

patent alone, brought after the expiration of the earlier one. *Consolidated Safety Valve Co. v. Crosby Steam Gage and Valve Co., 54 O. G. 633, C. D. 1891.

109. In the absence of evidence showing the amount of the damage, only nominal damages will be awarded. *Royer v. Schultz Belting Co., 55 O. G. 1141, C. D. 1891.

110. Plaintiff can recover only nominal damages for the infringement of an impracticable machine, or if he fails to show actual advantage to defendants by the use of his machine. *Lee v. Pillsbury, 60 O. G. 1752, C. D. 1892.

111. Plaintiff, owning a patent for two improvements in fruit-driers, sued for the infringement of but one. *Held*, that nominal damages only were recoverable where the evidence showed only the amount of a license fee for both devices and the profits to be made in manufacturing fruit-driers containing both improvements. *Hunt Bros. Fruit Packing Co. v. Cassidy, 62 O. G. 1965, C. D. 1893.

DEATH OF APPLICANT.

(See ABANDONMENT OF APPLICATION.)

DECREES OF COURT.

1. A party complained of as violating a decree who has never been a defendant of record in the suit cannot be bound by the decree except as privy to one or more of the defendants, or as a purchaser *pendente lite*. *Bate Refrigerating Co. v. Gillett, 39 O. G. 833, C. D. 1887.

2. To bind such a party not defendant of record as privy, the judgment must bind in relation to some specific right of property directly affected by the judgment and acquired after the judgment. *Id.

3. Where transfers are colorable, as for the purpose of avoiding an injunction, or if there has been a mere change of names, or if the transferring parties retain the management and principal ownership, and the violation is wilful, then privies not defendants of record are bound by decree. *Id.

4. There is no privity to a party not a defendant in the suit because of a purchase by such party *pendente lite* of property not involved in the suit. *Id.

5. A party not a defendant to the suit does not become privy thereto, and is not bound by the decree, by reason of a purchase of the property after suit and before the decree with an

agreement to meet all liabilities and obligations of the party selling existing at the date of the sale. *Id.

6. A decree absolute in its terms is an adjudication of the merits of the controversy, and constitutes a bar to any further litigation of the same subject between the parties. *Lyon v. Perin and Gaff Mfg. Co., 43 O. G. 983, C. D. 1888.

7. Where a suit for infringement of a patent is brought against a firm that is a branch of the company that manufactures the infringing device and such company conducts the defense, raising the question of validity of the patent, a decree for complainant is conclusive as to the validity of the patent as against the company conducting the defense, even in regard to alleged anticipations not referred to in the suit, since under the issues all anticipatory inventions might have been shown in defense. (50 Fed. Rep. 193, affirmed.) *David Bradley Mfg. Co. v. Eagle Mfg. Co., 66 O. G. 315, C. D. 1894.

8. Such decree is none the less conclusive because it was merely interlocutory at the bringing of the suit in which it is set up as a bar and subsequently ripened into a final decree. *Id.

9. In a suit to restrain infringement of a patent and to obtain an accounting, an interlocutory decree was rendered, granting a temporary injunction, and afterward a final decree, making the injunction perpetual, and awarding only nominal damages, was rendered upon a stipulation which provided that such decree should not be a bar to the recovery of substantial damages in a subsequent suit. *Held*, that the decree was conclusive as to the validity of the patent, the stipulation only affecting its force as an adjudication on the subject of damages. *Id.

10. The contrast suggested by the words "interlocutory order or decree" and "final decree," as used in the first paragraph of amended section 7, is between a decree which is preliminary to a hearing on the merits, and hence discretionary in the court, and one which follows a hearing on the merits and is hence final, conclusive, and as of right in the prevailing party—between a decree which is meant to preserve the subject-matter of the litigation or prevent irreparable injury till a hearing on the merits can be had and a decree which follows the hearing on the merits and ultimately determines the rights of the litigants. *Standard Elevator Co. v. Crane Elevator Co., 77 O. G. 811, C. D. 1896.

11. There is no power in the court of appeals whereby its affirmance or approval on review of a decree of the circuit court can give a finality to that decree which it did not have when entered of record in the circuit court. *Id.

12. The power incidental to appellate jurisdiction is the power to direct the circuit court to enter such a decree as on the showing of the record ought to have been entered by that court. What is done by a court of original jurisdiction pursuant to a mandate from a court of review on reversal is precisely what ought to have been done by the court of original jurisdiction in the first instance. *Id.

13. The general rule is that when a case has been once decided by the supreme court of the United States, whatever was before that court and disposed of by its decree is finally settled. The circuit court is bound by the decree, and must carry it into execution without variation or intermeddling, except as to matters left open by the decree. *Rosebrugh v. Holman, 78 O. G. 1258, C. D. 1897.

DEFENSES.

(See ANTICIPATION, PRIOR ART AND USE; PLEADING; PRIORITY OF INVENTION.)

I. IN GENERAL

II. BURDEN OF PROOF.

I. IN GENERAL.

1. The defense that two persons to whom a patent has been issued were not in fact joint inventors is so purely formal that it cannot be regarded with favor unless it be shown that the action of the patentees in that regard was disingenuous or calculated to mislead the defendants. (Butler v. Bainbridge, 29 Fed. Rep. 142.) *Consolidated Bunting Apparatus Co. v. Woerle, 38 O. G. 1015, C. D. 1887.

2. It is no justification for sales of infringing articles to allege that the patentees have violated their license contract with the vendor. *Willis v. McCollin, 38 O. G. 1017, C. D. 1887.

3. In a suit for infringement of a patent, the defense being that defendant was the first inventor, the fact that soon after the time of his alleged invention he applied for a patent relating to the same subject, which he based on an entirely different principle, overcomes his and his witness' testimony that he was the first inventor. *Lamson Cash Ry. Co. v. Osgood Cash Car Co., 38 O. G. 1490, C. D. 1887.

4. It is no defense in a suit for infringement that the defendant's machine was used for forming staple-seams in paper, and not in leather, both machines operating in the same way. *Thompson v. Gildersleeve, 43 O. G. 886, C. D. 1888.

5. It is not a valid defense to a suit for the infringement of letters patent granted under the Revised Statutes that the patentee in his application therefor made oath that he was a citizen of the United States when he was not, such misstatement as to his citizenship having been made innocently through mistake, without any improper design whatever. *Toudeur v. Chambers, 46 O. G. 1110, C. D. 1889.

6. A change in the position of a part of a machine will not avoid infringement where the part transposed continues to perform the same function as before. (Citing Adams v. Manufacturing Co., 3 Ban. & A. 1.) *Schlicht & Field Co. v. Chicago Sewing Machine Co., 46 O. G. 1394, C. D. 1889.

7. Held, that it was no defense that the patents had been infringed by other manufacturers, as the license contained no express covenant by plaintiff to protect the defendant against such infringement. *National Rubber Co. v. Boston Rubber Shoe Co., 50 O. G. 559, C. D. 1890.

8. It is no defense that the infringing article made under defendants' patent was manufactured by complainant's licensees where the latter did not account for them to complainant nor consider them within their license. *Timken v. Olin, 51 O. G. 1469, C. D. 1890.

9. Want of patentability is a defense, though not set up in an answer or plea. *May v. County of Juneau, 53 O. G. 1888, C. D. 1890.

10. In the ordinary case of a bill for infringement filed by the holder of a senior patent against the holder of a junior patent the claims whereof conflict, it is no defense that the defendant is acting under a patent. *American Roll Paper Co. v. Knopp, 54 O. G. 391, C. D. 1891.

11. Any person sued for infringement of an American patent may show in defense that the invention claimed was patented or described in some printed publication before the patentee's supposed invention or discovery thereof. *Clark Thread Co. v. Willimantic Linen Co., 56 O. G. 395, C. D. 1891.

12. In an action for infringing a patent demonstrable facts are the decisive factor in determining the actual bearing upon each other of the patents under consideration, and a de-

fense which rests upon a mere theory as to the philosophy of operation of the complainant's device will not be considered by the court when this theory is negatived by the history of the art and by the practical working of the device in question. *Stilwell & Bierce Mfg. Co. v. S. N. Brown & Co., 60 O. G. 1191, C. D. 1892.

13. The existence of letters patent issued in due form constitutes *prima facie* evidence of the validity of the patent; and where, in an action at law for infringement, such letters are introduced, an alleged want of invention is matter of defense, the burden of showing which is on defendant; and the court cannot direct a judgment for defendant, even though the patentee on cross-examination has given evidence that may tend to show a prior state of the art excluding invention on his part. *Hunt Brothers Fruit Packing Co. v. Cassidy, 62 O. G. 1965, C. D. 1893.

14. The allegation by defendants that they have invested large amounts in their enterprise based upon the patent for the improvement is not a valid defense to a suit for infringement in the face of repeated adjudication sustaining the complainant's patent. *American Bell Telephone Co. v. Brown Telephone and Telegraph Co., 65 O. G. 894, C. D. 1893.

15. The defense of want of patentable novelty operates not merely to exonerate the defendant, but to relieve the public of an asserted monopoly. *Haughey v. Lee, 66 O. G. 1450, C. D. 1894.

16. Where in a defense to a suit it is shown that more than two years before the suit was brought the complainant acquiesced in a decision adverse to him in an interference in the patent office in favor of a patent issued to the defendant, *held*, that his acquiescence in the decision for such length of time worked an abandonment of any claim he might have made to the invention. *Fassett v. Ewart Mfg. Co., 69 O. G. 953, C. D. 1894.

17. When defendant at the hearing had ample opportunity and every inducement to produce a result equal to that of the complainant with devices known in the art prior to the production of the device of the patent sued on, and failed, the presumption, notwithstanding his explanation to the contrary, is that the prior art was not sufficient for the production of results as good as the patentee's. *A. B. Dick Co. v. Henry, 75 O. G. 1204, C. D. 1896.

18. A defense that machines were bought by the defendant without notice of a clog upon the title to them will not avail when it appears that the contract by which the machines were

conveyed contains a reference to the license which contains the limitations constituting the clog referred to, and knowledge is justly imputable to the defendant in such case. *International Pavement Co. v. Richardson, 76 O. G. 166, C. D. 1896.

19. A contention that a patent built on the lines of the patent in suit was a failure will not avail defendants where it appears that there was no defect of principle. *Independent Electric Co. v. Jeffrey Mfg. Co., 78 O. G. 797, C. D. 1897.

20. Where an assignment of a patent by a corporation is executed by its president and secretary, who own all the stock, without any previous authorization by the board of trustees, *held*, that it is no defense to an infringement suit brought by the assignees against a third party where the corporation itself has never questioned the validity of an assignment. *Kansas City Hay-press Co. v. Devol, 81 O. G. 1277, C. D. 1897.

II. BURDEN OF PROOF.

21. Where an alleged infringer's defense relies upon unpatented devices claimed to be anticipations of the patent, and the use and existence of which are proven only by oral testimony, the courts not only impose the burden of proving such devices upon the defendant, but they demand proof that shall be clear, satisfactory, and beyond a reasonable doubt; and they will subject such evidence to the closest scrutiny. *Washburn & Moen Mfg. Co. v. Beat 'Em All Barbed Wire Co., 58 O. G. 1555, C. D. 1892.

22. The mere fact that in rejecting one of the claims of Roberts' original application the patent examiner said "that cones are common things in coiling-machines" is no proof that "rotary" coiling-cones were before used, and if any such cones were, in fact, used the burden was upon defendant to show it. *Roberts v. H. P. Nail Co., 63 O. G. 613, C. D. 1893.

23. In the manufacture of infringing devices, if any advantage results from the use therein of an improvement by the defendant, the burden is upon the defendant to show it. *Sayre v. Scott, 68 O. G. 1818, C. D. 1893.

24. Where the defense to an infringement suit is prior use the burden is on defendant, and it is not sustained where the evidence shows that the alleged prior use was only for experimental purposes and had with a view to perfecting the device. *Pacific Cable R. Co. v. Butte City Street R. Co., 64 O. G. 1397, C. D. 1893.

25. In order that a defense of prior public use may prevail against the patent sued on it is necessary to prove the use beyond a reasonable doubt. *Oval Wood Dish Co. v. Sandy Creek (New York) Wood Mfg. Co., 66 O. G. 1895, C. D. 1894.

26. To invalidate a patent by prior invention or use the proof must establish the fact beyond a reasonable doubt. This means that the defense must be established by proof as explicit and convincing as that required to convict a person charged with crime. *Dodge v. Post & Co., 78 O. G. 839, C. D. 1897.

DEPOSITIONS.

(See AFFIDAVITS; TESTIMONY; WITNESSES, CROSS-EXAMINATION OF.)

1. When a deposition is taken irregularly and without authority, or shows on its face reasons why it cannot and should not be considered, or where an entire deposition is irrelevant, unless there has been a waiver, an objection at the hearing would be entertained. *Milligan v. Niedringham, 38 O. G. 103, C. D. 1887.

2. Depositions may be taken *de bene esse* in equity causes before any notary public or any other officer authorized to take depositions in civil causes under United States Revised Statutes, section 863. *Stegner v. Blake, 45 O. G. 126, C. D. 1888.

3. All objections to mere informalities in depositions not called up before final hearing should be considered as waived. *Id.

4. Until depositions are filed in the patent office the commissioner has no control over them. There is no positive rule requiring the parties to file all depositions taken, and it necessarily follows that the commissioner is without authority to compel the filing of such depositions. †Petithomme v. Bedbury, 52 O. G. 605, C. D. 1890.

DESIGNS.

- I. APPEAL AND PETITION.
- II. CONSTRUCTION OF STATUTES.
- III. INFRINGEMENT.
- IV. LIMITED TO A SINGLE INVENTION.
- V. MECHANICAL PATENT.
- VI. PATENTABLE SUBJECT-MATTER.
- VII. PUBLIC USE AND SALE.
- VIII. PRACTICE IN PATENT OFFICE.
- IX. TEST OF IDENTITY.

I. APPEAL AND PETITION.

1. An application for patent upon "a design for ornamenting the surface of the walls of railway cars," etc., which, in the opinion of the examiner, contains nothing which can "constitute proper subject-matter for a design patent," should be by such examiner rejected. From such rejection an *appeal* will lie to the board of examiners-in-chief, as in ordinary cases of the rejection of claims. *Ex parte Harris*, 38 O. G. 104, C. D. 1887.

2. Objections to claims for non-segregable parts relate to the merits rather than to form, and upon rejection the appeal should go to the examiners-in-chief. *Ex parte Gérard*, 43 O. G. 1235, C. D. 1888.

3. An objection to descriptive phrases in the specification of a design application as being matter which tends to indicate mechanical functions rather than design goes to the form of the specification rather than to its merits and is properly brought to the commissioner on petition. *Ex parte Herrick*, 43 MS. D. (2 G. W. D.), May, 1890 (Fisher, Ass't Com'r).

4. Where a single entire design is claimed, and the question arises whether portions of the design claimed separately are segregable, a question of merits is presented, upon which the appeal lies to the examiners-in-chief, in case of rejection by the examiner. *Ex parte Petzold*, 35 O. G. 1651, C. D. 1891.

5. Where a petition was taken from the action of the examiner objecting to the claims as not setting forth proper subjects-matter for a design, no repetition of such action having been made, *held*, that the petition was prematurely taken and that the examiner should have made his reasons for *objecting* to the claims the basis for a *rejection*. *Ex parte Bishop*, 63 O. G. 153, C. D. 1893.

6. An objection that a claim for a design is not single goes to the merits and appeal lies to examiners-in-chief. *Ex parte Myers*, 64 O. G. 359, C. D. 1893.

II. CONSTRUCTION OF STATUTES.

7. The word "useful," employed by congress in legislation upon the subject of mechanical and design applications, defined and distinguished, and *held*, when applied to designs, to relate to matters of decoration and æsthetic art which reach the senses through the eye, and so used in an entirely different sense from that in which it is applied to the subject of

mechanical invention, where the *usefulness* contemplated by the statute relates to the employment of dynamic force, its modification or operation. *Ex parte Schulze-Berge*, 42 O. G. 293, C. D. 1888.

8. The word "manufacture," as used in section 4929 of the statute relating to designs, is to be construed so as to have the same meaning as the word "manufacture" in the prior statutes relating to mechanical patents. *Ex parte Lewis*, 54 O. G. 1890, C. D. 1891.

9. The word "manufacture" in the patent statutes has never been construed to include real estate, and it must be limited to manufactured articles — that is, those made by hand, machinery or art, from raw or prepared materials. *Id.*

10. The design covered by the patent in suit *held* to come within the first clause of this section, as a "manufacture," rather than within the third clause, as an "original impression, ornament," etc. **Eclipse Mfg. Co. v. Adkins*, 56 O. G. 1407, C. D. 1890.

11. The second clause of the section requires that there should be a description of the design, which is to be "printed, painted, cast or otherwise placed on or worked into any article of manufacture." **Id.*

12. The word "manufacture," as used in section 4929, Revised Statutes, *held* not to include such a generic term as the word "table-ware." *Ex parte Proeger*, 57 O. G. 546, C. D. 1891.

13. The act of February 4, 1887, entitled "An act to amend the law relating to patents, trademarks and copyrights," which *inter alia* imposes a penalty upon an infringer of a design patent to be recovered by the owner of the patent upon a bill in equity for an injunction to sustain such infringement, examined and *held* to be constitutional. (*Root v. Railway Co.*, 21 O. G. 1112, 105 U. S. 189, 206; *Stevens v. Gladding*, 17 How. 454, and *Stevens v. Cady*, 2 Curt. 20.) **Untermeyer v. Freund*, 65 O. G. 1767, C. D. 1893.

14. The act of February 4, 1887, was passed for the manifest purpose to enlarge the remedy against infringers of design patents and to declare that the measure of profits recoverable on account of the infringement should be considered to be the net profits upon the whole article. The rule which the act declares for the computation of profits is the total profit from the manufacture or sale of the article to which the design was applied, as distinguished from the pre-existing rule of the profit which could be proved to be attributable to the design. **Id.*

15. The word "expense" in the statute relating to design patents means a "disbursement of money" and also "the employment and consumption of time and labor." To confine its meaning to the mere expenditure of money would be contrary to the purpose of the statute, which purpose is to secure to those who shall invent and produce a new and original design a monopoly in the design. **Matthews & Willard Mfg. Co. v. Trenton Lamp Co.*, 75 O. G. 674, C. D. 1896.

16. The word "useful" in the statute relating to designs has reference to mechanical rather than purely esthetic features in designs relating to machinery. The excellence of such a design depends upon its nice adaptation. The word "useful" may be applied to the shape or configuration of a patentable form with a signification much wider than "not harmful." *Ex parte Lunken*, 76 O. G. 785, C. D. 1896.

III. INFRINGEMENT.

(See TEST OF IDENTITY.)

17. The test of infringement is the "identity of appearance, determined by the eye of the ordinary observer — the public." (*Gorham Co. v. White*, 14 Wall. 511.) *Ex parte Gérard*, 43 O. G. 1235, C. D. 1888.

18. Where the alleged infringing manufactures of the defendants produced a different effect upon the eye of the ordinary observer from what was produced by the complainant's manufacture, *held*, that there was no infringement. **Dukes v. Bauerle*, 51 O. G. 805, C. D. 1890.

(See, also, page 808, same volume.)

19. The statute relating to designs only insists — in order to sustain an action for infringement — that the design shall have been applied without license, coupled with a sale, the party selling knowing that the design has been so applied. **Pirkl v. Smith*, 52 O. G. 1372, C. D. 1890.

20. The drawing of the patent represents, and the specification describes, a square mat, but the specification adds "it might be oblong or other desirable shape." Defendant's mat shows the design as applied to an oblong mat, which involves changes in the central panel. An ordinary purchaser would take one for the other. **New York Belting and Packing Co. v. New Jersey Car Spring & Rubber Co.*, 48 Fed. Rep. 556 (1891).

21. Although the suit does not involve the method of producing the result, yet in consid-

ering the question of anticipation the court may properly take into consideration the fact that the patentee invented the method of making articles of glassware having a "blown" body and a "pressed" neck, thereby rendering possible the raised ornamentation of the neck in the patent. *Ripley v. Elson. Glass Co., 60 O. G. 298, C. D. 1892.

22. In determining whether a design patent is infringed, the test is whether there is a substantial similarity in appearance not to the eye of the expert, but to that of the ordinary observer giving such attention as would ordinarily be given by a purchaser of the article bearing the design. *Id.

23. Where the infringement of a design patent is deliberate and intentional, the court will impose upon the defendant the penalty of \$250 provided for by act of February 4, 1887. *Id.

24. The only new feature of the patented design being the sharp drop of the pommel at the rear, while the saddles of the defendants have only a slight curved drop at the rear of the pommel, *held*, that the difference was so marked that the defendants' saddle could not be mistaken for the saddle of the complainant, and that there was therefore no infringement. *Smith v. Whitman Saddle Co., 63 O. G. 912, C. D. 1893.

25. A design which imitates the figures of a patented design in their characteristic and important features and produces the same general appearance infringes, though the imitative figures are much smaller than those of the patent. *Whittall v. Lowell Mfg. Co., 80 O. G. 809, C. D. 1897.

26. Design Patent No. 18,190 not infringed by defendant's stove, which in its appearance, either generally or in detail, does not so far resemble the complainant's design as to deceive purchasers or dealers, but, on the contrary, seems to be well distinguished in form and ornamentation. *Michigan Stove Co. v. Fuller-Warren Co., 80 O. G. 1892, C. D. 1897.

IV. LIMITED TO A SINGLE INVENTION.

27. A design application will not be permitted to embrace more than one subject of invention. The same principles in this particular which control in mechanical applications must obtain in design applications. A distinct and separate invention relating to the form or configuration cannot be lawfully included in a patent embracing a distinct and separate invention as to surface ornamenta-

tion—as, for instance, an *alto-rilievo* cannot be joined with an ornamentation or picture to be worked into a woolen fabric; but when the shape and the ornamentation are parts of the same article of manufacture, so that both unite in producing the same result, then they are not distinct and separate within the purview of the rule. *Ex parte Gérard*, 43 O. G. 1235, C. D. 1888.

28. Under the statute the design must be a *finished and completed* thing—must be one entire and integral thing. It cannot consist of several integral different designs aggregated, so as to protect the several individual parts, nor so that these parts may be separately applied to other and different articles or parts of articles of manufacture. *Id.*

29. The doctrines of combinations and elements of combinations and of genus and species obtaining in mechanical inventions cannot be applied to designs. In a mechanical combination, when one element is withdrawn that combination ceases; but in a design, a subordinate and unimportant feature may be withdrawn and yet the design as a whole remain, and to simulate the predominant features would infringe the whole. *Id.*

30. As the subject of identity of the design is addressed to the eye of the ordinary observer—the public—so the questions of the extent and character of claims in patents for distinctive and segregable parts must be determined largely by the skill and judgment of the experts of the office. *Id.*

31. The relation of genus and species does not exist in designs. The question involved in designs is one of identity. *Ex parte Gérard*, 43 O. G. 1240, C. D. 1888.

32. A patent for a design must be limited to a single invention; but such patent may cover any variation or modification, provided the distinct and predominant features so far remain as to preserve the identity of the original completed design. *Id.*

33. While it is probable that a design patent may have different claims for different ornaments to be placed on the same manufactured article, yet a single claim cannot cover several ornaments in no way depending upon each other. *Dukes v. Bauerle, 51 O. G. 805, C. D. 1890.

34. Where two or more designs are not only claimed, but are represented in the drawings, neither one being a part of either of the others, applicant must elect which one he will retain in the pending application, and any appeal

from the examiner's action in requiring the election should be taken to the commissioner. *Ex parte Petzold*, 55 O. G. 1651, C. D. 1891.

35. Where one design is illustrated and two or more designs are claimed, neither one being a part of either of the others, the examiner should decline to consider any claim excepting the one for the design illustrated, requiring the remaining claims to be severed from the application. *Id.*

36. The question of similarity or dissimilarity arising upon the comparisons of designs is determined by the eye of the ordinary observer and not by the judgment of experts. *Ex parte Petzold*, 55 O. G. 1652, C. D. 1891.

37. The patent office should not seek to forestall the judgment of the courts by holding, upon the judgment of its experts, that certain designs differing from the design illustrated in the drawing are mere modifications thereof. *Id.*

38. A claim for the design as illustrated, if new and patentable, should be allowed, leaving the question whether or not other designs which are claimed by the applicant to be mere modifications are or are not independent designs, to be determined by the lawful tests applied in the courts. *Id.*

39. Any number of designs require for their protection the same number of patents unless one or more of them are component parts of another design from which they are segregable. *Id.*

40. Cases arise in which separable subordinate designs form when united one principal and complete design, and if such separable subordinate designs are new and patentable there would seem to be no reason why they should not be claimed in the same application with such principal and complete design, whether or not the experts of the office are of opinion that the separable subordinate designs are in and of themselves suggestive of the design in its entirety. *Ex parte Bennett*, 55 O. G. 1821, C. D. 1891.

41. If the design as a whole is patentable as constituting one complex whole of beauty or attractiveness, and a border, or center-piece, or other design element which is segregable therefrom, would be in itself new and patentable, if it constituted the entire ornament, *held*, that claims may properly be allowed in the same application for the complex whole and the segregable element. *Id.*

42. If the designs are independent they should be the subject of separate applications. (*Ex parte Beattie*, C. D. 1879, 142.) *Id.*

43. The question whether or not three different forms cover the same design is for the courts and not for the office. *Ex parte Hess and Hess*, 56 O. G. 1334, C. D. 1891.

44. The practice of allowing two or more forms to be included in a single design patent would result in confusion in the office and ought not to be permitted. *Id.*

45. Only one design can be the subject of a design patent, and where applicant's specification attempts to cover more than this it is properly held defective. *Ex parte Petzold*, 57 O. G. 1277, C. D. 1891.

46. The range or scope of a design patent is to be determined by the courts and not by the patent office. It is therefore not proper for the office to issue a design patent which on its face purports to cover an indefinite variety of modifications which may or may not be within the proper scope of the claim, as that matter shall be determined by the courts. *Ex parte Finck*, 60 O. G. 157, C. D. 1892.

47. Where it appeared from the specification that certain words and figures shown on the face of the design in the drawing did not constitute an essential feature of the design, *held*, that the patent should not be permitted to seem to make them so, and that they should be erased. *Ex parte Requa*, 60 O. G. 295, C. D. 1892.

48. While the law may permit claims in one design patent for the entire design and for constituent parts complete in themselves, the patent office will not permit independent ornamental inventions to be joined in one patent. *Ex parte Petzold*, 61 O. G. 1789, C. D. 1892.

49. The practice of the office in refusing to permit independent and alternative mechanical inventions to be joined in one patent is warrant for a like refusal as to two independent and alternative designs. *Id.*

50. An *objection* to a claim for a design that it is not single; that it fails to set up any article of manufacture, but, on the contrary, calls for three separate articles aggregated, is one pertaining to the merits and should therefore have been a *rejection*. *Ex parte Myers*, 64 O. G. 859, C. D. 1893.

51. An applicant may describe and claim variations in his patentable form within such limits as are consistent with unity of design and to the extent claimed. *Ex parte Lunken*, 76 O. G. 785, C. D. 1896.

52. Separate claims for the entire design and for its separate parts may properly be allowed in one patent. (*Dobson v. Carpet Co.*, 114 U. S.

439.) *Britton v. White Mfg. Co., 79 O. G. 2195, C. D. 1897.

53. The patent office having allowed the separate claims in one patent, a mere statement by counsel during the prosecution of the case, of a reason why it was desirable to include them in a single patent does not estop the patentee to claim what was clearly granted him under said patent. *Id.

54. Where applicant presents two distinct articles of manufacture—a cradle-supporting frame and a cradle-body—and claims them as such, *held*, that the application should be restricted to one or the other of these two designs. (Ex parte Patitz, C. D. 1883; 101, and Ex parte Brower, C. D. 1873, 151, followed.) Ex parte Haggard, 80 O. G. 1126, C. D. 1897.

55. Claims of a design patent are related as generic and specific when one has more elements recited therein than the others. Ex parte Coe, 81 O. G. 2086, C. D. 1897.

56. When an inventor has produced a design, he has produced a single shape or configuration and not a plurality of them. He may make additions to that design, but may not make modifications. Two different manifestations constitute two distinct species, of which one is a modification of the other. *Id.*

57. Two separate designs are never permissible in one application. (Ex parte Patis, 25 O. G. 980, and Ex parte Brower, C. D. 1873, 151.) Claims for a cradle-body and a cradle-supporting frame *held* inharmonious. Ex parte Ries W. Haggard, 62 MS. D., June, 1897. (Rehearing, Greeley, Ass't Com'r.)

58. An application disclosing two castings for use in adjoining parts of a bedstead, and adapted to interlock and form a joint, *held* to cover distinct inventions not constituting a unitary design, but merely an aggregation. Ex parte Brand, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

(A patent for a design held not bad because it embraced more than one letter of the alphabet. *Miller v. Smith, 18 O. G. 1047, C. D. 1880.)

V. MECHANICAL PATENT.

59. The inventor and patentee of a mechanical device may also receive a design patent for the configuration, ornamentation or decoration which the mechanical invention is capable of receiving. Ex parte Schulze-Berge, 42 O. G. 293, C. D. 1888.

60. A new and original design under the statutes may also be the subject of a mechan-

ical patent. (Ex parte Schulze-Berge, 42 O. G. 293.) Ex parte Gérard, 43 O. G. 1235, C. D. 1888.

61. Since the subject-matter of an application for a design patent and of a mechanical patent is different, since the matter claimed in the design application could not have been claimed in the other, and since the grant of the design patent cannot extend the term of the other, *held*, that the mechanical patent is no bar to the grant of a design patent upon the same article. Ex parte Lunken, 76 O. G. 785, C. D. 1896.

(The question whether a mechanical patent showing a design is a bar to the grant of a patent for such design subsequently applied for by the patentee was first decided adversely, under the law of 1870 (in Ex parte Kohler, C. D. 1873, 84), by the supreme court of the District of Columbia, the chief justice (Carter) dissenting. Subsequently the circuit court (Blatchford, J.) rendered an opposite opinion, which, taken with Commissioner Marble's decision in Ex parte Palmer, 21 O. G. 1111, C. D. 1881, settled the practice which still prevails.)

VI. PATENTABLE SUBJECT-MATTER.

62. It is not novelty which will sustain a design patent to transfer to rubber, or to a rubber mat, an effect or impression to the eye which has been produced upon other materials or articles by contrast or variation of light and shade. *New York Belting & Packing Co. v. New Jersey Car Spring and Rubber Co., 30 Fed. Rep. 785 (1887).

63. The fact that an article is useful does not make it less patentable as a design if it is new as a design. *Kraus v. Fitzpatrick, 42 O. G. 1292, C. D. 1888.

64. It is no answer to the validity of a design patent that special features of it are found separately in prior things. *Id.

65. The validity of a patent for a design does not depend upon the exercise of the "inventive faculty of the mind" in the sense in which that expression is used in connection with inventions which relate strictly to the useful arts. *Untermeyer v. Freund, 47 O. G. 527, C. D. 1889.

66. The policy which protects a design is akin to that which protects the works of an artist by copyright. If the design produce a different impression upon the eye, even though it be simple, and does not show wide departure from other designs, its use will be protected. *Id.

67. When two design patents were applied for by the same person and issued to the same person on the same day, and were each for a

design for a sewing-machine case, and each design exhibited one or more features found in the other, *held*, that each qualified and limited the other. *Dukes v. Bauerle, 51 O. G. 805, C. D. 1890.

68. A design patent must exhibit exercise of the inventive or original faculty as clear and of as high degree as is called for in patents for inventions or discoveries. In the latter class there must be novelty and utility; in the former, beauty and originality. *Cahoone Barnett Mfg. Co. v. Rubber & Celluloid Harness Co., 45 Fed. Rep. 582 (1891).

69. Appropriation of the invention of another, though the design may disclose alteration, does not justify issue of a patent. *Id.

70. Whether the peculiar effect — “a sort of kaleidoscope effect” — produced by the particular design in question impressed upon the substance of India rubber would constitute a quality of excellence which would give to the design a specific character and value and distinguish it from other similar designs that have not such an effect, *quære*. *The New York Belting and Packing Co. v. The New Jersey Car Spring and Rubber Co., 54 O. G. 135, C. D. 1891.

71. A design for jewelry pins, consisting of a piece of metal in the shape of a spoon or fork two inches long, precisely similar in appearance to common spoons or forks six inches long, lacks the novelty necessary to support a design patent. *Foster v. Crossin, 54 O. G. 1115, C. D. 1891.

72. In order to support a patent for a design, as for any other subject, under the acts passed by congress in the exercise of its constitutional power to secure to inventors the exclusive right to their discoveries, there must be some invention and not a mere application to a new material of something already known. *Id.

73. A dwelling-house is not a “manufacture” in the statutory sense, and a design for the exterior of a dwelling-house is not patentable. *Ex parte Lewis*, 54 O. G. 1890, C. D. 1891.

74. Articles which are manufactured and sold with reference to becoming a part of a house ultimately, such as mantels, are “manufactures” within the meaning of the statute relating to designs. *Id.*

75. A patent for an improvement in a design is valid if it be clear from the specification and drawings that the design is of itself new and distinctive and improved as compared with others and not merely an improvement upon

another design. *Anderson v. Saint, 57 O. G. 546, C. D. 1891.

76. A design patent is not invalid because it covers scrolls and ornamentations, similar in effect to scrolls and ornamentations that have been before used, if a new idea is embodied in the method of their arrangement. *Id.

77. The plaintiff did not design an album case proper, nor an ornament proper for an album case, but he appears to have conceived the idea of placing such ornament upon an album case. The statute provides for patent upon designs for articles of manufacture and for patents for ornaments to be placed upon or worked into such articles, but does not appear to provide for a patent for the mere placing of an ornament on such articles. Patent held invalid. *Bergner v. Kaufmann, 52 Fed. Rep. 818 (1892).

78. Three design patents for pen cases and tips — Nos. 20,156, 20,157, 20,158 — present changes in assemblage and construction of parts which produce things not exactly known before, and in that sense new, but they seem to have been due more to good taste than to inventive skill, and are really too slight to sustain any one of the three patents. (*Atlantic Works v. Brady*, 107 U. S. 192, 2 Sup. Ct. 225.) *Eagle Pencil Co. v. American Lead Pencil Co., 53 Fed. Rep. 368 (1892).

79. As high a standard of originality is required for design patents as for any other class, and such originality goes to appearance or ornamentation rather than to utility. *Ex parte Williams, Jr.*, 58 O. G. 803, C. D. 1892.

80. The object sought in the design is a new effect upon the eye alone — a new appearance, which alone the law regards. *Held*, that a Masonic design for decorating rugs, composed of certain Masonic symbols grouped in an orderly and tasteful manner so as to form a panel large enough to cover the face of the rugs, was sufficient to sustain the patent. *Smith v. Stewart, 55 Fed. Rep. 481 (1893).

81. In determining the patentability of a design for a new and original shape or configuration of an article of manufacture its utility is an element for consideration. (*Lehnbeuter v. Holthaus*, 21 O. G. 1783, 105 U. S. 94.) *Smith v. Whitman Saddle Co., 63 O. G. 912, C. D. 1893.

82. The exercise of the inventive or origina-tive faculty is required in the production of a patentable design, and a person cannot be permitted to select an existing form and simply put it to a new use any more than he can be

permitted to take a patent for the mere double use of a machine. If, however, the selection and adaptation of an existing form amount to more than the exercise of the imitative faculty and the result is in effect a new creation, the design may be patentable. *Id.

83. The patent being for a design for a riding-saddle, and the evidence showing that the form of tree was that of one known type, the form of cantle that of another known type, and that the central open slot was old, *held*, that the presence or absence of the slot was not material, and that the addition of a well-known cantle to a known saddle, in view of the fact that such use of the cantle was common, did not in itself involve genius or invention or result in a patentable design. *Id.

84. If the design in the patent consists merely in a transfer of an old form for a design or its mere adaptation by imitation from one kind of manufacture to another kind, it is not an invention, and the patent, therefore, is void; but if the adaptation is more than the exercise of the imitative faculty, and the result is in effect a new creation, the design is an invention and is patentable. (Smith v. Whitman Saddle Co., 63 O. G. 912, 148 U. S. 674.) *Untermeyer v. Freund, 65 O. G. 1767, C. D. 1893.

85. It cannot be said to require exercise of the inventive faculty to emboss a pattern on a radiator which had before been painted thereon. *Eclipse Mfg. Co. v. Holland, 69 O. G. 372, C. D. 1894, 62 Fed. Rep. 465.

86. Under the statute and decisions of the supreme court a design must exhibit originality and the exercise of the inventive faculty. *Hammond v. Stockton Combined Harvester and Agricultural Works, 70 Fed. Rep. 716 (1895).

(See Gaskill v. Myers, 81 O. G. 1111, C. D. 1897.)

87. Where two designs are in their prominent features identical, and their sole difference lies in the fact that the protuberance of one has a small nut on the end and the other has none, the difference is not of such material character as to afford ground for the grant of a design patent. *Welker v. Weller, 75 O. G. 185, C. D. 1896.

88. Originality was not displayed, invention was not exercised, and novelty was not introduced by placing different shades of color in divided stripes upon an old form of flag. *Caldwell & Co. v. Powell, 75 O. G. 1206, C. D. 1896.

89. A design patent for the case of a "nickel-in-the-slot machine," *held* invalid, because used on a gambling device (which was asserted to

be adapted for other purposes). (Quoting Device Co. v. Lloyd, 40 Fed. Rep. —, 1889, which concerned a patent for a "toy automatic race course.") *Reliance Novelty Co. v. Dworzek, 80 Fed. Rep. 902 (1897).

90. A design as a whole should be of unchanging character and should not include movable parts, since the shape or configuration of a device is varied by varied positions of its elements. Ex parte Smith, 81 O. G. 969, C. D. 1897.

(On the question whether utility as well as ornamentation may form the basis of a design patent, see the following cases: Ex parte Crane, C. D. 1869, 7 (Foote, Com'r); Ex parte Solomon, C. D. 1869, 49 (Hodges, Acting Com'r); Ex parte Bartholomew, C. D. 1869, 103 (Fisher, Com'r); Ex parte Fenno, C. D. 1871, 52 (Duncan, Acting Com'r); Ex parte Parkinson, C. D. 1871, 251 (Leggett, Com'r); Ex parte Doolittle, C. D. 1872, 176 (Thacher, Acting Com'r); Ex parte Oglesby, 8 O. G. 211, C. D. 1873, 5 (Leggett, Com'r); Ex parte Fairchild, 8 O. G. 323, C. D. 1873 (Thacher, Acting Com'r); Ex parte Collender, 2 O. G. 360, 1873 (Thacher, Acting Com'r); Ex parte Norton, 22 O. G. 1205, C. D. 1882 (Marble); *Theberath v. Rubber & Celluloid Harness Trimming Co., 23 O. G. 1121, C. D. 1883; Ex parte Stetson, 36 O. G. 691, C. D. 1874 (Leggett, Com'r); *Smith v. Whitman Saddle Co., 63 O. G. 912, C. D. 1893.)

VII. PUBLIC USE AND SALE.

91. Original designs, like inventions and discoveries, are patentable unless they have been in public use or on sale for more than two years prior to application for patent or have been abandoned. *Anderson v. Eiler, 57 O. G. 410, C. D. 1891.

92. Sale before application for patent of an article bearing a design by the designer to a manufacturer with knowledge that the manufacturer buys to obtain the design for use on his goods does not constitute abandonment, but operates as a license to the manufacturer. *Id.

VIII. PRACTICE IN PATENT OFFICE.

93. It has been customary to require that the words "as shown and described" shall be employed in the claims of design patents, in order that the patents may be limited to the subject-matter shown and described. The introduction of such words operates as a guidepost to inform all persons that the patent is limited to the precise invention shown and described, and that there is no hidden mystery or secret trap by which those who attempt to enter the same field of invention or to use other articles may be arrested in their efforts or mulcted in damages. Ex parte Gérard, 43 O. G. 1235, C. D. 1888.

94. An applicant who has filed an application for a design patent for the term of three and a half years, which has received examination on the merits, will not be permitted to have the government fee paid on filing such application applied as part payment on a second application filed for the full term of fourteen years for the same subject-matter. *Ex parte Haley*, 44 O. G. 1399, C. D. 1888.

95. It is doubtful whether a claim, in a design patent, which is not restricted to the particular pattern shown in the drawing, is valid, because not a claim for a particular design in the sense of the statute. The claim must be to a particular impression or ornament, of a particular configuration, or color, or pattern, and it must be so shown or described as to be identified. **Condé v. Valkenburgh*, 39 Fed. Rep. 788 (1889).

96. An application for a design patent, which the applicant has elected to prosecute for the shortest period prescribed by law, cannot be amended to run for a longer period after favorable action on the merits. *Ex parte Kinnear*, 51 O. G. 156, C. D. 1890.

97. The rules of the patent office require that the specification shall distinctly point out the characteristic features of the design for which a patent is sought. *Ex parte Pegel*, 55 O. G. 1528, C. D. 1891.

98. The examiner should exercise his judgment in each case as to the extent to which the characteristic features shown in the drawings should be pointed out in the specification in order to comply with the requirement of distinctness. *Id.*

99. Where a floral border for a rug was designated by the letter A, and the characteristic features of the design were pointed out as consisting of a floral border A surrounding an oval field center, *held* sufficient. *Id.*

100. An application for a design patent may properly be rejected upon a drawing in a former patent, although such drawing is not accompanied by any detailed description. *Ex parte Crouch*, 57 O. G. 845, C. D. 1891.

101. Where certain words and figures (numerals) appeared on the illustration of a design, *held*, that they should be erased if they form no part of the design. *Held* further, that the examiner should reject if such words, etc., are a part of the design, provided he is of the opinion that words and figures (numerals) may not form part of the subject-matter of a design patent. *Ex parte Van Slyke*, 60 O. G. 893, C. D. 1892.

102. The discretion of the commissioner of patents is not limited by the statute to dispensing with the model of a design. *Ex parte Aumonier*, 63 O. G. 1815, C. D. 1893.

103. Rule 83 (relating to drawings, etc.) is not "inconsistent with law" (Rev. Stats., sec. 483), and it has all the force of a statute. *Id.*

104. The chief draftsman is the proper person to decide whether a line-drawing can be made of a design. *Id.*

105. Granting the fact that *fac-similes* may be received as models or specimens, the question as to whether a line-drawing or photograph should be furnished is not affected thereby. *Id.*

106. In a design application showing more than one modification, applicant is permitted to show, describe and claim modifications generically. (*Ex parte Hess and Hess* (56 O. G. 1334) and *Ex parte Finck* (60 O. G. 157) overruled.) *Ex parte Bark*, 69 O. G. 369, C. D. 1894.

107. The use of mechanical terms in setting forth the relation of the parts of a design and their uses is not objectionable. *Ex parte Lunken*, 76 O. G. 785, C. D. 1896.

108. The three claims in a design patent covered (1) the body part, A, (2) the upper part or cover, D, and (3) the body part A and the upper part or cover D together. **Britton v. White Mfg. Co.*, 61 Fed. Rep. 93 (1894).

109. In a design, claims for the segregable features may be allowed, whether accompanied by a claim for the whole design or not. *Ex parte Ringold*, 58 MS. D., Nov., 1895 (Seymour, Com'r).

110. The drawing of a design application may include an illustration of the practical use of the device. *Ex parte Bensinger*, 59 MS. D., May, 1896 (Fisher, Acting Com'r).

111. A claim reading "In a design for a carpet, the body, A, substantially as shown" refers to the description as well as the drawing. **Whittall v. Lowell Mfg. Co.*, 80 O. G. 809, C. D. 1897.

112. Black and white drawings illustrating the designs in a design patent are to be considered as forms, into which may be filled a great variety of arrangements or effects of color or shades without affecting the patented design. **Id.*

113. The essentials of a design are what cannot be changed without destroying its characteristic appearance; and where shading shown in the drawings may be reversed or removed without such effect, it must be considered as but one of many permissible ways of treating

the design, and therefore as an unnecessary addition to the conventional black and white outline drawing, which neither restricts nor enlarges the scope of the design. *Id.

114. A drawing of a design case should disclose the entire design, not merely a part thereof. *Ex parte Parker*, 80 O. G. 1892, C. D. 1897.

IX. TEST OF IDENTITY.

(See INFRINGEMENT, *supra*.)

115. The question is whether to the eye of the ordinary purchaser—and this is the recognized test in such cases—the designs of the plaintiff and defendant present the same appearance. **Macbeth v. Gillinder*, 54 Fed. Rep. 171 (1891).

116. The true test of identity of designs is sameness of appearance—that is, sameness of effect upon the eye of an ordinary observer bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give. **Smith v. Whitman Saddle Co.*, 63 O. G. 912, C. D. 1893.

117. The novelty of a design is to be tested, not by investigation of the means employed for its creation, but by ocular comparison of the design itself with the prior designs in the art. **Braddock Glass Co., Limited, v. Macbeth*, 70 O. G. 1799, C. D. 1895.

DISCLAIMER.

I. IN APPLICATION.

II. IN PATENT (UNDER THE STATUTE).

I. IN APPLICATION.

1. The primary examiner should not and has no right to require applicant to “acknowledge the subject-matter shown to be old by the references,” nor, indeed, to *acknowledge* anything else. *Ex parte Massicks and Crooke*, 38 O. G. 1487, C. D. 1887.

2. In such cases, if applicant “should claim things as new which the examiner clearly thought to be old, this would constitute no reason why the examiner should require an acknowledgment or recognition on the part of applicant that such things in dispute were really old. He should rather reject for that reason.” *Id.*

3. Rule 36 contains nothing indicating that in presenting an application for a patent, the invention being a mere improvement, the ap-

plicant is required to disclaim anything that may be old. That rule only requires that the particular and specific claim of the applicant shall be put in such clear and unambiguous form that the public and any person called upon to construct the machine or device may be able to distinguish between the thing claimed as new and that which is old. *Ex parte Firm*, 39 O. G. 1199, C. D. 1887.

4. Neither rule 42 nor rule 104 has any application in the present case. The disclaimers contemplated by the former are between several applications of the same individual, covering, either by claiming or showing, the same device or invention, and the rule was adopted to prevent the party from procuring a prolongation of the monopoly of his patent by securing two patents for the same thing, and also to prevent an abuse which occasionally might occur of a re-issue upon a patent which showed but did not claim the whole invention. *Id.*

5. In Letters Patent No. 172,608, issued January 25, 1876, to John W. Cassidy, for an improvement in fruit-driers, the patentee first claimed “spring or other catches,” but, on an objection that his application was not in proper form, amended by striking out “or other.” *Held*, that this was not a disclaimer of gravity-catches, which were known mechanical equivalents for spring-catches. **Hunt Bros. Fruit Packing Co. v. Cassidy*, 62 O. G. 1965, C. D. 1893.

II. IN PATENT (UNDER THE STATUTE).

6. Where in the original there was a disclaimer of an earlier patent, and it appeared that in a subsequent interference proceeding it was determined that such subsequent patent was for a different invention, the omission of the disclaimer in a re-issue was proper. **Eames v. Andrews*, 39 O. G. 1319, C. D. 1887.

7. After a decision by the supreme court that the first claim of the re-issue was invalid as being for an invention different from that of the original patent, the owner of the re-issue filed a paper setting out that the specification and claim of the re-issue are too broad, including that of which the patentee was not the first inventor, and disclaiming the first claim. *Held*, that this disclaimer was broad enough to carry with it all of the specification which was applicable only to such claim. **Tarrant v. Duluth Lumber Co.*, 39 O. G. 1425, C. D. 1887.

8. A disclaimer is properly employed for the surrender of a separate claim, or some other

distinct and separate matter, which can be excised without mutilating or changing what is left standing. Perhaps it may be used to limit a claim to a particular class of objects, or to change the form of a claim which is too broad; but certainly it cannot be used to change the character of the invention. *Hailes v. The Albany Stove Co., 42 O. G. 95, C. D. 1888.

9. Sections 4917 and 4922, Revised Statutes, have reference to the same sets of circumstances as grounds for disclaimer, the former authorizing the filing of a disclaimer and the other legalizing suits brought on such patents as have been amended under the first-mentioned section. *Id.

10. The patent might be held to be invalid on account of its covering the product, of which the patentee is not the inventor, and which is a material and substantial part of the thing patented (R. S. 4920); but regarding this as claimed through inadvertence, accident or mistake, without any wilful default or intent to defraud or mislead the public, the patentee may file a disclaimer to the second claim now, and thereupon have a decree for the infringement of the first claim, without costs. *Hake v. Brown, 47 O. G. 1071, C. D. 1889.

