

right thereto, and agreed to stand upon his record date.

A party who alleges no date in his preliminary statement earlier than the filing date of the application or applications of the other party or parties shall not have access to the preliminary statement of said party or parties.

### CONSTRUCTIONS.

A preliminary statement unopened because the opposing party failed to overcome record date is not accessible even after patent issued.

Bacon, 1902 C. D. 151, 99 O. G. 861.

If a person makes a motion that requires a suspension of the running of the time limited he must take notice that the time begins to run again immediately upon the determination of the motion.

Whipple v. Sharp, 1902 C. D. 2, 98 O. G. 225.

Where an action is required to be taken within a certain time after a decision the date of the decision and not the date of the receipt of the notice of it is what governs.

Whipple v. Sharp, 1902 C. D. 2, 98 O. G. 225.

The statement will not be returned even if it is not opened.

Baxter, Jr., 1891 C. D. 147.

### Rule 112. Notice to Amend.

If, on examination, a statement is found to be defective in any particular, the party shall be notified of the defect and wherein it consists, and a time assigned within which he must cure the same by an amended statement; but in no case will the original or amended statement be returned to the party after it has been filed. Unopened statements will be removed from interference files and preserved by the office, and in no case will such statements be open to the inspection of the opposing party without authority from the Commissioner. If a party shall refuse to file an amended statement he may be restricted to his

record date in the further proceedings in the interference.

### CONSTRUCTIONS.

Where the application was made by the administrator and assigned, the assignee may make the statement.

The preliminary statement required in interference proceedings are in the nature of pleadings which require certainty of expression. It is within the jurisdiction of the Examiner of Interferences to require an amended statement whenever, in his opinion, the circumstances are such as to throw doubt upon the accuracy of the statement already submitted. The decision of the Examiner will not be reviewed except in a clear case.

*Opaller v. Huges*, 158 O. G. 481.

The rule requires that these dates and the extent of use be set forth, or, if there has been no model reduction to practice or use, that such facts be specifically disclosed. A preliminary statement lacking this should not be accepted until attention has been called to its defects and opportunity has been given for amendment. The objection should have been made before the parties were permitted to inspect the statements of their opponents. Not having been made then it should, in view of all the circumstances of the case, be made now.

*Schoonmaker v. Sintz*, 123 O. G. 2974.

The Office can not strike out part of a statement, but may strike out the entire statement because a part of it is improper, and then require a statement omitting the improper part.

*Shaw v. Gally*, 1902 C. D. 348, 100 O. G. 3014.

### Rule 113. Motion to Amend.

In case of material error arising through inadvertence or mistake, the statement may be corrected on motion (see Rule 153), upon a satisfactory showing that the correction is essential to the ends of justice. The motion to correct the statement must be made, if possible, before the taking of any testimony, and as soon as practicable after the discovery of the error.

*HISTORY.*

Rule introduced about 1878.  
See Historical Notes to Rule 110.

*CONSTRUCTIONS.**IN GENERAL.**EXCUSE FOR MISTAKE.**In General.*

The fact that applicant was not notified that two design applications by his opponent were included, is sufficient to warrant the allowance of an amendment.

*Hocker v. Farr*, 193 O. G. 1220.

Insufficient showing to warrant the allowance of an amendment.

*Richnitzer v. Bernegau*, 193 O. G. 512.

A motion to amend depending upon testimony should be made at the final hearing and should be appealed as a part of the decision on priority.

*Grammeter v. Thropp*, 190 O. G. 266.

Notice that motion to amend would be made on final hearing.

*Perre v. Thoma*, 188 O. G. 1053.

An amendment allowed in view of loss of memory due to sickness.

*Lindstrom v. Macdonald*, 187 O. G. 831.

A motion under this rule may very properly be postponed to the final hearing where it is necessary to consider all the testimony in deciding the motion.

*Gammeter v. Thropp*, 178 O. G. 320.

A preliminary statement allowed to be amended so as to permit evidence to show that an alleged model was in fact a full sized machine or apparatus.

*Klink v. Kruse*, 177 O. G. 1300.

The discretion of the Commissioner will not ordinarily be disturbed by the Court of Appeals.

*Thomas v. Wientraub*, 177 O. G. 772.

In matters of record or publications which do not depend upon fallible witnesses less strictness is required.

*Cramer et al. v. Carrier*, 177 O. G. 769.

Amendments largely within discretion of Examiner.

*Cramer et al. v. Carrier*, 177 O. G. 769.

An amendment will not be permitted except upon the most satisfactory proof of actual mistake and a showing of the

utmost care in the preparation of the original statement.  
Cases.

Whitall v. Gillispie v. Blaw, 171 O. G. 744.

The showing rather indicates that if the drawings had been examined with reasonable diligence the allowed new matter would have been discovered. Moreover neither a drawing nor a copy of them has been produced. Showing insufficient.

Goldberg v. Crumpton v. Carlin, 141 O. G. 286.

A motion to amend a preliminary statement will not be granted in the absence of a valid ground therefore, even though the proposed amendment does not seek to change the sequence of dates, but only to avoid any unfavorable presumptions arising owing to the discrepancy between the statement and testimony.

Ridgway v. Tilyon, 137 O. G. 979.

The Examiner of Interferences will not hereafter set a limit of appeal in decisions granting motions to amend preliminary statements. He will, however, set a limit of appeal in his decisions denying leave to amend preliminary statements.

Smith & Wickes v. Emerson v. Sanders, 133 O. G. 1433.

The failure of II, the assignee, to communicate this information to P, or to obtain data for the statement for counsel, clearly shows such negligence on the part of the parties interested as should preclude the granting of their request for relief.

Anderson v. Peck, 133 O. G. 229.

It is well settled that the applicant is chargeable with such acts of negligence on the part of counsel.

Anderson v. Peck, 133 O. G. 229.

No amendment after testimony.

Green v. Farley, 132 O. G. 235.

Lack of proper care. It is discretionary with the Examiner, by whom the testimony is to be considered, whether or not he will postpone the consideration of the motion until the final hearing.

Smith v. Ingram, 131 O. G. 2420.

The showing is deemed insufficient to warrant the amendment for reasons indicated above and more fully set forth in 112 O. G. 449; 108 O. G. 56; 116 O. G. 874.

Johnston v. Erekson and Carlson v. Burnard, 131 O. G. 2419.

After making preliminary statement, applicant consulted his wife and stenographer, and this recalled a matter that had

escaped his memory. In view of prompt action amendment allowed.

Davis v. Kinnard, 1907 C. D., 131 O. G. 695.

Apparently if a motion is made to amend in view of the fact that applicant had recalled material facts in consultation with others, the names of those consulted should be given.

Davis v. Kinnard, 1907 C. D., 131 O. G. 695.

Amendments to preliminary statements are to be permitted, after a party has had opportunity to inspect his opponent case, only in cases where bona fide mistakes of fact have been made and a full and clear showing is made that there was no negligence in discovering the true facts.

Borg v. Strauss, 130 O. G. 2719.

A party will not be permitted to amend his preliminary statement to carry back his date of disclosure to cover the date proved by his opponent in a prior interference with a third party where the amended date is earlier than that set up in a preliminary statement filed three years before in an interference between his and said third party and where the affidavit in support of the motion indicates an uncertainty whether the alleged disclosure took place prior to the date originally given.

Beall, Jr., v. Lyon, 126 O. G. 388.

Whether leave shall be given to amend a preliminary statement is a matter that rests in the discretion of the Commissioner and is not reviewable save possibly in a case of palpable abuse of that discretion.

Neth & Tamplin v. Ohmer, 1906 C. D. 693, 123 O. G. 998, 30 App. D. C. 478.

The filing of a statement after other statements are opened will not be permitted except in a clear case.

Dutcher v. Matthew v. Dutcher & Peters v. Jackson, 1905 C. D. 455, 118 O. G. 2538.

The question of extension of time for filing preliminary statements is left wholly within the discretion of the Examiner of Interference and that from his decision upon these matters no appeal will lie. In rare cases to prevent hardship an appeal may be allowed. In all such cases the decision of the Examiner must be complied with until the appeal is allowed.

Ohmer v. Neth & Tamplin, 1905 C. D. 412, 118 O. G. 1686.

On a motion to amend a preliminary statement the question

is not whether the moving party would be able to prove his case if amendment were permitted but is whether the showing made warrants permitting amendment.

*Neth and Tamplin v. Ohmer*, 1905 C. D. 177, 116 O. G. 874.

Whether an amendment shall be allowed under the rules of practice of the Patent Office calls for the exercise of a wide latitude of discretion by the Commissioner and certainly nothing less than an abuse of that discretion, causing a palpable miscarriage of justice, would warrant the review and reversal of this action. (*Cross v. Phillips*, 14 App. D. C. 228.)

*Hammond v. Basch*, 1905 C. D. 615, 115 O. G. 804, 24 App. D. C. 469.

Amendment of preliminary statement, question not reviewed by the Court of Appeals.

*Richards v. Meissner*, 114 O. G. 1831, 24 App. D. C. 305.  
Acts in foreign country.

*Emmet v. Fullager*, 1905 C. D. 52, 114 O. G. 1551.

The publication is something which is fixed and certain both as to date and subject matter. Under such circumstances the rule requiring that the utmost diligence must be shown to have been exercised in preparing the original statement may be applied with less strictness.

*Fullagar v. Junggren*, 1905 C. D. 51, 114 O. G. 1550;  
*Davis v. Ocumpaugh v. Garrett*, 1903 C. D. 1987, 104 O. G. 2440; *Emmett v. Fullagar*, 1905 C. D. 52, 114 O. G. 1551.

After the testimony of one of the parties has been taken, relying upon the dates alleged by the other party, he will not be permitted to amend his statement to change these dates without a most clear and satisfactory showing. (*Franklin v. Morton v. Cooley*, 95 O. G. 2063.)

*Bliss v. Creveling*, 1904 C. D. 381, 112 O. G. 499.

It would seem that in view of the fact that the consideration of Bauer's testimony is necessary in order to rightly determine whether or not he is entitled to amend his preliminary statement, this consideration should be postponed until the date or final hearing.

*Bauer v. Crone*, 1904 C. D. 336, 111 O. G. 1930.

In case of a clerical error where the motion to amend is made promptly, it is proper to allow it.

*Osborn v. Mitchell*, 1904 C. D. 254, 111 O. G. 300.

The burden was upon him to show that he could not have

made the discovery by diligent and careful search and he has not done this.

*Hamilton v. Carroll v. Goldberg v. Stahlberg*, 1904 C. D. 248, 110 O. G. 2510.

If a fact is well known when the preliminary statement is made and is not set forth therein, the failure to include it is negligence and is not a mistake of fact, such as to warrant the amendment of preliminary statement.

*June v. Linn*, 1904 C. D. 203, 110 O. G. 1430; *Solley v. Peck*, etc., 1903 C. D. 259, 105 O. G. 1262.

Refused to let contestant change model to full sized machine to correspond with the testimony under the circumstances of the case.

*Parkes v. Lewis*, 1904 C. D. 142, 110 O. G. 305.

If parties exercised the care in preparing their statements which they exercise in discovering evidence after knowing their opponent's dates, motions to amend preliminary statements would seldom be made and parties would never find themselves in the position of being unable to produce pertinent evidence because of their preliminary statements. Amendment not permitted.

*Fowler v. Boyce v. Temple & Goodrum*, 1904 C. D. 22, 108 O. G. 562.

The motion to amend is defective in that he merely alleges that he made a mistake as to his date of reduction to practice and wishes to amend. He does not state the date he wishes to allege nor the facts upon which the allegation is to be based.

*Fowler v. Boyce v. Dyson v. McBerty*, 1903 C. D. 434, 107 O. G. 544.

Failure to mention the finding of a sketch to his attorney, or make any move to amend until after he had learned from the testimony taken by Andrews what date it was necessary for him to allege which is in itself a sufficient reason for denying the motion.

*Andrews v. Nelson*, 1903 C. D. 287, 105 O. G. 2059.

Insufficient reasons for amendment, laches.

*McHarg v. Schmidt & Maryland*, 1903 C. D. 216, 105 O. G. 263.

A showing of facts upon which the Commissioner can reach the conclusion that the mistakes arose from inadvertence, must be made.

*Brown v. Keeney*, 1903 C. D. 211, 105 O. G. 260.

The fact that a motion to amend a statement is brought after the testimony of the opposing party has been taken is

always a suspicious circumstance, and the showing in support of such a motion is to be carefully scrutinized.

*Pope & Mimo v. McLean*, 1903 C. D. 186, 104 O. G. 2147.

If amendments to preliminary statements were permitted merely because the evidence shows the facts to be in accordance therewith, the rule requiring preliminary statements might as well be abolished.

*Woodward v. Kennedy*, 1903 C. D. 106, 104 O. G. 1393.

It must appear clearly that the party used all reasonable care and diligence in preparing his original statement and in discovering the facts he alleged therein.

*Woodward v. Kennedy*, 1903 C. D. 106, 104 O. G. 1393.

It is not believed that the desire of the Office to discover all the facts and to issue the patent to the one who is in fact the first inventor justifies it in relieving a party from the effects of such negligence as has been exhibited in this case.

*Steiver*, 1902 C. D. 381, 101 O. G. 1130.

An amendment refused because of negligence in the first preparation.

*King v. Hansen*, 1902 C. D. 378, 101 O. G. 1129.

An amendment stating date of making a model admitted.

*Williams v. Liberman*, 1902 C. D. 295, 100 O. G. 1332.

A new preliminary statement will not be admitted upon a redeclaration of the interference with part of the counts in it only.

*Seaman v. Brooks*, 1902 C. D. 267, 100 O. G. 685.

It is not stated what the additional facts are; nor is it stated that the utmost diligence was exercised in making the discovery. The affidavit does not state the ways and means employed in finding the new facts neither does it point out why the same ways and means could not have been earlier employed. The showing is not sufficient.

*Seaman v. Brooks*, 1902 C. D. 267, 100 O. G. 685.

An affidavit by the inventor and by another received in support of the motion. Where no testimony has been taken and the new dates are not earlier than his opponent's, the motion will the more readily be granted.

*Gales v. Berrigan*, 1902 C. D. 232, 100 O. G. 232,

Courts do not relieve against mistakes of law.

*V. v. M. v. Cooley*, 1901 C. D. 49, 95 O. G. 2063; *Dahl-*

*gren v. Crocker*, 1902 C. D. 107, 98 O. G. 2586.

The rule is that only the utmost diligence will be a sufficient showing. But may be relaxed under proper circumstances.

*Silver v. Eustes*, 1902 C. D. 91, 98 O. G. 2361.

If the case has so far advanced that testimony has been



taken, each party relying on the other's statement for the dates which must be overcome, an amendment to set back these dates is open to suspicion and will be received only upon a clear showing of mistake, and, further than that, the moving party must be free from negligence and must show the utmost diligence in seeking to correct the mistake.

Henderson v. Noakes, 1892 C. D. 114, 29 O. G. 1431;

Lockwood v. Schmidt, 1902 C. D. 253, 100 O. G. 453;

McDermott v. Hildreth, 1902 C. D. 43, 98 O. G. 1282.

The preliminary statement ought not to be amended, after testimony taken, to insert facts which were within the knowledge of the affiant before the testimony was closed.

Mills v. Tortance, 1902 C. D. 17, 98 O. G. 416.

Must relieve of default before making motion.

Atkins v. Paul v. Johnson, 1901 C. D. 35, 94 O. G. 1785.

Must be presented to Examiner of Interferences.

China and Japan Trading Co., Limited, 1900 C. D. 157, 92 O. G. 2508.

May not be amended to read as early as May instead of in May.

Miehle v. Read, 1899 C. D. 191, 89 O. G. 354.

When the error is merely a mistake in a legal conclusion and it is not sought to set up a different state of facts, the amendment may be made.

Richardson v. Humphrey, 1899 C. D. 179, 88 O. G. 2241.

Motions to amend preliminary statements should not be disposed of upon affidavits alone, but upon the entire record.

Foster & Foster v. Bent, 1896 C. D. 89, 77 O. G. 1781.

Amendments to the preliminary statement should be governed by the same rules as are applied to pleadings by the courts. "The preliminary statement should be amended where indisputable fact or clearly proved circumstances support the necessary inference that a mistake has been made which would defeat the ends of justice, where with all reasonable diligence in ascertaining facts and in making the statement a drawing or a model or an abandoned application or some other fact of clear date and origin has been unearthed which by reasonable diligence could not have been found and which in fact was not found earlier.

Foster & Foster v. Bent, 1896 C. D. 89, 77 O. G. 1781.

A decision of the Commissioner of Patents denying an interfering party's motion to amend his preliminary statement is a judicial rather than a ministerial act, and consequently one over which the Secretary of the Interior has no appellate jurisdiction.

Noakes, 1892 C. D. 243, 66 O. G. 575.

No appeal lies to the Secretary of the Interior from the Commissioner's refusal to admit an amended statement.

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

Utmost care and diligence must be shown before amendment allowed.

Henderson v. Noakes, 1892 C. D. 114, 59 O. G. 1431.

Motions to reopen brought in the first instance before the Examiner of Interferences.

Bowen v. Bradley, 1892 C. D. 13, 58 O. G. 386.

The Office acts judicially rather than ministerially in permitting or denying the amendment of a preliminary statement.

Henderson v. Noakes, 1892 C. D. 123, 59 O. G. 1762;

Washburn v. Hadfield, 1891 C. D. 234, 57 O. G. 1719.

When a preliminary statement is amended for any reason, the original statement remains to confront the applicant and to be considered in determining what the real truth was.

Zwietusch v. Stockheim, 1890 C. D. 151, 53 O. G. 755.

An amendment of the preliminary statement should not be permitted in order to allow the date of conception and reduction to practice in a foreign country to be inserted.

Boulton v. Illingworth, 1888 C. D. 32, 43 O. G. 508.

If a person knowing that the dates alleged in his preliminary statement are not the earliest he can establish, neglects to ask a postponement until he can refresh his memory, and waits until his opponent has put in his evidence before asking to amend, he has not used sufficient diligence to entitle him to an amendment.

Donnelan v. Berry, 1887 C. D. 140, 41 O. G. 1499.

A motion to amend the preliminary statement can not be repeated after having been once rejected without especial permission. Practice in such cases.

Clemson v. Fowler, 1886 C. D. 35, 37 O. G. 671.

The preliminary statement may be amended in respect to the date of invention upon a proper showing, so that the evidence taken may be at least considered.

Robinson v. Seymour, 1885 C. D. 98, 33 O. G. 113.

It is only in cases where parties have failed to comply with the law after having made reasonable and proper efforts to do so that further opportunity to amend is or should be accorded.

Smith v. Thomas v. Cowles, 1885 C. D. 12, 30 O. G. 343.

Where it is made reasonably certain that a mistake has been made an amendment of the preliminary statement should be allowed at any time before the closing of testimony. If

such amendment renders it necessary for the opposite party to take further testimony, he should be allowed to do so on proper motion.

Moore v. Brown, 1882 C. D. 20, 22 O. G. 1882.

Unless the party having made such statement asks to amend the same before any testimony is taken in the case, all parties have a right to proceed on the issue as made in the respective statements.

Hopkins v. LeRoy, 1880 C. D. 188, 18 O. G. 859.

It is contrary to public policy to allow amendments of preliminary statements after they are opened.

Oliver v. Zeller, 1876 C. D. 187, 10 O. G. 416.

Ignorance and carelessness are not adequate reasons for allowing an amendment of the preliminary statement after the statement is open to the inspection of the opposite party.

Guest v. Finch, 1876 C. D. 144, 10 O. G. 165.

If an applicant was of unsound mind at the time of making the preliminary statement he may be permitted to amend, or the preliminary statement can be dispensed with.

Brooks, 1874 C. D. 84, 6 O. G. 296.

An amendment to the preliminary statement after the decision by the Examiner and the Board, which attempts to carry back the date of invention, could, in the light of the proof, have no possible effect, unless to impugn deponents veracity.

Cutting v. Kaylor, 1872 C. D. 265, 2 O. G. 704.

The sole object of the rule requiring sworn preliminary statements is to prevent all shuffling with regard to the date, when a party in interference made his invention. Nothing but a fraud, perhaps, practiced on the deponent should relax this rule, but a mere clerical error might be corrected.

Allen & Moody v. Gilman, 1872 C. D. 205, 2 O. G. 293.

#### *Excuse for Mistake.*

F's explanation as to his misuse of the word "model" in its legal sense is a reasonable one, and in view of the fact that his motion was brought prior to the taking of any testimony it is thought his motion should have been granted, if the only change he desired to make was to allege that a device made in a certain date constituted a reduction to practice instead of a model.

Day v. Adt v. Hardy, 1906 C. D. 526, 125 O. G. 2765;

Fordyce v. Tarsey, 1903 C. D. 31, 102 O. G. 821.

A motion to amend a preliminary statement to correct the inadvertent use of the word "model" instead of the words "full sized machine" will not be granted where it is found

that the device referred to as the "full sized machine" does not disclose the issue.

*Parkes v. Lewis*, 1906 C. D. 2, 120 O. G. 323.

The meaning of words should be ascertained before using them in a preliminary statement. A mistake in this respect is not an excuse permitting an amendment.

*Dunn v. Halliday*, 1905 C. D. 510, 119 O. G. 1261.

That the search conducted was originally unsuccessful not sufficient excuse.

*Hoyt v. Sanders v. Hawthorne*, 1905 C. D. 508, 119 O. G. 1260.

Where the alleged error in a preliminary statement is discovered as soon as inspection of the opposing party's case reveals the fact that the allegation of an earlier date is necessary, the presumption is strong that the alleged error could have been discovered sooner if proper care had been exercised.

*Neth & Tamplin v. Ohmer*, 1905 C. D. 177, 116 O. G. 874.

Amendment to a preliminary statement will not be permitted where the excuse for the alleged error is forgetfulness and there is no showing what effort, if any, was made to refresh his recollection originally or what steps were taken to fix definitely and certainly the dates to be alleged.

*Friestedt v. Harold*, 1905 C. D. 161, 116 O. G. 594.

Negligence of attorneys is not sufficient excuse.

*White v. Hewitt & Nolen*, 1905 C. D. 130, 115 O. G. 1846.

G is the one to state what he understood. It is not sufficient for his attorney to allege what he supposed was G's understanding of the matter.

*Guett v. Tregoning*, 1905 C. D. 23, 114 O. G. 544.

It is for the Office to determine whether it was impossible for the deponent to get into communication with a witness.

*Bliss v. Creveling*, 1904 C. D. 381, 112 O. G. 499.

Where a preliminary statement was drawn under a fair misconception of the issue an amendment was permitted.

*Carroll v. Stahlberg*, 1904 C. D. 331, 111 O. G. 1937.

It is necessary not only to show that there was an actual mistake, but how it arose. Where original statement in writing shows certain dates and it is alleged that the dates were changed by oral conversation, it required a very good showing to permit their change to original condition.

*Heinitch & Morairty v. Congdon v. Kelsea*, 1903 C. D. 302, 106 O. G. 542.

If a fact is well known when the preliminary statement is

made and it is not set forth therein, the failure to include it is negligence and not a mistake of fact such as to warrant the amendment of the preliminary statement.

Soley v. Peck v. Clement v. Richards v. Meissner, 1903 C. D. 259, 105 O. G. 1262.

A mere statement that the mistake arose from inadvertence and mistake is not sufficient especially after two months delay.

Brown v. Cutler v. Keeney, 1903 C. D. 182, 104 O. G. 1896.

### **Rule 114. Failure to File Preliminary Statement.**

If the junior party to an interference, or if any party thereto other than the senior party, fail to file a statement, or if his statement fail to overcome the *prima facie* case made by the respective dates of application, such party shall be notified by the examiner of interferences that judgment upon the record will be rendered against him at the expiration of thirty days, unless cause be shown why such action should not be taken. Within this period any of the motions permitted by the rules may be brought. Motions brought after judgment on the record has been rendered will not be entertained unless sufficient reasons appear for the delay.

### *CONSTRUCTIONS.*

A party under an order to show cause can not have access to his opponent's papers.

Henderson and Camley v. Kindervater, 192 O. G. 741.

If the junior party, who is under an order to show cause, believes that the claims of the issue are improper or that he is the first inventor of subject matter common to the cases of the interferrants which is not set forth in the issue, it is his duty to present within the time allowed suitable motions either under Rules 122 or 109.

Crone v. White, 181 O. G. 1072.

If it is desired to take testimony a motion should be made to set the case down for hearing under Rule 130.

Noble v. Levin, 180 O. G. 602.

Barney v. Hess, 158 O. G. 702.

A party may move to dissolve for lack of patentability in reply to an order to show cause, but in order that he should be heard, it is incumbent on him to comply strictly with the rules. If filed subsequent to the thirty days very good reasons for the delay must be shown.

Ryder v. Brown v. Tripp and Means v. White, 137 O. G. 1228.

The affidavit of a physician that the applicant is mentally incapable of making a preliminary statement is insufficient if it does not "appear that any effort has been made to have a legal representative appointed."

Churchill v. Goodwin, 132 O. G. 1838.

A motion to dissolve on the ground of nonpatentability of the issue is a proper reply to an order to show cause under Rule 114.

Field v. Colman, 131 O. G. 1687.

Cause must be shown by motion.

Filbel v. Fox, 130 O. G. 2375.

A patent held not to evidence conception of invention at the date of filing the application inasmuch as the invention was improperly inserted.

McKnight v. Pohl, 130 O. G. 2069.

Hewitt v. Weintraub v. Hewitt & Rogers, 128 O. G. 1689.

See note under Rule 109.

Rule 114 was amended March 13, 1903, by the omission of the provision requiring a motion to be noticed within the limit of appeal and the practice under Meyrose v. Jahn, 1891 C. D., 56 O. G. 1447, has been modified in Kneedler v. Shepard, 1903 C. D. 180, 104 O. G. 1895, so that motions under said rule need not be noticed for hearing within the term allowed for filing motions.

Naully v. Cutler, 1907 C. D., 126 O. G. 3.

If a preliminary statement alleged a date between two limits and the later of said limits would not overcome the opponent's *prima facie* case, judgment should be rendered against affiant.

Steinmetz v. Thomas, 1906 C. D. 478, 125 O. G. 1351.

Rule does not clearly and unmistakably require the Examiner of Interferences to render judgment against a party who has been called upon to show cause under that rule and who fails to take any action in response. No appeal from a refusal to render judgment on the record.

Lemp v. Randall & Bates v. Thomson, 1906 C. D. 42, 120 O. G. 905.

Where the preliminary statement of N and T failed to over-

come the record date of O's application and motion by N and T to amend their preliminary statement has been denied and the denial affirmed on appeal. Held that O is entitled to an award of priority.

Neth & Tamplin v. Ohmer, 1906 C. D. 1, 120 O. G. 323.

A decision refusing to enter judgment on the record is not reviewable on an interlocutory appeal.

Mulligan v. Tempest Salve Co., 1905 C. D. 530, 119 O. G. 1924.

Under applicant's allegation of conception of invention in November, 1901, he is privileged, if he can, to establish conception of invention prior to November 16, 1901, the date on which Strouble filed his application. It is therefore seen that the statement filed by W does not fail to overcome the *prima facie* case made by Strouble's date of application.

Winsor v. Strouble, 1904 C. D. 158, 110 O. G. 600.

A showing to obtain an extension of time must necessarily be a verified one.

Kletzker & Goesel v. Dodson, 1904 C. D. 100, 109 O. G. 1336.

The original of a divided application fixes the date of filing.

Gilbert Stringer v. Johnson, 1903 C. D. 20, 102 O. G. 621.

A judgment upon the record set aside in order to redeclare the interference with a prior application of the defeated party from which the conflicting claims had been eliminated. In asserting a legal right motives are immaterial.

Thorp v. White, 1900 C. D. 66, 91 O. G. 1435.

Showing not required if suitable motion is made under Rule 122.

Law v. Wolf, 1891 C. D. 91, 55 O. G. 1527.

It is not the practice to issue an order to show cause.

Kendall v. Frasch, 1890 C. D. 36, 50 O. G. 1132.

An earlier application, in order to entitle a junior party to judgment on the record, must be upon its face an application in behalf of the same person who filed the application immediately in interference.

Oliver v. Everett, 1889 C. D. 214, 49 O. G. 731.

Rule 107 is based on Rule 111. The motion to adjudicate the case upon the record under this rule is in the nature of a demurrer to the declaration, and calls up the case for decision upon the pleadings. The objection that the prior applicant has not reduced the invention to a practical form is not

good if the specification and drawings show the invention to be capable of being put into a practical machine.

*Starr & Peyton v. Farmer*, 1883 C. D. 34, 23 O. G. 2325; affirmed by Secretary, 23 O. G. 2327.

A preliminary statement alleging a date of invention, 1872, does not overcome the *prima facie* case made by the date of application for a patent filed January 4, 1873, as a division of an application filed July 12, 1871.

*Huntley v. Smith*, 1880 C. D. 182, 18 O. G. 795.

No notice to adverse parties is required in cases under this rule.

*Booth v. Lyman*, 1880 C. D. 62, 17 O. G. 393.

Where default is made a new hearing will be more readily granted.

*Loring v. Hall*, 1879 C. D. 8, 15 O. G. 471.

It was no excuse for a patentee for not filing his preliminary statement, that he was waiting to obtain as much information of applicant's invention as the applicant had of his. This information should be refused by the Office.

*Spaulding & Aldrich v. Winchester*, 1871 C. D. 94.

#### *Additional Cases.*

Cases that pass on the subject matter of this rule:

*Benger v. Burson*, 1902 C. D. 164, 99 O. G. 1384; *Patten v. Wiesenfeld*, 1902 C. D. 197, 99 O. G. 2547; *Patten v. Wiesenfeld*, 1902 C. D. 114, 98 O. G. 2589; *Brough v. Snyder*, 1901 C. D. 3, 94 O. G. 221; *Meyer v. Sarfert*, 1901 C. D. 91, 96 O. G. 1037; *Bundy v. Rumbarger*, 1900 C. D. 143, 92 O. G. 2003; *Forbes v. Thomson*, 1890 C. D. 61, 51 O. G. 297.

### **Rule 115. Failure to File Testimony Excluding Setting up Invention Prior to Application Date.**

If a party to an interference fail to file a statement, testimony will not be received subsequently from him to prove that he made the invention at a date prior to his application.

See Rule 53 of 1871 quoted under Rule 110.

### **Rule 116. Presumption as to Order of Invention.**

The parties to an interference will be presumed to have made the invention in the chronological order



in which they filed their completed applications for patents clearly disclosing the invention; and the burden of proof will rest upon the party who shall seek to establish a different state of facts.

### HISTORY.

Rule 56 of 1869 reads in part as follows: "In case of interference the party who first filed his application for a patent will be deemed the first inventor in the absence of all proof to the contrary."

In 1870, inserted the words "so much of" between "his" and "filed" and the words "as illustrates his invention" between "patent" and "will."

In 1878, instead of "as illustrates his invention" the words "as is required by Rule 7" were used.

Rule 111 of 1879, see appendix.

The wording of the present rule is in the edition of September 1, 1880.

In 1892, instead of "filed" the words "claimed the same in" were used. The present wording restored June 18, 1897.

See notes under Rule 122, title "Shifting Burden of Proof." Also as to filing date, Rules 31 and 171.

### CONSTRUCTIONS.

- (1) BURDEN OF PROOF—RECORD DATE.
- (2) CLEARNESS REQUIRED.
- (3) DIVISIONAL APPLICATION.
- (4) ABANDONED APPLICATION.
- (5) FORFEITED APPLICATIONS.
- (6) AMENDMENTS.
- (7) FOREIGN PATENTS.

#### (1) *Burden of Proof—Record Date.*

A sole application may be a continuation of a joint application.

In re Roberts, 273 O. G. 410.

Mechanical application does not give a record date to a design application.

McArthur v. Gilbert, 1904 C. D. 245, 110 O. G. 2509; see also Lowrie v. Taylor et al., 186 O. G. 1681.

The question of shifting the burden of proof is a matter within the jurisdiction of the Examiner of Interferences and not the Primary Examiner, and there is no appeal from his decision prior to final judgment. (Raulet & Nicholson v. Adams, 114 O. G. 1827.)

Scott v. Southgate, 1906 C. D. 104, 121 O. G. 689.

A petition that a divisional application be substituted for the original application in interference and that an amendment be entered in the original case to eliminate the interfering subject matter and put the case in condition, for allowance granted.

The question whether the claims are patentable over the issue is one for the Primary Examiner.

*Burchart v. Nolan & Wright v. Christianaeu*, 180 O. G. 601.

We must consider then the claim in issue as properly relating back to the filing of the original specification, and that date as the date of reduction to practice.

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

The rule which permits a divisional application to relate back to the filing date subject-matter as long as it remains open in the Patent Office is a very liberal one that sometimes works hardship upon intermediate inventors and it ought not to be extended to cases not clearly within it, as where a patent has issued on the first application.

*Spitteler*, 134 O. G. 1299; *Wainwright v. Parker*, 142 O. G. 1115.

Where a patent is inadvertently issued while an application by another is pending without, an interference, no advantage accrues, to the patentee on the question of burden of proof.

*Cutler v. Lenard*, 136 O. G. 439.

A divisional application dates back to the original one and secures to the applicant the benefit of a constructively reduction to practice whether the claims of the divisional application were in the original when filed or not.

*Lotz v. Kenny*, 135 O. G. 1801.

The invention was embraced in the claims of the original application, and therefore no rights have become vested in later inventors which stop Newman from making these claims. (*McBirly v. Cook*, 1900 C. D. 248, 90 O. G. 2295.)

*Hopkins v. Newman*, 131 O. G. 1161.

Part of claims were in former application, the burden of proof different as to these claims.

*Bliss v. McElrery*, 128 O. G. 458.

The alleged improper placing of the burden of proof forms no proper basis for motion for dissolution and that the question should be presented by separate motion to shift the burden of proof.

*Blackmore v. Hall*, 118 O. G. 2538, 1905 C. D. 456.

Under the practice announced in *Raulet & Nicholson v. Adams* (114 O. G. 1827), the question of shifting the burden

of proof is a matter to be considered and decided by the Examiner of Interferences and is not appealable prior to the final decision in the case.

*Duryea & White v. Rice*, 118 O. G. 2249, 1905 C. D. 428.

Where an appeal was taken from the action of the Primary Examiner denying a motion to shift the burden of proof, the appeal not considered and case remanded to Examiner of Interferences. Head note to

*Fisher v. Daugherty*, 118 O. G. 1681, 1905 C. D. 399.

Opinion does not seem to bear out head note.

As a general rule, the burden of proof rests on the party against whom judgment would be rendered if no evidence were adduced on either side. This question, involving the taking of testimony, should be considered by the Examiner of Interferences and there is no appeal from his decision prior to the final appeal.

*Fennell v. Brown v. Borsch, Jr.*, 115 O. G. 1328, 1905 C. D. 117.

Claimed that the invention was not shown in original application, but was introduced by amendment subsequent to the filing of opponent's application, "If well founded, this would entitle S, who was the first to conceive, the benefit, also, of the earlier reduction to practice, and an inquiry into the question of diligence would be unnecessary."

*Seeberger v. Dodge*, 114 O. G. 2382, 1905 C. D. 603, 24 App. D. C. 476.

As held in the case of *Raulet & Nicholson v. Adams* (114 O. G. 1827), no appeal will be entertained upon interlocutory motion relating to the burden of proof, but that the matter may be brought up with the final decision as to priority of invention. Such motions should be made before the Examiner of Interferences.

*Osborne v. Armstrong*, 114 O. G. 2091, 1905 C. D. 65.

A previous application which does not show all the elements of the issue can not avail to shift the burden of proof.

*Norden v. Spaulding*, 114 O. G. 1829, 1905 C. D. 588, 24 App. D. C. 286.

Motions to shift the burden of proof should be made before the Examiner of Interferences within the twenty days after the approval of the preliminary statements allowed for motions. This case withdraws jurisdiction from the Primary Examiner in this class of cases.

*Raulet & Nicholson v. Adams*, 114 O. G. 1827, 1905 C. D. 55.

Said by Commissioner on Appeal. Before the interference

proceeds further, it should be positively determined whether or not these new references anticipate the issue.

Wright & Stebbins v. Hansen, 114 O. G. 761, 1905 C. D. 27.

Motions to shift the burden of proof are brought under the provisions of Rule 116. In a proper case the burden of proof can be shifted without dissolving and redeclaring the interference.

Dinkel v. D'Alier, 113 O. G. 2507, 1904 C. D. 572.

The pendency of a motion for dissolution is no good reason for delay in bringing a motion to shift the burden of proof. (See McArthur v. Gilbert, 111 O. G. 1624.)

Harvey v. Lubbers v. Raspillaire, 112 O. G. 1215, 1904 C. D. 411.

F's patent does not make him the senior party in the proceeding, as D was the first to file an application, he is the senior party in this proceeding, and it is incumbent upon F in order to prevail to establish his case by a preponderance of evidence.

Furman v. Dean, 111 O. G. 1366, 1904 C. D. 305.

When an error is discovered by the Examiner of Interferences which would amount to such an irregularity as would preclude proper determination of the question of priority, such as the improper placing of the burden of proof, the interference should be forwarded to the Primary Examiner with a statement of facts, that he may correct his letter forwarded to the Examiner of Interferences under Rule 97.

Lutz v. Lewis, 110 O. G. 2014, 1904 C. D. 227.

A subsisting patent lawfully issued can not be invalidated or in any manner effected by any subsequent proceeding in the Patent Office even to the extent of imposing the burden of proof upon its holder that it was lawfully issued.

Lutz v. Lewis, 110 O. G. 2014, 1904 C. D. 227.

The date of invention can not be carried back to a previous joint invention.

Arnold v. Vaughen et al. v. Arnold et al., 109 O. G. 805, 1904 C. D. 78; Haskell v. Miner v. Ball, 109 O. G. 3170, 1904 C. D. 131.

This rule is applicable, notwithstanding the fact that a patent was inadvertently issued to the junior party without an interference.

Watson v. Thomas, 106 O. G. 1777, 1903 C. D. 370.

The burden of proof is upon the junior party to show that he was diligent.

Pihl v. Mersman, 106 O. G. 1777.

As Ostrom is entitled to his filing date as his date of reduction to practice and as Quest was wholly inactive at this time, Ostrom is entitled to priority.

Quest v. Ostrom, 106 O. G. 1501, 1903 C. D. 348.

An application for a patent when filed complete in the Patent Office which warrants the issue of a patent and is not abandoned, is in law a constructive reduction to practice. Before it is filed it may be only evidence of conception.

Hopfelt v. Read, 106 O. G. 768, 1903 C. D. 319.

If one wishes to establish the date of filing of an earlier application he should do so by a motion to shift the burden of proof, in which case the decision of the Primary Examiner as to the admission of claims will be final. If such earlier application is brought in the course of taking the testimony it will be considered like other testimony by all the tribunals having jurisdiction.

Robinson v. Copeland, 102 O. G. 466, 1903 C. D. 13.

Between two applicants one may have the benefit of the date of filing a previous application, but between an applicant and a patentee the rule is modified. A subsisting patent lawfully issued, can not be invalidated or in any manner affected by any subsequent proceeding in the Patent Office, even to the extent of imposing the burden of proof upon its holder that it was lawfully issued.

Asencio v. Russell, 99 O. G. 2321, 1902 C. D. 188.

The words "their completed applications" are not limited to mean only the applications involved in the interferences nor those pending concurrently thereupon. They refer to any completed application in which the invention is disclosed by means of which judgment of priority would necessarily be rendered in favor of the party so disclosing, provided no testimony at all (Rule 114) or no more testimony were taken.

Meyer v. Sarfert, 96 O. G. 1037, 1901 C. D. 91.

Motion to shift need not set up facts unless they are outside the record.

Sheppard v. Webb, 94 O. G. 1577, 1901 C. D. 32.

A reissue application is entitled to the date of the original application.

Walsh v. Hallbauer, 88 O. G. 2409, 1899 C. D. 184;

Austin v. Johnson, 95 O. G. 2585, 1901 C. D. 391, 18

App. D. C. 83.

A motion to shift the burden of proof may be founded upon matters outside of the record.

Bundy v. Rumbarger, 92 O. G. 2001, 1900 C. D. 143.

The first to make a claim in substance and effect covering the invention is the senior party.

Richards v. Leidgen, 77 O. G. 153, 1896 C. D. 63.

The word "claimed" does not include the description.

Edison v. Ball, 71 O. G. 1313, 1895 C. D. 811.

As recently amended and construed in the light of decisions bearing upon it, means that he who first made a claim of statement of invention covering the invention in interference should be considered the senior party.

Huson v. Crowell v. Yale, 64 O. G. 1006, 1893 C. D. 107.

Held on appeal that as the applicant disclosed, but did not claim the invention in controversy in an application antedating his opponent's earliest claimed date, the office must consider this in determining the question of priority.

O'Shaughnessy v. VanDepolle, 62 O. G. 1063, 1893 C. D. 19.

The date on which each applicant made his claim or equivalent statement of invention for the subject-matter involved in the interference issue determines his status.

Kennyson v. Merritt, 1892 C. D. 54; 58 O. G. 1415.

Burden of proof when originality denied.

Wherry v. Heck, 1889 C. D. 201, 49 O. G. 559.

To take back the record date to a former application, or to other records in the patent office, there must be something in the application in question identifying it with such records.

Booth v. Lyman, 1880 C. D. 151, 18 O. G. 132; Huntley v. Smith, 1880 C. D. 182, 18 O. G. 795.

Priority of invention, under rule 107 is determined prima facie as between two original applications by the dates of filing the applications; as between an original pending application and one or more patents by the date of filing the pending application, and the application on which the patents were granted; as between a pending reissue application and one or more unexpired patents by the date of filing the original application for the patent of which a reissue is asked and the application upon which the other patents were granted.

Booth v. Lyman, 1880 C. D. 62, 17 O. G. 393.

Date of filing, or perhaps date of jurat should be assumed as the date of invention in absence of other proof.

Knight v. Annan, 1871 C. D. 34.

Cases that pass on the subject-matter of this rule.

McGill v. Adams, 119 O. G. 1259; Byron v. Henry, 104 O. G. 1895; Brough v. Snyder, 1901 C. D. 1, 94 O. G. 221; Osborne v. Hotsapillar, 1901 C. D. 16, 94 O. G. 583; Oliver v. Everitt, 1889 S. D. 214, 49 O. G. 731.

*(2) Clearness Required.*

An applicant should not be given the record date of an earlier application if there is reasonable doubt if it disclosed the issue. The Examiner's decision that the issue was not so disclosed raises a doubt and the question should again be brought in question by introducing such earlier application in evidence instead of by appeal.

Munroe v. Alexander, 1903 C. D. 334, 106 O. G. 1000.

A claim suggested under rule 96 applicant did not insert it but made another application. Held that in view of the indistinctness upon the point in question of first application applicant could not have date of first application.

Krakaw v. Harding, 1903 C. D. 264, 105 O. G. 1531.

In the original application of which the one in controversy was a division the combination was not shown in the drawings as a unit but was described in the specification. Held sufficient to establish the date. Even a disclaimer would not prevent this provided the claims were made in a later application.

Dittigen v. Parmenter, 1902 C. D. 218, 99 O. G. 2966.

What constitutes clearly illustrating and describing.

Silverman v. Hendrickson, 1902 C. D. 527, 99 O. G. 1171,  
19 App. D. C. 381.

*(3) Divisional Application.*

Date of original of a divisional application.

Robinson v. Seelinger, 1905 C. D. 640, 116 O. G. 1735,  
25 App. D. C. 237; Duryea & White v. Rice, Jr., 1907  
C. D. 28, 126 O. G. 1357, 28 App. D. C. 423.

An applicant should not be given the record date of an earlier patent application when there is reasonable ground to refuse it, he may, however, introduce the earlier application as a part of his evidence and contend that it shows the invention.

Greenwalt v. Marks, 1904 C. D. 352, 111 O. G. 2224.

As it has been finally decided that the disclosure is sufficient in the divisional application to support the claims, it follows that the disclosure in the original application is sufficient.

Hopfelt v. Read, 1903 C. D. 319, 106 O. G. 767.

If a divisional application also contains original matter it is a division of the former so far as it contains matter that was in the original but no further.

Gilbert-Stringer v. Johnson, 1903 C. D. 20, 102 O. G. 621.

Purpose of rule. Failure of junior party to bring motion

to shift the burden of proof raises no presumption that his application is not a division of an earlier one.

Phelps v. Hardy v. Gattman & Stern, 1896 C. D. 70, 77 O. G. 631.

When an application is filed describing and illustrating more than one invention, and during the pendency in the Office another application is filed by the same inventor, stating that it is a division of the original application and claiming an invention described and illustrated, the latter application is to be considered a divisional application for the purpose of interference proceedings, whether or not the divisional invention was claimed in the first application. It is to be noticed that this rule is entirely silent upon the subject of claiming the invention.

Forbes v. Thomson, 1890 C. D. 61, 51 O. G. 297.

Where an application is made clearly describing an invention but expressly disclaiming it with a view of making a second application for said invention, where the second application is put in interference the date of filing the first application is the date referred to by this rule.

Sellen v. Hockhausen, 1885 C. D. 103, 33 O. G. 995.

#### (4) *Abandoned Applications.*

When an applicant files a complete application for a patent on a certain invention and thereafter files another application and allows the first to become abandoned, the applicant is entitled to his date of the first application for the date of his constructive reduction to practice for the invention which is common to the two applications. The effect is different if he permits the first application to become abandoned before he files the second one; but when the two applications are pending together the applicant has the benefit of the first date of filing for a constructive reduction to practice as the whole constitutes one continuous proceeding.

Lotterhand v. Hanson, 1904 C. D. 39, 108 O. G. 799.

An abandoned application gives the date of conception.

Silverman v. Hendrickson, 1902 C. D. 527, 99 O. G. 1171, 19 App. D. C. 381.

An abandoned application does not establish a date of reduction to practice, it is only evidence of conception.

Carty v. Kellogg, 1896 C. D. 188, 74 O. G. 657, 7 App. D. C. 542.

The original of a divisional application is the one to fix the date under this rule, but an abandoned application cannot be used for that purpose.

Henderson v. Reese, 1883 C. D. 67, 25 O. G. 191.



(5) *Forfeited Applications.*

Where an applicant has made a previous application in which he might have made the claims, this is sufficient to establish the date. Query if case was abandoned for non-payment of final fee.

Lowry v. Spoon, 1904 C. D. 173, 110 O. G. 858.

Where one party has been at fault in causing an application to become forfeited, he cannot be permitted to take advantage of that fact. (Christensen v. Noyes, 99 O. G. 227 distinguished.)

Russell v. Asencio, 1904 C. D. 106, 109 O. G. 1605.

Where an application is abandoned by a failure to pay the final fee within six months after allowance, and a renewal application is filed within two years after the allowance of the first application, the date of the first application is to be taken.

Thomson v. Waterhouse, 1885 C. D. 2, 30 O. G. 177.

(6) *Amendments.*

These amendments were made prior to the time appellant entered the field, and the rule in this instances is far more liberal than where it is sought to enlarge the scope of an application to the prejudice of inventors whose rights have accrued between the date of filing and the date of amendment.

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

Where the invention was caused to appear in a party's patent by an amendment to the application improperly extending the original disclosure. Held that the patent is not evidence of invention by the patentee at any time, as the matter in question is not supported by oath stating that it was invented by him.

Pohle v. McKnight, 1905 C. D. 549, 119 O. G. 2519.

A motion to shift the burden of proof because the invention in issue was introduced by amendment is improper. The remedy is by motion to dissolve under rule 122.

Tripp v. Wolff v. Jones, 1903 C. D. 141, 103 O. G. 2171.

An amendment is entitled to the date of filing.

Walsh v. Hallbauer, 1899 C. D. 184, 88 O. G. 2409.

Where a new invention is introduced by amendment, such amendment fixes the date of invention.

Hull v. Lowden, 1881 C. D. 30, 20 O. G. 741.

(7) *Foreign Patents.*

Even where a party secures for his application here the benefit of the filing date of a foreign application, the actual filing date in this country must appear and cannot be changed to the foreign filing date.

Pauling, 1905 C. D. 131, 115 O. G. 1848.

An ex parte affidavit is not sufficient to change the burden of proof by carrying back a party's filing date to that of a foreign application.

Raulet v. Nicholson v. Adams, 1905 C. D. 55, 114 O. G. 1827.

If the application is filed over 12 months after foreign application, applicant cannot have the benefit of the foreign filing date.

Muller v. Lauber, 1903 C. D. 387, 106 C. D. 2016.

**Rule 117. Statement not Evidence.**

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

*CONSTRUCTIONS.*

Even after amendment the original statement remains a part of the case, with its full effect under this rule.

Foster & Foster v. Bent, 1896 C. D. 89, 77 O. G. 1781.

**Rule 118. Time for Taking Testimony.**

Times will be assigned in which the junior applicant shall complete his testimony in chief, and in which the other party shall complete the testimony on his side, and a further time in which the junior applicant may take rebutting testimony; but he shall take no other testimony. If there be more than two parties to the interference, the times for taking testimony will be so arranged that each shall have an opportunity to prove his case against prior applicants and to rebut their evidence, and also to meet the evidence of junior applicants.

## CONSTRUCTIONS.

Surrebuttal testimony on the subject of operativeness?

Keith et al. v. Lundquist v. Lorimer et al., 157 O. G. 754.

Where an inventor testifies in favor of the opponent of his assignee that he was not the inventor of a part of the alleged invention it constitutes a surprise and a motion to take surrebuttal should be allowed.

Sandage v. Dean v. Wright v. McKenzie, 130 O. G. 981.

A mere difference of opinion will not warrant rebuttal testimony.

Sandage v. Dean v. Wright v. McKenzie, 130 O. G. 981.

Testimony attacking the validity of the senior party's date of filing should be taken in the examination in chief and not in rebuttal.

Kinsman v. Strohm, 125 O. G. 1699.

Surrebuttal testimony will not be authorized merely that a party may strengthen his case upon finding that the case made out against him in his opponent's rebuttal testimony is stronger than he anticipated.

Herbst v. Record & Goldsborough v. The Rothenberg Co., 123 O. G. 2311.

Surrebuttal testimony should only be accepted from a party where new matter is introduced in his opponents proof, which is in the nature of a surprise to the party seeking surrebuttal proofs.

Marani v. Shoemaker v. Fessenden, 121 O. G. 2666.

Rebuttal testimony which related solely to the patentability of the issue, held to have been properly stricken out.

Parkes v. Lewis, 120 O. G. 323.

This Office has authority to make an order to perpetuate testimony by analogy to the practice in equity courts, and the circumstances here justify it.

Lowry v. Spoon, 117 O. G. 903.

It is very clear that Hull has simply changed his mind or received new light upon the law of the case and has not discovered any new facts which would warrant reopening a decided case.

Hull v. McGill, 117 O. G. 597.

