

practice. *Coffee v. Guerrant, 68 O. G. 279, C. D. 1894.

418. Where a large dynamo was provided with the brush-holders in issue and was run for a time successfully under conditions of use such as would represent actual practice, *held* to constitute a reduction to practice. Thomson v. Priest, v. Wetmore, 71 O. G. 1769, C. D. 1895.

419. Where the brush-holder was used successfully on a dynamo, then laid aside, and could not be found when the testimony was taken, *held*, that the failure to produce the device had no effect on the question of reduction to practice, except that it suggests that the device did not work successfully; but on this point the direct evidence outweighs the suggestion. *Id.*

420. As a rule, to reduce a method or process to practice the series of acts which constitute such method or process must be performed. Croskey v. Atterbury, 75 O. G. 1359, C. D. 1896.

421. Actual reduction to practice of a process consists in the actual performance of the process. Making a device by means of which the process can be carried out is not such a performance, and is not, therefore, a reduction to practice. *Croskey v. Atterbury, 76 O. G. 163, C. D. 1896.

422. Although a device was not commercially perfected and did not do as efficient work as later devices, yet, as it showed every feature of the invention in controversy and was adapted to perform the work for which it was intended and actually did such work, it is *held* that such a device was a reduction to practice. Loewer v. Ross, 76 O. G. 1711, C. D. 1896.

423. When a senior party has shown that he was in possession of a machine which would make the article—a chain—of the issue, the actual production of such chain may be safely presumed. Breul v. Smith, 78 O. G. 1904, C. D. 1897.

424. The use of a shoe-last in trimming soles is not a reduction to practice of the same last for use in leveling soles, where the conditions are different and the strain upon the last much greater. Arnold v. Taylor, 79 O. G. 154, C. D. 1897.

425. An invention that is complete and that produced the result sought to be accomplished by the inventor to his satisfaction and that of competent witnesses, and which was tried in connection with a working system, is a satisfactory reduction to practice, even though the device was never in fact incorporated into and made a part of the system, if the conditions of the trial were complete and satisfactory. *Wurts v. Harrington, 79 O. G. 337, C. D. 1897.

426. 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. **Id.*

427. A work-shop test of a wick-lift for a lamp, which consisted in determining whether the lift would operate the wick-holder of a lamp provided with neither oil nor wick, when it appears that such is the ordinary shop way of testing wick-lifts, is a sufficient reduction to practice. Nankervis v. Johnson, 79 O. G. 1519, C. D. 1897.

(c) *Constructive.*

429. Webster filed an application in 1867 showing but not claiming the invention. It was rejected and the rejection acquiesced in. In May, 1875, Sanford filed an application claiming the invention, and in July the patent issued. June, 1876, Webster filed a second application claiming the invention, and was put into interference with Sanford's patent. Sanford conceived the invention in December, 1873, and diligently reduced it to practice as early as July, 1874. Webster did nothing toward a reduction to practice except filing his application of 1867. *Held*, that the filing of the application in 1867 constituted conception but not reduction to practice, and that showing no diligence priority of invention must be awarded to Sanford. The filing of such an application in the patent office does not constitute "prior knowledge or use by others" within the meaning of the statute. It requires the invention to be reduced to practice in "a concrete and perfect form to make it capable of prior knowledge or use by others." Mere drawing and description not published will not bring the invention within the requirement. *Webster v. Sanford, 44 O. G. 567, C. D. 1888.

430. The filing of a caveat does not give to the caveator the standing of an applicant with respect to constructive reduction to practice. The statute does not contemplate that a caveator shall stand as an obstruction to the diligent efforts of other inventors in the same field of art. Elges v. Miller, 46 O. G. 1514, C. D. 1889.

431. Actual reduction to practice is not the only competent evidence of perfection and adaptation to use; but the inventor's act in filing an allowable application is to be regarded in law as such an efficient and crowning step as to give it the standing of an invention so perfected and adapted. Lorraine v. Thurmond, 51 O. G. 1781, C. D. 1890.

432. The filing of an application, which is pronounced by the experts of the office to be sufficient to authorize the granting of a patent, is for the purpose of a judgment upon the record conclusive evidence of perfected invention on the part of the applicant at or before its filing date. *Lindsay v. McDonough*, 55 O. G. 1402, C. D. 1891.

433. An application for a patent which eventuates in the grant of a patent is a constructive and presumptive reduction to practice. *Hunter v. Jenkins*, 56 O. G. 1705, C. D. 1891.

434. The filing of an allowable application constitutes a reduction to practice. (Citing *Lorraine v. Thurmond*, 51 O. G. 1781, C. D. 1890, 86; *Telephone Cases*, 60 O. G. 1753, 126 U. S. 535.) **Porter v. Loudon*, 73 O. G. 1551, C. D. 1895.

435. Carty filed an application April 20, 1885, which became abandoned October 21, 1887. He filed another original application November 17, 1887. Kellogg filed an original application July 30, 1887. *Held*, that Carty's abandoned application is only evidence of conception; that his excuse for want of diligence in prosecuting his claim being weak, Kellogg, who first constructively reduced to practice by filing an application, is entitled to award of priority. **Carty v. Kellogg*, 74 O. G. 657, C. D. 1896.

436. The filing of a completed allowable application for a patent for the invention is a constructive reduction to practice and is as effectual in a contest of priority as actual reduction to practice. (*Porter v. Loudon*, 23 Wash. L. R. 689; *Yates v. Huson*, 24 id. 214, and the cases and authorities referred to in the opinions in those cases.) **Croskey v. Atterbury*, 76 O. G. 163, C. D. 1896.

437. The filing of a complete application is a constructive reduction to practice, even though such application be subsequently amended, provided such amendment is made to secure conformity between parts of the application. **Id.*

438. Neither an executed specification nor an incomplete application nor anything except a complete allowable application can be regarded as a constructive reduction to practice. *Phelps v. Hardy, v. Gattman and Stern*, 77 O. G. 631, C. D. 1896.

439. On the question of the sufficiency of a party's application to enable him to avail himself of his specification and drawings as constructive reduction to practice on the date of their filing, it is necessary to distinguish be-

tween those which are sufficient to show an intellectual conception of an improvement and those which are sufficient in a patent to enable others skilled in the art to build the machine without extraneous aid. *Fowler v. Dodge*, 78 O. G. 2045, C. D. 1897.

440. Allowed applications operate as constructive reduction to practice of the inventions claimed, and it is therefore incumbent upon the other applicant to show by clear proof completed invention prior to the dates of such applications. (*Porter v. Loudon*, 73 O. G. 1551, 7 App. D. C. 64, 72; *Soley v. Hebbard*, 70 O. G. 921, 5 App. D. C. 99, 103; *Christie v. Seybold*, 64 O. G. 1650, 1653.) *Mergenthaler v. Scudder*, 81 O. G. 1417, C. D. 1897.

(d) *Diligence.*

441. Mere working models, allowed to rest in oblivion for many years, will not prevail to establish priority when application for patent is delayed and not filed until after another and more diligent inventor has entered the same field of invention and established his claim as an independent inventor. *Green v. Hall et al.*, 46 O. G. 1515, C. D. 1889.

442. A failure in an interference proceeding, for more than two years after conception, to do anything to reduce the invention to practice, cannot be excused by engagements in other matters. *Lowe v. Springer, v. Morse, v. Granger*, 41 MS. D. (1 G. W. D.), Nov., 1889 (*Mitchell, Com'r*).

443. B. had an application pending for an invention not involved in this interference. After forwarding the application for such invention to the patent office, he conceived the invention in controversy and offered to incorporate it by amendment, unaccompanied by any oath, in the application already filed. *Held*, that the only effect of such action was to establish diligence. *Lorraine v. Thurmond*, 51 O. G. 1781, C. D. 1890.

444. A. was under no obligation to effort until B. had conceived the invention. A party second to conceive does not prevail in virtue of his own diligence, but by reason of lack of diligence on the part of his competitor. *Id.*

445. A party who had been previously diligent, and at the date of conception on the part of his opponent was actually engaged in preparing to file his application for patent, having already finished working drawings of the invention, *held* to have exercised reasonable diligence. *Lorraine v. Thurmond*, 52 O. G. 1949, C. D. 1890.

446. The settled rule of law is that whoever first perfects the invention is entitled to the patent and is the real inventor, although others may have previously had the idea and made some experiments toward putting it in practice. To this rule a single exception is recognized, to wit: that if the one first to conceive the invention was at the time using reasonable diligence in adapting and perfecting the same, he is to be recognized as the first inventor, although the second to conceive may have been the first to reduce to practice. *Ecaubert v. Hofmann*, 53 O. G. 2107, C. D. 1890.

447. In the case under consideration, *held*, that the last applicant has failed to establish by credible evidence that he first perfected the machine or the process, so as to come within the rule, or that he used reasonable diligence in adapting and perfecting the invention so as to come within the exception. *Id.*

448. Where, in a suit for infringement, it appeared that the application on which the patent in suit was granted was filed January, 1887, and that some months previous thereto the defendant had devised and constructed the machine complained of as an infringement, and that in the winter of 1883-84 the plaintiff had described it to his solicitor, and that in 1886 he repeated the description more fully, and that he did not intend at either date to reduce the invention to practice, his only concern being to protect himself in the construction and sale of the machine made under an earlier patent, and did not ever intend to apply for a patent at all unless it should seem necessary as a means for preventing others from making these machines, and that at the time of applying for patent he had not embodied his invention in a machine for practical use, and it further appeared that at the time of his first conversation with the solicitor he was as well prepared to reduce his invention to practice and apply for a patent as he was at the date of the second, and that any competent mechanic accustomed to such work could have constructed the machine from the first description almost, if not quite, as readily as from the second, *held*, that the plaintiff had failed in diligence. **Wright v. Postel*, 53 O. G. 603, C. D. 1890.

449. It is the duty of inventors to use reasonable diligence in reducing their conceptions to practice and applying for patents when desired, and they cannot neglect it without danger to their rights. **Id.*

450. A delay of over two months, wholly

unexplained, counted against an applicant when his opponent, though later in conception, showed earlier and prompt reduction to practice. *Morgan v. Wheeler*, 46 MS. D. (3 G. W. D.), April, 1891 (Mitchell, Com'r).

451. If the first person to conceive would prevail in a contest of priority over his rival, who has first reduced the invention to practice, he must show that he was using reasonable diligence in adapting and perfecting the invention at the time when his competitor entered the field. He must show that his diligence antedates the inceptive invention of his rival if he would prevail over him, and he must show that his diligence extends back to his own conception if he would carry his invention back to the date of that conception. *Christie v. Seybold*, 54 O. G. 957, C. D. 1891.

452. Where in an interference proceeding it appeared that the senior party was the first to conceive and disclose the invention, but did nothing whatever toward adapting and perfecting the invention until six months after the time when the junior party entered the field without adequate excuse for his inaction, the junior party having meanwhile reduced the invention to practice also, *held*, that the junior party was the first inventor. *Id.*

453. A delay of a year and a half between conception of the invention and filing of the application, there being no reduction to practice, during which time a rival inventor applied for and obtained a patent for the same invention, and during which time the inventor first mentioned obtained a patent containing the more substantial elements of the invention in dispute, but not containing claims broad enough to give substantial protection as regards a structure such as that now sought to be patented, *held* not to be excusable. *McDougall v. Phinney*, 56 O. G. 928, C. D. 1891.

454. The general rule is that he who is the first to conceive of an invention is entitled to a patent for it if he reduces the same to practice with reasonable diligence; but if he does not reduce to practice with reasonable diligence, he who is subsequent to conceive but first to reduce to practice will prevail. *Hunter v. Jenkin*, 56 O. G. 1705, C. D. 1891.

455. The reasonable diligence which is required in a contest over priority of invention applies alike to actual reduction to practice and to the constructive reduction to practice involved in an application. *Id.*

456. An applicant delayed making his application for five years after his conception

of the improvement, being all this time possessed of adequate means and busy upon a similar device. *Held* not an exercise of reasonable diligence in adapting and perfecting his invention. *Ligowsky v. Peters, v. Hisey*, 57 O. G. 1593, C. D. 1891.

457. Where an applicant delays for more than two years after his conception of invention before reducing it to practice, and where it appears that he had abundant means and was busy meanwhile upon other inventions, and the actual reduction to practice was a simple matter and one not involving great time or expense, *held* applicant was not reasonably diligent. *Thomson v. Ries*, 59 O. G. 298, C. D. 1892.

458. As between interference contestants, he who was last to conceive of an improvement is not entitled to take a patent therefor over him who was first to conceive, unless by reason of the latter's delay his opponent becomes the first to reduce to practice. *Eckerson v. Cox*, 60 O. G. 437, C. D. 1892.

459. Sibbald filed an application for a patent in September, 1887, which passed to issue in October, 1888, and became abandoned in October, 1890. Meanwhile Cassidy and Smith filed an application in February, 1890, and took a patent in June, 1890. Sibbald filed his second application in January, 1891. The proofs established priority of conception for Sibbald, and while satisfactorily accounting for his delay on the score of poverty showed that he took steps to file his second application before the two years' limit had expired. *Held*, the facts save Sibbald's case from abandonment and give (or justify) judgment of priority in his favor. *Sibbald v. Cassidy*, 61 O. G. 563, C. D. 1892.

460. What an applicant has done abroad by way of disclosure or reduction to practice is not pertinent to the question as to whether he exercised reasonable diligence arising in an interference in the office. *Peters v. Hisey*, 62 O. G. 315, C. D. 1893.

461. An interval of a year and a half after conception of an invention, during which the inventor practically gave up work on his improvement, *held* to negative reasonable diligence. *Slattery v. Shallenberger*, 62 O. G. 1515, C. D. 1893.

462. Where a party to an interference claimed to have had a conception of the invention in controversy on or about April 1, 1887, and to have made various sketches and disclosures of it between that date and March 7, 1889, when he filed an application for patent, and

where it appears that he took no other step toward developing the invention during that interval, although he knew the great value of the invention, was an experienced inventor, and meanwhile filed at least two other applications for patents, *held* his delay to either actually or constructively reduce to practice in this interval was not the exercise of reasonable diligence. *Brungger v. Smith*, 62 O. G. 1511, C. D. 1893.

463. The person who first conceived a comparatively simple improvement in power-presses for bookbinding made a rough sketch of it within a few months. Three years after his first conception he had working drawings made, and six months thereafter a machine was manufactured. He excused the delay by asserting that he could neither afford to buy the necessary tools sooner nor use them in his small shop. His reason for not having the machine made at another shop was that he would have made no profit on machines made by others according to his invention. *Held*, that he did not use due diligence so as to entitle him to patent as against one who conceived the invention later, but reduced it to practice sooner, than himself. **Christie v. Seybold*, 64 O. G. 1650, C. D. 1893.

464. The man who first reduces an invention to practice is *prima facie* the first inventor under act of July 4, 1836 (5 St., p. 117), but the man who first conceives the invention may date it back to such conception if he uses due diligence in reducing it to practice, and he must use such diligence before as well as after the second conception of the invention. (*Reed v. Cutter*, 1 Story, 590, followed.) **Id.*

465. Where under the above facts, and considering that the patentee was the applicant's superior officer, was adverse to him in interest in this question, had already obtained his patents, and told him, upon the latter complaining of this, that "that was all right," and had persuaded him not to apply for a patent, the applicant did not file his application until nine months after the date of his conception and more than five months after he knew of the patentee's patents, *held*, it must be considered, under these somewhat adverse circumstances, that the applicant had not incurred the penalties of negligence. *Reynolds v. Wells, Jr.*, 66 O. G. 1594, C. D. 1894.

466. Where the first to conceive is negligent in reducing to practice, and the second to conceive is so diligent as to put the invention into practice before the date of the reduction to

practice by the first to conceive, *held*, under such facts, that the second to conceive is the first inventor. *Calhoun v. Hodgson*, 67 O. G. 1329, C. D. 1894.

467. In the cases where delay in completing an invention is excused there is something of compelling power in the circumstances that produce it. *Dailey v. Jones*, 67 O. G. 1719, C. D. 1894.

468. While an inventor who is first to conceive and is reasonably diligent in completing his invention should ordinarily prevail over a competitor who subsequently conceives but is first to complete his invention, still if the first to conceive has means, credit, influence and friends, and is not brought to a standstill by anything in the nature of compulsion, but chooses delay on business grounds, he thus excludes himself from the advantage which flows from his prior conception. *Id.*

469. A second patent for the same invention upon an application filed nearly three months after the patent issued is refused where the applicant made the hoop-coupling and tried it upon a strap around a block of wood, but soon afterward put it under his bench, where it remained for more than two years and until after the senior party invented it, put it into practice, and obtained a patent therefor. *Burr v. Ford and Ferguson*, 68 O. G. 655, C. D. 1894.

470. "Although Yates was the first to apply for a patent, and did so prior to the completion of Huson's machine, and subsequently received a patent thereon a few days before Huson made application, Huson was the first inventor; he was proceeding with reasonable diligence from April, 1891, to the completion of his invention on December 3, 1891, and was diligently engaged therein when Yates formed his first conception of this invention in October, 1891." *Huson v. Yates*, 72 O. G. 1201, C. D. 1895.

471. Croskey conceived the invention in December, 1890, and reduced it to practice October 3, 1892. Atterbury conceived the invention in July, 1892, and filed an allowable application October 1, 1892. *Held*, that Atterbury is the prior inventor in the absence of a showing of reasonable diligence on Croskey's part. *Croskey v. Atterbury*, 73 O. G. 1359, C. D. 1895.

472. When at any time within two years Croskey could have completed his process and failed to do so, he has not established a case of reasonable diligence against Atterbury, who conceived later than Croskey, but filed an application before Croskey reduced to practice. *Id.*

473. A delay of six years, unexcused by sickness or poverty, fatal to a claim of priority depending upon connecting an earlier conception to a later reduction. **Porter v. Loudon*, 73 O. G. 1551, C. D. 1895.

474. Huson, being the first to conceive the invention and using reasonable diligence in adapting and perfecting the same at the time of Yates' conception, must prevail as against Yates, although Huson failed to reduce to practice until after Yates had filed his application for patent. **Yates v. Huson*, 74 O. G. 1732, C. D. 1896.

475. The words of the law, "was using reasonable diligence," refer to the very time of the second conception. For the prior conceiver to show that his diligence only began with the time of the second conception would not be sufficient; all that is necessary is that the first conceiver shall have begun and prosecuted with diligence the work of adapting and perfecting his invention before the date of his rival's conception. **Id.*

476. While it is required that the first conceiver shall prosecute his labors in reducing to practice with reasonable diligence, that diligence, however, is a matter to be determined by the special circumstances of the particular case. **Id.*

477. While the general policy of the law (sec. 4920, R. S.) is to require diligence in adapting and perfecting inventions on the part of those who wait and work to that end, yet it is to at the same time encourage those efforts to such a degree as that their merits and value might be practically tested before application for patent. **Id.*

478. If Chase had the germ of the idea in 1883 and did not reduce to practice until 1891 and did nothing during the intervening years. *held*, that the idea had been forgotten and abandoned. **Chase v. La Flare*, 74 O. G. 1735, C. D. 1896.

479. There is no general rule of what constitutes due diligence. It is reasonable diligence, and that is to be determined by all the facts in the case. An inaction of eighteen months, in the absence of controlling adverse conditions, is not reasonable diligence in the case of an invention which required but one month for actual development. **Croskey v. Atterbury*, 76 O. G. 163, C. D. 1896.

480. Scudder being the first to conceive of the invention and having used reasonable diligence, under the circumstances, in reducing to practice, is awarded priority. *Scudder v. Mergenthaler*, 76 O. G. 1851, C. D. 1896.

481. Scudder, after conceiving of the invention, being confronted with large expenditure as to the making of the machine, and with the question whether the machine when perfected was an improvement upon the existing Mergenthaler machine, and not capable of separate and independent manufacture, except by license under the Mergenthaler patents, is entitled to some indulgence while he is enlisting the capital of others, while maturing his own plans, and, in the case of so complicated a machine, while dwelling upon the details of construction. *Id.*

482. While an inventor might file an application in the patent office covering an invention before making a test, yet it is not required that he should do so; but, on the other hand, it is presumable, if it be not required, by plain implication from the language of section 4920, Revised Statutes, that he should occupy himself first in adapting and perfecting his invention. *Id.*

483. Lack of diligence is not excused by applicants relying upon the advice of an attorney that the invention was not patentable. *Gray v. Alexander*, 62 MS. D., July, 1897 (Butterworth, Com'r).

484. Attorney's advice to an interferant to the effect that the invention of the issue is covered by his prior patent is an excuse but not a justification for delay in reducing to practice or applying for a patent. *Breul v. Smith*, 78 O. G. 1904, C. D. 1897.

485. Long delay in filing an application for a patent after alleged conception of the invention casts a doubt upon the allegation of conception, but it may be shown by the circumstances to be not inconsistent with inventorship. **Hunt v. McCaslin*, 79 O. G. 861, C. D. 1897.

486. Delay of four years is too long for reduction to practice of a simple device by a manufacturer possessed of ample means. *Arnold v. Tyler*, 79 O. G. 154, C. D. 1897.

487. The fact that an applicant made inquiries as to the patentability of a device is immaterial to the question of reduction to practice and does not establish diligence. *Id.*

488. Mistaken advice on the part of a solicitor, from which followed long delay in putting an invention into practice, will not be allowed to militate against the just claims of others who have been diligent in the realization of their conceptions. **Arnold v. Tyler*, 79 O. G. 156, C. D. 1897.

489. Whether reasonable diligence is exer-

cised in reducing an invention to practice is a question to be determined in view of all the circumstances of the case. While the law is indulgent to the inventor and saves him from the consequences of delays which he could not avoid, it gives him no option as to the diligent pursuit of his reduction according to his actual abilities, but holds him strictly to the rule, as justice and the public interest require. No difficulties in reducing to practice will excuse delay, unless they relate to matters or circumstances beyond the control of the inventor, such as sickness, poverty, or other involuntary disability not having the consent of the claimant. **McCormick v. Cleal*, 80 O. G. 1614, C. D. 1897.

490. M's application, except the claims, was prepared in February, 1894, but he delayed filing until October, 1894, and in the meantime, in July, 1894, C. filed his application. *Held*, that the sole excuse of the delay—that M's attorney was too busy with other engagements to take up his case—was insufficient to defeat C's right to a patent. **Id.*

491. Where the practice of the office is settled, it should be followed, unless there are very good reasons for changing it. The rule *stare decisis* must prevail in the patent office as in the courts. **Id.*

(e) *Drawings or Sketches.*

492. Mere drawings and description not published, *held* not sufficient to meet requirements and show reduction. **Webster v. Sanford*, 44 O. G. 567, C. D. 1888.

493. A rough sketch of an invention is not such a reduction to practice as to make its author the original inventor within the meaning of the patent laws. **Christie v. Seybold*, 64 O. G. 1650, C. D. 1893.

494. While the failure to produce the original sketches, specimens of the device made, or the machine upon which it was made is always the subject of adverse criticism, yet it may be so explained that priority may be awarded to the party who does not produce such evidence to show reduction to practice. *Shellaberger v. Sommer*, 74 O. G. 1897, C. D. 1896.

495. An illustration which amounts to no more than a suggestion is not sufficient warrant for a claim filed nearly two years after the application and nine days after an interfering patent. *Dewey v. Colby*, 75 O. G. 1860, C. D. 1896.

496. An illustration of a device of doubtful purpose is not a reduction to practice. *Id.*

(f) Experiment, Abandoned or Unsuccessful.

497. Where one of the parties to an interference had first made a machine upon which the issue can be read, but which was inoperative and was dismantled and not assembled until and except for the purpose of the interference, and, furthermore, after such dismantling the party continued to experiment in that line with other devices and finally was only successful by substituting in his machine a device of another inventor, *held*, that the first machine was an experiment and not a reduction to practice. *Glidden v. Busell*, 67 O. G. 675, C. D. 1894.

498. While reduction to practice may be made with an experimental device, it must be by practical and successful operation and must be in such use as the device would have to stand when manufactured and sold. *Arnold v. Tyler*, 79 O. G. 154, C. D. 1897.

499. When a manufacturer recognized the need of an article in his business to perform certain functions performed by the device of another, the fact that he laid aside for four years a device which he subsequently claimed was a reduction to practice of the invention in question raises a strong presumption that such device was merely an unsuccessful experiment. *Id.*

500. The contention that an interferant was for four years trying to devise means for making a certain device practicable is inconsistent with the contention that such device was a complete reduction to practice. *Id.*

(g) Working Model.

501. It is well settled that a working model designed and intended as such is not a reduction to practice. *Green v. Hall, v. Siemens, v. Field*, 46 O. G. 1515, C. D. 1889.

(Decision (by Hall, Com'r) affirmed in *Green v. Hall et al.*, 47 O. G. 1631, C. D. 1889—*Mitchell, Com'r.*)

502. An exhibit which does not show the identical thing in issue, and which was manifestly designed and intended as a mere working model and nothing more, may be evidence to lay the foundation of a claim to priority, but is not of itself sufficient evidence of reduction to practice of the alleged invention. **Porter v. Loudon*, 73 O. G. 1551, C. D. 1895.

XXVI. REINSTATEMENT OR RE-OPENING OF.

503. When the office has called the attention of an applicant to his right to cover in his

claim certain specific matter, and advised him to amend accordingly, and the applicant, declining to do so, enters into an interference contest upon the broad issue, in which he is finally defeated, he cannot, after acquiescing for a long period in such award of priority and waiting nearly ten years after filing his application, return to the office for the purpose of proposing the amendment suggested by the office and declined by him, and which, if admitted, would result in a new interference. *Ex parte Gray*, 46 O. G. 1277, C. D. 1889.

504. The tribunals adjudicating the interference discussed and considered the specific invention and intimated that a motion to dissolve and reform the issue would be entertained; but applicant declined to avail himself of the suggested remedy. *Held*, that the decisions, involving the very question presented in the amendment now insisted upon, are final and conclusive upon Gray's right to claim the subject-matter presented in the proposed amendment. *Id.*

505. Decisions upon motions to re-open an interference and for the introduction of additional testimony after expiration of the time set for taking testimony, but before the hearing, are "generally regarded as within the discretion of the examiner of interferences, and the commissioner will not disturb such decisions unless it appears there has been some abuse of discretion or disregard of some rule or law." *Schnabel v. Shellaberger*, 52 MS. D., March, 1893 (Frothingham, Ass't Com'r).

506. When in an interference proceeding the commissioner upon reconsideration vacates a former decision of abandonment, the reinstatement of the interference which had been dissolved by reason of the former decision follows as a necessary consequence. *Young v. Case*, 58 O. G. 945, C. D. 1892.

XXVII. RENEWAL APPLICATION.

507. A renewal application properly filed in place of a successful application forfeited for non-payment of final fee is, for purposes of interference, a continuation of the earlier application and takes its filing date therefrom. *Duchemin v. Priester and Schutz*, 58 O. G. 1416, C. D. 1892.

XXVIII. SERVICE OF NOTICE.

508. When an interference is declared between an application and a patent issued inadvertently during the pendency of that application, and the applicant files a motion to dissolve

the interference and to stay proceedings without having made any proof of service of notice of said motion upon the opposite party, said motion will not be entertained. (Rule 153.) *Bechman v. Johnson*, 48 O. G. 673, C. D. 1889.

509. The case is the same as if the interference had been declared between two pending applications, and the interference is rightly declared when declared under rule 94, paragraph 1, without the affidavit called for by rule 94, paragraph 2. *Id.*

510. While a motion to dissolve the interference and suspend proceedings will not be refused if made without notice to the opposite party, *quære*, whether in a case like the present a petition, without notice to the opposite party, to *vacate* the order establishing the interference might not be sustained. *Id.*

511. Pending the interference in such case an amendment which does not come within the terms of rules 106, 107, 109 will not be received or considered. (Rule 130.) *Id.*

512. H., a party to an interference, served notice on P., the opposing party, that he would take the testimony of certain persons named therein upon a certain day. When the testimony was taken, the party P., who had not been named as a witness in the notice, was called upon by H. and testified under protest. Upon motion here made to suppress his deposition, *held*, that P. as a witness for H. stands in the same position as any other witness under the rule regulating the taking of depositions, that the same formalities of notice must be observed, and the deposition having been taken informally should be suppressed. *Hill v. Parmelee*, 59 O. G. 631, C. D. 1892.

513. The provision of rule 104 which gives the examiner of interferences discretion to dispense with service on an opposing party of notice of motion to extend time for filing preliminary statement does not contemplate a case where such service can be reasonably effected, and it should not be exercised in such a case. *Illinois Watch Co. v. Robbins and Avery*, 61 O. G. 721, C. D. 1892.

514. Where the junior party having the earlier filing date filed in the office a notice that he would take no testimony, but would rely upon his application and the record of the interference as evidence of invention and reduction to practice, *held*, that service of the same should have been made upon the other party; but no substantial injury having resulted to the latter because of lack of such service, and the amendment of rule 16 being comparatively re-

cent, want of service was waived. *Lane v. Hunter, Jr.*, 63 O. G. 151, C. D. 1893.

515. The office, when it has reason to believe that an inventor is dead, should endeavor to ascertain the identity of his heirs before the declaration of an interference, and should send the interference notices to such heirs if no formal or authentic notice of the death of the inventor has been given. *Decker v. Looseley*, 77 O. G. 2140, C. D. 1896.

XXIX. STATUTORY BARS, IN GENERAL.

(See DISSOLUTION—STATUTORY BARS, *supra*;
JOINT AND SOLE APPLICATIONS, *supra*.)

516. Two applications of La Dow are involved in this interference, in one of which he is the junior and in the other the senior applicant. In his preliminary statement he sets up public sale of the invention, which, if established, would bar all parties. Clark moves that La Dow be required to file drawings and descriptions of the invention alleged to have been sold and furnish other information. *Held*, that in view of the averment of public use it would be unjust and unnecessary to put Clark to the expense of taking his evidence first, so long as La Dow was attempting to destroy the necessity of an interference, and ordered that La Dow be required to proceed first and take such evidence as he desires which shall establish the facts set forth in his preliminary statement, and also in support of the question of priority. Clark may then follow with evidence rebutting that offered by La Dow. *Clark v. La Dow*, 43 O. G. 248, C. D. 1888.

517. There is no precedent or principle justifying the granting of applicant's demand that a patent be allowed to him, in order that an interference may be instituted with a patent previously granted to another, when it distinctly appears that the applicant is not entitled to letters patent as between himself and the public. *Ex parte Meucci*, 51 O. G. 249 C. D. 1890.

518. So long as an applicant's claims are held to be unpatentable, he has no right either to the institution or continuance of an interference. *Abel and Dewar v. Maxim and Nobel*, 56 O. G. 139, C. D. 1891.

519. Although the testimony in an interference suggests a statutory bar to the grant of a patent, it is the usual practice to let the case take its regular course to final hearing and award of priority. *Bohls v. Bonsack*, 63 O. G. 464, C. D. 1893.

520. Where the applicant has the fundamental patent upon which the invention in issue is based, and where the question of the patentability of the invention in issue over the fundamental patent was discussed at the request of the commissioner, although the invention was patented, *held*, that the question of the patentability of the invention in the issue would now be referred to the examiner for his reconsideration. *Reynolds v. Wells, Jr.*, 66 O. G. 1594, C. D. 1894.

521. The consideration of alleged anticipations in the patents of third parties and one of the parties to the interference refused in this proceeding and referred to the primary examiner, under the usual practice of the office, approved by the court of appeals in *Peters v. Hisey*, 71 O. G. 892. *Hunter v. Spencer*, 71 O. G. 1767, C. D. 1895.

522. Where the record contains testimony that the invention was in public use for more than two years prior to the application of L, *held*, that since priority is the only question before the office upon the record, L is entitled to a further hearing upon this point, and the application referred to the primary examiner for this purpose. *Lossier v. Cowles et al.*, 71 O. G. 1616, C. D. 1895.

XXX. SUSPENSION.

(a) *In General.*

523. Interference proceedings should not be suspended in view of the advanced stage (appeal to examiners-in-chief pending) to which the case has progressed. Motion denied for the present, but may be called up at final hearing. *Adams v. Kinzer*, 44 MS. D., Sept., 1890 (Mitchell, Com'r).

524. Practice approving stipulations for the suspension of interference proceedings during the pleasure of the parties disapproved. Interference proceedings, like all other proceedings in the patent office, should be dispatched under a sense of responsibility to the public at large, and the suspension of proceedings during the pleasure of the parties should never be permitted by the examiner of interferences, and all postponements should be to a fixed and reasonable future time. *Baglin v. Doubleday*, 53 O. G. 1833, C. D. 1890.

525. The senior party, who was a patentee, having raised the question whether the application of his opponent had not become abandoned by non-prosecution, ordered that the

interference be suspended and the applicant required to show cause why his application should not be held to have become abandoned under section 4894, Revised Statutes of the United States. *Id.*

526. When an interference is suspended under rule 128, the claims anticipated should be rejected by the primary examiner, and the files and papers should not be returned to the examiner of interferences until it has been determined whether the appellate tribunals will sustain the examiner in rejecting the claims, or until the laches and delay of the applicant in taking an appeal are such as to authorize the office to dissolve the interference or to issue a patent to the opposing party. *Westinghouse v. Thomson*, 56 O. G. 142, C. D. 1891.

527. The consideration of references under rule 128 should be *ex parte*. *Id.*

528. Petition for suspension of an interference in order that a question of the patentability of a claim might be considered denied, it appearing that the same interference had been previously suspended for nearly two years for a similar purpose. *Holt v. Mills*, 56 O. G. 1059, C. D. 1891.

529. An interference may be suspended on final hearing before commissioner and the case remanded to primary examiner for consideration of operativeness. *Ex parte Archer*, 57 O. G. 696, C. D. 1891.

530. A motion to stay the proceedings in interference may be granted pending the determination of a motion to dissolve. *Lamb v. Warren*, 64 O. G. 437, C. D. 1893.

(b) *For Adding New Parties.*

531. When an application is received in this office which, in the opinion of the primary examiner in charge, should be included in a pending interference, the fact and date of the filing of such application should be reported by such examiner to the examiner of interferences, together with a request for the suspension of the interference proceeding for the purpose of adding such new party. *Reed v. Jordan*, 38 O. G. 601, C. D. 1887.

532. If the files in the interference disclose that testimony has actually been taken, the examiner of interferences should forward to the commissioner a report to that effect, accompanied by the report of the primary examiner to himself, together with his recommendation as to whether or not, in his opinion, the new party should be added. *Id.*

533. If the interference files do not disclose the fact that any testimony has been taken, the examiner of interferences will advise the parties to the proceeding that a new application has been filed, that it should probably be included in the interference, that it is necessary to know whether or not any testimony has been taken, and if so, when, where and how much, together with the names of the witnesses who have been sworn; and if not, when and where the first testimony is expected to be taken. *Id.*

534. The examiner of interferences may, if he think necessary, take additional steps to assure himself as to the fact of whether or not testimony has been taken. *Id.*

535. If, after proper inquiry, the examiner of interferences is satisfied that no testimony has been taken, he may grant the suspension, and the new party may be added to the interference without the direction of the commissioner. *Id.*

536. If, on the contrary, after such inquiry the examiner of interferences is satisfied that testimony has been taken, he should report the facts, together with his conclusions and recommendation, to the commissioner. *Id.*

537. When no testimony has been taken, the primary examiner may, after suspension of the interference, add such new party thereto without the order of the commissioner. *Id.*

538. If, however, testimony has been taken, no new party can be added to the interference without the order of the commissioner. *Id.*

539. Where one effect of suspending an interference to add a new party would be to practically reinstate a party thereto who has allowed his rights to lapse by neglecting to take his testimony within the limited time, a request to suspend will be denied. *Wein v. Northrop*, 58 O. G. 1416, C. D. 1892.

XXXI. TESTIMONY.

(See EVIDENCE IN A FOREIGN COUNTRY.)

(a) *In General.*

540. An applicant who, to save expense, employs counsel unfamiliar with interference proceedings to take testimony cannot, after discovering that he has not made out his case in such a manner as he might if the testimony had been taken by counsel familiar with such proceedings, be allowed to retake his testimony. *Ricker v. Merrill*, 43 MS. D., 2 G. W. D., July, 1890 (Fisher, Ass't Com'r).

541. The testimony of a witness in interference proceedings to the effect that he is the inventor of the subject-matter of the issue in controversy is not an incomplete caveat or application for patent within the meaning of the patent laws. *Bohls v. Bonsack*, 63 O. G. 464, C. D. 1893.

542. When a party to an interference is surprised by evidence or a line of defense which he has had no reason to anticipate or opportunity to prepare against, he should have the privilege of answer or explanation whatever may be the stage of the proceedings, even though he has had the opportunity of cross-examination. *Scribner and Warner v. Childs, v. Balsley*, 63 O. G. 1961, C. D. 1893.

543. The fact that an applicant in his testimony states his conception at an earlier date than in his statement, the fact that he declined to submit for general examination by opponent's counsel the sketch-book from which he states the drawings offered in evidence were cut, and the fact that he declined to answer some of the questions put to him, do not constitute grounds for disregarding his testimony. **Croskey v. Atterbury*, 76 O. G. 163, C. D. 1896.

544. It is contrary to established practice to receive *ex parte* affidavits as testimony in interference in absence of stipulation to that effect between the parties. *McDonough v. Cleal*, 61 MS. D., April, 1897 (Fisher, Ass't Com'r).

545. An extension of time to take testimony refused when repeated extensions had already been granted and specific warnings against delay been given. *Birrell v. Regan*, 61 MS. D., June, 1897 (Greeley, Ass't Com'r).

546. A request for a commission to take testimony abroad should be decided by the examiner of interferences on its merits, whether it contains a request for extension of time or not. *Freeman v. Bernstein, v. Hunter, v. Thomson and Houston, v. The Westinghouse Electric Co. & Gibbs*, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

547. The rule for extension of time for taking testimony is a salutary one, made in the interest of all parties. Where there is an obvious disregard of the rule, there is nothing left to do but to abolish the rule or compel its observance, and there is only one way to accomplish the latter, which is to refuse to permit testimony to be taken when it is not observed. *Keller v. Wethey, v. Roberts*, 81 O. G. 331, C. D. 1897.

548. It is better to insist upon a reasonable and just compliance with the rules of practice

of the office, though it may work a hardship in an individual case, than adopt a course which would result in a practical abrogation of them, with consequent confusion. (Citing *Smith and Thomas v. Cowles*, 30 O. G. 343.) *Id.*

(b) *Admissibility of Record in Former Case.*

549. Testimony taken in an interference may not be used in another interference between the same parties, unless the latter so agree. *Goodell v. Ellrich*, 34 MS. D., April, 1887 (Montgomery, Com'r).

550. Where a party on trial of an interference gives notice that reference will be made to proceedings and testimony of a former interference between the parties, the whole record will be presumed to be meant unless the notice distinctly specifies a part of the record and the purpose for which its admission is sought. *Wilson v. Haines*, 57 O. G. 1278, C. D. 1891.

551. Testimony taken in one interference cannot be used in a subsequent interference when such use is opposed by a party to such later interference who was neither a party nor privy to the earlier interference at the time the testimony was taken and thereafter, when it does not appear that the witnesses who testified in the earlier interference cannot be procured to testify in the later one. *Hunter v. Sprague*, 63 O. G. 611, C. D. 1893.

552. Testimony taken in one interference should not be admitted into a subsequent interference between different parties against the protest of one of the parties to the later interference, even though the evidence sought to be introduced is pertinent to the later issue and the protesting party was also a party to the earlier interference. *Secor and Secor v. Knapp*, 63 O. G. 612, C. D. 1893.

(c) *Filing.*

553. There is no positive rule requiring parties to file all depositions taken in a contested case, and the commissioner is without authority to compel the filing of such depositions. †*Petithomme v. Bedbury*, 52 O. G. 605, C. D. 1890.

554. Assistant attorney-general suggests that the commissioner be directed to consider and report upon the advisability of adopting a rule to the effect that either party to an interference may have the right to file and use the testimony upon payment of the costs for taking the same with appropriate penalties for obstructing the filing thereof. †*Id.*

(d) *Interested Parties.*

555. Where the notary taking depositions in an interference case was an employee of a company holding the interest of one of the parties thereto by assignment, and also appeared as a witness in the case, the other party having formally objected at the proper time to the taking of the testimony before him, *held*, on motion to strike out the testimony so taken, that the notary was an interested party within the meaning of rule 156, and that the testimony must be stricken from the record. *Vanness v. Shettler*, 57 O. G. 843, C. D. 1891.

556. The rules and practice of this office regarding the taking of depositions look first of all to the strict impartiality of the magistrate and must be strictly applied, and the office will exercise a jealous supervision in this respect. *Id.*

557. Rule 156 is broad enough to cover any interest in or relation to the party or subject-matter sufficient to raise a presumption of bias. *Id.*

558. If the proceedings were originally repugnant to the rule, the depositions taken thereunder are void *ab initio*, regardless of any question of actual fraud or prejudice resulting therefrom. *Id.*

(e) *Irrelevant.*

559. Where the record abounds in improper remarks, long statements touching the conduct of counsel and witnesses, imputations of fraud, perjury and bribery, which are not proof and are not proper parts of the record, *held*, that such matter should have been expunged before printing, and would have been excluded upon motion. (*Smith v. Elliott*, 9 Blatchf. 400, 407.) *Northall v. Painter, v. Bernardin*, 71 O. G. 1159, C. D. 1895.

560. Where the record is unnecessarily voluminous from the method of examination adopted, *held*, that the office should be burdened with the reading of additional and wholly irrelevant discussion of other matter of the kind alluded to is intolerable, and the insertion of such things in the record cannot be too strongly condemned. *Id.*

XXXII. VACATING JUDGMENT.

561. *Held*, that applicant might make a motion to vacate the judgment in interference so far as it related to subject-matter not common to both parties, and that if the facts were as alleged proper relief might be afforded. *Ex parte Booth*, 49 O. G. 1841, C. D. 1889.

562. Where, after a judgment of priority by the commissioner, and after the claims of the defeated party had been rejected under rule 132, it appeared that certain of said claims were clearly special to his structure and would not be infringed by anything contained in the device of the prevailing party, *held*, that said judgment should be vacated as to said claims. *Held*, further, that as to another of said claims, which was liable to be construed so as to embrace matter common to the organization of the structures of both parties, the judgment should not be vacated. *Ehrlich v. Van Horn*, 54 O. G. 506, C. D. 1891.

563. On the granting of a motion to dissolve the interference after judgment upon the record, the examiner of interferences will vacate the judgment of priority. *Garrison v. Hübner*, 54 O. G. 1889, C. D. 1891.

564. Vacation of judgment of priority ordered on the granting of a motion to dissolve an interference on the ground that there was no interference in fact. *Rogers v. Winssinger*, 56 O. G. 804, C. D. 1891.

565. On a motion to vacate a judgment rendered in an interference, based upon a misunderstanding as to what applications were included, and where it appears that the office action was clear and unequivocal, *held*, the office will not interfere to cure mere remissness and inadvertence of an applicant, and the motion denied. *Hunter v. Knight*, 61 O. G. 423, C. D. 1892.

INTERFERING PATENTS.

(See SUBSEQUENT APPLICATIONS; RESERVATION IN APPLICATION; CROSS-REFERENCES; DIVISIONAL APPLICATIONS.)

I. SAME INVENTOR.

II. DIFFERENT INVENTORS.

I. SAME INVENTOR.

1. Decision in *Ex parte Holt*, April 26, 1884, reiterated. A patent should not issue upon an application covering subject-matter shown in a prior patent to the same party, but not constituting a proper division of said patent. *Ex parte Ransom*, 39 O. G. 119, C. D. 1887.

2. Where the subject-matter of invention is one, integral and indivisible, the issuance of the first patent bars all subsequent applications, whether concurrent with the first or filed subsequently. This results because the law conclusively infers from the issuance of the first

patent that the inventor dedicated to the public the unclaimed features of his invention. It is against public policy to permit the inventor in such case to prolong the monopoly of his invention by a second or repeated patents. *Ex parte Roberts*, 40 O. G. 573, C. D. 1887.

3. After a patent has been granted for an article described or made in a certain way the inventor cannot afterward obtain a valid patent on an independent application for the method or process of making the article in the way described in the earlier patent. **The Mosler Safe and Lock Co. v. Mosler, Bahmann & Co.*, 43 O. G. 1115, C. D. 1888.

4. Where a patent fully describes an invention which could be claimed therein and makes no reservation and gives no warning to the public, a second patent granted upon an application filed after the first patent was issued, which claims simply the invention previously made public, is invalid. (*Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co.*, 33 Fed. Rep. 254.) **Brush Electric Co. v. Julien Electric Co.*, 41 Fed. Rep. 679 (1890).

5. To grant a patent upon an application claiming an invention broadly or generically after a patent has been granted to the same inventor for the same invention embodied in the same structure and more restrictedly stated would be in effect to grant a re-issue of the previous patent and at the same time extend its term. *Ex parte Edison*, 54 O. G. 263, C. D. 1891.

6. The case to be clearly distinguished from that of *Ex parte Edison* (C. D. 1889, 234, 49 O. G. 1691), a case relating to specific improvements. *Id.*

7. It is not permissible to allow claims appearing in a patent to be transferred to a subsequent application by the same inventor. Such a course would extend the monopoly beyond the period of time allowed by the statute. *Ex parte Barrett*, 56 O. G. 930, C. D. 1891.

8. The date of the application, and not the date of the patent, controls in determining the legal effect to be given to two patents issued at different dates to the same inventor and the order in which they are to be considered. **Washburn & Moen Mfg. Co. v. Beat 'Em All Barbed Wire Co.*, 58 O. G. 1555, C. D. 1892.

9. Where pending a long interference as to a broad invention the applicant takes out a patent for a narrow or specific part of that broad invention, which patent states on its face that it is a division of the broad application and which patent describes but does not

claim the broad invention, *held*, that the earlier narrow patent should receive a limited construction in accordance with its apparent scope, and that the later broad patent is valid. *Electrical Accumulator Co. v. Brush Electric Co., 61 O. G. 886, C. D. 1892.

10. Where two patents exist for the same invention, the applications for which were filed on the same day by the same inventor, the patents were issued on the same day, and are owned by the same person, and the testimony shows that it can never be ascertained which patent actually first received the final signature which rendered it a complete and legal deed, *held*, that there are no known presumptions which can be resorted to upon which to base a finding as to which of the two is the earlier patent, and *held* that the owner of both patents has the right to elect the one upon which it will rest its title to a monopoly, even though that one be the one having the higher or later serial number. *Id.

11. *Held*, also, that in such case, in connection with the finding of validity of the one patent, the court should adjudge the other patent to be inoperative and should prohibit its assignment or sale. *Id.

12. *Held* that in such case, where the patentee was the actual and first inventor of the whole of the described and patentable thing which is specified in the patent, the sections of the statutes in regard to disclaimer were not intended to apply and do not apply. *Id.

13. Where the inventor of a machine for coupling the links of drive-chains simultaneously filed two applications for patents, one for a machine for an endwise and one for a machine for a sidewise thrust of the coupling-bar, and had a patent issued on the first machine, *held*, that it was not afterward entitled to a patent on the second machine, as it was only a matter of mechanical skill, and not invention, to adapt the endwise to the sidewise thrust. *Fassett v. Ewart Mfg. Co., 64 O. G. 439, C. D. 1893.

14. A patent having been granted for a machine and for a dish made by it, a subsequent patent for the process was held invalid. *Oval Wood Dish Co. v. Sandy Creek (N. Y.) Wood Mfg. Co., 60 Fed. Rep. 285 (1894).

(Miller v. Eagle Co., 66 O. G. 845, declared "the latest and most pronounced case on this subject.")

15. Of two patents for the same invention issued to the same inventor the later is void. (Suffolk Co. v. Hayden, 3 Wall. 815; James v. Campbell, 21 O. G. 337, 104 U. S. 382; Mosler

Safe Co. v. Mosler, 43 O. G. 1115, 127 U. S. 355; McCreary v. Pennsylvania Canal Co., 57 O. G. 1131, 141 U. S. 467; Underwood v. Gerber, 149 U. S. 224, 63 O. G. 1063.) *Miller v. Eagle Mfg. Co., 66 O. G. 845, C. D. 1894.

(Decision of United States supreme court.)

16. The reason for the rule established by the above-cited cases is that the power to create a grant is exhausted by the first patent, and for the further reason that a new and later patent for the same invention would operate to extend or prolong the monopoly beyond the period allowed by law. (Odiorne v. Amesbury Nail Factory, 2 Mason, 28, 1 Robb, 300.) *Id.

17. The result of the authorities on this point of law is that no later patent can be issued for an invention actually covered by an earlier patent, especially to the same patentee, although the terms of the claims in the two patents may differ and the later patent may contain the broader claims, but that where the later patent covers matter described in the earlier patent, which, however, is essentially distinct and separable from the invention covered by the earlier patent and claims made thereunder, its validity may be sustained. *Id.