11. To disclaim the skein except for use in the process of dyeing would not change the patent into one for the process. The patent for the skein would still be void and the process of using it be still free from the patent. *Grant v. Walter, 47 O. G. 1220, C. D. 1889.

12. Where a case had been heard and decided upon its merits, *held*, the plaintiff could not file a disclaimer in court or introduce new evidence upon that or any other subject, except at a rehearing granted by the court, upon such terms as it thought fit to impose. *Roemer v. Neumann, 49 O. G. 1535, C. D. 1889.

13. Where a formal petition for rehearing had been filed to enable plaintiff to avail himself of a disclaimer filed after decision on the merits and the petition had been granted conditionally, *held*, that the terms imposed as a condition precedent to the rehearing not having been complied with the disclaimer was not in the case. *Id.

14. A patentee is not required to disclaim anything in the specification not covered by the claim, and it is only when the claim following the specification is too broad, in the sense of embracing something as new which is not new, that he is required by section 4922 to disclaim. *The Brush Electric Co. v. The Fort Wayne Electric Light Co., 50 O. G. 434, C. D. 1890.

15. Section 4917 of the Revised Statutes, relating to disclaimers, is broad enough to cover disclaimers made to avoid the effect of having included in the patent more devices than could properly be made the subject of a single patent. *Sessions v. Romadka, 59 O. G. 939, C. D. 1892.

16. Section 4917 of the Revised Statutes must be construed with reference to section 4922, and when so read the only effect of delaying a disclaimer until after the commencement of a suit upon the patent containing the disclaimed subject-matter is to prevent the recovery of costs. *Id.

17. A disclaimer to so much of the claim as does or might make such claim apply to a skein which by reason of being coated with gum or by reason of the manner of its lacing, or for any other reason, is not in condition for dyeing for ordinary manufacturing purposes, *held* to be insufficient to give any increased validity to the patent for a skein or to change it into one for a process. *Grant v. Walton, 63 O. G. 910, C. D. 1893.

18. Where a disclaimer has been filed by a patentee as a result of litigation, the validity of the patent as regards the question of novelty is to be tested not by its original terms and scope, but by what remains after the disclaimer, in the same manner as if the matter disclaimed had never been a part of the patent. (Dunbar v. Myers, 11 O. G. 35, 94 U. S. 194.) *Schwarzwalder v. New York Filter Co., 72 O. G. 1043, C. D. 1895.

19. The disclaimer of matter which is not a part of the description, but is merely a recital designed to enlarge the scope of the patent, operates merely to expunge from the claim what otherwise would, by force of the recital, be incorporated into it constructively. *Id.

20. It is not the office of a disclaimer to broaden a patent. In this case the elimination of one element of the claim clearly broadened it. If one element may be disclaimed out of a combination patent, there would be no limit to the changes which might be effected. *Cerealine Mfg. Co. v. Bates, 77 Fed. Rep. 883 (1897).

DIVISION OF APPLICATION.

(See DIVISIONAL APPLICATIONS; AMENDMENT—ELECTION AND DIVISION; INTERFERENCE.)

I. IN GENERAL.

II. APPARATUS AND PROCESS.

III. CLASSIFICATION IN PATENT OFFICE.

IV. PRACTICE.

V. PROCESS AND PRODUCT.

VI. STATUS OF INVENTION IN THE ARTS.

I. IN GENERAL.

1. When the applicant has a claim for a combination between several elements or parts, and the claim for combination cannot be sustained for want of co-operation, then division between the distinct elements or parts should be required in accordance with the principle hereinbefore announced. *Ex parte Herr*, 41 O. G. 463, C. D. 1887.

2. When inventions are so near the dividing line as to render impossible the determination with certainty whether in a proper sense co-ordination and combination exist, so as to constitute them one invention or combination, the doubt should be resolved in favor of the inventor, and he should be allowed to unite them in one application if he so elect. *Id.*

3. While a patent would not be declared void, but would be supported in the courts, even though it might cover two independent inventions, the commissioner in the proper administration of the office is vested with the discretionary power to require division in certain cases. *Ex parte Sartell*, 42 O. G. 295, C. D. 1888.

4. The question of division as decided in *Ex parte Herr* (41 O. G. 463), re-examined and that decision adhered to. The case of *Mosler Safe and Lock Co. v. Mosler, Bahmann & Co.* (48 O. G. 1115) considered. *Ex parte Simonds*, 44 O. G. 445, C. D. 1888.

5. The practice of selecting one of the elements of a combination claim, as if it were claimed separately, and some other element which is claimed specifically outside the combination and requiring division, *disapproved*. Such practice denies an applicant the legal right to an appeal on his combination claim. (*Ex parte Hyams*, MS., v. 36, p. 260; *Ex parte Gessner*, *id.* 277.) By taking such appeal applicant forfeits no right, nor is his status changed with reference to the remaining claims in his application. *Ex parte Gillette*, 44 O. G. 819, C. D. 1888.

6. The determination of the present case must depend upon whether the invention consists of a new sewing-machine originally new in all its parts and elements, or only new in its combination of old or new elements or parts of each, or whether the invention consists simply of "improvements" upon parts of an

old organism, but which do not disturb its original organism or identity as such. *Ex parte Willcox and Borton*, 45 O. G. 455, C. D. 1888.

7. Mere improvements upon an old element in a combination, which improvements do not change the identity of that element, will not render the element patentable in the same application with the combination. As corollary to this, several improvements upon parts of a distinct organism, which tend to improve the proximate result of the whole but do not disturb its identity, may be claimed in the same application. The "improvements" here contemplated do not embrace or relate to mere additions, adaptations of new parts, or attachments which are not incorporated in the old organism and do not assist in improving the specific function of the whole organism. *Id.*

8. Division must be required for two reasons: *first*, because the distinct subjects of invention ought not to be embraced in one application; *second*, because the applicant has not the right, by aggregating claims to any number of distinct inventions under a false claim to a combination, to force the office to examine and act upon his several inventions. *Ex parte Carter*, 46 O. G. 1391, C. D. 89.

9. Division of an application should not be demanded unless there is in the given case such a total want of interdependence between the two matters claimed as would render them absolutely independent and distinct inventions. *Ex parte McMahan*, 48 O. G. 255, C. D. 1889.

10. Rule 41 does not require that, in order to authorize a single patent for several distinct inventions which mutually contribute to a single result, there must be such intimacy of interconnection and co-operation as to result in a third invention or combination. *Ex parte Lord*, 50 O. G. 987, C. D. 1890.

11. The question of division has always been held to pertain to the administrative side of the functions of the commissioner; jurisdiction over this question is not changed by reason of its being presented in the present form. *Ex parte Chambers*, 51 O. G. 1943, C. D. 1890.

12. Where the machine or apparatus improved upon is old and no claims are made professing to cover its fundamental organization, the several specific improvements are to be grouped with reference to the several single functions which they mutually contribute to discharge, and it is not enough to justify joinder in the same application that they all relate to the same machine or apparatus and in various disconnected ways tend to improve

it. *Ex parte Stearnes*, 57 O. G. 1768, C. D. 1890.

13. Two sets of claims involving separate and distinct inventions may be joined in the same application if the inventions are dependent upon each other and mutually contribute to produce a single result. *Ex parte Wahlquist*, 42 MS. D. (2 G. W. D.), Jan., 1890 (Mitchell, Com'r).

14. The general rule is that when a new combination has been invented the several elements, if new, may be patented in the same application. *Ex parte Blume*, 45 MS. D. (3 G. W. D.), Jan., 1891 (Mitchell, Com'r).

15. Where, in an application for a patent describing a series of mechanisms in one machine performing certain functions in succession, the applicant made certain claims for combinations which were not limited in their scope to either one of the mechanisms of the series, and also other claims for elements and sub-combinations which were limited to one of the mechanisms of the series, but were also contained in the broader combinations not so limited, *held*, that division could not be required until it had been determined whether the broader combinations were true combinations within the meaning of the law. *Ex parte Speckbauch*, 54 O. G. 1265, C. D. 1891.

16. Where the machine improved upon is as a whole an old and well-known machine performing in succession a series of separate and distinct functions, and some of the improvements are limited in their scope to the mechanism performing one function, the remaining improvements being limited to other mechanism performing different functions, division should be required and the claims should be grouped with reference to the mechanism to which they pertain. *Id.*

17. Although it appears that certain claims in an application are for a mechanism capable of use in other relations than that which forms the specific subject-matter of the application, division will not be required if these claims have elements in common with the more specific claims of the application. *Ex parte Kerr*, 58 O. G. 1553, C. D. 1892.

18. Where applicant's machine was in its entirety a mangle or ironing machine, *held*, that the examiner properly required division as to certain claims in the application which related purely to a belt-shifting device. *Ex parte Wendell*, 59 O. G. 630, C. D. 1892.

19. Within the limits of validity of the grant, claims for distinct but dependent inventions

may be joined in the same application or be made in separate applications, at the option of the applicant. This general rule leaves to the discretion of the office the requirement of division in those exceptional cases in which the inconvenience resulting from a single application amounts to the necessity to divide, and leaves room, also, for the exercise of that inherent discretion necessarily left on this subject to the office. (*Bennet v. Fowler*, 8 Wall. 445.) *Ex parte Demeny*, 64 O. G. 1649, C. D. 1893.

20. Division required of an application having claims for (1) frame of a bicycle, (2) the bearings, (3) the brace, (4) the toe-clips. (*Ex parte Burgess*, 80 O. G. 1758, construed.) *Ex parte Rose*, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

21. Division is not required when certain claims relate to a machine, and other claims relate to mechanical elements which are also elements of the claims to said machine. It is not a question of difference of species, but of scope of claims. The invention is unitary. (Case distinguished from *Ex parte Burgess*, 80 O. G. 1759.) *Ex parte Harris*, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

22. In an application for the manufacture of incandescent lamps, division was required between the part relating to the lamp and that relating to the exhausting apparatus, since there is not such an interdependence between the two as would warrant their being joined in one application. *Ex parte Olan*, 79 O. G. 861, C. D. 1897.

23. It does not follow because the courts would not hold a patent invalid that it is the duty of the patent office to allow more than one invention to be claimed in the same application. Whether a given invention or improvement shall be embraced in one, two or more patents is a matter about which some discretion must be left with the head of the patent office. *Ex parte Burgess*, 80 O. G. 1759, C. D. 1897.

24. Claims for distinct and independent improvements on a gun, one set of the claims being for a gun-barrel or false muzzle, which falls within a different classification from the other claims, cannot remain in the same application. *Id.*

25. "Although the classes in one division may relate to somewhat analogous arts, it does not follow that two inventions which belong in that division are so closely related as to be properly claimed in one application, since the

inventions may be as separate, distinct and independent of each other as if they belonged in different divisions." *Ex parte Southgate*, 62 MS. D., Aug., 1897 (Greeley, Ass't Com'r).

26. An applicant is entitled to claims embodying essentially different statements of the same invention, if the art permits. Division is not properly required when the parts of a unitary invention are claimed separately or in different combinations. *Ex parte Shipley*, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

II. APPARATUS AND PROCESS.

27. It must be regarded as settled by the very highest authority that an apparatus and a process are separate and distinct inventions. There is no requirement of law that they must or ought to be comprehended in a single patent, while there are many reasons why they should not be. A claim for a machine or apparatus and a claim for a process should be prosecuted in separate applications, and each, when allowed, comprehended in separate patents. *Ex parte Herr*, 41 O. G. 463, C. D. 1887.

28. The relation between process and apparatus is not that of genus and species, but of independent inventions. If the inventor of an apparatus is subject or tributary to a patent for a process, it is due to the patent law, which forbids all persons to use the invention of another for which a valid patent has been issued. *Ex parte Atwood*, 44 O. G. 341, C. D. 1888.

29. When a process and product, or a process and machine, are so intimately connected that neither can exist without the other, the process is only the function of the machine, or the structure of the product or method of its construction, and when this relation does not exist the process and product and the process and machine are independent and distinct inventions, to be solicited in different applications. A process which is merely the function of a machine does not constitute patentable matter. Such a process may be an industrial fact or entity inherent in a machine, or such a process may be inherent in its product; but then it possesses no patentable novelty as a separate invention. (*Ex parte Blythe*, 30 O. G. 1324.) *Ex parte Simonds*, 44 O. G. 445, C. D. 1888.

30. Where there is no express provision of the statute limiting or controlling the discretion of the commissioner in embracing more than one invention in the same letters patent, and the courts would not for that reason de-

clare such a patent void, the statute does prohibit the introduction into re-issue patents of new matter or other invention than that covered by the original patent. The supreme court has held that under this prohibition no new matter could be introduced; that process and apparatus are separate and distinct inventions, and that when a patent for one has issued, although the other was distinctly shown, a re-issue for both could not be maintained. (*Burr v. Duryee*, 1 Wall. 531; *James v. Campbell*, 104 U. S. 358; *Powder Co. v. Powder Works*, 98 U. S. 126; *Heald v. Rice*, 104 U. S. 737.) *Ex parte Tainter*, 47 O. G. 135, C. D. 1889.

31. When the apparatus cannot operate for any other purpose than to carry out the process, and the process can be carried out only by a machine operated substantially upon the principle of that shown by the applicant, division should not be required. *Ex parte McMahan*, 48 O. G. 255, C. D. 1889.

32. In such case there is no reason for requiring a division upon the ground that the examination of the office would be facilitated, because the field of search is precisely the same whether the application is divided or not. *Id.*

33. But one substantive apparatus for carrying out a process—other, of course, than mere sub-apparatuses—can be joined in the application with the process claims. *Ex parte Bayne*, 42 MS. D. (2 G. W. D.), Feb., 1890 (Mitchell, Com'r).

34. Although a process and an apparatus for carrying out the process are separate inventions, they are not necessarily independent inventions within the meaning of rule 41, and when they are dependent upon each other and mutually contribute to produce a single result they may be joined in one application. *Ex parte Lord*, 50 O. G. 987, C. D. 1890.

35. Perhaps a good working rule would be that process and apparatus are presumptively connected in design and operation where the examination of both belongs to the same division of the office. *Id.*

36. The requirement of the examiner for division on the ground that the process and apparatus cannot be "mutually dependent" upon each other unless each is "absolutely indispensable" to the exercise of the other, overruled, and held that such a construction of rule 41 is unwarranted. *Ex parte Norwood*, 50 O. G. 1129, C. D. 1890.

37. It is sufficient to justify joinder of process and apparatus if, as matter of fact, the single result had in view by the inventor as the

proximate purpose of his invention is contributed to by both process and apparatus. In such case there is mutual contribution and interdependence within the meaning of the rule. *Id.*

38. Where it appeared that the method could not be carried out in any other way than by an apparatus substantially like that claimed, *held*, that division should not be required. *Ex parte Hyde*, 50 O. G. 1293, C. D. 1890.

39. Interdependence means no more than that, in the language of rule 41, process and apparatus are dependent upon each other and mutually contribute to produce a single result, or that they are in their nature or operation connected together. If they sustain this relation it is immaterial whether or not the process may possibly be carried out by some other means. *Id.*

40. It has been held by the courts and by the patent office that a clear line of division exists between apparatus and process. The fact that the office has at some periods regarded division as imperative, while at other periods it has been looked upon as optional, does not alter the fact that the capacity for division has always been recognized. *Ex parte Chambers*, 51 O. G. 1943, C. D. 1890.

41. When an application containing claims for a process and a described apparatus for practicing the process has been divided in compliance with the requirement of the office, and patent thereafter issues for the apparatus, the examiner is not warranted in subsequently rejecting the application for the process on the ground that the patent for the apparatus disclosed and covered the process. Such action is in effect a reversal of his decision requiring division, and if his present action be correct division should not have been required. *Id.*

42. Where the application as filed discloses an apparatus and also a patentable process, and the relation between them is such that they could be joined in one application, and the apparatus only is embraced in "the statement of invention or claims as originally presented," there is no reason why claims for the process may not be incorporated, if seasonably presented and supported by supplemental oath. *Ex parte Lillie*, 53 O. G. 181, C. D. 1890.

43. There is no rule which excludes a case where apparatus and process are appropriately described and but one of them claimed from being brought within the scope and remedial agency of a supplemental oath. *Id.*

44. The amendment and supplemental oath

should be seasonably presented. The applicant has as good a right to confine his application to either apparatus or process as he has to embrace both in his claims, and where division is optional it is accompanied by the responsibility of electing whether to divide or not and also by the obligation to stand by the election, when decisively made. *Id.*

45. Where the earlier of two applications described an apparatus and a process and claimed the former, and without claiming the process stated that it formed the subject of another application which was identified by serial number and date, and the other and later application declared itself to be a division of the application first filed, which was identified also by serial number and date, *held*, that the later application was technically a division of the earlier. *Forbes v. Thomson*, 53 O. G. 2042, C. D. 1890.

46. The practice of the office recognizes the right of an inventor to secure protection in one patent for an apparatus and a process under certain conditions, but applicant has the right, if he so elects, to file separate applications for such inventions. *Ex parte Hopkinson*, 54 O. G. 264, C. D. 1891.

47. Division of an application as between claims for apparatus and claims for process is unnecessary where no wider range of search is required for the two than for the one. *Ex parte Curtis*, 57 O. G. 1128, C. D. 1891.

48. As a general rule claims for a process and claims covering means for carrying out such process may be joined in one application; but when the process belongs to one division of the office and the apparatus to another, joinder should not be permitted. *Ex parte Everson*, 63 O. G. 1381, C. D. 1893.

49. Claims to a method, if no such method is warranted by the original disclosure, rest upon an uncertain basis; but such claims, if so bound up with the apparatus of another application of the same inventor as not to warrant different ownership of the two, may accompany the real invention, which is the apparatus, proper oath being filed. *Dewey v. Colby*, 75 O. G. 1360, C. D. 1896.

III. CLASSIFICATION IN PATENT OFFICE.

50. The decision in *Ex parte Blythe* (C. D. 1885, 82) re-affirmed in so far as it is held that congress has recognized the natural classification of arts as existing in four great divisions, and that a single and distinct invention clearly

belonging in one ought not to be joined in the same invention with an invention belonging in another division. This conclusion arises from the fact that congress has required a careful examination to be made of each application, has recognized classification as a necessary part of the system, has invested the commissioner with large discretion in the matter, and that without such arrangement and classification it is impossible to carry out the express requirement as to examination; but it is not based upon any statutory declaration or any ascertained intention of congress except as results from the system itself. *Ex parte Herr*, 41 O. G. 463, C. D. 1887.

51. There has been a general practice in the office to permit an applicant to claim in the same application and secure in one letters patent his combination and any *new* element which constitutes part of the combination, even though they are separate inventions. This has been allowed under a general proposition that the applicant may claim his invention as an entirety and also everything that goes to make up his invention — much as a grant for land in fee covers all the improvements, hereditaments and appurtenances to the soil itself. But this general proposition has been and must be modified by the important necessity and usefulness of classification in the arts. The examination required by statute renders it necessary that some regulation and classification shall be adopted by which such examination shall be complete and satisfactory in order to prevent the duplication of patents for the same thing. It follows that there should not be a commingling of different subjects in different classes of art in the same patent; for if this be allowed not only will examination by those expert in a specific art be rendered practically impossible, but the patent when issued can find no appropriate place in classification for reference when future applications are to be examined. *Ex parte Willcox and Borton*, 45 O. G. 455, C. D. 1888.

52. The classification in the patent office is not founded upon names and titles but upon the actual subjects of art. It determines what is or is not a machine, a tool or implement; whether it is generically new and original or is composite, made of two recognized old machines, tools or implements, or whether it presents mere additions to or improvements upon what already exists and is known. *Id.*

53. When one particular element of a machine is dependent upon and acts with the

other elements thereof to produce a single result, it may be claimed in the same application with them without regard to the office classification. *Ex parte Coe*, 48 O. G. 1119, C. D. 1889.

54. An apparatus attached to a photographer's lamp for feeding a magnesium spray to the flame may be claimed in the same application with other parts of the lamp. *Ex parte Iljinsky*, 48 O. G. 1399, C. D. 1889.

55. Where all the elements which go to make up a complete device are so connected in design and operation as to form parts of one complete whole, they may stand in the same application regardless of the office classification. *Ex parte Harris*, 42 MS. D. (2 G. W. D.), Jan., 1890 (*Fisher, Ass't Com'r*).

56. Classification is not the controlling circumstance in determining the question of division. The things to be considered are: are the devices interdependent; are they connected in design and operation; are they capable of use in other relations than that in which they are shown; have they acquired a recognized standing in the art as subjects of separate manufacture and sale? And where all these questions could not be answered affirmatively as to the devices in question, *held*, that they were properly included in one application. *Ex parte Bennett*, 43 MS. D. (2 G. W. D.), July, 1890 (*Fisher, Ass't Com'r*).

57. Independent inventions pertaining to the same structure cannot be joined in one application, especially when the office classification is such as to require their examination in different divisions. *Ex parte Steinhilber*, 57 O. G. 1720, C. D. 1891.

58. Where the inventions are classified in different divisions, such mere difference of the location of the inventions in the office classification is not the sole test in determining the question of division. *Ex parte Demeny*, 64 O. G. 1049, C. D. 1893.

59. The confusion and litigation likely to follow the grant of two patents which might come into the hands of two separate owners, neither having the full enjoyment of the right to work his own, if both be valid, and the doubt cast upon the validity of both, are more important considerations than the suggestion that the inventions are classified in different divisions. *Id.*

60. Where the requirement for division between dependent inventions was made because the sub-classes in the office classification have acquired a distinct place in the arts to which the several parts of this application would go,

held, that this in itself presents no ground for a requirement to divide. *Ex parte Carr*, 68 O. G. 653, C. D. 1894.

61. The time arrived long since when a proper classification in the patent office, so as to facilitate examination and prevent mistakes in the granting of patents, requires that improvements on an old machine having a distinct status in the arts and classified separately in this office should be presented in separate applications. *Ex parte Burgess*, 80 O. G. 1759, C. D. 1897.

IV. PRACTICE.

62. An exhaustive search cannot be made in advance of compliance with the requirement of division, but the best references which the examiner can furnish as the result of a cursory examination should be furnished upon request. *Ex parte Stearns*, 46 MS. D. (3 G. W. D.), March, 1891 (Mitchell, Com'r).

63. Under rule 64 questions of form are always subordinate to those of merit. The question of division, being one of form, should, if the applicant declines to accede to the examiner's requirement, be postponed until after a final determination of the merits. Exception to this practice applies to cases in which the examiner is of the opinion that the patent, if granted, would be held invalid by the courts as covering two or more independent inventions. In such cases the examiner should reject for that reason. *Ex parte Ofeldt*, 54 MS. D., Feb., 1894 (Fisher, Ass't Com'r).

64. "Since the present inventions would be classified in one division of the office, the state of the art on both of them should be cited before the requirement for division is insisted upon." *Ex parte Southgate*, 62 MS. D., Aug., 1897 (Greeley, Ass't Com'r).

V. PROCESS AND PRODUCT.

65. The examiner required division, and advised applicant that the product could be produced by other processes, but refused to state to applicant what those processes were. *Held*, that the examiner should furnish applicant with all the information upon which he bases his opinion that the product is not new, in order that applicant may act intelligently as to the requirement of division; that the examiner ought not, when he has information which would bar the issue of patent, require an applicant to go to the trouble and expense of filing an application which must necessarily fail of

success. *Ex parte Pastor Perez de la Sala*, 42 O. G. 95, C. D. 1888.

66. The opposite conclusion has been reached in regard to process and product when both were new and the process could produce no other product and the product could be made by no other process. This conclusion is based upon the premise that such process and product constitute one single invention. It must be deemed settled by the highest authority that such processes and products are not separate and distinct but unitary inventions, and that the process and product may be regarded and claimed as parts of such invention, much as different elements in a combination may be separately claimed. This conclusion finds satisfactory support in the nature of the invention itself, as well as in the character of legal property residing in it. *Ex parte Tainter*, 47 O. G. 135, C. D. 1889.

67. This conclusion excludes all other cases of process and product, such as when either process or product is not new, or when the product can be made by some other process or the process will produce some other product. *Id.*

68. The novelty of the tablet in the present case doubted, but not determined; but the novelty and patentability of the process denied. The question of division in such case, being a preliminary one, must be settled first, and consequently the action of the examiner in requiring division is affirmed for this reason, and not upon the general proposition. *Id.*

69. Where the article of manufacture claimed could be made by other methods than that claimed, and the method, if practiced, would not necessarily eventuate in that particular article of manufacture, *held*, that division was properly required. *Ex parte Greenfield*, 58 O. G. 274, C. D. 1892.

70. It is the proximate result of the process and not its ultimate result which is to be considered in disposing of questions of division. *Id.*

71. Where it appeared that if claims for a method and claims for an article of manufacture were presented in separate applications, such applications would be assigned and examined in different divisions of the office, *held*, that *Ex parte Fefel* (57 O. G. 409) and *Ex parte Curtis* (57 O. G. 1128) presented no grounds for overruling the requirement of division. *Id.*

72. On appeal from examiner's decision requiring division between claims for a printing block or plate and the process of making it, *held*, that no wider range of search being re-

quired under the present practice of the office for both groups of claims than for one of them, division should not be required. *Ex parte Hines*, 60 O. G. 576, C. D. 1892.

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

74. Where it appears that the process can produce no other product and the product can be produced by no other process, the process and product are parts of one invention, and division should not be required. *Ex parte Demeny*, 64 O. G. 1649, C. D. 1893.

75. Where, if the application were a patent containing claims for a process and product, it would not be invalid because of independent inventions, division ordinarily ought not to be required, and not unless some exceptional burden would be placed upon the office in conducting the examination. *Id.*

76. Where the examiner stated the issue to be whether articles made by numerous processes other than the applicant's process can be claimed in the same application, *held*, that if the issue is correctly stated it is in effect equivalent to a decision that the product is old, and, this being the case, the claims for the product could never pass to issue at all, either in this or in a separate application. *Ex parte Kny*, 65 O. G. 1403, C. D. 1893.

77. It is in the direction of good practice to forbear to order division between process and product claims unless in the exceptional cases alluded to in *Ex parte Demeny*, 64 O. G. 1649. *Id.*

78. The words "mutually contribute to produce a single result" are not confined to the result of the process, but to the ultimate result with a view to which the whole invention was made. *Id.*

79. Where a process and its product are claimed in one application the office will not concern itself with the inquiry whether the article might be made by any other process or whether the process will necessarily result in the particular product, for the purpose of determining whether division should be ordered between process and product. *Ex parte Thomson*, 66 O. G. 653, C. D. 1894.

80. The above inquiry would be no guide in the case where the process was new, as to which the office could not say with certainty whether it must always result in the product. *Id.*

81. Similarly, in the case of a new article such rule would require the office to solve the insoluble question whether the article might not be made by some other method not yet invented or discovered, or else when a known process had produced the article the order to divide would be followed by the rejection of the claim for the article as old. *Id.*

82. It has been the practice to require division upon an inspection of the prior art which is only cursory. Should the applicant follow the intimation of the office thus made and cancel one aspect of his claimed invention, and further, acting upon the intimation, should forbear to file a new application for the elements canceled, he might lose, upon the suggestion of the office, protection for a valuable invention. If, on the other hand, he should file a new and divisional application, and the cursory examination should turn out to be a correct disclosure of the prior art, and the process or its product, as the case might be, turn out to be old, that being the ground upon which division was ordered, the applicant would have been required to file a fruitless application. *Id.*

83. Process and its product concern inventions which are so related that they may, at the option of the applicant, be placed in the same application, he taking all the risks of future difficulties in the courts, and it is generally thought to be the better practice to include them both in one application, since division between process and product may produce confusion in the arts and conflicting interests, as intimated by the court in *McKay v. Dibert* (19 O. G. 1351, 5 Fed. Rep. 587), since no patent has been declared void by reason of the joinder of such claims, while many have been held to be valid, since manifest advantages would follow from one uniform rule as to division, and, more important than all else, since division or joinder approaches, if it does not present, a question of right in the applicant to choose between two courses, both of which are open to him, it is broadly announced that division in such cases will not be required. *Id.*

84. Requirement for division between claims for process and product overruled. *Ex parte Kny*, 58 MS. D., Jan., 1896 (Seymour, Com'r).

85. When, upon a requirement of division, claims for a process were canceled and an application was limited to the claims for an article, and a second application for the process was filed while the first application was pending, but not within two years from the can-

cellation of the process claims from the first application, *held*, that the process claims were not abandoned and that the second application was a division of the first. *Edison v. Ball*, 71 O. G. 1313, C. D. 1896.

86. Where a patent first describes a new and patentable process producing an article chemically or technically identical with an article formerly known, but superior thereto, and the invention is a meritorious one, a valid claim may be made for the product as well as for the process. **Matheson v. Campbell*, 79 O. G. 684, C. D. 1897.

VI. STATUS OF INVENTION IN THE ARTS.

87. Among the rules and principles announced in *Ex parte Herr* for determining when division should be required was one applicable to combinations, and the proposition is there stated that in the case of a combination applicant may claim such combination and also any element therein which in itself is new and possesses individual utility separate from the combination; provided, that element has not already obtained a distinct location in the arts as an independent subject of invention and possesses utility in various other relations than that in which it is used in the particular combination claimed. *Ex parte Sartell*, 42 O. G. 295, C. D. 1888.

88. The classification referred to in *Ex parte Herr* was not a mere classification to be found in the different examining divisions of the office, and it was not intended that division of an application should be required because one examining division had one subject and another division another subject, both of which might be sometimes found in a combination; but the principle therein announced was based upon the determination of the fact as to whether the particular device sought to be made a part of a combination had become a separate and distinct subject of invention and classification, made so by the inventors and manufacturers themselves. *Id.*

89. In the case under consideration the inventors and manufacturing interests of the public have made the coupler a distinct subject of invention and manufacture, and applicant, therefore, ought not to be allowed to claim this particular invention in the present application, because as an individual coupler it is a distinct and separate invention from the combination, which it is claimed has for its object the heating of cars. *Id.*

90. An element forming part of a combination which has become the subject of general invention and manufacture, and which can be used in other relations, cannot be joined in the same application with claims covering the general combination. *Ex parte La Borde*, 44 O. G. 700, C. D. 1888.

91. Sub-mechanisms and parts of a machine which have not acquired a distinct place in the arts and the industries and are not capable of use in other relations, but are manufactured and sold to take the place of corresponding parts in the general organism which have been broken or worn out, are not required to be separately applied for and patented. *Ex parte Willcox and Borton*, 45 O. G. 435, C. D. 1888.

92. Where a combination of elements is held to be legitimate, the elements and sub-combinations may be claimed in the same application, unless they have acquired a definite status in the arts, industries and trades — that is to say, pertain to and are improvements upon parts or devices which have acquired such status. *Ex parte Specbauch*, 54 O. G. 1265, C. D. 1891.

93. In order to necessitate the dividing out of elements, when the combination as a whole is held to be patentable, it must appear, *first*, that the elements or parts of the invention which are to be divided out have obtained a definite place in art and manufacture, and *second*, that they can be used in other relations. *Id.*

94. A device which has obtained a distinct status in the industries and trade should be the subject-matter of a separate application. *Ex parte Sawn*, 54 O. G. 1561, C. D. 1891.

95. Where there are claims which severally cover substantially the whole mechanism comprised by the invention, or a combination of several partially-independent but co-operating parts of the same, and other claims, each covering a part or sub-mechanism, division will not be required unless the particular part or sub-mechanism in question is capable of use in other relations and has acquired a distinct status in the arts, manufactures and trades. *Ex parte Hine*, 58 O. G. 385, C. D. 1892.

96. Where a certain claim was considered as a *combination* claim and not a claim for *some of the elements* of the combination, *held*, that the subject-matter of the claim had not acquired a definite status in art and manufacture. *Ex parte Connelly*, 59 O. G. 787, C. D. 1892.

97. Where certain devices were claimed separately and also in combination, *held*, that division should not be required unless one or each of such devices could be used in other

relations and belonged to a class that had acquired a distinct status in manufacture and trade. *Ex parte Learned*, 63 O. G. 1962, C. D. 1893.

98. Where the respective structures have reached definite places in the arts and in the office classification, they cannot be claimed in the same application. *Ex parte Korff*, 64 O. G. 1397, C. D. 1893.

99. Where there are claims for specific structures and combinations of the structures, and the structures have acquired distinct status in the arts, division should be required between the claims for one of the structures and combinations of the structures on the one hand and the claims for the other structure on the other hand. *Id.*

DIVISIONAL APPLICATIONS.

(See SUBSEQUENT APPLICATIONS; DIVISION OF APPLICATIONS; RESERVATION IN APPLICATIONS; INTERFERING PATENTS.)

I. DIVISIONAL APPLICATIONS, IN GENERAL. II. ISSUE OF.

I. DIVISIONAL APPLICATIONS, IN GENERAL.

1. By filing a second divisional application before a patent issued on the first, the applicant avoided and prevented the legal inference of dedication to the public. *Ex parte Roberts*, 40 O. G. 573, C. D. 1887.

2. Applicant has two or more separate and distinct applications pending, which show and describe, substantially, the same invention, in each of which respectively he has broad and limited claims, which are not, in the opinion of the examiner, drawn upon legitimate lines of division. An applicant should not be allowed to prosecute at the same time several applications for the same indivisible subject-matter. *Ex parte Smith*, 44 O. G. 1183, C. D. 1888.

3. Such practice would enable an applicant to defer the exercise of option as to which invention or sub-combination he will elect to be the subject of his patent in any one of the applications, and would result in enabling him to prolong the period of his monopoly. *Id.*

4. Applicants must make clear distinctions between the inventions in their respective applications; otherwise the task is thrust upon the office, which properly belongs to themselves, of defining and maintaining the lines

between divisional applications, the perplexities and difficulties of examinations are increased, and repeated and careful comparisons of all cases made necessary at every stage of the proceedings. *Id.*

5. If the invention be of such a character that it is incapable of division upon proper lines, then the office should refuse to recognize or proceed with the consideration of the divisional application. Independent applications of this or any other kind must receive examination of a preliminary character, under rule 64, until some question arises beyond which the examination cannot proceed; but unquestionably the examiner ought not to be required to proceed with the consideration of such cases, examine them, and allow or reject them as if they were wholly independent, separate applications. *Id.*

6. When an application is filed describing and illustrating more than one invention, and during its 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 so described and illustrated, the later 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. *Forbes v. Thomson*, 51 O. G. 297, C. D. 1890.

7. Where applicant filed an application containing a claim for a process declaring it to be a division of a former application, and it appeared that said process was not embraced or indicated in the claims or statement of invention as originally sworn to, and that no oath had been filed which included said process as any part of the thing for which a patent had been solicited, *held*, that the examiner was correct in ruling that the process claim as tendered could not be entered in the alleged divisional application. *Ex parte Lillie*, 53 O. G. 2041, C. D. 1890.

8. The application under discussion *held* not a division of the earlier application, because its subject-matter is not reached by any claim or statement of invention contained in said earlier application. *Ex parte Freeman*, 58 O. G. 522, C. D. 1892.

9. The subject-matter of a divisional application must always be a part of the subject-matter of the original application without any additions to that original subject-matter. *Ex parte Fuller*, 58 O. G. 804, C. D. 1892.

10. An application containing claims for new

matter in addition to claims for the matter shown and described in an earlier application of which it does not on its face purport to be a division is not a proper division of such earlier application. *Searle v. Frumveller, v. Sessions*, 58 O. G. 804, C. D. 1892.

11. Where an alleged divisional application describes and claims something different from what was disclosed in the original application, it is not properly a division of such original application. *Ex parte Hunter*, 60 O. G. 295, C. D. 1892.

12. The only questions for the examiner are whether or not the new application is a legitimate division of the earlier application, and whether or not the original application is in proper condition for the substitution of the divisional application. *Ex parte Perkins*, 61 O. G. 1015, C. D. 1892.

13. The action of the patent office allowing a separation of the claims is not conclusive upon the court but may be reviewed. In the patent office applications for patents are not severable except upon structural, *i. e.* physical, lines, which actually divide the machine into separable parts. **Fassett v. Ewart Mfg. Co.*, 58 Fed. Rep. 360 (1893).

14. A divisional application should only contain matter carved out of the parent case; but if the matter has been fully disclosed in the earlier application, although not reached by any claim or statement of invention, such disclosure should be sufficient to secure to the applicant the benefit of the date of the parent case. *Ex parte Henry*, 64 O. G. 299, C. D. 1893.

15. The matter claimed additional to what was claimed in the parent case should always be supported by a proper supplemental oath, or if claimed in the divisional application as first filed the oath prescribed by rule 46 should be correspondingly changed. *Id.*

16. In a divisional application the addition of mere details, such as braces for a frame, does not affect the status of such application as properly divisional, especially when such details were shown in other figures of the original not included in the divisional application. *Phelps v. Hardy, v. Gattman & Stern*, 77 O. G. 631, C. D. 1896.

II. ISSUE OF.

17. When two applications by the same inventor are pending at the same time and it is stated in one that it is a division of the other, even if the divisional case should issue before the principal one and the inventor were re-

sponsible for the delay, the fact of such prior issue would in no way mislead the public. They never for a moment acquired the right to use the broad invention. **Brush Electric Co. v. Electrical Accumulator Co.*, 56 O. G. 1334, C. D. 1891.

18. Where an applicant has several alleged divisional applications pending at the same time and the examiner holds that there is no proper line of division between the respective applications, but one of the applications is ready for issue, while the others stand rejected on references, *held*, that the proper practice would be to pass to issue the application ready for issue, and if the other applications be further prosecuted, and the examiner still be of the opinion that there is want of divisibility between the claims of the respective applications, he reject them for that reason. *Ex parte Cahill*, 63 O. G. 1815, C. D. 1893.

19. When only one of several divisional applications is in condition for allowance, it is contrary to the recent decisions and practice of the office and inconsistent with rule 106 to withhold such application from issue until all the other divisional applications are ready for allowance. *Ex parte Drawbaugh*, 64 O. G. 155, C. D. 1893.

20. The doctrine announced in *Ex parte Holt*, 29 O. G. 171, that all the divisions of an application should be passed to issue simultaneously, overruled. *Id.*

21. There is no proper line of division between one application covering a specific rail and implying certain adjuncts and another application by the same inventor for the combination of the rail and the adjuncts, and one application should not go to patent while the other is in interference. **Porter v. Loudon*, 73 O. G. 1551, C. D. 1895.

DRAWINGS.

(See AMENDMENT; PATENTS — CONSTRUCTION OF, BY DRAWINGS.)

1. In describing a process, but few of many reference letters on the drawings, which show a complicated machine, were used. *Held*, that the lettering of the drawings should correspond to the references contained in the descriptive portion of the specification. *Ex parte Borgfeldt*, 49 O. G. 132, C. D. 1889.

2. An applicant may illustrate in his drawing the generic apparatus claim by more than one figure, provided his specific claims are all

confined to one preferred form of his invention. *Ex parte Payne*, 44 MS. D., July, 1890 (Mitchell, Com'r).

3. Present rule 51 prohibits the use of the same reference letter to designate parts which, although claimed to be equivalents, are nevertheless different in structure. If alternative constructions or modifications are shown, a permissible method is to employ the same letter with an appended figure or exponent, as A A' A² A³, thereby conforming to the rule and at the same time suggesting the presence of similarity and the absence of sameness. *Ex parte Cook*, 51 O. G. 1620, C. D. 1890.

4. A drawing filed as a part of an application cannot be transferred to a new application filed in place thereof. *Ex parte Ayres*, 51 O. G. 1944, C. D. 1890.

5. The number of sheets of an application drawing should not be more than is absolutely necessary. *Ex parte Krause*, 56 O. G. 1708, C. D. 1891.

6. The statute requires that drawings should be signed. Stamped signatures are not sufficient. *Id.*

7. The office rule requiring line-drawings in design cases *held* to apply to cases pending at the time of its adoption; but where, in such a case, the acceptance of a photograph had already been specially approved by the commissioner, ordered that the line-drawing be furnished by the office. *Ex parte Poole*, 61 O. G. 1655, C. D. 1892.

8. The discretion implied in section 4530, Revised Statutes, as to the requirements of drawing or photograph in design cases is vested in the office and not in the applicant. *Id.*

9. The discretion under rule 83 as to permitting the use of photographs in place of line-drawings vests in the office and not in the applicant. *Ex parte Petzold*, 61 O. G. 1780, C. D. 1892.

(The drawings should show the parts or elements of a machine combined as claimed, and separate views of each particular feature will not suffice. *Ex parte Kemp*, 15 O. G. 775, C. D. 1879.)

EMPLOYER AND EMPLOYEE.

I. EMPLOYER AND EMPLOYEE, IN GENERAL. II. GOVERNMENT EMPLOYEE.

I. EMPLOYER AND EMPLOYEE, IN GENERAL.

1. The relation of employer and employee cannot be established where it appears that one

party received no pay whatever for his services, and that it was not pretended there was any promise of payment on the part of the other or expectation of payment on the part of the former, although it appears that there were frequent interchanges of courtesies between the parties and "in this interchange of courtesies that honors were easy." *Wherry v. Heck*, 49 O. G. 559, C. D. 1889.

2. Although a mechanic may be employed to devise and perfect a machine, and although the employer may clearly communicate the result to be attained by the machine proposed, yet if the idea of means, including the general plan and the specific details, is conceived and reduced to practice by the employee, the latter, and not the former, is the inventor, and to him the patent should be granted. *Greenlee and Ström v. Roberts*, 55 O. G. 1399, C. D. 1891.

3. To employ a mechanic to make one machine do what three machines have done is not to disclose the general plan of the machine. A man may be profoundly impressed with the idea that a competent person can make one machine do the work of three old machines, and yet have no definite idea whatever of the organization by which the triple function is to be performed. *Id.*

4. Although the relation of the employer to the employee may entitle the former to an equitable interest in the invention and patent therefor, it does not entitle him on that account to take the place of the inventor as the lawful grantee. *Id.*

5. Where the conclusion reached in the former opinion that the employer did not explain the invention in such a way that the machine could be built from the instructions given was professedly founded upon the testimony as to what took place prior to the building of the machine, and it appeared that all the testimony as to what transpired after as well as before the machine was built was considered so far as it had any bearing upon what instructions were given to the employee, *held* no error. *Id.*

6. Where a skilled workman is employed to embody an inventor's idea in practical form, the results are the property of the inventor unless they show that the workman has discarded the original idea and proceeded upon a wholly distinct and separate plan. *Hisey v. Peters*, 58 O. G. 1691, C. D. 1892.

7. Where an employer discloses the general idea and plan of his invention to an employee, no suggestion from the latter which does not

involve a radical departure therefrom will give him any rights as an inventor. (Citing *Agawam Co. v. Jordan*, 7 Wall. 583.) *Hayes v. Hopkins*, 59 O. G. 157, C. D. 1892.

8. Where one has conceived of an invention and discloses the essence of it to another whom he employs to develop and perfect it, suggestions from the employee in the course of experiments and dependent upon the main idea will not ordinarily give the employee any rights as an inventor. (Citing *O'Reilly v. Morse*, 15 How. 62, and *Agawam Co. v. Jordan*, 7 Wall. 583.) *Webster v. Parkhurst and Ham*, 60 O. G. 1325, C. D. 1892.

9. A manufacturing corporation which has employed a skilled workman for a stated compensation to take charge of its works and to devote his time and services to devising and making improvements in articles there manufactured is not entitled to a conveyance of patents obtained for inventions made by him while so employed in the absence of express agreement to that effect. **Dalzell v. Dueber Watch Case Mfg. Co.*, 63 O. G. 1381, C. D. 1893.

10. Where the testimony of the superior employee that he made the invention is corroborated by the mechanical engineer of the establishment; where the subordinate employee makes the pattern for the invention of his superior, but announces no claim at the time that he was the originator of it, and where the invention was openly manufactured there without a circumstance or fact occurring at the time showing the subordinate to be the inventor, and, still more, where the acts of both of them are more conformable to the probability that the former made the invention, and there is no indisputable fact that is not conformable to this theory, *held*, that the testimony leads to the conclusion that the superior employee was the originator of the invention. *Leeman v. Smith*, 66 O. G. 1307, C. D. 1894.

11. *Held*, that an employer may assume that he may allot the brain-work of his employees as he pleases and take out in the name of one a patent for an invention which he knows to have been made by another, because it may in some way suit his convenience, is an assumption that may be repudiated by the common sense of mankind. **Soley v. Hebbard*, 70 O. G. 921, C. D. 1895.

12. A contract between an employer and employee, wherein the employee obtains service with the employer on condition that any improvement he may make on the machines of the employer shall be for the exclusive use of

his employer, *held* valid. **Hulse and Wright v. Bonsack Machine Co.*, 70 O. G. 1498, C. D. 1895.

13. Where an employee made a device under the direction of his employer, who applied for a patent, and received an allowance, with the knowledge of the employee, who made no suggestion that the device embodied his invention, *held*, that the employer was the original inventor. *Northall v. Painter, v. Bernardin*, 71 O. G. 1323, C. D. 1895.

II. GOVERNMENT EMPLOYEE.

14. The chief of the government bureau of printing and engraving, being requested by his superior officer to devise an internal revenue stamp, conceived the idea of a self-canceling stamp, and under his direction the employees of the bureau, using government property and machinery, prepared a die for printing. Recommending the adoption of this stamp, he stated to the commissioner of internal revenue that he would make no charge for its use because he was in the government employ and used government machinery in producing it. He however applied for a patent, which was issued December 21, 1869, to his assignee, who brought suit for the use of said stamp. *Held*, that the government had a right to use the stamp without making any compensation therefor. (Affirming 21 Ct. Cl. 479, and 22 Ct. Cl. 335.) **Solomons v. United States*, 54 O. G. 265, C. D. 1891.

15. Where one in the employment of the government experiments and finally perfects an invention, he is entitled to a patent therefor in the absence of an explicit assent and agreement on his part that his invention shall be the property of the government. (Discussing and distinguishing *Solomons v. United States*, 137 U. S. 342, 54 O. G. 265, C. D. 1891.) *Riley v. Barnard*, 59 O. G. 1919, C. D. 1892.

16. "Wherever inventions are the outcome of the assignment of the officers making them to the special duty of experimenting with a view to suggesting improvements upon existing methods, special facilities having been afforded them by the department to that end, it has been held that the product of their experiments is the property of the United States. If, however, an invention is the result of the personal enterprise and effort of the officer making it, no expense being incurred or facilities furnished by the government, the inventor is entitled to the fruits of his labor, and letters

patent issued to him for such invention are his property and cannot be acquired by the government without his consent and the payment to him of such royalty as he may demand." Annual Report of the Judge-Advocate-General (Lemley) of the Navy to the Secretary of the Navy, November, 1897.

17. A workman, in the employ of another, manufactured for him in his shop and with his materials and upon weekly wages, machines which the employer used as a part of his tools without objection, and for which the inventor obtained a patent during the term of his employment. *Held*, that the workman as patentee could not enjoin the use by the employer of the particular machines thus made. *Blauvelt v. Interior Conduit & Insulation Co., 80 Fed. Rep. 906 (1897).

EQUITY.

(See EVIDENCE; INJUNCTION; SUIT; INFRINGEMENT; TESTIMONY.)

- I. BILLS — ORIGINAL, CROSS, AND SUPPLEMENTAL.
- II. JURISDICTION.
- III. PROCEDURE.
- IV. TESTIMONY BEFORE AN EXAMINER.

I. BILLS — ORIGINAL, CROSS, AND SUPPLEMENTAL.

1. Where the assignment under which the complainant holds title employs, so far as the bill shows, such words as "all the right, title and interest," *held*, that the complainant had no right to a discovery prior to the date of transfer. *Kaolatype Engraving Co. v. Hoke, 39 O. G. 589, C. D. 1887.

2. Mere intention, not signified in an assignment of letters patent, to include therein claims for infringements previously committed, will not suffice to invest the assignee with any equitable title to those claims, and such assignee, after bill filed, in a suit for infringement brought by him, having procured an assignment of said claims, will not be permitted in that suit to set up by a supplemental bill this post assignment. *Emerson, Smith & Co. (Limited) v. Hubbard, 46 O. G. 976, C. D. 1889.

3. The court held that the whole basis and foundation of the present suit had disappeared by reason of its decree in a former case, and that

the cause should be remanded to the circuit court with instructions to allow the appellant, defendant below, to file such supplemental bill as he may be advised, in the nature of a bill of review, or for the purpose of suspending or avoiding the decree, upon the new matter arising from the reversal of the decree in the former case. *Ballard v. Searles, 47 O. G. 655, C. D. 1889.

4. Leave to file cross-bill in proceeding under section 4915, Revised Statutes, denied, the object of the cross-bill being to enjoin the complainant from infringing a patent for the same invention already issued to defendant. *McCormick Harvesting Machine Co. v. Deering, 47 O. G. 1222, C. D. 1889.