Basch alleges conception prior to this date; but this testimony was taken within the time set for the taking of rebuttal testimony, and as such testimony is a part of his *prima facie* case and is not in rebuttal of any testimony taken by Hammond it clearly is improperly introduced and is entitled to no weight.

Basch v. Hammond, 113 O. G. 552.

Priority and originality are the only issues. Rebutting testimony relating to patentability stricken out.

Huber v. Aiken, 1899 C. D. 166, 88 O. G. 1525.

This rule cannot be disregarded by stipulation of parties, and its provisions should be rigidly enforced. Testimony taken in violation of this rule must be excluded.

Connor v. Williams, 1878 C. D. 137, 15 O. G. 387.

A case that passes on the subject-matter of this rule.

See Chesebrough v. Toppan, 1872 C. D. 100.

Unless the established rules of the Office are enforced the rights of the contestants will never be secured. Testimony taken in conflict with this rule excluded.

Neal & Adams v. Daniels, 1871 C. D. 156.

### **Rule 119. Failure to Take Testimony.**

Upon the filing of an affidavit by any senior party to an interference that the time for taking testimony on behalf of any junior party has expired and that no testimony has been taken by him, an order shall be entered that the junior party show cause within a time set therein, not less than ten days, why judgment should not be rendered against him, and in the absence of a showing of good and sufficient cause judgment shall be so rendered. If any showing be made in response to the order, it must be served upon the opposing party and noticed for hearing by the party filing it.

#### *CONSTRUCTIONS.*

Affidavits accompanied motion for judgment on the record. It is clearly improper for counsel to request this Office to decide the question of priority on *ex parte* affidavits.

Horfnagle v. Beardsley, 193 O. G. 510.

If there were good reasons why judgment should not have been rendered on the question of priority under this rule, he should have brought them forward in answer to the order to show cause. If he was dissatisfied with the judgment which was rendered, his remedy was by appeal from the judgment. He cannot have that judgment reviewed on appeal from the order to show cause.

Bombard v. United States Graphite Co., 129 O. G. 479.

A stipulation filed in lieu of testimony in which one of the two parties states that he is not the inventor of the subject-matter in issue, there is no reason for continuing the interference, and the Examiner may render judgment without setting a day for hearing.

Townsend v. Corey, 119 O. G. 2237.

If there were good reasons why judgment should not be rendered against McHarg, he should have brought them forward in answer to the order to show cause.

McHarg v. Schmidt et al., 106 O. G. 1780.

If the testimony relates exclusively to public use it should be stricken out upon motion properly made and judgment rendered under this rule.

Stroud v. Miller, 101 O. G. 2075, 1902 C. D. 423.

The date of the decision and not the date of the receipt of notice governs.

Whipple v. Sharp, 98 O. G. 225-6, 1902 C. D. 2, 5.

Cases that pass on the subject-matter of this rule.

Osborn v. Austin, 115 O. G. 1065; Trufant v. Prindle v. Brown, 111 O. G. 1035; Kempshall v. Sieberling, 110 O. G. 1427; Winsor v. Struble, 110 O. G. 600; Hoegh v. Gordon, 108 O. G. 797; Franklin v. Morton v. Cooley, 95 O. G. 2063, 1901 C. D. 49; Atkins v. Paul v. Johnson, 94 O. G. 1785, 1901 C. D. 35; Walsh v. Hallbauer, 94 O. G. 223, 1901 C. D. 9; Brough v. Snyder, 94 O. G. 221, 1901 C. D. 3; Knight v. Bagnall v. Curtis v. Morgan, 76 O. G. 1115, 1896 C. D. 109.

## **Rule 120. Postponement of Hearing.**

If either party desire to have the hearing continued, he shall make application for such postponement by motion (see Rule 153), and shall show sufficient reason therefor by affidavit.

### *CONSTRUCTIONS.*

If party has not been diligent no extension of time will be permitted.

Bryon v. Henry, 104 O. G. 1895.

The fact that the title of one of the parties is in litigation is not sufficient ground for the postponement of the hearing; either to await the determination of the question of title or to make the hearing coincident with another interference proceeding in which the same patent is involved.

Keith v. Faure, 25 O. G. 289, 1883 C. D. 72.

A case that passes on the subject-matter of this rule.  
Olemkley v. Biekhius, 158 O. G. 886.

**Rule 121. Enlargement of Time for Taking Testimony.**

If either party desire an extension of the time assigned to him for taking testimony, he shall make application therefor, as provided in Rule 154(d).

See notes to rule 114.

**CONSTRUCTIONS.**

The setting of times for taking testimony is a matter peculiarly within the discretion of the Office.

Victor Talking Machine Co. v. American Graphophone Co., 161 O. G. 753.

It must appear that the motion is made in good faith and if there has been delay it must be excused. A prima facie case must be made out.

Roffe v. Super, 159 O. G. 991.

An order extending time cannot be appealed from.

Wickers and Farlong v. Weinwarm, 129 O. G. 2501.

An appeal should be allowed where permission to take testimony is refused.

Pym v. Hadaway, 128 O. G. 457.

Decisions of the Examiner of Interferences are final on motions to extend time for taking testimony, and no limit of appeal should be set.

Christensen v. McKenzie, 117 O. G. 277.

It is believed that it will be to the interest of all parties concerned, if the Examiner of Interferences in granting motions for extension of time for taking testimony should not set a limit of appeal from such decision.

Goodfellow v. Jolly, 115 O. G. 1064.

Three weeks delay in moving the court to compel witness to answer is sufficient reason for denial of motion to extend time for this cause.

Downing v. Anderson, 111 O. G. 582.

A third extension refused where petitioner was waiting for such time as he could get all his witnesses together at once.

Spindler v. Nathan & Bolge, 109 O. G. 2171.

The office will not fix the time for taking testimony so that the testimony may be taken in both cases at once.

Lipe v. Miller, 107 O. G. 1662.

The motion should be made before the expiration of the time limit. It should be accompanied by affidavits setting forth good reasons.

Turner v. Bensinger, 102 O. G. 1551.

Time for taking testimony will not be extended to permit testimony to be offered which is inadmissible in its nature.

Trufant v. Frindle v. Brown, 101 O. G. 1608, 1902 C. D. 397.

A stipulation for extending time for taking testimony which contemplates the absence of one of the attorneys may act to prevent the running of the 20 day provided for by rule 122.

McKean v. Morse, 94 O. G. 1572, 1901 C. D. 33.

See Sponsel v. Darling, 105 O. G. 498.

### **Rule 122. Motion to Dissolve for Irregularity, Non-patentability, etc.**

Motions to dissolve an interference (1) alleging that there has been such informality in declaring the same as will preclude the proper determination of the question of priority of invention, or (2) denying the patentability of an applicant's claim, or (3) denying his right to make the claim, should contain a full statement of the grounds relied upon and should, if possible, be made not later than the thirtieth day after the statements of the parties have been received and approved. Such motions and all motions of a similar character, if in the opinion of the Commissioner they be in proper form, will be heard and determined by the law examiner, due notice of the day of hearing being given by the office to all parties. If in the opinion of the Commissioner the motion be not in proper form, or if it be not brought within the time specified and no satisfactory reason be given for the delay, it will not be considered and the parties will be so notified.

When the motion has been decided by the law ex-

aminer the files and papers, with his decision, will be sent at once to the docket clerk.

Motions to shift the burden of proof should be made before, and will be determined by, the examiner of interferences. No appeal from the decision on such motions will be entertained, but the matter may be reviewed on appeal from the final decision upon the question of priority of invention.

### HISTORY.

The Revision of December 1, 1879, reads as follows:

“116. Motions to dissolve an interference which deny the patentability of an applicant's claim, or his right to make the claim, will be submitted to the examiner of interferences before the day fixed for filing the statements provided for in Rules 97 and 102, and will be transmitted by him, with the files and papers, to the primary examiner, who will take jurisdiction of the case for the determination of such motions, and will return the files and papers to the examiner of interferences, with his decision, at the expiration of the time limited for appeal, if no appeal shall have been taken, or sooner if the party entitled to appeal shall file a waiver in writing of his right of appeal; and such decision will be binding on the examiner of interferences unless reversed or modified on appeal. From a decision of the primary examiner on such motion denying the patentability of a claim or the right of an applicant to make it, an appeal may be taken *ex parte* to the examiners-in-chief; but from his decision affirming its patentability or the applicant's right no appeal can be taken.”

“118. Appeal may be taken directly to the commissioner from decisions on all motions, except motions to dissolve interferences denying the patentability of applicant's claims, or their right to make the claims, and other lawful motions involving the merits of the case, which, when appealable may be appealed to the board of the examiners-in-chief. (See Rule 116.)”

See *Allen, Commissioner of Patents v. The United States of America, ex rel. Lowry and Planter's Compress Company*, 1905 C. D. 643, 116 O. G. 2253 (May 24, 1895).

Previous to the last revision, the rule read as follows:



Motions to dissolve an interference (1) upon the ground that there has been such informality in declaring the same as will preclude a proper determination of the question of priority of invention, or (2) which deny the patentability of an applicant's claim, or (3) which deny his right to make the claim, or (4) which allege that counts of the issue have different meanings in the cases of different parties should contain a full statement of the grounds relied upon, and should, if possible, be made not later than the thirtieth day after the statements of the parties have been received and approved. Such motions, and all motions of a similar character, should be accompanied by a motion to transmit the same to the primary examiner, and such motion to transmit should be noticed for hearing upon a day certain before the examiner of interferences. When in proper form the motion presented will be transmitted by the examiner of interferences, with the files and papers, to the proper primary examiner for his determination, who will thereupon fix a day certain when the said motion will be heard before him upon the merits, and give notice thereof to all the parties. If a stay of proceedings be desired, a motion therefor should accompany the motion for transmission.

When the motion has been decided by the primary examiner the files and papers, with his decision, will be sent at once to the docket clerk.

Motions to shift the burden of proof should be made before, and will be determined by, the examiner of interferences. No appeal from the decision on such motions will be entertained, but the matter may be reviewed on appeal from the final decision upon the question of priority of invention.

The following notes have references to this rule. The present rule has not been in force long enough to have been construed.

### *CONSTRUCTIONS.*

- (1) IN GENERAL.
- (2) GENERAL POLICY AND MEANING OF RULE.
- (3) SUBJECT-MATTER OF MOTION.
- (4) GROUND FOR DISSOLUTION.
- (5) PATENTEE—APPLICANT.
- (6) FORM OF MOTION.
- (7) TRANSMISSION OF MOTION.
- (8) PETITION TO EXTEND TIME.
- (9) EVIDENCE—AFFIDAVITS.

- (10) DELAY IN BRINGING MOTION—EXCUSE FOR SECOND MOTION.
- (11) EXPEDITING PROCEEDINGS—EXAMINER'S ACTIONS—TIME LIMIT.
- (12) GROUNDS OF APPEAL.
- (13) SHIFTING BURDEN OF PROOF.
- (14) MISCELLANEOUS.

(1) *In General.*

The practice under the present rule is to render judgment upon the opening of the preliminary statements, without an order to show cause why such award should not be made, leaving the party failing to prevail to bring any of the motions permitted by the rules within the time limited for appeal.

Kendall v. Frasch, 1891 C. D. 36

It is contended by B. that under long standing practice he should be permitted to give notice of other references five days before the hearing of the motion. The reasons for this practice which was followed in the past, but which has not been permitted for some time, do not now exist. Since the date of the decisions under which an applicant was permitted to give notice five days before the hearing, of additional reasons for dissolving the interferences, Rule 122 has been amended and the time within which motions may be made extended from twenty to thirty days. It has also been amended to require that a motion for dissolution must contain a full statement of the grounds relied upon.

Papendell v. Bunnell v. Reizenstein v. Gaisman v. Gillett, 131 O. G. 362.

(2) *General Policy and Meaning of Rule.*

Last clause applies where judgment is rendered on the record under rule 114.

Barney v. Hess, 158 O. G. 702.

Last clause (authorities).

Braun v. Wahl, 189 O. G. 254.

The first ground mentioned while in a sense broad, is exclusive of the other three grounds.

Rountree v. Sloan, 189 O. G. 1282.

The practice of the Office contemplates that the question of the patentability of the subject-matter of an interference should be decided before an interference is declared. But

if it has not been, then it must be before the interference can go on.

*Lynch & Raff v. Dryden & Underwood*, 73 C. D. 73.

There is nothing in the rules that limits the question to be discussed upon a motion to dissolve to those which have not previously been considered by the Primary Examiner.

*Law v. Woolf*, 55 O. G. 1527.

One object of motion is to enable the Examiner to decide inter partes what he had previously decided without a hearing.

*Law v. Woolf*, 1891 C. D. 91; 55 O. G. 1527.

Motions must be made after the declaration of interference.

*Seevert v. Shuman*, 76 O. G. 1714.

Matters relating to marking can only be established by evidence. The motion not transmitted.

*Earll v. Love*, 140 O. G. 1209.

A motion to dissolve on the ground that the issue is not patentable will not be considered where based upon ex parte affidavits.

*Barrett v. Swinglehurst*, 144 O. G. 818; *White v. Powell*, 160 O. G. 776.

The additional patent which is now cited by White is in the same art as the patents previously considered and was presumably within his knowledge at the time the original motion was brought. It is well settled that such delay is fatal to a motion to dissolve. *McKee v. Baker*, 120 O. G. 657; *Josley v. Hulse*, 130 O. G. 1689.

*Blackmore v. Hall*, 132 O. G. 1587; *White v. Powell*, 160 O. G. 776.

If a disclaimer has been filed, or there is no subject-matter, the interference should be dissolved.

*Jones*, 180 O. G. 880.

When an interference has been dissolved as to a part of the counts, a new preliminary statement will not be admitted as to the remainder.

*Seaman v. Brooks*, 100 O. G. 685.

The absurdity of a declaration of interference with a reservation at the same time of the question of patentability for future adjudication, would be, so far at least as this count is concerned, too glaring to be tolerated.

Such questions should be referred for determination.

*Oliver v. Felbel*, 100 O. G. 2384.

If a motion to dissolve for want of interference in fact is not made, the decision of the interference is not conclusive on this point, and the defeated party may raise the question

when his competitors' patent is cited as a reference.

Schupphaus, 100 O. G. 2775.

There may be an interference in fact notwithstanding the devices are intended for different purposes.

Blue v. Power v. Owen, 101 O. G. 2076.

If a motion to dissolve because one applicant is not entitled to make the claim is not filed, the question cannot be considered on the final adjudication.

Woods v. Waddell, 106 O. G. 2017.

As stated in Maxwell v. Bryon v. Henry, 98 O. G. 1968, an interference should not continue between two parties as to certain counts and between three parties as to other counts.

Dow v. Benson, 107 O. G. 1378.

The differences in structure referred to, however are not included in the claims, and are, therefore, immaterial.

Auerbach & Gubing & Wiswell, 108 O. G. 289-290.

Dissolution is necessary only where the irregularity is such as will preclude a proper determination of the question of priority. It is not necessary in all cases of irregularity. For instance, the fact that one applicant inserted a second specific claim in order to secure an interference is not material.

Hoefler, Hoefler & Hoefler v. Barnes, 108 O. G. 560.

Where the claims of interfering parties are in identical language and each party has a construction responding in function to the broad terms thereof, there is an interference in fact, although the constructions are specifically different.

Gordon v. Wentworth, 120 O. G. 1165.

Action should not be taken by the Office without sufficient reason where an adverse determination upon the merits of the patent may result; but where reasons for action exist the Office is not to be deterred therefrom because, as an incident thereto, a cloud may be cast upon a patent.

Griffith v. Dodgson, 122 O. G. 2064.

No testimony as to inoperativeness, or public use, previous to motion to dissolve.

Barber v. Wood, 127 O. G. 1991.

Where claims have been suggested to an applicant and he makes the same under protest accompanying the protest with a statement that he does not believe that he has a right to make them, giving his reason for that statement, and where after inspecting the other parties application he still contends that he has no right to make them, he should be permitted to argue the question before the primary Examiner.

The practice announced in *Miller v. Perham*, 121 O. G. 2667, is modified to this extent, 129 O. G. 3161.

*Eichelberger and Hibner v. Dillen*, 129 O. G. 3161.

The Office has found by experience that in order to properly transact business the questions which are sought to be raised by applicants appearing before it must be presented according to certain procedure. While it is not desired to be too technical, yet applicants must be required to follow the simple and well-known procedure laid down in the Office rules and in a long line of decisions.

*Filbel v. Fox*, 130 O. G. 2375.

A motion under this rule is a proper way of showing cause under rule 114.

*Filbel v. Fox*, 130 O. G. 2375.

### (3) *Subject-Matter of Motion.*

When dissolved the matter becomes *ex parte* and one party can not interfere with the issuing of a claim to the other.

*Sovereign et al. v. Lillie*, 185 O. G. 830.

In an interference between a patent and an application for the reissue of a patent, it appears that the invention was not shown in the original patent, priority awarded to patentee.

*Nelson v. Felsing and Felsing v. Wilson*, 142 O. G. 289.

Under the rulings of the Court of Appeals of the District of Columbia in *Foster v. Antisdell*, 88 O. G. 1527, *Prendle v. Brown*, 112 O. G. 957, this question could not be considered in the Interference. If it were established that Ashton alone were the inventor this of itself would afford no ground whatever for the award of priority to Pickard. In any case it would be necessary for Pickard to establish priority of invention on his part to warrant a decision in his favor.

*Pickard v. Ashton and Curtis*, 137 O. G. 732.

That the application of a third party should be included.

*Carroll v. Hallwood*, 135 O. G. 897.

That a concession of priority was obtained by duress may not be considered collaterally.

*Wilson v. Felsing and Felsing v. Nelson*, 142 O. G. 289.

An interference should be dissolved when the interference claim is improperly introduced into a reissue application by one of the parties.

*Evans, Bussel & Vose*, 1873 C. D. 36.

An interference should be dissolved when the interference claims are not legitimate combinations.

*Pearl & Sawyer*, 1874 C. D. 58; *Lynch & Roff v. Dryden & Underwood*, 1873 C. D. 73.

A motion to dissolve the interference on the ground of lack of patentable invention in the claim involved allowed.

Dunton v. Young & McFarren, 10 O. G. 243; Chambers & Mendham v. Tucker et al., 11 O. G. 1009.

Motion to dissolve for non-interference in fact, only involves all inquiries which assume patentability of the claims.

Zeidler v. Leech, 1891 C. D. 9.

If the applicant does not choose to restrict his application in the manner pointed out in Rule 104, but thinks the claims do not interfere, he may move to dissolve the interference under this rule.

Drawbaugh v. Blake, 23 O. G. 1221.

If one party is a joint applicant and is not a joint inventor, the opposite party may move to dissolve the interference on the ground that his opponent has no right to make the claim. (Authorities reviewed.)

Hicks & Keating v. Purvis & Bilgram, 40 O. G. 348.

After the time limit has expired it is discretionary with the Examiner of Interferences whether or not he will transmit the motion.

Scribner & Warner v. Childs v. Balsby, 1892 C. D. 104.

Motion to dissolve on the ground that the affidavit under Rule 75 was insufficient.

Schmertz v. Appert, 77 O. G. 1784.

#### (4) *Ground for Dissolution.*

Since the date on which the Suedeker applications were filed are subsequent to the date of invention alleged in Kitselman's Preliminary statement the patents cited are not valid references (Forsyth v. Richards, 113 O. G. 1537). Even when such patents claim the invention in question and therefore could not be overcome by affidavits. Motion should not be transmitted.

Raymond v. Kitselman v. Sommers et al., 134 O. G. 2243.

In this case the Primary Examiner dissolved the interference on the affidavit of one of the Trauts as a sole inventor. This order was irregular; after the declaration of an interference it cannot be dissolved except by the Examiner of Interferences, or the Commissioner, or by the Board of Examiners, or Commissioner on appeal.

Traut & Traut v. Disston & Morse, 70 O. G. 99.

A motion for dissolution should not be based upon testimony, affidavits, or other actions of an adverse party filed after the approval of the preliminary statements and which,

if accepted by the office, may form grounds for judgment of priority.

Sullivan v. Thomson, 94 O. G. 585; Page v. Bugg, 89 O. G. 1342; Felbel v. Oliver, 92 O. G. 2339; Winton v. Jeffery, 112 O. G. 500; Ellis v. Schoreder v. Allen, 134 O. G. 1803.

Insufficiency of opponents affidavit under rule 75 held to be sufficient ground for dissolution.

Hodgkinson v. Potter, 185 O. G. 251.

Where applicant's preliminary statement shows two years' public use.

Schenck v. Rider, 1870 C. D. 135.

Where the proof shows that neither party made the invention, the question of priority is at an end, and there can be no further interference. Interference dissolved.

A sole inventor is not a party to an interference between third party and himself and another as joint inventor.

Pugh v. Hamilton, 1871 C. D. 116; Walters et al. v. Yost et al., 1875 C. D. 59.

Where the specifications disclose compositions that are essentially different both as to proportions and the character of the ingredients used and the process of using the composition, the interference should be dissolved.

Jackson v. Nichols, 1871 C. D. 278.

An interference should be dissolved when the interfering claim is to elements which are not shown to be capable of use by themselves.

Jackson v. Nichols, 1871 C. D. 278.

The interference dissolved by the Examiners-in-Chief on the ground that the two applications did not interfere, on an appeal from the final judgment of the Examiner of Interferences.

Frick, 1872 C. D. 124.

An interference should be dissolved when the two inventions are radically different and designed for entirely different purposes.

Pearl & Sawyer, 1874 C. D. 58; Dod v. Cobb (1876 C. D. 232), 10 O. G. 826.

An interference dissolved because the claim was too broad in view of the state of the art.

Scott v. Ford, 14 O. G. 413.

If the claims are substantially the same the interference should not be dissolved.

Drawbaugh v. Blake, 23 O. G. 1221.

A motion to dissolve an interference on the ground that the oath to one of the applications was not taken before a

proper officer considered, and the Commissioner says: "Judgment as to the application of A and B has been admitted to examination, notwithstanding the effect under consideration, the examination will not be suspended." But no patent should issue until the mistake was rectified.

Warnant v. Warnant, 17 O. G. 265.

When an interference is sent back to the Primary Examiner on a motion to dissolve or suspend the interference, or by direction of the Commissioner upon the allegation that there exists a statutory bar to the claim, or that the claim is not patentable, or that the applicant has no right to make the claim (Rule 116-120), which motion is granted by the Examiner, the interference is *pro hac vice* dissolved, and the application involved becomes *ex parte*.

Faure v. Bradley v. Cowles & Cowles, 40 O. G. 243.

Interference dissolved to permit Primary Examiner to require an oath applying to date of completion of the application.

Miller v. Lambert, 72 O. G. 1903.

The mere possibility that the claims may be made by the parties and new controversies may arise is no justification for dissolving an interference already in progress.

Annand v. Spalckhaver, 87 O. G. 2741.

Matter which has been raised on a motion to shift the burden of proof cannot be again raised on a motion to dissolve.

Baetz v. Kukkuck, 148 O. G. 1343.

Motion to dissolve interference upon the ground of estoppel by oath of applicant to a preliminary statement and by the testimony of his witnesses in a previous interference wherein he was one of two applicants.

Mead & Brown, 48 O. G. 397.

Where foreign patent expired because of non-payment of tax and applicant summoned to show cause why interference should not be dissolved for want of right to make the claim. His failure to respond construed an admission.

Armstrong, 71 O. G. 1615.

A motion to dissolve because opponents were estopped from having this interference in view of a prior interference transmitted.

Foglesing v. Hutt & Phillips, 61 O. G. 151.

Interference dissolved because of non-patentability of issue, claims were limited and new interferences declared; motion to dissolve because patentability was *res adjudicata* refused.

Kitsee v. Robertson, 97 O. G. 2306.

In that case (121 O. G. 1978) the existence of interference



in fact was regarded as doubtful, and it was in view of the doubt that the consent of the parties was permitted to turn the decision in favor of dissolution. I have no doubt as to the existence of interference in fact in the present case. The interference must accordingly continue. (Trade-Mark.)

• *Hirsch & Co. v. Jennen v. Hilbert & Sons v. Sample & Co.*, 122 O. G. 1724.

A motion for dissolution bases upon the ground that the moving party has no right to make the claim to the subject-matter in issue should not be transmitted.

*Martin v. Mullin*, 127 O. G. 3216; *Miller v. Perham*, 121 O. G. 2667; *Bellows v. King*, 106 O. G. 997; *Robins, Jr., v. Titus*, 110 O. G. 310.

In *Hirsey v. Peters* (6 App. D. C. 68) this court said an applicant who claims an alleged patentable invention is not to be heard to urge non-patentability of his claim after it has been placed in interference with other claims.

*Potter v. McIntosh*, 127 O. G. 1995.

(5) *Patentee—Applicant.*

So far as the question of estoppel is concerned counsel has referred to no case, and I have been able to find none, in which an applicant has been held estopped to present claims copied from, and to contest an interference with a patent during the pendency of the application where the invention covered by these claims was disclosed in the application as, originally filed.

*Stevens v. Grissinger*, 202 O. G. 951.

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

*Both v. Barr.*

Should it be determined in the interference that the applicant did not make the invention until after his opponent, a patent on his application will be refused for this reason, and there will be no occasion for attempting to establish a statutory bar.

*Luden v. Claus & Claus*, 190 O. G. 265.

Had the patentee moved to dissolve because the Applicant had no right to question the patentability of the issue it would have been granted.

At this stage of the proceeding, however, it is thought best to terminate the proceeding by an award of priority.

*DeFerranti v. Lindmakr*, 183 O. G. 783.

Where both the parties are applicants the fact that each of them moved to dissolve the interference on the ground that the issue is not patentable does not warrant the dis-

solution of the same if the Examiner, is of the opinion that the issue is patentable.

*Thomlinson v. Kelly*, 183 O. G. 784.

It is well settled that where an applicant is involved in an interference with a patentee and alleges in a motion to dissolve the non-patentability of the issue, his conclusion will be accepted and the interference dissolved without transmitting the motion. See 109 O. G. 1608, 111 O. G. 584, 111 O. G. 810, 115 O. G. 2136, 116 O. G. 1731.

*Paterson v. Neper*, 192 O. G. 215; *Blood v. Ross*, 161 O. G. 267.

Patentee applicant.

*Earll v. Love*, 140 O. G. 1209.

The issue should have the broadest construction possible, even when one party is a patentee.

*Morgan v. Taylor v. Hanson*, 208 O. G. 985.

Patentee can not contend that the Interference should be dissolved because it is too narrow to include applicant.

*Morgan v. Taylor v. Hanson*, 208 O. G. 985.

A patentee can not be heard to contend for the non-patentability of an invention defined in the claim of his patent, for this would be to give him a right of opposition based upon a patent which pro tanto is void and from which no right can be derived.

*Kennedy v. Hazelton*, 128 U. S. 667; *Commissioner Ewing in Fend v. Midgett*.

An applicant should not be permitted to unnecessarily consume the term of a Patent.

*Gregory, etc. v. Ledux*, 219 O. G. 929.

Transmission refused to examine into the question of public use alleged to be shown by preliminary statement of an applicant on motion of a patentee. Cases reviewed.

*Thomson & Unbehend v. Hisley*, 66 O. G. 1596.

Where a patentee claiming specifically would be entitled to all his claims, even if he were an applicant, in spite of a judgment of priority in favor of his opponent, the fact that his opponent's claim would dominate his own is no sufficient reason for declaring or continuing an interference. Rule 75 provides for precisely such a case.

*Reed v. Landman*, 1891 C. D. 73.

Where a party's opponent is a patentee said party can not move to dissolve on the ground that he has no right to make the claims adopted by him when suggested under Rule 96, otherwise if opponent is an applicant.

*Hernsdorf v. Driggs v. Schneider*, 133 O. G. 1189.

An applicant for reissue moved to dissolve the interference on the grounds that the issue was not patentable. Held, such motion should not be considered.

*Bellows v. King*, 106 O. G. 997.

Where R., an applicant, moved to dissolve on the ground that the issue was not patentable, it was said:

"The only question to be determined in the interference is whether a patent should issue to R., since he is the only applicant claiming the invention, and since he admits by his motion that he is not entitled to the claims there seems to be no reason why the Office should consume time in considering the matter."

*Robbins, Jr., v. Titus and Titus*, 110 O. G. 310.

A patentee is clearly entitled to make a motion upon any of the grounds specified.

*Fickinger & Balke v. Hulett*, 110 O. G. 859.

An applicant may move to dissolve interference on the ground that a patentee had no right to make the claims.

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

Where one of the parties to an interference is a patentee and the applicant brings a motion to dissolve on the ground that the issue is not patentable, held that the interference will be dissolved, and the applicant will be thereafter regarded as estopped from insisting upon the claims.

*Weissenthaner v. Goldstein*, 111 O. G. 810; *Lippe v. Miller*, 109 O. G. 1608; *Robins, Jr., v. Titus et al.*, 110 O. G. 310; *Griffith v. Dodgson*, 116 O. G. 173; *DeFerranti v. Lindmark*, 183 O. G. 782.

A patentee may move to dissolve an interference on the ground that the claims are not patentable.

*Baltzley v. Seiberger*, 115 O. G. 1329 (overruling *Manson v. Huchinson*, 201 O. G. 569).

Where an applicant is in interference with a patentee and moves for a dissolution of the interference on the ground of non-patentability of the issue, the interference should be dissolved even where patent has been inadvertently issued during pending of application.

*Griffith v. Dodgson*, 116 O. G. 1731; *Garnell v. Pope*, 115 O. G. 2136.

The statute does not specifically provide for the consideration of motions, and Rule 122 both in the letter and reason limits the fight to such consideration to those cases where the opponent of the moving party is an applicant.

*Griffith v. Dodgson*, 116 O. G. 1731.

In *Hisey v. Peters* (6 App. D. C. 68) this court said an

applicant who claims an alleged patentable invention is not to be heard to urge non-patentability of his claim after it has been placed in interference with other claims.

Potter v. McIntosh, 127 O. G. 1995.

(6) *Form of Motion.*

• Transmission of motion.

Winter v. Slick v. Wollkommer, 97 O. G. 1837.

The statements should be such as to advise an opponent of the reasons which are to be urged at the hearing.

Burleigh v. Elliott, 197 O. G. 242.

A concession of priority is a basis for a judgment of priority and is not a ground for dissolution.

Mesnard v. Hodgkinson, 190 O. G. 1027.

It is asserted on behalf of L. that in order to read the issue upon the McD. construction, it must be given a certain construction which interpretation is inapplicable to the L. device. This is a matter of right to make the claim and not a difference of meaning.

Lindstrom v. MacDonald, 187 O. G. 832.

Right to make claim, and difference of meaning do not depend upon the prior art nor necessitate any consideration of the prior art by the Primary Examiner.

Fowler v. Uptegraff, 184 O. G. 803.

A motion partly on the ground of alleged lack of right to make the claim and in part upon an alleged difference in the meaning of the counts, as informal.

Vandervild v. Smith, 159 O. G. 490.

It is well settled that where a party moves to dissolve an interference when more than one reference is relied upon, it must be pointed out how the references are to be combined.

Vandervild v. Smith, 159 O. G. 490.

An appeal to the Commissioner. The motion is irregularly presented in that it is not accompanied by a motion to restore the Jurisdiction to the Examiner of Interferences, or by a motion to transmit the same. Furthermore no excuse is given why the grounds set forth in the present motion were not urged at the time the original motion for dissolution was presented.

Langslow v. Malocsay, 155 O. G. 1043.

The matter that is not readable upon the device should be clearly stated. If new matter improperly introduced is alleged it should be clearly stated of what that new matter consists.

Baetz v. Kukkuick, 148 O. G. 1343.

If the motion has reference to a certain word that occurs in some but not all the counts, it must be specified which counts it refers to.

*Baetz v. Kukkuck*, 148 O. G. 1343.

Form of Motion. That some of the counts do not properly read on the patented structure of the moving party relates to the right of the patentee to make the claims and is not a question of formality on the declaration.

*Earll v. Love*, 140 O. G. 1209.

That the counts of the issue when considered in the light of the disclosure of C. who first made the claim, will not read on applicants structure or in other words, that applicant has no right to make the counts of the issue; that the counts have a different meaning when read upon C.'s structure from what they have when read upon his own. Neither of these reasons is proper subject-matter to urge under the head of informality in the declaration.

*Corey v. Eiseman and Mason*, 122 O. G. 2063; *Danquard v. Courisville*, 131 O. G. 242; *Skinner v. Carpenter*, 135 O. G. 661.

If it is to be contended that the claims are vague and indefinite there should be a statement to that effect.

*Skinner v. Carpenter*, 35 O. G. 661.

An objection to the patentability of a claim should be made by a motion to dissolve the interference and not by an attempt to restrict the issue.

*Hockhausen v. Weston*, 18 O. G. 857.

Form and practice under this rule.

*Green v. Siemens v. Hall v. Field*, 37 O. G. 1475.

Irregularity in declaring an interference has reference to a case where, in consequence of some defect, some misdescription, some error in describing the thing alleged to be the subject of the interference, or something of that character, a proper solution of the question of priority can not be reached. It does not refer to what are irregularities in consequence of a violation of the provisions of Rules 121 and 122.

*Edison & Gilliland v. Phelps*, 38 O. G. 539.

The decision must be confined to the question presented.

*Zeidler v. Leech*, 1891 C. D. 9.

If facts are relied upon other than those disclosed by the record, they should be stated in order to receive consideration.

*Law v. Woolf*, 1891 C. D. 91, 55 O. G. 1527.

Patentability is not in question in a motion to dissolve for non-interference in fact.

*Forslund v. Matthews*, 1891 C. D. 237.

On the granting of a motion to dissolve the interference after judgment on the record the Examiner of Interferences will vacate the judgment of priority.

Garrison v. Hubner, 1891 C. D. 59.

Failure to make a motion to dissolve, upon a ground that an accepted amendment to one of the applications involved is for new matter, amounts to an acquiescence in such acceptance and in the decision of the Office that such amendment does not involve new matter.

Croskey v. Atterbury, 1896 C. D. 437.

Moving to dissolve an interference upon any of the grounds stated in Rule 122 before the preliminary statements are opened and approved is a practice not to be encouraged.

King v. Babendrier v. Libby, 89 O. G. 2653.

A motion to vacate judgment is not an alternative remedy with a motion to dissolve.

Patten v. Weisenfeld, 98 O. G. 2589.

In a decision the four reasons for dissolution should be kept distinct.

Woodward v. Newton, 86 O. G. 490.

The case remanded to have a decision having regard to the distinctions pointed out above.

Owens v. Richardson, Jr., 111 O. G. 1038.

A motion to extend time for filing an appeal should be accompanied by appeal.

Greuter v. Matthew, 112 O. G. 253.

That the counts are vague and indefinite is such an irregularity in the declaration of an interference as to preclude a proper determination of the question of priority.

Dinkel v. D'Olier, 113 O. G. 2507.

It is proper in motion to dissolve to allege that a party has no right to make the claims giving the reasons therefor and to follow that allegation by the other allegation that the counts of the issue have different meanings in the event that the motion to dissolve should be denied on the first ground. The reason for this ground should also be given.

Rowntree v. Sloan, 189 O. G. 1281.

To justify transmission of motion to dissolve because of difference in meaning of the count of facts must be alleged indicating something more than a possible lack of right of one of the parties to make the claims.

McIntosh v. Riley, 184 O. G. 801.

The motion to extend the time for filing motions was properly denied by the Examiner, who stated that the rea-

sons set forth might justify the excuse for delay should a motion be made.

*Egly v. Schulze*, 117 O. G. 276.

If the motion is for the purpose of including "allowable claims" in another pending application which has been filed by applicant, the motion should be accompanied by a copy of such claims.

*Normand v. Krimmelbein*, 115 O. G. 249.

A motion to dissolve for non-interference which does not specify which of two opponents does not interfere is irregular and should not be transmitted.

*Vreeland v. Fessenden v. Schloemilch*, 117 O. G. 2633.

The four grounds for dissolving interferences relate respectively to very different matters and should not be confused with one another.

The question raised by the contention of non-interference in fact is whether the claims as found in the cases of the respective parties define one and the same invention, and the question is independent of the patentability of the claims, the right of the parties to make them or any irregularity in the declaration of the interference.

*Kaczander v. Hodges & Hodges*, 118 O. G. 836.

As pointed out in the cases of *Woodward v. Newton*, 86 O. G. 490, and *Owens v. Richardson*, 111 O. G. 1037, the four grounds for dissolution given in Rule 122 have distinct meanings which should not be confused.

*Pfingst v. Anderson*, 118 O. G. 1067.

A motion for dissolution should give the opposing party a reasonably definite idea of the points to be considered when the hearing is had. The counts of the issue against which non-interference is alleged should be specified.

*Vreeland v. Fessenden v. Schloemilch*, 119 O. G. 1259.

In a motion to dissolve the bare allegation that there is no interference in fact is insufficient.

The point or points to be argued should be specified with great particularity. Not only the count or counts, but the particular element or elements which are to be brought into question should be specified.

*Dunker v. Reist*, 119 O. G. 1925.

Dissolution for non-interference in fact must be based only on those facts and reasons which show that the counts of the issue have such different meanings that they might properly be allowed to both parties.

*Townsend v. Copeland v. Robinson*, 119 O. G. 2523.

A motion to transmit because opponents' application did

not originally contain the subject-matter of a combination claim must specify what element or elements of the combination were wanting.

*Latour v. Lundell*, 122 O. G. 1046.

In setting forth facts in motions for dissolutions the distinction between the general grounds of dissolution which have been pointed out in *Woodward v. Newton*, 86 O. G. 490, *Owen v. Richardson*, 111 O. G. 1037, and *Kaczander v. Hodges & Hodges*, 118 O. G. 836, must be carefully observed. The observance of these distinctions is necessary to the logical presentation of the question raised and to the avoidance of confusion in the matter of appeals.

*Klepetko v. Becker*, 120 O. G. 658.

It is to be noted that the motion does not specify the element or elements of the counts which can not be read on the two devices with the same meaning and gives no information to the opposing parties of the points to be argued.

Therefore the motion was not in proper form and should not have been transmitted.

*Miller v. Mann*, 122 O. G. 730.

A motion to dissolve alleging non-patentability of the opposing parties' claims in view of certain specified patents is not indefinite simply because the patents are enough to anticipate the claims of both parties.

*Latour v. Lundell*, 122 O. G. 1046.

The recently established practice requiring definiteness requires that motions shall distinctly and definitely set forth the points to be argued, but not arguments themselves.

*Garcia v. Pons*, 122 O. G. 1396.

In a motion to dissolve because of indefiniteness of the counts the moving party should point out wherein the supposed indefiniteness lies, so that the opposing party will know the character of the arguments that he will be called on to meet.

*Berry, Kane & Stengard v. Hildreth*, 122 O. G. 1722.

The right of the appellant to allege and urge that there is no interference in fact is recognized, but under the present practice of the Office he is required to make clear upon what point he intends to base his arguments.

*Dickinson v. Hildreth*, 122 O. G. 1397.

Where matter is set forth in a motion for dissolution as basis for one ground thereof which should only be considered in connection with another and different ground, the motion is not in proper form and should not be transmitted.

*Corey v. Eisman & Misar*, 122 O. G. 2063.



The statement contains no positive allegation that certain terms appearing in the issue have such distinct meaning when read as claims in the different applications that different inventions are represented thereby in the respective cases.

Motions to dissolve on this ground are not in proper form unless they contain specific allegation of the kind mentioned.

Booth, Booth & Flynt v. Hanan & Gates v. Marshall,  
123 O. G. 319.

The question of incompleteness of the claims is one of merits, and can not be raised under the allegation of informality.

Lotterhand v. Cornwall, 148 O. G. 1344.

A motion to dissolve on the ground that the testimony shows the affidavit under Rule 75 was false, refused.

Schuler v. Barnes v. Swarturrio, 140 O. G. 505.

The failure to include claims not patentably different from the issue furnishes no ground for dissolution of the interference.

Earll v. Love, 140 O. G. 1209.

Public use is not a basis for a motion to dissolve.

Gardner v. Delson v. Sampliver v. Meyers, 184 O. G.  
1073-4.

The practice to be pursued in establishing public use of an invention is clearly set forth in the following decisions.

Sanford Mills v. Aveyard, 88 O. G. 385; Van Ausda,  
91 O. G. 1617.

The question of intervening rights is not one which is material to the question of priority. A right to a reissue is an ex parte question.

Perkins et al. v. Weeks, 188 O. G. 1052.

It is not enough to state certain facts, it is desirable to state that those are the facts he desires to prove.

Henderson & Chanley v. Kindervater, 192 O. G. 741.

Any or all motions provided for in Rule 122 may be brought in connection with claims introduced under Rule 109 or the issue including the same, even though such motion were brought and the question raised thereby decided, under the interference as originally declared.

Jenne v. Brown v. Booth, 1892 C. D. 78.

Failure to make a motion to dissolve upon a ground that an accepted amendment to one of the applications involved is for new matter amounts to an acquiescence in such acceptance and in the decision of the Office that such amendment does not involve new matter.

Croskey v. Atterbury, 1896 C. D. 437.

Trade-Mark. If the issue in respect to the class of goods is narrower than the class of goods upon which the other party uses the mark, there has been such irregularity in declaring the interference that it should be dissolved.

Banigan Co. v. Bloomingdale, 89 O. G. 1670.

The contention that the issue is devoid of patentable novelty is not a proper one for consideration, since it is *ex parte* in character.

Benjamin v. Searle, 59 O. G. 630.

The question of operativeness may best be determined when the witnesses are called and each party given a chance to make such tests as may be desirable.

The question as to whether one applicant has the right to make the claim and whether he did in fact make it, are not properly appealable.

Eastman v. Houston, 87 O. G. 1871.

These motions must be solely based on the applications.

Felbel v. Oliver, 92 O. G. 2339.

It is well settled that motions to dissolve an interference can not properly be based on matter outside of the record.

Bundy v. Rumbarger, 92 O. G. 2002.

It is well settled that the bar to a party's right which is contemplated by the rule—must exist independent of the interference.

Horton v. Summer, 93 O. G. 2339.

The fact that applicant asserts that his application is a division of a former one does not constitute an irregularity under this rule.

Meyer v. Sarfert, 96 O. G. 1037.

One party discovered that his opponent's device did not act as described in the application on cross examination of the party—not matter coming within this rule.

Sullivan v. Thomson, 94 O. G. 585.

The question of public use is not a proper foundation for a motion under this rule, but the question of anticipation by patents is.

Davis v. Smith, 96 O. G. 2409.

The motion to the Examiner of Interferences should be accompanied by a motion to transmit. If not made within twenty days excuse should be made. This is not the proper way to try the question of joint or sole ownership.

Frederick v. Frederick & Frederick, 99 O. G. 1865.

It is the settled practice of this Office that nothing can be considered by the Primary Examiner on a motion to dissolve on interference which is not contained in the record of the

case, unless timely notice of such matter as may be urged in support of the motion which is not of record, is served upon the opposing party before the time set for hearing.

Summers v. Hart, 98 O. G. 2585.

Where W. had two applications pending in either of which the claims in controversy could be made and he elected to make them in the later case, held that he is entitled to the date of his earlier case as his record date, even if the earlier application should have been included. In the absence of some substantial contention the interference will not be dissolved for this reason after judgment.

Holland, 99 O. G. 2548.

Facts which are alleged to be established by the testimony are to be determined on final hearing and not on motion for dissolution.

Shallenberger v. Andrews, 100 O. G. 3013.

The question as to whether it was a serious error for the Examiner to have declared the interference without formally allowing the claim is one which should be raised under this rule.

Luger v. Browning, 100 O. G. 231.

A protest against the declaration of an interference. Such motions should be determined under this rule. It is contrary to the settled practice of the Office for the Commissioner to consider in advance the propriety of the proposed action of a lower tribunal.

Sarfert, 102 O. G. 1049.

The question of operativeness of invention should be determined by a motion under this rule.

Osborn v. Hotsapillar, 102 O. G. 1296.

A petition asking that the action setting aside a default resulting in abandonment, dismissed for lack of equity.

Gerand v. Abbott, Grand & McGirr, 103 O. G. 662.

A motion upon alleged anticipatory matter should be made under this rule in due time and not under Rule 126.

Dittgen v. Parmenter, 103 O. G. 1164.

Two interferences declared between the same parties. That these two issues are not patentably distinct is not ground for dissolution under this rule.

Dorr v. Ames & Rearson, 106 O. G. 263.

Questions as to new matter must be brought up under this rule and not by motion to shift the burden of proof under Rule 116.

Tripp v. Wolff v. Jones, 103 O. G. 2171.

The case will not be transmitted under this rule to the Primary Examiner to investigate the question of public use.

Shrum v. Baumgarten, 104 O. G. 577; Kneisley v. Kaiserling, 174 O. G. 830.

Whether or not the junior party materially altered his application after filing it, is a question not to be considered by a motion under this rule.

Hopkins v. Scott (See Rowe & Brickmann, 133 O. G. 515), 105 O. G. 1263.

If the matter of the propriety of suggested claims under Rule 96 is to be discussed it should be by motion under Rule 122.

Sutton v. Steele, 107 O. G. 541.

No appeal from the refusal of the Examiners in Chief to direct the attention of the Commissioner to certain patents alleged by one of the contestants to constitute a statutory bar.

Schmedl v. Walden, 1891 C. D. 150.

The question whether or not a supplemental oath should be furnished is an *ex parte* question. The absence of such an oath even where it should have been furnished is not such irregularity as will preclude the proper determination of the question of priority.

Auerbach & Gubing v. Wiswell, 108 O. G. 289; *vid.*

Rowe v. Brinkmann, 133 O. G. 515.

Motion made to dissolve because of lack of oath. Refused transmission. But time given to file oath with a notice that if it was not filed the interference would be dissolved. A formal defect in the oath filed was excused.

Graham v. Langhaar, 164 O. G. 740.

Where, however, the moving party to an interference calls attention to an informality in an oath and contends that he should not be compelled to contest the interference unless and until his opponent files an oath in compliance with the rules, it would seem that an order may properly be issued calling upon the delinquent party to file an oath in compliance with Rule 46, within a limited time set under penalty of dissolution of the interference.

Graham v. Langharr, 164 O. G. 740.

Patentability of opponent's claims must be presented under this rule and not by appeal against award of priority.

Kempshall v. Sieberling, 110 O. G. 1427.

Joint or sole inventor. Interference not suspended to determine.

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

Failure to make a motion to dissolve upon a ground that

an accepted amendment to one of the applications involved is for new matter amounts to an acquiescence in such acceptance and in the decision of the Office that such amendment does not involve new matter.

*Croskey v. Atterbury*, 1896 C. D. 437.

If it were true that the counts of the interference covered two specific forms not to be included in one application, still this would be no ground for dissolution.

*Atherton & Happ v. Cheney*, 111 O. G. 1040.

It is well settled that the question as to whether the original application contains the invention should be raised by a motion to dissolve. It will not be considered upon an appeal upon the question of priority of invention.

*Seeberger v. Dodge*, 113 O. G. 1415.

Question of joint inventorship relates to a statutory bar and not to priority of invention, and therefore such an inquiry in an interference proceeding is not proper.

*Robin v. Muller & Bonnett*, 113 O. G. 2506.

Facts outside of the record should be stated in the motion to receive consideration.

*Law v. Woolf*, 1891 C. D. 91, 55 O. G. 1527.

**Trade-Marks.** A motion to dissolve based on the ground that the date of adoption and use alleged by one of the parties was subsequent to that of registration of H. and Co. Held properly refused transmission but in view of the fact that an interference, between the application of this party and the registration of H. and G. had been finally decided in favor of the former.

*Gobel & Sons Grocer Co. v. Johnson*, 180 O. G. 880.

In trade mark cases an appeal as to priority and identity of subject-matter will not be considered.

*Horne v. Somer and Co.*, 129 O. G. 1609.

The Examiner decides nothing but the question raised by the motion and appeal brings up nothing but the decision and the motion decided.

*Zeidler v. Leech*, 1891 C. D. 9.

As held in the case of *Jenne v. Brown v. Booth*, 50 O. G. 157; C. D. 1892-78, any or all motions provided for in Rule 122 may be brought in connection with the new claims included in the interference under the provisions of Rule 109, and therefore P.'s motion as to the new counts was a proper one.

*Pfingst v. Anderson*, 114 O. G. 264.

It is the general policy of this Office to have all questions

which may be brought in issue between the parties settled in one interference.

*Normand v. Krimmelbein*, 115 O. G. 249.

Error in suggesting a claim under Rule 96, is not considered such an irregularity in the declaration as will preclude a proper determination of the questions of priority, and is not therefore a sufficient warrant for dissolving the same.

*Templin v. Sergeant*, 119 O. G. 961.

The presumptive is that the Office did its duty in notifying the caveators of the filing of the interfering application, and the burden is upon them to establish their allegation of no notice by adequate proof.

*Killeher & Grimm v. Mayhew*, 72 O. G. 895.

Where a motion for dissolution rests only on limitations into the claims by the moving party and not stated in such claims. Held that the motion was properly denied.

*Votey v. Tally*, 119 O. G. 339.

A person is not estopped from moving to dissolve because he made the claim constituting the issue and filed a preliminary statement relating thereto.

*Van Auken v. Osborne v. Harrison v. Canfield & Van Auken*, 119 O. G. 1584.

The improper issuing of a patent to one's opponent is not a ground for dissolution.

*Dunker v. Reist*, 119 O. G. 1925.

Non-interference in fact was placed in the rules as a ground for dissolution of interference at a time when parties were put in interference proceedings who had not made the same claims; it can only occur now where the same terms, though properly used in the application of each party, have distinctly different meanings in the respective cases.

*Blackmore v. Hall*, 119 O. G. 2533. See *Townsend v.*

*Copeland v. Robinson*, 119 O. G. 2533.

Upon a petition that the Examiner be directed to hear a party upon his opponents' motion to amend on the question his opponent's right to make proposed claims. Held, that petitioner may present his arguments upon motion for dissolution in case the proposed claims are admitted.

*Moore v. Curtis*, 120 O. G. 324.

Unsubstantial and clerical errors do not form proper basis for dissolution.

*Gally v. Burton*, 120 O. G. 325.

Matters which may be considered in determining the question of priority should not be transmitted to the Primary Examiner. Such as effect of prior applications.

*Struble v. Young*, 121 O. G. 339.

Lack of Notarial Seal not a sufficient reason for dissolving interference.

Scott v. Hayes & Berger, 121 O. G. 2326.

The right of the moving party to make the claims corresponding to the issue can not properly be raised on a motion to dissolve the interference, because he is of the opinion that he has no right to make the claims, he should take action in accordance with the provisions of Rule 125, concerning priority or abandoning the invention.

Miller v. Perham, 121 O. G. 2667; Bellows v. King, 106 O. G. 997; Robinson v. Titus, 110 O. G. 310; Martin v. Mullen, 127 O. G. 3216; Balzley v. Seiberger, 115 O. G. 1329; Griffith v. Dodgson, 116 O. G. 1731; Garnall v. Pope, 115 O. G. 1329; Potter v. McIntosh, 127 O. G. 1995.