18. In the last class of cases just mentioned it must distinctly appear that the invention covered by the later patent was a separate invention distinctly different and independent from that covered by the first patent. It must consist in something more than a mere distinction of the breadth or scope of the claims of each patent. *Id.

19. Nor, in view of the aforesaid authorities, can the proposition be sustained that whether the invention shall be protected in part of its *features* by one patent and as to the rest by another, or shall be completely protected by a single patent, is a matter which concerns solely the patent office and the inventor. *Id.

20. While it is settled law that a process and its product, an apparatus and its product and an improvement on a patented invention each may be patented in separate later patents, yet in each case the invention must be clearly distinct from and independent of the one previously patented. (Sewall v. Jones, C. D. 1876, 256, 9 O. G. 47, 91 U. S. 190; Merrill v. Yeomans, C. D. 1877, 279, 11 O. G. 970, 94 U. S. 94.) *Id.

21. The invention covered by the first patent (No. 222,767) consists in a spring which serves the double purpose of *lifting* or *holding* down the plows at will, the patent thus embrac-

ing both the lifting and depressing operations and the later patent (No. 242,497) consists in the identical spring used for the single purpose of the *lifting* operation. The subject-matter being the same, no patentable distinction can be drawn between the two patents, and the rule above announced can have no application to the case. *Id.

22. The invention in the earlier patent covered the means by which the results sought by the later patent were to be accomplished, and, as it is settled law that the patentee of a device is entitled to all its uses whether described or not (*Roberts v. Ryer*, C. D. 1876, 439, 10 O. G. 204, 91 U. S. 105; *Stow v. Chicago*, C. D. 1892, 131, 21 O. G. 790, 104 U. S. 547), the increased lifting effect of the spring sought to be covered in the later patent being clearly shown and described and claimed in the earlier patent, it follows that it was not the subject of a later patent. *Id.

23. The claims in both patents might have been made in either patent, as they covered one and the same invention, and to hold that the second patent, which was for one part of the invention or in its function, after such part or its action had been covered by a prior patent, presents distinct invention, or that both are valid for the same invention, would involve the drawing of distinctions too refined for the practical administration of the patent law. *Id.

24. The decision of the supreme court in the case of *Miller v. Eagle Mfg. Co.* (66 O. G. 845) interpreted and *held* that it did not change the law. It simply declared a second patent void on the plain ground that it was for the same invention as the first, and the effect of it, if sustained, would be to prolong the monopoly beyond the period intended by the patent law. **Fenton Metallic Mfg. Co. v. Office Specialty Mfg. Co.*, 68 O. G. 1390, C. D. 1894.

25. Patent to Emile Berliner, No. 463,569, dated November 17, 1891, is void because one of the functions of the device shown in the patent No. 233,969, dated November 2, 1880, to the same inventor—namely, the function of transmitting articulate speech—is identical with the sole object or function of the device covered by the patent of 1891, and the device for effecting the transmission is identical in both patents. (*Miller v. Eagle Mfg. Co.*, 66 O. G. 845, 151 U. S. 186.) **United States of America v. American Bell Telephone Co.*, 69 O. G. 1778, C. D. 1894.

26. Patent No. 238,315 to Elihu Thomson and

Edwin J. Houston, issued March 1, 1881, examined and *held* an unwarrantable prolongation of the just monopoly-conferred by letters patent No. 223,659 to the same inventors, for substantially the same invention, issued January 20, 1880. *Thomson-Houston Electric Co. v. Western Electric Co.*, 73 O. G. 1123, C. D. 1895.

27. The fact that a patent was granted for a specific means for operating quick-action air-brakes after the grant of a pioneer patent describing and illustrating a different means is, in effect, a ruling by the patent office that the subsequent patent does not infringe the pioneer patent, and such a decision, while not conclusive, is entitled to great respect. **Boyden Power Brake Co. v. Westinghouse Air Brake Co.*, 73 O. G. 1857, C. D. 1895.

28. The issuing of a subsidiary patent for specific improvement during the pendency of an application for a primary patent held in the patent office without any fault of the inventor does not invalidate the primary patent subsequently issued. **Thomson-Houston Electric Co. v. Winchester Avenue R. Co.*, 73 O. G. 2155, C. D. 1895.

29. Where a patent for improvements issued with a reference to a prior application and a disclosure of the broad original invention contained therein, it is not a bar to a subsequent patent for the broad invention issued pursuant to the said prior application. (Distinguishing the familiar rule repeated in *Miller v. Eagle Mfg. Co.*, 66 O. G. 845, 151 U. S. 186.) **Thomson-Houston Electric Co. v. Elmira and Horseheads Ry. Co.*, 74 O. G. 144, C. D. 1896.

30. The grant of a later patent to defendants for a machine designed to accomplish the same result as that of the patents in suit raises the presumption that there is a substantial difference between them, and that the later is not an infringement of the earlier patents. **Illinois Steel Co. v. Kilmer Mfg. Co.*, 74 O. G. 1282, C. D. 1896.

31. When a prior application for a generic invention has been delayed in the patent office without the fault of the applicant the grant of a subsequent patent for a specific, distinct and separate improvement upon the principal invention will not invalidate a patent subsequently issued upon the original application. (*Miller v. Eagle Mfg. Co.*, 66 O. G. 845, 151 U. S. 186; *Thomson-Houston Electric Co. v. Winchester Ave. R. Co.*, 73 O. G. 2155.) **National Machine Co. v. Wheeler & Wilson Mfg. Co.*, 74 O. G. 1588, C. D. 1896.

32. Letters Patent No. 424,695, to Charles J.

Van Depoele, is not invalid because of the prior issuance of Patent No. 397,451, for certain improvements on the broad invention covered by the first-named patent, the application for which was filed more than a year before that of Patent No. 397,451. *Thomson-Houston Electric Co. v. Ohio Brass Co., 80 O. G. 654, C. D. 1897.

33. Where a patent for mere improvements was granted during the pendency of an earlier application for the broad invention, *held*, that a patent subsequently granted on the earlier application is not invalid, though the elements covered by its claims were shown and described but not claimed in the earlier patent. (Cases of *Suffolk v. Hayden*, 3 Wall. 315, and *Barbed Wire Patent*, 58 O. G. 1555, 143 U. S. 280, discussed.) *Id.

34. Where a patent for an improvement issues while the application for the broad invention is pending in the patent office, *held*, that the monopoly in the broad invention is not extended. The patent for the improvement expires in seventeen years. After that any one may use the improvement without infringing the patent issued upon it. If he uses the improvement without a license to use the main invention, he is liable for the infringement, not of the patent for the improvement, but of the patent for the main invention, and in estimating the damages for the same the value of the main invention, and not that of the improvement, would be the basis for estimating the damages. *Id.

35. It can make no difference in considering this question whether the patent for the improvement issues to the patentee of the main invention or to another. The right of the public to use the improvement when the patent on it expires is exactly the same whether the patentees of the two inventions are the same or not, because in each case the improvement can only be used with the license of the patentee of the main invention. *Id.

36. Claims 6, 7, 8, 12 and 16 of Patent No. 495,443, granted to the administrators of Charles J. Van Depoele, construed and *held* to be void because the invention covered thereby had been previously claimed by the same inventor in Letters Patent No. 424,695, dated April 1, 1890. *Thomson-Houston Electric Co. v. Hoo-sick Ry. Co., 80 O. G. 967, C. D. 1897.

37. Where two patents are intended to and do secure to the patentee the same general inventions, differing only in the scope of the claims, the second patent is inseparably in-

involved in the matter embraced in the first patent and is void. (Citing *Miller v. Manufacturing Co.*, 151 U. S. 198, 66 O. G. 845.) *Id.

II. DIFFERENT INVENTORS.

38. Under rule 41, Rules of Practice of the patent office, as interpreted by *Ex parte Blythe* (30 O. G. 1321) and *Ex parte Herr* (41 O. G. 463), two patents in which the description was substantially the same, No. 348,072 for a composition for transfer surfaces for producing copies of type-writing, and No. 348,073 for a process of reproducing surfaces for type-writing and manifolding, were obtained with a single claim on each, instead of one patent with two different claims, each embodying one of the above inventions. Suit for infringement was instituted upon Patent No. 348,073 alone, which patent was held void in view of the state of the art. *Underwood v. Gerber, 48 O. G. 116, C. D. 1889.

39. Where, after priority had been adjudicated by the patent office to one of two parties in an interference proceeding, and a patent had been issued in accordance therewith, it appeared that the circuit court, upon a bill in equity filed by the other party under section 4915 of the Revised Statutes, had decreed that the plaintiff was the original, first and sole inventor of the invention in controversy and entitled to a patent therefor, and that a certified copy of said decree had been filed in the patent office in accordance with the provisions of the statute referred to, *held*, that the commissioner was authorized by such adjudication to issue a patent to the plaintiff, notwithstanding it appeared that defendant had duly appealed to the supreme court of the United States and had filed a bond for the payment of costs. *Daniels v. Morgan*, 54 O. G. 113, C. D. 1891.

40. Where a suit was instituted under Revised Statutes, section 4918, to procure an adjudication of invalidity of a patent on the ground of interference with plaintiff's prior patent, and where the defendant filed an answer denying the validity of the prior patent and affirming the validity of his own patent, and where proofs were taken by both parties, *held*, that the defendant may obtain affirmative relief under that provision of the statute that "the court, on notice to adverse parties, . . . may adjudge and declare either of the patents void;" and *held*, further, that the court will refuse a motion to dismiss by the plaintiff, if it appears that the granting of such motion will prejudice the rights of the defendant.

*Electrical Accumulator Co. v. Brush Electric Co., 55 O. G. 573, C. D. 1891.

41. In such a suit questions of anticipation, novelty and duration of the patent will not be considered, as they are matters for a suit for infringement and not an interference suit. *Id.

42. Where the bill prays that defendant's patent may be adjudged void by reason of an interference with a prior patent, and the answer prays that the plaintiff's patent may be declared void, the suit cannot be regarded as a suit for infringement. *Id.

43. Allegations that plaintiff's assignor obtained a patent; that defendant obtained patents of later date which interfere with plaintiff's rights; that defendant is making and selling machines under his patents, and that he has in other ways disturbed the plaintiff in the use and enjoyment of the privileges conferred by his patent, sufficiently charge interference. *Stonemetz Printers' Machinery Co. v. Brown Folding Machine Co., 56 O. G. 263, C. D. 1894.

44. The invention which a man patents is that which he claims, and patents interfere under section 4918, Revised Statutes, only when they claim in whole or in part the same invention. (Distinguishing Garratt v. Seibert, 15 O. G. 383, 98 U. S. 75.) *Nathan Mfg. Co. v. Craig, 58 O. G. 1093, C. D. 1892.

45. Patents interfere under section 4918, Revised Statutes, only when they claim in whole or in part the same invention. *Dederick v. Fox, 63 O. G. 1963, C. D. 1893.

46. The question of interference between patents is determined by the claims, not by the general appearance and function of machines shown but not claimed. *Id.

47. Patents interfere only when they claim the same invention in whole or in part, and in a proceeding under section 4918 the court cannot go beyond the claims and consider generally the two patents as a whole. An interference does not exist, within the meaning of the statute, between a patent having a dominant broad claim and a junior patent having a subordinate specific claim. *Stonemetz Printers' Machinery Co. v. Brown Folding Machine Co., 64 O. G. 1135, C. D. 1893.

48. The patent claimed by complainant Bradley was for a process of separating metals from their ores, in which fusion by external heat was dispensed with and an electric current made to perform the double function of first fusing the ore and then separating the metal by electrolysis. The patents issued to defend-

ants Cowles and others were for a process of smelting ore by electricity and means for accomplishing the same, wherein heat was distributed through the mass of ore by the current flowing through a granular conductor of high resistance. These patents were all filed as exhibits with the plea. *Held*, that the facts as presented are not sufficient to show interference between the Bradley and Cowles patents, whatever might be developed by expert evidence under an answer, and the plea will be overruled. *Lowry v. Cowles Electric Smelting and Aluminum Co., 65 O. G. 295, C. D. 1893.

49. When 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 the question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction. (Morgan v. Daniels, 67 O. G. 811, 153 U. S. 120.) *Appleton v. Ecaubert, 71 O. G. 1617, C. D. 1895.

50. The printed copy of the testimony in the interference proceedings before the patent office and the opinion of the commissioner of patents *held* to be irrelevant, as a suit under section 4918, Revised Statutes, is an independent one, although between the same parties as in the patent office proceeding. *Id.

51. *Held*, further, that the opinion of the commissioner was not a decree and was not the finding of facts which a court is frequently called upon to make. It was the argument and recital of the considerations which led the commissioner to his conclusions and a statement of the effect of the testimony upon his mind, and was not a part of the judgment record. (In re Buckingham's Appeal from Probate, 60 Conn. 143.) *Id.

52. When the decision of the office is in favor of a junior applicant and a patent issues to him, in a subsequent suit under Revised Statutes, section 4915, the burden of proof is shifted, and it then devolves upon the senior applicant to show either that his invention antedates that of the patentee or that the latter never made the invention. *Standard Cartridge Co. v. Peters Cartridge Co., 78 O. G. 621, C. D. 1897.

INTERLOCUTORY APPEAL

(See APPEAL.)

INTERNATIONAL CONVENTION.

(See TREATY; TRADE-MARKS — TREATY.)

1. This treaty is a reciprocal one. Each party to it covenants to grant in the future to the subjects and citizens of the other parties certain special rights in consideration of the granting of like special rights to its subjects and citizens. It is a contract operative in the future infratorially. It is therefore not self-executing, but requires legislation to render it effective for the modification of existing laws. †Opinion of the Attorney-General of the United States, 47 O. G. 398, C. D. 1889.

(See *Appert v. Parker, 75 O. G. 120, C. D. 1896; also "Trade-marks — Treaty.")

2. The international convention of March 20, 1883, to which, among others, Spain and France and the United States were parties, has not the force of a statute in the United States. (Citing opinion of Attorney-General Miller, April 5, 1889, 47 O. G. 398.) *Electrical Accumulator Co. v. Julien Electric Co., 64 O. G. 559, C. D. 1893.

INVENTION.

(See PATENTABILITY.)

INVENTOR, DECEASED.

(See PATENT TO DECEASED INVENTORS.)

ISSUE IN INTERFERENCE.

(See INTERFERENCE.)

ISSUE OF PATENT.

(See WITHDRAWING FROM ISSUE; WITHHOLDING FROM ISSUE.)

JOINDER OF INVENTIONS IN AN APPLICATION.

(See APPLICATIONS, JOINT AND SOLE; DIVISION OF APPLICATION; INTERFERENCE — DIVISIONAL APPLICATION and JOINT AND SOLE APPLICATIONS; JOINT INVENTIONS.)

1. One piece of mechanism may perform its function upon the material or subject of its

action which at once falls or is delivered into the operation of another mechanism without the existence of any relation or combination between the two, and without the possibility of the separate action of the two constituting a patentable method or process. Ex parte Herr, 41 O. G. 463, C. D. 1887.

2. The question whether two or more inventions may be joined in single letters patent is not the same when presented for consideration by the courts as when it arises in the administration of the patent law in the patent office. In the courts the maxim *ut res magis valeat quam pereat* finds great favor, and it would require an express rule of law or an inexorable necessity to justify a court in declaring void a patent issued by the office to a patentee who is the inventor of new and useful inventions and who has taken out his patent in good faith. But in administering the patent laws the large discretion vested in the commissioner of patents should be exercised in the matter of directing what inventions should be comprehended in a single patent as in all other particulars, so as to subserve the great purposes of the patent system and to protect inventors. Id.

3. While, possibly, the courts have never declared a patent void because comprehending more than one distinct and separate invention, there are numerous *dicta* to that effect. But there are numberless decisions holding valid patents, and there have continuously existed for years office rules authorizing their issuance, where the two or more inventions bore clear and distinct relation to each other, as where they were "connected in design and operation," etc. *Held*, that "connection and operation," the "mutually contributing to produce a single result," must be the proximate, immediate, direct act of the several inventions, respectively, not a remote one existing in the mind of the person who uses them, and the contribution must be such as to produce a resultant operation proceeding from all the inventions comprehended, such as would be manifest to one skilled in the art who should be called upon to construct or operate them. Id.

4. Whenever the original invention is such that it could properly be the subject of a patent, and the organism has not changed in its structure or identity, it is believed that several improvements on its parts may be embraced in one patent, providing they co-operate in affecting the whole organism, improving it as a whole, and provided, also, invention and art have not subsequently so advanced as to select

the improved parts as distinct subjects of invention, art and manufacture. *Id.*

5. This does not exclude the idea that such improvements upon a distinct organism could not have been united in a single original patent, provided it retained its identity and was not affected by the advance in arts and invention. But since the repeal of section 5, act March 3, 1837, by section 53, act July 8, 1870, the separate re-issue patents allowed for different parts of the invention are necessarily for divisional parts, for which separate patents might have originally issued. In cases of new combinations, in which some of the elements are new, claims for the combination and for the new elements may be united in one patent, because they all properly constitute one invention, and in such a case the applicant might embrace the claims for the new elements without making claim to the combination, for he is not required to do the latter, and by omitting the combination he would dedicate it to the public. But this is only true of elements new generically, and not of claims for mere improvements upon old elements which can be used and applied in other relations in the arts. *Id.*

6. An inventor who proceeds to invent a machine designed solely to carry out a particular process, and the only function of which is to execute that process, is entitled to protection. A process which is distinct and separate from the machine does not lose its identity because of any course pursued by the inventor in prosecuting his claims for a patent, or from the fact that he may not at the time of completing his machine have been fully conscious that he had also invented the process. If, at any time before he comes to the office or takes out his patent, he discovers or becomes conscious of the fact that his invention is of a twofold character—viz., that it constitutes both the machine and the process which it executes—and prepares his application accordingly, there can be no reason for holding that he has merged the two inventions or that the two are in fact one. *Ex parte Young*, 46 O. G. 1635, C. D. 1889.

7. That two or more inventions capable of joint use, although not always used conjointly, may be joined in the same patent is beyond question. *Ex parte Fefel*, 57 O. G. 409, C. D. 1891.

8. It does not follow, however, that the patent office must or will permit such inventions always to be thus joined. Such permission will be given if no wider range of search is required for all than for one. *Id.*

JOINT INVENTIONS.

(See APPLICATIONS—JOINT AND SOLE; EMPLOYER AND EMPLOYEE; INTERFERENCE—JOINT AND SOLE APPLICATIONS; JOINDER OF INVENTIONS, *supra*.)

1. The mere fact that two or more persons unite in an application for a patent as the product of their joint inventive efforts creates a very strong presumption that the device sought to be patented is the result of their united ingenuity, and to overthrow this presumption the evidence should be clear and unequivocal. (*Gottfried v. Philip Best Brewing Co.*, 17 O. G. 675.) **Consolidated Bunging Apparatus Co. v. Woerle*, 38 O. G. 1015, C. D. 1887.

2. If one conceives the entire invention and another makes a suggestion of practical value which the first one failed to think of, but which is needed to make the conception a success, this will be sufficient to constitute them joint inventors. **Id.*

3. Where two parties work together in the making of an invention, each making suggestions to the other, the invention covered by a joint patent will generally be considered as the result of their joint efforts or contributions. **Schlich & Field Co. v. Chicago Sewing Machine Co.*, 46 O. G. 1394, C. D. 1889.

4. Where the patentee applied to a certain person as a mechanic who knew how to make "reversers," and who understood how to adapt them to machines of any description, to make a reverser for his fulling-machine, giving him a plan of the latter, and the mechanic successfully applied a reverser which he had previously applied to a washing-machine, and it did not appear that the patentee had given him any instructions or that the latter worked under his supervision, *held*, that the patentee was not solely entitled to the credit of the invention, but that the mechanic was at least a joint inventor, even if the combination were patentable. **Royer v. Schultz Belting Co.*, 50 O. G. 557, C. D. 1890.

5. It is settled that letters patent to parties as joint inventors are *prima facie* evidence that the invention therein described was joint. (*Hotchkiss v. Greenwood*, 4 McLean, 456.) **Page Woven Wire Fence Co. v. Land*, 49 Fed. Rep. 936 (1891).

JUDICIAL NOTICE.

(See PATENTS—CONSTRUCTION OF.)

1. A court will not take notice, on demurrer, of the contents of printed publications, such

as mechanical dictionaries, encyclopedias, etc., as the same do not fall within the category of things of general knowledge of which courts take judicial notice, but can more properly be considered at the final hearing, with an opportunity on the part of the complainant to explain or rebut them. *Kaolatype Engraving Co. v. Hoke, 39 O. G. 589, C. D. 1887.

2. The court will take judicial notice of matters of common knowledge, such as a strap used by the driver at the front of an omnibus to open and close the rear door, devices for opening or closing valves at a distance in steam and hydraulic apparatus, and devices used at railway switches for opening and closing the rails. *Aron v. The Manhattan Ry. Co., 49 O. G. 1365, C. D. 1889.

3. It appearing that in the former decisions of the office judicial notice was taken of the fact that the telephone had been in public use for more than two years prior to the filing of the application under consideration, *held* no error. *Ex parte Meucci*, 51 O. G. 299, C. D. 1890.

4. In the absence from the record of references showing exactly certain features which were old, *held*, that the rights of the public demand that judicial notice shall be taken of what is well known to be old. (*Phillips v. Detroit*, 111 U. S. 604.) *Ex parte Jones*, 49 MS. D. (3 G. W. D.) Dec., 1891 (*Frothingham, Acting Com'r*).

5. A patent may be held void on demurrer to a bill by the court's taking notice, from common knowledge, that the structure is old. **Wall v. Leck*, 68 Fed. Rep. 552.

6. Where the device used is within common knowledge, judicial cognizance may be taken of it. **Black Diamond Coal Mining Co. v. Excelsior Coal Co.*, 70 O. G. 1797, C. D. 1895.

7. The court did not err in assuming judicial knowledge of the construction and operation of grain elevators and in holding that these elevators contained practically the same elements as the grain-transferring apparatus of the Richards patent. **Richards v. Chase Elevator Co.*, 73 O. G. 1710, C. D. 1895.

8. The court has legal right and it is its duty to take judicial notice of such matters of science, art and mechanism and things of common knowledge as are involved in cases brought before it for determination. **Carter Machine Co. v. P. H. Hanes & Co.*, 74 O. G. 1277, C. D. 1896.

9. In considering the question of the validity of a patent on its face the court way

take judicial notice of facts of common and general knowledge tending to show that the device or process patented is old or lacking in invention, and the court may refresh its recollections of what facts were of common knowledge at the time of the application for the patent by reference to printed matter which is known to be reliable and to have been published prior to the application for the patent. **American Fibre Chamois Co. v. Buckskin Fibre Co.*, 75 O. G. 833, C. D. 1896.

JURISDICTION.

(See APPEALS; EQUITY; INJUNCTION; PATENT OFFICE PRACTICE; SUITS FOR INFRINGEMENT.)

- I. PRIMARY EXAMINER.
- II. EXAMINER OF INTERFERENCES.
- III. EXAMINERS-IN-CHIEF.
- IV. ASSISTANT COMMISSIONER.
- V. COMMISSIONER.
- VI. SECRETARY OF THE INTERIOR.
- VII. FEDERAL COURTS.
- VIII. COURTS, IN GENERAL.
- IX. UNITED STATES SUPREME COURT.

I. PRIMARY EXAMINER.

1. The office of primary examiner in the patent office is continuing, and does not change with the person of the incumbent. An application is not assigned to the examiner as an individual, but to the division over which he presides, and notwithstanding the resignation of an incumbent who has taken action upon a case and the appointment of his successor, the jurisdiction continues unaffected by the change. *Ex parte Fredericks and Burns*, 40 O. G. 691, C. D. 1887.

2. An application continues in the patent office, and in acting upon it the primary examiner is the vice-representative of the commissioner, and until reversed or modified his action or decision is that of the commissioner. This jurisdiction of the primary examiner continues until the case is taken out of his division by the superior jurisdiction operating through the rules of the office or by special order. *Id.*

3. An examiner has jurisdiction until the case is allowed and passed to issue. It is not until the examiner signs the file-wrapper and forwards the application to the issue division that he can be said to have rendered a favorable decision. He may have formed an opin-

ion in its favor and expressed an oral or even a written suggestion in the same direction; but these do not constitute his formal favorable decision. (Citing *Ex parte Starr*, C. D. 1879, 91; *Ex parte Buell*, 26 O. G. 437.) *Id.*

4. When the examiner, after action upon a case, had advised the applicant that his application "was now in condition for allowance, but required a new drawing," but had not signed the file-wrapper and forwarded the case to the issue division, *held* this did not deprive the successor in office of the primary examiner of jurisdiction to reconsider and reject the application. *Id.*

II. EXAMINER OF INTERFERENCES.

5. The examiner of interferences is a primary examiner; but under the organization of the patent office the examiner in charge of the interference possesses no jurisdiction over the question of the patentability of the inventions or the declaration of interferences, but he has exclusive jurisdiction of the trial of the issues when declared. *Faure v. Bradley*, 44 O. G. 945, C. D. 1888.

III. EXAMINERS-IN-CHIEF.

6. The examiners-in-chief have no jurisdiction in case of appeal from examiner of interferences in public use proceedings. *Ex parte Finch*, 40 O. G. 1027, C. D. 1887.

7. Examiners-in-chief have no jurisdiction of the question of division, which is a matter appealable to the commissioner. *Ex parte Gillette*, 44 O. G. 819, C. D. 1888.

8. Under the organization of the various tribunals of this office and the system in force, it follows as a necessity that the recommendation which the examiners-in-chief may make under rule 139 must relate exclusively to the particular matter brought before them on appeal, or over which they have jurisdiction. *Id.*

9. A recommendation or statement incorporated in the decision of the examiners-in-chief touching the question of division, which is a matter appealable to the commissioner and not to the examiners-in-chief, is unwarranted, and in effect would contravene the practice settled by the present commissioner. Such practice should not be challenged or repudiated by a subordinate tribunal. *Id.*

10. The examiners-in-chief have exclusive jurisdiction of the question of new matter on appeal from the examiner. *Ex parte Razor*, 41

MS. D. (1 G. W. D.), Sept., 1899 (Mitchell, Com'r).

11. The board has no authority to decide the question of public use, but may call attention thereto, and no appeal lies from their refusal to act under rule 126. (*Schmiedl v. Walden*, 56 O. G. 1563.) *Hill v. Hodge*, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

IV. ASSISTANT COMMISSIONER OF PATENTS.

12. The duties of the assistant commissioner are necessarily the same in kind as those of the commissioner and such duties are directly prescribed by statute. *Ex parte Hughes*, 56 O. G. 1448, C. D. 1891.

13. The assistant commissioner, under assignment by the commissioner, has authority to hear and determine any *quasi-judicial* question on appeal, and his determination is a legal determination thereof. *Hisey v. Peters*, 76 O. G. 333, C. D. 1896.

V. COMMISSIONER OF PATENTS.

(See SECRETARY OF THE INTERIOR, *infra*.)

14. While the commissioner of patents is authorized to establish rules and regulations for taking depositions, he is necessarily compelled to proceed under and in accordance with the laws of congress. He has no power to legislate as to the competency of witnesses nor as to the admissibility of evidence. Such rules of evidence as congress establishes or recognizes for courts of general jurisdiction must be deemed to be prescribed for officers and tribunals of inferior and limited powers and jurisdictions, unless they are expressly excepted or special rules are made for them. While sections 876 and 877 (Rev. Stats. of the D. C.) do not specifically name the patent office, and may not be held to embrace it as a court or tribunal, still there has never been any law of evidence prescribed for it, except as it has been prescribed for the courts. In other words, the law of evidence recognized in the courts for their guidance, whether common law, statute law, or both, becomes, *proprio vigore*, the law for the patent office and other bureaus, except when otherwise provided. *Marsh v. Rein, v. Ruppel*, 43 O. G. 1453, C. D. 1888.

15. The commissioner of patents has no control over witnesses. Their production, attendance and conduct are under the control of the United States courts. *Osgood v. Badger, v.*

Bennett, 44 O. G. 1065, C. D. 1888. See, also, Kelly v. Park, 81 O. G. 1931, C. D. 1897.

16. The duties to be performed by the commissioner of patents are divisible into two classes, viz.: (1) duties imposed by congressional legislation, and (2) duties imposed only by departmental rules and regulations emanating from or authorized by the secretary of the interior. †Houston v. Barker, v. Bannister, v. Eastman, 44 O. G. 697, C. D. 1888.

17. The discretion of the commissioner of patents cannot be controlled by the secretary of the interior in the performance of judicial or quasi-judicial duties. †Id.

18. The determination of questions concerning the admissibility of evidence in interference proceedings involves the exercise of judicial functions. †Id.

19. Authority to suppress incompetent evidence is conferred upon the commissioner by the statutes and not by any departmental regulation. †Id.

20. The commissioner has no equitable jurisdiction over the rights of parties claiming under assignments and grants of inventions and patents. He cannot set aside or vacate such instruments, nor can he recognize equitable rights growing out of transactions between inventors and applicants and other parties. McDonough v. Gray, 46 O. G. 1295, C. D. 1889.

21. Rule 144 confers upon the commissioner of patents jurisdiction to rehear the decisions of his predecessor when grounds other than those of fraud, error in computation or newly-discovered evidence are alleged. Daniels v. Morgan, 47 O. G. 811, C. D. 1889.

22. Rule 144 had its origin in an executive order, was transformed into a judicial rule when the commissioner of patents was, by act of July 1, 1870, substituted for the supreme court of the District of Columbia as the tribunal having final jurisdiction, and at a later date the office of commissioner was recognized as a continuing one, placed upon the same footing as a court, and given the power of granting new trials. Id.

23. The commissioner of patents exercises the function of a court in determining the question of priority in interference. Id.

24. The question of division has always been held to pertain to the administrative side of the functions of the commissioner. Ex parte Chambers, 51 O. G. 1943, C. D. 1890.

25. Request that the commissioner pass upon the patentability of a claim, which question

had been previously decided by the examiner, denied. Walker v. Diescher and McGill, 56 O. G. 927, C. D. 1891.

26. The commissioner of patents has no jurisdiction to alter the patent by a certificate of correction, and such certificate is wholly void. *Edison Electric Light Co. v. United States Electric Lighting Co., 61 O. G. 564, C. D. 1892.

27. The supervisory authority of the commissioner should be exercised under section 481 of the Revised Statutes only under extraordinary circumstances. Duncan v. Westinghouse, Jr., 66 O. G. 1005, C. D. 1894.

28. The duties of the commissioner of patents are in part administrative and in part of a judicial nature. In the discharge of the latter duties he acts as the direct representative and agent of the law, subject to no appeal excepting to the tribunals expressly designated by statute. The rule limiting the right of an administrative officer to review his predecessor's decision to the three cases specified may be applicable to the commissioner in his capacity as an administrative officer; but it is clear that it is not binding upon the commissioner in the discharge of his official duties. *Daniels v. Morgan, 67 O. G. 811, C. D. 1894.

29. Notwithstanding that the law has provided certain official agencies to advance the work of the patent office, the commissioner is the head of the bureau, and if there be any reasonable ground within his knowledge why a patent should not issue, whether specific objection be raised by the examiners or not, it is his duty to refuse the patent; and it is especially his duty to do so when the primary examiner and the examiners-in-chief have found such ground for refusal to exist. *Drawbaugh v. Seymour, Com'r of Patents, 77 O. G. 313, C. D. 1897.

VI. SECRETARY OF THE INTERIOR.

30. While the secretary of the interior has a supervising jurisdiction over the patent office, to the extent of prescribing proper rules for the business of that office and to the extent of enforcing a due observance of such rules, yet over the acts of the head of that office involving the exercise of the judicial functions conferred upon him by law the secretary has no jurisdiction. †Petithomme v. Bedbury, 52 O. G. 605, C. D. 1890.

31. The action of the commissioner in an interference proceeding refusing to reject certain evidence filed in behalf of one of the parties

clearly involved the judicial function imposed upon him, and from such action no appeal lies to the secretary. †*Id.*

32. While it may be true that the action of the commissioner in refusing to make an order directing one of the parties to file a certain deposition taken in his behalf belonged to that class of actions which involved the exercise of ministerial functions only, yet, in the absence of a rule giving either party the right to file and use the testimony upon payment of costs for taking the same, with appropriate penalties for obstructing the filing thereof, there has been no such disregard in the present case of any rule regulating the conduct of the business of said office as requires the interference of the secretary in the exercise of his supervising authority. †*Id.*

33. A decision of the commissioner of patents denying an interfering party's motion to amend his preliminary statement is a judicial rather than a ministerial act, and consequently one over which the secretary of the interior has no appellate jurisdiction. (Citing *Petit-homme v. Bedbury*, 52 O. G. 605.) †*Ex parte Noakes*, 66 O. G. 575, C. D. 1892.

34. The secretary of the interior has no jurisdiction over such acts of the head of the patent office as involve the exercise of judicial functions conferred upon him by law. †*Warner v. Stimson*, 78 O. G. 1901, C. D. 1887.

35. The decision of the question as to whether an interference shall be allowed to proceed or not involves a judicial or quasi-judicial determination, and the secretary has no appellate jurisdiction. †*Jenkins v. Jenkins & Armat*, 78 O. G. 1902, C. D. 1897.

36. The secretary has no authority to interfere to determine whether or not any one may be a proper party to an interference. †*Id.*

VII. FEDERAL COURTS.

(See COURTS, IN GENERAL, *infra*; PRACTICE IN THE COURTS.)

37. Parties to the suit are citizens of the same state. To the extent of questions arising out of the patent and defendant's acts in alleged infringement thereof the United States courts have jurisdiction. **Willis v. McCollin*, 38 O. G. 1017, C. D. 1887.

38. Over controversies arising out of license contracts they have not. **Id.*

39. The \$2,000 limitation placed upon the jurisdiction of the court under the act of March 3, 1887, does not apply to patent cases

or to suits for the infringement of patents. **Miller Megee Co. v. Carpenter*, 43 O. G. 1118, C. D. 1888.

40. Under the act of March 3, 1887, a defendant can no longer be sued outside of the district of which he is an inhabitant, unless he consents or waives his right to object, except where the jurisdiction of the circuit court is founded only on the fact that the action is between citizens of different states. **Halstead v. Manning, Bowman & Co.*, 44 O. G. 344, C. D. 1888.

41. Under the act of March 3, 1875, the circuit courts have cognizance of all suits at law or in equity where the amount in dispute is sufficient. **The United States v. The American Bell Telephone Co.*, 45 O. G. 1311, C. D. 1888.

42. The circuit courts have jurisdiction of suits brought to recover penalties imposed by the copyright laws of the United States. **Taft v. Stephens Lithographing and Engraving Co.*, 47 O. G. 142, C. D. 1889.

43. Where a suit was brought to restrain defendants from unlawful competition in business and the complaint alleged that the defendants were fraudulently selling an article in imitation of that of plaintiff by using labels, bottles, etc., in imitation of those previously used by the plaintiff, and it appeared that the patent for the design for such bottles, etc., had expired, *held* that, whether the defendants were using the same in good faith or under false colors, the suit did not involve a federal question. **Société Anonyme de la Distillerie de la Liqueur Benedictine de l'Abbaye de Fe-camp v. Cook*, 50 O. G. 1298, C. D. 1890.

44. The circuit court of the district of New Jersey has no jurisdiction over the commissioner of patents in a suit brought under section 4915 of the Revised Statutes when it appears that he has not been served with process or that no appearance has been entered for or by him. **Illingworth v. Atha and Commissioner of Patents*, 51 O. G. 803, C. D. 1890.

45. Where the defendant corporation, created under the laws of the state of New Jersey, desiring to transact business in Massachusetts, agreed as a condition precedent that it would submit to all lawful process in the manner required by the law applicable to foreign corporations enjoying such a privilege, and that such service should have the same effect as if the corporation existed therein, *held*, that it bound itself to submit to be sued within the state, the same as if it were a corporation or-

ganized under the laws of the state, and that upon the facts presented the circuit court had jurisdiction. *Consolidated Store Service Co. v. Lamson Consolidated Store Service Co., 51 O. G. 969, C. D. 1890.

46. The circuit courts have jurisdiction of a suit, as arising under the laws of the United States, even though one issue which may be raised in the case is whether the grant is still in force. *Rapp v. Kelling, 52 O. G. 1666, C. D. 1890.

47. Where one lives and has his factory and place of business in one district and also sells by an agent living in another district, he does not thereby become an inhabitant of the latter district within chapter 866, acts of 1888, and a bill against him for infringement cannot be maintained in such district by service of subpoena upon the agent. *Anderson v. Germain, 58 O. G. 1092, C. D. 1892.

48. Where a plaintiff's bill in equity is purely a bill for the infringement of patent-rights, asking for the usual relief in the usual form, and containing no suggestion of contract relations between plaintiff and defendant, the mere fact that the defendant's answer sets up an alleged contract gives the court no warrant to dismiss the case for want of jurisdiction on the ground that the rights of the parties are governed by contract. *White v. Rankin, 59 O. G. 1606, C. D. 1892.

49. In such a case the question is upon the infringement of the patent, and the subject-matter of the action is disclosed in the bill, the defendant's answer being in effect a mere denial of infringement, and raising an issue clearly within the jurisdiction of the court. *Id.

50. The word "inhabitant," as used in the act of March 3, 1887, ch. 373, sec. 1 (24 Stat., 552), corrected by the act of August 13, 1888, ch. 866 (55 Stat. 434), in the light of previous legislation upon the subject of original jurisdiction of the federal courts and of the connection in which it is used, held to be synonymous with "resident." *Bicycle Step-Ladder Co. v. Gordon, 65 O. G. 601, C. D. 1893.

51. It comprehends locality of existence, the dwelling place where one maintains his fixed and legal settlement, not the casual and temporary abiding place required by the necessities of present surrounding circumstances. A mere "sojourner" is not an "inhabitant" in the sense of the act. *Id.

52. The interpretation in Shaw v. Quincy Mining Co. (144 U. S. 444) of the word "inhabitant," as used in the act, followed. *Id.

53. The decision in United States v. Southern Pacific Ry. Co. (49 Fed. Rep. 297), not applicable to natural persons. *Id.

54. A corporation cannot be sued in the federal courts of a district other than in the state of its incorporation. *National Typewriter Co. v. Pope Manufacturing Co., 65 O. G. 755, C. D. 1893.

55. Upon a motion to dismiss a bill in equity for infringement of a United States patent by a receiver appointed by a state court, upon the ground that the complainant had not obtained leave to sue from the court making the appointment, held, that the general rule that a court will not entertain jurisdiction of a suit against a receiver appointed by another court until the appointing court has given its consent does not apply when the jurisdiction of the court in which the receiver is sued is conferred by federal laws. *Hupfeld v. Automaton Piano Co., 72 O. G. 287, C. D. 1895.

56. In a suit to restrain the infringement of a patent by a receiver appointed by a state court, held, that the federal courts will entertain jurisdiction of such suit, without leave of the state court first obtained, to enjoin individuals, even though they be officers of a state court, from acts of infringement. *Id.

57. The authority of a district judge when holding a circuit court under Revised Statutes, section 609, is co-extensive with that of any judge sitting in the same court, and the restrictions of Revised Statutes, section 719, relative to the granting of injunctions by district judges do not apply. *McDowell v. Kurtz, 78 O. G. 1104, C. D. 1897.

58. A demurrer setting forth that there is no jurisdiction in a circuit court of an interference case decided by the court of appeals of the District of Columbia; that the matter is *res adjudicata*; that the circuit court has no jurisdiction to determine the jurisdiction of the circuit court of appeals to entertain an appeal from the commissioner of patents, and that plaintiff and defendant are citizens of the same state, overruled. *Bernardin v. Northall and Seymour, Com'r of Patents, 78 O. G. 1740, C. D. 1897.

59. The bill establishing the court of appeals of the District of Columbia and permitting appeals thereto from the decision of the commissioner of patents in interference cases did not by implication repeal the statute providing remedy by bill in equity in a circuit court. *Id.

60. The decision of the court of appeals of the District of Columbia is not conclusive upon

a circuit court in patent matters, since the question of jurisdiction in such matters is not settled by a comparison of their relative dignity and importance. The appellate court merely affirms or reverses the commissioner in accordance with the general office of an appellate tribunal. The trial in a circuit court is a judicial hearing by original bill. *Id.

61. Where there was an assignment of an interest in an invention for which an application was prepared, which application while pending was divided and two patents issued thereon, a controversy whether the assignment applied to a third patent presented a federal question and the court had jurisdiction. *Puetz v. Bransford, 41 O. G. 353, C. D. 1887.

VIII. COURTS, IN GENERAL.

(See FEDERAL COURTS, *supra*; PRACTICE IN THE COURTS.)

62. The civil circuit courts of Indiana are courts of general jurisdiction, and may authorize the sale of property of decedents' estates whenever it is deemed for the interest of the parties concerned or necessary to wind up the administration. *May v. Logan County, 41 O. G. 1387, C. D. 1887.

63. The fact that the original order of court merely authorized a sale of the patent-rights does not invalidate the transfer therewith of accrued claims and demands of the estate arising thereunder if such transfer and sale are duly approved, ratified and confirmed by the court. The ratification and confirmation of the sale is equivalent to, and has the same legal effect and operation in, transferring the claims and demands included therein as if the court had previously directed their sale. *Id.

64. The court having jurisdiction to authorize the sale, and having exercised such authority, the propriety or validity of the sale is not open to examination in a collateral proceeding, though the record fail to disclose a strict compliance with all the provisions of the statute in making such sale. *Id.

65. Where a non-resident defendant corporation had appeared in a suit for infringement of letters patent, filed an answer, gone to proof and submitted the case for final hearing, it was held the court had jurisdiction to entertain the suit. *Morrison v. The Canton Surgical and Dental Chair Co., 49 O. G. 733, C. D. 1889.

66. Where the records show that the proceedings in the patent office are regular, and after the issue of the patent a question arises as to who is the true owner of the patent, the

place to settle such controversy is in the courts. *Ex parte Fowler & Hutton*, 64 O. G. 1131, C. D. 1893.

67. An assignment being alleged fraudulent and void, in the absence of the parties who made it the court cannot decree that the commissioner of patents (he having been made a party defendant) shall expunge from the records of the patent office the record of the assignment as being there without authority, and declare the same null and void. Even if the court had jurisdiction, so far as the commissioner of patents was concerned, that jurisdiction was not complete over the subject-matter in the absence of the non-resident defendants, and no consent of the commissioner could give the court jurisdiction of the subject-matter. *Backus Portable Steam Heater Co. v. Simonds, Com'r of Patents, 66 O. G. 1893, C. D. 1894.

68. The jurisdiction of the supreme court of the District of Columbia to proceed in a suit under section 4915 can arise only in case of refusal of an application by the commissioner of patents or the supreme court on appeal from him. *Durham v. Commissioner of Patents, 69 O. G. 597, C. D. 1894.

69. The court of claims has no jurisdiction to hear and determine claims against the United States for mere torts. Some element of contractual liability must lie at the foundation of every action. *Schillinger v. United States, 69 O. G. 1505, C. D. 1894.

IX. UNITED STATES SUPREME COURT.

70. When a patent is in force at the time of filing the bill and there was then time for procuring a preliminary injunction, the jurisdiction of the court is not defeated by the expiration of the patent before final decree. *Beedle v. Bennett, 39 O. G. 1326, C. D. 1887.

71. No question arising in a patent suit reviewable in this court can be regarded as finally settled, so as to establish the law for like cases, until it has been determined in this court. *Andrews v. Hovey, 42 O. G. 1285, C. D. 1888.

72. Where in a suit at law in a state court for the recovery of license fees under a written contract the plaintiff recovered damages, and the defendant by writ of error brought the suit into this court as involving a federal question, and the defendant in error moved in this court to dismiss the writ of error for want of jurisdiction, and also moved to affirm the judgment of the state court, held, that the motion to dismiss must be denied because the validity of a second re-issue subsequent to that under which

the license was given had been set up in defense below and that presented a federal question. *Held*, that the motion to affirm the judgment of the state court must be granted because the same was clearly right. *Dale Tile Mfg. Co. (Limited) v. Hyatt, 43 O. G. 249, C. D. 1888.

73. In an action of *assumpsit* in a state court for the recovery of license fees under a written contract the plaintiff recovered damages and the defendant brought the suit into this court as involving a federal question, and the defendant in error moved in this court to dismiss the writ of error for want of jurisdiction. *Held*, that as the question at issue in the state court was not of priority of invention or of the validity or construction of any patent, but simply whether the reels made and sold were the same, or substantially the same, as mentioned in the contract, no federal question was presented. *Held*, in allowing a writ of error to this court, the certificate of the chief justice of a state court that a federal question arose is not conclusive upon this court and cannot supply the want of evidence of such fact in the record. *Felix v. Scharnweber, 43 O. G. 251, C. D. 1888.

74. In the suit at bar, which was for patent license fees under a contract, where both the validity of the patent and infringement were put in issue and decided by the circuit court, there is no doubt that this was "a case touching patent-rights" and came within the jurisdiction of this court under section 689, Revised Statutes, without regard to the sum or value in dispute. *St. Paul Plow Works v. Starling, 43 O. G. 1350, C. D. 1888.

75. When one of two joint owners of a patent, not partners, dies after decree in circuit court under certain other conditions stated, the cause of action did not survive to the remaining owner and the supreme court had no jurisdiction of suit. *Dolan v. Jennings, 55 O. G. 141, C. D. 1891.

76. In order to give the supreme court jurisdiction by writ of error to a state court, it must appear affirmatively, not only that a federal question was presented for decision to the highest court of the state having jurisdiction, but that its decision was necessary to the determination of the case, and that it was actually decided, or that the judgment as rendered could not have been given without deciding it. *The Walter A. Wood Mowing and Reaping Machine Co. v. Skinner, 54 O. G. 1891, C. D. 1891.

77. Where the action was upon an agreement by the defendant that, in consideration

of the right to the exclusive use of complainant's patented device, it would use it upon all mowing and reaping machines and would pay a reasonable value for such use, and the value of such use was the only question of fact, and neither the construction nor the validity of the complainant's patent was regarded as material by the trial court, and it did not appear upon what ground the highest court of the state proceeded in affirming the judgment below, but it did appear that the case might properly have been determined upon a ground broad enough to support the judgment without resort to a federal question, *held*, that the supreme court had no jurisdiction. *Id.

78. It was not the intention of congress in the circuit courts of appeals act of March 3, 1891 (ch. 517, 26 Stats. 828), to narrow the appellate jurisdiction of the supreme court in case of a suit brought by the United States as a sovereign in respect of an alleged miscarriage in the exercise of one of its functions as such, deeply concerning the public interests and not falling within the reasons of the limitations of the act. *United States of America v. American Bell Telephone Co. and Berliner, 73 O. G. 1285, C. D. 1895.

79. A suit brought by the United States to annul a patent is a suit brought by the United States as a sovereign in respect of an alleged miscarriage of one of its functions, as such deeply concerns the public interests, does not fall within the limitations of the act creating the circuit courts of appeals, and is within the appellate jurisdiction of the supreme court of the United States. *Id.

LABELS.

(See PRINTS; TRADE-MARKS.)

1. To maintain an action for protection of a label by virtue of its registration in the patent office under the act of June, 1874, notice of such registration must have been given in the form prescribed by the copyright law. *Higgins v. Keuffel, 39 O. G. 832, C. D. 1887.

2. Publication of the label with a defective notice is the same as a publication without notice, and is practically an abandonment of the copyright. *Id.

3. If the orators have any rights to the contents of the label growing out of its use as a trade-mark, these rights are not involved in a suit for infringement of copyright of the registered label. *Id.

4. The word "Magic" for liniment, *held* ar-

bitrary matter in a label, and required to be registered as a trade-mark. *Ex parte Barber*, 36 MS. D., March, 1888 (Vance, Ass't Com'r).

5. A label for towels, embodying the words "The Athlete's Towel," *held* not registrable, since they did not convey to the mind "some conception either as to quality, ingredients or method of use as an article." *Ex parte Leakes*, 38 MS. D., Aug., 1888 (Hall, Com'r).

6. The words "California Vitalizer," refused registration as a label upon the ground that they constituted a trade-mark. *Ex parte Logan*, 38 MS. D., Oct., 1888 (Vance, Ass't Com'r).

7. *Held*, "A tropical scene" and the title "Aqua de Florida" in a label should be registered as a trade-mark before registering the label. *Ex parte Nunez*, 39 MS. D., Feb., 1889 (Vance, Ass't Com'r).

8. *Held*, the word "Ervilline" in a label should be registered as a trade-mark before registering the label. *Ex parte Jellerson*, 39 MS. D., June, 1889 (Vance, Ass't Com'r).

9. A label is not registrable until trade-mark matter therein shall have been registered. *Ex parte Columbia Sewing Machine Co.*, 41 MS. D., Nov., 1889 (Mitchell, Com'r); *Ex parte Field*, 41 MS. D.