5. The original bill not necessarily involving the question of infringement of the defendant's patent, such a cross-bill is not germane thereto. *Id.

6. The purpose of a cross-bill is to obtain discovery of facts in aid of the defense to the original bill, or to obtain full relief to all parties touching the matter of the original bill. *International Tooth Crown Co. v. Carmichael, 54 O. G. 1116, C. D. 1891.

7. The defendant in an equity suit for infringement of patent cannot file a cross-bill to enjoin the complainant from publishing the fact of infringement and thus interfering with his trade or business. In such case the fact sought to be presented by cross-bill, being at most merely an independent unlawful act by the complainant, would neither throw light upon the subject, nor avail to defeat the patent or justify an infringement of it, if valid. *Id.

8. A supplemental bill by the plaintiff, alleging that since the beginning of the suit plaintiff's patent had been adjudged valid by another court in a case to which defendant was not a party, on plaintiff's filing a disclaimer limiting the scope of the patent, and that in view of such disclaimer the two patents no longer interfere, will not be stricken out on general demurrer, as the facts alleged can be made to appear by supplemental bill only. *Electrical Accumulator Co. v. Brush Electric Co., 55 O. G. 573, C. D. 1891.

9. Under Revised Statutes, section 4915, the only question the court can consider is whether the complainant is the first inventor of a patentable device. Whether respondent or a third party was the inventor of the device for which respondent has received a patent should not be inquired into either by the court or by the commissioner in interference proceedings between

the same parties. *Christie v. Seybold, 64 O. G. 1650, C. D. 1893.

10. On a bill by the assignee of a patent against the assignors for infringement, praying for an accounting, defaults of the assignee in not complying with conditions of the assignment and other wrongs on his part, which do not authorize a forfeiture by the terms of the contract, are not grounds for a cross-bill by the assignors to cancel the assignment or to remove the cloud on their title to the patent arising therefrom or for other affirmative relief where all the matters complained of may be pleaded as defenses to the original bill and damages therefor may be considered on the accounting. *E. C. Atkins & Co. v. Parke, 68 O. G. 1510, C. D. 1894.

11. Where a defeated party to an interference in the patent office files a bill in equity, under section 4915, against his successful contestant and patentee as defendant, the propositions submitted by the defendant that under section 4915 something more than the ordinary *quantum* of evidence is required of the complainant and that the suit must proceed upon the same lines as though it were a bill filed to set aside a judgment at law, certainly have force. *Held*, however, that it was unnecessary to discuss them in this case, as the weight of evidence sustains the defense. *Rudolph v. Williams, 69 O. G. 642, C. D. 1894.

12. Claims canceled in the patent office cannot be reinstated or reviewed in bill in equity under section 4915, Revised Statutes. *Durham v. Seymour, Com'r of Patents, 71 O. G. 601, C. D. 1895.

13. Where in a suit under section 4918, Revised Statutes, after the filing of a cross-bill by defendant, and the right to affirmative relief thereunder having been decided adversely to defendant, and an appeal to the court of appeals, plaintiff assigned its patent, *held*, that the assignment did not abate the suit, but directed that when the case is remanded to the circuit court that court be instructed that if the assignee of complainant files an original bill, in the nature of a supplemental bill, within a designated time, and proof of interest is made, and the validity of title sustained, a decree in favor of the assignee be entered. *Appleton v. Ecaubert, 71 O. G. 1617, C. D. 1895.

14. When the suit was under section 4915, and not under section 4918, of the Revised Statutes, it is a continuation of the interference contest in the patent office, and the only question that can be considered is whether the com-

plainant is entitled to receive a patent for the invention described in the bill and as specified in his claim filed in the patent office. *Standard Cartridge Co. v. Peters Cartridge Co., 72 O. G. 742, C. D. 1895.

15. Where on a suit under section 4915, Revised Statutes, much additional testimony was introduced, but it was mostly either in corroboration or in contradiction of the testimony in the interference case in the patent office, *held*, that the decision of the commissioner ought not be set aside upon merely cumulative or impeaching evidence, which is no ground for the granting of a new trial at law. *Id.

16. A party asking relief by bill of review must satisfy the court that the evidence upon which he relies could not, with the exercise of due diligence, have been secured prior to the hearing. *Bennett & Shepherd v. Schooley, 77 O. G. 1432, C. D. 1896.

17. Proof that respondent wrote to a firm of attorneys instructing them to send him copies of all patents relating to a certain subject does not amount to proof that such attorneys made a search to discover all such patents, though they sent a number, and presumption in favor of such search having been made is negated by the discovery of the patents now urged in the place where prudence would have suggested a search. *Id.

II. JURISDICTION.

18. A bill in equity which sets forth a license to defendants to use certain patents embodied in machines leased to them by plaintiff, the license providing for payment of license fees, or purchase and use of license stamps, and for rendering accounts, and which alleges failure of defendants in their obligations under the license, and prays for discovery and account, and decree for payment of fees, and an injunction until such payment, shows a cause for equitable relief. *McKay v. Smith, 39 O. G. 959, C. D. 1887.

19. This court had jurisdiction because the complainant had equitable rights for which he had no remedy at law; the suit did not depend upon an injunction and the amount in dispute exceeded five hundred dollars. *Rogers v. Reissner, 41 O. G. 351, C. D. 1887.

20. A patentee is not compelled to sue at law and establish the validity of his patent. Questions affecting validity are usually heard and determined for themselves by courts of

equity. *Wise v. Grand Avenue Ry. Co., 33 Fed. Rep. 277 (1888).

21. A bill for a discovery and account, and for a decree for the payment of the royalties and damages sustained, and for an injunction against the use by the defendants in the meantime of any of the inventions recited in the license, exhibits a case for equity cognizance. *Hat Sweat Mfg. Co. v. Porter, Crofut & Hodgkinson, 44 O. G. 1070, C. D. 1888.

22. If the sole object of the bill was to enforce the payment of the royalties, the complainant would have an adequate remedy at law; but as discovery is sought as well, and an order to compel the defendants to perform their covenants or abstain from the use of the patents, and as the denial of equitable relief might result in a multiplicity of suits, equity jurisdiction is attained even in the absence of irreparable damage. *Id.

23. The general powers of a court in equity include the right to annul and set aside contracts or instruments obtained by fraud, to correct mistakes in them, and to require their delivery for cancellation or correction. *The United States v. The American Bell Telephone Co., 45 O. G. 1311, C. D. 1888.

24. A patentee who grants a license to manufacture and sell the patented article under a contract by which the licensee is to make monthly reports and pay a stipulated royalty, and for failure to comply with which the licensor may declare a forfeiture, cannot sue in equity to compel the licensee to make reports and account for royalties due, or on his failure to do so to enjoin him from further manufacture or sale. By such prayer he waives the forfeiture clause, and is left to his action at law for the royalties. *Washburn & Moen Mfg. Co. v. Cincinnati Barbed Wire Fence Co., 52 O. G. 2110, C. D. 1890.

25. It is more than doubtful if an original bill will lie to enjoin publications injurious to one's trade or business; and this upon the ground that the injured party has a complete remedy at law. *International Tooth Crown Co. v. Carmichael, 54 O. G. 1116, C. D. 1891.

26. Objection that equity has no jurisdiction comes too late when raised for first time at final hearing and after answer has tendered a number of issues upon which much testimony has been taken. *Vaile v. Buckeye Iron and Brass Works, 63 O. G. 1965, C. D. 1893.

27. The failure of a party in an interference proceeding in the patent office to raise the question whether his opponent's invention includes

the issue declared in the interference does not estop such party to raise that question in an equity suit, under Revised Statutes, section 4915, to determine his right to a patent. *Christie v. Seybold, 64 O. G. 1650, C. D. 1893.

28. The preliminary objection of defendants that the complainants had created a close corporation, trust or syndicate to crush rivals and had resorted to vexatious and frivolous suits, compromises and other devices to control the market and fix prices of tobacco, and therefore that a court of equity should not and cannot aid the complainants in the prosecution of their unlawful designs, overuled, the court stating that, in the absence of fraudulent or improper conduct toward the defendants, the motives of the complainants in procuring and exercising their exclusive rights under the patents may not be the subject of judicial inquiry; that patent-rights are essentially monopolistic and patent contracts or contracts relating to patents are not subject to the general rules governing contracts in restraint of trade; and that it follows that a patentee may secure and protect his monopoly in any lawful way by suit, purchase, sale or combination; that a case requiring the most elaborate investigation and careful consideration cannot be considered vexatious and frivolous, and it is not in point to urge that other pending suits are without merit; that there can be no reason for the interference of the courts, notwithstanding the existence of patent-rights, to secure the uninterrupted manufacture of cigarettes, which are neither necessary nor beneficial to the public, and that there should be no interference by any department of the government with open competition in the markets. *Bonsack Machine Co. v. Smith, 73 O. G. 963, C. D. 1895.

29. Where in a patent case no equitable right is presented which cannot be made available at law, the parties should proceed in the usual manner in the action at law. The possible cost and expenses to which an applicant would be put by defending an action at law is no reason for enjoining such a pending action. *Germain v. Wilgus, 73 O. G. 1555, C. D. 1895.

30. The action of a patent owner in harassing purchasers with threats of litigation when no possible ground of action exists against them, even if the patent is valid, in attempting to dismiss his bill, whereby defendant, in order to prevent it, is compelled to file a cross-bill, and in delaying the taking of evidence until after defendant begins the taking of testimony, is not such as commends the cause to a court of

equity. *American Fibre Chamois Co. v. Port Huron Fibre-Garment Mfg. Co., 75 O. G. 836, C. D. 1896.

31. When a bill in equity discloses that more than forty-nine thousand machines are in use and charges a long-continued infringement and a purpose to continue therein, both upon the ground of avoiding a multiplicity of law-suits and upon the general and apparent inadequacy of a suit at law for damages, a court of equity has jurisdiction. *Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co., 78 O. G. 171, C. D. 1897.

III. PROCEDURE.

(See PRACTICE IN THE COURTS; PLEADING.)

32. In a proceeding under a bill in equity alleging the assignment of an invention to the complainant and the identity of said invention with an invention alleged by the defendant to have been subsequently made by him and not assigned, and also alleging the consequent ownership by the complainant of both inventions, and apparatus embodying both of said inventions being in possession of the defendant and inaccessible to the complainant, *held*, a court in equity has the inherent power, on motion of the complainant, to grant him an order of inspection of the apparatus in possession of the defendant which is alleged to embody the inventions in controversy, to the end that the complainant may be enabled to adduce evidence in support of the allegations of his bill. †Wilson v. Keely, 43 O. G. 511, C. D. 1888.

33. On a bill to set aside an alleged assignment of a patent by defendant as being a cloud on complainant's title, he claiming under an assignment of the inventor, the issue raised by the plea was that the patent belonged to defendant because it was included in an instrument executed while the application was pending, by which the inventor assigned to defendant all inventions and applications that did or might interfere with pending applications of defendant. Patents were afterward granted upon said applications of both parties. *Held*, that the presumption from this result is that the applications did not interfere, and the burden is on defendant, in order to sustain his plea, to show from the patents or their file or papers that there might have been such an interference. *Lowry v. Cowles Electric Smelting and Aluminum Co., 65 O. G. 295, C. D. 1893.

34. To a suit in equity to have an assignment

of patent-rights, alleged to be fraudulent and to constitute a cloud on plaintiff's title, declared to be fraudulent and void, for the cancellation of such assignment and that the record thereof be expunged from the records of the patent office, the parties by whom the alleged assignment was made are indispensable parties, and no decree declaring the assignment fraudulent and void and directing its cancellation can be made in their absence. *Backus Portable Steam Heating Co. v. Commissioner of Patents, 66 O. G. 1893, C. D. 1894.

35. The rights involved in such a suit are strictly *in personam*, and no decree can be made affecting them unless it be founded upon control of the parties by the court after due process served or their voluntary appearance. *Id.

36. Where the title to a patent passed to the assignee upon a contract which was champertous, the assignee's bill in equity will be dismissed. *Keiper v. Miller, 71 O. G. 1916, C. D. 1894.

37. The assignee's title, founded upon an agreement that the assignee should bring suits at his own expense and divide with the assignor the amount recovered, is tainted with champerty. *Id.

38. Evidence was developed upon cross-examination of the patentee to require of complainant to set forth with fullness the actual contract upon which title to the patent was founded and to require of him to clear the contract of its champertous features. *Id.

39. The distinction between complainant's agreement upon which he sues and a champertous agreement for the compensation of an attorney discussed. *Id.

40. A court of equity will not grant a decree on another ground where the bill charges actual fraud as the ground for relief and the fraud is not proven. (62 Fed. Rep. 584, reversed.) *Dashiell v. Grosvenor, 74 O. G. 500, C. D. 1896.

41. A court of equity will not be overzealous in behalf of a defendant who persists in producing an old article which concededly contains all the elements save one of a combination uniformly forbidden him in previous suits. *Beach v. Inman, 77 O. G. 1275, C. D. 1896.

42. When it is urged by the defendant, a corporation, in justification of failure to answer certain interrogatories propounded that the complainants' waiver of an answer under oath is a waiver of all right to exceptions for insufficiency, *held* that, the cause being against a corporation only, an answer under oath, even if not waived by the bill, could not have been

required. Corporations answer under the sanction and solemnity of their seals only. But whether defendant answers under oath or under corporate seal, when oaths are waived they are required to answer fully on every material issue. *National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co. (No. 4,047), Chicago Railway Equipment Co. v. Interchangeable Brake-Beam Co. (No. 4,048), 81 O. G. 1423, C. D. 1897.

43. The waiver of an oath in any case is made by the complainant for the purpose of depriving the defendant of the advantage of his answer as evidence in his favor. If no such waiver is made, a sworn answer is taken as evidence in favor of the defendant so forceful as to require two witnesses or one witness and corroborating circumstances to overcome it. *Id.

44. The sole purpose of a waiver of an oath to an answer is to affect the evidential character and value of the answer. It has nothing to do with the answer as a pleading, and the rule prevails that the defendant must answer fairly and fully to each and every material fact alleged in the bill. This fair and full answer should serve the purpose of eliminating many undisputed facts from the case. *Id.

45. Equity rule 89 discussed and construed. *Id.

IV. TESTIMONY BEFORE AN EXAMINER.

(See TESTIMONY.)

46. On a motion for the appointment of an examiner to take testimony in an equity cause the court will not limit or restrict the taking of testimony or determine what is proper testimony. Objections taken to evidence on the ground of incompetency or irrelevancy properly come before the court at the final hearing. *United States v. American Bell Telephone Co. and Alexander Graham Bell, 48 O. G. 824, C. D. 1889.

47. Under the sixty-seventh rule in equity of the United States courts an examiner is required to note the exceptions, but cannot decide their validity, and must take down all the examination in writing and send it to the court with the objections noted. *Appleton v. Ecaubert, 55 O. G. 717, C. D. 1891.

48. The materiality of the questions propounded on the direct examination will not be passed upon in advance. *Id.

49. Testimony taken under a stipulation by the parties before an officer qualified, but with-

out special appointment by the court, as an examiner, is beyond the control of the party in whose behalf it was taken, and cannot be withheld if the opposing party insists upon its introduction. *J. L. Mott Iron Works v. Standard Mfg. Co., 58 O. G. 277, C. D. 1892.

EQUIVALENTS.

(See CLAIMS FOR.)

1. "Where change of form or combination only is involved, each inventor must be content with the structure described and claimed by him." "The doctrine of equivalents cannot be invoked to suppress improvements on a well-known machine." *Hill v. Sawyer, 31 Fed. Rep. 282 (1887).

2. Where there were a number of devices similar to that covered by the patent in existence when the patent was applied for, the doctrine of mechanical equivalents should have a restricted operation. *Archer v. Arnd, 40 O. G. 1032, C. D. 1887.

3. A stationary plate with radial slots and a perforated disk rotating in close proximity to the same in a prior patent is not the equivalent of complainant's stationary perforated plate and knives rotating in close proximity thereto. *Enterprise Mfg. Co. of Pennsylvania v. Sargent & Co., 42 O. G. 1403, C. D. 1888.

4. The mechanical devices used by the defendant are known substitutes or equivalents for those employed in the Morley machine to effect the same results, and this is the proper meaning of the term "known equivalents," in reference to a pioneer machine, such as that of Morley. *Morley Sewing Machine Co. v. Lancaster, 47 O. G. 267, C. D. 1889.

5. The doctrine of equivalents is as applicable to improvements and combinations of old elements as to original inventions and new devices. (Citing Gould v. Rees, 15 Wall. 192; Seymour v. Osborne, 11 Wall. 555, and Gill v. Wells, 22 Wall. 28.) *Tatum v. Gregory, 41 Fed. Rep. 142 (1890).

6. If two devices do the same work in substantially the same way, and accomplish exactly the same results, in the sense of the patent law they are the same devices, notwithstanding the differences in name, form or shape. (Cases cited.) *Harmon v. Struthers, 43 Fed. Rep. 437 (1890).

7. The invention being of a primary character, the patentee and his assignees are en-

titled in full measure to the benefit of equivalents. (Cases cited.) *Id.

8. It is a well-established rule of the office that the words "or its equivalent" may not be used in a claim unless an equivalent device is described in the specification. (Dolph, Ex parte, 39 O. G. 239; Cook, Ex parte, 43 MS. D. 1.) Ex parte Lockwood, 43 MS. D. (2 G. W. D.), June, 1890 (Fisher, Ass't Com'r).

9. An inventor is always entitled to equivalents—that is to say, to devices which operate in substantially the same way to accomplish substantially the same result in a combination. If he desires some advantage beyond that which the law of equivalents gives him, he is seeking more than can properly be accorded to him. Ex parte Cook, 51 O. G. 1620, C. D. 1890.

10. In combinations the doctrine of equivalents is construed most strongly against him who alleges infringement, and each party is held to his own element or device or a positive and exact equivalent which performs the same functions in the same manner, the burden being upon the complainant to show this. *Dudley E. Jones Co. v. Munger Improved Cotton Machine Mfg. Co., 58 O. G. 274, C. D. 1892.

11. The general principle is that, in order to be considered an equivalent of another, one device must perform the same functions and perform them substantially in the same way. *Id.

12. Where change of form or combination only is involved, the doctrine of equivalents cannot be invoked to suppress improvements, and each inventor must be content with the mechanism claimed by him. *Dederick v. Gardiner, 59 O. G. 790, C. D. 1892.

13. When patents deal with inconsequential details, each patentee must be confined to the precise structure which he has contributed to the art. (Cases cited.) There is no room in such a case for the doctrine of equivalents. *Dietz v. C. T. Ham Mfg. Co., 58 Fed. Rep. 367 (1893).

14. When an invention is of a primary character, a larger latitude is to be given to the doctrine of equivalents than if the art had been well explored. *Dederick v. Seigmund, 60 O. G. 1193, C. D. 1892.

(See numerous cases cited in this decision.)

15. When a combination patent covers a new arrangement of old elements, producing a new and useful result, the same may be protected by invoking the doctrine of equivalents, as against the substitution for any particular ele-

ment of a different device known at the date of the patent as a means of performing similar work; and the fact that the substitute performs some additional functions does not prevent it from being an infringement. *Norton v. Jensen, 60 O. G. 1326, C. D. 1892.

16. In comparing the patented combination with the defendant's machine, "though some of the corresponding parts of the machinery are not the same, and, separately considered, could not be regarded as identical or conflicting, yet, having the same purpose in the combination and effecting that purpose in substantially the same manner, they are the equivalents of each other in that regard. *National Cash Register Co. v. American Cash Register Co., 62 O. G. 449, C. D. 1893.

17. Two things are the same in the sense of the patent law when they perform the same function in substantially the same way and accomplish the same result. *Sayre v. Scott, 63 O. G. 1818, C. D. 1893.

18. Complainants are not entitled to claim, broadly, the benefit of the doctrine of equivalents, which is rightly applicable to inventions of a primary character, Poyton being a mere improver, structurally, of an old and commonly-used device and having applied no new principle and produced no distinctively new result. *Vincent v. Rigby, 64 O. G. 861, C. D. 1893.

19. The substitution of spring-rockers for a pivot or hinge to produce a tipping movement in one of the plates of a lasting-machine is an infringement, for the two are equivalents. *McKay & Copeland Lasting Co. v. Dizer, 68 O. G. 281, C. D. 1894.

20. Where the patented machine never before existed, it will not be carrying the doctrine of equivalents too far to hold a device an infringement which does the same work as the patented machine, if not by the same, certainly by equivalent means. *Beach v. American Box Machine Co., 69 O. G. 1067, C. D. 1894.

21. The patentee is not "a pioneer in the art," and therefore the doctrine of equivalents does not apply to this case, so as to include all forms of devices which operate to perform the same functions or accomplish the same results. (Citing Miller v. Manufacturing Co., 151 U. S. 186.) *Wells v. Curtis, 66 Fed. Rep. 318 (1895).

22. Such an addition to the mechanical details of the combination embraced in the claims is within the doctrine of equivalents when the patented invention is a broad one, as this is, and cannot be evaded by the fact that the addition itself is an improvement. *Westing-

house Air Brake Co. v. New York State Air Brake Co., 70 O. G. 388, C. D. 1895.

23. *Held*, that powdered asbestos is the equivalent of powdered soapstone within the meaning of the issue. Pratt and Johns v. Thomson, 72 O. G. 1347, C. D. 1895.

24. As a general definition, a mechanical equivalent that may be properly substituted for an omitted mechanical element, device or agency in a patented machine is one that performs the same function by applying the same force to the same object through the same mode and means of application. As applied to a combination of old elements, it is special in its significance and materially narrower in its range than when applied to an invention consisting of a new device or an entirely new machine. *Carter Machine Co. v. P. H. Hanes & Co., 74 O. G. 1277, C. D. 1896.

25. In applying the doctrine of equivalents a distinction is made between inventions of specific devices and those of combinations. In a simple invention the range of equivalents is much wider than in a combination. In the former a change which would be held to be a substitution of equivalents may in the latter be considered to be an introduction of a new idea of means. *Erie Rubber Co. v. American Dunlop Tire Co., 74 O. G. 1443, C. D. 1896.

26. In applying the doctrine of equivalents it is essential there be an identity of function, and the function must be performed in substantially the same way by the alleged equivalents. *Engle Sanitary and Cremation Co. v. City of Elwood, 73 Fed. Rep. 484 (1896).

27. It is an essential rule governing the application of the doctrine of equivalents that not only must there be an identity of function between the two things claimed to be equivalents, but also that function must be performed in substantially the same way. *Engle Sanitary and Cremation Co. v. City of Elwood, 75 O. G. 1713, C. D. 1896.

28. Where an invention is fundamental the patentee should have the benefit of the doctrine of equivalents. *Société Anonyme Usine J. Cleret v. Rehfuss, Same v. Selig, 75 Fed. Rep. 657 (1896).

29. When two forms are known interchangeable substitutes for each other at the time of the patentee's invention, a claim for one must be held to include the other as its manifest equivalent. *Id.

30. For the purpose for which the thimbles or bushings are employed, metal is not the mechanical equivalent of wood. *Dodge v. Post & Co., 78 O. G. 339, C. D. 1897.

31. When at the date of the invention of an improvement the state of the art is such that an inventor can only claim the exact construction which he has selected as the embodiment of his improvement or its ordinary equivalent, the broad range of equivalents permissible in the case of a primary invention cannot be allowed. *Edward Miller & Co. v. Meriden Bronze Co., 79 O. G. 1520, C. D. 1897.

32. A patentee cannot speculate on the equivalents of his invention, and thereby oblige the public to resort to experiments in order to determine the scope of his patent. He has no right, when he has made a discovery relative to one or more specific substances of a certain class, to base upon this a contention that his patent relates to and covers the use of all substances of that class, especially when it appears that his discovery does not in fact relate to most of such substances. *Matheson v. Campbell, 79 O. G. 686, C. D. 1897.

33. Claims 2 and 5 of Letters Patent No. 472,094, and claim 2 of Letters Patent No. 472,095, granted to Charles H. Willcox, for a sewing machine, cannot be construed to cover defendants' device without unduly straining the doctrine of equivalents. *Willcox & Gibbs Sewing Machine Co. v. Merrow Machine Co., 81 O. G. 1613, C. D. 1897.

34. An equivalent is an element or device which was well known as a proper substitute for the one described in the specification at the date of the patent. Hence he is an infringer who employs a substitute which "performs the same function as the ingredient for which it is so substituted, and it appears that it was well known at the date of the patent that it was adaptable to that use." (Gill v. Wells, 22 Wall. 1.) *Norton v. Jensen, 81 Fed. Rep. 494 (1897).

35. The term "equivalent" is special in its signification when applied to an invention consisting merely of combinations of old ingredients, and somewhat different from what is meant when the term is applied to an invention consisting of a new device or an entirely new machine. *Id.

ESTOPPEL.

(See PRIOR ADJUDICATION; INJUNCTION, PRIOR JUDGMENT.)

1. The defendant in this suit having been a defendant in a former suit upon the same patent, where the assignor of the complainant corporation was the party complainant, and wherein the defendant had filed an answer

setting up substantial defenses and then permitted a decree by consent for nominal damages, with no costs, and with an injunction, *held*, that upon this state of facts it is not open to the defendant on this motion to deny the validity of complainant's patent in suit. *United States Metallic Packing Co. v. Tripp, 39 O. G. 1554, C. D. 1887.

2. The defendants, having had and enjoyed the exclusive rights under the patents, cannot question their validity. *Rogers v. Reissner, 41 O. G. 351, C. D. 1887.

3. Where a patentee has assigned his patent he is estopped, in an action brought against him for infringement by his assignee, from denying the validity of re-issues of his patent, though such re-issues were obtained since the assignee acquired an interest in the patent, and the latter might have known that they were void when he accepted them. *Burdall v. Curran, 42 O. G. 1167, C. D. 1888.

4. A party applying for a patent as a joint invention of himself and another should be estopped as against a *bona fide* owner of the patent from defeating it by proof tending to show that he took a false oath or otherwise imposed upon the patent office. Having given life to the patent by one oath, he cannot be heard to destroy it by another. *Schlicht & Field Co. v. Chicago Sewing Machine Co., 46 O. G. 1394, C. D. 1889.

5. A former licensee is not estopped from questioning the validity of a patent after his license has expired in vindication of acts done subsequent to its termination. *H. Tibbe & Son Mfg. Co. v. Heineken, 47 O. G. 1221, C. D. 1889.

6. *Held*, that defendant was estopped from setting up the invalidity of the patents that were still in force, as it appeared that from the date of the license until after the period for which recovery was brought in this action the defendant acted under the license and enjoyed its benefits. *National Rubber Co. v. Boston Rubber Shoe Co., 50 O. G. 559, C. D. 1890.

7. Though a patent is void by reason of its anticipation by an earlier foreign patent, the patentee is estopped from urging that as a defense to a suit by his assignee for an infringement of the patent. *Adee v. Thomas, 51 O. G. 1132, C. D. 1890.

8. A patentee who has assigned his patent cannot deny its validity, as against his assignee, on the ground that it infringes another patent previously acquired by him, where the application for the assigned patent is sufficiently broad

to include the previous one. *Adee v. Thomas, 51 O. G. 1134, C. D. 1890.

9. Where defendants admit that they have manufactured and sold under a license, and that they have assigned whatever rights they had thereunder, they will not be permitted to plead that they were led to make the contract by complainant's false and fraudulent representations, nor that the patent was invalid, as complainant knew. *Hatfield v. Smith, 54 O. G. 1892, C. D. 1891.

10. After a stipulation by the defendant that a decree might be entered for a royalty, he is estopped from claiming that the invention is useless. *Western Electric Co. v. La Rue, 55 O. G. 571, C. D. 1891.

11. One who has adopted and used in the manufacture of an article some feature covered by a patent is estopped from afterward denying the utility of the invention. *Gandy v. Main Belting Co., 59 O. G. 1106, C. D. 1892.

12. Where a manufacturer of mantels purchased two mantels of a design not then patented, for the usual price and for the avowed purpose of using them as copies in his business, *held* equivalent to the consent on the part of the inventor that the manufacturer might use the design, and that, having subsequently obtained a patent therefor, he could not maintain a suit for infringement against the manufacturer. *Anderson v. Eiler, 60 O. G. 740, C. D. 1892.

13. The fact that the defendant sought through one of his employees to obtain a patent for the device, *held* to be no ground of estoppel to prevent him from asserting that there is no patentable novelty in the device. *Haughey v. Lee, 66 O. G. 1450, C. D. 1894.

14. The rule that a patentee is estopped from claiming a construction of the claims equivalent to those canceled applies when the canceled claim is narrower as well as when it is broader than those rejected. (Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co., 67 O. G. 272.) *Johnson v. Olsen, 68 O. G. 1146, C. D. 1894.

15. Where the patents of several parties are assigned to a corporation, which corporation subsequently re-assigns to each party his patents in order that he might resume what he had put into the corporation, *held*, that this was a mere transfer of stock in the corporation and did not estop the corporation from denying the validity of the patents. *Electric Ry. Co. of the U. S. v. Jamaica & Brooklyn R. Co., 68 O. G. 769, C. D. 1894.

16. Where a patentee was advised by the patent office that his application disclosed, but did not claim, an invention claimed in a pending application by another party, and upon this information added claims for the invention, and the resulting interference was decided in his favor, but subsequently canceled the additional claims because the patent office, on change of opinion, rejected them on reference to a patent and took his patent with his original claims, *held*, that he was not estopped from insisting on his narrower construction of the original claims in order to avoid anticipation of them as not including the invention in the canceled claims nor met by the patent that caused their rejection and cancellation. **Id.*

17. Where a party to an interference practically withdrew by means of a stipulation by which he agreed that the preliminary statement of the other party should be accepted as evidence, that no additional evidence should be received, and that priority should be decided on this evidence and without argument, and where, a patent having been issued to his opponent, he accepted a license thereunder, *held*, that the stipulation amounted to an admission of priority sufficient, as evidence in a suit for infringement, to show, *prima facie*, that the successful party in the interference was the first inventor. **Shoemaker v. Merrow*, 68 O. G. 1523, C. D. 1894.

18. Where an interferant in the patent office dissolved the interference by canceling his claim for the specific element forming the issue, *held*, that he is estopped from asserting such element as part of his claim in his patent. **Id.*

19. Where an applicant in the patent office withdrew claims which were rejected and substituted others with the statement that they were the ones on which he would want a final decision, *held*, that such action was a waiver by the applicant of his right to assert title to the withdrawn claims in a bill in equity under section 4915. **Durham v. Commissioner of Patents*, 69 O. G. 507, C. D. 1894.

20. The assignment of a patent by a patentee for a valuable consideration estops him, when sued for infringement thereof by an assignee deriving title under the assignment, from setting up the question of validity, except as affected by the state of the art and anticipatory matter as a part of the state of the art, and these only as bearing on the construction of the patent. **Babcock v. Clarkson*, 69 O. G. 1773, C. D. 1894.

21. In a suit for infringement brought by

the assignee against the assignor of a patent the latter is estopped from denying its validity; but the prior state of the art is admissible in evidence to aid the court in the construction of the patent. (*Ball & Socket Fastener Co. v. Ball Glove Fastening Co.*, 58 Fed. Rep. 818; *Babcock v. Clarkson*, 69 O. G. 1773, 63 Fed. Rep. 607.) **Martin & Hill Cash-Carrier Co. v. Martin*, 72 O. G. 744, C. D. 1895.

22. An interference judgment in the patent office in a proceeding between the complainant and the patentee whose device the defendant is using does not estop the defendant from denying novelty and priority of invention of complainant's patent when the issue in such proceeding included an additional element and the only evidence that the defendant was a party in privity or that the opposing application was made in its interest rested upon a single inconclusive reply to a question. **McCarty v. Lehigh Valley R. Co.*, 73 O. G. 1707, C. D. 1895.

23. Defendants set up, as anticipating the patent sued on, another patent owned by complainant. It appeared that this patent, together with numerous others relating to the same art, owned by complainant and other parties, had by agreement been conveyed to a trustee to issue licenses to others for the use of all the patents, and that in this way licenses had been granted under the alleged anticipating patent, but not to the defendant. *Held*, that complainant was not estopped by reason of such licenses from showing, as against the claim of anticipation, that the patent in question was inoperative, and that the fact of such licenses was only evidential in character, as an admission, and its force as evidence was rebutted by the character of the arrangement under which the licenses were granted. **McCormick Harvesting Machine Co. v. C. Aultman & Co.*, 73 O. G. 1999, C. D. 1895.

24. When a claim of an application assigned was void at the time of the assignment, in view of references cited thereto, and the vendees completed the payment of the consideration after they learned that such claim had been rejected, their act amounts to an election of the remedy by ratification and estoppel in preference to that by repudiation for fraud. **National Conduit Mfg. Co. v. Connecticut Pipe Mfg. Co.*, 75 O. G. 1361, C. D. 1896.

25. The foundation of the estoppel against a vendor patentee to deny the validity of his patent is the fact that he has received and retained a valuable thing in consideration of the statement contained in the application. **Id.*

26. Such a sale is an agreement by the vendor that, whatever may be the status of the patent as to the public, he will not thereafter interfere with the vendee's rights in the invention covered by the patent during the life of the patent. *Id.

27. Manufacturers being defendants, having stamped articles made by them under a patent in the manner provided by the statutes, and having accounted to and paid royalty to the patentee, are estopped to deny that they contain the patented improvement. *Andrews v. Landers, Frary & Clark, 75 O. G. 510, C. D. 1896.

28. Said defendants are not estopped to deny that other articles do not contain the patented improvement when such articles do not contain the elements of the patented article, have not been represented by them as containing such improvement, and when there is nothing to show that by any act or omission of theirs was the position of the patentee, who is the plaintiff, affected to his prejudice. *Id.

29. It would be carrying the doctrine of estoppel to an extravagant length to hold that an unsound and unsuccessful argument made in the patent office by the applicant with respect to a rejected claim should have the effect of imposing a destructive limitation upon allowed claims. An estoppel is not to be implied from circumstances of doubtful import. *Société Anonyme Usine J. Cléret v. Reh fuss, 76 O. G. 336, C. D. 1896.

30. From defendants in privity with former interferants with a patentee a contention that there is no patentable novelty in the invention comes with ill grace. *Fenton Metallic Mfg. Co. v. Chase, 76 O. G. 478, C. D. 1896.

31. The fact that defendant was a licensee cannot estop him from disputing the validity of the patent under which he takes his license in a suit for infringements charged to have taken place after the license was drawn, though in a doubtful case it might have considerable evidential force as an admission of validity. *Dueber Watch Case Mfg. Co. v. Robbins, 77 O. G. 154, C. D. 1896.

32. Under the rule that if one was silent when it was his duty to speak he shall not be permitted to speak when he should be silent, since defendants, when threatened with a former suit upon the patent now sued upon failed to claim any interest in said patent, they should not be permitted to assert it now. *Independent Electric Co. v. Jeffrey Mfg. Co., 78 O. G. 797, C. D. 1897.

EVIDENCE.

(See TESTIMONY; DEFENSES; ESTOPPEL; PLEADING.)

- I. IN GENERAL.
- II. ADMISSIBILITY.
- III. WEIGHING.

I. IN GENERAL.

1. Where in the patent in suit the only cutting claimed was by a revolving knife in close proximity to a stationary perforated plate, and the contention of the defendants was that in their machine there was a preliminary cutting before the material reached the perforated plate, the silence of defendants' patent in this respect is persuasive evidence to the contrary. *Enterprise Mfg. Co. of Pennsylvania v. Sargent & Co., 42 O. G. 1403, C. D. 1888.

2. Orders procured by fraud which affect the rights of person or property or are injurious to the persons affected should be vacated; but an order recognizing the right of a party to secure and present to the court all his evidence in support of his allegations, which in no sense invades or affects the rights of his adversary, should not be disturbed. Osgood v. Badger, v. Bennett, 44 O. G. 1065, C. D. 1888.

3. Pullman, in his affidavit of April 1, 1889, forwarded to the patent office, stated that he completed his invention prior to the filing of the Sessions application, and it was contended by the defendants that Pullman finally obtained his patent because the patent office believed that his invention was prior to Sessions', and not that it embraced anything patentable outside of Sessions'. *Held*, that in the absence of record proof the court had no right to assume that the patent was issued on that affidavit or for that particular reason, it appearing by the record in the present case that Sessions swore that what Pullman said in his affidavit as to his invention was true in point of fact. *Pullman's Palace Car Co. v. Boston & Albany R. Co., 53 O. G. 1255, C. D. 1890.

4. When a patent has been referred to and used in the examination, marked as an exhibit in the cause by the examiner, and returned and certified as part of the record, it will be received as offered in evidence, even though the depositions contain no express minute that the patent was so offered. *Clark Thread Co. v. Willimantic Linen Co., 56 O. G. 395, C. D. 1891.

5. The doctrine of privileged communications is confined to cases of counsel, solicitor

and attorney. *Brungger v. Smith, 58 O. G. 388, C. D. 1892.

6. Testimony must be construed with reference to "the ordinary laws that govern human conduct." (Quoting and discussing Atlantic Works v. Brady, 93 O. G. 1330, 107 U. S. 192, and The Telephone Cases, 43 O. G. 377, 126 U. S. 1.) *Brungger v. Smith, 62 O. G. 1513, C. D. 1893.

(Motion for rehearing.)

7. Anticipations must be proven by evidence so cogent as to leave no reasonable doubt in the mind of the court that the transaction occurred substantially as stated. *Deering v. Winona Harvester Works, 69 O. G. 1641, C. D. 1894.

8. Certified copies of assignments are sufficient to establish *prima facie* evidence of title to a patent. *American Cable Ry. Co. v. Mayor, etc. of the City of New York, 64 O. G. 1008, C. D. 1893.

(Circuit court, Coxe, J.)

9. A copy of an assignment of letters patent, certified by the commissioner of patents to be a true copy from the records of the patent office, if objected to at the time of offer, is not competent evidence of title. *American Cable Ry. Co. v. Mayor, etc. of the City of New York, 67 O. G. 1334, C. D. 1894.

(Circuit court of appeals.)

10. The inventor's application oath, especially when accompanied by an affidavit filed in the course of prosecution further supporting its statements, is not to be overcome by the testimony of a former employee of the inventor after nine years of silence and after the death of the inventor so that the testimony cannot be met. *Thomson-Houston Electric Co. v. Winchester Avenue R. Co., 78 O. G. 2155, C. D. 1895.

11. It is not for a moment supposable that if a device produced in an incomplete state by the defense in a court suit was or had been practically operative, it would not have been produced in evidence in an operative condition. In view of this and in view of a finding by the supreme court that the original instrument did not disclose the complete invention and that all claims to the contrary are wholly unfounded in truth, such finding will be accepted as final and conclusive. Drawbaugh v. Seymour, Com'r of Patents, 77 O. G. 313, C. D. 1896.

12. The fact that one contestant witnessed the signature of a second contestant, as in-

ventor, to a drawing made by the latter and disclosing the invention in controversy may be overcome by testimony in behalf of the first contestant that said drawing was intended to disclose as the invention of the second contestant an improvement merely and by additional facts tending to show conception by the first contestant and then disclosure by him to the second. *Standard Cartridge Co. v. Peters Cartridge Co., 78 O. G. 621, C. D. 1897.

II. ADMISSIBILITY.

13. Parol evidence as to the existence of an established license for a patent is not hearsay. *Timken v. Olin, 51 O. G. 1469, C. D. 1890.

14. The foreign publication held to be competent as evidence in regard to the state of the art and as a foundation for the inquiry whether it required invention to pass from the structure therein disclosed to the patented structure. *French v. Carter, 53 O. G. 1572, C. D. 1890.

15. Where in the preparation for trial of several suits it was agreed by the parties thereto that testimony taken in either of the suits might be used in either of them, and where the complainant introduced a patent in rebuttal in explanation of the record in one of the cases, but it was not mentioned in the pleading of either party and no testimony was given in respect to it, such patent is not admissible under the general issue in the other of the suits as an anticipation of the patent sued upon, without an amendment of the pleadings setting it up. *Vermont Farm Machine Co. v. Gibson, 64 O. G. 300, C. D. 1893.

16. That a witness may be twice called is a circumstance touching his credibility alone, and not the competency of the evidence. A second deposition by a witness, therefore, cannot, as mere matter of law, be excluded from the consideration of the various tribunals. Jenkins v. Burke, 77 O. G. 973, C. D. 1897.

III. WEIGHING.

17. A court would not be warranted in rejecting the positive testimony of two respectable and unimpeached witnesses as to the fact of invention at a certain date upon the presumption that the same idea, alike even in mutual details, could not have occurred to two persons in different continents without one of the persons had known of the other device. *Bliss v. Merrill, 42 O. G. 97, C. D. 1888.

18. An *ex parte* test made by the defendant

and a defective test made by the complainant held to be entitled to no weight in evidence. *Ferneline Chemical Co. v. Carolina Oil and Creosote Co., 46 O. G. 974, C. D. 1889.

19. When a cross-examiner allows an ambiguous answer of the witness to go unexplained, the mere uncertainty in the witness' answer will not necessarily be construed against him. His testimony will be considered with reference to the probabilities and surrounding circumstances. Woodward v. Burton, 57 O. G. 1597, C. D. 1891.

20. Where parties to an interference flatly contradict each other upon a material point, the preponderance of evidence may be determined by reference to surrounding circumstances and the natural probabilities. Ligowsky v. Peters, v. Hisey, 57 O. G. 1593, C. D. 1891.

21. When the court takes the responsibility of branding as unworthy of belief the uncontradicted testimony of reputable witnesses, it should have some reason to advance for a course so unprecedented. *American Tubing and Webbing Co. v. Nicholls, 75 O. G. 183, C. D. 1896.

22. The negative opinion of a witness, however skilled or expert, that a drawing is meaningless of which he was not informed what the subject-matter was does not weigh greatly against the positive testimony of another witness who finds meaning in the same drawing, when the drawing itself appears naturally to support such meaning. All the testimony must be construed together and in such manner that, like charters and statutes, it may have meaning, if it reasonably may, rather than that it fall away. Scudder v. Mergenthaler, 76 O. G. 1851, C. D. 1896.

23. Numerous witnesses of unquestioned credibility concurring in one matter may nevertheless be mistaken, particularly upon the question whether what is shown them as they testify is the identical thing which they saw more than two years before. In such a case, in weighing the testimony, the circumstances must be taken into account, considering that that which is conformable to experience is more probable than that which runs counter to it. Johnston v. Stone, 77 O. G. 2137, C. D. 1896.

24. The inherent improbability of the story is sufficient to negative the testimony of witnesses. *Dodge v. Post & Co., 78 O. G. 339, C. D. 1897.

25. Evidential weight of alleged declarations of one contestant in favor of his opponent, in

a suit under Revised Statutes, section 4915, is much impaired by the fact that, though accessible, they were not introduced during the interference proceedings. *Standard Cartridge Co. v. Peters Cartridge Co., 78 O. G. 621, C. D. 1897.

26. Held, that the decided weight of the evidence supports the claim of the appellee, and that the decision of the commissioner of patents is correct and must be affirmed. *Roberts v. Brinkman, 79 O. G. 1190, C. D. 1897.

EXAMINATION OF APPLICATION.

(See AMENDMENT; CLAIMS; INTERFERENCE; PATENTABILITY; DIVISION OF APPLICATION.)

- I. IN GENERAL.
- II. INFORMATION AND ADVICE TO APPLICANTS.
- III. LIBERALITY IN ALLOWANCE OF CLAIM.
- IV. REJECTION.
- V. ACTIONS OTHER THAN REJECTION.

I. IN GENERAL.

1. Any opinion which the examiner of trademarks may express as to the propriety of covering matter by a mechanical application is purely *dictum* and cannot bind the examiner before whom the question of patentability comes in regular order. Ex parte Eiche, 41 MS. D. (1 G. W. D.), Oct., 1889 (Fisher, Ass't Com'r).

2. Where no references are found, no questions of form are to be antecedently insisted upon which are inconsistent with the allowance of the broadest claims to which the inventor of a new machine or art is entitled. Ex parte Ambler, 41 MS. D. (1 G. W. D.), Oct., 1889 (Mitchell, Com'r).

3. An application which is practically a division of another pending application will not be given precedence in order of examination because of applicant's intention to obtain foreign patents and because the time for payment of final fee on the parent application is about to expire. Ex parte Dickermann, 52 MS. D., Feb., 1893 (Frothingham, Ass't Com'r).

4. A requirement for new drawings waived until the result of action on the merits shall enable applicant to determine to what extent the application can be advantageously prosecuted. Ex parte Herzog, 60 MS. D., Sept., 1896 (Fisher, Acting Com'r).

5. Rule 63, section 3, giving preference in ex-

amination to applications for inventions patented abroad, applies to interference proceedings at every stage of their progress. *Bolt v. Burton, v. Gatchell*, 62 MS. D., Sept., 1897 (Greeley, Acting Com'r).

(It had been previously the custom not to apply the rule after formal declaration of an interference by the primary examiner.)

6. A petition taken from the action of the examiner rejecting claims on the ground of inoperativeness of the device and suggesting a model as a possible way in which the operative-ness might be established, although the structure of the apparatus was understood, was dismissed, holding that, the claims being rejected, the applicant may either show to the examiner that the apparatus is operative or appeal to the examiners-in-chief. *Ex parte Beach*, 80 O. G. 1476, C. D. 1897.

7. The commissioner should not be called upon to instruct an examiner as to how he should act upon an application or pass upon questions arising during the prosecution of a case until the case is properly before the commissioner by petition or appeal. It is the examiner's duty to act on applications as they come before him, using his best judgment in deciding any question that may arise in the consideration of the case. If exception is taken to his ruling, there is relief by petition or appeal. *Ex parte Sellers*, 81 O. G. 803, C. D. 1897.

8. An application will not be transferred from one division to another on the ground that it is not receiving proper treatment by the examiner in charge of it. Other relief will be applied when it is clear that an examiner is not performing his duties as he should. *Ex parte Weaver*, 81 O. G. 967, C. D. 1897.

9. While a claim deemed allowable by one examiner is always subject to rejection by his successor upon references or reasons not before considered, and it may be, in exceptional cases, on the references previously considered, the spirit of rule 144 would seem to indicate that the favorable action of an examiner should be at least extremely persuasive upon his successor. *Ex parte Nealon*, 81 O. G. 1787, C. D. 1897.

II. INFORMATION AND ADVICE TO APPLICANTS.

10. It is the duty of the examiner when he is satisfied that an application contains a patentable invention which is not claimed, but which he has reason to believe the applicant is seeking to cover, to advise the applicant briefly

and specifically in the premises, precisely as the examiners-in-chief and commissioner are authorized to make suggestions and recommendations. *Ex parte Donovan*, 44 O. G. 698, C. D. 1888.

11. Rules 68 and 139 provide that at all times in the investigation of an application and in the progress of appeals it is the duty of each tribunal to see to it that the inventor shall secure a patent for whatever patentable subject-matter may be shown in his application. The office must put itself in the attitude of a friend and not of a litigant with the applicant. *Id.*

12. It should never be a work of supererogation on the part of an examiner to give to an applicant such full and complete information as to objections as will enable him to judge of the propriety of complying with the demands of the examiner or of taking a petition or appeal. *Ex parte Burt*, 49 O. G. 1986, C. D. 1889.

13. When an applicant asks for advice, there is no reason why it should not ordinarily be given. Rule 14 makes an exception "as to questions arising within the office." *Ex parte Bailey*, 52 O. G. 608, C. D. 1890.

14. On petition that the references be explained and their pertinency pointed out as clearly and fully as would be done in the examiner's answer to appeal, should appeal be taken, *held*, that an applicant is entitled, before the case is closed before the examiner, to an explanation of the references and their bearing on the claims rejected, as full and clear as any explanation that would be considered necessary to be made at any subsequent stage in the progress of the case. *Ex parte Barnes*, 80 O. G. 2038, C. D. 1897.

(An attorney may properly ask information from an examiner, orally or in writing—say his opinions on points of interference—when it is done in good faith; but in the particular case, *held*, the counsel being experienced, it is unnecessary to instruct him in respect to the references (patents). *Ex parte Deacon, Fleming and Neimau*, 80 MS. D. 1836—Montgomery, Com'r.)

III. LIBERALITY IN ALLOWANCE OF CLAIM.

15. The patent office, in cases where the prior art admits of such a course, should grant to the applicant a claim or claims which will enable him to cover his invention, even when an infringer interchanges or reverses some of the elements, otherwise the invention made is inadequately protected. *Ex parte Tobie*, 50 O. G. 992, C. D. 1889.

