation, in a few specific words, just why the element of the claim which is not in the reference is regarded as insufficient, or just what the modification of the reference consists of. Where the subject-matter is more complicated, these explanations are correspondingly more advantageous. Where an attorney is known to be well skilled in the art, less explanation is necessary. Where an inventor is prosecuting his own case but exhibits sufficient knowledge of patent law to warrant the Examiner in the belief that suggestions will enable the inventor to conclude his case without the aid of an attorney, the explanations should be correspondingly extended and made as specific as possible.

This practice places before the inventor or his counsel all formal objections, the complete art, and the Examiner's interpretation of the relation of such art to the application. It is evident the termination of the prosecution of the case before the Examiner need not be greatly prolonged. In the reasonably simple cases, where the entire scope of the invention can be readily seen and comprehended, the third action by the Examiner with the same references before him should ordinarily be sufficient to conclude the case. There are some cases, where special reasons exist, in which further consideration will be necessary. The Examiner should exercise judgment in each case and not make any fixed rule. With the increase in the complexity and extent of the subject-matter of other cases, a reasonable increase in the number of actions is inevitable.

Even in these cases, however, the early citation of the complete art, and the notation of all formal objections, will go far to reduce the number of reconsiderations and reexaminations, while in no manner preventing the applicant obtaining full protection for all he has invented.

Whenever final rejection is about to be taken, and whenever the condition of the case indicates such a course would be helpful, the Examiner should suggest in brief specific terms any amendment which he thinks would advance the case or render the claims allowable.

There is a class of applications that I can not approach without realizing I am standing on holy ground. These are the *old* pending cases. Some have been pending, five, ten, fifteen, and even twenty-five and more years. I know of no one, or half a dozen, things that will bring about so great an improvement in the condition of work before this Office as the conclusion of the pendency of these cases. Over and over again have they been examined. Unusually they have been amended once a year, some are so old that they fall under the old law of requiring amendment only once every two years. For a variety of reasons, some good and some bad, these cases have been kept in the Office, growing older, their records larger and more cumbersome, and adding very greatly to the labors of the examining corps. The annual amendments made to them have not been calculated or intended to really advance them toward a conclusion. The Examiners, too, have in the past despaired of making much advancement, and their annual actions have sometimes been less complete than they might have been. Until a comparatively recent time the Examiners have felt helpless to solve this problem.

Section 4904, R. S., states: "Whenever, on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejections, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specifications, the Commissioner shall order a reexamination of the case."

Rule 68 is based on this statute and provides that an applicant "may amend as often as the Examiner presents new references or reasons for rejection."

Section 4909, R. S., states: "Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected . . . may appeal from the decision of the Primary Examiner."

Rule 134, which is based on this statute, specifies: "There must have been two rejections of the claims as originally filed, or, if amended in matter of substance, of the amended claims, and all the claims must have been passed upon, . . . before the case can be appealed to the Examiners-in-Chief."

These two sections of the statutes and these two rules have constituted the basis for a practice that existed from the adoption of the law, to almost the present time, and which was to the effect that an Examiner could never close the prosecution of a case before him so long as an applicant presented at each reconsideration at least one claim that was different in scope from any previously

considered. When it is recalled that an application may have anywhere from half a dozen to several hundred claims, it is at once apparent any skilled attorney could, under such practice, keep an application pending so long as he desired.

This has been the cord that tied the hands of the Examiners and has rendered possible this great accumulation of old cases. By the decision in *Ex parte Miller* (139 O. G. 730), the cord was severed and the examining corps was relieved from this helpless condition which had become well-nigh intolerable. That decision is based upon the view, which is clear enough, that the statute does not contemplate nor require the repeated reconsideration of an application, dependent only upon the will of the applicant or the skill of his counsel in varying the language used to define the invention.

That decision held: "Where the Examiner has held that certain claims are unpatentable and has fully advised the applicant of his reason for such holding and the latter, after reasonable prosecution of the case, has failed to so amend as to necessitate the citation of new references and has been unable by argument to convince the Examiner that he was in error, an issue is reached, and the Examiner is justified in refusing to accept further amendment and in finally rejecting the claims then of record in the case."

This ruling, which has been subsequently fully upheld in *Ex parte Perry* (140 O. G. 1001), a second *Ex parte Miller* (150 O. G. 827), and *Ex parte Lang* (153 O. G. 1081), constituted a very marked departure from the old practice, in that it transferred from the applicant to the Examiner, the power to bring the prosecution of an application before the Examiner to a close. This at once made it possible for the corps to put a check upon what was becoming, in some instances, a grave abuse of the latitude of the Office procedure.

In explaining this holding of *Ex parte Miller*, *Perry*, etc., Mr. Billings pointed out that while it was true Rule 68 provided that an applicant had a right to amend as often as the Examiner presented new references or reasons, this rule also made it incumbent upon the applicant in amending to "clearly point out all the novelty which he thinks the case presents in view of the art disclosed." It is a natural deduction that if an applicant really does this, when he amends, a condition will ordinarily be reached in one or two actions where the Examiner has no new references or reasons to present.

Still the Examiners are not out of the wilderness. These old cases are often complex and extensive in subject-matter. It is not difficult, and the more complicated they are the easier it is, in amending them, to drive the Examiners to "new references or new reasons." This precludes the application of the *Miller* doctrine, in such instances, and brings them under Rule 68, giving applicants the right to further amend and argue.

Many inventors and attorneys, since the real condition of the Office and the possibility of stringent legislation being enacted have been made known to them by the Commissioner, have recognized the necessity, in the interests of all, for prompt action looking to a bringing to a conclusion these old cases, and have presented carefully prepared amendments which have enabled the Office to considerably reduce the number of such cases. In passing it is worthy to remark that it is surprising and also gratifying to note the

extent to which it is possible to advance one of these old cases, by a carefully prepared amendment, without sacrificing any of the inventor's rights.

There are, however, quite a number of these old cases where financial and other reasons impel the applicant to seek a further delay. Sometimes large rival concerns have many applications pending relating to a general subject or art, and are involved in many interferences which delay their cases in the office. Their interests are financially very great. Millions have been and are being expended in the production and perfection of these inventions. The securing of patents which will protect the owners in the use of such inventions is vital. To take out some of their patents, while so much is being litigated, and while rival concerns still have pending cases relating to analogous subject-matter, would be productive of enormous loss. These considerations must be given due weight.

Some cases, in which a plea for further delay is made, it would appear that counsel merely hopes, by repeating and impressing his arguments in various forms, to finally win over the Examiner.

Whether rightly or not a good many attorneys do not wish to be denied the privilege of impressing their arguments on the Examiner over and over again. This should not be necessary. If the applicant and the Examiner fully understand the case and the art, there is no necessity for this repeated review.

Some few of these applicants whose cases have been long pending are undoubtedly actuated by motives similar to those which actuate the citizen who does not want to enlist. They hope that, by some hook or crook, to keep their cases going a year or two longer and by that time, they are trusting, the war may be over, and they will finally escape the firing line.

So grave has become this evil of long pending cases, so great is the inertia of this load, so clearly is a remedy necessary to the preservation of our patent system and the interests of inventors and the public alike, that the Commissioner has seriously set about the work of bringing these cases to a conclusion. Results are plainly apparent, but the end has not been reached. Eager to afford these tardy prosecutors an additional opportunity to protect their inventions as he is, yet he has firmly impressed upon these applicants that he will not permit any needless delay. To that end he has sought to limit amendments to those that will not longer delay the case. He has taken over the personal consideration of all amendments to applications pending five years or over.

"If an amendment is filed in such a case which puts it in condition for allowance or final rejection, it will be accepted, but if the amendment does neither of these two things, as, for example, when an applicant undertakes to put in new claims the amendment will be considered without being entered and the applicant notified by the Commissioner of the character of a supplemental amendment which will put the case in condition for allowance or final rejection. If the applicant fails to file such supplemental amendment, the amendment which has already been filed will be refused admission and the case when the year is up will be held abandoned." (Commissioner's address to the Patent Bar Association, Chicago, Ill., Nov. 19, 1914, *Sci. Am.* Dec. 12, 1914, p. 491.)

It will be readily apparent that this plan is going to bring the prosecution of this class of cases to a close, yet there is given each

applicant, after all the opportunities he has already had, a still further opportunity to draw his claims to cover what he believes he has invented, and if he can not agree with the Examiner to obtain the judgment of the higher tribunals. Even where an applicant seeks to expand his case anew, at this late date, by claiming something he has not claimed before, thereby necessitating "new references or reasons of rejection" the office goes so far as to examine this new amendment and indicate to him what part, if any, is allowable, and gives him an opportunity to incorporate this part in his patent.

It would seem that this plan is as liberal as is possible, consistent with the end had in view, and that no one can justly claim his rights have not been safeguarded.

Returning to the consideration of applications generally, there is thought to be some loss of time due to what may be called debatable rejections. There is no need to discuss here practices that are settled, grounds of rejection that are fixed, but there are several grounds of rejection that are very frequently used and possibly a little more uniformity throughout the corps would be an economy of time.

I have read office letters rejecting claims on the ground they recite aggregations, where the claims would seem to be for true combinations, which were merely old combinations. Perhaps the ultimate end, the amendment of the claim, is finally reached, but often such rejection precipitates argument and needless waste of time.

While the United States Supreme Court in the decisions of *Hailes v. VanWormer* (20 Wall. 368); *Florsheim v. Schelling* (53 O. G. 1737); *Adams v. Bellaire Stamping Co.* (57 O. G. 1280); *Richards v. Chase Elevator Co.* (71 O. G. 1456); *Reckendorfer v. Faber* (92 U. S. 347), and the U. S. C. C. of Appeals, Seventh Circuit, in the case of *Deere and Co. v. Rock Island Plow Co.* (82 O. G. 1561), discuss very fully this question of aggregation versus combination, the following from a decision of the Examiners-in-Chief, made in a recent case, is so pertinent that I take the liberty of quoting it.

"In the first place, it should be observed that the problem of whether a given claim sets out a patentable combination or an aggregation is not to be solved by the citation of references. A true combination of elements, working together under a cooperative law, and producing a given result, remains a true combination for all time, irrespective of the antiquity of its original creation, . . . the ground of rejection which is proper is not that the combination is illegitimate, but that it is old."

The question settles itself by determining whether the elements named in the claim *cooperate, work together*, though not necessarily simultaneously, but so that by virtue of what they *together* accomplish, a different result is secured from what would be secured if the elements were used separately. As was said by the Supreme Court in the *Reckendorfer v. Faber* case, *supra*: "There must be a new result produced by their union; if it is not so it is only an aggregation of separate elements." This case was based on a lead pencil with a rubber eraser at one end. The court aptly pointed out that the rubber did not perform any function in connection with the writing. It remained inoperative, and could as well be absent. So in erasing the marks, the pencil remained inactive, did nothing, could

as well be absent. These two things never worked together, and never accomplished any joint function or result.

A second ground of rejection that gives rise to much trouble and creates considerable argument and friction is applied to claims for alleged machine or apparatus methods or processes as distinguished from chemical and article methods.

It is not the purpose of this paper to discuss this class of claims from an academic viewpoint or quote from the many learned exponents of this subject. Further, the matter has been ably treated in a previous paper presented to this body. It is desired here, however, to make, if possible, a few practical, rough suggestions which may be helpful in determining whether a claim is for a true method or for the function of the apparatus.

The authorities are pretty well settled that the old definition of the United States Supreme Court in *Cochrane v. Deener* (11 O. G. 687), stands as about the most tangible and workable definition yet given. There must be present an act or a series of acts and they must be performed upon something to change it to a different state or thing. Remembering that only so-called machine processes are under consideration, and that the main difficulty is to distinguish them from the function of the machine or apparatus, it may be helpful to first note that the claim does not recite specific means or mechanism. If this specific mechanism is necessary to support the alleged steps, it is probable these latter are inevitably the function of such mechanism. It is well to try to discover what the step is or what the series of steps are; to recognize them in the language used in the claim. Then the thing they are performed on should, if possible, be identified. This may be the electric current, as in the *Telephone Cases* (126 U. S. 1532), and *O'Reilly v. Morse* (15 Howard 62). If these can be identified it is generally easy enough to determine whether the steps are so tied to specific mechanism as to be but its function, or whether they can be performed, within the language or terms of the claim, by different mechanisms differently organized, or, if the nature of the steps permit, by hand. While no function can be carried out without some means to do it, yet the function must be distinct from the means, from its practical embodiment, and its immediate effect. There must be some other means, with some other embodiment, to which this function is common. *Robinson on Patents* cites the example of smoothing something, and explains how different things, like running water, a single knife, a sliding weight, a group of revolving knives, may perform this function. The machine step of smoothing, therefore, is performed by some means, but is not a function of any specific means, but is a function of several different mechanisms or means, and is a proper step of a method. Again, this author cites the function of exploding or igniting a substance, and notes this may be accomplished by different means, as a red hot iron, a flame, the electric spark, etc. The function is common to these different devices, and also these different devices can operate without producing the function of exploding or igniting a substance. These things have separate existence, the means is a permanent thing and the function is a transient, intangible thing.

If these principles concerning this class of claims can be had in mind considerable time can be saved, both in determining when a claim should be rejected and in making suggestions to an applicant who discloses but is not succeeding in properly claiming a method of this character.

There is another ground of rejection which is not uniformly interpreted throughout the office. This is that the claim is functional in that it fails to recite the means for accomplishing the results specified. Sometimes the mere length of a functional statement, predicated upon a properly included means, is made the basis of rejection. Obviously this is in error.

The so-called "whereby" clauses, and those beginning with the word "adapted," are often found to be unsupported by the inclusion in the claim of the means for accomplishing these functions. In such cases, the means should be included. But the statement of means, mechanisms, or devices, accompanied by their functions, constitute the long accepted manner of drawing claims for mechanical inventions. If the elements are recited, the length of the functional clause is of no moment. If recited generically, the claim is merely broad and if otherwise patentable is allowable.

There is a class of claims wherein the entire invention is recited in the generic words "means," mechanism, or devices, accompanied by the functions of such means, or mechanism, without defining anywhere in the claim the structural nature of the means or mechanisms or devices. Of course, these claims are as broadly drawn as possible, and in language, cover any and all means for accomplishing these functions, cover means substantially different.

There are at least two views held in this Office as to such claims. One is that they are too broad, are broader than the invention, and that they are therefore unpatentable. Beside several Commissioner's decisions there are decisions of the United States courts which look to the support of this view. (Consolidated Electric Light Co. v. McKeesport Electric Light Co., U. S. Supreme Court, 159 U. S. 465; Madison v. Campbell, U. S. C. C., 78 Fed. Rep. 910; Wilson Trolley Catcher Co. v. Frank Ridlon Co., U. S. C. C. of Appeals, First Circuit, 159 O. G. 244; *Ex parte* Denning, 26 O. G. 1207; *Ex parte* Knudson, 72 O. G. 589; *Ex parte* Pacholder, 51 O. G. 295.)

The other view is that no matter what the breadth of terms used in the claim, an inventor is only entitled to what he has invented and produced, and substantially its equivalents and, if the invention is of a pioneer character, the range of equivalents will be proportionally broadened when, on proofs, this is made to appear. These claims, if they can not be met by references, are, therefore, to be allowed.

The cases where courts have held such claims void on this ground alone, of being broader than the invention, are so few, and modern judges are so prone to construe claims to save a really meritorious invention that the question is one of no very great moment.

There is one other ground of rejection of which mention may be made. This is upon the so-called Hawley doctrine. This doctrine was first emphasized and made prominent in the decision of the Court of Appeals of the District of Columbia, *In re Hawley* (121 O. G. 691), although it is but a repetition of the substance of *Ex parte* Griffith (85 O. G. 936). This holding has been confirmed by the same court *In re* McNeil (20 Ct. App. D. C. 294), and *In re* Ratican (162 O. G. 540). Later the Circuit Court of Appeals, Third Circuit, held a claim void on this ground in the case of *Langan v. Warren Axe and Tool Co.* (166 O. G. 986).

This doctrine is to the effect that where the combination recited in the claim is old and the distinction over the prior art resides in one element only of the combination and does not result

in a modified or improved action of the other elements of the combination the claim is unpatentable and should be limited to the element *per se*.

The doctrine has been quite extensively applied by some Examiners and but little used by others. It is a proper ground of rejection when properly applied.

It is believed the vital determining factor is whether the element which has been improved constitutes a complete thing itself capable of separate and independent use, or one that has acquired a distinct status in the arts and trades. If neither of these conditions is present, it is doubtful if the doctrine applies.

In the Hawley case, the improvement was in a tape to be used in a recording mechanism. The latter was not modified in any way and was admittedly old. Obviously the tape fulfilled the conditions above noted. No one would buy a new recorder every time he used up the tape, any more than one would buy a new typewriter machine every time he used up his supply of paper. The tape was clearly a separate subject of invention, a separate article of manufacture and sale and should not have been claimed in combination with the old recorder.

In the Ratican case, the invention resided in a nozzle for a street washing machine, otherwise old. It is plain enough the nozzle was a separate, complete unitary thing, did not in any manner change the operation of any part of the machine, was a separate subject of manufacture and sale. Obviously no one, wishing a new nozzle, would purchase an entire new street washing machine.

The case of Langan v. Warren Axe and Tool Co. is a very much more important one. The decision was rendered by the United States Circuit Court of Appeals, the patent was already granted and the claim was held invalid.

There exists some difference of opinion as to whether this ruling may be said to uphold the so-called Hawley doctrine. There was a very plain discrepancy between the statement of invention in the specification and the structure covered by the claim. The specification made it very clear that the patentee had invented a new kind of grab-hook, and merely described how such hooks were to be used, in pairs, with a draft device in skidding logs. The claim, however, was for the combination of a pair of hooks with the draft device. The novel details of the hook were, however, specified in the claim.

The court emphasized this lack of consistency between the statement of invention in the description, which was that applicant had merely improved the hook, and the statement of the claim, and in doing so said: "There is no suggestion that any part of the patentee's invention resides in the combination of the grab-hooks and the draft appliance. The connection between the grab-hooks and the draft appliance by means of links or claims is mentioned, but such connection was as old as grab-hooks themselves, and the patentee expressly states that his invention consists, not in any such combination, but in the particular and peculiar form of hook. . . .

Not only is the claim for a combination foreign to what is set forth in the specification, but there is no new coaction or cooperation of the elements of the combination. The grab-hooks and the draft appliance of the patent, in combination, coact as grab-hooks and draft appliances have always done. The grab-hook of the patent, by reason of its peculiar construction and form, is very probably an improvement of no little utility. But the patentee can not, merely

because of this fact, have a patent for a combination, which shall have, as one of its elements, a pair of such grab-hooks. He did not invent the combination. He invented, if he invented anything, an improved grab-hook."

On being urged by counsel to construe the claim as for the hook alone, the court said: "Manifestly, we can not so construe it. The claim is for a combination of grab-hooks, of a peculiar form, and a draft device. We are not at liberty to distort its plain language."

Whatever may be the view as to the general effect of this decision, the fact is plain enough that this patentee lost his invention because he did not claim the hook alone, because he claimed it in the old combination which it did not affect in any new way.

It is hardly to be presumed the court would have found the claim valid if the patent itself had not contained the inconsistencies noted by the court, provided the proofs adduced at the trial had been such as to set forth this same state of facts.

This decision is sufficiently suggestive, that in plain cases, the doctrine should be applied.

In the usual house door-bell arrangement, in use all over this city, there is a push button switch, a bell, a battery, and the wire conductors. Each is a separate subject of invention and has a distinct status in the art and trades. An inventor may improve the bell, the switch, the battery, or the wires. None of these improvements would affect the mode of operation of the other elements, and the claims should be confined to whichever element—the switch, the bell, the battery or the conductors—that is improved. A combination claim should not be allowed.

But if an invention is made in a part of the switch, or the bell, or the battery, which part has no general utility, no separate status, it is doubtful if the Office is warranted in objecting to a claim that includes the entire switch or the entire bell, or battery. These are unitary things, and to carry the Hawley doctrine to their details of structure constitutes a refinement of procedure that can only result in harmful confusion, friction and delay.

An adherence to this firmer ground in the application of this doctrine will in no way endanger the validity of any grant, but will save much time and needless argument.

In conclusion, I leave with you, therefore, this suggestion:

If this great and ever-increasing quantity of work is to be carried on at all, if there is not to be such an accumulation of pending applications as will cause the whole examining system to fall of its own weight, there must be a greater uniformity of practice on the part of the various Examiners, there must be fewer needless objections, fewer needless rejections, better first searches, more carefully considered actions, both on the part of the Examiners and on the part of the applicants as well, and a more prompt conclusion of the pendency of cases before the corps.

By Wm. A. Kinnan, Examiner, Division Sixteen.

Rule 69. Request for Reconsideration.

In order to be entitled to the reexamination or reconsideration provided for in Rules 65 and 67 the applicant must make request therefor in writing, and he must distinctly and specifically point out the sup-

posed errors in the examiner's action; the applicant must respond to every ground of objection and rejection of the prior office action except as provided in Rule 64, and the applicant's action must appear throughout to be a *bona fide* attempt to advance the case to final action. The mere allegation that the examiner has erred will not be received as a proper reason for such reexamination or reconsideration.

CONSTRUCTIONS.

See notes to Rule 68.

A broadening of the claims without explanation is improper, if the Examiner objects to the multiplicity of claims this should be replied to.

Creviling, 197 O. G. 779.

Amendment by telegram confirmed by letter is proper.

Whear, 197 O. G. 534.

A petition to set aside a final rejection dismissed as premature where no request had been made of the Primary Examiner to withdraw that rejection.

Lawton, 172 O. G. 259.

The claims rejected on three references, one claim withdrawn. The other claim rejected on two of said references. Good final rejection.

Guitry, 162 O. G. 537.

It is not sufficient that applicant distinguishes his device from one of the references it must be from all.

Inman, 160 O. G. 1038.

If applicant does not consider all the references cited and point out where in his opinion the references do not apply the action is not responsive and the case is abandoned.

Sachs, 157 O. G. 755.

Applicant was entitled to have the claims considered and the reasons of rejection fully stated and such action should now be taken.

Pledger, Jr., and Campbell, 157 O. G. 486.

In *Ex parte Perry* the practice was condemned of repeatedly filing amendments in the hope of wearing the Examiner into allowing a claim upon the ground that because of its specific character it can do no harm.

Pledger, Jr., and Campbell, 157 O. G. 486.

It is clear that a mere request for a reconsideration is useless unless accompanied by some statement or argument which

controverts rulings made by the Examiner or throw light upon the facts of the case.

Einstein, 121 O. G. 1675.

A mere request for a reconsideration is not sufficient.

Ruthinburg, 121 O. G. 337.

The applicant must give reasons why he thinks the Examiner erred, for lack of which reasons the case may be held to be abandoned.

Linde, 115 O. G. 1329.

The questions have not been presented for reconsideration with the specification of errors as required by the rules and without a request for a reconsideration applicant is not entitled to have the matter reviewed.

Gally, 115 O. G. 802.

Action must be responsive.

Parkes, 113 O. G. 2213.

It is not inconsistent with section 4903 to require applicant to give his reasons for requesting a reconsideration.

Alton, 113 O. G. 1968-1969.

Where applicant made a slight amendment to one of the claims and discussed various references it was properly construed by the Examiner as a request for a reconsideration.

Leilich, 108 O. G. 561.

A communication from applicant saying "Such action as will permit appeal is requested" is not a compliance with this rule.

Lewis, 108 O. G. 559.

The applicant is required to state why he thinks the Examiner has erred.

Tyson, 1902 C. D. 476, 101 O. G. 3105.

Must point out the supposed error in Examiner's action.

Shone, 99 O. G. 863.

Last clause reaffirmed.

McKnight, 1901 C. D. 238, 97 O. G. 2742.

The burden of proof is upon applicant to establish by proof which is clear and conclusive the patentability of the invention as claimed (this is a case of a bill in equity).

Durham v. Seymour, Com., 71 O. G. 457.

Where applicant claimed a method of transmitting speech by intermittent impulses he must show: First, that his apparatus makes and breaks contact; second, that this action causes the articulate speech.

Barney, 1890 C. D. 171.

See also,

Krejci, 121 O. G. 1011.

Rule 70. Amendments to Correspond to Original Drawing or Specification.

In original applications all amendments of the drawings or specifications, and all additions thereto, must conform to at least one of them as it was at the time of the filing of the application. Matter not found in either, involving a departure from the original invention, can not be added to the application even though supported by a supplemental oath, and can be shown or claimed only in a separate application.

HISTORY.

Rule 35 of 1869 reads in part as follows: "All amendments of the model, drawings, or specification, must conform to at least one of them as they were at the time of the filing of the application."

In 1870 the words "in the case of original applications" were added after "specification."

In 1871, Rule 32 read in part as follows: "All amendments of the model, drawings, or specification, in the case of original applications which are capable of illustration by drawing or model, must conform to at least one of them as they were at the time of the filing of the application, further changes than this can only be made by filing a new application. If the invention does not admit of illustration by drawing, amendment of the specification may be made upon proof satisfactory to the Commissioner that the proposed amendment is a part of the original invention."

In 1873, the words "involving a departure from the original invention" were inserted after "further changes than this."

In 1879, Rule 69 read substantially as present Rule 70, except that substantially the last sentence of the previous rule was retained, with the addition of the words "or model" after "drawing" and the clause "the affidavits prescribed in Rule 47 may or may not be sufficient" was added. The affidavits referred to were "supplemental oaths."

The present rule was made in 1892.

See notes to Rules 66, 68 and 69.

CONSTRUCTIONS.

We do not see that the plaintiff is bound to find in his original claims one which is substantially the same as his amended claim, if his original application did cover his amended claim in the sense that it included that claim and more.

Motion Picture Co. v. Colehoff Co., 248 Fed. 229.

If rejected for new matter the new matter should be definitely pointed out.

Ferguson, 229 O. G. 939.

An applicant may amend to make his case correspond with the one of which it is a division.

Ayers, 220 O. G. 1375.

In determining whether matter introduced by way of amendment is new matter the original drawings are to be understood with such variations in form, shape, and proportions as common sense and mechanical skill in that art would suggest (on the verge).

Mine & Smelter Supply Co. v. Braeckel Concentrator Co., 197 Fed. 897.

An elaborate discussion of this subject matter is included in

Mine & Smelter Supply Co. v. Braeckel Concentrator Co., 197 Fed. 897.

The additional matter in the second was a mere amplification of the disclosure of the first.

Clark Blade & Razor Co. v. Gillette Razor Co., 194 Fed. 421. and

The cases of Orewiler, 170 O. G. 481 and Hilliker, 183 O. G. 1035, were not intended to apply to cases in which applicant filed his own case and afterward employed an attorney such as here are in question. The substitute specification and drawing should be received and considered.

Clifford, 193 O. G. 511.

Rejected for want of operativeness on amendment because of new matter reviewable on appeal and not by petition.

Thomas, 191 O. G. 832.

The fact that an amendment contains new matter is no reason for refusing to enter it. It should be entered a requirement made to eliminate new matter and any claims based thereon rejected.

Meyers, 184 O. G. 802.

This holding which is in substance that the disclosure as it stands is insufficient to support the claims, but that it may

be amended in such a way that it will support them is clearly inconsistent.

Seacombe v. Burks, 1912 C. D. 270, 182 O. G. 974.

Claims to apparatus and product may apparently be introduced into a method apparatus.

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

An applicant can not insert matter from an abandoned case.

Hagey, 173 O. G. 1081.

A claim may afford the basis for an amendment of the drawing.

160 O. G. 775.

Question of new matter appealable to the Examiners-in-Chief.

Fadern and Berman, 155 O. G. 553.

An applicant permitted to change his application from a design to an article of manufacture where it is shown that this was the original intention of the applicant.

Saunders, Jr., 131 O. G. 1164.

The statement in the original specification that the cutter 20 is secured to the leg of the landside by a pivot or bolt, when taken in connection with the statement in claim 5 that the cutter is adjustable is believed to constitute a sufficient disclosure of the adjustable feature of this invention to warrant amendment to the drawing showing an ordinary means for adjusting said cutter.

Sylevestersen, 129 O. G. 3160.

As there is no suggestion in the application relative to the omission of this part, a claim specifying a mode of operation that can be secured only when said part is omitted constitutes new matter.

Scott v. Southgate, 1906 C. D. 491, 125 O. G. 1703.

A drawing showing the tool-shank in any other form than that originally shown inadmissible although such form might also result from a twisting operation.

Freund, 1905 C. D. 477, 119 O. G. 651.

Where a claim, inserted by amendment, includes matter not originally disclosed, held that if the change from the original is an obvious one which would occur to any one it is not patentable, and if it is not obvious it constitutes new matter.

Scott, 1905 C. D. 665, 117 O. G. 278.

Applicant is not permitted at any time to introduce new matter into his application and obtain therefor a date as of the date of the original application.

It is the duty of the Commissioner of Patents to reject

all claims, a basis for which is not found in the application as originally filed.

Dilg, 1905 C. D. 620, 115 O. G. 1067.

Mere clerical or draftsman's errors may be corrected where the errors are clear from the application itself; but changes can not be made in the application based upon allegations of fact not shown by the record. Not even to make the device disclosed operative.

Willits, 1905 C. D. 107, 115 O. G. 1064.

Mere clerical or draftsman's errors may be corrected where the errors are clear from the application itself; but changes can not be made in the application based upon allegations of fact not shown by the record; not even to make the device disclosed operative.

Willets, 115 O. G. 1064.

May not amend to claim a species not originally claimed.

Lillie, 1905 C. D. 15, 114 O. G. 541.

The contention that applicant has the right to amend the original disclosure by the addition thereto of a specific structure if the same is not new, and falls within the scope of general statements in the original specification is fallacious as (e. g.) the patentability of combination claims drawn to include the added parts would be independent of the novelty of these parts.

Scott, 1904 C. D. 4, 114 O. G. 260.

The description of a specific form briefly referred to in the original specification may not be inserted.

Mothes, 1900 C. D. 500, 113 O. G. 1146.

In *Luger v. Browning*, 10 O. G. 1123, it was held that when new matter is introduced into an application it can not be allowed to dominate previous claims of another applicant; but when matter has been disclosed, but not claimed, it is proper to include it in claims, and they may take precedence over previous claims of another applicant.

Galley v. Brand, 1904 C. D. 488, 113 O. G. 851.

While the omission of elements in some cases may involve new matter the omission of unnecessary elements does not.

Smith & Hoyland, 1900 C. D. 176, 93 O. G. 939.

The strips should be placed at right angles to their present position. The device as now illustrated is inoperative, and it seems obvious that the defects in the illustration are such as could only have occurred through a clerical error in making the drawing. Amendment permitted.

Bailey, 1898 C. D. 16, 82 O. G. 894.

The objection to new matter can not be avoided by changing the date of filing to that of the proposed amendment.

Kinney, 1904 C. D. 240, 110 O. G. 2235.

A rejection on the ground that the amendment involves new matter, appealable to the Examiner-in-Chief, and the question should be determined before discussing the question of cancellation of the matter.

Schmidt, 1904 C. D. 165, 110 O. G. 603.

Applicant may not insert a third specific form of the invention which was not in the papers as originally filed.

Butcher, 1904 C. D. 60, 108 O. G. 1588.

A change from a sole to a joint application can only be made by a new application.

Gordon, 1904 C. D. 20, 108 O. G. 561.

Matter can not be read into a case or inserted by way of amendment merely because it was invented before the application was filed and was intended to be included.

Dow v. Converse, 1903 C. D. 404, 106 O. G. 2291.

An applicant is not entitled to shift his ground from the article to the process, whether or not both inventions were disclosed originally.

Christensen, 1903 C. D. 256, 105 O. G. 1261.