10. A bill to restrain defendants from making and selling counterfeits of labels that are not trade-marks may be maintained, even though it does not show that defendants have affixed any of the spurious labels to articles of their own manufacture, or that they have sold any articles bearing the counterfeit labels, where it appears that complainant has a right to use the label and the right to use it is a valuable one, and the adoption of the label is not unlawful or opposed to public policy, and that he has sustained such special pecuniary damage as gives him a right to complain of the fraud. From the fact that defendants have made and sold spurious labels and advertised them for sale, it will be presumed that they intended that they should be used by the persons who buy them on articles similar to those on which complainant uses them and that they manufacture and sell them for that purpose. **Carson v. Ury*, 49 O. G. 411, C. D. 1889.

11. Such case is not a trade-mark case, and the court cannot interfere as in ordinary trade-mark cases. **Id.*

12. Cases of Cigar Makers' Protective Union, No. 98, *v. Conhaim* (41 N. W. Rep. 943) and *Schneider v. Williams* (14 Atl. Rep. 812) distinguished from the case at bar. **Id.*

13. The settled doctrine of the office is that

labels containing or constituting trade-marks cannot be registered as labels until the trade-mark matter has already been registered in accordance with the statute regulating the registration of trade-marks. *Ex parte Diamond Laboratory Co.*, 43 MS. D. (2 G. W. D.), July, 1890 (Mitchell, Com'r).

14. A trade-mark must be registered for the particular class of goods upon which the label is to be used before the label is entitled to registration. *Id.*

15. The use of a capsule of the same color as that used by complainants on bottles of champagne will not be enjoined where there has been no attempt at deception thereby and where the labels used by the defendant were so unlike those of complainants that a person of average intelligence, exercising ordinary care, could readily ascertain the difference. **Von Mumm v. Kirk*, 50 O. G. 1134, C. D. 1890.

16. A label containing a trade-mark cannot be registered. (Cases cited.) *Ex parte Whitman & Son*, 49 MS. D. (3 G. W. D.), Dec., 1891 (Frothingham, Ass't Com'r).

17. On motion for rehearing of above case in view of decision in *In re Palmer*, 58 O. G. 384, registration was still denied. *Id.*

18. The clause of the constitution under which congress is authorized to legislate for the protection of authors and inventors has reference only to such writings and discoveries as are the result of intellectual labor. It does not have reference to labels which simply designate or describe the articles to which they are attached, and which have no value separated from the articles, and no possible influence upon science or the useful arts. **Higgins v. Keuffel*, 55 O. G. 1139, C. D. 1891.

19. To be entitled to a copyright the article must have by itself some value as a composition, at least to the extent of serving some purpose other than as a mere advertisement or designation of the subject to which it is attached. **Id.*

20. *Scoville v. Toland* (6 Western Law Journal, 84) quoted with approval in holding that the law of 1831 could not bear a construction admitting an ordinary label for merchandise within its protection. That law was as broad as the law now in force, and the rule applied in that case is applicable now. **Id.*

21. A mere label designates or indicates the article contained in the bottle, package or box to which it is affixed, and does not, like a trade-mark, distinguish the article otherwise. **Id.*

22. The Revised Statutes secure protection to

the author of any subject of copyright on his compliance with certain provisions which are specifically set forth. They provide that in order to maintain an action for infringement of his copyright he shall have given notice thereof by a certain formula of words inscribed upon a certain designated part of the book, print, or other article. The formula allowed by the act of 1874 includes the simple word "copyright," with the addition of the year it was entered and the name of the party by whom it was taken out. *Id.

23. Assuming that the constitution authorizes legislation for the protection of mere descriptive labels as properly the subject of copyright, and that the statute relating to subjects of copyright includes such labels, the proceedings taken to secure protection in this case were insufficient and ineffectual, and no action can be maintained for infringement, and no suit in equity to restrain future use of the label, because the form of words prescribed by the law has not been followed in giving notice of the copyright. *Id.

24. A label consisting of the name of the article contained in the bottle or package to which it is applied, a statement of the uses of the article, directions for applying it, the price at which it is sold, and the name and address of the firm by which it is prepared, and exhibiting no attempt at art or literary merit, is not entitled to registration under the recent decision of the supreme court as announced in the recent case of Higgins v. Keuffel (55 O. G. 1139). Ex parte Eldredge & Co., 55 O. G. 1278, C. D. 1891.

25. It is the settled practice of the office to consider the words "not a trade-mark," in the statute referring to the registration of labels, as applying to anything appearing on a label susceptible of appropriation as a trade-mark and not already registered as such. Ex parte Ruckstuhl, 56 O. G. 927, C. D. 1891.

26. Although a label may be artistic, yet if it is merely fanciful and arbitrary, and is not descriptive of the contents of the package to which it is to be applied, it is not registrable. Ex parte J. & P. Baltz Brewing Co., 51 MS. D., Oct., 1892 (Frothingham, Ass't Com'r).

27. Applicant offered for registration as a label "a pictorial representation descriptive of the hammock to which the label applies." Held proper subject for registration as a label. Ex parte Palmer, 58 O. G. 383, C. D. 1892.

28. A label in order to be entitled to registration by the commissioner of patents under

the copyright law must have the same degree of artistic excellence as would entitle it to copyright in the office of the librarian of congress. The Trade-mark Cases (100 U. S. 82) and Higgins v. Keuffel (55 O. G. 1139, 140 U. S. 428) quoted and discussed. Id.

29. A label which is purely descriptive of the article to which it is intended to be attached is not registrable within the meaning of the law. (Quoting Higgins v. Keuffel, 55 O. G. 1139, 140 U. S. 428.) Ex parte C. G. Hainline & Co., 58 O. G. 947, C. D. 1892.

30. In label and trade-mark cases, as in patent cases, matters of form should be settled before the application is finally disposed of upon its merits. Ex parte Vermont Maple Sugar Makers' Association, 52 MS. D., July, 1893 (Fisher, Ass't Com'r).

31. A label for bitters containing arbitrary or fanciful matter suitable for a trade-mark refused registration. Ex parte Mette & Kanne Distilling Co., 53 MS. D., July, 1893 (Fisher, Acting Com'r).

32. A label for alcoholic liquors denied registration because it was a fanciful device and did not describe the article. Ex parte Librowicz, 53 MS. D., Sept., 1893 (Fisher, Acting Com'r).

33. A label having no value as a composition *per se* held not registrable in view of Higgins v. Keuffel and Ex parte Eldredge & Co., 55 O. G. 1278. Ex parte King & Co., 53 MS. D., Nov., 1893 (Fisher, Acting Com'r).

34. The purpose of the so-called "Label act" was to relegate to the patent office all registry in the general nature of or akin to copyright of things which are mere adjuncts or appurtenances of articles of trade, and to leave to the librarian of congress the registry of things whose value in exchange resides in themselves. In any case some spark of intellectual creation must be present. (See Ex parte Palmer, 50 O. G. 383.) Ex parte H. J. Heinz Co., 62 O. G. 1064, C. D. 1893.

35. Until the supreme court distinctly says otherwise the label law is, for the patent office, constitutional. Id.

36. A label refused registration which failed to reach the standard set up by the supreme court in Higgins v. Keuffel, 55 O. G. 1139. Ex parte Bevan & Co., 55 MS. D., July, 1894 (Fisher, Ass't Com'r); also Ex parte Cohen, 55 MS. D., Dec., 1894 (Fisher, Ass't Com'r).

37. A label for canned goods having the title "Brownie Brand" (which had been already registered as a trade-mark) and representing Brownies engaged in fishing, etc., held to have

sufficient artistic merit to entitle it to registration. *Ex parte Williams & Co.*, 57 MS. D., July, 1895 (Fisher, Ass't Com'r).

38. A label entitled "Scroll Back No. 2 in Capital Brand of U. S.," for playing-cards, ruled not registrable, because primarily a design to be placed upon an article of manufacture to become a part thereof. *Ex parte United States Printing Co.*, 57 MS. D., Aug., 1895 (Fisher, Acting Com'r).

LICENSE.

(See ASSIGNMENT.)

- I. DEFINED.
- II. IMPLIED.
- III. IN GENERAL.
- IV. TO MAKE, SELL AND USE.

I. DEFINED.

1. The right of the patent owner to permit or license the use of the invention is not the creature of the federal franchise or statute, but of the common law. **United States v. American Bell Telephone Co.*, 38 O. G. 1237, C. D. 1887.

2. A conveyance by a patentee of the right "to use and manufacture and sell rights to use" the patented article in a certain county is a mere license, not entitling the grantee to sue for infringement in his own name, since it does not convey the right to sell the patented article. **Rice v. Boss*, 46 Fed. Rep. 195 (1891).

3. A grant, by the owner of a patent, of the sole and exclusive right and license to manufacture and sell the patented article throughout the United States does not include the right to use such patented article, at least if manufactured by third persons, and is therefore a mere license. **Waterman v. Mackenzie*, 54 O. G. 1562, C. D. 1891.

4. An instrument which is in terms a transfer by complainant to defendant of the exclusive right "to manufacture and sell and vend" certain patented articles, the purchasers to have the right to use the articles, which expresses that it is intended for the purpose of vesting in defendants all the rights of complainant in the manufacture and sale of such articles, but which expressly provides that complainant shall retain the ownership of the patent, and in which defendants stipulate for payment of royalties and to do all reasonable things for the successful manufacture and sale

of the patented articles, is a mere license. **Hatfield v. Smith*, 54 O. G. 1892, C. D. 1891.

5. A conveyance, under a patent, of the right "to use and manufacture and sell rights to use" the patented device in a specified locality is a mere license and does not entitle the grantee to maintain an action in his own name. **Rice v. Boss*, 56 O. G. 528, C. D. 1891.

6. "In consideration of the premises . . . I do hereby license and convey . . . the full and exclusive right to manufacture, use and sell . . . all inventions, whether patented or not, which I may hereafter make," etc. *Held* not only a license but an assignment of the inventions or improvements thereof that might thereafter be made and patents obtained therefor. **Regan Vapor-Engine Co. v. Pacific Gas-Engine Co.*, 56 O. G. 1886, C. D. 1891.

7. It has been said that the sole matter conveyed by a license is the right not to be sued. **Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co.*, 78 O. G. 171, C. D. 1897.

8. A licensee is one who is not the owner of an interest in the patent, but who has by contract acquired a right to make or use or sell machines embodying the invention. **Id.*

9. Purchaser of a machine, upon the condition that such machine is to be used only upon or in connection with articles from a particular source, is a mere licensee. All alienations of a mere right to use the machine operate only as licenses. **Id.*

II. IMPLIED.

10. The extent of an implied license to make and sell patented articles is to be construed according to the presumed intent of the parties as inferred from the circumstances. **Montross v. Mabie*, 41 O. G. 931, C. D. 1887.

11. A firm having been largely engaged during several years in manufacturing and selling stoves upon designs patented by one of the partners, and accounts between them having been repeatedly settled embracing such sales and the profits thereon, as firm business, *held*, without regard to the question whether the patent was equitably the exclusive property of the patentee, (1) that a license by the patentee to the firm to make the stoves and to sell those manufactured was implied; (2) that such license, by necessary implication, was co-extensive with the business of the firm and continued until the copartnership affairs were wound up by any lawful agencies for that purpose; (3) that consequently the copartner of the patentee had

the same authority after dissolution as before to sell for the benefit of the firm the stoves manufactured for sale before dissolution; and (4) that a receiver of the partnership effects, appointed by a state court in a suit brought for winding up the affairs of the partnership, had a similar authority to sell the stoves remaining on hand, both as the representative of the parties and as a lawful agency for closing up the partnership business, and was by necessary implication included in the implied license. An application for an injunction to restrain him from selling was therefore refused. *Id.

12. Where the defendant bought and paid for the right to use certain flush tanks, which, in combination with a system of sewers, were covered by plaintiff's patent, and the plaintiff, claiming a royalty upon the sewers in connection with which said tanks were used, brought suit for an injunction against the use by defendant of said tanks and for an account, *held*, that such suit could not be maintained, but that if plaintiff had a claim it lay in the direction of an action at law for royalties upon an implied license. *Drainage Construction Co. v. City of Chelsea, 50 O. G. 559, C. D. 1890.

13. The granting of a license may be proved by the acts and dealings of the parties who own and permit others to use the patent without the necessity of resorting to written instruments. *The Holmes Burglar Alarm Telegraph Co. v. The Domestic Telegraph and Telephone Co., 51 O. G. 2093, C. D. 1890.

14. Where an employee of a firm made an invention in the direct line of its business while in its pay, and there were circumstances which raised a presumption of an implied license to the firm to sell the invention in its line of business, and where the firm is developed into a corporation upon the same basis—liabilities, assets and business—as the firm was, and where both employee and succeeding corporation continued the same relation to each other as existed between him and the firm, *held*, that the implied license to the firm was transmitted to its successor, the corporation. (Hapgood v. Hewitt, 37 O. G. 1247, 119 U. S. 226; Troy Iron and Nail Factory v. Corning, 14 How. 193; Oliver v. Rumford Chemical Works, 25 O. G. 784, 109 U. S. 75; Hammond v. Mason & Hamlin Co., 92 U. S. 724; Lightner v. Boston and Albany R. Co., 1 Lowell, 338.) *Lane & Bodley Co. v. Locke, 65 O. G. 1406, C. D. 1893.

15. Where a party is employed to assist in developing the line of machinery manufactured by the employer, and while in such em-

ployment uses the tools and workshop of his employer to experiment with in making and perfecting an invention relating to the development of such machinery, and such invention was immediately put into use and sale in the employer's machinery, which use and sale were fully known to and acquiesced in by the employee, and where the employee did not apply for a patent until several years after such use and sale by his employer, *held*, that such facts raised a conclusive presumption of an irrevocable equitable right or license in the employer to use and sell the invention in connection with his machinery both before and after the grant of a patent to the employee. (McClurg v. Kingsland, 1 How. 202; Solomons v. United States, 54 O. G. 265, 137 U. S. 342.) *Id.

III. IN GENERAL.

16. The contracts between the American Bell Telephone Company and the local telephone corporations create the relation of licensor and lessor on the one side and licensee and lessee on the other, and not a relation of agency. *United States v. American Bell Telephone Co., 38 O. G. 1237, C. D. 1887.

17. Transactions, such as the American Bell Telephone Company has had with the licensee corporations of Ohio at its place of business in Boston, and not elsewhere, is not the carrying on of business by it in Ohio, nor are such licensee corporations its "managing agents." *Id.

18. The right of the patent owner to permit or license the use of the invention is not the creature of the federal franchise or statute, but of the common law, and in exercising this common-law right of licensing others to use its patent the corporation owner is no more nationalized than a private owner would be under the same circumstances; nor does the fact that a patent-holding corporation licenses others to use its patent in a particular state have any more effect and operation in domesticating it within such state than the same act on the part of a private owner would have in rendering him a citizen and resident of every state in which his patent might be used. *Id.

19. A licensee failed to make returns of his manufactures and sales, and to pay royalty according to his contract; *held*, this was no ground for annulling the contract, since the complainant had an adequate remedy at law for the injuries complained of. *Densmore v. Tanite Co., 32 Fed. Rep. 544 (1887).

20. Complainant was entitled to his three-

eighths share of the royalties from defendant, although the license provided for payment to Norris. At law this was due to Norris as trustee for complainant; in equity it was due directly to the complainant. *Rogers v. Riessner, 41 O. G. 351, C. D. 1887.

21. Where a patentee induces a manufacturing company to accept a license under the patent, representing that rival manufacturers were paying the schedule rates, when they were really paying only one-half of those rates, the company so imposed upon is not liable for the royalties agreed upon and is entitled to a decree canceling the license. *Hat-Sweat Mfg. Co. v. Waring, 56 O. G. 806, C. D. 1891.

22. A licensee who covenants not to dispute the validity of a patent under which he is licensed will not be permitted to do so. *Marsh v. Quick Meal Stove Co., 60 O. G. 1056, C. D. 1892.

23. Where an inventor, in consideration of assistance given him, verbally agreed to give an interest in the manufacture of his invention, but did not make an assignment of such interest in legal form, and where he subsequently made an assignment of the patent to another party without notice of the previous verbal interest, *held*, that no effect, as against the assignee, could be given to such verbal license or interest. *Gates Iron Works v. Fraser, 67 O. G. 1065, C. D. 1894.

24. When a buyer enters into an implied agreement that he will not use the machine contrary to his license, and when the agreement contains a provision for a reverter of the structure itself in case of breach, the licensor may have a remedy at law either for liability upon the broken contract or for the tortious use of the invention. *Heaton-Peninsula Button Fastener Co. v. Eureka Specialty Co., 78 O. G. 171, C. D. 1897.

25. A license operates only as a waiver of the monopoly as to the licensee and estops the licensor from exercising its prohibitory powers in derogation of the privileges conferred by him upon the licensee. *Id.

26. A court will not sustain the objection that a patentee has no right to license upon condition that the licensees use the invention only in conjunction with a non-patentable article made by himself, when the ground of objection is that an illegal monopoly will thereby be created. Courts will not lightly interfere with the freedom to contract, and especially will not sit in judgment upon the limitations

which a patentee may put upon the use of his invention. *Id.

27. Each machine sold has a metal label affixed thereon to the effect that with such machines fasteners made by a certain company only are to be used. This is equivalent to notice of a restricted license only, and the purchaser of the machine obtains title subject to a reverter in case of violation. *Id.

IV. TO MAKE, SELL AND USE.

28. By a contract in 1877 between plaintiff, who was the patentee of a printing-press and of a subordinate improvement thereon, and defendant, the defendant agreed to manufacture presses for the plaintiff at agreed prices, keeping enough on hand to meet the demands of the market, and the plaintiff agreed to buy of no one else than defendant. Defendant was to have a license to sell, paying a royalty, "the conditions of sale" by defendant to be the same as the conditions under which plaintiff should sell, "so long as he continues in the business" in New York. Afterward a modified agreement as to prices was made, to last two years, at the end of which time the defendant should "be obliged to continue to furnish the presses at the prices" fixed by the original contract. Further than shown, no time was specified in the contract. Upon a motion for a preliminary injunction, *held* (not as a final decision, but for the purposes of the motion), that after the expiration of the patents on the press in 1886, but not on the improvement, being after the expiration of the two years named in the modified agreement, defendant was not obliged longer to make presses under the contracts either with or without the improvement; that he could sell presses for plaintiff without the improvement without restriction and without paying a royalty, but that as to presses with the improvement he could not undersell plaintiff. *Gally v. Colt's Patent Fire Arms Mfg. Co., 41 O. G. 576, C. D. 1887.

29. A license granting the right "to use a patented device must be considered as granting the right to make it for use. (Citing Walker on Patents, sec. 298; Stonecutter Co. v. Short-sleeves, 16 Blatchf. 381, and Woodworth v. Curtis, 2 Woodb. & M. 524.) *Illingworth v. Spaulding, 43 Fed. Rep. 827 (1890).

30. A contract granting the right to make and sell an article under a patent within a specified territory, whether or not it amounts

to an exclusive license, and containing no limitation on its face, cannot be terminated by the grantee without the consent of the grantor, and the latter can recover the royalty fixed by the contract, even though the grantee has previously given notice of the termination thereof. *St. Paul Plow Works v. Starling, 55 O. G. 1821, C. D. 1891.

31. Under such a contract, grantee, at all times during the existence of the patent, can set up the contract as a defense against a claim for infringement and limit his liability to the royalty fixed by the terms of the contract. *Id.

32. In addition to the grant of an exclusive license to manufacture and sell in certain specified parts of the United States the license in this case contained the following clause: "And, so far as we can control the same, the exclusive right to build harvesters and binders under the rights herein granted, for sale in Europe, Australia and South America." *Held* that, fairly and reasonably construed, this language conferred upon the licensee an exclusive right to manufacture throughout the whole United States for sale in the foreign countries named, and hence that an injunction should issue against the parties manufacturing outside the territorial limits in the United States in which the licensee was authorized to sell to restrain them from manufacturing for such foreign trade. *Adriance, Platt & Co. v. McCormick Machine Co., 63 O. G. 1688, C. D. 1893.

33. In the absence of words showing that it was intended that the license might be assigned, a license conferring the exclusive right to manufacture and sell patented articles is not assignable, and does not vest in a receiver of the property of the licensee, appointed in proceedings supplementary to execution under the New York code of civil procedure. *Waterman v. Shipman, 64 O. G. 713, C. D. 1893.

34. A transfer of "plant and good-will, . . . including the contract of license," is a contract to the effect that machines which form a part of the plant are thereby transferred subject to any restrictions of the license, and such machines cannot be used or sold except in accordance with the terms of such license. *International Pavement Co. v. Richardson, 76 O. G. 166, C. D. 1896.

35. When machines are acquired under the provisions of a license which prohibits the disposal of such machines, except to other licensees, and which permits the purchasing licensee to use and enjoy such machines subject to all

the conditions of his own license, the said conditions are equitably enforceable against such purchasing licensee. *Id.

LIMITATION BY FOREIGN PATENTS.

(See FOREIGN PATENTS; INTERFERENCE — PRIORITY, FOREIGN PATENTS; ANTICIPATION — PATENTS, ETC.)

1. The time of expiration of a United States patent falling within the provisions of section 4887, Revised Statutes, is to be ascertained by the "term" of the foreign patent. *Paillard v. Bruno, 38 O. G. 900, C. D. 1887.

2. Fourteen years is the "term" of an English patent, and although said patent ceases to be in force after three years from its date if the stamp duty is not paid, it only operates by limitation upon an after-granted United States patent for fourteen years. *Id.

(By the thirteenth section of the British act of 1883, every patent is dated and sealed as of the day of the application, and by the twelfth section every patent is limited in duration to fourteen years from its date. The time begins to run from the date of the patent, including that day. Thus, a patent dated February 26, 1825, was held to expire at twelve o'clock on the night of February 25, 1839.)

3. The Canadian amendatory act of May 25, 1883, did not affect the duration of the Bate United States patent at the time of its issue in 1877, and no subsequent legislation anywhere could change its duration. *Bate Refrigerating Co. v. Gillett, 40 O. G. 1020, C. D. 1887.

4. A patent of the United States does not terminate at the date when an earlier English patent of the same inventor for the same invention becomes void for the non-payment of taxes. *Id.

5. The United States patent was for the same invention as the patent in Great Britain, although the former contained improvements which were not exhibited in the latter. The principal inventions were the same in both patents. *Guarantee Insurance, Trust and Safe Deposit Co. v. Sellers, 41 O. G. 1165, C. D. 1887.

6. A patent cannot be exempted from the operation of the law by adding some new improvements to the invention, and cannot be construed as running partly from one date and partly from another, which would be productive of endless confusion. *Id.

7. The act of 1861, section 16, was only in-

tended to change the length of the term during which patents should be in force and not the point of the commencement. The latter continued, as before, "the date of issue," as defined by the previous laws, referring either to the issue of the United States patent itself when no foreign patent had been previously obtained, or to that of the latter when such a patent had been obtained. *Id.

8. Upon application made May 31, 1871, letters patent of the United States for an invention were granted on February 6, 1872. On October 12, 1871, the inventor caused application to be made in England for letters patent for the same invention, and a provisional specification was then filed. Pursuant to this application letters patent of Great Britain for said invention were sealed April 3, 1872, and dated October 12, 1871. The complete specification for the English patent was filed April 12, 1872, the same having been subscribed March 22, 1872. *Held*, that the invention was not "first patented, or caused to be patented," in England within the meaning of the twenty-fifth section of the act of July 8, 1870 (sec. 4887, R. S.), and that the life of the United States patent was not abridged by the antedating of the foreign patent. *Emerson, Smith & Co. (Limited) v. Lippert. 42 O. G. 904, C. D. 1888.

9. No opinion expressed as to the effect on the life of a United States patent of the filing in a foreign country of a complete specification. *Id.

10. The effect of section 4887 of the Revised Statutes is not to render invalid an American patent by an English patent of an earlier date for the same invention, but only to limit its term. *Dolbear v. American Bell Telephone Co., 43 O. G. 377, C. D. 1888.

11. Under section 4887, Revised Statutes, it is not material whether the foreign patent is granted to the inventor who made the application in this country or to some other person to whom he has caused the invention to be patented, nor that the inventor who makes the application here is one of our citizens. *Edison Electric Light Co. v. United States Electric Lighting Co., 43 O. G. 1456, C. D. 1888.

12. A patent of the United States taken out by the inventor, a citizen of the United States, expires at the date of expiration of a foreign patent for the same invention previously taken out by the same inventor, or by his request, although the patent of the United States had been first applied for and the invention had

been put in use in the United States before the foreign patent had been applied for. *Id.

13. Where the Canadian statute under which the extensions of the Canadian patent were granted was in force when the United States patent was issued, and also when that patent was applied for, and where, by the Canadian statute, the extension of the patent for Canada was a matter entirely of right, at the option of the patentee, on his payment of a required fee, and where the fifteen years' term of the Canadian patent has been continuous and without interruption, the United States patent does not expire before the end of the fifteen years' duration of the Canadian patent. *Bate Refrigerating Co. v. Hammond, 46 O. G. 689, C. D. 1889.

14. The provisions of the act of 1870 and the Revised Statutes mean that the United States patent shall not expire so long as the foreign patent continues to exist, not extending beyond seventeen years from the date of the United States patent, but shall continue in force, though not longer than seventeen years from its date, so long as the foreign patent continues to exist. Under section 4887, although the United States patent may on its face run for seventeen years from its date, it is to be so limited by the courts, as a matter to be adjudicated on evidence *in pais*, as to expire at the same time with the foreign patent, not running in any case more than seventeen years; but, subject to the latter limitation, it is to be in force as long as the foreign patent is in force. *Id.

15. While it may be proper, in a case where the date of a foreign patent issued prior to the granting of a United States patent to the same patentee for the same invention is made known to the patent office prior to the granting of the United States patent, to insert in that patent a statement of the limitation of its duration, in accordance with the duration of the foreign patent, it does not affect the validity of the United States patent if such limitation is not contained on its face. *Id.

16. Section 4887 of the Revised Statutes of the United States so limits the power of the commissioner of patents that where an invention has been patented in a foreign country he cannot lawfully issue an American patent for the same invention for a term to extend beyond the actual duration of the life of the foreign patent. *Huber v. N. O. Nelson Mfg. Co., 47 O. G. 1732, C. D. 1889.

17. Letters patent of the United States granted after a foreign patent for the same in-

vention had lapsed and become null and void by reason of the non-payment of a stamp duty, *held* granted without authority of law and void. *Id.

18. The termination of a foreign patent prior to the time specified on the face of the grant by the failure of the patentee to comply with some requirement of the foreign law has the effect of terminating a subsequently-issued American patent for the same invention. *Id.

19. The "term" of a foreign patent referred to in United States Revised Statutes, section 4887, which requires letters patent issued for an invention previously patented abroad to be limited "to expire at the same time with the foreign patent," or, if there be more than one, "with the one having the shortest term," is not the original term expressed in the controlling foreign patent, but its period of actual existence. *Pohl v. Anchor Brewing Co., 49 O. G. 1695, C. D. 1889.

20. A patent should never be declared invalid because of the expiration of a foreign patent, if there is a doubt about the inventions being the same. The doubt should be resolved in favor of the patent. *Brush Electric Co. v. Julien Electric Co., 41 Fed. Rep. 679 (1890).

21. There is nothing in the statute (Revised Statutes, section 4887) which admits of the view that the duration of the United States patent is to be limited by anything but the duration of the legal term of the foreign patent in force at the time of the issuing of the United States patent, or that it is to be limited by any lapsing or forfeiture of any portion of the term of such foreign patent, by means of the operation of a condition subsequent, according to the foreign statute. *Pohl v. The Anchor Brewing Co., 51 O. G. 156, C. D. 1890.

22. Section 4887, Revised Statutes, is to be read as if it said that the United States patent is to be so limited as to expire at the same time with the expiration of the term of the foreign patent, or, if there be more than one, at the same time with the expiration of the term of the one having the shortest term. *Id.

23. The ground of the decision in *Bate Refrigerating Co. v. Hammond* (46 O. G. 689, 129 U. S. 151) was that the "term" of the Canadian patent granted in January, 1887, was by the Canadian statute at all times a term of fifteen years' duration, made continuous and uninterrupted by the action of the patentee, as a matter entirely of right, at his own option. *Id.

24. In a suit for infringement of re-issued

Letters Patent No. 10,137, granted June 13, 1882, to the Commercial Manufacturing Company, Consolidated, as assignee of Hippolyte Mége, for an improvement in treating animal fats, *held*, that the invention covered by this patent was substantially the same as that described in a Bavarian patent which expired April 8, 1876, and in an Austrian patent which expired May 26, 1876, both granted to said Mége, and that the United States letters patent expired with said foreign patents prior to the beginning of this suit. *The Commercial Mfg. Co., Consolidated, v. The Fairbank Canning Co., 51 O. G. 965, C. D. 1890.

25. The leading features of the present British statute distinguishing it from the former statutes are that the complete specification must be filed before the patent is granted; that such specification is not open to the inspection of the public when filed, nor even when afterward accepted, but only when advertisement is made of the fact of acceptance, and that the seal of the patent is the last step preceding its publication as a patent. *De Ferranti v. Westinghouse, Jr.*, 52 O. G. 457, C. D. 1890.

26. Under the present British statute a British invention cannot be said to be patented, within the meaning of sections 4886 and 4887 of the Revised Statutes, until the final act of affixing the seal. *Id.*

27. Where a foreign statute, under which an extension of a foreign patent was granted or attempted to be granted, was in force at the time of the application for or issuance of a United States patent, and where, under such statute, the extension, in the absence of unfulfilled conditions, was a matter entirely of right, at the option of the patentee, on his payment of the required fee, the fifteen-year term of such foreign patent being, by the affirmative action of the foreign government in renewing it, continuous and uninterrupted, *held*, that the United States patent does not expire before the end of the fifteen years' duration of such foreign patent, although before the expiration of the first five years the foreign patent may have lapsed or become forfeited by the non-observance of a condition subsequent, or by the happening of a subsequent condition, imposed by a statute of the country granting such foreign patent. *Edison Electric Light Co. v. Perkins Electric Lamp Co.*, 52 O. G. 1370, C. D. 1890.

28. Under section 4887 of the Revised Statutes a United States patent runs for the term for which the foreign patent was granted, not-

withstanding the lapse or forfeiture of the foreign patent by the non-observance of a condition subsequent prescribed by the foreign patent law. *Consolidated Roller-Mill Co. v. Walker, 54 O. G. 136, C. D. 1891.

29. By the Austrian patent law the "longest duration of privileges is fixed at fifteen years," and every patentee whose privilege has been granted for a shorter period than the longest may claim its prolongation for one or more years within the fixed longest period, provided such prolongation be demanded before the privilege has become extinct. In the original grant of an Austrian patent the allowance of the franchise was for one year, but on request it was four times extended, from year to year, and at the end of the fifth year the franchise was suffered to expire. A United States patent to the same patentee, and for the same invention, was issued after the Austrian patent was granted and during the first year it was in force. *Held*, that by the original grant of the Austrian patent the patentee was invested with the right, at his mere option, to have the patent prolonged for the full term of fifteen years, and that, under section 4887 of the Revised Statutes, the United States patent ran for that term, notwithstanding the expiration of the Austrian patent at the end of its fifth year. *Id.

30. Under the Austrian patent law the ministry of commerce, in deciding the question of the length of the term which appertains to every Austrian patent, exercises a judicial function, and its opinion on that subject will be followed here, agreeably to the established rule that the courts of the United States adopt the construction of a statute of a foreign country made by the courts of that country. *Id.

31. The tests of identity, under section 4887 of the Revised Statutes, are as follows: Is the principal invention in each the same; is the thing patented abroad the same in all essential particulars as the thing patented here; would the home patent be infringed by a structure made in accordance with the provisions of the foreign patent? *Brush Electric Co. v. Electrical Accumulator Co., 56 O. G. 1334, C. D. 1891.

32. The Canadian patent act which provides that, "when a foreign patent exists, the Canadian patent shall expire at the earliest date at which any foreign patent for the same invention expires" refers only to foreign patents which exist before the issue of the relevant Canadian patent. *Edison Electric Light Co.

v. United States Electric Lighting Co., 61 O. G. 564, C. D. 1892.

33. A prior Canadian patent issued for five years and extended for the further period of ten years should be regarded as having a continuous term for the entire period, and as not limiting the United States patent to any shorter term. *Id.

34. The failure to limit the patent on its face to a shorter term than seventeen years, so as to expire at the same time with the prior foreign patent having the shortest term, does not affect its validity. *Id.

35. Where a previously granted foreign patent to the same inventor is not the same in its essential particulars with any one of the inventions which are claimed in the domestic patent, the latter is not limited in its term by the former. *Electrical Accumulator Co. v. Brush Electric Co., 61 O. G. 886, C. D. 1892.

36. The United States patent was issued January 30, 1877. Application for an English patent was filed December 9, 1876. The latter was sealed on May 15, 1877, but antedated to December 9, 1876. *Held*, the invention was not patented abroad before the actual sealing and issuance of the patent there. *American Bell Telephone v. Cushman, 57 Fed. Rep. 842 (1893).

37. A United States patent applied for and granted after the expiration of a foreign patent for the same invention never had any force or validity. The delay in applying for the United States patent until after the foreign patent expired amounted to an abandonment of the right to a United States patent. *Huber v. N. O. Nelson Mfg. Co., 63 O. G. 311, C. D. 1893.

38. The tests of identity of invention for the purposes of section 4887, United States Revised Statutes, collated from the leading cases of Siemens v. Sellers (123 U. S. 276) and Commercial Mfg. Co. v. Fairbank Canning Co. (51 O. G. 965, 185 U. S. 176) and applied. The tests are: Is the principal invention of the domestic patent found in the foreign patent? Is the subject-matter of the one the same in all essential particulars as that of the other? Would a structure made pursuant to the foreign patent infringe the domestic patent? Could both patents have been granted in this country? *Electrical Accumulator Co. v. Julien Electric Co., 57 Fed. Rep. 605, 64 O. G. 559, C. D. 1893.

39. The two patents need not be in identical garb or employ identical forms of expression. *Id.

40. Evidence of an intention to patent the

same invention in the two patents is material and important. *Id.

41. Admissions, express or implied, that the two patents are respectively for the same invention as a third and earlier patent issued in a third country are material and important. *Id.

42. The same canons or methods of criticism applied to the ambiguities or perspicuities of the domestic patent should be also applied to those of the foreign patent. *Id.

43. The comparison should be instituted with the domestic patent as it was issued and not with the domestic patent as it may afterward exist after being cut down by a disclaimer and limited by the state of the art. If a patent when granted covers an invention which has been previously covered by a foreign patent, it expires with the foreign patent, notwithstanding the fact that it has subsequently been pared down to cover only one method of practicing the invention or restricted to a single claim. *Id.

44. Though the domestic patent claim the product and the foreign patent claim the process, still where the process makes the product and the product can be made only by the process, the product and the process constitute one discovery and the patents are for the same invention. (Citing *Mosler v. Mosler*, 43 O. G. 1115, 127 U. S. 354; *Plummer v. Sargent*, 120 U. S. 412.) *Id.

45. In the present state of the law the date of issue of the domestic patent is controlling under section 4887, United States Revised Statutes, not the date of application for the domestic patent. (Citing *Gramme Co. v. Arnoux*, 25 O. G. 145, 17 Fed. Rep. 838; *Edison v. United States Co.*, 35 Fed. Rep. 134.) *Id.

46. The right to obtain an extended term of the foreign patent on application within a time limited, if not availed of by actual application within such time, does not constitute such a potential term in the foreign patent as to prolong the domestic patent through or into such extended term. (Distinguishing *Consolidated Roller Co. v. Walker*, 54 O. G. 136, 43 Fed. Rep. 575, 580, and citing *Bate v. Gillett*, 46 O. G. 1029, 31 Fed. Rep. 809; *Bate v. Hammond*, 46 O. G. 689, 129 U. S. 151; *Huber v. Nelson*, 63 O. G. 311.) *Id.

47. Under Revised Statutes, section 4887, a United States patent expires with a foreign patent granted for the same invention to the same inventor prior to the date of the United States patent but subsequent to the application therefor. (*Refrigerating Co. v. Gillett*, 13 Fed.

Rep. 553, followed.) **Bate Refrigerating Co. v. Sulzberger*, 65 O. G. 135, C. D. 1893.

48. The term "patented" in section 4887 of the Revised Statutes does not mean the preliminary proceedings, but the actual issuance of the patent under the seal of the government. (Citing *Telegraph Co. v. Telegram Co.*, 31 O. G. 1559, 23 Fed. Rep. 340; *Emerson Smith & Co. v. Lippert*, 42 O. G. 964, 31 Fed. Rep. 911; *Seibert Cylinder Oil Cup Co. v. William Powell Co.*, 47 O. G. 1072, 35 Fed. Rep. 591; *Smith v. Goodyear Dental Vulcanite Co.*, 11 O. G. 246, 93 U. S. 486-498.) A United States patent granted January 30, 1877, not limited by British patent which was sealed May 15, 1877, but antedated to December 9, 1876, the date of filing the provisional specification, and conditioned that on or before June 9, 1877, a complete specification should be filed. **American Bell Telephone Co. v. Cushman*, 65 O. G. 135, C. D. 1893.

49. Where a domestic patent was granted February 20, 1883, and a British patent for the same invention was sealed August 20, 1883, and a re-issue application was filed January 21, 1893, *held*, that since the term of the re-issue would not be affected by the foreign patent, it was unnecessary to require the re-issue applicant to recite the British patent in his oath. (*Ex parte Beck*, C. D. 1880, 54, 17 O. G. 329, discussed.) *Ex parte Cowles*, 65 O. G. 2060, C. D. 1893.

50. The voluntary act of a patentee in causing his patent to be amended after issuance so as to be limited to expire with a foreign patent secured by him, even though taken under the mistaken view that the law required such limitation to appear on the face of the patent, estops him, as against one who invested money in a manufacturing plant on the faith of his action, from claiming that the amendment was invalid and of no effect or from relying upon a subsequent annulment of the amendment secured by him only a short time before the amended patent would have expired. **Edison Electric Light Co. v. Buckeye Electric Co.*, 67 O. G. 529, C. D. 1894.

51. Where the petition for correction in such case states that, while the inventor's American application was pending, "he applied for and obtained" letters patent for the same invention in several countries—enumerating such patents, with their dates—and prays that the American patent may be amended so as to be limited to expire with the expiration of that one of them having the shortest time to run, the petition does not, by reason of the indefi-

nitensness of this language, put the public upon investigation as to the laws of the various countries, so as to affect them with notice that the British patent, which was the one first expiring, did not begin to run on the day of its date, but upon the day of its sealing and issuance. *Id.

52. Where the application for the United States patent for the invention was filed in 1876, December 1; the foreign patents obtained in 1877, January 9 and July 26, respectively, and the United States patent in 1877, November 20, *held*, that the invention for which the United States patent was issued was "previously patented in a foreign country," within the meaning of those words in section 4887, and the United States patent expired under the terms of that section before the expiration of seventeen years from its date. *Bate Refrigerating Co. v. Sulzberger, 70 O. G. 1633, C. D. 1895.

(Controlling decision — supreme court.)

53. The words "previously patented in a foreign country" are plain and unambiguous. Therefore the court has no authority to add to them the words "prior to his application." To do so would be to legislate and not to interpret the section. *Id.

54. Where a British patent to applicant became void prior to the filing of his United States application, by reason of failure to pay a renewal fee, *held*, that he was properly rejected for such reason, since no valid patent could issue to him. (Huber v. Nelson Mfg. Co., 63 O. G. 311, 148 U. S. 270.) *Ex parte* Armstrong, 71 O. G. 1615, C. D. 1895.

55. The word "expire," in section 4887 of the statute, is construed by the United States supreme court to mean cease to exist because of the termination of the duration of the original grant, and not to mean cease or determine by reason of some penalty or forfeiture for the non-performance of some condition subsequent. (Citing Pohl v. Brewing Co., 134 U. S. 381, 10 Sup. Ct. 577.) "A United States patent, therefore, runs for the term for which the foreign patent was granted, without reference to whether the latter patent became lapsed or forfeited in consequence of the failure of the patentees to comply with the requirements of the foreign law." (Cases cited.) *Bonsack Machine Co. v. Smith, 70 Fed. Rep. 383 (1895), 73 O. G. 963, C. D. 1895.

56. Under the Canadian act of 1872 a patent granted for five years is granted for a term independent of any other. Extension of the term

is a privilege, not a duty, and the term is not forfeited, but expires. The patentee did not choose to renew his patent, and his patent expired because its term had expired. By his own act he made his invention free abroad, and thereupon it became free in this country. *Id.

57. The identity of invention patented required by the statute is of material substance and does not extend to minor details. (Siemens v. Sellers, 123 U. S. 276.) *J. L. Mott Iron Works v. Henry McShaue Mfg. Co., 79 O. G. 865, C. D. 1897.

58. Letters Patent No. 245,318, granted August 9, 1881, to John Robertson, for an improvement in supply-tanks, appears to be for the same invention in substance as Canadian patent to same inventor and expired with the latter patent. *Id.

MANDAMUS.

1. An order by a circuit court to entertain and grant a petition for a rehearing upon a case decided by the supreme court, without previous leave obtained therefrom, is irregular and unauthorized, and such action affords good ground for a *mandamus* setting aside such order. *In re C. & A. Potts & Co., 78 O. G. 2049, C. D. 1897.

2. *Mandamus* to compel the commissioner of patents to reinstate an interference which he dissolved upon the ground that the issue was not patentable when the question of priority came before him on appeal will not lie. *Seymour, Com'r of Patents, v. United States of America ex rel. Brodie, 79 O. G. 509, C. D. 1897.

3. A *mandamus* lies for the enforcement of the performance of some act or duty required by law to be performed, in the performance or non-performance of which the applicant for the writ is interested, where there is no other legal remedy. *Id.

4. The mere fact that the relator has been put to trouble or expense in legal proceedings or has suffered commercial injury is no basis for the writ of *mandamus* when the respondent has failed in no legal duty. *Id.

5. A petition for a writ of *mandamus* to a public officer of the United States abates by reason of his retirement from office as well after judgment and pending an appeal therefrom as before. Seymour, Com'r of Patents, v. Nelson, 79 O. G. 1522, C. D. 1897.

6. Where pending an appeal on a petition

for a writ of *mandamus* against a public officer the officer retires, *held*, that the appeal will not be dismissed; but the judgment of the court below will be reversed and the cause remanded to said court with directions to dismiss the suit for want of proper parties. The result is the same whether the judgment appealed from is in favor of or against the officer. **Id.*

7. Where an appellant delayed in applying to the court of appeals for the District of Columbia beyond the time provided in the rules of said court, in consequence of which said appeal was dismissed, *held*, that a writ of *mandamus* to compel the court of appeals to entertain the appeal will not lie to the supreme court of the United States. *Ex parte Hien*, 79 O. G. 507, C. D. 1897.

MANUFACTURE OF PATENTED ARTICLE OR MACHINE.

(See RIGHT TO MAKE, USE AND SELL.)

MANUFACTURE AND USE OF THEIR INVENTIONS BY PATENTEES.

1. A patentee failed for some years to manufacture his device; *held*, this could not avail to defeat his or his assignees' rights vested in them by the grant of a patent. (*Campbell Printing Press and Manufacturing Co. v. Manhattan Ry. Co.*, 49 Fed. Rep. 930.) **Masseth v. Johnston*, 59 Fed. Rep. 613 (1894).

2. Whether a patentee exercises his exclusive right to his discovery by manufacturing his device cannot affect his exclusive right under the patent. (*Masseth v. Johnston*, 59 Fed. Rep. 613.) **Masseth v. Reiber*, 59 Fed. Rep. 614 (1894).

3. Grants of patents are made upon the reasonable expectation that patentees will use their inventions or permit them to be used; but the public has no security to enforce such expectation beyond the interest of the patentee. **Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co.*, 78 O. G. 171, C. D. 1897.

MARKING ARTICLES "PATENTED."

1. Where a manufactured article contains, in addition to what is described and claimed in patents owned by the manufacturer, something which is new, substantial and valuable in the market, he has no right to mark the article as

a whole "patented" by reason of his patents, simply because the new article embodies the inventions covered by the patents. **Deverall v. Banker*, 45 O. G. 591, C. D. 1888.

2. In an action brought under section 4901 of the Revised Statutes of the United States seeking to enforce a penalty of \$100 for each offense for marking articles "Patent Applied for," *held*, that the mark was not an offense, for the reason that it did not import that the article was covered by a subsisting patent. **Schwebel v. Bothe*, 49 O. G. 1696, C. D. 1889.

3. Marking of goods with the design claimed to have been infringed, or else notifying the infringer, is a prerequisite to a claim for damages by the party insisting upon such infringement. **Schofield v. Dunlop*, 52 O. G. 1369, C. D. 1890.

4. Where marking of goods is omitted, and notice relied upon, the burden of proof is on the plaintiff. **Id.*

5. The court will proceed upon the hypothesis that the burden of averring and proving a failure to mark is on the defendant, the plaintiff not being held to proof of marking in the first instance, such marking being inferred. **Id.*

6. Where a defendant has shown a failure on the part of the plaintiff to mark the articles vended, the burden is upon the plaintiff to show that the defendant was notified before suit was brought that he was infringing. **Id.*

7. A defense based upon the failure to mark the date of the patent upon the articles bearing the patented design should be set up in the answer. If set up for the first time in the hearing it will not be considered. **Anderson v. Saint*, 57 O. G. 546, C. D. 1891.

8. When a dealer sells articles bearing a patented design knowing that the manufacturer had no license to apply such design, he is liable to the penalty prescribed in the act of congress of February 4, 1887. **Id.*

9. Where there is any question under section 4900 of sufficiency of notice to the public that the device sued upon was a patented article, the presumption against the public arising from the record of letters patent in the United States patent office requires the averment of want of knowledge on the part of the defendant in his answer to the bill. **Sessions v. Romadka*, 59 O. G. 939, C. D. 1892.

10. The patentee of wooden dishes which might have been marked "Patented," etc., as required by section 4900, Revised Statutes, did not stamp the dishes, but only the crates in

which they were packed. Upon a suit for penalties under the second paragraph of section 4901 against the defendants for placing a similar stamp upon crates of similar dishes made by the defendants without license, *held*, on demurrer to the complaint, that sections 4900 and 4901 must be construed together, that the stamping of articles capable of stamping was necessary, and that the stamping of the crates containing them was insufficient and was not protected by sections 4900 and 4901, and that a similar stamping of their own crates by the defendants did not render them liable to any penalty. *Smith v. Walton, 61 O. G. 289, C. D. 1892.

11. In an action for the recovery of penalties under section 4901, Revised Statutes of the United States, it appeared the article was marked with the number and date of each of the seven patents named in the license under which the defendant claimed it was manufactured and sold, and although it did not contain the improvements set forth in a particular one of the seven patents, there is no evidence even tending to show that it was not covered by them, nor is there any showing that it was in fact in any part unpatented. Judgment for defendant. *Russell v. Newark Machine Co., 55 Fed. Rep. 297 (1893).

12. In an action under the Revised Statutes, section 4901, to recover penalties for marking unpatented articles as "Patented," the jury can only consider cases in which the marking was done within five years before the commencement of the suit and within the judicial district in which it is brought. *Hotchkiss v. Samuel Cupples Wooden-Ware Co., 63 O. G. 1690, C. D. 1893.

13. To render defendant liable for the penalty the marking must have been done for the purpose of deceiving the public, and in determining the existence of such purpose the jury may consider that, although the articles were in fact unpatented, they were claimed to have been manufactured under a certain patent, and that the question whether they were covered by such patent was one upon which persons skilled in the patent law might reasonably entertain different opinions. The fact that defendant may have become convinced sometime after the marking was done that the articles were not covered by the patent would not render it liable. *Id.

14. A corporation may be held liable under this section when the wrongful acts are proven to have been committed by some officer or

agent thereof acting within the scope of his authority, knowing that the articles were unpatented and with intent to deceive the public. *Id.

15. The marking of a number of separate articles with intent to deceive the public does not constitute separate offenses when it is all done on the same day and at the same time, so that the marking is practically a continuous act, and in such case but one offense is committed and one penalty is recoverable. *Id.

16. Where the complaint showed that the word "Patented," etc., was not stamped on plaintiff's patented article, as required by Revised Statutes, section 4900, not because of the "character of the article," but because the cost of such stamping would destroy the patentee's profits, *held*, on demurrer to the complaint in an action to recover penalties under section 4901 for an unauthorized use by defendants of the word "Patented," etc., on their articles, that the complaint was demurrable. *Smith v. Walton, 64 O. G. 1789, C. D. 1893.

17. The meaning of section 4900 is that the owner of the patent cannot recover damages of infringers unless he establishes that he has given notice of his patent-right either by marking his article "Patented" or by particularly informing infringers of his patent and of their infringement of it. *Dunlap v. Schofield, 67 O. G. 139, C. D. 1894.

18. This statute requires that, in order to charge either a manufacturer or seller of a patented design, the patentee must prove that the infringer applied the design or some colorable imitation thereof "with a knowledge of the patent and of his infringement." *Id.