Where two interferences are declared, one between application of S. and a divisional application of P., and the other between the same application of S. and the parent case of P., the fact that the issue involving the parent case could as well have been included in the interference involving the divisional application does not constitute such an irregularity as will prevent a proper determination of the question of priority.

Phillips v. Sensenich, 122 O. G. 1047.

So long as the parties are claiming common features of the invention it is not of consequence which is superior, and the alleged superiority of one over the other is no ground for a dissolution of the interference.

Kolb v. Hemingway v. Curtis, 122 O. G. 1397.

If it is decided that one party has no right to make the claims, the question of interference in fact will not be considered after decision becomes final.

Warner v. Mead, 122 O. G. 2061.

The motion for dissolution in this case seems to have been based upon the ground of non-interference in fact, in addition to that of a lack of right of a party to make claims, in order that the same facts of reason may be urged in connection with either or both grounds; but this is exactly what a party should not be permitted to do, in view of the labor and delay attending such double consideration both before the Primary Examiner and on Appeals.

Booth, Booth & Flynt v. Hanan & Gates v. Marshall, 123 O. G. 319.

Where the interference is generic the first inventor of a species is entitled to judgment.

Lovejoy v. Cady, 123 O. G. 654.

If a party has no reasons to allege in his motion to transmit which would support dissolution upon appealable grounds, he would not be permitted to waste the time and labor of his opponents and of the Office with appeals which can have no other object than to obtain a review of an unappealable decision.

Pym v. Hadaway, 123 O. G. 1283.

Interference and patentability considered by the Primary Examiner a careful examination nevertheless made to determine whether there is anything in the record of this case, as there was in the case of Podlesak and Podlesak v. McInnerney (Court of Appeals Jan. 4, 1906) necessitating limitations of the claims in the respective applications to specific non-interfering features.

Bechman v. Southgate, 123 O. G. 2309, citing Sobey v. Holsclaw, 119 O. G. 1922; Potter v. McIntosh, 120 O. G. 1823; Bechman v. Wood, 89 O. G. 2459; Bechman v. Wood, 89 O. G. 2462.

The failure to include the claims did not constitute an irregularity.

Locke v. Crebbin, 124 O. G. 317.

It is to be noted that the question involved in the contention of Blackford relates to the patentability of the present issue over the subject-matter of the issue of the former interference, and not of the right of Wilder to make the claim by reason of the nature of the disclosure. The question is therefore not in the class indicated in my decisions as subject to consideration in determining the award of priority.

Blackford v. Wilder, 124 O. G. 319.

Question of *res adjudicata* properly raised under this rule.

Blackford v. Wilder, 124 O. G. 319, citing Blackford v. Wilder, 104 O. G. 578; Potter v. McIntosh, 122 O. G. 1721; Sobey v. Holsclaw, 119 O. G. 1922; Pohle v. McKnight, 119 O. G. 2519; Kilbourne v. Hirner, 122 O. G. 729; Podlesak v. McInnerney, 120 O. G. 2127.

Apparently an interference dissolved because of the inoperativeness of one party's device is not *res adjudicata*.

Moore, Commissioner, v. U. S. ex rel. Coburn Machine Glass Co., 191 O. G. 293.

So far as now appears there is nothing in the statute or



rules requiring the defects in Turner's oath to be corrected before the same is accepted as a complete application. Such being the case the correction of these defects is an *ex parte* matter which may be attended to after termination of interference.

Dukesmith v. Carrington v. Turner, 125 O. G. 348.

A motion to require a supplementary oath and to shift filing date to the date of such oath should be presented as a motion to dissolve.

Dukesmith v. Carrington v. Turner, 125 O. G. 348.

It is the general policy of this Office to have all questions which may be brought in issue between the parties settled in one interference. (99 O. G. 669.)

Normand v. Krimmelbein, 115 O. G. 249.

Interlocutory motions are not permitted upon questions requiring the taking of proof such as originality and public use. (44 O. G. 945; 87 O. G. 180; 96 O. G. 2409; 103 O. G. 1164; 104 O. G. 577.)

Cory, Gilhart & Martin, Jr., v. Blakely, 115 O. G. 1328;  
Kneisly v. Kaiserling, 174 O. G. 830.

A motion under this rule is a proper reply to an order to show cause under Rule 114.

Filbel v. Fox, 130 O. G. 2375.

The real meaning of the words of the claims may not be apparent when viewed solely in the light of the disclosure of one party. It is believed therefore that the best practical results will be obtained by permitting a party when moving to dissolve an interference not only to raise the question of the right of the other party to make the claims of the issue, but also the question of the meaning of the claims when applied to the respective structures involved.

Eilerman v. McElroy, 130 O. G. 2721.

To be continued in the light of accompanying amendment.

Newberth v. Sizotte, 141 O. G. 1162.

Motion denied transmission for the reason that the question of interference in fact is no longer a part of the grounds enumerated in Rule 122.

Eilerman v. McElroy, 130 O. G. 2721.

A motion to dissolve which alleges that the opposite party is not entitled to receive a patent on his reissue application, involving matters that should be considered on the *ex parte* reissue application should be transmitted.

Emmet v. Fullagar, 130 O. G. 2719.

A motion to dissolve on the ground of non-patentability of

the issue is a proper reply to an order to show cause under Rule 114.

Field v. Colman, 131 O. G. 1686. See Moffat v. Weiss, 137 O. G. 1481.

But formalities must be strictly complied with and the motion brought within the time limit.

Ryder v. Brown v. Tripp and McMann v. White, 137 O. G. 228.

Vagueness and indefiniteness of the issue have uniformly been held a proper question to raise under informalities, or irregularity in the declaration of the interference, and it is thought properly so held.

Field v. Colman, 131 O. G. 1686.

It would seem that misrepresentation in a collateral matter would be sufficient for dissolution of a trade-mark interference.

L. W. Levy & Co. v. Uri, 131 O. G. 1687.

Appeal on motion to shift the burden of proof dismissed.

Dukesmith v. Carrington v. Turner, 125 O. G. 348.

The redeclaration of an interference to include new counts does not relieve against negligence in making a motion as to original claims.

Murphy v. Borland, 132 O. G. 231.

Grounds three, four and five, allege the bar of prior knowledge and use based upon the affidavit of one Plumb. These grounds were properly refused transmission under the well-established practice set forth in 66 O. G. 1596; 96 O. G. 2409; 104 O. G. 577; 115 O. G. 1328. M. contends that because these decisions refer primarily to the bar of public use the practice set forth therein is not applicable. This contention however, is not well taken, since the bar of prior knowledge and use alleged in the Plumb affidavit would have to be proved in a manner similar to the bar of public use.

Murphy v. Borland, 132 O. G. 231.

Motion to dissolve upon the ground that public use was shown by the preliminary statement of the applicant. Transmission joint and sole invention.

Thomson & Unbehend v. Hisley, 66 O. G. 1596.

The question whether a third party not involved in the interference is the real inventor of the subject-matter in issue is not pertinent to the question of priority of invention.

Hamm v. Black, 132 O. G. 841. (Cases cited.)

The question whether or not a supplemental oath should be required has been uniformly held by this Office to be an

*ex parte* matter upon which the proper determination of priority is not dependent.

Auerback & Gubing v. Wiswell, 108 O. G. 289; Silverman v. Hendrickson, 99 O. G. 445; Kane v. Brill & Adams, 84 O. G. 1142; Rennyson v. Merritt, 58 O. G. 1415; Phelps v. Sensenich, 132 O. G. 677.

It was directed in this case that the interference be suspended to give applicant a chance to file a proper oath and that in default the interference should be dissolved.

Rowe v. Brinkman, 133 O. G. 515.

Where one of the parties to an interference added the claims in issue by amendment, without a supplemental oath, the court of appeals would not be justified in awarding priority to the opposing party because of such failure. The most that the court could do under the circumstances would be to remand the proceeding in order that a supplemental oath may be made and matter reviewed.

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

The question whether the applicant will be permitted to amend his specification after such dissolution to incorporate the matter submitted or any other amendment is an *ex parte* question, which must be determined independently of any interference proceeding.

Wheeler v. Palmros, 133 O. G. 230.

Facts which are alleged to be established by the testimony are to be determined on final hearing and not on motion to dissolve.

Mead v. Brown, 48 O. G. 397; Campbell v. Brown, 56 O. G. 1565; Chase v. Ryder, 61 O. G. 885; Lotticem v. Force and Parenteau, 82 O. G. 185; Shiels v. Lawrence, 87 O. G. 180; Felbel v. Oliver, 92 O. G. 2339; Horton v. Summer, 92 O. G. 2339; Shellenberger v. Andrews, 100 O. G. 3013; Faure v. Bradley and Crocker v. Cowles and Cowles, 44 O. G. 945; Paget v. Bugg, 89 O. G. 1342; Sullivan v. Thomson, 94 O. G. 585; Frederick v. Frederick and Frederick, 99 O. G. 1865; Ritter v. Krakaw and Connor, 104 O. G. 1897; Thompson and Unbehend v. Hisley, 66 O. G. 1596; Hopkins v. Scott, 105 O. G. 1263; Winlow v. Jeffery, 112 O. G. 500; Cory, Gebhart and Martin, Jr., v. Blakey, 115 O. G. 1328; Struble v. Young, 121 O. G. 339; Schroeder v. Allen v. Ellis, 134 O. G. 1803; Falk Tobacco Co. v. Kinney Tobacco Co., 142 O. G. 567; Schuler v. Barnes v. Swartout, 140 O. G. 509.

Where no testimony has been taken and there is no ob-

jection by the other parties who have made similar motions—a motion to transmit to reform the issue should be granted.

Townsend v. Copeland v. Robinson, 124 O. G. 623 (but see same case 124 O. G. 1845).

A motion to amend the specification involved in an interference for the purpose of curing an alleged error therein should not be transmitted. (See also note to 109.)

Wheeler v. Palmros, 133 O. G. 230.

A motion based on defective oath should not be transmitted.

Rowe v. Brinkmann, 133 O. G. 515.

Apparently a defective oath in a reissue application may form a basis for dissolution.

Emmet v. Fullagor, 130 O. G. 2719.

A motion should not be transmitted to inquire whether or not one application can be changed from a joint to a sole application.

Gasaw & Co. v. Odell, 190 O. G. 1028.

The transmission of a motion filed outside of the regular time is a matter resting largely within the discretion of the Examiner of Interferences (cases).

Bastian v. Champ, 126 O. G. 2837.

An indefinite motion should not be transmitted.

Rowe v. Brinkmann, 133 O. G. 515.

A petition to transmit on the ground of informality in that certain additions to original disclosure were improper, refused transmission. As the matter relates to right to invoke the claim and not as to form.

Losher v. Barrett, 166 O. G. 751.

The only contentions and arguments which are in order in support of motions to dissolve interferences for non-interference in fact where the parties have made the same claims are those tending to show that the claims have different meanings in the case of the respective parties notwithstanding a perfect right upon the part of each party to make the claims.

Goodwin v. Smith, 123 O. G. 998.

The objection urged to ground C is that non-patentability of the issue is alleged therein, not generally but to Hadaway. The objection is not a valid one as it is conceivable that the claims might have such different meanings in the cases of the respective parties as to represent patentable subject-matter in one case and non-patentable subject-matter in the other.

Pym v. Hadaway, 123 O. G. 1283.

It is urged that if the claims are literally construed they are not patentable in view of a certain specified patent, and

for this reason they must be limited by construction to the specific device shown by the respective parties and that as so limited there is no interference in fact. The question of patentability can not be thus raised on a motion to dissolve alleging non-interference in fact.

Klepetko v. Becker, 124 O. G. 908.

Grounds must be specific. If it is alleged that new matter has been improperly introduced the new matter should be pointed out.

Lizotte v. Newberth, 124 O. G. 1842.

Robinson's motion to amend the issue does not come within the provisions of Rule 109. The proposed claims are claims not made by either of the opposing parties and were asserted for the first time in this motion. Besides there was too much delay in bring the motion.

Townsend-Copeland v. Robinson, 124 O. G. 1845.

In inaugurating the practice of requiring definiteness in motions to dissolve it was not the intention to require the parties to give the arguments, but it was the intention that the opposite party should be given reasonable notice of the points to be argued.

If the moving party is of the opinion that each of the references is a substantial anticipation of each of the claims it should be so stated; if not the motion should enumerate the reference in connection with the claims to which they will be applied in the argument.

Heyne, Haywood and McCarthy v. DeVilbiss, Jr., 125 O. G. 669.

Where a motion is made before the Examiner of Interferences to set times for taking testimony as to operativeness, a showing of reasons which do not apply to applicants' own case must be made.

Clement v. Browne v. Stroud, 125 O. G. 992.

Where a party makes a reasonable showing before the Examiner of Interferences tending to show that his opponent has no right to make a claim, and that showing does not extend to his own structure, he may be permitted to take testimony provided that the proposed testimony is of a character to justify such action.

Pym v. Hadaway, 125 O. G. 1702.

Townsend's argument that it is useless for him to appeal on the question of his right to make the claim until it is settled that the claims are patentable is not sound. As well might he argue that it would be useless for him to contest

the patentability of the claims as long as it was held he had no right to make the claims.

*Townsend v. Ehret*, 125 O. G. 2051.

The distinction between the several grounds for dissolution—refused to exercise supervisory power upon question of patentability under the circumstances.

*Daggett v. Kaufmann*, 127 O. G. 3641.

M. moved to dissolve as to one set of counts if the other set were found unpatentable on T.'s motion. Transmission refused because it was alternative and bad in form.

*Turner v. Macloskie*, 128 O. G. 2835.

The statement that this count "does not involve patentable invention over each of the following letters patent" after which certain patents are specified, is a sufficient compliance with the practice of the Office as set forth.

*Heyne et al. v. De Vilbiss*, 125 O. G. 1292.

Nothing is alleged in this case in support of the motion to dissolve because the counts have different meanings in the two applications, which may not be fully accounted for by lack of right of one or the other of the parties to make the claim, or which indicates that any other reason exists for dissolving the interference; under these circumstances the refusal to transmit the motion was right.

*Cushman v. Edwards*, 128 O. G. 457.

It is not pointed out in the motion what meaning may be given to counts four and five in one case that would justify the allowance of these claims to each party without regard to which was the prior inventor. Such a statement is essential for transmission on the ground of different meanings.

*Cushman v. Edwards*, 128 O. G. 456.

M. moved to dissolve as to one set of counts if the other set were found unpatentable on T.'s motion. Transmission refused because it was alternative and bad in form.

*Turner v. Macloskie*, 128 O. G. 2835.

Where claims have been suggested to an applicant and he makes the same under protest, (accompanying the protest with a statement that he does not believe that he has a right to make them, giving his reasons for that statement, and where after inspecting the other parties' application he still contends that he has no right to make them, he should be permitted to argue the question before the Primary Examiner. The practice announced in *Miller v. Perhan*, 121 O. G. 2667, is modified to this extent.

*Eichelberger & Hibner v. Dillon*, 129 O. G. 3161; *Hermsdorf v. Driggs v. Schneider*, 133 O. G. 1189.

Fifteen patents were cited but their pertinency was not

explained. Should not be transmitted. (Same case.)

*Eichelberger & Hibner v. Dillon*, 129 O. G. 3161.

The ground of motion based upon the prior art is entirely too indefinite to satisfy the requirement of the present practice. It gives the opponent no information as to what patents are to be urged against the respective counts or how applicant purposes to use or combine them to anticipate the inventions of the counts.

*Brown v. Inwood and Lavenberg*, 130 O. G. 978.

That the claims are unpatentable to C, and because lacking in invention, considered separately, and in light of the prior art as evidenced by patents cited against the respective applications of the parties and other patents known to the Examiner and the parties hereto, is so obviously indefinite as to need no comment. It is well settled that where patents are relied upon they must be named specifically and applied.

*Brown v. Inwood and Lavenberg*, 130 O. G. 978; *Phillips v. Scott*, 130 O. G. 1312; *Lotterhand v. Cornwall*, 148 O. G. 1344.

The invention involved in this controversy is exceedingly simple in character, and the application of the reference would appear to be obvious upon their inspection. In my opinion the general statement above quoted when read in connection with the specific discussion of each patent is ample to apprise the other parties and the Examiner of the application of the respective references to the claims.

*Herber v. Payne and Simmins v. Friedlander*, 177 O. G. 1046.

The reasons given are general and do not point out the specific portions of the claims which are alleged to have different meanings in the two applications, and is too indefinite to be transmitted.

*Eichelberger & Hibner v. Dillon*, 129 O. G. 3161.

Where the reasons for delay appear clearly upon the record it is unnecessary to call attention to them in the motion to transmit.

*Cutler v. Carichoff*, 130 O. G. 656.

If a machine is alleged as an anticipation it should be stated where it can be found.

*Brown v. Inwood & Lavenberg*, 130 O. G. 978.

The ground of the motion based upon the prior art is entirely too indefinite to satisfy the requirements of the present practice. It gives the opponent no information as to what patents are to be urged against the respective counts or how

applicant proposes the use or combine them to anticipate the inventions of the counts.

*Brown v. Inwood & Lavenberg*, 130 O. G. 978.

It is stated in the motion that each of the counts from one to nine inclusive is unpatentable in view of the eight cited patents, and it is said: "Each of the counts is also met in each of the above patents, singly or in combination." This statement is clearly alternative and therefore the motion in that particular instead of being clear and specific, which was the end desired to be accomplished by inaugurating the present practice, is vague and indefinite.

*Thullen v. Townsend*, 130 O. G. 1312; *Phillips v. Scott*, 130 O. G. 1312.

Where a motion is brought which in accordance with the practice can not be transmitted, it is no excuse for the delay in bringing the motion in proper form that numerous appeals and petitions have been taken in an attempt to have the original motion transmitted.

*Brantingham v. Draver & Draver*, 130 O. G. 2720.

The first ground of the motion is insufficiently stated, for the reason that it is not pointed out in what respect the claims of the issue comprise aggregations and not combinations.

*Papendell v. Bunnell v. Reizenstein v. Gainsman v. Gillett*, 131 O. G. 362.

The second ground is insufficiently stated since the difference in the meanings of the claims are not pointed out.

*Papendell v. Bunnell v. Reizenstein v. Gaisman v. Gillett*, 131 O. G. 362.

A motion to dissolve because the issue is anticipated, must specify the anticipation. The practice of allowing additional references to be cited five days before the hearing has been discontinued.

*Papendell v. Bunnell v. Reizenstein v. Gaisman v. Gillett*, 131 O. G. 362.

The refusal of the Examiner to dissolve the interference on the ground that there is no interference in fact was correct, notwithstanding affidavits which have been filed alleging that no confusion has resulted from the use of the marks referred to (Trade-Mark).

*Philadelphia Watch Case Co. v. The Dueber Watch Case Co. v. etc.*, 122 O. G. 1725.

Dow can not be permitted to establish the fact that he made the invention and its date by *ex parte* affidavits.

*Dow v. Converse*, 106 O. G. 2291.



Motion to dissolve an interference, affidavits as to operative-ness received. Motion to remove from files refused (D. v. T. v. H., 99 O. G. 2550).

Dickinson v. Thibodeau v. Hildrett, 1902 C. D. 202.

The allegations is in the alternative that the counts are "anticipated or necessarily limited", but the motion does not state which counts he intends to urge as being anticipated and which limited, nor does it state which of the patents cited he relies upon as showing anticipation and which for restriction of the counts.

Murphy v. Borland, 132 O. G. 231.

It is not intended to follow the technical rules of the Court, but merely to require that motions shall clearly and definitely set forth the points to be urged.

Murphy v. Borland, 132 O. G. 231.

Ground eleven does not state what grounds it is alleged against, and for that reason is indefinite and should not be transmitted. (125 O. G. 669.)

Murphy v. Borland, 132 O. G. 231.

A motion alleging that the opposing party has no right to make the claims on account of informality of his specification is too indefinite. If petitioner meant that new matter had been improperly introduced into his opponent's specification he should have said so definitely.

Roe v. Brinkmann, 133 O. G. 515.

#### (7) *Transmission of Motion.*

(See "Form of Motion.")

Transmission refused. "The part B. may move on or before October 5, 1914, accompanied by a showing of facts, for leave to take testimony to establish that the forfeiture worked abandonment.

Gehring et al. v. Barry v. Long v. Wittiemore v. Molyneux, 225 O. G. 371.

Trade-Mark. The reasons why interference did not exist did not state whether the question related to the goods or the mark. Indefinite.

Hickor Jones Jewell Co. v. Ballard, 192 O. G. 992.

A motion to dissolve made as to the same counts in a previous interference between the same parties *res adjudicata*.

Townsend v. Thullen v. Young, 138 O. G. 768.

A motion to dissolve alleging that one of the parties can not make the claims because the subject-matter formed no

part of the original application since it did not include certain specified elements. Sufficiently Definite.

Stoddard v. Malins v. Peterson and Peterson, 196 O. G. 804.

The necessity for this motion according to Schulze, arises out of the holding of the Examiner in his decision on the first motion in which the counts were interpreted in a wholly unexpected way. I am of the opinion that S.'s position on this point is sufficiently well founded to justify the transmission of the motion.

Schulze v. Sinnox, 181 O. G. 541.

It is not the practice to transmit motions to dissolve filed before the preliminary statements are opened. (Whipple v. Sharp, 96 O. G. 2229) an exception may be made where the circumstances are such that the parties would be held bound by the decision rendered on such motion (as where files furnished by opponent are relied on).

Dunn v. Douglas, 184 O. G. 804.

The assignee being the real party in interest in a previous motion, can not make the same motion in his own name. Such motion should not be transmitted.

Townsend v. Ehrig v. Young v. Struble, 137 O. G. 1485.

A motion to dissolve because opponent had no right to make the claim in the earlier of two applications which are divisions of each other is one relating to the shifting of the burden of proof and should be decided by the Examiner of Interference and not transmitted.

Townsend v. Ehrig v. Young v. Struble, 137 O. G. 1484.

A motion founded on public use should be refused transmission; one based on affidavits should be refused as far as the affidavits are concerned.

Dunn v. Douglas, 184 O. G. 805.

It is no reason for refusing to transmit a motion, that the question has been considered *ex parte*.

Reynolds v. Haberman, 49 O. G. 130.

When motion in proper form and made within the former. For these reasons grounds seven and nine, should the time limit the Examiner of Interferences can not refuse to transmit it.

Cammet v. Hallett, 93 O. G. 939.

Motion to transmit in order to consider the question of shifting the burden of proof. Examiner of Interferences only decides if it is in proper form.

Sheppard v. Webb, 94 O. G. 1577.

These motions should not be transmitted previous to the approval of the preliminary statements.

*Whipple v. Sharp*, 96 O. G. 2229.

Under the Practice announced in *Picard v. Ashton and Curtis*, 137 O. G. 977; *Thien v. Bowen*, 143 O. G. 1345; *Knight v. Cutler*, 140 O. G. 119) the transmission of motions to dissolve is left largely to the discretion of the Examiner of Interferences.

*Blood v. Ross*, 161 O. G. 267.

Where no objection is made to the transmission of a motion on the ground of indefiniteness it may be assumed that the motion is sufficiently definite to meet the view of the parties to the interference, under such circumstances the motion should be transmitted.

*Hicker Jones Jewell Milling Co. v. Ballard and Ballard*, 192 O. G. 992.

Where a motion made in good faith is denied transmission because the same is not sufficiently definite. A properly made motion curing this defect will be transmitted.

*McQuarrie v. Manson*, 142 O. G. 288.

A motion to dissolve a trade-mark interference based on the ground that the label introduced during the taking of testimony contains certain deceptive statements, should not be transmitted as it is based on matter brought out in testimony, and applicant should be given an opportunity to explain on final hearing.

*Falk Tobacco Co. v. Kenney Tobacco Co.*, 142 O. G. 567.

A motion to dissolve on the ground of intervening rights refund transmission.

*Perkins et al. v. Weeks*, 188 O. G. 1052.

A motion to dissolve because an oath had not been required covering the matter, not transmitted.

*Berg v. Miller, Moon & Bell v. Frost*, 192 O. G. 159.

For the same reasons which apply to motion to amend preliminary statements (*Smith and Wickers v. Emerson v. Sanders*, 133 O. G. 1433) and to motions with respect to the taking of testimony (*Goodfellow v. Jolly*, 115 O. G. 1064) the question of transmitting motions to dissolve should be left largely to the discretion of the Examiner of Interferences, and where he grants a motion to transmit, his decision will not be disturbed unless it be clearly shown that such discretion has been abused.

*Pickard v. Ashtmand Curtis*, 137 O. G. 977.

Affidavits as to operativeness should not be transmitted for consideration upon motion for dissolution.

*Horton v. Leonard*, 155 O. G. 305; *Keys and Kraus v. Yunek*, 182 O. G. 248.

A motion to insert claims under Rule 109, and a motion to dissolve because such claims are unpatentable, should not be transmitted.

Weinberg v. Boyce v. Russel and Russel, 185 O. G. 249.

The first ground while in a sense broad is exclusive of the other three grounds (quoting Weis v. Mack, 185 O. G. 830).

Rowntree v. Sloan, 189 O. G. 1281.

If the references are not applied motion should not be transmitted.

Rowntree v. Sloan, 189 O. G. 1282.

A motion to dissolve on the ground the opponent had no right to make the claim because of long delay, should not be transmitted as it can be argued at final hearing.

Long v. Plagg & Livermore, 190 O. G. 265.

If in a case containing a number of claims, a motion to dismiss is made and refused, as to patentability in view of references cited, but is granted as to one claim upon another ground and dissolved as to that ground and redeclared with a substitute claim alleging non-patentability and citing other references which are also applicable to the other claims, should not be transmitted as to such other claims.

Kennedy v. McLain, 158 O. G. 547.

A petition to transmit on the ground of informality in that certain additions to original disclosure were improper, refused transmission as the matter relates to rights to make the claim and not to form.

Lasher v. Barrett, 166 O. G. 751.

If the motion is made within the twenty day limit the Examiner of Interferences seems to have no discretion but to transmit the motion. If made after that time it is a matter of discretion and will not be disturbed except when there has been an abuse of this discretion. The specific facts upon which a motion to dissolve is based need not be stated when the only facts relied upon are disclosed in the record.

Winter v. Slick v. Vollkommer, 97 O. G. 1837.

Ritter's motion to dissolve was based upon the testimony taken and was properly refused transmission.

Ritter v. Kralkaw & Connor, 104 O. G. 1897.

In the absence of an explanation of the delay the motion will not be transmitted, or when the cause for dissolution arises out of the testimony.

Hopkins v. Scott, 105 O. G. 1263.

A motion to transmit an amendment canceling claims before statements filed will not be transmitted under this rule.

Colley v. Copenhaver, 107 O. G. 268.

It is not ground for a motion to transmit because the Examiner has requested such a course in another case.

*Parkin & Parkin v. Riotte*, 109 O. G. 1335.

As a general rule motions to dissolve an interference are not transmitted when the reasons for bringing the same arise out of the testimony. (*Felbel v. Oliver*, 92 O. G. 2339.)

*Winton v. Jeffrey*, 112 O. G. 500.

When an applicant has had ample opportunity to present such claims as he wished and had presented several sets, a motion to transmit the interference in order to permit the Examiner to consider another set of claims was properly denied.

*Scott v. Emmet & Hewlett*, 116 O. G. 1184.

One party appealed to the Board on the question of patentability but recommended changes. The motion to transmit for reformation and dissolution should be denied as it appears that no good purpose would be served thereby.

*Brown, Lindmark*, 109 O. G. 1071.

Where a motion for dissolution is brought long after the time fixed by the rules and is based upon patents discovered six months before the motion was made, the motion should not be transmitted to the Examiner for consideration.

*Wilcox v. Newton*, 116 O. G. 1452.

A motion to dissolve should not be transmitted when the Commissioner has ruled upon the point involved.

*Egly v. Schulze*, 117 O. G. 2366, 1900 C. D. 237.

A decision of the Examiner of Interference refusing to transmit will not be disturbed unless it is shown that it was clearly erroneous.

*Dann v. Halliday*, 119 O. G. 2236.

The Examiner of Interferences properly refused to transmit to the Primary Examiner motions which the Primary Examiner has no authority to decide.

*Becker & Patiz v. Edwards*, 123 O. G. 1990.

The Examiner of Interferences properly refused to transmit to the Primary Examiner motions which the Primary Examiner has no authority to decide.

*Becker & Patiz v. Edwards*, 123 O. G. 1990.

A motion to transmit for inserting claims that: it appears from a decision of the Primary Examiner in the case can not be made by the party, should be refused.

*Townsend v. Copeland v. Robinson*, 124 O. G. 623.

(8) *Petition to Extend Time.*

The Examiner of Interferences was right in not extending the time for filing motions, for the granting of such extension would have no other effect than to cause unnecessary delay in the proceedings in those cases where the motion contemplated was not filed.

*Egly v. Schulze*, 117 O. G. 226, 1905 C. D. 237.

The time within which to bring motions was first set to expire January 11, but in view of stipulations by the parties this was extended to expire on February 11.

*Barratt v. Swindlehart*, 144 O. G. 818.

A petition to extend the limit of appeal to include an appeal filed after the expiration thereof must be supported by verified showing in excuse for the delay.

*Kletzker & Goesel v. Dodson*, 109 O. G. 1336; *Autenrith & Rane v. Soresen*, 120 O. G. 2126.

When an appeal is filed after the time limited it should be accompanied by a motion to restore jurisdiction.

*Greuter v. Mathiew*, 112 O. G. 253.

As the present motion is not accompanied by affidavits showing why appeal has not been taken to the Examiner-in-Chief within the limit of appeal originally set, it has no standing and must be dismissed from further consideration.

*Kletzker & Goesel v. Dodson*, 109 O. G. 1336; 110 O. G. 305-308.

Although the date of a reference relied upon in a motion to dissolve alleging anticipation of the issue is later than the date of conception set in the preliminary statement of the opposing party, the motion may nevertheless be transmitted in order that the Primary Examiner may consider the pertinency of the reference and permit the filing of an affidavit alleging the facts required by Rule 75, outside of those contained in such preliminary statement.

*Martin v. Goodman v. Dyson v. Suttig & Goodrum*, 130 O. G. 1485.

No reasons being given in support of the reasons for dissolution, transmission was properly refused.

*Miller v. Wallace*, 131 O. G. 1689.

The original counts, one and two, stand so related to the added counts that whatever conclusion the Examiner reaches regarding the dissolution of the interference as to the latter counts would probably be applicable to be transmitted as to all counts.

*Murphy v. Borland*, 132 O. G. 231.

A motion alleging informality showing that the real grounds relate to the right of a party to make the claim should not be transmitted.

Danquard v. Courville, 131 O. G. 2421.

Where a party acting in good faith files a motion which is held to be indefinite and an amended motion covering the informality is promptly filed within the limit of appeal set from the prior decision, the Examiner of Interferences should transmit the second or amended motion. He can not, however, be permitted to present his case experimentally. The first motion having been denied because not sufficiently definite and decisions cited, the second motion should have cured the defect, a third motion refused transmission.

Gold v. Gold, 131 O. G. 1422; Rockstroh v. Warnick, 131 O. G. 234; Papendell v. Bunnell v. Reizenstein v. Gaisman v. Gillette, 132 O. G. 1837.

Where the reasons for delay appear clearly upon the record it is only necessary to call attention to them in the motion to transmit.

Cutler v. Carichoff, 130 O. G. 656.

The transmission of a motion filed outside of the regular time is a matter resting largely within the discretion of the Examiner-of-Interference (cases).

Bastian v. Champ, 128 O. G. 2837.

Where an amendment to a motion was filed after the time limit had expired, the original motion having been filed in time, and no delay being occasioned, held that the time of filing the amendment was no objection.

Smith v. Fox, 130 O. G. 1312.

### (9) Evidence—Affidavits.

Affidavits received on both sides as to public use.

Young v. Hoard, 1870 C. D. 59.

Affidavits asserting inoperativeness of opponents device improper.

Quensel v. Knox v. Pries v. Murphy, 185 O. G. 248.

Affidavits as to non-patentability should not be considered.

Ellis v. Boyce v. Burchenal, 195 O. G. 273.

Affidavits received as to utility of device.

Munger, 1869 C. D. 3; Cheesbrough, 1869 C. D. 18.

Backed by affidavits of others.

Harris, 1870 C. D. 62; Phillips, 1871 C. D. 273; Richardson, 1872 C. D. 144.

As to the former practice of invention with the affidavits of experts.

William Thie, 1870 C. D. 61.

*Ex parte* affidavits are not competent to establish the statutory bar of two years' public use.

Wicks & Wyman v. Knowles, 11 O. G. 196; Anson v. Woodbury, 12 O. G. 1.

It is not enough for the applicant to charge fraud, which is never presumed, but must always be strictly proved, and then to demand that he be relieved from the burden of proof which the law has imposed upon him. Such a course will not shift the burden of proof.

Hansen v. Davis, 1891 C. W. 72.

If the operativeness of the device is denied, whether on a motion to dissolve the interference, or in any other proceeding, the applicant has a right, under Rule 31 (76) to submit affidavits in proof of the operativeness of his invention. An applicant can not by indirection be deprived of the benefit of this rule.

Fuller v. Brush, 79 C. D. 328, 16 O. G. 1188.

This rule (76) is in accordance with law.

Hedges v. Daniels, 1880 C. D. 64.

The Commissioner is not authorized to reject an application on the ground of more than two years' public use and sale, on *ex parte* affidavits, without giving the applicant an opportunity to cross-examine the affiants. The proof should conform to the fundamental canons of the law of evidence.

Alteneck, 23 O. G. 269; decision by the Supreme Court of the District of Columbia.

Public use and sale asserted, and affidavits tending to establish such facts filed, an order that all files be forwarded to the Commissioner. Upon examining the affidavits and files, an order issued requiring applicant to show cause, at a certain date, assigned, why an order directing an inquiry, into the question of public use and sale, should not be made. A copy of order directed to be served on applicant.

Barricklo, 37 O. G. 672; see also Barricklo, 38 O. G. 417.

The oaths of the applicant that he is the first and original inventor and does not know and does not believe that the same was ever before known or used, and that letters patent for the same invention for the United Kingdom of Great Britain and Ireland have been granted to Charles William Siemens, as a communication from abroad bearing date the 5th of June, 1873, etc., is sufficient to identify the applicant with the British patentee, so as to defeat a motion to dis-



solve the interference on the ground that the same invention was described in said previous British patent.

Van Alteneck v. Thompson, 17 O. G. 57.

Where on final hearing before the Commissioner an interference is suspended and the case remanded to the Primary Examiner for consideration of the question of operativeness, this question will not be considered *inter partes* but will be determined by the Examiner, subject to the regular course of appeal in *ex parte* proceedings.

Archer, 1891 C. D. 191, 57 O. G. 696.

The affidavit of a party that the device was operative is questionable in view of the fact that the testimony of others, who were not produced, was accessible.

Kelly v. Flynn, 92 O. G. 1237.

Where certain patents and publications are referred to on a motion to dissolve, and opposing party states on the record that he has no objection to their consideration, although five days' notice has not been given, the reference should be considered.

Lake v. Cahill, 110 O. G. 2235.

Where there were two attorneys of record the sickness of one is not sufficient excuse for neglect to look up evidence.

Ingoldsby v. Bellows, 113 O. G. 2214.

Motion to dissolve an interference, affidavits as to operativeness received. Motion to remove from files refused.

Dickinson v. Thibodeau v. Hildreth, 99 O. G. 2550,  
1902 C. D. 202.

Affidavits as to interference in fact and as to scope of claims in support of motion under Rule 122 refused.

Dickinson v. Thibodeau v. Hildreth, 99 O. G. 2550;  
Summers v. Hart, 98 O. G. 2585.

Dow can not be permitted to establish the fact that he made the invention and its date by *ex parte* affidavits.

Dow v. Converse, 106 O. G. 2291.

Affidavit of Expert received and considered as to identity of invention.

Felbel v. Oliver, 92 O. G. 2339.

A party's rights are not limited by proceedings had in another interference between different parties.

Gray v. McKenzie v. McElroy, 113 O. G. 1968.

No testimony as to inoperativeness or public use previous to motion to dissolve.

Barber v. Wood, 127 O. G. 1991.

If the Examiner when the case is reached for action rejects claims on the ground of non-invention the applicant may undoubtedly present in response to such rejection and

have admitted affidavits which include so much of the present affidavits as relate to the merits and efficiency of his device, but which omit the irrelevant statements made in the affidavits concerning the devices of others.

Robinson, 115 O. G. 1584.

The refusal of the Examiner to dissolve the interference on the ground that there is no interference in fact was correct, notwithstanding affidavits which have been filed alleging that no confusion has resulted from the use of the marks referred to. (Trade-Mark.)

Philadelphia Watch Case Co. v. The Dueber Watch Case Co. v. etc., 122 O. G. 1725.

I am of the opinion that testimony upon the operativeness of the device disclosed by the senior party should be accepted and considered in determining who is the prior inventor in this case, provided a *prima facie* case of imperativeness is made out and a satisfactory showing is presented that the proposed evidence is of a character to justify opening the case for taking testimony. Whether testimony may be taken in this case should be determined in the first instance by the Examiner of Interferences.

Lowry & Cowley v. Spoon, 122 O. G. 2687.

Consideration of affidavits upon motions to dissolve is not a right which the parties are entitled to demand. The rights of parties on such motions extend no further than is expressly provided by rules of practice. Usually will extend no further than testimony and rebuttal.

Browne v. Stroud, 122 O. G. 2689.

Affidavits as to operativeness of opponent's device in an interference proceeding.

Clement v. Brown v. Stroud, 125 O. G. 992.

Affidavits as to inoperativeness of opponent's device in interference cases proper for making a *prima facie* case.

Lowry & Cowley v. Spoon, 124 O. G. 1846.

*Ex parte* affidavits as to intervening rights in interference cases.

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

An *ex parte* affidavit is not enough to carry a party's filing date back to that of a foreign application and change the burden of proof.

Raulett & Nicholson v. Adams, 114 O. G. 827.

These affidavits as to operativeness of invention may be filed notwithstanding an interference has been dissolved because of the inoperativeness of the device.

Mark, 117 O. G. 2636.

An affidavit refused consideration on the ground that cer-

tain testimony referred to therein was not properly authenticated as to officer taking it.

*Brown v. Inwood & Savenberg*, 131 O. G. 1423.

A motion made and judgment passed upon it *res adjudicata* and can not be entertained a second time upon the same state of facts.

*Little v. Little, Pillard & Sargent*, 10 O. G. 543.

The matter at issue in an interference proceeding and a public use proceeding are different, and it is for this reason that testimony taken on the question of priority in an interference is not used on the issue of public use without further proceedings, in which the party adversely affected is given an opportunity to cross-examine the witnesses with that issue framed and to produce witnesses to explain the evidence. (*Weber*, 101 O. G. 2570.) For the same reason testimony taken in the public use proceeding can not be held conclusive of the question of priority of invention, and should not be used against *Gilman* without the institution of a second interference.

*Ex parte Menzelman & Overholt*, 132 O. G. 232.

(10) *Delay in Bringing Motion, etc.—Excuse for Second Motion.*

It does not appear that the references now principally relied upon could not have been found within the time originally set for bringing motions, if proper search had been made at that time. The Examiner of Interferences, properly refused therefore, to transmit the motion. (99 O. G. 774, 1385; 111 O. G. 222; 117 O. G. 597.)

*Topping v. Price*, 160 O. G. 774, 340.

R. and O. in interference afterward M. added R. moved to dissolve for non-patentability refused as the motion should have been made in first interference. The fact that M.'s device threw new light on the question not an excuse.

*Onderdonk v. Rentke v. Moffat*, 183 O. G. 507.

A subsequent motion may be treated as a motion for a new trial.

*Fowler v. Uptegroff*, 184 O. G. 803; *Dunn v. Douglas*, 184 O. G. 529.

A new meaning placed upon the issue by the Examiner no excuse for a second motion because the broadest possible interpretation will be given them.

*Burden v. Manson*, 185 O. G. 529.

The filing of a motion to take special testimony affords no excuse for the delay in bringing this suit.

*Pettengell v. Webster and Towle*, 186 O. G. 799.

The assignee of a party did not move to dissolve he was now permitted to do so afterward as an assignee of a subsequently added party.

Waller v. Coe v. Browne, 193 O. G. 511.

The rules contemplate that a motion to dissolve the interference on the ground of non-patentability of the subject-matter when the facts on which it is based are known should be made at the outset. Such a motion by a defeated party refused after judgment because of the delay.

Blinn v. Gale, 16 O. G. 459; Mark, 117 O. G. 2636.

Where both parties are applicants and under the head of informality in declaring the interference it is alleged in a motion to dissolve that the claims do not apply to the structure of either party. Held that this is not such an admission as to justify a decision on priority adverse to the moving party. The case of Lipe v. Miller, 109 O. G. 1608, distinguished.

Danquard v. Courville, 131 O. G. 2421.

The 20 days having elapsed a motion to restore jurisdiction to the Examiner of Interference for the purpose of moving to dissolve should be accompanied by the motion to dissolve.

If such latter motion can not be made within the time limit it should be made as soon thereafter as possible.

Niedermeyer v. Walton, 97 O. G. 2306.

In case of discovering new facts after granting the motion to transmit to the Primary Examiner, he may consider such facts provided due and timely notice thereof be given to the party opposing the motion. A petition to amend is unnecessary.

Kurz v. Jackson & Pierce, 98 O. G. 2586.

Whether a delay beyond the time limited shall be excused lies somewhat within the discretion of the Examiner.

99 O. G. 1383.

When a second motion to transmit is made on the ground of newly discovered evidence it is proper for the Examiner of Interferences to consider the question of due diligence.

Whitlock & Huson, 99 O. G. 1385.

Delay in making motion excused in view of the cost of obtaining a copy of opposite party's application, the difficulty of getting the money for the same, and the complicated nature of the case. In the above case the delay was due in part to the Office.

Kletzer & Goesel v. Dodson, 101 O. G. 2822.

A motion pending under this rule is not a bar to a motion under Rule 109, nor does it excuse delay.

*Perrussel v. Wichmann*, 99 O. G. 2970.

If a motion is not made within the 20 days limited, the burden is upon the mover to show that it could not have been sooner.

*Niedringhaus v. Marquard v. McConnell*, 101 O. G. 1610.

Under the circumstances of this case even admitting that Miller did not appreciate the pertinency of the patents referred to till April 21, 1903, a delay of over a month in bringing his motion after this date was not exercising due diligence. The affidavit accompanying witness' motion is defective in that it does not appear therefrom that the patents on which he relies to anticipate the issue could not have been obtained earlier by the exercise of reasonable diligence.

*Lipe v. Miller*, 105 O. G. 1532.

As the applicant has made no satisfactory showing that the references could not have been found before, and the motion presented earlier to grant his appeal would, in effect nullify the clause in Rule 122 requiring such motions to be made within twenty days following the approval of the preliminary statement.

*Sturgis & Hopewell*, 109 O. G. 1067.

When no testimony has been taken and the delay is slight, the motion may be entertained.

*Harrison v. Shoemaker*, 109 O. G. 2170.

Where parties have not seen each other's statements a slight delay may be excused.

*Doble v. Eckhart v. Henry*, 110 O. G. 604.

It appears, therefore, that the real reason for bringing the motion at this time is a change of purpose, arising from the fact that the applicant has appointed a new attorney. Such reason is not sufficient excuse for the delay.

*Rayburn v. Strain*, 110 O. G. 603.

A second motion to transmit considered as a motion for a new trial and no limit of appeal set.

*Goodfellow v. Jolly*, 110 O. G. 602.

After twenty days the burden of proof is upon applicant to show diligence. In the absence of such showing a refusal to transmit is proper. The pendency of a motion to shift the burden of proof is no excuse.

*McArthur & Gilbert*, 111 O. G. 1624.

The fact that an alleged anticipating patent was not dis-

covered until the expiration of the time limit not considered sufficient excuse.

Schirmer v. Lindemann & Stock, 111 O. G. 2222.

The pendency of a motion for dissolution is no good reason for delay in bringing a motion to shift the burden of proof. (See McArthur v. Gilbert, 111 O. G. 1624.)

Harvey v. Lubbers v. Raspillaire, 112 O. G. 1215.

A second motion for dissolution will not be entertained unless there is good showing why new reasons advanced were not presented at the time of the first motion.

Hedlund v. Curtis, 113 O. G. 1419.

The pendency of a motion to dissolve by one party does not excuse delay in making such a motion by another party.

Jackson v. Cuntz, 115 O. G. 510.

The excuse for delay in bringing motion was the non-discovery of a German patent.

Some of the grounds alleged had nothing to do with the German patent and therefore that was no excuse for delaying the motions on these grounds. No reason why the German patent was not discovered earlier was given and no sufficient excuse was given for the delay of more than two months after such discovery. "The pendency of an appeal upon the first motion, which had been decided against him is no excuse."

Pfingst v. Anderson, 117 O. G. 597.

A mere change of opinion after retention of new counsel will not justify transmission of the motion for dissolution long after (two months) the time when it should have been brought.

Carver v. McCanna, 117 O. G. 599.

It is against the policy of the Office to permit piecemeal motions in interference cases.

Egley v. Schulze, 117 O. G. 276; Crecent Oil Co. v.

W. C. Robinson & Son Co., 142 O. G. 1113.

Unexcused delay in bringing motion.

Carney v. Latimer, 119 O. G. 6522.

If the excuse for delay in bringing a motion does not cover the entire time the motion should not be transmitted.

McKee v. Baker, 120 O. G. 657.

That one was not able to get copies of papers within the twenty days' limit received as an excuse. It was however unnecessary to allege the paper were furnished by the Office.

Steinmetz v. Thomas, 119 O. G. 1260.

The provisions of Rule 122 requiring motions to be brought, *if possible*, within a time fixed is conducive to

orderly procedure and must be enforced. The Examiner of Interference was right in refusing to transmit a motion not made in time and unaccompanied by a proper excuse.

Townsend v. Copeland v. Robinson, 124 O. G. 1210.

Where an amendment to a motion was filed after the time limit had expired, the original motion having been filed in time and no delay being occasioned, held that the time of filing the amendment was no objection.

Smith v. Fox, 130 O. G. 1312.

Motions on ground of inoperativeness are not favored and it is incumbent upon one bringing them to do so promptly.

Joslyn v. Hulse, 130 O. G. 1689.

In response to an order to show cause under Rule 114 applicant moved to dissolve for non-patentability of issue, but was not sufficiently specific in applying references, amendment filed seven days after limit. In view of this attempt to apply the references, the promptness with which the second motion was filed, and the fact that refusal of the motion will be fatal to appellant's case, it is thought that the last motion to dissolve should be transmitted to the Primary Examiner.

Anser v. Pierce, Jr., 131 O. G. 359.

A junior party, cited to show cause why judgment should not be rendered against him on the record, may move to dissolve for non-patentability of the issue.

Papendell v. Bunnell v. Reisenstein v. Gaisman v. Gillett, 131 O. G. 362.

The bringing of motions or the taking of petitions to the Commissioner will not stay the running of the limit of appeals from a decision on priority.

Pym v. Hadaway, 131 O. G. 692.

As to claims involved in a second interference between the same parties which could have been made in the first interference, held that a final decision in the first interference on the question of priority renders that question *res adjudicata*.

Hopkins v. Newman, 131 O. G. 1161.

It is well settled that piece-meal action can not be permitted, but where a party acting in good faith files a motion which is held to be indefinite, and an amended motion curing the informalities is promptly filed within the limit of appeal set from the previous decision, the amended motion should be transmitted.

Gold v. Gold, 131 O. G. 1422. See, however, Rockstroh v. Warnock, 132 O. G. 234.

To permit a party to prosecute separately by renewal motions, one or more separate grounds of dissolution advanced

in an original motion and then to appeal on the separate motions as they are decided against him would be to sanction a piecemeal procedure, which has been uniformly, and properly, condemned by the Office. W.'s renewal motion accordingly amounted to an abandonment of his right to appeal on the original motion. Appeal on original motion out of order appeal on renewal motion proper.

Williams v. Webster v. Sprague, 148 O. G. 880; Lotterhand v. Cornwall, 148 O. G. 1344.

A second interference between the same parties upon the same subject-matter should not be instituted.

Wenzelman & Overholt, 132 O. G. 232.

Delay not relieved against by redeclaration to include additional counts.

Murphy v. Borland, 132 O. G. 231.

Transmission of motion to dissolve refused in view of the fact that the excuse for delay was insufficient in that it alleged that business of great importance prevented him from consulting his attorney in time, but did not show why the matter could not be attended to by correspondence.

Blackmore v. Hall, 132 O. G. 1387.

The pendency of a motion to shift the burden of proof is no excuse for the delay in bringing a motion to dissolve.

Price v. Blackmore, 133 O. G. 514; McArthur v. Gilbert, 111 O. G. 1624.

In the absence of positive written law excluding Sundays from the period of time prescribed for any purpose, they are counted, even though the period ends on Sunday. (Lewis Southerland Statutory Construction, Vol. I, p. 335.) The same rule is applicable to holidays. (Trade-mark.)

Robert A. Keasley Company v. Portland Cement Fabrik Hemmor, 133 O. G. 1936.

The transmission of a motion filed outside of the regular time is a matter resting largely within the discretion of the Examiner of Interferences (cases).

Bastian v. Champ, 126 O. G. 2837.

(11) *Expediting Proceedings. Examiner's Actions—  
Time Limit.*

Motions under this rule formerly required to be noticed for hearing within the time limited for appeal, so that the jurisdiction should not be lost.

Meyrose v. Jahn, 56 O. G. 1417, 1891 C. D. 145.

The redeclaration of an interference to add a new party



does not excuse delay beyond thirty days from the original declaration.

*Townsend v. Ehrig v. Young v. Struble*, 137 O. G. 1484.

The fact that the Examiner discovered a new reference and brought it forward in a companion interference does not excuse delay in making the motion, if it does not appear that the reference could not have been found in time.

*Townsend v. Ehrig v. Young v. Struble*, 137 O. G. 1484.

The decision must be confined to the question presented.

*Zeidler v. Leech*, 1891 C. D. 9.

The time limited for the making of motions runs from the day the original statements are received and approved, and a subsequent amendment of a preliminary statement does not of itself operate to extend this time.

*Scribner & Warner v. Childs v. Balsley*, 1892 C. D. 104.

Upon a motion to dissolve an interference upon the ground of irregularity in declaring the same the Primary Examiner is not at liberty to decide the question of patentability.

*Hutt & Phillips v. Foglesong*, 1892 C. D. 190.

On hearing nothing should be considered by the Primary Examiner outside of the fact disclosed by the record unless a showing of such additional facts accompanies the motion to transmit, but that where moving parties rely upon the record it is unnecessary for them to state in the motion the facts upon which the motion for dissolution is based. In the case of the discovery of new facts after granting the motion to transmit, the Primary Examiner may consider such facts provided due and timely notice thereof be given to the opposite party.

*Wells v. Packer*, 90 O. G. 1947.