When an amendment is filed which in the judgment of the Examiner substantially varies the scope of the application as originally filed and necessitates a change in the drawings, the amendment should be entered and rejected on the ground of new matter and for all other reasons which bar its patentability.

The drawing should not be changed until question is settled.

Luber, 1894 C. D. 47, 67 O. G. 529; Furness, 1903 C. D. 174, 104 O. G. 1655.

Where the parts described will not operate as stated and it appears from the whole case that through a clerical error the parts were misnamed, an amendment correcting the error and adding a new figure to the drawing permitted.

Larson, 1902 C. D. 452, 101 O. G. 2568.

Where applicant showed and described two forms of the invention and his claims were broad enough to cover both forms, held that he was entitled to claim a specific form. "The original claims and description included both forms of the invention. The claims did not include one form to the exclusion of the other. Distinguished from Heaton, 15 O. G. 1054.

Plimpton, 1902 C. D. 452, 101 O. G. 2567.

A claim was made for a washing machine and a combina-

tion of such machine with a particular kind of hinge. These were rejected. Applicant was not permitted to insert a claim to the hinge alone, it being a differently classified invention.

Swantusch, 1902 C. D. 377, 101 O. G. 1129.

Two parts originally jointed together, amendment stating that they are practically integral; new matter. Where an element performs several functions the statement that it has only one function is inaccurate and involves new matter.

Kieffer, 1902 C. D. 360, 101 O. G. 449.

If the Examiner considers the matter sought to be introduced by amendment to be a departure from the original he should reject the application for this reason, from such a rejection appeal lies to the Examiners-in-Chief.

Keith, 1901 C. D. 155, 97 O. G. 551; Howlett, 1902 C. D. 338, 100 O. G. 2775.

Where the applicant is dissatisfied with the original disclosure and desires to take out the patent based upon another disclosure which he considers a better mode of applying the principle of the invention, the proper course to pursue is to file a new application. This discrepancy can not be cured by amendment.

Heogh, 1902 C. D. 254, 100 O. G. 453.

Matter in the specifications sufficient to found a new claim on.

Silverman v. Hendrickson, 1902 C. D. 123, 99 O. G. 446.

If to make the device operative requires a radical change in the construction shown and in the description thereof, such change can not be made. If the device is operative, though not to the degree of perfection desirable, it can not be changed to a preferable form.

Clay, 1901 C. D. 256, 97 O. G. 2980.

Where a connection between parts was suggested in the specification, but none shown in the drawing, a form of connection may be shown but he must file a proper supplemental oath.

Wareham, 1901 C. D. 204, 97 O. G. 1600.

May change form of claim (from one statutory class to another) by consent of Examiner before appeal or on recommendation of Board after appeal.

Travette, 1901 C. D. 170, 97 O. G. 1176.

If an amendment is presented which in the opinion of the Examiner involves new matter, he should enter the same and then reject the claims so presented for want of identity with the original invention.

Keith, 1901 C. D. 155, 97 O. G. 551.

If to make the device operative requires a radical change in the construction shown and in the description thereof, such change can not be made if the device is operative, though not to the degree of perfection desirable, it can not be changed to a preferable form.

Clay, 1901 C. D. 256, 97 O. G. 298.

If the omission of a part changes the mode of operation the amendment is within the prohibition of this rule.

Cook, 1900 C. D. 19, 95 O. G. 585.

An illustration which amounts to no more than a suggestion is not sufficient warrant for a claim filed nearly two years after the application and nine days after an interfering patent.

Dewey v. Colby, 1896 C. D. 12, 75 O. G. 1360.

A drawing may not be amended to correspond with a model not a part of the record of the case.

Austin, 1891 C. D. 127, 67 O. G. 1059.

If the idea of constructing an apparatus without the flushing chamber had occurred to B, he would have set forth such construction in one of the figures of the drawing, because the omission of the flushing chamber would have promoted both cheapness and simplicity.

Huber v. N. O. Nelson Mfg. Co., 63 O. G. 311.

The question raised upon an amendment sought to be introduced into a pending application is not whether the applicant's invention of its subject matter dates back to the filing of his original application, but whether such subject matter is itself new so far as it relates to said pending application.

Burson, 1892 C. D. 53, 58 O. G. 1414.

Where a proposed amendment embodied a substitute claim and descriptive matter relation to the subject matter of such claims, the amendment should be entered, and if, in the opinion of the Examiner, it included matter not disclosed by the application as originally filed the claim should be rejected.

Harvey, 1892 C. D. 47, 58 O. G. 1257.

Where an application as filed discloses an apparatus and also a patentable process and the relation between them is such that they could be joined in one application, and the apparatus only is embraced in the statement of invention, and claims as originally presented, claims for the process may be subsequently incorporated, if seasonably presented and supported by a supplemental oath.

Perkins, 1891 C. D. 63, 55 O. G. 139.

Amendments can not be made to correspond with a model that was never filed in the case.

Rissner, 1890 C. D. 164, 53 O. G. 919.

The unauthorized addition of new figures to the drawings is a violation of the rules.

Burt, 1889 C. D. 251, 49 O. G. 1986.

Cases passing on the subject matter of this rule:

Rolin v. Slingluff, 182 O. G. 975; Kilbourn v. Hirner, 128 O. G. 1689; Ernest, 1896 C. D. 33, 76 O. G. 1417; Robinson, 1902 C. D. 433, 101 O. G. 2080; Dilg, 1904 C. D. 463, 113 O. G. 547; Grinnell v. Buel, 1899 C. D. 235, 89 O. G. 1863; Hulett v. Long, 1899 C. D. 446, 89 O. G. 1141; Snyder, Ex parte, 1882 C. D. 22, 22 O. G. 1975; Nicholin & Ochsenreiter, 1891 C. D. 155, 56 O. G. 1565; Smith, 1892 C. D. 70, 58 O. G. 184.

See Luberger v. Dodge, 1905 C. D. 603, 114 O. G. 2382.

Rule 71. Inaccuracies or Prolivity.

The specification and drawing must be amended and revised when required, to correct inaccuracies of description or unnecessary prolixity, and to secure correspondence between the claim, the specification, and the drawing. But no change in the drawing may be made except by written permission of the office and after a photographic copy of the drawing as originally presented has been filed.

HISTORY.

Rule 39 of 1869 reads: "The specification, especially if the claim be amended, will be subject to examination and revision by the Examiner, for the purpose of correcting inaccuracies of language or unnecessary prolixity, and of securing correspondence between the description of the invention and the claim."

Rule 36 of 1870 reads: "The specification, especially if the claim be amended, must be amended and revised, if required by the Examiner, for the purpose of correcting inaccuracies of language or unnecessary prolixity, and of securing correspondence between the description of the invention and the claim."

"Mere errors of orthography or of grammatical construction will be corrected by the Examiner in charge" was added to the rule in 1871, and in 1873 the words "statement and" inserted after "between the" and before "description."

Rule 70 of 1879 reads: "The specification must be amended

and revised, when required, for the purpose of correcting inaccuracies of description or unnecessary prolixity, and of securing correspondence between the claim and the other parts of the specification."

In 1888 the words "and drawing" were inserted after "specification" in the first line, and "the claim, the specification and the drawing" substituted for "other parts of the specification." The present rule in the revision of June 18, 1897.

Rule 72. Specification not to be Returned.

After the completion of the application the office will not return the specification for any purpose whatever. If applicants have not preserved copies of the papers which they wish to amend, the office will furnish them on the usual terms.

The drawing may be withdrawn only for such corrections as can not be made by the office; but a drawing can not be withdrawn unless a photographic copy has been filed and accepted by the examiner as a part of the application. Permissible changes in the construction shown in any drawing may be made only by the office and after an approved photographic copy has been filed. Sketches filed to show proposed changes in construction must be in permanent ink. (Amendment of April 17, 1919.) Substitute drawings will not be admitted in any case unless required by the office.

HISTORY.

Rule 40 of 1869 reads: "The Office will not return specifications for amendment; and in no case will any person be allowed to take any papers, drawings, models, or samples from the Office. If applicants have not preserved copies of such papers as they wish to amend, the Office will furnish them on the usual terms."

The sentence between the semicolon and period does not appear in the rule in 1878.

In 1879, Rule 71 read: "After the completion of the application the Office will not return the specification for any purpose whatever. The model or drawing (but not both at the

same time), may be withdrawn for correction. If applicants have not preserved copies of such papers as they wish to amend, the Office will furnish them on the usual terms."

In 1883 there is a footnote which reads: "Note—Drawings will in no instance be returned to an applicant or his authorized agent unless a model has been filed and accepted by the Examiner as a part of the application."

In 1888, Rule 72 read: "After the completion of the application the Office will not return the specification for any purpose whatever. If applicants have not preserved copies of the papers which they wish to amend, the Office will furnish them on the usual terms.

"The model or drawing, but not both at the same time, may be withdrawn for correction. But a drawing can not be withdrawn unless a model has been filed and accepted by the Examiner as a part of the application."

The words "or photograph copy of the drawing" added 1907. Present rule 1908.

CONSTRUCTIONS.

A substitute drawing refused admission where it appeared that the original could be corrected to embody all that was sought to be introduced into the substitute.

Conner and Pearson, 193 O. G. 753.

The rules and practice of the Patent Office do not permit the return of a complete application or the transfer of parts thereof to a new and different application.

Giles, 190 O. G. 547.

A photographic copy of the original drawing should be filed where a change is made in any of the original sheets, whether by amendment of a figure or addition of a new figure.

Campbell, 1905 C. D. 196, 116 O. G. 1452.

A photographic copy of the drawing must be filed before altering the signature thereon.

Hanson, 114 O. G. 2381.

The applicant should file a blue print of the original drawing and indicate either on this print or by means of a sketch the change on the original drawing which it is desired to make. The blue print and sketch should then be filed, accompanied by a written request for permission to alter the drawing.

Zwibel, 1904 C. D. 198, 110 O. G. 1428.

"It is the settled practice of the Patent Office to refuse to return any of the papers of a complete application, that is, an

application which comprises all necessary papers properly executed and on which the filing fee has been paid.

Applications which do not comprise all papers necessary to a complete application properly executed may be returned where their return is necessary in order to enable the applicant to complete the papers, and this may be done whether the filing fee has been paid or not."

Van Etten, 1897 C. D. 68, 80 O. G. 1760.

Doubtful if any papers that have been received and stamped may be returned. If so, stamp should be erased.

Van Etten, 1897 C. D. 68, 80 O. G. 1760.

Rule 73. Amendments must be Specific.

In every amendment the exact word or words to be stricken out or inserted in the application must be specified and the precise point indicated where the erasure or insertion is to be made. All such amendments must be on sheets of paper separate from the papers previously filed, and written on but one side of the paper. Erasures, additions, insertions, or mutilations of the papers and records must not be made by the applicant.

Amendments and papers requiring the signature of the applicant must also, in case of assignment of an undivided part of the invention, be signed by the assignee. (Rules 6, 107.)

HISTORY.

In 1869, Rule 35 read in part as follows: "And all amendments of specifications or claims must be made on separate sheets of paper from the original, and must be filed in the manner above directed. Even when the amendment consists in striking out a portion of the specification, or other paper, the same course should be observed. No erasure must be made. The papers must remain forever as they were when filed, so that a true history of all that has been done in the case may be gathered from them."

In 1870 "by the applicant" was inserted after "erasure" and the following matter added to the rule:

"In every case of amendment the exact word or words to be

stricken out or inserted should be clearly specified, and the precise point indicated where any insertion is to be made."

The present rule in 1888, except that instead of "additions, insertions, or" in the last sentence of the first paragraph there was the word "and."

Rule 74. Specification Rewritten.

When an amendatory clause is amended it must be wholly rewritten, so that no interlineation or erasure shall appear in the clause as finally amended, when the application is passed to issue. If the number or nature of the amendments shall render it otherwise difficult to consider the case, or to arrange the papers for printing or copying, the examiner may require the entire specification to be rewritten.

HISTORY.

This is Rule 73 of 1879.

CONSTRUCTIONS.

The specification may not be arbitrarily rewritten by an applicant.

Hilliker, 183 O. G. 1035; see Oreweiler, 170 O. G. 1067; Henrick, 191 O. G. 1067.

A substitute specification will not be admitted unless requested by the Office.

Orewiler, 170 O. G. 481.

Neglect of the requirement of this rule held not to cause abandonment.

Gaylord, 117 O. G. 2366.

If it is desired to restore a claim previously canceled, the claim must be rewritten, it is not sufficient to refer to it as "the original language."

Mumler, 1883 C. D. 62, 24 O. G. 1090.

Case which passes on the subject matter of this rule.

Gally, 1903 C. D. 480, 107 O. G. 1661.

Rule 75. Patents Showing but not Claiming Invention.

When an original or reissue application is rejected on reference to an expired or unexpired domestic

patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention in this country before the filing of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, and shall also make oath that he does not know and does not believe that the invention has been in public use or on sale in this country, or patented or described in a printed publication in this or any foreign country for more than two years prior to his application, and that he has never abandoned the invention, then the patent or publication cited shall not bar the grant of a patent to the applicant, unless the date of such patent or printed publication be more than two years prior to the date on which application was filed in this country.

HISTORY.

Substantially this rule introduced, as Rule 74, in 1879. The concluding clause, "except upon interference as provided in Rule 94," of the 1879 rule was omitted in 1886, "in this country" was inserted after "completion of the invention" in 1888 and the wording "before the filing of the application for the domestic patent" was changed to "before the filing of the application upon which the domestic patent issued."

The wording of the present rule appears in 1899.

Oath to be submitted to Law Examiner Order 2,255, 227 O. G. 1.

Since May 18, 1916, oaths forming part of applications for reissue, and affidavits filed under the provisions of Rule 75 for the purpose of carrying the applicant's date of invention back of a cited reference, have been referred to and passed upon by a law examiner.

As to the affidavits under Rule 75, it became clear at once from the character of the affidavits submitted and the arguments presented by counsel that the practice under this rule had been very different in the various divisions of the Office. The essentials of affidavits under Rule 75 are set forth in a

harmonious line of Commissioner's decisions reaching back 35 years (*Ex parte Gasser*, 1880; *Ex parte Saunders*, 1883; *Ex parte Donovan*, 1890; *Ex parte McElroy*, 1909). In passing upon the affidavits referred under this order it has been the purpose to enforce the rulings in these decisions as to essential requirements, but with an eye to the substance of the matter rather than a strict adherence to form or manner of statement.

Commissioner Report, 1916.

CONSTRUCTIONS.

Discussion of rule.

Thomas, 251 O. G. 850.

The acquiescence of an applicant in a rejection on references precludes him from carrying his date of invention back of such references in a suit.

Milber v. School District of Pittsburg, 243 F. R. 196.

A very full discussion of this rule by Com. Newton Thomas, 251 O. G. 850.

As to showing diligence. Question raised but not decided on petition. The question is appealable to the Board.

Hamby, 182 O. G. 511.

If applicant relies upon a foreign application he must furnish a copy of the original application, certified to by the country in which it was filed.

Burlnells, 179 O. G. 574.

Affidavits should so describe the device relied upon to show the completion of the invention, either verbally or by sketches, that the Office can of itself determine whether the device so constructed constitutes the completion of the invention at the date upon which it is alleged to have been made.

Romunder, 157 O. G. 209.

Affidavits under Rule 75 will not be accepted after the claims have been finally rejected in the absence of good and sufficient showing duly verified why such affidavits were not earlier presented. (*Berg*, 120 O. G. 903.)

Romunder, 157 O. G. 209.

Apparently an affidavit under this rule should contain a showing of diligence in completing the invention.

McElroy, 140 O. G. 1207.

It is the practice of the Office to accept testimony taken in an interference in lieu of an affidavit (*Homan*, 117 O. G. 2088). But an excerpt of the interference testimony relied upon, should apparently be filed.

Newman, 135 O. G. 1122.

Copy of affidavit refused a party to an interference.

U. S. Standard Voting Machine Co., 130 O. G. 1486.

A party in an interference proceeding is not entitled to see affidavits filed under this rule.

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

After a claim has been finally rejected on several references an antedating affidavit under Rule 75 tending to overcome one of the references can not be admitted.

Berg, 1905 C. D. 36, 120 O. G. 903.

A question of whether ones own patent may be avoided as a reference by affidavits under this rule is appealable to the Examiners-in-Chief.

Marsteller, 1905 C. D. 431, 118 O. G. 2250.

Where an interference is declared, it is the practice of the Office to seal up affidavits filed under Rule 75 during the ex parte prosecution of a case.

Kinsman v. Kintner, 1905 C. D. 363, 118 O. G. 837.

If applicant specifically points out what portion of the evidence in an interference proceeding he wants considered this may be used in lieu of an affidavit under this rule. The decision in the interference need only be followed when the decision indicates a finding that the applicant is not entitled to an earlier date of invention than those found.

Homan, 1905 C. D. 288, 117 O. G. 2088.

The question of the sufficiency of affidavit is appealable to the Examiners-in-Chief.

Nordstrom, 1905 C. D. 114, 115 O. G. 1327.

A preliminary statement held equivalent to an affidavit under this rule. (See notes to Rule 110.)

Forsyth v. Richards, 1905 C. D. 115, 115 O. G. 1327.

The Primary Examiner rejected the claims on several patents cited as references, the Examiners-in-Chief overruled the Primary Examiner as to all the references except one, a petition to reopen the case before the Primary Examiner to permit the filing of an affidavit under this rule granted.

Parrish, 1905 C. D. 113, 115 O. G. 1327.

One can not overcome a patent granted to himself in this way.

Hallowell, 1903 C. D. 268, 105 O. G. 1533.

Rule 75 says that when the inventor makes the affidavit no further proof is necessary. (Johnson, 89 O. G. 1341.) In the absence of such affidavit the question of the amount of proof which will be regarded as sufficient is a matter for the judgment of the tribunal having jurisdiction of the question."

Where the affidavit of the inventor can not be obtained, the affidavit of the assignee or other party may be received.

Foster, 1903 C. D. 123, 105 O. G. 261.

These affidavits are not open to inspection either by the public or by parties in interference. Before the files are exhibited to parties to an interference the affidavit must be either removed or sealed up.

Gasser, 1880 C. D. 94, 17 O. G. 507; Davis v. Ocumpaugh v. Garrett, 1903 C. D. 130, 103 O. G. 1679.

Rule 75 is not inconsistent with law. The affidavit presented referring to inventions abroad are incompetent to show invention in this country prior to the date of the references.

Grosselin, 1901 C. D. 248, 97 O. G. 2980.

If there is a patent and an application the patent containing claims which interfere, the affidavit under Rule 75 may be postponed until after the interference.

Sorrle, 1900 C. D. 42, 90 O. G. 2133.

An affidavit under this rule disclosing the contents of a caveat in part may be placed in the confidential archives on request.

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

An affidavit required if a patent be issued upon one of two applications pending at the same time, upon the prior application, the patent containing no claim to the invention.

Sorrle, 1900 C. D. 42, 90 O. G. 2133.

If, however, the Examiner believes that the applicant's affidavit is fraudulent and so charges, the applicant would be given leave to file corroborative affidavits.

Hurlbut, 1890 C. D. 135, 52 O. G. 1062; Johnson, 1899 C. D. 212, 89 O. G. 1341.

The affidavit of others than the applicant can not be required.

Hurlbut, 1890 C. D. 135, 52 O. G. 1063; Johnson, 1899 C. D. 212, 89 O. G. 1341.

Sufficiency appealable to Examiners-in-Chief, cumulative evidence required appealable to Commissioner, also as to producing original drawing or structure. Latter requirement is within the discretion of the Examiner.

Ex parte Johnson, 1899 C. D. 212, 89 O. G. 1341.

Sufficiency of affidavit not appealable to Commissioner.

Schmirtz v. Appert, 1896 C. D. 95, 77 O. G. 1784.

Affidavit construed with a subsequent preliminary statement.

Schmirtz v. Appert, 1896 C. D. 95, 77 O. G. 1784.

What the affidavit should contain. An example of a too liberal construction of the language.

Schmirtz v. Appert, 1896 C. D. 95, 77 O. G. 1784.

A deposition taken in an interference proceeding admitted as an affidavit under this rule.

Keller, 1892 C. D. 238, 61 O. G. 1790.

"The rule says that the inventor's affidavit will be sufficient; but it does not say that the fact may not be established in some other way. For instance, if the testimony taken in an interference proceeding showed invention by the applicant before the patentee's date it is very clear that there is no necessity for the affidavit provided for in Rule 75.

Keller, 1892 C. D. 238, 61 O. G. 1790.

If the applicant rests his claim of invention upon drawings or devices made by him, he should produce such drawings or machines or furnish copies or representations of the same, in order that the Office may judge whether he in fact made the invention claimed in his application.

Saunders, 1883 C. D. 23, 23 O. G. 1224; Donovan, 1896 C. D. 109, 52 O. G. 309; Hansen v. Davis, 1891 C. D. 72, 55 O. G. 998; Hurlbut, 1890 C. D. 135, 52 O. G. 1062.

Where it was alleged that a drawing was made and disclosed to others previous to a certain date, held that the drawing should be filed but that the affidavits of such other persons need not be furnished.

Hurlbut, 1890 C. D. 135, 52 O. G. 1062.

No affidavit required where application was in the Office previous to that on which the patent was granted.

Bonna, 1890 C. D. 126, 52 O. G. 751.

The mere statement that he disclosed the invention is of no avail, either to constitute evidence of disclosure or to impart sufficiency to a statement of facts in themselves inadequate. What facts should be stated.

Donovan, 1890 C. D. 109, 52 O. G. 309.

An insufficient affidavit. Did not state facts.

Royer, 1889 C. D. 249, 49 O. G. 1985.

This interpretation of Rule 75 by Mr. Commissioner Paine (1879) is doubly valuable from the fact that the rule was made by him, and it is therefore to be presumed that he was fully advised as to its scope.

Hunter, 1889 C. D. 220, 49 O. G. 1043.

Where a patent had been issued to joint inventors and more than two years of public use had occurred before the filing of a separate application by one of the joint inventors, and the applicant in the joint application claimed to be the sole inventor of the device claimed in the joint patent, held that the

said public use was a bar to his obtaining a patent on his sole application.

MacLay, 1889 C. D. 220, 49 O. G. 1043.

Where an affidavit filed under Rule 75 showed that the applicant had conception of the invention prior to the dates of the references, but there was no complete reduction to practice until after said date, and also stated that he had "used every diligence possible in putting the invention into use" without setting forth facts tending to show such diligence. Held not to be a sufficient compliance with the rule.

Hunter, 1889 C. D. 218, 49 O. G. 733.

The applicant must state on oath facts showing either that a reduction to practice had been before the filing of the application on which the patent was granted, or that the invention had been conceived before that time and by due diligence connected with a subsequent reduction to practice.

The mere statement that the invention was made by applicant before that time is not sufficient and as that may be a matter of opinion.

Gasser, 1880 C. D. 94, 17 O. G. 507; Lanfrey, 1881 C. D. 39, 20 O. G. 892; Saunders, 1883 C. D. 23, 23 O. G. 1224.

These affidavits are not open to inspection either by the public or by parties in interference.

Gasser, 1880 C. D. 94, 17 O. G. 507.

Cases which pass on the subject matter of this rule.

Eddleblute, 1890 C. D. 124, 52 O. G. 124; Tournier, 1901 C. D. 306, 94 O. G. 2166; Byron v. Maxwell, 1903 C. D. 230, 105 O. G. 499; Card & Card, 1904 C. D. 383, 112 O. G. 499; McNeil, 1901 C. D. 313, 10 O. G. 1976; Annand v. Spalekhaver, 1901 C. D. 234, 97 O. G. 2741; Martin v. Goodrum v. Dyson v. Gully and Goodrum, 130 O. G. 1485.

Rule 76. Application Rejected on References Showing but not Claiming Invention, etc.

When an application is rejected on reference to an expired or unexpired domestic patent which shows or describes but does not claim the invention, or on reference to a foreign patent, or to a printed publication, or to facts within the personal knowledge of an employee of the office, set forth in an affidavit (when

requested) of such employee (Rule 66), or when rejected on the ground of public use or sale, or upon a mode or capability of operation attributed to a reference or because the alleged invention is held to be inoperative or frivolous or injurious to public health or morals, affidavits or depositions supporting or traversing these references or objections may be received, but affidavits will not be received in other cases without special permission of the Commissioner. (See Rule 138.)

HISTORY.

The last sentence of Rule 31 of 1873 reads: "Affidavits in support of applications will not be received at any stage of the examination, unless the Office denies that the device is operative."

In 1878 the words "or useful" were added.

The present rule was introduced in 1879, except in Rule 75 of that date, which rule is now 76, a request for the Examiner's affidavit was not required and there was not reference to "Rule 86," which provided for affidavits of employees of the Office and others traversing or confirming the applicant's affidavit in reissue cases. The parenthetical clause (when requested) and reference to Rules 66 and 140 (now 66 and 141) appear in 1888.

See paper read by Elonzo T. Morgan, Sept. 21, 1916, before the Examining Corp of U. S. Patent Office, entitled, Establishing Novelty by Affidavits.

CONSTRUCTIONS.

The Court of Appeals refused to review the decision of the Commissioner because there were no affidavits tending to establish patentability.

In re Merrill, 199 O. G. 619.

Affidavit should set forth facts other than appear on the face of the document discussed.

Chapman, 198 O. G. 237.

No evidence was taken nor were affidavits called for in the Patent Office. The statement of appellant in his application must be accepted as true.

Harbeck, 191 O. G. 586.

Had applicant so desired he could have filed rebutting affi-

davits under Rule 76 and the court would then have had the benefit of those affidavits and the comments thereon by the Patent Office tribunals.

In re Gold, 180 O. G. 606.

Affidavits as to public use only effective when there is doubt.

McElray, 161 O. G. 753.

In the present case there is no doubt that the appellant's font of type is ornamental in appearance, and the fact that it has gone into very extensive use, as shown by affidavits of record in this case, confirms in my mind the artistic value of the design.

Smith, 130 O. G. 1688.

"In addition there were affidavits showing the large sale of the patent in suit, and tending to show that no prior weeder had been a success."

Cooperating Merchants' Co. v. Hallock, 128 F. R. 596-598.

Affidavits explaining a mistake in an amendment considered where the question related to abandonment.

Richards, 1906 C. D. 321, 124 O. G. 627.

Affidavits and arguments presented as to operativeness.

Durvea & White v. Rice, Jr., 1906 C. D. 172, 122 O. G. 1395.

Affidavits going to show the practical success of the applicant's device where the truth thereof is substantially conceded are entitled to material weight in view of the fact that the grant of a patent confers no absolute right of property and in view of the customary rule of resolving ordinary doubts in favor of applicant.

Thompson, 1906 C. D. 566, 120 O. G. 2756.

The Examiner is not bound to accept the conclusion of affidavits filed to overcome a rejection on the ground of inoperativeness, nor is he compelled to cite references and authorities.

Davidson, 1905 C. D. 81, 120 O. G. 2753.

When the party fails to make his demonstration and to submit his evidence in response to the original rejection before prosecuting his case to final rejection the case will not be thereafter reopened except upon showing of good and sufficient reasons why the evidence whose admission is sought was not earlier presented.

Richmond, 1905 C. D. 41, 120 O. G. 905.

The affidavit of a party that his device was operative questionable in view of the fact that others were available and were not called. (Interference.)

Kelly v. Flynn, 1900 C. D. 339, 92 O. G. 1237.

Although met by the same substantial objection from the beginning the applicant made no effort to enlighten her contention through the aid of experts in the art.

In the absence of such enlightenment there arises in our own minds nothing beyond a mere conjecture that the appellant's claim may have attained the dignity of invention.

Beswick v. Com., 1900 C. D. 294, 91 O. G. 1436.

Decisions under old rules not thought to be applicable to the present rule.

Stone v. Greaves, 1880 C. D. 70, 83 O. G. 1805; Anson v. Woodbury, 1877 C. D. 49 and 1877 C. D. 4, 12 O. G. 1; Hedges v. Daniels, 1880 C. D. 64, 17 O. G. 394.

The affidavits filed at the hearing from different manufacturers giving their opinions and experiences in regard to the novelty of the invention and its utility, as well as its extensive adoption by the trade, have been carefully considered. It is true that where the patentability of a device is not clear extensive sales may resolve the doubt. This is, however, an unsafe criterion (authorities cited).

Flomerfelt, 1896 C. D. 59, 76 O. G. 2007.

The affidavits referred to include not only the special affidavits provided for by Rule 75, but all other affidavits supporting or traversing references or objections.

Grosselin, 1896 C. D. 39, 76 O. G. 1573.

The Examiner's action in holding that no testimony as to the operativeness of an invention would be sufficient to warrant the withdrawal of the objection to the granting of a patent unless confirmed by a personal inspection of the Examiner or his deputized assistant, not warranted by the rules.

Munn & Co., 1893 C. D. 48, 63 O. G. 153.

Pending applications not effected by others in interference.

Woodward, 1892 C. D. 62, 58 O. G. 1554.

Affidavits of mechanics tending to show that the description in an Eng. Prov. Sepec. was insufficient to enable one to make the device received, but the practice of filing such affidavits disapproved.

Taylor & Banks, 1872 C. D. 239, 2 O. G. 519; Webster v. Sanford, 1888 C. D. 92, 44 O. G. 567.

A special order made by the Commissioner and approved by the Secretary of the Interior permitting the filing of affidavits to prove that a mixture operated more effectually or rapidly and was more convenient in use than any of the substances of which it was compounded.

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

The rules now in force contain no provision for counter-affidavits on the question of the operativeness of these devices. Such affidavits can not therefore be received in this case.

Fuller v. Brush, 1879 C. D. 328, 16 O. G. 1188.

As to relative utility in respect to reference cited, as a claim to patentability.

Mosley, 1870 C. D. 53.

Affidavits which assert a decided superiority of operation over the devices cited certainly make a prima facie case of superior utility for applicant's device, and a decided difference in utility may well import a difference in principle.

Tuttle, 1870 C. D. 3.

Cases which pass on the subject matter of this rule:

Davis v. Ocumpaugh v. Garrett, 1903 C. D. 130, 103 O. G. 1679; Dickinson v. Thibodeau v. Hildreth, 1902 C. D. 202, 99 O. G. 2550.

Rule 77. Abandonment.

If an applicant neglect to prosecute his application for one year after the date when the last official notice of any action by the office was mailed to him, the application will be held to be abandoned, as set forth in Rule 171.

Suspensions will only be granted for good and sufficient cause, and for a reasonable time specified. Only one suspension may be granted by the primary examiner; any further suspension must be approved by the Commissioner.

Whenever action upon an application is suspended upon request of an applicant, and whenever an applicant has been called upon to put his application in condition for interference, the period of one year running against the application shall be considered as beginning at the date of the last official action preceding such actions.

Whenever, during a time when the United States is at war, publication of an invention by the granting of a patent might in the opinion of the Commissioner

be detrimental to the public safety or defense or might assist the enemy or endanger the successful prosecution of the war, he may suspend action on the application therefor.

As amended in July, 1914, see 239 O. G. 945.

Rev. Stat., sec. 4894.

HISTORY.

As to first paragraph see Rule 171.

Second paragraph, in 1888, read: "Whenever action upon an application is suspended upon request of an applicant, the period of two years running against such application shall be considered as beginning at the date of the last official action preceding such request.

Next to last paragraph added 1892.

Last paragraph added 1899.

The following paragraph added in 239 O. G. 945:

Whenever, at any time when the United States is at war, publication by the granting of a patent might, in the opinion of the Commissioner, be detrimental to the public safety or defense, or might assist the enemy or endanger the successful prosecution of the war, he may suspend the action on the application therefor.

CONSTRUCTIONS.

See notes to Rules 65, 66, 68, 69 and 171.

Any application pending more than five years to be reported to the Commissioner.

Order 2,107, 200 O. G. 1119; Order 2,095, 199 O. G. 1.