19. Where a thing is marked "Patented" as of a date not of its patent, but of the date of an earlier patent to the same patentee, upon which it is an improvement, *held* not to be a compliance with section 4900 of the United States Revised Statutes and to secure to him no right to damages on proof of infringement of the improvement. *Traver v. Brown, 69 O. G. 1071, C. D. 1894.

20. The evidence proved that the articles covered by design patent were marked "as a rule." *Held*, this was insufficient to prove compliance with the statute. *Matthews and Willard Mfg. Co. v. National Brass and Iron Works, 71 Fed. Rep. 518 (1895).

21. "Marking patented articles or notice to the infringers is made by the statute a prerequisite to the patentee's right to recover damages against him." (Cases cited.) *Id.

22. Where it was objected that defendant was not liable because the patented machine was not marked with notice of the patent, *held*, that such defense to be available must be set up in the answer and established by proof. (Rob. on Pat., sec. 1046; *Goodyear v. Allyn*, 6 Blatchf. 38.) **United States Printing Co. v. American Playing Card Co.*, 72 O. G. 1499, C. D. 1895.

23. A bill dismissed in view of the failure to mark the goods (design), and the voluntary desistance of the defendant from manufacture when duly notified. When there is failure to mark, notice must be proved. **Pairpoint Mfg. Co. v. Eldridge Co.*, 71 Fed. Rep. 307 (1896).

24. The contention that there is no proof of public notice by the complainant by marking his machines relates only to the question of damages and does not apply to an injunction proceeding. **Beach v. Inman Mfg. Co.*, 74 O. G. 379, C. D. 1896.

25. Where plaintiffs have manufactured and sold their device without opposition for upward of five years, there is sufficient proof of public acquiescence, and it is immaterial that a large number of their devices were not marked "Patented" when it appears that enough were so marked to give general notice of the patent. **McDowell v. Kurtz*, 78 O. G. 1104, C. D. 1897.

MECHANICAL SKILL.

(See PATENTABILITY—INVENTION AND SKILL DISTINGUISHED.)

METHOD.

(See PATENTABILITY.)

MODELS.

1. A model should not be indorsed upon the file-wrapper and be considered a part of the application unless the applicant has been required by the office to furnish one. *Ex parte Beaumel*, 56 O. G. 1203, C. D. 1891.

2. The office required a model, which applicant furnished, clearly indicating, however, at that time and subsequently, that he wished the model returned. The office did not, in response to applicant, insist upon the permanent filing of a model, nor were the receipt and application of the model to the case under consideration entered on the file-wrapper, under rule 56.

Held, on renewed request by the applicant for its return, that the model was not regularly filed, and should be returned. *Ex parte Hunter*, 59 O. G. 1477, C. D. 1892.

3. A model filed with the application for a patent is not a part of the patent and not available as a defense to prove prior invention. **Lalance & Grosjean Mfg. Co. v. Mosheim*, 65 O. G. 300, C. D. 1893.

4. A requirement for a model should be regarded simply as an alternative for an intelligible disclosure of the invention. The requirement may often be waived if better drawings and a full and clear description be furnished. *Ex parte Tuttle*, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

MORTGAGE OF PATENT.

1. A mortgage by a patentee vests in the mortgagee the whole title to the patent-rights, subject only to be defeated by performance of the condition, or by redemption by bill in equity within a reasonable time after default; and the right of possession to the incorporeal property is, in legal effect, delivered to the mortgagee at the time of the recording of the mortgage at the patent office. **Waterman v. Shipman*, 64 O. G. 713, C. D. 1893.

2. The recital in a mortgage of patent-rights of the existence of a license is notice to the mortgagee and purchasers of the patent-rights under the mortgage of all the terms and conditions of the license. **Id.*

NEW TRIAL AND REHEARING IN THE COURTS.

1. It is not sufficient ground for reopening a decree on petition of co-defendants that they were only nominal defendants, were ignorant of the patent in suit, and were misnamed in the bill, it appearing that they had answered without objection and the law imputing knowledge of patents as public records. **Bate Refrigerating Co. v. Gillett*, 40 O. G. 1029, C. D. 1887.

2. Due diligence in making the motion is required of a party who seeks to correct or amend a decree, and a lapse of more than four years is not reasonable diligence. **Id.*

3. A new trial should not be granted if the newly-discovered evidence submitted would not change the result of the verdict and judgment. **Starling v. St. Paul Plow Works*, 41 O. G. 818, C. D. 1887.

4. After hearing upon the merits defendant moved to open the case to allow additional testimony to be taken upon a point where testimony had already been put in evidence, and the motion was denied because such additional testimony would be merely accumulative. *Pfanschmidt, Dodge & Co. v. P. H. Kelly Mercantile Co., 41 O. G. 1501, C. D. 1887.

5. Upon an application for rehearing in a suit for infringement of a patent, the invalidity of the patent being re-argued in the light of some additional evidence as to the state of the art, but no reason being assigned for failure to produce this evidence at the hearing, *held*, that the evidence would not be considered. *Burd-sall v. Curran, 42 O. G. 1167, C. D. 1888.

6. Courts are uniformly liberal in extending times for the taking of testimony, provided the parties act in good faith and are reasonably diligent; but the degree of diligence required in procuring evidence before trial is not so great as that required to secure a new trial. Especially is this true when the evidence has actually been procured and is in the presence of the court before the trial begins. Osgood v. Badger, v. Bennett, 44 O. G. 1066, C. D. 1888.

7. In a suit for infringement of a patent an application for rehearing after settlement of the case must be denied. *Zinsser v. Kremer, 49 O. G. 414, C. D. 1889.

8. The granting or refusal, absolute or conditional, of a rehearing in equity, as of a new trial at law, rests in the discretion of the court in which the case has been heard or tried and is not the subject of appeal. *Roemer v. Neumann, 49 O. G. 1535, C. D. 1889.

9. The judgment of the circuit court awarding damages in an action at law for infringement of said claims reversed, and the case remanded with direction to grant a new trial for the reason that the said court upon the evidence presented ought to have directed a verdict for the defendant on the ground that the patent was void. *County of Fond du Lac v. May, 53 O. G. 1884, C. D. 1890.

10. Where in an action for infringement it appeared that the defendants had introduced evidence in respect to a certain device at the close of a long and expensive hearing before the master, and that while plaintiff's counsel had not brought themselves without question within the rules which ordinarily govern the reopening of a hearing to admit newly-discovered evidence, the plaintiff had not presented that part of its case and had not had a full opportunity to do so, and it appeared that it would

be inequitable to say that it never should present it, *held*, that a motion to reopen by plaintiff for the purpose of introducing new testimony in respect to said device should be granted. *Webster Loom Co. v. Higgins, 54 O. G. 300, C. D. 1891.

11. A petition for a new trial, brought as a motion for a rehearing, dismissed, it appearing that the evidence was not newly discovered, much less that it might not have been discovered prior to the previous hearing by the exercise of reasonable diligence. (Spill v. Celluloid Co., 22 Blatchf. 441, 459; Giant Powder Co. v. California Powder Co., 18 O. G. 1339, 5 Fed. Rep. 197, 201.) Bostad and Krabol v. Johnson, 72 O. G. 898, C. D. 1895.

12. Where the claims of a patent had been adjudicated adversely to defendants and at another trial the sole defense relied upon by them was new evidence of anticipation, the burden is upon them to support the defense by such proof as would convince the court that had it been presented upon the former trial it would probably have led to a different conclusion. *Allington & Curtis Mfg. Co. v. Lynch, 74 O. G. 1126, C. D. 1896.

13. Upon a petition for rehearing on the ground that the court of appeals of the District of Columbia had no jurisdiction over an interference case appealed to it, except on the question of priority of invention, and yet that, instead of deciding that question, it decided that appellant was entitled to the patent on account of the relations existing between him and the appellee, *held*, that it was not necessary to adjudge in formal terms that the appellant is the prior inventor when he has been adjudged to be, in law, the only inventor. *Milton v. Kingsley, 75 O. G. 2195, C. D. 1896.

14. The ruling that the time for prosecuting appeals from decrees in equity or writs of error from a judgment at law is stayed by a motion for rehearing or for new trial and only begins to run from the refusal of such motion is founded upon the principle that the judgment is not complete until the rehearing is disposed of. *Ross v. Loewer, 77 O. G. 2141, C. D. 1896.

15. On a rehearing, new testimony for the losing party not in harmony with previous silence of the same witness for the same party, when such testimony relates to an important feature of the case, is not adequate to satisfy a court that justice toward a losing party requires a rehearing. *Tuttle v. Clafin, 78 O. G. 1739, C. D. 1897.

16. An order by a circuit court to entertain

and grant a petition for a rehearing upon a case decided by the supreme court without previous leave obtained therefrom is irregular and unauthorized, and such action affords good ground for a *mandamus* setting aside such order. *In re C. & A. Potts & Co., 78 O. G. 2049, C. D. 1897.

17. When questions of novelty and infringement are before the supreme court and are disposed of by it, they must be deemed to have been finally settled and cannot afterward be reconsidered by a lower court either by granting a new trial, or a rehearing, or to permit new defenses on the merits by amendment or answer. *Id.

NOVELTY.

(See PATENTABILITY.)

OATH TO APPLICATION.

- I. ORIGINAL
- II. SUPPLEMENTAL
- III. NEW OR RENEWED.

I. ORIGINAL.

1. The oath accompanying the application contained the statement that the invention had not been patented to the applicant, "nor with his knowledge or consent in any foreign country," the words "to others" being omitted and the word "foreign" inserted before *country*. Ex parte Mason, 43 O. G. 627, C. D. 1888.

2. *Held*, the oath is indefinite and may be construed to mean that the invention has not been patented to applicant in any country, or to himself in any foreign country, or with his knowledge or consent in any foreign country. Id.

3. If the rules are violated or departed from in one material particular, the practice would soon become lax in other particulars. The several requirements of the rule with regard to the oath must be enforced. Id.

4. The taking of the oath is but a prerequisite to the granting of the patent, and is in no degree essential to its validity. *The Holmes Burglar Alarm Telegraph Co. v. The Domestic Telegraph and Telephone Co., 51 O. G. 2083, C. D. 1890.

5. Only those officials specified in the law (section 4892, Revised Statutes of the United States) *held* to be empowered to administer the

application oath. Ex parte Hakansson, 63 O. G. 1688, C. D. 1893.

6. An application oath administered by an official not named in rule 47 *held* to be defective and not to be received and accepted as in full compliance with the rule. Id.

7. Rule 46 has all the force of a statute, and it contemplates that the oath shall set forth that the invention has not been in public use or on sale in this country for more than two years prior to the filing of the complete application. Miller v. Lambert, 72 O. G. 1903, C. D. 1895.

8. A portion of the original application oath relating to foreign patents, and alleged to be erroneous, cannot be canceled, but applicant may file explanations. Ex parte Schmidt-Storjohann, 62 MS. D., Sept., 1897 (Greeley, Ass't Com'r).

9. The oath in an application is not subject to amendment. Ex parte Brand, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

10. An oath which does not comply with the requirements of the law is legally no oath and can be given no force and effect. It must give the residence of an applicant as a means of identification. Id.

II. SUPPLEMENTAL.

11. The supplemental oath required under an office rule, that applicant shall make oath that the matter introduced by amendment was a part of the original invention, does not of itself establish the fact that such matter was actually a part of the original invention. Whether the matter covered by the proposed amendment is a departure from the original invention shown and described must be determined by an inspection of the application, the specification and drawing. This is manifest from rule 70. Ex parte Regan, 45 O. G. 589, C. D. 1888.

12. The office of a supplemental oath, as set forth in an office rule, is to justify the introduction by amendment of a claim not substantially embraced in the statement of invention or claim originally presented, and affords no justification for the introduction of matter by way of amendment which is not substantially described or disclosed in the application as filed. Steward v. Ellis, v. Lee, v. Howe, 49 O. G. 1983, C. D. 1889.

13. It is not the province of a supplemental oath to introduce new matter. The supplemental oath simply enables the applicant to

cover and include in his claim such portion of his original disclosure or description as was not embraced in "the statement of invention or claims originally presented." *Ex parte Lillie*, 53 O. G. 2041, C. D. 1890.

14. The various considerations bearing upon the question whether, in a given case, the right to amend where a supplemental oath is required has been exhausted should be passed upon by the primary examiner in the first instance, and cannot in the nature of the case ordinarily be decided by the commissioner until he obtains the special information, based upon special knowledge, which it is the province of the primary examiner to possess. *Id.*

15. A supplemental oath is required to justify the insertion of a claim through the medium of a divisional application where it would be requisite if the claim were to be inserted in the parent application. *Forbes v. Thomson*, 53 O. G. 2042, C. D. 1890.

16. Where an application as filed discloses an apparatus and also a patentable process, and the relation between them is such that they could be joined in one application, and the apparatus only is embraced in the statement of invention and claims as originally presented, claims for the process may be subsequently incorporated, if seasonably presented and supported by a supplemental oath. *Ex parte Perkins*, 55 O. G. 139, C. D. 1891.

17. The question whether a supplemental oath shall or shall not be required is *ex parte* in its nature and not open to argument on the part of an opposing interference contestant. *Rennyson v. Merritt*, 58 O. G. 1415, C. D. 1892.

18. The absence of a supplemental oath, although it may be necessary before allowance, does not furnish a ground for rejecting the claims and is an *ex parte* question not open to argument by an opponent in interference proceedings. (*Rennyson v. Merritt*, 58 O. G. 1415.) *Ex parte Weidemann*, 81 O. G. 2245, C. D. 1897.

19. Where it appears that it is impossible at the present time for the assignee to obtain the signature of the inventor to a supplemental oath, *held*, that the necessity for such oath may properly be left for consideration until after the decision in the interference under rule 96. *Id.*

III. NEW OR RENEWED.

20. Where an application, executed in Liverpool, England, was filed forty-eight days later, *held*, that the delay was not unreasonable

and that an additional oath should not be required. Previously decided cases reviewed. *Ex parte Wilson*, 63 O. G. 465, C. D. 1893.

21. An additional oath required to an application which, although filed the day after execution of the proper oath, was not completed until more than ten months afterwards. *Ex parte Miller*, 58 MS. D., March, 1896 (Fisher, Ass't Com'r).

22. An additional or new oath required in the case of several applications filed four to six months after execution of the oaths. The fact that the application papers were filed within a reasonable time after execution of the oaths, but without the fees, does not avail, since the applications were not complete until the fees were paid. *Ex parte Enos B. Willix*, 62 MS. D., July, 1897 (Greeley, Ass't Com'r).

23. A new oath is required in an application filed seventeen months after the original oath was made. An affirmation by the assignee cannot take the place of the oath the statute requires from the inventor so long as the latter is alive. (Citing *Ex parte Stevens*, 59 O. G. 299.) *Ex parte Elijah McCoy* 80 O. G. 2037, C. D. 1897.

PATENTABILITY.

(See ANTICIPATION; CLAIMS.)

- I. IN GENERAL.
- II. COMBINATION.
- III. INVENTION AND SKILL DISTINGUISHED.
- IV. INVENTION AND SUGGESTION DISTINGUISHED.
- V. EVIDENCE OF EXTENSIVE USE.
- VI. EVIDENCE OF RESULT.
- VII. UTILITY.
- VIII. BURDEN OF PROOF.
- IX. NOVELTY AND INVENTION.
 - (a) *New Use or Adaptation.*
 - (b) *Process or Method.*
 - (c) *Particular Cases.*
- X. NOVELTY WITHOUT INVENTION.
 - (a) *Aggregation.*
 - (b) *Arrangement.*
 - (c) *Composition of Matter.*
 - (d) *Degree.*
 - (e) *Double or Analogous Use.*
 - (f) *Mechanical Process or Method.*
 - (g) *Omission of Mechanical Parts.*
 - (h) *Product of Nature.*
 - (i) *Process or Method.*
 - (j) *Substitution of Materials or Parts.*
 - (k) *Particular Cases.*

I. IN GENERAL.

1. One patented machine is an improvement upon another when the general construction and arrangements of parts, the principles of operation, and the results are substantially similar in both instances, although the later machine may be much better than the earlier one. *Aspinwall Mfg. Co. v. Gill, 40 O. G. 1133, C. D. 1887.

2. An inventor of a mechanical invention is entitled to give to it such enhancement by way of ornamentation and decoration as it is capable of receiving, and this without in any way modifying or detracting from his right to a patent. *Ex parte Schuiz-Berge*, 42 O. G. 293, C. D. 1888.

3. Although the patentee may be entitled to the merit of being the first to conceive of the convenience and utility of mechanism for accomplishing a certain purpose, his right to a patent must rest upon the novelty of the means he has contrived to carry his idea into practical operation. *Aron v. The Manhattan Ry. Co., 49 O. G. 1365, C. D. 1889.

4. The office should not overlook the fact that it must be shown that invention was exercised in producing the article or machine, and that it is not every person who has made a new or useful thing who is entitled to a patent. *Ex parte Devin*, 45 O. G. 709, C. D. 1888.

5. It is not enough that a thing shall be new in the sense that in the shape or form in which it is produced it shall not have been known before, and that it shall be useful, but it must, under the constitution and the statute, amount to an invention or discovery. *Hill v. Wooster, 50 O. G. 560, C. D. 1890.

6. The practical inventor who may succeed in building and equipping an air-ship consisting of a metallic shell from which the air has been wholly or partially exhausted, and who may hereafter first teach the world how to practice his invention by disclosing the means invented and discovered by him for overcoming obstacles, should not find himself forestalled by a theorist, and compelled to occupy the position of an infringer, when he is the first person who has ever been in position to teach the world how to build an air-ship operating upon the principle embodied in his apparatus. *Ex parte De Bausset*, 50 O. G. 1766, C. D. 1890.

7. An inventor is not to be deprived of the fruit of his invention simply because the physical laws upon which it operates are not sus-

ceptible of satisfactory exposition. *Knickerbocker Co. v. Rogers, 67 O. G. 1448, C. D. 1894.

8. The object of an invention is not patentable; the means may be. *Brush Electric Co. v. Western Electric Co.*, 77 O. G. 1273, C. D. 1896.

II. COMBINATION.

9. The court finds that one element of the combination claimed in the patent in suit was new, and that the combination was useful, and determines that the invention was patentable. *Temple Pump Co. v. The Goss Pump and Rubber Bucket Mfg. Co., 39 O. G. 467, C. D. 1887.

10. Where the patent in suit remedied serious defects in a former machine by the employment of old devices, it would appear to present a new combination involving invention. *Osborn v. Glazier, 40 O. G. 1137, C. D. 1887.

11. The facts that a patent for a device consisting of a combination of appliances previously used separately was granted after the device had been subjected to rigid scrutiny and comparison with previous patents by the patent office examiners, and that the combination, although useful, did not appear to have been used or proposed before, *held* sufficient to sustain the patent as against a defense of want of novelty. *Shaver v. Skinner Mfg. Co., 41 O. G. 232, C. D. 1889.

12. Where one patentee has invented a combination for a particular purpose, the field is open to another to invent a combination of the same parts effecting the same result by a different mode of operation. *Railway Register Mfg. Co. v. Third Avenue Ry. Co., 42 O. G. 379, C. D. 1888.

13. Where the elements of a combination in a claim co-operate in a result, these parts constitute the combination claimed, and all the other parts of the machine which make these parts operate in this way to produce the result required are for that purpose equivalents of the parts of any other machine (however different they may be in themselves) which also make these parts operate in the same way to produce the same result. *Thompson v. Gildersleeve, 43 O. G. 886, C. D. 1888.

14. Claims for combinations distinguished from claims covering elements having a specific construction and arranged in such peculiar relation as to be adapted to use with each other. While it cannot be doubted that it is the better practice in all cases of novel combination to express the claim in combination

form, it sometimes occurs that an invention is of such peculiar character as to render such a claim unimportant. *Ex parte Weeks*, 43 O. G. 1585, C. D. 1888.

15. A combination claim includes whatever is made a part of the combination by the words of the claim, or by necessary inference is a material part in the construction of the patent. **Thompson v. Gildersleeve*, 43 O. G. 886, C. D. 1888.

16. In a combination it makes no difference in principle whether the separate elements are similar to each other or dissimilar if they produce a novel effect. **Stearns v. Phillips*, 43 Fed. Rep. 792 (1890).

17. The simultaneous co-operation of the parts is not essential to a patentable combination if the parts are so arranged that the successive action of each contributes to produce some one practical result, which result, when attained, is the product of the simultaneous or successive action of all the elementary parts viewed as one entire whole. The term "co-operation" does not mean acting together or simultaneously, but unitedly to a common end. **The Holmes Burglar Alarm Telegraph Co. v. The Domestic Telegraph and Telephone Co.*, 51 O. G. 2083, C. D. 1890.

18. In a patentable combination of old elements, all the constituents must so enter into it as that each qualifies every other. It must form either a new machine of a distinct character and function, or produce a result due to the joint and co-operating action of all the elements, and which is not the mere adding together of separate contributions. The combination of old devices into a new article without producing any new mode of operation is not invention. **Florsheim v. Schilling*, 53 O. G. 1737, C. D. 1890.

19. *Pickering v. McCullough*, 21 O. G. 73, 104 U. S. 310, examined and explained. It is not necessary in a new combination of old elements that each element should modify or change the characteristic mode of action or method of operation of the others, but only that the combination should produce a new and useful result as the product of the combination, and not a mere aggregate of several results each the complete result of one of the combined elements. Where a new result is produced as a product of the combination, it is enough that each element contributes to its production. **National Cash Register v. American Cash Register Co.*, 62 O. G. 440, C. D. 1893.

20. *Held*, that the combination is an entirety,

and if one of the elements is given up the thing claimed disappears (*Vance v. Campbell*, 1 Blatchf. 427-429); and this principle prevails even where the patentee has claimed more than is necessary to the successful working of his device. (*McLain v. Ortmyer*, 57 O. G. 1129, 141 U. S. 419-425.) **Vincent v. Rigby*, 64 O. G. 861, C. D. 1893.

21. In a patentable combination of old elements all the constituents must so enter into it as that each qualifies every other. . . . It must form either a new machine of a distinct character and function or produce a result due to the joint and co-operating action of all the elements, and which is not the mere adding together of separate contributions. The combination of old devices into a new article without producing any new mode of operation is not invention. **Deere & Co. v. J. L. Case Plow Works*, 65 O. G. 441, C. D. 1893.

22. Where the first advance over an eccentric device for moving the valves in a machine consisted in connecting the valves by a walking-beam, but such beam was in itself an old device and any one might have incorporated it in the combination, *held*, that such combination would not, on account of no one having previously used a walking-beam therein, become patentable unless the elements of the combination interacted in the manner set forth in *Bates v. Coe* (15 O. G. 337, 98 U. S. 31). *Tremain v. Curtiss*, 66 O. G. 1447, C. D. 1894.

23. *Quære*, whether, when a machine is designed to manufacture, distribute or serve out to users a certain article, the article so dealt with can be said to be a part of the combination of which the machine itself is another part. **Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.*, 67 O. G. 271, C. D. 1894.

24. When a desired object is attained as a result of the mutual relation and co-operation of the several parts of an application embraced in a claim, said claim is for a combination and not for an aggregation. **American Soda Fountain Co. v. Green*, 76 O. G. 964, C. D. 1896.

25. The Bowers claims are not mere aggregations, because the result produced is the product of the combination in which each element affects the action of all the others, and all of the elements co-operate in the one result of severing by the forward and side action of the machine the material in place where it is not wanted and depositing it in another place where it is wanted. **Von Schmidt v. Bowers*, 80 O. G. 347, C. D. 1897.

26. No combination of elements that so operate can be regarded as a mere aggregation, for each one has a direct influence upon the action of each of the others, the result necessarily being the product of the combination itself and not a mere aggregate of several results each the complete product of one of the combined elements. (Hailes v. Van Wormer, 5 O. G. 89, 20 Wall. 353; Royer v. Roth, 49 O. G. 1987, 132 U. S. 201, 10 Sup. Ct. 58; Reckendorfer v. Faber, 10 O. G. 71, 92 U. S. 347; Beecher Mfg. Co. v. Atwater Mfg. Co., 31 O. G. 306, 114 U. S. 524, 5 Sup. Ct. 1007.) *Id.

27. In a combination of old elements all the parts must so act that each qualifies every other. It is not enough that these independent parts are conveniently associated in one machine if each performs the same function it did before they were united. They must be so connected that the new result is due to their co-operative action. (Bunching Machine Co. v. Williams, 44 Fed. Rep. 191, and cases there cited; Green v. American Soda Fountain Co., 78 Fed. Rep. 119.) *Paul Boyton Co. v. Morris Chute Co., 80 O. G. 1894, C. D. 1897.

III. INVENTION AND SKILL DISTINGUISHED.

28. If to adapt separate elements to each other, so that they can act in one organization, requires the use of means not within the range of mere mechanical skill, then the means of effecting a mutual arrangement of the parts would be patentable. (The Thatcher Heating Co. v. Burtis, 39 O. G. 587, C. D. 1887.)

29. The difficulty of drawing the line between skill and invention considered. The standard of skill is being constantly raised, and the standard of invention is, as a necessary consequent, correspondingly raised. The standard of the date of the alleged invention is that by which the test is to be made. *Wilcox v. Bookwalter Bro. & Co., 39 O. G. 1200, C. D. 1887.

30. Invention may be a discovery or it may be the embodiment, novel and useful, of a mental conception. *Id.

31. The patent system was not designed to protect the chimerical schemes of visionaries or closet theorists. Invention consists in more than the work of the imagination. To conceive of a scheme of vast dimensions is the work of a dreamer; to make the mathematical computations requires the ordinary knowledge of the student; to face the difficulties of construction

and devise means to overcome them, is the true work of the inventor. Ex parte De Bausset, 43 O. G. 1583, C. D. 1888.

32. It is not sufficient that an applicant shall have made a *new* and *useful* article or machine; but he must have made an *invention* or *discovery*. It must be the result of the exercise of the inventive faculty, not simply of the mechanical faculty. Ex parte Devin, 45 O. G. 709, C. D. 1888.

33. The courts have uniformly held that the thing said to be new and useful must be the result of *invention*. A mere change or modification, or a mere shop device which any intelligent artisan or mechanic would suggest or make upon knowing the necessity or requirement, is not an invention within the meaning of the patent law. Ex parte Gibford, 45 O. G. 1557, C. D. 1888.

34. At the time applicant becomes conscious of the fact that there exists in his mental operations and discoveries a distinct process as well as a concrete machine he completes not only the invention of the process, but perfects his knowledge of it, and comes into the status of an inventor who may obtain the security of the patent laws. Ex parte Young, 46 O. G. 1635, C. D. 1889.

35. It is not easy to draw the line that separates the ordinary skill of a mechanic, versed in his art, from the exercise of patentable invention; and the difficulty is specially great in the mechanic arts, where the successive steps in improvements are numerous, and where the changes and modifications are introduced by practical mechanics. *Krementz v. Cottle Co., 48 O. G. 1775, C. D. 1889.

36. To do that which any competent mechanic familiar with devices well known in the state of the art could have done readily and successfully, upon the mere suggestion of the purpose which it was desirable to effect, does not constitute invention. *Aron v. The Manhattan Ry. Co., 49 O. G. 1365, C. D. 1889.

37. It is the province of the inventor to devise, by the exercise of the creative faculty, means for overcoming difficulties which are developed along the lines of theoretical calculation and to demonstrate that that can be done which theorists, basing their computations upon the results of previous experience, have believed to be impossible. Ex parte De Bausset, 50 O. G. 1766, C. D. 1890.

38. Following Ex parte De Bausset (43 O. G. 1583), *held*, that the alleged invention is wholly

theoretical, everything being based upon calculation, and nothing upon trial or demonstration. *Id.*

39. A conception of the mind is not an invention until represented in some physical form, and unsuccessful experiments or projects, abandoned by the inventor, are equally destitute of that character. **Clark Thread Co. v. Willimantic Linen Co.*, 56 O. G. 395, C. D. 1891.

40. The word "invention" cannot be defined in such a manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not. **McClain v. Ortmyer*, 57 O. G. 1129, C. D. 1891.

41. Whoever discovers a previously unknown mode of action in the world of physical things and reduces it to practice, getting a novel product or process within the range of patentable subject-matter, distinctly useful and lying outside the range of experience and skill, makes a patentable discovery, even though the discovery be entirely accidental. *Vollrath v. Comstock*, 59 O. G. 1105, C. D. 1892.

42. Whenever in an art, machine, manufacture or composition of matter a change, however apparently minute, is made which is not obvious and results in marked advantages, a patentable invention has been produced. *Ex parte Champney*, 60 O. G. 1051, C. D. 1892.

43. Changes which turn failure into success and which were not obvious to ordinary mechanical skill constitute invention. **Sayer v. Scott*, 63 O. G. 1818, C. D. 1893.

44. It may be safely affirmed that one who perfects a device of confessed utility, which satisfactorily supplies a long-existing and imperative need of any branch of industry, and which excels in operation and results other existing appliances, superseding them at home and abroad, and by its structure overcoming difficulties and objections which have for years baffled the ingenuity of his fellow-craftsmen the world over, has proved beyond cavil that average mechanical skill was not equal to what he has accomplished. **Consolidated Brake-Shoe Co. v. Detroit Steel & Spring Co.*, 59 Fed. Rep. 902 (1894).

45. It is not the result, effect or purpose to be accomplished which constitutes invention or entitles a party to a patent, but the mechanical means or instrumentalities by which the object sought is attained. (*Rubber Tip Pencil Co. v. Howard*, 20 Wall. 498, 7 O. G. 172; *Ful-*

ler v. Yentzer, C. D. 1877, 218, 11 O. G. 551, 94 U. S. 288.) A patentee cannot so split up his invention for the purpose of securing additional results or of extending or of prolonging the life of any or all of its elemental parts. **Miller v. Eagle Mfg. Co.*, 66 O. G. 845, C. D. 1894.

46. Where the only differences in an applicant's structure over those in the references reside in the skill of its construction, *held*, that such differences embody no exercise of the inventive faculty nor any change not within the range of mechanical ingenuity. *Ex parte Snider*, 66 O. G. 1309, C. D. 1894.

47. The patentee cast solid certain parts which had before been made separate and soldered together, and thus produced a "very strong and durable" electrode which may be "handled without fear of separation." These are not new results, but the ordinary consequences of casting solid, which is well known in the arts. The new results are facts so ordinary, common and immemorial that courts as well as juries must take notice of them. (*Potts v. Creager*, 155 U. S. 597.) **Consolidated Electric Mfg. Co. v. Holtzer*, 67 Fed. Rep. 907 (1895).

48. To make an apparatus portable is not a patentable improvement. **Black Diamond Coal Mining Co. v. Excelsior Coal Co.*, 70 O. G. 1797, C. D. 1895.

49. *Held*, that a device, though a simple one, was a creation of the inventive faculty and not a product of mere mechanical skill, since it provided for a want which had been perceived and felt, but which no one had been able to meet. **Diamond Match Co. v. Schenck*, 71 Fed. Rep. 521 (1895).

50. The right to improve upon prior devices by making solid castings in lieu of construction of attached parts is so universal in the arts as to have become a common one. **Consolidated Electric Mfg. Co. v. Holtzer*, 72 O. G. 415, C. D. 1895.

51. The lowest order of invention is something more than the highest mechanical skill, and the question is not whether a particular or every mechanic could make the improvement, but whether any mechanic might, without invention. **Johnson Co. v. Pennsylvania Steel Co.*, 72 O. G. 594, C. D. 1895.

52. When it requires more than the discernment of the skilled mechanic to ascertain the cause of the defect in an existing machine and the kind of motion and the proper means of applying it to obviate the defect, there is in-

vention. *Smith v. Macbeth, 73 O. G. 619, C. D. 1895.

53. If the idea of furnishing an element to a device was not present to the mind at the time the thing was made, but was an afterthought perceived from subsequent experiences or scientific inspection and analysis, *held*, that there is no invention in thus by accident supplying the means of a function not contemplated. *Wells v. Curtis, 74 O. G. 495, C. D. 1896.

54. Mere change of proportion is not sufficient to establish difference of invention. *Thomson-Houston Electric Co. v. Western Electric Co., 75 O. G. 347, C. D. 1896.

55. An invention does not cease to be meritorious because it is simple. The test should not be whether the mechanism is simple or complex, but whether the patentee has given the world something new, whether the public is richer for his contribution to the art, whether he has produced novel and beneficial results. Invention should be determined more by an ascertainment of what the inventor has actually accomplished than by a technical analysis of the means by which the result is attained. *Gould Coupler Co. v. Pratt, 75 O. G. 1547, C. D. 1896.

56. Not every change or improvement is patentable invention, and the merits of the exercise of the inventive faculty must be refused to such things as are plainly within the scope of mechanical ingenuity. *Draper v. Seymour, Com'r of Patents, 79 O. G. 864, C. D. 1897.

57. Notwithstanding that appellant's device may be superior in finish, neater in its appearance, and generally better accommodated for the uses for which it is intended than the devices which it is said to have displaced, yet it is not a patentable device. *Id.

58. The matter of elastic suspension by springs and of otherwise giving either entire or partial support is so common in the arts that the presumption is against the patentability of any such mere form of suspension. The selection of a form of support is in the common field of mechanical construction. *Thomson-Houston Electric Co. v. Athol and Orange Street R. Co., 81 O. G. 969, C. D. 1897.

59. It may be that for any established art or any subdivision of any special art there would be invention in so adapting or shaping guides, gouges, packing-boxes or any other common tools and means as to adapt them to the special art or to the special subdivision; but whoever does this cannot, where the field is so common, encroach on any other person's special art or

subdivision. *Bates v. Keith, 81 O. G. 1115, C. D. 1897.

60. To change the form of a pin from a round shank with a button-head to a square-shanked pin with an oblong head to overcome a defect in operation was simply a matter of variation in construction and not affecting the substance of the invention claimed, and such change or variation in form could be made by mere mechanical skill, without the exercise of the faculty of invention, in order to render more perfect the operation of the original device. (Pickering v. McCullough, 21 O. G. 73, 104 U. S. 319.) *Hien v. Buhoup, 81 O. G. 2087, C. D. 1897.

61. Form and proportions may sometimes involve patentable invention. (Winans v. Denmead, 15 How. 330; Mabie v. Haskill, 2 Cliff. 507.) *Lovell v. Johnson, 82 Fed. Rep. 206 (1897).

("Now that it has succeeded, it may seem very plain to any one that he could have done it as well. This is often the case with inventions of the greatest merit.") *Coon Co. v. Higgins, 21 O. G. 2031.

Whether invention is involved in a particular case must depend upon the facts and circumstances of the latter. *Buttes v. Bainbridge, 29 Fed. Rep. 142 (1886).

For decisions of the United States supreme court determining what degree of development of thought or experiment constitutes invention, see cases cited in American Sulphite Pulp Co. v. Howland Falls Pulp Co., 70 Fed. Rep. 998.

"Invention is evidenced from the long-existing evil which was thereby remedied, and which would have been cured long since in the art, had it depended simply on mechanical skill." *Eppinger v. Richey & Bouiface, 12 O. G. 712, C. D. 1877.

When an inventor merely brings an old element into his machine he makes no invention; but where he does more — dispenses with certain parts, duplicates others, re-arranges and simplifies the machine — he must be held to have made an invention. *Mundy v. Lidgerwood Mfg. Co., 27 O. G. 718, C. D. 1884. See, also, *Dederick v. Caselli, 20 O. G. 1233; In re Jackson, 1 MacAr.'s Pat. Cases, 485; *Crandall v. Watts, 21 O. G. 945.

A single change, which others failed to discover, and which remedied a grave defect, *held* to constitute a patentable difference. *Adams v. Howard, 26 O. G. 823, C. D. 1884.

The degree of inventive skill is immaterial. *Forbush v. Cook, 2 Fish, 608, 1857.)

IV. INVENTION AND SUGGESTION DISTINGUISHED.

62. The mere suggestion of a use for an invention is not sufficient to make the suggester a joint inventor with the person who invented the device. Logan v. Ringlander, 42 MS. D. (2 G. W. D.), Jan., 1890 (Mitchell, Com'r).

63. Suggestion is not invention. Over twenty years before Bell's invention of the telephone, an eminent scientist had said, "reproduce pre-

cisely these vibrations," to wit, the vibrations made by the human voice in uttering syllables, "and you will produce precisely the syllables;" yet Boursuel neither claimed nor invented the telephone. Whether a suggestion may be styled a "principle" or an "idea," it is a mere abstraction and unpatentable. (Cases cited.) *Consolidated Brake-Shoe Co. v. Detroit Steel & Spring Co., 59 Fed. Rep. 902 (1894).

64. Neither invention nor novelty is negated by proof of the pre-existence of suggestion, as distinguished from practically available description; and neither is disproved by showing, after the invention in question has been made known, that its object might be obtained by adapting and uniting some of the components of prior inventions in a manner and for a purpose which had not been contemplated. *Diamond Match Co. v. Schenck, 71 Fed. Rep. 521 (1895).

(If suggestion furnishes all the information necessary to enable the patentee to construct the improvement, the patent may be invalidated. *Pitts v. Hall (1851), 2 Blatch. 229 (Judge Nelson). The entire invention must be suggested. *Celluloid Mfg. Co. v. Chrolithion Collar & Cuff Co., 23 Fed. Rep. 397 (1885).

Mere suggestions are not sufficient to constitute an invention. They must leave nothing for the mechanic to do but to work out what has been suggested. Hall v. Johnson, 23 O. G. 2411, C. D. 1883 (Marble, Com'r). See decision of United States supreme court in O'Reilly v. Morse, 15 How. 62.)

V. EVIDENCE OF EXTENSIVE USE.

65. The general introduction and use of driven wells since the date of Green's patent strongly corroborate the supposition that their construction and mode of operation are based upon the application of some natural force not previously known or used. *Eames v. Andrews, 39 O. G. 1319, C. D. 1887.

66. Where the manufacture under the patent had been extensive for several years, where numerous licenses had been granted under it, where the hat manufacturer almost universally had recognized the validity of it, where prior suits had been settled by the defendants in such suits taking licenses, the acquiescence in the validity of the patent may be regarded as established. *Hat Sweat Mfg. Co. v. Davis Sewing Machine Co., 41 O. G. 1273, C. D. 1887.

67. The circumstance that Shipman's apparatus immediately commended itself to the public is persuasive that what he did by way of improvement was not such an obvious thing as to deprive it of the merit of invention.

*Shipman Engine Co. v. Rochester Tool Works (Limited), 44 O. G. 1067, C. D. 1888.

68. The utility of the invention is inferentially established by large sales of the patented article. *Schneider v. Missouri Glass Co., 45 O. G. 1069, C. D. 1888.

69. Public acceptance of an invention is persuasive, and warrants a court in sustaining a patent if no anticipating structure is shown. *Chicopee Folding Box Co. v. Nugent, 41 Fed. Rep. 139 (1889).

70. The popularity of a patented device, attested by large and rapidly increasing sales, is an inducement to the court to lean towards a favorable construction of the patent. *Stearns v. Phillips, 43 Fed. Rep. 792 (1890).

71. Where a patented improvement possessed such marked utility and so speedily and universally came into public use as the Pullman vestibule system, *held*, that the court should hesitate to declare the patent invalid for want of utility, because these circumstances tended strongly to prove invention. *Pullman's Palace Car Co. v. Boston and Albany R. Co., 53 O. G. 1255, C. D. 1890.

72. Facts that the Gately packing went at once into such extensive use as almost to supersede all packings made under other methods, and that, although the cost of production was less, the market price was higher for the Gately than the old packings, commented upon as evidence of novelty, value and usefulness. *Magowan v. New York Belting and Packing Co., 57 O. G. 845, C. D. 1891.

73. While in a doubtful case the fact that a patented article has gone into general use is evidence of its utility, it is not conclusive even of that, much less of its patentable novelty. *McClain v. Ortmyer, 57 O. G. 1129, C. D. 1891.

74. Where the question is upon the patentable character of the invention, evidence that it had practically superseded all other devices of its kind and tending to establish novelty is not material. Where there is no invention, the extent of use is not a matter of moment. *Adams v. Ballaire Stamping Co., 57 O. G. 1280, C. D. 1891.

75. The facts that the Dunlop tire was the first one to be commercially adopted, and that the first year after it was put on the market over one hundred thousand were sold in Great Britain, even if the question of patentable novelty were a doubtful one, would go far towards resolving that doubt in favor of the patentee. (Cases cited.) *Featherstone v. George R. Bidwell Cycle Co., 53 Fed. Rep. 113 (1892).

76. The allegation that an improvement claimed to be patentable was simple and perfectly obvious is negated by the fact that up to the time of its discovery a more expensive compound was in general use. *Ex parte Sommer*, 58 O. G. 1255, C. D. 1892.

77. Where several inventors are striving for the same end and all of them fall just a little short of its attainment, the existence of that state of facts is practically conclusive evidence that he who attains the whole measure of success does so by doing something that was not obvious, and that involves patentable invention. *Ex parte Shannon*, 59 O. G. 297, C. D. 1892.

78. The fact that a device has gone into extensive public use is entitled to great weight in determining the question of patentable novelty. **Dederick v. Gardiner*, 59 O. G. 790, C. D. 1892.

79. Where there had been several unsuccessful attempts to produce a satisfactory article in the trade, and the plaintiff, who had been experimenting with the subject for years, finally produced a device which when patented was at once largely adopted and went into and remains in general use, *held* sufficient evidence of novelty and utility. **Gandy v. Main Belting Co.*, 59 O. G. 1106, C. D. 1892.

80. Where the question of patentable novelty in a device sued upon is not free from doubt, a general and extensive use by the public will incline the court to resolve the doubt in favor of the patent. **Topliff v. Topliff*, 59 O. G. 1257, C. D. 1892.

81. In determining what constitutes invention and what is a "new and useful result," a "new function" or a "new sphere of action," the court will give weight to facts showing (1) that the improvement, though desired for years, was not secured until brought out by the patentee; (2) that the product of the improved machine or process displaced wholly or in a great degree prior products; (3) that while the prior products had been unsuitable from lack of cheapness or adaptation the new product answered all reasonable requirements. **Watson v. Stevens*, 60 O. G. 1884, C. D. 1892.

82. Where a complainant was an extensive manufacturer, engaged in the special trade to which the patent sued upon relates, yet testified that he had held the patent for seven years but had never put upon the market a chair constructed to conform to it, *held* of great weight in determining the question of

"invention" from the standpoint of utility. **Waite v. Robinson*, 60 O. G. 1888, C. D. 1892.

83. Large sales of a patented machine, while evidence more or less cogent of value and usefulness, are not conclusive evidence of patentable novelty and are of little weight when it appears that such sales are the result of active and energetic efforts by means of circulars and traveling agents. (*McClain v. Ortmyer*, 57 O. G. 1129, 12 Sup. Ct. Rep. 76, 141 U. S. 427-429, followed.) **Fox v. Perkins*, 62 O. G. 160, C. D. 1893.

84. The fact that a machine is capable of doing more work and at less expense than prior devices, while persuasive, is by no means decisive, and is only available to turn the scale in cases of grave doubt respecting the validity of the invention. **National Hat Pouncing Machine Co. v. Hedden*, 63 O. G. 466, C. D. 1893.

85. The fact that a patented article has gone into general use is evidence of its utility, but is not conclusive of that, and still less of its patentable novelty. (*McClain v. Ortmyer*, 57 O. G. 1129, 141 U. S. 419, 425, and authorities there cited.) **Grant v. Walter*, 63 O. G. 910, C. D. 1893.

86. The fact that a patented device gains immediate popularity, meets with large sales, and stimulates the activity of business competitors to produce an equally useful and popular device is an unsafe criterion in determining the question of patentability, and can at most only suffice to turn the scale in favor of the patentee when the question is one of doubt. **Duer v. Corbin Cabinet Lock Co.*, 63 O. G. 1060, C. D. 1893.

87. The popularity of a patented device may be the result of a more attractive appearance, a more perfect finish, more extensive advertising, larger discounts in price, or greater energy in pushing sales, and even though due to greater usefulness or a particular demand for such a device at the time it is put upon the market, such device does not necessarily contain any patentable feature of construction. **Id.*

88. Utility is established by sales which, since the adoption of the improvement claimed, have increased from three hundred to ten thousand or twelve thousand per annum. The patent seems to fall within the settled rule that where a number of persons have all been engaged in repeated, but unsuccessful, efforts to accomplish a certain result, and one of them finally succeeds and secures a patent therefor, the courts will not be inclined to adopt such a narrow con-

struction as would be fatal to the validity of such patent. (Cases cited.) *Stahl v. Williams, 64 Fed. Rep. 121 (1894).

89. When the question is whether the patented device exhibits patentable invention, the fact that it is has gone into general use and displaced other like devices is always of importance and entitled to weight. (Smith v. Good-year Dental Vulcanite Co., 11 O. G. 246, 93 U. S. 495.) *Keystone Mfg. Co. v. Adams, 66 O. G. 654, C. D. 1894.

90. Where the change in the patented hook is beneficial and embodies a new and better mode of operation; where numerous other patents have issued for hooks between the dates of invention of the alleged anticipating hooks and the patented hook, without its having occurred to those skilled in the art to make the change; where the best of the prior inventions met with only moderate success, and where the patented hook has great utility, extensive public use, and marked commercial success, *held*, that these considerations are sufficient to resolve any doubt on the question of patentability in favor of the patentee. *Richardson v. Shepard, 67 O. G. 144, C. D. 1894.

91. A pipe-cutter was seemingly without patentable invention; but it was shown that sales thereof had increased from three thousand nine hundred and twenty-six in 1885 to ten thousand seven hundred and twenty-seven in 1891. There was nothing to show to what extent price, workmanship, liberal discounts to dealers and extensive advertising had contributed to the success in introducing the tool. It appeared, also, that an old form of cutter still remained in very general use, and that there was a strong competitor in another patented cutter. *Held*, that the increased use was not sufficient to show patentable invention. *Saunders v. Allen, 67 O. G. 1330, C. D. 1894.

92. In a suit on a patent, when the other facts leave the question of invention in doubt, the fact that the device has generally displaced other devices of its kind on its merits, *held* to be sufficient to turn the scale in favor of invention. *Krementz v. S. Cottle Co., 69 O. G. 241, C. D. 1894.

93. While the patented article may have been popular and met with large sales, *held* those facts are not important when the alleged invention is without patentable novelty. (Citing Duer v. Lock Co., 63 O. G. 1060, 149 U. S. 216.) *Olin v. Timken, 69 O. G. 1361, C. D. 1894.

94. Where the record shows that plaintiff's device was novel in construction, that it was useful, and that it went into immediate and general use, the appellate court cannot hold that the jury should have been instructed that there was no invention therein. *Holmes v. Truman, 73 O. G. 448, C. D. 1895.

95. Extensive recognition by the public, large sales, and the fact that manufacturers have generally taken license under the patent, are potential facts largely influencing the judgment of the court. *Robbins v. Dueber Watch Case Mfg. Co., 74 O. G. 965, C. D. 1896.

96. The facts that a patented device was the first successful device and is of the greatest utility, and the further facts of long-continued use and public acquiescence, confirm the presumption of invention in the patent and entitle it to favorable consideration. *A. B. Dick Co. v. Henry, 75 O. G. 1204, C. D. 1896.

97. Invention cannot be predicated upon popularity alone. *Ypsilanti Dress Stay Mfg. Co. v. Van Valkenburg, 76 O. G. 333, C. D. 1896.

98. Where the patentability of a device is not clear, extensive sales may resolve the doubt of patentability in favor of an applicant. This, however, is an unsafe criterion and must be cautiously applied. *Ex parte Flomerfelt*, 76 O. G. 2007, C. D. 1896.

99. The fact that a machine has met great favor and general acceptance in the trade can have no persuasive force in view of the prior art, which limits the claim simply to the exact combination specified. *Rowlett v. Anderson, 76 Fed. Rep. 827 (1896).

100. Extensive use is only to be considered evidence of invention in doubtful cases, and it loses its force when attributable to another device used in connection with the alleged invention and which was useful and popular. *Dueber Watch Case Mfg. Co. v. Robbins, 77 O. G. 154, C. D. 1896.

101. That an invention has readily overcome initial distrust and disfavor, has had a phenomenal growth, and has acquired widely-extended mechanical and commercial success, are facts which testify powerfully to the novelty of the invention. *Dodge v. Post & Co., 78 O. G. 339, C. D. 1897.

102. The fact that the patentees are the first in an art in which there are many inventors and the fact that their device is the only one now used are significant of invention. *Fairbanks Wood-Rim Co. v. Moore, 79 O. G. 514, C. D. 1887.

VI. EVIDENCE OF RESULT.

103. A patent for a device or process used for one purpose cannot be patented to use in the same way for another similar purpose; but where a new and useful result is produced thereby it is patentable. *Byerly v. Cleveland Linseed Oil Works, 31 Fed. Rep. 73 (1887).