16. In the case of patents which represent the infancy of an art or the stage of its earliest

practical development, this office is solicitous that the inventor should be accorded a breadth of claim which is commensurate with the extent and importance of the invention which he desires and is entitled to protect. While the office will insist upon as much definiteness in the language of the claim as the statute calls for, it will also, if it properly discharge its function as the protector of the inventor, leave something to the salutary and benignant agency of construction in the courts. *Ex parte Pacholder*, 51 O. G. 295, C. D. 1889.

17. There is a permissible latitude of choice in the use of language which may be safely accorded to the inventor or his solicitor without violating the statute, and without detriment to that branch of the public service which has for its object not only to grant letters patent for new inventions, but to grant them at the earliest possible date. *Id.*

18. When clear differences of construction between the device claimed and the references cited against it are such that a doubt is raised as to whether they constitute patentable invention, the applicant should have the benefit of it. *Ex parte Fanshawe*, 57 O. G. 1127, C. D. 1891.

19. An applicant will generally be allowed all possible latitude in framing his claim. *Ex parte Cahill*, 63 O. G. 1815, C. D. 1893.

20. There being no doubt as to lack of invention in this case, there is no room for the application of the doctrine which the appellant enunciates—that in cases of doubt of invention that doubt should be solved in favor of the applicant. *Ex parte Snider*, 66 O. G. 1309, C. D. 1894.

IV. REJECTION.

21. Claims rejected during the pendency of an application should be prosecuted under the regular course of appeal pending the issue of the patent, and not by a separate application on a so-called division after the issue of the patent. *Ex parte Ransom*, 40 O. G. 119, C. D. 1887.

22. An applicant has the right to present claims to combinations, and he cannot be deprived of those claims by the requirement for division. If there be no combination, but only aggregation, the claims must be rejected and the applicant allowed his right of appeal before division can be required. *Ex parte Willcox & Borton*, 45 O. G. 455, C. D. 1888.

23. Amendments which present claims involving a departure from the original inven-

tion should be admitted for consideration, and (under rule 133) rejected for such reason. *Ex parte Regan*, 45 O. G. 589, C. D. 1888.

24. The action of the examiner requiring a division before the question of combination was finally disposed of was irregular. The commissioner has repeatedly held that when a claim is presented which, in the opinion of the examiner, does not cover a patentable combination, the proper course for the examiner to pursue is to reject for such reason, in order that applicant may exercise his right of appeal to the examiners-in-chief. *Ex parte Bullard*, 45 O. G. 1569, C. D. 1888.

25. It is the province of claims to relegate to the specification the enumeration of such details of construction as shall be found upon examination to be immaterial to the true scope of the actual invention. The object of enumerating these parts is to enable persons skilled in the art to practice the invention in the form set out in the patent, but not to so limit the claim of the inventor as to make it the easy prey of the infringer. *Ex parte Laskey*, 48 O. G. 539, C. D. 1889.

26. The examiner should act with reference to all questions which may be raised in rejection of any or all of the claims, so that the case may go forward to the examiners-in-chief as a whole, and all matters relating to patentability may be determined by that tribunal in one proceeding. *Ex parte Burt*, 49 O. G. 1986, C. D. 1889.

27. An action by an examiner, which, if incorrect, would entitle the applicant to an appeal upon the merits, should consist in a full rejection, and not merely in noting that the claims are objectionable. *Ex parte Baker*, 49 O. G. 1363, C. D. 1889.

28. Where the examiner had objected to a claim because of its undue breadth only, and declined to further consider it upon the merits until it had been restricted in form, *held*, that the reason given was a reason why the claim should be rejected and not why an examination should be refused. *Ex parte Opdyke*, 50 O. G. 1293, C. D. 1890.

29. All grounds of rejection should be stated by the examiner, in order that the entire merits of the application may be determined upon a single appeal to the examiners-in-chief. *Ex parte Wiard*, 51 O. G. 155, C. D. 1890.

(See, also, *Ex parte Roberts*, same volume and page.)

30. An application having been rejected upon the ground that its claim described an

article of manufacture merely by the process of making it, which rejection was sustained by the examiners-in-chief and the commissioner, upon petition the application was remanded to the primary examiner for an examination upon the merits, so that if it should be desired to take an appeal to the supreme court of the District of Columbia the whole case might go up at one time, or so that the applicant might be fully advised of the state of the art before deciding whether to adopt a claim suggested by the examiners-in-chief or a suggestion made by the commissioner that the proper form of claim was a process. *Ex parte Rogers*, 52 O. G. 460, C. D. 1890.

31. Where claims are rejected they should be rejected for all the reasons which, in the opinion of the examiner, are applicable, in order that each case may, upon each appeal, take a decisive step forward toward completion. *Ex parte Bailey*, 52 O. G. 608, C. D. 1890.

32. A patent granted subsequently to applicant's filing date, but on an application filed prior thereto, which patent shows and describes, but does not claim, the invention, is a proper reference. *Ex parte Eddleblute*, 52 O. G. 751, C. D. 1890.

33. If the examiner is of the opinion that the proposed process claim, seasonably presented, covers new matter, he should incorporate the claim and reject it, in order that an appeal may be taken to the examiners-in-chief. *Ex parte Perkins*, 53 O. G. 139, C. D. 1891.

34. Where the claims of an application are rejected in whole or in part, it is the duty of the commissioner to notify the applicant in order to enable him, if he desires, to make his description and specification of claims more specific and precise. **Pullman Palace Car Co. v. Boston and Albany R. Co.*, 53 O. G. 1255, C. D. 1890.

35. The proper course to be pursued by an examiner on discovering a new ground for rejection subsequently to an appeal to the examiners-in-chief is to direct the attention to it of both the applicant and the examiners-in-chief. The applicant may then elect to continue the prosecution of the appeal or to withdraw the appeal and be heard by the primary examiner. *Ex parte Mevey*, 56 O. G. 805, C. D. 1891.

36. The action of the examiner requiring the elimination of claims because they presented illegitimate combinations overruled, and *held* that in such case the examiner is required by the rules to *reject* the claims. Applicant is

entitled to have his claims allowed, or to have them rejected in such language as to make it unmistakable that action has been had under Revised Statutes, section 4909. *Ex parte Wiard*, 57 O. G. 155, C. D. 1891.

37. The following practice is prescribed in the treatment of *ex parte* cases: 1. The first action (unless there are vital objections as to form) should state all the objections to every part of the application and the best references should be cited. 2. The application as a whole should not be rejected, but only the claims thereof. 3. Rejection should be in plain, unmistakable terms, and the word "reject" should be used. 4. Final rejection should not be given until all matters of form are settled. 5. Final rejection should not be given until all the non-allowable claims are in condition for such action. *Ex parte Eastman*, 57 O. G. 410, C. D. 1891.

38. If the examiner is of the opinion that there is a want of divisibility of invention between the claims of an application and the claims of a patent to the same applicant, both applications having been pending concurrently, he should *reject* the claims of the application for that reason. *Ex parte Feister*, 61 O. G. 152, C. D. 1892.

39. Rule 65 provides that when a case is rejected by an examiner "the reasons for such rejection will be fully and precisely stated, and such information and references will be given as may be useful in aiding the applicant to judge of the propriety of prosecuting his application or of altering his specification," and when an applicant receives an office letter stating objections to his application, and he, without demanding action under said rule, proceeds to ask for a reconsideration, which ultimately results in a second rejection, he has waived any right he may have had under the rule. *Ex parte Mahlecke*, 61 O. G. 285, C. D. 1892.

40. The question whether or not a claim for a so-called "process" is a claim for the function of a particular machine is one relating to the merits. The examiner's action in such a case should take the form of a *rejection*. *Ex parte Williams*, 61 O. G. 423, C. D. 1892.

41. A rejection for "lack of invention," *held*, in effect, a rejection for "want of novelty," and that the examiner must cite references under rule 66. *Ex parte Clifford*, 62 O. G. 316, C. D. 1893.

42. An examiner should not merely object to claims, but should make his objection the basis for rejection. *Ex parte Bishop*, 63 O. G. 153, C. D. 1893.

43. A claim containing words of limitation which are dependent upon the location or operation of mechanism that forms no part of the invention claimed and is neither shown nor described is objectionable. *Ex parte Baackes*, 63 O. G. 909, C. D. 1893.

44. Parenthetical clauses which do not contribute to clearness or exactness in stating the applicant's invention, but which at least are only superfluous, will not be allowed. *Ex parte Cahill*, 63 O. G. 1815, C. D. 1893.

45. Final rejection should not be given until all matters of form are settled. *Ex parte Klaus*, 64 O. G. 299, C. D. 1893.

46. A rejection may be given upon a patent granted to the same inventor upon an application which was pending concurrently with the application containing the rejected claim, and such rejection is, like all others, appealable to the examiners-in chief. *Ex parte Hulbert*, 66 O. G. 315, C. D. 1894.

(See, also, *Ex parte Feister*, 61 O. G. 152, C. D. 1892.)

47. The examiner decided the claims were met by the references, but the examiners-in-chief held there was no invention in the device. *Ex parte Fergusson*, 66 O. G. 651, C. D. 1894.

48. Complete anticipation is rare, and to reject a claim on the ground that it is substantially met by a reference is practically the same as to reject it on the ground of lack of invention in view of the reference, such differences as remain not involving invention. The two grounds of rejection, as applied to this case, are the same subject-matter of thought viewed from different points. *Id.*

49. Whether an amended claim can properly be finally rejected on the first action does not depend upon avoidance of the references, but whether, as a matter of language, the amended claim presents the same idea of invention as the old one. (*Ex parte Pfeiffer*, 66 O. G. 845; *Ex parte Griswold*, 50 O. G. 838.) *Ex parte Holland*, 62 MS. D., Aug., 1897 (*Greeley, Ass't Com'r*).

50. An examiner may always reject on new reasons or references a claim which his predecessor deemed allowable, or, in exceptional cases, upon a reference previously considered; but the favorable action of the former examiner should be at least extremely persuasive upon his successor. *Ex parte Nealon*, 62 MS. D., Oct., 1897 (*Greeley, Ass't Com'r*).

51. In this case the favorable view of the former examiner, and the fact that the appli-

cation has been twice in interference, are evidence of full and careful consideration and the claim should be allowed to remain. *Id.*

52. It is not necessary that a duly certified transcript record of a case in a federal court be filed in the patent office in order to render it competent for its tribunals to take notice of and be guided thereby. The officials of the patent office are not obliged to find their conclusions and judgments upon such evidence produced in such manner and form as is required by the rules of common law. They are not confined to merely technical evidence, but may resort to any source of intelligence upon which they can reasonably and safely act. The findings and judgment of a court as published in an official report are therefore competent to them, and were in this case ample ground for the rejection of claims. **Drawbaugh v. Seymour, Com'r of Patents*, 77 O. G. 313, C. D. 1897.

V. ACTIONS OTHER THAN REJECTIONS.

53. In an application for patent for "a mere improvement" the primary examiner may require applicant, in conformity to rule 36, to "broadly point out the parts to which it (the improvement) relates," and "by explicit language distinguish between what is old and what is claimed as new." *Ex parte Massicks and Crooke*, 38 O. G. 1489, C. D. 1887.

54. When an application contains claims both for genus and for several species, one of which latter claims imperfectly describes a feature clearly illustrated in the drawings, it is irregular on the part of the examiner to first require applicant to elect which of the species he will retain and prosecute. *Ex parte Johnston*, 40 O. G. 574, C. D. 1887.

55. The first proper action in such case is for the examiner to require applicant to amend such claim so as to disclose the subject-matter thereof more clearly. *Id.*

56. In examining an application there are two steps to be taken: *first*, to determine whether it is in proper form; *second*, the consideration of the merits. These steps are to be continuous and practically one, except where a *vital* objection as to form exists. In such a case the examiner will proceed no further, but clearly point out to applicant the objections, and inform him that no action on the merits can be taken until the informalities are removed. *Ex parte Mill*, 40 O. G. 918, C. D. 1887.

57. When the formal objections are not *vital*,

or when found to exist in certain claims only, while others may be free from objection, the examiner will proceed to consider the merits, and in his first letter clearly point out to applicant the formal objections, reject the one class of claims and allow the others, and further state that further action on the merits cannot be had until the formal objections are disposed of. By such course the applicant receives at the earliest moment full information as to the opinion of the office upon his application, and is enabled to act advisedly, and the examiners are saved multiplied examinations, the tendency to make examinations slightly is avoided, and the results generally are more satisfactory. *Id.*

58. The question of division would be a vital objection, or a claim for a combination where one of the elements was so vague and indistinct as to be incapable of examination on its merits, or where an important element was wholly lacking; but as to the dividing line between objections which are vital and those which are not, much must be left to the judgment and discretion of the examiner. *Id.*

59. The examiner may refuse to enter an amendment describing an alleged equivalent which constitutes new matter. *Ex parte Johnston*, 43 O. G. 507, C. D. 1888.

60. The office has no right to say that an element of a combination claim is not a part of the combination in advance of an action on the merits thereof. *Ex parte Connelly*, 59 O. G. 787, C. D. 1892.

61. The examiner's action in holding that no testimony as to the operativeness of an invention would be sufficient to warrant the withdrawal of the objection to the granting of a patent unless confirmed by personal inspection of the examiner or his deputized assistant, *held* not warranted by the rules. (Rule 76.) *Ex parte Munn & Co.*, 63 O. G. 153, C. D. 1893.

62. It is the settled practice of the office not to detail examiners to supervise and report upon tests of inventions outside of the city of Washington. *Id.*

63. While an exhaustive search cannot be made in advance of compliance with the requirement of division, the best reference which the examiner can furnish as the result of a cursory examination should be furnished, upon request, to assist the applicant in determining what course to pursue in view of the decision of the office that the application must be divided. Information readily accessible should

not be withheld which would enable the applicant to act wisely with reference to the requirement of division. *Ex parte Stearnes*, 50 O. G. 1768, C. D. 1890.

64. Objection to a drawing that an unnecessarily large variety of forms is shown should not be insisted upon when it appears that the several figures relate to and show modifications of the generic invention claimed. *Ex parte Nolan*, 79 O. G. 861, C. D. 1897.

65. The examiner's action in making formal requirements after the case had been decided by the examiners-in-chief and the commissioner on appeal was regular and in accordance with rule 25. *Id.*

FEES.

I. PAYMENT.

II. REFUNDMENT.

I. PAYMENT.

1. Where the original application had been stricken from the files because it appeared that the inventor had signed and sworn to it in blank, *held*, that the fee formerly paid upon said application could not be applied to a new application filed in place thereof. *Ex parte Ayres*, 51 O. G. 1944, C. D. 1890.

2. The fee on an application must be paid within two years from date of filing, to save an application from abandonment. *Ex parte Fenno*, 52 O. G. 1665, C. D. 1890.

3. The commissioner of patents has no authority to directly or indirectly extend the time for paying a final fee to a period later than six months from *that* allowance of the application which results from proceedings according to law in the office. *Ex parte Simonson*, 53 O. G. 1571, C. D. 1890.

4. *Held*, where one of two sub-treasury certificates had been held by the applicant nearly two years, and the other taken out on the last day of the six months, the certificate could not be received. *In re Wiegand*, 45 MS. D. (3 G. W. D.), Jan., 1891 (Mitchell, Com'r).

5. It is proper that a rule should be adopted requiring the prompt presentation of the evidences of payment of final fees, made in conformity with section 4935, Revised Statutes; but in view of the different practice that has been allowed to obtain, the public should have due notice of the adoption and enforcement of the new rule of practice. †*Ex parte Wiegand*, 56 O. G. 803, C. D. 1891.

6. If the final fee is not received by the office within the six-months period provided by statute, the application will be held to be forfeited, even though said fee was mailed before the six months had expired. *Ex parte Riley*, 56 O. G. 1203, C. D. 1891.

7. Handing twenty dollars to a watchman not employed by the patent office at 11:55 P. M. on the last day of the six-months limit is not a payment of a final fee to the office within the six months allowed by law. *Ex parte Poulter*, 57 O. G. 1128, C. D. 1891.

8. A final fee, which reached Washington on Thanksgiving day — the last day for paying it — when the patent office was closed, not accepted. *Ex parte Robertson*, 51 MS. D. (4 G. W. D.), Dec., 1892 (*Frothingham*, Ass't Com'r).

9. Section 4935, regulating the payment of patent fees, is specific in its terms, and limits the officers of the government authorized to receive such fees to those mentioned therein. †*Ex parte Poulter*, 58 O. G. 519, C. D. 1892.

10. That provision of section 4885 which requires the payment of a final fee within six months after its allowance is mandatory and leaves the commissioner no discretion to accept it after the expiration of such time. *Ex parte Anderson*, 61 O. G. 886, C. D. 1892.

11. No discretion is vested in the commissioner by virtue of the terms of section 4885 of the Revised Statutes to accept and apply a final fee received more than six months after notice of allowance sent to the applicant, even though the last day of the six months falls upon a national holiday. *Ex parte Mills*, 62 O. G. 317, C. D. 1893.

12. Under the practice of the patent office the time within which a final fee may be paid is six calendar months from the date of the notice of allowance. *Ex parte Brown*, 63 O. G. 759, C. D. 1893.

13. A patent regular on its face is not subject to collateral attack because the patent office fee was not paid within the time prescribed by the Revised Statutes of the United States, section 4897. **Lamprey Boiler Furnace Mouth Protector Co. v. Economy Feed Water Heater Co.*, 69 O. G. 509, C. D. 1894.

14. An appeal fee may be applied as final fee on an application when a reference has been found and cited which meets the claim appealed. *Ex parte Kratzer*, 59 MS. D., May, 1896 (*Fisher*, Ass't Com'r).

15. The six months in which to pay the final fee expired on a Sunday. The fee was mailed the day before, but not received in due time.

Application held forfeited. (*Ex parte Riley*, C. D. 1891, 136.) *Ex parte Barry*, 60 MS. D., Dec., 1896 (*Fisher*, Ass't Com'r).

II. REFUNDMENT.

16. A fee paid on a caveat for a design will be returned, since there is no law authorizing the filing of such a caveat. *Ex parte Carty*, 44 O. G. 570, C. D. 1888.

17. In a case where indistinctness of date of circular of allowance has misled an applicant, *held*, that no relief can be afforded him; the commissioner has no power to remit the office fee. *Ex parte Chumard*, 41 MS. D. (1 G. W. D.), Dec., 1889 (*Mitchell*, Com'r).

18. Where an application was filed to take the place of an application which had been stricken from the files because signed and sworn to in blank, *held*, that the fee paid on the first application could not be applied to the second application, as the case came within the principle laid down in *Ex parte Hogan*. *Ex parte Sereno N. Ayres*, 43 MS. D. (2 G. W. D.), May, 1890 (*Fisher*, Acting Com'r).

19. An appeal fee cannot be refunded after reversal of the examiner's decision on appeal, and after the examiner has again rejected the claim upon a newly-discovered reference and the claim has been canceled. *Ex parte Ellis & Spence*, 46 MS. D. (3 G. W. D.), May, 1891 (*Frothingham*, Ass't Com'r).

20. Where an applicant paid a second renewal fee on the very day that a decision was published to the effect that there was no authority in the statute for more than one renewal of an application for patent, *held*, that the fee was paid by mistake and that it should be returned. †*Ex parte Smith*, 71 O. G. 297, C. D. 1895.

21. Request after examination for the return of fee paid upon an application for a design upon the same day that a patent issued to the same inventor for the same design refused. †*Ex parte Flomerfelt*, 73 O. G. 1411, C. D. 1895.

22. Section 4885 of the Revised Statutes applies only to mechanical cases, and not to applications for designs. †*Id.*

23. A request for the return of an appeal fee where the appeal was not prosecuted denied, as the law establishes certain payments to be made upon filing certain papers, and this irrespective of whether the case is further prosecuted or not. *Ex parte Borton*, 77 O. G. 2137, C. D. 1896.

24. Where an appeal is regularly taken and the fee therefor paid, but thereafter the appellant changes his purpose and concludes not to prosecute the appeal, *held*, that there was no such mistake in the payment as would warrant the return of the appeal fee. †*In re Borton*, 81 O. G. 800, C. D. 1897.

25. Where a draft presented in payment of the fee in an application for patent is dishonored because of the failure of the bank by which it was issued, *held*, that it did not constitute payment of the fee. †*In re Nash*, 81 O. G. 799, C. D. 1897.

26. Such draft was not a compliance with rule 223, specifying the manner in which money shall be paid, since the money was never received by any officer of the United States. †*Id.*

27. An appeal fee should be returned in a case where the commissioner held (on petition) that appeal lay to the examiners-in-chief, and they dismissed it. *Ex parte Crowell*, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

FOREIGN PATENT.

(See ANTICIPATION — PATENTS AND PRINTED PUBLICATIONS; INTERFERENCE—PRIORITY, FOREIGN PATENTS.)

1. Where an earlier English provisional specification did not precisely anticipate the patent in suit, it may be used to show that no invention was required to make the simple alteration or addition which distinguishes it from the patent in suit. **McNab & Harlen Mfg. Co. v. Nathan Mfg. Co.*, 40 O. G. 1240, C. D. 1887.

2. An English patent is only effective from the date of its sealing as an anticipatory publication. **Bliss v. Merrill*, 42 O. G. 97, C. D. 1888.

3. The filing of a "provisional specification" in the English patent office secures to the applicant for the term of six months "provisional protection"—*i. e.*, during this period the invention may be used and published without prejudice to any letters patent to be granted for the same, but does not invest the applicant with any of the powers, rights or privileges of a patentee. **Emerson, Smith & Co. (Limited) v. Lippert*, 42 O. G. 964, C. D. 1888.

4. The filing of a complete specification not only protects the invention for six months, but during that period the applicant is clothed with the like powers, rights and privileges as if letters patent had already issued. **Id.*

5. Foreign patents containing limited claims

will not bar an applicant from securing in this country claims for a broader invention, provided he can maintain and substantiate them in an interference contest. *Faure v. Bradley and Crocker v. Cowles and Cowles*, 44 O. G. 945, C. D. 1888.

6. When an English patent, though dated as of November 1, 1870, was not sealed until April 2, 1871, *held*, that said English patent was not in fact issued until said latter date. **The Holmes Burglar Alarm Telegraph Co. v. The Domestic Telegraph and Telephone Co.*, 51 O. G. 2083, C. D. 1890.

7. An invention patented abroad was not patented under the British law prior to the patent amendment act of 1852, so as to operate as a bar to the grant of a patent or as a defense to a patent already granted, until the enrollment of the complete specification, and under that act and acts amendatory thereof prior to the act of 1883 the invention did not become patented until the filing of the complete specification. *De Ferranti v. Westinghouse*, 52 O. G. 457, C. D. 1890.

8. The fact that the specification of a British patent was accessible to public inspection on a certain date is immaterial, for it was not then a printed publication, and it certainly was not a patent. *Id.*

9. It cannot be contended that an invention was either patented or described in a printed publication by reason of the filing of the provisional British specification or the later filing of the complete specification. Under the British act of 1883 the filing of the complete specification is not accompanied by publication as was the case under the prior acts. *Id.*

10. It cannot be said that under the present law an invention is patented before the seal is finally attached. *Id.*

11. The Spanish law permits a patent for twenty years, but if a patent has been obtained in one or more foreign countries the term is for ten years only. **Accumulator Co. v. Julien Electric Co.*, 57 Fed. Rep. 605 (1893).

FORFEITED APPLICATION.

(See RENEWAL OF.)

FORMER DECISIONS AFFIRMED.

1. Commissioners' decisions in *Ex parte Demming*, C. D. 1884, 18, 26 O. G. 1207; *Ex parte Kerr*, *id.* 27, 28 O. G. 95; *Ex parte Holt*, *id.* 43,

29 O. G. 171; and *Ex parte Wilkin*, id. 71, 29 O. G. 950, approved. *Ex parte Paige*, 40 O. G. 807, C. D. 1887.

2. The decision of the United States court in the case of *Uhlmann v. Bartholomae & Leicht Brewing Co.* followed in holding that the patent granted to the senior party was a valid patent. *Zwietusch v. Stockheim*, 53 O. G. 755, C. D. 1890.

3. *Smith & Griggs Mfg. Co. v. Sprague and City of Elizabeth v. Pavement Co.* applied and explained. **Root v. Third Avenue R. Co.*, 46 O. G. 1393, C. D. 1889.

4. Previous decisions discussed and principles deduced. **Reece Button-Hole Machine Co. v. Globe Button-Hole Machine Co.*, 67 O. G. 1720, C. D. 1894.

INDUSTRIAL UNION.

(See INTERNATIONAL CONVENTION.)

INFRINGEMENT.

(See DAMAGES AND PROFIT; INJUNCTION; MARKING ARTICLES "PATENTED;" NEW TRIAL; PRACTICE IN THE COURTS; SUITS FOR INFRINGEMENT; TRADE-MARKS.)

I. IN GENERAL.

II. BURDEN OF PROOF.

III. CLAIMS FOR COMBINATION.

IV. CONTRIBUTORY.

V. BY COUNTIES AND CORPORATIONS.

VI. BY MANUFACTURE WITHOUT USE.

VII. MAKING AND SELLING.

VIII. PROCESS.

IX. SECRET USE.

X. STATE OF THE ART.

XI. PARTICULAR CASES.

I. IN GENERAL.

1. The assignment by a patentee of his interest in a patent does not prevent him from recovering for an infringement during the time he was owner of it. **May v. Saginaw Co.*, 32 Fed. Rep. 629 (1887).

2. There may be several judgments in respect to the same act of infringement, but there can only be one satisfaction. **Jennings v. Dolan*, 38 O. G. 1018, C. D. 1887.

3. Where an improvement is made and patented in a machine, the first patentee cannot use the improved machine without the consent of the second, and the second cannot use his ma-

chine without the consent of the first. **Royer v. Coupe*, 39 O. G. 239, C. D. 1887.

4. If the first patentee's machine is not operative and the second patentee's is operative, the first patentee must be confined to his own particular application of his principle, and there is no infringement by the second patentee. **Id.*

5. The patent held infringed by defendants' apparatus, although the latter differs somewhat in construction from that described in the patent. The fact that the main features in the patented apparatus—such as the circuit-breaker, single circuit, operating the gas-cock directly by the armature—are old should not limit the patentee to the exact form of mechanism found in the patent. **Boston Electric Co. v. Fuller*, 39 O. G. 710, C. D. 1887.

6. An infringement results when defendant employs the equivalents of the elements of the combination claims of the patent in suit for substantially the same purposes and with substantially the same result. **Barnes v. Ruthenburg*, 40 O. G. 693, C. D. 1887.

7. The use of a device doing the same work in substantially the same way and accomplishing substantially the same result as another patented device is an infringement of the patent. **Shaver v. Skinner Mfg. Co.*, 41 O. G. 232, C. D. 1887.

8. An improvement including a patented device or combination infringes the patent. **Id.*

9. Where the supposed infringing machine was for the same purpose as complainant's patented machine and produced the same result in operation but by different means from those claimed in the patent in suit there was no infringement. **Dryfoos v. Wiese*, 42 O. G. 490, C. D. 1888.

10. A claim is not avoided because the specification does not describe details of construction in elements of the claims well known in the particular art and employed only by the defendant. **Thompson v. Gildersleeve*, 43 O. G. 886, C. D. 1888.

11. The infringement of a patent is in the nature of a trespass upon the exclusive rights of the owner of the patent secured by it, for which an action would lie at common law. The action would be an action on the case as for a tort, in which all who participate are principals, and for which they are jointly and severally liable for the whole. **Babcock & Wilcox Co. v. Pioneer Iron Works*, 43 O. G. 756, C. D. 1888.

12. The mere change in form or an alteration in unessential parts, or the use of known

equivalent powers not varying essentially the machine or its mode of operation or organization, will not avail to avoid infringement.

*The Butz Thermo-Electric Regulator Co. v. Jacobs Electric Co., 45 O. G. 833, C. D. 1888.

13. Where an invention is one of a primary character and the mechanical functions performed by the machines are as a whole entirely new, all subsequent machines which employ the same means to accomplish the same results are infringements, although the subsequent machines may contain improvements in the separate mechanisms which go to make up the machine. *Morley Sewing Machine Co. v. Lancaster, 47 O. G. 267, C. D. 1889.

14. To justify a decree for infringement actual proof must be presented of the defendant's illegal acts. It will not do to substitute therefor suspicion and conjecture. *Winne v. Bedell, 49 O. G. 2152, C. D. 1889.

15. Where defendants in their apparatus used an instrument which was recognized in the art as an equivalent of certain devices shown in the patent, the fact that said instrument is made to perform an additional function in the defendants' apparatus will not relieve them from the charge of infringement so long as all the elements of the complainants' patent are embraced in their system. *The Holmes Burglar Alarm Telegraph Co. v. The Domestic Telegraph and Telephone Co., 51 O. G. 2083, C. D. 1890.

16. Where in a suit for infringement it appeared that an interference had been declared between the claims of the patent in suit alleged to have been infringed and a prior and still pending application for patent, and that in said interference proceeding priority of invention was awarded in favor of the applicant as against plaintiff's assignor, and that under the proofs before the court such an award was indisputable, *held*, that said application was competent evidence upon the issue whether the plaintiff's assignor was the original and first inventor of the thing alleged to be within the claims of the patent in suit. *Westinghouse, Jr. v. The Chartiers Valley Gas Co., 53 O. G. 599, C. D. 1890.

17. Where in a suit for infringement it appeared that plaintiff was not manufacturing and had not manufactured or sold any machines under the patent in suit, but manufactured a machine made under an earlier patent and seemed to be using the latter patent merely to keep other manufacturers out of the market, *held* that, whatever its technical right to

make use of the patent might be, its conduct evidently deprived the public of whatever advantage the patent in suit possessed, contrary to the true policy of the patent laws. *American Roll Paper Co. v. Knopp, 54 O. G. 139, C. D. 1891.

18. A foundation patent is infringed by a machine in which each of the mechanisms performs the same function as the corresponding mechanism in the patented machine in substantially the same way and with substantially the same result, even though there are differences in form and structure tending to simplicity and perhaps improvement. *National Typographic Co. v. New York Typograph Co., 56 O. G. 661, C. D. 1891.

19. The defendants were not bound to inquire whether their purchasers were licensed by the plaintiff to use the invention, and having done no wrong themselves they are not answerable for the unlawful acts of others. *Lane & Park, 59 O. G. 788, C. D. 1892.

20. An infringement takes place whenever a party avails himself of the invention of the patentee without such a variation as constitutes a new discovery. *Norton v. Jensen, 60 O. G. 1326, C. D. 1892.

21. Where there is a difference between the construction of a patent and the construction used by the defendant, it is evidence of non-infringement where the device of the defendant does not accomplish the results of the patent. *Simpkins v. Perry Pie Co., 64 O. G. 859, C. D. 1893.

22. The patent is upon the device and not upon the functions, real or supposed, and if the device is appropriated in its essential features it will be an infringement notwithstanding some change in the location or relation of parts whereby a doubtful function of little comparative worth is eliminated. *Western Electric Co. v. Sperry Electric Co., 65 O. G. 597, C. D. 1893.

23. Although the defendants' improvement be an invented addition to the device in the complainant's patent and patentable as an independent invention, yet a patent for the improvement does not carry with it the right to use the complainant's invention. *American Bell Telephone Co. v. Brown Telephone and Telegraph Co., 65 O. G. 894, C. D. 1893.

24. Where the essential operations of two devices are wholly different, *held*, that there is no equity in charging infringement upon a defendant who apparently accidentally adopts in the practice of his invention an immaterial

feature of the plaintiff's patent, which feature is of no value to the alleged infringing device and an alleged advantage to the patentee never contemplated by him nor alluded to in his specification. *Ball and Socket Fastener Co. v. Kraetzer, 65 O. G. 1501, C. D. 1893.

25. Where the specific device described in and covered by the patent sued on could not be used in the defendant's combination, nor his device be used in the machine in the patent, this interchangeability or non-interchangeability is an important test in the question of infringement. (Prouty v. Ruggles, 16 Pet. 336; Brooks v. Fiske, 15 How. 212; Eames v. Godfrey, 1 Wall. 570.) *Miller v. Eagle Mfg. Co., 66 O. G. 845, C. D. 1893.

26. Where the identity of the device sued on and the infringing device is admitted they cannot be patentably distinguished by a suggested distinction in the purposes to which they are respectively applied. (Knapp v. Morss, 65 O. G. 1503, 150 U. S. 221.) *Wollensak v. Sargent & Co., 66 O. G. 1007, C. D. 1893.

27. Claim 20 is not invalid because inoperative for want of additional elements. The appropriate means for rendering the combination operative will be understood in any such case. This claim is valid and infringed. *Deering v. Winona Harvester Works, 69 O. G. 1641, C. D. 1894.

28. The use of an infringing device is not justified by the fact that defendant had previously attempted to use one made under complainant's patent, which proved to be useless. *Masseth v. Johnston, 67 O. G. 143, C. D. 1894.

29. The refusal of a patentee to furnish his device, when requested, does not justify the use of an infringing article. *Masseth v. Reiber, 67 O. G. 143, C. D. 1894.

30. The fact that a person has made an improvement on a patented machine does not give him the right to use such machine with his improvement nor absolve such use from being an infringement of it. *Traver v. Brown, 69 O. G. 1071, C. D. 1894.

31. A process patent, when involving a combination of different elements, is similar to a patent for a combination of mechanical devices. No infringement can be sustained unless every one of the constituent elements is employed. (Cases cited.) *Kennedy v. Solar Refining Co., 69 Fed. Rep. 715 (1895).

32. The infringement of a patented art or process consists only in the performance of all the acts of which it is composed, or their equivalents, in the manner and in the order in

which they are claimed in the patent. (3 Rob. Pat., sec. 925.) *Id.

33. One who purchases a patented machine from an infringer and operates it unlawfully for a term of years cannot acquire a right to its use because the vendor and owner of the patent subsequently enter into partnership, and the owner is not estopped from charging infringement when no act calculated to deceive or mislead the defendant can be shown. *Thomson-Houston Electric Co. v. Elmira and Horseheads Ry. Co., 74 O. G. 144, C. D. 1896.

34. A device is none the less an infringement because it contains an improvement upon the patented invention. *Robbins v. Dueber Watch Case Mfg. Co., 74 O. G. 965, C. D. 1896.

35. An inventor of a machine consisting of a new combination of old elements, which is shown by experiment to be valueless and impracticable for the purpose intended, cannot, after obtaining a patent therefor, abandon his specifically-described novel invention and substitute as a mechanical equivalent the methods of old machines which he claimed to have improved upon, and sue as infringers persons who employed the old device in the old way. *Carter Machine Co. v. P. H. Hanes & Co., 74 O. G. 1277, C. D. 1896.

36. Mere change of proportion is not sufficient to avoid a charge of infringement, and is not, therefore, sufficient to establish difference of invention. *Thomson-Houston Electric Co. v. Western Electric Co., 75 O. G. 347, C. D. 1896.

37. A contention that defendants' device being patented is *prima facie* proof that it does not infringe complainant's patent, and that therefore it is not competent for the court upon inspection of the patents alone to adjudge infringement, might be sustained in some cases; but it cannot be in this one, where the patent set up by defendants is manifestly for an alleged improvement upon complainant's invention, the use of which it necessarily involves. *Hardwick v. Masland, 75 O. G. 350, C. D. 1896.

38. A trespasser cannot acquire a legal right to the continuance in his wrongful acts without affirmative proof of some such act or omission to act on the part of him whose property rights are invaded as would make it inequitable to assert such rights. The inequity of permitting the enforcement of such claim is founded on knowledge of an opportunity to enforce rights on the one hand, and on changes in the conditions or relations of the adverse

party on the other. *Imperial Chemical Mfg. Co. v. Stein, 75 O. G. 1551, C. D. 1896.

39. A claim which includes "means . . . for automatically opening and retaining" is not infringed by a device which has means for performing but one of these functions. *Gould Coupler Co. v. Trogan Car Coupler Co., 75 O. G. 2009, C. D. 1896.

40. A construction which might perform the functions of a complainant's device to some extent, but which lacks a communication between two parts substantially as described in complainant's specification, does not infringe a claim in which such communication is claimed "substantially as described." *Scarborough v. Neff, 76 O. G. 475, C. D. 1896.

41. The court is not prepared, in view of authorities, to sanction the proposition that the infringer of a patent may escape liability by showing that the legal owner is engaged in a supposed unlawful combination or trust. *National Harrow Co. v. Quick, 76 O. G. 1574, C. D. 1896.

42. In determining the question of rights intervening after the grant of a patent and before an application for a re-issue, the office does not decide whether any of the claims of the original patent are infringed. The question of infringement is not involved. *Loewer v. Ross*, 76 O. G. 1711, C. D. 1896.

43. A mere transposition or reversal of parts is not a material departure from a patented invention and will not avoid a charge of infringement. *Société Anonyme Usine J. Cléret v. Reh fuss, 76 O. G. 336, C. D. 1896.

44. The fact that the infringing part is capable of a lawful as well as an unlawful use, by way of reparation or restoration of a patented device, does not raise the presumption that the lawful use is the one for which it is alone intended. *Thomson-Houston Electric Co. v. Kelsey Electric Railway Specialty Co., 76 O. G. 609, C. D. 1896.

45. Mere differences in form are not sufficient to avoid infringement. *Taylor v. Sawyer Spindle Co., 77 O. G. 452, C. D. 1896.

46. A series of guesses will not suffice to inculpate a defendant. Neither will the fact that he received a bid for alleged infringing devices in behalf of another party, in the absence of any threat on his part and in the absence of any showing of profit resulting to him, render him liable. *Edison Electric Light Co. v. Kaelber, 77 O. G. 1430, C. D. 1896.

47. Every patent for a composition must identify the composition by certain character-

istics or tests, and it is sound law and reasonable common sense to hold that the tests of prime importance in a suit for infringement are those which the patent itself sets up. *Matheson v. Campbell, 79 O. G. 686, C. D. 1897.

48. Mere reversal or immaterial change of parts will not avoid a charge of infringement. (*Cleret v. Reh fuss*, 76 O. G. 336, 75 Fed. Rep. 657; *Devlin v. Paynter*, 69 O. G. 1365, 64 Fed. Rep. 390.) *Edward Miller & Co. v. Meriden Bronze Co., 79 O. G. 1520, C. D. 1897.

49. The fact that a defendant was using an article four or six months before a patent on the article issued and the further fact that the defendant did not respond to a notice advising him of the issue of the patent is not sufficient to prove infringement or an intent to infringe. *Brill v. St. Louis Car Co., 79 O. G. 2017, C. D. 1897.

50. The Bowers patent has broad, generic claims, and all subsequent machines which employ substantially the same means to accomplish the same result are infringements, notwithstanding the subsequent machine may contain improvements in separate mechanism which go to make up the machine. *Von Schmidt v. Bowers, 80 O. G. 347, C. D. 1897.

51. The fact that the first machine built by a patentee whose patent is sued on was not successful in operation is unimportant and no reason for denying him relief, especially where his subsequent machines have proved successful in practice. *Id.

52. A patent owner who is suing an importer for infringement by the importation of infringing goods which have been detained by the customs officials and libeled for forfeiture because of fraudulent undervaluation may, for the protection of his interests, be permitted to intervene in the forfeiture proceedings on giving proper security. *United States v. One Case Chemical Compound (two cases), *In re Société Fabriques de Produits Chimiques de Thaun et de Mulhouse* (two cases), 81 O. G. 804, C. D. 1897.

II. BURDEN OF PROOF.

53. The burden of proof upon the issue of infringement is not satisfied merely by showing a state of facts from which infringement may be conjectured. *Morgan Envelope Co. v. The Albany Perforated Wrapping Paper Co., 60 O. G. 303, C. D. 1890.

54. The burden of proving an infringement rests on complainant, and it is not enough to show that defendant's furnace ought theoret-

ically to perform the functions covered by the patent sued upon; but the facts must be shown. *Siemens v. Chambers & M'Kee Glass Co., 62 O. G. 1351, C. D. 1893.

55. It is not presumptive evidence of infringement when a defendant offers no proof in support of his answer of intention not to infringe. The burden of showing infringement rests on complainant, and the law and well-settled practice forbids this burden being shifted upon the defendant. *Brill v. St. Louis Car Co., 79 O. G. 2017, C. D. 1897.

56. In a suit for infringement of a process and product patent covering a composition or chemical product, the complainant has sustained the burden of proof resting on him as to infringement when he shows that defendant's product corresponds to the tests of identity, and the burden is then upon defendant to show that it was not made by the patented process. *Matheson v. Campbell, 79 O. G. 684, C. D. 1897.

III. CLAIMS FOR COMBINATION.

57. A patent for a combination is not infringed by the use of less than the entire number of elements claimed. *Royer v. Schultz Belting Co., 38 O. G. 898, C. D. 1887.

58. The doctrine that a party may be held liable as an infringer solely because an article sold by him might be used by the purchaser as one element of a patented combination would be too dangerous to be upheld. *Snyder v. Bunnell, 38 O. G. 1130, C. D. 1887.

59. Where all the parts claimed, with one exception, were old and had been used in a similar combination in other things of the same general character, the defendant not using the excepted part escapes infringement. *Bragg v. Fitch, 39 O. G. 829, C. D. 1887.

60. When the patent in suit is the first in its particular field of invention, its claim is infringed by a combination which employs well-known mechanical equivalents to accomplish the results which follow from the combination claimed in the patent. *Tarrant v. Duluth Lumber Co., 39 O. G. 1425, C. D. 1887.

61. When defendants' machine did not have elements which could be successfully employed in the combination claimed in the patent, there was no infringement. *Gray v. Bangs, 40 O. G. 812, C. D. 1887.

62. The defendant using that part of the construction which produced the principal effect of the combination in the claim of complainants' patent, although dispensing with

other parts of such combination, infringed such claim. *Thompson v. American Bank Note Co., 45 O. G. 347, C. D. 1888.

63. Applying the rule that, where none of the elements of a combination are new or are claimed separately and there are other similar kindred combinations in use, the patentee is limited to the particular form of the various elements composing the combination shown by his drawings to Letters Patent No. 304,195, granted August 26, 1884, to Herman Heine, for purifiers for the feed-water of steam-boilers, the patent is not infringed by a device differing essentially therefrom in construction. *Heine Safety Boiler Co. v. Smith Feed Water Heater and Purifier Co., 47 O. G. 1634, C. D. 1889.

64. When the same thing is used in a series this should be considered as one entire thing and not a mere combination, and therefore the appropriation of any one of these things is an infringement of the whole. *Morrison v. The Canton Surgical and Dental Chair Co., 49 O. G. 733, C. D. 1889.

65. Where the patentee had described a device of a certain shape and a use to which it might be put, but did not claim it in that shape, either singly or in combination, *held* he could not maintain infringement against one who sold the device in that particular form only and who had not adopted the combination of the claim. *Winne v. Bedell, 49 O. G. 2150, C. D. 1889.

66. A party who uses a patented combination cannot escape the consequences of infringement by showing that he uses something in addition to the combination. *Williames v. Barnard, 41 Fed. Rep. 358 (1890).

67. To defeat a patent for a combination it is not enough to show that all the elements of the combination, separately considered, were old at the date of the invention. *Alaska Refrigerator Co. v. Wisconsin Refrigerator Co., 51 O. G. 125, C. D. 1891.

68. There cannot be any infringement of a combination claim unless every element of the combination or a mechanical equivalent of an omitted element is used. *Norton v. Jensen, 69 O. G. 1326, C. D. 1892.

69. The principle that "a combination is an entirety, and if one of the elements is given up the thing claimed disappears," prevails (*Vance v. Campbell*, 1 Black, 427), even where the patentee has claimed more than is necessary to the successful working of his device (*McClain v. Ortmyer*, 141 U. S. 419). *Vincent v. Rigby, 58 Fed. Rep. 371 (1893).

71. Where a patent shows and describes a duplicate construction, but contains no description of the manner in which one of the members of the construction can be used, and the defendant is using one member only, the bill will be dismissed. *Pacific Cable Ry. Co. v. Butte City Street Ry. Co., 66 O. G. 1758, C. D. 1894.

72. To constitute infringement of a combination the alleged infringing device must include every element of the combination as claimed. The fact that the omitted element is not of the essence of the invention is immaterial. *Kinzel v. Luttrell Brick Co., 72 O. G. 900, C. D. 1895.

73. A machine is a concrete thing, being an entirety of co-operating elements and agencies. When it consists of a combination of old elements and devices, the leaving out of one of the essential elements of the combination destroys the identity of the combination, and a person cannot be sued as an infringer who uses a machine in which a material part of the combination patent is omitted. *Id.

74. Where a patent is for a combination, to support a charge of infringement it must be shown that the infringer has used substantially the same combination, including every one of the elements thereof, or a mechanical equivalent for any one that has been omitted. *Erie Rubber Co. v. American Dunlop Tire Co., 74 O. G. 1443, C. D. 1896.

75. The omission of a part whose presence or absence does not affect, essentially, the mode of operation nor determine whether a particular apparatus exemplifies one patent or the other is of no significance. *Thomson-Houston Electric Co. v. Western Electric Co., 75 O. G. 347, C. D. 1896.

76. It is a rule of universal application in construing "combination" claims that the omission in an alleged infringing device of one element of the combination embodied in any claim will repel the charge of infringement based on that claim. *Engle Sanitary and Cremation Co. v. City of Elwood, 75 O. G. 1713, C. D. 1896.

77. Combination patent held infringed by a device using but one element of the combination. *American Graphophone Co. v. Amet, 74 Fed. Rep. 789 (1896).

(The claim in this case was substantially for the combination, with a sound record formed in wax, of a reproducer having a rubbing style for receiving sonorous vibrations from said record.)

78. Separate sale of such element by the patentee does not release it from the patent. *Id.

IV. CONTRIBUTORY.

79. Where one makes and others sell infringing articles they are liable jointly and severally. *Jennings v. Dolan, 38 O. G. 1018, C. D. 1887.

80. Where a person makes and puts on the market an article which of necessity and to the knowledge of such person is to be used for the purpose of infringing a patent, such person will be held liable under the doctrine of contributory infringement. *Snyder v. Bunnell, 38 O. G. 1130, C. D. 1887.

81. In order to hold a party liable under the doctrine of contributory infringement, there must be proof that what he did was for the purpose and with the intent of aiding infringement. (Saxe v. Hammond, 1 Holmes. 456.) *Id.

82. The claims cover a window-screen frame made up of side pieces or bars having several specified features of construction. While it may not be an infringement to make these bars, defendants will be liable as infringers if they manufacture them with the intent that they shall be put together in the form of window-screens. (Walker, Pat., sec. 407.) *Stearns v. Phillips, 43 Fed. Rep. 792 (1890).

83. The sale of an element of a combination segregated from the whole combination does not break the patentability of the combination. *American Graphophone Co. v. Amet, 76 O. G. 1273, C. D. 1896. Also 74 Fed. Rep. 789 (1896).

84. Claims 6, 7, 8, 12 and 16 of Letters Patent No. 495,443, granted April 11, 1893, to the administrators of Charles J. Van Depoele, for a traveling contact for electric railways, which cover the combination consisting generally of an electric railway having an overhead conductor and a car for said railway provided with a "trolley-stand" carrying a trailing arm which is pressed into engagement with the under side of the conductor, are not contributory infringed by defendant who makes and sells only the "trolley-stand" of the combination. *Thomson-Houston Electric Co. v. Kelsey Electric Railway Specialty Co., 76 O. G. 2008, C. D. 1896.

85. Where a patent covers the combination of a draw-head, a knuckle, a pivot-pin and a locking-pin, it is not infringed by a defendant who furnishes the knuckles to replace broken ones. *Shickle, Harrison & Howard Iron Co. v. St. Louis Car Coupler Co., 77 O. G. 2142, C. D. 1896.

86. Defendants who aid and abet infringement by intentionally and maliciously persuad-

ing and inducing the licensees of machines to exceed their licenses, and who furnish them with the means for such infringement, are themselves infringers and liable as tort-feasors. The knowledge that the articles made and sold by defendants are to be used for infringing, coupled with an active intent that they shall be so used, constitutes contributory infringement. *Heaton Peninsular Button Fastener Co. v. Eureka Specialty Co., 78 O. G. 171, C. D. 1897.

87. The principle governing infringement of combination patents, by furnishing a necessary element in the combination with the intent that it be used to effect infringement, is applicable to a case where one sells an unpatented article with the knowledge and intent that it will be used to effect infringement by enabling a licensee to violate the conditions of his license. *Id.

88. When complainant insists in his patent that one of the essentials to his device is a certain connection with which the defendant may dispense, and which at best he uses not as essential to its construction, but as a mere convenience to its operation, *held*, that infringement is not shown. *Edward Miller & Co. v. Meriden Bronze Co., 79 O. G. 1520, C. D. 1897.