If an applicant is referred to this rule he should examine it.

Vesey, 195 O. G. 213.

Affidavit under Rule 75 filed and held insufficient and a new reference cited, argument as to sufficiency of affidavit. Final rejection premature.

Hamby, 183 O. G. 1031.

That claims under Rule 96 were not suggested is no excuse for failure to amend.

McRie, 130 O. G. 980.

That a case was inadvertently crossed off the attorney's docket not sufficient excuse where it appears that delay until near the close of the period was intended.

Duryea, 128 O. G. 1291.

A person has a perfect right to delay action until near the

end of the year but in so doing he risks a delay due to a mistake.

Grant, 128 O. G. 885.

Where the Examiner suspends action upon a case and fixes a definite period, as required by the rule, he should take the case up for action at the expiration of the time.

Herzog v. Wheeler, 1905 C. D. 216, 116 O. G. 2009.

Where after amendment of a case the Examiner writes suspending action to permit the applicant to file another amendment agreed upon at an oral interview and no further action is in the case for more than two years. Held that the case is abandoned, notwithstanding the fact that the Examiner made his suspension for the definite period of thirty days.

Herzog v. Wheeler, 1905 C. D. 216, 116 O. G. 2009;

Hunter, 1905 C. D. 199, 116 O. G. 1731.

The petition is not only objectionable in asking an indefinite suspension but requests suspension beyond the year in which action must be taken as required by statute. In such cases the Commissioner has no authority to grant the petition and it is therefore denied.

Whitney, 1904 C. D. 139, 109 O. G. 2442.

The Commissioner has no power during the time limited to grant an extension beyond the limit.

Bauercamper, 1902 C. D. 130, 99 O. G. 448.

The above case was where the Examiner held that the claims were identical with those of another application by the same applicant, which was involved in interference. The applicant has a right to appeal from such a ruling.

Ostergen v. Tripler, 1901 C. D. 350, 95 O. G. 838.

It is contrary to the well settled policy of the Office to suspend action on any application pending before it unless such suspension is absolutely necessary to determine the right of the applicant to a patent on that application.

Bullier, 1899 C. D. 155, 88 O. G. 1162.

Rule 78. Amendment after Notice of Allowance without Withdrawal from Issue.

Amendments after the notice of allowance of an application will not be permitted as a matter of right, but may be made, if the specification has not been printed, on the recommendation of the primary ex-

aminer, approved by the Commissioner, without withdrawing the case from issue. (See Rule 165.)

CONSTRUCTIONS.

The establishment of a proper line of division between this case and the other can be effected under the provisions of Rule 78 without withdrawal from issue.

Dyson, 233 O. G. 755.

The presumption is that applicant made as broad claims as he was entitled to make and a broadened claim requiring a reexamination will not be made under this rule.

Goldsmith & Whiting, 184 O. G. 553.

Amendment under this rule not a matter of right and will not be permitted when the Examiner reports the claim as not allowable.

Fleming, 126 O. G. 2590; Goldsmith & Whelting, 184 O. G. 553.

A specific claim allowed a successful party after interference upon a generic claim.

Van Yors, 170 O. G. 243.

If no sufficient reason why the claim was not previously presented is given and the Examiner is of the opinion that it is lacking in patentable novelty, its entry will be refused.

Langhaar, 159 O. G. 747.

Rule 78 does not provide for withdrawing cases from issue, but for the admission of amendments without withdrawing the case from issue. It is the well settled practice that where amendments are presented under Rule 78, containing claims which the Examiner recommends as patentable, such amendments will be entered, but that amendments presenting claims which the Primary Examiner holds are not patentable will not be entered.

Orndoff, 140 O. G. 100.

It is not necessary for the Examiner to give in detail his reasons for holding that the claims are unpatentable, and the rule does not provide for an indirect prosecution of the application.

Orndoff, 140 O. G. 1001.

The allowance was one day later than the receipt of the amendment, the allowance was therefore irregular. It should be withdrawn from issue (even if it should require a division).

Law, 111 O. G. 1038.

Where claims are sought to be inserted by amendment under the provision of Rule 78 in an allowed application it is

not necessary for the Examiner to state fully and in detail his reasons for reaching the conclusion that the claims are not patentable, as is necessary in the ordinary examination of a case. His action is merely in the nature of advice to the Commissioner upon which he can base his action in approving or disapproving the entry of the amendment.

Stone, 1902 C. D. 434, 101 O. G. 2080.

It is not the practice of the Office to permit the withdrawal of applications from issue for the purpose of further amendment except as provided by Rule 78.

Pierce, 1901 C. D. 224, 97 O. G. 2307.

Second clause. This allows broadening the claims in proper cases.

O'Connor, 1899 C. D. 446, 89 O. G. 1141.

Only where it is not necessary to reopen the case.

91 O. G. 1034; Woodward, 91 O. G. 1801.

Where an applicant has two applications in the Office disclosing different species of the same invention, each containing specific claims and one containing a claim broad enough to cover both species, and the one containing only specific claims has been allowed, a cross-reference disclaiming the subject matter of the broad claim may be inserted into the allowed case under Rule 78 without withdrawing it from issue.

Anderson, 1893 C. D. 51, 63 O. G. 463.

When such amendments affect the merits, they can not be made without withdrawing the case from issue upon a proper showing.

Cornelius, 1891 C. D. 124, 56 O. G. 929.

Amendment after allowance only permitted in cases where its refusal would work irreparable injury as to introduce claims that could not be patented in a separate application.

Myers, 1889 C. D. 198, 49 O. G. 131.

Subject of affidavits considered.

Steinmetz, 244 O. G. 363.

Cases which pass on the subject matter of this rule:

Meacham, 113 O. G. 1417; 94 O. G. 2169.

See Order No. 1365, 93 O. G. 557.

DESIGNS.

Rule 79. Design Patents, to Whom Granted.

A design patent may be obtained by any person who has invented any new, original, and ornamental

design for an article of manufacture, not known or used by others in this country before his invention thereof, and not patented or described in any printed publication in this or any foreign country before his invention thereof, or more than two years prior to his application, and not caused to be patented by him in a foreign country on an application filed more than four months before his application in this country, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, upon payment of the fees required by law and other due proceedings had, the same as in cases of inventions or discoveries.

Rev. Stat., secs. 4929 to 4933.

See *The Law of Patents for Designs*, by Wm. L. Symons.

CONSTRUCTIONS.

In this case the Circuit Court decided (182 F. 150), that a painting, if it possess artistic merit and be suitable, also, for use as a design may, at the owner's election, be protected either by copyright or by patent. On this broad question we express no opinion.

Louis De Jonge & Co. v. Brenker & Kessler Co., 191 F. R. 35.

The liability of one article being taken for the other.

Graff, Washbourne & Dunn v. Webster, 189 F. R. 905.

If the characteristics of the device relate to its mechanical function it is not patentable even if this mechanical function is to produce an appearance supposed to be beautiful.

Mygatt, 188 O. G. 1055.

The plain simplicity and beauty of the defendant's tomb is not due to anything found in the second claim of the patent. The patent is not for a design.

Tayntor Granite Co. v. Goelchius, 183 F. R. 130-131.

Where, as in the art of printing, the field of inventive design is limited to modifications of details in predetermined forms of letter and an inventor has succeeded in producing a new font having clearly distinguishing characteristics running through the whole and the esthetic value of the production is

confirmed by an extensive demand for the same, it is believed that he should be granted the right to a lawful monopoly of the results of his labors for the limited time provided by the design statutes.

Smith, 130 O. G. 1688.

It is not enough that the design should comprise features which would commend it to persons familiar with the art because of its functional value; it must possess an inherent beauty.

Bettendorf, 127 O. G. 848.

The application of mica flakes to the surface of insulating tubes.

The effect is one of design and can not be rightfully appropriated as a trade-mark any more than can the distinctive functioning features of a machine. The latter when new, useful and involving invention, are the legitimate subjects of mechanical patents. The former when new, ornamental and the result of invention are subjects of design patents.

American Circular Loom Co., 122 O. G. 1725.

Congress in enacting the patent statutes, relating as well to designs as to mechanisms, was not establishing a school of the fine arts and did not provide for juries of artists, or artistic experts, to pass upon the questions of originality and invention.

Schraubsladter, 120 O. G. 1168.

Where a font presents peculiarities in some of the letters, but these peculiarities do not bear such relation to the font as a whole as might distinguish novelty and invention in the font, even though such qualities could be predicated upon these peculiarities for the individual letters in which they appear and the letters display no common or pervading characteristic which might appeal either to the ordinary observer or to the trained expert as new and ornamental. The font is not patentable.

Scott v. Emmet & Hesolett, 116 O. G. 1184.

To apply to the W. & G. letters the wavy outline of the I letters is to provide them with the same effect of ornamentation that has been disclosed by I and in the same manner.

Schmohl, 115 O. G. 505.

Novelty and invention in designs.

Schmohl, 115 O. G. 505.

“The ground of rejection here is not aggregation, but lack of invention, by reason of the mere obviousness of the changes relied upon to distinguish over prior designs.”

Barnhart, 115 O. G. 247.

"It is to be noted that in designing his lamp the appellant has changed the form and arrangement of parts designed to perform mechanical functions; but it is also to be noted that the changes were made solely for the purpose of obtaining the new and ornamental appearance." Held patentable.

Gray, 114 O. G. 543.

The doctrine of genus and species does not apply to designs and there can be no modification of a design.

Schraubstadter, 1904 C. D., 110 O. G. 2015.

Change in form to conserve mechanical function not patentable as a design. Lack of invention. Movable parts.

Nickel & Crane, 1903 C. D., 109 O. G. 2441.

Substantial difference is required to render two several devices patentable as designs. The difference between patentable novelties in mechanical matters and patentable novelties in matters of design, results from the different nature of the two things. Detail is of little consequence in the latter; it may be all important in the former.

Freeman, 109 O. G. 1339.

So far as this design possesses any peculiarity of appearance, due to a configuration created and employed for the performance of a mechanical result, that is to say, by which it fits the place where it is to be used, such appearance must be eliminated from consideration of this subject as an ornamental design.

Kern, 1903 C. D., 105 O. G. 2061.

There is, in reference to a design, lack of invention in an aggregation of old parts.

Hanson, 1903 C. D., 105 O. G. 2058.

A design may properly be placed upon a device having mechanical utility; but the design itself is not founded upon such utility. The function of the design is to appeal to the esthetic taste, or to produce "pleasure or admiration in its contemplation."

Hartshorn, 1903 C. D., 104 O. G. 1395.

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations.

Blistein v. Donaldson Lithgph. Co., 102 O. G. 1553.

Movability of parts: The subject matter of patents must be definite and certain, and since designs relate solely to shape or configuration the subject matter must be of a fixed and definite shape. This is not possible in the case of a machine made up of movable parts whose change in position changes the appearance of the devices. It is probably because of this

fact that the design law was limited to articles of manufacture.

It has, however, never been the practice of the Office to require absolute immovability of the parts of an article.

Steck, 98 O. G. 229-231.

Useful: Our ideas of beauty are derived to a certain extent from our ideas of the fitness of things for the purpose for which they were designed, and therefore it is practically impossible to disassociate the ideas of beauty from that of use in all articles intended for mechanical use.

Steck, 1902 C. D. 9, 98 O. G. 228.

Must be an invention. Example of lack of invention.

Westinghouse Electric and Mfg. Co. v. Triumph Electric Co., 90 O. G. 603.

As to an APPEARANCE of having a certain mechanical construction.

Feder v. Poyet, 89 O. G. 1344.

A design as a whole should be of unchanging character and should not include movable parts, since the shape or configuration of a device is varied by varied positions of its elements.

Smith, 1897 C. D. 170, 81 O. G. 969.

Where applicant presents two distinct articles of manufacture, a cradle-supporting frame and a cradle-body, and claims them as such, held that the application should be restricted to one or the other of these two designs (cases cited).

Haggard, 1897 C. D. 47, 80 O. G. 1126.

A mechanical patent is no bar to a design patent for the same thing.

Lunken, 1896 C. D. 22, 76 O. G. 785.

The range or scope of a design patent is to be determined by the courts and not by the Patent Office.

Finck, 1892 C. D. 139, 60 O. G. 157.

As high a standard of originality is required for design patents as for any other class, and such originality goes to appearance or ornamentation rather than to utility.

Williams, Jr., 1892 C. D. 23, 58 O. G. 803.

Only one design may be protected by one patent.

Petzold, 1891 C. D. 207, 57 O. G. 1277.

The practice of allowing two or more forms to be included in a single design patent would result in confusion in the Office and ought not to be permitted.

Hess & Hess, 1891 C. D. 142, 56 O. G. 1334.

A dwelling-house is not a "manufacture" in the statutory sense, and a design for the exterior of a dwelling-house is not patentable.

Lewis, 1891 C. D. 61, 54 O. G. 1890.

Statutes first passed in 1842 used the word "useful" in connection with "patterns or prints or pictures, to be either worked into or worked on, etc." It has since been modified to the form here shown. Too much prominence was formerly given to the word "useful," the subject of invention so far as shape, form or configuration is concerned must be useful in the sense that it tends to promote pleasure, refinement, comfort, depending upon the sense of the beautiful. It must be useful in the sense that it must not be mischievous, or obscene in its tendency.

Schulze-Berge, 1888 C. D. 4, 42 O. G. 293; Parkinson, 71 C. D. 251.

A design patent relates to form or configuration and not to color or the material used. A patent might be granted for a combination of colors or material, but not a design patent. The distinction should be observed between design and other patents.

Traitel, 25 O. G. 783.

A previous mechanical patent is no bar to the grant of a patent to the patentee therein for a design shown in such patent.

Palmer, 21 O. G. 111; Burton v. Greenville, 80 C. D. 602.

If the design is new and original and also useful it is patentable as a design under the law whether it be or not ornamental or beautiful.

Shoeninger, 1878 C. D. 128, 15 O. G. 384; Bartholomew, 1869 C. D. 103; Fenno, 1871 C. D. 52; Crane, 1869 C. D. 7.

A previous design patent is no bar to the grant of a mechanical patent to the same applicant.

Bartholomew, 1871 C. D. 298; Collender, 1872 C. D. 217.

A design patent and a mechanical patent would not be granted on the same subject matter. But a design patent may be granted for the configuration and a mechanical patent for the construction.

Bartholomew, 1871 C. D. 298; Collender, 1872 C. D. 217.

There can be but little doubt that in the enumeration of subjects for design patents as contained in the statute, regard was had to the external ornamentation of articles of manufacture; and that to this end it was the intent of the law that the various designs should be so affixed to the manufactured articles or so wrought into their texture as to become in

effect a part of them. A trade-mark can not be patented as a design.

William Whyte, 71 C. D. 304.

See subject of design patents for a combination of colors discussed in Weinberg, 1871 C. D. 244. Produced in the statutes relating to designs means created.

Weinberg, 1871 C. D. 244.

The kind of material used and process of construction have nothing to do with the patentability of a design, a claim which stands only upon novelty of forms, and can not be strengthened by their introduction.

G. H. Sellers, 1870 C. D. 58.

Doctrine of genus and species as applied to designs discussed.

W. M. Bartholomew, 1869 C. D. 103.

Rule 80. Terms of Design Patents.

Patents for designs are granted for the term of three and one-half years, or for seven years, or for fourteen years, as the applicant may, in his application, elect.

Where the applicant requests that the patent issue for one of the shorter terms, he may, at any time before the allowance of the application, upon the payment of the additional fee, amend his application by requesting that the patent be issued for a longer term.

HISTORY.

Rev. Stat., sec. 4931.

Add to Rule 80 the following paragraph, where the applicant requests that the patent issue for one of the shorter terms, he may at any time before the allowance of the application upon the payment of the additional fee, amend the application by requesting that the patent be issued for a longer term.

Order No. 2,102, 200 O. G. 1.

CONSTRUCTIONS.

The election may be changed any time before allowance.

Forward, 196 O. G. 275.

Rule 81. Proceedings.

The proceedings in applications for patents for designs are substantially the same as in applications for other patents. Since a design patent gives to the patentee the exclusive right to make, use, and vend articles having the appearance of that disclosed, and since the appearance can be disclosed only by a picture of the article, the claim should be in the broadest form for the article as shown.

Rev. Stat., sec. 4933.

CONSTRUCTIONS.

A number of patents were introduced in evidence to show the prior state of the art. These do not show to the court such a universal knowledge of the features which the plaintiff's patent, No. 38,855, sought to protect as would require a limitation of the claim. While one or two of the letters or figures of the font may be similar to the like characters or character of the prior patents, a casual examination clearly demonstrates that as a whole there is such dissimilarity of configuration and ornamentation of the font described in patent No. 38,855 as involves patentable novelty.

Keystone Type Foundry v. Wynkoop, 239 F. R. 355.

The invention is not the article and is not the design *per se*, but is the design applied.

Cady, 232 O. G. 621.

The invention resides at least partly in the very act of adaptation to the article.

Cady, 232 O. G. 620.

The statute requires the applicant to specify some one article of manufacture to which he has applied the design, it seemingly can not be required that his patent be limited to one article.

Cady, 232 O. G. 620-621.

The applicant should state in his specification that his design is to be used as the figure of an enumerated number of articles.

Cady, 232 O. G. 679.

A disembodied design or mere picture is not the subject of patent and the specification must not so state.

Cady, 232 O. G. 621.

Applicant may state that his design is not to be limited to an article in three dimensions.

Cady, 232 O. G. 621.

Where applicant has shown the design applied to one article he has reduced it to practice and he may state other articles to which the design is to be applied if, and only if, the mode and effect of such application have been rendered obvious by the example given.

Cady, 232 O. G. 621.

A design patent gives no right to a name by which the design may become known.

Wilson v. Hecht, 216 O. G. 1319.

Block letters had been previously used, no invention in putting them in sets to be used by children.

Baker & Bennett Co. v. W. D. Case Co., 216 O. G. 1014.

May apply to things having movable parts.

Klemm & Schreiber, 218 O. G. 603, 1.

Mechanical advantages no bearing upon the question of the patentability of a design.

Sherman, 147 O. G. 237.

The St. Louis, Premier, and Shirly were exhibited side by side in the courtroom at the time of the argument. We thought then, and further examination convinces us, that defendant's radiator does not infringe. There is nearly as much difference between the Shirly and Premier as the Premier and St. Louis. Both patents may be treated as valid within narrow limits.

Am. Radiator Co. v. Shirly, etc., 199 Fed. 424.

It is evident that the mere fact that one device looks like another has no controlling effect in determining the validity of a design patent, because such patent does not operate as a trade-mark, nor involve considerations of unfair competition in business. Color constitutes no element of a design patent.

Star Bucket Pump Co. v. Butler Mfg. Co., 198 F. R. 863.

The ornamental design for leather or like material as shown is proper. The amendment cancelling "substantially" and substituting "or any colorable imitation thereof" disapproved.

Owen, 195 O. G. 1049.

We suppose it is true that a design which by mere merit attains quick and great popularity must have the grace of novelty; but a great popular demand which is stimulated and worked up by much money and ingenuity spent in advertising does not go far in suggesting the same attribute.

Phoenix Knitting Works v. Rich, 194 F. R. 716.

It seems somewhat absurd to claim such configuration as

part of an ornamental design which is only visible when the article to which it pertains is not in use.

Phoenix Knitting Works v. Hygenic, etc., 194 F. R. 699.

The practice of dispensing with a formal description referred to but not criticised.

Phoenix Knitting Works v. Hygenic, etc., 194 F. 699;

Phoenix Knitting Works v. Louer Bros., 194 F. 701.

Requirement of the elimination of the description disapproved.

Phoenix Knitting Works v. Rich, 194 F. R. 710.

There is no invention in aggregating separate designs.

Phoenix Knitting Works v. Hygenic, etc., 194 F. R. 699.

Surface ornamentation taken into account.

It is not clear what if any part shape and configuration may play as the basis for a design patent.

Phoenix Knitting Works v. Hygenic Co., 194 F. R. 699.

Where the seemingly unimportant variations in details produced an important general effect, there was invention and the design was patentable.

Weatherly, 191 O. G. 833.

Design patents no longer attempt to describe in literary parlance the effect of the ocular sensation conveyed by the drawings; and the court in the present instance must limit the scope of the complainant's design patent to the discovery or teaching shown in the patent, and must examine the exhibits.

Graff, Washbourne & Dunn v. Webster, 189 F. R. 905.

Suggestion of utility as an element of beauty.

Ashley v. Talum Co., 186 F. R. 339, pages 342-3.

As to description, see Cady, 232 O. G. 620 and 621, in connection with Ashley v. Talin Co., 186 F. R. 339.

Whether a painting possessing artistic merit, but suitable also for use as a design, may at the owner's election be protected either by copyright or by patent. I believe the question should be answered in the affirmative, but it can only be treated in one way.

Louis De Jonge Co. v. Brenker & Kessler Co., 182 Fed. 150.

A certain production held to be either copyrightable or patentable, but not both.

Louis De Jonge Co. v. Brenker & Kessler Co., 182 Fed. 150.

We can not find in the lower dome of his patent combined with a square base any useful function, although the com-

pleted structure may be more artistic and attractive; but that element would be the subject of a design patent.

Ashley v. Talum Co., 172 O. G. 262.

It is well settled that a design patent can be granted only upon a single shape or configuration, and not upon several, and that there is no distinction between generic and specific design patents as is recognized in mechanical patents (82 O. G. 1988; 83 O. G. 1994; 83 O. G. 1513; 110 O. G. 2015; 97 O. G. 1373; 113 O. G. 2215).

Lette, Jr., 160 O. G. 1272-3.

Mygatt, 121 O. G. 1676; Cheney Bros. v. Weinret, 157 O. G. 1002.

A design patent held not invalid for want of description in words.

Cheny Bros. v. Weinret & Weiner, 157 O. G. 1002.

Utility an argument in favor of a design.

In re Sherman, 154 O. G. 839.

Generally speaking the mere looks of things do not bear upon their novelty, except in case of a design patent.

Dayton Malleable Iron Co. v. Forster Waterbury & Co., 153 O. G. 201-204.

A design patent though invalid may apparently anticipate a mechanical patent. (*Cary Mfg. Co. v. Neal* (C. C.), 90 Fed. 725.)

Williams Calk Co. v. Neverslip Mfg. Co., 136 F. R. 212.

A mechanical patent may be void because of a previously granted design patent where the two are indistinguishable in their characteristics, and manifestly the outcome of one and the same invention idea.

Williams Calk Co. v. Neverslip Mfg. Co., 136 Fed. 212.

An examination of the model of the design and the drawing leads us to the conclusion that the design in question relates to that class where a description is not only proper, but necessary, and that the claim should carry a description of the salient features of the design. This is rarely the case.

Mygatt, 121 O. G. 1678.

The absence of any description of the design is authorized by the Patent Office rules relating to designs.

Schraubstadter, 120 O. G. 1167.

The preamble to a claim should be limited to the words "I claim."

Weihman, 118 O. G. 2252.

The drawing should show the article as it appears to observers and should not include a panoramic view of the ornaments to be placed thereon.

Weihman, 118 O. G. 2252.

He describes matters which are clearly shown in the drawing. The present practice of the Office is to dispense with all such descriptions as surplusage and as calculated to mislead.

Mygatt, 117 O. G. 598.

The description should not deal with the use to which the article is put, the function which it performs or its mechanical construction, since it would lead the unskilled to suppose that they constitute essential elements of the design for which protection is furnished by the design patent.

Mygatt, 117 O. G. 598.

In design cases the claim covers merely the design which the applicant discloses, and any attempt to vary the scope of the claim by the words used is objectionable, since it is likely to confuse the public.

Claim "for design and form" the words "and form" should be canceled.

Kahn, 116 O. G. 2008.

The statement that "the shape or outline of the blade forms no part of the design" required to be canceled, in accordance with the rule announced in *Ex parte Freeman*, 104 O. G. 1396, and *Ex parte Goldsmith*, 110 O. G. 309.

Remington, 114 O. G. 761.

The claim must be limited to a single article of manufacture, by changing the words "metal blades" to metal blade.

Remington, 114 O. G. 761.

The claim should be to the design as a whole, any limitation to specific features may make the claim objectionable in form, but can not make the application allowable that was not so without such limitation.

Kurz, 113 O. G. 2215.

When the ornamental appearance must be seen by a glance at the drawing, it is clearly superfluous to attempt to describe its appearance in the specification. Descriptive matter and reference letters on the drawing required to be erased.

Lloyd, 112 O. G. 251.

A drawing should show every feature, but a description except to indicate the figure is unnecessary.

Goldsmith, 110 O. G. 309-310.

Amendment to the specification is not necessarily an alteration of the claims.

Segelhorst, 109 O. G. 1887.

In a patent for a design a picture of the design serves to convey a greatly more adequate idea of the design than any description could possibly do; and in the presence of the pic-

ture, a superadded verbal description is generally useless and often times confusing.

Freeman, 109 O. G. 1339.

This descriptive language in connection with the drawings in the case, illustrates the utter futility of attempting by words to describe the appearance of an object which may be perceived immediately upon the inspection of a picture thereof. In designs the appearance is the new thing which is to be secured by a patent. Words do not explain, but rather confuse when added to the disclosure of the drawing. For this reason such descriptive material should be reduced to a minimum, or better still, entirely eliminated from a design patent specification.

Freeman, 104 O. G. 1396; Freeman, 109 O. G. 1339.

Amended descriptive matter may emphasize one feature or another, but it can not change the design.

Hanson, 103 O. G. 1417.

The claim covered the design as an entirety and that can not be changed.

Hanson, 103 O. G. 1417.

If an applicant claims in a design application subject matter for which a design patent can not be granted the claims must be rejected.

Waterman, 1902 C. D. 235, 100 O. G. 233.

A figure illustrating the internal construction of an article should be eliminated from the drawing.

Tucker, 1901 C. D. 140, 97 O. G. 187.

Experimental use does not apply to a design. As to anticipating,

See Tournier, 90 O. G. 1948; same case on appeal to the Court of Appeals; 94 O. G. 2165.

All reasons for rejecting shall be given by the Examiner at one time.

Sherman & Harms, 89 O. G. 2067.

There is no such distinction as generic and specific in design patents as there is in mechanical patents.

Feder v. Poyet, 1899 C. D. 218, 89 O. G. 1343.

The claims of a design patent are related as generic and specific when one has more elements than the other.

Coe, 1897 C. D. 187, 81 O. G. 2086.

An applicant may describe and claim variations in his patentable form within such limits as are consistent with unity of design and to the extent claimed, and may use mechanical language.

Lunken, 1896 C. D. 22, 76 O. G. 785.

In a design application showing more than one modification applicant is permitted to show, describe, and claim modifications generally.

Bark, 1894 C. D. 108, 69 O. G. 369.

Where certain words and figures (numerals) appeared on the illustration of a design, held that they should be erased if they form no part of the design.

Van Slyke, 1892 C. D. 175, 60 O. G. 893.

A specification comprising two separate descriptions of the same subject matter of invention that are substantially alike except that one contains references to the drawings, is unnecessarily prolix.

Kinney, 1892 C. D. 72, 60 O. G. 737.

The word "manufacture" does not include such a generic term as the word "tableware."

Proeger, 1891 C. D. 182, 57 O. G. 546.

Sufficiency of description.

Pegel, 1891 C. D. 93, 55 O. G. 1528.

The question of similarity or dissimilarity arising upon the comparisons of designs is determined by the eye of the ordinary observer and not by the judgment of experts.

Petzold, 1891 C. D. 97, 55 O. G. 1652.

An application for a design patent, which the applicant has elected to prosecute for the shortest period prescribed by law, can not be amended to run for a longer period after favorable action on the merits.

Kinnear, 1890 C. D. 54, 51 O. G. 156.

A claim must be for a segregable integral part, or for the entire design.

Pope, 1883 C. D. 74, 25 O. G. 290.

Applicant is not confined to one claim.

Sheppard, 1870 C. D. 22; Beattie, 1879 C. D. 142.

Applicant should be required to erase from his description all reference to the function of the device.

Diffenderfer, 1872 C. D. 154; Norton, 22 O. G. 1205;

Fairchild, 1873 C. D. 45.

More than one design can not be included in one patent.

Beattie, 1879 C. D. 142, 16 O. G. 267.

If the device claimed is not shown either in drawings or models, and is capable of such illustration, the applicant has not complied with section 27 of the Act of July 8, 1870, and Rule of Dodge, 1870 C. D. 149.

The application for the reissue was based solely upon alleged ambiguities and uncertainties in the wording of the

claims rendering them in effect mechanically inoperative. Therefore, under the application itself, there was no warrant for amending the claims except in so far as verbal corrections were necessary to make them mechanically operative.

Grand Rapids Show Case Co. v. Baker et al., p. 1360.

Rule 82. Arrangement of Specification.

The following order of arrangement should be observed in framing design specifications:

(a) Preamble, stating name and residence of the applicant, title of the design, and the name of the article for which the design has been invented.

(b) Description of the figure or figures of the drawing.

(c) Claim.

(d) Signature of applicant.

CONSTRUCTIONS.

The words "in testimony whereof" immediately preceding the signature is surplusage.

Pappenhausen, 79 Ms. D. 157.

Rule 83. Model.

When the design can be sufficiently represented by drawings a model will not be required.

Rev. Stat., sec. 4930.

Rule 84. Drawings.

The design must be represented by a drawing made to conform to the rules laid down for drawings of mechanical inventions.

(For forms to be used in applications for design patents, see appendix.)

CONSTRUCTIONS.

An unsigned photograph is not a compliance with this rule.

Bennett, 189 O. G. 1032.

A cross-section may be used at the election of applicant if it helps to illustrate the exterior construction of the article.

Lahmann, 184 O. G. 287.

Additional drawings required.

Mygatt, 180 O. G. 1395.

The edges of the prism that form the upper surface of the shade constitute reflecting surfaces and are not merely superficial ornamentation. It is therefore obvious that the contour of the article is as much a part of the design as the prisms which are formed on the outside of the shade. It is necessary that the design be shown accurately in the drawing. A side elevation proper.

Mygatt, 171 O. G. 125.

The drawing in design cases should show the article as it appears to observers and therefore (in this case) a cross-sectional view is not admissible.

Kohler, 116 O. G. 1185. •

The fact that the present drawing was made with a pen does not remove the objection to it, since it is made up of fine dots instead of continuous lines.

Lloyd, 112 O. G. 251-2; Kohler, 116 O. G. 596.

Design patents have nothing to do with the interior construction, but are concerned solely with the external appearance, a figure showing the interior construction is objectionable.

Colton, 104 O. G. 1119.

Applicant should not be permitted to show in his drawing anything more than the design on which he wishes a patent.

Modifications do not exist in design.

Burdick, 1901 C. D. 184, 97 O. G. 1373.

In design patents it is the showing of the design which is of primary importance, the description being merely auxiliary to the showing.

Feder v. Poyet, 89 O. G. 1344.

If an inventor has a generic design capable of modification, that is, a design made up of a small number of simple elements to which other elements may be added without modification of the essential elements, he should, in order to secure protection for the generic design, show the design in his application in its simplest form. He must show the genus stripped of additions.

Feder v. Poyet, 1899 C. D. 218-220-221, 89 O. G. 1343.

A drawing of a design case should disclose the entire design, not merely a part thereof.

Parker, 1897 C. D. 73, 80 O. G. 1892.

Under the old rule allowing photographs in some cases.

The discretion of the Commissioner of Patents is not limited by the statute to dispensing with the model of the design.

The chief draftsman is the proper person to decide whether a line drawing is practicable.

Aumonier, 1893 C. D. 77, 63 O. G. 1815.

The discretion as to whether a photograph or line drawing shall be required rests with the Commissioner.

Poole, 1892 C. D. 233, 61 O. G. 1655; Petzold, 1892 C. D. 235, 61 O. G. 1789.