When motions to dissolve are brought upon the grounds specified in Rule 122, the Examiner should decide the motion on all grounds, and if this decision is of such a nature that appeals therefrom may be taken he should fix a limit of appeal.

*Hingley v. Parker*, 97 O. G. 2742.

The Examiner should decide the motion upon all the grounds presented.

*Oldham & Padbury v. P. v. C. v. R.*, 99 O. G. 670.

If the Examiner is of the opinion that part of the claims are unpatentable he should dissolve the interference as to these claims and continue it as to the remainder. If the remaining claims are sufficient to base a conclusive decision upon, the interference should not be dissolved to present new claims in place of those held unpatentable. A motion to

amend may be granted conditioned on the filing of an affidavit under Rule 75.

Hillard v. Eckert, 101 O. G. 1831.

When a motion is made on all the grounds specified in Rule 122, it is the duty of the Examiner to consider and determine all these grounds and assign limits of appeal to all that are appealable.

Cutler v. Riddell, 100 O. G. 763. See also Hopfelt v. Read, 106 O. G. 767 and cases cited.

Where time is limited in which to take action after the rendering of a decision, the date of the decision and not the date of the receipt of notice thereof governs.

Greuter v. Mathieu, 112 O. G. 254.

If there is a broad invention common to the respective inventions, it would seem that this fact could be determined by the respective parties and the claims included in the issue, so that this interference can proceed on its merits without further delay, of which there has been too much in this case.

Normand v. Krimmelbein, 115 O. G. 249.

The time limit fixed in the rules for motions means actual time, and Sundays and holidays are not excluded in computing it.

Dickinson v. Norris, 116 O. G. 593.

Where an interference is transmitted to the Primary Examiner for the purpose of determining the right of one of the parties to make the claim, and the Examiner also decides the question of interference in facts—held that the Examiner exceeds his jurisdiction.

Podlesak & Podlesak v. McInnerney, 118 O. G. 835. See next case also, 118 O. G. 836.

The time limited for appeal begins to run when the case is returned to the Examiner of Interferences and formal resumption of proceedings is noted.

Hewitt v. Steinmetz, 122 O. G. 1396.

Where the questions involved are patentability and the right of party to make claim, the motion should not be granted on the ground of non-interference in fact.

Thullen v. Young & Townsend, 118 O. G. 2251.

Successive motions discouraged.

Scott v. Emmet & Hewlett, 119 O. G. 2233.

Prior *ex parte* decision by appellate tribunal not binding on Primary Examiner in *inter partes* consideration.

Felsing v. Nelson, 120 O. G. 2445.

The Examiner may upon a motion for dissolution of an interference where a party has filed a certified copy, determine whether or not it is necessary for the other party to see other parts or the whole of the original application.

Fagan v. Graybill, 121 O. G. 1013.

It is well settled that where an interference is transmitted to the Primary Examiner for the consideration of one question, he is without jurisdiction to consider an entirely independent question.

Moore v. Curtis, 121 O. G. 2325.

Where the Examiner finds on motion to dissolve an interference that the subject-matter in issue is not patentable, he should take such action in the applications subsequent to his decisions as will put them in condition for statutory appeal, so that the appeal may be continued directly to the Court of Appeals without the necessity of a second course of appeal through the Patent Office.

Newcomb v. Thomson, 122 O. G. 3013.

No good reason appears for holding that a tribunal may not properly render a decision on a motion for a hearing made within the time limited for an appeal but noticed beyond such limit.

Naulty v. Cutler, 126 O. G. 389.

If a motion is made before the expiration of the thirty days, the balance of the time is waived.

Rockstroh v. Warnick, 132 O. G. 234.

No limit of appeal should be set on a decision refusing to expunge testimony.

Green, Tweed & Co. v. Manufacturers' Belt Hook Co.,  
132 O. G. 680.

Where an Examiner rejects claims presented by a party for interference under Rule 109, he should set a limit of appeal from his decision whether the claims had been allowed to the other party or had been made for the first time by the moving party.

Matticè v. Langworthy, 132 O. G. 1073.

### (12) *Grounds of Appeal.*

When an interference is dissolved on the ground of right of parties to make claims, the question becomes an *ex parte* one.

Woodridge v. Conrad, 165 O. G. 241.

When it appears upon the face of the paper that the real grounds of a motion to dissolve relates to the merits, the

Commissioner will not take jurisdiction either by appeal or petition.

Manny v. Easley v. Greenwood, Jr., 48 O. G. 538, 86 O. G. 490-491, 98 O. G. 415, 97 O. G. 1172, 110 O. G. 6036, 107 O. G. 1098, 88 O. G. 2409, 96 O. G. 844, 86 O. G. 1636, 89 O. G. 1862, 78 O. G. 1904.

It thus appears that the Court of Appeals will not entertain an appeal from a decision on a motion to dissolve an interference, even where the decision is adverse to the right of a party to make the claim. This latter question may be settled *ex parte* in the usual way after the interference. The whole proceeding relating to motion for dissolution is one of office procedure provided for by the authority of R. S. Sec. 483. *Newcomb v. Lemp*, 112 O. G. 1216. But see U. S. *ex rel. The Newcomb Motor Co. v. Moore Com.*, 133 O. G. 1680.

Examiner required to set a limit for appeal upon the question of irregularity and interference in fact. If these grounds are mere pretenses to get the question not appealable under Rule 124 reviewed the appeal will be dismissed.

*Duryea & White v. Rice*, 115 O. G. 803.

It having been finally determined that Struble has no right to make claims corresponding to the counts of the issue, the question raised by the appeal, namely, the question of interference in fact, becomes moot and will not, therefore, be decided.

*Coleman v. Struble*, 114 O. G. 973.

All the reasons given where alleged but the case was not appealed *solely* upon the ground of non-patentability of his opponent's claim. The Examiner properly set a limit of appeal, as he is not the judge of the propriety of the appeal.

*Harnisch v. Gueniffet Benvit & Nicault*, 117 O. G. 1492.

A decision that a claim has not been abandoned by failure to prosecute is appealable under this rule.

*Meden v. Curtis*, 117 O. G. 1795.

It is not a question whether the issue applies to both structures and means the same thing in both cases, but whether giving it to its natural and ordinary meaning the issue is patentable. The Examiner's decision on patentability being favorable the motion to dismiss this appeal is granted.

*White v. Thomson*, 101 O. G. 1371 and 2825.

On appeal matters not urged before the Examiner will not be considered.

*Pfingst v. Anderson*, 118 O. G. 1067; *McFarland v. Watson*, 146 O. G. 257.

In trade-mark cases on an appeal as to priority, identity of subject-matter will not be considered.

Horne v. Somers & Co., 129 O. G. 1609.

Whether or not the application discloses the subject-matter of the interference, and, therefore, whether or not the interference is properly declared, is a question ordinarily to be determined by the Patent Office. (See *Ostergen v. Tripler*, 17 App. D. C. 558; *Herman v. Fullman*, 23 App. D. C. 264-265.) However, this Court has held that in extreme cases where palpable error has been committed, the decision of the Patent Office holding identity of invention between the devices of the parties to the interference may be reversed. (See *Podlesak & Podlesak v. McInnerney*, 26 App. D. C. 399.)

McMulken v. Bolee, 130 O. G. 1691.

Where the claims of the interfering party are in identical language there is an interference in fact, although there may be specific differences in the two constructions, such specific differences not being specified in the claims.

Gordon v. Wentworth, 1906 C. D. 52; 120 O. G. 1165.

### (13) *Shifting Burden of Proof.*

See Rule 116.

Burden of proof when originality denied.

Wherry v. Heck, 49 O. G. 559.

It is not enough for the applicant to charge fraud, which is never presumed, but must always be strictly proved, and then to demand that he be relieved from the burden of proof, which the law has imposed upon him. Such a course will not shift the burden of proof.

Hansen v. Davis, 1891 C. D. 72.

The burden of proof in an interference is upon the contestant who fails to make a claim to the improvement in controversy or a statement equivalent thereto until the same was claimed by the other party to the interference.

Reichenbach v. Goodwin, 1893 C. D. 50.

A formal abandonment of the earlier application does not shift the burden of proof, if there is a clear continuity of action between it and the second application, where the two applications are filed by the same applicant and cover substantially the same subject-matter.

Parmly v. Hockhausen, 1891 C. D. 180.

The presumption is that the Office did its duty in notifying the caveators of the filing of the interfering application, and

the burden is upon them to establish their allegation of no notice by adequate proof.

*Killeher & Grimm v. Mayhew*, 72 O. G. 895.

A reissue has the same standing as to burden of proof as the original patent.

*Hansen v. Davis*, 1891 C. D. 72.

Motion to shift need not set up facts unless they are outside the record.

*Sheppard v. Webb*, 94 O. G. 1577.

A motion to shift the burden of proof because the invention in issue was introduced by amendment is improper. The remedy is by motion to dissolve under Rule 122.

*Tripp v. Wolff v. Jones*, 103 O. G. 2171.

If one wishes to establish the date of filing of an earlier application he should do so by a motion to shift the burden of proof, in which case the decision of the Primary Examiner as to the admission of claims will be final. If such earlier application is brought in the course of taking the testimony it will be considered like other testimony by all the tribunals having jurisdiction.

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

A motion to shift the burden of proof may be founded upon matters outside of the record.

*Bundy v. Rumbarger*, 92 O. G. 2001-2.

When an error is discovered by the Examiner of Interferences which would amount to such an irregularity as would preclude proper determination of the question of priority, such as the improper placing of the burden of proof, the interference should be forwarded to the Primary Examiner with a statement of facts, that he may correct his letter forwarded to the Examiner of Interferences under Rule 97.

*Lutz v. Lewis*, 110 O. G. 2014. (Sup.)

The pendency of a motion for dissolution is no good reason for delay in bringing a motion to shift the burden of proof (See *McArthur v. Gilbert*, 111 O. G. 1624).

*Harvey v. Lubbers v. Raspillaire*, 112 O. G. 1215.

F.'s patent does not make him the senior party in the proceeding; as D. was the first to file an application, he is the senior party in this proceeding, and it is incumbent upon F. in order to prevail to establish his case by a preponderance of evidence.

*Furman v. Dean*, 111 O. G. 1366.

Motions to shift the burden of proof are brought under the provisions of Rule 116. In a proper case the burden of proof can be shifted without dissolving and redeclaring the interference.

Motions to shift the burden of proof should be made before the Examiner of Interferences within the twenty days after the approval of the preliminary statement allowed for motions. This case withdraws jurisdiction from the Primary Examiner in this class of cases.

Raulet & Nicholson v. Adams, 114 O. G. 1827.

As held in the case of Raulet & Nicholson v. Adams (114 O. G. 1827) no appeal will be entertained upon interlocutory motion relating to the burden of proof, but that matter may be brought up with the final decision as to priority of invention. Such motions should be made before the Examiner of Interferences.

Osborne v. Armstrong, 114 O. G. 2091.

An *ex parte* affidavit is not sufficient to change the burden of proof by carrying back a party filing date to that of a foreign application.

Raulet & Nicholson v. Adams, 114 O. G. 1827.

A previous application which does not show all the elements of the issue can not avail to shift the burden of proof.

Norden v. Spaulding, 114 O. G. 1828.

An applicant shows two species but claims only one; held that a second application for the species not claimed may have the date of the original application.

Van Recklinghauser v. Dempsler, 148 O. G. 277.

Said by Commissioner on Appeal—Before the interference proceeds further it should be positively determined whether or not these new references anticipate the issue.

Wright & Stebbens v. Hansen, 114 O. G. 761.

Claimed that the invention was not shown in original application but was introduced by amendment subsequent to the filing of opponent's application. If well founded this would entitle S., who was the first to conceive, to the benefit, also, of the earlier reduction to practice, and an inquiry into the question of diligence would be unnecessary.

Seeberzer v. Dodge, 114 O. G. 2382.

As a general rule the burden of proof rests on the party against whom judgment would be rendered if no evidence were adduced on either side. This question involving the taking of testimony, should be considered by the Examiner of Interferences, and there is no appeal from his decision prior to the final appeal.

Fennell v. Brown v. Borsch, 115 O. G. 1328.

The alleged improper placing of the burden of proof forms no proper basis for motion for dissolution, and that

question should be presented by separate motion to shift the burden of proof.

Blackmore v. Hall, 118 O. G. 2538.

The question of shifting the burden of proof is a matter within the jurisdiction of the Examiner of Interferences and not the Primary Examiner, and there is no appeal from this decision prior to final judgment.

Raulet & Nicholson v. Adams, 114 O. G. 1827; Scott v. Southgate, 121 O. G. 689.

Where an appeal was taken from the action of the Primary Examiner denying motion to shift burden of proof, the appeal not considered and case remanded to Examiner of Interferences. (Head note.) Opinion does not seem to bear out head note.

Fisher v. Daigherly, 118 O. G. 1681.

(14) *Miscellaneous.*

See note to Rules 15, 66, 76 124, 126, 130, 145, 153.

Cases that pass on the subject-matter of this rule.

Allen, Com., etc., v. U. S. ex rel. Lowry et al., 116 O. G. 2253; Eschinger v. Drummond & Lieberknecht, 121 O. G. 1348; Ingoldsly v. Bellows, 116 O. G. 2532. See note to Rule 128. Wallace, 118 O. G. 1686; Cazen v. Von Welsbach, 119 O. G. 650; Sobey v. Holsclaw, 119 O. G. 1922; Park v. Lewis, 120 O. G. 323; Felsing v. Nelson, 121 O. G. 1347; Garnall v. Pope, 115 O. G. 2136; Miller, 116 O. G. 2532; Hicks v. Costello, 103 O. G. 1163; Sibley Soap Co. v. Lambert Pharmacal Co., 103 O. G. 2172; Dickinson v. Thibodeau v. Hildreth, 99 O. G. 2550; Fessenden v. Potter, 101 O. G. 2823; Votey v. Weist, Jr., v. Donovan, 111 O. G. 1627; Macey v. Tobey v. Laning, 97 O. G. 1172; Potter v. Van Vleck v. Thomson, 95 O. G. 2484; Valiquet v. Johnson, 92 O. G. 1795; Banks v. Snediker, 17 O. G. 508; Carroll v. Stahlberg, 111 O. G. 1937; Fickinger & Blake v. Hulett, 111 O. G. 2492; Wilkinson v. Junggren, 112 O. G. 252; In re Lowry, 90 O. G. 445; Philadelphia Watch Case Company; The Dueber Watch Case Manufacturing Co.; The Keystone Watch Case Company v. Byron L. Strasburger & Company, 122 O. G. 1725; Kugele v. Blair, 127 O. G. 1253; Hewitt v. Weintraub v. Hewitt v. Rogers, 128 O. G. 1689; U. S. A. ex rel. The Newcomb Motor Co. v. Allen (Moore), Commissioner, 124-130 O. G. 302; Hewitt v. Weintraub v. Hewitt and Rogers, 128 O. G. 1689.



**Rule 123. Motions to Effect Stay of Proceedings.**

Setting a motion brought under the provisions of Rule 109 or of Rule 122 for hearing by the law examiner will act as a stay of proceedings pending the determination of the motion. To effect a stay of proceedings in other cases, motion should be made before the tribunal having jurisdiction of the interference, who will, sufficient grounds appearing therefor, order a suspension of the interference pending the determination of such motion.

- (1) HISTORY.
- (2) STAY OF PROCEEDINGS.
- (3) JURISDICTION.

(1) *History.*

See case cited under History of Rules 122-124 above.

See Rule 117 of 1879 in appendix.

Rule 59 of 1878 reads in part as follows:

After the declaration of the interference and before the time for filing the preliminary statements, has expired, motions to dissolve the same on the grounds of lack of novelty, or that no interference in fact exists, or that there has been such other irregularity in declaring the same as will preclude the proper determination of the question of right between the parties, must be made before the examiner by whom the interference was instituted. After the declaration of interference such motion must be made before the tribunal having jurisdiction at the time. Appeal may be taken to the commissioner in person; but if the examiner should decide that the subject-matter is not patentable in view of the state of the art the interference will be dissolved, and the matter decided upon can be proceeded with *ex parte*.

Previous to the last revision the rule read as follows:

All lawful motions, except those mentioned in Rule 122, will be made before and determined by the tribunal having jurisdiction at the time. The filing of motions will not operate as a stay of proceedings in any case. To effect this, motion should be made before the tribunal having jurisdiction of the interference, who will, sufficient grounds appearing therefor, order a suspension of the interference pending the determination of such motion.

The following notes have this rule in view.

*CONSTRUCTIONS.**(2) Stay of Proceedings.*

A motion for a rehearing—even if filed within the limit would not operate as a stay.

*Carmichael v. Fox*, 104 O. G. 1656.

A motion to operate as a stay of proceedings should be accompanied by a petition to that effect. An order should then be entered at or before the hearing of said motion granting or refusing the petition.

*Dubois v. McCloskey*, 17 O. G. 1158.

When Alexander's motion to reopen was filed on March 11, only three days remained to him for the time limited for appeal. The suspension of proceedings at that time did not have the effect of setting aside and nullifying the order fixing thirty days as the limit of appeal, but merely stopped the running of the time until the question raised could be finally disposed of. As soon as that question was disposed of by the decision of May 13, the time for appeal again began to run. A limit of appeal will not usually be extended.

*Blackman v. Alexander*, 105 O. G. 2059.

There is no necessity for a suspension of proceedings, as there is now no limit of appeal running against any of the parties.

*Robinson v. Townsend v. Copeland*, 106 O. G. 997.

A petition under Rule 145 is not good ground for asking a suspension of the interference.

*Churchward v. Douglas v. Cutler*, 106 O. G. 2016-17.

It is deemed better in the interest of uniform practice to require that motions be filed as provided in Rules 122 and 123 should a suspension of proceedings be desired pending the determination of any lawful motion.

*Hocgh v. Gordon*, 108 O. G. 797.

A motion for rehearing does not operate as a stay of the running of the time in which an appeal from that decision should be taken.

*Cole v. Zarbock v. Greene*, 116 O. G. 1451.

It is no ground for the suspension of an interference that an infringement suit is pending.

*McBride v. Kemp*, 109 O. G. 1070; *Kletzker & Goesel v. Dodson*, 109 O. G. 1336.

If it is difficult to obtain testimony and a party elects to take his chances without it, he can not have the case reopened to introduce such evidence.

*Greuter v. Matthew*, 111 O. G. 583.

A stay will not be granted to await the determination in an *ex parte* consideration of an application not involved in the interference.

Mark v. Greenwalt, 118 O. G. 1068.

The pendency of one motion is no excuse for the failure to bring other motions, and a suspension of proceedings as to one motion does not extend the period of time for bringing other motions. (Cases cited.)

Moore v. Curtis, 121 O. G. 2325; Naully v. Cutler, 126 O. G. 389.

Cases in the Office will not be suspended to await the final decision of the Courts upon another case where similar questions are raised.

Potter v. McIntosh, 116 O. G. 1451.

### (3) *Jurisdiction.*

The Examiner of Interferences has no jurisdiction to determine whether access to files may be had.

Shaver v. Dilg and Fowler, 157 O. G. 1001.

The interference is transmitted to the Examiners in Chief, and they are given jurisdiction to render a supplemental decision upon the question of right to make the claim from which they will set new limit of appeal.

Schutte v. Rue, 157 O. G. 753-754.

It is a matter wholly within the discretion of the Commissioner what questions or whether all questions arising out of interference cases shall be decided in the first instance, by the Examiner of Interferences or some other Primary Examiner.

Weitling v. Cabell, 72 C. D. 185. See also 22 O. G. 22-33.

To what tribunal they (questions arising in an interference proceeding) may be appealed may be determined altogether by the nature of the questions themselves, and the law relating to them.

Weitling et al. v. Cabell, 1872 C. D. 187, 185.

Questions of patentable combinations remanded to the Primary Examiner for consideration.

Lynch & Raff v. Dryden & Underwood, 1873 C. D. 73.

The question of two years' public use as a statutory bar receives consideration from the Examiner of Interferences. He overlooks in this connection, the question of sale. This appears to be a very important point. This case was remanded by the acting Commissioner to the Primary Examiner

to consider the question of sale more than two years before application.

Keller & Olmesdahl v. Felder, 10 O. G. 944.

The Examiner of Interferences is the tribunal before whom an interference is originally to be heard. It is irregular to present the question to the Board of Examiners in the first instance.

Farnsworth v. Andrews, 9 O. G. 195.

The practice indicated by this Rule approved by McArthur J., but Judge Wylie said "I have no idea that it was the intention of the law makers that in questions of interferences the Office should go into the question of abandonment, and he did not think the Commissioner had a right to establish a rule permitting it."

Bigelow v. The Commissioner of Pats., 7 O. G. 606.

If in the judgment of the Examiner of Interferences neither party is entitled to a patent for want of novelty, he must send the question back to the Primary Examiner for determination. He can not decide it himself.

Neuboeker v. Schafhaus, 1873 C. D. 138.

The Examiner of Interferences has no jurisdiction over questions of patentability. Such questions should go to the Primary Examiner as they are appealable to the Supreme Court of the District, and matters within the jurisdiction of the Examiner of Interferences can not be appealed from the Decision of the Commissioner.

Little v. Little et al., 10 O. G. 543.

Facts establishing two years' public use before application for a patent developed in an interference can not afterward be explained away by *ex parte* affidavits. Case remanded to the Primary Examiner to consider such question.

Stearns v. Prescott, 13 O. G. 121.

The Examiner of Interferences has no jurisdiction over of two years' public use as a bar to a patent.

Little v. Little et al., 76 C. D. 207; Ansen v. Woodbury, 77 C. D. 4.

Questions of statutory bar of public use referred to the Primary Examiner by the Commissioner without an appeal from the decision of the Examiner of Interferences.

Quimby v. Randall, 14 O. G. 748.

The Examiner of Interferences can not dissolve an interference in view of *ex parte* affidavits setting forth public use as a bar to the application. The question should be remanded to the Primary Examiner.

Hedges v. Daniels, 17 O. G. 152.

The Examiner of Interferences has jurisdiction to hear and determine the fact of joint or sole invention in an interference between joint patentees and a sole applicant who is one of said patentees.

Lourien v. Banister, 18 O. G. 299 (*ex parte* Bruker, M. S.)

If it is decided that there was no joint invention the sole applicant would be the prior inventor, as the entity, the joint inventors, never invented it at all.

Kohler v. Kohler & Chambers, 43 O. G. 247. See Harrison v. Hogan, 18 O. G. 921.

Judgment of priority given by the Commissioner and the case remanded to the Primary Examiner to determine the question of a statutory bar by reason of public use.

Smith v. Dimond, 20 O. G. 742.

After the declaration of an interference a motion to dissolve should be made to the Examiner of Interferences.

Barney v. Kellogg, 17 O. G. 1096.

The Examiner of Interferences is a proper person to hear and determine questions relative to abandonment.

Von Heffner v. Alteneck, 23 O. G. 2233.

The practice indicated by this rule (126?) seems to be that such reference by the Commissioner can only be made when the case is brought to him regularly on appeal. In a case where the testimony conclusively establishes the fact that the invention had been in public use for more than two years prior to the time when the application for a patent was filed, I do not know that it would be a violation of the Rule for the Commissioner to order that the question should be determined before any decision of priority is made. But as above stated such is not the practice under said Rule. Such reference will not be made if the testimony relating to public use is not conclusive.

Finch v. Bailey & Talbot, 25 O. G. 191.

The restoration of jurisdiction for one purpose does not restore it for all.

Benger v. Burson, 99 O. G. 1384.

Motion for the dissolution of the interference on the ground that it was declared in violation of the provisions of Rules 121 and 123 should be determined by the Examiner of Interferences.

Edison & Gilliland v. Philps, 38 O. G. 539.

Motion to reopen for the purpose of taking more testimony comes properly before the Examiner of Interferences.

McCallum v. Bremer, 93 O. G. 1918; Hildreth, 97 O. G. 1374.

After appeal it was refused to restore jurisdiction to the Examiner of Interferences in order to present a motion to dissolve.

Fessenden v. Potter, 101 O. G. 2823.

The fact that a similar question has been raised by another party furnishes no ground for a rehearing.

Davis v. Ocumpaugh v. Gerrett, 103 O. G. 227.

Motions to shift the burden of proof should be made before the Examiner of Interferences within the twenty days after the approval of the preliminary statements allowed for motions. (Changing jurisdiction from Primary Examiner to Examiner of Interferences.)

Raulet & Nicholson v. Adams, 114 O. G. 1827; Townsend v. Ehret v. Young v. Struble, 137 O. G. 1484.

Jurisdiction of Examiner of Interferences.

Lowry & Cowley v. Spoon, 122 O. G. 2687; Behrend v. Lammer v. Tingley, 124 O. G. 2536; Kugele v. Blair, 125 O. G. 1350.

The reason set up in the present petition why the motion should be remanded to the Examiner of Interferences, relate in the most part to the merits of that motion and are questions which should be presented before the Primary Examiner and not before the Examiner of Interferences.

Pickard v. Ashton and Curtis, 137 O. G. 977.

It is urged that the earlier application does not disclose the invention, and it is very clear that this is a matter which is to be considered and determined by the Examiner of Interferences and not the Primary Examiner.

Dickinson v. Hildreth, 122 O. G. 1397.

The only apparent questions for consideration on a motion to restore jurisdiction to the Examiner of Interferences are whether the motion is in proper form and whether so far as can be seen, without going into the merits of that motion, it is brought in good faith.

Newell v. Clifford v. Rose, 122 O. G. 730.

Jurisdiction restored to the Examiner of Interferences after time limited for appeal had expired. The party should have a hearing upon the question whether the showing made by him is sufficient to warrant the reopening of the case.

Lipscomb v. Pfeiffer, 122 O. G. 351.

An interference will not be suspended in order to give time for the issuing of a patent on an application referred to but not included in the interference, before the other party has access to the files.

Field, 130 O. G. 1587.

It is the well settled practice of this Office that the bring-

ing of motions or taking petitions to the Commissioner will not stay the running of the limit of appeal from a decision on priority.

Pym v. Hadaway, 129 O. G. 2073.

The pendency of a motion under Rule 109 no excuse for delay.

Josley v. Hulet, 130 O. G. 1689.

### Rule 124. Appeals from Adverse Decisions.

Where, on motion for dissolution, the law examiner renders an adverse decision upon the merits of a party's case, as when he holds that the issue is not patentable or that a party has no right to make a claim, he shall fix a limit of appeal not less than twenty days from the date of his decision. Appeal lies to the examiners in chief in the first instance and will be heard *inter partes*. If the appeal be not taken within the time fixed, it will not be entertained except by permission of the Commissioner.

No appeal will be permitted from a decision rendered upon motion for dissolution affirming the patentability of a claim or the applicant's right to make the same.

Appeals may be taken directly to the Commissioner, except in the cases provided for in the preceding portions of this rule, from decisions on such motions as, in his judgment, should be appealable.

#### HISTORY.

The rule previous to the last amendment read as follows:

Where, on motion for dissolution, the Primary Examiner renders an adverse decision upon the merits of a party's case, as when he holds that the issue is not patentable or that a party has no right to make a claim or that the counts of the issue have different meanings in the cases of different parties, he shall fix a limit of appeal not less than twenty days from the date of his decision. Appeal lies to the Examiners-in-Chief in the first instance and will be heard *inter partes*. If the appeal is not taken within the time fixed, it

will not be entertained except by permission of the Commissioner.

No appeal will be permitted from a decision rendered upon motion for dissolution affirming the patentability of a claim or the applicant's right to make the same or the identity of meaning of counts in the cases of different parties.

Appeals may be taken directly to the Commissioner, except in the cases provided for in the preceding portions of this rule, from decisions on such motions as, in his judgment, should be appealable.

See Historical note under Rule 122.

### CONSTRUCTIONS.

- (1) HISTORY AND SUBJECT-MATTER.
- (2) ABANDONMENT—SHIFTING THE BURDEN OF PROOF.
- (3) RIGHT TO MAKE THE CLAIM.
- (4) AFFIRMING PATENTABILITY.
- (5) AMENDMENTS.
- (6) REHEARINGS.
- (7) ASSIGNMENTS OF ERROR.
- (8) DECISION OF THE COMMISSIONER.
- (9) TIME WHEN TAKEN—EXCUSE FOR DELAY—PETITION TO EXTEND TIME.
- (10) TO THE BOARD OR TO THE COMMISSIONER.
- (11) DECISION OF THE BOARD.
- (12) MISCELLANEOUS.

#### (1) *History and Subject-Matter.*

These rules cannot take away the right of an applicant to an appeal after two rejections by the Primary Examiner. (R. S. see 4909.)

U. S. ex. rel., *The Newcomb Motor Co. v. Allen (Moore)*, Commissioner, 130 O. G. 302.

Refusal to suppress testimony not reversible error.

*Rempshall v. Royce*, 129 O. G. 3162.

No appeal to the Court of Appeals of the District on interlocutory motions in Trade-Mark cases.

*The Union Distilling Co. v. Schnieder*, 129 O. G. 2503.

No appeal from decision of the Examiner extending time for taking testimony. Can only be modified by exercise of supervisory authority of Commissioner, and this only in unusual cases.

*Wickers and Furlong v. Weinwurm*, 129 O. G. 2501.

Inoperativeness and public use question in motions to dissolve not appealable.

*Barber v. Wood*, 127 O. G. 1991.



There is no appeal from the decision of the Primary Examiner affirming the opponent's right to make the claims or the identity of meaning of the claims in their respective application.

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

This rule is not inconsistent with section 4909 of the Revised Statutes.

Lowry v. Spoon, 112 O. G. 732. (See 133 O. G. 1680.)

The decision of the Examiner of Interference transmitting a motion will not be reviewed on appeal or petition.

Rich v. Porter v. Hamlin, 192 O. G. 1261.

No appeal from a decision denying a judgment on the record.

Christiant v. Brunneschenke v. Rosañz, 181 O. G. 819.

No appeal to the Secretary of the Interior in matters of a quasi judicial nature such as extending time for a final hearing so as to relieve against a default in filing printed testimony.

Dunkley v. Bukhuis, 158 O. G. 886.

The rule that there is no appeal from decisions on motions to shift the burden of proof, applies also to cases where such a motion is made in response to a rule to show cause and judgment on the record results from the decision of the Examiner of Interferences on such motion.

Barney v. Hiss, 158 O. G. 702.

A motion will not be considered on appeal—although the reason for dismissing it no longer exists.

Kieth, Erickson, etc., v. Lundquist v. Larimer, 158 O. G. 701.

A petition for the Commissioner to exercise his supervisory authority, is not a remedy that may be used instead of the appeal refused by this rule.

Frost v. Chase, 151 O. G. 741.

The Examiner's action refusing to declare an interference may not be appealed. (Trade-Mark.)

Yonkers Brewery Co. v. Iler and Burgweger, 143 O. G. 258.

No appeal from a decision of the primary examiner, that the evidence does not establish the bar of public use.

Hartley, 136 O. G. 1767.

Notice of opposition to trade-mark registration on the ground that the notice of opposition was not signed.

The motion is in effect a motion for judgment on the record and under the established practice of the Office no in-

terlocutory appeal lies from a refusal to render such a judgment.

Geo. Wostenholm & Son, Limited, v. Crowley, 135 O. G. 1121.

Previous to 1880 an appeal seems to have been allowed from a decision affirming the patentability of a claim. The same result can now be attained by a protest under Rule 12.

Fowler v. Benton, 17 O. G. 266.

Propriety of rule discussed. (Consolidating Interferences.)

Klein v. Groebli, 110 O. G. 305-308.

The practice indicated by Rules 122-123-125 may not be the best, but as long as it is the established practice it should be observed.

Brown v. La Dow, 18 O. G. 1049.

Determined means ended or decided. This rule should control Rules 116 and 120.

Hicks v. Keating & Bilgram v. Purvis, 40 O. G. 344.

The statutes do not provide for an appeal to the Examiners-in-Chief from a decision upon a motion to dissolve an interference.

Allen, Commissioner, v. U. S. ex rel. Lowry et al., 116 O. G. 2253.

Refusing to suspend interference to await determination of suit at law (having a different issue) is not such an abuse of discretion as will warrant the exercise of supervisory authority.

Brown v. Inwood and Lavenberg, 135 O. G. 895.

No appeal from a decision refusing to suppress testimony.

O'Brien v. Gale v. Limimer v. Colderwood, 133 O. G. 514; Dietsch Brothers v. Looner, 131 O. G. 2146.

No appeal from the Examiner of Interferences granting a motion to admit testimony the printed copies of which were not filed within the time requested by the rule.

Blackmore v. Hill, 137 O. G. 1237.

Whether or not, applicant should be requested to point out the elements of his claims in his application is a matter of procedure within the discretion of the Examiner. The question is not generally appealable.

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

No appeal as to new matter.

Samulson v. Flanders, 171 O. G. 745.

No appeal from decision affirming operativeness of opponents device.

182 O. G. 973.

No appeal from a refusal to strike out testimony.

Reed & Carnbrick v. Waterbury Chemical Co., 183 O. G. 219.

This rule refers to a decision affirming patentability rendered after an inter partes hearing.

Quensel v. Knox v. Pries v. Murphy, 185 O. G. 248.

The Commissioner has, however, supervisory authority over these matters.

Anderson & Dyer v. Lowry, 89 O. G. 1861.

It is more than doubtful whether a construction of Rule 124 which would deprive the Commissioner of jurisdiction would be a valid one.

Von Welsbach v. Lungen, 48 O. G. 537.

Questions arising under this rule are not reviewable by the Supreme Court of the District of Columbia on Appeal.

Hulett v. Long, 89 O. G. 1141. See however U. S. ex rel.

The Newcomb Motor Co. v. Moore, Com., 133 O. G. 1680.

I know of no confusion in the practice at present existing as to the proper course of appeal upon the question of interference in fact. Rule 124 seems clear and unmistakable upon this point.

Allfree v. Sarver, 122 O. G. 2391.

Where a party may not appeal from a motion he may not appeal from a determination upon the admissibility of affidavits filed with that motion.

Brown v. Inwood et al., 131 O. G. 142.

Appeal denying motion to dissolve for non-interference in fact is to the Commissioner and not to the Board.

Zeidler v. Leech, 1891 C. D. 9.

The Rules cannot take away the right of an applicant to an appeal after two rejections by the Primary Examiner. See R. S. Sec. 4809.

U. S. ex rel The Newcomb Motor Co. v. Allen (Moore) Commissioner, 130 O. G. 302.

The same reasons for not permitting an appeal from a favorable decision exists in the case of a motion brought under Rule 109 as on motion to dissolve. The practice on motions under Rule 109 should follow the practice under Rule 124.

Townsend v. Copeland v. Robinson, 126 O. G. 1355;

Josleyn v. Hulse, 132 O. G. 844.

No appeal from the refusal of the Examiner-in-Chief to direct the attention of the Commissioner to certain patents alleged by one of the contestants to constitute a statutory bar.

Schmiede v. Walden, 1891 C. D. 150.

No appeal from a decision denying a motion to suppress testimony or requiring a party to print exhibits.

*Deitsch Brothers v. Looner*, 131 O. G. 2146.

No appeal from a decision setting aside a record judgment and fixing a time for final hearing, as this is not a final determination of the rights of petitioner in the premises.

*O'Brien v. Gale v. Limmer v. Calderwood*, 133 O. G. 514.

A party to an interference has no right to a review by the Commissioner of a favorable decision by the Primary Examiner in a motion to dissolve alleging non-patentability of the issue either on direct appeal or upon petition for the exercise of his supervisory authority (R. S. 4904) urged to the contrary.

*Hawkins v. Coleman v. Thullen*, 133 O. G. 1187.

A decision refusing to dissolve an interference on the ground of *res adjudicata* is a favorable decision on the merits and was not to be reviewed on appeal.

*Degen v. Pfadt*, 133 O. G. 514.

The provision of the statute giving an applicant the right to have a claim twice rejected (Secs. 4903-4909) does not apply in *inter partes* cases. Where a Primary Examiner, on motion to dissolve decides that one of the parties has no right to make the claims of an interference issue, and such party after filing an appeal from said decision fails to prosecute the same, and abandons it, such decision becomes final and binding on the parties and precludes the subsequent *ex parte* consideration of the same question.

*U. S. ex rel. The Newcomb Motor Co. v. Moore*, Commissioner of Patents, 133 O. G. 1680.

An appeal from the Examiner's ruling raises only the question whether or not the Examiner was right in postponing the consideration of the question, which is a matter that will not be reviewed and reversed except in a clear case of abuse of discretion.

*Royce v. Kempshall*, 119 O. G. 338.

### (2) *Abandonment, Shifting the Burden of Proof.*

Appeal allowed from decision of Examiner of Interferences fixing dates for taking testimony as to abandonment of opponent's application.

*Kinsman v. Strohm*, 125 O. G. 1699.

No appeal is permitted prior to final judgment on a motion to shift the burden of proof, and any supposed error in the decision thereon will be reviewed in connection with the decision upon the question of priority of invention.

*McGill v. Adams*, 119 O. G. 1259.

A decision that a claim is not abandoned is not one that is not appealable under the last paragraph of this rule, but is appealable under Rule 122.

*Meden v. Curtis*, 117 O. G. 1795.

A mandamus refused to compel the Commissioner to allow an appeal where the question of abandonment was decided in favor of the applicant.

*Bigelow v. Commissioner of Patents*, 7 O. G. 603.

An appeal should be allowed where permission to take testimony is refused.

*Pym v. Hadaway*, 128 O. G. 457.

Refusal to suppress testimony not reversible error.

*Kempshall v. Royce*, 129 O. G. 3162.

It is believed that it will be to the interest of all parties concerned, if the Examiner of Interferences in granting motions for the extension of time for taking testimony would not set a limit of appeal from such motion.

*Goodfellow v. Jolly*, 115 O. G. 1064.

Decisions of the Examiner of Interferences are final on motions to extend time for taking testimony, and no limit of appeal should be set.

*Christensen v. McKenzie*, 117 O. G. 277.

No appeal from a decision refusing to shift the burden of proof.

*Miller v. Wallace*, 131 O. G. 1689.

Decision on a motion to shift the burden of proof will be reviewed only in a clear case of an abuse of discretion. Certainly his action will not be reviewed where no such motion has been brought.

*Young v. Townsend v. Thullen*, 134 O. G. 1804.

### (3) *Right to Make the Claim.*

Whether certain additions to original disclosure was proper relates to right to make the claim and not to form.

*Sasher v. Barrett*, 166 O. G. 751.

No appeal from the refusal of the Examiner to suggest claims to opponent under Rule 96.

*Stronach v. Shaw*, 192 O. G. 989; *Mortimer v. Thomas v. Brownson*, 192 O. G. 215.

No appeal from a decision on a motion under Rule 109 that cannot be made the basis for the rejection of a claim.

*Mortimer v. Thomas v. Brownson*, 192 O. G. 215.

When it was contended that one of the parties did not interfere because he did not show one element of the issue,

the question was one of the right of the party to make the claim, and the question was not appealable.

Ball v. Rigo, 119 O. G. 1258.

*Res adjudicata* is a question of right to make the claim and will not be considered on petition from a favorable decision.

Eschinger v. Drummond & Lieberknecht, 121 O. G. 1348.

There is no appeal from a judgment of priority rendered in view of the admission of a party that he is not the inventor, and no limit of appeal need be set from such a decision.

Townsend v. Corey, 119 O. G. 2237.

Where both parties were agreed that the claim was unpatentable the appeal was entertained under the supervisory authority of the Commissioner.

Reichert v. Brown, 124 O. G. 2903.

Favorable decision as to right to make the claim not considered on appeal.

Plackford v. Wilder, 124 O. G. 319; Samuelson v. Flanders, 171 O. G. 745.

As the question of the operativeness of one of the devices now in interference is directly presented to us as an incident of the main question of priority, we hold that it is not one for our consideration. It is as we have before indicated a preliminary question determinable in the first instance in the case of every application for a patent, and when determined in favor of the applicant is not appealable. When determined in his favor, and an interference declared thereon with another similarly allowed application, the same rule applies.

Duryea & White v. Rice, Jr., 126 O. G. 1357.

Interferences are to determine priority. Though parties in these proceedings are permitted to secure reconsideration by the Primary Examiner of his *ex parte* conclusions that their opponents, aside from the conflicting claims of priority, are entitled to patents, and though they are entitled to appear and oppose such reconsideration, their opponents' right to a patent, the interest of a party has never been considered such that he should be permitted to appeal from the Examiner's *inter partes* conclusion affirming his opponent's right to a patent.

Gueniffet, Benoit & Nicault v. Wictorsohn, 117 O. G. 1492.

The provisions of the last clause cannot be avoided by a petition to the Commissioner to exercise his supervisory authority.

Kampshall v. Sieberling, 104 O. G. 1395.

It is a well settled principle that a decision relating to sufficiency of disclosure will not be disturbed except for manifest error.

*Auerbach & Gubing v. Wisweld*, 108 O. G. 289.

No appeal from the decision of the Examiner that affidavit was sufficient to overcome the reference.

*McChesley v. Kruger*, 101 O. G. 219.

No appeal can be taken from the decision of the Primary Examiner allowing claims upon an affidavit under Rule 75, as this is a favorable decision.

*Byron v. Maxwell*, 105 O. G. 499.

Decision that a claim is a good combination and is not anticipated is not appealable.

*Wickers & Furlong v. Weinwurm*, 117 O. G. 1797.

Where a party requests an interference, and the Examiner rules that he is not entitled to make the interfering claim. Held that the matter will not be reviewed on interlocutory petition or appeal.

*Hanson*, 117 O. G. 2632.

Question of new matter is not one of regularity but one of right to make the claim, from which no appeal lies.

*Brooker v. Smith*, 119 O. G. 652.

Matters urged as irregularities, but which relate to right to make the claim, will not be heard on appeal.

*Pryor v. Ball v. Brand*, 119 O. G. 653.

There is no appeal from an affirmative decision upon the right of a party to make a claim, and equivalent consideration is not to be obtained by presenting the contention in different form and under a different name. As, for instance, whether the counts mean the same in reference to both applications.

*Weintraub v. Hewitt*, 124 O. G. 2534.

The contention that the opposing parties do not have a construction responding to a certain language in the issue is one relating to the right to make the claim and not to interference in fact—No appeal.

*Carnell v. Glasgow v. Cook*, 120 O. G. 901.

There is no appeal from the decision of the Primary Examiner affirming the opponent's right to make the claims or the identity of meaning of the claims in their respective applications.

*Daggett v. Kaufmann*, 127 O. G. 3641.

A petition to review a decision affirming patentability, or the right to make the claim, and identity of meaning of counts, in the exercise of supervisory authority, will be considered only in extraordinary cases.

*Lipschutz v. Floyd*, 130 O. G. 2718.

(4) *Affirming Patentability.*

The Examiners-in-Chief having allowed a claim corresponding to count five to Strouble, there is consequently no appeal from that decision.

Coleman v. Bullard v. Strouble, 114 O. G. 973.

The part of this rule denying an appeal in certain cases applies to appeals from the Examiners-in-Chief.

Langslow v. Malocasy, 155 O. G. 1043.

No appeal lies from the decisions of the Examiner-of-Trade-Marks adjudging that a party is entitled to the registration of a trade-mark.

Sibley Soap Co. v. Lambert Pharmacal Co., 103 O. G. 2172.

It would be only in a very clear case that the Examiner's decisions affirming patentability would be reviewed on appeal.

Rinsche v. Sandherr, 105 O. G. 1780.

There is no appeal from a decision of the Examiner holding that the issue is patentable when construed broadly enough.

Bachman v. Southgate, 111 O. G. 805.

An appeal does not lie from a decision affirming patentability.

White v. Thomson, 101 O. G. 2825.

No appeal lies from the refusal of the Examiners-in-Chief to call attention to the question of patentability under Rule 126. So long as this rule stands it must be enforced, and it has been approved by the different Commissioners.

Benet & Mercie v. McClean, 97 O. G. 1595.

The law makes no provision for an appeal from the favorable decision of the Examiners-in-Chief affirming patentability.

Barney v. Kellogg, 17 O. G. 1096.

Last clause affirmed.

Faure v. Bradley v. Crocker v. Cowles & Cowles, 40 O. G. 243.

The supervisory authority of the Commissioner will be exercised to review a favorable decision on patentability only in very exceptional cases.

Read v. Scott, 101 O. G. 449.

When the Examiner has decided in favor of the patentability of claims, it would seem that the right of the opposing party to raise this issue was at an end.

Sobey v. Holsclaw, 119 O. G. 1922.

The validity of this rule, as to denying an appeal in deci-



sions affirming patentability of a claim, affirmed by the Supreme Court of the United States, two justices dissenting.  
U. S. ex rel. Lowry v. Allen, Com., 125 O. G. 2365.

(5) *Amendments.*

The fact that there has been a "final rejection" in the course of the interference should not be taken to mean, as the applicant seems to fear it may, that further amendments will not be permitted except as an act of grace or leniency.

Sanders v. Hawthorne v. Hoyt, 125 O. G. 1347.

This rule does not authorize amendment of the claims during the interference.

Sanders v. Hawthorne v. Hoyt, 125 O. G. 1347.

(6) *Rehearings.*

There is no appeal from a decision refusing a rehearing.

Carmichael v. Fox, 104 O. G. 1656; Bryon v. Henry, 104 O. G. 1895; Reynolds v. Bean, 101 O. G. 2821; Roemer v. Neumann, 49 O. G. 1535; Cole v. Zarbock v. Greene, 116 O. G. 1451.

The question of *res adjudicata* may be raised at any time, and may be raised by any tribunal of its own motion.

Carroll v. Hallwood, 135 O. G. 896.

If the claims could have been raised under the first trial they cannot be reheard.

Carroll v. Hallwood, 135 O. G. 896.

The court of appeals held that where in an interference it was held that neither party had a right to make the claim and the time for appeal had expired, that the matter was *res adjudicata* and could not be presented by one of the applicants prosecuting his application *ex parte*.

Herbst, 141 O. G. 287.

(7) *Assignment of Error.*

A question involving the right of an applicant to make the claim in interference will not be passed upon by the Commissioner on appeal from the decision of the Primary Examiner upon a motion to dissolve the interference.

Sweeney v. Jarvos, 1892 C. D. 97; Pryor v. Ball v. Brand, 119 O. G. 653; Weintraub v. Hewitt, 124 O. G. 2534.

Example of assignment of reasons.

Carroll v. Hallwood, 135 O. G. 896; Phillips v. Lensenich, 134 O. G. 1806.

We think the question of *res adjudicator* was preserved in

the assignment of error which assails the decision of the Examiner of Interferences in awarding priority on the whole case.

Carroll v. Hallwood, 135 O. G. 896.

On an appeal on priority the court will not review the finding of the Commissioner upon the sufficiency of a showing to support a petition for the reinstatement of an abandoned application where there appears to have been no abuse of power on the part of the Commissioner.

Kinsman v. Strohim, 136 O. G. 1769.

Where no irregularity in declaring the interference independent of the allegation of non-interference in fact was presented, held that the appeal as to the ground of irregularity in declaration would be dismissed.

Walker v. Brunhoff, 118 O. G. 2537; Blackmore v. Hall, 118 O. G. 2538.

Where the Examiner dissolves the interference because the issue is not patentable, Held, that an appeal relating to interference in fact involves a moot question, and will not be determined.

Newell v. Hubbard, 115 O. G. 1847.

There is no appeal from the Examiner's action holding that the counts are patentable, and therefore the sole question to be determined is whether the counts in question are the same when applied to the structure of both parties.

Anderson v. Vrooman, 123 O. G. 2975.

Questions cannot be raised on appeal which have not been raised by the motion and passed on below.

Larkin Company v. Pacific Coast Borax Co., 132 O. G. 679.

Where it has been decided that one of the parties to the interference has no right to make the claims, the question of interference in fact is a moot question and will not be considered on appeal.

Selden v. Gerts & Palmer, 105 O. G. 1531.

Right to make claims and patentability will not be reviewed upon appeals on non-interference in fact, and irregularity in declaration.

Thullen v. Young & Townsend, 118 O. G. 2251.

On appeal on question on priority, patentability will not be considered.

Fairbanks & Sauer v. Karr, 119 O. G. 651.

Where on an appeal to the Commissioner on the question of interference in fact it appears from the opinion of the Primary Examiner and the brief of the appellant that the

real question is one relating to the right to make the claims, the appeal will be dismissed.

Schofield v. McGovern v. Woods, 119 O. G. 1924.

Contentions which go to the right of a party to make claims can afford no proper basis for dissolution upon the ground of non-interference in fact. Appeal dismissed.

Blackmore v. Hall, 119 O. G. 2523; Blackmore v. Hall, 120 O. G. 1477.

The decision of Primary Examiner affirming patentability will not be reviewed in an appeal relating to other grounds permitted by Rule 122.

Wilkinson v. Junggren, 112 O. G. 252.

This appeal while nominally on appealable grounds is really for the purpose of getting a review of the Examiner's decision affirming patentability and applicant's right to make the claims. It is therefore dismissed.

Forsyth v. Emery, 113 O. G. 2215.

An affirmative decision upon the right of the appellee to make the claim is not appealable and will not be considered in an appeal on other grounds.

Kinney v. Goodhue, 123 O. G. 1663.

A new appeal fee must be paid on the appeal denying the patentability of a claim in an *inter partes* matter notwithstanding an appeal has been once taken on that point on an *ex parte* matter.

Cheney v. Venn, 125 O. G. 1703.

Applicant's claims were involved in two interferences. A motion has been made in each on the ground of lack of patentability, which was granted. Held that one appeal fee was sufficient.

Miller v. Mann v. Bacon v. Torrance, 115 O. G. 1063.

Where an interference is dissolved by the Primary Examiner on motion, appeal cannot be taken by the party bringing such motion, though granted on a part only of the grounds urged therein.

Zeitinger v. Reynolds v. McIntire, 1891 C. D. 212; Ries v. Thomson, 1891 C. D. 233.

No valid reason appears to exist for making an exception where the motion is appealable to the Examiners-in-Chief and in allowing only one party to the contested proceedings to appear and be heard.

Duncan v. Westinghouse, Jr., 66 O. G. 1005.

When both parties move to dissolve the interference upon all grounds permitted by the rules and the motions are granted, held that an appeal will not be entertained since

a party cannot appeal from a decision in his favor merely because he disagrees as to the reason.

Scott v. Badeau, 116 O. G. 2007.

Favorable decision not appealable.

Potter v. McIntosh, 116 O. G. 1451.

Where a review is requested by G. of Examiner's rulings upon the meaning of claims in his decision granting G.'s motion for dissolution, held that G. was not entitled to such review: his motion for dissolution as to counts embodying the substance of these claims having been granted.

Votey v. Gally, 119 O. G. 339.

Where a party made no motion for dissolution he cannot appeal from the refusal of a motion made by another party.

Townsend v. Copeland v. Robinson, 119 O. G. 2523.

The supervisory authority will not be exercised to review a favorable decision on the question of patentability except in a very clear case.

Eschinger v. Drummond & Lieberknecht, 121 O. G. 1348.