104. Shipman combined in effectual relations an automatic regulator, which was not novel in itself, with the atomizers of earlier patents. This combination presents one test of patentable invention if it produced a new result due simply to the combination. *Shipman Engine Co. v. Rochester Tool Works (Limited), 44 O. G. 1067, C. D. 1888.

105. A change in the method of making an article of manufacture producing a different and beneficial result, although the difference consists only in improving or cheapening the article, and the change and its advantages not having been seen or made by others interested in seeing and making it, is sufficient evidence of invention to sustain a process patent. *Zinsser v. Kremer, 48 O. G. 114, C. D. 1889.

106. A conceded difference of construction between the device claimed and the references cited, together with a clear advantage as a result of it, constitutes patentable novelty. *Ex parte Scriven*, 57 O. G. 1128, C. D. 1891.

107. When a change however minute is made which was not obvious and results in marked advantages, and when such a change has remained unmade for a considerable time, in spite of inducements to make it by reason of its value, that is evidence approaching the conclusion that change was not obvious. *Ex parte Champney*, 60 O. G. 1051, C. D. 1892.

108. A combination producing a group of useful results held not to be anticipated by several prior combinations of some of the elements, each producing some, but not all, of said results, the superiority of the patented device over the prior devices resulting not from any particular part or element, but rather from the combination and arrangement of the parts as a whole. (Affirming 50 Fed. Rep. 542.) *Illinois Watch Co. v. Robbins & Avery, 61 O. G. 721, C. D. 1892.

109. The fact that a device has utility and will perform that which no prior device will do is evidence of patentable novelty, and in a doubtful case will turn the scale in favor of the patentee. *Sayre v. Scott, 63 O. G. 1818, C. D. 1893.

110. Simplicity in change of constructions

does not negative patentability where the change produced a new and beneficial result never attained before. *American Cable Ry. Co. v. Mayor, etc. of City of New York, 64 O. G. 1008, C. D. 1893.

111. A change of form and proportions may be patentable where new result is produced. *Front Rank Steel Furnace Co. v. Wrought Iron Range Co., 72 O. G. 288, C. D. 1895.

112. Where it appears that all the elements of the combination claimed in the patent are old, but a new and valuable result has been obtained, the safety and efficiency of the machine greatly enhanced, and the profits resulting from its operation greatly increased, held, that the combination itself displays invention. *United States Printing Co. v. American Playing Card Co., 72 O. G. 1409, C. D. 1895.

113. A patent for the re-use of previously-cooled slag, which consists of remelting it with lime (or with silica, or with both) and then converting the mixture into mineral wool, is not anticipated by processes which consist in using slag before it has cooled, for the same purpose, when it appears that the patentee was the first to use successfully previously-cooled slag and when it appears that his product is superior to the former product. *Western Mineral Wool and Insulating Fibre Co. v. Globe Mineral Wool Co., 77 O. G. 1127, C. D. 1896.

114. Simplicity does not negative invention, when a new and useful result is accomplished, where the process has clearly assisted in the manufacture of the product, and where, if the process were to be eliminated from public knowledge, loss to the public would result. *Id.

("If a new and useful result is produced, neither the simplicity of the structure nor the greater or less amount of invention or intellect employed as an element are of importance in determining the validity of the patent." *Teese v. Phelps*, 1 McAll. 48.)

("A change made in an old device, which though simple is effective, and produces a new and useful result, held to involve invention." *Sewing Machine Co. v. France*, 24 Fed. Rep. 500.)

VII. UTILITY.

115. The office is bound to raise the question of utility of an alleged invention in cases where natural laws and established principles are disregarded, for the reason that the law does not authorize the grant of letters patent except for novel and useful inventions. In such cases, even if novelty were admitted, a patent would be withheld until applicant should demonstrate the operativeness of his de-

vice. *Ex parte* statements or theoretical arguments are not sufficient; applicant must prove by practical demonstration his assertions. *Ex parte De Bausset*, 43 O. G. 1583, C. D. 1888.

116. The patent office is bound to take notice of the question of utility, and the grant of a patent is assurance to the public of the favorable conclusion of the office thereon. *Id.*

117. The patent for a "toy automatic race-course," used only for gambling purposes in saloons, bar-rooms and other drinking places, is not "useful" in the sense of the statute. The term "useful" is applied to inventions which are of beneficial use in society in contradistinction to those which are injurious to the morals, health or good order of society. (Following *Bedford v. Hunt*, 1 Mason, 302.) **National Automatic Device Co. v. Lloyd*, 40 Fed. Rep. 89 (1889).

118. In an application for an inflatable uterine supporter the examiner required cancellation of a figure; on petition the commissioner said, in substance, that the case appeared to be presented and prosecuted in such an unseemly manner that the applicant was entitled to nothing. Therefore the application was ordered stricken from the files. *Ex parte Nelson*, 58 MS. D., Jan., 1896 (Seymour, Com'r).

119. The degree of utility of a device is unimportant in determining whether a device be patentable. If the invention is not frivolous or prejudicial to the public and has any degree of usefulness, no matter how slight the practical utility, then within the meaning of the law it is useful and may be patented. *Ex parte Sanche*, 80 O. G. 185, C. D. 1897.

120. The degree of utility is not a question for the patent office to arbitrarily determine. The mere assertion of theorists that they do not believe that a device possesses utility cannot prevail against the evidence of reliable witnesses who have by tests demonstrated that it does possess such utility as is claimed for it. *Id.*

121. Letters patent for improvements in coin-controlled apparatus, *held* invalid for want of utility, as the only use to which the inventions have been put or applied is for gambling purposes. **Schultze v. Holtz*, 81 O. G. 2249, C. D. 1897.

122. A statement in a verified answer that complainant's invention is used only for gambling purposes in saloons and bar-rooms and cannot be used for any other purpose is sufficient evidence of want of utility, in the absence of testimony supporting the patent, to over-

come the *prima facie* case made by the patent itself. **Id.*

(See *Mitchell v. Tilgham*, 19 Wall. 287, 5 O. G. 299, for definition of utility.)

VIII. BURDEN OF PROOF ON APPLICANT.

123. Where an applicant for a patent upon a method of telephonic transmission, having described his apparatus, claimed in various forms of statement the method of reproducing articulate speech as well as other sounds by intermittent impulses of electricity, *held*, that the burden was upon the applicant to show, *first*, that his apparatus made and broke the circuit while operating to transmit speech; and *second*, that it was because of the make-and-break characteristic that articulate speech was reproduced; and *held*, that if the first proposition had been established the applicant had failed to establish the second; and *held*, that the opinion of the experts of the office that the effect of reproducing speech was due to varying pressure, the initial contacts having been established, and not to the "fine staccato punctuations or discontinuities," must prevail. *Ex parte Barney*, 53 O. G. 1569, C. D. 1890.

124. The burden is upon the applicant to establish, by proof that is clear and conclusive, the patentability of the invention as claimed. **Durham v. Seymour*, Com'r of Patents, 71 O. G. 601, C. D. 1895.

125. In an application for a patent the onus of showing that all the conditions and provisions of the law have been fully complied with, making it appear that the inventor is justly entitled to a patent under the law, and showing that the invention is sufficiently useful and important to justify the issue of a patent, is upon the applicant. **Drawbaugh v. Seymour*, Com'r of Patents, 77 O. G. 813, C. D. 1896.

IX. NOVELTY AND INVENTION.

(a) *New Use or Adaptation.*

126. The purpose, object and result of the application of heat in the method described in the patent differing from that before employed in the manufacture of other kinds of springs made such method patentable. **Cary v. Lowell Mfg. Co. (Limited)*, 40 O. G. 1239, C. D. 1887.

127. The promotion of an old device to a new sphere of action, in which it performs a new function, involves invention, but the transfer or adaptation of the same device to a sim-

ilar sphere of action, where it performs substantially the same function, does not involve invention. *Western Electric Co. v. La Rue, 55 O. G. 571, C. D. 1891.

128. If an old device or process be put to a new use which is not analogous to the old one, and the adaptation of such process to the new use is of such a character as to require the exercise of inventive skill to produce it, such new use will not be denied the merit of patentability. *Ansonia Brass and Copper Co. v. Electrical Supply Co., 58 O. G. 1692, C. D. 1892.

129. It is not sufficient to constitute anticipation that the device relied upon might by modification be made to accomplish the function performed by the patent in question if it were not designed by its maker, nor adapted, nor actually used for the performance of such functions. *Topliff v. Topliff, 59 O. G. 1257, C. D. 1892.

(See, also, Westinghouse v. New York Air Brake Co., 59 Fed. Rep. 581; Telephone Co., 57 Fed. Rep. 842; New Departure Bell Co. v. Bevin Bros. Mfg. Co., 61 Fed. Rep. 631, 1895.)

130. An adaptation of an old machine to the new purpose which was proposed almost simultaneously by three distinct and independent parties by an alteration of mechanism slightly different structurally, but the same in principle in each case, is evidence that such change was obvious and did not involve invention. *Bromley Brothers Carpet Factory v. Stewart, 61 O. G. 1481, C. D. 1892.

131. Where the novelty of an invention resides in the particular form adopted, it is not negated by prior structures in another art which are not capable of doing its work, though afterward, in the light of that invention, they can be modified to perform its function. *Knickerbocker Co. v. Rogers, 67 O. G. 1448, C. D. 1894.

132. When re-adaptation—a decided change of form—is essential to success of a machine in its changed use, invention is inferable. *Id.

133. The patentee sewed the edges of celluloid sheets between leather bindings so that they were held by the stitches. It was a discovery that they could be thus sewed and held. This does not appear to be a merely mechanical double use, but a new use brought about by contrivance, experiment and adaptation. Such use held patentable. (Citing Potts v. Creager, 155 U. S. 597, 15 Sup. Ct. 194.) *Collins v. Gleason, 68 Fed. Rep. 915 (1895).

134. The bringing together, adapting in size, proportion and relation, and so inclosing parts

as to form a tool capable of guidance by the hand in drilling, involves invention over prior like parts operating by steam or air in engines of various sorts. (Citing Potts & Co. v. Creager, 155 U. S. 597.) *American Pneumatic Tool Co. v. Fisher, 69 Fed. Rep. 331 (1895).

135. Where the alleged novelty consists in transferring a device from one branch of industry to another, the answer depends upon a variety of considerations. In such cases we are bound to inquire into the remoteness of relationship of the two industries; what alterations were necessary to adapt the device to its new use, and what the value of such adaptation has been to the new industry. If the transfer be to a branch of industry but remotely allied to the other, and the effect of such transfer has been to supersede other methods of doing the same work; the court will look with a less critical eye upon the means employed in making the transfer. *Potts & Co. v. Creager, 70 O. G. 494, C. D. 1895.

(In this important case, upon newly-discovered evidence, a new trial was granted by the circuit court without leave obtained from the supreme court, and the patent declared invalid. (See 80 O. G. 196, C. D. 1897.) The case was again taken to the supreme court and the action of the circuit court criticised as unauthorized and irregular, and as good ground for *mandamus*. See "Mandamus;" In re C. & A. Potts & Co., 78 O. G. 2047, C. D. 1897.)

136. Combinations of parts in a clay-disintegrator are not anticipated by a cylinder with cutting-blades in its periphery for grinding apples, nor by a cylinder for preparing paper, nor for polishing wood, nor by such like devices in other arts which were not used for a purpose analogous to that in the patent nor operated in the subject-matters in a way like that of the patented apparatus. *Id.

137. Where the devices alleged to anticipate the patented device were not designed to meet nor subjected to conditions analogous to those of the patented thing, *held*, that such prior structures did not anticipate the patented device. *National Meter Co. v. Thompson Meter Co., 70 O. G. 925, C. D. 1895.

138. Where the divergence between the uses of two devices is so radically extreme, the conditions so radically different, and the difficulties so peculiar to the one that the adaptation of what was useful in one sphere to use in another would possibly require more inventive faculty than the creation of something novel in itself, the new adaptation is not double use. (Potts v. Creager, 70 O. G. 494, 155 U. S. 607,

cited.) *Taws & Hartman v. Laughlin & Co., Limited, 73 O. G. 287, C. D. 1895.

139. A new combination and arrangement of old parts, whereby spinning-spindles instead of running in rigid bearings are flexibly mounted on the rails, so as to allow of greatly-increased speed of revolution, *held* to involve invention and not to be anticipated by the use of similar devices in centrifugal machines for drying sugar or creaming milk. The two devices are so different in size, structure and uses to which they are adapted that it is not a case of double use. (Potts & Co. v. Creager, 70 O. G. 494, 15 Sup. Ct. 194, 155 U. S. 607, applied.) *Taylor v. Sawyer Spindle Co., 77 O. G. 452, C. D. 1896.

140. Under the decision in Potts v. Creager (70 O. G. 494, 155 U. S. 597), power picks and plows are not anticipations for a mining machine, since they do not belong to related arts. *Independent Electric Co. v. Jeffrey Mfg. Co., 78 O. G. 797, C. D. 1897.

141. Novelty is not negatived nor overcome by showing prior construction of a similar thing for a wholly different and foreign use not suggestive of the particular use to which the patented invention is applied. (Cases cited.) *Kinneer & Gager Co. v. Capital Steel-Metal Co., 81 Fed. Rep. 491 (1897).

142. A patent for a panel or ceiling section stamped from sheet-metal plates cannot be defeated by showing a continuous sheet in a bird-cage bottom, or tea-tray, coal-vase cover, etc. The only resemblance is in the merest outline of form, and there is not the slightest resemblance suggested in the end accomplished, or in the uses to which the two things are applied. *Id.

143. An invention, whether original or an improvement, is not anticipated by a thing which was in its original form and use neither designed, adapted nor actually used to perform the same function; nor by showing a prior construction of a similar one for a wholly different and foreign use. (Cases cited.) *Id.

144. An old device or process put to a new or non-analogous use, and the adaptation to the new use requiring the exercise of inventive skill, patentability is involved. *Ansonia Brass & Copper Co. v. Electrical Supply Co., 144 U. S. 11, 12 Sup. Ct. 601.

(b) *Process and Method.*

145. Where a process is capable of being carried on by a variety of apparatus, the validity of the claim is not affected by the want of

novelty in the apparatus if the process is new and produces a new result. *New Process Fermentation Co. v. Maus, 39 O. G. 1419, C. D. 1887.

146. A process may be patentable irrespective of the particular form of instrumentalities used. *Eastern Paper Bag Co. v. Standard Paper Bag Co., 41 O. G. 231, C. D. 1887.

147. The omission of one step of an old process with improved result constitutes a new process. *Lawther v. Hamilton, 42 O. G. 487, C. D. 1888.

148. Where the new process requires greater care, or even greater skill, on the part of the workmen than formerly, it does not change its character as a process or materially affect its utility. *Id.

149. Where it appeared that the process embraced in applicant's claim was such that it could be performed by certain machines other than that disclosed in his application, that it could be performed by hand, and that the said process was invented before the machine which which carried it out, *held*, that such process was patentable and was not the mere function of the machine, regardless of the fact that applicant has an application pending covering the machine. (Following *Ex parte Young*, 46 O. G. 1635.) *Ex parte Kerr*, 53 O. G. 919, C. D. 1890.

150. If one of the steps of a process is novel for the purposes in hand, it gives novelty to the process considered as a whole. *Ex parte Kalteyer and Bartholomew, Jr.*, 57 O. G. 1127, C. D. 1891.

151. Where the essential feature of the improvement is the method of manufacturing structural material by working the material from the center toward the ends consists in operating upon all parts of the cross-section of the material at every pass, and the best mode of applying the improvement is explained in connection with the applicant's machine for rolling structural material, and the references only indirectly disclose methods for shaping round and convex forms in the art of rolling iron bars, *held*, that the method is not the mere function of applicant's machine nor a discretionary variation of the well-known practices indicated by the references. *Ex parte Buiz*, 67 O. G. 677, C. D. 1894.

152. Passing upward through falling impurities and flour commingled a current of air purified by centrifugal action, then subjecting the dust-laden air to centrifugal action, and finally passing the air so purified back to be used again and again in the same series of

steps, all in closed chambers and conduits, constitute a true process. *Ex parte Holt*, 68 O. G. 536, C. D. 1894.

153. Such process is patentable over one consisting of the same steps except that the purification of the dust-laden air is effected by the agency of a setting-chamber in place of a vortex-chamber. *Id.*

154. It is patentable over a process consisting of the first and second steps followed by the discharge of the purified air in the mill instead of its use over and over again in a closed circuit. *Id.*

155. It is patentable and is not the mere function of a machine, although but one apparatus is known or suggested for carrying the process out, and that the one patented to this applicant, the process and the apparatus having been originally in one and the same application. *Id.*

156. The cooking of various grains and crushing or otherwise breaking or dividing while in a soft state were old and well-known processes. The patentee prepared peas by cooking them, and flattening them while moist, without breaking them, thus changing their normal shape and preserving their individuality. Patent held valid. **Everett v. Haulenbeck*, 68 Fed. Rep. 911 (1895).

157. Processes of manufacture which involve chemical or other similar elemental action are patentable, though mechanism may be necessary in the application or carrying out of such processes. **Risdon Iron and Locomotive Works v. Medart*, 71 O. G. 751, C. D. 1895, 158 U. S. 68.

158. Where mechanism to carry out a process is subsidiary to the chemical action, *held*, that the fact that the patentee may be entitled to a patent upon his mechanism does not impair his right to a patent for the process, since he would lose the benefit of his real discovery, which might be applied in a dozen different ways, if he were entitled to such patent. **Id.*

159. A process of reducing fibrous sheets to a soft and pliable condition by first moistening and then pounding the sheets while in a moist condition is not a mere mechanical process or an aggregation of functions within the limitation announced by the supreme court in the case of *Risdon Iron and Locomotive Works v. Medart* (71 O. G. 751, 158 U. S. 68). The moistening of the sheets and the treatment in a moistened condition is more or less chemical in its character. **American Fibre Chamois Co. v. Buckskin Fibre Co.*, 75 O. G. 833, C. D. 1896.

160. A process of spotting tobacco leaves, whereby they resemble Sumatra tobacco leaves, *held* to be a useful invention or discovery and entitled to a patent. *Ex parte Rickard & Long*, 62 MS. D., July, 1887 (Butterworth, Com'r).

(c) *Particular Cases.*

161. Wooden troughs with a covered float and valve at one end were old, and iron troughs with a standing supply-pipe and an overflow were old. The trough of complainant having a supply-pipe and an incased valve and float so arranged that the inflow of water came from the bottom of the trough through openings in the case involved patentable invention. **North American Iron Works v. Fiske*, 39 O. G. 1086, C. D. 1887.

162. The problem which confronted the patentee he solved by simple means, it may be, but successfully and with highly beneficial results. The problem was new, and its successful solution was not obvious. **Hussey Mfg. Co. v. Deering*, 40 Fed. Rep. 87 (1889).

163. The substitution in an evaporating apparatus of comparatively short parallel tubes for the old coils of pipe, and the addition of a separating-chamber into which they discharge both the liquid and vapor, with provision for an equal supply to each of the tubes, together with other changes from the old devices of less consequence, declared to constitute patentable novelty. **Sugar Apparatus Mfg. Co. v. Yaryan Mfg. Co.*, 53 O. G. 920, C. D. 1890.

164. Steel springs made of flat sheet steel have been used in a manner to give a torsional spring action. *Held*, that they did not anticipate spiral springs which operate on a straight line, tilt or draw, and have a regular yield. The two springs belong to different classes, and the flat spring has not been successful. **Rocker Spring Co. v. Flinn* (six cases), 46 Fed. Rep. 109 (1891).

165. The difference between plaintiff's wick carrier and all others produced is small, but it is an essential and useful difference, and therefore patentable. **Wilson v. Ansonia Brass & Copper Co.*, 48 Fed. Rep. 681 (1891).

166. The use of a coiled spring in an angler's fly-book for holding the flies is not anticipated by a leaf spring adapted to hold one fly each. It performs new and useful functions in its new relation. Bray's fly-book has displaced the old ones by reason of its superiority. **Bray v. United States Net and Twine Co.*, 70 Fed. Rep. 1006 (1895).

167. A foot-board in a row-boat curved upward at an angle of about forty-five degrees, *held* to be a patentable invention, despite the common practice of turning up or curving of foot-rests, in view of the facts that what the patentee accomplished by this simple expedient had not occurred to other experimenters, and that it came into general use after it had been suggested by him. *Davis v. Parkman, 71 Fed. Rep. 961 (1895).

168. The Brown and Stillman patent No. 488,494, dated December 20, 1892, for a pneumatic tire containing an inflatable tube and made inextensible circumferentially by means of circumferential reinforcements along two lines within the edges and above the bottom of the groove, whereby the tire is made to seat itself on inflation and the necessity for mechanical connection with the rim is obviated, construed as to the first claim, which is *held* to show patentable invention and to be infringed by the Moomy patent, No. 513,617, of January 30, 1894. *American Dunlop Tire Co. v. Erie Rubber Co., 74 O. G. 963, C. D. 1896.

169. A construction which consists in giving the holes in a gas-heater a downward inclination, when such construction is attended by greater efficiency, is patentable over the prior art, which consisted in the use of holes with a horizontal or with only an accidental inclination. *Taylor Burner Co. (Limited) v. Diamond, 76 O. G. 477, C. D. 1896.

170. Upon the evidence, the device is not worthless; and if it be said the results obtained are due to the imagination of the patient, it may be replied as in *Ex parte Kram*, 26 MS. D. 424, that "if some scientist will devise some way or means of working on the imagination so as to cure physical disease he will be a public benefactor and this office will be prompt to issue a patent, if his invention has the element of novelty." *Ex parte Sanche*, 61 MS. D., June, 1897 (Butterworth, Com'r).

171. Though the only difference in the methods of producing a knitted fabric consists in the use of a single different yarn, the two fabrics, being articles of manufacture, may be patentably distinct. *Hanifen v. E. H. Godshalk Co., 79 O. G. 510, C. D. 1897.

172. The substitution for a wheel-rim made of a single piece of metal of a laminated rim made of a series of sections so constructed as to form a compact, durable, symmetrical and highly efficient structure involved invention. *Fairbanks Wood Rim Co. v. Moore, 79 O. G. 514, C. D. 1897.

173. A cylindrical journal-bearing provided with a conical journal obliquely placed, so that the surfaces of the two have a line of contact, is patentable over a ball-and-socket bearing in which there is but a point of contact, and a claim therefor does not express merely the function of the machine. *Gates Iron Works v. Fraser & Chalmers, 79 O. G. 2015, C. D. 1897.

174. Though a chuck at first sight seems to present nothing beyond a simple duplication of an old chuck, the fact that the single chuck was used for many years, while a need was felt for something to do the work which the double chuck now performs, and the further fact that defendants as soon as they heard of the improvement adopted it, are sufficient to establish original conception on the part of the inventor and not mere skill. *Gindorff v. Deering & Co., 80 O. G. 653, C. D. 1897.

X. NOVELTY WITHOUT INVENTION.

(a) Aggregation.

(For authoritative definition of "aggregation" see decision of U. S. Sup. Ct. in *Halles v. Van Wormer*, 5 O. G. 89, 20 Wall. 353; also, *Reckendorfer v. Faber*, 10 O. G. 71, C. D. 1876; *Pickering v. McCullough*, 21 O. G. 73, 104 U. S. 310.)

175. Simply transferring the well-known fuel-magazine from an outstanding base-burning stove to a fire-place heater, when each of the parts performed the same functions and operated in the same way as in the old relation, produces an aggregation of old elements, and does not possess patentable novelty. *Thatcher Heating Co. v. Burtis, 39 O. G. 587, C. D. 1887.

176. Where two old and well-known devices are brought into juxtaposition, and each continues to perform its old function, without any new result issuing from their united action, no patentable combination is produced. *Dosh v. A. J. Medlar Co. (Limited), 40 O. G. 1242, C. D. 1887.

177. Where there was merely a good selection from among known joints and involved good workmanship and apparently nothing more, there was no patentable invention. *Babcock & Wilcox Co. v. Pioneer Iron Works, 43 O. G. 756, C. D. 1888.

178. A convenient arrangement of old operative parts, each part doing in the combination what it had done before, is but an aggregation, and not a patentable combination. *Jones v. Clow, 39 Fed. Rep. 785 (1889).

179. An old oil reservoir with an old coil-burner and an old fire-pot mounted upon it, by which arrangement of such old parts together a more portable and convenient heater is produced, does not form a patentable combination since no new result is produced. *Id.

180. The mere aggregation of processes, each accomplishing independent of the other its well-known result, is not patentable, any more than a mere aggregation of mechanical devices. Ex parte Gent, 41 MS. D. (1 G. W. D.), Nov., 1889 (Mitchell, Com'r).

181. A claim consisting of a number of elements which do not co-act to produce a new and useful result is a mere aggregation and not a patentable combination. *Brinkerhoff v. Aloe, 46 O. G. 338, C. D. 1889.

182. Where several old elements are so combined as to produce a better instrument than was formerly in use, but each of the old elements does only what it formerly did in the instrument from which it was borrowed and in the old way, *held*, that the combination is not a patentable one. *Id.

183. Where the joint operation of mechanical parts, old in themselves, when combined is the same as and only that of their separate operation in the older machines, there is no patentable combination, although there may be some convenience in bringing these parts together and making a more compact machine. Such change is merely mechanical, and does not rise into the realm of invention. *Ide v. Ball Engine Co., 49 O. G. 283, C. D. 1889.

184. An alleged combination which consists in a mere aggregation of parts, each to perform its separate and independent function substantially in the same manner as before combination with the other and without contributing to a new and combined result, is not patentable. *Watson v. The Cincinnati, Indianapolis, St. Louis & Chicago Ry. Co., 49 O. G. 1843, C. D. 1889.

185. Claims which cover merely placing several apparatus side by side, and connecting them in substantially the same manner as had previously been done with analogous apparatus, a pump to cause a flow of liquid from one to another being the only new element, do not, even though the individual apparatus had a special fitness for such connection, cover patentable novelty. *Sugar Apparatus Mfg. Co. v. Yaryan Mfg. Co., 52 O. G. 920, C. D. 1890.

186. The patent was for a corset that involved nothing original in the construction of its parts, nor in their relation to one another,

nor any change in the function of any one of them; the combination of them produced no original mechanism or device. *Florsheim v. Schilling, 53 O. G. 1737, C. D. 1890.

187. Inasmuch as the angle-door of the patent in suit was an old contrivance, and as locks and bolts upon doors were old, *held*, that the combination of it with the safe lock or bolt I, claimed in claim 1, was not new or patentable. *Held* further, that the combination of an angle-door with a lock of any kind was not a patentable invention, even though the particular lock had not before been put upon an angle-door. *County of Fond du Lac v. May, 53 O. G. 1884, C. D. 1890.

188. Inasmuch as the mechanical operation and effect of the patented devices were the same, whether there was a grating or other barrier or not, *held*, that there was no patentable combination between the devices and the grating. The case was one of mere aggregation. *Id.

189. *Held*, that so far as the grating was sought to be made an element in the combinations of claims 3 and 4 it was not an element of the mechanism. It was no part of the machine and had no effect upon its operation. *Id.

190. Where in a suit for infringement it appeared that all the elements of the claims of the patent in suit were to be found in various prior patents—some in one patent and some in another, but all performing like functions in well-known inventions having the same object as the patent in suit—and that there was no substantial difference between a certain old and well-known metal-cutter and the patentee's cutter, except in the configuration of their molded surfaces, *held*, that such a combination of old elements did not constitute patentable invention. *Held* further, that said difference in configuration was not a patentable difference, even though the one cutter was used in the metal art and the other in the leather art. *Busell Trimmer Co. v. Stevens, 53 O. G. 2044, C. D. 1890.

191. There is no invention in aggregating in a single vendible commodity magnesium adapted to use for flash-light purposes and put up in a case or shell and a time-fuse attached to said case or shell for communicating fire to the magnesium. The improvement may possess commercial advantages, but it lacks the quality of invention. Ex parte White, 54 O. G. 387, C. D. 1891.

192. A combination of old elements, when

no new function is performed by the combination, is a mere aggregation, and hence not patentable. *Union Edge Setter Co. v. Keith, 55 O. G. 285, C. D. 1891.

193. An aggregation of old devices, each working out its own office without securing some new and useful result as the joint product of the combination, does not constitute a patentable invention. (Quoting Hailes v. Van Wormer, 5 O. G. 89, 20 Wall. 353, and Pickering v. McCullough, C. D. 1882, 28, 104 U. S. 810.) *Adams v. Bellaire Stamping Co., 57 O. G. 1280, C. D. 1891.

194. A claim for a combination of old elements producing no new and useful result, each element having no essential change of individual structure or function, is invalid. *American Cable Ry. Co. v. City of New York, 56 Fed. Rep. 149 (1893); *Deere & Co. v. J. I. Case Plough Works, 56 Fed. Rep. 841 (1893).

195. The claim for the combination of an oven and an air-pump for working the process examined and found to be for an aggregation. Ex parte Rudd, 68 O. G. 535, C. D. 1894.

196. The state of the art disclosed that a cylindrical guide, a trough-like connection, and a combination of flat guides and trough each was old. *Held*, that claim 2, which covers a combination of the cylindrical guide and trough-like connection, is void, as covering a mere aggregation, or, if the combination is superior to the old one, it is a difference in degree, not rising to the dignity of invention. *Wright v. Yuengling, 69 O. G. 639, C. D. 1894.

197. The patentee made a convertible dredger adapted to use either a scoop or a clam-shell bucket. The parts do not, however, co-operate by contributing to a common end. The function and operation of the machine, where either bucket is attached, is exactly the same as it would be if the means for attaching the other bucket were not present. It is simply an aggregation, although it is true that there may be a true combination in which different parts perform different and separate functions, but all require a new result or an old result in a new way. *Osgood Dredge Co. v. Metropolitan Dredging Co., 69 Fed. Rep. 620 (1895).

198. An assemblage of old elements concerting no new and useful result is not a combination. *Palmer v. Corning, 70 O. G. 1497, C. D. 1895.

199. So long as each element performs some old and well-known function the result is not a patentable combination but an aggregation

of elements. The multiplicity of elements may go on indefinitely without creating a patentable combination unless by their collocation a new result be produced. *Richards v. Chase Elevator Co., 71 O. G. 1456, C. D. 1895.

200. The use in the same wire band of two features separately old in wire bands to effect the identical functions performed separately by each of them in the prior devices, *held* not to constitute patentable novelty. Griswold v. Seymour, Com'r of Patents, 78 O. G. 482, C. D. 1897.

201. A twin wire "dress stay" for stiffening women's gowns with water-proof materials is anticipated by steel stays covered with rubber and twin stays covered with textile material, and steel stays enveloped in celluloid or rubber and sewed to the garment. The form of the stay was old, the materials were old, and in bringing them together as described no new characteristics nor capacity were developed. *Janowitz v. Levison, 82 Fed. Rep. 63 (1897).

(b) *Arrangement.*

202. The reversal of a tongue and its recess in the same kind of a structure, even if productive of an improved, but not a new, result, does not require patentable invention. *Sax v. Taylor Iron Works, 40 O. G. 118, C. D. 1887.

203. The invention being a book spaced for each bond, and its coupons in proximity when paid, with appropriate descriptive matter, and an earlier invention being a book with no place for the bonds, and adapted for the arrangement of the coupons in the order of payment instead of in groups, there was no invention in the special arrangement of the bonds and coupons together. *Munson v. City of New York, 42 O. G. 1061, C. D. 1888.

204. The defendant's entire machine is simply a re-arrangement of the Gray combination for the obvious purpose of an attempt to avoid his patent. The result attained by both combinations is the same. The means adopted to attain such result differ only in the location of the several elements and such dependent differences as are made necessary by such change of location. *Consolidated Roller Mill Co. v. Coombs, 48 O. G. 255, C. D. 1889.

205. Where certain parts of a water-tight shoe were old, a simple change in the form and arrangement of such parts, subserving the same purpose as like parts of shoes constructed under earlier patents and without causing any new function to be performed, does not constitute

invention. *Burt v. Ivory, 50 O. G. 1294, C. D. 1890.

206. In a water-heating apparatus the arrangement of vertical pipes over instead of at the side of the fire does not constitute patentable novelty, and varying the length of these pipes so as to avoid interfering with the fuel-space is an obvious change for an obvious purpose and does not amount to invention. *Ex parte Garland*, 58 O. G. 273, C. D. 1892.

207. The only real difference between the devices in the prior state of the art and the patent is that in the patent two cooking-tanks were so arranged that each should be partly over the storage-heater, whereas in the prior art there was only one cooking-tank placed immediately over the storage-tank, the advantage of the arrangement in the tanks in the patent being the use of one storage-heater for two cooking-tanks. *Held*, that such new arrangement was not invention, but only an economical re-arrangement, such as would have suggested itself to any one with a slight knowledge of the art. *Vaile v. Buckeye Iron and Brass Works, 63 O. G. 1965, C. D. 1893.

208. Wooden bearings in excelsior machines being old, there is no patentability in a wooden bearing in such machine placed therein so that the grain of the wood will run vertically with the line of motion of the journal instead of at right angles thereto. *Johnson v. Olsen, 68 O. G. 1146, C. D. 1894.

209. There is no invention in setting the knives of a cutter-head at the precise angle of forty-five degrees. *Caverly v. Deere, 73 O. G. 1711, C. D. 1895.

210. In the patent the tool-holder is stationary and the chuck movable; in the defendant's machine the chuck is stationary and the tool-holder movable. This reversal involving no change in the principle of operation nor in the result, *held*, that the two forms were substantially the same thing. *Société Anonyme Usine J. Cleret v. Rehfuß, Same v. Selig, 75 Fed. Rep. 657 (1896).

(c) *Composition of Matter.*

211. When a mechanically-combined material composed of particular ingredients is old, a person who has merely altered the proportions of ingredients or the process of combining them has not discovered a new composition of matter in the sense of the patent law. To be a new composition of matter the product must have some distinctly new property or be

applicable to some new use. *Van Camp v. The Maryland Pavement Co., 43 O. G. 884, C. D. 1888.

212. It is difficult to find invention in mixing or putting together in a dry state two materials, it being old to mix the same materials during the process of manufacturing or brewing. *Geis v. Kimber, 44 O. G. 108, C. D. 1888.

213. A remedial compound which is nothing more than such a compound of medicinal agents as could be made by the exercise of the skill of a physician is not patentable. *Ex parte Crippen*, 43 MS. D. (9 G. W. D.), May, 1890 (Fisher, Ass't Com'r).

(d) *Degree.*

214. A mere carrying forward or more extended application of an original idea—a mere improvement in degree—is not invention. *Burt v. Ivory, 50 O. G. 1294, C. D. 1890.

215. The improvement of the patent in suit over the features of the earlier patents declared to be only an improvement in degree and therefore not patentable. *Bussell Trimmer Co. v. Stevens, 53 O. G. 2044, C. D. 1890.

216. The mere carrying forward of an original conception, resulting in an improvement in degree simply, is not invention. *Consolidated Roller Mill Co. v. Walker, 54 O. G. 1415, C. D. 1891.

217. Where the patent covered an improvement which was simply a slight advance over the corresponding device which had been in public use for over two years, covering a mere superiority in workmanship or finish over the same, *held*, that something more was required to support a patent. *International Tooth Crown Co. v. Gaylord, 55 O. G. 865, C. D. 1891.

218. The knives of the cutter-head were set at an angle, or between forty-five and eighty-five degrees, but "the change was only in degree and consequently not patentable." (*Guidet v. Brooklyn*, 105 U. S. 550.) *Caverly v. Deere, 52 Fed. Rep. 758 (1892).

219. Cutter-heads with knives set with some degree of angularity were known and in use long prior to the alleged invention by Caverly, and the change to an angle of forty-five degrees is such as any skilled mechanic could make, and did not involve invention. *Id.

220. A device which is an improvement upon a pre-existing one must, in order to be patentable, contain a new idea and perform some new function, and not present changes of de-

gree only. *Williams v. The Goodyear Metallic Rubber Shoe Co., 58 O. G. 1257, C. D. 1892.

221. Where the cross reeling and lacing in the skein of the patent perform substantially the same function in substantially the same way as in the earlier skeins, but at a later and different stage or condition of the silk thread forming the skein, *held*, that the improvement constitutes, simply, a mere carrying forward or extended application of the original device with the change only in degree, but doing substantially the same thing in the same way by substantially the same means with some better results, and that it is therefore not patentable. (Smith v. Nichols, 21 Wall. 112.) *Grant v. Walter, 63 O. G. 910, C. D. 1893.

222. A combination superior to an old one, but one differing in degree only, does not rise to the dignity of patentable invention. *Wright v. Yuengling, 69 O. G. 639, C. D. 1894.

223. It is not sufficient that the patentee has produced a better or more merchantable article, but there must be some invention in the article itself. *Andrews v. Thum, 72 O. G. 899, C. D. 1895.

224. Though the patentees may have produced a more perfect counter-die than their predecessors, if they have added no novel mechanism and no new principle of operation they have produced no new product of a creative mental conception. *National Folding Box and Paper Co. v. Stecher Lithographic Co., 78 O. G. 1253, C. D. 1897.

225. It involves only the exercise of ordinary faculties to vary the temperature required in a certain process in which heat is essential, even when this variation is great. *Musgrave and Nye v. Commissioner of Patents, 78 O. G. 2047, C. D. 1897.

(e) *Double or Analogous Use.*

226. A difference in location is immaterial where the function performed, the result attained and the mode of operation are the same so far as the essential purpose of the invention is concerned. *Kirk v. Du Bois, 42 O. G. 297, C. D. 1888.

227. A patent covers a device in all the uses to which it may be applied. (Roberts v. Ryer, 91 U. S. 157.) *McClain v. A. Ortmyer & Son, 42 O. G. 724, C. D. 1888.

228. The chilling of wearing surfaces being old there is no invention in chilling a particular wearing surface. *Gates Iron Works v. Fraser, 42 Fed. Rep. 49 (1890).

229. The use of a deflector on an automatic fire-extinguisher, which had been used on hand hose, is not a patentable novelty. *Grinnell v. Walworth Mfg. Co., 43 Fed. Rep. 590 (1890).

230. There was no invention in applying steam-pipes to the interior of a cask for the purpose of heating the wine contained therein, steam-pipes having been previously applied to the interior of a closed tub for the purpose of heating water in the same. *Dreyfus v. Searle, 42 O. G. 491, C. D. 1888.

231. Where the same combination was employed in square-cornered safes it was simply an unpatentable aggregation to employ it in round-cornered safes. *Mosler Safe and Lock Co. v. Mosler, Bahmann & Co., 43 O. G. 1115, C. D. 1888.

232. The state of the art showing that dies could be used to compress and finish articles of vulcanizable gum, and to compress plastic material surrounding a metal core or skeleton in making articles of harness trimmings, it required no exercise of invention to use dies to compress and finish similar articles in which a vulcanizable gum was used to envelop a metal core. *Rubber and Celluloid Harness Trimming Co. v. India Rubber Comb Co., 44 O. G. 343, C. D. 1888.

233. Where it appeared that a turn-over seam was an old and well-known substitute for the ordinary seam in making garments, and that such seam had been used in hat-sweats as shown in a prior patent as a substitute for the ordinary seam and for the purpose of protecting the hat from the perspiration, *held* not to be an invention to unite in a hat-sweat the tacking-slip to the leather band by a turn-over seam instead of by the ordinary seam in which the stitches perforate the outer face of the band. *Hat Sweat Mfg. Co. v. Davis Sewing Machine Co., 49 O. G. 1214, C. D. 1889.

234. Where the employment of a device to effect a certain purpose was such as would naturally suggest itself to any mechanic, and the same device was used in the new relation to perform an office analogous to that in which it had been frequently formerly used, *held*, such employment of said device did not constitute invention. *Day v. The Fair Haven and Westville Ry. Co., 49 O. G. 1364, C. D. 1889.

235. The mere application to a new situation of old devices which had been previously applied to analogous uses does not constitute new invention. *Aron v. The Manhattan Ry. Co., 49 O. G. 1365, C. D. 1889.

(Same. *Royer v. Roth, 49 O. G. 1987, C. D. 1889.)

236. It does not constitute invention to put up paper in the form of an oblong or oval shaped roll when it appears that it was old to put it up in that exact form, though in rolls of smaller size. *Morgan Envelope Co. v. The Albany Perforated Wrapping Paper Co., 50 O. G. 303, C. D. 1890.

237. The application of an old process or machine to a similar or analogous subject, with no change in the manner of applying it and no result substantially distinct in its nature, will not sustain a patent, even if the new form of result has not before been contemplated. *The Howe Machine Co. v. The National Needle Co., 51 O. G. 475, C. D. 1890.

238. The application or adaptation of an old device, which had previously been used with the roller of a washing-machine to reverse the motion of the roller periodically, to the drum of a fulling-machine to make it revolve in different directions at intervals, is merely an exercise of ordinary mechanical skill. *Royer v. Schultz Belting Co., 50 O. G. 557, C. D. 1890.

239. The application of an old process or machine or apparatus to a similar or analogous subject, with no change in the manner of application and no result substantially distinct in its nature, will not sustain a patent, although the new form of result may not have before been contemplated. *St. Germain v. Brunswick, 51 O. G. 1129, C. D. 1890.

(*Consolidated Roller-Mill Co. v. Walker, 54 O. G. 136, 1415, 1891.)

240. Where the prior art disclosed that it was old and well known to apply electrical energy to the propulsion of a boat by means of a battery, mounted upon the boat, capable of being regenerated, and also to propel a locomotive engine or vehicle by means of electricity supplied by a primary battery mounted thereon, and that such contrivances were successful in the sense of being operative, although they involved great expense and were not successful commercially, *held*, that no invention was exercised in applying the Faure secondary battery to the propulsion of vehicles, no adaptation being required to make it available for the specified purpose. *Ex parte Faure*, 52 O. G. 752, C. D. 1890.

241. *Held*, that a patent was rightly refused for want of invention by the patent office, although said patented storage battery of applicant was superior to all others of its kind for the purpose and rendered the device commercially practicable. *Faure v. The Commissioner of Patents, 52 O. G. 754, C. D. 1890.

242. *Held* further, that otherwise the monopoly granted by applicant's patent upon his storage battery would be prolonged. *Id.

243. *Held*, that the propulsion of vessels through water by a secondary battery comes within the same principle as locomotion upon land. *Id.

244. A combination of parts to perform a certain function when patented entitles the patentee to that combination in all situations for all analogous purposes, and a claim for a construction for raising, lowering and fastening the grain platform of a harvester is anticipated by a device for doing the same thing to a window-sash, there being no mechanical difference between the functions of the two devices. *Deering v. McCormick Harvesting Machine Co., 52 O. G. 1223, C. D. 1890.

245. The patentee merely used the same device which had before been used by other persons, between one side of an interposed barrier and the other, with the same mechanical effect as when used without the barrier, and therefore the case was one merely of a double use. *County of Fond du Lac v. May, 53 O. G. 1884, C. D. 1890.

246. The application of a well-known form of blade, used in the old hand-tool for trimming sole-edges, to a metal milling-cutter, also old and well known, for the purpose of producing a rotary cutter for trimming sole-edges, is a mere case of double use and therefore not patentable. *Busell Trimmer Co. v. Stevens, 53 O. G. 2044, C. D. 1890.

247. The difference in configuration between a certain old and well-known device and the patentee's *held* not patentable, even though the one was used in the metal art and the other in the leather art. *Id.

248. A method of charging beer having been practiced for treating water or neutral liquids, *held* to be the mere application of an old process to a new but analogous subject. *Zinsser v. Krüger, 58 O. G. 805, C. D. 1892.

249. The application of an old process or machine to a new and analogous purpose does not involve invention, even if the new result had not before been contemplated. *Ansonia Brass and Copper Co. v. Electrical Supply Co., 58 O. G. 1692, C. D. 1892.

250. The use of a mechanical contrivance for subjecting bretzels to a hot alkaline bath, when an analogous appliance has long been employed for steaming crackers, shows nothing more than ordinary mechanical skill. *Stauffer v. Spangler, 59 O. G. 632, C. D. 1892

251. The use of a single sheet of metal and the absence of "joint, seam or interior angle" do not confer patentability, since these features are old in analogous devices. *Kilbourne v. W. Bingham Co., 60 O. G. 577, C. D. 1892.

252. Applying an old process to an analogous subject, with no change in the manner of the application, is a "double use." *McKay & Copeland Lasting Machine Co. v. Clafin, Same v. Dizer, 58 Fed. Rep. 353 (1893).

253. The public cannot be deprived of an old process because some one has discovered that it is capable of producing a better result or has a wider range of use than was before known. (Citing Smith v. Nichols, 21 Wall. 112; Roberts v. Ryer, 10 O. G. 204, 91 U. S. 150; Hollister v. Benedict Mfg. Co., 113 id. 59.) *Lovell Mfg. Co. (Limited) v. Cary, 62 O. G. 1821, C. D. 1893.

254. It is not patentable invention to apply old and well-known devices and processes to new uses in other and analogous arts. *Id.

255. Skeins of raw or gummed silk diagonally reeled and tightly laced across the width so as to separate the skein into two or more sections, being old in the art, *held*, that a skein of ungummed silk diagonally reeled and loosely laced across the width presents at most a discovery of a new use for an old device, which does not involve patentability. *Grant v. Walter, 63 O. G. 910, C. D. 1893.

256. Where the patent in suit described an ink and claimed only a rubber fabric having ornamental figures printed in such ink on its surface, *held*, that the case then reduces itself to the single question whether there is any novelty in printing a rubber fabric with such an ink. (Underwood v. Gerber, 63 O. G. 1063.) *Brigham v. Coffin, 63 O. G. 1385, C. D. 1893.

257. Where the devices claimed were parts of a watch mechanism, *held*, that a use in a watch mechanism of a different type would not be a use in other relations. *Ex parte Learned*, 63 O. G. 1962, C. D. 1893.

258. It is settled law that the patentee of a device is entitled to all its uses whether described or not. *Miller v. Eagle Mfg. Co., 66 O. G. 845, C. D. 1894.

259. When the identity of the two devices is admitted, they cannot be patentably distinguished by a suggested distinction in the purpose to which they are respectively applied. (Knapp v. Morse, 65 O. G. 1593.) *Wollensak v. Sargent & Co., 66 O. G. 1007, C. D. 1894.

260. A rectangular terra cotta conduit-pipe having partitions made in one integral piece

by forcing the material, while plastic, through a die, and burning it, does not distinguish it as a new article, the making of sewer-pipe of clay by the same process being old, and hollow rectangular blocks of terra cotta divided into ducts by partitions being old, although used as building material rather than as conduits for wire. *Browning v. Colorado Telephone Co., 68 O. G. 1145, C. D. 1894.

261. The use of lugs to prevent lateral movement being well known, their employment in an excelsior machine to prevent lateral movement of the sliding plate involves no invention. *Johnson v. Olsen, 68 O. G. 1146, C. D. 1894.

262. There was no invention in applying the lubricator to a peculiar car, and, moreover, the lubricators of the prior patents were capable of like application. *Market Street Cable Ry. Co. v. Rowley, 70 O. G. 632, C. D. 1895.

263. Where it was old to make Cardigan jackets by a peculiar stitch and to sew their parts together in a certain manner, *held* not to involve invention to apply the same stitch and manner to the making of undershirts. *Dalby v. Lynes, 71 O. G. 1317, C. D. 1895.

264. A patentee is entitled to any beneficial function of his invention, whether he then knew all its beneficial uses or not. (Cases cited.) *Goshen Sweeper Co. of Grand Rapids, Mich., v. Bissell Carpet-Sweeper Co., 72 Fed. Rep. 67 (1895).

265. Under the doctrine that the patentee is entitled to all known and unknown uses to which his invention may be applied, the public is entitled to all uses of devices covered in expired patents, and the discoverer that old means will do a new work is not entitled to a monopoly. *Wright & Colton Wire-Cloth Co. v. Clinton Wire-Cloth Co., 72 O. G. 1046, C. D. 1895.

266. A claim that an older device was not designed for the particular use to which a new device is peculiarly adapted is no answer to the fact that the older device would perform the same functions. *Codman v. Amia, 74 O. G. 1738, C. D. 1896.

267. Where the elements of a syringe are found operating together in a pump in the same way as in the syringe and for the same purpose, *held* that, a syringe being a kind of pump, the uses of the elements in each are closely analogous. The difference, if any, is only in size, which does not, however, affect the relation or operation of the elements. *Tagliabue v. Sondermann, 75 O. G. 128, C. D. 1896.

268. The mere adaptation from a different art of devices which successfully accomplish in a given apparatus results hitherto imperfectly accomplished by crude and inefficient apparatus does not involve invention. *Excelsior Elevator Guard and Hatch Cover Co. v. Foote, 75 O. G. 1364, C. D. 1896.

269. The use of a rack and pinion for raising and lowering a cutter-head used in an ice-planer does not involve invention in view of the previous use of such rack and pinion for adjusting a wood-planer. *Ex parte Briggs*, 75 O. G. 1854, C. D. 1896.