Unessential features should be erased from the drawing.

Requa, 1892 C. D. 148, 60 O. G. 295.

Every applicant for a design patent has an undoubted right to show both the observe and reverse of the ornamental work which he has devised. Should illustrate like portions of the device claimed.

Diffenderfer, 1872 C. D. 154.

REISSUES.

Rule 85. Granting Reissue.

A reissue is granted when the original patent is inoperative or invalid by reason of a defective or insufficient specification, or by reason of the patentee claiming as his invention or discovery more than he had a right to claim as new, provided the error has arisen through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention.

Reissue applications must be made and the specifications sworn to by the inventors if they be living.

Rev. Stat., secs. 4895, 4916.

CONSTRUCTIONS.

The proposition that A was under a special duty arising out of the fact that he is a reissue applicant, which is the main ground of my decision, is in accord with the general treatment of the subject of reissues by the courts.

Lette, Jr., v. Armstrong (motion for rehearing), 232 O. G. 938.

A reissue application should be expedited.

Altman, 220 O. G. 1373.

A first reissue abandoned claims in the original, a second reissue allowed to reinsert them, but one who had gone into the manufacture of such device because of the first reissue was allowed to continue. One judge thought the original claims ought not to have been inserted in second cases.

Autopiano Co. v. American Player Action Co., 217 O. G. 1055.

Defendant's position seems to be that there never can be a reissue of a claim once allowed in the original and omitted from a first reissue; but to this proposition we do not assent.

Autopiano Co. v. American Player Action Co., 217 O. G. 1055.

There is no reason why the mistake should not be corrected even though it occurred in an attempt to amend, as by mistake as to what the prior art contained.

Autopiano Co. v. American Player Action Co., 217 O. G. 1055.

These can not be remedied by reissue nor can the deliberate act of applicant's attorney in protracted proceedings in the Patent Office leading to the issue of the patent, be treated as the result of inadvertence, accident, or mistake.

Grand Rapids Show Case Co. v. Baker et al., 208 O. G. 1359.

Regardless of the question as to whether the entire reissue patent is rendered void by the insertion of a new and unauthorized claim, as suggested, *obiter* in *Liggett v. Avery*, 101 U. S. 259, it is clear that such claim of the reissue patent is itself void and will not sustain a bill for infringement. (Cases.)

Grand Rapids Show Case Co. v. Baker et al., 208 O. G. 1359-1360.

If, by reason of inadvertence, accident or mistake, a patentee fails to claim any part or all of the actual invention disclosed in his specification and drawings, and intended or sought to be covered, the patent is to be deemed to such extent "inoperative" and may be lawfully reissued so as to cover the entire invention in its claims. (Cases.)

Grand Rapids Show Case Co. v. Baker et al., 208 O. G. 1359.

If the patentee has described but failed to claim the means used by this defendant, probably he may apply to the Patent Office and claim them yet.

Lorraine Development Co. v. General Electric Co., 198 F. R. 116.

As clearly they did not intend to abandon the claim that

the drop-bars in themselves constituted an invention, we should not impute to them an intention to abandon the arrangement and location of their drop-bars whereby they could gain the advantage due to the special form of drop-bar.

Coldwell Geldard Co. v. Stafford Co., 197 F. R. 573.

We find no case where it has been held that when a patent has been issued to a party for all he claimed in his application the party may subsequently make a new application for a new patent upon omitted matters, and that such new application was a continuation of the first or original application, without surrendering the first patent and obtaining a reissue of the first for the unexpired term of the first patent, as provided in section 4916 R. S.

Model Bottling Machine Co. v. Anheuser Busch B. Assn., 190 F. R. 576.

Weber v. Automobile & Accessories Mfg. Co., 190 F. R. 193.

A reissue is not necessarily void because it contains broadened claims.

Weber v. Automobile & Accessories Mfg. Co., 189 F. R. 193.

A reissue to correct manifest errors in the specification and to more fully describe the construction illustrated in the drawing rests upon a different footing from a reissue to include enlarged claims, and a showing in excuse of the delay which would be sufficient in the first case may not be so in the second.

Tilden, 182 O. G. 971.

A patent will not be reissued with enlarged claims upon an application filed more than two years after the grant of the original patent unless unusual circumstances are shown to excuse the delay.

Tilden, 182 O. G. 971.

Apparently the rule is more strict as to delay in the case of a second reissue.

Tilden, 182 O. G. 971.

Claims abandoned in original can not be reinstated (after ten years).

National Casket Co. v. Stolls, 197 F. R. 940.

The defense of laches being negative does not strongly appeal to the courts where the reissue narrows the claims. In such cases more delay in applying for a reissue, even for a long period (12 years) does no more than suggest laches. There being nothing on the face of the original patent to charge the patentee with notice that his claims were too

broad, proof that the patentee acted with reasonable diligence when he was put to the inquiry whether his claims were confined to the actual invention is sufficient to negative laches. (Mahn v. Harwood, 112 U. S. 554.)

Steiner, etc., v. Tabor Sash Co., 178 F. R. 831-842.

Neither the defendant nor any other member of the public obtained any rights by infringing the device, disclosed in the original patent, and which is protected by the reissue. The doctrine of intervening rights can not be invoked in such a case. The claims were narrowed in this case.

Steiner, etc., v. Tabor Sash Co., 178 F. R. 831-843.

If the solicitor fails to understand and properly describe or claim the real invention, by making claims so broad as to be anticipated, or so narrow as to be inoperative, this is such a mistake as to authorize a reissue if authorized on other grounds.

Toledo Computing Scale Co. v. Moneyweight S. Co., 178 F. R. 559.

The general power of reissue, however, does not depend upon statute, but on the general spirit and purpose of the constitution, and the laws relating to patents.

Toledo Computing Scale Co. v. Moneyweight S. Co., 178 F. R. 560. See this case in Court of Appeals. This was held by the Supreme Court in Grant v. Raymond, 6 Pet. 218.

While inadvertence and diligence are usually mixed questions of fact and law, yet as all the facts are generally of record, without dispute or conflict, the proper deduction is a conclusion of law and will be reconsidered by the court.

Toledo Computing Scale Co. v. Moneyweight S. Co., 178 F. R. 559.

Certain mistakes, even though present, are not enough. Examples of these are mistakes creating public rights acted on or arousing an estoppel in favor of another patentee, as in Dobson v. Lees, 137 U. S. 258, and mistakes attended with negligence and laches.

Toledo Computing Scale Co. v. Moneyweight S. Co., 178 F. R. 558-9.

A disclaimer was introduced into the specification which was afterwards found erroneous. The public had acted on the disclaimer. Reissue to remove the disclaimer improper.

Casem Co. v. Collins Co., 155 O. G. 554.

That the invention was shown in the original drawing not sufficient.

Nelson v. Felsing and Felsing v. Nelson, 142 O. G. 289.

A delay of two years in filing an application for a reissue of a patent with broader claims will usually be treated as an abandonment to the public of everything not claimed in the original. The rule is based upon the analogy between a reissue application and the case of an inventor who fails to apply for a patent of his invention within two years from the date of its public use or sale.

Ams., 127 O. G. 3644.

A patent may be reissued to include a process when only the apparatus was originally claimed. Inadvertence of attorney may be remedied by reissue.

Heroult, 127 O. G. 3217.

The original claims were directed to the holding and adjusting means alone, and it is now sought to insert by reissue claims covering broadly the combination of the gage with the holding and adjusting means.

It is believed that the invention now sought to be claimed is the "same invention" as that intended to be claimed in the original patent within the meaning of the statute.

Hansen, 125 O. G. 2050.

A delay of five years not excused because counsel advised that the claims were as broad as could be secured in view of the previous state of the art.

Arns, 125 O. G. 347; affirmed by C. A. D. C.

A patent upon an apparatus can not be reissued for the purpose of incorporating claims to a process.

Hirault, 124 O. G. 1843; cites *Heald v. Rice*, 1882 C. D. 215.

A reissue with broadened claims may be proper.

In re Briede, 123 O. G. 323.

Foreign inventor and attorney as an excuse for a delay.

In re Briede, 123 O. G. 323.

We must now regard the law as settled by the Supreme Court of the United States, that after the lapse of two years after the issue of a patent, a reissue which seeks to enlarge the claims of the original patent will not be granted, or if granted, will be held invalid, unless special circumstances are shown to excuse the delay.

Felbel v. Aguilar, 121 O. G. 1012.

The entire failure to disclose these in the original application effectually precludes the allowance of claims based thereon in any application which relates back to or takes benefit from such original application.

Briede, 117 O. G. 2085.

There was no attempt to claim the subject matter in the

original application and there is no intimation in the original application that the invention covered by the claim submitted in the reissue was the invention of the applicant, held that the invention covered by the reissue claim must be regarded as abandoned or waived.

Briede, 117 O. G. 2085.

The intention to claim the invention must evidently appear in the original application.

Briede, 117 O. G. 2085.

What would have been new matter in the original may not be claimed in the reissue.

Briede, 117 O. G. 2085.

It is irregular to permit a reissue during an interference.

Lalleg & Goodrum v. Dean, 111 O. G. 301-2.

There is no arbitrary limit of two years for the time of filing application.

Powers, 108 O. G. 1051-3.

A lapse of six years before application, even after a recent decision unfavorable to applicant, is fatal to the application, also the decision shows that the matter sought to be introduced is new matter.

Starkey, 105 O. G. 1259.

It would seem to be intimated that a patent may be reissued to correct a mistake in withdrawing a claim because it was said to be identical with another.

98 O. G. 582-585.

Analysis of them will show that there is a distinction well marked between reissues broadening the claims of the original but confined to the invention therein exhibited, which the courts sustain and reissues that depart from the invention exhibited in the original and included under its statement of invention.

Crown Cork & Seal Co., etc., v. Aluminum Stopper Co., etc., 1901 C. D. 450, 96 O. G. 2579.

The case shows that the court fully recognized the right to modify the claims so as to secure fully the invention described or attempted to be described in the original.

Crown Cork & Seal Co., etc., v. Aluminum Stopper Co., etc., 1901 C. D. 450, 96 O. G. 2578.

Where an applicant acquiesced in the limited construction put on his invention, and at no time during the prosecution of his original application suggested or intimated that the invention resided in the broad device now sought to be claimed in the reissue application, held that the failure to make the

claim in the original patent did not arise through inadvertence, accident, or mistake.

Bryant, 1896 C. D. 66, 76 O. G. 451.

Wollensak v. Sargent & Company, 1894 C. D. 164.

Identity of language in the claims of two patents does not necessarily import that the invention patented to each is identical, nor does a difference of phraseology necessarily import that they are for different inventions.

The test of identity is whether both, when properly construed in the light of the description, define essentially the same thing.

Thompson-Houston Co. v. Elmira Co., 74 O. G. 144.

Where the claim sought to be reissued is similar to one that was presented in the original application and rejected by the Office and canceled by applicant in order to obtain his patent, held that under such circumstances the applicant is estopped from setting up such claim in an application for a reissue.

The claim has apparently properly withdrawn.

Bowman, 1894 C. D. 25, 66 O. G. 1310.

Where an applicant has by "inadvertence" claimed less than he was entitled to claim he may have a reissue with enlarged claims.

Stanley, 1892 C. D. 166, 60 O. G. 735.

If an applicant omits to claim an invention that might have been claimed, because he did not believe it to be patentable, that fact is not sufficient ground for a reissue. It is not inadvertence, accident, or mistake.

Mahnken, 40 O. G. 915; Whiteley v. Bayley & Dyer, 36 O. G. 1142.

If the associate attorney cancels a claim, the applicant is bound by his act and can not afterwards reassert the withdrawn claim by reissue.

Hatchman, 25 O. G. 979.

A delay of more than two years is fatal.

Timken, 24 O. G. 1089.

An unexplained delay of more than five years is altogether unreasonable in a case where the reissue is for the purpose of expanding and enlarging the claims. Scope of the claims.

See 23 O. G. 342, 1882 C. D. 6.

Claims for inventions patented in foreign countries which patents have expired will not be allowed in reissue.

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

A clerical mistake in the specification of a patent can only be cured by a reissue.

Andrew, 1870 C. D. 75.

When mistakes are those of the Office, they will be corrected without expense to the applicant; but when he makes them, they can be cured only by a surrender of his old patent for corrections payment of the fee, and the issue of an amended patent.

Havemeyer Elder & Loosey Assin's Kronig, 1870 C. D. 5.

Until the reissue is actually issued from the Office the original patent remains uncanceled, it is usually deposited in the Office with the application. The uniform practice has been to return the original patent if a reissue is finally refused.

Whiteley, 1869 C. D. 72.

Rule 86. Abstract of Title.

The petition for a reissue must be accompanied by an order for a certified copy of the abstract of title, to be placed in the file, giving the names of all assignees owning any undivided interest in the patent. In case the application be made by the inventor it must be accompanied by the written assent of such assignees.

A reissue will be granted to the original patentee, his legal representatives or assigns, as the interest may appear.

CONSTRUCTIONS.

Abstract of title and assent of assignee necessary.

Powers, 108 O. G. 1053-4.

It is not necessary that the abstract of title and petition should agree in all cases. Where the records of the Office show an assignment and the assignee's name does not appear in the reissue application papers, the Office may properly refuse to proceed with the examination of the application. This, however, is not merely because the abstract of title and the petition do not agree, but because the assignee of record has not consented to the application.

Gold, 106 O. G. 998.

Filing date will not be given until abstract of title is furnished. The object of rule is not only to show what assign-

ments have been made, but whether an assignment has been made.

Blackmore, 102 O. G. 622.

A petition to change date of filing in order to bring that date within two years from date of patent refused as useless.

Griffin, 1900 C. D. 83, 91 O. G. 2001.

Where an application for reissue of a patent which has been assigned was not accompanied by the written assent of the assignee, but subsequent to the filing of the application the assignee reassigned to the inventor, held, that the date of filing of the complete application as entered upon the file wrapper should be changed to the date upon which the abstract of title was filed showing the reassignment.

Pender, 123 O. G. 2975.

Abstracts of title ought to be insisted upon.

Wright, 1876 C. D. 217; Fassett, 1877 C. D. 32.

Rule 87. Prerequisites.

Applicants for reissue, in addition to the requirements of the first sentence of Rule 46, must also file with their petitions a statement on oath as follows:

(a) That applicant verily believes the original patent to be inoperative or invalid, and the reason why.

(b) When it is claimed that such patent is so inoperative or invalid "by reason of a defective or insufficient specification," particularly specifying such defects or insufficiencies.

(c) When it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new," distinctly specifying the part or parts so alleged to have been improperly claimed as new.

(d) Particularly specifying the errors which it is claimed constitute the inadvertence, accident, or mistake relied upon, and how they arose or occurred.

(e) That said errors arose "without any fraudulent or deceptive intention" on the part of the applicant.

CONSTRUCTIONS.

Oath to be submitted to Law Examiner, Order 2,255, 227 O. G. 1.

No mere inference can take the place of such proof. Ordinarily what is called for by the words same invention should appear in some way on the face of the original patent, and it can not be gathered from mere inferences or suggestions with reference to what the patentee might or might not have conceived.

Stafford Co. v. Coldwell Gildard Co., 202 O. G. 745.

While some of the requirements of Rule 87 may possibly go beyond the power conferred, a matter which we are not now called upon to decide, there is nothing in so much of the rule as is mentioned above that is inconsistent with the statute.

Fullagor, 192 O. G. 1263.

Having disclosed the process, the failure to claim was either intentional or the result of inadvertence, accident or mistake for which section 4916, Revised Statutes, furnishes a remedy.

Hervilt, 127 O. G. 3217.

Where a domestic patent was granted Feb. 20, 1883, and a British patent for the same invention was sealed August 20, 1883, and a reissue application was filed January 21, 1893, held, that since the term of the reissue would not be affected by the foreign patent, it was unnecessary to require the reissue applicant to recite the British patent in his oath.

Cowles, 1893 C. D. 135, 65 O. G. 2060.

Order of proceeding by the Examiner: First, whether or not the original patent is inoperative or invalid; second, if so, for what reason?; third, if so, did the error arise from an advertence, accident or mistake, and without fraudulent intention; fourth, whether there are any references.

Ernst, 33 O. G. 235.

The statement must allege facts, the opinion of the allegor is not sufficient.

Timken, 24 O. G. 1089; Pfaudler, 23 O. G. 269.

Applicant should state if foreign patents have been issued for the invention, and the dates of such patents should be given.

C. W. Siemens, 1877 C. D. 41.

Rule 88. New Matter.

New matter shall not be allowed to be introduced into the reissue specification, nor in the case of a machine shall the model or drawings be amended except each by the other.

CONSTRUCTIONS.

Claims for matter not in the inventor's mind when original application was made void.

Smith Incandescent Light Co. v. Welsbach Gaslight Co.,
197 F. R. 951.

An application can only be reissued for matter that was contemplated in the original.

Sovereign et al. v. Lettie, 185 O. G. 830.

The invention was shown in the original drawings, but was only referred to in the application for a reissue. Held void.

Marvel Buckle Co. v. Alma Mfg. Co., 180 F. R. 1002;
refers to Parker & Whipple Co. v. Grele Lock Co.,
123 U. S. 87, 8 Sup. Ct. 38, 31 L. Ed. 100.

The new matter added is not limited to a new theory. It contemplates an intentional variation in construction, and the new theory explains what takes place with the new construction. Not admissible.

Taylor, 183 O. G. 1032.

Original for combined devices reissue for one of the combined devices. Reissue valid.

Hareford v. Hollander, 163 F. R. 948.

A reissue which seeks to enlarge the claims of the original patent will not be granted or if granted will be held invalid unless special circumstances are shown to excuse the delay.

In re Starkey, 104 O. G. 2150; Court of Appeals D. C.

A patent for a machine can not be reissued to cover a process.

Pfandler, 1882 C. D. 17, 22 O. G. 1881.

A claim can not be inserted in a reissue for matter which was described but not claimed in the original specification.

Pfandler, 22 O. G. 1881.

An applicant for reissue is entitled to make use of any terms in describing his invention in a reissue application which would have been correct in the original application.

Bissell & Moore Mfg. Co., 1870 C. D. 157; Coleman,
1880 C. D. 205.

A suggestion of a new use may be inserted in a reissue.

Palmer, 1880 C. D. 129, 17 O. G. 976.

It is proper to remedy a defective description by reissue.

Siemens, 1877 C. D. 98, 12 O. G. 626.

Affidavits can not be received as to an element not shown in the model.

Stockwell v. Haines, 1877 C. D. 82, 12 O. G. 137.

Illustrations of last clause.

Ingraham, 1871 C. D. 164; Dieckerhoff, 1877 C. D. 77, 12 O. G. 429.

A reissue can not be based upon a void patent, as upon one issued upon an application subscribed and sworn to in blank.

Benton, 23 O. G. 341.

Or upon a patent issued to joint inventors for an invention made by but one.

Barsaloux, James & Lyon, 1878 C. D. 154.

Where the ambiguity is explained in a manner not inconsistent with the original invention, and where the patent is clearly inoperative by reason of such ambiguity, it is but just that the discretion reposed by the law in the Commissioner should be exercised in favor of the patentee upon sworn statements of the character herein filed.

Gottstein, 1877 C. D. 47; Winslow, 1876 C. D. 96.

A patent may be reissued to include an invention shown in the original drawing, but not shown in the drawing attached to the patent.

Baldwin, 1876 C. D. 76.

No new matter should be introduced.

Aldrach & Evans, 1876 C. D. 40.

The Office has been compelled to construe the provisions of this rule as literally as a court would a criminal statute.

Warring, 1871 C. D. 228.

The applicant should be held rigidly to the language adopted in his patent except when good reasons appear for departing from such language.

Underwood, 1872 C. D. 118, 1 O. G. 549.

Testimony may be received as to a lost model as a basis for an amendment of the drawings.

Neal & Adams v. Daniels, 1871 C. D. 156.

Examples of new matter.

Lewis, 1871 C. D. 82.

The drawings can not be amended by the written description alone.

Keith, 1870 C. D. 69; Dodge, 1869 C. D. 27.

Rule 89. Division of Reissue of Application.

The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for each division of such reissued letters patent. Each division of a reissue constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division; and the drawing may represent only such part or parts, subject to the provisions of Rule 50. Unless otherwise ordered by the Commissioner, all the divisions of a reissue will issue simultaneously; if there be any controversy as to one division, the others will be withheld from issue until the controversy is ended, unless the Commissioner shall otherwise order.

CONSTRUCTIONS.

Where an application is filed for the reissue of a patent, held that division can not be required. (Ex parte Lippincott, 16 O. G. 632, overruled.)

Van Nostrand, 1913 C. D. 215.

Examples of a division required by the Commissioner.

Lippincott, 1879 C. D. 212, 16 O. G. 632; see Van Nostrand, 1913 C. D. 215.

The Commissioner has power to issue the several divisions at different times.

Greaves, 1880 C. D. 213; Decision of Secretary, 18 O. G. 623.

An applicant can not disaggregate his machine, and set up as a part of the same invention a special organization of parts producing some special effect he desires to cover, to the entire exclusion of all other results regularly flowing out of the complete device as originally organized.

Powell, 1878 C. D. 72, 13 O. G. 911.

A patent may be divided and reissued to eliminate the part covered by expired foreign patents.

Pulvermacher, 1876 C. D. 154.

In an application for reissue parts of a device can not be

selected to make up a new device not hinted at in the original patent.

Wheeler and Wheeler, 1873 C. D. 101, 4 O. G. 3.

If the inventor of a process finds that the same result can be obtained without carrying out the entire operation, he is entitled to the benefit thereof, and he may secure it, if he be a patentee by reissue.

Wooten, 1872 C. D. 264, 3 O. G. 521.

Rule 90. Reexamination of Reissue Claims.

An original claim, if reproduced in the reissue specification, is subject to reexamination, and the entire application will be revised and restricted in the same manner as original applications, excepting that division will not be required.

CONSTRUCTIONS.

It is proper to cite patents which were granted subsequently to applicant's filing date, but on applications filed prior to that date.

Bryan, 178 O. G. 886.

Rule 91. Original Patent.

The application for a reissue must be accompanied by the original patent and an offer to surrender the same, or, if the original be lost, by an affidavit to that effect, and a certified copy of the patent. If a reissue be refused, the original patent will be returned to applicant upon his request.

CONSTRUCTIONS.

If claims in patent are rejected on reissue application it does not affect the claims in the patent before the original patent is canceled and reissue issued.

100 O. G. 449.

Rule 92. Matter to be Claimed only in a Reissue.

Matter shown and described in an unexpired patent which is an indivisible part of the invention claimed

therein, but which was not claimed by reason of a defect or insufficiency in the specification, arising from inadvertence, accident, or mistake, and without fraud or deceptive intent, can not be subsequently claimed by the patentee in a separate patent, but only in a reissue of the original patent.

CONSTRUCTIONS.

See notes under the heading "Reference to Applicant's Previous Patent." Rule 66.

An interference dissolved as one of the applicants contains claims made in violation of this rule.

Du Bois v. McCloskey, 1880 C. D. 142.

An inventor can not claim in a second patent matter described but not claimed in a former patent to himself.

Hill v. Prentice, 24 O. G. 1176; Hill v. the Com. of Patents, 33 O. G. 757.

This rule must be administered in subordination to the statute securing the right of issue. If the thing shown, but not claimed, in the two patents can not be lawfully claimed on reissue of the earlier, but can be lawfully claimed on reissue of the later patent, it may be so claimed, notwithstanding the rule; for the rule can not be permitted to defeat the law.

Locke, 1879 C. D. 311.

INTERFERENCES.

Rule 93. Interference Defined.

An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention. *In order to ascertain whether any question of priority arises, the Commissioner may call upon any junior applicant to state in writing the date when he conceived the invention under consideration. All statements filed in compliance with this rule will be returned to the parties filing them. In case the applicant makes no reply*

within the time specified, not less than ten days, the Commissioner will proceed upon the assumption that the said date is the date of the oath attached to the application. The fact that one of the parties has already obtained a patent will not prevent an interference, for although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who proves to be the prior inventor. (As amended June, 1917.)

Rev. Stat., sec. 4904.

HISTORY.

See *Ewing, Com., v. U. S. ex rel. The Fowlor Car Company Case*, Ct. of A. D. C. and S. C., 226 O. G. 700.

See notes to 127.

Lowery's Interference Rules, §§ 1, 3 and 4, page 111, has the following:

§ 1. *Introduction.*

The first statutory provision relating to interferences was that of the Act of 1793, Chap. XI, Section 8, which provided that interfering applications should be submitted to arbitration, and established a rule for the selection of the arbitrators.

There was no further legislation on the subject until the Act of 1836, which established the United States Patent Office, with the Commissioner of Patents as its head, and which provided in Section 8 for a form of procedure in the Patent Office in cases of interferences.

Section 16 of the same act gave a remedy by bill in equity on an adverse decision of the Board of Examiners in the case of an interfering application and an unexpired patent.

The Act of 1870 repealed that of 1836 and reenacted in Sections 42 and 46 the substance of Section 8 of 1836. To these correspond Sections 4904 and 4909 of the Revised Statutes now in force.

§ 3. *Rules of the Patent Office.*

The Act of 1839, Section 12, conferred on the Commissioner of Patents the authority required for the making of regulations in respect to the taking of evidence to be used in

contested cases before him; this power was further enlarged by the Act of March 2, 1861, Section 1.

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

The Act of March 2, 1861, Section 2, established a Board of Examiners-in-Chief, and provided that they should be governed in their action by the rules to be prescribed by the Commissioner of Patents.

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

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

The conclusiveness of the Patent Office rules has been considered in:

Arnold v. Bishop, 1841, Cranch Ch. J. 1 Mac A., Pat. Cases 27; Nichols v. Harris, 1854; Morsell, J. Ibid 302; O'Hara v. Hawes, 1859; Morsell, J. Law's Digest 96; Dyson, ex parte 1860; Dunlop, J. Ibid 96.

§ 4. *Editions of the Rules.*

It is said that in 1820 the Secretary of State issued a set of instructions relating to applications for patents, and as early as 1828 we find in the Franklin Journal, 2d Sr., Vol. 2, page 332, directions of a semi-official nature for the guidance of persons applying for patents; but the first official publication of Patent Office rules is undoubtedly that of 1836, which appeared simultaneously with, and was based upon, the new law of the same year. From then on various editions have been issued with which we are not concerned; that of November, 1869, being the last prior to the passage of the Act of July, 1870."

CONSTRUCTIONS.

The Commissioner is required to put the machinery of the law in operation by the declaration of an interference. It is not possible for him by any short cut he may devise to deprive the applicant of this right.

Ewing, Com., v. U. S. ex rel. The Fowler Car Company, 226 O. G. 700.

The Supreme Court reversed the Court of Appeals in this case.

Ewing, Com., v. Fowler Co., 238 O. G. 983.

During the year the practice of having all prospective interferences between applicants for patents submitted to one of the law examiners has been continued. A total of 1,823 interference proposals were reviewed by the law examiner assigned to this task. Of these, 924, or 51 percent, were approved as submitted; 583, or 29 percent, were approved after modification; and 369, or 20 percent, were disapproved; 1,286 new interferences were declared, and in 168 existing interferences new parties were added. In 344 of the interferences orders to show cause were issued to all junior parties. But for the mandamus granted by the Court of Appeals of the District of Columbia in the case of United States ex rel. Fowler Car Co. v. Commissioner of Patents, the number of interferences actually declared would have been reduced by several hundred. The amount of labor involved, both for the office and litigants, in disposing of several hundred interferences in which no question of priority of invention is involved is very great, and several hundred applicants are denied their patents when they demand them and are harrassed and put to expense at the instance of applicants who presumably have no right to the invention in controversy. The Fowler case has been taken up by the Supreme Court of the United States on a writ of certiorari and is to be argued there, it is hoped, at an early date.

Commissioner's Report, 1916. See paper by Commissioner Ewing, read before the Examining Corp.

T's design application was rejected upon design patent to A. The Examiner thought A's application was allowable over the previous state of the art and that T's was not, and refused to declare an interference, but said if T's and A's devices were held to be alike on appeal, he would declare the interference. Held the interference should not be declared until the subject matter was held to be patentable.

Taylor, 174 O. G. 287.

Whether the senior applicant may be entitled to priority of invention as against all persons, is not the issue in an interference case between two claimants of the invention; but the question is whether the junior applicant has established his own claim to priority over that of his apponent.

Boisart v. Pohl, 135 O. G. 453.

In re Mills, 117 O. G. 904.

Schubert v. Munro, 113 O. G. 284.

Equities are not with a sole applicant in trying to dissolve an interference with an application that he has made as a joint applicant. The question should be investigated.

Girard v. Abbott, Girard & McGerr, 103 O. G. 662.

Recent amendment.

Lane v. Hunter, Jr., 1893 C. D. 43.

There may be an interference in fact on a generic issue based on two devices which are specifically different.

Kolb v. Hemingway v. Curtis, 120 O. G. 2445.

Some of the claims constituting the issue were made in this case; but others have not been made and can not be made here for the reason that there is no foundation in this case for them. It is therefore impossible to include this case in the interference upon the issues there stated. The declaration of a second interference including a part of the issue in the first would also be improper.

Adams, 119 O. G. 650.

Where the terms of an issue are generic there may be an interference in fact although the device of the parties may differ in specific details.

Sanders v. Melvin, 119 O. G. 1921.

The devices were different, but the issue was to parts having corresponding functions. Held properly declared.

Walker v. Brunhoff, 118 O. G. 2537.

Where the devices of the parties are identical in substance so far as they are defined by the claims in issue, though such devices differ in specific characteristics to which said claims are not limited, held that there is interference in fact as to such claims.

Greer v. Christy, 116 O. G. 297.

If the Examiner does not regard the claims as patentable he should reject them and applicant's remedy is by appeal on the question of patentability.

Dukes, 115 O. G. 803.

Where one of two alleged joint inventors refused to sign the specification the Commissioner said since no patent could be issued upon this application, the Office must refuse to make the examination which is ordinarily made and must refuse to conduct an interference which is one form of species of examination. (Refers to 4 Wall. 527.)

In re Adam, 106 O. G. 999.

Do not claim substantially the same invention when the counts include an element not found in one applicant's claims and when the claims include elements not found in counts.

Wheildon v. Tench, 106 O. G. 763.

An interference will not be declared where the Office is willing to allow applicant's claims over the issued patent.

Gibloney, 105 O. G. 976.

In order to constitute an interference in fact the language of the counts must mean the same thing when applied to each of the interfering inventions.

MacDonald v. Edison, 105 O. G. 973.

There is an interference in fact between two applications disclosing the same process notwithstanding one describes two preliminary steps as preferable, or if one describes as preferable though not essential the employment of an additional intermediate step.

Power v. Proeger, 1902 C. D. 482, 101 O. G. 3108.

Whether application was altered or not in issue, at least in this particular case.

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

Questions proper to an interference will not be considered in a separate application.

Stone, 1902 C. D. 434, 101 O. G. 2080.

The question of originality, except as between the parties, will not be considered.

Trufant v. Prindle v. Brown, 1902 C. D. 397, 101 O. G. 1608.

The interference was between an application and a patent and also an application for the reissue of said patent. Two claims that were in the patent were rejected in the application for reissue on reference to opponent's English patent and the rejection acquiesced in. Held that the two claims were still involved in the interference.

Read v. Scott, 1902 C. D. 242, 100 O. G. 449.

Interference cases will not be entertained for the purpose of settling a moot question but only to determine priority.

Weston v. Jewell, 1902 C. D. 20, 98 O. G. 417.

In trade-marks the practice follows that of mechanical patents.

Carey v. New Home Sewing Mch. Co., 1901 C. D. 165, 97 O. G. 1171.

Reece v. Fenwick, 1901 C. D. 143, 97 O. G. 188.