89. Where one makes and sells one element of a combination covered by a patent, with the intention and for the purpose of bringing about its use in such a combination, he is guilty of contributory infringement and is equally liable to the patentee with him who in fact organizes the complete combination. *Thomson-Houston Electric Co. v. Ohio Brass Co., 80 O. G. 654, C. D. 1897. Also 80 Fed. Rep. 712 (1897).

90. Where a party makes a device which is adapted to be used only in a patented combination and is offering said device for sale to the public, he is legally presumed to intend the natural consequences of his act, and it is therefore *held* that he intended that the device made should be used in the patented combination, and an injunction will be granted. *Id.

91. Many of the most valuable patents are combinations of non-patentable elements, and the only effective mode of preventing infringement is by suits against those who, by furnishing the parts which distinguish the combination, make it possible for others to assemble and use the combination, and who by advertisement of the sale of such parts and otherwise

intentionally solicit and promote such invasions of the patentee's rights. *Id.

92. A party may furnish parts for repairing and renewing a patented combination; but when he does so he must ascertain, if he would escape liability for infringement, that the one buying and using them for this purpose has a license, express or implied, to do so. *Id.

(The leading case on this subject is Wallace v. Holmes, 9 Blatchf. 65, 29 Fed. Rep. 79.)

V. BY COUNTIES AND CORPORATIONS.

93. A suit brought against a county for infringement of a patent, or for damages after the expiration of a patent, may be maintained. *May v. County of Ralls, 40 O. G. 575, C. D. 1887.

94. A contract for building a county jail provided for a patent lock device, which was put in by the contractor or a subcontractor, but without authority from the owner of the patent. In less than two years after the county took possession of the jail the patent expired, and in the meantime the lock device was not used. The county authorities knew nothing of the contractor having put in the lock without authority from the patentee. *Held*, that the county was not liable in tort for infringement of the patent. *May v. Juneau Co., 41 O. G. 578, C. D. 1887.

95. Counties are liable for infringements of patents. Jacobs v. Hamilton Co. (1 Bond, 500) disapproved. *May v. Logan Co., 41 O. G. 1387, C. D. 1887.

96. Where the council of Portland authorizes a contractor to lay a sewer in one of its streets in pursuance of a power contained in its act of incorporation, and in so doing the contractor infringes upon the patent of another for making sewer-pipe, the act being a corporate one for the benefit of the corporation, it is liable for such infringement the same as a private corporation or person. *Asbestine Tiling and Mfg. Co. v. Hepp, 49 O. G. 413, C. D. 1889.

VI. BY MANUFACTURE WITHOUT USE.

97. It constitutes an infringement to manufacture for the purpose of use, even if not actually used. *The Butz Thermo-Electric Regulator Co. v. Jacobs Electric Co., 45 O. G. 833, C. D. 1888.

VII. MAKING AND SELLING.

98. It is no justification for such sales to allege that the patentees have violated their license contract with the vendor. *Willis v. McCollin, 38 O. G. 1017, C. D. 1887.

99. The claim being for a composition of matter or dry mixture, *held* not infringed by the sale of one of the materials forming part of the mixture, the use of both materials forming the mixture being old in the art. *Geis v. Kimber, 44 O. G. 108, C. D. 1888.

100. The mere fact that a person sells an article to which a patented device may be attached does not make him an infringer, provided the article is not so constructed that the patented device and no other can be used with it. *Bliss v. Merrill, 42 O. G. 97, C. D. 1888.

101. Where the article produced is perishable in its nature, which it is the object of the apparatus to deliver, and which must be renewed periodically, whenever the apparatus is used, and where the article so produced is not patented, *held*, that there is no infringement of the combination by the making and sale of the article. *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co., 67 O. G. 271, C. D. 1894.

102. The fact that a defendant made and sold a patented article before the patent issued does not prove or tend to prove infringement. *Brill v. St. Louis Car Co., 79 O. G. 2017, C. D. 1897.

VIII. PROCESS.

103. It does not follow that processes are different because the various steps do not succeed each other in precisely the same order, and an infringement is not thereby avoided. *Hammerschlag Mfg. Co. v. Bancroft, 40 O. G. 1339, C. D. 1887.

104. When a patentee emphasizes in his specification and makes a part of the claim allowed by the patent office a particular step in a particular process, which step in the process the defendant does not use, it is not allowable for him to disregard that step or to contend that it is not essential. *Van Camp v. The Maryland Pavement Co., 43 O. G. 884, C. D. 1888.

105. Even in a good claim for a composition of matter which is not described otherwise than by the process of making it, nothing can be in infringement which is not made by the process described. *Id.

106. The omission of a step of a process claimed averts the charge of infringement. *Id.

107. A person who subsequently discovers a new mode of carrying out a patented process is not entitled to use the process without the consent of the patentee. *Morley Sewing Machine Co. v. Lancaster, 47 O. G. 267, C. D. 1889.

108. The discoverer of a process is only required to point out one practicable method of using his process and may claim tribute from all who thereafter use the process, whether with his apparatus or with a different or improved means. *McCormick Harvesting Machine Co. v. C. Aultman & Co., 73 O. G. 1999, C. D. 1895.

109. Process claims of a patent in which one specific step of the process is described as affected by means of a particular device and in which there is no suggestion that such means could be dispensed with, even when the step referred to is stated in broad terms, are not infringed by a process which employs some other means. *Philadelphia Creamery Supply Co. (Limited) v. Davis and Rankin Building and Mfg. Co., 79 O. G. 1194, C. D. 1897.

IX. SECRET USE.

110. In a suit for an alleged infringement conducted secretly in a manufactory, reliable evidence tending to show such infringement must be produced. The plaintiff cannot depend upon the chance of obtaining evidence to support the charge from the defendant and his workmen or from an inspection of his machinery. *Dobson v. Graham, 48 O. G. 976, C. D. 1889.

111. Defendant's business is conducted in private. By contract and in equity his workmen are bound to secrecy. They have not been permitted to answer questions when it would tend to describe peculiarities of defendant's machinery, and the court cannot properly compel them to go further, nor compel defendant to submit his machinery to inspection, in absence of a showing of positive knowledge that he infringes. *Dobson v. Graham, 49 Fed. Rep. 17 (1889).

112. Order to inspect premises of respondent where a process infringing a patent was alleged to be in use, granted on terms. *Maryland Hominy and Ceralline Co. v. Dorr, 55 O. G. 1143, C. D. 1891.

113. The defendants concealed their machines so that the complainant could not make satisfactory proof of infringement. Complainant thereupon called one of the directors of the defendant corporation and proved by him

that the defendants' machines contained the elements mentioned in certain claims of complainant's patents, and then moved the court for an order requiring the defendants to produce drawings or a model of said machines or to permit complainant's experts to visit their shops and make such drawings from the machines. *Held*, first, that although such order should not be granted upon mere suspicion or allegation of infringement, yet here, as the complainant had shown probable cause for believing that infringement was going on, the order should be granted; second, that the fact that an application for a patent on one of the defendants' machines was pending was no ground for denying the order, the rule of secrecy in the patent office having no application to investigations of causes by the courts; third, rule entered for the defendants to produce drawings of the alleged infringing machines upon payment of the cost thereof by the complainant. *Diamond Match Co. v. Oshkosh Match Works, 69 O. G. 1508, C. D. 1894.

X. STATE OF THE ART.

114. Where an infringer has attempted to avoid the patent by the use of a well-recognized mechanical equivalent, the court is bound to look to the state of the art at the time the patent was applied for to determine the limitations of the claim. *Rodebaugh v. Jackson, 47 O. G. 1758, C. D. 1889.

115. Where an invention is of a primary character and stands at the head of an art, it is entitled to a liberal construction of its claims, and all persons who make devices or machines operating on the same principle and performing the same function by analogous means or equivalent combinations, even though the machine may be an improvement of the original and patentable as such, are to be treated as infringers. *Norton v. Jensen, 60 O. G. 1326, C. D. 1892.

116. Where a device covered by a patent granted two and one-half years after the date of the patent in suit was invented before that of the earlier patentee, and such earlier patentee had full knowledge of it before he made his alleged invention, *held*, that the device covered by the later patent should be considered as part of the art as it existed at the date of the earlier patent. *Duer v. Corbin Cabinet Lock Co., 63 O. G. 1060, C. D. 1893.

117. "The distinction suggested by the circuit court between inventions employing

cranks and levers visible to the senses and those employing compressed air, which operates by modes not visible to the senses, as to which latter devices the circuit court held that "in judging of an infringement we are to direct our attention rather to functional equivalents than to mechanical equivalents," we do not think well taken, even in favor of pioneer inventions." *Boyden Power Brake Co. v. Westinghouse Air Brake Co., 73 O. G. 857, C. D. 1895.

118. With respect to a primary or pioneer patent the well-settled rule is that the patentee who has by the success of his patent pointed out the combination of functions needed to reach the new result, and has claimed the combination of mechanical parts performing those functions, may enjoin the use of another machine producing the same result where the second machine differs from the first only in a substitution for parts or elements in the patented device of parts or elements which, though different in form and kind, perform the same functions in substantially the same way. It may be that the substituted parts are well-known equivalents of those shown in the patent for the performance of the functions to which they are respectively applied, in which case there is manifestly no inventive faculty shown in the change; or it may be that, being shown by the successful operation of the patent the exact nature of the functions to be performed by a part of the patented device, the infringer by the use of his inventive faculty hits upon something as a substitute which will perform the same functions more completely and satisfactorily. In the latter case he is a tributary inventor; but he is none the less an infringer if he uses the whole machine, with his substituted part, to accomplish the same new result. *McCormick Harvesting Machine Co. v. C. Aultman & Co., 73 O. G. 1999, C. D. 1895.

119. The rule as to infringement of patents for pioneer inventions, which point the way to new products or results, is analogous to that applied to cases involving process patents. *Id.

XI. PARTICULAR CASES.

120. Each of the claims of this patent being limited to a buckle having a spring-clamp composed of two elastic wings or arms approaching each other, but not connected, they are not infringed by a buckle having its wings or arms firmly joined, and possessing no more

resiliency than is due to the character of the material, although it performs all the functions of the patented buckle. *Bruff v. Waterbury Buckle Co., 38 O. G. 1250, C. D. 1887.

121. In action for infringement of Letters Patent No. 77,920, issued to Herman and Louis Royer, May 12, 1868, for a machine for treating hides, plaintiffs' machine softened the hide by fastening it to a vertical shaft revolving in a crib, in which the hide was revolved under the pressure of a weight in the upper part of the crib, through which the shaft passed. Defendant's machine softened hides in the same way, except that his shaft was horizontal and the pressure on the hides was applied through the head of the crib by screws. *Held* an infringement, the principle and method of the plaintiffs being used in the design of the defendant. *Royer v. Coupe, 39 O. G. 239, C. D. 1887.

122. Where the specification showed that one material part of the invention was the detachment of the piston from the piston-rod, *held*, that a steam bell-ringer not containing this contrivance did not infringe the patent, although the most important features of the bell-ringer were suggested by the invention of the patentee. Decree of court below affirmed. *Snow v. The Lake Shore and Michigan Southern Ry. Co., 39 O. G. 1081, C. D. 1887.

123. When the original patent described and claimed a "bridge-piece," it described and claimed a piece which crossed an open space. *Patent Clothing Co. (Limited) v. Glover, 40 O. G. 1135, C. D. 1887.

124. The defendants, not using a bridge-piece which crossed an open space, did not infringe. *Id.

125. Although defendant employed a higher heat than that described in the patent and cooled the springs by plunging them into cold water, the patent being silent as to the method of cooling the springs, the patented method was infringed. *Cary v. Lowell Mfg. Co. (Limited), 40 O. G. 1239, C. D. 1887.

126. Where a patent is limited by disclaimer to a flat or "tape-wire" knife for cutting dough, there is no infringement in the use of a round wire. *Dosh v. A. J. Medlar Co. (Limited), 40 O. G. 1242, C. D. 1887.

127. Buttons similar to those made by the patentee's process were old, and the defendant in manufacturing a like article is not liable for infringement of any patent. *Cottle v. Krementz, 40 O. G. 1243, C. D. 1887.

128. The claim in controversy called for "outer sheets or layers of celluloid and an in-

terlining of textile or fibrous material." The infringing article was made by one of the defendants of two sheets of muslin or cloth with a paper interlining, and sent in this form to another of the defendants, who placed a thin coating of zylonite upon one side of the compressed fabric and returned the same to the first defendant, who shaved off the cloth edge of the fabric and turned the zylonite side over upon itself, so that there was a surface of zylonite upon both sides of the collar except at the neckband. These collars were then sold by the third defendant. *Held*, that the claim of the patent had been infringed by each of the defendants. *Celluloid Mfg. Co. v. American Zylonite Co., 40 O. G. 1453, C. D. 1887.

129. It being contended that the fabric as manufactured did not infringe the patent, and the conversion of it into a collar being by an old and well-known method, *held*, that the question was whether an unpatented fabric had been changed into a patented one, and not whether a change had been effected by a familiar method. *Id.

130. A patent upon a device for an improvement in wagon-gear, designed to render the wagon-gear elastic and to relieve the strain upon the side springs, reach and head-block, is infringed by using a device substantially the same, although the latter is utilized also to aid the wagon to track. *Shaver v. Skinner Mfg. Co., 41 O. G. 232, C. D. 1887.

131. Although the bustle manufactured and sold by defendant was made, for all practical purposes, in imitation of the bustle patented by complainant, except that it was of rattan instead of wire, yet, as complainant in his specification limited himself to a bustle made of wire, he authorized the public to make and use bustles of any other material, and cannot complain of such use as an infringement of his rights. *Western & Wells Mfg. Co. v. Rosentock, 41 O. G. 354, C. D. 1887.

132. Round rock-shafts in tilting malt-kiln trays are old and now common property, and it is an old expedient to tilt frames by square rock-shafts; but where the patentee sees fit to limit his claim to a square rock-shaft, the defendants who use a round shaft cannot be held liable. Also, while a patent may cover a new hook, it cannot prevent the use of an old door-latch. *Toepfer v. Goetz, 41 O. G. 933, C. D. 1887.

133. A patent claiming as an element in a combination "double braces," which are described in the specification and shown in the

drawings as extended in opposite directions, is not infringed by a construction where the "braces" extend in the same direction with a manifest advantage. *Morss v. Manchester, 41 O. G. 1392, C. D. 1887.

134. Where complainant's patent claimed "conical feed-rolls," and the defendant's machine had short cylindrical feed-rolls feeding in a circular direction, these latter rolls were not the equivalent of complainant's conical feed-rolls, and there is no infringement. *Dryfoos v. Wiese, 42 O. G. 490, C. D. 1888.

135. The complainant's patent is held to claim a spring-impelled cash-carrier and to have been infringed by a cash-carrier impelled by the expansion of compressed air. *Rapid Service Store Ry. Co. v. Taylor, 42 O. G. 721, C. D. 1888.

136. Where the defendant's anvil was made in separate parts, while the complainant's was a single piece, if the operation and results of each were the same, one construction was the equivalent of the other. *Thompson v. Gildersleeve, 43 O. G. 886, C. D. 1888.

137. The claim of the patent embracing a longitudinal groove as a guide for honey combs, the employment of pieces of wax as a guide is not a mechanical equivalent and not an infringement. *Fornecrook v. Root, 43 O. G. 984, C. D. 1888.

138. The cylinder of the claim being described as having chambers or depressions, and the defendants' cylinder being smooth throughout, there was no infringement in this particular. *Hendy v. The Golden State and Miners' Iron Works, 43 O. G. 1117, C. D. 1888.

139. The process consisting of subjecting the slab of celluloid to pressure, then heating the mass from below, then applying the heat above, held infringed by defendants' process, in which the heat is first applied from above and afterward from below. *Celluloid Mfg. Co. v. American Zylonite Co., 42 O. G. 961, C. D. 1888.

140. A hay-press adapted to bale two bales at the same time, having a partition-board attached to and moving with the follower, is not infringed by a press having a partition-board which is removed before the pressure is applied and does not perform the offices of the complainant's board except to a limited extent. *Kulp v. Souder, 45 O. G. 712, C. D. 1888.

141. The first claim of Letters Patent No. 252,230, granted January 10, 1882, to George Ligowsky, for a target-trap — being "the combination, in a target-trap, of a spring-lever, a rack, and an adjustable tension-arm carrying

the trigger, with which latter is engaged said lever" — is not infringed by a target-trap not having such notched rack and in which the adjustable tension is not produced by means of the tension-arm, but by means of a screw which operates a rod attached to the lower end of a coiled spring. *Ligowsky Clay Pigeon Co. v. Peoria Target Co., 45 O. G. 1457, C. D. 1888.

142. The distinguishing feature of the Teipel patent being that it is adapted to the use of the longitudinally-strained spring, and not the coiled spring, and the first and second claims being for the combination of the spring strained between the end of the lever and the point at which it is fastened to the bed-piece, they are not infringed by the defendants' device, in which such strained spring does not appear. *Id.

143. Where the claim is limited to a lever locking in vertical position, and defendants' lever, like a prior patented lever locked in a horizontal position, held, that the claim is either anticipated or not infringed. *Rodebaugh v. Jackson, 47 O. G. 658, C. D. 1889.

144. Where after official rejection a patentee's claim was limited to the specific device described, in which the lever for operating the dog-bar locked when in vertical position, and the defendant's lever was so arranged as not to lock in that position, held to be no infringement. *Rodebaugh v. Jackson, 47 O. G. 660, C. D. 1889.

145. The combination covered by the third claim of plaintiffs' patent, which includes an inclined and retreating anvil to sustain the wire of the staple while being bent and to support the staple while being driven, is infringed by defendant's device having a two-part anvil, which, though different in form, accomplishes the same result in the same way. *Thompson v. American Bank Note Co., 48 O. G. 540, C. D. 1889.

146. The only difference between the two gripping devices is that the pulleys in the defendant's device are connected with the movable jaw, while in the device of the patent they are connected with the fixed jaw; and in the patented devices the movement of the lower jaw to release the cable is a vertical movement both as respects the fixed jaw and the pulleys, while in the defendant's apparatus the movement of the lower jaw is a vertical movement as respects the fixed jaw, but not as respects the pulleys. These are merely formal differences. They do not involve any inventive thought, and are immaterial as respects the function and mode of operation of the parts of

the combination. *Root v. Third Avenue R. Co., 48 O. G. 674, C. D. 1889.

147. The selling by the defendant of valves under the name of "Foley's," or "Foley's Patent Valves and Overflows," signifies that they are the kind of valves invented and patented by Foley, but not that they are the valves which he or his successor is manufacturing. *Adee v. Peck Brothers & Co., 48 O. G. 823, C. D. 1889.

148. Defendant's lock was substantially identical with the lock of the defendant in Yale Lock Co. v. Berkshire Nat. Bank, except that in the latter there was an additional dog controlled by the time mechanism, which dog added nothing to the efficiency or value of the lock. The defense of that case was assumed by a lock company, or its president, who afterward became president of defendant, and all the questions presented here were presented in that case. On the authority of that case, *held*, that defendant's lock was an infringement. *Yale & Towne Mfg. Co. v. Consolidated Time Lock Co., 48 O. G. 1399, C. D. 1889.

149. Letters Patent No. 170,012, granted November 16, 1875, to John B. Newbrough, for improvement in dental chairs, *held* not to be infringed by a device used by the defendant, which simply operates to regulate the tilt of the back of the chair and not to tilt the body of the chair, which was the object of patentee's invention, and where it appears that the tilting of the back of the chair in the complainant's case is made by a different apparatus entirely from that used by defendant. *Brush v. Condit, 49 O. G. 1211, C. D. 1889.

150. The construction claimed in Letters Patent No. 272,598, granted February 20, 1883, to John F. Steward, has for its object to provide means in an automatic grain-binder to automatically regulate the position of the band on the gavel without aid or attention from the operator, and in view of the prior state of the art the claims must be restricted to the exact combinations set forth in them, and such claims are not infringed by parties using a different construction. *Deering v. McCormick Harvesting Machine Co., 52 O. G. 1223, C. D. 1890.

151. A claim in Letters Patent No. 266,913, granted October 31, 1882, to John F. Steward, relating to a construction for compressing the grain before tying, in connection with a spring-link for relieving the strain and avoiding breakage, is not infringed, in view of the prior state of the art, by a device for the same purpose which is not identical with the construction set forth in such claim. *Id.

152. The Scribner lamp held to infringe the Brush patent, as it contemplates a dissimultaneous arc-forming separation by mechanism not radically different from that of Brush. *Brush Electric Co. v. Western Electric Light and Power Co., 52 O. G. 1950, C. D. 1890.

153. The patent is infringed by a device whose only difference from the patented machine is that its trip-rod receives the stroke of the hammer in its backward instead of its forward motion. *Walker v. City of Terre Haute, 54 O. G. 507, C. D. 1891.

154. Where in a suit for infringement it appeared that the patent in suit was granted August 13, 1889, on an application filed December 2, 1887, and renewed March 28, 1889, and that the defendants manufactured and sold the alleged infringing machine made in accordance with letters patent issued to defendants' assignor December 4, 1888, on an application filed September 8, 1888, *held*, assuming that defendants' machine embodied substantially the same invention claimed and described in the patent in suit, and that the device of said patent possessed patentable novelty, that, under the circumstances and in the absence of other evidence, the court would not presume that plaintiff's assignor was the first inventor, simply because his application for a patent was first filed. *Held*, further, that the burden was on the plaintiff to establish that he was the first inventor; that such fact had not been shown, and that it was just as reasonable to infer that defendants' assignor was the first inventor. *American Roll Paper Co. v. Knopp, 54 O. G. 139, C. D. 1891.

155. A patent for a lens-holder is infringed by a lens-holder having a number of pieces operating in substantially the same way as the patented article, even though the number of pieces is not the same in the two holders. *White v. Walbridge, 56 O. G. 1204, C. D. 1891.

156. The words of the claim and specification which refer to the body of the vessel as "globe-shaped" or "spherical" must be taken in their ordinary rather than their mathematical signification, and infringement cannot be avoided by merely elongating the body so as to render it an ovoid rather than a sphere or globe. *Ripley v. Elson Glass Co., 60 O. G. 298, C. D. 1892.

157. The claim for "A new article of manufacture, a smoking pipe made of corncob, in which the interstices are filled with a plastic self-hardening cement, substantially as and for the purposes set forth," *held* infringed when

any plastic mixture—such as ground corncob and starch or ground corncob and shellac—which will set or harden is applied as a filler to the exterior surface of the bowl of a corncob pipe, and that it makes no difference whether the plastic self-hardening mass is moistened and mixed before it is applied or in the act of applying. *H. Tibbe & Son Mfg. Co. v. Lamparter, 61 O. G. 427, C. D. 1892.

158. Where the claim is for “the treatment of the prepared rawhide in the manner and for the purposes set forth,” and the process as described comprehends “the removal of the hair from the hide by means of sweating,” and further avers that the patentee avoids “the use of lime, acid or alkali,” a treatment which omits the “sweating” but uses the “liming” process is not an infringement. *Royer v. Coupe, 62 O. G. 318, C. D. 1893.

159. Where the complainants’ instruments differed in mechanical structure from those of the defendant to such an extent as to result in a noticeable difference in the tones of the instruments, calling for a different kind of trade, *held*, that there was no infringement. *Dobson v. Cubley, 63 O. G. 1059, C. D. 1893.

160. The infringement is not avoided by so attaching the gripping device that it may be detached when required, for the terms “permanently attached” in the claim import, merely, that the gripping device is an essential part of the car, and not that it is incapable of removal. *Pacific Cable Ry. Co. v. Butte City Street Ry. Co., 64 O. G. 1397, C. D. 1893.

161. Claim 1 of Patent No. 223,812, dated January 27, 1880, describing a swinging elevator located upon the *grain* or ascending side of the main belt, pivoted at its *lower* end and movable at its *upper* end, cannot be construed to cover a similar device located upon the *stubble* side, pivoted at its *upper* end and swinging at its *lower* end, particularly in view of the facts that the patent is not a pioneer patent, that the specification confines the invention to the terms of the claim, that in no one of the six claims is there a suggestion that the elevator or belt could be located upon the stubble side, that the invention was of doubtful utility and never went into practical use, that the mechanism set forth in the patent to Bullock and Appleby of October 31, 1882, No. 266,949, under which the defendant manufactured its machines, was extensively sold throughout the country for about eight years before any assertion of adverse right under the Olin patent, the

plaintiff himself becoming a licensee under the patent, and that though Olin, while in the patent office, was thrown into an interference with another application having broader claims, he made no attempt to insert such broader claims. The Olin patent was not infringed. *Deering v. Winona Harvester Works, 69 O. G. 1641, C. D. 1894.

162. The claim for “a toy bank consisting of a hollow toy provided with a coin-receiving and coin-discharging aperture, a movable cover for the discharging aperture, and a spring-latch to secure the same from within, said spring-latch being normally closed, but constructed to be opened by the weight of the coin within,” *held* infringed by a device consisting of the same elements, but in which the cover to the discharging aperture is retained in place until a pressure applied through the contained coin greater than the weight of the coin releases said cover. *Colby v. Card, 69 O. G. 125, C. D. 1894.

163. A patent for an improvement in shirts, all the claims of which apply only to shirts which have a double or supplementary front, is not infringed by a shirt having a false front forming part of the shirt, giving the appearance, without the reality, of a double or supplementary front. *Knit Goods Patents Co. v. Shuman, 69 O. G. 511, C. D. 1894.

164. Claims 1, 2 and 4 in Patent No. 360,070, dated March 29, 1887, to George Westinghouse, Jr., for an improvement in brake mechanism, which broadly covers “an auxiliary valve device, actuated by the piston of the triple valve and independent of the main valve,” *held* infringed by a structure in which the piston of the triple valve acts upon the auxiliary valve, not directly, but by opening a port which reduces pressure on one side of another piston in a supplemental chamber, the movement of such supplementary piston opening the auxiliary valve. *Westinghouse Air-Brake Co. v. New York Air-Brake Co., 70 O. G. 388, C. D. 1895.

165. Claim 1 in Patent No. 376,837, dated January 24, 1888, to George Westinghouse, Jr., for an improvement in fluid pressure automatic brake mechanisms, which broadly is for a piston actuated “by pressure from an auxiliary reservoir,” *held* infringed by a structure in which the piston is moved by a charge from an additional reservoir charged in the same way as the auxiliary reservoir is charged. *Id.

166. Because the differences do not involve invention and the function is the same in both,

there is infringement. *Holmes v. Truman, 73 O. G. 448, C. D. 1895.

167. Claim 1 of letters patent to A. A. Whiteley, No. 418,257, for an elastic cord exercising apparatus, issued December 31, 1889, held infringed. "The function, utility or result of defendant's apparatus is contained in that of complainant. . . . An infringement is not avoided because the infringing device is better, more useful and more acceptable to the public than that of the patent infringed, nor, on the other hand, because the infringing device by some colorable variation or expedient merely impairs or narrows the function and usefulness of the device infringed." *Whiteley v. Fadner, 74 O. G. 968, C. D. 1896.

168. Browning's device does away with the presence of a trainman in coupling cars, since it is automatic in its character, and a claim for it is not infringed by a device which is without any automatic means for necessarily placing the device in position for coupling. *Gould Coupler Co. v. Trojan Car Coupler Co., 75 O. G. 2009, C. D. 1896.

169. The patentee placed between the dies used in making his articles short sections of a smooth straight-sided tube. One effect of the dies is to change the thickness of metal of these sections by swaging or upsetting. This is not infringed by a process for making similar articles in which sections of a corrugated tube are used, in operating upon which the effect of the dies is to fold or unfold the corrugations without upsetting the metal or changing its thickness. *Jackson v. Birmingham Brass Co., 75 O. G. 677, C. D. 1896.

170. The fact that defendant employs a paper impregnated with a wax having a melting-point different from that of the wax used by complainant is not sufficient to avoid infringement when the essential characteristic of the wax employed in each case is its hardness and the degree of hardness is the same in both. *A. B. Dick Co. v. Henry, 75 O. G. 1204, C. D. 1896.

171. A claim for a torpedo, a detachable clip, and means for attaching the clip to the torpedo is infringed by a device which has the same elements, although differing in details. *Bennett v. Schooley, 76 O. G. 335, C. D. 1896.

172. A claim which includes as a persistent, express and pronounced feature an air-chamber is not infringed by a device some particular part of which may be a "compartment" or "inclosure," but which part never contained a

volume of air. *Scarborough v. Neff, 76 O. G. 475, C. D. 1896.

173. The contention that, since it is physically impossible for two sets of carbons to be separated at one and the same electrical instant, the defendant's devices must infringe is manifestly fallacious. *Brush Electric Co. v. Western Electric Co., 77 O. G. 1273, C. D. 1896.

174. Devices which effect a distinctly simultaneous separation of pairs of carbons of a lamp do not infringe a patent in which there is claimed a device for securing a dissimultaneous separation of such pairs of carbons. *Id.

175. The substitution of a horizontally-moving roller presser and cutter for a vertically-moving direct plunger and cutter will not suffice to avoid infringement in the case of a defendant who was also an unsuccessful defendant in a long course of prior litigations, even though the structure complained of evades the wording of the claims in suit. *Beach v. Inman, 77 O. G. 1275, C. D. 1896.

176. A centrifugal separator in which a pump is employed to remove the separated cream is not infringed by a device in which the pump is omitted, when its omission is attended with a corresponding omission of its function, the same result being attained by a nice adjustment of the remaining parts. *Philadelphia Creamery Supply Co., Limited, v. Davis & Rankin Building and Mfg. Co., 79 O. G. 1194, C. D. 1897.

177. A device which uses a single continuous admission of air does not infringe a claim of which a second admission has been made a material feature. *Westinghouse Air-Brake Co. v. New York Air-Brake Co., 79 O. G. 1679, C. D. 1897.

178. When any two parts or spaces abut directly upon each other, the idea of a connecting-passage is necessarily dispensed with, and such construction does not infringe a claim in which the connecting-passage is an essential element. *Id.

179. A construction which has air in a chamber in free communication with a train-pipe is still train-pipe air in effect and has train-pipe pressure, and is not infringed by a device which is worked by air in a chamber absolutely cut off by a slide from a train-pipe. *Id.

180. A claim, one element of which is a curved spring-plate upon the vibrating end of a pitman, is not infringed by a press which lacks this element. *Kansas City Hay-Press Co. v. Devol, 81 O. G. 1277, C. D. 1897.

INJUNCTION.

(See DAMAGES AND PROFITS; EQUITY.)

- I. IN GENERAL.
- II. DISSOLUTION.
- III. PRELIMINARY, WHEN GRANTED.
- IV. PRELIMINARY, WHEN DENIED.
- V. PERMANENT.
- VI. PRIOR JUDGMENT.
- VII. STAY OF.

I. IN GENERAL.

1. Where a patent has been applied for on an invention, the court has jurisdiction to grant an injunction to restrain its infringement pending the hearing. *Butler v. Ball, 38 O. G. 420, C. D. 1887.

2. There is no jurisdiction in the United States courts of equity to enjoin a libel on the rights or title of an owner of letters patent. *Baltimore Car Wheel Co. v. Bemis, 38 O. G. 1132, C. D. 1887.

3. The sale of materials to be used in an infringing process—the parties using said process having no license therefor—will be enjoined. *Willis v. McCollen, 38 O. G. 1017, C. D. 1887.

4. An injunction granted in this cause February 5, 1886, is not violated by the defendant in the use of a device which is a stop on moving the trip-hand of a fare-register forward beyond zero, but is not capable of being fixed where registration is begun away from the proper place so as to indicate that fact. *Railway Register Mfg. Co. v. Broadway and Seventh Avenue R. Co., 40 O. G. 1243, C. D. 1887.

5. The fact that defendant used a combination of his own in his self-feeding pen was not sufficient to overcome the fact that his combination was merely additional to plaintiff's combination, which he was using, and to prevent which an injunction would be granted. *Wirt v. Brown, 41 O. G. 236, C. D. 1887.

6. The complainant having filed his bill for infringement in the usual form, one of the defendants—a manufacturing company—applied for an order restraining the complainant from suits for infringement against its customers during the pendency of the suit against it. The petition for the restraining order was sworn to, and set out the defenses which would be made in the answer, particularly its own patent, under which it manufactured governors, and was supported by affidavits. The complainant put in no evidence in answer to the petition, but

rested upon the proposition that, as a matter of law, the grant of the patent gave him the right to sue all infringers of it. *Held*, that the petition was proper, and the order was granted. **Ide v. Ball Engine Co.*, 41 O. G. 1271, C. D. 1887.

7. The court has authority under the general chancery powers to issue such an order before the filing of an answer or of a cross-bill. The form of such restraining order stated. **Id.*

8. The use of words which are technically descriptive will be enjoined where it appears that they are used as a means of effecting a fraud. **Moxie Nerve Food Co. v. Various Defendants*, 43 O. G. 888, C. D. 1888.

9. Complainants' licensees established telephone exchanges in certain cities and towns in the state of Indiana, but withdrew them upon the passage by the legislature of that state of an act limiting the rates of charges. The defendants re-established them, using the "Cushman" telephones, which have been held by this court to infringe the complainants' patents. *Held*, that the fact that the complainants' licensees had withdrawn their telephonic service from these cities furnished no excuse or defense for the infringement of their patents by the defendants. Injunction granted. **American Bell Telephone Co. v. Cushman Telephone Service Co.*, 45 O. G. 1193, C. D. 1888.

10. Under the law the monopoly secured by a patent ceases with the expiration of the patent, and articles made during the life of the patent in infringement of it cannot be enjoined after its expiration, and an injunction already granted as to such articles will be dissolved. **Westinghouse v. Carpenter*, 46 O. G. 244, C. D. 1889.

11. In a suit for infringement of a patent a court of equity has the power, upon petition of defendants, to restrain complainant from bringing further suits against the purchasers or users of the patented article, and will do so when the affidavits filed by defendants show that the suits brought are vexatious and oppressive. **National Cash Register Co. v. Boston Cash Indicator and Recorder Co.*, 51 O. G. 626, C. D. 1890.

12. Section 4921 of the Revised Statutes confers upon courts vested with jurisdiction of cases arising under the patent laws power to grant injunctions according to the course and principles of courts of equity; but the exercise of the power is limited to a specific purpose—namely, to prevent the violation of any rights secured by patent. **Illingworth v. Atha and*

Commissioner of Patents, 51 O. G. 803, C. D. 1890.

13. A defendant in a patent suit who was the manufacturer of certain articles claimed to be an infringement of plaintiff's patent sought to obtain an order enjoining the prosecution of three suits begun in other districts against its customers, as well as the commencement of new suits, and the sending of letters and circulars to others engaged in the trade threatening prosecution for selling articles made by the defendant. *Held*, first, that the prosecution of suits in other districts should not be enjoined, because such suits were begun before this suit, and because comity demanded that application should be made to the court in which such suits were pending. *Kelley v. Ypsilanti Dress-Stay Mfg. Co., 54 O. G. 659, C. D. 1891.

14. *Held*, further, that as the plaintiff might recover substantial damages against the defendant's vendees, in addition to those which he would be entitled to recover against the defendant as manufacturer, the commencement of new suits should not be enjoined unless irreparable injury was threatened to defendant's business, or there was evidence of malice or bad faith on the part of the plaintiff in commencing such suits. *Id.

15. And *held*, further, that plaintiff had a right to notify persons using his device of his claim and to call attention to the fact that by selling or using it they were making themselves liable to prosecution, and that an injunction would not be ordered unless the language of his letters or circulars was false, malicious, offensive or opprobrious, or they were used for the wilful purpose of inflicting an injury. *Id.

16. It is not necessary to show in a suit for infringement of a patent that the plaintiff is or has been engaged in the manufacture, sale or use of the patented inventions, or that they have been a source of profit to him, or a prior adjudication upon the validity of the patent, or acquiescence by the public in the use and enjoyment thereof, if a preliminary injunction is not asked for. *Wirt v. Hicks, 56 O. G. 663, C. D. 1891.

17. It is proper to issue an injunction against one who has already infringed a patent, even though he denies that he intends to make any further infringement. *White v. Walbridge, 56 O. G. 1204, C. D. 1891.

18. On the question as to whether an injunction should issue it is immaterial that the owner

of the patent has never made, used or sold any of the patented articles or licensed any one to do so, especially when it appears that he has not done so because defendant and other railroad companies, being unwilling to pay the price asked by him, adopted his invention without leave, expecting to pay a less sum by way of damages for infringement. *Campbell Printing Press & Mfg. Co. v. Manhattan Ry. Co., 60 O. G. 894, C. D. 1892.

19. Defendant cannot escape the injunction on the ground of hardship to itself or to the public, since the decree may provide for a gradual removal from its cars of the patented article so as not to cause the withdrawal from service of a large amount of rolling stock at any one time, and for that purpose the amount of rolling stock required and available for its business may be proved by affidavits or the oral examination of its superintendent or master-mechanic. *Id.

20. Where a defendant has been guilty of bad faith toward a complainant in an infringement suit, he is not equitably entitled to ask a bond from complainant as a condition to the granting of a preliminary injunction, and the court will waive the requirement of bond where the record discloses proof of such a state of facts. *Pasteur Chamberland Filter Co. v. Funk, 60 O. G. 1479, C. D. 1892.

21. The right to an injunction rests on anticipated and threatened infringements, and where a bill avers reasonable ground for fearing such future infringements a failure to show prior infringements is unimportant except on question of damages. *Canton Steel Roofing Co. v. Kanneberg, 61 O. G. 424, C. D. 1892.

22. On motion for a preliminary injunction, where a patent is set up as anticipation, which on its face antedates the patent in suit, complainant may show, if he can, that his patented invention was actually made prior to the date of the anticipating patent, and he will thereby avoid anticipation, and the alleged anticipating patent will not be considered. *Norton v. Eagle Automatic Can Co., 65 O. G. 442, C. D. 1893.

23. The rule is well established that a patent does not create a sufficiently strong presumption of its own validity to justify a court in a preliminary injunction. *Palmer Pneumatic Tire Co. v. Newton Rubber Works, 73 Fed. Rep. 218 (1896).

24. The monopoly under a patent does not commence until the patent issues. An inventor

has no right to injunctive relief while his application for a patent is pending in the patent office. *Brill v. St. Louis Car Co., 79 O. G. 2017, C. D. 1897.

25. Where devices covering several patents are capable of embodiment and conjoint use in a single machine and it was sought to recover in a single suit for infringement, the failure of the complainant either to establish title to one of the patents or to show infringement of one or more of them does not affect his right to an injunction and an accounting in respect of others if the proof is sufficient to show that they are infringed. *Kansas City Hay-Press Co. v. Devol, 81 O. G. 1277, C. D. 1897.

26. While the issuance of an injunction would be advantageous to the complainant in its efforts to protect its business and prevent an onslaught upon it, yet when there are serious doubts as to the validity of the contested claims of the patent, injunction against infringement should not issue. Such an interference with the business of one manufacturer to strengthen the position of another pending an attack upon the validity of his patent seems to be an undue stretch of the power of a court of equity. *Welsbach Light Co. v. Benedict and Burnham Mfg. Co., 82 O. G. 2247, C. D. 1897.

II. DISSOLUTION.

27. Motion to dissolve an injunction on the ground that the invention covered by the patent was described in a prior patent to same inventor denied. *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co., 40 O. G. 1242, C. D. 1887.

28. An injunction as to articles made during the life of the patent in infringement of it will be dissolved after expiration of the patent. *Westinghouse v. Carpenter, 46 O. G. 244, C. D. 1889.

29. After a patent, the infringement of which has been enjoined, expires the injunction will be dissolved without reference to such articles as were manufactured while the patent was alive. The patentee may recover damages for such acts of infringement. *Westinghouse v. Carpenter, 54 O. G. 140, C. D. 1891.

30. The burden of proof is on defendant to show cause for dissolving a temporary injunction; but nevertheless a dissolution will be granted upon new evidence sufficient to raise grave doubts as to the complainant's right to such injunction. *Edison Electric Light Co. v. Buckeye Electric Co., 67 O. G. 529, C. D. 1894.

III. PRELIMINARY, WHEN GRANTED.

31. Should plaintiff use the injunction to injure the defendants' business, without regard to their use of the invention, his standing in a court of equity will be destroyed and the injunction promptly dissolved. †Russell v. Lundeen, 72 O. G. 420, C. D. 1895.

32. A preliminary injunction to restrain infringement of a patent will not be granted unless there is a special presumption that the patent is valid. The presumption may arise by proof that the patent has been suitably adjudicated in the federal courts and there held valid, or that its validity has been suitably acquiesced in by the public, or that the patent has successfully undergone an interference in the patent office. *Edward Barr Co. (Limited) v. New York & New Haven Automatic Sprinkler Co., 32 Fed. Rep. 79 (1887).

33. It appearing that the packing made by defendant since the injunction in the former suit differed only in form from that enjoined, but operated in the same way, a preliminary injunction is proper. *United States Metallic Packing Co. v. Tripp, 39 O. G. 1554, C. D. 1887.

34. Where the injury to the defendants would be trifling should a preliminary injunction be granted, and where the injury to the complainants would be destructive if the preliminary injunction should not be granted, and the infringement is not seriously denied and acquiescence is proved, the court will not hesitate to grant the relief asked for. *Hat Sweat Mfg. Co. v. Davis Sewing Machine Co., 41 O. G. 1273, C. D. 1887.

35. The mere fact that a defendant has ceased to infringe a patent is not a sufficient reason to withhold the issuance of preliminary injunction. *Celluloid Mfg. Co. v. Arlington Mfg. Co., 42 O. G. 828, C. D. 1888.

36. A complainant may have a preliminary injunction against an infringing defendant who is a mere selling agent, where, the patent having nearly expired, the court might refuse it against a manufacturer giving proper security. *Remington Standard Type-Writer Mfg. Co. v. Bailey, 60 O. G. 440, C. D. 1892.

37. Although the complainant has not shown the manufacture by the defendants of the infringing articles, preliminary injunction will be granted based upon proof that they have kept such articles in stock and offered them for sale. Although the defendants may have no present intention of continuing such sales, in view of the fact that there is a final decision sustaining the patent, the court will exercise

its discretion to secure the continuance of that intention by the granting of a preliminary injunction. *New York Belting and Packing Co. v. Gutta-Percha and Rubber Mfg. Co., 61 O. G. 892, C. D. 1892.

38. A patentee assigned all his interest in a patent, agreeing not to manufacture or sell the patented machine or make any improvement thereon which would adapt it to any other kind of work. Subsequently the assignee sued him for infringement in making an improvement on the machine. *Held*, on motion for preliminary injunction, that in the light of the above contract, although the suit was not based thereon, the patentee was not in so favorable a position before a court of equity as one who infringes ignorantly or inadvertently, and that the patent should be construed liberally as against him. *Loring v. Booth*, 61 O. G. 1483, C. D. 1892.

39. An injunction will not be refused on a suggestion that an improper use may be made thereof by advertising to embarrass defendants in the sale of non-infringing articles, since it must be presumed that the injunction was sought in good faith, and should the contrary appear the court could reconsider its action. *New York Belting and Packing Co. v. Gutta-Percha and Rubber Mfg. Co., 64 O. G. 1534, C. D. 1893.

40. The offering of additional *ex parte* testimony not a reason for the grant of a preliminary injunction against a patent which has been so severely attacked and uniformly sustained. *American Bell Telephone Co. v. Cushman, 65 O. G. 135, C. D. 1893.

41. There are cases where the courts have refused a preliminary injunction and allowed defendant to give bonds in lieu thereof on the ground of hardship that would be entailed upon the defendant by an injunction, notwithstanding the fact of prior adjudication of validity of the patent; but upon consideration of the facts here it is held that this is not such a case, and the injunction is granted, although it may entail a hardship on the respondent. *Norton v. Eagle Automatic Can Co., 65 O. G. 442, C. D. 1893.

42. Although the patentees in this case have elected to enjoy the monopoly of their patent by granting licenses, nevertheless, it appearing that to refuse them a preliminary injunction would absolutely destroy the value of that patent, a preliminary injunction will be granted. *Id.

43. Where, on motion for a preliminary injunction, it is shown that six months prior to commencement of the suit complainant's attorneys visited the factory of respondent and there saw in operation respondent's machine, and it further appears that complainant had then pending, but undecided, in the same circuit a suit against another party upon a machine involving some, if not all, of the questions involved in the case at bar, complainant had a right to wait until a decision was rendered in the suit against the other party before bringing suit against respondent; and where complainant commenced his suit against respondent two weeks after the decision against such other party in the other case, he is not guilty of laches such as will disentitle him to a preliminary injunction. *Id.

44. Letters Patent Nos. 308,981 and 308,982, issued December 9, 1884, to Frank L. Palmer, are for improvements for stitching comfortable by machinery. Owing to the commercial advantages given by these patents, complainants, who owned them, were enabled to practically command the entire business of this country in this kind of quilts. The validity of the patents had never been denied except by one other party, who, after suit brought for infringement, compromised the same, and has ever since paid a royalty. *Held*, that on an application for preliminary injunction where infringement was plain, the patents would be presumed to be valid and the injunction granted, unless defendants gave a sufficient bond to secure any damages decreed against them. *Palmer v. Mills, 65 O. G. 1069, C. D. 1893.

45. Where a new art and apparatus, such as that of electric welding, is widely accepted by the scientific world and the public generally as novel and important, and is speedily put in operation, and the machines and rights under the patent are eagerly sought for by manufacturers, thus supplanting to a large extent the older methods—all with no question as to the validity of the patent, except in the case of the defendant,—this is sufficient evidence of acquiescence to justify the issuance of a preliminary injunction, unless defendant can clearly show that the patent is invalid. *Thomson Electric Welding Co. v. Two Rivers Mfg. Co., 69 O. G. 1207, C. D. 1894.

46. The rule is well established that a patent does not create a sufficiently strong presumption of its own validity to justify a court in a

preliminary injunction. *Palmer Pneumatic Tire Co. v. Newton Rubber Works, 73 Fed. Rep. 218 (1896).

47. A preliminary injunction will only be granted where the patent has been previously sustained, or public acquiescence is shown, or where it has withstood a contest by interference in the patent office. *Id.

48. A motion for a preliminary injunction will be granted when it appears that the defendant's structure is the same as the complainant's in all respects save one, and that one, though differing in a narrow technical sense, is the same in principle, and when it further appears that the complainant's patent has been uniformly upheld during years of arduous litigation with the present defendant. *Beach v. Inman, 77 O. G. 1275, C. D. 1896.

49. Injunction will be granted against the attorneys-at-law of an absent defendant to prevent importation of an infringing article when such attorneys are acting as attorneys-in-fact for such absent defendant. *Société Fabriques de Produits Chimiques de Thann et de Mulhouse v. Sander, 78 O. G. 1432, C. D. 1897.

IV. PRELIMINARY, WHEN DENIED.

50. In an action for an infringement of a patent, where there is doubt as to the priority of the invention, if the defendants are amply responsible and the plaintiff sells licenses for a royalty, so that there will be no difficulty in ascertaining the damage, a preliminary injunction will be denied. *National Hat Pouncing Machine Co. v. Hedden, 38 O. G. 1129, C. D. 1887.

51. A preliminary injunction will not be granted to restrain the infringement of a "design for a banner-rod, consisting of a conventional imitation of a straight twig with the bark and slantingly-cut ends," the section which relates to design patents demanding, it may be supposed, the exercise of more genius than is exhibited by it. *Osborn v. Judd, 38 O. G. 1132, C. D. 1887.

52. A motion for a preliminary injunction was denied where it appeared that the validity of the patent in suit was vigorously assailed and that the defendants did not manufacture the infringing articles, but bought the same from the manufacturer living in another district, against whom complainant had a suit pending in which a preliminary injunction had been applied for and denied with leave to

renew. *Hicks v. Beardsley, 41 O. G. 235, C. D. 1887.

53. Leave to renew the motion was granted should an injunction preliminary or final be obtained in the suit against the manufacturer. *Id.

54. Preliminary injunction denied when there was no special presumption in favor of the patents, arising from an adjudication in a federal court, acquiescence by the public, or a successful interference in the patent office. *Edward Barr Co. (Limited) v. New York and New Haven Automatic Sprinkler Co., 43 O. G. 392, C. D. 1888.

55. A preliminary injunction against the infringement of a patent will be denied where plaintiff does not show a prior adjudication sustaining the validity of the patent, or public acquiescence on which a presumption of validity may be based, and where it does not clearly appear that there is an infringement. *Raymond v. Boston Woven Hose Co., 48 O. G. 1776, C. D. 1889.