270. It does not require invention to provide an old form of garment-stay with projections, which are also old, for the same purpose in devices of a similar character, by means of which the stay may be attached to a garment. *Ypsilanti Dress Stay Mfg. Co. v. Van Valkenburg, 76 O. G. 333, C. D. 1896.

271. There is no patentable novelty in adding end caps to the steel of a particular garment-stay when such caps had previously been attached to similar steels. **Id.*

272. The fact that an inventor claims only certain functions for his invention does not prevent him from reaping the advantage of any other function within the claim, as properly construed, although known to him and omitted in the specification without fraud, or not known to him. (*Reece Co. v. Globe Co.*, 61 Fed. Rep. 958.) **Long v. Pope Mfg. Co.*, 77 O. G. 1428, C. D. 1896.

273. The decision in *Potts v. Creager* does not apply to the circumstances of this case, in which an old construction of cutter-head used in a wood-planing machine is applied to an ice-planing machine, since the uses are analogous. **Briggs v. Seymour, Com'r of Patents*, 78 O. G. 169, C. D. 1897.

274. The patentee is entitled to all the uses of which his invention is capable, whether or not he foresaw them at the time of making his invention. **Edward Miller & Co. v. Meriden Bronze Co.*, 79 O. G. 1520, C. D. 1897.

275. Where the disintegration and shredding of clay had been accomplished by means of bars running across the face of rollers, *held*, that no invention was involved in adapting a mill for grinding or grating apples to the purpose of disintegrating and shredding clay, where the only change required was the substitution of bars of steel running across the face of the roller, parallel with the axis, in place of rows of thick steel knives. **Potts & Co. v. Creager*, 80 O. G. 186, C. D. 1897.

276. The circumstance that the same congregation of devices has never been assembled in a new location is not controlling and is often of little value in determining the question of patentable novelty. Their assemblage may be nothing but another instance of a double use, and when they require special adaptation to the new arrangement and occasion it still remains to inquire whether this has required invention. (76 O. G. 788, reversed.) **Dunbar v. Eastern Elevating Co.*, 80 O. G. 1127, C. D. 1897.

(f) *Mechanical Process or Method.*

277. The necessary effects or operations of specific mechanism are not necessarily processes or methods within the meaning of the patent laws. A method or process such as the law recognizes as patentable must have an existence independent of the machine or apparatus by which it is carried out to a result. It must be a method or process that can be carried out by hand or by various kinds and forms of mechanism or apparatus. *Ex parte Herr*, 41 O. G. 463, C. D. 1887.

278. If the act or result is simply that of the mechanism itself, so related to it that it cannot exist independently, and is the sole utterance of the machine, then the supposed method or process does not exist. The function of a machine can have no separate existence, and is completely and sufficiently covered by a patent for the latter. *Id.*

279. It being conceded that a process is not patentable which is merely the effect or function of specific mechanism, the question necessarily arises in every case whether the process claimed is capable of being performed by a machine differently organized from that described, or even without an organized machine — by ordinary tools or by hand. *Ex parte Young*, 46 O. G. 1635, C. D. 1889.

280. A method or process which depends for its novelty upon the preparation of an adhesive stay and the various steps employed to carry such article forward to the final act of affixing it to the corners of boxes for the purpose of strengthening the corners, *held* to be not a proper method or process, but the mere operation of the machine. *Ex parte Jaeger*, 46 O. G. 1637, C. D. 1889.

281. Where it appeared that all that applicant professed to do was to take an old and well-known bolt and nut and to screw them together in the ordinary way, and then to take an old and well-known chisel and make an in-

cision in the bolt lengthwise and nearest the upper surface of the nut in order to prevent the bolt from rotating, *held*, that applicant had only displayed the expected skill of the calling and accomplished what a skilful mechanic would do whenever required. *Ex parte* Shields, 54 O. G. 387, C. D. 1891.

282. Processes which consist solely in the operation of a machine are not patentable. The function of a machine is entirely independent of any chemical or other similar action. **Risdon Iron & Locomotive Works v. Medart*, 71 O. G. 751, C. D. 1895, 158 U. S. 68.

(Followed in *Travers v. Gem Hammock & Fly Net Co.*, 75 O. G. 678; *Wells Glass Works v. Henderson*, 72 O. G. 285.)

283. The decisions in the cases of *Neilson v. Harford* (1 Web. Pat. Cas. 331); *Hauschill Coal and Iron Co. v. Neilson* (1 Web. Pat. Cas. 673); *O'Reilly v. Morse* (15 How. 62, 115); *Tilghman v. Proctor* (19 O. G. 859, 102 U. S. 707, 724); *Mowry v. Whitney* (14 Wall. 620); *Cochrane v. Deener* (11 O. G. 687, 94 U. S. 780); *New Process Fermentation Co. v. Mauss* (39 O. G. 1419, 122 U. S. 413); *Bell Telephone Co.* (43 O. G. 377, 126 U. S. 1); *Wyeth v. Stone* (1 Story, 273); *Corning v. Burden* (15 How. 252), reviewed. **Id.*

284. A process consisting of purely mechanical steps, *held* not patentable in view of decision in *Risdon, etc. v. Medart* (158 U. S. 68). *Ex parte* Rowe & Heys, 60 MS. D., Dec., 1896 (*Seymour, Com'r*).

285. A "method consisting of mechanical steps and involving no action which is separable or distinguishable from the function of the several mechanical devices which are employed to effect the result" is not patentable. (**Risdon Iron and Locomotive Works v. Medart*, 71 O. G. 285, and other cases cited.) *Ex parte* Over & Schwan, 62 MS. D., July, 1897 (*Butterworth, Com'r*).

286. Letters Patent No. 524,965, granted to Matthew Gindorff for a method of and machine for serrating sickle-sections, examined, and claims 4 and 5 *held* void for lack of patentability, in view of *Risdon Iron and Locomotive Works v. Medart* (71 O. G. 751, 158 U. S. 68). **Gindorff v. Deering & Co.*, 80 O. G. 653, C. D. 1897.

287. Where, except for the described functions of a machine, there is nothing stated in a claim save the manual transposition or turning of the articles undergoing operation, so that a fresh part may be treated, such transposition, superadded to the function of the machine,

does not make the process which the patent law contemplates. **Id.*

(*Corning v. Burden*, 15 How. 252, 1 Whitman, 687; *The Telephone Cases*, 126 U. S. 1, 43 O. G. 377, C. D. 1898.)

(g) *Omission of Mechanical Parts.*

288. A reconstruction of a machine so that a less number of parts will perform all the functions of the greater may be invention of a high order; but the omission of a part with a corresponding omission in function, so that the retained parts do just what they did before in the combination, cannot be other than a mere matter of judgment, depending upon whether it is desirable to have the machine do all or less than it did before. **McClain v. Ortmayer & Son*, 42 O. G. 724, C. D. 1888.

289. Hence, where a device is made double, and experience shows that one-half of it is superfluous, no invention is required to dispense with such superfluous portion, and a patent for the part retained will be held void. **Id.*

290. An original patent for a device covered duplicate parts which performed similar functions and one of which was superfluous and unnecessary. A patent for improvement of the same, which merely dispenses with this unnecessary duplicate part and shows no material difference in the method of operation, is void for want of patentable novelty. **McClain v. Ortmayer*, 57 O. G. 1129, C. D. 1891.

291. If a person has invented a combination of three elements, all of which are necessary to the operation of his device, he cannot by making a claim for two of them forestall another who has so combined these two elements that they perform the same function that the three elements of the former patent performed; but otherwise if the third element of the first device is not essential to its operation, and if by the mere omission of such third element the two devices perform substantially the same function. **National Hat Pouncing Machine Co. v. Hedden*, 63 O. G. 466, C. D. 1893.

292. Where a patented hat-pouncing machine contained as an element a feed-roll for feeding the hat in a direction opposite to that of the motion of the pouncing cylinder, and it appeared that the feed-roll might be omitted and the hat fed in the opposite direction, *held*, that the hat-support and pouncing-cylinder would accomplish practically the same functions as the corresponding parts of a subsequently patented machine having no feed-roll,

and that it required no invention to omit the feed-roll of the former machine and to make the subsidiary changes necessary to produce a working device. *Id.

293. When the only difference between two apparatuses consists in the omission in the later apparatus of an important feature of the prior device, *held*, that the change consequent upon such omission does not rise to the dignity of invention and is not patentable. *Magin v. Karle, 65 O. G. 2060, C. D. 1893.

294. While the omission of an element in a combination may constitute invention if the result of the new combination be the same as before, yet if the omission of an element is attended by a corresponding omission of the function performed by that element there is no invention if the elements retained perform the same function as before. (Stow v. Chicago, 3 Han. & M. 32.) Richards v. Chase Elevator Co., 73 O. G. 1710, C. D. 1895.

(h) *Product of Nature.*

295. A product of nature, although conceded to be valuable and useful, such as fiber which is procured, derived or freed from a certain species of pine, by means of a new and novel process for which patent has been granted to applicant, *held* to be not such a patentable invention as is required by the statute. Ex parte Latimer, 46 O. G. 1638, C. D. 1889.

296. The product has not been affected, changed or altered by the process, and whatever there is of an invention resides in or consists of the process itself, by which the fiber can be taken from the natural sheath or membrane of the leaf or pine-needle in which it has been developed or produced by the processes of nature. Id.

297. A contrary ruling would result in granting to one inventor the exclusive use of one species of fiber, and so on, successively, patents might be obtained upon the fibers of the various trees of the forest and the plants of the earth, which, because being natural products, are no more the subjects of patents when eliminated from their surroundings than wheat which has been cut by some new method of reaping can be patented *as wheat* cut by such a process. Id.

(i) *Process or Method.*

(See ART.)

298. The application of artificial heat to ripen wine being old and the application of artificial

heat to the outside of casks to ripen wine contained therein being old, it did not require invention to apply artificial heat to the inside of the casks to ripen the wine in the same. *Dreyfus v. Searle, 42 O. G. 491, C. D. 1888.

299. Where the art of advertising as claimed produces no physical effects, but only a state of mind in the purchaser of the newspaper amounting to a predisposition to read the advertisements, and there ends unless the reader wills otherwise, *held*, that such art of advertising is not a patentable art. Ex parte Turner, 66 O. G. 1593, C. D. 1893.

300. Where the art as claimed omits a step necessary to its lawful practice, *held*, that such omission was a proper ground for the rejection of the claims. Id.

301. The change in a process of making yeast, the chief feature of the improvement consisting in treating grains of cereals whole or only slightly broken instead of reducing them to small fragments, *held* to be invention. (Lawther v. Hamilton, 42 O. G. 487, 124 U. S. 1, wherein the step of "grinding" was omitted, discussed and followed.) Ex parte Blumer and Slagenhauser, 72 O. G. 1783, C. D. 1895.

302. The discovery that the old process of fumigating plants and trees by hydrocyanic acid gas, after covering them with an oiled tent, is more effective in the absence of the actinic rays of the sun gives no right to a patent for the use of that process at night or in cloudy or foggy weather, when such rays are excluded by the processes of nature. (68 O. G. 1273, 61 Fed. Rep. 291, followed.) *Wall v. Leck, 74 O. G. 877, C. D. 1896.

303. In a process of purifying oil the use of pulverized copper matte to remove the "skunk" from the oil is an improvement upon the use of a mixture of pulverized copper oxid and pulverized iron oxid of such character as is not to be expected from those versed in the art, and required invention. Ex parte Frasch, 77 O. G. 1427, C. D. 1896.

304. A process which employs low heat for a long time is not patentable over another which uses a high heat for a short time when the result — namely, the partial distillation of coal — is the same in both cases. Ex parte Musgrave and Nye, 78 O. G. 2046, C. D. 1897.

305. The discovery of a new process in any art by the addition of heat as a material factor, where heat had never before been applied or suggested, would constitute invention; but the adoption of a discretionary temperature in treating coal, subject to increase or diminution,

as experience, as well as the varying character of the material treated, may suggest, does not amount to invention. *Musgrave and Nye v. Commissioner of Patents, 78 O. G. 2047, C. D. 1897.

(j) *Substitution of Materials or Parts.*

306. An applicant who has done nothing but exercise his judgment and knowledge in selecting a better but well known material for use in constructing an old and well-known instrument, notwithstanding the results produced may be superior, has not displayed invention. *Ex parte Krell*, 44 O. G. 1505, C. D. 1888.

307. When a T lever had already been used for operating a saw-mill dog, there was no invention in the substitution of an eccentric-lever which was used to perform the same function in a no more effectual manner. *Rodebaugh v. Jackson, 47 O. G. 658, C. D. 1889.

308. Where the only change involved is a change of material, accompanied by the expected skill of the calling in effecting the substitution and making it efficient, the result is not patentable. *Ex parte Odenheimer*, 49 O. G. 1693, C. D. 1889.

309. It does not constitute invention to stir by a well-known and simple mechanical device a liquid which had before been stirred by hand. *Marchand v. Emken, 49 O. G. 1841, C. D. 1889.

309a. The mere substitution of a revolving screw, driven from a power shaft, for paddles operated by hand, for stirring such liquid is not patentable. *Id.

310. The substitution of one material for another, which does not involve change of method nor develop novelty of use, even though it may result in a superior article, is not necessarily a patentable invention. *Florsheim v. Schilling, 53 O. G. 1737, C. D. 1890.

311. No valid claim can be founded upon the use of an inferior article when it is shown that the use of the superior article or material is old. *Brush Electric Co. v. Electrical Accumulator Co., 56 O. G. 1334, C. D. 1891.

312. A mere change of material, with no advantages except such as were known in advance would be attained by the selection of the material in question, does not confer patentability. *Ex parte Foss*, 56 O. G. 1564, C. D. 1891.

313. A claim for a patent for an inside slip-

per of bladder or other thin animal tissue, which is met by the references cited on every point except that of material, has not patentable novelty. *Ex parte Foss*, 57 O. G. 1277, C. D. 1891.

314. The use of wrought iron or steel in lieu of cast metal is a mere substitution of materials and is not patentable, notwithstanding the superior results obtained. *Kilbourne v. W. Bingham Co., 60 O. G. 577, C. D. 1892.

315. This view is substantiated by the decisions in *Hotchkiss v. Greenwood*, 11 How. 248; *Hicks v. Kelsey*, 5 O. G. 94, 18 Wall. 670; *Phillips v. Detroit*, 17 O. G. 121, C. D. 1880, 4 Sup. Ct. Rep. 580; *Brown v. Dist. Col.*, 47 O. G. 398, C. D. 1889; *Florsheim v. Schilling*, 53 O. G. 1737, C. D. 1890. *Id.

316. As an article of manufacture, a bicycle frame of a known and aluminum alloy, cast in one piece, is not a patentable invention merely by reason of its material. *Ex parte Grayson and Crecelius*, 68 O. G. 1021, C. D. 1894.

317. It is not every new and useful improvement produced by the adaptation or substitution of one well-known material for another that will entitle a party to a patent. The improvement must be the result of invention. *Cheneau v. Commissioner of Patents, 70 O. G. 924, C. D. 1895.

318. Where the article sought to be patented differs from prior like articles merely in the difference and superiority of the material of which it is composed, the material and its properties being old and known, *held*, that such article involves the mere substitution of one old material for another. *Id.

319. There is no invention apparently involved in putting some other mechanism well known in the art and well adapted for such use in the place of previously-used mechanism in an old device operating in an old way when such substitution does not involve any material re-arrangement. *New Departure Bell Co. v. Bevin Brothers Mfg. Co., 75 O. G. 2196, C. D. 1896.

320. There is no presumption in favor of invention in a device which embodies the substitution of an old form of mechanism for one which did not render the device practicable, though such substitution renders the device simple, durable, reliable, convenient and attractive, when there is no showing that the old form of mechanism was known to workers in the art. *Id.

(k) *Particular Cases.*

321. An improvement in the nail-carrier of a nailing machine which consists in making the edge of the carrier smooth instead of corrugated cannot be held to be an invention. *Cross v. Union Metallic Fastening Co., 39 O. G. 361, C. D. 1887.

322. Placing a large register in a stove-oven door where a small register had been used previously is not patentable invention. *Filley v. The Littlefield Stove Co., 39 O. G. 1203, C. D. 1887.

323. Self-feeding regulated lubricators where the drip of the oil from a reservoir was visible being old and well known, and self-feeding regulated lubricators where the oil flowed from a reservoir into a transparent pipe having been described in an earlier English provisional specification, it required no invention to make a self-feeding regulated lubricator where the oil was delivered in drips from the reservoir into a transparent chamber below the same. *McNab and Harlem Mfg. Co. v. Nathan Mfg. Co., 40 O. G. 1240, C. D. 1887.

324. Neither did it require invention to employ a transparent chamber to avoid the effects of wind and dirt upon the old and well-known unprotected drips. *Id.

325. The use of a piece of tape, linen or other suitable material as a re-enforce piece to strengthen the parts of the files in places where they were weak, was not the discovery of anything new nor the application of genius to things known, but simply mechanical skill, and does not cover a patentable invention. *Cooke v. Globe Files Co., 40 O. G. 1244, C. D. 1887.

326. The addition simply of a non-elastic tape measure in connection with the ribs of a dress-form does not involve invention. *Morss v. Manchester*, 41 O. G. 1392, C. D. 1887.

327. A claim for a "circular stove" having a perforated fire-pot with a grate-bottom having provision for the admission of air below the point of suspension of said fire-pot, *held*, to be met by prior patents showing all the elements of the claim save the circular cylinder, that element being old *per se*, on the ground that no invention was required to combine these features. *Hailes v. The Albany Stove Co., 42 O. G. 95, C. D. 1888.

328. It being old to put a flanged bottom into an iron shell, or into an iron shell washed with tin, or into an iron shell with a lining of sheet-

tin adhering thereto, and old also to provide a soda-fountain with a separable sheet-tin lining, it did not require the exercise of the inventive faculty to place a flanged bottom covered with a separable sheet-tin lining into a shell lined in a similar manner. *Matthews v. Iron Clad Mfg. Co., 42 O. G. 382, C. D. 1888.

329. Merely putting rollers under an article to make it movable when without the rollers it would not be movable does not involve patentable invention. *Hendy v. The Golden State and Miners' Iron Works, 43 O. G. 1117, C. D. 1888.

330. There is no patentable combination between rollers which make the support movable and a feeding-cylinder mounted on such support. *Id.

331. A speculum consisting of a tube with a slide and a closed end was old. *Held*, that adding an incline to the closed end to prevent the impaction of pile-tumors did not involve invention. *Brinkerhoff v. Aloe, 46 O. G. 338, C. D. 1889.

332. The second claim of the Brinkerhoff patent covers a slotted tube having an incline and a slide. *Held*, that the incline acted precisely as it did when placed in the forward end of a slotted tube not provided with a slide, and that therefore the claim covered an aggregation only and was void. *Id.

333. There was no invention in providing a bearing-surface upon the frame of a dash, to which the foot of a brace was to be attached to support the brace and dash, either by an increase in the quantity of metal or otherwise, so as to strengthen the proper part, in a proper way, for its proper duty. *Peters v. Hanson, 47 O. G. 945, C. D. 1889.

334. Where it appears that plackets in drawers have been bound in substantially the same manner as the applicant's alleged invention, it is not invention to extend that idea and make the binding include the opening for the wrist or neck or body in a shirt or other garment, or to slightly or obviously modify the manner in which the binding is turned, or to omit a cord from the binding which is simply a strengthener, or to merely prolong the binding itself. *Ex parte West*, 47 O. G. 1731, C. D. 1889.

335. The cases of *Smith v. Nichols* (21 Wall. 112) and *Hollister v. Benedict Mfg. Co.* (113 U. S. 59) followed in this respect. *Id.*

336. It does not seem to involve invention to put up paper in an oblong or oval-shaped roll when it had been put up in the form of

cylindrical rolls. *Morgan Envelope Co. v. The Albany Perforated Wrapping Paper Co., 50 O. G. 303, C. D. 1890.

337. In view of the testimony as to the state of the art, *held*, that it required no invention to make a single die to cut dough, on a flat surface, into any particular shape desired, whether the shape of a pretzel or any other shape. *Butler v. Steckel*, 53 O. G. 1090, C. D. 1890.

338. To make a suspender-end of flat cord in substantially the same way that suspender-ends of round cord had been made and in substantially the same way in which flat button ends had been made for the purpose of fastening or securing other articles of wearing apparel than trousers does not involve invention. *Shenfield v. The Nashawannuck Mfg. Co., 53 O. G. 1092, C. D. 1890.

339. It being old to bind the cut edges of cloth, either for ornament or to prevent raveling, and also old to make dress-shirts by securing a linen bosom to the body of the shirt by a row of stitches passing through the edge of the bosom, *held*, that attaching the bosom to the shirt by a separate line of stitches through the binding involves nothing which under a most liberal construction could be held to be an exercise of the inventive faculty. *Cluett v. Claffin, 55 O. G. 999, C. D. 1891.

340. The first claim is for a continuous rubber sole, with projections at the heel and tread, all moulded from a single blank. The second claim adds to the first that the projections shall be conoidal and arranged in certain regular order. *Held*, that the claims involved trivial detail but without result and lacked patentability. (Citing *Burt v. Ivory*.) *Marshall v. Packard, 51 Fed. Rep. 755 (1892).

341. An applicant for a patent for an improvement in letter files already held a patent for an indexed letter file consisting of a series of perforated index sheets arranged at one end to hinge and slide upon an upright rod and being free at the other end to permit of their being lifted from their position. The perforations in the sheets were circular and little larger than the rod itself. *Held*, that an improvement which consisted merely in making these perforations elliptical to admit of freer action upon the rod does not constitute patentable invention. *Odell, Adm'r, v. Commissioner of Patents, 60 O. G. 580, C. D. 1892.

342. Where the only difference between the attachments in the references and those in the claims resided in the particular means by which

the attachments were secured in place for use and the means simply involved a selection for the purpose, *held*, that there was no invention in selecting the particular means employed by the applicant regardless of whether his particular means had ever been used to attach the device to its place or not. *Ex parte Fergusson*, 66 O. G. 651, C. D. 1894.

343. Where the only differences between the pumps in the application and the references consist in mere variations of detail in the applicant's construction of the pump to adapt it to the particular uses he has in mind, *held*, that such differences do not show invention nor mechanical skill in advance of that revealed in the references. *Ex parte Thomson*, 66 O. G. 1447, C. D. 1894.

344. Where a claim in an application for a striker plate had been rejected by the commissioner for want of patentable novelty and such rejection acquiesced in, a claim by the same inventor in another application for the combination of a door or casing and the striker plate *held* not patentable. *In re Forg, 66 O. G. 515, C. D. 1894.

345. Where the change consisted in widening a pawl of a ratchet-wheel so that its heel would rest upon the tooth behind it and be prevented from turning, *held*, to be a modification so obvious to a person skilled in that subject as not to have required anything more than the ingenuity which such a person might be expected to possess. *Wells v. Curtis, 74 O. G. 495, C. D. 1896.

346. There is no invention in simply clamping an open ring of metal around a braided or twisted rope to prevent unbraiding or untwisting. *Covert v. Travers Brothers Co., 75 O. G. 349, C. D. 1896.

347. It is not invention to insert an additional gear and pinion-wheel in a train of such wheels; nor is it invention to substitute a reacting spring at one end of the train of motion for a similar spring at the other end. *New Departure Bell Co. v. Bevin Bros. Mfg. Co., 75 O. G. 2196, C. D. 1875.

348. It does not require invention merely to unite two short cars so as to make a single long car with a transverse platform running across its center. *Chesterman v. Lindell Ry. Co., 76 O. G. 479, C. D. 1896.

349. There is no patentable invention involved in swaging or striking up by means of a die, from a blank of iron or steel, a rail-brace of a form which had previously been made of cast metals. (*Kilbourne v. W. Bingham Co.*,

60 O. G. 577, 1 C. C. A. 617, 50 Fed. Rep. 697, followed.) *Strom Mfg. Co. v. Weir Frog Co., 77 O. G. 1125, C. D. 1896.

350. Notwithstanding that appellant's device may be superior in finish, neater in appearance and generally better adapted for the uses for which it was intended than the devices which it might have displaced, yet it is not a patentable device. *Ex parte Ellison*, 61 MS. D. 435, June, 1897 (Butterworth, Com'r).

351. It does not involve invention to provide channels or grooves in the counter-die of a press to co-operate with the embossing-rules of the die for creasing the fold-line of a paper-box blank. *National Folding Box and Paper Co. v. Stecher Lithographic Co., 78 O. G. 1253, C. D. 1897.

352. The particular way of hanging a door does not involve invention and is not sufficient to sustain the validity of a patent. *Green v. American Soda Fountain Co., 78 O. G. 1105, C. D. 1897.

353. The mere enlargement of a covering-box, shield or plate of a holding-stud of a garment-supporter, so as to allow greater space within said box, is not the result of an application of the inventive faculty. *Draper v. Seymour, Com'r of Patents, 79 O. G. 864, C. D. 1897.

354. A claim for a ring having an inwardly-extending flange and a cross fastened down on the latter, for the purpose of holding a paper-pulp barrel while drying, is doubtfully patentable, in view of the use of rings for similar purposes in this and analogous arts. It is not infringed by the use of a plain, angle iron ring, having no similar flange nor supporting cross. *Keyes v. United Indurated Fibre Co., 82 Fed. Rep. 32 (1897).

PATENTED ARTICLE OR MACHINE.

(See RIGHT TO MAKE, USE AND SELL.)

PATENTS.

(See ANTICIPATION; CLAIMS—PATENTABILITY; INTERFERING PATENTS; SUBSEQUENT APPLICATIONS; WITHDRAWAL FROM ISSUE; WITHHOLDING FROM ISSUE.)

- I. PATENTS, IN GENERAL.
- II. PRESUMPTION OF VALIDITY.
- III. DEFECTIVE OR VOID.
- IV. CONSTRUCTION OF, IN GENERAL.

- V. CONSTRUCTION OF, LIBERAL OR BROAD.
- VI. CONSTRUCTION OF, BY DRAWINGS.
- VII. CONSTRUCTION OF, BY SPECIFICATIONS.
- VIII. CONSTRUCTION OF, BY STATE OF ART.
- IX. CLAIMS FOR COMBINATION.
- X. CLAIMS LIMITED BY THEIR TERMS.
- XI. CLAIMS LIMITED BY AMENDMENT IN PATENT OFFICE.
- XII. CLAIMS CONSTRUED BY REFERENCE LETTERS IN DRAWING.
- XIII. TO ASSIGNEES.
- XIV. TO DECEASED INVENTORS.

I. PATENTS, IN GENERAL.

1. There may be many modes of effecting a desired result, but every patent must rest upon its mechanical devices therefor. *Steam Gauge and Lantern Co. v. St. Louis Railway Supplies Mfg. Co., 38 O. G. 107, C. D. 1887.

2. The constitutional grants of power to congress to legislate upon patents for lands and for inventions are substantially alike, and such patents are of the same nature, character and validity. *The United States v. The American Bell Telephone Co., 45 O. G. 1311, C. D. 1888.

3. A patent is addressed to those having a peculiar and technical knowledge of the subject. (Loom Co. v. Higgins, 105 U. S. 580.) *Electrical Accumulator Co. v. Julien Electric Co., 38 Fed. Rep. 117 (1889).

4. A patent for an invention conveys nothing which the government owns or its predecessor ever owned, is the evidence of the inventor's exclusive right, and creates for him a property interest, which government secures to him by a grant. *Marsh v. Nichols, Shepherd & Co., 46 O. G. 239, C. D. 1889.

5. This grant, however, is regulated by statute, and requires the signatures of all the officials required by statute. *Id.

6. A patent issued to an applicant is only *prima facie* evidence that he is the inventor. *Kennedy v. Hazelton, 46 O. G. 973, C. D. 1889.

7. Theoretically, an inventor in taking out a patent under the statutes of the United States subtracts nothing from and adds nothing to his actual invention, and, except for the provisions which for public interests require in a patent a description and claim, the same unrestricted rules of the common law would protect an inventor's statute right as are relied on to support a trade-mark or business goodwill. *Reece Button-Hole Machine Co. v. Globe Button-Hole Machine Co., 67 O. G. 1720, C. D. 1894.

8. A monopoly depending upon the merits of an invention to which it is a mere incident is neither obnoxious to public policy nor an illegal restraint of trade. *Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co., 78 O. G. 171, C. D. 1897.

9. The property right of a patentee is but a property right and is subject to the general law of the land. He may not, by virtue of his patent, make illegal contracts or do any other illegal acts. A prohibited business is not protected by the patent laws because it is conducted through instrumentalities which are the subject of patent-rights. *Id.

(A right of property may legally exist in an unpatented invention or discovery, if kept secret, which a court will protect. †Salomon v. Hertz, 35 O. G. 1109, C. D. 1886, following Peabody v. Norfolk, 98 Mass. 452.)

II. PRESUMPTION OF VALIDITY.

10. To overthrow the presumption arising from the patent the evidence should be satisfactory, convincing. *Vulcanite Paving Co. v. American Artificial Stone Pavement Co., 42 O. G. 828, C. D. 1888.

11. A presumption of validity arising from a successful interference in the patent office only applies against the parties to the interference and their privies. It does not extend to litigants who do not make the infringing article under a grant from the interferer. *Edward Barr Co. (Limited) v. New York and New Haven Automatic Sprinkler Co., 43 O. G. 392, C. D. 1888.

12. The rule is well settled that the production of letters patent for a design establishes a *prima facie* right in the patentee which can only be defeated by proofs which are of convincing force. *Untermeyer v. Freund, 47 O. G. 527, C. D. 1889.

13. The fact that in its progress through the patent office the specification and claims of the patent in suit were made more clear and accurate, so as to express the patentee's actual invention, affords no reason for casting doubt upon the validity of the patent. *Pullman's Palace Car Co. v. Boston and Albany R. Co., 53 O. G. 1255, C. D. 1890.

14. The fact that the patent has been unquestioned for more than five years, during which time the machines have been put on the market and largely advertised and over a million dollars have been invested in their manufacture, even if there has been no prior adjudication in its favor, sufficiently fortifies the *prima facie*

presumption of the patent. *National Typographic Co. v. New York Typograph Co., 56 O. G. 661, C. D. 1891.

15. In an interference between a patent and an application, where the question was not one of independent origination, but a dispute over the invention of the specific thing patented, the natural presumption existing in favor of validity of the patent is greatly strengthened by the fact that the junior party to the interference had full knowledge of the patentee's proceedings before the office, but was fifteen months behind him in filing his application. Hisey v. Peters, 58 O. G. 1691, C. D. 1892.

16. The rule is well settled that complainant's introduction in evidence of his patent in due form is sufficient to show that he is the first and original inventor of his device or improvement, as defined and construed by the courts, unless sufficient evidence to overcome that presumption and to establish the contrary allegation of the answer is exhibited in the record. The burden of proof is on the defendant to show that the patentee was not the original and first inventor. *Page Woven Wire Fence Co. v. Land, 59 O. G. 159, C. D. 1892.

17. A patent subsequently granted to the defendant does not overcome this *prima facie* presumption in favor of the prior patentee. (Citing Goodyear Dental Co. v. Gardner, 4 Fish. 224.) *Id.

18. Where the question of invention is closely balanced, the presumption in favor of the patentee arising from his recognition as an inventor by the patent office will incline the court to sustain his patent. *Watson v. Stevens, 60 O. G. 1884, C. D. 1892.

19. The law is settled that, as to every point touching the validity of a claim, the patent itself is *prima facie* evidence (Mitchell v. Tilghman, 19 Wall. 287), although often very slight and purely technical. *Chase v. Fillebrown, 58 Fed. Rep. 374 (1893).

20. The existence of letters patent issued in due form is *prima facie* evidence of the validity of the patent. *Hunt Bros. Fruit Packing Co. v. Cassidy, 62 O. G. 1965, C. D. 1893.

21. The presumption is against the suggestion of inadvertence in the grant of a patent, and is always, in the absence of proof or substantial identity of claim, that the patent was granted in full view of the application. Edison v. Ball, 71 O. G. 1313, C. D. 1895.

22. "Not only in the courts, but within the office as well, the patent as it stands is *prima facie* correct and valid. . . . Once they are

issued, patents no longer come within the jurisdiction of the commissioner, except so far as they may be indirectly affected by a decision upon the question of priority upon a clear showing that against the presumption attaching to a patent another patent for the same invention to another person is decreed to issue." *Carty v. Kellogg*, 73 O. G. 285, C. D. 1895.

23. *Prima facie* letters patent are evidence that all the requirements of the statute have been fully complied with, and if it be true that the patentee has been at no pecuniary expenditure in realizing the conception of the design it follows, presumably, that no such expenditure was demanded by the circumstances. The burden of showing the necessity of such expenditure is upon the defendant in any case. **Matthews & Willard Mfg. Co. v. Treuton Lamp Co.*, 75 O. G. 674, C. D. 1896.

III. DEFECTIVE OR VOID.

(See CLAIMS FOR COMBINATION.)

24. Where only mechanical skill is required to supply defects in the invention as described, such defects do not render the patent invalid. **Temple Pump Co. v. The Goss Pump and Rubber Bucket Mfg. Co.*, 39 O. G. 467, C. D. 1887.

25. Where the patent describes an element as concavo-convex, the degree of concavity or convexity is left to practical experience and judgment, and the validity of the patent is not affected. **Id.*

26. In the particular instance the claims were for the combination of the two elements, no matter how or by what means it might be effected, and such a patent cannot be sustained. **The Thatcher Heating Co. v. Burtis*, 39 O. G. 587, C. D. 1887.

27. A patent based on an alleged combination which is inoperative without the addition of another element is void. **Tarrant v. Duluth Co.*, 39 O. G. 1425, C. D. 1887.

28. A patent covering an article possessing no novelty in the features claimed, and only in a feature unclaimed, cannot be sustained. **Ingham v. Pierce*, 42 O. G. 1062, C. D. 1888.

29. It is fatal to a patent for a process that a patentee claims as essential a step which is unnecessary. **Van Camp v. The Maryland Pavement Co.*, 43 O. G. 884, C. D. 1888.

30. The taking of the oath is in no degree essential to the validity of a patent. **The Holmes Burglar Alarm Telegraph Co. v. The Domestic Telegraph and Telephone Co.*, 51 O. G. 2083, C. D. 1890.

31. Where a patent is void *ab initio*, no rule of estoppel can be invoked to aid a complainant thereon, since no act of an individual can vitalize and make valid a patent which never had validity or took effect as a grant. **De La Vergne Refrigerator Machine Co. v. Featherstone*, 58 O. G. 1842, C. D. 1892.

32. Where experiment and inventive skill on the part of a skilled operator or user are necessary in addition to the instructive statements of the specifications to render the invention available and the use successful, *held*, that the patent is fatally defective and the patent based thereon void. (*Lockwood v. Faber*, 27 Fed. Rep. 63; *McNamara v. Hulse*, 2 Web. 128; *Tyler v. Boston*, 7 Wall. 327.) **The Tannage Patent Co. v. Zahn*, 71 O. G. 1161, C. D. 1895.

33. Where a specification fails in any material respect to make the invention fully known and accessible to the public skilled in the art to which the invention relates, *held*, that it is fatally defective, and the patent based upon it *ipso facto* becomes void. (*Wayne v. Holmes*, 2 Fish. 20.) **Id.*

34. The very fact that a machine is patented is some evidence of its operativeness as well as of its utility, and where a model is constructed after the design shown in a patent which is not perfectly operative, but can be made so by a slight alteration, the inference is that there was an error in working out the drawings, and not that the patentee deliberately took out a patent for an inoperative device. **Dashiell v. Grosvenor*, 75 O. G. 507, C. D. 1896.

35. Where the patentee at the time of his application considered that a dye to be used should be waterproof and that the yielding surface used in polishing must be an inflated air-cushion, neither of which facts was disclosed by the specification, *held*, that the patent is void because of implied purpose to deceive the public. **Electric Boot and Shoe Finishing Co. v. Little*, 77 O. G. 456, C. D. 1896.

IV. CONSTRUCTION OF, IN GENERAL.

36. In determining the question whether a patent is operative, the workings, not of a machine made as a literal copy of the drawings of the patent, but of one made with the mechanical devices which will tend to make a machine practical and operative, and which are within the duty of the mechanic, are to be considered. **Royer v. Coupe*, 30 O. G. 239, C. D. 1887.

37. A claim in a patent cannot be changed by intendment when the effect of such change will make such claim precisely like another claim in the same patent. *Fillee v. Littlefield Stove Co., 39 O. G. 1203, C. D. 1887.

38. The specification and the claim of the patent described the invention as a method of "tempering." The word "tempering" is to be construed as the particular method described, and not as the usual method of "tempering." *Cary v. Lowell Mfg. Co. (Limited), 40 O. G. 1239, C. D. 1887.

39. It being expressly stated in the specifications attached to a patent that the claimant makes no claim to a certain combination patented by another, held, that the patent conferred no right to the use of such combination. *Shaver v. Skinner Mfg. Co., 41 O. G. 232, C. D. 1887.

40. The sound of articulate speech is one of the "vocal or other sounds" referred to in Bell's patent. The art or process described in said patent consists in gradually changing the intensity of a continuous electric current so as to make it correspond exactly to the changes in the density of the air caused by the sound of the voice, and devising a way in which these changes of density could be made and speech actually transmitted put the art in a condition for practical use. In doing this both discovery and invention, in the popular sense of these terms, were involved—discovery in finding the art and invention in devising the means to make it useful. A patent for the art does not necessarily involve a patent for the particular means for doing it, and the mention of means in the specification is only necessary to show that the art can be used to advantage. *Dolbear v. American Bell Telephone Co., 43 O. G. 377, C. D. 1888.

(Decision of United States supreme court in "The Telephone Cases.")

41. What Bell claims is the art of creating changes of intensity in a continuous current of electricity exactly corresponding to the changes of density in the air caused by the vibrations which accompany vocal or other sounds, and of using that electrical condition thus created for sending and receiving articulate speech telegraphically. *Id.

42. This claim is not in opposition to the decision in O'Reilly v. Morse, but is sustained by it, as this claim is not for the use of a current of electricity in its natural state as it comes from the battery, but for putting a continuous current in a closed circuit into a cer-

tain specific condition, suited to the transmission of vocal and other sounds and using it in that condition for that purpose. *Id.

43. It may be that electricity cannot be used at all for the transmission of speech except in the way Bell has discovered, and that therefore, practically, his patent gives him its exclusive use for that purpose; but that does not make his claim one for the use of electricity distinct from the particular process with which it is connected in his patent. *Id.

44. A claim in the following words, namely: "In a concrete pavement, the use of crushed and pulverized rock, when the same is heated and saturated with dead-oil, crude petroleum or the residuum of petroleum, and mixed with natural asphaltum, Cuban, Trinidad or California, previously dissolved to a pitch by crude petroleum or the residuum of petroleum, substantially as described, and for the purpose set forth," construed as for a process, and also as for a process in which the previous saturation of the rock with dead-oil, crude petroleum or the residuum of petroleum is one of the essential steps. *Van Camp v. The Maryland Pavement Co., 43 O. G. 884, C. D. 1888.

45. Under a proper construction of the language such a claim as the foregoing cannot be held to cover both a process and also a composition of matter. *Id.

46. A claim for a composition of matter which is described by the process of making it, sustained. *Id.

47. Where an applicant's specification describing a process closed with the words "and then coated with a thin layer of varnish," but his claims omitted any mention of this step, and it appearing it was not mentioned in the original statement of invention, nor in the original claims, such step need not be treated as an essential part of the invention. Ex parte Koller, 41 MS. D. (1 G. W. D.), Nov., 1889 (Mitchell, Com'r).

48. The first six claims of Patent No. 219,208, granted September 2, 1879, to Charles F. Brush, in view of the fact that he was a pioneer in this branch of electrical construction, construed to cover all forms of mechanism constructed to separate the two or more pairs of carbons "dissimultaneously" or successively, in order that the light may be established between the members of but one pair or set at a time, while the members of the remaining pair are maintained in a separated relation. *Brush Electric Co. v. Western Electric Light and Power Co., 52 O. G. 1950, C. D. 1890.

49. The word "dissimultaneous" used in said claims of said patent construed as referring to that separation which results in the production of a single arc. *Id.

50. The claim involved a friction-plate or pressure contrivance for retarding the force of rebound; *held*, that it must be construed to be one for the application of friction to retard movement unlimited to any particular form or character of mechanical means for effecting such application, and could not be upheld. *Dederick v. Seigmund, 52 O. G. 1537, C. D. 1890.

51. A correspondence between the inventor and the patent office prior to the grant of the patent cannot control the import of claims the terms of which are not ambiguous. *Sugar Apparatus Mfg. Co. v. Yaryan Mfg. Co., 53 O. G. 920, C. D. 1890.

52. The act of July 4, 1836, provides for granting a patent for any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement in any art, machine, manufacture or composition of matter. *Held*, that this patent, which is for an apparatus for improvement in the construction of prisons, was not granted for an art or a process, and that it was not a manufacture or a composition of matter. *County of Fond du Lac v. May, 53 O. G. 1884, C. D. 1890.

53. The result or operation of the Day and Brush lamps held to be widely different; the complainants' lamp burns its carbons by alternate arcs between each pair, necessarily producing a light unsteady and unsatisfactory and varying in intensity, because the increase of distance between the burning carbons causes the light to weaken and finally to form the arc between the other pair of carbons, to repeat the same process of weakening the light until it shifts back to the first pair, and so on, while in defendants' lamp the light burns steadily until the pair of carbons between which it is first produced are wholly consumed, when it shifts to the other pair and consumes those. *Seeley v. The Brush Electric Co., 54 O. G. 661, C. D. 1891.

54. It is the duty of courts to construe a patent by a reference to the language of its claims and an examination of the specifications and drawings accompanying the same. *Norton v. Jensen, 60 O. G. 1326, C. D. 1892.

55. The question of the construction of the claims of a patent is the province of the court and does not rest with the jury. *Marsh v. Quick Meal Stove Co., 60 O. G. 1056, C. D. 1892.

56. Where a claim of a patent reads "In a gasoline stove, etc.," and then enumerates a number of other elements, the words "In a gasoline stove" will be understood as including the well-known essential elements of such stoves, and to enable the plaintiff to recover the other elements of the claim or their substantial equivalents must be all found in the defendant's stove. *Id.

57. Broad and narrow claims on the same invention are not to be so construed as to render their expressed distinctions meaningless. The distinction between them must be maintained, that both may be given effect. *National Cash Register Co. v. American Cash Register Co., 62 O. G. 449, C. D. 1893.

58. The language of a claim is to be read with reference to the purpose to be accomplished by the invention, and the phrase "a continuous-cutting edge" when applied to a fruit-parer means a cutting edge continuous in action, an edge which continuously cuts, and is not limited to an edge free from any nick or notch whatsoever therein. *Sayre v. Scott, 63 O. G. 1818, C. D. 1893.

59. The supreme court, construing the claims of the telephone patent, says: "The claim is not for these several things in and of themselves, but for an electric telephone in the construction of which these things or any of them are used." *American Bell Telephone Co. v. Cushman, 65 O. G. 135, C. D. 1893.

60. The construction of two patents and determination of the identity of the inventions described and claimed therein are matters of law for the court to determine. (Heald v. Rice, 21 O. G. 1443, 104 U. S. 749.) *Miller v. Eagle Mfg. Co., 66 O. G. 845, C. D. 1894.

61. In construing a patent the courts are necessarily subject to the restraints arising from the incorporation into them of the description and claim which the statutes require, but it must be the rule in interpreting these that it is to be presumed the inventor did not intend to split up his invention. *Reece Button Hole Machine Co. v. Globe Button Hole Machine Co., 67 O. G. 1720, C. D. 1894.

62. The maxim *enumeratio unius exclusio alterius* by reason of the doctrine of equivalents does not apply as fully to patents as to instruments in general. *Id.

63. If the recitals of the state of the art in the specification do not tend to limit, explain or nullify the grant, they are of no possible pertinence; but if they do have such tendency the patentee is bound thereby, and the patent must

be construed in the light of the facts so recited. *Heaton Peninsular Button-Fastener Co. v. Schlocht-Meyer Button-Fastener Co., 69 Fed. Rep. 592 (1895).

64. The claim of E., copied from B.'s patent, held not the same as the original method claim of E., reciting a different sequence of steps. Edison v. Ball, 71 O. G. 1313, C. D. 1895.

65. Where a claim of a patent does not in terms include a certain element included in another claim, but such element is recognized in the specification as being necessary, the attempt to create a distinct and separate invention out of the first claim and to differentiate it from the actual invention of the second claim has the fault of adhering to technicality without regard to substance. *Appleton v. Ecaubert, 71 O. G. 1617, C. D. 1895.

66. After a disclaimer under the statute a patent is to be construed by what remains. *Schwarzwalder v. New York Filter Co., 72 O. G. 1043, C. D. 1895.

67. In comparing patents, in order to ascertain whether they cover the same or different inventions, not only the face of the patents but also evidence concerning the construction and operation of devices made in alleged exemplification of the patented devices should be considered. *Thomson-Houston Electric Co. v. Western Electric Co., 75 O. G. 347, C. D. 1896.

68. Distinctly different results perceived and understood by the mere practical use of the devices of different patents constitute a fair and liberal test for diversity of invention. *Id.

69. In a claim for a particular form of spindle and support there is no necessity for expressing in terms the devices for revolving the spindle, since the appropriate means for operating it will be understood. *Taylor v. Sawyer Spindle Co., 77 O. G. 452, C. D. 1896.

70. The terms "inward delivery" in a claim for an excavator have direct reference to the mechanism itself, and cannot properly be limited to the description or effect of such mechanism. The clear meaning of a claim to "an excavator having inward delivery" or "with inward delivery through itself" is an excavator so constructed as to produce an inward delivery. *Von Schmidt v. Bowers, 80 O. G. 347, C. D. 1897.

71. The unnecessary designation of certain elements in a claim does not invalidate it. *American Street Car Advertising Co. v. Newton Street Ry. Co., 81 O. G. 506, C. D. 1897.

V. CONSTRUCTION OF, LIBERAL OR BROAD.

72. Where it does not appear in evidence that the object desired and claimed has been accomplished by any analogous method before the patentee conceived and described the means of effectuating it, he is fairly entitled to all the benefits his patent was intended to confer upon him. *Kirk v. Du Bois, 42 O. G. 297, C. D. 1888.

73. Where a claim calls for a device "as an attachment" to something it may be subject to the construction that it is a claim for the device baldly, and the words descriptive of its use rejected as surplusage, on the theory of Roberts v. Ryer (91 U. S. 157), that a patent covers a device in all the uses to which it may be applied. *McClain v. A. Ortmayer & Son, 42 O. G. 724, C. D. 1888.

74. Where a patentee says that he expects in practical operation to use a device—as, for example, a rivet—to accomplish a certain thing, but does not confine himself specifically to it, any other device which secured the result intended would be allowable and open to him. *Id.

75. While a patent is to be liberally construed, so as to sustain it as a grant of the invention actually made and actually claimed, it can never by judicial construction be made to cover an invention nowhere claimed in it, and which the public has had no fair notice that the patentee intended to claim. *Van Camp v. The Maryland Pavement Co., 43 O. G. 884, C. D. 1888.

76. A claim to a combination covers all the effects produced by the combination, even when such effects are not specifically set forth in the specification. *Thompson v. American Bank Note Co., 45 O. G. 347, C. D. 1888.

77. A patent for a primary invention will not receive a liberal or broad construction where the invention is of a very low order. *Dederick v. Seigmund, 60 O. G. 1193, C. D. 1892.

78. Courts do not construe letters patent for the purpose of their destruction nor in the critical and hostile spirit which a plea in abatement formerly encountered. *Electrical Accumulator Co. v. Brush Electric Co., 61 O. G. 886, C. D. 1892.

79. The claim of a patent for a primary invention should be as liberally interpreted as its fair import will allow, to the end that the inventor's conception shall be justly protected to

its true extent and in its broad and actual scope. *National Cash Register Co. v. American Cash Register Co., 62 O. G. 449, C. D. 1893.

80. In such a claim, while it may be true that particular mechanism is mentioned, it does not necessarily result that the patentee intended to limit the claim to any special devices or that the law will so restrict it. *Id.

81. Where a patentee has made a meritorious invention the court should not be overzealous in trying to defeat him by an illiberal construction of the patent. On the contrary, the court should seek a construction which gives life to the patent and protection to the inventor. *Lalace & Grosjean Mfg. Co. v. Habermann Mfg. Co., 62 O. G. 452, C. D. 1893.

82. While courts have no right to enlarge a patent beyond the scope of its claims as allowed by the patent office, the inventor is entitled to a liberal construction to secure to him his actual invention. (Citing *Winans v. Denmesd*, 15 How. 341.) *Brush Electric Co. v. Electric Improvement Co. of San José, 62 O. G. 1651, C. D. 1893.

83. Unambiguous terms in a claim should not be given a narrow or forced construction not required by the state of the art which practically would defeat the patent. *Sayre v. Scott, 63 O. G. 1818, C. D. 1893.

83a. While a claim should not be construed so as to expand it, on the other hand it should not be given a narrow interpretation which would defeat the patent, unless absolutely required by the state of the art. *Id.