Between designs applications.

Tyler v. Amand, 1901 C. D. 301, 94 O. G. 1969.

The applicant must be found entitled to a reissue before the interference is declared.

Bagot & Dishart, in re, 1900 C. D. 80, 91 O. G. 1802.

Substance, not words, the test of identity.

Edgecombe v. Eastman v. Houston, 1899 C. D. 207, 89 O. G. 707.

The gist of an interference resides in the claim and not in mere disclosures in the application.

Van Depoele v. Daft, 1892 C. D. 15, 58 O. G. 520.

Where a patent has issue inadvertently and interference is subject to the same rules as when between two applications.

Bechman v. Johnson, 1889 C. D. 184, 48 O. G. 673.

Doubted if after applicant has voluntarily eliminated his claims and apparently abandoned them should be permitted after invention has been developed to return after eleven years and amend and claim an interference.

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

An interference is properly declared between the applications of joint applicants and one of said joint applicants claiming to be a sole inventor.

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

Kohler v. Kohler & Chambers, 1888 C. D. 19, 43 O. G. 247; *Welpton*, 1873 C. D. 21.

Where two combinations producing the same effect are identical except as to a single element, which is present in one but wanting in the other, a case of interference arises, because the latter combination if first invented will anticipate and defeat the former.

Banks v. Snediker, 1880 C. D. 95, 17 O. G. 508; see *Fletcher v. Abraham*, 1870 C. D. 26.

An application put in interference with two patents so that the patentees should incidentally prove their rights as to each other.

Wilson & Matthews v. Yakel & Rogers, 1876 C. D. 245, 10 O. G. 944.

An interference is declared between the applications or the invention involved rather than between the applicants or patentees.

Hicks v. Keating v. Purvis & Bilgram, 1887 C. D. 40, 40 O. G. 343.

The two applications must claim the same invention. Description in the specification is not sufficient ground for an interference proceeding.

Drawbaugh v. Blake, 1883 C. D. 17, 23 O. G. 1221; *Emerson*, 1880 C. D. 143, 17 O. G. 1461; *Wright*, 1870 C. D. 60.

Neither the spirit of the law nor public policy sanction the

granting of patents with specific claims while applications with generic claims are still pending.

Upton, 1884 C. D. 26, 27 O. G. 99; see Gardner v. Dudley, 1880 C. D. 123, 17 O. G. 801; Bacheller v. Porter & Bancroft, 1869 C. D. 64; Boon v. Hinman, 1870 C. D. 7.

But the Commissioner seems to think differently in

Drawbaugh v. Blake, 1883 C. D. 17, 23 O. G. 1221.

The Commissioner can not declare an interference with an unlawful application, as with one improperly divided.

Holt, 1884 C. D. 43, 29 O. G. 171; or with unpatentable claims, Jackson v. Nichols, 1871 C. D. 278.

It is not as a prior patentee that one of two conflicting applicants, who have inadvertently obtained a patent, obstructs the application of the other, but as a rival claimant or conflicting applicant, necessitating an interference. An interference should be declared *nunc pro tunc* under the first clause of Rule 93. (Marston, 1882 C. D. 1, 21 O. G. 633.)

An affidavit seems to have been required in Upton, 1884 C. D. 26, 27 O. G. 99, however.

An interference should not be declared between a native and a foreign invention in order to allow the foreign inventor to establish the date of his invention in a foreign country, as this is an immaterial question. But, upon a proper affidavit being presented, an interference may be declared to give the foreign inventor a chance to establish the dates of introducing the knowledge of the invention into this country. An interference will not be declared in order to show dates of publication.

Thomas v. Reece, 1879 C. D. 335, 26 O. G. 1234; 1888 C. D. 12, 17 O. G. 195.

The word "showing" should be construed as in Rule 74.

Graydon, 1883 C. D. 71, 25 O. G. 192.

If the original patent is involved in an interference proceeding and a reissue is sought, the examination should be proceeded with and if the reissue is allowed, the reissue patent should be substituted in the interference proceeding.

Zay, 1881 C. D. 20, 19 O. G. 1496; see also Wright, 1870 C. D. 60.

If, pending an interference between A, B, & C whose preliminary statements have been filed, D shall file an application not claiming or showing the invention in interference, but claiming other matter claimed by A and shown by B and C, he will be entitled to an interference with A and also upon due amendment of the applications with B and C without

waiting for the final adjudication of the pending interference between A, B, and C.

Smith, 1880 C. D. 77, 17 O. G. 447.

The claims must conflict in substance not necessarily in words.

Drawbaugh v. Blake, 1883 C. D. 17, 23 O. G. 1221;
Greenough v. Drummond, 1879 C. D. 213 and 267, 16
O. G. 959 (16 O. G. 586, 213 and 267).

The Commissioner can not declare an interference with a forfeited application.

1877 C. D. 122, 12 O. G. 979; Holt, 1884 C. D. 43, 29
O. G. 171; Spear, 1874 C. D. 25.

The Commissioner can not declare an interference with an abandoned application.

Casilear v. McIntire, 1875 C. D. 117; Contra Rouse v.
Stoddard, 1875 C. D. 33, 7 O. G. 169; see Leavitt,
1873 C. D. 27.

It is not necessary to an interference that the combination of each party should consist of elements identically the same in form so long as the combinations as entireties are the equivalents in arrangement and mode of operation.

Withington v. Locke, 1877 C. D. 27, 11 O. G. 417.

It was at one time thought that the Commissioner had no authority to declare an interference with reissues.

Becker v. Throop, 1875 C. D. 87; Paris v. Bussey, 1875
C. D. 145.

But the practice was soon resumed in proper cases.

Sargent v. Burge, 1876 C. D. 175, 10 O. G. 285; Carroll
v. Morse, 1876 C. D. 61, 9 O. G. 452.

Where the claim in interference is broader in scope than the special devices shown by either of the parties, the subject matter involved can not be limited to just what is shown by either of said parties.

Sacroix and Welch, 1873 C. D. 155.

Or by a patent having been granted without an interference as where a caveator failed to receive the notice sent by the Office, of the second application.

Frevert v. Gahr, 1873 C. D. 92.

The claims differ in this: Chapman claims the process described and Finley the article produced; but either might, by amendment or reissue, insert the clause of the other.

I have no hesitancy in deciding that the interference was properly declared.

Liggett in Finley v. Chapman, 1872 C. D. 53; see also
Chesebrough v. Toppan, 1872 C. D. 100.

An application will not be prejudiced by the mistake of the Office in granting a patent to his opponent instead of declaring an interference between the applications.

• Goodman v. Scribner, 1872 C. D. 254; Hamilton v. Foster, 1869 C. D. 30.

The devices of applicants differ as much from each other as they do from the device which was prior to both of them. They are improvements upon that original, but not upon each other. They perform the same result, but they differ in their mode of performing it, which is their principle of operation, as much as they differ from the original; there can, therefore, be no conflict between them.

Barton v. Babcock, Manton & Boyd, 1869 C. D. 67.

Rule 94. When Declared.

Interferences will be declared between applications by different parties for patent or for reissue when such applications contain claims for substantially the same invention which are allowable in the application of each party, and interferences will also be declared between applications for patent, or for reissue, and unexpired original or reissued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved: *Provided*, That where the filing date of any applicant is subsequent to the filing date of any patentee, the applicant shall file an affidavit that he made the invention before the filing date of the patentee.

Parties owning applications or patents which contain conflicting claims will be required before an interference is declared to show cause why these claims shall not be eliminated from all but one of the applications or patents of common ownership.

CONSTRUCTIONS.

The Supreme Court say that an applicant has two (2) years from the grant of a patent in which to insert the claims thereof, reversing the Court of Appeals D. C. as shown in next paragraph.

Chapman v. Wintroath, 272 O. G. 913.

Failure for more than a year to make claims of patent an estoppel unless explained.

Wintroath v. Chapman et al., 248 O. G. 1003, 1004.

Rules 125 and 91 seemingly conflict in the present instance. The inventor can not be bound to make concession of Rule 125.

Schreiber v. Bauer, 258 O. G. 813.

If two applications are pending at the same time no affidavit required in order to justify an interference.

Soille, 90 O. G. 2133.

If a patent is issued upon an application claiming an invention, while another application showing but not claiming it is pending, the second applicant may make the claims and have an interference declared without making the affidavit.

Timley, 1899 C. D. 248, 89 O. G. 2259.

When two applications are pending contemporaneously the necessity for such an affidavit does not exist.

Simonds, 114 O. G. 1549.

Specific and generic claims do not interfere.

Williams v. Perl, 87 O. G. 1607.

A case passing on the subject matter of this rule:

Forbes v. Thomson, 1890 C. D. 61, 51 O. G. 297.

An interference with an unexpired patent will not be declared until the application is rejected with reference to that patent.

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

The affidavit under Rule 94 does not call for a showing of facts. The Office may call for such a showing.

Ries v. Thomson, 1891 C. D. 233.

The affidavit required must identify the invention in controversy and state that affiant made it before the patentee's application was filed, but it does not call for a statement of facts showing date of invention. The right to call for such a showing is discretionary with the Office.

Davis, 1893 C. D. 41.

Said not to require a statement of facts as in Rule 75.

Ries v. Thomson, 1891 C. D. 233, 57 O. G. 1598.

The affidavit must state facts from which the conclusion can be reached that the invention was made before the patentee's application was filed.

Graydon, 1883 C. D. 71, 25 O. G. 192.

Rule said to have been amended since Graydon was decided and above said to be a mere dictum.

Ries v. Thomson, 1891 C. D. 233, 57 O. G. 1598.

Rule 95. Preparation for Interference.

Before the declaration of interference all preliminary questions must be settled by the primary examiner, and the issue must be clearly defined; the invention which is to form the subject of the controversy must have been patented to one of the parties or have been decided to be patentable, and the claims of the respective parties must be put in such condition that they will not require alteration after the interference shall have been finally decided, unless the evidence adduced upon the trial shall necessitate or justify such change.

In case the subject matter in controversy has been patented to one of the parties but is deemed by the examiner not to be patentable, he shall call the case to the attention of the Commissioner, who may direct the declaration of the interference.

CONSTRUCTIONS.

See notes to Rules 96 and 97.

Disclosure must be shown in original application, and must be such as required for an application by the statute.

Cooper v. Downing, 230 O. G. 909.

In reaching a conclusion as to what one skilled in the art would do we are confined to the application as originally filed. Testimony not admissible.

Cooper v. Downing, 230 O. G. 909.

Apparently to warrant the introduction of a claim of a patent the disclosure in the original application must be that required for the invention of an application.

Cooper v. Downing, 230 O. G. 909-10.

Where it is necessary that an application be amended before a patent can issue, it is desirable that the amendment be made during the interference.

Liebmann et al. v. Newcomb, 229 O. G. 613.

In declaring an interference each count of the issue should be patentably distinct from all the others.

Votey v. Walsh, Jr., v. Duncan, 111 O. G. 1627.

The Examiner states that if broader claims are allowed a

new interference will be necessary, this is a matter relating to the merits. The proposed claims should be entered.

Thurman, 111 O. G. 1625-26.

95 and 96 should be considered together. When so considered it will be noted that 95 relates only to the claims of the issue. There is no rule which prohibits the formal entry and consideration of an amendment after the proceeding has terminated.

Thurman, 111 O. G. 1625-26.

The question whether or not an applicant, whose application is involved in interference, has a right to make the claim put in issue is determined and becomes *res adjudicata* by the declaration of interference so far as the interference proceedings are concerned.

Herman v. Fullman, 109 O. G. 1890.

The declaration of an interference is an allowance of the claims it would seem.

Luger v. Browning, 1902 C. D. 230, 100 O. G. 231.

If claims are not formally allowed it is not such a matter as will be considered on appeal on other grounds.

Luger v. B., 1902 C. D. 230, 100 O. G. 231.

Should be construed together. It is not the policy of the Office to delay the declaration of an interference after one of the interfering applications is ready for issue any longer than is absolutely necessary.

The same reasoning applies where one is a patentee.

It is not fair to a patentee for the Office to permit delays in the declaration for the purpose of first requiring questions to be settled which do not in any way affect the interference issue.

It is otherwise where the claims would form counts of the issue.

Sponi, 97 O. G. 1375.

The claims should be liberally construed in favor of declaring an interference.

Drawbaugh v. Blake, 1883 C. D. 17, 23 O. G. 1221.

There can be but little hesitation in choosing between the natural interpretation which sustains the interference as declared and a forced construction of the same, which, in effect puts two of the parties out of court. Especially where former action of the Office had indicated the first construction.

Locke v. Levalley, 1881 C. D. 26, 20 O. G. 671.

In determining whether two applications conflict, the claims should be construed with reference to the specification.

Greenough v. Drummond, 1879 C. D. 213 and 267, 16 O. G. 586 and 959; Duthie v. Caslear, 1872 C. D. 50.

Confusion caused by a violation of this rule illustrated the Primary Examiner allowed matter alleged to have been improperly introduced in violation of Rule 69 to remain in the specification.

Wm. Carlock, 1875 C. D. 88.

See example of unsettled claim in *Farnsworth v. Andrews*, 1876 C. D. 3, 9 O. G. 195.

The patent to Clinton and McNamara is not an anticipation of any of the counts for the same reason that the "Hillard's Exhibit No. 2 typewriter equipped with escapement of 1891" is not a reduction to practice of the invention.

Brooks v. Hillard, 1903 C. D. 335, 106 O. G. 1237.

Construction of the Issue.

See also notes to Rules 96 and 97.

A claim should be given the broadest interpretation that it will reasonably support, and limitations will not be read into it to meet exigencies. (*Miel v. Young*, 29 App. D. C. 481; *Getz et al. v. Crozier*, 32 App. D. C. 324; *Western Electric Co. v. Martin*, 39 App. D. C. 147; *Leonard v. Horton*, 40 App. D. C. 22.) But, where the difference in the inventions clearly appears, the claims should be given a *reasonable* interpretation consistent with the specification in which they originated to the end that the real inventor may be given the award of priority.

Murphy v. Cooper, 228 O. G. 1458.

Evidence considered and held to justify an award of priority to appellee, especially in view of the original attitude of appellant as to the name and function of an important element of his early machine. (Headnote.)

Ruggles v. Ash, 226 O. G. 699.

"Means for causing said nozzles to follow the direction of the tube."

We agree with the tribunals of the Office that such means must be within the blower itself, and does not include a ball and socket joint which permits of the nozzles being guided by resting in the tubes.

Coe v. Brown, 225 O. G. 372-373.

The additional bend forms no part of the loop, especially in appellee's device, and hence to insert it into the claim would not be the mere construing of it, but the reading into the claim of a limitation not called for to save it from destruction.

Clulee v. Aat, 224 O. G. 742.

In an interference proceeding we must give to claims the broadest interpretation which they will reasonably support, and we are not at liberty to import limitations therein to meet the exigencies of a particular situation. (Cases.)

Kirby v. Clements, 216 O. G. 1319.

“Adapted” does not necessarily imply an actual combination with the element to which it refers.

In making his claim the inventor is at liberty to choose his own form of expression, and while the court may construe the same in view of the specifications and the state of the art, they may not add to or detract from the claim. (Quoted from *Unhairing Co. v. American Co.*, 198 U. S. 399) in

Diamond Patent Co. v. Carr Co., 216 O. G. 327.

Seymour’s device includes means for cutting the sheets one at a time, etc., and there is a substantial advantage in this process.

In Barber’s machine the sheets are cut two at a time and there is no suggestion in his application of a mechanism by which it would be possible to cut sheets one at a time, etc. By no fair interpretation of the language could “a sheet” be construed to cover a group of sheets. Barber had no right to make the claim.

Barber v. Seymour, 215 O. G. 1500.

Where the application of W. & H. discloses two compositions, one containing wax but not benzol and the other benzol but not wax, this application does not disclose the use of both benzol and wax in the same composition.

Wilson & Harris v. Ellis, 211 O. G. 957.

The division of the issue into counts implies that the Patent Office considers there is a patentable difference between the counts (dictum).

Wilson & Harris v. Ellis, 211 O. G. 957.

There is a rule which has been long established and many times confirmed that all limitations appearing in the counts of an interference will in interference proceedings in the Patent Office be regarded as material to the invention covered by said counts.

Wilson & Forrest v. Ellis, 211 O. G. 286.

On the facts as we find them one conclusion of law is that claims 1 to 7, inclusive, are limited by their own terms and by the prior art to high pressure and small volume means, and that claims 8 and 9, unless likewise limited, are void as seeking to monopolize the general result.

Atlas Portland Cement Co. v. Sandusky Portland C. Co.,
196 Fed. 398.

This rotary motion of the barrel has no purpose in complainant's pistol except to permit disassembling. The expert for complainant so concedes, and since he further concedes that in defendant's pistol rotation of the barrel plays no part in disassembling, we do not deem it necessary to enter into any discussion of the prior art.

Colts Patent Firearms Mfg. Co. v. New York Sporting Goods Co., 190 F. R. 564.

In order to construe the claim properly recourse must be had to the specification and the prior art. We can not permit speculation and guesswork to guide us as to the character and structure of the elements of the claim. The answers to these questions are made clear by an examination of the specification and drawings and the proceedings in the Patent Office.

Colts Patent Firearms Co. v. New York S. G. Co., 190 F. R. 561.

When the inventor of a particular device chooses to make claims broader than necessary to cover the same, he can not when thrown into interference with another inventor in the same general field, ask that they be limited to correspond with his own particular structure.

Leonard v. Horton, 189 O. G. 781.

The words "Pivoted directly to the lazy tongs" does not necessarily involve a point in common and is answered by a construction which comes substantially within it though not literally.

Leonard v. Pardee, 188 O. G. 516, 559 (186 O. G. 559.)

The issue may be construed in light of the previous art.

Richards v. Bennis, 187 O. G. 514.

The addition of a new party is no excuse for not having comprehended the breadth of the issue.

Onderdout v. Routke v. Moffat, 183 O. G. 507.

The holding which is in substance that the disclosure as it stands is insufficient to support the claims, but that it may be amended in such a way that it will support them, is clearly inconsistent on its face.

Seacombe v. Burks, 182 O. G. 973.

We have been cited to nothing in the prior art which limits this expression to the specific construction shown in the application since the prior patents all disclose no more than means for drawing from a shallow pan:

Rolin v. Slinghoff, 182 O. G. 975.

To read the issue, therefore, on to appellee's device where the question of patentability is exceedingly close, would be to

give him something strongly anticipated by the prior art; while confining it to appellant's invention we have an easy application of the issue to a device distinctly novel, where the resetting operation is clearly confined to the breakdown connection.

Rice v. Schutte, 180 O. G. 605.

The issues should be construed as broadly as possible, without giving a strained or unnatural meaning.

Emerson v. Sanders, 174 O. G. 831.

The question of the scope of the issue is, however, not one upon which testimony should be permitted. The question is one to be determined by the tribunals of the Office under the well settled practice of giving claims in issue the broadest construction which they will support. Von Keller v. Hayden v. Kruh will support Jackson, 173 O. G. 285.

Von Keller v. Hayden v. Kruh v. Jackson, 173 O. G. 285.

The decisions of the Court of Appeals of the District of Columbia in the case of Blackford v. Wilder, 127 O. G. 1255, and Horines v. Wend, 129 O. G. 2858, in which the court discountenances second interferences, emphasize the importance of a clear and definite issue.

Walker & Walker v. Gichrist, 164 O. G. 507.

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

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

A limitation in a claim that is without function ought not to be used to deprive an inventor of his rights.

Arbetta v. Lewis, 154 O. G. 516, 519.

"Independent circuits" construed in a previous case on a different device.

Weintraub v. Hewett, 148 O. G. 1087.

Apparently a limitation was disregarded as being non-functional, but this limitation was what distinguished it from the art. Overruled.

Sinclair v. Engel, 147 O. G. 769.

A limitation of the issue not required by the prior art refused in order to avoid opponent's date of reduction to practice.

Gutz & Hosack v. Crozier, 140 O. G. 757.

The party who first presents claims should not later be heard to urge limitations upon terms thereof which might

readily have been expressed therein had it been intended that they should be so restricted. (Cases.)

Junge v. Harrington, 131 O. G. 691.

In the case of patents for improvements, it is necessary to consider the state of the art.

Oehrle v. W. H. Horstmann Co., 131 F. R. 490.

The function is not inherent in the mechanism shown for the reason that it does not flow from the mechanism as shown and described, but from that mechanism minus one of its parts.

Scott v. Southgate, 125 O. G. 1703.

A metal bar with corrugated sides, the relative position of the corrugations on the respective sides being accidental, is not evidence of the conception of the invention set forth in a claim for a metal bar provided with interceptions in the surface and having substantially the same cross-sectional area throughout its length.

Johnson v. Mueser, 124 O. G. 2533.

Good case.

Manley v. Williams, 1911 C. D. 397.

Podlesak v. Podlesak, 123 O. G. 1989.

Would not construe the qualification in the issue, that the tongue was of nonmagnetic material.

Andrews v. Wilson, 123 O. G. 1667.

Where claims are copied from a patent they are to be construed in light of such patent.

Bourn v. Hill, Jr., 123 O. G. 1284.

Meanings should not be construed into claims, nor should the claims be limited by construction.

Cutler, 123 O. G. 655.

Words given a broad meaning so as to include both devices.

Limp v. Randall & Bates, 123 O. G. 319.

Where the terms are broad enough to cover both structures it matters not that there are specific differences in function.

Gordon v. Wentworth, 120 O. G. 1165; *Heintzelman v.*

Vroalstad, 120 O. G. 906; see *Goss v. Scott*, 96 O. G. 842.

Limitations read into a claim by the moving party is not ground for dissolution.

Votey v. Gally, 119 O. G. 339.

Claims pending in the Office should not be narrowed by reading limitations into them to avoid the prior art. Practice condemned.

Briggs v. Lillie v. Cooke, 116 O. G. 871.

Rule 96. Failure to Prepare for Interference.

Whenever the claims of two or more applications differ in phraseology, but relate to substantially the same patentable subject matter, the examiner, when one of the applications is ready for allowance, shall suggest to the parties such claims as are necessary to cover the common invention in substantially the same language. The examiner shall send copies of the letter suggesting claims to the applicant and to the assignees, as well as to the attorney of record in each case. The parties to whom the claims are suggested will be required to make those claims and put the applications in condition for allowance within a specified time in order that an interference may be declared. Upon the failure of any applicant to make the claim suggested within the time specified, such failure or refusal shall be taken, without further action as a disclaimer of the invention covered by the claim, and the issue of the patent to the applicant whose application is in condition for allowance will not be delayed unless the time for making the claim and putting the application in condition for allowance be extended upon a proper showing. If a party make the claim without putting his application in condition for allowance, the declaration of the interference will not be delayed, but after judgment of priority the application of that party will be held for revision and restriction, subject to interference with other applications.

Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney, the examiner shall notify each of said principal parties and also the attorney of this fact.

HISTORY.

A part of Rule 51 of 1878 reads as follows: "Where a party who is required to put his case in proper shape for the purposes of an interference delays doing so beyond a reasonable time specified, the interference will at once proceed. After final judgment of priority the application of such party will be held for revision and restriction, subject to interferences with other applications or new references."

Only verbal changes were made in 1879.

The present form of the rule had its origin in the case of *Hammond v. Hart*, decided April 25, 1898. (1898 C. D. 52.)

See Rule 94 of 1879 as to suggestion of claims.

In *Wolfenden v. Price*, 1898 C. D. 87, Commissioner Duell said: "In deciding the case of *Hammond v. Hart* it was my intention to bring about a practice in the Office that would result in making the issue of an interference both definite and clear, and to that end to cause the parties to the proposed interference to claim substantially the same patentable invention so as to obviate the many motions and appeals that have unnecessarily arisen in the Office."

The correctness of this decision has been called in question in a pamphlet by Mr. J. H. Whitaker published by the Patent Law Association of Washington, D. C.

The edition of the Rules of July 18, 1899, reads: "Whenever two or more applications disclose the same invention, and one of said applications is ready for allowance and contains a claim to said invention, the Primary Examiner will notify the other applicant of such fact, furnish him with a copy of the patentable claim, and require him to make such claim and put his case in condition for allowance within a specified time, so that an interference can be declared. Upon the failure of any applicant to make the claim suggested within the time specified, such failure or refusal shall be taken without further action as a disclaimer of the invention covered by the claim, and the issue of the patent to the applicant whose application is in condition for allowance will not be delayed unless the time for making the claim and putting the application in condition for allowance be extended upon a proper showing. If a party make the claim without putting his application in condition for allowance, the declaration of the interference will not be delayed, but after judgment of priority the application of such party will be held for revision and restriction, subject to interference with other applications.

See notes to Rules 95 and 97.

CONSTRUCTIONS.

- (1) PURPOSE AND MEANING OF RULE.
- (2) WHEN SUGGESTION PROPER.
- (3) CONSTRUCTION AND EFFECT OF CLAIMS.
- (4) NEGLIGENCE AND REFUSAL TO MAKE CLAIM—TIME LIMIT.
- (5) ADDITIONAL CASES.

(1) Purpose and Meaning of Rule.

An action under this rule establishes a date, from which the one year limited for action by the applicant runs.

Coulson v. Callendar, etc., 1902 C. D. 395, 101 O. G. 1607.

Rule 109 contemplates the possibility of the allowance by the Examiner upon argument of claims which were for some reason not suggested under Rule 96.

Davis v. Ocumpaugh v. Garrett, 103 O. G. 1679.

The procedure of this rule is applicable where it is proposed to place an application into interference with a patent.

Card & Card, 112 O. G. 499.

The requirement as to the form of a claim is not for the purpose of bringing about a conflict, but to define the conflicting subject matter in the same words, so as to avoid confusion and to prevent disputes.

Card & Card, 112 O. G. 499-500.

Claims taken from a patent were refused entry because involving new matter.

Dilg, 112 O. G. 953.

The purpose of Rule 96 is to bring about uniformity in the wording of the claims. The practice is a good one. No reason appearing why the claims of R. and B. should not be brought to correspond in phraseology, the interference should have been dissolved on the ground of irregularity in the declaration.

Reichert v. Brown, 124 O. G. 2903.

I am of the opinion that the adoption of suggested claims and the prosecution of an interference can not be construed as an election of the species involved in the absence of other acts or statements on the part of the applicant binding him to such species.

Burk, 184 O. G. 2089.

An application abandoned and renewed, meanwhile a patent issued to another applicant. The first applicant inserted

claims from the patent, held that this was not contrary to the principles laid down in *Bechman v. Wood*, 89 O. G. 2459.

Jansson v. Sarsson, 132 O. G. 477.

Cases passing on the subject matter of this rule.

Harnisch v. Gueniffit, Benert and Nicault, 128 O. G. 455;

Martin v. Mullin, 127 O. G. 3216.

(2) *When Suggestion Proper.*

Three applications showing apparatus for performing a process only one of which claimed the process. In the latter division was required. The process claimed should not be suggested to the other applicants as they were not trying to claim it (*Myers v. Brown*, 139 O. G. 197), but if an apparatus claim covering the three applications can be found it should be suggested.

Wirner, 139 O. G. 197.

A second species may be suggested to an applicant, and incorporated into his application, for the purpose of an interference, but may afterward be required to be canceled.

Priebe, 221 O. G. 351.

An examination of the record of the patent makes it clear that the invention of this issue was not disclosed in the original specification and drawings. This omission, coupled with the fact that he failed to disclose the same until it was admittedly disclosed to him, is almost sufficient of itself to warrant the conclusion that *McKnight* never independently invented the invention of the issue.

McKnight v. Pohle & Croasdale, 105 O. G. 495.

The question as to the right of *Brown* to make the claims is one relating to the merits of the case and depends upon the disclosure made by *B* in his application. The Examiner has held that the disclosure in the *Brown* application is sufficient to support the claims corresponding to the issue, and from this affirmative decision there is no appeal. (Rule 124.)

Myers v. Brown, 112 O. G. 2093-4.

Where motion for dissolution is based upon the contention that the suggestion of the claim in interference to a party by the Examiner was improper because said party had not claimed substantially the same invention. Held that the question raised involves no such irregularity in declaring the interference as might preclude proper determination of the question of priority of invention, and that no ground for dissolving the interference is presented.

Meden v. Curtis, 117 O. G. 1795.

An interference was decided on the record. In view of the fact that the new claims were made by the successful party,

that they differ from the issue in other respects than in scope, and that the defeated party already has an allowable claim relating to the same subject matter, it is held that the Examiner may properly suggest the new claims to the party under Rule 96.

Cramer & Hoak, 118 O. G. 1068.

Where an applicant appealed from the refusal of an Examiner to inform him of the subject matter of the issue in a proposed interference in order that he might amend so as to include the issue in his claims. Held that it is not the practice of the Office to suggest claims to an applicant in order to create possible interferences.

Weeden, 1892 C. D. 185.

Where a party shows a certain structure and claims it broadly, and his claims are all rejected, and another party claims the same structure more narrowly and such claims are allowed and suggested to the other party. Held no error in so suggesting such claims, as both parties were attempting to claim the same invention within the meaning of Rule 96.

Templin v. Sergeant, 119 O. G. 961.

Claims should be suggested only when parties are attempting to claim the same thing.

Myers v. Brown, 112 O. G. 2093; Templin v. Sergeant, 119 O. G. 961; Bryant, Wolcott & Davidson, 121 O. G. 2663.

In the case at bar, however, the tension controller of the Quest and Hogan application was specifically different from the tension controller of the Ostrom application. The practice announced in Hammond v. Hart, therefore, would not have warranted the Examiner in suggesting the Quest and Hogan claims to Ostrom.

Quest v. Ostrom, 106 O. G. 1502; see also Townsend v. Thullen, 142 O. G. 1116.

The Examiner ignoring the plain dissimilitude between T's claim one, allowed by his superiors over his rejection only on the narrow construction, and the mufflers Mead is talking about in his application, invited the latter as above stated to adopt it, and thus gave it a breadth of application for which neither its originators ever contended, nor the Examiners-in-Chief granted.

Phoenix Knitting Co. v. Rich, 194 Fed. 725.

The claims were suggested to appellant under the provisions of Rule 96. When appellant accepted the claims and included them in his application, he laid claim to the possession of the invention which they define.

If now the appellant wishes to withdraw the claim to the

possession of the invention disclosed in the issue, he may properly do so by conceding priority or abandoning the invention.

Miller v. Perhams, 127 O. G. 2667.

(3) *Construction and Effect of Claims.*

See notes to Rules 95 and 97.

Where there are two applications each making a specific claim and no generic claim to an invention that might be included in one generic claim, in the absence of any means of avoiding the possible question as to equivalents, the Examiner will suggest a generic claim to the applicants.

Thompson, 1902 C. D. 6, 98 O. G. 227.

The question whether those claims can be made by Costello and are suggested to him under Rule 96, can not be considered as affecting Hicks' rights unless and until Costello makes them.

Hicks v. Costello, 103 O. G. 1164.

The question of identity of invention is in general one which should be settled by the experts of the Office.

Luger v. Browning, 104 O. G. 1123.

The Hammond v. Hart decision, 83 O. G. 743, (1898 C. D. 52) did not make it mandatory on Examiners to suggest claims, but merely stated that under certain conditions, no good reason appearing for not doing so; the only condition expressly referred to was where two applicants disclosed the same specific structure and one of the applicants had specific claim to the structure and the other a generic claim thereto.

Quest v. Ostrom, 106 O. G. 1501.

There seems to be no reason why the Examiner should enter into a discussion or argument with these applicants as to the patentability of suggested claims.

Sutton & Steele, 107 O. G. 541.

The claims were suggested to appellant under the provisions of Rule 96. When appellant accepted the claims and included them in his application, he laid claim to the possession of the invention which they define.