There is no reason, as was pointed out in Miller v. Perham, 121 O. G. 2627, why the Office, having once decided that a party is entitled to make certain claims should reconsider the question on the party's own motion.

Goodwin v. Smith, 123 O. G. 998.

It is the substance of the decision which determines whether it is appealable to the Commissioner and not the reason given by the Examiner.

Von Welsbach v. Lungren, 48 O. G. 537. Cited, 85 O. G. 1738.

Only one injured may appeal.

Judd v. Campbell, 110 O. G. 2017.

No appeal from favorable decision.

Cazin v. Von Welsbach, 119 O. G. 650.

Last clause. A petition will not be entertained except in a clear case, to review a favorable decision.

Denton et al. v. Riker, 98 O. G. 415.

Non-appeal lies from a refusal to declare an interference with an existing patent accompanied by an allowance of applicant's claims under the last clause.

Gibboney, 105 O. G. 976.

When ample opportunity to introduce a prior application is given, and the matter will be reviewed on appeal, a case will not be reopened because of difference of interpretation given by the Primary Examiner and the Examiner of Interferences.

Dixon v. Bliss, 185 O. G. 1381.

(8) *Decision of the Commissioner.*

The judgment of the Examiner will not be controlled by an order made in advance.

Marks v. Greñawall, 118 O. G. 1967.

An appellant will not be heard to argue that an interference should be dissolved, upon the ground under Rule 122, not argued before the Examiner.

Pfingst v. Anderson, 118 O. G. 1067.

Last clause. This clause may not be avoided by considering the standing of the application as evidence.

Shupphaus v. Stevens, 95 O. G. 1452.

The Commissioners may, upon appeal upon points not involving the question, declare that there is no conflict in fact.

Schupphaus v. Stevens, 95 O. G. 1454.

Does not prevent the Commissioner from considering any reason for dissolving an interference which may be brought to his attention or which he may discover. A petition will not be entertained when it seeks to obtain indirectly a review of an Examiner's decision from which no appeal lies, by merely misnaming the proceedings.

Goss v. Scott, 96 O. G. 844.

Decision of Primary Examiner. When a motion to dissolve is brought upon the grounds specified in Rule 122 the Examiner should decide the motion upon all grounds, and if the decision is of such a nature that appeal therefrom may be taken he should fix a limit of appeal.

Duryea & White v. Rice, 115 O. G. 803.

If appealable grounds are presented an appeal may not be refused by an Examiner because he chooses to decide the motion upon unappealable grounds.

Silverman v. Hendrickson, 88 O. G. 1703.

(9) *Time when Taken—Excuse for Delay—Petition to Extend Time.*

An appeal from a decision on a motion will not be entertained and considered *nunc pro tunc* after the limit of appeal has expired, because of a showing that it was the intention to appeal and the failure was due to a misunderstanding between attorneys.

Gerdon v. Ehrhardt, 116 O. G. 595.

No limit of appeal was set by the Examiner of Interferences, which should have put appellant upon notice that the Examiner did not regard the question decided as an appealable one; under such circumstances appeal should be taken promptly, if at all, in order that opposing parties may not

proceed under a misapprehension as to the condition of the case.

Geo. Wostenholm & Son, Limited, v. Crowley, 135 O. G. 1121.

Negligence or oversight of attorneys not sufficient excuse for not taking appeal within the time limited.

Brissenden v. Roesch, 118 O. G. 2253.

An appeal filed after the expiration, the limit of appeal will be entertained only in very unusual and extraordinary cases.

Briggs v. Conley, 104 O. G. 1119; Blackman v. Alexander, 105 O. G. 2059; Kiltzker and Goesel v. Donan, 109 O. G. 1336; Greuler v. Mathew, 112 O. G. 253; Gerdon v. Ehrhardt, 116 O. G. 595; Brisender v. Roesch, 118 O. G. 2253; Townsend v. Ehret, 125 O. G. 2051; Wenzelmann and Overholt, 123 O. G. 995; McKeen v. Jerdone, 134 O. G. 2027.

It is thought the Commissioner has authority to permit an appeal after the limit.

McKeen v. Jerdone, 134 O. G. 2027.

Since the defeated party failed to take his appeal within the limit set, he is not now entitled to have that decision reviewed by another tribunal.

Briggs v. Conley, 104 O. G. 1119.

A limit of appeal should be set in decisions denying a right to make a claim.

Judd v. Campbell, 110 O. G. 2016.

Where in an interference it is decided that one of the parties has no right to make the claim, it seems clear that it is not just to the other party to withhold indefinitely his application, which is ready to issue, merely to await the pleasure of the other party. A limit of appeal should be set.

Hutin v. LeBlanc v. Steinmetz v. Scott v. Fairfax, 97 O. G. 2744.

The exercise of discretion in refusing to longer continue the case in order to give appellant further time to file his preliminary statement is not subject to review by us, unless it clearly appears from the record that the rights of appellant have been prejudiced by an unwarranted departure from the law or rules of procedure regulating proceedings of this kind in the Patent Office.

Hallowell v. Darling, D. C. App.; Churchill v. Goodwin, 141 O. G. 569.

No appeal from a decision of the Examiner extending time for taking testimony. It can only be modified by the exercise

of the supervisory authority of the Commissioner, and this only in unusual cases.

*Wickers & Furlong v. Weinwurm*, 129 O. G. 2501; *The Shaw and Willy Shirt Co. v. The Quaker City Shirt Mfg.*, 157 O. G. 1000. See, however, *Kinsman v. Strohm*, 125 O. G. 1699.

The bringing of motions or the taking of petitions to the Commissioner will not stay the running of the limit of appeal from a decision on priority.

*Pym v. Hadaway*, 131 O. G. 692.

(10) *To the Board or to the Commissioner.*

Appeal denying motion to dissolve for non-interference in fact is to the Commissioner and not to the Board.

*Zeidler v. Leech*, 1891 C. D. 9.

A motion of one party to amend his application by inserting two claims taken from his opponent's application, not appealable directly to the Commissioner.

*Berry v. Fitzsimmons*, 99 O. G. 863.

Interference in fact appealable to Commissioner in person.

*Oldham & Padbury v. Peck v. Clement v. Richards*, 99 O. G. 670.

Appeal, from decision dissolving interference because there is no right to make the claims, appealable to Examiners-in-Chief.

*Story v. Criswell*, 100 O. G. 683.

An appeal from an action holding that there is no such combination does not lie to the Commissioner.

*Webber*, 98 O. G. 2362.

(11) *Decisions of the Board.*

If the Examiners-in-Chief are equally divided, the Primary Examiner is affirmed, and upon questions of patentability there is no appeal.

*Porter v. McIntosh*, 120 O. G. 1823.

The only question that can be presented to the Board, under the statute, on an appeal in an interference case upon the merits, is priority of invention. The Board has no right to make the question of whether there is an interfering matter in the device a part of their decision.

*Brown v. La Dow*, 18 O. G. 1049.

No appeal from favorable decision of the Board on questions of right to make the claim.

*Joselyn v. Hulse*, 132 O. G. 844; *Coleman v. Bullard v. Struble*, 114 O. G. 973.

(12) *Miscellaneous.*

Cases that pass on the subject matter of this rule.

Mill v. Midgley, 136 O. G. 1534; Harnisch v. Gueniffet, Benoit and Nicault, 128 O. G. 455; Bechman v. Southgate, 123 O. G. 2309.

Last clause.

In re Locke, 94 O. G. 432; Myers v. Sarfert, 96 O. G. 1037; Reece v. Fenwick, 97 O. G. 188; Hinkley v. Barker, 97 O. G. 2742; Sharer v. McHenry, 91 O. G. 1034; Wheeler v. Seeberger, 125 O. G. 2363; Hopfelt v. Read, 106 O. G. 767; Myers v. Brown, 112 O. G. 2093-4; Schubert v. Munro, 113 O. G. 284-3; Gully v. Brand, 113 O. G. 852; Harnisch v. Gueniffet, Benoit & Nicault, 117 O. G. 1492-3; Allen, Commissioner, v. U. S. ex rel. Lowry et al., 116 O. G. 2254-3; Neth v. Tamplin v. Ohmer, 120 O. G. 323; Brewer, Tily, Reh-fuss & Reh-fuss v. Dement, 116 O. G. 2010; Duryea & White v. Rice, 123 O. G. 2627; Locke v. Baldwin, 124 O. G. 317; Harnisch v. Gueniffet, Benoit & Nicault, 128 O. G. 355.

**Rule 125. Determination.**

After an interference is finally declared it will not, except as herein otherwise provided, be determined without judgment of priority founded either upon the evidence, or upon a written concession of priority, or upon a written disclaimer of the invention, or upon a written declaration of abandonment of the invention, signed by the inventor himself (and by the assignee, if any).

*CONSTRUCTIONS.*

Both applications owned by the same party—one applicant could not be found.

Schreiber v. Bauer, 258 O. G. 813.

Both parties moved to dissolve because of non-patentability. They might simultaneously file abandonment.

Krakaw v. Harding, 107 O. G. 1662; Tomlinson v. Riely, 183 O. G. 784.

A declaration of abandonment should not give reason there-



fore. But one containing such reasons should not be stricken from the files.

Carrington v. Turner, 136 O. G. 1067; Clutcault v. The New York Herald Company, 136 O. G. 437.

Copy of a record under this rule.

Carroll v. Hallwood, 135 O. G. 896-7.

The inventor of his representative must sign the concession of priority even when the entire interest has been assigned.

Alt. v. Carpenter, 132 O. G. 1587.

Where applicant moves for dissolution upon ground of non-patentability and his opponent is involved upon a regularly issued patent and the motion is brought after the expiration of the time for taking testimony and no testimony has been taken, held that the practice announced in Lipe v. Miller, 109 O. G. 1068, should not be followed and that the case should proceed to judgment.

Smith v. Slocum, 123 O. G. 1990.

An unequivocal, unconditional, unlimited declaration of abandonment of the invention which forms the subject-matter of the issue of the present interference is the only abandonment which can be filed under this rule.

Gabrielson v. Felbel, 121 O. G. 691.

The declaration must be unequivocal and absolute.

Gabrielson v. Felbel, 1906 C. D. 108, 121 O. G. 691.

If during an interference a patentee applies for and obtains a reissue omitting the interfering claims, a motion for dissolution should be made and allowed.

Lattig & Goodrum v. Dean, 117 O. G. 1798.

One can not be adjudged the prior inventor upon the contention that his opponent's application does not disclose the issue. The contention, if sound, warrants dissolution, not judgment.

Jenner v. Dickinson v. Thibodeau, 116 O. G. 1181.

If one of the parties applies for a reissue omitting claims involved, this is to be regarded as a written concession of priority and judgment under this rule rendered accordingly.

Lattig & Goodrum v. Dean, 115 O. G. 505.

When an interference has been decided upon its merits, the judgment will not be set aside on a concession of priority by the successful party.

Humphrey v. Fickert, 112 O. G. 2094.

A judgment rendered upon a technicality reversed upon a concession of priority by the successful party.

Couper & Somers v. Bannister, 112 O. G. 1480.

The signature of the inventor is necessary to abandonment.  
Skinner v. Murray, 107 O. G. 542.

The rules nowhere provide for a determination of an interference after it has been once declared on a mere cancellation of the claims.

Read v. Scott, 100 O. G. 449, 1902 C. D. 242.

A former decision should be rendered by the Primary Examiner. The practice should follow that under Rule 122.

Macey v. Tobey v. Laning, 97 O. G. 1172-3, 1901 C. D. 168.

Rule may not be evaded by means of a protest.

Schweitzer, 97 O. G. 1171, 1901 C. D. 179.

Where the structure of one of the parties to an interference is inoperative, priority of invention can not be awarded to him.

Glidden v. Noble, 67 O. G. 676, 1894 C. D. 51.

Cancellation of the claims is not sufficient.

Curtis v. Marsh, 92 O. G. 1236, 1900 C. D. 127.

The withdrawal of one of the applications does not end the interference.

Adler v. Van Wagener, 1875 C. D. 123; to the contrary, see Eames & Selley v. McDougall, 1871 C. D. 206.

If public use for more than two years is shown by preliminary statement the interference should be dissolved.

Schenck v. Rider, 1870 C. D. 135.

This rule was part of the rules of practice in 1871. See Rule 59 quoted in

Eames & Seeley v. McDougall, 1871 C. D. 206.

## **Rule 126. Statutory Bar Suggested.**

The examiner of interferences or the examiners in chief may, either before or in their decision on the question of priority, direct the attention of the Commissioner to any matter not relating to priority which may have come to their notice, and which, in their opinion, establishes the fact that no interference exists, or that there has been irregularity in declaring the same (Rule 122), or which amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference. The Commissioner may suspend the interference and remand

the case to the primary examiner for his consideration of the matters to which attention has been directed. From the decision of the examiner appeal may be taken as in other cases. If the case shall not be so remanded, the primary examiner will, after judgment, consider any matter affecting the rights of either party to a patent which may have been called to his attention, unless the same shall have been previously disposed of by the Commissioner.

#### *HISTORY.*

Rule 120 of 1879 reads: "In their decision of the question of priority, or before such decision, the examiner of interferences and the examiners-in-chief will direct the attention of the commissioner to any fact not relating to priority which may have been brought to their notice (by motion or otherwise), and which in their opinion amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference.

The commissioner may, before judgment on the question of priority of invention, suspend the interference, and remand the case to the primary examiner for the consideration of the statutory bar so suggested, subject to appeal to the examiners-in-chief, as in other cases. If the case shall not be so remanded, the primary examiner will, after judgment, consider and determine the same, unless it shall have been previously disposed of by the commissioner."

Rule 59 of 1878 reads in part as follows: "In their decision of the question of priority, or before such decision, the examiner of interferences, or the examiners-in-chief, as the case may be, will direct the attention of the commissioner to any fact not relating to priority which may have come to their attention (by motion or otherwise), and which, in their opinion, amounts to a statutory bar to the grant of a patent to either or both parties. After final judgment the primary examiner will consider and determine any such matter not previously disposed of by the commissioner."

I find no provision in the Rules of September 1, 1873.

#### *CONSTRUCTIONS.*

A petition for public use proceedings to prove the use of anticipating machinery as much as twelve years and more ago. Held, insufficient where it was unaccompanied by a

print, photograph or like evidence as to the alleged anticipating structure.

Dwiggins, 229 O. G. 1573.

If no motion to dissolve under Rule 122 has been made action under this rule should be taken only when the case is perfectly clear.

White v. Wege, 227 O. G. 1107.

Question of statutory bar not in issue in interference proceedings.

Johnson v. Martin, 201 O. G. 267.

There is nothing in the showing to indicate that the alleged use was public rather than private, or that the alleged use in public was more than an abandoned experiment.

Price v. Adamson, 197 O. G. 1291.

An applicant in interference with patentee can not get an adjudication of the question of the patentability of the counts under this rule.

Pattersen v. Weher, 192 O. G. 215.

The petition should be served upon the opposing party and an offer to produce the witnesses and to bear the expense of investigation.

Duellen v. Claussen & Claus, 190 O. G. 265; Seebert v. Bloenberg, 124 O. G. 628.

Proceeding outlined in a public use proceeding.

Betts v. Gerson, 189 O. G. 524.

Public use proceedings can not determine the issue of priority.

Wenzelmann and Cloverholt, 180 O. G. 1394; Kennedy v. McLain, 158 O. G. 547.

Rule 130 provided that a party may urge that his opponent has no right to make the claims of the issue at final hearing, provided he has prosecuted a motion under Rule 122 for dissolution upon this ground. While it is not the practice where the junior party is under an order to show cause for the Examiner of Interferences of his own motion to set a case down for hearing under Rule 130, it is the practice to grant such a hearing where a motion or request, therefore, is made before, or within a reasonable time after the entry of judgment on the record.

Noble v. Levin, 180 O. G. 602.

Testimony being proposed in a proper showing.

This rule not applicable where the party is not entitled to make claim. See note to Rule 130.

McBerty v. Shore and Shore, 175 O. G. 843.

The question of public use is considered a question separate

from that of priority of invention raised in an interference proceeding and to require a separate investigation. It is not the practice to suspend an interference proceeding when at the present stage, in order to investigate public use, especially where the bar, if established, would apply only to the application of one party.

Perrault v. Pierce, 98 O. G. 793, 108 O. G. 2146, 131 O. G. 942; Kneisly v. Kaisling, 174 O. G. 830.

Public use proceedings are instituted only upon formal petition, accompanied by proof of service upon the applicant together with an offer to produce the witnesses and to bear the expenses of the investigation.

Kneisly v. Kaisling, 124 O. G. 628, 174 O. G. 830.

A petition for public use proceedings postponed to await the outcome of a motion to dissolve.

Snyder v. Woodward, 173 O. G. 863.

Will not suspend action in an interference proceeding where testimony has been taken and the case is ready for final hearing in order to institute public use proceedings. (Deoble v. Henry, 118 O. G. 2249; West v. Borst and Grosch, 122 O. G. 2062.)

Brenizer v. Robinson, 166 O. G. 1281.

The motion is informal, since the Commissioner and not the Primary Examiner is the official who determines whether a public use proceeding should be instituted. (Hartley, 136 O. G. 1767; Rolfe, 155 O. G. 799.)

Benizer v. Robinson, 166 O. G. 1281.

Some counts two and five are held to be unpatentable, the question of whether the Curtis structure covered thereby is operative or is a moot question which it would serve no useful purpose to determine in the interference proceeding. (100 O. G. 683, 105 O. G. 1531, 111 O. G. 2492, 115 O. G. 1847.)

Inasmuch as the interference now stands dissolved, the question of what claims Curtis may be entitled to is one for ex parte consideration.

Curtis v. Kleinert, 160 O. G. 1038; Yarnell v. Pope, 115 O. G. 2136.

The right of his adversary to make the claim at issue has been uniformly held to be ancillary to the question of priority of invention. This is also true where it is urged by a moving party that his opponent has no right to make the claim for the reason that the device shown in the application is inoperative. In the latter case the moving party has upon presentation of a sufficient showing been permitted the

right to take testimony to show that his opponent's device is inoperative.

Barney v. Hess, 158 O. G. 702.

Patentability was denied claims of an applicant that had inadvertently been patented to another. The Court of Appeals says, "In view of the inadvertence of the Patent Office in granting a patent which is now beyond the control of the Office it would probably have been more equitable practice to have assumed patentability for the purpose of determining the question of priority.

Orcutt, Etc., 141 O. G. 567.

Ordinarily the protestant is ignorant to a greater or less extent of the contents of applicant's case, and the Office is not warranted in giving the protestant information of the application or in offering him an opportunity to gain such information. The privilege of filing a brief gives the protestant all the privileges to which he is entitled.

Henry, Jr., 140 O. G. 508.

In public use proceedings it is customary merely to set a time within which the parties, the protestant as well as the applicant, may file briefs, with the Primary Examiner.

In re Henry, Jr., 140 O. G. 508.

A motion to require joint applicants to show by testimony that they are in fact joint inventors of the invention in issue, refused.

Pickard v. Ashton v. Curtis, 137 O. G. 732.

Public use proceedings are ex parte in their nature, the sole question being whether the applicant is barred from obtaining a patent on the invention claimed by reason of the public use or sale of devices embodying the invention claimed.

Hartley, 136 O. G. 1767.

The affidavits presented by the protestant were deemed sufficient to lay the foundation for the introduction of testimony, but they are not themselves testimony.

Hartley, 136 O. G. 1767.

While it is the practice to permit one of the general public to file a protest and to take testimony in behalf of the Patent Office upon this question, such party has no right in the controversy other than those authorized by the Commissioner.

Hartley, 136 O. G. 1767.

A motion to take testimony as to inoperativeness of opponent's apparatus, brought in the regular course of the proceedings, affords petitioner an adequate remedy without the necessity of invoking the supervisory authority of the

Commissioner, and should be determined in the first instance by the Examiner of Interferences.

Lowry & Cowley v. Spoon, 122 O. G. 2687; Barber v. Wood, 132 O. G. 1588.

The question whether one of the parties to an interference proceeding is debarred from receiving a patent by reason of his having secured a foreign patent for the same invention is a question for *ex parte* consideration after the termination of the interference.

Gueniffet, Benoit and Nicault v. Wictorsohn, 134 O. G. 255.

A petition that a rule be issued against an opposing party to show cause why it should not be held that he has abandoned his invention, and that petitioner be permitted to offer testimony upon such question, will not be entertained under the Commissioner's supervisory authority where the petitioner has other remedies and is in fact pursuing another remedy before the Examiner of Interferences.

(Cases cited) Barber v. Wood, 132 O. G. 1588.

Public use is considered in the practice of this Office as a separate question, requiring an investigation independent of the question of priority of invention involved in an interfering proceeding (96 O. G. 2409, 104 O. G. 577). No testimony has been taken and there is nothing in the case upon which the Primary Examiner at the present time can intelligently consider the bar of public use. No error is found in the refusal to transmit on this ground.

Barber v. Wood, 129 O. G. 2835.

It is thought that the commissioner should remand the case and not decide it himself.

Serrel v. Donnelly, 129 O. G. 2501.

A protest on the ground of public use was once dismissed because unaccompanied by an offer to produce witnesses and bear expenses. It is now dismissed because affidavit set up conclusions instead of facts. Applicant should present this case as well as may be done by affidavits so as to give the opponent an opportunity to intelligently oppose the institution of the proceeding and the consequent delay.

Booth, 128 O. G. 1291; Wickers & Furlong v. McKee, 129 O. G. 1269.

A protest on the ground of public use was once dismissed because unaccompanied by an offer to produce witnesses and bear expenses. It is now dismissed because affidavits set up conclusions instead of facts. Applicant should present his case as well as can be done by affidavits so as to give the

opponent an opportunity to intelligently oppose the institution of the proceedings and the consequent delay.

Booth, 128 O. G. 1291.

An appeal should be allowed where permission to take the testimony is refused.

Pym v. Hadury, 128 O. G. 457.

It is designed by the practice instituted in this case to avoid these complications, in those cases where the recommendations of the examiners-in-chief covers matters considered and passed upon by the Primary Examiner in an *inter partes* decision, by substituting at the outset the entry of a rejection *Pro Forma* by the Primary Examiner putting the case at once in a condition for a course of appeals which may be carried to the Court of Appeals.

Holz v. Hewitt, 127 O. G. 1992. (See Bunnell, 103 O. G. 1993.)

Petitioner has not made such a showing as would warrant institution of public use proceedings. (Siebert v. Bloomberg, 124 O. G. 628.)

Barber v. Wood, 127 O. G. 1991.

The affidavits fail to make out a *prima facie* case of public use of the invention more than two years prior to Siebert's filing date. They state the conclusions of the witnesses largely to the exclusion of the facts upon which such conclusions are based. Where facts are given they are not recited with sufficient particularity and certainty. A portion of the showing is also objectionable as hearsay. The Office should not institute a proceeding that may uselessly consume the time and labor of all parties upon such a showing.

Siebert & Bloomberg, 124 O. G. 628.

Thought that it would be an improvement if the Examiner of Interferences in these cases would make his opinion the bases of a judgment of priority of invention instead of calling attention to the supposed facts under Rule 126.

Brown v. Hodgkinson, 123 O. G. 2973. Cites Podlesak & Podlesak v. McInnerney, 120 O. G. 2127; Allen, Commissioner of Pats., v. The U. S. of America ex rel. George A. Lowry & Factors Compress Co., 116 O. G. 2253.

The proper practice when a case is referred to the Primary Examiner upon suggestions by the Examiners-in-Chief of lack of right of a party to make claims, and the Primary Examiner disagrees with the conclusions of the Examiners-in-Chief, is to refer the case to the Commissioner for decision.

Duryea & White v. Rice, 123 O. G. 2627.



I see no reason why I should act to control the discretion of the Examiner of Interferences calling attention to matter under Rule 126 or refusing to call attention under that rule:

Wert v. Borst & Groscop, 122 O. G. 2062; Munro v. Walker, 122 O. G. 2062; Andrews v. Nilson, 123 O. G. 1667.

A consideration of the affidavit and testimony referred to by the protestant makes it seem probable that such bar does exist. It is not necessary to analyze that testimony to determine whether it is technically sufficient if true to prove public use.

Ashton, 122 O. G. 730; Duryea & White v. Rice, Jr., 122 O. G. 1395.

Examiners thought one party had not disclosed the invention.

The interference remanded to the Primary Examiner, to hear the parties and furnish his opinion as to the question raised, together with a statement of the reasons for his conclusions. The examiner's opinion placed in the interference file, copies sent to the parties and the case returned to the Commissioner for decision upon the appeal.

Kilbourn v. Hirner, 122 O. G. 729.

Where all the evidence is before the Office upon which to base a final determination upon priority, such final determination should in general be reached before consideration of *ex parte* rights is undertaken.

Dunbar v. Schellenger, 121 O. G. 687.

An interference will not be suspended for the purpose of considering the question of estoppel against one party where dissolution of the interference would apparently leave the way clear to the allowance of a patent to another party who may not be the first inventor.

Dunbar v. Schellenger, 121 O. G. 687.

This rule does not provide for the filing of motions (as for the return of the case to the Primary Examiner to determine a question of Statutory Bar). Motion entitled under it dismissed.

Struble v. Young, 121 O. G. 340.

A suggestion by the Examiners-in-Chief referred to the Primary Examiner who agreed. There is no conflict of opinion, because the Examiner previously thought differently, to warrant a review by the Commissioner.

Snider v. Bunnell, 121 O. G. 338.

The parties are therefore notified that the testimony already taken will be used as a *prima facie* case in support of

the allegation of public use, and that if any one of them wishes to take testimony in explanation or rebuttal he must so notify the Office within 20 days.

Niedringhaus v. Marquard v. McConnell, 121 O. G. 337.

It is thought that the Commissioner should remand the case and not decide it himself.

Serrell v. Donnelly, 120 O. G. 2501.

Reference under Rule 126 consideration of merits of an application not postponed on account of possible erroneous decision on priority.

Newell v. Clifford v. Rose, 119 O. G. 1583; Sobey v. Holsclaw, 119 O. G. 1922.

The Examiner referred the case to the Commissioner because he thought the first count patentable to C. in the interference, N. v. C. v. R., and not patentable to N. or R: *Held*, that the two interferences should proceed.

Newell v. Rose, 119 O. G. 337.

The question of patentability and interference in fact were presented for consideration on motion but not pressed, and that they were argued before the Examiner of Interferences and the Examiners-in-Chief on final hearing and these tribunals asked to make a recommendation under Rule 126 and such recommendation was refused, these facts do not warrant a review by the Commissioner.

Bell v. Flora, 117 O. G. 2362.

If Carver is of the opinion that there is no invention in fact, he is not without remedy. The provisions of Rule 126 are available when this case comes on for final hearing.

Carver v. McCanna, 117 O. G. 599; In re Mill, 117 O. G. 904.

If an applicant in contest with a patentee admits a statutory bar to himself the interference should be dissolved.

Griffith v. Dodgson, 116 O. G. 1731.

A case transmitted to consider patentability where one party was a patentee. The Office will not waste time deciding a moot question simply to avoid casting cloud upon a patent.

Yarnell v. Pope, 115 O. G. 2136.

Public use suggested by assignee of entire interest sufficient to warrant action by the Office.

Cummings, 114 O. G. 2090.

In the matter of trade-marks.

Frank & Gutmann v. Macwilliam, 114 O. G. 542.

Public use alleged against some of the counts, but not all.

Held that the question of public use if necessarily raised at all should be after the conclusion of the interference.

Moss v. Blaisdell, 113 O. G. 1703.

Originally there were two counts in the interference, but under the procedure set forth in Rule 126 one of these has been eliminated.

Spaulding v. Norden, 112 O. G. 2091.

If an alleged anticipating patent is discovered too late for a motion under Rule 122, it may still be called to the attention of the Commissioner under this rule.

Schrimer v. Lindemann & Stock, 111 O. G. 2222.

It is held, therefore, that when the question upon which the Examiner and the Examiner of Interferences differ relates to the patentability of the claims or the right of one of the parties to make the claims, and thereby involves the merits of the invention, the interference should be referred to the Examiners-in-Chief; but when the difference of opinion is merely upon formal matters, such as interference in fact or irregularity in declaring the interference, the case should be referred to the Commissioner for final determination.

Weber v. Hall, 111 O. G. 809.

A mechanical application can not affect the burden of proof in interference between designs.

McArthur v. Gilbert, 110 O. G. 2509.

The question of public use may be determined *inter partes*.

Mills v. Torrence, 110 O. G. 857; Judd v. Campbell, 110 O. G. 2017.

Successful applicant did not think the invention patentable to him. Interference dissolved.

Lipe v. Miller, 109 O. G. 1608.

In an interference between an applicant and a patentee if the Examiner of Interferences is of the opinion that the applicant is not entitled to make the claims, the case should be transmitted to the Primary Examiner for immediate determination.

Hall v. Weber, 109 O. G. 1607.

The rule provides sufficiently for the consideration by the Office on its own motion of matters which might have been made the basis of the motion mentioned in Rule 122, but which were not so presented; and the action of the Examiner refusing to transmit will not be disturbed except in a clear case.

Sturgis v. Hopewell, 109 O. G. 1008.

It is contrary to usual practice to suspend an interference

between two applicants to investigate the question of public use.

Perrault v. Pierce, 108 O. G. 2146.

Where public use is shown by testimony regularly taken, its effect can not be overcome by *ex parte* affidavits, but only by evidence regularly taken.

Tournier, 108 O. G. 798.

The question of patentability is *ex parte* in character, and if it becomes necessary to take testimony upon that question the Office will investigate in a proceeding independent of the interference.

Steinmetz v. Hewitt, 107 O. G. 1972.

If both parties file an abandonment of the invention the Examiner of Interferences should call attention to this bar.

Krakaw v. Harding, 107 O. G. 1662.

The question of public use is, furthermore, one which can not properly be decided against Winter without giving him an opportunity to take rebutting proofs, since that evidence was taken upon a different issue.

Weber, 101 O. G. 2570; Winter v. Slick v. Volkommer, 107 O. G. 1659.

The Examiner's action or failure to act under this rule is not appealable. It is in effect a favorable decision as to the patentability of the claims.

Woods v. Waddell, 106 O. G. 2017; Kempshall v. Sieberling, 107 O. G. 541; Dittgen v. Parmenter, 107 O. G. 1098.

Where he (the Primary Examiner) disagrees with the other tribunals, it is believed that the question should be regarded as unsettled and should be referred to a higher tribunal for decision.

Snider v. Bunnell, 103 O. G. 890; Mills v. Torrence, 106 O. G. 544.

Under this rule, the Examiners-in-Chief may, if they deem it advisable, call the attention of the Commissioner to any matter not relating to priority which in their opinion establishes the fact that no interference exists or that there has been irregularity in declaring the same or which amounts to a statutory bar to the grant of a patent to either party for the claim in interference. This is not, however, compulsory upon them, and if they refuse to do so, no appeal lies.

Walsh v. Hallbauer, 94 O. G. 223; Wilcomb v. Lasher, 105 O. G. 743.

The Examiner of Interferences was of the opinion that one applicant had no right to make the claims. The matter referred to the Primary Examiner who thought applicant had

such right. The matter was then referred to the Board who held that applicant had no such right. The Commissioner directed that a limit of time to appeal from the decision of the Board be set.

Robinson v. Copeland, 105 O. G. 263.

Public use proceedings not applicable to trade-marks.

Dietz, 104 O. G. 1852.

Public use is considered in the practice of this Office as a separate question, requiring an investigation independent of the question of priority of invention involved in an interference proceeding. No testimony has been taken, and there is nothing in the case upon which the Primary Examiner at the present time can intelligently consider the bar of public use. No error is found in the refusal to transmit on this ground.

Davis v. Swift, 96 O. G. 2409; Shrum v. Baumgarten, 104 O. G. 577.

Such investigation, however, would not be made as a part of the interference, but as an independent proceeding. It would be made only upon motion for suspension for that purpose, accompanied by a satisfactory showing of public use and an expression of a willingness on the part of the moving party to produce the witnesses for examination and to bear the expense of the proceeding, including the expense of an officer detailed from the Office to conduct the proceeding.

Shrum v. Baumgarten, 104 O. G. 577.

Claims can not be rejected or held unpatentable upon such affidavits alone.

Shrum v. Baumgarten, 104 O. G. 577.

It is designed by the practice instituted in this case to avoid these complications in those cases where the recommendation of the Examiners-in-Chief covers matters considered and passed upon by the Primary Examiner in an *ex parte* decision by substituting at the outset the entry of a rejection *pro forma* by the Primary Examiner, putting the case at once in condition for a course of appeals which may be carried to the Court of Appeals.

Holz v. Hewitt, 127 O. G. 1992; Greenawalt v. Mark, 103 O. G. 1913.

In public use proceedings the Patent Office alone represents the public and its approval is necessary to make any agreement affecting the merits of the case binding.

Kephart, 103 O. G. 1914.

It is the question, not the evidence, which is transmitted for consideration and determination. In passing upon a question so transmitted the Examiner may avail himself of

any information which he may obtain throwing light upon the question. To prevent surprise, due and timely notice should be given of any facts to be considered which are not disclosed by the record.

*Greenawalt v. Mark*, 103 O. G. 1913.

Motion to transmit to Primary Examiner to consider question of two years' public use, noted by Examiner of Interferences, also asking to have a foreign patent considered as an anticipation. Refused. The evidence taken in an interference can not without further proceedings be used as the basis for the rejection of claims on the ground of public sale of the invention. Questions relating to anticipatory matter should be raised by a motion to dissolve under Rule 122.

*Dittgen v. Parmenter*, 103 O. G. 1164.

The rules properly provide that a favorable decision by the Examiner upon the merits is not appealable; but at the same time they provide for review of such a decision in certain cases, not as a matter of right by the parties, but as a matter of public policy.

*Snider v. Bunnell*, 103 O. G. 890.

The Board thought that no interference in fact existed and that one of the parties had no right to make the claim. Case remanded to Primary Examiner, who held that an interference existed and the party had a right to make the claim. Case placed on Commissioner's docket for final decision.

*Snider v. Bunnell*, 103 O. G. 890.

The question as to whether one of the parties received knowledge of the invention from a third party will not be considered in an interference proceeding. Otherwise, if it is a question of originality between the parties.

*Trufant v. Prindle v. Brown*, 101 O. G. 1608.

Public use proceedings instituted.

*Weber*, 101 O. G. 2570; *Snider v. Bunnell*, 101 O. G. 2572; *Fessenden v. Potter*, 101 O. G. 2823; *Osborn v. Hotsapillar*, 102 O. G. 1296-7.

If the Examiner be of the opinion that certain actions should be made in an application which is involved in an interference, and said actions relate to matters which do not in any way relate to or affect the interference then pending, the proper practice to follow is for the Examiner to file a request with the Commissioner that jurisdiction of the case be restored to him for the purpose of making such action.

*Hildreth*, 97 O. G. 1374; *Felbel v. Oliver*, 100 O. G. 2175-6; *Read v. Scott*, 101 O. G. 449.

Primary Examiner and Board take different views.

*Thomson v. Weston*, 94 O. G. 986.

'Two years' public use in designs.

Fournier, 94 O. G. 2166.

Whether or not the Board shall suggest statutory bar, etc., is optional with them and can not be reviewed on appeal.

Walsh v. Hallbauer, 94 O. G. 223.

The question of statutory bar considered by Commissioner upon appeal on question under Rule 122.

Valiquet v. Johnson, 92 O. G. 1795.

The Commissioner may take notice of these matters on his own motion.

Anderson & Dyer v. Lowry, 89 O. G. 1861; Larter v. Jones, 92 O. G. 383.

In the public use proceeding a copy of an application involved refused protesting party.

National Phonograph Co., 89 O. G. 1669.

Bar arising should not be considered during the interference proceeding by subordinate tribunal, but referred to Commissioner.

Paget v. Bugg, 89 O. G. 1342.

Interference suspended to take testimony relative to public use proceedings, without a recommendation.

Sanford Mills v. Aveyard, 88 O. G. 129.

Where the structure of one of the parties to an interference is inoperative, priority of invention can not be awarded to him.

Glidden v. Noble, 67 O. G. 676.

With the small sum appropriated by Congress for conducting public use proceedings the Patent Office is not justified in instituting such proceedings unless a strong *prima facie* case is made.

Fay v. Conradson, 65 O. G. 75.

The establishment of abandonment or of two years' public use requires proof so clear as to put the matter beyond all reasonable doubt.

Bury v. Thompson, 58 O. G. 1255.

The invalidating two years' public use of the statute does not require the knowledge, allowance or consent of the inventor.

Drawbaugh, 57 O. G. 546.

The interference should not be delayed by public use proceedings unless for extraordinary and amply sufficient reasons.

Campbell v. Brown, 56 O. G. 1565.

When an allegation of public use comes up for consideration in connection with an application which is being considered *ex parte* after the termination of the interference pro-

ceedings, the proper practice is for the Examiners to pass upon the question whether or not a *prima facie* case of public use has been established, rejecting the claims in the case if he decided the question in the affirmative. Unsworn statements do not make a *prima facie* case.

Beatty, 56 O. G. 1563.

Bar of public use not avoided by caveat.

Meucci, 51 O. G. 299.

Public use proceeding on motion of defeated party to an interference refused.

Beardslee v. Moeslein, 46 O. G. 1640.

The question as to what is the correct practice under this rule when joint applicants prove not to be joint inventors has presented itself in a variety of phases to the Commissioners, and their conclusions are by no means in harmony. During the period covered by these decisions the rule has been changed and modified, but this fact will not explain the conflict in them. Decisions reviewed.

Hicks v. Keating v. Purvis & Bilgram, 40 O. G. 343.

The question of statutory bar as contemplated in Rule 120 relates to matter that is purely a bar as contradistinguished from title, or whether applicants are joint inventors. Under the present rule a statutory bar to either one of the parties in interference may call into exercise the action authorized by it. Formerly, it was only a statutory bar to both.

Hicks v. Keating v. Purvis & Bilgram, 40 O. G. 343.

If the question presents itself in the preliminary statement, applicant should be given a chance to avoid the objection by amendment; if he does not do so the preliminary statement should be approved if correct in other particulars, and in his decision of the question of priority the Examiner of Interferences should call the attention of the Commissioner to the existence of the statutory bar.

Hicks v. Keating v. Purvis & Bilgram, 40 O. G. 343.

The joint patentees proving not to be joint inventors the interference was decided against them and the case was remanded to the Primary Examiner to consider whether there was not a statutory bar existing to the grant of the patent by reason of the right of one of said joint patentees to obtain a patent.

Harrison v. Hogan, 18 O. G. 921.

The provisions of this rule must not be construed to provide an alternate remedy, but can only be availed of when motions relating to a statutory bar can not be made as prescribed in the other rules.

Barney v. Kellogg, 17 O. G. 1096.



When the Examiner of Interferences finds that neither party is the first and original inventor he should render his judgment accordingly. As this question relates to priority it should be appealed to the Board and not referred to the Commissioner under this rule.

Wood v. Eames, 17 O. G. 512.

The law of 1836 provided that in connection with interference proceedings, like proceedings should be had to determine which, or whether either of the applicants is entitled to receive a patent as prayed for. But in the act of 1870 this provision was omitted.

Smith v. Perry, 9 O. G. 688.

Nor can I think that an interference proceeding authorized by law for one specific purpose (i. e., to determine priority of invention), can be rightfully used by the Commissioner for any other purpose, and in my judgment, no part of the testimony taken and submitted in such case, if plainly outside the issue, is evidence at all against the right of the adverse party. This decision related to abandonment by public use apparently.

Smith v. Perry, 9 O. G. 688.

In the case of Rouse and Stoddard, 75 C. D. 33, the practice of sending letters of inquiry to the inventor who has filed and abandoned an application, calling for information in the form of affidavits as to public use of the invention, and informing the applicant that another application for the same invention is pending, was inaugurated; this practice was discontinued in the case of

Casilear & McIntire, 1875 C. D. 117.

I believe it has been the custom of the Commissioners, although such matters are purely *ex parte*, to hear other parties, in order that he might be as fully informed as possible in relation to the merits of the case.

Com. Spear in Carter & Dwyer v. Perry & Dickey, 1875 C. D. 111.

The question of novelty is always a proper one for consideration of the Office at any time prior to the grant of a patent. An interference case reopened to admit testimony of that kind after the time for taking testimony had expired. The Examiner of Interferences directed to assign dates for taking such testimony.

Wood v. Morris, 1873 C. D. 39. See Hovey v. Hufeland.

If public use for more than two years is shown by preliminary statement the interference should be dissolved.

Schenck v. Rider, 1870 C. D. 135..

The question of priority decided by the Commissioner and the case referred to the Primary Examiner to determine the question of novelty in view of newly discovered references.

Yost v. Heston, 1871 C. D. 226.

Cases that pass on the subject matter of this rule.

Foster v. Bell, 159 O. G. 241; Hess v. Jorrissen v. Filbel, 131 O. G. 1419; Dixon and Marsh v. Graves and Whittemore, 130 O. G. 2374; Potter v. McIntosh, 127 O. G. 1995.

### Rule 127. Second Interference.

A second interference will not be declared upon a new application for the same invention filed by either party.

#### CONSTRUCTIONS.

This rule prohibits the declaration of a second interference between the same contesting parties upon the same invention and a second interference between the same applications should be declared only in rare cases and under very exceptional circumstances. Reason of the rule. See also note to 122.

Blackford v. Wilder, 124 O. G. 319.

Held, that the testimony in a prior interference may be given the force and effect of an *ex parte* affidavit in the consideration of the question whether a second interference with a broader issue is justified.

Wende v. Horine, 118 O. G. 1070.

The decision in the first case is *prima facie* evidence that applicant was not the first inventor even when decision was rendered upon a default.

Votey, 114 O. G. 259.

Or because a party has enlarged the scope of his claims.

Corry and Barker v. Trout v. McDermott, 110 O. G. 306.

From the earliest organization of the office, it has been the settled practice to declare such second interferences, and therein when proper, to reverse the decision in the former one, and numerous patents have been granted to the successful parties upon such second interferences, notwithstanding patents have been granted to their adversaries upon the previous trials.

Abraham v. Fletcher, 1869 C. D. 50.

**Rule 128. Suspension of Interference for Consideration of New References.**

If, during the pendency of an interference, a reference be found, the primary examiner shall call the attention of the law examiner thereto, and the latter may request the suspension of the interference until the final determination of the pertinency and effect of the reference, and the interference shall then be dissolved or continued as the result of such determination. The consideration of such reference shall be *inter partes* and before the law examiner.

**HISTORY.**

Previous to the recent revision, this rule read as follows:

If, during the pendency of an interference a reference be found, the interference may be suspended at the request of the primary examiner until the final determination of the pertinency and effect of the reference, and the interference shall then be dissolved or continued as the result of such determination. The consideration of such reference *shall be inter partes*.

This provision is in the rules of 1892, but "*ex parte*" is replaced by "*inter partes*" in the Rules of June 18, 1897.

**CONSTRUCTIONS.**

Consideration of references should be *ex parte*.

Westinghouse v. Thomson, 1891 C. D. 110.

This rule can have no application before the opening of the preliminary statements, because the proceeding provided for must be *inter partes*, and there can be no proper *inter partes* consideration of the question of dissolution prior to access to opponents' cases. The interference is not pending within the meaning of this rule previous to that time.

Behrend v. Lamme v. Tingley, 124 O. G. 2536.

If the Examiner has secured jurisdiction as to certain counts an applicant can not demand that he consider other counts.

Lugoldshy v. Bellows, 116 O. G. 2532.

On appeal from the decision of the Primary Examiner shifting the burden of proof on the Examiner requesting a return of the case for consideration of new references. Be-

fore the interference proceeds further it should be positively determined whether or not these new references anticipate the issue.

Wright & Stebbins v. Hansen, 114 O. G. 761.

Because the Primary Examiner has requested jurisdiction under this rule in one interference, it is no ground for granting a motion to transmit the files in another case in which the same application is involved as the subject matter is presumably different and therefore the reference not applicable in both cases.

Parkin & Parkin v. Riotte, 109 O. G. 1335.

The Examiner erred in practice in his action rejecting the claims and then setting a day for a hearing on this rejection. When the interference was transmitted he should have set a day for hearing upon the question of patentability. After the hearing if he was of the opinion that the claims were not patentable in view of the references he should have rendered a decision dissolving the interference on that ground. After the interference was dissolved each of the applications should have been considered *ex parte*.

Struble, 109 O. G. 1335.

Judgment of priority not suspended to await determination of *ex parte* questions relating to the application of the successful party not affecting in any manner the rights of the defeated party.

Smith v. Dimond, 20 O. G. 742, 1881 C. D. 34.

The interference will be suspended a sufficient time to permit the usual appeals from the primary examiner.

Stone v. Greaves, 17 O. G. 260, 1880 C. D. 23.

If at any time pending an interference, new references are discovered by the primary examiner, the interference may be suspended for examination.

Banks v. Snediker, 16 O. G. 1096, 1879 C. D. 304;  
Anson v. Woodbury, 11 O. G. 243; 1877 C. D. 4.

A party may have a reasonable time to appeal.

Abel & Dewar v. Maxim v. Nobel, 1891 C. D. 102.

Cases that pass on the subject matter of this rule:

Turner v. Macloskie, 128 O. G. 2835; Mill v. Midgley, 136 O. G. 1534; Cazin v. VonWelsbach, 119 O. G. 650; Durafort, 110 O. G. 2017; Parkin & Parkin v. Riotte, 109 O. G. 1336; Hicks v. Costello, 103 O. G. 1163; Macey v. Laning v. Casler, 101 O. G. 1608, 1902 C. D. 399.

**Rule 129. For Addition of New Parties.**

If, during the pendency of an interference, another case appear, claiming substantially the subject matter in issue, the primary examiner shall request the suspension of the interference for the purpose of adding said case. Such suspension will be granted as a matter of course by the examiner of interferences if no testimony has been taken. If, however, any testimony has been taken, a notice for the proposed new party, disclosing the issue in interference and the names and addresses of the interferants and of their attorneys, and notices for the interferants disclosing the name and address of the said party and his attorney, shall be prepared by the primary examiner and forwarded to the examiner of interferences, who shall mail said notices and set a time of hearing on the question of the admission of the new party. If the examiner of interferences be of the opinion that the interference should be suspended and the new party added, he shall prescribe the terms for such suspension. The decision of the examiner of interferences as to the addition of a party shall be final.

*CONSTRUCTIONS.*

The Primary Examiner requested that the interference be returned to him for dissolution.

*Welch v. Aufiero*, 219 O. G. 930.

If two parties are in interference upon certain issues and one inserts a claim of a patent, the proper course is for the Primary Examiner to request jurisdiction and suggest the patented claim to both parties and declare an interference between the three on that issue.

*Dow v. Benson*, 107 O. C. 1378.

As stated in *Maxwell v. Byron v. Henry*, 98 O. G. 1968, an interference should not continue between two parties as to certain counts and between three parties as to other counts.

*Dow v. Benson*, 170 O. G. 1378.

One of the applicants filed a second application. The Com-

missioner says, if the claims are patentable over the issue and can be made by the other parties to the interference the Examiner should ask to have the applications of the other parties restored to his jurisdiction for the purpose of suggesting claims of the petitioners' application. If, on the other hand, the claims in this application are not patentable over the issue of the old application they should be rejected thereon.

Robinson, 106 O. G. 1242.

After decision on priority by the Examiner, Examiners-in-Chief and Commissioner it is too late to dissolve merely for the purpose of adding a new party.

Such a motion should be denied rather than dismissed for irregularities.

Corry v. Barker v. Trout, 99 O. G. 2547, 1902 C. D. 195.

The junior party has taken testimony, and the time allowed the senior party has expired without the taking of testimony by him. The effect of adding a new party at this stage would be practically to reinstate the latter, and as there is ample opportunity for a second interference between the junior and the third party the present interference will not be suspended for the purpose indicated.

Wein v. Northrop, 58 O. G. 1416.

An interference dissolved in order to include a former application by one of the parties.

White v. Demarest, 41 O. G. 1161, 1887 C. D. 133.

A motion to dissolve an interference made in violation of this rule should be determined by the examiner of interferences.

Edison v. Gilliland v. Phelps, 38 O. G. 539, 1887 C. D. 11.

An interference may be suspended but not dissolved for the mere purpose of adding new parties before taking testimony.

Maloney v. Kidwell, 16 O. G. 1139, 1879 C. D. 311.

It is unnecessary to dissolve the interference in order to include a second interfering patent, but the matter may be corrected by the examiner of interferences in his notice to the parties upon giving the time for taking testimony.

Wilson & Matthews v. Yakel & Rogers, 10 O. G. 944, 1876 C. D. 245.

### **Rule 130. Nonpatentability at Final Hearing.**

Where the patentability of a claim to an opponent is material to the right of a party to a patent, said

party may urge the nonpatentability of the claim to his opponent as a basis for the decision upon priority of invention. A party shall not be entitled to raise this question, however, unless he has duly presented and prosecuted a motion under Rule 122 for dissolution upon this ground or shows good reason why such a motion was not presented and prosecuted. When the law examiner has denied such a motion for dissolution the question shall not be reinvestigated by the examiner of interferences except in view of evidence which was not before the law examiner, but it may be raised before the appellate tribunals on appeal from award of priority by the examiner of interferences.

#### *HISTORY.*

See *Podlesak and Podlesak v. McInnerney*, 1906 C. D. 558, 120 O. G. 2127, and cases referring to it, especially *United States of America ex rel. The Newcomb Motor Company v. Moore*, Commissioner of Patents, 133 O. G. 1680.

#### *CONSTRUCTIONS.*

##### *(1) What May be Considered on Final Hearing.*

Patentability of the issue, and difference in meaning, may not be argued under this rule, and especially no testimony will be taken.

*Molyneux v. Onderdonk*, 191 O. G. 292.

R. 130, however, only gives a party the right to argue at final hearing the unpatentability of a claim to an opponent, and then only when it is material to such party's right to a patent.

*Molyneux v. Onderdonk*, 196 O. G. 292.

A motion to dissolve because the issue means different things when applied to the different applications is no ground for consideration as to whether the issue is patentable to the opponent.

*Havemeyor v. Cougel*, 186 O. G. 558.

A person is not entitled to argue that his opponent has no right to make the claim unless he has urged this in a motion to dissolve.

*Weis v. Mack*, 185 O. G. 830.

Neither an allegation by a party to an interference that he himself has no right to make the claims, nor an allegation that the counts have different meanings in the two cases, forms a basis for a decision on priority and can not be urged at final hearing.

Weis v. Mack, 185 O. G. 830.

I am of the opinion that the adoption suggested claims and the prosecution of an interference can not be construed as an election of the species involved in the absence of other acts or statements on the part of the applicant binding him to such species.

Burk, 184 O. G. 289.

"The method of treating molten blast furnace slag, consisting in flowing the same over an artificially cooled moving surface while passing from a fluid to a solid state." Referring to feeding the slag into a hollow cooled rotating cylinder, may not be made on an apparatus which feeds the slag between the fitting surfaces of cooled rolls. The results being different.