56. Where, in a suit for the infringement of a patent, the validity of which was dependent upon the result of an appeal in a former suit for its infringement, it appeared that the defendant was a manufacturer and the complainant was not, and that the defendant had been carrying on its business in good faith and in ignorance of the alleged infringement, and that a sudden stoppage of its business might be ruinous to it, while if the decree in the former suit were affirmed the complainant would have an adequate remedy in damages, *held*, that a provisional injunction would not be granted. *Consolidated Roller-Mill Co. v. Richmond City Mill Works, 50 O. G. 1133, C. D. 1890.

57. Where, in a suit brought under section 4915 of the Revised Statutes by the defeated party in an interference proceeding, a motion was made to make absolute a temporary order restraining the commissioner of patents from issuing to the successful party a patent for the subject-matter in controversy in said interference, and restraining the successful party from receiving a patent for the same, and for a preliminary injunction against both defendants in terms pursuant to the prayer of the bill, and it appeared that the most that could be said in review of the testimony was that it might be that the commissioner had made a mistake in awarding priority of invention, *held*, that the motion should be refused and the restraining order discharged as to both defendants. *Illing-

worth v. Atha and Commissioner of Patents, 51 O. G. 803, C. D. 1890.

58. A preliminary injunction should not issue in a suit for infringement where upon the issue of priority of invention the evidence is merely oath against oath. *Mack v. Spencer, 54 O. G. 1418, C. D. 1891.

59. A preliminary injunction will be denied when in the patent upon which suit is brought there is a disclaimer of what is covered by another application of the same inventor and the application or a copy thereof is not furnished. *National Typographic Co. v. New York Typograph Co., 56 O. G. 661, C. D. 1891.

60. An unexplained delay of over seven years in bringing suit for infringement of a patent deprives the complainants of the right to a preliminary injunction and perhaps to an account for past infringement. Further infringement, however, will be prevented by an injunction, notwithstanding previous laches. *Price v. Joliet Steel Co., 56 O. G. 664, C. D. 1891.

61. On a motion for an interlocutory injunction against the resale in the United States of patented goods purchased from a foreign corporation operating under the same patent as complainant, it must appear that defendant had notice of restriction against such resale when he paid the purchase price or the injunction will not issue. *Dickerson v. Matheson, 57 O. G. 1724, C. D. 1891.

62. A preliminary injunction will not issue in a case to restrain the infringement of letters patent where it appears that (1) the plaintiff's title is involved in some obscurity; (2) the patents have never been adjudicated; (3) the proof of acquiescence is inadequate; (4) infringement is not conclusively established; (5) defendant's financial ability is unquestioned. *R. E. Dietz Co. v. C. T. Ham Mfg. Co., 57 O. G. 1884, C. D. 1891.

63. If the court can see that there is any likelihood of the defendant's success on final issue, it should not permit the writ to issue, even though "it is probably true that the complainants have reason to complain of the defendant's course." *Id.

64. A motion for preliminary injunction to restrain the use of certain machines claimed an infringement of complainant's patent will not prevail where it appears that defendant is solvent and able to respond in damages to any amount suffered by complainant on account of such alleged infringement. *Whitcomb v. Girard Coal Co., 58 O. G. 523, C. D. 1892.

65. In an action for infringement, where it

appears that both complainant and defendant sold the articles prior to grant of patent, and that the only instance of infringement by defendant was a sale made shortly after the patent was granted and prior to notice thereof, preliminary injunction should be denied. *Anderson v. Germain, 58 O. G. 1092, C. D. 1892.

66. When the court has a real doubt whether there is any infringement, and assurances have been given that a prompt final hearing shall be had, temporary injunction will not issue. *Hammond Buckle Co. v. Goodyear Rubber Co., 59 O. G. 301, C. D. 1892.

67. A motion for a preliminary injunction in advance of any adjudication by the courts or an adjudication by the patent office as to priority will not be allowed unless the case is entirely clear and unless irrevocable injury is to result from withholding the injunction. *Iron-Clad Mfg. Co., Incorporated, v. Jacob J. Vollrath Mfg. Co., Limited, 60 O. G. 1480, C. D. 1892.

68. Where the evidence as to the construction of claims and their infringement was necessarily and largely *ex parte*, and where the damages which the complainants may suffer can be compensated in money by the respondents. *held*, that a preliminary injunction ought not to be granted. *Standard Elevator Co. v. Crane Elevator Co., 64 O. G. 438, C. D. 1893.

69. Although complainant's patent has been upheld in a suit against other parties in which defendants' patent was pleaded, a preliminary injunction against alleged infringement by manufacturing devices under the latter will not be granted when it appears that the former suit was so decided on the ground that there was an estoppel to question the novelty of complainant's patent, so that the validity of defendants' patent was not considered. *Ney Mfg. Co. v. Superior Drill Co., 64 O. G. 1133, C. D. 1893.

70. A preliminary injunction will not be granted in an infringement suit where complainant does not apply for it until two months after his bill was filed, during which time defendant has proceeded to fill up his stock of the alleged infringing articles for the coming season, which lasts but a short time. *Id.

71. A preliminary injunction will not be granted in an infringement suit where the affidavits of experts disclose a conflict that cannot be decided in complainants' favor without danger of unjustly interfering with the business of defendants, who are merely users of the device in question, and whose financial responsi-

bility is not questioned. *Williams v. McNeely, 64 O. G. 1268, C. D. 1893.

72. Where the defendant avers that the subject-matter of the infringement alleged differs substantially from that of the patent, the question ought not to be decided upon the *ex parte* affidavits, but, unless the defendant's contention be plainly frivolous and unsupported, left entirely open for decision upon the evidence as finally presented. *Id.

73. Where the patent in suit has not been litigated and sustained, evidence of its validity in the nature of licenses to manufacturers, sales and public acquiescence must be so clear and conclusive as to carry conviction; and where it appears that the licenses were taken merely to avoid the annoyance of litigation and at half the fee demanded, that the sales were mere placing on the market for sale, and the public acquiescence was merely that the patent had lain dormant for a period of years, *held*, that the evidence was insufficient to sustain the order granting an injunction *pendente lite*. *George Ertel Co. v. Stahl, 70 O. G. 1068, C. D. 1895.

74. Where the infringement of the patent is doubtful, *held*, that an injunction *pendente lite* ought not to be allowed. (Standard Elevator Co. v. Crane Elevator Co., 64 O. G. 438, 9 U. S. App. 556.) *Ertel v. Stahl, 70 O. G. 1069, C. D. 1895.

75. Application for preliminary injunction on Re-issue Patent No. 11,443, re-issued September 25, 1894, to William B. Page for an improvement in pneumatic testers for cans, refused on the ground that there had been no adjudication of the patent and nothing that amounted to public acquiescence. *Page v. Buckley, 70 O. G. 1642, C. D. 1895.

76. Where it appears that the invention had been used for more than seventeen years with the knowledge and assent of appellants and without any complaint on their part, except that appellee had not paid royalties after complainants quit its employment, *held*, that the laches of appellants were such as to disentitle them to a preliminary injunction. *Keyes v. Eureka Consolidated Mining Co., 71 O. G. 1027, C. D. 1895.

77. Whether the first claim of Letters Patent No. 376,837, dated January 24, 1888, to George Westinghouse, Jr., for an improvement in brake mechanism, is infringed is too doubtful to be resolved in favor of complainant upon a motion for a preliminary injunction, and should be re-

served for disposition upon the final hearing of the cause. *Westinghouse Air-Brake Co. v. New York Air-Brake Co., 72 O. G. 1350, C. D. 1895.

78. When the claims relate to most minute improvements and are not asserted to be fundamental, and the defendant has introduced some minor departures which may or may not be important, and the patent has never been adjudicated nor the claims construed, injunction should be denied and defendant required to give bond pending final hearing. *Consolidated Fastener Co. v. Columbian Fastener Co., 73 Fed. Rep. 828 (1896).

79. Where the validity of a patent is attacked and there is not a clear preponderance in its favor, injunction *pendente lite* should not issue. *Fenton Metallic Mfg. Co. v. Chase, 76 O. G. 478, C. D. 1896.

80. A decision of the supreme court of the District of Columbia in which no opinion was expressed may have been intended to express the conclusion that for some reason particular defendants should be enjoined, while at the same time it may have been intended to avoid giving the patentee a supporting adjudication. *Id.

81. The doubts of the infringement of claim 3 of Letters Patent No. 364,081, granted May 31, 1887, to Albert J. Bates for a pneumatic drilling-tool, which arise from the difference in the mode of operation of the valves as described in said claim and that of the infringing device are such as to require a denial of the motion for a preliminary injunction. *American Pneumatic Tool Co. v. Bigelow Co., 79 O. G. 2198, C. D. 1897.

V. PERMANENT.

82. An injunction may be granted against a defendant who was not included in terms by the writing of the settlement. *Babcock & Wilcox Co. v. Pioneer Iron Works, 43 O. G. 756, C. D. 1888.

83. Where in a suit against a railroad company for infringement the answer admits the validity of the patent, complainant's title thereto and the infringement, the company cannot avoid an absolute injunction by averring that the invention is of trifling value and offering to submit to a decree for nominal past damages and to an injunction against the adoption of any more of the patented articles on condition of the undisturbed use of those already upon its trains. *Campbell Printing-Press & Mfg.

Co. v. Manhattan Ry. Co., 60 O. G. 894, C. D. 1892.

84. The fact that patent is about to expire is no reason to the mind of the court for refusing an injunction to restrain its infringement. *American Bell Telephone Co. v. Brown Telephone & Telegraph Co., 65 O. G. 1894, C. D. 1893.

85. Where, though the defendants ceased manufacturing the infringing article within the jurisdiction of the court that issued the preliminary injunction restraining infringement of the patent, yet remain in a business related to the production of the article, *held* to be more the reason why there should be a decree and injunction which would avoid further litigation on the same subject-matter between the parties in another tribunal. *Brad-dock Glass Co., Limited, v. Macbeth, 70 O. G. 1799, C. D. 1895.

86. Where the defendants do not intend to use a secret invention an injunction cannot harm them; but if the injunction be refused and the secret be divulged all harm possible will be done and the law will be powerless to afford plaintiff any remedy. *Russell v. Lun-deen, 72 O. G. 420, C. D. 1895.

87. The mere fact that the plaintiff may be injured by enforcing the injunction is not sufficient reason for refusing it. *Id.

VI. PRIOR JUDGMENT.

(See PRIOR ADJUDICATION; COMITY.)

88. Where a preliminary injunction had been refused in another circuit in a suit for infringement against the manufacturer of the machines used by the defendant in this case, such refusal was not considered binding upon this court. *Thompson v. American Bank Note Co., 45 O. G. 347, C. D. 1888.

89. The utility of the invention is inferentially established by large sales of the patented article, and, interlocutory injunctions having been granted by several circuit courts, a restraining order pending suit, prohibiting the sale of an imported shade-holder adapted and intended to be used as a substantial part of the combination of the patented invention, granted. *Schneider v. Missouri Glass Co., 45 O. G. 1069, C. D. 1888.

90. Upon motion for a preliminary injunction, all the questions arising upon opposition to said motion having been settled favorably to complainant in a suit between said complainant and others in another court, but a later decision of the supreme court in another case

being thought to conflict with the former, where the defendants are engaged in an extensive manufacturing business, which would be entirely broken up by a temporary injunction, so that it could not be restored in case of a final decision in their favor, thus working defendants an irreparable injury, they should be allowed to give bond conditioned to satisfy the decree of the court against them for damages by infringement pending the suit, in case any be rendered, and in default of such bond within a fixed time such injunction should be granted. *Eastern Paper Bag Co. v. Nixon, 45 O. G. 1571, C. D. 1888.

91. It appears that in a suit for infringement a decree for a perpetual injunction was granted; that a second patent for a similar invention was issued, and that the defendant began to manufacture under the second patent. *Held*, that the court would not on motion declare that the injunction had been violated, but that the proper remedy was a new suit. *Truax v. Detweiler, 56 O. G. 662, C. D. 1891.

92. A prior adjudication sustaining a patent on the ground that the testimony was not sufficient to overcome the *prima facie* effect of the patent, said testimony being merely the statement by the defendant that he did not think there was any invention in the patent, is not sufficient to warrant the issuance of a preliminary injunction when the existence of an anticipating device is shown by testimony which is undisputed save by the opinion of an expert. *Jacobson v. Alpi, 57 O. G. 276, C. D. 1891.

93. Where upon a motion for a preliminary injunction to restrain infringement of certain patents it appears that these patents are anticipated by certain foreign patents, unless it is proved that the inventions patented were made at a certain time earlier than the dates of the applications, the finding of the examiner of interferences that the inventions were made at the earlier date is not sufficient to warrant the issuance of an injunction when the evidence upon which the examiner of interferences based his finding is not presented. *Siemens-Lungren Co. v. Hatch, 57 O. G. 1723, C. D. 1891.

94. Where the validity of complainants' patent is assailed, the fact that it has been sustained by adjudications of another court in the same district is not enough of itself to warrant the granting of a preliminary injunction by this court. *Whitcomb v. Girard Coal Co., 58 O. G. 523, C. D. 1892.

95. On appeal from a preliminary injunction

the prior adjudication on which such injunction was based will, in the absence of some controlling reason, have the same weight with the circuit court of appeals which it should have had with the circuit court which granted the injunction. *American Paper Pail & Box Co. v. National Folding Box & Paper Co., 61 O. G. 287, C. D. 1892.

96. The review of the interlocutory order for an injunction cannot be converted into a review of the final adjudication upon which it is based; but while the circuit court, upon a motion for an injunction, might deem itself constrained, contrary to its own judgment, to adopt the rulings of another circuit court upon questions of law made at final hearing, the circuit court of appeals is at liberty to re-examine such ruling, dispose of the questions of law conformably to its own convictions, and accord to the former adjudication such weight as in its judgment such adjudication was entitled to upon the motion. *Id.

97. Where letters patent have been twice sustained in another circuit, a preliminary injunction against infringers will issue as a matter of course, and such injunction will not be denied because of *ex parte* affidavits of alleged new evidence in respect to anticipation, especially when it appears doubtful whether such evidence was not known to the defendants in such prior cases, and that the defendant corporation herein was closely allied with the corporations defendant in the prior litigation and contributed to the expenses thereof, either directly or through its individual stockholders. *Brush Electric Co. v. Accumulator Co., 61 O. G. 726, C. D. 1892.

98. Where, however, an injunction will seriously affect defendants' business, and it appears that an appeal has been taken from the decisions in the other cases, the court will require complainants to give bond to secure payment of damages in case the injunction is subsequently dissolved. *Id.

99. Where upon motion for a preliminary injunction it is shown that the claim alleged to be infringed has already been adjudged by a federal court to be valid on substantially the same evidence as is presented with the motion, *held*, the validity of the claim for the purpose of issuing the injunction is thereby conclusively established. *S. S. White Dental Mfg. Co. v. Johnson, 64 O. G. 303, C. D. 1893.

100. In patent cases the infringement upon which a preliminary injunction will be granted must be without reasonable doubt and the

rights of the patentees clear, and, failing in prior adjudication in favor of the validity of a patent, there must be shown such continued public acquiescence in the exclusive right asserted as raises a presumption of validity of the patent. *Standard Elevator Co. v. Crane Elevator Co., 64 O. G. 438, C. D. 1893.

101. A decision of the supreme court of the United States sustaining a patent must be regarded as conclusive upon a motion for preliminary injunction. *American Bell Telephone Co. v. McKeesport Telephone Co., 64 O. G. 1134, C. D. 1893.

102. Complainant in a suit for the infringement of a patent is entitled to a preliminary injunction where it appears that the supreme court of the District of Columbia has in a prior suit sustained the validity of his patent. *S. S. White Dental Mfg. Co. v. Johnson, 64 O. G. 1268, C. D. 1893.

103. The granting of a preliminary injunction by a circuit court in a patent case does not require the issuance of such an injunction by another circuit court in a suit between different parties when the defense, though the same, is supported by additional evidence. *Edison Electric Light Co. v. Columbia Incandescent Lamp Co., 65 O. G. 133, C. D. 1893.

104. Where infringement is established and it is shown that the validity of complainant's patent has been sustained in a contested suit in another district, a preliminary injunction will be granted him when the only additional evidence is such that, had it been introduced in the prior suit, the decision of the court must, under the view expressed in its opinion, have been the same. *Sawyer Spindle Co. v. Taylor, 65 O. G. 300, C. D. 1893.

105. When a patent has been sustained by prior adjudications in the same circuit, on motion for a preliminary injunction in a subsequent suit against other parties, the only question open is that of infringement and consideration of all other questions will be postponed until the final hearing, except in cases where new evidence is presented which is in itself of such a conclusive character that if it had been presented in the former case it would have probably led to a different conclusion; but in such contingency the burden of showing this is upon the defendant. *Norton v. Eagle Automatic Can Co., 65 O. G. 442, C. D. 1893.

106. Where a patent has been fully adjudicated and held valid by the court of last resort and the respondent is aware of this fact, but nevertheless builds and puts in operation a

large number of infringing machines, relying upon the opinions of his experts, as opposed to the decision of the court, that said machines are not an infringement, the respondent must be considered as acting with his eyes open to the exact condition of affairs, and in such case cannot avert a preliminary injunction on the ground of hardship, it being clear to the court that under the prior adjudications his machines are an infringement. *Id.

107. Where, on motion for a preliminary injunction in a subsequent suit against other parties, certain prior patents are set up in anticipation, which were so set up in prior suits in the same circuit and therein held not to anticipate, such patents will not be considered on motion, and the prior adjudication in that regard will be held conclusive. *Id.

108. Where the circuit court of appeals has sustained the patent, its decision will be regarded as conclusive on a motion for a preliminary injunction. *Edison Electric Light Co. v. Philadelphia Trust, Safe Deposit and Insurance Co., Trustee, 66 O. G. 1597, C. D. 1894.

109. Although the validity of the patent sued on had been sustained in previous litigation and was beyond dispute, yet where on a motion for a preliminary injunction the proof of infringement is not clear and decisive, but is in doubt, and further, where the complainant is guilty of laches in standing idly by for several years during the time of the alleged infringement, *held*, that for these reasons the motion for preliminary injunction must be denied. *Brush Electric Co. v. Electric Storage Battery Co., 69 O. G. 1508, C. D. 1894.

110. The granting of an injunction by the supreme court of the District of Columbia without an opinion, where defendant had been a contestant in interference proceedings, *held* insufficient ground for a preliminary injunction in a suit against a different defendant. *Fenton Metallic Mfg. Co. v. Chase, 73 Fed. Rep. 831 (1896).

111. A decision granting a preliminary injunction, where no counsel appeared for defendant, though some affidavits were submitted in his behalf, does not preclude the court in a subsequent suit against a different defendant from considering anew the question of the validity of the patent. *Covert v. Travers Brothers Co., 75 O. G. 849, C. D. 1896.

112. An adjudication sustaining a patent is not conclusive in favor of granting a preliminary injunction in a suit in another circuit where a decisive question raised in the latter

suit was not contested in the former and it appears that in the former a motion for re-argument for the purpose of raising this point has been entertained but not yet decided. *American Graphophone Co. v. Leeds, 78 O. G. 802, C. D. 1878.

113. When a patent has been sustained by a circuit court of appeals, the only question open on a motion for a preliminary injunction in another suit is that of infringement, unless there is new evidence of such a conclusive character that, if introduced in the former case, it would probably have led to a different conclusion, the burden of establishing which is on defendant, against whom every reasonable doubt is to be resolved. *Tannage Patent Co. v. Adams, 79 O. G. 158, C. D. 1897.

(Affirmed, *verbatim*, in *Bowers v. Pacific Coast Dredging & Reclamation Co., 80 O. G. 2041, C. D. 1897. See cases therein cited.)

114. The appellate court sustained the patents in this case after *bona fide* and protracted litigation upon the merits. The proofs were voluminous and the defense was conducted by experienced counsel. The pendency of that suit was well known to the trade most interested in defeating the patents. It is then a fair presumption that the defense was exhaustive. *Id.

115. Where the court of appeals has decided that a patent is valid, its decision should be regarded as final until sufficient reason for departing from it shall be made to plainly appear, and the patentee should not, upon a motion to dissolve a preliminary injunction, be deprived of the advantage he holds as the result of such a decision upon anything less than thoroughly-convincing additional proofs. *Adams v. The Tannage Patent Co., 79 O. G. 2015, C. D. 1897.

VII. STAY OF.

116. It is well settled that while a patent may be adjudged valid and the defendant an infringer, the award of a preliminary injunction is purely a matter of discretion, and courts are in the habit of withholding it upon such terms as to the giving of a bond and the like as may seem just and equitable, having regard to the comparative injury that will result to the parties by granting or withholding it. *Consolidated Paper Mill Co. v. Coombs, 48 O. G. 973, C. D. 1889.

117. The power of the court to stay an injunction, even after final decree, not denied. *Id.

118. A complainant is ordinarily entitled to

an injunction after final hearing and decree in his favor, and in the southern district of New York it will be suspended only in exceptional cases. (*Pasteur v. Blount*, 61 O. G. 1484, 51 Fed. Rep. 610, disapproved.) **Lalace & Grosjean Mfg. Co. v. Habermann Mfg. Co.*, 62 O. G. 746, C. D. 1893.

INTERFERENCES.

(See APPEAL TO COURT OF APPEALS OF THE DISTRICT OF COLUMBIA; INTERFERING PATENTS.)

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- XXXII. VACATING JUDGMENT.

I. IN GENERAL.

(Interferences were first provided for in the act of 1793, and, under it, three persons acted as arbitrators, two being selected by the applicant and one by the secretary of state. The act of 1836 gave the commissioner of patents the same authority, subject to appeal to a board of examiners. By the act of 1839 this appeal was given to the chief justice of the district court of the United States for the District of Columbia. By the act of 1861 the primary examiner decided the issue, subject to appeal to examiners-in-chief and commissioner. The act of 1870 gave authority to appoint a special examiner of interferences, whose office still continues. Appeal now lies to the examiners-in-chief, the commissioner, and the court of appeals of the District of Columbia. This court was created by act of February 9, 1893. 27 Stat., 434, ch. 74.)

1. The primary examiner, having seen proper to grant a motion to dissolve the interference for the purpose of including another and earlier application filed by one of the contestants, occupies the same position he did when the interference was declared originally, and neither of the parties at this stage of the procedure has any right to demand or be furnished with a copy of such application. *White v. Demarest*, 41 O. G. 1161, C. D. 1887.

2. When the primary examiner declares an interference and prescribes the issue, he acts wholly without the cognizance of the respective parties to that issue, and they have no right then or at any time to be present before him to control his action in determining what applications shall be brought into the interference proceeding and what shall not. *Id.*

3. The ultimate authority under the statute upon the question whether an interference exists in fact is "the opinion of the commissioner" (Rev. Stats., sec. 4904), and it is more than doubtful whether a construction of rule 124 which would deprive the commissioner of jurisdiction could possibly be a valid one. *Mead v. Brown*, 48 O. G. 397, C. D. 1889.

4. Where it appeared that an earlier application disclosed the subject-matter claimed in a later application involved in interference, and the earlier application was filed in a name different from that under which the later application was filed, and the claim was made that both applications were by the same inventor, *held*, the only manner in which the applicant could have the benefit of the earlier application was by way of testimony in the case. *Oliver v. Everitt*, 49 O. G. 731, C. D. 1889.

5. There can be no doubt that an interference cannot be declared in the patent office between two patents. *Haish v. Rosado, v. Aish-ton*, 43 MS. D., 2 G. W. D., May, 1890 (Mitchell, Com'r).

6. When a completed application is filed accompanied by a proper oath, it is presumed by the office, for all purposes of the interference, that the party filing the application is an original inventor. This presumption extends throughout the entire course of the proceedings and stands unless overcome by the proofs duly taken in the case. *Gessner v. Miller*, 50 O. G. 433, C. D. 1890.

7. In an interference case the important point is to fix the earliest date of invention, and an issue is joined when the allegations of either party are met by the other's denial and

opposing testimony. The question of date is then to be decided, like any other question of fact, upon a preponderance of evidence. *Clark v. Broad*, 57 O. G. 1426, C. D. 1891.

8. The province of the patent office in interference cases is to determine the issue of priority, the construction of patents being for the courts to determine when the occasion arises upon infringement proceedings. **Iron-Clad Mfg. Co., Incorporated, v. Jacob J. Vollrath Mfg. Co., Limited*, 60 O. G. 1480, C. D. 1892.

9. 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*, 61 O. G. 885, C. D. 1892.

10. The object of an interference is to determine priority of invention, and if that question is properly raised as to a pending application it ought to be tried to a final issue, leaving questions of abandonment or public use or proper parties to be decided at the proper time. *Id.*

11. A decision upon an interference is conclusive between the parties when no steps are taken to set it aside. **Fassett v. Ewart Mfg. Co.*, 58 Fed. Rep. 360 (1893).

12. Where A. agreed to furnish the labor and material if B. would build a machine, with the understanding that if it worked well A. should pay a royalty on the product, to which B. consented, provided he be paid mechanic's wages during the construction, and where A. then caused B. to be engaged under his direction to make the machine in question, *held*, that judgment of originality must be awarded to B. *Greenfield v. Prentice*, 67 O. G. 1189, C. D. 1894.

13. A commissioner's decision is entitled to respect and consideration in every controversy, and where the controversy was properly disposed of in the patent office the court will not set aside the judgment of the commissioner where nothing has been presented to it which will justify such action. **Appleton v. Ecaubert*, 68 O. G. 1025, C. D. 1894.

14. The commissioner has no power to determine the question of priority between contestants except they be applicants for patents, or except one of them be an applicant to whom, if he should prevail, a patent might at the time of the decision be properly issued. (*Bourne v. Goodyear*, 9 Wall. 811; *Mills v. Green*, 16 S. C. R. 132; *Cheong Ah Moy v. United States*, 113 U. S. 216; *Dakota Co. v. Glidden*, 113 U. S. 222.) *Hopkinson v. Hunter*, 74 O. G. 653, C. D. 1896.

15. An independent inventor ignorant of an-

other's prior conception and diligent efforts in reducing to actual practice has the right to file an application without testing the practicability of his invention and to prosecute the same to the issue of a patent, and it could not be said that he had obtained the same surreptitiously or by unfair practices; but it does not follow that he can retain an advantage so obtained when it is made to appear intrinsically unjust. *Yates v. Huson, 74 O. G. 1732, C. D. 1896.

16. If one party has appropriated the invention of another and claims it as his own, there can properly be no question of priority of invention or of prior inventor. There is but one invention and one inventor, and the other is simply a claimant without right. Yet it is not to be supposed that rival claims of such parties do not constitute a proper subject for interference proceedings in the patent office. *Milton v. Kingsley, 75 O. G. 2195, C. D. 1896.

17. C. obtained a patent which discloses all the improvements embraced in the issue before he filed his present application; but such patent contained no claim to the present interfering subject-matter. This is significant of the facts that C. did not consider himself the inventor of the invention in question. Couch v. Finnegan, 77 O. G. 1595, C. D. 1896.

18. When lower tribunals of the office conclude that the inventions of two applications are the same and the commissioner concludes that they are different, since in interference cases the question of priority only is before the court, the court will not decide which is the proper theory, but will accept the theory of the commissioner. Each contestant is accordingly entitled to a patent for his particular invention. *Cushman v. Lines, 78 O. G. 2051, C. D. 1897.

19. Where fraud has been attempted upon a true inventor, and where another not the inventor has attempted to surreptitiously obtain a patent, the office will go to the limit of its jurisdiction, upon clear and convincing proof, to right such wrongs. Roberts v. Brinkman, 79 O. G. 1189, C. D. 1897.

20. In interference cases the proceeding to obtain a patent is distinctly judicial. The controversy is waged between adverse claims of the same right of property, and the public has no interest therein. It contains all the elements of a civil case — a complainant, a defendant and a judge — actor, *reus et judex*. (Fong Yui Ting v. United States, 149 U. S. 698, 729.) *Bernadin v. Seymour, Com'r of Patents, 79 O. G. 1190, C. D. 1897.

II. ACCESS TO AND PRODUCTION OF PAPERS IN PATENT OFFICE.

21. Under rule 126, when an application is involved in an interference, the adverse party thereto will be "permitted to see or obtain copies of the interfering claims and of so much of the specifications as relate thereto." *Ex parte Fischer*, 38 O. G. 1237, C. D. 1887.

22. During the pendency of an interference proceeding, and at any time before patent issues, the interference files, while accessible to each of the parties to such proceeding, are not accessible to any other person. *Id.*

23. When parties to an interference have entered into a written agreement to produce certain paper exhibits on file in the patent office at any session duly held for the taking of testimony, the commissioner will enforce the agreement by proper order upon the refusal of a party so bound to produce such papers. *Brungger v. Smith*, 57 O. G. 1883, C. D. 1891.

III. AMENDING APPLICATIONS.

24. Whether an applicant who has voluntarily eliminated his claims and apparently abandoned them should be permitted, after the invention has been publicly introduced and made commercially valuable, to return after eleven years and amend and claim an interference with a patent so long outstanding, is a serious question, and the right to relief should be most convincing. *McDonough v. Gray*, 46 O. G. 1245, C. D. 1889.

25. Where a motion was made by one of the parties to an interference to change the date of the filing of the completed application of one of the other parties to the date of the filing of an amendment by the latter, on the ground that before the filing of such amendment the latter had not clearly illustrated and described the invention in controversy, *held*, that the motion must be denied because rule 116 only takes cognizance of the filing dates of completed applications and ignores the dates of amendments altogether. *Steward v. Ellis, v. Lee, v. Howe*, 49 O. G. 1983, C. D. 1889.

26. It is within the discretion of the examiner of interferences to extend, upon a proper showing, the limitation of time within which a motion for leave to amend an application under rule 109 should be brought. *House v. Butler*, 62 O. G. 587, C. D. 1893.

IV. APPEAL.

(a) *In General.*

27. The brief statement of the reasons which rule 147 requires should accompany appeals in interference cases is not to be considered of the substance of the appeal in any such sense as that either the omission of such statement or the filing of a defective statement would make the appeal void, and if such statement be defective the opposite party is entitled to a further statement if he desires. *Pitney v. Smith and Egge*, 49 O. G. 129, C. D. 1889.

28. The commissioner has no power to determine what appeals, seasonably taken, are intended for delay. *Id.*

29. 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. Jaros*, 60 O. G. 1883, C. D. 1892.

30. While it is within the discretion of the commissioner to extend the limit of appeal in an interference case, he will not exercise it in a case where a party has deliberately allowed the limit for taking appeal to expire without action and the facts show that his subsequent petition is based upon a mere change of mind. *Guerrant v. Cable, v. Coffee*, 61 O. G. 285, C. D. 1892.

31. In all motions to dissolve an interference both parties have the right to appear and be heard before the primary examiner, and if the motion is appealable to the commissioner both parties are heard before him. No valid reason appears to exist for making an exception when 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, C. D. 1894.

32. During the pendency of appeal in an interference between a patentee and an applicant it conclusively appeared that it is not possible in any contingency to issue a patent to the applicant. *Held*, that the appeal should be dismissed without deciding the question of priority. *Hopkinson v. Hunter*, 74 O. G. 653, C. D. 1896.

33. Rule 123 of the patent office, which provides that in order to obtain a stay of proceedings motion must be made specifically to that effect, applies in reason and analogy to this

case. The running of the time for appeal was not arrested by filing the motion for rehearing. **Ross v. Loewer*, 77 O. G. 2141, C. D. 1896.

34. The fact that the court of appeals of the District of Columbia has refused to consider questions of patentability of issues in priority cases 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, C. D. 1897.

35. An error of procedure on the part of the commissioner cannot be construed as amounting to a final adjudication of the question of patentability of an issue. **Id.*

36. It is not competent for the court of appeals of the District of Columbia, in an interference proceeding, to abandon the question of priority and pass upon the patentability of the alleged invention. **Doyle v. McRoberts*, 79 O. G. 1029, C. D. 1897.

37. An appeal to the court of appeals of the District of Columbia in an interference case is not a proceeding in equity, and the provisions of Revised Statutes, section 4915, do not apply. It is a proceeding at law, and hence a decision of the supreme court of the United States as to the statute referred to does not apply in this case. **Id.*

38. A motion by the junior and defeated party to an interference to dismiss an appeal to the court of appeals of the District of Columbia upon the ground that there is no invention in the patent-right claimed is at variance with the oaths in the application and the preliminary statement. **Id.*

(b) *Appeal Lies.*

39. For a decision of the primary examiner granting or denying a motion to dissolve an interference on the ground that no interference in fact exists, an appeal lies to the commissioner under the first paragraph of rule 124 without any reference whatever to the reasons which the examiner may give for deciding the motion either affirmatively or negatively. *Von Welsbach v. Lungren*, 48 O. G. 537, C. D. 1889.

40. A motion to dismiss such appeal on the ground that the decision of the primary examiner is affirmative of appellant's right to a patent, that the law makes no provision for appeal from such favorable decision, and that the commissioner of patents is without jurisdiction of said appeal, must be denied. *Id.*

(c) *No Appeal Lies.*

41. The decision of the primary examiner is an adverse decision if it denies the patentability of the invention or the right of an applicant to make the claim, from which there exists no right of appeal. To permit an appeal under such circumstances would be a clear departure from a marked and peculiar feature in the procedure of the office, distinctly recognized in the statutes and rules relating to the subject. An applicant who has been in interference has no greater right in defeating the grant of a patent to his adversary than any other member of the public. The presumption is that the office will act against the improper issuance of patents. *Faure v. Bradley*, and *Crocker v. Cowles and Cowles*, 40 O. G. 243, C. D. 1887.

42. Section 482 does not provide for an appeal in such cases to the examiner-in-chief. *Id.*

43. The primary examiner having held that *Faure* had the right to make the claims and was not barred by the state of the art or publications, he could not do otherwise than overrule the motion to dissolve. From such decision no appeal lies. *Faure v. Bradley*, 44 O. G. 945, C. D. 1888.

44. No appeal lies to the commissioner from a decision upon a motion to dissolve except upon the ground that there is no interference in fact, or that there has been such irregularity in the declaration as to preclude a proper determination of the question of priority. *Manny v. Easley, v. Greenwood, Jr.*, 48 O. G. 538, C. D. 1889.

45. Where it appears upon the face of the papers that the real ground of a motion to dissolve relates to the merits, the commissioner will not take jurisdiction either by appeal or petition. *Id.*

46. It is no ground for an appeal from a decision of the examiner of interferences remanding a motion to dissolve filed seasonably in view of the showing made, to the primary examiner, that the reasons given in support of the claim that the interference issue is unpatentable were fully canvassed by the primary examiner before he originally declared the interference. Such motion simply makes a controversy *inter partes* before the examiner as to matter which he had previously considered in an *ex parte* matter. *Reynolds v. Haberman*, 49 O. G. 130, C. D. 1889.

47. From a decision of the examiner upon a motion to dissolve, involving the right of one of the parties to make the claim in issue, there

is no appeal to the commissioner. *Steward v. Ellis, v. Lee, v. Howe*, 49 O. G. 1983, C. D. 1889.

48. No appeal can be taken to any tribunal from a decision of a primary examiner affirming the patentability of a claim or the applicant's right to make the same. *Edison v. Stanley*, 56 O. G. 273, C. D. 1891.

49. When an interference is dissolved by the primary examiner on motion, appeal cannot properly be taken by the party bringing such motion, though granted on a part only of the grounds urged therein. *Zeitinger v. Reynolds, v. McIntire*, 57 O. G. 1279, C. D. 1891.

50. When in an interference case an appeal is taken to the examiners-in-chief on which appellant only has a right to be heard, his claims are the only ones to be considered; and any comment in their decision relative to the equivalence of the devices of the several parties to the interference, on which would depend the question of interference in fact, can properly have no binding effect upon the judgment of the primary examiner, which should be independent. *Id.*

51. An appeal from the action of the examiner of interferences in reinstating an interference will not lie. *Young v. Case*, 58 O. G. 945, C. D. 1892.

52. Objections to the operativeness or patentability of the subject-matter of the issue of an interference are not proper subjects for an interlocutory appeal to the commissioner from an examiner's refusal to dissolve the interference. *Lossier v. Willson, v. Cowles, and Cowles v. Rogers, v. Darling, v. Boguski, v. Gratzel*, 59 O. G. 1605, C. D. 1892.

53. A petition asking that the examiner of interferences be directed to reconsider his decision awarding priority, upon the ground that such decision is a travesty on equity practice, a gross injustice, that it is in direct contradiction to the evidence, and that the examiner has exceeded his powers, when the record of the case discloses that the examiner acted with deliberation and apparent fairness, is wholly unjustifiable and should not have been presented. *Clarke v. Pettengill, v. Crancer*, 77 O. G. 1271, C. D. 1896.

54. Appeal by Appert from refusal to grant motion to dissolve, brought upon the ground of no interference in fact and also upon the ground that Schmertz had not overcome French patent to Appert under rule 75, dismissed upon both grounds. *Schmertz v. Appert*, 77 O. G. 1784, C. D. 1896.

55. A holding that an applicant has not pre-

sented an affidavit sufficient to overcome a foreign patent under rule 75, since it relates to the merits, is not properly appealable to the commissioner. *Id.*

56. In an interference of two issues, one of which the commissioner decided was made by one contestant and the other by the other, when he also holds in the same decision that the two are structurally and patentably different, the party adjudged the prior inventor has no ground of appeal, since, if the commissioner was right in his holding, the first issue covers all that there is patentable, and if the commissioner is not right his mistake does not injure such prior inventor. *Shellaberger v. Schnabel, 77 O. G. 339, C. D. 1897.

57. When the commissioner decides that one of two issues of an interference was invented by one party and the other by the other party, but that the second issue has no patentable novelty to distinguish it from the one first invented, an appeal from his decision awarding priority of the second issue amounts to nothing more than a moot case and should not be adjudicated. **Id.*

(d) *Burden of Proof.*

1. In General.

58. 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. Hochhausen, 57 O. G. 545, C. D. 1897.*

59. A. filed an application July 31, 1890. B. filed an application April 21, 1891. A. filed his second application for substantially the same subject-matter as his first on April 23, 1891, accompanying it with a request that it take the place on the patent office files of his first application. Two days later he filed a formal abandonment of the first application. *Held,* that in an interference between the parties it was correct to give A. the benefit of the date of the filing of his first application for the purpose of fixing the burden of proof upon B. *Id.*

60. Where a party to an interference in which his divisional application is involved relies on an alleged statement of invention in his original application for the purpose of determining where the burden of proof lies, such statement must clearly and definitely cover the invention claimed in the divisional application. *Sprague v. Hunter, 59 O. G. 1605, C. D. 1892.*

61. Where it is admitted by the parties that a machine had been built from patterns designed by H., one of the contestants, but where S., the other contestant, claims that H. derived the invention from him, consequently that the reduction to practice ought to inure to his benefit, *held,* that the burden of proof is upon S. to prove his claim, and, failing to do so, priority of invention must be awarded to H. **Soley v. Hebbard, 70 O. G. 921, C. D. 1895.*

62. In such case the contestant, in order to prevail, must prove his claim by a clear and fair preponderance of evidence. **Id.*

63. The only question to be determined is priority. The burden of proof is upon complainants, and they must establish their proof beyond a reasonable doubt. **Standard Cartridge Co. v. Peters Cartridge Co., 72 O. G. 742, C. D. 1895.*

64. Testimony which should be rejected for insufficiency cannot be used in favor of a party on whom is the burden of proof to defeat another party, although the truthful intent of the witnesses may not be doubted. It is incumbent upon the party on whom is the burden of proof to produce such clear and direct evidence as will satisfactorily prove his case. **McCormick v. Cleal, 80 O. G. 1614, C. D. 1897.*

2. Upon Later Applicant.

65. Where in an interference case the contention of the junior party was that he was the originator of the improvement in controversy and communicated the invention to the senior party prior to the senior party's application for patent, and it appearing that there was a difference of five months between the filing dates of the respective applications, and that the senior party had constructed a machine in accordance with the idea involved in the invention, while the junior party had never done so, *held,* that these facts raised a very strong presumption in favor of the prior applicant, and that the burden was strongly and squarely upon the junior party to show the origination and disclosure which he claimed. *Zerbe v. Ohl, 58 O. G. 1839, C. D. 1892.*

66. Where an attorney and skilled expert of a company made application for certain patents with the full knowledge of the company, and the president of the company applied for patents for the same invention, sixteen and seven months, respectively, later than the senior party, *held,* that the presumption and probabilities are all with the senior party and

can only be rebutted by the strongest possible proof. *Tompkins v. Selkirk*, 59 O. G. 629, C. D. 1892.

67. K. filed his application before M., and the reduction to practice of the invention claimed by both was under the direction of K. exclusively. "He is now in the position of a defendant in possession. The burden of proof is upon his opponent to show, not only that he at some time had the idea, but that he had it first, and also that this idea, once exclusively his, was actually communicated to Kingsley; otherwise he can take no benefit from the reduction to practice." (Citing *Solely v. Hebbard*, 70 O. G. 921, C. of App. D. C., Jan. 7, 1895.) *Milton v. Kingsley*, 71 O. G. 887, C. D. 1895.

68. In such a case, where the reduction to practice by one of two associated inventors has put him in the position of a defendant in possession and placed the burden of proof upon his opponent, "it will not do merely to raise a doubt upon this point. There must be a reasonable preponderance of evidence in order to overcome the presumption of right arising from the state of one in possession." (*Ibid.*) *Id.*

3. On Party Last to Claim (Rule 116).

Rule 116 of the Rules of Practice of the 13th Revised Edition, April 1, 1892, was as follows:

116. In original proceedings in cases of interference the several parties will be presumed to have made the invention in the chronological order in which they claimed the same in their completed applications for patents clearly illustrating and describing the invention; and the burden of proof will rest upon the party who shall seek to establish a different state of facts. (1897, 111.)

In the present edition of the rules, promulgated June 18, 1897, this rule was changed by omitting the italicized words "claimed the same in," and substituting the word "filed."

69. Where one party to an interference filed his application in March, 1887, and the other in February, 1887, and the former asserted that he communicated the invention to the latter, and that he (the latter) simply embodied as a constructor and mechanic the ideas conceived by the former and described by him to the latter, and that even if the latter were an original inventor he (the former) was the first to conceive of the subject-matter in interference, and was using due diligence in reducing the invention to practice, while the latter was making the complete machine, it was held that the burden of proof was upon the former to establish one of those propositions under rule 116, and that the burden is discharged by establishing a fair preponderance of legal evidence in behalf of

him upon whom the burden rests. *Wherry v. Heck*, 49 O. G. 559, C. D. 1889.

70. The object of ascertaining which of two contesting applicants first disclosed in a completed application the invention in controversy is to determine not only upon whom should rest the burden of proof under rule 116, but also in whose favor a judgment may be rendered upon the record, in case the opposite party fail to file a preliminary statement or such statement fail to overcome the *prima facie* case made by the respective dates of application. (Rule 114.) *Oliver v. Everitt*, 49 O. G. 731, C. D. 1889.

71. Rule 116, placing the burden of proof upon the last applicant, means precisely what it says. It announces that the last applicant must prove his case or fail. Nor is the rule an arbitrary one. It has its foundation in the same legal principle which finds expression in the maxim *prior tempore potior jure*. The senior party litigant has a right to expect that the rule will be applied and that he may be absolutely silent until a *prima facie* case is made out against him. *Ecaubert v. Hofmann*, 52 O. G. 2107, C. D. 1890.

72. The relation of the parties, under rule 116, is to be determined by the date on which each applicant made his claim or equivalent statement of invention for the subject-matter involved in the interference issue. *Rennyson v. Merritt*, 58 O. G. 1415, C. D. 1896.

73. 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 of invention equivalent thereto until after the same was claimed by the other party to the interference. *Reichenbach v. Goodwin*, 63 O. G. 311, C. D. 1893.

74. Rule 116, as recently amended and construed in the light of decisions bearing upon it, means that he who first made a claim or statement of invention covering the invention in interference should be considered the senior party. *Huson v. Crowell, v. Yates*, 64 O. G. 1006, C. D. 1893.

75. The word "claimed" in rule 116 does not include the description or any part thereof; and the first to make a claim covering the invention is the senior party. *Edison v. Ball*, 71 O. G. 1313, C. D. 1895.

76. The first to make a claim in substance and effect covering the invention is the senior party. (*Edison v. Ball*, 71 O. G. 1313.) *Richardson v. Leidgen*, 77 O. G. 153, C. D. 1896.

77. The sole purpose of rule 116 is to deter-

mine the position of parties as plaintiff and defendant, in order to determine who shall first take testimony. Failure of junior party to bring motion to shift the burden of proof raises no presumption that his application involved is not a division of an earlier one. In any case he may introduce his earlier one to show that he made the invention of the issue before the date of the application involved. *Phelps v. Hardy, v. Gattman and Stern*, 77 O. G. 631, C. D. 1896.

4. When Patent Has Issued to One Contestant.

(See INTERFERENCE; DECLARATION; APPLICATION AND PATENT, *infra*.)

78. When one of the parties to an interference is a patentee the burden of proof is heavily upon his opponents, and, unless the evidence is such as would be held sufficient by a court to invalidate the patent already granted, the decision will be in favor of the patentee. *De-prez and Carpentier v. Bernstein*, 54 O. G. 1711, C. D. 1891.

79. The burden of proof is heavily upon an applicant striving to overthrow a prior patent. This burden is only shifted, when the applicant has overcome the patentee's *prima facie* case, arising from the previous grant of a patent, by proof beyond a reasonable doubt. *Hansen v. Davis*, 55 O. G. 998, C. D. 1891.

80. 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. *Id.*

81. Since patents are now re-issued strictly for the same invention covered by the original patent, and since the surrender of the original patent does not take effect until the issue of the amended patent, a re-issue application ought to have the same standing as to burden of proof as the original patent has. *Id.*

82. When one of the contestants has a patent for the invention in dispute and the other is an applicant for a patent, the latter, in order to prevail, must present a case, both as to conception and as to reasonable diligence, which does not admit of a reasonable doubt. *Hunter v. Jenkin*, 56 O. G. 1705, C. D. 1891.

83. In an interference where neither party establishes a perfectly clear case on the evi-

dence, the presumption is in favor of a party having a patent as against one who has not, and the latter, in order to prevail, needs to establish his case by proof which does not admit of a reasonable doubt. *Weston v. Richardson*, 57 O. G. 1425, C. D. 1891.

84. Where an applicant for patent seeks to overcome a patent already granted, he must make out a case both as to conception and diligence in reduction to practice which does not admit of a reasonable doubt. (Following *Hunter v. Jenkin*, 56 O. G. 1705.) *Hunter v. Van Depoele*, 57 O. G. 1720, C. D. 1891.

85. In an interference an applicant to prevail against a patent already granted must prove his case beyond a reasonable doubt. (Following *Hunter v. Jenkin*, 56 O. G. 1705.) *Dillon v. Kimball and Wirt*, 58 O. G. 384, C. D. 1892.

86. Where it appears that an applicant for a patent in interference with a patent already granted contracted with the original patentees, before making his application, to manufacture and supply them with certain articles to be made under their patent, his subsequent application and the evidence offered to support it should be subjected to the sharpest scrutiny. *Id.*

87. A patent is of weight as evidence in favor of the patentee upon his contention that he is the first inventor, and it is a sound and recognized administrative rule that a second patent should not issue for the same invention to a rival claimant except in a clear case. *La Flare v. Chase*, 72 O. G. 741, C. D. 1895.

88. The application which eventuated in the Mayhew patent was filed during the life of the Kelleher and Grimm caveat. Kelleher and Grimm made application after the expiration of the caveat and the grant of the Mayhew patent. The presumption is that the office did its duty in notifying Kelleher and Grimm of the filing of the interfering application, and the burden was upon them to establish their allegation of no notice by adequate proof. *Kelleher and Grimm v. Mayhew*, 72 O. G. 895, C. D. 1895.

89. The patent to Mayhew need not be treated as an application, because the presumption is against the lack of notice to the caveator and because there is no direct evidence that Kelleher and Grimm did not know of the Mayhew application. *Id.*

90. Pratt and Johns, in view of the issue of the patent to their opponent, have the burden of showing beyond a reasonable doubt that

they are prior inventors and entitled to a patent for the same subject-matter. *Pratt and Johns v. Thompson*, 72 O. G. 1347, C. D. 1895.