84. Meritorious inventions of primary character call for liberal interpretation. (*Tilghman v. Proctor*, 19 O. G. 859, 102 U. S. 707; *Morley Machine Co. v. Lancaster*, 47 O. G. 267, 129 U. S. 263; *Béné v. Jeantet*, 47 O. G. 403, 129 U. S. 693.) *Celluloid Mfg. Co. v. Arlington Mfg. Co., 64 O. G. 1263, C. D. 1893.

85. Patentee is entitled to all the advantages incident to the patented apparatus, even though not described in the specification or originally perceived by the inventor. (*Roberts v. Ryer*, 10 O. G. 204.) *Aerated Fuel Co. v. Woodbury Glass Co., 64 O. G. 1266, C. D. 1893.

86. Although the complainants have not made a pioneer invention in the broad sense of the term, they are entitled to a construction liberal enough to cover a machine which in the same art performs the same work in manner almost identical. *Loewer and Schelter v. C. P. Ford & Co., 64 O. G. 1236, C. D. 1893.

87. The fact that the pioneer machine, when first produced, failed to produce an absolutely

perfect "linotype," which fault was remedied, however, by the patentee, and perfect justification produced by improved machines subsequently made by others, is no reason for denying relief to the pioneer patentee to the full extent of his invention. *Mergenthaler Linotype Co. v. Press Publishing Co., 65 O. G. 2062, C. D. 1893.

88. *Held*, that an inventor is entitled to all the necessary and legitimate results attained by his invention, including such as were not foreseen. It is the thing, and not the uses which it may be found capable of, which is patentable. *National Meter Co. v. Thomson Meter Co., 70 O. G. 925, C. D. 1895.

89. Commercial success of a patented article due to the demand caused by a change of fashion and to extensive and seductive advertisement will not serve to broaden the scope of the patent. *Richardson v. America Pin Co., 75 O. G. 351, C. D. 1896.

90. Where the true value of the invention lies in one element of a combination, and an infringer has appropriated that, he should not be permitted to escape upon the plea that he has omitted a subordinate and comparatively non-essential feature unless it is clear that he has omitted it. To find an invention meritorious and then defeat it by an illiberal construction is as inconsistent as it is unfair. To decide that an inventor has conferred a benefit upon mankind and subsequently destroy his patent by a harsh construction is condemned both by the general principles of equity and by express authority. The court should be diligent to give him the rewards of his genius and labor and resolve doubtful points in favor of the patent. *Gould Coupler Co. v. Pratt, 75 O. G. 1547, C. D. 1896.

91. The circumstance that a patentee, when an applicant, had no attorney is no reason for adopting any peculiarly liberal construction of his patent. *Gould Coupler Co. v. Trojan Car Coupler Co., 75 O. G. 2009, C. D. 1896.

92. So much of the mere form given in the specification, drawings and claim as is necessary to accomplish all the functions expressly enumerated is essential and must be retained. A function afterward discovered cannot be used to broaden a claim, and such function is available to the patentee only when the patent, construed in the light of the circumstances existing when it is applied for, is broad enough to embrace it. When there is nothing to show that the new function was in the mind of either the inventor or of the patent office when

the patent issued, it cannot be said that if the patent be narrow on its face it should be broadened out by construction to cover this new function. It would establish a very dangerous precedent to give to a mere paper patent which has lain dormant for years a breadth not contemplated on its face by reason of some new function discovered long after its issue and after that function had been availed of in practice by others. Such precedent, if established, would on the whole operate more to entrap honest manufacturers than to advance the useful arts. *Long v. Pope Mfg. Co., 77 O. G. 1428, C. D. 1896.

93. The principle that a patent should be construed in a liberal spirit to sustain the just claims of the inventor is not to be carried so far as to exclude what is in it or to interpolate anything which it does not contain; but liberality, rather than strictness, should prevail where the fate of the patent is involved and the question to be decided is whether the inventor shall hold or lose the fruits of his genius and his labors. *Matheson v. Campbell, 79 O. G. 684, C. D. 1897.

94. The Bowers patents disclose and cover inventions of a pioneer character, standing at the head of the art, and their claims are entitled to a broad and liberal construction. *Von Schmidt v. Bowers, 80 O. G. 347, C. D. 1897.

95. Said claims are not functional in form, nor are they claims for results, nor are they limited to any particular form of construction of the elements which make up the combinations, but they are broad generic claims without any limitation as to the form of construction of the particular elements. *Id.

96. If a reasonable doubt exists as to the novelty of an invention covered by a patent, it is to be resolved in favor of the patent. *Kinnear & Gager Co. v. Capital Steel Metal Co., 81 Fed. Rep. 491 (1897).

97. This patent held to cover a digester having a structural lining composed of materials possessing plastic, adhesive, cohesive and acid-resisting characteristics, and not to be limited to a lining of hydraulic cement or any other particular cementitious ingredient. *American Sulphite Pulp Co. v. Howland Falls Pulp Co., 80 O. G. 515 (1897).

98. The law applicable to the patent distinguished from that in the Incandescent Lamp Patent (159 U. S. 465). In the latter Sawyer and Mann did not limit themselves to a particular material, or even to a class; but the patentee limits himself to a class of material, and, still

further, within that class to a material possessing the required acid-resisting qualities. *Id.

99. A pioneer inventor is entitled to a patent covering his adaptation of the forces in matter which he has discovered and the compositions with which he has successfully experimented and such as would naturally develop in the growth of the art without invention, as well as those which he has described. *Id.

100. Where an invention consists of great merit and is a substantial advance over mechanical constructions heretofore used in the art to which it appertains, the claims of the patent should be such a construction as will give the patentee the full benefit of the mechanical advance which he has contributed to the mechanical arts and claimed. *Mitchell v. Ewart Mfg. Co., 80 O. G. 1762, C. D. 1897.

101. The device is wholly new. Nothing in anticipation thereof has been brought to the attention of the court nor cited by way of reference in the patent office. *Held*, patent is entitled to have such a broad construction put upon it as will enable the patentee to obtain the benefit of the full scope of his invention. *Forge v. Duff Mfg. Co., 81 O. G. 1113, C. D. 1897.

VI. CONSTRUCTION OF, BY DRAWINGS.

102. One part of the invention is properly described in the body of the specification, but the second part is not, although shown in the drawings. Doubtful and ambiguous specifications can be aided and made plain by drawings but the latter cannot supply an entire absence of description. The claim, which is broad enough to cover the second part of the invention, cannot be sustained. *Gunn v. Savage, 80 Fed. Rep. 366 (1887).

103. The drawings of a patent may be appealed to in construing its claims, if the language is ambiguous and leaves something for construction, but in this case the language of the claim is plain and the drawing, being inconsistent with it, cannot be used to elucidate it. *Kidd v. Horry, 83 Fed. Rep. 712 (1888).

104. The court below having decided where certain devices were shown in the drawing of the patent but not in terms referred to either in the specification or in the claims as a part of the invention, nor in any way alluded to, except incidentally in the specification, that the claims could not be thereby limited by construction to make such devices an essential feature of the invention, *held*, that the construction the court gave to the claims of the

patent as originally issued was indisputably correct. *Roemer v. Neumann, 49 O. G. 1535, C. D. 1889.

105. A claim containing as elements certain tubes, without specifying vertical or horizontal tubes, is not confined to vertical tubes, though the drawings show them only in this position, and their ends are designated as "upper" and "lower," where the invention clearly includes horizontal tubes, especially where, in other claims, the patentee intends to confine himself to vertical tubes, and he so expresses himself in plain language. *Sugar Apparatus Co. v. Yaryan Mfg. Co., 53 O. G. 920, C. D. 1890.

106. The drawings are illustrative and explanatory, but not definitive, and are only to be treated as part of the description of the thing patented. *Perrin v. Manhattan Ry. Co., 62 O. G. 1209, C. D. 1893.

107. Although the drawing of a patent shows knives of a cutter-head set at a certain angle, this will not enable the patentee to rest his invention on that particular degree of angularity when there is nothing in the specification to show that it is intended to limit the pitch of the knives to that angle. *Caverly v. Deere, 73 O. G. 1711, C. D. 1895.

VII. CONSTRUCTION OF, BY SPECIFICATION.

108. Where the patented invention is but one of a series of improvements, all having the same general object and purpose, the claims of the patent must be restricted to the precise form and arrangement of the parts as described in the specification and to the purpose indicated therein. *Bragg v. Fitch, 39 O. G. 329, C. D. 1887.

109. Claims must be construed by the language which the patentee has employed in his specification, and not by the language which he might have employed. *Patent Clothing Co. (Limited) v. Glover, 40 O. G. 1135, C. D. 1887.

110. Admitting the rule to be that a claim in a patent is to be construed with reference to the specification, yet, when the claim, considered with reference to the specification, is ambiguous, special significance should be attached to correspondence between the patentee and the patent office, showing how the latter construed it, and what was the extent of the monopoly intended to be granted. *Royer v. Schultz Belting Co., 50 O. G. 558, C. D. 1890.

111. Though a claim is to be construed in

connection with the explanation contained in the specification, and it may be so drawn as in effect to make the specification an essential part of it, yet the specification and drawings are usually looked at only for the purpose of better understanding the meaning of the claim and certainly not for the purpose of changing it and making it different from what it is. *The Howe Machine Co. v. The National Needle Co., 51 O. G. 475, C. D. 1890.

112. A patentee's claim is the measure of his right of relief, and while the specification may be referred to to limit the claim it can never be made available to expand it. *McClain v. Ortmyer, 57 O. G. 1129, C. D. 1891.

113. While the drawings only illustrate the invention in its application to railroad cars and to railroad cars having each two four-wheeled trucks, from the language of the specification it is apparent that the invention was designed to be applied to a series of vehicles of kinds that are not provided with four-wheeled trucks, but are usually provided with two-wheeled trucks. *Perrin v. Manhattan Ry. Co., 62 O. G. 1209, C. D. 1893.

114. The terms of the claim are co-extensive with the description of the patent. *Id.

115. The true meaning of claims must be gathered by comparing them with the context of the specification. *Celluloid Mfg. Co. v. Arlington Mfg. Co., 64 O. G. 1263, C. D. 1893.

116. Where claims in a patent are not supported by a description in the patent, such claims are of no validity. *Pacific Cable Ry. Co. v. Butte City Street Ry. Co., 66 O. G. 1758, C. D. 1894.

117. The specification in the case at bar was so referred to in the claims that either may aid in the interpretation of the other. (Pearl v. Ocean Mills, 11 O. G. 2, 2 Ban. & A. 469, Fed. Cas. No. 10, 876; Rob. on Pat., sec. 517.) *American Sulphite Pulp Co. v. Howland Falls Pulp Co., 80 O. G. 514, C. D. 1897.

VIII. CONSTRUCTION OF, BY STATE OF ART.

(See X, CLAIMS LIMITED BY THEIR TERMS.)

118. Claims must be construed with reference to the prior state of the art. *Grier v. Wilt, 38 O. G. 1365, C. D. 1887.

119. Hammerschlag, being a pioneer in the art described in his patent, is entitled to a broad construction of his claim in controversy. *Hammerschlag Mfg. Co. v. Bancroft, 40 O. G. 1339, C. D. 1887.

120. Where it does not appear in evidence that the object desired and claimed has been accomplished by any analogous method before the patentee conceived and described the means of effectuating it, he is fairly entitled to all the benefits his patent was intended to confer upon him. *Kirk v. Du Bois, 42 O. G. 297, C. D. 1888.

121. A claim for a process consisting of several steps may be limited by the state of the art and the description in the patent to the instrumentalities or their equivalents as thus described, which are essential in the carrying out of the process claimed. *Lawther v. Hamilton, 42 O. G. 487, C. D. 1888.

122. In cases where none of the elements of a combination is new nor is claimed separately and there are other similar kindred combinations in use, the evident tendency of late decisions is to limit the patentee to the particular form of the various elements composing the combination shown by his drawings. *Heine Safety Boiler Co. v. Smith Feed Water Heater and Purifier Co., 47 O. G. 1634, C. D. 1889.

123. The prior state of the art and the express language of the specification in Letters Patent No. 180,857 combine to restrict the second claim to the use of a stencil made by electric pen. *Edison v. Klaber, 47 O. G. 1486, C. D. 1889.

124. Claims of patents should receive such interpretation as will enlarge or restrict them, so as to cover the actual invention when not absolutely inconsistent with the language used by the patentee. (Winans v. Denmead, 15 How. 380; Van Martyr v. Miller, 15 Blatchf. 562.) If, upon the one hand, the state of the art shows the invention to have been a narrow one, a strict interpretation will be given the claims. (Manufacturing Co. v. Ladd, 102 U. S. 408.) And it is of no practical consequence whether such restrictions are imposed by the patent office or not. (Toepfer v. Goetz, 41 O. G. 933.) If, upon the other hand, the patentee has taken a decided step in advance of the state of the art at the time his application was filed, the courts will, if possible, construe the language of his claim so as to give him the full benefit of his improvement. (Turrill v. Railroad Co., 1 Wall. 491; Rubber Co. v. Goodyear, 9 id. 788.) *Consolidated Roller Mill Co. v. Coombs, 48 O. G. 255, C. D. 1889.

125. When a patentee is a pioneer in a branch of invention, his claims may be construed to cover all forms of mechanism constructed to effect the same result as the particular mechan-

ism covered by said claims. *Brush Electric Co. v. Western Electric Light and Power Co., 52 O. G. 1950, C. D. 1890.

126. In construing a claim, in view of the prior art, it cannot be limited beyond the plain import of its terms. It must have this effect or be disallowed. *Enterprise Mfg. Co. v. Deissler, 56 O. G. 1205, C. D. 1891.

127. It is true that when the invention is of a primary character a larger latitude is given to the equivalents which the patent includes than if the invention was a modification of a well-explored art; but this doctrine cannot be applied to primary invention of low order. *Dederick v. Seigmund, 60 O. G. 1193, C. D. 1892.

(See, also, *Vincent v. Rigby, 64 O. G. 861, C. D. 1893, and *Carter Mach. Co. v. Hanes & Co., 74 O. G. 1277, C. D. 1896.)

IX. CLAIMS FOR COMBINATION.

(See CONSTRUCTION OF CLAIMS; PATENTABILITY—COMBINATION; PATENTS DEFECTIVE AND VOID.)

128. Where a part of a machine covered by a combination patent is described in a claim as having a certain motion, that motion, as distinguished from the means of producing it, is not covered by the claim. *Royer v. Schultz Belting Co., 38 O. G. 898, C. D. 1887.

129. A claim for a combination of mechanical elements cannot be construed to cover a process or mode of operation, but must be limited to the mechanical features claimed and their equivalents. *Grier v. Wilt, 38 O. G. 1365, C. D. 1887.

130. Where the claim covered the combination of three elements, each designated by letter and by general description, it does not follow that the invention is confined to other particulars of construction of these elements described in the specification. *Temple Pump Co. v. The Goss Pump and Rubber Bucket Mfg. Co., 39 O. G. 467, C. D. 1887.

131. Claims must be construed with reference to the specification; and where the latter imposes a restriction or limitation upon an element of a combination, a claim for the combination cannot be so construed as to avoid such limitation. *Snow v. The Lake Shore and Michigan Southern Ry. Co., 39 O. G. 1081, C. D. 1887.

132. Where a claim in a patent is for a combination of several elements, and it appears in evidence that the combination is inoperative without the addition of another element, such

claim is void. *Tarrant v. Duluth Lumber Co., 39 O. G. 1425, C. D. 1887.

133. In claims for combinations it is unnecessary to include any elements except such as are essential to the peculiar combination and affected by the invention. *Rapid Service Store Ry. Co. v. Taylor, 42 O. G. 721, C. D. 1888.

134. Where a claim covered the combination of one element named with another element named, "or other part," these last words would mean some other equivalent part and the claim would be sufficiently certain. *Babcock & Wilcox Co. v. Pioneer Iron Works, 43 O. G. 756, C. D. 1888.

135. While the law recognizes the patentability of a combination of old devices producing a new and useful result, it patents the entire combination, and not any single element of it, nor any combination containing different or other elements. *Dudley E. Jones Co. v. Munger Improved Cotton Machine Mfg. Co., 5 O. G. 274, C. D. 1892.

136. The claims being for combinations expressed in broad and general terms, they are to be construed in the light of the specification and each claim is to be "regarded as including such devices and combinations as are necessary to meet the requirements of the general terms in which it is expressed." *Illinois Watch Co. v. Robbins and Avery, 61 O. G. 721, C. D. 1892.

137. In a combination patent it is permissible for the patentee, after claiming the whole machine, to claim the combination of fewer parts than the whole, if this combination of parts is new, even though, taken alone, it will not result in any known useful product. (Wells v. Jaques, 5 O. G. 864, followed.) *Roberts v. H. P. Nail Co., 63 O. G. 613, C. D. 1893.

138. The claim 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. *Deering v. Winona Harvester Works, 69 O. G. 1641, C. D. 1894.

139. In claims for combination of a spindle, supporting tube and other connected parts, it is not necessary to specify, in terms, the device for revolving the spindle. Any suitable means will be understood. *Taylor v. Sawyer Spindle Co., 75 Fed. Rep. 301 (1896).

140. It is not requisite to include in a claim as elements thereof parts of the machine which are necessary to its action so far as they may be understood and can be supplied by those

who are ordinarily skilled in the art. *American Street Car Advertising Co. v. Newton Street Ry. Co., 81 O. G. 506, C. D. 1897.

X. CLAIMS LIMITED BY THEIR TERMS.

(See VIII, STATE OF ART, *supra*.)

("The claim is a statutory requirement prescribed for the very purpose of making the patentee define precisely what his invention is, and it is unjust to the public as well as an evasion of the law to construe it in any manner different from the plain import of its words." White v. Dunbar, 26 O. G. 353, 119 U. S. 47, C. D. 1884.)

141. Where certain of the claims of a patent give to an element in a combination a particular mechanical construction, the same element without such description of mechanical construction occurring in combination in other claims must be limited to the particular mechanical construction, where no other mechanical construction is described in the patent. *Railway Register Mfg. Co. v. Third Avenue Ry. Co., 42 O. G. 379, C. D. 1888.

142. Where the import is plain, resort cannot be had to the specification for the purpose of enlarging the scope of claims. *Id.

143. A patentee claiming a cement consisting of eight ingredients is limited thereto, although the specification states that one of said ingredients is to be used only when the cement is to be applied upon rough or uneven surfaces. The patent must stand or fall by the combination claimed. *Otley v. Watkins, 86 Fed. Rep. 323 (1888).

144. While the specification makes many references to the use of the skein in the process of dyeing, which process of using might be patentable, it is not covered by the claims, and they rigidly control. *Grant v. Walter, 47 O. G. 1220, C. D. 1889.

145. Where persons so skilled in the construction of mechanical devices as in the present case disagree, the safer course to pursue is to take each patent—Pullman and Sessions—as it stands and give to each inventor no more and no less than what he describes and claims as his invention. *Pullman's Palace Car Co. v. Boston and Albany R. Co. 56 O. G. 1255, C. D. 1890.

146. When an inventor applies for a patent and clearly specifies and limits his invention and afterwards amends his application without disclosing any change of subject, and is granted a patent on his amendment, he is limited to the invention as he originally set it forth and is estopped from claiming that it covers something not included in the original application. *Will-

iams v. Goodyear Metallic Shoe Co., 58 O. G. 1257, C. D. 1892.

147. The patentee conceived the idea of gradually stopping the backward movement of the plunger in a rebound baling-press by applying a friction-brake. *Held*, that as friction-brakes are very old it was a low order of invention to apply such a brake to a baling-press, and a patent which with difficulty maintains its right to patentability must receive a narrow construction. *Dederick v. Seigmund, 60 O. G. 1193, C. D. 1892.

148. If the Fox machine could be held to show patentable invention, it constitutes one of a series of improvements, all having the same general object and purpose, and the patent must therefore be limited to the precise form and arrangement of parts described in the specifications and to the purpose indicated therein. (Bragg v. Fitch, 39 O. G. 829, 7 Sup. Ct. Rep. 980, 121 U. S. 483, and Phoenix Caster Co. v. Spiegel, 50 O. G. 1591, 10 Sup. Ct. Rep. 409, 133 U. S. 360, followed.) *Fox v. Perkins, 62 O. G. 160, C. D. 1893.

148a. This construction of the patent is also rendered necessary by the fact that various broader claims were rejected and abandoned under both the original and the re-issue applications. *Id.

149. Appellants' exclusive right may not be expanded by construction beyond the terms chosen to express the invention to include all means however differing in mode of action and principle from the process described in the patent. (McClain v. Ortmyer, 57 O. G. 1229, 141 U. S. 419.) *Celluloid Mfg. Co. v. Arlington Mfg. Co., 64 O. G. 1263, C. D. 1893.

150. The cancellation of the phrase "mechanical or cohesive action" from application by his own voluntary act indicated intention clearly inconsistent with defendant's present insistence. *Id.

151. *Held*, that where a claim calls for a particular device, the procuring by the patentee of a subsequent patent for a different device, which the defendants' device resembles, operated at least as a recognition on the part of the patentee and of the patent office that there is a patentable difference between the two, which may be fairly invoked to limit the patent to the specific means described in the claim. McCormick Harvesting Machine Co. v. C. Aultman & Co., 64 O. G. 1791, C. D. 1893.

152. There is no support for the proposition that, for the purpose of preserving the possibility of a function which the patentee had re-

puted before the patent issued, the claims, though worded differently, should be so read as to cover only the exact construction and relation of parts illustrated in the drawings.

*Western Electric Co. v. Sperry Electric Co., 65 O. G. 597, C. D. 1893.

153. In construing a claim elements will not be imported into it that would operate to so enlarge its scope as to cover an invention not indicated upon the face of the invention. (Day v. Railway Co., 49 O. G. 1364, 132 U. S. 98.) *Wollensak v. Sargent & Co., 66 O. G. 1007, C. D. 1894.

154. Where the claims are respectively drawn, the fact that the invention is a pioneer cannot serve to do away with the restrictions specified in the claims. *Groth v. International Postal Supply Co., 68 O. G. 413, C. D. 1894.

155. Where an element is described, declared to be an essential feature of the invention, and made an element in the claims, *held*, that the patentee is not at liberty to say that it is immaterial or that a device which dispenses with it is an infringement. (Vance v. Campbell, 1 Black, 427; Water-Meter Co. v. Desper, 101 U. S. 332; Gage v. Herring, 23 O. G. 2119, 107 U. S. 640, 648; Gould v. Rees, 15 Wall. 187; Brown v. Davis, 34 O. G. 435, 116 U. S. 237, 249.) *Wright v. Yuengling, 69 O. G. 639, C. D. 1894.

156. If patentable at all, a combination of old means with improvements adapting it to new and non-analogous material and use, a patent will be limited to the combination modified by the improvements. *Wright & Colton Wire-Cloth Co. v. Clinton Wire-Cloth Co., 72 O. G. 1046, C. D. 1895.

157. While a feature may be read into a claim with a view of showing the connection in which a device is used and proving that it is an operative device, an element which is not present may not be read into the claim for the purpose of making out a case of novelty or infringement. *McCarty v. Lehigh Valley R. Co., 73 O. G. 1707, C. D. 1895.

158. A statement in the specification that in the best methods of applying their invention the patentees use a supplemental device there described is not to be read, as a limitation, into a claim which contains no reference to it, especially when the significance of its omission is emphasized by its incorporation into a subsequent claim. *American Dunlop Tire Co. v. Erie Rubber Co., 74 O. G. 963, C. D. 1896.

159. Mere improvers in combinations of old elements and ingredients should be limited by

a strict construction of their patents, so as to leave the unappropriated field of art open to other improvers, that they may be encouraged to exercise their industry and inventive genius. *Carter Machine Co. v. P. H. Haines & Co., 74 O. G. 1277, C. D. 1896.

160. The fact that a patented device is meritorious is no reason why the patent should be construed to cover any other construction than that which was evidently in the inventor's mind and expressed in the specification. *Gould Coupler Co. v. Trojan Car Coupler Co., 75 O. G. 2009, C. D. 1896.

161. A claim for a street-car platform guard made of wire, *held* not so far limited that it would not be infringed by any screen in that place save one made of wire. *Johnson v. Brooklyn Heights R. Co., 75 Fed. Rep. 668 (1896).

162. The law is imperative that the language of the description and claims, when clear and unambiguous, must be adhered to, even though the court be of the opinion that the patentee has unnecessarily restricted his claims. *Beale v. Spate, 76 O. G. 965, C. D. 1896.

163. The statement of the specification that the patented pulleys are to be made of wood governs the construction of the patent, subject only to the expressed exceptions stated in a subsequent part of the specification. *Dodge v. Post & Co., 78 O. G. 339, C. D. 1897.

164. The duty of the court is to construe the claims according to the plain meaning of their words, and if the claims are susceptible of two interpretations that one should be chosen which upholds and vitalizes the patent; but this cannot be held to include the formulation of claims by reading into or adding to them elements or restrictions which are not therein set out and not referred to in the specification except by implication. *Paul Boynton Co. v. Marius Chute Co., 80 O. G. 1894, C. D. 1897.

XI. CLAIMS LIMITED BY AMENDMENTS IN THE PATENT OFFICE.

165. A patentee having, in compliance with the requirements of the patent office, excluded by amendment certain matter from his original specification, is not at liberty to insist upon a construction of his patent which will include what he was expressly required to abandon and disavow in it. *Sutter v. Robinson, 38 O. G. 230, C. D. 1887.

166. It is wholly irrelevant to inquire whether the patentee was obliged to limit himself by

the ruling of the patent office. It is enough to say that he did so limit himself. *Toepfer v. Goetz, 41 O. G. 933, C. D. 1887.

167. Where the applicant in soliciting a re-issue limits his claims in view of the objections of the patent office, he is bound by such limitation in subsequent suits upon that re-issue. *Crawford v. Heysinger, 42 O. G. 197, C. D. 1888.

168. As thus limited, the first and second claims of the Heyl re-issue cover only the precise combinations set forth in them, as described in the specifications and illustrated in the drawings of such re-issue. *Id.

169. The applicant adopted the advice of the examiners-in-chief and accepted a certain claim. If, now, the narrow construction which must be adopted by the court will render the patent virtually useless, it is a sufficient answer that the patent office contemplated this construction and would not otherwise have granted the patent. A broader construction would have given him precisely what the office refused. *Geis v. Kimber, 36 Fed. Rep. 105 (1888).

170. The intimation in *Sargeant v. Hall* (114 U. S. 38) that the limitations introduced into an application after it was persistently rejected must be strictly construed against the inventor and in favor of the public, and looked upon as in the nature of disclaimers, means no more than that when under the state of the art and the action of the office a patentee of a combination has modified and limited his claim he shall be held strictly to the combination as he has described it. It does not debar the patentee from the benefit of the doctrine of equivalents. *Rodebaugh v. Jackson, 47 O. G. 658, C. D. 1889.

171. Where a claim in complainants' application broad enough to cover the machine used by defendants was rejected on reference to a prior patent, and the applicant was compelled to present a new claim having a limitation not found in the claim first presented, the new claim cannot be enlarged to cover what was first rejected. *Rodebaugh v. Jackson, 47 O. G. 660, C. D. 1889.

172. A patentee will not be permitted to say that certain specified elements of his combination claim are not essential to the combination. *Watson v. The Cincinnati, Indianapolis, St. Louis & Chicago Ry. Co., 47 O. G. 1843, C. D. 1889.

173. The claim as allowed defines the patentee's invention, and it ought not to be enlarged beyond the fair interpretation of its terms. It would not be justifiable to import

into the claim an element which would operate to so enlarge its scope as to cover an invention in no manner indicated upon its face. *Day v. The Fair Haven and Westville Ry. Co., 49 O. G. 1864, C. D. 1889.

174. Where a patentee has modified his claim in obedience to the requirements of the patent office, he cannot have for it an extended construction which has been rejected by the patent office; and in a suit on his patent such claim must be limited, when it is a combination of parts, to a combination of all the elements which he has included in his claim as necessarily constituting that combination. *The Phoenix Caster Co. v. Spiegel, 50 O. G. 1591, C. D. 1890.

175. A restricted claim as finally formulated by an applicant for a patent and allowed by the office after the rejection of broader claims is strictly binding upon the patentee, and he is precluded from afterward insisting on a broader construction. *Lane v. Park, 59 O. G. 788, C. D. 1892.

176. Where the defendants claimed that while the claims originally presented by Brush were broad enough to cover the feature of the successive burning of the two pairs of carbons, yet these had been rejected as functional, and he had subsequently accepted narrower claims, and that consequently he could not thereafter claim by construction such feature. *Brush Electric Co. v. Western Electric Light & Power Co., 52 O. G. 1950, C. D. 1890.

177. Where it appeared that the original application for the first patent in suit included the device afterward patented in the second, and that in erasing a description of this there was also erased a description of a modification of the first, in which a "dome" placed above the evaporating tubes was dispensed with, and that the claims in issue did not include the dome as an element of the combination, *held*, that the claims should be construed to cover the combination set out therein, and that the word "dome" should not be read into the claims. *Sugar Apparatus Mfg. Co. v. Yaryan Mfg. Co., 53 O. G. 920, C. D. 1890.

178. A letter from applicant for patent replying to a rejection by the patent office, distinguishing a claim from the references cited against it by calling attention to the fact that the surfaces made an element therein were vertical, not horizontal, as in the alleged anticipation, affects no claim but the one rejected. *Id.

179. Where an applicant before the patent

office originally presents broad claims, and being rejected upon them by references to patents already granted, amends his specification and claims and is granted a patent upon the amended claims, he waives the broad claims of his first application and cannot afterward, in an action for infringement, broaden the scope of his invention by claiming that it was made before the anticipating patents issued. *Shaw Stocking Co. v. Pearson, 58 O. G. 948, C. D. 1892.

180. Whatever the date of the invention it must be construed with the limitations imposed by the patent office as a condition of the grant. *Id.

181. Where an applicant has acquiesced in the rejection by the patent office of his original claims by submitting amended claims and taking a patent therefor, the court will limit him to a strict construction of the allowed claims. *J. L. Mott Iron Works v. Standard Mfg. Co., 59 O. G. 2067, C. D. 1892.

182. Where a patentee, on the rejection of his application, inserts in his specification limitations and restrictions for the purpose of obtaining his patent, he cannot, after he has obtained it, claim that it shall be construed as it would have been if such limitations and constructions were not contained in it. *Royer v. Coupe, 62 O. G. 318, C. D. 1893.

183. Letters Patent No. 207,058, issued August 13, 1878, to Miller & Coll, for an improvement in sheet-metal cans, is, by reason of the rejection and abandonment of a broader claim, strictly limited to the form therein described. *Coll v. Seneca, 64 O. G. 1132, C. D. 1893.

184. Letters Patent No. 150,506, February 9, 1875, to Marquis L. Gorham, having been surrendered for a re-issue, which re-issue application contained claims substantially, if not identically, the same as the claims in the patent, together with other claims which were broader than the claims in the patent, and which broader claims and certain of the other claims as well were rejected, and which certain of the other claims are here sued on, and the rejection having been acquiesced in and the original patent returned to the owners — *McCormick Harvesting Machine Co. v. C. Aultman & Co., 64 O. G. 1791, C. D. 1893.

185. *Held*, that the same principle is applicable to a re-issue proceeding where a party voluntarily resubmits his patent to the examination and revision of the patent office and acquiesces in a rejection of claims or in a construction placed thereon which operates to

restrict or narrow the patent that obtains in acquiescences in rejections upon original proceedings. *Id.

186. *Held*, that by the presentation of claims meaning substantially or identically the same things as the claims sued on, which were rejected and the rejections acquiesced in, the claims sued on had become destroyed by the re-issue proceedings and the patent amended to the extent of the original claims rejected. *Id.

187. *Held*, that after an adverse decision by the patent office on certain claims the patentee or his successor in right and interest is not entitled to assert the validity of such claims or insist upon the benefit thereof unaffected by the re-issue proceedings and adverse action. *Id.

188. *Held*, that claims having been voluntarily resubmitted to the revising jurisdiction of the patent office by an application for re-issue, which repeated them literally or in substance, and having been rejected or adjudged against the patentee, not on formal grounds, but for reasons and on references to prior patented devices, and no appeal having been prosecuted from such decision, the effect of such adverse decision should be regarded as fatal to said claims to the same extent as their rejection upon the original application would have been. *Id.

189. Where it appears, on an examination of the file-wrapper and contents of the original application, that the applicant sought broad claims, but narrowed them on citation of references and rejection by the patent office in order to obtain the patent, *held*, that the patentee and those holding under him are estopped thereby from insisting upon such construction of the allowed claim as would cover what had been previously rejected, and also re-issuing to broaden such narrow claim by including what had been previously rejected and canceled in the original application. *Corbin Cabinet Lock Co. v. Eagle Lock Co., 65 O. G. 1066, C. D. 1893.

190. Where the applicant has acquiesced in the rejection of a claim, he is estopped thereby, when a patentee, to claim the benefit of his canceled claim or such a construction of his patented claim as would be equivalent thereto. This rule is applicable both when the canceled claim is broader and narrower than the patented claim. *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co., 67 O. G. 271, C. D. 1894.

191. Words which might otherwise be regarded as non-essential may be introduced in

such manner as to make them essential, as those introduced by way of amendment. *Reece Button-Hole Mach. Co. v. Globe Button-Hole Mach. Co., 67 O. G. 1720, C. D. 1894.

192. It would defeat the ends of justice to rigidly hold that phrases inserted or omitted by amendment were emphasized. *Id.

193. The patentee, having altered his specification to accord with the views of the patent office examiner, cannot now claim any broader construction of his patent. (Cases cited.) *Kennedy v. Solar Refining Co., 69 Fed. Rep. 715 (1895).

194. *Held*, that where a patentee during the pendency of his application presented matter whereby he described and sought to include a device substantially identical in form and in details of construction with that made by the defendants, which matter the patent office regarded as for an entirely distinct and independent invention from that embraced in the invention as originally filed, and which matter was for such reason excluded, and the applicant acquiesced in such ruling, he cannot be heard to insist that the matter so excluded is nevertheless covered by the patent. *Wells Glass Co. v. Henderson, 72 O. G. 285, C. D. 1895.

195. Patentee, when applicant, having been obliged, in view of certain references cited by the office, to elect to prosecute one of two features as the essential characteristic of his invention, and electing to show, describe, claim and insist upon his invention as consisting in one feature having certain functions, is bound by his admission, and is not in a subsequent suit in a position to claim that his invention consisted in the feature which he ignored in making his election. *Richardson v. American Pin Co., 75 O. G. 351, C. D. 1896.

196. When, in order to obtain an allowance of a claim, it is amended by the insertion of certain limiting words, it cannot afterward be construed to be the same as the original claim. To hold that words inserted with such formality mean nothing is going beyond any reported authority. *Beale v. Spate, 76 O. G. 965, C. D. 1896.

197. Where the patentee acquiesced in the ruling of the patent office that the application of hand-wheels to a road-grading machine for imparting motion to the devices for raising and depressing the scraper-blade was old, and, for the purpose of obtaining his patent, restricted his claims in this particular to momentum or balance wheels, *held*, that he is bound by such restriction. *American Road

Machine Co. v. Pennock & Sharp Co. (Limited), 77 O. G. 633, C. D. 1896.

198. When a patentee accepts his original patent without objection and without applying for re-issue, he must be assumed to have assented to such changes as were made by his solicitor while the application was on its way through the office. *Matheson v. Campbell, 79 O. G. 686, C. D. 1897.

XII. CLAIMS CONSTRUED BY REFERENCE LETTERS IN DRAWING.

199. The claims are not narrowed by any letters of reference to the drawing. *Perrin v. Manhattan Ry. Co., 62 O. G. 1209, C. D. 1893.

200. *Held*, that where the elements which go to make up the combination of a claim are mentioned specifically and by reference letters, such specific reference operates to confine and restrict the claim to the particular devices described. *McCormick Harvesting Machine Co. v. C. Aultman & Co., 63 O. G. 1791, C. D. 1893.

201. In addition to the limitations made necessary by the prior art the language employed narrows the first claim of Letters Patent No. 266,895 to the precise mechanism of the patent. Every element is restricted by a reference letter to the structure described and shown. A claim so explicit cannot be enlarged by construction. *Parry Mfg. Co. v. Hitchcock Mfg. Co., 64 O. G. 860, C. D. 1893.

202. The rule is that where the applicant acquiesces in the rejection of claims by the patent office or in a construction which narrows or restricts them, and where the elements which go to make up the combination of the claim are mentioned specifically and by reference letters, leaving no room for question as to what was intended, the claim must be confined and restricted to the particular device described. (Knapp v. Morss, 65 O. G. 1593, 150 U. S. 221.) *Lehigh Valley R. Co. v. Kearney, 72 O. G. 139, C. D. 1895.

203. The mere use of reference letters in the claims of a combination patent does not of itself, where the invention is really of a primary and pioneer character, limit the scope of the claims to the exact form shown. On the contrary, nothing will restrict a pioneer patentee's rights save the use of language in his specifications and claims which permits no other reasonable construction than that he positively intended to limit the scope of his invention to the particular form shown, thus indicating a

willingness to abandon to the public any other form. (58 Fed. Rep. 773.) *McCormick Harvesting Machine Co. v. C. Aultman and Co., 73 O. G. 1999, C. D. 1895.

204. If the invention is broad and meritorious, and a decided advance in the art, reference letters alone in the claims will not limit them to the exact form of the device described. (Cases cited.) *Muller v. Lodge and Davis Machine Tool Co., 77 Fed. Rep. 621 (1896).

XIII. To ASSIGNEES.

(See ASSIGNMENT—DISPUTED TITLE.)

205. The legal title to a patent vests at once on its issuance to the person who by the record is entitled to it; but it is not mandatory under the language of the statute that the patent run in form to such record owner. (Gaylor v. Wilder, 10 How. 477.) *Consolidated Electric Light Co. v. McKeesport Light Co., 44 O. G. 110, C. D. 1888.

206. The purpose of section 4895 of the Revised Statutes is to permit a patent to issue to the person who has the record title to the invention, and is attained when the patent runs to the ultimate assignee, and therefore a patent may issue to the person who by the records of the office is assignee of the invention, although not technically the assignee of the inventor. (Selden v. Stockwell Gas Burner Co., 19 Blatch. 544; S. C., 9 Fed. Rep. 390.) *Consolidated Electric Light Co. v. McKeesport Light Co., 44 O. G. 110, C. D. 1888.

207. A patent is properly issued to any assignee whose assignment is duly recorded when it can be done without impairing the rights of any other person having a paramount title to the invention, and is therefore valid when issued to any such assignee of record. (Consolidated Electric Light Co. v. Edison Electric Light Co., 33 O. G. 1597.) *Id.

208. A patentee may not, as against the assignees of his entire interest, so restrict and qualify the claims of his patent as to make them void for want of novelty. *Adee v. Thomas, 47 O. G. 528, C. D. 1889.

209. Gaylor v. Wilder, 10 How. 477, and Consolidated Electric Light Co. v. Edison Electric Light Co., 33 O. G. 1597, expressly hold that section 4895, Revised Statutes, does not make it obligatory upon the commissioner of patents to issue a patent to the assignee of an inventor, and the decisions and the rules of the patent office prescribe that patents can issue to the

assignee only where the invention is clearly and unmistakably identified. *Ex parte Samuel J. Murray*, 44 MS. D. (2 G. W. D.), Aug., 1890 (Fisher, Acting Com'r).

210. The mere fact that an assignment and application bear the same date and refer to the same general class of invention is not sufficient to make it imperative upon the office to issue the patent to the assignee named in the assignment. *Ex parte Samuel J. Murray*, 47 MS. D. (2 G. W. D.), May, 1891 (Mitchell, Com'r).

211. It is not obligatory upon the office to issue a patent to an assignee. The commissioner may issue the patent to the inventor and relegate the parties to the courts for the settlement of their rights. *Ex parte Spielman*, 49 MS. D. (3 G. W. D.), Dec., 1891 (Simonds, Com'r).

212. Although a transfer of the exclusive right to a patent within and throughout a specified part of the United States is, properly speaking, an assignment, and vests in the assignee a title to so much of the patent itself with the right to sue infringers, yet section 4895 of the Revised Statutes, as interpreted by section 4916 thereof, and as always and consistently understood by the framers of the Rules of Practice, authorizes the commissioner to grant a patent only to assignees of the entire interest or undivided parts thereof. *Ex parte Buchanan*, 56 O. G. 140, C. D. 1891.

213. The statute authorizing the commissioner to issue a patent to an assignee of record is not mandatory, and in case of contest between two parties, each claiming to hold valid title by assignment, the commissioner may in his discretion issue the patent to the inventor. *Ex parte Spielman*, 58 O. G. 141, C. D. 1891.

214. It is the uniform practice of the office to issue a patent to an assignee upon a request contained in an assignment which is in proper form and was filed before the payment of the final fee. An assignment to a company alleged to have been defunct from the start will nevertheless be followed as to direction to issue the patent to such company as assignee. *Ex parte Fowden*, 53 MS. D., Nov., 1893 (Fisher, Ass't Com'r).

215. Where two joint inventors appoint an attorney to prosecute an application and receive the patent and one of the inventors assigns his entire interest to a third party and requests that the patent issue jointly to the other inventor and the assignee, and the said attorney does not indicate that there was any objection on the part of the other inventor to so granting the patent, *held*, that there was no

mistake on the part of the office in granting the patent as requested. *Ex parte Fowler and Hutton*, 64 O. G. 1131, C. D. 1893.

216. Where there has been an assignment of an undivided interest in an invention, accompanied by a request that the patent issue jointly to the inventor and assignee, no legal objection seems to exist why the patent should not be so issued. *Id.*

217. Where the assignment is recorded in the patent office the day after the payment of the final fee, it is too late to have the patent issue to the assignee, although the assignment may contain a request that the patent should issue to the assignee. †*Ex parte Coté Co.*, 65 O. G. 1915, C. D. 1893.

218. The duty of the commissioner of patents under the rule does not require the exercise of judgment or discretion, nor is it imposed by acts of congress; but it is a duty under the rules of office practice, approved by the secretary of the interior, and consequently is subject to the appellate jurisdiction of the secretary of the interior. (*Houston v. Barker, v. Bannister, v. Eastman*, C. D. 1888, 173, 44 O. G. 697.) †*Id.*

219. The provisions of the rule in this matter are never departed from except in cases where both the inventor and the assignee request that the patent shall issue to the assignee, the assignment being on record not later than the day of closing the weekly issue—namely, Thursday of every week. †*Id.*

220. Where an assignment from one of several joint inventors contains a request that the patent shall issue to his assignee, *held*, that the request will be observed and the patent be issued jointly to the remaining inventors and the assignee. *Ex parte Fowler*, 69 O. G. 1641, C. D. 1894.

221. An assignment of an unpatented invention which does not contain a request that the patent issue to the assignee does not convey a legal title to the patent when granted, but gives only an equitable interest. †*Harrison v. Morton*, 76 O. G. 1275, C. D. 1896.

222. It is not mandatory on the commissioner to issue a patent to the assignee of an inventor. (*Ex parte Gallatin*, C. D. 1892, 106, 59 O. G. 1104.) *Ex parte McFarlane*, 76 O. G. 1418, C. D. 1896.

223. The question that should govern the patent office in issuing patents is who on the record possesses the *legal* title to the invention, and the patent should issue accordingly, provided the requirements of the office in such

case have been complied with. *Ex parte Nichols*, 80 O. G. 1891, C. D. 1897.

224. A request that a power of attorney given by an alleged assignee be approved and that a patent issue to said assignee denied, as the assignment fails to fully identify the application and to specifically request the issue of the patent to the assignee. *Ex parte Chillingsworth*, 80 O. G. 1892, C. D. 1897.

(*Held*, that if an assignment be of record in the patent office before patent issued, conveying all rights, etc., it was sufficient to transfer the right to the assignee, although a patent was afterward issued to the assignor. *Gaylor v. Wilder*, 10 How. 477. See, also, *United States Stamping Co. v. Jewett*, 7 Fed. Rep. 809, for substantially same doctrine.)

A transfer of the exclusive right to a patent within and throughout the United States is an assignment in the proper sense, yet under the statute it does not warrant issuing the patent to the assignee. For that purpose there must be a transfer of the whole or an undivided interest in the patent. *Ex parte Buchanan*, 56 O. G. 140, C. D. 1891.)

XIV. DECEASED INVENTORS.

(See ATTORNEYS.)

225. Section 4896, Revised Statutes, construed in connection with the right of the executor or administrator to prosecute the application of a deceased inventor or to file a new application for the invention of the decedent. *Ex parte Smith*, 43 O. G. 505, C. D. 1888.

226. A patent issued in the name of an applicant who died while his application was pending and before issue is void for want of a grantee. **De La Vergne Refrigerating Machine Co. v. Featherstone*, 58 O. G. 1842, C. D. 1892.

(Circuit court, Blodgett, J.)

227. The word "heirs" in a grant of a patent for an invention has the same significance as in a grant or deed of lands—it limits or defines the grantee's estate therein, and is not a word of purchase. **Id.*

228. The statute having in clear terms provided what shall be done to preserve an inventor's right to a patent in the event of his death before the patent is granted, it is only by following this mode that a valid patent can be obtained in such a case. **Id.*

229. A patent to a man dead at the time of the grant is not void for want of a grantee, since the phrase "his heirs or assigns" must be construed as creating a grant in the alternative, and the use of the word "heirs" in a patent grant raises no limitation in the sense of the strict common-law rule applied to realty. (Re-

versing *De La Vergne Refg. Co. v. Featherstone*, 58 O. G. 1842.) **De La Vergne Refrigerating Machine Co. v. Featherstone*, 63 O. G. 741, C. D. 1893.

(United States supreme court.)

230. Where objection was made to the validity of a patent because of an amendment made by the attorneys after the applicant's death, no new power of attorney having been filed in the patent office, and no new administrator having intervened and filed a new oath, *held*, (1) the amendment was within the scope of the original specification and required no new oath; (2) it appearing that the attorneys had power in fact to act, and that their acts were subsequently ratified by both administratrix and assignee, the amendment did not invalidate the patent. (Distinguishing *Eagleton Mfg. Co. v. West*, C. D. 1884, 261, 27 O. G. 1237, 111 U. S. 400.) **Id.*

PETITION IN APPLICATION.

1. A petition that fails to refer to or identify the specification is defective and must be amended to contain a reference to the specification for a full disclosure of the invention. *Ex parte Mason*, 43 O. G. 627, C. D. 1888.

2. The petition failed to refer to or identify the specification. *Held*, that the petition was defective and must be amended to contain a reference to the specification for a full disclosure of the alleged invention. *Id.*

PETITION TO COMMISSIONER.

(See APPEAL.)

PLEADING.

(See DEFENSES; EQUITY; PRACTICE IN THE COURTS.)

- I. IN GENERAL
- II. DEMURRER.
- III. MULTIFARIOUSNESS.

I. IN GENERAL.

1. Where the answer sets up generally want of equity in the bill to defeat an injunction without alleging reasons why the injunction would be inequitable, the court will not consider such defense. **Puetz v. Bransford*, 39 O. G. 1083, C. D. 1887.

2. If a defendant relies on the complainant being estopped from enforcing his rights against the defendant, such estoppel must be set up in the pleadings or the court will take no notice of it. *Puetz v. Bransford, 39 O. G. 1427, C. D. 1887.

3. The defense of no patentable invention can be made without setting it up in an answer. *Hendy v. The Golden State and Miners' Iron Works, 43 O. G. 1117, C. D. 1888.

4. Where notice is not given in the answer of a specified prior use of the invention described in the patent, it cannot be set up as an anticipation of such invention; but, as exhibiting the state of the art, the evidence is competent to aid the court in putting a proper construction on the patent. *Stevenson v. Magowan, 42 O. G. 1063, C. D. 1888.

5. The defendant pleaded that he should not be called upon to answer, because by reason of the expiration of a foreign patent for the same invention the patent in suit had expired, and the complainant had a plain, adequate and complete remedy at law, and the court should not take cognizance in equity of the suit. The complainant contended that such a defense could not be raised by plea, and if it could that the plea was insufficient both in matters of form and substance to present such a defense. *Edison Electric Light Co. v. United States Electric Lighting Co., 43 O. G. 1456, C. D. 1888.

6. Although under the acts of congress the power of the courts of the United States with respect to the amendment of equity pleadings is plenary, the allowance of such amendment is a question of judicial discretion depending largely on the special circumstances of the cases. *United States of America v. American Bell Telephone Co., 49 O. G. 284, C. D. 1889.

7. One of the defendants, C., filed a general answer to the bill and another defendant, B., filed a plea and answer in support thereof. Before any evidence had been taken in the cause the defendant C. asked leave to withdraw its answer and to file the same plea and answer in support thereof which had been filed by the defendant B. *Held*, that the motion was not open to the objection of introducing a new defense on a new state of facts, or of changing the substance of the case made by the bill, or of setting up a merely technical defense, and that, as the convenience of the case would be best promoted by having the issues proceed *pari passu* as to each defendant, the motion should be granted. *Id.