Wood v. Duncan, 183 O. G. 1033.

It is well settled that the patentability of the issue will be considered on final hearing only under the *supervisory* authority of the Commissioner and in a clear case.

DeFerranti v. Lindmark, 183 O. G. 783 (Cases).

The question of inoperativeness may be presented upon proper showing at the final hearing of the case, and if circumstances justify it, testimony may be taken in accord with the cases cited.

Keys and Kraus v. Yunck, 182 O. G. 248-9.

The refusal to include certain trade-marks in the interference does not preclude them from being introduced at the final hearing.

Blanke Tea & Coffee Co. v. Herst, 182 O. G. 247.

Claims added under Rule 109 may be objected to a final hearing if the question has been previously raised.

Josleyn v. Hulse, 132 O. G. 844; Hopkins v. Cleal, 180 O. G. 1393.

The question as to whether the renewal was properly filed raised under this rule.

Le Brow v. Wix, 177 O. G. 771.

Where it appears that one of the parties has no right to make the claims in interference, the Examiners-in-Chief properly awarded priority to the party, and did not recommend that the interference be dissolved.

McBerty v. Shore, 175 O. G. 843.



Question of new matter may be heard under this rule.

*Samulesen v. Flanders*, 171 O. G. 745.

In view of their conclusion that Schutte was the prior inventor the Board should have considered and determined the question of the right of Schutte to make the claim as ancillary to the question of priority of invention, notwithstanding that they had previously considered that question on motion and the Commissioner had refused to exercise his supervisory authority.

*Schutte v. Rice*, 157 O. G. 753.

Petitioner has an adequate remedy in the interference proceeding, where the question (right to make the claim) can be raised at final hearing under Rule 130.

*Frost v. Chase*, 151 O. G. 741.

Questions of public use not considered at final hearing.

*Lacroix v. Tyberg*, 148 O. G. 831.

That counts one, two and three have different meanings in the respective applications, and that there is consequently no interference in fact, that counts four and five are not readable on his own device, and that counts four, five and six are not patentable over the prior art, and that for these reasons the interference should be dissolved, do not relate to matter that can properly be considered at final hearing except under circumstances such as would warrant the exercise of the supervisory authority of the Commissioner.

*Lacroix v. Tyberg*, 148 O. G. 831.

Question not raised below will not be considered on appeal.

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

An affidavit of counsel for the petitioner to the effect that efforts were made to obtain an amended preliminary statement should have been presented before the Examiner of Interference, and it is not entitled to consideration when presented on appeal in the first instance.

*Williams v. Foyer and Kurz*, 142 O. G. 1114.

In *Podlesak v. McInnerney*, 26 App. D. C. 405, the rule previously adhered to in this court was modified, and we held that in awarding priority of invention the right of a party to make a claim might be considered as an ancillary question. But the concurrent decisions of the lower tribunal on the question will not be disturbed except in a clear case, especially where the subject-matter is a complicated construction in reference to which we are more liable to ERR than the Experts of the Patent Office.

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

S. did not bring a motion to dissolve the interference on

the ground that the other parties had no right to make the claims, and as no showing was made why such motion was not brought, he is not entitled to urge this question under the provision of Rule 130. The fact that no such motion was made does not prevent the tribunals of the Office from considering the question of their own motion, when it clearly appears that one or more of the parties have no right to make the claims.

*Smith v. Foley v. Anderson v. Smith*, 136 O. G. 847.

It was incumbent upon appellant to raise this question (sufficiency of disclosure) before the Primary Examiner whose skill in the particular art peculiarly qualified him to consider it.

*Cutler v. Leonard*, 136 O. G. 438; *McFarland v. Watson et al.*, 146 O. G. 257.

Inasmuch as the pertinency of the question can not be judged as well when taken by themselves as when considered in connection with the answers thereto, any serious doubts as to the propriety or materiality of the interrogatories should be resolved in favor of allowing them to remain subject to objection until the final hearing.

*Actiengesellschaft & Aulanerbrau Salvator Braueri v. Conrad Seipp Brewing Co.*, 135 O. G. 1121.

If the cross-interrogatories were not suppressed until final hearing, it is clear that appellant might thereby improperly obtain information to the irreparable injury of the adverse party.

*Actiengesellschaft & Aulanerbrau Salvator Braueri v. Conrad Seipp Brewing Co.*, 135 O. G. 1121.

A motion to suppress testimony decided at final hearing may not be appealed separately, but may be considered by the appellate tribunal on appeal upon the main question.

*Dyson v. Sand v. Dunbar v. Browne*, 133 O. G. 1679.

The fact that on appeal from a decision on a motion to dissolve the Examiners-in-Chief have held that a party has a right to make the claims does not prevent the question being raised before the Examiner of Interferences at final hearing under Rule 130.

*O'Brien v. Gale v. Limmer v. Calderwood*, 133 O. G. 514.

It is evident that what Rule 130 requires is that the question of the patentability of the claims to the other party shall have been duly presented and prosecuted before the Primary Examiner, and it is therefore immaterial whether

this was done on a motion to dissolve or on a motion to amend.

*Josleyn v. Hulse*, 132 O. G. 844.

Where testimony must be considered in determining a motion to amend a preliminary statement, it is within the discretion of the Examiner to consider such testimony for the purpose of deciding the motion prior to final hearing. When in his opinion the conditions of the case justify an early adjudication of the questions raised, his decision should not be delayed.

*Smith v. Ingram*, 131 O. G. 2420.

Rule in accordance with the holding of the Court of Appeals in the decision in *Podlesak and Podlesak v. McInnerney* (120 O. G. 2127), and in *Kilbourn v. Hirner* and in *Wickers and Furlong* (129 O. G. 869).

*Hopkins v. Newman*, 131 O. G. 1161.

The question of the patentability of the issue will not be considered on an appeal on priority except under such special circumstances as would warrant the exercise of the supervisory authority of the Commissioner.

*Hess v. Jorrissen v. Felbel*, 131 O. G. 1419.

Rule 130 does not confer upon a party the absolute right to contest his opponent's right to a claim, but allows him to do so only when the objection urged against his opponents to make the claim do not apply with equal force to his own case.

*Pym v. Hadaway*, 131 O. G. 692; *Anderson & Dyer v. Lowry*, 89 O. G. 1861; *Bechman v. Southgate*, 127 O. G. 1254; *Bechman v. Wood*, 89 O. G. 480; *Briggs v. Conley*, 104 O. G. 1119; *Cory v. Gibhart & Martin, Jr., v. Blakey*, 115 O. G. 1328; *Denton v. Parker*, 98 O. G. 415; *Goss v. Scott*, 96 O. G. 844; *Gally v. Burton*, 120 O. G. 325; *Horne v. Somers & Co.*, 129 O. G. 1609; *Jenner v. Dickson v. Thibodeau*, 116 O. G. 1181; *Kilbourn v. Hirner*, 128 O. G. 1689; *Kempshall v. Sieberling*, 110 O. G. 1427; *Locke v. Crebbin*, 124 O. G. 317; *McGill v. Adams*, 119 O. G. 1259; *Miel v. Yough*, 121 O. G. 1350; *Read v. Scott*, 101 O. G. 449; *Ruische v. Sandherr*, 105 O. G. 1780; *Seeberger v. Dodge*, 113 O. G. 1415; *Shallenberger v. Andrews*, 1902 C. D. 246; *Sobey v. Holsclaw*, 119 O. G. 1922; *Talbot v. Morrell*, 99 O. G. 2955; *Weintraub v. Hewitt*, 124 O. G. 2534; *Hopkin v. Cleal*, 180 O. G. 1393.

The Examiner of Interferences has jurisdiction to decide at final hearing the question raised upon this motion, namely, whether "mixed paints" and "ready mixed paints" are goods of different descriptive properties, for the trade-mark statute provides for the determination of the question of the "right of registration to such trade-mark." The trade-mark statute gives much larger jurisdiction than the patent statute, which merely provides for the determination of the question of priority.

Lewis & Bros. Co. v. Phoenix Paint & Varnish Co., 131 O. G. 361.

The sole contention on this appeal is that the issue is not patentable to either party. The question has been before the Primary Examiner both *ex parte* and *inter partes*, and in each case he has held the issue to be patentable. Both the Examiner of Interferences and the Examiner in Chief upon appeal on priority have refused to recommend under Rule 126 that the claims be rejected as being without patentable novelty. Under these circumstances the question presented will be considered only under my supervisory authority for the purpose of correcting a manifest error.

Dixon & Marsh v. Graves & Whittemore, 130 O. G. 2374.

See note to Rule 122.

McNulken v. Bollee, 130 O. G. 1691.

Evidence considered (by Court of Appeals) and held to show that the application on which the patent was granted did not, as originally filed, disclose the invention in issue, and priority therefore awarded to the junior party.

McKnight v. Pohle, 130 O. G. 2069.

Evidence considered (by Court of Appeals) and held to show that the application on which the patent was granted did not, as originally filed, disclose the invention in issue, and priority therefore awarded to the junior party.

McKnight v. Pohle, 130 O. G. 2069.

A motion to suppress testimony calling for an examination of a large part of the record will be postponed to the final hearing.

Dyson v. Sand v. Dunbar v. Browne, 130 O. G. 1690.

We greatly doubt whether the affidavits in this record presented for the consideration of this court and controverting the sufficiency of disclosure found in the Weinwurm application in interference, could be profitably considered by this court. The question should come before us upon testimony taken in the interference proceeding. C. A. D. C.

Wickers and Furlong, 129 O. G. 2074.

Not every case comes within the provision of Rule 130, and until it is shown that it does, a party has no right to argue the question of the non-patentability of his opponent's claims before the Examiner of Interferences.

*Pym v. Hadaway*, 129 O. G. 2073.

Rule 130 was intended to cover those cases where it was contended that one party had a right to make the claims, but the other did not, and that therefore the latter was not entitled to the date of filing of his application as a date of conception and constructive reduction to practice of the invention in issue. The reasons given must not be applicable to both cases.

*Pym v. Hadaway*, 129 O. G. 2073.

Trade-marks.

*Harne v. Somers & Co.*, 129 O. G. 1609.

After record judgment of priority in favor of O. and upon motion by B. the interference was reopened in order to permit him to urge under Rule 130 that O. had no right to make the claims of the issue.

*Becon v. Otis*, 129 O. G. 1267.

In *Podlesak v. McInnerney*, 26 App. D. C. 399, this Court has held that the question of the right to make a claim may sometimes be an ancillary question to be considered in awarding priority of invention.

*Wickers v. Furlong v. McKee*, 129 O. G. 869.

In cases 122 O. G. 2687 and 2688, it was decided that where a party makes a reasonable showing before the Examiner of Interferences of the inoperativeness of his opponent's device, and that showing does not extend to his own structure, he may be permitted to take testimony provided that the proposed testimony is of a character to justify such action. No reason appears for making any distinction between a case where a party alleges that his opponent's device is inoperative and one where it is contended that the opponent has no right to make the claim in issue. Such testimony should be permitted only under Rule 130.

*Pym v. Hadaway*, 129 O. G. 480.

It is believed that testimony consisting wholly of the opinion of expert patent lawyers as to the legal effect of claims should not be received.

*Pym v. Hadaway*, 129 O. G. 480.

W.'s preliminary statement failed to overcome the record date of H. and W. In response to our order to show cause why judgment should not be rendered against him W. moved

to dissolve the interference on the ground that H. and R. had no right to final hearing on priority under Rule 130.

This proceeding should be a part of the main case and not a separate proceeding. All relates to priority.

*Hewitt v. Weintraub v. Hewitt & Rogers*, 128 O. G. 1689.

An award of priority is also proper under Rule 130 of the Rules of Practice of the Office, where it is shown at the final hearing of an interference that the application of a party relied upon as evidence of invention at the date thereof does not warrant the claim in issue.

*Martin v. Mullin*, 127 O. G. 3216.

Interferences are for the purpose of determining the question of priority only. That the issue is not patentable to either party has no bearing.

In cases contemplated by Rule 130, however, a decision that the issue is not patentable to one party would necessarily result in a decision of priority in favor of the other party.

*Dixon & Marsh v. Graves & Whitemore*, 127 O. G. 1993.

Where the operativeness of an opponent's device or his right to make the claim is material to the right of a party to a patent, said party may urge the matter at final hearing before the Examiner of Interferences as a basis for his award of priority; but as a condition precedent to such right, the party must first present the matter upon a motion for dissolution or show good reason why such motion was not made and prosecuted.

*Barber v. Wood*, 127 O. G. 1991.

After the present motion to dissolve is disposed of petitioner may pursue his motion for an order permitting him to take testimony under the practice announced in *Browne v. Stroud*, 122 O. G. 2687, and *Lowry & Crowley v. Spoon*, 122 O. G. 2687.

*Barber v. Wood*, 127 O. G. 1991; operativeness and public use.

The Court of Appeals in the District of Columbia, in the case of *Podlesak v. McInnerney* (120 O. G. 2127), held that the question of the right of a party to make a claim may be an ancillary question to be considered in awarding priority of invention. In my decision in the case of *Pohle v. McKnight* (119 O. G. 2519), and of *Kilbourn v. Hirner* (122 O. G. 729), certain reasons are set forth why the question of the right to make the claims may be considered as a basis for an award of priority rather than a dissolution of the interference. Under the practice indicated above it was held that one of the parties had no right to make the claim

of the issue because its subject matter was not shown in the original application.

Emmet v. Fullagar, 124 O. G. 2179; citing Gallagher v. Hien, 115 O. G. 1330; Laas & Sponenburg v. Scott, 122 O. G. 352; Podlesak v. McInnerney, 120 O. G. 2127; Pohle v. McKnight, 119 O. G. 2519; Kilbourn v. Hirner, 122 O. G. 729; Robinson v. Seelinger, 116 O. G. 1735.

We greatly doubt whether the affidavits in this record presented for the consideration of this Court and controverting the sufficiency of disclosure found in the W. application in interference could be profitably considered by this Court. That question should come before us upon testimony taken in the interference proceeding. (A. D. C.)

Wickers v. Furlong v. McKee, 124 O. G. 908.

The right of McKee to make the claims questioned by Wickers and Furlong will be given consideration as ancillary to the question of priority.

Wickers & Furlong v. McKee, 124 O. G. 908, citing Podlesak & Podlesak v. McInnerney, 120 O. G. 2127; Pohle v. McKnight, 119 O. G. 2519.

The right of Crebbin to make the claims corresponding to the issue may be urged at the final hearing.

Locke v. Crebbin, 124 O. G. 317.

The consideration of the question of patentability or right to make the claims will not be considered at the final hearing, where the moving party is in no case entitled to receive a patent on the subject matter.

Potter v. McIntosh, 122 O. G. 1721.

I am of the opinion that the question raised by this attack (sufficiency of disclosure) is one properly considered in determining the question of priority in those cases where a holding that a party is entitled to make the claim in issue results in a judgment against a party, who, if he be the true inventor, is entitled to a patent.

Kilbourn v. Hirner, 122 O. G. 729.

The question of the right to make a claim is reviewable, if at all, with the final decision in the interference and not upon interlocutory appeal.

Zimmermann v. Lamboni, 121 O. G. 2326.

No interlocutory appeal on decision affirming right to make claims, but an opponent's right to make claims "may" be questioned upon appeal from decisions upon priority of invention where a holding of right on the part of one party

to make the claims operates to deny a patent to another party who if such holding be in error is the first inventor.

Miel v. Young, 121 O. G. 1350. See also Noble v. Sessions, 1210 O. G. 1348.

The question of the right of a party to make a claim goes to the very foundation of an interference, for if the party has not such right the interference falls. If it be incorrectly held that such a party has a right to make the claim priority may be awarded to him and his adversary be deprived of a substantial right in that he is not given a claim where he necessarily is the prior inventor, his adversary never having made the invention. Manifestly that question should not be finally determined by the Primary Examiner who originally declared the interference.

Podlesak v. Podlesak v. McInnerney, 120 O. G. 2127.

Where the question is appealed to the Commissioner on the question of priority, a motion to transmit the interference to the Primary Examiner to consider the question of patentability will not be granted unless a clear and unmistakable error appears in the prior decision.

Parker v. Lewis, 120 O. G. 323.

A decision of the Examiner of Interferences refusing to expunge testimony will only be reviewed at the final hearing.

Royce v. Kempshall, 119 O. G. 338; Greene, Tweed & Co. v. Manufacturers' Belt Hook Co., 132 O. G. 680.

Where the defeated party alleges public use, *held*, that the matter will not be considered until the decision on priority becomes final.

Doble v. Henry, 118 O. G. 2249.

Questions of patentability raised for the first time on appeal to the Commissioner refused consideration and brief on question stricken from the files.

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

It has been the uniform practice not to suppress the testimony before final hearing.

Andrews v. Nelson, 111 O. G. 1038.

Motions requiring the whole case to be gone into will be considered only at the final hearing.

Hall v. Alvord, 101 O. G. 1833.

In certain cases it is better to postpone the consideration of questions relating to the suppression of testimony until final hearing. The present case is not one of these. The Examiner of Interferences' decision granting motion to strike out affirmed.

Brill & Adams v. Uebelacker, 99 O. G. 2966.



To pass upon the question of whether or not the evidence should be suppressed would require such a consideration of the very voluminous record in this case as will necessarily be given at the final hearing, and for that reason a final disposition of the matter should be postponed until that time.

Talbot v. Monell, 99 O. G. 2965.

If a witness refuses to answer a material question and no application is made to the U. S. Court, testimony will not be stricken out except preparatory to final hearing.

Independent Baking Powder Co. v. Fidelity Mfg. Co.,  
94 O. G. 223.

The pendency of a motion to dissolve before the Primary Examiner does not prevent the parties from bringing any other proper motion before the Examiner of Interferences.

Meehlin v. Horn, Colclazer & Munger, 92 O. G. 2507-8.

Where the question of priority has been decided without the suspension of an interference proceeding, the question of patentability of a claim involved in the interference will be considered not *inter partes*, but *ex parte* by the Primary Examiner.

Pell v. Pierpoint, 76 O. G. 1573.

Question of patentability refused consideration on final hearing in view of the fact that no motion was made under Rule 122.

Schnabel v. Shellaberger, 68 O. G. 658.

Priority of invention can not be awarded to an applicant whose device is inoperative.

Glidden v. Noble, 67 O. G. 676.

Where an applicant copied the claims of a patent, all the tribunals must pass upon the question of the right of applicant to make the claim.

Reichenbach v. Goodwin, 63 O. G. 311.

Where the Examiner of Interferences refused to consider a motion to strike out a wife's testimony and reserved the question until final hearing, *held*, on appeal to the Commissioner, that this was a proper subject for interlocutory action.

Crawford v. Lichenstein, 61 O. G. 1480.

In view of the obvious irregularities in declaring the interference, it is extremely difficult to render a decision on the question of priority.

The Examiner is directed to carefully consider the question of patentability of the issue and take such action as the case demands.

Mets v. Crane & Bloomfield, 58 O. G. 947.

It is the clear duty of the Office in such a case to decline

to further consider the question of abandonment of Y's application until the question of priority of invention shall have been determined, when unquestionably a much fuller light will have been shed upon the whole matter.

Young v. Case, 58 O. G. 945.

Where on final hearing before the Commissioner an interference is suspended and the case remanded to the Primary Examiner for consideration of the question of operativeness, this question will not be considered *inter partes*, but will be determined by the Examiner subject to the regular course of appeals in *ex parte* proceedings.

Archer, 57 O. G. 696.

Cases that pass on the subject matter of this rule:

Kilbourn v. Hirner, 128 O. G. 1689; Bechman v. Southgate, 129 O. G. 1254.

### **Rule 131. Prosecution or Defense by Assignee.**

When, on motion duly made and upon satisfactory proof, it shall be shown that, by reason of the inability or refusal of the inventor to prosecute or defend an interference, or from other cause, the ends of justice require that an assignee of an undivided interest in the invention be permitted to prosecute or defend the same, it may be so ordered.

#### *CONSTRUCTIONS.*

The American Steam Boiler Cleaner Co.'s assignment, not containing any request, was not noted on the file, and the Examiners in declining to interfere, probably overlooked the assignment, even though there was no request to issue the patent to it, it had the right to prosecute this application. (See *ex parte* Hill & Hill, 206 O. G. 1437.)

Schreiber v. Bauer, 258 O. G. 813.

Interference between the joint application of G. and L. and the sole application of G. The assignee of L. allowed to appoint an attorney.

Gilbert v. Gilbert and Lindley, 160 O. G. 775; Churchill v. Goodwin, 132 O. G. 1838.

An exclusive licensee permitted to have full knowledge of proceedings so that it might intervene if any evidence of collusion appears.

The National Railway Materials Co., 129 O. G. 481.

A separate motion such as is provided for by Rule 131 is unnecessary where the assignee holds the entire interest.

Hastings v. Gallagher, 93 O. G. 189; Sotterhad v. Cornwall, 148 O. G. 1344.

The record shows L. has taken no action in the case and has not filed a preliminary statement, although the time for filing has expired.

The circumstances are such as to warrant permitting the assignee of an undivided part interest to prosecute the interference.

Lottridge v. Eustice, 121 O. G. 689.

The motion is proper where applicant has assigned one of two applications containing claims in common, one of which is involved in an interference.

Adams, 119 O. G. 650.

After an inventor has assigned his entire interest, he can not obtain copies of the files without giving a good reason.

Duncan v. Duncan, 109 O. G. 806.

No appeal lies from the refusal of the Commissioner to expunge certain assignments from the records.

Casey, 101 O. G. 2567. C. D. 1902-492.

A merely equitable assignee refused recognition, McPhail, 89 O. G. 521, however, copies of papers furnished so that proceedings might be watched and if necessary the equitable owner permitted to intervene.

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

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

Chase v. Ryder, 1892 C. D. 219.

### **Rule 132. Claims of Defeated Parties after Interference.**

Whenever an award of priority has been rendered in an interference proceeding by any tribunal and the limit of appeal from such decision has expired, and whenever an interference has been terminated by reason of the written concession, signed by the applicant in person, of priority of invention in favor of his opponent or opponents, the primary examiner shall advise the defeated or unsuccessful party or

parties to the interference that their claim or claims which were so involved in the issue stand finally rejected.

### HISTORY.

Rule introduced in 1888. Discussion of rule in 56 O. G. 141.

Rule 130 of 1899 reads: "Amendments to the specification will not be received during the pendency of an interference, except as provided in Rules 106, 107, and 109."

### CONSTRUCTIONS.

May have a generic claim though defeated in an interference.

Kahn, 241 O. G. 623.

The winning party is entitled to the full benefit of the judgment, but where he seeks to broaden his claims the testimony and the ground upon which the judgment is based must always be considered in determining to what limits the privilege of enlargement of the claims may be extended.

Little v. Armstrong, 232 O. G. 935.

The grant should not be refused of claims for common subject-matter to a party who loses an interference upon an interpretation of the issue too narrow to cover the common subject-matter when such party had in his application throughout the interference claims broad enough to cover the common disclosure and the prevailing party fails to make any such claim either during or after the interference and takes a patent limited to the specific feature which was held to be disclosed by him alone. Decision of the Board of Examiner in Chief, 232 O. G. 939.

The Primary Examiner may and should consider whether the differences between the counts awarded U. and those awarded L. are patentable when the case is returned to him at the end of this priority contest and refuse to L. such counts as are not patentably different from those awarded U.

Leewellyn v. Upson, 227 O. G. 367.

After judgment a party may amend so as to avoid the issues.

The Underwood Typewriter Co. v. The Stenotype Co. and cases cited. 191 O. G. 831.

It is unfortunate perhaps that the Patent Office Practice permits amendments by the successful party to broaden the scope of his claims after a final decision in interference upon

claims for the same invention of narrower scope. That question, however, is not before us.

Horine v. Wende, 129 O. G. 2885.

The rejection upon reference to an opponent in an interference is for new ground. Such ground having been found to exist and the claims of the issue having been rejected thereon under Rule 132, the Rules (65-68) and the statute (4903) heretofore noted gives applicant the right to amend in an endeavor to avoid such references. Said rules, for the reason stated, are considered applicable to this application rather than Rule 142.

Klepetko, 126 O. G. 388.

Final rejections are given under Rule 132 and in cases where division is required without closing the case to amendments.

Sanders v. Hawthorne v. Hoyt, 125 O. G. 1347.

The rejection under Rule 132 is to be considered as a rejection in an *ex parte* case upon a new ground, an applicant is entitled to request a reconsideration and to point out why the rejection is not proper.

Lyon, 124 O. G. 2905.

Where a party to an interference did not appeal from the adverse decision of the Examiners-in-Chief upon priority, so that under Rule 132 of the Patent Office the claims which were involved in that interference stand finally rejected, such party has no standing before the Court in the interference as to these claims.

Fowler v. Boyce, 121 O. G. 1014.

Where the successful party to an interference inserts broader claims and his patent issues containing these claims, *held*, that the defeated party may contest the issue of priority of invention as to the broad claims upon making a *prima facie* showing that he invented the broad issue prior to the date established by the successful party.

Wende v. Horine, 118 O. G. 1070.

Where testimony has been taken in an interference proceeding, *held*, that new and patentable counts should not be suggested to the parties by the Examiner before judgment of priority of invention.

Freeman v. Parks, 117 O. G. 276.

The question whether the petitioner is entitled to the allowance of the new claims presented should be determined by a consideration of the principles announced in Corry & Barker v. Trout v. McDermoth, 110 O. G. 306.

Greuter, 116 O. G. 596.

Bar of prior invention by another established in an interference proceeding. The bar was therefore a new reason for rejection discovered and cited against the claim. The petitioner was entitled to amend in an effort to avoid this new ground. (*Ex parte* Harvey, 102 O. G. 621.)

Greuter, 116 O. G. 596.

Where an interference is dissolved neither party has a right to be heard upon the consideration of claims subsequently presented by the other party.

Meigs, Hughes & Stout v. Gerdon, 116 O. G. 184.

The Examiner can not require an applicant to insert or abandon certain claims in less time than established by law in an *ex parte* proceeding.

Hewlett, 108 O. G. 1052.

It is only the claims as they stand that are finally rejected, new and amended claims may be substituted.

Harvey, 102 O. G. 621-23.

A motion to extend time for taking appeal made on the last day of limit and set for hearing two days after refused by Examiner for want of jurisdiction. This was restored on motion.

Jean & Goode v. Hitchcock, 100 O. G. 3011-12, 1902 C. D. 342.

It would seem that the applicant would under the rules have the right of appeal from such a rejection—notwithstanding, etc.

Schüpphaus, 100 O. G. 2776, 1902 C. D. 339.

A claim can not be canceled from an application involved in an interference by the mere filing of an amendment to that effect.

Read v. Scott, 100 O. G. 449, 1902 C. D. 242.

It would undoubtedly lead to confusion to have the applications involved in an interference under the jurisdiction of the Examiner of Interferences subject to amendment and change before an independent tribunal of the Office.

Annand v. Spalckhaver, 97 O. G. 2741, 1901 C. D. 234.

This rule prohibits amendments canceling claims unaccompanied by a disclaimer or abandonment of the invention covered by them.

Curtis v. Marsh, 92 O. G. 1236, 1900 C. D. 127.

This rule was established for the purpose of imposing the duty of making a formal final rejection in the case of the defeated party to an interference proceeding, and not for the purpose of prescribing the extent and measure of that duty.

Booth, 56 O. G. 141, 1891 C. D. 107.

No claim should be allowed the defeated party which could by any latitude of construction be held to embrace matter common to the structure of both parties to the interference.

Booth, 56 O. G. 141, 1891 C. D. 107.

Pending an interference between application pending and patent inadvertently issued an amendment which does not come within the terms of Rules 106, 107, 109 will not be received or considered.

Bechman v. Johnson, 48 O. G. 673, 1889 C. D. 184.

This is a mere matter of regulation and does not deny the fundamental right of the applicant to prosecute his application by any suitable action thereon within the life of said application.

Reynolds, 24 O. G. 993, 1883 C. D. 56.

Amendments by B. and C. claiming the subject-matter claimed by D., but not relating to the issue in the pending interference are not within the prohibition of Rule 124.

Smith, 17 O. G. 447, 1880 C. D. 77.

*APPEALS TO THE EXAMINERS IN CHIEF AND TO  
THE COMMISSIONER AND PETITIONS TO  
THE COMMISSIONER IN THE EX PARTE  
PROSECUTION OF APPLICATIONS.*

**Rule 133. Appeal to Examiners in Chief.**

Every applicant for a patent, any of the claims of whose application have been twice rejected for the same reasons, upon grounds involving the merits of the invention, such as lack of invention, novelty, or utility, or on the ground of abandonment, public use or sale, inoperativeness of invention, aggregation of elements, incomplete combination of elements, or, when amended, for want of identity with the invention originally disclosed, or because the amendment involves a departure from the invention originally presented; and every applicant who has been twice required to divide his application, and every applicant for the reissue of a patent whose claims have been twice rejected for any of the reasons above enumerated, or on the ground that the original patent

is not inoperative or invalid, or if so inoperative or invalid that the errors which rendered it so did not arise from inadvertence, accident, or mistake, may, upon payment of a fee of \$10, appeal from the decision of the primary examiner to the examiners in chief. The appeal must set forth in writing the points of the decision upon which it is taken, and must be signed by the applicant or his duly authorized attorney or agent.

### CONSTRUCTIONS.

- (1) RULE IN GENERAL.
  - (2) LACK OF INVENTION.
  - (3) ABANDONMENT.
  - (4) INOPERATIVENESS.
  - (5) COMBINATION.
  - (6) AGGREGATION.
  - (7) WANT OF IDENTITY.
  - (8) DIVISION.
  - (9) REISSUE.
  - (10) APPEAL TO BOARD AND TO COMMISSIONER.
  - (11) SECOND APPEAL.
  - (12) INTERFERENCE.
  - (13) APPEAL TO BOARD—AFFIDAVITS UNDER RULE 75—SUFFICIENCY OF.
  - (14) CRITICISM AS TO WORDING AND DESCRIPTION.
  - (15) CLEARNESS—FUNCTIONAL.
  - (16) LACHES.
  - (17) TWO CLAIMS DIFFERENT.
  - (18) REJECTION ON APPLICANT'S PREVIOUS PATENT.
  - (19) REFERENCES.
  - (20) ADDITIONAL CASES.
- Rev. Stat., sec. 4909.

#### (1) *Rule in General.*

A refusal to grant a design patent on the specification presented appealable in the first instance of the Board.

Goldsohl, 189 O. G. 523.

An appeal is the proper remedy in case of a refusal to dissolve a trade-mark interference on the ground of non-interference in fact.

George & Baeker Co. v. The Laffray & Herrman Co.,  
188 O. G. 1051.



Question as to whether applicant has shifted ground appealable to Examiner-in-Chief.

Fast, 172 O. G. 552.

Applicant appealed to the Board who reversed the Primary Examiner but suggested other references and recommended that the application be rejected thereon. The Examiner rejected it on said references. Appeal to the Board.

Motsinger, 143 O. G. 1110.

B. has appealed, but in his assignment of errors does not challenge the decision of the Commissioner on the question of priority of invention, "and to this extent he is presumed to have acquiesced in the decision against him." (Bechman v. Wood, 15 App. D. C.)

Bechman v. Southgole, 127 O. G. 1254.

We have carefully scrutinized these several rules and we perceive nothing in them that can by any fair and reasonable construction be held to be inconsistent with the provisions of the statute.

U. S. ex rel. Steinmetz, 104 O. G. 853.

Proper subject matter for design patent, question appealable to Examiners-in-Chief.

Proudfit, 10 O. G. 585, 1876 C. D. 202, changing the practice; Pressprich, 11 O. G. 195, 1877 C. D. 18; Stetson, 36 O. G. 343, 1884 C. D. 20; Schulze-Berge, 42 O. G. 293, 1888 C. D. 4; Groves, 89 O. G. 1671; Sherman & Harnes, 89 O. G. 2067; Hale, 92 O. G. 1437.

Rule does not enumerate mutually exclusive points of appeal in such sense that one must be wholly different from another. The subject matter of each appeal is the rejection of a claim and not the reasons upon which it was rejected.

Briggs, 75 O. G. 1854, 1896 C. D. 17.

Question of whether design has patentable merit is not subject matter for an interlocutory appeal.

Walter, 62 O. G. 1205, 1893 C. D. 26.

Questions involving the rejection of a claim are not reviewable on petition.

Tobie, 50 O. G. 992, 1890 C. D. 28; Kuhn, 58 O. G. 1256, 1892 C. D. 46.

From the judicial acts of the Examiner an appeal lies to the Board, from his executive acts the appeal is to the Commissioner.

Krake, 1869 C. D. 100; Morton, 1871 C. D. 169.

(2) *Lack of Invention.*

Where claims are rejected the appeal is to the Examiners-in-Chief.

Davis, 109 O. G. 1068.

The question of completeness of conception to constitute invention relates to the merits and is appealable to the Board.

Auerbach & Gubing v. Wiswell, 108 O. G. 289-90.

Pertinency of reference.

Kerr, 28 O. G. 95.

Novelty and utility.

Buchanan, 1879 C. D. 288.

As to whether application contains patentable subject matter.

Underwood, 1872 C. D. 120.

(3) *Abandonment.*

The abandonment referred to is of the invention. Questions as to abandonment of the application are reviewable on petition.

Mygatt, 184 O. G. 801.

Question of abandonment of invention appealable to Board.

Springer, 120 O. G. 2754.

Whether a reissue omitting the claims in interference is an abandonment of the invention disclosed therein is a question appealable to the Examiners-in-Chief.

Lattig & G. v. Dean, 111 O. G. 301.

Questions relating to the merits and to abandonment are appealable to the Examiners-in-Chief.

100 O. G. 3012.

(4) *Inoperativeness.*

The question whether certain elements necessary to an operative combination are brought into the claims is obviously one that relates to the merits.

Lawton, 172 O. G. 259; Du Montay, 1879 C. D. 195;

Muhl, 1880 C. D. 117; Ferguson, 56 O. G. 1334,

1891 C. D. 143; Brisbane, 107 O. G. 109; Davidson,

120 O. G. 2753; Nenner, 122 O. G. 1379.

(5) *Combination.*

A claim for an illegitimate combination, including diverse inventions, should be rejected and appeal taken to Examiners-in-Chief.

46 O. G. 1391, 1889 C. D. 100; 83 O. G. 593, 98 O. G. 2364.

Lack of patentable combination. Aggregation.

Ellis, 1876 C. D. 140; Pintsch, 1877 C. D. 43; Keith, 1876 C. D. 93.

Cases that pass on the subject matter of this rule:

Ellis, 1876 C. D. 140; Kuth, 1876 C. D. 93; Pintsch, 1877 C. D. 43; Barcellos, 1880 C. D. 4; Ketson, 1881 C. D. 40; Eastman, 57 O. G. 410, 46 O. G. 139, 1889 C. D. 100, 1891 C. D. 178; McClellan, 59 O. G. 1763, 1892 C. D. 125; Dodge, 125 O. G. 665.

(6) *Aggregation.*

Questions of aggregation appealable to the Examiner-in-Chief.

Baker, 1889 C. D. 232.

Baker, 1889 C. D. 232; Feucht, 88 O. G. 2066.

(7) *Want of Identity.*

The question as to whether or not an applicant is entitled to amend his trade-mark application, is a question of new matter reviewable on petition.

Benach, 197 O. G. 241.

New matter goes to Examiner-in-Chief.

Fadem & Berman, 155 O. G. 553; Thompson, 183 O. G. 781.

New matter not appealable to Board.

Edwards, 108 O. G. 1051.

If the Examiner is of the opinion that the amendment constitutes new matter he should reject the claims affected thereby, and appeal should be taken to the Examiners-in-Chief.

Smyth, 114 O. G. 762.

A petition asking that the Examiner be instructed that it is not proper to insist upon cancellation of alleged new matter is premature before the Examiners-in-Chief have decided that the amendment is of that character.

Schmidt, 110 O. G. 603.

Questions of "Claims involve new matter" or are "unfounded in the disclosure" appealable to Examiners-in-Chief.

Hoegh, 100 O. G. 453.

Amendments involving the departure of invention from the original disclosure raise no question for the Examiners-in-Chief, unless they consist of new claims, either in whole or in part, or unless they alter or enlarge the meaning of old claims.

Gabel, 55 O. G. 863, 1891 C. D. 65.

When the objection of new matter is that it is merely in the descriptive part of the specification or drawing and does not effect the scope of the claim, an interlocutory appeal lies to the Commissioner; but when new matter appears in or affects a claim the appeal lies to the Examiners-in-Chief.

Suler, 59 O. G. 1431, 1892 C. D. 112.

For want of identity with the invention originally disclosed.

McDougall, 1880 C. D. 147; Lanstrom, 1880 C. D. 118; Bennett, 35 O. G. 1004; Woodruff, 1880 C. D. 90; Howlett, 1902 C. D. 338; Chapman, 120 O. G. 2446; Nenninger, 122 O. G. 1397; Nicolin & Oehsenreiter, 56 O. G. 1565, 1891 C. D. 155; Turner, Van Beck & Brown, 56 O. G. 1708, 1891 C. D. 165; Burt, 49 O. G. 1986, 1889 C. D. 251; Teller, 113 O. G. 548, 97 O. G. 191; Courville, 96 O. G. 2061, 1901 C. D. 125.

(8) *Division.*

Cases that pass on the subject matter of this rule.

Hulbert, 1894 C. D. 1; Frasch, 109 O. G. 1338; Tuttle, 113 O. G. 1967; Teller, 113 O. G. 548; Richardson, 112 O. G. 1751; Barnes, 115 O. G. 247; Gally, 115 O. G. 802.

See notes to Rules 41, 42.

(9) *Reissue.*

The questions of inadvertence and laches in applying for a reissue will not be reviewed upon petition.

McCombs, 105 O. G. 2057.

Whether the facts set forth in the statement filed with a reissue application constitute inadvertence accident, or mistake is one pertaining to the merits, and is appealable to the Board.

Murphy & Atkinson, 56 O. G. 1449, 1891 C. D. 149.

(10) *Appeal to Board and to Commissioner.*

An appeal was taken both to the Board and to the Commissioner in person. The case was decided a second time by the Commissioners on appeal from the Board.

W. v. T., 101 O. G. 2825.

Applicant appealed to the Board in an interference matter, then concluded that he ought to have appealed to the Commissioner after time limited for appeal had expired. The petition to transfer appeal to the Commissioner was refused.

Beck v. Long, 100 O. G. 451.

(11) *Second Appeal.*

It is well settled that a second appeal fee is not required upon taking a second *ex parte* appeal to the Examiners-in-Chief from the rejection by the Primary Examiner of an Applicant's claims.

Cheney v. Venn, 125 O. G. 1703.

See also note to 146.

If new references are cited by the Examiner after appeal to the Board which references should have been cited before appeal, applicant will not be required to pay a second fee.

Dysart, 34 O. G. 1390.

(12) *Interference.*

A decision of the Examiner-of-Interferences refusing to enter judgment on the record is not reviewable in an interlocutory appeal.

Mulligan v. Tempest Salve Co., 119 O. G. 1924.

Questions of non-interference in fact are not appealable to the Board of Examiners-in-Chief.

Kaczander v. Hodges & Hodges, 118 O. G. 836.

Questions of patentability arising under Rule 109 should be reviewed, if at all, in the first instance by the Examiners-in-Chief.

Lemp v. Ball, 115 O. G. 249.

The question whether the Examiner was right in rejecting the claims under the provision of Rule 96 would not be considered upon this petition if the final rejection was regarded as regular.

Schulze, 114 O. G. 1550.

Interference decided adverse to G. for want of diligence on his part, D. being a foreign inventor, G. petitioned Commissioner to order a reconsideration. Refused. G.'s remedy is by appeal to the Examiners-in-Chief.

Gallagher v. Desprackels, 114 O. G. 973.

The Examiners-in-Chief called the Primary Examiner's attention to the fact that one of the parties to the issue apparently had no right to make a claim to one count of the interference. The Examiner dissolved the interference as to this count. Appeal should be to the Examiners-in-Chief.

Dittgen v. Parmenter, 107 O. G. 1098.

A denial of motion to amend under Rule 122 is appealable to

E. I. C., 101 O. G. 1831.

The decision on a motion of a party to an interference to

amend his application by inserting claims from his opponent's patent is appealable to the Board.

B. v. F., 99 O. G. 862-3.

Notice to dissolve an interference brought on various grounds among other interferences in fact appeal dismissed by Board because appealable directly to Commissioner. *Held*, as this question was involved with the right to make the claim that the Board should have decided it.

O. & P. v. C. v. R., 99 O. G. 670.

(13) *Appeal to Board—Affidavit Under Rule 75—  
Sufficiency of.*

Sufficiency of affidavit under Rule 75 a question of merits.

Hanby, 183 O. G. 1031.

As to whether said affidavit under Rule 75 must show diligence is appealable to Board.

Hanby, 182 O. G. 511.

Cases that pass on the subject matter of this rule.

Boyer, 49 O. G. 1985, 1889 C. D. 249; Donovan, 52 O.

G. 309, 1890 C. D. 109; Foster, 105 O. G. 261; Mars-  
tetter, 118 O. G. 2250; Nordstrom, 115 O. G. 1327.

(14) *Criticisms as to Wording and Description.*

Whether the structure recited is sufficient to sustain the whereby clause is appealable to the Board.

173 O. G. 1081.

An appeal from a requirement of the Examiner that an alleged erroneous description should be inserted goes to the merits, and is appealable to the Board.

Braseir, 125 O. G. 2365.

The question of the propriety of defining an article by reference to its mode of manufacture seems to be one which may be considered properly by the Examiners-in-Chief in connection with the other questions of patentability.

Warren, 120 O. G. 2755.

The requirement that unnecessary matter be canceled from the drawing and specification of a design case is a mere ruling as to the form of the application and is not appealable to the Examiners-in-Chief.

Mygatt, 118 O. G. 1685.

The question as to the meaning of a word in claims held to go to the merits and to be appealable to the Examiner-in-Chief.

Beucher, 104 O. G. 310.

Objection that added element of one of several claims is

old and well known and does not patentably distinguish claim goes to merits.

101 O. G. 499.

Sufficiency of description appealable to Examiners-in-Chief.

Coe, 81 O. G. 2086, 1897 C. D. 187.

As to whether the drawing sufficiently illustrates the invention.

Kitson, 81 C. D. 49; Barcellos, 80 C. D. 4.

(15) *Clearness—Functional.*

The objection that claims are functional apparently appealable to the Board.

Stimpson, 160 O. G. 1271.

When the objection that a claim is functional, is appealable to the Commissioner and when to the Board.

Plumb, 131 O. G. 1165.

From the rejection of a claim because it is distinguished from the previous state of the art only by a functional limitation appeal in the first instance is to the Examiners-in-Chief.

Morgan, 101 O. G. 2568, 1902 C. D. 451.

Rejection under Rule 96 appeal to Board.

97 O. G. 192.

Rejections of functional claims are appealable to the Examiners-in-Chief.

Halfpenny, 73 O. G. 1135, 1895 C. D. 91.

Question as to functional claim relates to merits.

Williams, 61 O. G. 423, 1892 C. D. 213.

The question of "incomplete combination of elements," and an objection that a claim covers only the function of a machine, involves the merits and are appealable to the Examiners-in-Chief in the first instance.

McClellan, 59 O. G. 1763, 1892 C. D. 125.

An appeal from an objection that a claim is so lacking in clearness that no certain meaning can be gathered from it, is appealable to the Commissioner; but when the vagueness relates to the bounds of the invention the appeal lies to the Board.

Reynolds, 1874 C. D. 119.

(16) *Laches.*

A question as to the propriety of rejecting a claim presented after the time limited under Rule 96 is appealable to the Examiners-in-Chief.

*Ex parte* Swift, 111 O. G. 2494; *Ex parte* Post, 112 O. G. 1214; *Myero v. Brown*, 112 O. G. 2093.

Laches in applying and inadvertences are questions that may only be appealed to the Board.

McCombs, 105 O. G. 2057.

Where an applicant who has been in interference seeks, after a decision of priority in his favor, to amend his claims, and the Examiner rejects his amendment as covering matter which applicant has claimed too late, the question should go to the Examiners-in-Chief.

Woodward, 60 O. G. 1052, 1892 C. D. 179.

Neither the rules nor the law confer upon the Commissioner the dangerous power of determining what appeals seasonably made are intended for delay.

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

(17) *Two Claims Different.*

Whether two claims are patentably different is appealable to the Board.

Chapman, 120 O. G. 2446, 1902 C. D. 416.

Whether certain features are novel and claimable as such must be appealed to the Examiners-in-Chief.

Petzold, 55 O. G. 1651, 1891 C. D. 95.

(18) *Rejection on Applicant's Previous Patent.*

Where the Examiner rejects a claim as not patentable in view of the allowance to the applicant of another claim, *held*, that the remedy is by appeal to the Examiners-in-Chief and not by petition:

Besant, 116 O. G. 2531.

It being settled that it is proper in some cases to reject upon reference to applicant's allowed case, the question whether the particular rejection was proper goes to the Examiners-in-Chief.

Davidson, 93 O. G. 191, 1900 C. D. 163.

Where the Examiner holds that there is no proper line of division and rejects a claim upon the allowed case, the question whether his holding is correct relates to the merits and is appealable to the Examiners-in-Chief. It will not be reviewed upon petition.

Osborne, 92 O. G. 1797.

Where an application was rejected on a previously allowed application taken cumulatively with a patent and the applicant petitioned the Commissioner for relief from such action, the question was appealable to the Examiners-in-Chief.

Seymour, 65 O. G. 751, 1893 C. D. 127.

The question whether or not the Examiner should cite as



a reference an applicant's former patent, the application for which was co-pending with the present application, is one pertaining to the merits and not reviewable on petition.

McDonald, 64 O. G. 857, 1893 C. D. 99.

(19) *References.*

A dispute as to the date of a foreign patent cited as a reference will not be considered on petition.

Beck, 105 O. G. 1781.

(20) *Additional Cases.*

Cases that pass on the subject matter of this rule.

Bitner, 140 O. G. 256; Millett v. Reed, 125 O. G. 2764; Mygatt, 121 O. G. 1675; Beath, 111 O. G. 2220; Kinney, 110 O. G. 2235; Harvey, 102 O. G. 622; Story v. Criswell, 100 O. G. 683, 1902 C. D. 262; Holland, 99 O. G. 2548-49; Keith, 97 O. G. 551, 1901 C. D. 155; Myers, 64 O. G. 859, 1893 C. D. 103; Johnson, 89 O. G. 1341; Kuhn, 58 O. G. 1256, 1892 C. D. 46; Thomson, 56 O. G. 1203, 1891 C. D. 138; Laskey, 48 O. G. 539, 1889 C. D. 181; Warren, 12 O. G. 2755.

### **Rule 134. Prerequisites.**

There must have been two rejections of the claims as originally filed, or, if amended in matter of substance, of the amended claims, and all the claims must have been passed upon, and except in cases of division all preliminary and intermediate questions relating to matters not affecting the merits of the invention settled, before the case can be appealed to the examiners in chief.

#### *HISTORY.*

The first sentence was in the Rules of 1869. The rest of the rule was added, substantially, in 1871. The words, "Not affecting the merits of the invention," were not in the Rules of 1871 or 1873, but are found in Rules of 1876.

#### *CONSTRUCTIONS.*

That the claim of the applicant for a patent shall have been twice rejected by the Primary Examiner is jurisdictional and a condition precedent to any right of appeal

whatever. Such rejection has not been made in this case, and it can not be substituted by an order of rejection.

Mann v. Brown, 214 O. G. 1026.

Where, after thorough discussion of references with an Examiner, an issue has been reached and the applicant has received a second rejection upon the same claims in view of the same references he has a right to appeal at the time, notwithstanding the fact that the Examiner did not designate his action as a final action.

McPhail, 141 O. G. 1162.

Whether the words used in the claims are objectionable as alternative must be settled before appeal taken.

Phillips, 135 O. G. 1801.

Whether words used in the claims are objectionable as alternative must be settled before appeal taken.

Phillips, 135 O. G. 1501.

Formal objections should be remedied before the appeal is forwarded.

Dodge, 125 O. G. 665.

Under Rule 134 appeal can not be taken until all formal questions relating to matters not affecting the merits of the invention have been settled.

Thomas, 124 O. G. 623; Dodge, 125 O. G. 665.

The Examiner was right in refusing to forward the case until formal objections were removed.

Mygatt, 111 O. G. 2493.

The Examiner can not reject finally a claim that has been amended in matter of substance in one action.

Slaughter, 105 O. G. 498.

Appeal can not be taken on a part of the claims rejected.

Benjamin, 103 O. G. 1680; Holland, 99 O. G. 2548-549, 1902 C. D. 199.

The amendment changed the wording of the claims and strictly construed they might be held to set forth features of construction not specifically included in the previous claims and therefore they can not be considered the same, although for the practical purposes of the examination the real invention is the same. Amendment entered and claims stand rejected.

Courville, 96 O. G. 2061, 1901 C. D. 125.

It is the fact of a second rejection and not the language of the letter that is material. However, the Examiners are instructed to state definitely that the rejection is final, hereafter. They may, however, reconsider the case after final rejection if it is advisable in their judgment.

Kendall, 93 O. G. 1754.

The refusal of the Examiner to forward to the Examiners-in-Chief an appeal taken from his action holding that an application was not a proper divisional application, *held*, to have been properly made. Petition under Rule 145 proper.

Fuller, 57 O. G. 1883, 1891 C. D. 243.

The setting forth of the points of appeal are not of the essence of the proceeding, and do not confer jurisdiction as in appeals to the Court of Appeals. If the statement is defective the opponent may demand a better statement.

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

The first letter did not state that the claims were rejected, but after calling attention to certain formal objections, he cited references anticipating the claims (see Siliman, 34 O. G. 1389). After the formal objections had been eliminated the applicant was advised the references were adhered to. These actions justified the applicant in believing that there were two rejections and the appeal held to be proper.

Mill, 40 O. G. 919, 1887 C. D. 92.

Under Rule 129 two rejections are necessary to give either the Examiners-in-Chief, or the Commissioner, appellate jurisdiction of an application.

Mill, 40 O. G. 919.

An example of the setting forth of points of appeal.

Huntly v. Smith, 1880 C. D. 182.

Reasons for appeal not necessary to confer jurisdiction. If reasons are insufficient opponent may move to correct.

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

Amendments in matter of substance are such changes as affect the nature of the subject matter of the claim by the addition, or omission of certain features, or elements changing the character of the invention as at first set forth, and which must amount to something more than a mere change of phraseology.

Winchester, 1880 C. D. 92. (Hammond, 1872 C. D. 149.)

Neither the Commissioner nor the Examiners-in-Chief should act upon a case unless the case is in condition to go immediately to issue if the Examiner is reversed.

Mewes, 72 C. D. 163.

The rule excludes all amendments, except special amendments after the case leaves the Examiner.

Hammond, 1872 C. D. 149.