If now the appellant wishes to withdraw the claim to the possession of the invention disclosed in the issue, he may properly do so by conceding priority or abandoning the invention.

Miller v. Perham, 123 O. G. 2667.

Where claims are copied from a patent they are to be construed in light of such patent.

Bourn v. Hill, Jr., 123 O. G. 1284; Townsend v. Thullen, 142 O. G. 1116.

Each of the two applicants for patent has made a claim in identical language. The claim reads without violence to the proper natural meaning of its terms upon the devices disclosed by each party; but the patentable invention which this claim is supposed to represent is found only in the device of one of the parties; clearly under these circumstances the claim fails to define the invention.

Podlesak & Podlesak v. McInnerney, 123 O. G. 1989.

(4) *Neglect and Refusal to Make Claim—Time Limit.*

A time limit should be set where claims are rejected on a prior patent on the ground that the applicant can make certain thereof and can establish his right to a patent only by an interference.

Card and Card, 112 O. G. 499; Weber and Woodford, 264 O. G. 863.

Rule 96 provides that upon a proper showing the time for making the suggested claims may be extended. It is within the discretion of the Examiner to grant such extension if in his opinion the showing warrants it.

Curtis, 97 O. G. 189.

If applicant is prosecuting his own case, and has gone abroad, time to communicate with him should be allowed.

Hellmund, 141 O. G. 555.

See example of unsettled claim.

Farnsworth v. Andrews, 1876 C. D. 3, 9 O. G. 195.

Where a party unreasonably delays to put his application in such form that an interference may be declared, a patent will be issued to his opponent.

Lombard, 1888 C. D. 56, 43 O. G. 1347.

Claim proposed by Examiner but not accepted for ten years and until after an interference on broader claim.

Gray, 1889 C. D. 91, 46 O. G. 1277.

The Office and not the applicant is the judge of the reasonableness of the time.

Lombard, 1888 C. D. 56, 43 O. G. 1347.

The time at which the request is made, whether the request and accompanying showing be within the time limited or not, may affect the character of the showing, but it does not affect the jurisdiction of the Examiner.

Curtis, 1901 C. D. 147, 97 O. G. 189.

In this case there is an allowable claim under consideration,

and a party who can make it and will not do so within a specified time.

Furman v. Dean, 111 O. G. 1366-68.

Where applicant seeks to enter the suggested claim after the expiration of the time limited, the claim should be entered and then rejected.

Swift, 111 O. G. 2494.

Where an amendment is filed under the provisions of Rule 96, after the limit of time specified by the Examiner has expired and the Examiner rejects the claims in accordance with the rule, the rejection relates to the merits and is not reviewable by the Commissioner upon petition, but should be considered on appeal in the first instance by the Examiners-in-Chief.

Haug, 97 O. G. 192.

Applicant refused to put his claims in proper shape insisting upon his right to amend any time within one year. Held that the Examiner should suggest claims to both parties, and proceed with the interference leaving any question of estoppel for future consideration. If applicant refuses to make claims suggested he should be held to have abandoned their subject matter.

Ferris, 114 O. G. 541.

Where an applicant is a resident of a foreign country, the Examiner should grant the attorney's petition for a sufficient extension of time to consult his client.

Schulze, 114 O. G. 1550.

Rule 96 contemplates that the issue shall be in the terms of the claims actually made by both parties, or at least that both parties should have had an opportunity to make such claims. If neither party has made a claim which can be made by the other party by reason of the inclusion of elements which are not of the essence of the invention, then as pointed out in *ex parte Thompson* (98 O. G. 227), the Examiner should suggest a claim to each which will cover the real invention common to the two cases, omitting such limitation.

McBride v. Kroder, 133 O. G. 1680.

(5) Additional Cases.

Cases that pass on the subject matter of this rule:

Klepetko, 126 O. G. 387; Harvey, 102 O. G. 621-22;
Holland, 1902 C. D. 199, 99 O. G. 2548; Haug, 1901
C. D. 153, 97 O. G. 192; Tizley, 89 O. G. 2259; Hildreth, 1899 C. D. 248, 1901 C. D. 186, 97 O. G. 1374;

Van Auken v. Osborne v. Harrison v. Canfield & Van Auken, 119 O. G. 1584; Egly v. Schulze, 117 O. G. 2366; Blackwood v. Wilder, 124 O. G. 319; Anderson v. Vrooman, 123 O. G. 2975; Weidemann, 1897 C. D. 194, 87 O. G. 2245.

Rule 97. Examiner Preparing Interference Notices, etc.

When an interference is found to exist and the applications are prepared therefor, the primary examiner shall forward to the examiner of interferences the files and drawings; notices of interference for all the parties (as specified in Rule 103) disclosing the name and residence of each party and those of his attorney, and of any assignee, and, if any party be a patentee, the date and number of the patent; the ordinals of the conflicting claims and the title of the invention claimed; and the issue, which shall be clearly and concisely defined in so many counts or branches as may be necessary in order to include all interfering claims. Where the issue is stated in more than one count the respective claims involved in each count shall be specified. The primary examiner shall also forward to the examiner of interferences for his use a statement disclosing the applications involved in interference, fully identified, arranged in the inverse chronological order of the filing of the completed applications, and also disclosing the issue or issues and the ordinals of the conflicting claims, the name and residence of any assignee, and the names and residences of all attorneys, both principal and associate.

HISTORY.

Previous to the Revision of December, 1879, the Primary Examiner was required to notify the parties, and in the Rules of 1878 he was required to "briefly and concisely define the interfering subject matter."

See Rule 97 of 1879.

See notes to Rules 95 and 96.

CONSTRUCTIONS.

Issue and Notices.

If the Examiner of Trade-Marks finds it necessary to include two applications he should take care to specifically inform the other party of that fact.

Hoeker v. Farr, 193 O. G. 220.

A case that passes on the subject matter of this rule.

Hick, 172 O. G. 261.

"Means" followed by a statement of function is properly readable on a structure in which such means consists of more than one element.

Lacroix v. Tyberg, 148 O. G. 831.

A claim should be given the broadest interpretation its terms will permit.

Milans, 135 O. G. 1122; Pratt v. De Ferranti and Hamilton, 148 O. G. 569.

Nevertheless it can not be enlarged beyond the plain import thereof as set forth in the specification on which the claim is based.

Sinclair v. Engel, 147 O. G. 769.

It is well settled that where a party copies the claim of a patent for the purpose of interference such claim must be read in the light of the disclosure of the patent. (Cherney v. Clause, 116 O. G. 597; Bowen v. Hill, 123 O. G. 1284; Sobey v. Holsclaw, 126 O. G. 304.)

Sinclair v. Engel, 147 O. G. 769.

When an interference is declared between an applicant and a patentee and the Examiner is of the opinion that the applicant has presented claims which do not differ, materially from the issue of the interference he should append to the declaration of the interference a statement that such claims, specifying them by number, will be held subject to the decision in the interference. If in his opinion there are no such claims he should append to the declaration a statement to that effect. The Primary Examiner directed to proceed in conformity to this practice.

Earll v. Love, 140 O. G. 1209.

Where the only claims are too broad in view of the state of the art.

Kafer & Gould v. Dennison, 1869 C. D. 14.

The devices in interference should so resemble each other

that a patentable form of claim could be framed which should include both devices.

Sargent v. Burge, 11 O. G. 1055.

The parties have no right to be heard as to what shall and what shall not be included in the interference.

White v. Demarest, 41 O. G. 1161.

The practice of appropriating literally the claim of a later inventor, which is drawn with reference to the employment of terms found in the preceding specification, and then applying the claims so appropriated to a specification of older date which does not contain words and expressions suitable to lead up to the language of the appropriated claim, condemned.

Rogers v. Winssinger, 1891 C. D. 111.

The test of an interference resides in the claims and not in mere disclosures in the application, and Office rules must be construed in connection with this settled principle of law.

Van Depoele v. Daft, 1892 C. D. 15; *Searle v. Frumveller v. Sessions*, 1892 C. D. 27; *Dodd v. Reading*, 1892 C. D. 49.

It is improper in declaring an interference, to include a broad claim in a narrow issue. The issue should be as broad as the broadest claim involved therein.

Short v. Sprague, 1891 C. D. 166.

The question whether an interference in fact exists depends not merely upon the language employed in the respective claims, but upon the question whether in addition to similarity in phraseology there is an interference between the subject matter of the respective claims.

Rogers v. Winssinger, 1891 C. D. 111.

It is a cardinal principle that in declaring an interference the issue must be as broad as the broadest claim included therein.

Morgan v. Hanson, 77 O. G. 154.

The correct solution of the question depends upon whether the two things disclosed by the respective parties have been clearly claimed and with the same limitations.

Essex v. Wood, 89 O. G. 353.

While it is unfortunate that there should be differences of opinion as to the meaning of the issue, such differences alone do not justify a dissolution of the interference.

Annand v. Spalckhaver, 97 O. G. 2083.

In an interference between a patent and an application, the issue is to be defined by reference to the patent.

Feder v. Poyet, 89 O. G. 1343-4.

Rule 97 contains nothing to authorize the disclosure of a

caveat which may have been referred to during the *ex parte* consideration of a case.

In re Lowry, 90 O. G. 445; Holland, 99 O. G. 2548.

The requirement of Rule 97 that "the invention claimed" be disclosed, means that the invention claimed should be disclosed by title.

Hoffstetter v. Kahn, 99 O. G. 1624.

The Office must define the issue and the testimony must be confined to this issue.

Brill & Adams v. Uebelacker, 99 O. G. 2966.

The Primary Examiner should arrange the parties in the inverse chronological order in which they filed their applications directly involved in the interference. He should call attention to any earlier application and leave the question of its effect for the determination of the Examiner of Interferences.

Raulet & Nicholson v. Adams, 114 O. G. 1827.

Without further delay of which there has been too much in this proceeding.

Normand v. Krimmelbein, 115 O. G. 249.

Though the applicant is the original inventor of the rotating baking surface he has presented no convincing evidence tending to prove originality of the combination claims, and priority upon these claims is awarded to the patentee.

Cherney v. Clauss, 115 O. G. 2137.

Remedy for failure to comply with this rule is by motion under Rule 122.

Cazin v. Von Welsbach, 119 O. G. 650.

Clerical error may be corrected by a letter from the Primary Examiner.

Gully v. Burton, 120 O. G. 325.

The terms of a claim should be given broadest construction.

Podlesak & Podlesak v. McInnerney, 120 O. G. 2127.

When a claim is taken from a patent to form an issue, that issue must be construed in reference to the specification of the patent.

Andrews v. Nilson, 123 O. G. 1667.

The senior party who has a patent may not be heard to ask that his claim be rewritten so that he may prevail in an interference.

Andrews v. Nelson, 123 O. G. 1667.

I am of the opinion that these terms are too vague and indefinite to point out with certainty any particular structure in either device, and that the interference should be dissolved as to this count on the ground of irregularity in declaration.

Anderson v. Vrooman, 123 O. G. 2975.

New references discovered "The Primary Examiner is directed to withdraw the notice of hearing which has been sent out and to determine whether the interference should continue without the aid of argument by either party."

Behrend v. Lamme v. Tingley, 124 O. G. 2536.

Care should be exercised in forming the issue that the terms used by the parties have a clear, definite, and common meaning in each application.

Anderson v. Vrooman, 123 O. G. 2975.

Less than half this number of counts should have sufficed.

Kempshall v. Royce, 129 O. G. 3162.

It is to the interest of the interfering parties, the public and the Office that the counts of the interference should properly cover the patentable invention which is common to the applications involved and that second interferences should be avoided.

Becker v. Otis, 129 O. G. 1267.

The Office is no more competent than the courts to say that an element which an applicant has put into his claim is an immaterial one.

Streat v. Freckleton, 87 O. G. 695; *Collom v. Thurman*, 131 O. G. 359.

In general while applications are pending in the Office the claims thereof will be construed as broadly as the ordinary meaning of the language will permit, for reasons stated in my decisions in *Cuter*, 123 O. G. 655.

Briggs v. Cooke v. Jones & Taylor, 116 O. G. 871;
Podlesak & Podlesak v. McInnerney, 123 O. G. 1989;
Lovejoy v. Cady, 123 O. G. 654; *Junge v. Harrington*,
131 O. G. 691; *Jenne v. Brown v. Booth*, 1892 C. D.
78.

See also notes under "Construction of the Issue," Rule 95.

Rule 98. Revision of Notices by Examiner of Interferences.

Upon receipt of the notices of interference, the examiner of interferences shall make an examination thereof, in order to ascertain whether the issues between the parties have been clearly defined, and whether they are otherwise correct. If he be of the opinion that the notices are ambiguous or are defective in any material point, he shall transmit his ob-

jections to the primary examiner, who shall promptly notify the examiner of interferences of his decision to amend or not to amend them.

CONSTRUCTIONS.

The Examiner properly objected to the declaration of an interference on the ground that the invention involved was met by the reference of record.

Lloyd v. Engeman, 1872 C. D. 253.

A case that passes on the subject matter of this rule.

Hoffstetter v. Kahn, 1902 C. D. 180, 99 O. G. 1624.

Rule 99. Reference to Commissioner.

In case of a material disagreement between the examiner of interferences and the primary examiner, the points of difference shall be referred to the Commissioner for decision.

CONSTRUCTIONS.

See Dixon v. Bliss, 185 O. G. 1381.

For example where the interference subject matter is not briefly and concisely stated and claims involved are not stated, this was an error of the Primary Examiner.

Stephen v. Bailey, 1878 C. D. 7, 13 O. G. 45.

Case referred to the Commissioner where there was a disagreement between the Examiner of interferences and the principal Examiner as to whether the claim was met by reference of record.

Lloyd v. Engeman, 1872 C. D. 253.

Cases that pass on the subject matter of this rule:

Smith v. Bunnell, 103 O. G. 890; Mills v. Torrance, 106 O. G. 544; Hoffstetter v. Kahn, 1902 C. D. 180, 99 O. G. 1624; Hildreth, 1901 C. D. 186, 97 O. G. 1374.

Rule 100. Primary Examiner Retains Jurisdiction.

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

See notes to Rules 101-123.

Rule 101. Jurisdiction of Examiner of Interferences.

Upon the institution and declaration of the inter-

ference, as provided in Rule 102, the examiner of interferences will take jurisdiction of the same, which will then become a contested case; but the law examiner will determine the motions mentioned in Rule 122, as therein provided.

See notes to Rule 123.

CONSTRUCTIONS.

The reference of motions to dissolve to the Law Examiner in the last revision, has made a part of the following notes of only historical interest.

For the reasons stated in my decision in *Clements v. Richards v. Meissner*, 111 O. G. 1627, it is competent for the Commissioner to entertain a motion to restore jurisdiction to the Examiner of Interferences, to hear and determine a motion to reopen while the case is pending before any of the appellate tribunals of this Office.

Clausen v. Dunbar v. Schellinger, 129 O. G. 499.

Jurisdiction of Examiner of Interferences.

Lowry and Cowley v. Spoor, 122 O. G. 2687.

Jurisdiction restored to the Examiner of Interferences after time limited for appeal had expired.

The party should have a bearing upon the question whether the showing made by him is sufficient to warrant the reopening of the case.

Lipscomb v. Pfeiffer, 122 O. G. 351.

Motions to shift the burden of proof should be made before the Examiner of Interferences within the twenty days after the approval of the preliminary statements allowed for motions.

Changing jurisdiction from Primary Examiner to Examiner of Interferences.

Raulet & Nicholson v. Adams, 114 O. G. 1827.

The only apparent questions for consideration on a motion to restore jurisdiction to the Examiner of Interferences, are whether the motion is in proper form and whether so far as can be seen without going into the merits of that motion, it is brought in good faith.

Newell v. Clifford v. Rose, 122 O. G. 730.

Examiner of Interference refused to consider a motion to extend time for appeal, made on the last day of the time

limit and set for hearing two days after for want of jurisdiction, jurisdiction restored on motion.

Jean and Goode v. Hitchcock, 1902 C. D. 342, 100 O. G. 3011-12.

The restoration of jurisdiction for one purpose does not restore it for all.

Benger v. Burson, 1902 C. D. 164, 99 O. G. 1384.

Motion to reopen for the purpose of taking more testimony comes properly before the Examiner of Interferences.

McCallum v. Bremer, 1900 C. D. 186, 93 O. G. 1918.

The Examiner of Interferences has jurisdiction to hear and determine the fact of joint or sole invention in an interference between joint patentees and a sole applicant who is one of said patentees.

Lovrien v. Banister, 1880 C. D. 152, 18 O. G. 299; Ex parte Bruker, M. S.

If it is decided that there was no joint invention the sole applicant would be the prior inventor, as the entity the joint inventors never invented it at all.

Kohler v. Kohler & Chambers, 1888 C. D. 19, 43 O. G. 247; see Harrison v. Hogan, 1880 C. D. 191, 18 O. G. 921.

Upon a proper showing the jurisdiction of the Examiner of Interferences will be restored for the purpose of considering a motion to dissolve.

Short v. Sprague, 1891 C. D. 166.

Judgment of priority given by the Commissioner and the case remanded to the Primary Examiner to determine the question of a statutory bar by reason of public use.

Smith v. Dimond, 1881 C. D. 34, 20 O. G. 742.

A motion to dissolve an interference declared in violation of Rule 127 should be determined by the Examiner of Interferences.

Edison & Gilliland v. Phelps, 38 O. G. 539; see notes to Rule 142, 1887 C. D. 11.

Questions of statutory bar of public use referred to the Primary Examiner by the Commissioner without an appeal from the decision of the Examiner of Interferences.

Quimby v. Randall, 1878 C. D. 111, 14 O. G. 748.

Facts establishing two years' public use before application for a patent developed in an interference can not afterwards be explained away by ex parte affidavits. Case remanded to the Primary Examiner to consider such question.

Stearns v. Prescott, 1878 C. D. 24, 13 O. G. 121.

The question of two years' public use as a statutory bar receives consideration from the Examiner of Interferences. He overlooks in this connection, the question of sale. This appears to be a very important point. This case was remanded by the Acting Commissioner to the Primary Examiner to consider the question of sale more than two years before application.

Keller & Olmesdahl v. Felder, 1876 C. D. 246, 10 O. G. 944.

The law of 1836 provided that in connection with interference proceedings, like proceedings should be had to determine which or whether either of the applicants is entitled to receive a patent as prayed for. But in the Act of 1870 this provision was omitted.

Smith v. Perry, 1876 C. D. 12, 9 O. G. 688.

Questions of patentable combinations remanded to the Primary Examiner for consideration.

Lynch & Raff v. Dryden & Underwood, 1873 C. D. 73.

If in the judgment of the Examiner of Interferences neither party is entitled to a patent for want of novelty, he must send the question back to the Primary Examiner for determination. He can not decide it himself.

Neuboecker v. Schafhaus, 1873 C. D. 138.

Cases that pass on the subject matter of this rule:

Kugele v. Blair, 125 O. G. 1350; Behrend v. Lamme v. Tingley, 124 O. G. 2536.

Rule 102. Institution and Declaration of Interference.

When the notices of interference are in proper form, the examiner of interferences shall add thereto a designation of the time within which the preliminary statements required by Rule 110 must be filed, and shall, *pro forma*, institute and declare the interference by forwarding the notices to the several parties to the proceeding.

Rev. Stat., sec. 4904.

CONSTRUCTIONS.

Contains nothing to authorize the disclosure of a caveat that may have been referred to during the *ex parte* consideration of a case.

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

Practice relative to trade-marks.

Frank & Gutmann v. MacWilliam, 114 O. G. 542.

Practice in case of a deceased inventor, heirs unknown.

Handley v. Bradley, 1899 C. D. 201, 89 O. G. 524.

Notice should be sent to the assignee of one of the inventors.

Aldrich & Spalding v. Bingham, 1871 C. D. 90.

Cases that pass on the subject matter of this rule.

Davis v. Garrett, 123 O. G. 1991; Kugele v. Blair, 127 O. G. 1253.

Rule 103. Notices to Parties.

The notices of interference shall be forwarded by the examiner of interferences to all the parties, in care of their attorneys, if they have attorneys, and, if the application or patent in interference has been assigned, to the assignees. When one of the parties has received a patent, a notice shall be sent to the patentee and to his attorney of record.

When the notices sent in the interest of a patent are returned to the office undelivered, or when one of the parties resides abroad and his agent in the United States is unknown, additional notice may be given by publication in the Official Gazette for such period of time as the Commissioner may direct.

CONSTRUCTIONS.

Replying to your letter of the 25th ultimo, you are advised that where a series of interferences are declared the issues of which are more or less closely related, each interference is provided with an identifying letter signifying that particular case is one of a series. It ordinarily has no significance to the parties and is used only for convenience in keeping the cases together.

Respectfully,

W. F. Woodlard, Chief Clerk.

Case that passes on the subject matter of this rule:

Commercial Mica Co., 129 O. G. 479; Hick, 172 O. G. 261.

Rule 104. Motion for Postponement of Time for Filing.

If either party require a postponement of the time for filing his preliminary statement, he shall present his motion, duly served on the other parties, with his reasons therefor, supported by affidavit, and such motion should be made, if possible, prior to the day previously set. But the examiner of interferences may, in his discretion, extend the time on *ex parte* request or upon his own motion.

CONSTRUCTIONS.

Court of Appeals will not review in ordinary cases.

Churchill v. Goodwin, 141 O. G. 568.

Facts considered sufficient to excuse the failure to file within the time limited.

Charlton v. Sheldon, 111 O. G. 2492.

The fact that applicant supposed notice to relate to one case when it in fact related to another is not a good excuse.

Hartley v. Mills, 110 O. G. 2236.

It is a matter of discretion with the Examiner whether time shall be extended.

Quick v. McGee, 107 O. G. 1376.

The question of primary importance is not whether they were able to file their statements within the time fixed, but why they did not make a showing of the facts and ask relief at the proper time.

Fowler v. Temple et al. v. Dyson v. McBerty, 107 O. G. 543.

A motion to extend time for filing preliminary statement must be for a definite time. Affidavit supporting it must be specific.

Keech v. Birmingham, 1902 C. D. 473, 101 O. G. 2825.

The declaration of interference and setting of time for filing of preliminary statements is constructive notice that testimony will be taken in a reasonable time.

Davis v. Cody, 1902 C. D. 388, 101 O. G. 1369.

Time for filing postponed by stipulation of counsel.

Jones v. Greenleaf, 1879 C. D. 23, 15 O. G. 560.

The attorney for the patentee refused to file their preliminary statement till they should find out as much of their

opponent's invention (an applicant) as he had means of knowing of theirs. An extension of time was refused.

Spalding & Aldrich v. Winchester, 1871 C. D. 94.

A case that passes on the subject matter of this rule.

110 O. G. 604.

Rule 105. Certified Copies Used in Interference Proceedings.

When an application is involved in an interference in which a part only of the invention is included in the issue, the applicant may file certified copies of the part or parts of the specification, claims, and drawings which cover the interfering matter, and such copies may be used in the proceeding in place of the original application.

HISTORY.

Rule 105 was introduced in 1888.

CONSTRUCTIONS.

- Whether or not the copy filed is sufficient to enable one to understand the mode of operation of the device, is a matter which should be considered in the first instance by the Primary Examiner who will fix a day upon which the parties may be heard.

Kugele v. Blair, 125 O. G. 1350.

In a motion for dissolution based upon the certified copy, it was assumed that such copy contained everything pertinent.

Fagan v. Graybill, 121 O. G. 1013.

Where a rejected claim is included in a certified copy, all actions relative thereto should be included in the copy.

Fagan v. Graybill, 121 O. G. 1013.

Where a party files a copy of portions of his application for use in interference proceedings, the question of sufficiency of the copy is a matter to be determined by the Primary Examiner in the first instance. A day should be fixed upon which the parties may be heard.

Riker v. Saw, 120 O. G. 2754.

If the petitioners think that the disclosure made by the certified copies of the parts of the earlier case, filed by Canfield, is incomplete or insufficient as to the subject matter involved in this interference, they should bring the matter

before the Primary Examiner who will determine the question in the first instance after a hearing of the parties.

Riker v. Law, 120 O. G. 2754; Kugele v. Blair, 125 O. G. 1350; Lewis v. Deulch v. Lum v. Murphy v. Canfield, 181 O. G. 265.

The reason for the rule of secrecy would seem to apply in the case of patents issued upon divisional applications.

Dyer, 106 O. G. 1508.

Provides for concealing a clearly divisible invention, but does not provide for concealing any part of a divisible invention in issue.

Davis v. Ocompaugh v. Gerrett, 103 O. G. 1679.

In a process application a claim having an additional step is a separate invention and may be reserved under the rule, the product is a part of the invention and may not be reserved.

Powrie, 1902 C. D. 200-1, 99 O. G. 2549.

If an application contains a description and claims of one or more inventions not related to the one in issue in such a manner as to affect its scope or meaning, the opposing party should not be allowed to inspect this part of the application.

Zweilusch v. Witteman, 75 O. G. 183.

Rule 105 is in accordance with law.

Smith & Thomas v. Cowles, 1885 C. D. 12, 30 O. G. 343.

Cases that pass on the subject matter of this rule:

Hall v. Dolmer, 189 O. G. 251; Shavir v. Dilg & Fowler, 157 O. G. 1001; Bastian v. Champ, 128 O. G. 2837.

Rule 106. New Application for Claims not in Interference.

When a part only of an application is involved in an interference, the applicant may withdraw from his application the subject matter adjudged not to interfere, and file a new application therefor, or he may file a divisional application for the subject matter involved, if the invention can be legitimately divided: *Provided*, That no claim shall be made in the application not involved in the interference broad enough to include matter claimed in the application involved therein.

CONSTRUCTIONS.

A new application for claims in interference should be suspended to await that action.

Wickers & Furling, 129 O. G. 2076.

Claims suggested were made in a separate application. Though made before the interference was declared they were made in view of such interference and Rule 106 applies.

Gueniffel, Benovit, and Nicault, 119 O. G. 338.

Where a divisional application is filed for the purpose of interference with claims to the same specific form shown in the original case, though the claims in the divisional case are narrower than the claims in the original case, held that the original application will not be allowed until the contemplated interference is terminated.

Gueniffel, Benovit and Nicault, 119 O. G. 338.

The rule was designed to apply especially to an interference between applicants, and for the purpose of preventing one party, going out before the world with a patent, showing perhaps the subject matter of a pending interference, and thereby leading the public to suppose that it was protected by said patent, to the great detriment, perhaps, of the other party contesting the claim. To some extent the provisos also apply in interference between an application and patent, for a portion of the claims in an interfering application ought not to be allowed, to go to patent under any circumstances, unless they are for separate inventions, or that, if the interference should result in the grant of another patent to the same party, the two will be distinct from each other; but if as in this case, one party already has a patent, the grant of a patent of the later date to another party can work no damage to the first patentee, even though it show the subject matter of the interference; especially if the second patent is subordinate to the one already in existence, which is the fact in this case.

Lacroix & Welch, 1873 C. D. 166.

Questions properly considered in an interference will not be considered in a separate application.

Robinson, 1902 C. D. 433, 101 O. G. 2079.

No proper line of division between an element and its combination.

Porter v. Loudon, 73 O. G. 155.

An applicant can only be allowed such claims in a separate application as can not be included in the interference by the other party under Rule 94.

Wheeler, 1883 C. D. 12, 23 O. G. 1031.

But only when the claims so withdrawn cover inventions which do not involve the device in manufacture.

Hermance v. Bussey, 1871 C. D. 216.

Cases that pass on the subject matter of this rule:

Phillips v. Sensenich, 122 O. G. 1047; Davis v. Garrett, 123 O. G. 1991; Assignee, 121 O. G. 689; Hildreth, 1901 C. D. 186, 97 O. G. 1374; Neiswanger, 1891 C. D. 37.

Rule 107. Disclaimer to Avoid Interference.

An applicant involved in an interference may, with the written consent of the assignee, when there has been an assignment, before the date fixed for the filing of his preliminary statement (see Rule 110), in order to avoid the continuance of the interference, disclaim under his own signature the invention of the particular matter in issue, and upon such disclaimer judgment shall be rendered against him.

CONSTRUCTIONS.

The statement of abandonment (Trade-Mark) was not so unequivocal and unconditional as required by the rules. The case is therefore remanded to the Examiner of Interferences with directions to vacate the judgment and resume proceedings.

The Thomson Wood Finishing Co. v. Renold Bros., 130 O. G. 980.

An ordinary amendment is not sufficient under this rule.

Colley v. Copenhaver, 107 O. G. 268.

The rules nowhere provide for the termination of an interference after it has once been declared on a mere cancellation of the claims.

Read v. Scott, 1902 C. D. 242, 100 O. G. 449.

The cancellation of claims is not sufficient.

Curtis v. Marsh, 1900 C. D. 127, 92 O. G. 1236.

If one makes a broad claim covering two species and the other makes a narrow claim to one species there is an interference which may be avoided by a disclaimer.

Kenyon v. Carter, 1894 C. D. 2; Grimmett v. Willett, 1894 C. D. 16.

This rule does not require a party who has been defeated in an interference proceedings and has canceled the claims

which were in interference to file a disclaimer of the matter covered by such claims.

Firm, 1887 C. D. 27, 39 O. G. 1199.

Where the Office has been in error in the declaration of the interference or has put a wrong construction upon the applicant's claim, he is enabled by the provisions of this rule to extricate himself from the controversy by properly restricting his application to the invention he desires to claim.

Drawbaugh v. Blake, 23 O. G. 1221.

A disclaimer should be put in proper form to be incorporated into the specification, and not as a preliminary statement.

Laverty v. Flagg, 1879 C. D. 303, 16 O. G. 1141.

Disclaimers must be as broad as the issue. Disclaiming the specific device claimed in opponents application will not extricate the disclaimant from an interference in which the issue is a general claim.

Walsh v. Shinn, 1879 C. D. 279, 16 O. G. 1006.

Parties can not stipulate patents into each others hands. Concessions of priority must be signed by the parties themselves and not by their attorneys, though the acts of the attorneys may be ratified by a party accepting the result of such stipulation.

Tucker v. Kahler, 1879 C. D. 71, 15 O. G. 966.

An applicant will be estopped from claiming in a reissue matter which was disclaimed in the original application, in order to avoid an interference. But a disclaimer not proved to have been authorized by applicant can not have that effect.

Lee v. Walsh, 1879 C. D. 29, 15 O. G. 563.

There is nothing in the nature of interference proceedings or in the character of the rights to be determined which precluded the application of the now well established doctrine of estoppel.

Berry v. Stockwell, 1876 C. D. 47, 9 O. G. 404; Walker on Patents, sec. 141.

An admission of priority will not debar a patent to the disclaimant on a subsequent application. Ex parte J. W. Cochran, 1871 C. D. 78, to the contrary cited and said to have been overruled by the Supreme Court of the District.

Allen & Moody v. Gilman, 1872 C. D. 204.

See note to Rule 119.

Cases that pass on the subject matter of this rule:

Townsend v. Corey, 119 O. G. 2237; Krakaw v. Harding, 107 O. G. 1662; Skinner v. Murray, 107 O. G. 542; Hildreth, 1901 C. D. 186, 97 O. G. 1374.

Rule 108. Inspection of Claims of Opposing Parties.

When applications are declared to be in interference, the interfering parties will be permitted to see or obtain copies of each other's file wrappers, and so much of their contents as relates to the interference, after the preliminary statements referred to in Rule 110 have been received and approved; but information of an application will not be furnished by the office to an opposing party, except as provided in Rules 97 and 103, until after the approval of such statements.

See note to Rule 105.

CONSTRUCTIONS.

No appeal lies from decisions which could not be made a ground of rejection of a claim after the determination of the interference.

Mortimer v. Thomas v. Brownson, 192 O. G. 215.

Where application is void, unless it has the filing date of the previous application, the opponent may have copies of the pertinent part of said first application.