91. The record held not to show that Thomson's patent was inadvertently issued, or that Pratt and Johns' application was not before the examiner who passed Thomson's application to issue, or that it was not done upon full consideration. In whatsoever division either application may have been, it is to be presumed that the office in treating one knew of the other, and that when the Thomson patent issued it was considered that he was justly entitled to his patent. The burden of proof is therefore on his opponent. *Id.*

92. Where a patent has been regularly issued and a question of anticipation or priority is raised in a suit for infringement or in proceedings in interference, a strict rule as to the proof required to overcome the patent, especially where the testimony from its nature and circumstances is open to suspicion, should prevail. **Wurts v. Harrington*, 79 O. G. 337, C. D. 1897.

93. The fact that a patent has been issued irregularly during the pendency of an interfering application does not give it an advantage in the interference proceeding, and such proceedings should be governed by the ordinary rules of the courts of law in respect to the burden of proof. **Id.*

94. The burden of proof is upon the party who is the last to file his application in the office, and this status of the parties is not changed by the fact that the junior applicant may have obtained a patent. **Hunt v. McCaslin*, 79 O. G. 861, C. D. 1897.

95. When one of the parties to an interference has received a patent, this on its face affords *prima facie* evidence that he is the inventor and that the thing patented is a novelty, and the patentee will not be defeated of his rights under the grant unless the applicant shall establish the priority of his invention beyond a reasonable doubt, and shall also show diligence in reduction to practice, especially where the question of priority has been passed upon in the same way by the various officials of the office. *Doyle v. McRoberts*, 79 O. G. 1029, C. D. 1897.

V. CAVEAT.

96. Congress, in the very statute which required inventors to file applications in the patent office, expressly provided that all applications interfering with *caveats* should be de-

posited in the confidential archives and be therefore privileged (Rev. St., sec. 4902), and inferentially they only. **Edison Electric Light Co. v. United States Electric Lighting Co.*, 45 Fed. Rep. 55 (1891).

97. In patent act of 1836, the three months in which a caveator's rights were regarded did not begin to run until after the caveator had received the notice of the filing of an interfering application. The act of 1861, however, changed the law in this respect and provided that the three months should begin to run from deposit in the patent office, plus the regular time for transmission to caveator. This is substantially what is required by the Revised Statutes. *Held*, that three months and two days were sufficient in this particular case, and that the commissioner has no power to extend the time. *Ex parte Moore*, 52 MS. D., Feb., 1893 (Frothingham, Ass't Com'r).

VI. CONCEPTION OF INVENTION.

98. If the thing described in the abandoned application is the same invention that is subsequently patented, it certainly does establish conception of the invention as of its own date, and if proof *dehors* the patent establishes reduction to practice or introduction into public use, and the time of the reduction to practice or public use is in dispute, then the application shows that reduction to practice *might* have taken place at any time subsequent to its date; but when, as in the present case, there is no proof even of experiment, it can have no other effect than to establish the date of conception of the invention which it discloses. *Beach v. Fowler*, 48 O. G. 821, C. D. 1889.

99. An abandoned application establishes only a date of conception. (*Beach v. Fowler*, C. D. 1889, 187; *Webster v. Sandford*, C. D. 1888, 92.) *Hien v. Pungs*, 68 O. G. 657, C. D. 1894.

100. The fact that sketches relied upon to establish conception are rude and imperfect and do not show a working machine is not a vital defect if skilled operators could from such sketches construct a machine embodying the improvement in dispute. **Standard Cartridge Co. v. Peters Cartridge Co.*, 78 O. G. 621, C. D. 1897.

101. A complete conception as defined in an issue of priority of invention is matter of fact and must be clearly established by proof. The conception of the invention consists in the complete performance of the mental part of

the inventive act. All that remains to be accomplished in order to perfect the act or instrument belongs to the department of construction, not invention. It is therefore the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice that constitutes an available conception within the meaning of the patent law. *Mergenthaler v. Scudder, 81 O. G. 1417, C. D. 1897.

102. The date of the conception is the date when the idea of means, including all the essential attributes of the invention, becomes so clearly defined in the mind of the inventor as to be capable of exterior expression; and it is settled both by practice and express decision that such exterior expression of the mind of the inventor, when relating to machinery, may be by exhibits either in the form of drawings or by model, so as to lay the foundation of a claim to priority, if thereby the invention be made sufficiently plain to enable those skilled in the art to understand it. *Id.

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

104. Any full and accurate description of the invention, either in words or drawings or by model, if it be of a machine, or even an unsuccessful effort to embody the conception, when the effort discloses that the idea was complete, will suffice, although the attempt to represent it may have failed. In the absence of all other proof, the date of the application for a patent, if containing a complete description, is taken as the date of the conception. *Id.

105. If drawings be exhibited and relied on as evidence of the conception of the invention, they must show a complete conception, free from ambiguity or doubt, and such as would enable the inventor or others skilled in the art to reduce the conception to practice without any further exercise of inventive skill. *Id.

106. Where drawings are in many essential particulars defective and wanting in completeness as means of showing and illustrating an invention involved in interference, such defects and want of completeness in the drawings cannot be aided and the defective drawings made effective by construction or by reference to the prior state of the art. *Id.

107. Where an inventor has undertaken to invent and construct a machine essentially different from pre-existing machines and not simply a mere improvement upon previous inventions, it is necessary for him to furnish such full, clear and definite drawings of his invention to prove conception as will enable any person skilled in the art of construction of such machines to reduce the invention to practical form. *Id.

VII. COPYING CLAIMS OF OPPONENT.

108. The practice of appropriating literally the claim of a later invention which is drawn with reference to the employment of terms found in the preceding specification, and then applying the claim so appropriated to a specification of an older date which does not contain words and expressions suitable to lead up to the language of the appropriated claim, condemned. Rogers v. Winssinger, 56 O. G. 804, C. D. 1891.

109. Where an applicant copied the claims of a patent and thus provoked an interference, held, that all tribunals that pass upon the question of priority of invention must decide whether the applicant is entitled to claim that invention in his application. Reichenbach v. Goodwin, 63 O. G. 311, C. D. 1893.

VIII. DECLARATION OF.

(a) *Application and Patent.*

(See INTERFERENCE; BURDEN OF PROOF; WHEN ONE CONTENDANT HAS A PATENT.)

110. An applicant for patent is not entitled to an interference with an unexpired domestic patent until he has been actually rejected on such patent. Ex parte Massicks and Crooke, 38 O. G. 1489, C. D. 1887.

111. An interference is declared between an applicant and a patentee for the sole purpose of determining whether a patent shall issue or be refused to the applicant, and when the question is settled the patentee has no further interest or concern in the case. *Beardslee v. Moeslein, 46 O. G. 1640, C. D. 1889.

112. The fact that in such case the office failed to declare an interference prior to the issue of the patent does not establish the fact that there is no conflict between the application and the patent. Bechman v. Johnson, 48 O. G. 673, C. D. 1889.

113. A patent issued inadvertently while another application for the same invention was

pending is as against such application to be treated, for purposes of interference, as an application still pending. *Ex parte Boyer*, 49 O. G. 1985, C. D. 1889.

114. An interference should not be declared between a pending application and a patent granted before such application was filed until the applicant overcomes the patent as a reference by the method provided in rule 94, 2, *i. e.* by filing affidavit. *Tavener v. Thomson*, 51 O. G. 1465, C. D. 1890.

115. Kellogg's original application, upon which patent issued to him July 31, 1888, which he seeks to correct by re-issue, was filed July 30, 1887. Carty's application was filed November 17, 1887, and was not put into condition for an interference for five years after the issue of the Kellogg patent. There is nothing in the record to show that in the opinion of the commissioner of that time an interference did exist or that such was the opinion of any examiner in the office, except the fact that an interference was afterward declared, and the patent cannot now be treated as an application. *Carty v. Kellogg*, 73 O. G. 285, C. D. 1895.

116. The status of a patentee in an interference maintained, although the interfering application was filed one day before the patent issued, because of the exigencies of the office work. It cannot be considered that the law contemplated the instantaneous examination of applications out of order, for the purpose of withdrawing from issue patents which have already been printed and signed, and are ready to be mailed, and the substance of which has been set forth in drawings published in the gazette accompanying the claims. *Bolens v. Morgan*, 60 MS. D., Dec., 1896 (Seymour, Com'r).

(b) *Claims; Genus and Species.*

117. An interference should not be declared between an unexpired patent which shows and claims one species of an invention and a subsequent application disclosing another and different species, even though the latter contains a claim of sufficient scope to include the species claimed in the unexpired patent. *Reed v. Landman*, 55 O. G. 1275, C. D. 1891.

118. Where a patentee claiming specifically would be entitled to all of 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. *Id.*

119. In case of an article of manufacture, when an applicant has claimed a genus and a patentee a species clearly coming within this genus, and the applicant has recited the same species in his application as being within the genus, there is an interference in fact. *Edison v. Stanley*, 57 O. G. 273, C. D. 1891.

120. An interference in fact exists between an application showing and describing several species and containing generic claims that cover all of such species and an unexpired patent containing claims based upon and limited to one of the species covered by the generic claims of the application. *Zeitinger v. Reynolds, v. McIntire*, 57 O. G. 1279, C. D. 1891.

121. When an unexpired patent contains claims limited to a single species and an application shows and describes several species, all different from that claimed in the patent, but contains generic claims broad enough to cover the species of both patent and application, there is no interference in fact. *Id.*

122. The rule of *Reed v. Landman* (55 O. G. 1275) does not apply where both parties are applicants. *Kinyon v. Carter*, 66 O. G. 513, C. D. 1893.

123. Where different specific forms are shown by two applicants, both capable of being covered by a broad claim, and one applicant makes such broad claim and the other makes a more limited claim to the same structure, there is an interference, which may be avoided by the disclaimer provided for by rule 107. *Id.*

124. Where two applications are pending concurrently and the claims of one dominate those of the other, an interference should be declared. *Grimmett v. Willett*, 66 O. G. 1006, C. D. 1894.

125. Where an unexpired patent shows and describes two species and contains a claim in an alternative form which includes both species, and an application shows and describes one of the species and contains a generic claim, an interference in fact exists. *Duncan v. Westinghouse, Jr.*, 66 O. G. 1005, C. D. 1894.

(c) *Claims; Subjects-matter Must Conflict.*

126. The primary examiner, when declaring an interference, must look alone to the language of the applications. *Faure v. Bradley*, 44 O. G. 945, C. D. 1888.

127. The inquiry in every case, whether or not an interference in fact exists, is whether the claims conflict; but in determining whether such conflict exists the subject-matter claimed

in the respective applications is to be considered and is to govern the conclusion, whatever resemblances or differences may exist in mere methods of expression. *Gray v. Robertson*, 50 O. G. 165, C. D. 1890.

128. Where the controversy related to teleautograph systems and the claims which were in interference consisted of combinations involving the use of a pen or stylus and a "pen supporter," in connection with the operation of receiving the message, but the instruments were different and differed in modes of operation, *held*, that there was no interference in fact. *Id.*

129. It is not sufficient that an applicant copy the claim of a patentee with the view of securing an interference, but the claims must conflict in subject-matter and not in language only. (*Gray v. Robertson*, 50 O. G. 165, follow.) *Bissell v. Robert*, 51 O. G. 1618, C. D. 1890.

130. When there is no interference by reason of conflicting subject-matter care should be taken on the part of the office to prevent an appearance of sameness because of similarity of language employed. *Id.*

131. There is nothing in *Ex parte Upton* that affords any warrant for the view that claims can conflict which are not for the same invention either generically or specifically stated. *Crane v. Merriam*, 51 O. G. 1783, C. D. 1890.

132. Interferences in the patent office, like interferences in the courts, exist only when the claimed inventions conflict. *Reed v. Landman*, 55 O. G. 1275, C. D. 1891.

133. The question whether an interference in fact exists depends not merely upon the language employed in the respective claims, but upon the question whether, in addition to similarity in phraseology, there is an interference between the subjects-matter of the respective claims. *Rogers v. Winssinger*, 56 O. G. 804, C. D. 1891.

134. A claim should not be included in an interference which is broader than the issue although there may be an interference in fact. *Ex parte Thomson*, 51 MS. D., Nov., 1892 (*Frothingham*, Ass't Com'r).

135. The test of an interference resides in the claims and not in mere disclosures in the application, and office rules must be construed in connection with this settled principle of law. *Van Depoele v. Daft*, 58 O. G. 520, C. D. 1892.

136. It is not enough for an application sought to be put in interference to merely

show and describe matter properly within the interference issue; but it must also claim such matter. (Following *Van Depoele v. Daft*, 58 O. G. 520.) *Searle v. Frumveller*, v. Sessions, 58 O. G. 804, C. D. 1892.

137. An interference should not necessarily be declared between two applications simply because a claim of one of them would dominate a claim of the other unless it also appears that the two applications are based upon the same structure of invention. *Id.*

138. Applications interfere only when they claim in whole or in part the same invention. (Citing *Gold and Silver Ore Separating Co. v. U. S. Disintegrating Co.*, 6 Blatchf. 307.) *Dodd v. Reading*, 58 O. G. 1413, C. D. 1892.

139. An interference is declared between the applications or inventions involved rather than between the applicants or patentees. *Snyder v. Kanneberg*, 58 O. G. 1840, C. D. 1892.

140. Where the devices covered by the claims of the two applications are substantially alike in structure and mode of operation, there is an interference in fact even though the claims are not the same in scope. *Moore v. Holland*, 63 O. G. 1962, C. D. 1893.

141. Where the claim in a patent contains an element not disclosed in an application involved in an interference with the patent, and where the applicant cannot make a claim that will be commensurate in terms with the claim of the patent, no interference in fact exists. *Dixon v. Van Auken*, 64 O. G. 1005, C. D. 1893.

142. The interference was declared on a claim for a "platen detachably connected with the power-driving mechanism and provided with a counterbalancing weight." In the *Christie* invention, however, the point of disconnection was between the ratchet-wheel and the lever-pawl. *Held*, that this construction was fairly within the language of the claim and interference, notwithstanding that the point of disconnection was not immediately at the platen proper, and that there was an interference between the two inventions. **Christie v. Seybold*, 64 O. G. 1650, C. D. 1893.

143. Interference cannot properly be declared except when two applications or a patent and an application conflict with each other. If the alleged inventions are substantially different from each other, so as to be each of them patentable, there is no ground for interference. In this case no question of priority can arise. *Cushman v. Lines*, 78 O. G. 2051, C. D. 1897.

IX. DISCLAIMER.

(See DISCLAIMER IN APPLICATION.)

144. Where, after an interference has been decided, the losing party thereto amends his application and cancels the claims which had been in such interference, he should not be required to formally *disclaim* the subject-matter described therein and which he has so canceled. *Ex parte Firm*, 39 O. G. 1199, C. D. 1887.

145. There is no law or rule which requires an applicant under such circumstances to enter a disclaimer. If the specification is too broad, if it covers any of the matter which has been in interference, or if it is so indistinct, informal or ambiguous that the public may be imposed upon by the issuance of a patent, it is the duty of the examiner to require correction and modification, so as to bring the case within the rules of the office, and if such modification be not made to refuse the patent. *Id.*

146. The effect of rule 104 is simply to allow one of the applicants to anticipate the award of priority in the interference, and to place himself in the condition he would be in had the proceedings continued regularly and the award been made; but it certainly cannot be extended by implication. *Id.*

147. Rule 107 makes no distinction between interferences which involve a conflict between co-extensive claims and interferences which involve a conflict between generic claims and subordinate specific claims, in respect of the period within which the disclaimer may be made. *Clark v. Lord, v. Grimes*, 51 O. G. 1943, C. D. 1890.

148. In case of an interference between a specific claim and a generic claim, the applicant making the specific claim is supposed to know from the time of the declaration of the interference what the "matter in issue" is, and that it is the matter in issue which he is required to disclaim in order to have the benefit of the rule. *Id.*

149. Rule 107 does not require that the tender of a disclaimer before the date fixed for the filing of the preliminary statement of the party proffering the disclaimer should be by motion, or that notice thereof should be given to the opposite party. **Diescher v. Walker, v. Diescher and McGill*, 52 O. G. 459, C. D. 1890.

150. While each party is in ignorance of the character of his opponent's invention the interference is declared, and before either party is entitled to have the veil of secrecy lifted the

office determines when a disclaimer is tendered whether the interference should continue. **Id.*

151. It is to be distinctly understood that this ruling extends only to cases where a disclaimer is tendered unaccompanied by any motion in the case. If, for instance, motion is made to suspend the interference pending the determination of the question whether the disclaimer ought to be permitted, the case is, as to such motion, a contested one, and notice should be given, as in other cases. **Id.*

152. Where in an interference the claims of one applicant dominate those of the other, the interference may be dissolved by filing a proper disclaimer by the applicant having the narrow claims. *Grimmet v. Willet*, 66 O. G. 1006, C. D. 1894.

(See, also, *Ex parte Greenwood*, 17 O. G. 626, C. D. 1880.)

153. It is the usual practice to allow entry of a disclaimer of the issue in an interference, leaving the question whether the disclaimant's claim is patentable over the issue to be determined *ex parte*. (Cases cited.) *Millar and Miller v. Calm*, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

154. Rule 107 should be considered as a whole. Applying the provisions of the first part of the rule to the second part, a copy of the disclaimer required by the second part must be made a part of the specification. *Cook v. Stover*, 76 O. G. 2007, C. D. 1896.

X. DISCLOSURE.

155. The descriptive language used should be such as to disclose the invention as a drawing would disclose it. The description, on its face, as detailed by the witness, must show not only that the applicant had a conception of the desirability of doing the thing, but also a conception of a way of doing it, and a way of doing it so definitely thought out that the listener, if skilled in the art, could produce the invention from the description, at least in a rude form of embodiment. *Wherry v. Heck*, 49 O. G. 559, C. D. 1889.

156. To constitute a disclosure of an invention of improvements of a known machine, it is not necessary that sketches made and shown by the inventor should have shown an organized machine. It is sufficient if the invention of the particular improvements is clearly and intelligently shown. *Ligowsky v. Peters, v. Hisey*, 57 O. G. 1595, C. D. 1891.

157. The disclosure by an inventor to his attorney entitles the inventor to the benefit of the rule laid down in *Agawam Co. v. Jordan* (7 Wall. 583) in a subsequent interference between the parties, the issue of which is the disclosed invention. *Wheaton v. Kendall*, 62 O. G. 1516, C. D. 1893.

XI. DISSOLUTION.

(a) *In General.*

158. A motion to dissolve an interference may be granted for the purpose of including another and earlier application filed by one of the contestants. *White v. Demarest*, 41 O. G. 1161, C. D. 1887.

159. Motion for dissolution of interference refused between a joint patent and a sole application, which was filed by one of the joint patentees. *Kohler v. Kohler and Chambers*, 40 O. G. 247, C. D. 1888.

160. Motion to dissolve interferences for the following reasons: *First*, that the foreign patents set forth by Faure in his preliminary statement are not patents for the invention in issue; *second*, that the invention in issue is a broader invention than that patented to Faure in the foreign patents set forth in his preliminary statement, and that on the principle of re-issues he is barred from making claims broader than those contained in his foreign patents. The question whether the invention covered by foreign patents is the same as that involved in interference, and therefore that such patentee is not entitled to the dates of such foreign patents, must be determined by the evidence adduced on the trial. The examiner of interferences has the exclusive right to determine the competency, construction, scope and legal meaning of the foreign patents or of any other evidence introduced, and to decide whether they cover the same invention as that involved in the interference. *Faure v. Bradley and Crocker v. Cowies and Cowles*, 44 O. G. 945, C. D. 1888.

161. The application is the procedure to obtain a patent, and, strictly speaking, a motion to dissolve an interference cannot be predicated upon something found in a preliminary statement, or anything *dehors* the application. *Id.*

162. There is no rule which requires that the facts upon which a motion to dissolve is based should be stated in the motion. If facts are, however, relied upon other than those disclosed by the record, they should be stated in order to

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

163. There is nothing in the rules that limits the questions to be discussed upon a motion to dissolve to those which have not previously been considered by the primary examiner. One object to be secured by such motions is to enable the examiner to decide *inter partes* what he had previously decided without a hearing. *Id.*

164. Whatever appears incidentally from the testimony in bar of the right of a party to a patent is, under the established practice of the office, not to be considered in a motion to dissolve; but in the interference the motions to dissolve contemplated by rule 122 are upon grounds which appear from the records to have existed before the testimony was taken. *Cook v. Leach*, 42 MS. D., March, 1890 (Fisher, Acting Com'r).

165. Upon a proper showing the jurisdiction of the examiner of interferences will be restored for the purpose of considering a motion to dissolve the interference. *Short v. Sprague*, 56 O. G. 1708, (C. D.), 1891.

166. When new claims are admitted, either under the original issue or under a new issue, in accordance with the provisions of rule 109, *held*, that any or all motions provided for in rule 122 may be brought in connection with the new claims and the issue including the same, even though such motions were brought and the questions raised thereby decided under the interference as originally declared. *Jenne v. Brown, v. Booth*, 59 O. G. 158, C. D. 1892.

167. Where a party to an interference moved its dissolution on the ground that the opposing party was estopped by a prior interference, and appealed from the action of the examiner of interferences transmitting the case to the primary examiner for his decision, the appellant alleging that the examiner of interferences should have himself decided the motion, since it did not go to the right of the opposing party to make the claim involved, *held* not to be a real distinction, and the examiner of interferences affirmed. *Foglesong v. Hutt*, 61 O. G. 151, C. D. 1892.

168. The granting of a motion to stay the proceedings pending the determination of a motion to dissolve does not release the interferents from a requirement to file other motions specially provided for within a stated period. *Lamb v. Warren*, 64 O. G. 437, C. D. 1893.

169. The primary examiner has authority to decide a question of dissolution of an interference which was instituted by the commissioner in person. *Ball v. Edison*, 53 MS. D., Nov., 1893 (Fisher, Ass't Com'r).

170. Motion to dissolve an interference between applications containing a broad and narrow claim respectively. A reason for not dissolving is that the features of novelty on which the claims were allowed are the same in each case, and that the differences of the specific claim over the broad one are held by the examiner immaterial in view of the prior state of the art. *Kinyon v. Carter*, 66 O. G. 518, C. D. 1894.

171. Where applicant's prior British patent became void by reason of failure to pay the renewal fee, which fact was published in the Illustrated Official Journal, and he was called on to show cause why an interference in which his application was involved should not be dissolved for the reason that he had no right to make the claim, and he made no reply, *held*, that his refusal to show cause was the full equivalent of testimony that the fee had not been paid. *Ex parte Armstrong*, 71 O. G. 1615, C. D. 1895.

172. Parts of Miller's application having been filed on February 3, 1894, and the application completed December 21, 1894, the interference dissolved to permit the primary examiner to require an oath applying to the later date. *Miller v. Lambert*, 72 O. G. 1903, C. D. 1895.

173. An interference dissolved when the claims of each case cannot be read upon the other in view of the prior art. (*Reed v. Landman*, C. D. 1891, 73.) *Barr v. McLennan*, 61 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

174. A motion to dissolve is a mere suggestion and not proof, and is not to be granted as a matter of course at any stage of the interference. *Hageman v. Young*, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

175. When it is doubtful, in view of the state of the art, whether either party could make the interfering claims, the interference will be dissolved. *Newton v. Woodward*, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

176. Where a party fails to make a full presentation of his case on a motion for dissolution, but relies on the case as presented, *held*, that he is bound by the decision rendered, and a rehearing will not be granted merely to permit of a further showing, but only on grounds which would warrant a new trial at law. *Bechman v. Wood*, 81 O. G. 2085, C. D. 1897.

177. The office may of its own motion, under the provisions of rule 126, take cognizance of matter which would properly constitute a basis for a motion to dissolve without regard to the fact that such motion has been previously made. *Id.*

178. All grounds for dissolution should be presented in one motion, since it is contrary to the established practice of the office to allow a party to make motions to dissolve by piecemeal. *Id.*

(For requirements of a motion to dissolve, see *Green v. Hall*, *v. Siemens*, *v. Field*, 37 O. G. 1475, C. D. 1886; *Law v. Woolf*, 55 O. G. 1527, C. D. 1891.)

(b) *Appeal.*

179. When an interference is remanded to the primary examiner on proper motion or other reference and said motion is granted, the interference is dissolved *pro hac vice*, the applications involved become *ex parte*, the original jurisdiction of the examiner again attaches, rule 95 applies, and the same right of appeal follows as in other *ex parte* cases. *Faure v. Bradley*, 40 O. G. 248, C. D. 1887.

180. Where, in an interference proceeding, the primary examiner fixed twenty days in which to appeal from his decision on a motion to dissolve, and the last day fell on Thanksgiving day, *held* that, that day being a legal holiday, the limit of appeal expired the day before. *Dean & Robie v. Troendle*, 42 MS. D. (2 G. W. D.), March, 1890 (Fisher, Ass't Com'r).

181. Appeal to commissioner from decision of the primary examiner dissolving an interference between an applicant and a patentee on the ground that the British patent of the applicant, upon which he relied to antedate the patentee and establish the interference, did not disclose an operative device, should be dismissed, for the reason that such an appeal, when proper, lies to the examiners-in-chief. *Tavener v. Thomson*, 51 O. G. 1465, C. D. 1890.

182. When neither party appeared at the hearing of an appeal on a motion to dissolve, and neither filed a brief, *held* that, with the limited time at the disposal of the commissioner, he could not investigate the intricate questions involved, and hence he affirmed the primary examiner's decision. *Jones v. Collerés*, 45 MS. D. (3 G. W. D.), Jan., 1891 (Mitchell, Com'r).

183. The appeal from a decision of the primary examiner denying a motion to dissolve on the ground that no interference in fact exists lies directly to the commissioner and not

to the examiners-in-chief. (Rule 124.) *Zeidler v. Leech*, 54 O. G. 503, C. D. 1891.

184. The question presented by such motion cannot be transformed into any other question by *obiter dicta* contained in the decision of the primary examiner; neither can the appellate jurisdiction be deflected by reasons of appeal which are not warranted by the nature of the question presented by the motion. In other words, the examiner decides nothing but the question raised by the motion, and the appeal brings up nothing for review but the decision and the motion decided. *Id.*

(c) *Applications for Process and Apparatus.*

185. Motion to dissolve an interference declared between an application for a process and a patent covering specific apparatus for carrying out the process, granted, and *held*, that the process and apparatus being separate and distinct inventions the claims for the one cannot conflict with claims for the other. *Crane v. Meriam*, 51 O. G. 1783, C. D. 1890.

186. It was expressly decided in *Ex parte Atwood* that the relation between process and apparatus is not that which exists between genus and species, but that they are "wholly separate and distinct inventions." *Id.*

(A process and product are two different inventions. **Excelsior Needle Co. v. Union Needle Co.*, 1885, 3 *Blatch.* 147; *Rob. on Patents*, note, p. 251, vol. 1.)

(d) *Rule 122.*

(See TIME ALLOWABLE FOR FILING MOTIONS, *infra*; EX PARTE PROCEEDINGS, *infra*.)

187. Where there was a motion to dissolve an interference upon the ground of irregularity in declaring the same, and it was alleged therein that such irregularity consisted in the fact that the claims of one of the parties were based upon new matter introduced into his description and drawings more than two and a half years after his application was originally filed, and it appeared that such party, if the preliminary statements were correct, was unquestionably the original and first inventor, *held*, that it should first be determined who was the original and first inventor of the issue in controversy, leaving the *ex parte* rights of the prevailing party for subsequent adjudication. *Steward v. Ellis, v. Lee, v. Howe*, 49 O. G. 1083, C. D. 1889.

188. When a motion is made to dissolve for

irregularity in declaring the interference, upon the consideration of such motion the question is not whether there has been irregularity merely, but whether there has been such irregularity as will defeat the purpose for which alone interference proceedings are authorized by the statute. *Id.*

189. The only question raised by a motion to dissolve for want of interference in fact is whether an interference in fact exists between allowable claims, and the only inquiry arising on such a motion is one which assumes that the claims are allowable. *Zeidler v. Leech*, 54 O. G. 503, C. D. 1891.

190. Patentability is not in question under a motion to dissolve an interference on the ground that no interference in fact exists. *Forslund v. Matthews*, 57 O. G. 1720, C. D. 1891.

191. 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 and Phillips v. Foglesong*, 60 O. G. 1477, C. D. 1892.

192. Failure to make a motion under rule 122 to dissolve an interference upon the 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*, 76 O. G. 163, C. D. 1896.

193. Rule 122 provides for motions to dissolve an interference on the ground of non-patentability, although this question had been favorably decided in an *ex parte* proceeding by the examiner or one of the appellate tribunals. On a motion to dissolve the question is considered and decided *de novo inter partes*. *Painter v. Hall*, 80 O. G. 1124, C. D. 1897.

194. In an *inter partes* case the examiner is not precluded by the decision of the examiners-in-chief in an *ex parte* case, although said decision should be very persuasive, though not conclusive. To hold otherwise would be to deprive a party of his rights and benefits under rule 122. *Id.*

195. The primary examiner may not, as a matter of course, ignore the decision of the higher tribunals simply because the question is before him in a proceeding *inter partes*, whereas it was before the appellate tribunal in a proceeding *ex parte*. It is not to be presumed, nor would it be tolerable, for a primary examiner to disregard the decision of the appellate tribunal where the decision of the higher tri-

bunal is binding under the settled rules of decision. *Id.*

196. The primary examiner in his decision in an *inter partes* proceeding should state the reasons why in his opinion the decision of the higher tribunal in the *ex parte* case should not be followed in the *inter partes* proceeding. *Id.*

197. The question of patentability decided *ex parte* cannot be said to be *res adjudicata* when raised *inter partes*. To make the matter *res adjudicata* there must be concurrence of four conditions—identity in the thing sued for, of a cause of action, of the parties to the action, and of the quality in the persons. In the matter under consideration the identity of parties is lacking. *Id.*

(e) *Time Allowable for Filing Motions.*

198. When a motion to dissolve an interference on the ground of non-patentability is made more than twenty days after approval of the preliminary statements it is not an abuse of discretion on the part of the examiner of interferences to grant such motion when it appears that no testimony had been taken, so that the case had not advanced beyond the stage which interference proceedings customarily reach within the first twenty days after approval of the preliminary statements. *Reynolds v. Haberman*, 49 O. G. 130, C. D. 1889.

199. The twenty days within which, under rule 122, a motion to dissolve an interference for certain specified causes should be made runs from the day when the original preliminary statements are received and approved, and a subsequent amendment of a preliminary statement does not of itself operate to extend this time. *Scribner and Warner v. Childs, v. Balsley*, 59 O. G. 1103, C. D. 1892.

200. The pendency of other motions in an interference case is no excuse for delaying a motion to dissolve the interference beyond the twenty days limited by the rule. *Hall v. Latta*, 59 O. G. 1431, C. D. 1892.

201. Where an interferant relied upon a proper tracing of the drawing of his opponent's application for an understanding of the latter's invention and was misled thereby, such misunderstanding will not excuse his delay to file a motion to dissolve after the period of twenty days. *Lamb v. Warren*, 64 O. G. 437, C. D. 1893.

202. The delay that may be excused within the discretion of the office provided for in rule 122 is not such as will be exercised to relieve an interferant from his own negligence. *Id.*

203. A motion to dissolve under rule 122 must be made after the declaration of an interference, at which time both parties have the right to be heard. *Sievert v. Shuman*, 76 O. G. 1714, C. D. 1896.

204. Under the present rules the only period during which a party may file a motion to dissolve and *demand* that, if in proper form, it be transmitted to the primary examiner, is during the period between the approval of the preliminary statements and the twentieth day thereafter. If an interfering party files a motion to dissolve before the twenty days begin to run, he should show by the face of the proceedings or otherwise that the hearing can be had under such circumstances as would make it just to hold the parties to the result of the contest as *res adjudicata*. *Laurent-Cély v. Payen*, 51 O. G. 621, C. D. 1890.

205. When a judgment upon the record has been entered under rule 114, and the examiner of interferences has lost jurisdiction by reason of the expiration of the limit of appeal, a motion made before the commissioner for permission to file a motion to dissolve the interference should be supported by affidavits setting forth the facts relied upon, both in excuse for the failure to file the same within the time specified in the rule and in justification for the granting of the motion. *Garrison v. Hübner*, 54 O. G. 1889, C. D. 1891.

206. A showing is not required under rule 114 when a motion to dissolve is brought within the period fixed as a limit of appeal from a judgment upon the record, although the time originally fixed has been extended by stipulation approved by the office, and although more than twenty days may have elapsed since the approval of the preliminary statements. *Law v. Woolf*, 55 O. G. 1527, C. D. 1891.

207. A motion to dissolve an interference will not be allowed unless made with due diligence, and this is a question of fact to be passed upon according to the circumstances surrounding the particular case. *Hall v. Latta*, 59 O. G. 463, C. D. 1892.

208. A motion to dissolve, filed after judgment, and more than a year after preliminary statements had been filed, refused, when the defeated party offers no explanation save that he had just discovered the machine of the opposing party was inoperative. *Cox v. Wood*, 61 MS. D., July 7, 1897 (Greeley, Ass't Com'r).

209. A motion to dissolve filed tardily, and alleging a newly-discovered reference, denied, where the circumstances attending the discov-

ery were not stated and there was no accompanying affidavit. *Hageman v. Young*, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

210. A motion to dissolve, purposely postponed until the testimony had been taken, denied. *Kelly & Pickles v. Park, v. Clark, v. Hayden, v. Corrington*, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

211. A motion to dissolve, made tardily and without a showing explaining the delay, was denied; but the attention of the primary examiner was called to newly-discovered references, referred to in the motion, and suspension of the interference suggested. *Borton v. Ammerman & Toof*, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

(f) *Statutory Bars.*

(See STATUTORY BARS, IN GENERAL; APPLICATIONS, JOINT AND SOLE.)

212. A history of the practice in the office in this particular, as shown in commissioners' decisions since *Pugh v. Hamilton*, C. D. 1870, 153. *Hicks v. Keating, v. Purvis, v. Bilgham*, 40 O. G. 343, C. D. 1887.

213. The rule (120), in so far as it authorizes the suggestion of a statutory bar to the grant of a patent as a cause for suspending or dissolving an interference, relates to such facts as are purely a bar, as contradistinguished from questions of title or joint inventors—a bar which, under the old rule, would operate against all the applicants in interference; but such a statutory bar to the claims of *either* one of the parties to the interference is sufficient to call into exercise the action contemplated by the rule. *Id.*

214. The rule does not require the examiner of interferences to act immediately upon being advised of the existence of a state of facts which might justify action looking toward suspension or dissolution of the interference. *Id.*

215. When a motion to dissolve is made showing a *prima facie* case in which there seems to be a statutory bar to the claims of the adverse party, the examiner of interferences has no discretion, but must at once refer the motion to the primary examiner. *Id.*

(This was under a former rule (116). The practice has been reversed. See *Thomson & Unbehend v. Hisley*, *infra*.)

216. When the question of public use arises in an interference proceeding, the progress of the interference should not be interrupted for the purpose of determining such question, un-

less for extraordinary and amply sufficient reasons. *Campbell v. Brown*, 56 O. G. 1565, C. D. 1891.

217. Whether or not a statutory bar exists against the grant of a patent to an applicant is immaterial upon a motion to dissolve an interference, since priority of invention is the primary question in an interference. *Lossier v. Willson*, 59 O. G. 1605, C. D. 1892.

218. Where a patentee moved to dissolve upon the ground that public use was shown by the preliminary statement of the applicant, *held*, that the examiner of interferences properly refused to transmit the motion to the primary examiner. *Thomson and Unbehend v. Hisley*, 66 O. G. 1596, C. D. 1894.

219. An interference should not be stopped to allow a party "to try to create a bar upon the basis of a disclosure of the interference proceedings. The rule provides only for the use of an already complete bar—a bar independent of the interference proceedings." *Id.*

(The decision in this case collects many decisions held to govern present practice, namely, that "citing of the bar of public use is not an adequate reason for dissolving an interference." It is not, however, held that a proper case for suspension and dissolution might not thus arise. The office rule provides only for use of a bar independent of the interference proceedings.)

220. The primary examiner should have considered whether or not the record of the former interference between Lambert and Henry F. Miller and George Miller established a *prima facie* case of public use against the subsequent application of George Miller. *Miller v. Lambert*, 72 O. G. 1903, C. D. 1895.

221. When the commissioner has determined that there is no patentable invention in issue, that determination is a virtual dissolution of any interference, for there cannot be interference unless there is at least *prima facie* patentable novelty. **Shellaberger v. Schnabel*, 79 O. G. 339, C. D. 1897.

(g) *Transmittal of Motions to Primary Examiner.*

(See DISSOLUTION—STATUTORY BARS, *supra*.)

222. Motions to dissolve an interference upon either one of the grounds mentioned in rule 116, viz.: *First*, that no interference in fact exists; *second*, that there has been such irregularity in declaring the same as will preclude a proper determination of the question of priority between the parties; *third*, or which deny the patentability of applicant's claims; *fourth*, or which deny applicant's right to make the

claims,— will, when in proper form, be transmitted by the examiner of interferences to the primary examiner for his determination. *Edison and Gilliland v. Phelps*, 38 O. G. 539, C. D. 1887.

223. It is not intended by the rule that every motion to dissolve an interference, even although the interference may have been irregularly declared, shall be transmitted to the primary examiner. The rule refers only to those motions where the irregularity is of that character which will preclude the proper determination of the question of priority. *Id.*

224. Motions to dismiss an interference upon grounds other than those mentioned in rule 116 should not be transmitted to the primary examiner by the examiner of interferences. *Id.*

225. Under rule 122 motions to dissolve are transmitted to the primary examiner "for determination." It is the province of the examiner of interferences to determine, subject to appeal to the commissioner, whether a motion to dissolve shall be "transmitted." *Levent-Cély v. Payen*, 51 O. G. 621, C. D. 1890.

(Transmittal discretionary with examiner of interferences. *Scribner & Warner v. Childs, v. Balsley*, 59 O. G. 1103, C. D. 1892.)

226. A motion to dissolve upon the ground of the bar of public use should not be transmitted to the primary examiner by the examiner of interferences. *Thomson v. Unbehend*, 66 O. G. 1596, C. D. 1894.

227. An application will not be stricken from the files and the examiner of interferences will not transmit a motion for dissolution of the interference on the ground that the testimony showed that the parties did not *jointly invent* the subject-matter of the interference. *Southwick v. Walker, v. Carnduff*, 58 MS. D., Dec., 1895 (Fisher, Ass't Com'r).

228. A motion to dissolve made after the twenty-day limit (rule 122) may be transmitted, when it appears the copies of opponent's papers were received late, and a motion by the opponent to amend had intervened. *Fairbanks v. Braley*, 62 MS. D., July, 1897 (Greeley, Ass't Com'r).

229. In a motion for dissolution there was no motion for transmittal, but this seems immaterial, since the examiner of interferences undoubtedly has the right of his own motion to transmit any proper motion to the primary examiner. *Johnson & Fry v. Leatherman*, 62 MS. D., Sept., 1897 (Greeley, Acting Com'r).

230. A motion to dissolve, filed before the preliminary statements are opened, should be transmitted when accompanied by an offer

from the moving party to furnish copies of his application to his opponents, exclusive of all dates. *Gilman & Yarnell v. Weaver, v. Hunter, v. McNeal*, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

XII. DIVISIONAL APPLICATION.

231. Where a new or divisional application has been filed under rule 106 for the purpose of including claims involved in an interference, other claims involved in a related interference subsequently arising may be transferred from the original to the divisional application. *Ex parte Neiswanger*, 50 O. G. 1182, C. D. 1890.

232. An application containing specific claims based upon the same embodiment of an invention as generic claims in another application of the same party involved in an interference cannot be allowed to go to patent before the determination of the question of priority. *Id.*

233. Only such parts of an invention as are not involved in an interference, or cannot be affected by the judgment therein, may be included in a divisional application and allowed to go out of the office during the pendency of the interference. *Id.*

234. In an interference a divisional application cannot stand upon the prior application of which it purports to be a division as to an improvement which the earlier application does not claim and upon which it bases no statement of invention. *Van Depoele v. Daft*, 58 O. G. 520, C. D. 1892.

235. When an applicant seeks to take advantage of the provisions of rule 106, he should not be required to file a certified copy of the interfering subject-matter. *Ex parte Perkins*, 61 O. G. 1015, C. D. 1892.

236. When an application goes to patent upon a claim which is not a proper division of another application in interference, the patentee should derive no advantage in an interference by presumption from the fact of issue of the patent on the divisional application; but, coming in subsequently to the filing of his opponent's claim, by claim of prior invention, he should bear the burden that such claim naturally imposes as between contending applicants in the production of proof as applied to both interferences. **Porter v. Lauden*, 78 O. G. 1551, C. D. 1895.

237. Hunter filed a motion to vacate judgment, stating his application was a division of another antedating Wightman's. The examiner decided Hunter had his remedy by motion to dissolve, or by motion to change the burden

of proof. *Held*, these facts did not justify the examiner. It was his duty to take such step as might have been necessary to correct the error in the most expeditious manner. *Hunter v. Wightman*, 81 O. G. 1788 (1897).

238. Whenever it is found that the rights of a party to an interference or the rights of any party before this office have been prejudiced by an error of any tribunal of the office, all tribunals of this office should co-operate to remedy the error with as little delay or formality as is consistent with a due regard to the proper keeping of the records. *Id.*

XIII. EFFECT OF PATENT OFFICE DECISIONS IN THE COURTS.

239. While a decision of the patent office awarding priority of invention in an interference proceeding not appealed from is not conclusive in a suit between the same parties on the same subject-matter, yet it is strongly persuasive that it was right. **Kirk v. Du Bois*, 42 O. G. 297, C. D. 1888.

240. Where there had been an interference between the Stonemetz and Brown applications in the patent office, the fact that priority of invention had been awarded to Stonemetz by the examiner of interferences, the board of examiners-in-chief, and the commissioner of patents, while not conclusive, is not without weight, especially in view of a subsequent disclaimer by Brown of the invention of the matter covered by the issue in the interference. **Stonemetz Printer's Machinery Co. v. Brown Folding Machine Co.*, 64 O. G. 1185, C. D. 1894.

241. Where the question decided in the patent office is one between contesting parties as to priority of invention, the decision there made must be accepted as controlling upon that question of fact in any subsequent suit between the parties, unless the contrary is established by testimony which in character and amount carries thorough conviction. **Morgan v. Daniels*, 67 O. G. 811, C. D. 1894.

242. The object of an interference proceeding in the patent office is to determine priority, not patentability; and while the decision in such proceedings may be *res adjudicata* as to this question it does not preclude a defendant in an equity proceeding from raising other questions not in issue in said proceedings. **National Machine Co. v. Wheeler & Wilson Mfg. Co.*, 74 O. G. 1588, C. D. 1896.

243. A decision of the patent office as to priority of invention must be accepted as con-

trolling upon that question of fact in any subsequent suit between the parties, unless the contrary is established by testimony which carries thorough conviction. (Citing *Morgan v. Daniels*, 67 O. G. 811, C. D. 1894, 285; 153 U. S. 124, 125.) **Standard Cartridge Co. v. Peters Cartridge Co.*, 78 O. G. 621, C. D. 1897.

244. It is not enough to justify a court in saying that the patent office was in error in a decision upon a question of priority that the declarations and admissions of the successful contestant cast discredit upon him as a witness. The evidence in the nature of admissions must make it clear that the evidence supporting the action of the office cannot be true. **Id.*

245. In a case of interference appealed to a court the decision of the patent office must stand unless the evidence shows beyond any reasonable doubt that the appellant was the original inventor. **Arnold v. Tyler*, 79 O. G. 156, C. D. 1897.

246. Failure of a party to move for dissolution of an interference in the patent office is not an acquiescence in the ruling that the inventions, as limited by the prior art there shown, were identical and patentable. While the decision on interference may be *res judicata* as to priority, it does not preclude either party from raising other questions. **National Machine Co. v. Wheeler & Wilson Mfg. Co.*, 79 O. G. 1863, C. D. 1897.

XIV. ESTOPPEL.

(See ESTOPPEL, PROPER.)

247. An applicant in a pending interference who claims to have been the sole inventor is not estopped by reason of his oath in a preliminary statement in a previous interference, wherein he was one of two joint applicants, nor by the testimony of his witnesses in that interference, from correcting an error, if an error can be shown to exist, as to the date when his invention went into public use, when the former statement of applicant and testimony of his witnesses were made with reference to an interference proceeding in which the question of two years' prior public use was not directly in issue. *Mead v. Brown*, 48 O. G. 397, C. D. 1889.

248. In such a case there is no irregularity in declaring the pending interference, and a motion to dissolve such interference upon the ground that the party claimed to be estopped has no legal standing in the office will be denied. *Id.*

249. In a contest for priority of invention the presumption referred to is conclusive against all of the parties to the proceeding, because each one is, by the fact of his making a claim to the improvement in dispute, estopped from denying its operativeness and completeness. *Hunter v. Jenkins*, 56 O. G. 1705, C. D. 1891.

250. A practical concession of priority in an interference proceeding makes a *prima facie* case against the party in a subsequent suit and estops him again claiming priority. **Shoemaker v. Merrow*, 61 Fed. Rep. 945 (1894).

251. *Held* further, appellant is not to be heard to urge non-patentability of his claim after it has been placed in interference. He is estopped on that question by reason of his own affirmative assertion that his claim is patentable. **Hisey v. Peters*, 71 O. G. 892, C. D. 1895.

252. The fact that Huson in his preliminary statement placed his conception in 1883, while his proofs of diligence apply only to the period subsequent to the "second conception" in 1891, does not create an estoppel *in pais*, because Huson did nothing nor omitted anything upon which Yates relied in building up his own status or upon the faith of which he acted otherwise than he would. *Huson v. Yates*, 72 O. G. 1201, C. D. 1895.

XV. EVIDENCE IN FOREIGN COUNTRY.

253. It is well settled that what an inventor did in a foreign country while a citizen of such country cannot in any way be used to antedate an invention made in the United States, and evidence tending to establish such facts would be wholly incompetent. *Boulton v. Illingworth*, 43 O. G. 508, C. D. 1888.

254. A party to an interference may have the right to prove what he did as an inventor, although living in a foreign country, for the purpose of showing his *knowledge*, but *not* for the purpose of establishing facts of invention as such. Such evidence is competent and admissible without the facts being set up in the preliminary statement. *Id.*

255. Evidence of invention in a foreign country cannot be received in an interference proceeding unless such evidence is in the form of a publication or patent, or is for the purpose of showing that some one of the contestants is not an original inventor. *Green v. Hall et al.*, 46 O. G. 1515, C. D. 1889.

256. In the case of a foreign invention the knowledge of it in this country must be proven

to be of such a nature as to comply with the statute. *Quære*, whether such knowledge was proven in this case. *Gessner v. Miller*, 50 O. G. 433, C. D. 1890.

257. As regards the case of a foreign interference contestant and upon the question of priority of invention, evidence of his acts performed abroad is to be excluded from consideration. *Brown and Taplin v. Bixby*, 57 O. G. 123, C. D. 1891.

258. When an inventor, during the course of his experiments, goes abroad and pursues his work in a foreign country and successfully opposes a motion to take testimony abroad with reference to his transactions there, evidence as to what occurred there will not be considered on behalf of the applicant in deciding a subsequent question of priority of invention. *Ligowsky v. Peters*, 57 O. G. 1593, C. D. 1891.

259. What an applicant has done abroad is not pertinent to the question whether he exercised reasonable diligence arising in an interference in the patent office. *Peters v. Hisey*, 62 O. G. 315, C. D. 1893.

260. Evidence of invention in a foreign country cannot be received in an interference proceeding unless such evidence is in the form of a publication or patent or is for the purpose of showing that some one of the contestants is not an original inventor. (*Green v. Hall, v. Siemens, v. Field*, 46 O. G. 1515.) *Parkin and Wright v. Jenness*, 63 O. G. 759, C. D. 1893.

261. A disclosure on board a foreign ship in mid-ocean may be received on the question of conception of an invention. *Peters v. Hisey*, 67 O. G. 927, C. D. 1894.

XVI. EX PARTE PROCEEDINGS.

(See DISSOLUTION; RULE 122, *supra*.)

262. Where it appears that after a declaration of an interference, including H. and L.'s application, P. filed certain claims some of which are identical with those of H. and L. and if allowed to P. would make him a party to a branch interference in which H. and L. are involved, and that said branch interference is suspended pending the determination of P.'s right to the claims, a petition by H. and L. that they be heard in opposition to P. in all proceedings relative to said claims denied, as it is contrary to the established practice to allow a party to be heard on this question prior to the declaration of the interference. *Ex parte Hutin and Leblanc*, 80 O. G. 1618, C. D. 1897.