**Rule 135. Examiner's Statement of Grounds of Decision.**

Upon the filing of the appeal the same shall be submitted to the primary examiner, who, if he find it to be regular in form, and to relate to an appealable action, shall within ten days from the filing thereof furnish the examiners in chief with a written statement of the grounds of his decision on all the points involved in the appeal, with copies of the rejected claims and with the references applicable thereto, giving a concise explanation of the invention claimed and of the subject matter of the references so far as pertinent to the appealed claims. The examiner shall at the time of making such statement furnish a copy of the same to the appellant. If the primary examiner shall decide that the appeal is not regular in form or does not relate to an appealable action, a petition from such decision may be taken directly to the Commissioner, as provided in Rule 142.

***HISTORY.***

This statement of the reasons of appeal should point out distinctly and specifically the supposed errors of the Examiner's action and should constitute a brief of the argument upon which the applicant will rely in support of his appeal. Before the appeal is entertained by the Board, this statement will be submitted to the Primary Examiner who will make answer in writing touching all the points involved therein. Rule 42 of 1873.

The provisions making the Primary Examiner the judge of whether or not the appeal is regular in form was inserted in Rules of December 1, 1879, and also the requirement of copies of the rejected claims and references applicable thereto.

***CONSTRUCTIONS.***

The statement should have been complete in itself and not have referred to the decision in another case previously considered by the Examiner-in-Chief unless the decision was

cited in support of some contention of law which could be understood without understanding the invention.

Morrison, 157 O. G. 1271.

After new grounds of rejection the Examiner offered to let applicant withdraw his appeal, which he did not do. . Too late after appeal.

Blackmore, 140 O. G. 1209.

The practice of raising objections for the first time in the the statement upon petition is not approved. To entertain such objections upon the petition where argument is made by the applicant in opposition to them would impose upon the Commissioner labor which should be performed as far as possible by the Examiner. The additional objection will not be considered upon this petition. (Trade-mark.)

Jos. B. Funke Company, 124 O. G. 2902.

If the Examiner discovers a new reason for rejection he should direct the attention to it of both the applicant and the Examiners-in-Chief. The applicant may thereupon continue to prosecute the application as though the new reference had been cited before the appeal had been taken or he may continue the prosecution of the appeal. (Mevey, 56 O. G. 805.)

Williams, 116 O. G. 298.

Where an appeal is regular in form it is the duty of the Examiner to answer it.

U. S. ex rel. Steinmetz & Allen Com., 109 O. G. 549.

No appeal from reasons for a decision.

Gebboney, 105 O. G. 976.

It is improper for an Examiner to refer in his answer to matters not of record. If after appeal he shall discover new grounds for rejection he shall notify applicant and the Examiners-in-Chief.

Dolan, 99 O. G. 2321, 1902 C. D. 193.

It is improper for an Examiner to cite a decision of the appellate tribunal in a pending case to which applicant has not access.

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

Petition to expunge argumentative matter and new reasons of rejection from the Examiner's statement refused.

If the Examiner discovers new grounds for rejection after appeal, he should call the attention of both applicant and the Board to them. Applicant may then elect whether to continue the appeal or to withdraw the same and be heard by the Primary Examiner.

Mevey, 56 O. G. 805, 1891 C. D. 115.

The present rules do not require that the reasons of appeal shall constitute a brief of the argument upon which applicant will rely, but is only that the point or points of decision from which appeal is taken shall be specified.

Callahan, 50 O. G. 990, 1890 C. D. 24.

All the references and reasons should be recited at or before final rejection; but if from any causes important reasons or references shall be overlooked or omitted the attention of the appellate tribunal should certainly be called to them.

Parker, 36 O. G. 119, 1886 C. D. 15.

If new references or reasons are discovered by the Examiner after appeal taken, applicant should be promptly informed of them.

Parker, 36 O. G. 119.

If the appeal is taken the Examiner should not only urge his objections to the validity of the combination (the appeal being on this point), but also cite all references he may have affecting the question of novelty, whether relating to the alleged combination or to other matters claimed in the application.

Pintsch, 1877 C. D. 43.

The Examiner should not raise new objections in his statement

Shippen, 1875 C. D. 126.

The Examiners-in-Chief are the judges of the sufficiencies of the reasons for the appeal. The principal Examiner can not refuse to allow an appeal because the reasons are insufficient.

Young, 1875 C. D. 124.

The Examiner's objections should be definite, such as will allow of an issue being formed.

Evarts, 1871 C. D. 39.

### **Rule 136. Appeal from Examiners-in-Chief to Commissioner.**

From the adverse decision of the board of examiners in chief appeal may be taken to the Commissioner in person, upon payment of the fee of \$20 required by law.

Rev. Stat., sec. 4910.

*CONSTRUCTIONS.*

Amendment of the claims suggested and case remanded with authorization to the Examiner to admit the amendment and allow the claims.

Burnham, 172 O. G. 260.

The practice of submitting new claims to Commissioner on appeal disapproved.

Sears, 148 O. G. 279.

Apparently no appeal from refusal to make a recommendation under rule.

Ball v. Flora, 117 O. G. 2362.

In the exercise of his authority the Commissioner may assign an appeal to the Assistant Commissioner for hearing.

U. S. ex rel. Stapleton v. Com., 93 O. G. 2532, 95 O. G. 1049.

The statute and rules allow applicants two (now one) years in which to appeal to the Commissioner.

Williams & Raidabaugh, 40 O. G. 1337.

If applicant goes back to the Primary Examiner and amends his case he waives his right of appeal.

Williams & Raidabaugh, 40 O. G. 1337.

It has been the established practice of the Office where both the lower tribunals are agreed upon the facts, not to overthrow their decisions thereon unless clearly at variance with the testimony.

Walpuski v. Jacobsen & Faben, 1876 C. D. 114; Fawcett v. Graham, 1869 C. D. 113; Dickson v. Kinsman, 1880 C. D. 211; White v. Purdy, 1870 C. D. 115; Berry v. Stockwell, 1869 C. D. 47; Blanchard v. Stain, 1870 C. D. 55; Russell v. Scow, 1874 C. D. 23.

A case that passes on the subject matter of this rule.

Millett v. Reed, 125 O. G. 2764. See note to 68.

### **Rule 137. Oral Hearing Before Examiners in Chief— Briefs.**

The appellant shall on or before the day of hearing file a brief of the authorities and arguments on which he will rely to maintain his appeal.

If the appellant desire to be heard orally, he will so indicate when he files his appeal; a day of hearing will then be fixed, and due notice thereof given him.

*CONSTRUCTIONS.*

A written certificate of counsel will not be stricken out as a supplemental brief.

Lindstrom v. Lipschutz, 120 O. G. 90.

Briefs on interlocutory motions and appeals need not be printed, but must be filed before the hearing.

Royce v. Kempshall, 116 O. G. 2011.

In all cases briefs should be filed before the hearing. Only one brief.

Newcomb & Lemp, 109 O. G. 2171.

**Rule 138. Application Remanded for Reconsideration on Affidavits.**

Affidavits received after the case has been appealed will not be admitted without remanding the application to the primary examiner for reconsideration; but the appellate tribunals may in their discretion refuse to remand the case and proceed with the same without consideration of the affidavits.

*HISTORY.*

Rule 135 of 1879 reads as follows: "If affidavits be received, under Rule 75, after the case has been appealed, the application will be remanded to the Primary Examiner for reconsideration."

In 1880 affidavits "under Rules 75 or 86" were specified.

In 1892 Rule 141 read as in 1879, except "under Rule 75" was omitted.

Present rule introduced in 1906.

*CONSTRUCTIONS.*

Apparently the fact that the Commissioner did not remand the case was equivalent to refusing to consider the affidavits.

Merrill, 199 O. G. 618.

When presented after final rejection or appeal affidavits or other new evidence should be accompanied by a verified showing of reasons for the delay, such as required by Rule 68, in the case of tardy amendments touching the merits of an application.

Pierce, 121 O. G. 1347.

It is a well-settled principle that no evidence should be considered on appeal that was not before the tribunal from



which appeal was taken. The affidavit referred to may have a material bearing. For this reason the case is remanded.

Penn Tobacco Co., 125 O. G. 2764, 1906 C. D. 523.

It is probable that in order to have it passed upon, the applicant should have requested that his application be remanded to the Examiner with leave to amend by inserting said claim. It could then have been brought up in regular order.

Garrett, 122 O. G. 1047, 1906 C. D. 645.

An affidavit has been filed in behalf of Townsend, by one Fredenreich, which is wholly expert in character. At the hearing a motion was made in behalf of Copeland to strike this affidavit from the record. It was argued that if the motion to reopen was granted the affidavit might form a basis for or necessitate the introduction of expert testimony. Motion granted.

Robinson v. Townsend v. Copeland, 106 O. G. 997.

### **Rule 139. Decisions of Examiners in Chief.**

The examiners in chief in their decision shall affirm or reverse the decision of the primary examiner only on the points on which appeal shall have been taken. (See Rule 133.) Should they discover any apparent grounds not involved in the appeal for granting or refusing letters patent in the form claimed, or any other form, they shall annex to their decision a statement to that effect with such recommendation as they shall deem proper.

Should the examiners in chief recommend the refusal of letters patent in the form claimed, their recommendation will stand as a rejection and will reopen the case for amendment or showing of fact, or both, before the primary examiner, responsive to that rejection. The recommendation of the examiners in chief is binding upon the primary examiner unless an amendment or showing of facts not previously of record be made which, in the opinion of the primary examiner, overcomes the recommendation. The ap-

plicant may waive the right to prosecution before the primary examiner and have the case reconsidered by the examiners in chief upon the same record, and from an adverse decision of the examiners in chief on reconsideration, appeal will lie to the Commissioner, as in other cases. The applicant may also waive reconsideration by the examiners in chief and appeal directly to the Commissioner.

Should the examiners in chief recommend the granting of letters patent in an amended form, the applicant shall have the right to amend in conformity with such recommendation, which shall be binding upon the primary examiner in the absence of new references or grounds for rejection.

If the Commissioner, in reviewing the decision of the examiners in chief, discovers any apparent grounds for refusing letters patent not involved in the appeal, he will, before or after decision on the appeal, give reasonable notice thereof to the applicant; and if any amendment or action based thereon be proposed, he will remand the case to the primary examiner for consideration.

Rev. Stat., secs. 482 and 4909.

### CONSTRUCTIONS.

- (1) RULE IN GENERAL.
- (2) DECISION CONFINED TO ISSUE.
- (3) RECOMMENDATIONS.
- (4) PRIMARY EXAMINER.
- (5) ADDITIONAL CASES.

#### (1) *Rule in General.*

As these claims were presented as a substitute for the appealed claims, the decision of the Examiner-in-Chief will be affirmed, and if the amendment containing proposed claims two and three, corrected as above indicated, is presented within 20 days from the date hereof, the Examiner is authorized to

enter it and allow the claims in the absence of further references.

Child, 231 O. G. 919.

It is well within the jurisdiction of the Commissioner to order a dissolution of the interference and the rejection of plaintiff's claims if convinced that the issues were barred by public use and therefore not patentable. From the decision of the Primary Examiner rejecting plaintiff's claims when the case goes back from the Board of Examiners-in-Chief plaintiff would have an appeal through the tribunals of the Patent Office to this court.

U. S. ex rel. Dwiggins v. Ewing Com. of Patents, 214 O. G. 1025.

If a new reference is cited the case should be reconsidered by the Primary Examiner.

Wade, 158 O. G. 704.

In the absence of one member of the Board, a decision by the other two constitutes a decision by the Examiners-in-Chief. If the two disagree, the case should be set down for hearing before the three.

Hilbig, 131 O. G. 1687.

New reference found after appeal in view of this fact, final judgment on the appeal will be suspended for 30 days. If an amendment or other action is filed, the case will be remanded to the Primary Examiner for further consideration. If no action is taken the right to amend will be regarded as waived, and a decision, considering the new reference, will be given. If the applicant does not desire to amend a rehearing of the appeal will be granted for argument on the new reference if desired.

Farling, 128 O. G. 886.

No decision upon patentability against any of the parties can be founded on the testimony taken upon the question of priority without permitting such parties to offer further evidence if they so desire.

Niedringhaus v. Marquard v. McConnell, 118 O. G. 1683.

An appeal includes only such claims as have been duly entered in the case.

Durafort, 110 O. G. 2017.

If only two members are present and these have opposite opinions, the Primary Examiner is affirmed.

91 O. G. 2207.

The Board of Examiners-in-Chief is a tribunal of appellate and not original jurisdiction. The principle Examiner can not submit a question to it without expressing an opinion.

Coleman, 1880 C. D. 205.

The third and fourth paragraphs are designed to secure the applicant from the effect of a final adjudication of his application upon ground of which he has had insufficient notice.

Reynolds, 24 O. G. 993, 1883 C. D. 56.

The applicant is entitled to an opinion which shall embody the judicial opinion of the Examiners-in-Chief.

Buchanan, 79 C. D. 288.

The Board may affirm the decision of the Examiner while it may discard entirely the adequacy of his reasoning.

Jones, 1874 C. D. 53; Rockwell, 1870 C. D. 111.

The board should give the reasons for their decisions in all cases

Chamblant, 1873 C. D. 119; Buchanan, 288.

(2) *Decision Confined to Issue.*

The alleged grounds seem to have been disregarded, and the appeal received upon the real or substantial grounds. Evidence not before Primary Examiner considered.

Harrison v. Shoemaker, 117 O. G. 1164.

An appeal in the Patent Office is analogous to an appeal in equity and not to writ of error, the whole case may be examined *de novo*.

Packard v. Sandford, 79 C. D. 314; Dickson v. Kinsman, 80 C. D. 211.

In an interference case appealed to the Board on the question of priority, it is improper to go into the question of identity of invention.

Brown v. La Dow, 1880 C. D. 199.

The Primary Examiner not having alluded to the question of new matter, the Examiners-in-Chief should have confined their action to the making of the statement to the Commissioner, as the rule provides.

Smoot, 1877 C. D. 51.

The Board cannot go outside of the record . . . as to cite new references.

Jones, 1874 C. D. 53.

As to matter of executive detail.

Rockwell, 1870 C. D. 111; Merton, 1871 C. D. 169.

The Board of Examiners-in-Chief are not confined in their decision to affirming, or reversing, the reasons for rejection given by the Primary Examiner.

Jones, 1874 C. D. 53; Rockwell, 1870 C. D. 111.

Remarks disparaging the character of the invention are of doubtful propriety.

Morse v. Clark, 1872 C. D. 58; Cheesborough, 1869 C. D. 18.

(3) *Recommendations.*

Had they so intended, they would have annexed a recommendation to this effect to their decision.

Norhind, 192 O. G. 989.

Where the Examiner-in-Chief recommended that certain claims be rejected upon new grounds stated by them, *held*, that the action of the Examiner in rejecting the claims upon the return of the case to him, for the reasons stated in the decision of the Examiner-in-Chief, was clearly a proper one, and since it was a new ground of rejection it opened the case for further prosecution as to the subject-matter of rejected claims.

Luten, 170 O. G. 482, citing Dietrich, 142 O. G. 568.

The recommendation is binding on the Primary Examiner.

White, 157 O. G. 1243.

Practice analogous to that under Rule 126 as set forth in Holz v. Hewitt. The Examiner is therefore directed to enter a rejection *pro forma* upon the grounds stated by the Examiners-in-Chief, and any other reasons which have not been considered by the Examiners-in-Chief.

Shaw, 131 O. G. 1687.

The suggestion of claim by the Examiners-in-Chief does not reopen the case for the admission of other claims.

Myers, 119 O. G. 902.

If the Examiners-in-Chief had concluded that amendment was proper and necessary to protect the invention set forth in the claims before them, it is to be presumed that they would have made a recommendation to that effect.

East, 116 O. G. 1186.

They made no recommendation under Rule 139 as they presumably would have done if they thought applicant was entitled to other claims.

Bourne, 110 O. G. 2510.

The Examiner is justified in holding that a case is beyond his jurisdiction when his ruling rejecting a claim has been affirmed on appeal unless the Examiners-in-Chief annex a specific recommendation to their decision.

LeBlanc, 98 O. G. 225.

If the Board recommend amendment of the drawings and specification, such amendments may be made, but not others.

Beck, 97 O. G. 2746.

It is proper for the Examiners-in-Chief to make a suggestion to that effect, when on the consideration of claims on appeal they become convinced that the applicant has made an invention, but has claimed it in a wrong form.

97 O. G. 1175.

The interpretation adopted by the Board in a collateral matter, as for example the mode of operation of the device is not binding upon the Primary Examiner.

Ex parte Christensen, 92 O. G. 1619.

It is not competent for the Board to recommend that an application for a process be changed to an application for an apparatus.

Adams v. Murphy, 91 O. G. 2373, but see case on rehearing, Adams v. Murphy, 91 O. G. 2209.

Such statement and recommendation can not be ignored or pleaded as of no effect. It is binding upon the Examiner and can not be disregarded.

Letellier, 81 O. G. 1611, 1897 C. D. 171.

A decision by the Examiners-in-Chief affirming a rejection by an Examiner, subject to certain recommendations made by them, is such an affirmance of the Examiner's decision that a petition to the Commissioner asking "that a record decision affirming the patentability of the invention in issue may be entered" will not lie.

McGowan, 1892 C. D. 168, 60 O. G. 735.

No appeal from a refusal of the Examiners-in-Chief to make a recommendation.

Schmiedl v. Walden, 1891 C. D. 150, 56 O. G. 1563.

The recommendations of the Examiners-in-Chief are not binding upon the Primary Examiner, but there is no good reason why an applicant should be put to the delay involved in going through a second appeal, simply to have the Examiners-in-Chief formally affirm what they have already decided in substance.

Williamson, 56 O. G. 1060, 1891 C. D. 128.

The Examiner may not allow amendments without the authority of the Commissioner after the decision of the Examiners-in-Chief.

Williams & Raidabaugh, 40 O. G. 1337.

An example of recommendation by the Board.

Dod v. Cobb, 1876 C. D. 196.

The authority of the Board extends to passing upon the merits of claims merely as they come from the Primary Examiner. It is also proper for them to make suggestions of alterations in either the specifications or claims, or with ref-

erence to other matters which may appear to them to be of importance either to the Office or to the applicant, and they would be derelict if they did not, but such suggestions have no binding force.

Dodge, 1872 C. D. 202.

(4) *Primary Examiner.*

If the Board and the Primary Examiner disagree, the case should be referred to the Commissioner, but not if amendments have been made.

Allen, 109 O. G. 1071.

When a case is sent back to the Primary Examiner with the recommendation of the Board, the Examiner must confine his decision to the point suggested by the Board.

Kirkbride, 1876 C. D. 123.

When a case is appealed to the Board the Examiner loses control over it, except to enter the amendment required by the Board. He can not require further amendments.

Brunner, 1872 C. D. 62.

(5) *Additional Cases.*

Cases that pass on the subject matter of this rule.

Duryea & White v. Rice, 123 O. G. 2627; Myers, 122 O. G. 351; Steinmetz, 117 O. G. 901; Burrowes, 110 O. G. 599.

**Rule 140. Rehearings.**

Cases which have been heard and decided by the Commissioner on appeal will not be reopened except by his order; cases which have been decided by the examiners in chief will not be reheard by them, when no longer pending before them, without the written authority of the Commissioner; and cases which have been decided by either the Commissioner or the examiners in chief will not be reopened by the primary examiner without like authority, and then only for the consideration of matters not already adjudicated upon, sufficient cause being shown. (See Rule 68.)

## CONSTRUCTIONS.

History reviewed.

Daniels v. Morgan, 1889 C. D. 150, 47 O. G. 811, 1889 C. D. 182.

Mandamus will not lie to compel the Commissioner to reopen an interference.

Briggs v. Commissioner, 257 O. G. 645 and 648.

Rehearing petition for 201 O. G. 569.

New information from client after appeal. A new trial not granted.

Wright, 193 O. G. 509.

An interference dissolved because of inoperativeness of one of the party's device not *res adjudicata*.

Moore Co. v. U. S., ex rel. Colburn Gloss Co., 191 O. G. 293.

A judgment against an applicant in a trade-mark case, precludes a new application.

Bostion Wine & Spirits Co., 189 O. G. 524.

A mistake as to the attitude of a witness toward a party is not such an excuse for not calling him as would justify reopening of the case to take his testimony.

Webber v. Wood, 184 O. G. 553.

There is no rule of the Patent Office providing for petitions for new trial or review, but the power to entertain such petitions and reopen the case has been exercised in the Office in two former instances.

Cooper and Somers v. Bannester, 112 O. G. 1480; Griffiths v. Taylor, 91 Ms. A. D. 1908.

The right assumed to exist, however.

Browne v. Dyson and Sand, 173 O. G. 866.

An interference between B. D. and L. I. did not appeal. After time for appeal had expired, D. conceded priority to L. and the case was reopened and judgment rendered in favor of L.

Browne v. Browne Dyson & Land, 173 O. G. 866.

Whether or not a ruling that the year begins to run at a certain date is correct or not will not be considered until the application is held to have been abandoned unless the error is clear.

Inman, 160 O. G. 1038 (149 O. G. 309).

A rehearing on the grounds that the tribunal was not informed as to the state of the art will not be granted because it was petitioner's duty to see that it was so informed.

White v. Powell, 160 O. G. 776.



Rehearing of an appeal will not be granted to present matter not presented to the Primary Examiner.

White v. Powell, 160 O. G. 776.

A rehearing peculiarly within the discretion of the Examiner of Interferences.

Denlap v. Creveling v. Rector, 160 O. G. 776.

Counsel considered evidence as proper rebuttal matter, when it was refused as not proper; rebuttal motion was made to open case for the purpose of extending the time to take testimony . . . is not an appealable question.

Goodfellow v. Jolly, 115 O. G. 1064; Christenson v. McKenzie, 117 O. G. 277; Wickers and Furlong v. Weinsurm, 129 O. G. 2501; California Fruit Cannery Association v. Raticliff-Sanders Grocer Co., 146 O. G. 958.

An applicant who prosecutes broad claims to a final conclusion has no right to the reopening of the case for the insertion of narrower claims. Snow, 80 O. G. 1271. And after a decision by the Court of Appeals new claims may not be admitted because the appellate tribunal put an unexpected construction upon the claims.

Millans, 135 O. G. 1122.

An interference decided against a party who afterward found he had an earlier application in the Office which would have altered the result apparently. A petition to withdraw such case from issue for the purpose of an interference refused, and an interference refused on a renewed application after that one had lapsed.

Cutler v. Hall, 135 O. G. 449.

The Court of Appeals having held that a second interference involving claims differing only in scope from those involved in the first interference should not have been declared, the latter will not be reopened for the purpose of allowing the issue of second interference to be contested therein.

Wende v. Horine, 130 O. G. 1311.

That a patent showing the invention was issued to one of the contestants in an interference proceeding, will not warrant a rehearing.

Latshaw v. Duffy v. Kaplan, 130 O. G. 980.

The granting of a rehearing or a refusal to grant the same are matters within the discretion of the tribunal having jurisdiction of the case at the time, and it is a well-settled principle that the Commissioner will not control that discretion except to prevent irreparable injury.

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

If the interference is to be reopened at all it should be done at once and not delayed until appellant has had an opportunity to test the sufficiency of the present record before the various tribunals.

Newell v. Clifford v. Rose, 125 O. G. 665.

It appears that the Commissioner of Patents, under the provisions of Rule 143 of the Patent Office which does not prescribe a specific time within which an appeal may be taken from a decision of the Examiner of Interferences, and under the provisions of Section 4904 of the Revised Statutes, which prescribes that certain appeals may be taken within such time as the Commissioner of Patents may prescribe, "not less than 20 days," fixes the time for appeal in this case at 20 days.

Wenzelmann v. Oerholt, 123 O. G. 995.

No cause for surprise if a rehearing is not granted so as to excuse taking an appeal within the time limit.

It is well settled that a mere request for a rehearing does not extend the limit of appeal.

Felsing v. Nelson, 122 O. G. 1722.

An interference case will not be reopened for the introduction of testimony which can only result in a denial of a patent and not in altering the result as to priority.

Dunbar v. Schellenger, 121 O. G. 2663.

The question of abandonment of an application decided by a former Commissioner will not be reviewed except upon a clear and satisfactory showing that the Commissioner was misled by the applicant, as to the facts, and mere expert affidavits can not be regarded as such showing.

Kinsman v. Strohm, 120 O. G. 2127.

An interference which has been reopened to admit deposition connecting an exhibit with original testimony will not be again reopened to correct said deposition.

Autenrieth & Kane v. Sorensen, 120 O. G. 1164.

If a second application is presented in place of one rejected it should be examined far enough to ascertain its nature and then rejected as *res adjudicata*.

Millitt and Ried, 128 O. G. 2836; Kenney, 118 O. G. 2936; Com. of Pat. v. Whitely, 71 U. S. Sup. Ct.

No amendment allowed between appeals. It is fundamental that the same case must be presented to the higher tribunal as was considered by the tribunal from which the appeal is taken.

Marks, 118 O. G. 2253.

The doctrine of *res adjudicata* applies to the decisions of

this Office as well as to decisions of the Courts. The new application should be received and rejected for above reason.

Kinney, 118 O. G. 2253.

Where it is alleged that there was error in the Examiner's decision because of a misunderstanding as to an oral waiver made at the hearing, *held*, that the error must be corrected by motion for rehearing promptly made and that it can not be corrected long after the limit of appeal has expired.

Hansen v. Wardwell, 116 O. G. 2008.

An applicant has no right to amend after decision on appeal except under unusual circumstances and where a proper showing is made.

Amer, 116 O. G. 595; Lesler, 117 O. G. 595.

An interference will not be reopened after decision upon an *ex parte* request of one of the parties, but only upon motion served upon the opposing party and supported by a showing of good reasons.

Smith v. Locklin, 116 O. G. 2009.

There is no appeal from a decision refusing to grant a rehearing.

Cole v. Zarbock v. Greene, 116 O. G. 1451.

Where a decision is rendered by a tribunal and it appears that an affidavit relating to the matters at issue was filed too late to be considered, *held*, that the appellant should move for a rehearing, rather than appeal, since matters not considered by the tribunal of original jurisdiction will not be reviewed on appeal.

Ocuppaugh v. McElroy, 115 O. G. 1847.

Case will not be reopened to take further testimony when it appears that the testimony already taken relates wholly to the right of the opposing party to make claims.

Osborn v. Austin, 115 O. G. 1065.

If there is error it should have been corrected by rehearing or by appeal. The decision has become final by the expiration of the limit of appeal, and it is now too late to raise the question of error, even by concession of priority by the successful party.

Humphrey v. Fickert, 115 O. G. 803.

A motion for a new trial is proper pending an appeal.

Clement v. Richards v. Meissner, 111 O. G. 1627.

The applicant is not entitled to demand consideration of new claims after appeal, whether they are patentable or not.

Bourne, 110 O. G. 2510.

The fact that a party failed to recollect certain facts is an insufficient reason for a new trial. Moreover the alleged new

evidence must be sufficient so that it might produce a different result.

*French v. Halcomb*, 110 O. G. 1727.

If the Examiners-in-Chief recommended the rejection of a claim upon a reference not cited by the Primary Examiner and the Primary Examiner adopts such suggestion, the applicant has a right to amend.

*Burrowes*, 110 O. G. 599.

Examiner extended limit of appeal upon the showing that applicant was a resident of England.

*Wilderman v. Simm*, 109 O. G. 275.

Where a motion to vacate a judgment of priority is not based upon newly discovered evidence, the question of primary importance is why the facts were not sooner presented by proper motion.

*Fowler v. Boyce v. Temple et al. v. Dyson v. McBerty*, 107 O. G. 543.

After a case has been decided by the Court of Appeals it must ordinarily be regarded as disposed of.

*Starkey*, 105 O. G. 745.

It is the practice not to grant hearings upon petitions to reopen an application after the same has been considered and disposed of on appeal.

*Borton*, 104 O. G. 851-2.

No appeal lies from a refusal of a lower tribunal to grant a rehearing.

*Reynolds v. Bean*, 101 O. G. 2821.

Refusal to rehear is not an appealable action.

*Macey v. Laning v. Caster*, 101 O. G. 1608.

A delay of six months with failure to show reasons of delay, or that irreparable injury will be the result of a refusal. Petition denied.

*Harrison*, 100 O. G. 3013.

Newly discovered evidence—a new trial for must show greatest diligence. Where a letter was found which had been wrongly labeled and therefore overlooked. New trial denied.

*Robinson v. Townsend v. Copeland*, 100 O. G. 683.

It is not the practice of the office to set for hearing motions for rehearing unless an examination of the record shows that a rehearing ought to be granted.

*Adams v. Murphy*, 91 O. G. 2373.

It is within the discretion of the Commissioner to refuse to reconsider a matter upon a new application.

*Fay v. Com.*, 90 O. G. 1156.

Manifest error in law, being ground for a new trial, is also ground for a rehearing under Rule 144.

Green v. Hall v. Siemens v. Field, 1889 C. D. 161, 47 O. G. 1631, c. c. 1889 C. D. 110-156, 88 O. G. 459, 81 O. G. 2087.

The Court of Appeals has several times considered and denied the right of an applicant to burden the office with successive applications relating to the same supposed invention.

Barratt, 87 O. G. 1075; Fay, 90 O. G. 1157; Mond, 91 O. G. 1437; Nealon, 1897 C. D. 174, 81 O. G. 1787.

The Examiner can not, under the rules, after a decision of the Examiners-in-Chief, admit even allowable claims, unless such claims are recommended by the Examiners-in-Chief, without written authority from the Commissioner.

Hunter, 1897 C. D. 161, 81 O. G. 504.

Where on appeal only broad claims were presented which were refused, *held*, that the case should not be reopened to admit narrow claims.

Snow, 1897 C. D. 48, 80 O. G. 1271.

Rehearings should not be lightly granted or sought without weighty reasons.

Atwater, 1897 C. D. 36, 80 O. G. 965.

A new trial allowed after two years, and after patent issued.

Hibbard v. Richmond, 80 C. D. 136.

To a motion for a rehearing diligence is a prerequisite.

Wicks v. McAvoy, 80 C. D. 190; Aldrich v. Bingham, 71 C. D. 90; Covell v. Maxim & Radley, 69 C. D. 78; Munson, Imlay, etc., 72 C. D. 183; Stevens v. Putnam, 80 C. D. 160.

Evidence which is merely cumulative is insufficient to warrant a new trial.

Stevens v. Putnam, 80 C. D. 160.

Misstatements in an argument are not grounds for a new trial.

Wicks v. McAvoy, 80 C. D. 190.

On motions for a rehearing the question of fact always is, whether the findings of fact in the former decision are either wholly unsupported by or clearly in conflict with the evidence.

Packard v. Sandford, 79 C. D. 314; Huttner v. Knox, 79 C. D. 247.

Except upon a new state of facts or upon grounds which would support a motion for a new trial.

Lee v. Walsh, 79 C. D. 29; Huttner v. Knox, 79 C. D. 281; J. L. Mason, 70 C. D. 20.

A motion for a rehearing can not be entertained after the case adjudicated has been amended by the removal of one or more of the claims.

Hoffman, 79 C. D. 247.

Cases that pass on the subject matter of this rule.

Atwood, 162 O. G. 1183; Bitner, 140 O. G. 256.

Rehearings are not favored in any case, and only upon special circumstances. Motion for rehearing will not be entertained where there has been long delay in bringing it. Rehearings must be applied for within the limit of appeal.

Messinger, 78 O. G. 1903, 1897 C. D. 1.

A motion for a rehearing will not be entertained by the Commissioner for the purpose of enabling an applicant to make a further presentation of his case when there is no satisfactory showing, but that he might have done so in the first instance.

Atley, 1892 C. D. 38, 58 O. G. 1091; Jerome, 1892 C. D. 29, 58 O. G. 945.

A rejected application for a patent, pending on appeal in the Supreme Court of the District of Columbia, is not open to review by the Commissioner of Patents.

Jerome, 1892 C. D. 29, 58 O. G. 945.

Where a party misjudged his proper line of defense a new trial will not be granted on that account.

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

A motion for rehearing ought to be governed, as far as practicable, by rules which in Courts govern new trials.

Spielman, 1891 C. D. 162, 56 O. G. 1707.

A case will not be reopened that has been decided by the Assistant Commissioner merely because the applicant wants a hearing by the Commissioner himself.

Hughes, 891 C. D. 148, 56 O. G. 1448.

Motions for rehearings by parties to an interference should be heard at one time.

Green v. Hall v. Siemens v. Field, 1889 C. D. 156, 47 O. G. 813.

An applicant by appealing his case waives his right to move for a rehearing, even if the appeal is unauthorized.

Gill v. Scott, 29 O. G. 949.

A notice in the following words, "Limit of Appeal ten days," should be taken as ten days from the receipt of the notice.

Pearson v. Lister v. Reixach, 1883 C. D. 119, 24 O. G. 1175.

As I understand the decision of the Honorable, the Secretary of the Interior in the case of *Manz v. Swab v. Cherry*, dated February 24 and May 29, 1883, a motion for reopening a case or for a new trial in this office is not to be determined by the same rules which obtain in courts of law, and even if there was such laches as would prevent a new trial at law, still if the new evidence is such as would change the result it should be admitted in a new trial.

*Eccard v. Drawbaugh*, 1883 C. D. 50, 24 O. G. 301.

It is an established rule in the Office that a rehearing in a case will only be granted on such a showing of the merits as would entitle a mover to a new trial in a suit at law.

*Dod v. Cobb*, 1876 C. D. 196; *Hovey v. Muller*, 1873

C. D. 26; *Pattee v. Russell*, 1872 C. D. 255; *Marsh v.*

*Dodge*, 1876 C. D. 245; *Wicks v. McAvoy*, 1880 C. D.

136; *Spielman*, 1891 C. D. 162, 56 O. G. 1707.

A and B, application is in interference with C. C fails to comply with the rules of the office, and a patent is demanded by and granted to A and B by default. C proves to have been the prior inventor. A and B buys C's rights. A rehearing refused as all rights were lost by laches of C.

*Jones v. Greenleaf*, 1879 C. D. 23, 15 O. G. 560.

Where default is made a new trial will be more readily granted.

*Loring v. Hall*, 1879 C. D. 8, 15 O. G. 471.

A case will not be reopened on the ground of newly discovered evidence, when the matter constituting the new evidence is not affirmatively set out in the affidavits.

*Dodd v. Cobb*, 1876 C. D. 196; *Pattee*, 1872 C. D. 255.

The new evidence must be such as could not have been produced on the former trial.

*Merrill & Merrill v. Glidden*, 1876 C. D. 243; *Kenyon*

*v. Wesson*, 1871 C. D. 10; *Pattee*, 1872 C. D. 255;

*Huttner v. Knox*, 1879 C. D. 281; *Marsh v. Dodge*,

1872 C. D. 245.

A case will not be reopened on the ground that the attorney misunderstood the issue.

*Dod v. Cobb*, 1876 C. D. 196.

After the taking of testimony the case reopened to admit evidence tending to negative novelty. If the testimony had been of a different character it would not have been admitted.

*Wood v. Morris*, 1897 C. D. 39.

From the decision of the Examiner refusing to act appeal is directly to the Commissioner. A case should not be re-

opened to admit evidence that could have been as well produced at the former trial.

Marsh v. Dodge, 1872 C. D. 245; Gillen, 1877 C. D. 20, 11 O. G. P. 419.

A rehearing ought never to be granted except upon the clearest showing that the petitioner has suffered injury by reason of defects in his case, which were unavoidable and for which he is not to blame.

Mason Inlay, 1872 C. D. 183.

Newly discovered evidence must be such as would necessarily change the result of the trial.

Merrill & Merrill v. Glidden, 1876 C. D. 243; Hamilton v. Fisher, 1871 C. D. 271.

An instance of a violation of this rule by the Board of Examiners-in-Chief.

Strain, 1870 C. D. 75.

Newly discovered evidence as to abandonment deemed sufficient to secure a new trial.

Disston v. Emerson, 1870 C. D. 84.

Cases that passes on the subject matter of this rule.

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

## **Rule 141. Jurisdiction.**

After decision by an appellate tribunal the case shall be remanded at once to the primary examiner, subject to the applicant's right of appeal, for such action as will carry into effect the decision, or for such further action as the applicant is entitled to demand.

### *CONSTRUCTIONS.*

See notes to Rules 78, 100, 101, 123, 140, 146.

Hereafter cases will be considered to be "pending before" the Examiner-in-Chief for the purpose of entertaining a motion for rehearing until the expiration of the statutory or specified limit of appeal or until such appeal shall have been taken.

Floyd, 129 O. G. 482.

The Examiner of Interference has no jurisdiction to extend the time for taking an appeal from a decision of the Examiners-in-Chief, even when the Board is not sitting.

Townsend v. Ehret, 125 O. G. 2051.



The Primary Examiner has no authority to extend the limit of appeal from his decision upon motion brought after said limit has expired.

Becker & Patitz v. Edwards, 123 O. G. 1990.

Motions to restore jurisdictions.

Hewitt v. Steinmetz, 122 O. G. 1395; Duryea & White v. Rice, Jr., 122 O. G. 1395.

Upon a motion to restore the jurisdiction of the Examiner of Interferences in a case pending on appeal before the Examiners-in-Chief, for the purpose of considering a motion to reopen the interference to take newly discovered evidence only a proper *prima facie* case is necessary the substance will be considered by the Examiner of Interferences.

Dunbar v. Schellinger, 118 O. G. 2536.

A motion to restore jurisdiction must be accompanied by a proper showing.

Brunker v. Schweigerer, 1903 C. D. 189, 104 O. G. 2148.

When limit of appeal has expired the tribunal before which the matter is pending has lost jurisdiction. The only way to restore it is by petition to the Commissioner.

Benger v. Burson, 1900 C. D. 185, 93 O. G. 1917;

Osborn v. Hotsapillar, 1901 C. D. 16, 94 O. G. 583.

Where a case was rejected on August 15, 1895, under Rule 68, then in force, not on references, but on the ground that there had been intentional delay in prosecution, and such rejection made final under Rule 65, *held*, that as these rules have been revoked and there has been no final rejection on references, the action under Rule 65 is set aside and the case opened for reconsideration.

Higgins, 1897 C. D. 73, 80 O. G. 2037.

The Commissioner will not authorize the reopening of a case by the Primary Examiner, under Rule 142, in the absence of good and sufficient reasons for long delay on the part of the applicant in presenting his reasons therefor, or a showing of great hardship or irreparable injury.

Goldsmith, 1892 C. D. 41, 58 O. G. 1092.

Cases that pass on the subject matter of this rule.

Klepetko, 126 O. G. 387; Merrill, 116 O. G. 1186; Recklinghausen & Potter, 113 O. G. 1146; Gilmer, 109 O. G. 1337; Buck, 94 O. G. 222; Cutten & Fraser, 98 O. G. 2172; Grant, 93 O. G. 2532; McCallum v. Bremer, 93 O. G. 1918.

**Rule 142. Petition to Commissioner, Without Fee.**

Upon receiving a petition stating concisely and clearly any proper question which has been twice acted upon by the examiner, and which does not involve the merits of the invention claimed, the rejection of a claim or a requirement for division, and also stating the facts involved and the point or points to be reviewed, an order will be made directing the examiner to furnish a written statement of the grounds of his decision upon the matters averred within five days. The examiner shall at the time of making such statement furnish a copy thereof to the petitioner. No fee is required for such a petition. Hearing will be granted in the discretion of the Commissioner.

*HISTORY.*

In the Revision of the Rules of March 3, 1885, Rule 140 read:

Decisions of the Examiner upon preliminary or intermediate questions, not involving the merits of the case, once repeated, will be re-examined by the Commissioner upon written statements of the points of appeal, and of the grounds of the Examiners' decisions, as in other appeals. For appeals of this class no fee is required.

Commissioner Montgomery gave his reasons for the change of practice as follows:

*Washington, D. C., November 25, 1885.*

*To the Patrons of the Patent Office:*

I desire to invite especial attention to the recent amendment to Rule 140 of the Rules of Practice of this Office.

Before proposing this amendment I had thought the matter over very carefully, and had come to the deliberate conclusion that the subject of "interlocutory appeals" which obtained in this Office should be substantially corrected and a substitute therefore provided.

In the *first* place, it is exceedingly difficult to understand how an *appeal* can be taken from no action at all.

In the *second* place, it is many times next to impossible

to ascertain the particular thing which is complained of, and—

In the *third* place, the practice of permitting the Examiners to answer an appeal at any time before the hour of hearing, is not conducive to an intelligent examination of the questions involved.

I have decided, therefore, to establish a little different practice, which, it is to be hoped, will result in expediting all these matters, in more clearly presenting the questions, and in general benefit to the Office and its patrons. I have no doubt that every practitioner will agree that this is desirable.

It will be observed that the rule, as amended, contemplates that instead of taking a loose appeal, a petition shall be filed reciting as definitely as possible what has been done and the particular grievance which is complained of, and asking specifically for the remedy which is desired.

I suggest the following as an ordinary example of such a petition:

*Sixth.* That your petitioner was then informed by Office letter of the ..... day of ..... that the former requirement relating to claim *one* would be adhered to, and that no action would be had on the merits of either claim until said amendment so required had been made;

Wherefore your petitioner requests that the Examiner in charge of such application be advised that such amendment so required by him to said *first* claim be not insisted upon, and directed to proceed to examine both said remaining claims upon their merits.

A hearing of this petition is desired on the ..... day of .....

....., *Applicant.*

....., *Attorney for Applicant.*

Of course, this example must be varied to suit the particular facts of each case. It is not intended that a petition shall be required to contain a recital of *all* that has taken place since the filing of the application, but it would be well to state the date and the substance of the first action which is complained of, and which is sought to be reviewed, and thereafter to trace through, step by step, the things which were done both by applicant and the Office, which, in applicant's opinion, makes it necessary for him to ask the relief.

If any material facts are alleged in such petition which are not shown by the records or files of the case, such petition

should be verified. I suggest the following form of verification:

STATE OF ..... }  
COUNTY OF ..... } ss:

On this ..... day of .....  
....., A. D. 1885, personally appeared before me, a notary public in and for said county ....., the above-named petitioner, who, being by me duly sworn, says that he has heard said petition read and knows its contents, and that the same is true, except as to the matters therein alleged on information or belief, and as to those matters he believes it to be true.

.....,  
*Notary Public.*

Upon receiving such petition an order will be made, as follows:

Referred to the Examiner in charge of Division .....  
....., who is directed to file an answer on the ..... day of ....., which answer shall exhibit the reasons, if any, why the request of the petition hereto attached should not be granted.

.....,  
*Commissioner.*

This answer will be required to be filed at least five days before the day of hearing, which day of hearing will be, when consistent, the one named by the petitioner.

I am also considering the subject of requiring copies of all such answers to be furnished to appellants, the same as copies of all other communications. This, however, will be determined hereafter.

**CONSTRUCTIONS.**

- (1) MISCELLANEOUS.
- (2) PETITION.
- (3) EXECUTIVE QUESTIONS.
- (4) TWO REJECTIONS.
- (5) REFUSAL OF THE EXAMINER TO ACT.
- (6) VAGUENESS.
- (7) INTERFERENCES.
- (8) ADDITIONAL CASES.

(1) *Miscellaneous.*

A question involving the wording and not the substance of a claim is reviewable on petition.

Owen, 195 O. G. 1049.

Abandonment of application reviewable on petitions.

Mygatt, 184 O. G. 802.

A refusal of the Examiners to permit an amendment of the drawing is reviewable on petition where the question is what the disclosure is and not whether it is operative.

Bogvoslawsky, 179 O. G. 1107.

As the points relied upon by the petitioner are technical, it is necessary to call attention to the fact that the rule requires two actions by the Primary Examiners.

Frelisch, 173 O. G. 864.

A petition and complaint at the same time improper.

Eggan, 172 O. G. 1091.

Whether or not a ruling that the year begins to run at a certain date is correct or not will not be considered until the application is held to have been abandoned unless the error is clear.

Inman, 160 O. G. 1038 (149 O. G. 309).

Matter of sufficiency of time allowed to make claims under Rule 96 considered by the Commissioner.

Hillmunch, 141 O. G. 565.

It seems a petition will lie to direct the Primary Examiner to allow a claim that has been previously allowed on a previous application and on a renewal of the same.

Hay, 139 O. G. 197.

Sufficiency of affidavit under Rule 75 is not reviewable on petition.

Nordstrom, 115 O. G. 1327.

Questions of division are not reviewable by petition.

Emerson, 109 O. G. 1610.

Questions of new matter go directly to the Commissioner.

Edwards, 108 O. G. 1056.

The question of operativeness of invention may not be considered by the Commissioner under this rule.

Brisbane, 107 O. G. 1097.

Refusal to register a trade-mark on the grounds that the label showed a misunderstanding not reviewable on petition.

Zinn, 107 O. G. 703.

It is not in accordance with good practice to present a matter for consideration on appeal which has not been considered and passed upon by the tribunal below.

Repetto v. Stephens, 105 O. G. 1779.

The case presented to the Commissioner must be that presented to the Examiner.

McHarg v. Schmidt & Mayland, 105 O. G. 263.

Seems to be approved by C. of A. D. of C.

U. S. ex rel. Steinmetz v. Allen Com., 104 O. G. 853-6.

The question as to the propriety of disclosing records of the office is one properly reviewed on petition.

Robinson v. Copeland, 102 O. G. 466 *et. req.*

An appeal was taken both to the Commission and Board. The Commissioner decided the case a second time on appeal from the board.

101 O. G. 2825.

There is no more excuse for loose practice under this rule than there is for improperly prepared pleadings in court cases.

Grant, 1900 C. D. 199, 93 O. G. 2532.

The case must be twice acted upon.

Haug, 97 O. G. 192.

Proper subject matter for a design patent not a proper subject matter of petition.

Groves, 89 O. G. 1671.

Where a question of aggregation and unity and diversity of invention arise, the first question must be settled before petitioning the commissioner on the latter.

Feucht, 88 O. G. 2066.

The Commissioner will not consider an appeal taken from the action of an Examiner rejecting an application.

Kuhn, 1892 C. D. 46, 58 O. G. 1250.

The question of redundancy or multiplicity of claims is one of form and not one involving the merits, hence the proper remedy is by petition.

Lawn, 1891 C. D. 44, 54 O. G. 1561.

If the Examiner refused to receive a claim presented in an amendment because it is a departure from the original invention an appeal lies to the Commissioner.

Bennett, 35 O. G. 1004.

From a refusal by the Examiner to receive an amendment for the reason that it is a departure from the invention originally disclosed, an appeal lies directly to the Commissioner. In what cases an Examiner should refuse to receive an amendment for this reason. Bennett, 35 O. G. 1003. See Barker v. Mack, 1873 C. D. 123.

When a case is appealed to the Commissioner the entire case is before him and is subject to review.

Blythe, 30 O. G. 1321.

Where the reasons for requiring a division are given with clearness, his action will not be reviewed upon petition upon the allegation that the reasons given by him are insufficient.

Wallace, 18 O. G. 1686.

As to the form of claims.

Williams, 1876 C. D. 227.

There is no limit of time prescribed either by the law or rules within which an appeal shall be taken on interlocutory matters.

Little v. Little, Pillard and Sargent, 1876 C. D. 207.

### (2) *Petition.*

B has appealed, but in his assignment of error does not challenge the decision of the Commission on the question of priority of invention and to this extent he is presumed to have acquiesced in the decision against him.

Bechman v. Wood, 15 App. D. C. 487; Bechman v. Southgate, 127 O. G. 1254.

The first paragraph of the petition is not a request for specific relief, but is in the nature of a complaint. It does not ask that the Examiner's action be set aside or overruled. It has therefore no proper place in a petition.

Lewis, 109 O. G. 559.

Questions involving the merits of invention are appealable in the first instance to the Examiners-in-Chief. A petition must state the facts involved and the point or points to be reviewed.

Organ, 100 O. G. 231.

### (3) *Executive Question.*

Remedy by petition applies only where the Examiner has been requested to take a particular action and refused to do so after the reasons have been fully stated and considered.

Lewis, 109 O. G. 560.

The question whether a claim has been reasonably presented is an executive one.

Perkins, 189 C. D. 63, 55 O. G. 139.

If there is a disagreement between an Examiner and an applicant as to whether an amendment is a matter of substance, an interlocutory appeal lies to the Commissioner who will determine on such appeal not whether references which may have been cited meet or do not meet the case, but whether as a matter of language the amended claim presents the same idea or invention as the old ones.

Winchester, 1880 C. D. 92.

The only appeal from the executive action of the Examiner is the Commissioner in person.

Morton, 1871 C. D. 169.

(4) *Two Rejections.*

The practice prescribed (requiring two actions by the Primary Examiner) should be strictly followed.

Lendl, 115 O. G. 250; Shone, 99 O. G. 863.

Case dismissed as the question of division. It had not been twice acted upon.

Lovejoy, 108 O. G. 1053.

Two actions by the Primary Examiner are essentially prerequisite.

Shone, 99 O. G. 863, 100 O. G. 231-2; Lovejoy, 108 O. G. 1053.

Until there is an issue between the Examiner and applicant the right of petition does not ordinarily exist.

104 O. G. 1119.

There is a principle governing the regulations of Rule 145, that two actions should be made by the Examiner before a petition can be brought and this principle is that the issue between the Examiner and the applicant shall be well defined before a review of the requirement of the Examiner is asked for by the applicant. The practice of *pro formal* actions condemned.

Tyson, 101 O. G. 3105-06; Amand, 103 O. G. 661.

The practice of carrying up questions before they have been carefully considered by the Primary Examiner condemned. The Examiner can not be expected to answer matter brought up for the first time in the argument.

Amand, 103 O. G. 661.

Two actions by Primary Examiner necessary.

Auchn, 1892 C. D. 120, 59 O. G. 1761.

(5) *Refusal of Examiner to Act.*

If the applicant is not convinced by the reasons given by the Examiner, he should apparently appeal and can not compel further reasons by petition.

Leilich, 108 O. G. 561.

Refusal to act because case is *res adjudicata* may be reviewed under this rule.

100 O. G. 2775-6.

A petition asking that the Primary Examiner be directed to reconsider the claims will not be considered in the absence of any allegation that the final rejection was premature, the request apparently being made because applicant thought the Examiner was in error in rejecting the claims.

Eickelberg, 100 O. G. 2773.



An interlocutory appeal lies from a refusal of the Examiner to consider the merits of the claims as amended.

Hoffman, 1880 C. D. 247.

The question appealed is, however, whether the amendment shall be received or not, and the Examiner may reject the case for containing matter not warranted by the original papers after he has been directed by the Commissioner to receive the amendment.

Vaile, 37 O. G. 563; Bennett, 35 O. G. 1004.

Appeal lies to the Commissioner in person if the Examiner for any reason declines to examine the case upon its merits.

Barker & Mack, 73 C. D. 123; Bennett, 35 O. G. 1003.

An appeal from the Examiner's decision refusing to act upon an application for a design patent because the subject matter was the subject of a mechanical patent, appealable to the Commissioner direct and not to the Examiners-in-Chief. Practice changed, see Notes to Rule 133.