Hall v. Folmer, 189 O. G. 251.

An interference held to be properly dissolved because of an insufficient affidavit under Rule 75.

Hidgkinson v. Roller, 185 O. G. 251.

It was suggested that the party had lost her right to conceal any part of her invention, by reason of delay, but it was held that it did not appear to be her fault altogether and was not sustained.

Harris v. Kennedy, 161 O. G. 530.

A party is entitled to copies of the communications relating to the invention in issue.

Harris v. Kennedy, 161 O. G. 530.

If an application filed under Rule 106 is referred to, it may be inspected.

Shaver v. Dilig and Fowler, 157 O. G. 1001.

After an interference is decided the parties are not entitled to further inspect each others papers.

Sirl, 138 O. G. 509.

Delay in filing an amendment in order to avoid inspection by the opposing party is not excusable.

Dilge and Fowler, Jr., 132 O. G. 1837.

An interference will not be suspended to secure the issuance of a patent on an application referred to but not included in the interference before the other party has access to the files.

Field, 130 O. G. 1687.

Where S requests copies of the decision of the Examiner upon a motion for dissolution in another interference in which F was a party and which is referred to in F's record, held that since S was not a party to the other interference and the claims forming the issue of that interference are not made by S, he should be denied access to the record of that interference even though the issue therefore is based upon the same structure as that upon which the claims in the present interference are drawn.

Slone v. Fessenden, 130 O. G. 1487.

Copy of affidavit under Rule 75 refused.

U. S. Standard Voting Machine Co., 130 O. G. 1486.

Where one party to an interference shows, describes, and claims an auxiliary invention which is not essential to the operativeness of the invention in issue and the other party has presented no claim which includes this auxiliary invention either broadly or specifically, there appears to be no reason why it should be disclosed to him.

Kugele v. Blair, 127 O. G. 1253.

A party who in a patent or in his testimony, refers to pending or an abandoned application, can not thereafter withhold such application from the inspection of the opposite party. (Authorities.)

Belle City Malleable Iron Co., 125 O. G. 1351.

Ordinarily when an application involved in interference contains a statement that it is a division of an earlier application the earlier application is thrown open to the inspection of the opposing party, and no reason is apparent for making an exception in the present case.

Steinmetz v. Thomas, 125 O. G. 1351.

The attorneys of the assignee of the entire interest is entitled to inspect papers.

Cazin v. Von Welsbach, 119 O. G. 650.

A copy of a previous application referred to in preliminary statement furnished opposing party.

Claasen v. Steffen, 113 O. G. 2507.

No good reason exists why a party to an interference should be permitted to examine papers relating to claims not in-

volved in the interference, even though the party in whose interest the papers were filed happens to be a party to the interference. (Op. Att'y Gen.)

Davis v. Garrett, 112 O. G. 1211.

If an applicant desires to avail himself of the date of his original application, the other party is entitled to see the original application.

Henderson, 107 O. G. 1661.

Requests for copies of pending or abandoned applications referred to in patents should be supported by a showing of reasons why they are desired.

Dyer, 106 O. G. 1508.

The parties to an interference are entitled to see so much of their opponent's cases as relate to the interference. This includes a copy of the specification, claims, and all claims relating to the interfering matter.

102 O. G. 228.

and specifically public use proceedings.

Mills v. Torrance, 106 O. G. 544.

Affidavits under Rule 75 not disclosed.

Davis Ocumpaugh v. Garrett, 103 O. G. 1679.

A motion to have the preliminary statement sealed up until the expiration of the time limited for motions to dissolve refused because not contemplated by the rules.

Whipple v. Sharp, 1902 C. D. 5, 98 O. G. 226.

If a former application is referred to to fix a date, opponent has a right to a copy of such application.

Gillespie, 1900 C. D. 149, 92 O. G. 2159.

After judgment of priority against applicant who makes a motion for dissolution and redeclaration of interference to include applicant's earlier application, the opposing party will be furnished with a copy of said earlier application.

Thorpe v. White, 1900 C. D. 46, 91 O. G. 227.

Contains nothing to authorize the disclosure of a caveat that may have been referred to during the ex parte consideration.

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

Affidavits under Rule 75 may not be shown to opposing parties or copies furnished.

Guiser, 1880 C. D. 94, 17 O. G. 507.

The fact that the applicant has access to the specification and claims of the patentee is no reason why this rule should be violated by furnishing the patentee with a copy of the specification and claims of the applicant.

Spalding and Aldrich v. Winchester, 1871 C. D. 94.

Cases that pass on the subject matter of this rule.

Kugele v. Blair, 125 O. G. 1350; Davis v. Garrett, 123 O. G. 1991.

Rule 109. Invention Shown, but not Claimed in Application.

An applicant involved in an interference may, at any time within thirty days after the preliminary statements (referred to in Rule 110) of the parties have been received and approved, on motion duly made, as provided by Rule 153, file an amendment to his application containing any claims which in his opinion should be made the basis of interference between himself and any of the other parties. Such motion must be accompanied by the proposed amendment, and when in proper form will be set for hearing before the law examiner. Where a party opposes the admission of such an amendment in view of prior patents or publications, full notice of such patents or publications must be given at least five days prior to the date of hearing. On the admission of such amendment, and the adoption of the claims by the other parties within a time specified by the law examiner, the primary examiner shall redeclare the interference, or shall declare such other interferences as may be necessary to include the said claims. New preliminary statements will be received as to the added claims, but motions for dissolution with regard thereto will not be considered where the questions raised could have been disposed of in connection with the admission of the claims. Amendments to the specification will not be received during the pendency of the interference, without the consent of the Commissioner, except as provided herein, and in Rule 106.

Any party to an interference may bring a motion to

put in interference any claims already in his application or patent, which in his opinion should be made the basis of interference between himself and any of the other parties. Such motions are subject to the same conditions, and the procedure in connection therewith is the same, so far as applicable, as hereinabove set forth for motions to amend.

HISTORY.

Rule 109, previous to last revision, was as follows: An applicant involved in an interference may, at any time within thirty days after the preliminary statements (referred to in Rule 110) of the parties have been received and approved, on motion duly made, as provided by Rule 153, file an amendment to his application containing any claims which in his opinion should be made the basis of interference between himself and any of the other parties. Such motion must be accompanied by the proposed amendment, and when in proper form will be transmitted by the Examiner of Interferences to the Primary Examiner for his determination. On the admission of such amendment, and the adoption of the claims by the other parties within a time specified by the Examiner, as in Rule 96, the interference will be redeclared, or other interferences will be declared to include the same as may be necessary. New preliminary statements will be received as to the added claims, but motions for dissolution will not be transmitted in regard thereto where the questions raised could have been disposed of in connection with the admission of the claims. Amendments to the specification will not be received during the pendency of the interference, without the consent of the Commissioner, except as provided herein, and in Rules 106 and 107.

See Rule 94 of 1879.

Present Rule 109 was promulgated in view of the decisions of the Court of Appeals of the District of Columbia in *Blackford v. Wilder*, 127 O. G. 2855, *Horins v. Wends*, 129 O. G. 2858, in which the court refused to consider a second interference for the purpose of permitting applicants to present claims covering all the patentable subject matter common to the interfering applications. But the time for presentation must be confined to thirty days.

Mattice v. Langworthy, 132 O. G. 678.

See note to Rule 122.

*CONSTRUCTIONS.**Insertion of Claims.*

When some of the claims which are copied from a patent are found to be allowable, but others are not, the interference should be declared without waiting to determine the applicant's right to the remaining claims. If necessary applicant can bring up that question by motion under Rule 109.

Weber and Woodford, 264 O. G. 863.

In this case appellant did not comply with the rules of the Office and file an amendment containing these claims prior to the dissolution of the interference. We, therefore, agree with Patent Office that he was thereafter estopped to urge them.

In re Copen, 214 O. G. 685 (see also page 683).

A denial of a motion to insert claims in opponent's application under Rule 96, not appealable.

Stronach v. Shaw, 197 O. G. 989; Mortimer v. Thomas v. Brownson, 192 O. G. 215.

Unless the moving party is of the opinion that the claims are patentable, he can not move to insert them.

Rich v. Porter v. Hamlin, 192 O. G. 1261.

Patentability should be determined under the motion to amend. If not, a motion to dissolve not permitted.

Henderson & Cantley v. Kindervaler, 192 O. G. 741.

An amendment to the drawing which is to cure an obvious clerical mistake, might be made during an interference.

Moore, Com., v. U. S. ex rel. Colburn Machine Glass Co., 191 O. G. 293.

A motion to insert claims is inconsistent with a motion to dissolve an interference on the ground of nonpatentability of such claims.

Weinberg v. Boyer v. Russell and Russell, 185 O. G. 249.

After interference had been appealed R presented claims by an amendment and asked an interference with another patent of C's. Primary Examiner should consider whether a second interference should be instituted, but if not, the amendment should await termination of the present one.

Crers v. Ruby, etc., 184 O. G. 552.

The junior party being in default transmission was refused of a motion by the senior party to include certain counts.

Crone v. White, 181 O. G. 1074.

The purpose is to permit all questions to be determined in one interference. It is the interest of the parties to have the issue corrected before taking testimony.

Kurowski v. Ransey, 181 O. G. 820.

Practice under Niedich, 172 O. G. 551.

Where a disclaimer is filed, permission for the opposing party to inspect papers will not be given, even if the wishes to see if other claims can not be made under the provision of Rule 109.

Hick, 172 O. G. 261.

A specific claim allowed the successful party in an interference involving generic claims.

Van Gox, 170 O. G. 243.

It is claimed that new light has been thrown upon the real invention which is at issue between the parties by the hearings which have been had before the Primary Examiner on the merits of the conflicting inventions. There is reason to believe that the original invention was not properly defined originally, and that it might be more clearly defined. The delay warranted and transmission of the motion ordered.

Walker et al. v. Gilchrist, 164 O. G. 507-8.

The purpose of this rule is to settled all preliminary questions relating to the issue of an interference in a single proceeding and the Examiner should decide under such circumstances not only the question of dissolution of the interference, but also the questions raised by the claims presented under Rule 109, in order that all these questions may be reviewed, if necessary, by the appellate tribunal upon the same appeal. The fact that the decision of the Examiner dissolved the interference upon the issues originally set forth does not preclude the right to inter partes consideration of the claims presented under Rule 109.

Hammond and Donahue v. Colley v. Norris, 148 O. G. 573.

The requirement as a condition precedent to transmission that applicant point out the elements of the claim in the application approved.

Hock v. McCaskey v. Hopkins, 141 O. G. 1161.

Where an Examiner rejects claims presented by a party to an interference under Rule 109, he should set a limit of appeal from his decision whether the claims had been allowed to the other party or had been made for the first time by the moving party.

Mattice v. Langworthy, 132 O. G. 1073.

In the case of Townsend v. Copeland v. Robinson, 126 O. G. 1355, it was pointed out that the practice on motions under Rule 109 should follow the practice under Rule 124.

Josleyn v. Hirlse, 132 O. G. 844.

It is not intended to permit a party to present claims and

if they are not acceptable to amend them and thus enter upon a regular prosecution of the case before the Examiner, nor is it intended to permit an applicant to present his proposed claims in a piecemeal manner.

Mattice v. Langworthy, 132 O. G. 678.

This is not properly a motion under Rule 109, since the proposed claims are not claims of the Becker application, but is brought under the practice announced in *Churchward v. Douglas v. Cutler*, 106 O. G. 2016. It is necessary for interferants to include in the one interference all matter that could have been presented and determined therein.

The above case and *Becker v. Otis*, 129 O. G. 1267.

(Rule adopted previous to Rule 96.)

In view of the transmission of the portion of the motion based on Rule 109 the transmission of the remainder of the motion will not occasion additional delay.

Baslain v. Champ, 128 O. G. 2837.

In view of the transmission of the portion of the motion based on Rule 109, the transmission of the remainder of the motion will not occasion additional delay.

Bastian v. Champ, 128 O. G. 2837.

Harnisch v. Gurniffit, Benoit and Wicault, 128 O. G. 455.

The fact that one was unable to get the papers from the Patent Office until three days prior to the expiration of the time limited, considered a sufficient excuse for not filing motion within such time.

Kugele v. Blair, 125 O. G. 1350.

See note to Rule 122.

Townsend v. Copeland v. Robinson, 124 O. G. 1545.

The purpose of Rule 109 is clearly to avoid a second interference, and where a party fails to take advantage of that rule he loses the right to contest the question of priority as to the claims made by his opponent.

Ex parte Sulton, Steele, and Steele, 121 O. G. 1012.

Substance and not words is the test of conflicting claims.

Upton, 27 O. G. 99; *Drawbaugh v. Blake*, 1883 C. D. 17, 23 O. G. 1221.

It is the general spirit of the practice of the Office as well as of the courts to all questions that can fairly be considered at the same time should be so considered. Therefore, where U brought a motion to dissolve for lack of interference in fact and B moved to amend under Rule 109, it was error for the Examiner to refuse to entertain B's motion on the ground that his decision thereon would depend on the determination of U's motion on appeal.

Ubelacker v. Brill, 1899 C. D. 118, 87 O. G. 1783.

It is recognized in the Office practice as desirable that the question of priority of invention as to all matters which may come in issue between the parties be settled in one interference proceeding and this is the purpose of Rule 109, but the mere possibility that other claims may be made by the parties and new controversies may arise is no justification for dissolving an interference already in progress.

Annand v. Spalckhaver, 1901 C. D. 234, 97 O. G. 2741.

This rule does not provide for the insertion of claims suggested by counsel for both parties after consultation before filing a preliminary statement or taking testimony. Case remanded to Primary Examiner for the purpose of consideration of such an amendment, under the general supervisory power of the Commissioner—Rule 213.

Reece v. Fenwick, 1902 C. D. 145, 99 O. G. 669.

A motion pending under this rule is not a bar to a motion under Rule 122, nor does it excuse delay.

Perrussel v. Wichmann, 1902 C. D. 228, 99 O. G. 2970.

A motion to reopen interference for the purpose of introducing further evidence must be accompanied by good reasons.

Shaffer v. Dolar, 1902 C. D. 344, 100 O. G. 3012-13;

Harris v. Stern & Lotz, 1902 C. D. 386, 101 O. G. 1132-33.

The statement that the Examiner will redeclare the interference should be taken to mean that he will amend the declaration by adding a new count. It is a reformation or amendment and not a new declaration.

Mitchell v. Fitts, 103 O. G. 1915.

A third interference is refused.

Sarfert v. Meyer, 109 O. G. 1885.

Twelve to fifteen days after receiving papers not unreasonable.

Connell v. Tobey, 110 O. G. 2015.

As held in the case of *Jenne v. Brown v. Booth*, 59 O. G. 157, 78 C. D. 1842, any or all the motions provided for in Rule 122 may be brought in connection with the new claims included in the interference under the provisions of Rule 109 and therefore Pfingst's motion as to the new counts was a proper one.

Pfingst v. Anderson, 114 O. G. 264.

A refusal to admit claims under this rule because they are not patentable should be reviewed, if at all, in the first instance by the Examiners-in-Chief.

Limp v. Ball, 115 O. G. 249.

It is contemplated by Rule 94 that the claims made in either application may be introduced into the other application by

amendment, and included in the interference upon motion made in accordance with that rule.

Wheeler, 23 O. G. 1031.

It is within the judicial discretion of the Examiner of Interferences to extend the time for motion.

House v. Butler, 1893 C. D. 14.

May not introduce matter not warranted by application as originally filed.

Grinnell v. Buell, 89 O. G. 1863; Smith v. Carmichael, 93 O. G. 1123.

A person making a specific claim only can not insert a generic claim when in the meantime another applicant has applied for another species.

Bechman v. Wood, 89 O. G. 2459-62. See, however, McBerty v. Cook, 90 O. G. 2295.

Contemplates the possibility of an allowance by the Examiner upon argument of claims which were for some reason not suggested under Rule 96.

Davis x. Ocumpaugh v. Garrett, 103 O. G. 1679.

Matters under this rule must come in the first instance before the Examiner of Interferences. If no claim is sought to be inserted the motion is unauthorized. Only matter contemplated by Rules 106, 107 and 109 may be included in an amendment during the continuance of an interference.

Smith v. Carmichael, 93 O. G. 1123.

It is not within the province of the Examiner of Interferences to consider the patentability or nonpatentability of the claims. This is so even if the proposed claims have been once rejected by the Primary Examiner. Applicant has a right to appeal. The purpose of this rule is to have counts added on motion of applicant if proper.

Reece v. Fenwick, 97 O. G. 188.

This rule does not provide for the insertion of claims suggested by counsel for both parties after consultation before filing a preliminary statement or taking testimony. Case remanded to Primary Examiner for the purpose of consideration of such an amendment under the general supervisory power of the Commissioner. Rule 213.

Reece v. Fenwick, 99 O. G. 669.

It is held that where a party promptly presents claims as proposed additional counts to the interference issue they should be considered by the Primary Examiner. The claims should be accompanied by a motion similar to that ordinarily presented under Rule 109 and by a motion before the Primary Examiner to transmit. Practice indicated.

Churchward v. Douglas, 106 O. G. 2016.

Tyden presented a claim in an amendment which was properly a second species which could not on that account be entered. This decision of the Examiner should only have been made after notice to the other party.

Tyden's divisional application should be considered and if there is interfering subject matter, an interference should be declared accordingly.

Myers v. Tyden, 108 O. G. 287.

Claims contained in a year old patent to one of the parties refused admission in view of the fact that the testimony was nearly complete.

Newell v. Hubbard, 108 O. G. 1053.

Practice prescribed where one of two interfering applicants wishes to file an amendment purporting to put the application in shape for another interference.

Moore v. Hewitt v. Potter, 115 O. G. 509.

Where a party considers that a claim of his opponent could be made by him under Rule 109, but believes that the claim is so vague and indefinite that proper determination of the question of priority could not be based thereon, held that the party should not ask the Office to make this claim an issue but should suggest some issue which would properly describe the invention.

Wickers & Furlong v. Weinman, 118 O. G. 1797.

P offers no new claim at this time though it would seem that from the inspection of these applications he might readily have formulated and presented by motion in analogy to motion under Rule 109 the broader allowable and interfering claims, which should, in his opinion, be included in the issue, if any such claim could be drawn.

Phelps v. Warmley v. McCullough, 118 O. G. 1069.

A motion to amend the issue of an interference under Rule 109 was properly refused transmission where it contained a proviso that the claims shall be added "without prejudice to the right to contest such claims under the provisions of Rule 122."

Wheeler v. Palmros, 133 O. G. 230.

Cases that pass on the subject matter of this rule:

Hick, 172 O. G. 261; *Brown v. Inwood and Lavenberg*, 130 O. G. 978; *Kugele v. Blair*, 127 O. G. 1253; *Corey v. Eiseman & Misar*, 122 O. G. 2063; *Fagan v. Graybill*, 121 O. G. 1013; *Hicks v. Costello*, 103 O. G. 1163; *Berry v. Fitzsimmons*, 1902 C. D. 153, 99 O. G. 862; *Hildreth*, 1901 C. D. 186, 97 O. G. 1374; *Jenne v. Brown v. Booth*, 1892 C. D. 78.

Rule 110. Preliminary Statements.

Each party to the interference will be required to file a concise preliminary statement, under oath, on or before a date to be fixed by the office, showing the following facts:

(a) The date of original conception of the invention set forth in the declaration of interference.

(b) The date upon which the first drawing of the invention and the date upon which the first written description of the invention were made.

(c) The date upon which the invention was first disclosed to others.

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

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

(f) The applicant shall state the date and number of any application for the same invention filed within twelve months before the filing date in the United States, in any foreign country adhering to the International Convention for the Protection of Industrial Property or having similar treaty relations with the United States.

If a drawing has not been made, or if a written description of the invention has not been made, or if the invention has not been reduced to practice or disclosed to others or used to any extent, the statement must specifically disclose these facts.

When the invention was made abroad the statement should set forth:

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

(b) Whether or not the invention was ever patented; if so, when and where, giving the date and num-

ber of each patent, the date of publication, and the date of sealing thereof.

(c) Whether or not the invention was ever described in a printed publication; if so, when and where, giving the title, place, and date of such publication.

(d) When the invention was introduced into this country, giving the circumstances with the dates connected therewith which are relied upon to establish the fact.

The preliminary statements should be carefully prepared, as the parties will be strictly held in their proofs to the dates set up therein.

If a party prove any date earlier than alleged in his preliminary statement, such proof will be held to establish the date alleged and none other.

The statement must be sealed up before filing (to be opened only by the examiner of interferences; see Rule 111), and the name of the party filing it, the title of the case, and the subject of the invention indicated on the envelope. The envelope should contain nothing but this statement.

(For forms, see 36 and 37, appendix.)

HISTORY.

1869. NO SIMILAR RULE.

1870. RULE 53, SEE APPENDIX.

In 1871, Rule 53 read as follows: Before the declaration of an interference proper a preliminary interference will be declared, in which each party, without the name of the other party being made known to him, will be required to file a statement under oath giving a detailed history of the invention, describing its original conception, the successive experiments, the extent and character of use, and the various forms of embodiment, and giving, so far as practicable, the exact dates of each step in its development. This statement must be sealed up before filing (to be opened only by the examiner of interference), and the name of the party filing it and the subject of the invention indicated on the envelope.

These preliminary statements shall not be opened to inspection of the opposing parties until both have been filed or until the time for filing both has expired, nor then, until they have been examined by the proper officer and found to be sufficiently definite as regards their declarations of dates.

If the party upon whom rests the burden of proof fails to file a preliminary statement, or if his statement fails to overcome the prima facie case made by the respective dates of application, or if it shows that he has abandoned his invention, or that it has been in public use more than two years before his application, the other party will be entitled to an immediate adjudication of the case upon the record; unless a presumption is created that his right to a patent is affected by the alleged public use of the invention, in which case the interference may be proceeded with.

If the earlier applicant fails to file a preliminary statement, no testimony will subsequently be received from him going to prove that he made the invention at a date prior to his application. The preliminary statement can in no case be used as evidence in behalf of the party making it. Its use is to determine whether the interference shall be proceeded with, and to serve as a basis of cross-examination for the other party.

If either party requires a postponement of the time for filing the preliminary statements, he must present his reason therefor, in the form of an affidavit, prior to the day previously fixed upon.

In 1873, Rule 53 read as follows: Before the declaration of an interference proper a preliminary interference will be declared, in which the primary examiner will notify the respective parties when the applications of the other parties were filed, together with their names and residences. Each party to the interference will be required to file a statement under oath, giving a detailed history of the invention, showing the date of the original conception, and the date that the invention was reduced to drawings or model, and the date of its completion, and the extent and character of use. The parties will be strictly held in their proof to the dates set up in their preliminary statements. This statement must be sealed up before filing (to be opened only by the examiner of interference), and the name of the party filing it and the subject of the invention indicated on the envelope.

These statements shall not be open to the inspection of the opposing parties until both have been filed, or until the time for filing both has expired, nor then, until they have been

examined by the proper officer and found to be satisfactory. At the time of the examination of the preliminary statements the examiner of interferences will also make an examination of the preliminary declaration (instituted by the primary examiner), in order to ascertain whether or not the issue between the parties has been clearly defined. If it is found, upon such examination, that the preliminary declaration is ambiguous in this particular, the interference will be suspended and the case returned to the primary examiner for amendment.

If the party upon whom rests the burden of proof fails to file a preliminary statement, or if his statement fails to overcome the *prima-facie* case made by the respective dates of application, or if it shows that he has abandoned his invention, or that it has been in public use more than two years before his application, the other party will be entitled to an immediate adjudication of the case upon the record, unless a presumption is created that his right to a patent is affected by the alleged public use of the invention, in which case the interference may be proceeded with.

If the earlier applicant fails to file a preliminary statement, no testimony will subsequently be received from him going to prove that he made the invention at a date prior to his application. The preliminary statement can in no case be used as evidence in behalf of the party making it. Its use is to determine whether the interference shall be proceeded with, and to serve as a basis of cross-examination for the other party.

If either party requires a postponement of the time for filing the preliminary statements, he must present his reasons therefor, in the form of an affidavit, prior to the day previously fixed upon.

In 1878, Rule 53 read as follows: Before the declaration of an interference proper a preliminary interference will be declared, in which the primary examiner will briefly and concisely define the interfering subject-matter, and specify the claims embracing the same, and also notify the respective parties when the applications of the other parties were filed, together with their names and residences. * * *

If the party upon whom rests the burden of proof fails to file a preliminary statement, or if his statement fails to overcome the *prima-facie* case made by the respective dates of application, the other party will be entitled to an immediate adjudication of the case upon the record. Or where there are more than two parties to the interference, and any

of them fail to file a preliminary statement, judgment may be rendered against such parties and the interference proceed between the remaining parties. * * *

In case of material error in the preliminary statement, arising through inadvertence or mistake, it may be corrected, upon showing to the satisfaction of the Commissioner that its correction is essential to the ends of justice.

The motion to correct the said statement must be made before the taking of the testimony relating to the alleged error, and as soon as practicable after the discovery thereof, and it must be accompanied by notice to the adverse party or parties.

Rule 105 of 1879 in appendix: In 1885 the words, "of the making of a drawing, of the making of a model" appear in lines 3 and 4, and the words "reduction to practice" appear in line 5 and the following matter was added to the Rule of 1879.

When the invention was made abroad the statement should set forth when and where, if ever, the invention was patented (giving the date and number of the patent), and when, if ever, it was described in a printed publication (giving the date and place of publication), and when, if ever, it was introduced, or knowledge of it was introduced into this country (giving the circumstances which are thought to establish the fact thereof).

In the general revision of 1888, Rule 110 reads: Each party to the interference will be required to file a concise statement, under oath, on or before a date to be fixed by the office, showing the following facts:

- (1) The date of original conception of the invention set forth in the declaration of interference.
- (2) The date upon which a drawing of the invention was made.
- (3) The date upon which a model of the invention was made.
- (4) The date upon which the invention was first disclosed to others.
- (5) The date of the reduction to practice of the invention.
- (6) A statement showing the extent of use of the invention.

If a drawing or model has not been made, or if the invention has not been reduced to practice or disclosed to others or used to any extent, the statement must specifically disclose these facts.

When the invention was made abroad the statement should set forth:

- (1) That applicant made the invention set forth in the declaration of interference.
- (2) Whether or not the invention was ever patented, if so, when and where, giving the date and number of each patent.
- (3) Whether or not the invention was ever described in a printed publication, if so, when and where, giving the title, place, and date of such publication.
- (4) Whether or not the invention was ever introduced into this country, if so, giving the circumstances, with the dates connected therewith, which are relied upon to establish the fact.

The preliminary statements should be carefully prepared, as the parties will be strictly held in their proofs to the dates set up therein.

The statement must be sealed up before filing (to be opened only by the examiner of interferences, see Rule 111), and the name of the party filing it, the title of the case, and the subject of the invention indicated on the envelope. The envelope should contain nothing but this statement.

In 1899 the words "the date of publication, and the date of sealing thereof" appear in the second numbered paragraph relating to inventions made abroad, and the following paragraph followed the caution that care should be used:

If a party prove any date earlier than alleged in his preliminary statement, such proof will be held to establish the date alleged and no other.

110 (7) (Added June 24, 1903.) The applicant shall state the date and number of any application for the same invention fixed within twelve (12) months before the filing date in the United States in any foreign country adhering to the international convention for the protection of industrial property or having similar treaty relations with the United States.

The requirement that the date of the first written description must be stated was added in the last revision.

CONSTRUCTIONS.

- (1) IN GENERAL.
- (2) AS A PLEADING.
- (3) EFFECT OF PRELIMINARY STATEMENT.
- (4) INACCURACY—VARIATION IN PROOF.
- (5) REDUCTION TO PRACTICE.
- (6) REDUCTION TO PRACTICE INDICATED BY UTILITY AND OPERATIVENESS.
- (7) DILIGENCE IN REDUCING TO PRACTICE.

- (8) MODEL AS A REDUCTION TO PRACTICE.
- (9) EXTENT OF USE.
- (10) CONCEPTION OF INVENTION.
- (11) DISCLOSURE OF INVENTION.
- (12) ADDITIONAL CASES.

(1) *In General.*

There seems to be a tendency to approximate the practice in patent cases under Equity Rule 58 to the Office practice in interference cases.

The rule requiring preliminary statements is a salutary one, its obvious object being to illicit from each of the parties certain vital information before any party is informed as to the statements of any other.

Thomas v. Weintraub, 177 O. G. 772.

A preliminary statement given the effect of an affidavit under Rule 75. (Perhaps this was in view of the particular circumstances of the case.)

Forsyth v. Richards, 1905 C. D. 115, 115 O. G. 1327.

Question if a disclosure to a wife is a disclosure within the meaning of the Patent Law.

Harter v. Barrett, 1905 C. D. 578, 114 O. G. 975; 24 App. D. C. 300.

Does not prohibit party's attorney from administering the oath.

Bundy v. Rumbarger, 1900 C. D. 94, 90 O. G. 2210.

After judgment on the record the defeated party may not examine the preliminary statement of his opponents.

Lindsay v. McDonough, 1891 C. D. 89.

Preliminary statements considered in connection with previously filed affidavit under Rule 75.

Schmertz v. Appert, 1890 C. D. 95, 77 O. G. 1784.

After judgment on the record permission to inspect the preliminary statement of the prevailing party refused.

Lindsay v. McDonough, 1891 C. D. 98, 66 O. G. 1402.

If there is any doubt as to the scope of the interference issue, each applicant should confine his preliminary statement to the invention contained in the claims of his application which are declared to be involved in the interference and not attempt to frame the statement to cover two or more possible constructions of the issue.

Haug v. DuBois, 1891 C. D. 131, 54 O. G. 1061.

The disclaimer authorized by Rule 104 can not be received as a preliminary statement.

Laverly v. Flagg, 1879 C. D. 303, 16 O. G. 1141.

(2) *As a Pleading.*

The sworn preliminary statements required when an interference has been declared constitute the pleadings of the parties, and we have had occasion several times and for reasons satisfactory now as then, to approve the practice of holding parties strictly to the dates given therein.

Parkes v. Lewis, 1906 C. D. 735, 123 O. G. 2313, 18 App. D. C. 1; *Luger v. Browning*, 1903 C. D. 593, 104 O. G. 1123, 21 App. D. C. 201; *Podlesak & Podlesak v. McInnerney*, 1906 C. D. 558, 120 O. G. 2127, 26 App. D. C. 399; *Adams*, 1905 C. D., 114 O. G. 2093, 24 App. D. C. 275; See *Berger v. Dodge*, 1905 C. D. 603, 114 O. G. 2383, 24 App. D. C. 481; *Robinson v. Copeland*, 1904 C. D. 664, 112 O. G. 501, 24 App. C. C. 68; *Paul v. Johnson*, 1904 C. D. 610, 109 O. G. 807, 23 App. D. C. 194; *Bader v. Vagen*, 1899 C. D. 1235, 87 O. G. 329, 14 App. D. C. 241; *Stevens v. Seher*, 1897 C. D. 761, 81 O. G. 1932, 11 App. D. C. 245; *Cross v. Phillips*, 1899 C. D. 342, 87 O. G. 1399, 14 App. D. C. 230; *Hammond v. Basch*, 1905 C. D. 615, 115 O. G. 804, 24 App. D. C. 469; *Fowler v. Boyce*, 1906 C. D. 659, 122 O. G. 1726, 27 App. D. C. 4852.

Preliminary statement in the nature of a pleading.

Huber v. Aiken, 1899 C. D. 166, 88 O. G. 1525.

Preliminary statements in interferences do not make the issue between parties and therefore they are not like pleadings in courts.

Woodward v. Kennedy, 1903 C. D. 166, 104 O. G. 1393.

The practice of requiring a preliminary statement approved. It is in the nature of a pleading. "Whether each statement is to be considered as a pleading in the case seems to me is not very material."