XVII. FILING BRIEFS.

263. The filing of briefs, as prescribed by rule 163, is not a positive requirement, but desirable. *Kelley v. Bassett*, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

XVIII. ISSUE.

264. In the matter of issues in interferences there is no rule applicable except that which provides the motion to dissolve. Clearly, however, when an issue has received a construction as to its meaning by the court and has been tried under that construction and the parties have acquiesced in it, the case becomes one in which the issue must be held to be complete and to read according to the construction thus given it. *Ex parte Gray*, 46 O. G. 1277, C. D. 1889.

265. When it appears that one party to an interference cannot be allowed a method claim while the other party bars the way, the issue covering the method practiced is properly declared, in spite of minor differences in the conflicting claims. *Beach v. Fowler*, 48 O. G. 821, C. D. 1889.

266. It is improper, in declaring an interference, to include a broad claim in a narrow issue. The issue should be as broad as the broadest claim involved therein. *Short v. Sprague*, 56 O. G. 1705, C. D. 1891.

267. When an interference has been declared upon a certain issue, that issue is the only subject-matter properly in dispute between the parties, and the office will not take notice of any arbitration between the parties conceding to each other priority as to certain patentable features, but not touching the actual issue of the case. *Clawson v. Williams and Roovers*, 58 O. G. 946, C. D. 1892.

268. The objectionable practice of making the issues of interferences broader than any of the claims included thereunder, or broader than are patentable in view of the state of the art, commented upon. *Mets v. Crane and Bloomfield*, 58 O. G. 947, C. D. 1892.

269. An application will not be included in an interference unless it falls within the requirements of the issue. *Henkle v. Hull*, 58 O. G. 1413, C. D. 1892.

270. In an interference proceeding the contention by one of the parties 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. 680, C. D. 1892.

271. In an interference where the senior party claimed "a curved-spring seat-support" and his application disclosed a spring support curved at both ends; *held*, that the junior party, showing a spring-support curved at one end only, was properly within the issue and satisfied its requirements. *Garford v. Edwards*, 60 O. G. 893, C. D. 1892.

272. Where an applicant appealed from the refusal of an examiner to inform him of the subject-matter of the issue in a proposed interference in order that he might amend so as to include the issue in his claims, *held*, that it is not the practice of the office to suggest claims to an applicant in order to create possible interferences. *Ex parte Weeden*, 66 O. G. 1191, C. D. 1894.

273. Where the device in the issue consists in certain particular means by which certain valves in the principal machine may be thrown, counts for the combination of the valves and a walking-beam connecting the valves together, but omitting a device for operating them, should not have been included in the issue, *Tremain v. Curtis*, 66 O. G. 1447, C. D. 1894.

274. In this respect the claims in these counts are to be distinguished from the claims in the patents discussed in *Webster Loom Co. v. Higgins* (21 O. G. 2031, 105 U. S. 580, 585 and 586), for the essence of the improvement in this interference is the mode of connection of the valves with the principal machine — that is to say, it is the means by which the valves may be thrown. *Id.*

275. Where no patentable difference exists between the issues, but one patent can be issued, notwithstanding one party originated one issue and the other party the other. *Schnabel v. Shellaberger*, 68 O. G. 658, C. D. 1894.

276. Where the appealing party urges at the final hearing the non-patentability of the issue, without having made a motion to dissolve on this ground within the time prescribed by rule 122, his contention will be left to the determination of the courts, except in a clear case. *Id.*

277. A battery with an interrupter in a telephone circuit *held* within an issue calling for a generator generating alternating electric currents for distribution of energy. *Hunter v. Spencer*, 71 O. G. 1767, C. D. 1895.

278. If no warrant be found in an application as originally filed for one of the counts of an interference issue, the applicant is not the inventor of such count. *Dewey v. Colby*, 75 O. G. 1360, C. D. 1896.

279. It is a cardinal principle that in declar-

ing an interference the issue must be as broad as the broadest claim included thereunder. *Morgan v. Hanson*, 77 O. G. 154, C. D. 1896.

280. In an issue in which the word "encircle" is used to define a construction which performs the functions of a hook, the extent to which the encircling is carried is a question of degree merely and immaterial to the scope of the issue. *Breul v. Smith*, 78 O. G. 1904, C. D. 1897.

281. The patent office should not give so liberal a construction to the terms of an issue as to enable it to include a structure which had previously been held to be patentably distinct therefrom. *Breul v. Smith*, 78 O. G. 1906, C. D. 1897.

282. When a view of the ground covered by the claims of an issue has been accepted by the parties and has prevailed in the patent office, it should not be departed from in the final decision if injustice might result from that departure. *Id.*

283. An error of procedure on the part of the commissioner cannot be construed as amounting to a final adjudication of the question of patentability of an issue. *Breul v. Smith*, 79 O. G. 153, C. D. 1897.

284. Before an interference is declared the subject-matter of the issue must be decided to be patentable. To declare an interference and put a party to the trouble of conducting it, and then when he succeeded reject his claims on the same reason urged prior to the declaration of the interference, is unwise and unjust. *Ex parte Weaver*, 81 O. G. 967, C. D. 1897.

XIX. JOINT AND SOLE APPLICATIONS.

(See DISSOLUTION, IN GENERAL; JOINDER OF INVENTIONS; JOINT INVENTIONS.)

285. Practice under rules 116 and 120 in cases where, from preliminary statements, evidence or otherwise, it appears that one of the applicants is not an inventor, or joint applicants are not joint inventors, etc., statutory bar, etc. *Hicks v. Keating et al.*, 40 O. G. 343, C. D. 1887.

286. Rule 219 is paramount, and when formal declaration of interference has been made the proceeding should not be determined without judgment of priority, except when clearly and certainly required by rules 116 and 120. *Id.*

287. An interference is declared between the applications or inventions involved rather than between the applicants or patentees. The question is, which invention as claimed was first

invented, rather than who has the ownership or title. Such inquiry may disclose a reason why one of the parties personally is not entitled to a patent, and at the same time not raise the consideration of a statutory bar. *Id.*

288. If the preliminary statements show that the joint applicants were not joint inventors, or other similar state of facts, the examiner's discretion should have in view the saving of time, avoiding delays, and protecting the rights of the parties and the public. Such statements should not be approved without first giving the parties an opportunity to correct them by amendment. If not amended and no disclaimer or concession of priority is made, the statement should be approved and the interference formally declared. If on final hearing priority should be awarded to one party when there was reason to believe he was not the first inventor, or that there was a statutory bar to his application, the examiner of interferences should call attention to the fact in his decision, as required by the rule. *Id.*

289. Should the same or other similar state of facts be developed in the evidence, the discretion of the examiner of interferences should be exercised in the direction of reaching a determination of the interference and awarding priority under rule 119, unless a statutory bar, as herein defined, is most conclusively shown, and to proceed with the interference would impose unusual and unnecessary trouble and expense upon the parties. The rule (120) does not require the examiner of interferences to act before rendering his decision, nor that the commissioner shall suspend the interference before such decision. The interest of the public is generally conserved by permitting the interference to take its course to final hearing. *Id.*

290. An applicant is not estopped by reason of his oath filed with a joint application from asserting his rights as sole inventor; nor should he be denied a patent on account of having made an error or mistake in the matter of joint inventorship. *Kohler v. Kohler and Chambers*, 43 O. G. 247, C. D. 1888.

291. One of two joint patentees files a sole application for the invention; an interference is declared between the patent of the joint patentees and the application of the sole applicant, and motion is made to dissolve, based on the ground that the office has no power to declare the interference and cannot issue a patent to the sole applicant under these circum-

stances. Motion overruled, and *held* that when patent issues to joint inventors as such neither is *the* inventor, but the invention is made by an entity composed of both parties, and that joint patentees are not the same as the sole applicant claiming the invention. *Id.*

292. The interference will develop the truth and the facts, and if it shall appear that the invention was joint, patent will be denied the sole applicant. If, on the other hand, it shall appear that the joint application was prepared and executed through misapprehension or mistake, then the interference should be determined in favor of the sole applicant. *Id.*

293. For all the purposes of interference a sole application filed by one of two or more joint patentees for the same invention as that for which the joint patent issued is as independent thereof as though filed by a third party. *Snyder v. Kanneberg*, 58 O. G. 1840, C. D. 1892.

294. The joint patent of Snyder and Belding was involved in an interference with the application of Kanneberg, in whose favor priority was decided. Pending the determination of this question, but too late to be included in the interference, Snyder filed a sole application for the identical invention already patented to Snyder and Belding. *Held*, that an interference was properly declared between the applications of Snyder and Kanneberg and that the fact that in the earlier interference Snyder and Belding contended that Snyder was the first inventor of the issue was no bar to his claim in the later interference. *Id.*

295. It being clear that as to the third issue George Miller, and not Henry F. Miller and George Miller jointly, contributed all that is not the invention of Lambert, and the question of priority between George Miller and Lambert not having been presented upon the record, the decision upon the third is confined to this, that Henry F. Miller and George Miller are not joint inventors of the third issue. *Miller and Miller v. Lambert*, 72 O. G. 1903, C. D. 1895.

296. Where S. alone filed an application for a patent for himself and another, as joint inventors, alleging in the oath, petition and preamble that he and another party are joint inventors of the invention for which a patent is solicited, *held*, that an application for a patent for a joint invention must be made by all joint inventors, and the present application should not be forwarded for examination. *Ex parte Schaeffer*, 76 O. G. 1118, C. D. 1896.

XX. JUDGMENT ON THE RECORD.

297. 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. Everitt*, 49 O. G. 781, C. D. 1889.

298. The practice under the present rule, 114, 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*, 50 O. G. 1132, C. D. 1890.

299. The senior party to an interference is not entitled to an order entering judgment against the junior party who fails to take testimony, until the time for taking such testimony has expired. *Baglin v. Doubleday*, 53 O. G. 1883, C. D. 1890.

300. The parties to an interference having indefinitely extended the times for taking testimony by stipulation approved by the office before the expiration of the period fixed upon for the junior party, the stipulation providing that the proceedings should be suspended until after notice by one of the parties to the other that proceedings would be resumed, and further providing that all dates for taking testimony should commence running upon delivery of said notice, *held*, that a motion for judgment by the senior party, made before giving the notice required by the stipulation, was premature. *Id.*

301. A judgment upon the record under rule 114 is a judgment rendered before the office has had the benefit of the views of counsel for either party upon the questions involved therein, and if a mistake has been made the entire public, as well as the injured party, is interested to have the mistake corrected. *Garrison v. Hübner*, 54 O. G. 1889, C. D. 1891.

XXI. MOTIONS GENERALLY.

302. Motions after judgment should be noticed for hearing within the time set for appeal, as otherwise the tribunal rendering judgment would not have jurisdiction at the time of hearing. *Meyrose v. Jahn*, 56 O. G. 1447, C. D. 1891.

303. When a motion to effect a stay of proceedings has been granted, the correct practice is to file all special motions at the times and periods specified for them. Such motions will then be determined in their usual order; or in

case of agreement of the interferants therein and upon approval of the agreement by the office the determination thereof will be adjourned to a day proper. *Lamb v. Warren*, 64 O. G. 437, C. D. 1893.

304. A construction of the rules of the office by means of which motions for mere dilatory purposes could be resorted to should not be adopted unless by express terms such construction cannot be avoided. **Ross v. Loewer*, 77 O. G. 2141, C. D. 1896.

XXII. PRACTICE ON FINAL HEARING AND AFTER JUDGMENT.

305. After a final award of priority there is no more reason for permitting the defeated party to the interference to be heard upon the relation of the prevailing party to the prior art than there would have been for permitting the same privilege before the institution of the interference. *Green v. Hall, v. Siemens, v. Field*, 47 O. G. 1633, C. D. 1889.

306. Where, after a judgment of priority upon the record, applicant refused to erase a certain claim included in the interference, alleging as a reason that it embraced subject-matter not disclosed by the other contestant, and no motion to dissolve had been made as to such claim, *held*, that it was too late for the examiner to pass upon the question whether or not applicant should be allowed the claim. *Ex parte Booth*, 49 O. G. 1841, C. D. 1889.

307. The examiner, after rejecting all claims involved in the interference of the defeated party which are or could be made by the prevailing party, may properly allow to the former such other claims as are held to be patentable and could not be made by the party prevailing in the interference. *Ex parte Booth*, 56 O. G. 141, C. D. 1891.

308. No claim should be allowed to the defeated party which could, by any latitude of construction, be held to embrace matter common to the structure of both parties to the interference. *Id.*

309. Rule 132 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. *Id.*

310. The cases of *Ex parte Booth* (C. D. 1889, 49 O. G. 1841) and *Ehrlich v. Van Horn* (54 O. G. 506) are to be regarded as precedents establishing the practice for obtaining relief when the

defeated party believes that the examiner has erred by treating claims limited to his specific structure as if they were concluded by the interference proceeding. *Id.*

311. 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. *Ex parte Archer*, 57 O. G. 696, C. D. 1891.

312. 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, C. D. 1896.

XXIII. PRELIMINARY STATEMENTS.

(a) *In General.*

313. If there is any doubt as to the scope of the interference issue, each applicant should confine his preliminary statement to the invention contained in the claims of his application which are declared to be involved in the interference and not attempt to frame the statement to cover two or more possible constructions of the issue. *Haug v. Du Bois*, 56 O. G. 1061, C. D. 1891.

314. A preliminary statement, after filing, becomes the property of the government like any other record and will not be returned to the applicant even if it was not used in the case or opened after it had been sealed up by the examiner of interferences. *Ex parte Baxter, Jr.*, 56 O. G. 1448, C. D. 1891.

315. The nature and theory of a preliminary statement discussed and commented on. *Washburn v. Hadfield*, 57 O. G. 1719, C. D. 1891.

316. "The utmost care and diligence," rather than mere "reasonable diligence," are required in the making of a preliminary statement. *Henderson v. Noakes*, 59 O. G. 1762, C. D. 1892.

317. Upon agreement of the parties the time for filing preliminary statements was advanced and the examiner of interferences directed to open the statements as soon as filed. *Ex parte Nickerson*, 57 MS. D., Oct., 1895 (Fisher, Acting Com'r).

318. The rule that one is bound by the statements in his preliminary statement applies only to the proceedings in which the parties are in-

volved. *Sievert v. Shuman*, 76 O. G. 1714, C. D. 1896.

319. Preliminary statements correspond to pleadings in a suit at law, and should be formal and exact. A statement which lacks certainty as to date when a model, if any, was produced should be amended. *Ansley v. Hamar*, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

320. It is of the utmost importance that strictness be observed as to the dates furnished in preliminary statements required in cases of interferences, for if parties were allowed to vary their dates at pleasure as to the time of discovery, invention or disclosure it would inevitably lead to the imputation of deception and bad faith practiced on the part of the party so changing his dates. **Stevens v. Seher*, 81 O. G. 1932, C. D. 1897.

(b) *Amendment of.*

321. A party who prepares his preliminary statement, knowing and advising his counsel that the dates alleged therein are not the earliest which he can establish, and who fails to ask for a postponement when he has not time to obtain fuller information and data, but files his statement in such imperfect condition, cannot prevail in a motion to amend when he waits until possessed of all the facts and dates relating to his adversary's case. *Donnelan v. Berry*, 41 O. G. 1499, C. D. 1887.

322. When such a party enters a protest against his opponent's preliminary statement, and amendment has been made thereof, but waits until after the testimony-in-chief has been taken and then moves to amend his own statement for no other purpose than to carry his dates back of those set up by his opponent, he must be held to be guilty of laches and not to have shown such diligence which the rule requires, nor compliance with the clear intent and purpose of the practice requiring preliminary statements. *Id.*

323. Motion to amend a preliminary statement to set back the dates of invention and to allege disclosure and reduction to practice in a foreign country should have been denied. *Boulton v. Illingworth*, 43 O. G. 508, C. D. 1888.

324. Explanations as to the reasons why a drawing and structure were forgotten which are satisfactory for the purpose of securing an amendment to a preliminary statement are not to be regarded as necessarily satisfactory as against the claim that the forgotten drawing and structure were abandoned. When a pre-

liminary 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. Stockholm*, 53 O. G. 755, C. D. 1890.

325. The decisions have been practically uniform that where ordinary care and prudence in the fixing of dates have been wanting, amendment of preliminary statement would not thereafter be permitted. (*Cleusen v. Fowler*, C. D. 1886, 35; *Heermans v. Eichbaum*, 41 MS. D. 391, 1 G. W. D. 93; *Lamb v. Spiro*, 42 MS. D. 445, and *Hunter v. Brill*, 44 MS. D. 156.) *Bell v. Overman*, 45 MS. D. (3 G. W. D.), Jan., 1891 (Fisher, Ass't Com'r).

326. Motion to amend a preliminary statement after a delay of four months and a half denied. *Gornall v. Lovejoy*, 56 O. G. 927, C. D. 1891.

327. When an interference has so far advanced that the junior party has taken his testimony, the patent office will not permit the other party to amend his preliminary statement by the addition of facts presumably within his knowledge at the time when the statement was originally filed. *Washburn v. Hadfield*, 57 O. G. 1719, C. D. 1891.

328. Where one party to an interference has taken his testimony, the office will not permit the other party to amend his preliminary statement in the absence of positive proof that the proposed amendatory matter or some material part of it was not within his knowledge when the statement was originally filed. (Affirming *Washburn v. Hadfield*, 57 O. G. 1719.) *Washburn v. Hadfield*, 59 O. G. 463, C. D. 1892.

329. An amendment to a preliminary statement which takes the amending party's date back of the corresponding date of his opponent will not be allowed upon a state of facts consistent with the supposition that the party seeking to amend might have presented this earliest date in his original statement if he had used the utmost care and diligence. *Henderson v. Noakes*, 59 O. G. 1451, C. D. 1892.

330. The office acts judicially rather than ministerially in permitting or denying the amendment of a preliminary statement. *Henderson v. Noakes*, 59 O. G. 1762, C. D. 1892.

331. Upon motion of a junior party to amend his own and strike out the senior party's amended preliminary statement, certain facts held to warrant an equitable treatment of the matter, and both amendments received. *Pratt and Johns v. Thomson*, 62 O. G. 449, C. D. 1893.

332. It is difficult to conceive a case in which

an amendment of a preliminary statement can be permitted, after testimony has been taken and no previous notice of intention to amend has been given. *Foster & Foster v. Bent*, 60 MS. D., Nov., 1896 (Seymour, Com'r).

333. It is always a suspicious circumstance in a case of interference that after the claim of one of the parties has been fully disclosed and fixed as a specified date the other party should then seek, by amendment of his preliminary statement, to show a date of invention prior to that of his original statement and prior to that of his opponent. **Parker v. Appert*, 75 O. G. 1201, C. D. 1896.

334. Appellant's statement that he made the sketches upon which he relies for proof of his earlier date at said date, but mislaid them and forgot where they were until after the disclosure of the dates of appellee, is not credible in view of the facts surrounding the case, and amendment to his preliminary statement should not have been allowed. **Id.*

335. The practice of the office should conform to the modern practice in courts, which allows amendments to pleadings upon a proper showing at any stage in the case; but it is not proper to allow an amendment to a preliminary statement at any stage of the case, as a matter of course, whenever asked for, without a showing of facts to justify it. *Foster and Foster v. Bent*, 77 O. G. 1781, C. D. 1896.

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

337. Amendments to preliminary statements should be permitted where indisputable facts or clearly-proved circumstances support the necessary inference that a mistake has been made which would defeat the ends of justice, and where such facts or circumstances by the exercise of reasonable diligence could not have been found and in fact were not found earlier. *Id.*

338. The fact that an affiant who is one of the parties did not give the original preliminary statement adequate study, did not follow back the details in his mind, did not at the time it was made recollect anything important about it, and confused the article which he afterward manufactured with the one which he then invented, are not sufficient grounds to justify disposing of the original statement by substituting therefor an amended one. *Id.*

339. If any material error occurs in the preliminary statements, or other statements made to the office, through inadvertence or mistake,

the statement may be corrected on motion upon showing to the satisfaction of the commissioner that the correction is essential to the ends of justice, and 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. It is only upon complying with this rule that the correction of any material error in preliminary statements can be made. **Stevens v. Seher*, 81 O. G. 1932, C. D. 1897.

340. A preliminary statement, which lacks certainty as to a date, should be amended. *Ansley v. Hamar*, 63 MS. D., Dec., 1897 (Greeley, Com'r).

(c) *Inspection of.*

341. After judgment upon the record on the ground that the filing date of the earlier applicant antedates the date of conception set up in the preliminary statement of the later applicant, a petition by the later applicant to inspect the preliminary statement of his opponent for the purpose of ascertaining whether he had reduced the invention to practice before filing his application will be denied. *Lindsay v. McDonough*, 55 O. G. 1402, C. D. 1891.

XXIV. PRIORITY.

(a) *In General.*

342. If the award of priority given to Bell can be vacated and set aside, it should only be done upon a showing of merits that would entitle Gray to a patent. Such patent would run for a period of seventeen years from its date, and would dominate and control all devices relating to the telephone for another period of seventeen years. The effect would be to subject the public to a renewed monopoly in all nearly, if not quite, thirty-four years. Such result would be in contravention of the spirit of the statute, and, in view of the liberal provisions of the patent system, cannot be tolerated except when the inflexible rules of law and justice compel it, especially in the present case, wherein it is clearly shown that the Bell Company is the "equitable if not the legal owner of Gray's telephone inventions." *McDonough v. Gray*, 46 O. G. 1245, C. D. 1889.

343. A model or drawing, although a sufficient foundation for a claim to priority, as was held in *Loom Co. v. Higgins*, must be followed up with reasonable diligence in order to establish full title to priority. *Green v. Hall, v. Siemens, v. Field*, 47 O. G. 1631, C. D. 1889.

344. Where it was alleged as error that the commissioner erroneously decided that one of the parties did not intend, at the time he constructed the apparatus upon which his claim to priority was based, to use it practically upon an electric railway, and it appeared that the commissioner did not decide what was the ultimate intention of such party with reference to his invention, but simply decided that certain models were designed and intended as models, *held* no error. *Id.*

345. Where it was alleged as error that the commissioner held that priority of invention was to be determined by the intent of the inventor as to the use to which his apparatus should be put, and it appeared that the actual finding of the commissioner upon that subject was limited to the intent with which certain models were made and used, *held* no error. *Id.*

346. Where the senior party to an interference directly and unqualifiedly contradicts the claim of the junior party that he communicated the invention to the senior party and that he employed the senior party to make a model to embody the ideas which he (the junior) communicated, the issue must be found against the junior party in spite of his own testimony to the opposite effect, unless there is other testimony in the case corroborative of his contention and sufficient to turn the scale. *Wherry v. Heck*, 49 O. G. 559, C. D. 1889.

347. Where in a suit for infringement it appeared that the application of the patent sued on was filed December 2, 1887, and the application of the defendants' patent was filed September 8, 1888, and that there was no evidence that the original application of the patent in suit was modified or amended in any respect after it was filed, *held*, that it must be conceded in the absence of other evidence that plaintiff's assignor was presumptively the first inventor. **American Roll Paper Co. v. Knopp*, 54 O. G. 391, C. D. 1891.

348. The question of priority of invention is determined by a fair preponderance of evidence, and doubts raised as to accuracy of witnesses upon certain minor points are not sufficient to overcome it. *Wilson v. Haines*, 57 O. G. 1278, C. D. 1891.

349. Although there was such obvious irregularity in declaring the interference as rendered a decision upon the question of priority extremely difficult, *held* desirable, if not absolutely necessary, that such a decision be rendered by the commissioner as would terminate

the interference proceedings, in view of the fact that the question of priority had been decided by both the examiner of interferences and the examiners-in-chief. *Mets v. Crane and Bloomfield*, 58 O. G. 947, C. D. 1892.

350. Where actual reduction to practice is wanting and testimony adduced by the parties to show date of conception is of the same character and quality, the earlier date will prevail, though the evidence to sustain it is meager and unsatisfactory. *Doane v. Johnson, Jr.*, 58 O. G. 1414, C. D. 1892.

351. Where one of the parties to an interference failed to file his preliminary statement within the time limited, and the examiner of interferences decided the interference in favor of his opponent "in accordance with the provisions of rules 114, 115 and 116," *held* on appeal that as the appellant disclosed, but did not claim, the invention in controversy in application antedating his opponent's earliest claimed date, the office must consider this in determining the question of priority. *O'Shaughnessy v. Depoele*, 62 O. G. 1063, C. D. 1893.

352. Where the applicant was the mechanical engineer and the patentee the general superintendent and manager for the same employer, and where at an interview between them the applicant made sketches of the invention, from which drawings were made and signed by him as inventor and by the patentee as a witness, and where it was thought at the time that the conception of the invention was complete, and where the latter had the custody of the sketches and failed upon request to produce them or account for their loss, and also failed to produce sketches alleged by him to have been made by him prior to those of the applicant, and where, in addition to these facts, the patentee's candor as a witness is considered, his defective recollection of the contents of the applicant's sketches, and the general terms in which he describes his own sketches, *held*, that these facts establish that the applicant was the originator of the invention in issue in the interference. *Reynolds v. Wells, Jr.*, 66 O. G. 1594, C. D. 1894.

353. Where F. suggests the idea to B. that a lifting-jack could be altered so as to adapt it to wrench the drill-rods of oil-wells, but gives no explanation of how such adaptation might be brought about, and where B., without further communication, changes the jack to adapt it to the suggested new use, *held*, that whatever of invention may be involved in the

change of the jack belongs to B. and not to F. **Forgie v. Oil Well Supply Co.*, 67 O. G. 1578, C. D. 1894.

354. Lambert brought to the Millers a can having the essential features of the first and second issues. Though the license agreement is not in evidence, the record shows that the Millers manufactured cans based upon Lambert's invention and paid royalty to Lambert. *Held*, that Lambert was the inventor of the first and second issues. *Miller and Miller v. Lambert*, 75 O. G. 1903, C. D. 1895.

355. After C. learned of F.'s patent he continued to make the patented article and made no protest about F.'s marking the article "Patented" and did not claim the article so marked as his own invention until after his employers had got into trouble with the owners of the patent. This conduct is not that of a person who had made the invention. *Couch v. Finnegan*, 77 O. G. 1595, C. D. 1896.

356. The conduct of the appellant Hill and of his assignee, the Sheldon Axle Co., toward the appellee for four months after their alleged discovery of the issue of a patent to the latter is wholly irreconcilable with any other theory than that they recognized the appellee as the true inventor of the device in controversy. **Hill v. Parmelee*, 78 O. G. 170, C. D. 1897.

357. The doctrine announced in *Webster Loom Co. v. Higgins* (21 O. G. 231, 105 U. S. 586, C. D. 1882, 285) to the effect that that which is common and well known in the art may be understood as if written out in the specification of a patent, applies with even greater force to the adequacy of sketch drawings when the question is one of carrying back the date of an invention to the time of a first conception. **Standard Cartridge Co. v. Peters Cartridge Co.*, 78 O. G. 621, C. D. 1897.

(Affirming commissioner's decision.)

(b) *Foreign Patent.*

(See FOREIGN PATENT, PROPER.)

358. Where in an interference proceeding an American applicant relied upon the filing date of his application — to wit, December 27, 1886 — for the date of his invention, and a foreign applicant relied upon a British provisional specification, dated December 9, 1885, and also a complete specification, dated September 9, 1886, said specifications being filed under the British act of 1883, for the same purpose, *held*, (1) that the adjudication of priority should be in favor of the American applicant, and (2) that

it would make no difference if it were proved that the complete specification was accepted on December 9, 1886, and made accessible to public inspection on the same date. *De Ferranti v. Westinghouse*, 52 O. G. 457, C. D. 1890.

359. A foreign patent is evidence of perfected invention, if the description contained therein is sufficiently clear and definite, and reduction to practice is not necessary to consummate a title to receive an American patent based upon it. *Deprez and Carpentier v. Bernstein*, 54 O. G. 1711, C. D. 1891.

360. Where a foreign patent exclusively relied upon as evidence of priority on behalf of an applicant as against a patentee failed to fully, clearly and exactly disclose the invention of the issue, *held*, that it could not avail the applicant as proof of prior invention; and *held* further, that if the claim of the applicant, when limited to that which was set forth as his invention in the foreign patent, contained anything patentable over the prior art, his right to a patent thereon was in no way affected by the granting of the subsequent patent. *Id.*

361. In an interference between an application and a patent where the applicant relies on a foreign patent granted to him and it is clear that the invention therein described has the advantage of priority, *held*, that if the application, when limited to that which is set forth in said foreign patent, contains anything patentable over the prior art, applicant's right to a patent thereon is in no way affected by the patent in interference. (Quoting and construing *Deprez and Carpentier v. Bernstein*, 54 O. G. 1711.) *Deprez and Carpentier v. Bernstein, v. Hunter, v. Gaulard and Gibbs*, 58 O. G. 1553, C. D. 1892.

362. Where L. proves that a French patent of a certain date was granted to him for the invention in issue and neither C. nor B. has proved a conception of the invention earlier than that date, *held*, that L. is the first inventor. *Lossier v. Cowles and Cowles v. Boguski*, 71 O. G. 1616, C. D. 1895.

363. Appert having patented the invention in a foreign country not only before Parker's completed invention but before Parker's first conception, he is held to be the prior inventor within the meaning of our statutes, whatever effect may be given to his foreign patent. *Appert v. Parker*, 74 O. G. 1587, C. D. 1896.

364. Appert, having patented the invention in France before Parker's first proved conception, is held to be the prior inventor. **Parker v. Appert*, 75 O. G. 1201, C. D. 1896.

365. Appert's application and patent were dated October 19, 1893, and the issue of the patent to him was on January 12, 1894. *Held*, that the latter was the earliest date which he could claim for the conception and publication of his invention. (Opinion of the Attorney-General of the United States, construing articles of the International Convention, cited, 47 O. G. 398, C. D. 1889.) **Id.*

(c) *Prior Conception and Reduction.*

366. An inventor (Hunter) who is the earliest to conceive, disclose and reduce to practice, and who connects his conception and completion by such diligence as his circumstances and the character of the invention admit of, cannot be defeated in his right to a patent by any amount of diligence in coming to the patent office of an inventor whose conception is of later date. *Hunter v. Miller*, 50 O. G. 1765, C. D. 1890.

(M.'s patent issued while H.'s application was pending.)

367. An inventor who first conceives and gives expression to the idea of an invention in such clear and intelligible manner that a person skilled in the business could construct the thing is entitled to a patent, provided he uses reasonable diligence in perfecting it, as against an inventor whose conception was of later date, but who was earlier to apply for a patent. **McCormick Harvesting Machine Co. v. Minneapolis Harvester Works*, 51 O. G. 1130, C. D. 1890.

368. An inventor is entitled to a reasonable time, to be judged of according to the circumstances of the case, in which to perfect his invention and reduce it to practice without impairing his claim to priority. **Id.*

369. Where A. was the first to conceive an invention and to apply for a patent, and followed up his conception with reasonable diligence in adapting and perfecting the invention, and B. was first to reduce to practice, it appearing, however, that A. had made sketches, a model and working drawings prior to B.'s conception, *held*, that A. was the first inventor and entitled to the patent. *Lorraine v. Thurmond*, 51 O. G. 1781, C. D. 1890.

370. An exception to the general rule that the first person to reduce his invention to actual practice is the first inventor is recognized in cases where the first person to conceive is diligent in adapting and perfecting the invention, and in all controverted interferences it must

first be ascertained whether the rule or the exception is applicable to the facts involved. *Id.*

371. Where A. conceived the invention in issue in September, 1885; tested it in an experimental apparatus and became satisfied that he had made an invention of value and importance in the same month; set up a plant embodying the invention in March, 1886, which was operated continuously until June of the same year; extensively introduced the invention thereafter, and applied for a patent in August, 1888, and B. conceived the same invention in June, 1886, reduced it to practice in December of the same year, and obtained a patent in July, 1888, *held*, that A. was the first inventor. *Stanley v. Slattery*, 54 O. G. 1709, C. D. 1891.

372. The junior party, who proves conception of the invention in 1884, disclosure to others in 1886, and reduction to practice in September or October, 1887, *held* entitled to a decision of priority as against the senior party, who proves conception in January, 1887, and no reduction to practice prior to January 19, 1888, the filing date of the application. *Mets v. Crane and Bloomfield*, 58 O. G. 947, C. D. 1892.

373. Where the testimony of one of the parties is that he conceived the invention and used it in his business at a date prior to the date of conception by the other party, which testimony is corroborated by his caveat filed before the date of conception of the other party, *held*, that he is the first inventor. **Colhoun v. Hodgson*, 70 O. G. 276, C. D. 1890.

374. H. conceived August 2, 1881. In January, 1884, he constructed an apparatus applying the conceived idea in the operation of a telephone, and November 9, 1887, filed an application, from which the application in interference was divided August 1, 1890. In August, 1890, the invention of the issue was operated upon a large scale by H. S. filed his application November 4, 1886, and has taken no testimony, and no further facts appear concerning his testimony. Priority adjudicated in favor of H. *Hunter v. Spencer*, 71 O. G. 1767, C. D. 1895.

375. Priority awarded to Mayhew, because Kelleher and Grimm not original inventors, and further, because Mayhew was the first to conceive and it was not clearly shown that he was not diligent in reducing to practice. *Kelleher and Grimm v. Mayhew*, 72 O. G. 895, C. D. 1895.

376. "Public policy and the settled practice of the office alike forbid the issue of a second

patent for the same invention in any but a clear case — clear beyond a reasonable doubt;” but the fact that one party has unjustly obtained a patent is not final, for the rule as applied to this case is that “he is the first inventor who first forms a complete mental conception of the improvement in question, as proved not merely by himself but by full and certain disclosure to another, and who, under all the circumstances of the case, proceeds with reasonable diligence to the construction of a full-sized machine embodying the improvement in working form; and that this is so although another with a later conception first fully reduces the invention to practice.” *Huson v. Yates*, 72 O. G. 1201, C. D. 1895.

377. Where it appears that S. produced a sketch and described the invention to others on September 9, 1887, made and tried a model in April, 1888, and applied for a patent on June 19, 1888, and that K. was not engaged upon the invention until December 1, 1887, but applied for a patent March 3, 1888, *held*, that S. was the first inventor. *Scribner v. Kellogg*, 72 O. G. 1495, C. D. 1895.

378. Chase having failed to prove conception and reduction to practice, although he has a patent granted prior to La Flare’s filing date, cannot prevail over La Flare, who conceived and reduced to practice prior to the filing of Chase’s application. **La Flare v. Chase*, 74 O. G. 1735, C. D. 1896.

379. On the record it must be held that Buhoup was not only the first to conceive and the first to reduce to practice, but that he actually disclosed the invention to Hien prior to his alleged date of conception. Hien may have forgotten the circumstances of this disclosure; but this cannot overcome the proof submitted on behalf of Buhoup. *Hien v. Buhoup*, 81 O. G. 2088, C. D. 1897.

380. Where it appears that Buhoup was the first to conceive the invention of a round-shanked gravity-pin and button-head and reduced the invention to practice after he had seen the model of the conception of the device in issue by Hien, *held*, that the subsequent modification of the pin from a round shank to a square shank with an oblong head and the substitution of this modification or form for that previously put into use was not such a departure from the original invention as to disentitle him to the right of priority against Hien, who had conceived subsequently to Buhoup, but not put into practical operation, a device of similar principle, but of different form and operation

from that of the original conception. **Hien v. Buhoup*, 81 O. G. 2087, C. D. 1897.

381. The decision of the assistant commissioner, holding that Buhoup was the first and original inventor, affirmed. **Id.*

(d) *Prior Reduction.*

382. When one of the parties to an interference has made the invention independently of the other party and has reduced it to practice upon an extended commercial scale, and has obtained a patent which he has held unchallenged for nearly a year, he must be adjudged the prior inventor as against the other, who, though he may have been the first to conceive the invention, without any excuse for his non-action, never did anything toward reducing it to practice, but who bases his claim to priority on a previous application filed by him which contained claims for the invention in controversy, which claims were rejected and positively and deliberately abandoned nearly four years before the filing of the application involved in this interference. *Beach v. Fowler*, 48 O. G. 821, C. D. 1889.

383. Property in patents ought not to be created as against a rival applicant first to reduce to practice and first in the office, upon mere verbal testimony indefinite in its character, unaided by the production of memoranda, drawings or models, under circumstances which in themselves tend to indicate its intrinsic improbability. *Wherry v. Heck*, 49 O. G. 559, C. D. 1889.

384. Where it appeared that the junior party to an interference involving a process for filtering beer had not reduced the invention to practice before its reduction to practice by the senior party, and that the latter had filed an application for a patent upon an apparatus, disclosing and describing the process at a time when the former had neither reduced the invention to practice nor was using reasonable diligence, and further, that the senior party had applied for and obtained a patent for the process before the application of the junior party was filed, *held*, that the senior party must be regarded as the original and first inventor of the process. *Zwietusch v. Stockheim*, 53 O. G. 755, C. D. 1890.

385. When a man has suggested the basic idea of a patentable improvement and has made it practicable to any degree and has never abandoned it, he cannot be deprived of the benefit of the invention or of the title of in-

ventor by any other person who subsequently carries out his idea more perfectly and to a greater degree of usefulness. *Riley v. Barnard*, 59 O. G. 1919, C. D. 1892.

(Case of protest against issue of patent. See 59 O. G. 1921, same parties.)

386. Where all the experiments of both parties were conducted in the same shop and were embodied in the same machines, and where the evidence on the part of the applicant is that he disclosed the invention on September 15, 1890, and embodied it in successful operation by October 2d following, and on the part of the patentee that he made sketches of the invention in June or July, 1890, which were not dated and not disclosed until and except by mailing them to his patent agent on October 4th, and his assertion that he made them in June or July is without corroboration of a single witness or circumstance and is contrary to his conduct in his efforts through August and early part of September to invent a device like that in the issue, *held*, that the patentee cannot be given an earlier date than October 4th, and consequently judgment of priority must be awarded to the applicant. *Tremain v. Curtiss*, 60 O. G. 1447, C. D. 1894.

387. Where the testimony is full, explicit and satisfactory that P. conceived the invention in September, 1888, reduced it to practice in November, 1888, and began to put it into extensive public use by March, 1889, and where the testimony of H., his opponent, to his own earlier conception is not corroborated save by the recollection of one witness as to a conversation four years and a half in the past, *held*, that P. is the prior inventor. *Peters v. Hisey*, 67 O. G. 927, C. D. 1894.

388. Where reduction to practice on the part of one of the contestants is established beyond doubt to have been at a certain date, and when his opponent fails to produce a single sketch or exhibit of the numerous sketches and specimens alleged by him to have been made earlier than the said certain date, without any serious attempt to recover them and with their loss insufficiently accounted for, and where certain of his claims of earlier production are found to be disproved and others improbable, *held*, that there is a failure of proof that the invention existed prior to the date established by the first-mentioned contestant. *Shellaberger v. Sommer, Sommer and Sommer*, 68 O. G. 533, C. D. 1894.

389. Where the invention has been reduced to practice in a positive form under the patent

and the applicant has simply filed his application, without doing anything to adapt and render the invention practical, and where he knew of the issue of the patent within a few days after its issue, and made no suggestion that the invention was his, but recommended it to purchasers, both orally and in writing, as the invention of the patentee, and where he did not assert any title to it until six months after the issue of the patent and after he had left the employ of the company who owned the patent to do service for a rival company, *held*, that priority must be awarded to the patentee. **Wells v. Reynolds*, 69 O. G. 121, C. D. 1894.

390. Where one of the parties has reduced the invention to practice, he will be regarded as the *prima facie* original and first inventor. **Soley v. Hebbard*, 70 O. G. 921, C. D. 1895.

391. Where it is admitted by the parties that a machine had been built from patterns designed by H., one of the contestants, but where S., the other contestant, claims that H. derived the invention from him, consequently that the reduction to practice ought to inure to his benefit, *held*, that the burden of proof is upon S. to prove his claim, and, failing to do so, priority of invention must be awarded to H. **Id.*

392. Where the machine relied on by one of the parties as establishing priority of invention is inoperative, and that relied on by his contestant is operative and successful, *held*, that priority should be awarded to him who produced the operative machine. **Glidden v. Noble*, 71 O. G. 141, C. D. 1895.

393. Ecaubert (Letters Patent No. 434,539, dated August 19, 1890) having abandoned any attempt to make his idea practically available and to develop his theory in fact, while Hoffmann (Letters Patent No. 435,835, dated September 2, 1890) conceived the idea, embodied it in means by which it could be carried out, and proceeded to make watch-case centers, and thereby first perfected it, is entitled to be recognized as the real inventor. (*Agawam Co. v. Jordan*, 7 Wall. 583; *Whitely v. Swayne*, *id.* 687; *Reed v. Cutter*, 1 *W. G.* 590; *Howe v. Underwood*, 1 Fish. 166; *Whitely v. Ecaubert*, 71 O. G. 1617, C. D. 1895.)

394. C. and L. both had the intellectual conception of the invention independently of each other. L. left his thought in abeyance in the presence of the activities of C. in reducing it to tangible form and incorporating it into a car. L. did not proceed promptly after learning that C. had obtained a patent for the improvement. He stood by and saw C. reduce the invention

to practice without any claim to the invention or for remuneration. The reduction and invention were C.'s. *La Flare v. Chase*, 72 O. G. 741, C. D. 1895.

395. Doyle not only failed in his attempts to reduce the invention to practice, but also failed to exhibit any interest or faith in the trials of McRoberts which proved successful. The neglectful conduct of Doyle after his attempts and his failure to establish his contention that McRoberts had been carrying out the invention of Doyle and the clear proofs of McRoberts, the patentee, entitle him to an award of priority. *Doyle v. McRoberts*, 73 O. G. 139, C. D. 1895.

396. Carty in his preliminary statement says "that he reduced the same to practice in part in February, 1885." It is no hardship to limit Carty by this explicit language and to consider that what he did at the time fell short of a reduction to practice. Carty, lacking both diligence and reduction to practice, cannot prevail over the patentee. *Carty v. Kellogg*, 73 O. G. 285, C. D. 1895.

397. Parmelee and Hill prove conception and disclosure at the dates set up in the statements; but, though Parmelee disclosed his invention to Hill and practiced it under contract with the company employing Hill as master mechanic, Hill did not claim it as his own invention at the time and did not file his application until eight months after the issue patent and, as stated, four months after Hill and his assignees knew of the patent. The conduct of Hill is inconsistent with a claim to originality. *Hill v. Parmelee*, 73 O. G. 447, C. D. 1895.

398. Shellaberger having proved reduction to practice in the spring of 1898 is awarded priority of invention over Sommer, whose earliest conception is September, 1898, and reduction to practice 1890. **Shellaberger v. Sommer et al.*, 74 O. G. 1897, C. D. 1898.

399. If effectual efforts were made to give an idea form, but were abandoned before reaching such a stage of completion as to require only ordinary mechanical skill to carry the conception to success, the claim of priority of conception cannot be sustained against a later independent conception carried into practical form at an earlier date. **Standard Cartridge Co. v. Peters Cartridge Co.*, 78 O. G. 621, C. D. 1897.

400. Where the testimony in an interference proceeding between an applicant and a patentee shows that the former was present on one of the first occasions upon which the invention which is the subject of the issue was tested and that he ridiculed the attempt as im-

possible of execution and dangerous to attempt, where the testimony also shows that the applicant did not claim credit for the invention when he was first accustomed to hear it attributed to the patentee, where it appears that the application was filed after the issue of the patent and is a substantial copy thereof, and where there are other and corroborating circumstances, the presumption that the patentee is the prior inventor has not been disturbed. *Doyle v. McRoberts*, 79 O. G. 1029, C. D. 1897.

XXV. REDUCTION TO PRACTICE.

(a) *In General.*

401. The purpose of the law is to benefit the public as well as to protect the inventor, and the inventor who reduces his invention to practice in such a complete way that he at once perfects it as an invention, and at the same time practically demonstrates its utility, is clearly to be preferred to one who merely made hints and suggestions to others and failed himself to act upon them. *Green v. Hall, v. Siemens, v. Field*, 46 O. G. 1515, C. D. 1889.

402. The allegation that the fact of an application being put in interference determines that the invention has been reduced to practice, overruled. The office possesses no machinery for ascertaining such fact, but assumes for the purposes of the interference that the invention of each applicant is within the issue, although the subsequent history of the rival inventions may develop the fact that while one of them is in a form capable of commercial use the other may be incapable of any practical use whatever. *Green v. Hall, v. Siemens, v. Field*, 47 O. G. 1631, C. D. 1889.

403. Where neither party made an actual reduction to practice before filing his application and neither makes out a satisfactory case, decision will follow the preponderance of evidence, however slight it may be. *Buckingham v. Jones*, 58 O. G. 1413, C. D. 1892.

404. Where a party to an interference claimed to have reduced to practice early in 1887 and then discontinued the use of his invention for two years, meantime applying for two other patents upon devices of the same general character, *held*, that such conduct was inconsistent with the supposition that he made a successful reduction to practice at the earlier date. *Rennyson v. Merritt*, 62 O. G. 151, C. D. 1893.

405. Where a caveat disclosed substantially

the invention in interference, *held*, that the expression in the caveat of a desire to mature the same does not show that the invention could not have been reduced to practice at its date. *Colhoun v. Hodgson, 70 O. G. 276, C. D. 1895.

406. At the time of the contract it was certainly not contemplated that the assignee should be let into the secrets of the invention and become entitled to the larger share of the profits and yet be free to experiment as he pleased and appropriate to his own use the result of his experiments. Such a course would be a fraud upon the partnership. *Milton v. Kingsley, 75 O. G. 2193, C. D. 1896.

407. Whether the appellee, who is the original assignee, made invention in question is not decided; but if he did, he made it for the benefit of the partnership, and therefore the appellant, who is the original inventor, should receive the patent. *Id.

408. The assignee, if he made the discovery in question, did so only in the elaboration and reduction to practice of the ideas of the original inventor, and his obligations to the latter he should not now be permitted to repudiate by procuring a patent in which the latter has no interest. To allow this would be to place a premium upon fraud. *Id.

409. Where a plaintiff claims to be an original inventor and the defense is that the defendant is a prior inventor, thus conceding the invention of the plaintiff, but challenging his claim to priority of invention, it is imperative that the invention or discovery relied upon as a defense must have been complete and capable of producing the result sought to be accomplished, and this fact must be shown by the defendant. Progress, as such, no matter how near it may have approximated the end in view, cannot avail to defeat a patent. (Citing Coffin v. Ogden, 5 O. G. 270, 18 Wall. 120-124.) *Drawbaugh v. Seymour, Com'r of Patents, 77 O. G. 313, C. D. 1896.

410. A device which differs from the terms of the issue in that particular feature which the office once held in the same case was sufficient to constitute a patentable distinction, is not a reduction to practice of the issue. Breul v. Smith, 78 O. G. 1906, C. D. 1897.

411. When complete reduction to practice amounts to two years' public use, the fact of such reduction must be established by evidence of the same degree as that required in evidence setting up the bar of public use. *Wurts v. Harrington, 79 O. G. 335, C. D. 1897.

412. In a controversy between two rival ap-

plicants the requirement that reduction to practice by the junior party before the senior should be established beyond a reasonable doubt, is unduly onerous. *Id.

413. On the proof, *held*, that the claim of Seher is not sufficiently and definitely established to maintain his patent, it having, as it can have, only *prima facie* effect; that he has failed to show that he has fully and completely established by experimental tests so as to enable persons reasonably skilled in the science of chemistry to determine whether or not the composition made and claimed by him as new and valuable in the arts really possesses those properties which he claims as the essential character as an operative means, for no invention or discovery in such case as the present can be regarded as complete until such tests have been applied and have been successfully maintained. *Stevens v. Seher, 81 O. G. 1932, C. D. 1897.

(b) *Actual.*

414. Reduction to practice of a mechanism consists in the construction of the mechanism of a size capable of practical use and a knowledge, preferably by actual trial, that it will work practically for the intended purpose. Juengst v. Boyer, 63 O. G. 152, C. D. 1893.

415. Where the mechanism embodying the issue in interference works practically, and another mechanism connected thereto fails to work practically, *held*, that each stands on its own basis and that the former is competent evidence of reduction to practice. *Id.*

416. Where the exhibit relied on to establish priority of invention has all the necessary parts to a full-sized working machine, and it fully accomplished at the date of its construction the purpose for which it was intended, and its mode of operation and utility were understood and appreciated by those who saw it operate, *held*, that such exhibit was a reduction to practice, regardless of the question whether the various other mechanisms entering into the machine all worked with practical success or not. *National Cash Register Co. v. Lamson Consolidated Store Service Co., 67 O. G. 680, C. D. 1894.

417. Where G. was the first to conceive and the first to reduce to operation, although the machine was far from perfect and never operated continuously for work in a commercial sense, *held*, that such machine was something more than an unsuccessful experiment—that it was a reasonably successful reduction to