Morton, 1871 C. D. 169.

The Commissioner should not be called upon to instruct an Examiner until the case is properly before him on appeal.

Sellers, 1897 C. D. 164, 81 O. G. 803.

It is contrary to settled practice to remand a case for the decision and at the same time direct the lower tribunal how to decide it.

R v. C., 102 O. G. 466.

#### (6) *Vagueness.*

Objections that a claim is indefinite and that claims are substantially identical reviewable on petition.

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

An appeal from the Examiner's decision, that the claim is vague and depends for its novelty entirely upon a device described only by its function, is to the Commissioner.

Doten, 1877 C. D. 115.

An appeal as to the clearness and fulness of the specification is to the Commissioner.

Gould, 1876 C. D. 164.

#### (7) *Interferences.*

Before the interference proceeds further it should be positively determined whether or not these new references anticipate the issue.

Wright & Stebbins v. Hansen, 114 O. G. 761.

It is eminently improper to encumber the records of an

interference with irrelevant matter as to the conduct of some particular officer or employee of the Department.

*Duryea & White v. Rice*, 114 O. G. 761.

Questions of interference in fact appealable to Commissioner and not to Board apparently.

*Hein v. Shepard*, 106 O. G. 2062.

A mere request by a party having an application on file is not sufficient to warrant ruling upon questions of procedure and practice in which he happens to be interested. The time to bring up such questions is after an adverse decision has been rendered upon them.

*Hicks v. Costello*, 103 O. G. 1163.

An appeal from the decision of the Examiner of Interferences dissolving an interference is to the Commissioner in person.

*Marsh v. Dodge*, 72 C. D. 245.

#### (8) *Additional Cases.*

Cases that pass on the subject matter of this rule.

*Kaczander v. Hodges & Hodges*, 118 O. G. 836; *Lay*, 107 O. G. 2237; *Blackman v. Alexander*, 1900 C. D. 186, 105 O. G. 2058; *McCallum v. Brenner*, 1900 C. D. 186, 93 O. G. 1917; *Frasch*, 100 O. G. 1967; *Osborne*, 92 O. G. 1797; *Johnson*, 89 O. G. 1341; *Shearman*, 1898 C. D. 190; *Suter*, 1892 C. D. 112, 59 O. G. 1431.

### *APPEALS TO THE EXAMINERS-IN-CHIEF AND TO THE COMMISSIONER IN CONTESTED CASES.*

#### **Rule 143. Remedy by Appeal.**

In interference cases parties have the same remedy by appeal to the examiners in chief and to the Commissioner as in *ex parte* cases.

Rev. Stat., secs. 4904, 4909, 4910, 4911.

#### *CONSTRUCTIONS.*

The distinction between the two classes of appeals is recognized in the Rules of Practice. Rule 133 prescribes the conditions for Appeals from the Primary Examiner while Rule 146 provides for appeals in interference cases.

*Cheney v. Venn*, 125 O. G. 1703.

The question of patentability is not generally open in an appeal in interference cases.

Orcutt v. McDonald, Jr., and McDonald, 123 O. G. 1288;  
Wenzelmann & Overholt, 113 O. G. 995.

D. on the face of the record has no substantial standing in the interference, and H. identified with D. in interest should not be permitted to prolong the extensive delay which has already occurred on account of D.'s unwarranted appeal.

Dalton v. Hopkins v. Newman, 120 O. G. 906.

The question of right to make claims is different from that of interference in fact and will not be considered on appeal for the former reason.

Blackmore v. Hall, 119 O. G. 2523; Heintzelman & Co. v. Vraalstad & Doyle, 120 O. G. 906.

It is well settled that this court can not and should not interfere with such (interlocutory) rulings, unless perhaps, in extreme cases it should be necessary for the maintenance of the jurisdiction of this court.

Ritter v. Krakaw & Connor, Jr., 114 O. G. 1553-1554.

There is no appeal from a decision refusing a rehearing.

Carmichael v. Fox, 104 O. G. 1656.

Court of Appeals regards it as improper for them to adjudicate the question of priority before the question of patentability is fully settled.

Slaughter v. Halle, 102 O. G. 469.

Decisions (concurrent) of Office will be adhered to unless in a clear case.

Howard v. Hey, 95 O. G. 1647.

Appeal on question of Priority, Decision of Office, as to whether or not invention is shown by one applicant will be taken as conclusive.

Ostergren v. Tripler, 95 O. G. 837; Schupphaus v. Stevens, 95 O. G. 1452.

In general questions of patentability will not be considered on appeal. Explains Bachmeyer v. Wood, 89 O. G. 2459.

Newton v. Woodward, 93 O. G. 2320; Latham v. Armat, 97 O. G. 232.

Application of rule.

Brown v. La Dow, 80 C. D. 199; Adams v. Murphy, 91 O. G. 2207.

As the motion involves the question as to what constitutes proper evidence in a certain case, and is not one of merely office practice, it is a matter on which the Board of Appeals should be allowed to also express an opinion, especially in view of the fact that the Examiner of Interferences has

passed upon the point in rendering a final decision upon the question of priority.

Chambers v. Duncan, 1876 C. D. 82, 223.

An appeal from the decision of the Examiner of Interferences dissolving an interference is to the Commissioner in person.

Marsh v. Dodge, 1872 C. D. 245.

### **Rule 144. Briefs in Appealed Cases.**

Appeals in interference cases must be accompanied by brief statements of the reasons therefor. Parties will be required to file six copies of printed briefs of their arguments, the appellant ten days before the hearing and the appellee three days. (See Rule 163.)

#### *CONSTRUCTIONS.*

All briefs should have conspicuously printed thereon a statement designating the particular tribunal of the Patent Office to which the brief is addressed.

(Order), 218 O. G. 607.

U. S. Statutes excusing the printing of record, etc., in case of poverty does not apply to these appeals.

In re Mattulath Adam, etc., 173 O. G. 1082.

A brief filed after oral argument and near the close of the hearing admitted. If counsel for P. wished to file a reply-brief he should have requested permission of the Primary Examiner to do so, when the brief of Stevens was filed, and it was within the discretion of the Examiner to grant such a request.

Stevens v. Paterson, 142 O. G. 568. See note to Rule 163.

One brief. Supplementary brief after hearing not admissible.

Newcomb v. Lenmp, 109 O. G. 2171.

### **Rule 145. Right to Open and Close.**

The appellant shall have the right to make the opening and closing arguments, unless it shall be otherwise ordered by the tribunal having jurisdiction of the case.

**Rule 146. Jurisdiction.**

Contested cases will be regarded as pending before a tribunal until the limit of appeal, which must be fixed, has expired, or until some action has been had which waives the appeal or carries into effect the decision from which appeal might have been taken.

. See Rules 140, 141, 123, 100, 101.

*RECONSIDERATION OF CASES DECIDED BY  
FORMER COMMISSIONER.*

**Rule 147. Reconsiderations and New Trials.**

Cases which have been decided by one Commissioner will not be reconsidered by his successor except in accordance with the principles which govern the granting of new trials.

*CONSTRUCTIONS.*

Cases decided by former Commissioner will not be heard. Manifest error in law, being ground for a new trial, is also ground for a rehearing under Rule 144.

Green v. Hall v. Siemens v. Field, 1889 C. D. 161, 47 O. G. 1631.

History reviewed.

Daniels v. Morgan, 1889 C. D. 150, 47 O. G. 811; McDonough v. Gray v. Bell v. Edison, 1889 C. D. 9, 45 O. G. 1245; McDonough v. Gray v. Bell v. Edison, 1889 C. D. 9, 46 O. G. 1245; Nealson, 1897 C. D. 174, 81 O. G. 1787.

. Except upon a new state of facts or upon grounds which would support a motion for a new trial.

Lee v. Walsh, 79 C. D. 29; Huttner v. Knox, 1879 C. D. 281; J. L. Mason, 1870 C. D. 20.

*APPEALS OF THE COURT OF APPEALS OF THE  
DISTRICT OF COLUMBIA.*

**Rule 148. Appeal to Court.**

From the adverse decision of the Commissioner upon the claims of an application and in interference

cases, an appeal may be taken to the Court of Appeals of the District of Columbia in the manner prescribed by the rules of that court. (See appendix.)

Rev. Stat., sec. 4911; sec. 9, act of February 9, 1893.

### HISTORY.

The "Act to establish a Court of Appeals for the District of Columbia, and for other purposes," approved February 9, 1893 (27 Stats. 434, 436, ch. 74), as to Section 9, reads as follows:

Sec. 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the General Term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eight of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be and the same is hereby vested in the Court of Appeals created by this act; and in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals.

This act was held constitutional in *United States ex rel. Bernardin v. Duall*, Commissioner of Patents, 86 O. G. 995.

The word "interference" in section 9 of the act establishing the Court of Appeals of the District of Columbia interpreted and *held* not to mean and include disputes in trademarks under section 3 of the Trade-Mark law of 1881, but to be confined to an interference in patent law.

*Einstein v. Sawhill*, 65 O. G. 1918.

### CONSTRUCTIONS.

- (1) JURISDICTION.
- (2) APPEAL.
- (3) FINAL DECISIONS OF COMMISSIONER.
- (4) MOTIONS.
- (5) RECORD.
- (6) RULES.
- (7) WEIGHT GIVEN COMMISSIONER'S DECISIONS.
- (8) MANDAMUS.
- (9) EFFECT OF DECISION OF THE COURT ON COMMISSIONER.
- (10) MISCELLANEOUS.

(1) *Jurisdiction.*

We have no more jurisdiction to question the patentability of the counts in an interference proceeding than in an *ex parte* proceeding.

*Seewellyn v. Upson*, 227 O. G. 367.

The jurisdiction of the Court of Appeals of the District of Columbia to entertain appeals from the decisions of the Commissioner of Patents in proceedings relating to patents is limited to two classes—(1) Where the claims of an application for a patent or the reissue of a patent after having been twice rejected have been finally rejected on appeal to the Commissioner in due course of proceeding. (2) Where on an appeal to the Commissioner in an interference proceeding there has been a final decision on priority in favor of one of the parties thereto. (R. S. Secs. 4909, 4910, 4911.)

*Westinghouse v. Duncan*, 2 App. D. C. 8, 17, 26; *Union Distilling Co. v. Schneider*, 29 App. D. C. 1; *In re Fullager*, 138 O. G. 259.

The Court of Appeals of the District of Columbia has no jurisdiction to entertain an appeal from a decision of the Commissioner of Patents on a motion to dissolve an interference between an appellant for reissue and an original application holding that appellant had no right to a reissue on the ground that his showing of inadvertence, accident, or mistake was insufficient and that he had failed to excuse the long delay of more than two years in filing the reissue application, as such judgment does not constitute an adjudication of the question of priority between the parties.

*In re Fullager*, 138 O. G. 259.

The Court has jurisdiction of appeals from the Commissioner of Patents in certain matters defined by statute, but has no original jurisdiction to direct and supervise the administration of the affairs of the Patent Office. A petition to direct the Commissioner to allow petitioner to proceed with the taking of testimony refused.

*DeFerranti v. Lindmark*, 137 O. G. 733; *Neill v. Commissioner of Patents*, 82 O. G. 749.

The Act establishing the Court of Appeals did not by implication repeal the Statute providing remedy by bill in equity in a circuit court.

*Bernardin v. Vorhall and Seymour*, Commissioner of Patents, 78 O. G. 1740.

The statutes given right of appeal only in cases where the various tribunals of the Office have acted.

*Serrell v. Donnelly*, 129 O. G. 2501.

(2) *Appeal.*

Whether the patent was properly granted in view of the state of the art can not be considered in the Court of Appeals.

Lautenschlager v. Glass, 249 O. G. 1223-1224.

Where upon appeal, on a motion to dissolve, the Commissioner held that C., the junior party, had no right to make the claims because of an inoperative disclosure, and thereafter, at C.'s request, changed the order from one of dissolution to one awarding priority to G., an appeal was taken to the court: *Held*, that a motion to dissolve is interlocutory and the Commissioner is without authority to convert an appeal on such a motion into an appeal on priority.

Caspor v. Gold, 34 App. D. C. 194, and 36 App. D. C. 302, cited by the Commissioner, distinguished.

Carlin v. Goldberg, 236 O. G. 1222.

Patentability considered in an interference suit even if evidence was taken before the Patent Office.

Slinguff v. Sweet, 230 O. G. 659.

Appeal lies to the Court of Appeals from an exercise of the supervisory power of the Commissioner rejecting a claim.

Moore Com. v. U. S. *ex rel.* Chott, 192 O. G. 520.

Apparently there is no appeal from a decision dissolving an interference under Rule 122, because it is not a final decision, nevertheless if the motion is made to change the decision to a final action, as to priority it may be appealed from.

U. S. *ex rel.* Scott et al. v. Moore, Com., 180 O. G. 607; (Cooper v. Gold, 36 App. D. C. 302-307).

A motion by E. that he be made a party to an appeal to the Court of Appeals of the District of Columbia taken by F. from a decision of the Commissioner of Patents on a motion to dissolve holding that F. had no right to make the claims of the issue because of his delay in filing his reissue application involved in this interference denied on the ground that the Commissioner's decision did not result in award of priority to E., and therefore F. could not bring him before the Court by an appeal. For the same reasons E.'s motions to have the docket entry changed and to dismiss F.'s appeal denied.

*In re* Fullagar, 138 O. G. 259.

Where an interference is declared between three parties and all present testified and but one of the parties takes an appeal to the Court of Appeals, the case made out by the party who has not appealed can not be considered in the determination of the controversy.

Richard v. Meissner, 114 O. G. 1831.



(Interference) the argument of Porter's counsel have failed to satisfy us that the case before us is one of those extraordinary cases in which the court may be called upon to inquire whether there is a patentable invention involved.

Potter v. McIntosh, 127 O. G. 1995.

(3) *Final Decisions of Commissioner.*

Up to the present time the Court of Appeals has entertained appeals in interference cases only from the final decision of the Commissioner upon the question of priority of invention. (Allen, Commissioner of Patents, v. The United States of America *ex rel* Lowry and Planter Compress Co., 116 O. G. 2253.)

DeFerranti v. Lindmark, 137 O. G. 731; Marshutz v. Commissioner of Patents, 85 O. G. 778.

The statutes give right of appeal only in cases where the various tribunals of the Office acted and not when the Examiners-in-Chief suggest that the issue is not patentable.

Serrell v. Donnelly, 129 O. G. 2501.

Neither the rules of this Court, nor of the Patent Office, mention amendments to the reasons of appeal; but when made in due time, to correct an assignment that may not be sufficiently specific, or some inadvertance in its preparation, and no possible injury could be done to the opposing party, we see no reason why it should not be permitted.

Horine v. Wende, 129 O. G. 2858.

The discretion of the Commissioner, in extending time for filing preliminary statement not reviewed by Court of Appeals.

Churchill v. Goodwin, 141 O. G. 569.

In general, the question of patentability is not open in an appeal in interference cases.

Hisey v. Peter, 71 O. G. 892; Doyle v. McRoberts, 79 O. G. 1029; Orcutt v. McDonald, Jr., and McDonald, 123 O. G. 1288; Newton v. Woodward, 93 O. G. 2320 (explaining Bechman v. Wood, 89 O. G. 2320); Latham v. Armat, 95 O. G. 232. (See subject "Patentability" in section 6.) Potter v. McIntosh, 127 O. G. 1995; Mill v. Midgley, 136 O. G. 1534; Luger v. Browning, 104 O. G. 112. (Distinguishing from Oliver v. Felbel, 100 O. G. 2384.) Dodge v. Fowler, 82 O. G. 595; Doyle v. McRoberts, 79 O. G. 1529.

The Court of Appeals regards it as improper for them to adjudicate the question of priority before the question of patentability is fully settled.

Slaughter v. Halle, 102 O. G. 469.

It is well settled that this Court can not and should not interfere with such (interlocutory) rulings, unless perhaps in extreme cases it should be necessary for the maintenance of the jurisdiction of this Court.

Ritter v. Krakaw & Connor, Jr., 114 O. G. 1553-1554.

The reopening of a case for the introduction of newly discovered evidence is a matter of discretion for the trial court, and will not be reviewed by this Court.

Richards v. Meissner, 114 O. G. 1831; Dunbar v. Schellenger, 128 O. G. 2837; Omes v. Starr, 117 O. G. 1495.

The decision was an interlocutory one relating to the general practice of the Office (Rules 30, 31, 75) in all such cases, and the question of its propriety as presented, is not necessarily involved in the decision on its merits. For the reasons given it is not the subject of review.

Westinghouse v. Duncan, 66 O. G. 1009; Mill, 11 App. D. C. 584, 588; Frasch, 100 O. G. 1977, 192 U. S. 566; Davis v. Garrett, 123 O. G. 1991; Hulett v. Long, 89 O. G. 1141.

The question whether the description in a design case is a proper one is not reviewable by the Court of Appeals except in an extraordinary case.

Mygatt, 121 O. G. 1676.

A trade-mark interference declared under the act of 1881 but not decided until after the passage of the act of February 20, 1905, is appealable to the Court of Appeals of the District of Columbia under the act of February 20, 1905, where the only application involved has been amended to bring it under the provision of that act.

Giles Remedy Company v. Giles, 120 O. G. 826.

A decision against a party on the ground that his original application did not contain the inventions seems to be one of priority of invention and the decision should be such as to give the unsuccessful party opportunity to take an appeal in the interference to the Court of Appeals and not one dissolving the interference.

Pohle v. McKnight, 119 O. G. 2519.

Question of the identity of the inventions involved proper to be considered by the Court of Appeals on appeal from the final decision of the Commissioner.

Bechman v. Wood, 89 O. G. 2459; but see Bechman v. Wood, 89 O. G. 2462.

It is only by regarding the proceedings in the Patent Office as quasi-judicial in their nature that the validity of the leg-

islation which authorizes appeals to the Court of Appeals from the decision of the Commissioner of Patents can be sustained.

*Barratt v. Duall, Commissioner of Patents, 87 O. G. 1075.*

A refusal to consider patentability in cases of priority does not establish the conclusion that the decision of the Commissioner upon questions of patentability in such cases is final and conclusive. Such questions should come before the Court by regular course of appeal.

*Breul v. Smith, 79 O. G. 153.*

The right of a party to make a claim will be considered as an ancillary question to be considered in awarding priority of invention.

*United States of America ex rel. The Newcomb Motor Company v. Moore Co., 133 O. G. 1680.*

The Court will confine its decision to the matter passed upon by the Commissioner and not consider the question of abandonment, prior public cases, and anticipation of the invention which have not been acted on in the Patent Office.

*Colhoun v. Hodgson, 70 O. G. 276; Cutler v. Leonard, 136 O. G. 438.*

Whatever practice should have been pursued in regard to the additional claim presented for the first time to the Commissioner in person which was neither considered nor rejected, we do not consider that we are at liberty to pass upon it on this appeal.

*Garrett, 122 O. G. 1047.*

Only claims considered by the Office will be considered by the Court on appeal. As to bill in equity see *Durhamy v. Seymour, Commissioner of Patents, 71 O. G. 601*, and the construction given by the Office adhered to.

*Breul v. Smith, 78 O. G. 1906.*

The right of appeal in case of the refusal of a patent upon the ground of non-patentability of the claim, and refusal of a patent because of interference with a prior right of invention, are distinct rights. The latter does not involve the former. This is clearly indicated in the Revised Statutes of the United States, section 4911, and in section 9 of the act of Congress of February 9, 1893, providing for the organization of this Court.

*Hisey v. Peters, 71 O. G. 892.*

The Court will not consider the question of patentability

a second time in a new application for the same subject matter.

Barratt v. Duall, Commissioner of Patents, 87 O. G. 1075.

Only appeals from final decisions considered.

Cross v. Phillips, 87 O. G. 1399; Hulett v. Long, 89 O. G. 1141; Westinghouse, Jr., v. Duncan, 66 O. G. 1009.

#### (4) *Motions.*

A motion to dismiss an appeal on the ground that it was taken in bad faith for the purpose of delay will not be postponed to the final hearing if a *prima facie* case is made out.

Jones v. Starr, 117 O. G. 1495.

The appellant having failed to have his cause filed and docketed, on motion of the appellee the cause was docketed and dismissed.

Cleveland v. Wright, 79 O. G. 886; Southall v. Seymour, Com., 79 O. G. 1684; McCreary v. Seymour, Com., 79 O. G. 1684; Morrissey v. Seymour, Com., 79 O. G. 1684.

Court will entertain a motion for a new trial pending an appeal.

Clement v. Richards v. Meissner, 111 O. G. 1627.

No appeal from orders refusing a new trial or rehearing. Greenwood v. Dover, 109 O. G. 2172; Messinger v. Commissioner of Patents, 83 O. G. 1995.

#### (5) *Record.*

Confined to the record made up in the Office.

Heroult, 127 O. G. 3217.

Failure to print transcript of record is ground under Court Rule for dismissing appeal.

Munson v. Carper, 79 O. G. 160; Pelton v. Evered, 77 O. G. 16.

The record of the proceedings in the Patent Office upon being filed with the clerk of the Court of Appeals become a public record.

Drawbaugh, 66 O. G. 1451.

#### (6) *Rules.*

The Court of Appeals was duly authorized by statute to make rules limiting the time of appeal from the decisions of the Commissioner of Patents.

77 O. G. 507.

See "Rules," page 783, and Instructions to Applicants, page 790.

*(7) Weight Given Commissioner's Decisions.*

Three tribunals of the Office concurring a different conclusion will only be reached where there is manifest error. *Creveling v. Jepson*, 256 O. G. 226.

*ON QUESTIONS OF FACT THE CONCURRENT DECISIONS OF THE LOWER TRIBUNALS WILL BE TAKEN AS CONCLUSIVE, UNLESS THE CONTRARY IS CLEAR.*

*Arnold v. Tyler*, 79 O. G. 156; *Hisey v. Peters*, 71 O. G. 892; *Hien v. Buhoup*, 81 O. G. 2088; *Ball v. Flora*, 121 O. G. 2668; *O'Connell v. Schmidt*, 122 O. G. 2065; *Park v. Lewis*, O. G. 2313; *Ostergren v. Tripler*, 95 O. G. 837; *Schiipphaus v. Stevens*, 95 O. G. 1452; *Austin v. Johnson*, 95 O. G. 2685; *Kilbourn v. Hirner*, 128 O. G. 1689; *Orcutt v. McDonald, Jr., and McDonald*, 23 O. G. 1287; *Ries v. Kirkgaurd and Jehsen*, 132 O. G. 845; *Baur v. Crone*, 120 O. G. 1824; *Bourn v. Hill, Jr.*, 123 O. G. 1284; *Bechman v. Southgate*, 127 O. G. 1254; *Herman v. Fullman*, 109 O. G. 1888. But see *Beals v. Finkerhiner*, 82 O. G. 598; *Ritter v. Krakaw and Connor, Jr.*, 114 O. G. 1553; *Rosell v. Allen*, 92 O. G. 1036; *Stone v. Pupin*, 100 O. G. 114; *Duryea and White v. Rice, Jr.*, 126 O. G. 1357; *Murphy v. Meissner*, 114 O. G. 592; *Cleveland v. Wilkins*, 123 O. G. 1286; *Weber v. Barry, Jr.*, 117 O. G. 1494; *Seeberger v. Dodge*, 114 O. G. 2382; *Beswick v. Commissioner*, 91 O. G. 1437; *Latham v. Armat*, 95 O. G. 232; *Munster v. Ashworth*, 28 O. G. 2688; *Clunies*, 123 O. G. 2361; *Adams*, 114 O. G. 2093; *Dunbar v. Schellenger*, 128 O. G. 2837; *Clenn v. Adams*, 83 O. G. 158; *Howard v. Hey*, 95 O. G. 1647; *Flora v. Powrie*, 109 O. G. 2668; *Esty v. Newton*, 86 O. G. 799; *Munster v. Ashworth*, 128 O. G. 2088; *Richards v. Burkholder*, 128 O. G. 2533; *Wickers and Furlong v. McKee*, 129 O. G. 869.

The rule that the concurrent decisions of the Office as to facts will be followed, except in a clear case, does not mean that the Court will be bound by the conclusions from such facts.

*O'Connell v. Schmidt*, 122 O. G. 2065; *Orcutt v. McDonald, Jr., and McDonald*, 123 O. G. 705.

The rule that concurrent decisions in the Patent Office will be followed, is especially applicable in a case which involves

complicated constructions about which the experts of the Patent Office are less liable to err than ourselves.

Lindmark v. Hodgkinson, 137 O. G. 228; Seeberger v. Dodge, 114 O. G. 2382.

That these tribunals have reached their conclusions by different paths does not detract from the weight to be given to their decisions.

Bourn v. Hill, Jr., 123 O. G. 1284.

Where the facts are admitted and a mere question of law is involved, the Court will not hesitate to reverse the judgment appealed from if convinced that an erroneous conclusion was reached.

Woods v. Poor, 130 O. G. 1313.

The burden of overcoming the cumulative decisions of the lower tribunals is on the applicant.

C. of D. of C. Bauer v. Crene, 120 O. G. 1824.

We have repeatedly held that except in extreme cases, we will not go behind the declaration of interferences in order to determine the question of identity of invention.

Bechman v. Southgate, 127 O. G. 1254.

The decisions of the expert tribunals of the Office (original disclosure) will be accepted, except in extreme cases where palpable error has been committed.

Kilbourne v. Hirner, 128 O. G. 1689.

We are not warranted in reversing a decision of the Office because of a mere doubt of its correctness.

Munster v. Ashworth, 128 O. G. 2088.

Where the tribunals of the Patent Office agree in deciding the same way in question of fact, this court will not reverse such a decision unless it clearly appears that the decision was against the weight of evidence.

Richards v. Burkholder, 128 O. G. 2533.

If the decisions of the lower tribunals had been the other way they would have been followed being as they are they will be followed.

Dunbar v. Schellinger, 128 O. G. 2937.

It is evident that the review of this case must be abridged as far as practicable.

In succession the three tribunals of the Office have agreed, in their conclusions, and as we have so often announced, this court will not reverse the unanimous decisions except in a very clear case.

Wickers v. Furlong v. McKee, 129 O. G. 869.

A unanimous decision by the experts of the Patent Office will be accepted as conclusive when there is no palpable error.

(Kilbourne v. Horner, 29 App. D. C. 54-52; Lindmark v. Hodgkinson, 31 App. D. C. 612.)

Becker v. Bird, 228 O. G. 407.

Where the facts are admitted, and a mere question of law is involved, the court will not hesitate to reverse the judgment appealed from if convinced that an erroneous conclusion was reached.

Woods v. Pover, 130 O. G. 1313.

The rule that concurrent decisions in the Patent Office will be followed is especially applicable in a case which involves a complicated construction about which the Experts of the Patent Office are less liable to err than ourselves.

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

#### (8) *Mandamus.*

Where a party delays beyond the time limited to take his appeal, mandamus will not lie to the Supreme Court to compel the Court of Appeals to entertain the appeal.

Hein, 79 O. G. 507.

A mandamus to compel the Court of Appeals to hear appeal from Commissioner on question of division not the remedy. It should be to the Examiners-in-Chief in the first place.

Frasch, 109 O. G. 554.

Mandamus is not an alternative remedy with appeal.

United States *ex rel.* Tuttle v. Allen, Commissioner of Patents, 126 O. G. 760.

Mandamus to the Commissioner on appeal to the Court, the remedy where an appeal to the Board is denied. Frasch, 109 O. G. 554. No appeal as to the division of an application.

Frasch, 100 O. G. 1977.

No appeal can be taken to the Supreme Court of the United States from a decision of the Court of Appeals refusing a mandamus to compel the Commissioner to register a trade-mark.

The United States *ex rel.* the State of South Carolina v. Seymour, Commissioner, 67 O. G. 1191.

#### (9) *Effect of the Decision of the Court on the Commissioner.*

The Commissioner is bound to follow the decision above upon those points only which were raised by the appeal, and upon no other.

It is for a judge to say that a decision of the Commis-

sioner shall be affirmed or reversed, not to say that a patent shall or shall not issue.

Abraham v. Fletcher, 69 C. D. 50.

The Office is bound to take notice of the decision of the Court and may base its action upon the finding of facts contained therein.

Tournier, 108 O. G. 798.

After a decision by the Court of Appeals it is too late to dissolve for lack of interference in fact.

Gilbart, 85 O. G. 454.

It is conceivable that a case might arise where the Commissioner might grant a rehearing after a decision by the Court of Appeals on the question of priority.

Scott v. Brooks, 71 O. G. 1314.

After an appeal to the Court of Appeals refusing the allowances of certain claims, a case will not be reopened for the consideration of additional claims except under unusual circumstances. That the Court put an interpretation on the claims not contemplated by applicant not sufficient.

Milans, 135 O. G. 1122.

After an appeal on the question of priority, the Commissioner may refuse a patent to the successful party.

Sobey v. Holsclaw, 126 O. G. 3041.

#### (10) *Miscellaneous.*

The Court can not control the discretion of the Commissioner as to the length of argument he should permit.

Sobey v. Holsclaw, 126 O. G. 3041.

The Court is powerless to direct the action of an executive officer unless a positive legal right is being invaded by the officer where the duty imposed upon him is clearly prescribed and enjoined by law. The duty, however, must be so plain and pointed that the officer has no discretion left. (Merriell on Mandamus, p. 64.)

Moore, Com. of Pats., v. U. S. *ex rel.* Boyer, 138 O. G. 530.

Neither writ of error or appeal will be allowed by this Court. Decision not to prejudice an application to any one of the justices of the Supreme Court.

Rousseau v. Brown, 104 O. G. 1122.

The two lower tribunals of the Office held that the inventions were the same, and the Commissioner that they were different, the theory of the Commissioner accepted without enquiry.

Cushman v. Lines, 78 O. G. 2051.



Judgment in an interference proceeding will not be made final by the Office after the filing of a notice of appeal, on the ground that it was filed one day late, it being regarded as being within the discretion of the Court to relieve against the default.

Proutt v. Johnston and Johnston, 130 O. G. 2718.

The Court has no power to award costs.

Wells v. Reynolds, 69 O. G. 1507.

When a record was introduced, but on examination found to have no bearing in the case, it must be at the cost of the one offering it.

Stevens v. Scher, 81 O. G. 1932.

A general assignment of error in appeal from the Examiner to the Board is sufficient to base the question of *res adjudicata* upon, or it might have been raised by the Board on its own motion.

Carroll v. Hallwood, 135 O. G. 896.

B. has appealed, but his assignment of errors does not challenge the decision of the Commissioner on the question of priority of invention and to this extent he is presumed to have acquiesced in the decision against him.

Bechman v. Wood, 15 App. D. C. 487.

(In an interference case.) The present is no more than a moot cause since upon the face of the record itself the question of patentability has been expressly reserved for further and future consideration.

Oliver v. Felbel, 100 O. G. 2384.

A party may take advantage of all the time allowed by law without prejudicing his case.

Jones v. Starr, 117 O. G. 1495.

An assignment of a trade-mark permitted after notice and before appeal is perfected.

Levy & Co. v. Uri, 131 O. G. 1689.

We will not consider affidavits filed either in this Court or the Patent Office relating to changes that have occurred in drawings, models, experimental machines and like exhibits. These matters must be wholly settled in the Patent Office (Blackford v. Wilder, 104 O. G. 580.)

Greenwood v. Dover, 109 O. G. 2173; Willsin v. Bradshaw, 91 O. G. 648.

Affidavit verified before notary who was also attorney in the case is invalid. The prohibition of attorneys acting as notaries in the Code of the District applies to attorneys outside of the District.

The Hall Safe Co. v. Herring-Hall-Marvin Safe Co., 135 O. G. 1804.

Appeal from a decision upon the right to amend preliminary statement.

Cross v. Phillips, 87 O. G. 1399.

### **Rule 149. Notice to Commissioner of Appeal to Court.**

When an appeal is taken to the Court of Appeals of the District of Columbia, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within forty days, exclusive of Sundays and holidays, but including Saturday half holidays, from the date of the decision appealed from, his reasons of appeal specifically set forth in writing.

Rev. Stat., sec. 4912; sec. 9, act of February 9, 1893.

#### *CONSTRUCTIONS.*

Court granted a petition relieving a default in view of the fact that the opposite party did not object.

Truby, 268 O. G. 383.

Reinstatement of an appeal not taken within the forty days allowed by Rule 21, refused.

Hitchcock, 247 O. G. 965.

Will entertain a motion for a new trial pending an appeal.

Clements v. Richards v. Meissner, 111 O. G. 1627.

This rule limits the time in which the appeal must be taken to forty days from the date of the order appealed from, excluding the day of date.

Burton v. Bentley, 87 O. G. 2326.

The Office has no power to extend time.

Clement v. Richards v. Meissner, 111 O. G. 1626-7.

Saturday after 12 o'clock is a legal holiday and is to be computed as one-half day.

Ocuppaugh v. Norton, 114 O. G. 545.

A party allowed to prosecute his appeal when notice was filed one day late.

Proutt v. Johnston and Johnston, 130 O. G. 2118.

The rule that all appeals taken from the Commissioner of Patents shall be taken within forty days from the date of the ruling and not afterward is a positive law to the Court and to the suitors therein.

Ross v. Loewed, 77 O. G. 2141; Bryant v. Seymour, Com. of Patents, 77 O. G. 1599.

The two years allowed for an action by R. S. 4894 is not applicable to appeals to the Court of Appeals.

77 O. G. 1600.

The running of the time limited for appeal is not arrested by a motion for a new trial.

Ross v. Loewer, 77 O. G. 2141; Bryant v. Seymour, Com. of Patents, 77 O. G. 1599.

Whenever the time for appeal has gone by the time for rehearing has elapsed with it.

Scott v. Brooks, 71 O. G. 1314.

### **Rule 150. Pro Forma Proceedings in Patent Office.**

*Pro forma* proceedings will not be had in the Patent Office for the purpose of securing to applicants an appeal to the Court of Appeals of the District of Columbia.

(For forms of appeals and rules of the Court of Appeals of the District of Columbia respecting appeals, see, Rules 148, 149.)

### **Rule 151. Hour of Hearing.**

Hearings will be had by the Commissioner at 10 o'clock a. m., and by the board of examiners in chief at 1 o'clock p. m., and by the examiner of interferences upon interlocutory matters at 10 o'clock a. m., and upon final hearings at 11 o'clock a. m., on the day appointed unless some other hour be specifically designated. If either party in a contested case, or the appellant in an *ex parte* case, appear at the proper time, he will be heard. After the day of hearing, a contested case will not be taken up for oral argument except by consent of all parties. If the engagements of the tribunal having jurisdiction be such as to prevent the case from being taken up on the day of hearing, a new assignment will be made, or the case will be continued from day to day until heard. Unless it shall be otherwise ordered before

the hearing begins, oral arguments will be limited to one hour for each party in contested cases, and to one-half hour in other cases. After a contested case has been argued, nothing further relating thereto will be heard unless upon request of the tribunal having jurisdiction of the case; and all interviews for this purpose with parties in interest or their attorneys will be invariably denied.

#### CONSTRUCTIONS.

The fact that two hearings before different tribunals are set at the same time is proper and does not invalidate the notice.

*Bombard v. United States Graphite Co.*, 129 O. G. 476.

#### **Rule 152. Wishes of Parties and Attorneys.**

Hearings in *ex parte* and contested cases will, as far as is convenient and proper, be set, advanced, and adjourned to meet the wishes of the parties and their attorneys.

#### **Rule 153. Practice in Motions.**

In contested cases reasonable notice of all motions, and copies of motion papers and affidavits, must be served as provided in Rule 154 (b). Proof of such service must be made before the motion will be entertained by the office. Motions will not be heard in the absence of either party except upon default after due notice. Motions will be heard in the first instance by the officer or tribunal before whom the particular case may be pending. In original hearings on motions the moving parties shall have the right to make the opening and closing arguments. In contested cases the practice on points to which the rules are not applicable shall conform as nearly as possible, to that of the United States courts in equity proceedings.

*CONSTRUCTIONS.*

Setting of hearing.

199 O. G. 1.

A petition by an assignee of a part interest to intervene in the prosecution of an application will be dismissed, where such petition was not accompanied by proof of service upon the other assignees and upon the applicant.

Kyle, 193 O. G. 753.

An objection for want of notice of filing an amended preliminary statement disregarded in view of the fact that objector had ordered a copy of the same.

Klenk v. Kruse, 177 O. G. 1300.

In serving notice for taking testimony, ample time should be given counsel to communicate with his client and arrange his business affairs before he is compelled to start on his journey. Otherwise testimony should be stricken out.

Randerson v. Hanna & Hanna, 173 O. G. 586.

The sufficiency of the notice depends largely upon the circumstances. In this case a notice given in New York City on May 3 that certain witnesses would be examined at Battle Creek, Mich., on May 5, *held* sufficient.

Kuth et al. v. Lundquit et al. v. Lorimer et al., 157 O. G. 754.

A party taking his own testimony thought it was only necessary for him to commence taking his testimony within the time limited. Ignorance held not to excuse.

Mattice v. Langworthy, 140 O. G. 507.

The motion of October 8 which is entitled "a motion for a rehearing" was, in effect, a motion to set aside the decision of October 6 for lack of service of Pickard's motion. As no abuse of discretion on the part of the Examiner of Interferences has been shown in holding that the reasons given were not sufficient to justify the setting aside of his prior decision, it will not be disturbed.

Pickard v. Ashton and Curtis, 137 O. G. 977.

After pleadings have been filed, proofs taken, and the case ready for final hearing, an applicant for cancelation will not be permitted to withdraw his application without prejudice to his right to file a new application.

Ontcault v. The New York Herald Company, 136 O. G. 437.

The rule provides that reasonable notice of all motions must be given and that a motion will not be entertained in absence of proof of service. The same reason exists for re-

quiring notice of the renewal of a motion as of the motion itself, and the mere request at the final hearing is not such notice.

*Dyson v. Sand v. Dunbar v. Browne*, 133 O. G. 1679.

He therefore granted the motion because the certificate of the notary showed that the requirement of the rule had not been complied with, citing *Rolle v. Taylor*, 111 O. G. 1938.

*Rhodes v. Rhodes*, 132 O. G. 680. But see note to Rule 159.

That a notice was not served in time should be remedied by an extension of time, and not noted on the record for subsequent consideration.

*Phillips v. Scott*, 130 O. G. 1312.

The statement made by an officer charged with the duty of correctly recording the testimony of a witness and such events as counsel may desire to have recorded can not be overcome by the oath of a single witness.

*Munsler v. Ashworth*, 129 O. G. 2085-2088.

A motion to amend declaration in a trade-mark case so as to insert a statement of ten years' exclusive use, which statement had been previously withdrawn in view of testimony in an interference case, refused.

*Kenyon*, 125 O. G. 1702.

The signature to a notice is sufficient if the party notified understands from the signature from whom or in whose interest the notice is given.

*Heyne, Haywood & McCarthy v. De Vilbliss, Jr.*, 125 O. G. 669; *Adams-Randall*, 125 O. G. 1700.

Where affidavits are filed by any of the parties which are not in answer to affidavits filed by opponents, they must ordinarily be served upon the opponents at least five days before the hearing. Affidavits in rebuttal may then be filed, but should be served before the hearing.

*Browne v. Stroud*, 122 O. G. 2688.

The petition must be denied on the merits, but it is to be noted also that copies were not served upon the opposing parties, and that therefore it is informal.

*Kolb v. Hemmingway v. Curtis*, 122 O. G. 1397.

It is the well-settled practise of this Office, as announced in *Kletsker & Goesel v. Dodson*, 109 O. G. 1336, C. D. 1904, 100, and other decisions, that an appeal filed after the expiration of the limit of appeal will not be entertained except upon a verified showing why it was not presented in proper time.

*Thullen v. Young & Townsend*, 120 O. G. 904.

The time of hearing is a matter resting in the discretion of the tribunal before whom the case is pending.

Cazin v. Von Welsbach, 119 O. G. 550.

A petition to suspend an interference and declare a new one will not be considered when the opposing party was not notified.

Hansen, 117 O. G. 2632.

A notice given at 10 o'clock that testimony was to be taken at 2, where all parties attended and the testimony was brief, testimony not stricken out, notwithstanding moving party refused to cross-examine.

Roberts v. Webster, 115 O. G. 2135.

It seems service of papers on Saturday afternoon in the District of Columbia is legal.

Goodfellow v. Jolly, 115 O. G. 1064.

New grounds for dissolution, not of record in either application and not included in the motion, must be served upon the opposing party at least 5 days before the hearing. If notice of the new grounds is not served, and service is not waived, these grounds will not be considered by the Primary Examiner in deciding the motion. (Wells v Parker, 90 O. G. 1947; Summers v. Hart, 98 O. G. 2585; Kurz v. Jackson v. Pierce, 2586; Whitlock v. Hudson v. Scott, 99 O. G. 1385.) In cases where due service of the new grounds could not have been rendered, a postponement of the hearing should be requested, and the request being accompanied by a statement of facts.

Young v. Eick, 113 O. G. 547; Fowler, 113 O. G. 549.

A notice that would necessitate travel on Sunday is insufficient. Counsel must be given time to prepare for a journey.

Goodfellow v. Jolly, 111 O. G. 1940.

Notice served June 16, at 12 o'clock, for taking testimony in Erie, Pa., 10 A. M. June 18, is insufficient, even if it contained names of witnesses.

Tripp v. Wolff v. Ames, 108 O. G. 563.

An affidavit filed after the hearing relating to the merits stricken from the files, as these rules contemplate that a party shall be given notice of his opponent's case before the hearing.

Miller, 105 O. G. 1532-33.

It should be noted that both applications here involved are owned by the same party, and that the same attorney appears for both parties; under such circumstances the Office should be particularly on its guard to prevent unreasonable delays. Unreasonable delays in the prosecution of interferences will not be permitted merely because the parties agree to the delay.

Sponsel v. Darling, 105 O. G. 498.

Notice of new matter in cases transmitted under Rule 126.

Greenawalt v. Mark, 103 O. G. 1913.

All parties must be notified.

Grand v. Abbott v. Grand & McGraw, 103 O. G. 662.

Motions in which no proof of service upon the opposite party is made will not be entertained.

Bechman v. Johnson, 1889 C. D. 184; 48 O. G. 673; C. C. 97 O. G. 2531; 92 O. G. 1236; 1890 C. D. 125.

The notice of certain named witnesses and, perhaps, others, does not warrant the taking of the testimony of any witnesses than those named, at least under the circumstances of the case. A notice one day that the testimony will be taken the next day is not sufficient where attorneys are in a distant city and only represented by an associate attorney.

Potter v. Ochs, 95 O. G. 1049, 1901 C. D. 39.

It is not the practice of the Office to require a party to serve upon his opponent copies of all office records referred to in a motion made by him.

Bundy v. Rumbacker, 92 O. G. 2002, 1900 C. D. 143.

A petition that a certain application be withdrawn from issue, and a rule made that cause be shown why the order should not be made permanent.

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

A motion based upon the same state of facts and reasons as a previous one should be refused on the ground that the matter is *res adjudicata*.

Little v. Little, Pillard & Sargent, 1876 C. D. 207, 15 O.

G. 543; Banks v. Snediker, 1880 C. D. 95, 17 O. G. 508.

A motion with notice is only necessary when a demand is made which may be refused. When a motion is made which must be granted, it is not a motion in the sense of this rule.

Booth v. Lyman, 1880 C. D. 170, 17 O. G. 393.

The usual rule is to exclude the first or last day of the notice, when not personally served.

Hoag v. Abbott, 1879 C. D., 15 O. G. 471.

A concession of priority excluded as evidence by the Examiner of Interferences for want of notice.

Tucker v. Kahler, 1879 C. D. 71, 15 O. G. 966.

A party cannot move to reform the declaration of interference without notice.

Gray v. Bell, 1878 C. D. 133, 15 O. G. 133; Bell v. Gray, 15 O. G. 776, 1879 C. D. 42.

If a party would be compelled to travel night and day, the notice is not reasonable.

Hoag v. Abbott, 1879 C. D. 3, 15 O. G. 471.



The appearance of a party in a case, and the submission of arguments on the merits of the disputed points, is a virtual waiver of the right of notice.

Keller & Olmsdahl v. Felder, 1876 C. D. 246, 10 O. G. 944

The usual rule is to exclude the first or last day of the notice when not personally served.

Hoag v. Abbott, 1879 C. D. 3, 15 O. G. 471.

The name of a witness was not given.

Kenerson v. Brown & Brown, 779 C. D. 249, 16 O. G. 857; Masury, 73 C. D. 110.

### **Rule 154. Notice of Taking Depositions.**

The following rules have been established for taking and transmitting testimony in interferences and other contested cases:

(a) Before the depositions of witnesses shall be taken by either party due notice shall be given to the opposing party, as hereinafter provided, of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and of the names and residences of the witnesses to be examined, and the opposing party shall have full opportunity, either in person or by attorney, to cross-examine the witnesses. If the opposing party shall attend the examination of witnesses not named in the notice, and shall either cross-examine such witnesses or fail to object to their examination, he shall be deemed to have waived his right to object to such examination for want of notice. Neither party shall take testimony in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other can not be had.

(b) The notice for taking testimony or for motions must be served (unless otherwise stipulated in an instrument in writing filed in the case) upon the attor-

ney of record, if there be one, or, if there be no attorney of record, upon the adverse party. Reasonable time must be given therein for such adverse party to reach the place of examination. Service of such notice may be made in either of the following ways: (1) By delivering a copy of the notice to the adverse party or his attorney; (2) by leaving a copy at the usual place of business of the adverse party or his attorney with some one in his employment; (3) when such adverse party or his attorney has no usual place of business, by leaving a copy at his residence, with a member of his family over 14 years of age and of discretion; (4) transmission by registered letter; (5) by express. Whenever it shall be satisfactorily shown to the Commissioner that neither of the above modes of obtaining or reserving notice is practicable, the notice may be published in the Official Gazette. Such notice shall, with sworn proof of the fact, time, and mode of service thereof, be attached to the deposition or depositions, whether the opposing party shall have cross-examined or not.

(c) Each witness before testifying shall be duly sworn according to law by the officer before whom his deposition shall be taken. The deposition shall be carefully read over by the witness, or by the officer to him, and shall then be subscribed by the witness in the presence of the officer. The officer shall annex to the deposition his certificate showing (1) the due administration of the oath by the officer to the witness before the commencement of his testimony; (2) the name of the person by whom the testimony was written out, and the fact that, if not written by the officer, it was written in his presence; (3) the presence or absence of the adverse party; (4) the place, day, and

hour of commencing and taking the deposition; (5) the reading by, or to, each witness of his deposition before he signs the same; and (6) the fact that the officer was not connected by blood or marriage with either of the parties, nor interested, directly or indirectly, in the matter in controversy. The officer shall sign the certificate and affix thereto his seal of office, if he have such seal. He shall then, without delay, securely seal up all the evidence, notices, and paper exhibits, inscribe upon the envelope a certificate giving the title of the case, the name of each witness, and the date of sealing, address the package, and forward the same to the Commissioner of Patents. If the weight or bulk of an exhibit shall exclude it from the envelope, it shall be authenticated by the officer and transmitted in a separate package, marked and addressed as above provided.

(*d*) If a party shall be unable to take any testimony within the time limited, and desire an extension for such purpose, he must file a motion, accompanied by a statement under oath setting forth specifically the reason why such testimony has not been taken, and distinctly averring that such motion is made in good faith, and not for the purpose of delay. If either party shall be unable to procure the testimony of a witness or witnesses within the time limited, and desire an extension for such purpose, he must file a motion, accompanied by a statement under oath setting forth the cause of such inability, the name or names of such witness or witnesses, the facts expected to be proved by such witness or witnesses, the steps which have been taken to procure such testimony, and the dates on which efforts have been made to procure it. (See Rule 153.)

(e) Upon notice given to the opposite party before the closing of the testimony, any official record, and any special matter contained in a printed publication, if competent evidence and pertinent to the issue, may be used as evidence at the hearing.

(f) All depositions which are taken must be duly filed in the Patent Office. On refusal to file, the office at its discretion will not further hear or consider the contestant with whom the refusal lies; and the office may, at its discretion, receive and consider a copy of the withheld deposition, attested by such evidence as is procurable.

Rev. Stat., sec. 4905.

### HISTORY.

In 1869, Rule 50 read in part as follows: "In contested cases no motion will be heard in the absence of the other party, except upon default after due notice; nor will a case be taken up for oral argument after the day of hearing except by consent of both parties. If the engagements of the tribunal before whom the case is pending are such as to prevent it from being taken up on the day of hearing, a new assignment will be made, or the case will be continued from day to day until heard."

And Rule 57 of 1869 reads: "If either party wishes the time for taking his testimony, or for the hearing, postponed, he must make application for such postponement, and must show sufficient reason for it by affidavit filed before the time previously appointed has elapsed, if practicable; and must also furnish his opponent with copies of his affidavits, and with seasonable notice of the time of hearing his application."

In 1870, the following rule was added: "Reasonable notice of all motions and copies of the motion papers and affidavits must be served upon the opposite party or his attorney."

In 1871 the rules read: "In contested cases, reasonable notice of all motions and copies of the motion papers and affidavits must be served upon the opposite party or his attorney. Proof of such service must be made before the motion will be entertained by the Office; and motions will not be heard in the absence of either party except upon default after due notice. Motions will be heard in the first instance by the officer

or tribunal before whom the particular case may be pending; but an appeal from the decision rendered may be taken to the commissioner in person."

See Rule 153 and notes.

### CONSTRUCTIONS.

- (1) NOTICE.
- (2) ORAL STIPULATION.
- (3) OFFICIAL CERTIFICATE.
- (4) MOTIONS TO EXTEND TIME FOR TAKING TESTIMONY.
- (5) OFFICIAL RECORDS AND SPECIAL MATTERS OFFERED IN EVIDENCE.
- (6) DEPOSITIONS TO BE FILED IN PATENT OFFICE.
- (7) MISCELLANEOUS.

#### (1) *Notice.*

A deposition was suppressed where a party had given notice once, but not attended at the time and place assigned; afterward he gave a second notice, and took the deposition which was suppressed.

Densten v. Burnham, 126 O. G. 388.

A notice given at 10 o'clock that testimony was to be taken at 2, where all parties attended, and the testimony was brief testimony not stricken out notwithstanding moving party refused to cross examine.

Roberts v. Webster, 115 O. G. 2135.

#### (2) *Oral Stipulation.*

The certificate of the notary on the record is sufficient proof of the agreement between counsel. An oral stipulation as to taking testimony is sufficient.

Fairbanks & Sauer v. Karr, 113 O. G. 1148.

#### (3) *Official Certificate.*

The omission of these formalities may be sufficient ground for suppressing the deposition.

Rolfe v. Taylor, 111 O. G. 1938.

#### (4) *Motion to Extend Time for Taking Testimony.*

The rule is very clear in requiring a verified showing, and there is no excuse for failing to comply with them.

Rippetto v. Stephens, 105 O. G. 1779.

If the irregularities arose through inadvertences, and not