Hopkins v. LaRoy, 1880 C. D. 188, 18 O. G. 859; *Guest v. Finch*, 1876 C. D. 144, 10 O. G. 165; *Schenck v. Rider*, 1870 C. D. 135.

The rule that the proof and pleading must correspond is as applicable in the Office as in the courts.

Young v. Rogers, 1880 C. D. 178, 18 O. G. 733.

The failure to make objection by the contestant operates to cure a defect in a preliminary statement so far as he is concerned, in analogy to the rules of pleading.

White v. Farmer, 1874 C. D. 19, 5 O. G. 338.

(3) *Effect of Preliminary Statement.*

Can applicant go back of the dates alleged in his preliminary statement in a bill in equity under R. S. 4915?

See *Greenwood v. Dover*, 194 F. R. 95.

It is well settled that a party to an interference is bound by the allegations of his preliminary statement. (123 O. G. 1665, 122 O. G. 1726, 115 O. G. 804, 87 O. G. 1399.)

Phillips v. Sensenich, 132 O. G. 677.

The appellee contends that the allegation in the preliminary statement of B to the effect that he constructed an experimental machine in January, 1901, does not amount to an allegation of a reduction to practice, and hence, in respect of that machine and the two other machines thereafter constructed, to which no date is given, limits B to the date of his application as his first reduction to practice. We can not concur in this view of the effect of the statement. It is not so precise as it might have been and if exception had been taken to it on that ground, *in limine* its amendment might possibly have been compelled; at any rate, if unamended, after exception, the limitations of its averments now insisted upon might reasonably be imposed.

Burson v. Vogil, 1907 C. D., 131 O. G. 942.

Unfortunately for them, under the rules of the Patent Office they are bound by the allegations of their preliminary statement that they did not reduce to practice the invention of the subject matter of this count until September, 1900.

Lowrie v. Taylor, 1906 C. D. 713, 123 O. G. 1665, 27 App. D. C. 522.

No evidence of conception prior to the date alleged could have been considered. (Cases cited.)

Neth & Tamplin v. Ohmer, 1906 C. D. 693, 123 O. G. 998, 27 App. D. C. 319.

F was refused permission to file an amended statement and in proceedings such as these we do not think that even consent of counsel, unless expressly approved by the Commissioner of Patents, warrants ignoring a rule of the Office that parties are limited to the dates set out in their preliminary statements, especially where leave has been asked and refused to permit the filing of an amended preliminary statement. Cases may often arise where the interest of the parties and the public will be best subserved by permitting dates earlier than set forth in preliminary statements to be proven. It should.

however, be done under the supervision of and with the approval of the Office.

Fowler v. Boyce, 1906 C. D. 659, 122 O. G. 1726, 27 App. D. C. 48-55.

Where a party in order to prevail depends upon earlier dates than those alleged in his preliminary statement and permission to amend the statement to set out said earlier dates has been refused the testimony relating to such earlier dates must be disregarded.

Fowler v. McBerty, 1906 C. D. 585, 121 O. G. 1015, 27 App. D. C. 41.

The meaning of words used in a preliminary statement must be ascertained at affiant's peril.

Dunn v. Halliday, 1905 C. D. 510, 119 O. G. 1261.

It is essential in interference proceedings that preliminary statements made by the respective parties without knowledge of their opponents' cases should not be disregarded where the proofs are taken.

Fowler v. Boyce, 1905 C. D. 615, 118 O. G. 2534, App. D. C. 48-55.

We have had occasion several times and for reasons satisfactory now as then, to approve the practice of holding the parties strictly to the dates given therein. (Bader v. Vajen, 14 App. D. C. 254; Stevens v. Seher, 11 App. D. C. 251; Cross v. Phillips, 14 App. D. C. 236.)

Hammond v. Basch, 115 O. G. 804, 24 App. D. C. 469,

Rule 110 and many published decisions have contained specific warnings to applicants that the statements must be carefully prepared and therefore there is no excuse for negligence in their preparation.

Woodward v. Kennedy, 1903 C. D. 166, 104 O. G. 1394.

The rule that one is bound by the statements in his preliminary statement applies only to the proceedings in which the parties are involved.

Sievert v. Shuman, 1896 C. D. 47, 76 O. G. 1714.

An allegation that the invention was reduced to practice in part at a certain date, held to limit affiant.

Carty v. Kellog, 1895 C. D. 83, 73 O. G. 285, 7 App. D. C. 542.

Warnant v. Warnant, 1880 C. D. 36, 17 O. G. 265.

An applicant is not permitted to carry his invention back of the date set up in his preliminary statement.

Hunt v. King, 1880 C. D. 22, 17 O. G. 200.

The preliminary statement goes for nothing as affirmative proof of the date of or fact of invention.

Lauder v. Crowell, 1879 C. D. 177, 16 O. G. 405.

The proof of the date of invention may be extended for-

ward but not backward from the date fixed in the preliminary statement.

Connor v. Williams, 1878 C. D. 137, 15 O. G. 387.

Evidence tending to show a date of invention earlier than that put down in the preliminary statement should be disregarded.

Hovey v. Hufeland, 1872 C. D. 229, 2 O. G. 493.

The testimony should be restricted to a substantial adherence to the date of invention set up in the preliminary statement.

Walpuski v. Jacobsen & Faber, 1876 C. D. 114, 9 O. G. 964.

The preliminary statement is conclusive against the party filing it, but can not be used as evidence against the adverse party.

Kenyon v. Wesson, 1871 C. D. 91; Schenck v. Rider, 1870 C. D. 135; Anson v. Woodbury, 1877 C. D. 49, 12 O. G. 1.

(4) *Inaccuracy—Variation in Proof.*

The looseness of assertion in the statement is inexcusable and tends to discredit him. (La Flare v. Chase, 74 O. G. 1735; Shafer v. Dolan, decided June 5, 1904.)

Blackman v. Alexander, 1903 C. D. 521, 113 O. G. 1703.

That a device alleged to be a model was in fact a reduction to practice is a variation that will not be permitted.

Basch v. Hammond, 1904 C. D. 474, 113 O. G. 552.

The allegations of M in his preliminary statement are so manifestly inaccurate that his whole case is rendered doubtful thereby.

Miles v. Todd, 1904 C. D. 420, 112 O. G. 1479.

The proof of such reduction to practice is on the part of both parties several months later than as alleged in the preliminary statement. This fact would indicate a reprehensible looseness of assertion in the preliminary statements, which tends to discredit both parties.

Shaffer v. Dolan, 1904 C. D. 592, 108 O. G. 2146.

Where there is a "Preliminary Statement" which has the alleged dates of conception and disclosure of a device within the issue of the interference sustained by the testimony and the date of reduction to practice is not sustained, but a later date is established, it can not be contended that the P. E. refers to a device not in issue. The Preliminary Statement is a valid one, and there is presented the simple case of one

of the dates in such statement having been erroneously alleged.

Storrie, 245 O. G. 845.

(5) *Reduction to Practice.*

If both parties reduced to practice on the same day priority will be awarded to the first to conceive.

McParland v. Ball, 231 O. G. 603.

These experiments sufficiently demonstrated the practicability of the invention and therefore amounted to reduction to practice.

Slingluff v. Sweet, 230 O. G. 659.

An applicant can not avail himself of a reduction to practice in a foreign country.

Loriner v. Erickson, 227 O. G. 1445.

Taking into consideration the original attitude of the appellant with reference to this device, its peculiar construction and the manner of its use, we are satisfied, as was the Patent Office, that the thing which is now called a mixer was intended for and was in fact merely a discharge spout.

Ruggles v. Ash, 226 O. G. 699.

An experimental use apart from the complete apparatus for which it was intended held a reduction to practice.

Creveling v. Jepson, 226 O. G. 339.

The petitioner should allege his reduction to practice positively in the terms of the rule, or should comply with the Examiner's requirement for a statement alleging whether the device was successfully used.

Klocke v. Burk, 189 O. G. 779.

A design patent as evidence of conception and reduction to practice.

Lowrie v. Taylor & Taylor, 186 O. G. 1681.

This allegation of reduction to practice should be alleged positively, either in the terms of the rule, or in such other language as will leave no question as to the actual reduction to practice of the invention.

Williams v. Foyer and Kurz, 142 O. G. 1114.

Filing of an incomplete application not a constructive reduction to practice. (Payment of fee.)

McElray, 140 O. G. 1207.

The filing of an application by an official of the Patent Office does not constitute a constructive reduction to practice.

McElray, 140 O. G. 1207.

It was the idea of the telescoping arm that constituted the invention. No patent could have been obtained on the set-

screw because that was old in the art. We, therefore, hold that this set-screw was a mere mechanical addition to the device and obvious to any one skilled in the art, and that its absence did not prevent the original test from constituting a reduction to practice.

Howard v. Bowes, 137 O. G. 733.

It is well settled that after reduction to practice a mere delay of the inventor in applying for a patent, in the absence of concealment, abandonment or suppression, will not prevent the inventor from getting a patent based upon priority of invention. (Rolfe v. Hoffman, 26 App. D. C. 336.)

Rose v. Clifford & Newell, etc., 135 O. G. 1361.

An inventor conceived an invention and embodied it in a model which was submitted to the company that controlled the sale of the machine for which the improvement was designed, but the company refused to purchase the invention and returned the model to the inventor. An officer of the company disclosed it to the foreman of the factory of a subsidiary corporation, who set about adapting it to the machine made by them for the parent company, and a completed machine was built embodying such invention. Held that such a reduction to practice does not inure the inventor.

Howell v. Hess, 132 O. G. 1974.

When a publication is sufficient to constitute a bar against all later inventors, it should manifestly be accepted as establishing the right of the one who made that disclosure and who with reasonable promptness filed his application for patent in the United States.

Marconi v. Shoemaker, 1907 C. D., 131 O. G. 1939.

Article in the "Electrical World and Engineer," by Marconi, as a constructive reduction to practice.

Marconi v. Shoemaker, 1907 C. D., 131 O. G. 1939.

Altered machine, evidence as to extent and kind of alteration necessary.

Burson v. Vogil, 125 O. G. 2361.

The same act or sets facts may or may not constitute reduction to practice, modified, as they may be by the special circumstances of the particular case.

Andrews v. Nilson, 123 O. G. 1667.

An inventor having reduced his invention to practice is entitled to a period of two years in which to put the same into public use and on sale without a forfeiture of his right to receive a patent based upon an application filed before the statutory bar has arisen. Neither abandonment nor forfeiture

within that period can be presumed but must be proved.

Rolfe v. Hoffman, 121 O. G. 1350.

It is necessary to prove a fact from which it can be concluded that the reduction to practice was accomplished.

Bauer v. Crane, 118 O. G. 1071.

In order for a device to constitute a reduction to practice of an invention defined in an issue of an interference, it is essential for that device to embody all the elements of the combination defined by the issue. If the elements are not present in the device which is offered in evidence and on which reliance is made the absence of these elements should be explained by the testimony.

Robinson v. Seelinger, 114 O. G. 262-3.

Buffer springs were tested by being placed under a steam hammer and were broken. Held that the fact that they were broken shows that the springs were not a successful reduction to practice.

Gallagher v. Hien, 114 O. G. 97.

A failure to disclose an unclaimed element does not prevent the disclosure from being good evidence.

Paul v. Johnson, 106 O. G. 2013-14.

An accidental use of device will not serve to establish a date of reduction to practice.

Whitney v. Howard v. Stanley & Stanley, 104 O. G. 1391.

"MacDonald only testifies that the machine was 'tried' and was used at 'intervals.' He does not state the result of this use.

"It is not necessary, of course, that the success must be a commercial success or a very high degree of success; but it is essential that it be established that there was at least some degree of success."

MacDonald v. Edison, 105 O. G. 975.

The tests of that machine were sufficient to establish its practicability and under well settled principle of law a commercial use of it was not necessary to constitute a reduction to practice. (Roe v. Hanson, decided by Court of Appeals of the District of Columbia, April 1, 1902.)

Donnelly v. Wyman, 103 O. G. 657-9, 104 O. G. 310.

A shop test with dummy matches, made under all of the other conditions of actual use, demonstrates the practicability of the device as effectually as would use with real matches.

Donnelly v. Wyman, 103 O. G. 657-8; affirmed, 104 O. G. 310.

An allowable application is a constructive reduction to practice.

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

By a reduction to practice a party's rights are perfected and are subject to be defeated only by some such course of conduct as that mentioned in *Mason v. Hepburn*, 84 O. G. 147; *Estey v. Newton*, 86 O. G. 799; *Osborn v. Holspillar*, 102 O. G. 1296.

Testifying to the identity of a piece of rubber tube produced by the party in interest with one used two years before in a construction that has since remained hidden from view lacks the weight necessary to overcome a former regularly issued patent.

Ruete v. Elwell, 95 O. G. 2119-22.

An allegation that the invention was reduced to practice in part at a certain date, held to limit affiant.

Carty v. Kellog, 1895 C. D. 83, 73 O. G. 285.

While the destruction or dismantling of a first construction and the loss of some of its parts or their use in making other machines are sometimes important, they are only important when depending upon other circumstances tending to cast doubts upon the claims of the earlier reduction to practice.

Funk v. Whitely, 17 O. G. 280.

(6) *Reduction to Practice Indicated by Utility and Operativeness.*

The ability to accomplish the general object of the machine apparently necessary. Failure apparently due to matters outside the invention.

Janin v. Curtiss, 231 O. G. 1539.

Taylor has offered to have the exhibit tested in order to show that it is now in operative condition. The result of such a test would, however, be immaterial.

The question involved is whether Taylor has established a reduction to practice and that must be decided on the record as presented.

Taylor v. Gilman, 158 O. G. 883.

A device proving itself.

Rolfe v. Kaisling v. Lieper, 143 O. G. 562.

A decision depends upon the facts of each case. Cases classified into three groups: First, those in which the device is simple so that it is clear that it will operate without trial; second, the device workable, but mechanically defective; third, those in which the device requires that its operations be demonstrated by trial. (Cases cited.)

In cases of the second and third class long delay in putting the machine in actual use has always been regarded as a

potent circumstance in determining whether the test was successful or only an abandoned experiment.

Sydeman & Meade v. Thoma, 141 O. G. 866.

Receiver for wireless messages. Sensitiveness of an iron core in a varying field. The invention clearly belongs to that class of inventions which require actual use or thorough test to demonstrate its practicability and in the absence of satisfactory proof of actual use or successful test it must be held that the devices were merely experimental in character and that none of them constitute a reduction to practice.

Marconi v. Shoemaker, 1907 C. D., 131 O. G. 1939.

A machine may be crude in construction but if it contains all the essential elements of the invention of the issue, and in its operation successfully demonstrates its practical efficacy and utility, reduction to practice is accomplished.

Burson v. Vogel, 1907 C. D., 131 O. G. 343, 29 App. D. C. 328.

Utilizing old material. This may be done without negating reduction to practice.

McCormick v. Hullwood, 1907 C. D., 130 O. G. 1487, 31 App. D. C. 106.

Reduction to practice must produce something of practical use coupled with a knowledge, preferable by actual trial, that the thing will work practically for the intended purpose.

Sherwood v. Drewsen, 1907 C. D., 130 O. G. 657, 29 App. D. C. 161.

The device in controversy belongs to the type of simple devices requiring no demonstration referred to in *Mason v. Hepburn*, 13 App. D. C. 510; *Roe v. Hanson*, 19 App. D. C. 559, and analogous cases rather than to the devices disclosed in *MacDonald v. Edison*, 21 App. D. C. 527 and analogous cases.

Rolfe v. Hoffman, 1906 C. D. 588, 121 O. G. 1350, 26 App. D. C. 336.

When the exhibits were made and tested "the work of the inventor was finished, physically as well as mentally," and there was a complete reduction to practice.

Rolfe v. Hoffman, 1906 C. D. 588, 121 O. G. 1350, 26 App. D. C. 336.

Tests admitted not to be very satisfactory, plant soon dismantled, friends refused to assist in view of experiments, no application for a patent, no further attempts to operate for several years when other experiments were attempted, held merely abandoned experiment.

Pohl v. McKnight, 1905 C. D. 549, 119 O. G. 2519.

The fact that one of the parts of the device broke after long use is not a sufficient reason for denying the inventor thereof the benefit of a reduction to practice (under the circumstances).

Footte v. Wenk, 1905 C. D. 391, 118 O. G. 1366.

Where the construction of a device shows that it was adapted only for temporary experiments and there is no convincing evidence that it proved satisfactory in use, it must be regarded as an abandoned experiment.

Andrews v. Nilson, 1905 C. D. 384, 118 O. G. 1363.

Where an invention is for an electrical circuit protector formed of delicate cooperative parts to be used in an art where an unexpected change in the current may cause vastly different effects. Held that such device needs a test in order to establish its practicability. It is not sufficient to prove that a device was used, it must be proved that it was successfully used.

Rolfe v. Hoffman, 1905 C. D. 352, 118 O. G. 833.

It is not sufficient to show that a machine was built; it must be shown that it was capable of successfully performing the work for which it was designed.

O'Connell v. Schmidt, 1905 C. D. 342, 118 O. G. 588.

Such an invention does not belong to the class of simple inventions which were considered in *Mason v. Hepburn*, 1898 C. D. 510, 84 O. G. 147, 13 App. D. C. 86; *Loomis v. Hauser*, 1902 C. D. 530, 99 O. G. 1172, 19 App. D. C. 401; *Coroch v. Barmett*, 1904 C. D. 650, 110 O. G. 1431.

O'Connell v. Schmidt, 1905 C. D. 342, 118 O. G. 588.

Evidence of reduction to practice must embrace all the elements of the issue, leaving nothing to inference merely.

Robinson v. Seelinger, 1905 C. D. 640, 116 O. G. 1735, 22 App. D. C. 237.

In a case where the new devices are of an old type and their novelty consists in specific constructions of that old type, it may well be that their practical utility may be determined without actual use of them under conditions of industry. But not so where, as here, the type of device is a new type.

Paul v. Hess, 1905 C. D. 610, 115 O. G. 251, 24 App. D. C.

The commercial article would be made of metal, or of some substance more durable than wood; yet the wooden article is operative and is a complete reduction to practice.

Norden v. Spaulding, 1905 C. D. 568, 114 O. G. 1827, 24 App. D. C. 286.

A machine working imperfectly because of a mechanical

defect, roughness of work, may nevertheless be a reduction to practice.

Cummins v. McKenzie, 1904 C. D. 180, 110 O. G. 1167.

The operation of the tip in issue was self-evident and therefore no test was necessary to constitute reduction to practice.

Shaffer v. Dolan, 1903 C. D. 422, 107 O. G. 539.

A specific form held to constitute reduction to practice notwithstanding it might be improved.

Slaughter v. Halle, 1902 C. D. 210, 99 O. G. 2771, 21 App. D. C. 19.

It seems it is not necessary that the machine should be one capable of doing full and satisfactory and economical work day after day in an industrial plant.

Kelly v. Fynn, 1900 C. D. 339, 92 O. G. 1237, 16 App. D. C. 573.

A material part of an apparatus may be separate from the apparatus and temporarily held up to its work, and yet constitute reduction to practice.

Andrews v. Nilson, 1906 C. D. 717, 123 O. G. 1667, 27 App. D. C. 451; Loewer v. Ross, 1896 C. D. 40, 76 O. G. 1711.

(7) *Diligence in Reducing to Practice.*

Does not require an inventor to devote his entire time thereto, nor can he be held responsible for reasonable delays in the preparation of the application.

Courson v. O'Connor, 224 O. G. 1057.

We have heretofore had occasion to remark that the law encourages such delay as is required to test the thoroughness and utility of supposed inventions, and to prevent the Patent Office from being overloaded with applications for patent for crude and imperfect devices.

Woods v. Poor, 130 O. G. 1313.

Diligence will not wait on business arrangements. (Kaksen v. Hitherington, 88 O. G. 1157.)

Paul v. Hess, 115 O. G. 251.

A person may not excuse himself for delay by showing that he was trying to commercially exploit the invention.

Seeberber v. Dodge, 113 O. G. 1415.

It is necessary for O, if he is to prevail in this proceeding, to establish the fact that he was diligent in reducing his invention to practice from a time just prior to the date on which Norton entered the field.

Ocuppaugh v. Norton, 110 O. G. 1723.

Diligence, lack of, not attributable to the first to reduce to practice.

Paul v. Johnson, 109 O. G. 807.

Diligence will not wait on business arrangements.

Kassen v. Hetherington, 88 O. G. 1157; Paul v. Hess, 113 O. G. 847-9.

An accidental, occasional, incomplete and imperfect operation of a structure, especially when said structure was constructed and designed to perform another and wholly different function, is not sufficient to establish the fact of invention. Such structure is not a reduction to practice.

Brooks v. Hillard, 1903 C. D. 335, 106 O. G. 1237.

In an interference proceeding the subject matter of which is an article of manufacture, an applicant is not chargeable with laxness, when he has manifested his willingness to disclose the invention by filing an application for a machine to make such article.

Blood v. Brown, 105 O. G. 496.

In the present case it was the combination of the issue which proved unsatisfactory and not some other part of the machine. A plunger and flexible plunger rod are essential features of the present issue, and until they proved satisfactory the invention was not complete.

Swihart v. Mauldin, 1902 C. D. 137, 99 O. G. 666, 19 App. D. C. 570.

In order to constitute a reduction to practice, it is necessary that the device should be capable of performing the function for which it was intended.

Loomis v. Hauser, 1902 C. D. 131, 99 O. G. 450, 19 App. D. C. 401.

Apparently not a reduction to practice unless utility was recognized.

Silverman v. Hendrickson, 1902 C. D. 123, 99 O. G. 445, 19 App. D. C. 381.

If a device would have worked, without doubt and clearly, on the omission of an element, but such element was not omitted, it was not a reduction to practice.

Latham v. Armat, 1901 C. D. 337, 95 O. G. 252, 17 App. D. C. 345.

There seems to be a tendency to require such proof of practical operation of a device, after long delay, especially if some repairing was done after the alleged operation, as almost precludes the use of such testimony.

Howard v. Hey, 1901 C. D. 375, 95 O. G. 1647, 18 App. D. C. 142.

The law encourages such delay as is required to test the thoroughness and utility of supposed inventions, also the law fosters diligence.

Griffin v. Swenvers, 89 O. G. 191.

The question of due diligence is one to be determined by the particular circumstances of each case.

Griffin v. Swenvers, 89 O. G. 191.

It has sometimes been held in the decisions of the Patent Office that the necessity for diligence on the part of the first conceiver does not arise until the date of the second conception, but this we think can not be supported on principle.

Christie v. Seybold, 64 O. G. 1650.

(8) *Model as a Reduction to Practice.*

A device which merely illustrates the mode of mechanical construction and operation of the conceived idea and which may be said to be an embodiment of the invention in visible form is not necessarily a reduction to practice, for though the device is operative as a mechanical movement there is no certainty that it will perform its function when put to use under full conditions of practical use.

Ocuppaugh v. Norton, 1905 C. D. 632, 115 O. G. 1850, 24 App. D. C. 296.

The lock is full sized and well made, and since it embodies the invention it constitutes a reduction to practice. The suggestion on behalf of Hope that it must be regarded as a mere model is clearly without force.

Voigt v. Hope, 1905 C. D. 30, 114 O. G. 763.

A model, no matter how well constructed, and notwithstanding the fact that it is complete in details and fully illustrative of an operative construction is not in law a reduction to practice.

Ocuppaugh v. Norton, 1904 C. D. 207, 110 O. G. 1723, 25 App. D. C. 90.

Making a full sized collar, exhibiting it to a number of persons and putting it on sale, is a reduction to practice. (Cites Lormis v. Hauser, 19 App. D. C. 401, in which a full sized illustrated model was held to be a reduction to practice.)

Couch v. Barnett, 1904 C. D. 650, 110 O. G. 1431, 23 App. D. C. 446.

A full sized working model not a reduction to practice. The statement that by complying with (4) applicant meant

to comply also with (3) and (5) is ingenious but not convincing.

Guett v. Tregening, 1905 C. D. 23, 114 O. G. 544.

It is well settled that a model, no matter how complete, can not establish reduction to practice (Hunter v. Stikeman, 85 O. G. 610).

Paul v. Hess, 1904 C. D. 475, 113 O. G. 848, 24 App. D. C. 462.

If a model is full size and capable of use to a sufficient extent to demonstrate the practical utility of the invention, it may be a reduction to practice.

Hammond v. Basch, 1905 C. D. 615, 115 O. G. 804, 24 App. D. C. 469.

(9) *Extent of Use.*

It is important that the extent of use of a complete invention be disclosed for reasons other than that it may possibly disclose the statutory bar of public use. It is not necessary that such disclosure should be prolix and give unnecessary details, but it should set forth in concise and explicit terms, the extent of use of the completed invention.

Loeben v. Hamrick, 1899 C. D. 228, 89 O. G. 1672.

Courts do not relieve against mistakes of law.

Dahlgren v. Crocker, 1902 C. D. 107, 92 O. G. 2586.

The extent and kind of use of the invention should be stated if the invention was perfected previous to two years before filing the application.

Dermody v. Pennock, 1878 C. D. 93, 14 O. G. 202.

So far as public use is concerned on an invention completed within two years prior to filing the application, it is unnecessary that the extent of use after completing be stated, if the preliminary statement is clear in setting forth the actual date of completion, and its use in a single instance. Where both are applicants the statement of such public use by one can not bar the other without an opportunity is afforded of examination and cross-examination of witnesses.

Wheat, 1878 C. D. 110, 14 O. G. 787.

(10) *Conception of the Invention.*

It is the practical conception which the patent law requires.

Storck v. Reickhelm, 227 O. G. 365.

The making of the device, therefore, amounted to a demonstration of utility and constituted reduction to practice. Indeed, it would be difficult to find a clearer case. *Not used.*

General Electric Co. v. Duncan Electric Mfg. Co., 165 O. G. 242.

Mere knowledge by a foreign inventor or his agent is not equivalent to a conception of the invention in this country.

Gueniffet, Benoit & Vicault v. Wictorsohn, 131 O. G. 1685.

That H may have had a certain definite result in mind is quite probable, but that he had devised any means for accomplishing that result is disproved by the surrounding fact and circumstances.

Hansen v. Dean, 129 O. G. 483.

A case that passes on the subject matter of this rule.

Bless v. McElray, 128 O. G. 458.

At most this buckle produced by R as G's original disclosure, was an experimental model put away in a drawer for years.

It was in the nature of an abandoned experiment.

Gibbons v. Peller, 127 O. G. 3643.

A complete conception as defined in an issue of priority of invention is matter of fact and must be clearly established by proof. The conception of the invention consists in the complete performance of the mental part of the inventive act.

Ritter v. Krakaw & Conner, 111 O. G. 1935-6.

It seems probable that Talbot, after seeing Monell's process performed, has convinced himself that it was what he had done some years before, must have been an afterthought on his part in the light of Monell's disclosure, and the evidence does not support his claims. It must be held that Talbot had no conception of the process in issue until he had seen it performed by Monell.

Talbot v. Monell, 107 O. G. 1093.

A specific form is sufficient to show a conception and disclosure of the generic invention.

Slaughter v. Halle, 99 O. G. 2771.

Date of conception.

Wallace v. Scott, 88 O. G. 1704.

"A reasonable doubt on this point will be resolved against the inventor, and special circumstance as, for example, unreasonable delay in making particular or commercial use of the invention or in applying for a patent and the like, would have a tendency to raise this doubt in a particular case."

Rente v. Elwell, 87 O. G. 2119.

"It is also apparent that he had no idea at the time and did not have until he saw Elwell's patent of the additional uses and advantages of a rubber insulating tube capable of being bent or curved without fracture either independent of or in combination with the metal armor tube. His failure,

however, to perceive this additional use and advantage would not bar his right to claim it as a part of his invention if it was a necessary incident, for it is well settled that one who is the first to make an invention is entitled to claim all the uses and advantages that belong to it, that is to say, that follow directly from it as described or manufactured whether they were conceived by him or not."

Reute v. Elwell, 87 O. G. 2119.

(11) *Disclosure of the Invention.*

Witness says he described the invention at a certain dinner. All the testimony goes to fixing the date of the dinner and there is no doubt but that a dinner occurred at that date. But there is no evidence of the disclosure at that time.

Steinmetz v. Thomas, 137 O. G. 479.

The communication of an idea of the desirability of accomplishing a certain result without a disclosure of the means to be employed, can not be regarded as a communication of an invention.

Fenner v. Blake, 134 O. G. 2244.

A wife is now a competent witness for or against her husband though she is apparently not compellable to testify.

Patee v. Cook, 167 O. G. 835.

Disclosure to a draftsman alleged but drawings and machine do not show it.

It must, therefore, be held on this branch of the case that appellant has failed to overcome the heavy burden resting upon him.

Peters v. Pike, Jr., 143 O. G. 259.

An effective disclosure is one that enables one skilled in the art to embody the invention in physical form.

Hopkins v. Newman, 131 O. G. 1161.

The sufficiency of a machine upon which a party would rely to establish his dates of invention as disclosure of the invention in issue should be determined by the official when the machine is introduced in evidence and in connection with the testimony which may be taken concerning it.

Barr v. Bugg, 122 O. G. 2061.

Competency of wife's.

Narsh v. Rein v. etc., 43 O. G. 1453; *Dobeck v. Wovolny*, 58 O. G. 804; *Crawford v. Seickentstein*, 61 O. G. 1480; *Kowen v. Quinet*, 23 O. G. 1329; *Workman v. Cork*, 107 O. G. 835; *Patee v. Westcott*, 1880 C. D. 167; *Harton v. Barrett*, 114 O. G. 975; *Davis v. Kennard*, 131 O. G. 695; *Davis v. Garrett*, 123 O. G. 1991.

Disclosure—-Skilled in the art.

Papin v. Strong, 100 O. G. 931.

Disclosure in the sense of the patent law must be made ordinarily to persons competent to understand and appreciate the alleged invention. Otherwise there is no true disclosure.

Examples:

Of the incompetent, Eastman v. Huston, 95 O. G. 2064;
of the competent, Papin v. Strong, 100 O. G. 931.

When an inventor disclosed one form of invention to his attorney but did not disclose a form having a fewer number of elements, etc., it tends to show that he had not thought of the second form at that time.

Pierce v. Hallett, 18 O. G. 265.

(12) *Additional Cases.*

Cases that pass on the subject matter of this rule:

Clement v. Richards v. Meissner, 1904 C. D. 492, 113 O. G. 1143; Quest v. Ostrom, 1903 C. D. 348, 106 O. G. 1501; Fowler v. Boyce, 1906 C. D. 580, 121 O. G. 1014, 27 App. D. C. 48-55; Davis v. Garrett, 1906 C. D. 724, 123 O. G. 1991, 28 App. D. C. 9; Steinmetz v. Thomas, 1906 C. D. 478, 125 O. G. 1351, 31 App. D. C. 574; Matthes v. Burt, 1904 C. D. 296, 111 O. G. 1363, 24 App. D. C. 265; Gallagher, Jr., v. Hien, 1905 C. D., 115 O. G. 1330, 24 App. D. C. 269; Frunk and Mickle v. Whitely, 1905 C. D. 34, 114 O. G. 971; Robinson v. Phresher, 123 O. G. 2976. (Cites Robinson v. Phresher, 123 O. G. 2627; Frunk v. Whitely, 25 App. D. C. 313-315.)

Rule 111. When Opened to Inspection.

The preliminary statements shall not be opened to the inspection of the opposing parties until each one shall have been filed, or the time for such filing, with any extension thereof, shall have expired, and not then unless they have been examined by the proper officer and found to be satisfactory.

Any party in default in filing his preliminary statement shall not have access to the preliminary statement or statements of his opponent or opponents until he has either filed his statement or waived his