8. Where the bill alleged that a certain for-

ign patent, granted previous to and for the same invention as the patent sued on, had not expired; that it was granted for the term of fifteen years from its date, and was then in full force and effect, and the defendant pleaded, among other things, that said foreign patent had expired before the commencement of the suit, *held*, that the plea was insufficient, and ordered that it stand as an answer or part of an answer to the bill. *The Edison Electric Light Co. v. Westinghouse, Church, Kerr & Co., 50 O. G. 806, C. D. 1890.

9. Revised Statutes of United States, section 4919, provide that damages for infringement of a patent may be recovered by an action on the case. Section 4920 prescribes the nature of pleadings to be used in the action, and was passed in 1874. Section 914, which provides that the practice, pleadings, etc., in the federal courts shall conform as near as may be to those "in like causes" in the state courts of the state where such federal courts are held, was passed in 1872. *Held*, that, as actions for infringements of patents are within the exclusive jurisdiction of the federal courts, the pleadings therein are governed by section 4920, and a declaration in such an action, conforming to a common-law declaration in an action on the case, is sufficient, though a different form is prescribed by the statutes of the state where the court is held, and that the answer in such an action should comply with the common-law pleadings in actions on the case in form covering one or more of the defenses permitted in section 4920. *Myers v. Cunningham, 54 O. G. 1417, C. D. 1891.

10. Where there are joint defendants to a bill for infringement, it is sufficient if the bill contains a general allegation of infringement, and it need not in terms allege a joint infringement. *Indurated Fibre Industries Co. v. Grace, 60 O. G. 896, C. D. 1892.

11. Where there were several related suits and in one of them a patent was introduced in rebuttal, but not mentioned in pleadings of either party and no testimony taken respecting it, the pleadings require amendment in order that the patent may be set up in any other of the same suits. *Vermont Farm Machine Co. v. Gibson, 64 O. G. 300, C. D. 1893.

12. In an action at law for infringement of a patent, defendants, although they plead the general issue, may also maintain a special plea that the combination covered by the patent was not an invention, and also a further plea that the combination covered by the patent re-

quired for its production nothing but mechanical skill, in view of the prior state of the art. *Brickill v. City of Hartford, 65 O. G. 892, C. D. 1893.

13. In an action at law for infringement of a patent defenses which have been raised by demurrer to the complaint and overruled cannot be made part of the answer without leave of court. *Id.

14. But in Connecticut the court will allow such defenses to be set up by plea for the purpose of saving a right to review on writ of error to the circuit court of appeals, it being uncertain whether, under the code pleading, an assignment of error in the ruling on the demurrer is sufficient to secure such right when the demurrant does not allow final judgment to go against him upon it. *Id.

15. A plea alleging want of novelty because the alleged invention had been previously patented, on specified dates, to other parties is insufficient, for Revised Statutes, section 4920, require an allegation that the invention had been patented or described in some printed publication before the time of the supposed invention. *Id.

16. Where the answer alleged that the invention had been in two years' public use and on sale without stating that such two years' public use or sale occurred in this country, such allegation may not be technically accurate; but the point cannot be raised for the first time on appeal. *Smith & Davis Mfg. Co. v. Mellon, 66 O. G. 173, C. D. 1894.

17. The defense of prior use should be pleaded, or notice of when, where and by whom the prior use was made, be given before the trial. *Klein v. City of Seattle, 17 O. G. 131, C. D. 1895.

18. After alleging the invention and grant of the patent and the assignment the pleader averred that the defendants, knowing the premises, infringed. This is not an averment that they had notice or knew that their machines infringed. The allegation in regard to infringement was traversed, but nothing was said below upon the subject of notice. It is too late to raise for the first time in an appellate court technical questions of pleading or proof which are not jurisdictional in their character. *Tuttle, Trustee, etc. v. Clafin, 77 O. G. 973, C. D. 1896.

II. DEMURRER.

19. Where a bill filed in 1886 stated that between the issue of the patent (in 1874) and the

filing of the bill and at divers times and occasions the defendants had infringed the patent, held, that the bill did not show affirmatively that there had been a continuous use for such period, and a demurrer on the ground of laches was overruled. *Kaolatype Engraving Co. v. Hoke, 39 O. G. 589, C. D. 1887.

20. Where the bill of complaint made the usual averments as to invention, the procurement of letters patent, ownership of the same, and to an infringement, and the demurrer was general and set up no particular ground, the court below erred in sustaining demurrer and in dismissing the bill. *McCoy v. Nelson, 39 O. G. 831, C. D. 1887.

21. Under Revised Statutes of the United States, section 4919, providing that "damages for the infringement of any patent may be recovered by action on the case," it is sufficient that the plaintiff's pleading, in an action to recover such damages, contains all the allegations material to make an action on the case, and it will not be demurrable because called a "petition," the code term, instead of "declaration," the common-law term. *May v. Mercer County, 41 O. G. 815, C. D. 1887.

22. After complainants had made out a *prima facie* case, it is too late for defendants to withdraw answer and file a demurrer. *Huber v. N. C. Nelson Mfg. Co., 44 O. G. 234, C. D. 1888.

23. The facts showing want of jurisdiction appearing upon the face of the bill, and the defendant not appearing generally, but specially to demur, the demurrer must be sustained. *Halstead v. Manning, Bowman & Co., 44 O. G. 344, C. D. 1888.

24. A bill by vendee against vendor for specific performance, which does not show any title in defendant, is bad on demurrer. *Kennedy v. Hazelton, 46 O. G. 972, C. D. 1888.

25. A demurrer may not only attack a bill in its entirety, but there may be special grounds of demurrer which relate to each of several letters patent separately. *International Terra Cotta Lumber Co. v. Maurer, 44 Fed. Rep. 618 (1890).

26. Where a bill for injunction alleged that the patentee was the original, first and sole inventor of the patented improvement, which had not been patented to himself or to others with his knowledge or consent in any country, and had not, to his or the orator's knowledge, been in public use or on sale in the United States for more than two years before his application for patent, and had not ever been known or used or described in any printed publication in this

or any foreign country prior to his invention and discovery thereof and application for letters patent therefor, *held*, on a general demurrer, that said allegations were adequate, and stated facts which are prerequisites to a valid patent. *American Cable Ry. Co. v. Mayor, etc. of New York City, 52 O. G. 161, C. D. 1890.

27. The joining of the president of a corporation as co-defendant on a complaint alleging that the corporation and the president have infringed complainant's patent is no ground for demurrer. *Cleveland Forge and Bolt Co. v. United States Rolling Stock Co., 52 O. G. 1808, C. D. 1890.

28. Where in a suit for infringement it appeared that the patent in suit was not set out in the bill or attached thereto as an exhibit, and that the bill did not contain any substantial description of the complainants' invention, *held*, that a demurrer to the bill should be sustained. *Stirrat v. Excelsior Mfg. Co., 53 O. G. 1094, C. D. 1890.

29. For the purpose of determining what construction or breadth should be given to the claims of the patent in suit and the patent under which, as plaintiffs allege, the defendant pretends to be manufacturing the alleged infringing device, it may be proper, or even necessary, on final hearing to consider what took place in the patent office when the interference proceedings between the applications on which said patents issued were pending; but a clause in the bill containing a recital of such proceedings is mere surplusage. *Id.

30. The point attempted to be raised that such clause is mere surplusage cannot well be raised by demurrer, but only by way of exceptions to the bill. *Id.

31. Where the question of the validity of a patent is doubtful, a demurrer to a bill for its infringement will be overruled and the question reserved for further consideration on final hearing. *Standard Oil Co. v. Southern Pacific Co., 53 O. G. 1250, C. D. 1890.

32. A demurrer to a whole bill must be overruled if the bill taken altogether entitles complainant to some kind of relief. *Merriam v. Holloway Publishing Co., 53 O. G. 1409, C. D. 1890.

33. Where in a suit for infringement the bill alleged that the defendant had "since the date of" the patent in suit, "since September 2, 1879," infringed upon complainant's rights, it appearing elsewhere in the bill that the complainant had no rights under the patent until September, 1880, *held* upon demurrer that it

could not be said that the complainant intended to aver that the defendant had infringed upon the complainant's rights continuously since September, 1879. *The Brush Electric Co. v. Ball Electric Light Co., 53 O. G. 1573, C. D. 1890.

34. With reference to claims 2 and 3, *held*, that as they might fairly be regarded as confining the patentee to the specific design shown and described in the patent, the demurrer to the bill should have been overruled. *The New York Belting and Packing Co. v. The New Jersey Car Spring and Rubber Co., 54 O. G. 135, C. D. 1891.

35. Objection to allegations as being not material and pertinent should be made by exception and not by demurrer. *Stonemetz Printers' Machinery Co. v. Brown Folding Machine Co., 53 O. G. 263, C. D. 1891.

36. Complaint did not aver defendants to be the owners of the alleged interfering patent. *Held* bad on special demurrer, because the only point in issue in a suit brought, as this is, under section 4918 of the Revised Statutes is the question of priority of invention between the owners of interfering patents. *Nathan Mfg. Co. v. Craig, 57 O. G. 1887, C. D. 1891.

37. In an action for infringement of letters patent a complaint which did not allege that the invention was not in public use or on sale for more than two years prior to the application for patent *held* bad on demurrer. *Id.

38. A bill which sets forth a patent for a "process" of making furniture-nails and then alleges that defendant, "in infringement of the aforesaid letters patent," did wrongfully "make, use, and vend to others to be used, furniture-nails embracing the improvement set forth and claimed" in said patent, *held* bad on demurrer as not alleging an infringement of the process. *American Solid Leather Button Co. v. Empire State Nail Co., 60 O. G. 1609, C. D. 1892.

39. Under Revised Statutes, section 4886, providing for the issuing of a patent where *inter alia* the invention has not been patented or described in any foreign country before the date of the invention, a bill for infringement of a patent is demurrable which does not allege such facts. *Overman Wheel Co. v. Elliott Hickory Cycle Co., 60 O. G. 1478, C. D. 1892.

40. Where in a joint complaint by two or more parties the facts stated do not show a joint cause of action in them, a demurrer on the ground that the complaint does not state

facts sufficient to constitute a cause of action must be sustained. *Blair v. Lippincott Glass Co., 61 O. G. 1792, C. D. 1892.

41. In a suit for infringement of a patent the bill may be met by a demurrer when it makes profert of the patent and the same appears on its face to be invalid for want of patentable invention. (Post v. Hardware Co., 35 O. G. 1226, 26 Fed. Rep. 618, followed.) *United States Credit System Co. v. American Credit Indemnity Co., 63 O. G. 818, C. D. 1893.

42. The mere fact that eight years elapse between the rendition of a judgment declaring a patent valid and the filing of a bill to restrain its infringement does not render the bill demurrable on the ground of laches. *Bragg Mfg. Co. v. City of Hartford, 64 O. G. 1537, C. D. 1893.

43. A bill for an injunction to restrain the infringement of a patent filed only four days before the term of the patent expires is demurrable where no preliminary injunction is asked, since it would be impossible to obtain a final decree before expiration of the patent. (American Cable Ry. Co. v. Chicago City Ry. Co., 52 O. G. 1666, 41 Fed. Rep. 522, followed.) *Bragg Mfg. Co. v. City of Hartford, 64 O. G. 1537, C. D. 1893.

44. The objection that public policy forbids the issuance of an injunction cannot be raised by demurrer to the bill, since that is a question addressed to the discretion of the court, especially where the bill alleges that complainant has reason to fear that defendant will continue his infringements. *Id.

45. On demurrer to a bill for infringement the patent will be declared invalid for want of novelty appearing on its face only where the case is free from doubt, and the court will only take judicial notice of matters within the field of common knowledge. *Hanlon v. Primrose, 65 O. G. 184, C. D. 1893.

46. In a bill for infringement the omission to aver that the invention had not been patented or described in any printed publication in this or any foreign country before the date of the invention is a defect of form which may be taken advantage of by special demurrer. *Id.

47. While ordinarily the determination of a demurrer setting up the identity of the patents to the same patentee in the bill of complaint would be left to final hearing, *held* that, as the question of identity is one of law, to be ascertained solely from the face of the patents, exception may well be made in favor of dis-

posing of the demurrer without waiting for the final hearing. *Russell v. Kern, 69 O. G. 1208, C. D. 1894.

48. While patent cases are usually disposed of upon bill, answer and proof, there is no objection, if the patent be manifestly invalid upon its face, to the point being raised on demurrer and the case being determined upon the issue so formed. The supreme court has repeatedly held that a patent may be declared invalid for want of novelty, though no such defense be set up in the answer. (Dunbar v. Myers, 11 O. G. 35, 94 U. S. 187; Slawson v. Grand Street R. Co., 24 O. G. 99, 107 U. S. 649; Brown v. Piper, 10 O. G. 417, 91 U. S. 37.) *Richards v. Chase Elevator Co., 71 O. G. 1456, C. D. 1895.

49. When the patent sued on is void on its face, the right of the court to dispose of the case on demurrer is well settled; but the right should not be exercised unless the case is plain and the conduct of the parties warrants it. (West v. Rae, 38 Fed. Rep. 45; Studebaker Bros. Mfg. Co. v. Illinois Iron & Bolt Co., 43 Fed. Rep. 51.) *American Fibre Chamois Co. v. Williamson, Executor, 72 O. G. 143, C. D. 1895.

50. A patent manifestly invalid upon its face may be so declared on demurrer to the bill; but this power should be exercised with the utmost caution and only in the plainest cases. All doubts should be resolved in favor of the patent. (Button-Fastener Co. v. Schlochtmeier, 69 Fed. Rep. 592, followed.) *Covert v. Travers Brothers Co., 75 O. G. 349, C. D. 1896.

51. Demurrer was sustained where it appears from an inspection of the patent in suit and by the exercise of common knowledge that the device patented is destitute of patentable novelty. *Chesterman v. Lindell Ry. Co., 76 O. G. 479, C. D. 1896.

52. Where a bill is demurred to on the ground that letters patent are void for want of patentable novelty, *held*, that while it is competent to raise the question of non-patentability by demurrer, yet a case should not be disposed of upon such a demurrer unless the invalidity of the patent be plain and the common knowledge relied upon to defeat it be of matters of which the court may properly take judicial notice. *Caldwell & Co. v. Powell, 75 O. G. 1206, C. D. 1896.

53. A design for a college badge, consisting of a pin having the shape of a guidon flag, upon which the letters "U. P." are placed, is not so absolutely void of invention upon its

face as to justify the court in sustaining a demurrer upon that ground. *Caldwell v. Powell, 77 O. G. 1272, C. D. 1896.

54. The effect of a demurrer is to admit the truth of the charge in the bill when the latter is well pleaded. *Id.

55. The fact that plaintiff and defendant are citizens of the same state will not sustain a demurrer to a bill brought under Revised Statutes, section 4915. *Bernardin v. Northall and Seymour, Com'rs of Patents, 78 O. G. 1740, C. D. 1897.

56. A demurrer brought against a bill for infringing a copyright of different portions of an index which, though a possible subject for a patent, is not a good subject for copyright, is well taken. *Amberg File & Index Co. v. Shea, Smith & Co., 79 O. G. 514, C. D. 1897.

57. The cause should be considered upon the merits on demurrer to the bill whenever it appears upon the face of the patent that it lacks invention. (Risdon Iron and Locomotive Works v. Medart, 71 O. G. 751, 15 Sup. Ct. 745, 158 U. S. 63, followed.) *Strom Mfg. Co. v. Weir Frog Co., 77 O. G. 1125, C. D. 1896.

58. In a bill of complaint it was alleged that the defendants have conspired to threaten, intimidate and prevent the customers of complainants from dealing with them by distributing false and threatening circulars, with intent to destroy complainant's business. A demurrer was overruled, but without prejudice and with leave to present the matter of the demurrer—namely, that the patent sued upon is invalid, or, if valid, is not infringed, and that the bill does not show title to the relief sought—by answer. *Lewin v. Welsbach Light Co., 79 O. G. 1867, C. D. 1897.

59. The only legitimate inquiry upon a demurrer alleging invalidity, non-infringement and no title in complainants is, are the acts and conduct of the defendant, alleged in the bill to be distributing false and threatening circulars with intent to injure complainant's business, such as a court of equity should restrain the owner of a presumptively valid patent from doing. *Id.

III. MULTIFARIOUSNESS.

60. Five distinct causes of action united in one suit in equity without allegation in the bill that the inventions were capable of conjoint use, or that the defendants' structure combined all the patented features. Bill held multifarious. *Griffith v. Segar, 29 Fed. Rep. 707 (1887).

61. Where a suit is brought against A. B. and C. D., doing business under the name of "A. B. Engraving Plate Co.," without stating whether the concern was a firm or corporation, *held*, that a conjoint use was shown, and a demurrer to the bill on the ground of multifariousness was not well taken. *Kaolatype Engraving Co. v. Hoke, 89 O. G. 589, C. D. 1887.

62. A bill in equity brought to repeal patents is not multifarious where the patents relate to the same invention, belong to the same parties and can be conveniently considered together, and the defendants have a common interest in sustaining the validity of both patents. *The United States v. The American Bell Telephone Co., 45 O. G. 1311, C. D. 1888.

63. There appears to be no objection to joining in the same bill a count for infringement and a count under section 4918, Revised Statutes of the United States. *American Roll Paper Co. v. Knopp, 54 O. G. 391, C. D. 1891.

64. A bill claiming relief for two causes—one, an interference between the patents of the plaintiff and defendant; the other, an alleged infringement by the defendant of plaintiff's patent—is not multifarious. *Stonemetz Printers' Machinery Co. v. Brown Folding Machine Co., 56 O. G. 263, C. D. 1891.

65. Where a complainant's bill asks for the specific performance of a contract set out, and also contains expressions looking to relief, as on a bill for infringement, *held* impossible to sustain the bill as one for a double aspect, because in a bill for infringement the determination who are necessary parties must be made from a standpoint different from that in a bill for specific performance, and the title to relief is not the same in each event. The bill must be treated as multifarious. *American Box Machine Co. v. Crosman, 60 O. G. 1750, C. D. 1892.

66. It has been repeatedly decided that a bill which omits to allege joint use of several inventions covered by several patents is demurrable for multifariousness. (Cases cited.) *Union Switch & Signal Co. v. Philadelphia and R. R. Co., 69 Fed. Rep. 833 (1895).

67. Where devices covered by several patents are capable of embodiment and conjoint use in a single machine, a bill which seeks to recover in a single suit for the infringement of all the patents is not multifarious. *Kansas City Hay-Press Co. v. Devol, 81 O. G. 1277, C. D. 1897.

POWER OF ATTORNEY.

(See ATTORNEYS AND POWERS.)

PRACTICE.**I. IN PATENT OFFICE.****II. IN UNITED STATES COURTS.****III. IN BRITISH COURTS.****I. IN PATENT OFFICE.**

(See AMENDMENT OF APPLICATION; APPEAL; APPLICATION FOR PATENT; ATTORNEYS; CLAIMS; DISCLAIMER; DESIGNS; DIVISION OF APPLICATION; DIVISIONAL APPLICATION; EXAMINATION OF APPLICATION; FEES; INTERFERENCE; JURISDICTION; PATENTS; PATENTABILITY; WITHHOLDING FROM ISSUE; WITHDRAWAL FROM ISSUE.)

1. Whatever may be the opinion or views entertained by an inferior tribunal of the action or rulings of the superior tribunal, it is manifestly improper to express them in their recorded decisions. Such practice tends seriously to impair the discipline and harmony of the office and destroys confidence in its rulings. *Ex parte Finch*, 40 O. G. 1027, C. D. 1887.

2. A disrespectful official letter from an examiner to an applicant ordered stricken from the files and another respectful one substituted. *Ex parte Sturtevant & Davis*, 33 MS. D., Feb., 1887 (Montgomery, Com'r).

3. The orders and practice of courts of equity govern in the patent office as far as practicable, but cases may arise in which they should not be rigidly enforced. *Osgood v. Badger, v. Bennett*, 44 O. G. 1065, C. D. 1888.

4. Since the commissioner of patents exercises the function of a court, reasonable rules and regulations, based upon analogies derived from the procedure in courts of law, are valid rules and regulations when prescribed by the competent authority. **Daniels v. Morgan*, 47 O. G. 811, C. D. 1889.

5. The commissioner refused to pass upon the patentability of a claim when the question had been decided by the examiner. *Walker v. Diescher and McGill*, 56 O. G. 927, C. D. 1891.

6. Whatever doubts may exist with reference to an act prescribing duties for the patent office, it remains for the office to treat it as a valid part of the law until the supreme court declares it unconstitutional. *Ex parte Palmer*, 58 O. G. 383, C. D. 1892.

7. Irrelevant personal reflections on an attorney struck out of the office letter, and the reply of the attorney thereto returned under rule 22. *Ex parte Oliver*, 76 O. G. 961, C. D. 1896.

8. The proceedings of the patent office are not controlled by the ordinary rules of practice that obtain in the courts of the country, but are controlled by statutory provisions and a code of rules made in pursuance of statutory provisions wholly unlike the rules of practice enforced in the courts. **Ross v. Loewer*, 77 O. G. 2141, C. D. 1896.

(The practice of the patent office is not a matter for regulation by the court of appeals of the District of Columbia, and irregularities therein, even if patent on the record, would only be considered by this court when some substantial right of a party has been denied and the point saved for presentation on appeal. **Neill v. Commissioner of Patents*, 82 O. G. 749.)

II. PRACTICE IN UNITED STATES COURTS.

9. Where a bill was filed for infringement of two patents, and upon the final hearing the following questions were presented: first, whether the plaintiff S. or the defendant H. was the first inventor of the device claimed in one of the patents, and second, had the invention been in public use more than two years before application for said patent?—*held*, that the first question presented a simple issue of fact, proper for the determination of a jury, and that the second question, which depended upon conflicting testimony, could be more satisfactorily determined by hearing of the witnesses in person. **Gray v. Halkyard*, 38 O. G. 784, C. D. 1887.

10. Where, in the trial before a jury of a suit at law for the infringement of a patent, the plaintiff introduces evidence to show infringement, and closes that branch of his case, and the defendant demurs to the evidence, it is the province of the judge to decide whether or not the plaintiff has made out a *prima facie* case of infringement, and if of the opinion that he has not, he should charge the jury to find for the defendant. †*Royer v. Schultz Belting Co.*, 38 O. G. 898, C. D. 1887.

11. After the validity of a patent has been established in a suit it may always be shown in another suit on the patent against another defendant, and even in answer to an application for a preliminary injunction, that the right claimed by the plaintiff in the new suit was not fairly in controversy in the former suit. **National Hat Pouncing Machine Co. v. Hedden*, 38 O. G. 1129, C. D. 1887.

12. Prior patents not set up in the answer may be introduced in evidence to show the state of the art and to aid in the construction of the plaintiff's claim, though not to invalidate that claim on the ground of want of novelty when properly construed. Doctrine in *Vance v. Campbell* (1 Black, 427, 430) and similar cases affirmed. **Grier v. Wilt*, 38 O. G. 1365, C. D. 1887.

13. Where an assignment is made to a defendant conveying to him an interest in an invention described in a certain application for patent, a broad claim of which was canceled after objection by the commissioner to allowing the claim, and the defendant did not attempt to show that he could have convinced the commissioner that he should allow the claim if he had been aware of its rejection, *held*, that the court will not assume that the defendant could have overcome the objection to allowing the claim. **Puetz v. Bransford*, 39 O. G. 1427, C. D. 1887.

14. Where a bill has been filed, pleadings perfected, proofs taken, and an application made at the hearing to dismiss the bill without prejudice as to one of the defendants, *held*, that the application should be denied. **Archer v. Arnd*, 40 O. G. 1032, C. D. 1887.

15. The practice adopted by an executive department of the government does not apply to the validity of patents by reason of pre-existing acts or omissions of the inventor of the character involved in this suit, but is properly a judicial question. **Andrews v. Hovey*, 42 O. G. 1285, C. D. 1888.

16. The determination of questions like those involved here by the commissioner of patents in the grant of a patent is not conclusive upon the courts as to the questions respecting the validity of such patents, and much less so as regards other patents. **Id.*

17. A stipulation in the suit included the evidence taken in another suit, and a certified copy of Fisher's original patent appearing in the record under the certificate of the clerk of the circuit court that it was a part of the record and of the proceedings in the cause, although there was no separate memorandum in the record of introduction of the original patent in evidence, this court assumes the same to be properly in the case. **Hoskin v. Fisher*, 43 O. G. 509, C. D. 1888.

18. The re-issue in suit being a second re-issue, and the first re-issue not being found in the record, no presumption of law arises that the first and the second re-issues were for the

same invention with similar second and third claims. To have the advantage of the first re-issue it should have been put in evidence. **Id.*

19. The original patent and the second re-issue being properly before the court, a comparison of the two may be made to determine the validity of the second re-issue. **Id.*

20. In a suit to restrain the infringement of a patent complainant was defeated because he sued on one only of two patents relating to the same invention. (48 O. G. 116.) The evidence introduced would be necessary under a bill based on the omitted patent. *Held*, that he should be permitted to amend by bringing in the other patent and alleging its infringement, and that the case should be opened for taking additional testimony, but that relief should be granted only on condition that complainant give an undertaking to pay the expense of such additional testimony, including witness fees, mileage, master's or examiner's fees and printing. **Underwood v. Gerber*, 48 O. G. 675, C. D. 1889.

21. Upon a motion for an attachment against the defendants for contempt in violating an injunction granted at final hearing, *held*, that as the present alleged infringing device differs from that adjudged to be an infringement, and also from the patented device, the question presented ought not to be determined upon such a motion as this, but only by an original suit. **The Pennsylvania Diamond Drill Co. v. Simpson*, 48 O. G. 676, C. D. 1889.

22. In an action at law for damages for the infringement of claims a motion was made at the close of the testimony in the court below for a verdict in favor of the defendant on certain grounds, which motion was sustained, and the jury was directed to return a verdict for the defendant, which was done. To this ruling the plaintiff excepted. *Held*, that the motion to direct a verdict for the defendant was broad enough to cover the question of the invalidity of the patent—a defense set up in the answer—although that ground was not then distinctly urged, and that the judgment of the circuit court should be affirmed. **May v. County of Juneau*, 50 O. G. 1888, C. D. 1890.

23. In a suit for infringement of a patent for an improvement in chutes for delivering timber, it is not error for the court to remark to the jury that counsel upon both sides had used the terms "flume" and "chute" synonymously, that the words of the patent were "an improved chute," but that in discussing it the terms had been used as of the same significa-

tion, where it appeared that plaintiff contended that his invention was a combination of a "flume" and a "chute" and the distinction contended for as existing between them was insisted on in that connection and made entirely clear throughout the case. *Haines v. McLaughlin, 51 O. G. 1465, C. D. 1890.

24. It is not error to refuse to instruct as to an abstract question, and instructions should never be given upon hypothetical statements of fact of which there is no evidence. *Id.

25. In a case of infringement it is for the jury to determine whether the invention is of a primary character, and whether plaintiff's is a pioneer patent, and also whether defendant's machine infringes its claims. *Royer v. Schultz Belting Co., 52 O. G. 157, C. D. 1890.

26. Where in a suit for infringement it appeared that the defendants held and were operating under a patent granted before plaintiff's patent was granted, *held*, that it was incumbent on the plaintiff to proceed in the first instance under section 4918, Revised Statutes of the United States, to have the invalidity of the defendants' patent, in whole or in part, judicially ascertained and declared, although the application upon which plaintiff's patent was granted was filed before that on which the defendants' patent issued. *American Paper Roll Co. v. Knapp, 54 O. G. 391, C. D. 1891.

27. Where a suit has been pending several years and defendant has sought affirmative relief in his answer, even if he has not filed a cross-bill, a motion to dismiss the case before hearing will be denied, and it is immaterial that plaintiff has sold his patent. *Electrical Accumulator Co. v. Brush Electric Co., 55 O. G. 573, C. D. 1891.

28. In an action at law for royalty the finding of the circuit court, upon the evidence offered by both parties as to the novelty of the invention covered by the patent, is a conclusion of fact and will not be reviewed by a higher tribunal. *St. Paul Plow Works v. Starling, 55 O. G. 1821, C. D. 1891.

29. After the introduction of evidence as to the question of novelty by the grantee and rebutting evidence on the same point by the grantor, it is within the discretion of the court to refuse to consider further evidence on the same point, which evidence might have been offered in the first instance. *Id.

30. After the grantee has introduced in evidence certain earlier patents, it is proper for the grantor or patentee to show that prior to the date of any of them he had reduced the in-

vention to practice in a working form. Proof of the date of the grantor's invention is strictly a matter of rebuttal after the grantee has put in the patents which were prior in date to the grantor's patent. *Id.

31. When the complainants themselves raise the question of priority of a foreign patent over the patent upon which suit was brought and this issue is accepted by the defendants in their answer, *held*, that there is no doubt as to the relevancy of that question in disposing of the case on its merits. *Clark Thread Co. v. Willimantic Linen Co., 56 O. G. 395, C. D. 1891.

32. In an action for the infringement of a patented improvement of a former patent owned by the same party but not included in the suit, the court will assume, for the purposes of the particular case under discussion, that defendant was entitled to the use of the former patent. *McCreary v. Pennsylvania Canal Co., 57 O. G. 1131, C. D. 1891.

33. To hold otherwise is to assume plaintiff's ownership of the earlier patent, its validity and its infringement by the defendant — questions not properly before the court in a collateral proceeding. For the purposes of this suit the master was bound to assume that the former patent was open to the defendant; otherwise he might be led into inquiries entirely foreign to the subject of his investigation. *Id.

34. *Quære*: Whether, if there had been an earlier patent for the same device outstanding at the date of the infringement and owned by a third person, defendant could claim that the device described in such patent was open to it. In such case it might perhaps be held that plaintiff was entitled to stand upon the *prima facie* validity of the earlier patent. *Id.

35. A bill may be dismissed by the court on its own motion where the proper allegations as to citizenship of the parties are not contained in the introductory part and are not pointed out by counsel elsewhere in the bill or where the prayer for subpoena does not contain the names of the defendants, as required by the rules. *City of Carlsbad v. Tibbetts, 61 O. G. 1166, C. D. 1892.

36. Whether there was invention in the patent, whether plaintiff was the first inventor, and whether the use of gravity-catches as mechanical equivalents of spring-catches was known at the time of plaintiff's application were questions of fact for the jury. *Hunt Brothers Fruit Packing Co. v. Cassidy, 62 O. G. 1965, C. D. 1893.

37. An exception to the court's refusal to di-

rect a verdict for defendant at the close of plaintiff's evidence is waived by proceeding in the cause and introducing evidence for the defense. (Railway Co. v. Cummings, 1 Sup. Ct. Rep. 493, 106 U. S. 700, and Insurance Co. v. Crandal, 7 Sup. Ct. Rep. 685, 120 U. S. 527, followed.) *Id.

38. The circuit court of appeals for one circuit having on a matter before it on appeal reached a conclusion opposite to that reached by the circuit court of appeals in another circuit under similar circumstances certified the case to the supreme court solely for this reason; *held*, that the certificate was essentially defective in that it did not specifically set forth the question to be determined and did not state that instruction was desired for the proper decision of such question. *Columbus Watch Co. v. Robbins, 63 O. G. 154, C. D. 1893.

39. In a suit for the infringement of letters patent defendants introduced in evidence a pamphlet of about twenty-five pages, published two years after the patents were issued, entitled "An Exposé of the Assumptions and Business Methods of a Dealer and Reputed Inventor," which was prepared and published by a rival manufacturer apparently for the purpose of discrediting the inventions of the complainant and his personal character and business methods. The greater part of the pamphlet was scandalous matter irrelevant to the issues. The author testified that, so far as it referred to the patents he had studied, the pamphlet correctly expressed his views respecting the same. *Held*, that the contents of the pamphlet could not be considered competent evidence upon the issue of novelty and that complainant's counsel was justified in refusing to cross-examine the author. *Waterman v. Shipman, 64 O. G. 713, C. D. 1893.

40. If defendants in a suit for infringing letters patent plead want of novelty and set up in their answer and offer in evidence a large number of patents prior in date to those of the complainant, the court will not examine these patents, in the absence of expert testimony to explain them or to indicate what they contain, to negative the novelty of the complainant's patents, unless the character of the invention has so little complexity that expert testimony is not required for that purpose. *Id.

41. In a suit to restrain alleged infringement of patents for rasps and files and the process of and machinery for making the same, plaintiffs failed for more than six months after the answer was filed to take any evidence, and

then applied for an order that they be allowed to inspect fully defendants' factory. Defendants denied infringement, and alleged that for years before the patents were granted they made files under a secret process, not patented, which they still use. They also produced files made by such process before the date of the patent, which were apparently the same as plaintiffs' files. *Held*, that the order for the examination would not be granted. *Stokes Brothers Mfg. Co. v. Heller, 64 O. G. 1654, C. D. 1893.

42. Where a corporation charged with infringing a patent was found with a small capital in order to avoid liability for such infringement, it is proper, as a condition of refusing a preliminary injunction against such corporation, to require it to give security for observing the decree in case it should be defeated in the suit. *Edison Electric Light Co. v. Columbia Incandescent Lamp Co., 65 O. G. 133, C. D. 1893.

43. In a suit for the infringement of a patent, when the defense is that complainant had parted with all his interest therein by assignment before filing his bill, and a copy of the record of such assignment in the patent office is introduced in support thereof, while, perhaps, such copy, if standing alone and seasonably and properly objected to, would be inadmissible, yet the objection that no foundation was laid for the introduction of secondary evidence will not be considered on appeal when it was not raised below. *Paine v. Trask, 65 O. G. 298, C. D. 1893.

44. Where the decision of the patent office was that there had been no such delay in the prosecution of the claim as to work an abandonment of the application, the court, even if it had the power, is not required to review the decision when the answer alleges abandonment of the invention and not of the application. *Western Electric Co. v. Sperry Electric Co., 65 O. G. 507, C. D. 1893.

45. The facts touching the prosecution of the application being matters of record in the patent office, easily accessible, the respondents must, if they propose to tender an issue of abandonment of the application, do so by averments to that effect, specific and clear enough to be understood. *Id.

46. Where an interlocutory decree in the first suit was alleged in the second bill, a final decree in the first suit, rendered pending the second suit, may be shown in evidence therein without supplemental pleading, where defendant took no exceptions to the bill, consented to

the introduction of the final decree in evidence so far as the same was material, and only objected thereto on the ground that in rendering such decree the court erred through failure to understand the operation of an alleged anticipatory invention. *David Bradley Mfg. Co. v. Eagle Mfg. Co., 66 O. G. 315, C. D. 1894.

47. Taking testimony in the second suit as to the validity of the patent is not a waiver of the bar of the final decree in the former suit where such testimony was taken before said final decree was rendered, since until rendition of the final decree the proceedings in the first suit were no bar. *Id.

48. The plaintiffs having failed to stand upon an exception and having accepted the ruling of the lower court in the conduct of the trial, *held*, a waiver of error assigned. *Campbell v. City of Haverhill, 70 O. G. 385, C. D. 1895.

49. Where defendant put in evidence a number of patents prior in date to the plaintiff's and asked the court to compare the inventions and devices therein described with those claimed by the plaintiff and no extrinsic evidence was given or needed to explain terms of art or to apply the descriptions to the subject-matter, so that the court was able, from mere comparison, to say what was the invention described in each and to affirm from such comparison whether the inventions were or were not the same, the question was one of pure construction and not of evidence, and consequently was a matter of law for the court, without any auxiliary fact to be passed upon by the jury. *Market-Street Cable Ry. Co. v. Rowley, 70 O. G. 632, C. D. 1895.

50. *Held*, that whether the thing defined by the claims of the patent in suit is infringed by that used by the defendant is a question of fact to be determined by the jury under instructions by the court as to the scope of the patent and the character of the defendant's device. *Coupe v. Royer, 70 O. G. 779, C. D. 1895.

51. Where there was evidence in the form of interviews between plaintiff and defendant, from which the plaintiff sought to infer the fact of actual notice of infringement, and the defendant offered evidence to show that he had never received any notice, actual or constructive, of the patent or any infringement of it, *semble*, that the question of notice ought to be submitted to the jury for their decision. *Id.

52. Whether Berliner's later patent is void on the ground that the earlier patent "was granted upon the same application, to the same applicant, and for the same invention," will

not be determined by the court in a suit by the United States to cancel the later patent, it appearing that the officials of the patent office had before them all the facts bearing on this subject which the court had and understood the law, so that the patent was issued under no mistake of either law or fact. *American Bell Telephone Co. v. United States of America, 71 O. G. 1903, C. D. 1895.

53. Where the defendant had obtained extension of time to plead, answer, demur or take such other action as it may be advised, *held*, this is equivalent to a general appearance. *Hupfeld v. Automaton Piano Co., 72 O. G. 287, C. D. 1895.

54. In a suit for infringement of a patent, defendant while testifying volunteered the statement that after the action was commenced he had offered \$250 in settlement and that plaintiffs demanded \$350 and required that defendant should agree to pay a royalty and to sell no carts below a certain price. *Held*, that the court properly refused defendants' request to charge that this offer of compromise should not be construed as an admission of any right in plaintiffs, for, while correct as a proposition of law, it was misleading, because it ignored the evidence relating to plaintiffs' proposition in response to that of defendants. *Holmes v. Truman, 73 O. G. 448, C. D. 1895.

55. Where counsel for an appellant or a plaintiff in error files a brief and makes an oral argument and does not allude in either to one or more of his assignments of error, he must be taken to have waived them. The court cannot be expected to examine the assignment of error and find the reason for reversal itself. *American Fibre Chamois Co. v. Buckskin Fibre Co., 75 O. G. 833, C. D. 1896.

56. An objection that complainant has failed to prove title might be fatal if made when the certified copies from the patent office were offered, but comes too late when offered at the final hearing. *A. B. Dick Co. v. Henry, 75 O. G. 1204, C. D. 1896.

57. When after arduous litigation the equities and presumptions are all with the complainant, if either party should suffer during final decree it should be the defendant. New York Filter Mfg. Co. v. Niagara Falls Waterworks Co., 77 O. G. 1255, C. D. 1897.

III. IN BRITISH COURTS.

58. In England the repeal of a patent for an invention might be by a bill in chancery, or by

scire facias in a court of chancery or in any proper court. *The United States v. The American Bell Telephone Co., 45 O. G. 1311, C. D. 1888.

59. The English practice grows out of royal prerogative, of which there is nothing corresponding in this country, and all patents issue under the authority of the United States. *Id.

PRINTED PUBLICATIONS.

(See ANTICIPATION.)

PRINTING TESTIMONY.

(See TESTIMONY.)

PRESUMPTION OF VALIDITY.

(See PATENTS.)

PRINTS.

(See LABELS; TRADE-MARKS.)

1. Under section 3 of the act of June 18, 1874, relating to patents, trade-marks and copyrights, "prints" as well as "labels" are entitled to registration. *Ex parte H. J. Heinz Co.*, 62 O. G. 1064, C. D. 1893.

2. The device sought to be registered as a print *held* to have sufficiency of novelty and intellectual creation to merit it. *Id.*

3. A print, to be used for foods, including canned goods, and consisting of a pictorial representation of a disorderly school, *held* registrable, although showing arbitrary and fanciful matter, in view of *Ex parte Heinz Co.*, 62 O. G. 1064; *Palmer*, 58 O. G. 383; *Eldridge & Co.*, 55 O. G. 1278, and *Higgins v. Keuffel*, 55 O. G. 1139; *Ex parte Bovril (Limited)*, 53 MS. D., July, 1893 (*Fisher, Acting Com'r*).

4. Registration of a print exhibiting a number of designs on a sheet of paper refused because not for a copyrightable subject (in view of *Higgins v. Keuffel*, 55 O. G. 1139). *Ex parte Schlegel*, 53 MS. D., Aug., 1893 (*Fisher, Ass't Com'r*).

5. The word "prints" as used in the statute authorizing the registration of prints in the patent office means a picture similar in kind to an engraving, cut or photograph. *Held*, therefore, that a sheet of paper with several multicolored

designs on both sides, with no attempt to produce such unitary effect as is produced by a single cut or engraving, was not such a print as could be registered. *Ex parte Schlegel*, 64 O. G. 1132, C. D. 1893.

6. To be registrable a print must have by itself some value as a composition, at least to the extent of serving some purpose other than as a mere advertisement. *Id.*

(Up to 1893 it was the practice of the patent office to construe as synonymous the words "prints" and "labels" in section 3 of the act approved June 18, 1874.)

PRIOR ADJUDICATION.

(See COMITY; INJUNCTION; PRIOR JUDGMENT.)

1. The question of priority of invention as between rival inventors having been once thoroughly tried and decided, and the defeated party's assignee having in consequence disclaimed the invention as the condition of obtaining a decree on a narrower and different invention, a renewal of a discussion of the question of priority by that assignee in a suit against it for infringement of the rival inventor's patent is useless. **Electrical Accumulator Co. v. Brush Electric Co.*, 61 O. G. 836, C. D. 1892.

2. Where the question upon the merits was determined in a former suit between the parties, though the judgment by reason of the small amount in dispute was not reviewable by a court of appellate jurisdiction, *held*, that the court below did not err in holding that the judgment in the former suit concluded the question between the parties, regardless of the fact that the judgment in the first suit was not subject to review by an appellate court. **Johnson Street Steel Rail Co. v. William Wharton, Jr., & Co., Limited*, 67 O. G. 274, C. D. 1894.

3. The conclusion of the commissioner of patents that the addition to the original claim of a feature shown and described in the original patent does not confer patentability on the re-issue claim was right, since the whole combination was substantially passed upon by the circuit court of appeals. **Briggs v. Seymour, Com'r of Patents*, 78 O. G. 169, C. D. 1897.

PROCESS.

(See PATENTABILITY.)

PRODUCT OF NATURE.

(See PATENTABILITY.)

PROTEST AGAINST ISSUANCE OF PATENT.

1. A protest against the issuance of a patent to an applicant is fatally defective unless it embodies something equivalent to a distinct denial of the applicant's sworn statement of invention. *Riley v. Barnard*, 59 O. G. 1021, C. D. 1892.

2. Where a protestant only filed an affidavit without model or drawing of the alleged anticipating device, *held* insufficient. *Fay v. Conradson*, 65 O. G. 751, C. D. 1893.

PUBLIC FAVOR.

(See PATENTABILITY, EVIDENCE OF EXTENSIVE USE.)

PUBLIC USE OR SALE.

I. IN GENERAL.

II. KNOWLEDGE AND CONSENT OF INVENTOR.

III. IN FOREIGN COUNTRIES.

I. IN GENERAL.

1. Where an invention had been publicly known and practiced more than two years before the date of filing the application, adding to such application new features which did not require invention does not avoid the bar of the previous public knowledge and use. **International Tooth-Crown Co. v. Richmond*, 39 O. G. 1550, C. D. 1887.

2. Where the defense to a suit for the infringement of a patent process is that machines embodying the process claimed were sold and in public use more than two years before the date of the application for the process patent, such defense is not sustained by proof that the use made of the machine before that date was experimental only and not capable of working the process. There is no real invention of a process until a machine is constructed to work the process. **Eastern Paper Bag Co. v. Standard Paper Bag Co.*, 41 O. G. 231, C. D. 1887.

3. When a machine was used by a manufacturer in the regular conduct of his business

by his own workmen, and in the view of such part of the public as resorted to his establishment for the purpose of buying or selling, such use was a public use. **Smith & Griggs Mfg. Co. v. Sprague*, 41 O. G. 1037, C. D. 1887.

4. Where the machine in question consisted in the new combinations of old elements, each of which constituted a new invention, and the machine was practically useful, and its product was used commercially and profitably in the ordinary course of business, such use was not experimental, although the inventor was engaged in the improvements by which it was hoped and expected that the machine would be made more valuable and useful. **Id.*

5. Use by the inventor of a machine in order to devise by experiment improvements upon the same to perfect it is permissible even where, as an incident, the product of the machine is sold; but where the use is mainly for trade and profit and the experiments for improvement are incidental, then the principal and not the incident gives character to the use, and the latter is a public use under the statute and comes within its prohibition if it takes place more than two years before the application for the patent. **Id.*

6. When the purchase or construction of the patented machine or article took place at a time more than two years prior to the application, whether with or without the knowledge, consent or allowance of the patentee, the patent is invalid, and that is the effect of section 24 of the act of 1870 and of section 4886 of the Revised Statutes. **Andrews v. Hovey*, 41 O. G. 1162, C. D. 1887.

7. If the invention is in public use or on sale at a date more than two years before the application for a patent upon it, it will be conclusive evidence of abandonment and the patent will be void. **Id.*

8. The period of two years' public use or sale is to be reckoned from the date when the application is filed in the patent office, and not from the date of its execution. **Campbell v. Mayor, etc. of New York*, 44 O. G. 1185, C. D. 1888.

9. A "sale" to invalidate a patent must have been completely effected more than two years before the application for the patent. **Campbell v. Mayor, etc. of New York*, 45 O. G. 345, C. D. 1888.

10. The putting of a patent on sale by assigning it more than two years prior to the application for it is not a sale of the invention in the sense of section 4886 of the Revised Statutes.

*United States Electric Lighting Co. v. Consolidated Electric Light Co., 33 Fed. Rep. 869 (1888).

11. Use of an invention for business purposes or profit and in which the test of its success and value was only incidental will defeat a patent if it occurred more than two years before application. *Root v. Third Avenue R. Co., 46 O. G. 1393, C. D. 1889.

12. Where a patent had been issued to joint inventors and more than two years of public use had occurred before the filing of a separate application by one of the joint inventors, and the applicant in the separate application claimed to be the sole inventor of the device claimed in the joint patent, *held*, that said public use was a bar to his obtaining a patent on his sole application. *Ex parte MacLay*, 49 O. G. 1043, C. D. 1889.

13. Where the mechanism of the anticipating device was such as to be necessarily concealed from view during its legitimate use and would not operate as perfectly as that of the patented invention, *held* not to be sufficient objections to overcome the defense of anticipation. *Brush v. Condit, 49 O. G. 1211, C. D. 1889.

14. Where there had been a public, well-known practical use in ordinary work, with as much success as was reasonable to expect at that stage in the development of the mechanism belonging to electric-arc lighting, of the exact invention which was subsequently made by the patentee, *held*, that, although only one article like the patented invention was ever made, which was used two and one-half months only, and the invention was then taken from the lamp and was not afterward used with carbon pencils, it was an anticipation of the patented device under the established rules upon the subject. *Id.

15. The statutory bar of public use is not avoided by a caveat. In other words, applicant cannot take any benefit, as against the allegation of prior public use as a bar or defense, from any act which falls short of such an application as the statutes authorize and make provision for. *Ex parte Meucci*, 51 O. G. 299, C. D. 1891.

16. In determining whether A. should receive a patent the record should be carefully examined by the primary examiner with reference to the question whether more than two years of public use preceded his application, and in view of certain prior printed publica-

tions the examiner should inquire whether the claims of A. are anticipated. *Stanley v. Slatery*, 54 O. G. 1709, C. D. 1891.

17. Where an inventor disclosed his invention to a company which adopted it and put it into complete and practical operation in and for the ordinary purposes of trade and commerce, and where it appears that the inventor regarded his invention as complete at the time of its adoption by such company, such use for more than two years before application for patent is a public use within section 4886, Revised Statutes, and not one of experiment. *Root v. Third Avenue Ry. Co., 61 O. G. 1947, C. D. 1892.

18. *Elizabeth v. Pavement Co.* (97 U. S. 126), distinguished, and *Smith & Griggs Mfg. Co. v. Sprague* (41 O. G. 1037, 123 U. S. 249), and *Hall v. Macneale* (23 O. G. 937, 107 U. S. 90), cited and commented on. *Id.

19. The experimental use of an invention by the inventor or by persons under his direction, if made in good faith, solely in order to test its qualities, has never been regarded public use. (Cases cited.) *Harmon v. Struthers, 57 Fed. Rep. 637 (1893).

20. The inventor's device was applied to an engine that went out from the shop of his employers and was sold and delivered more than two years before the application for a patent. *Held*, that the sale was for the purpose of a test or for experimental use, and did not involve public use or sale constituting a statutory bar. *Id.

21. Where a manufacturer places an article upon the market, in the usual and accustomed line of business, more than two years before applying for a patent, to see what his customers think of it, it cannot be said that it was an experiment within the meaning of the statute. "It is a trader's and not an inventor's experiment." *Smith & Davis Mfg. Co. v. Mellon, 66 O. G. 173, C. D. 1894.

22. Where more than two years' public use are proved, the evidence that a change was made in the invention within the two years prior to the application for the patent, but which change is described only as a preferable form, will not save the patent. *Id.

23. Where the device set up establishing prior public use did not contain one of the features of the patented device, and which feature was useful and novel, *held*, that the public use was not established. *Costa v. Drobaz, 69 O. G. 374, C. D. 1892.

24. The evidence of use by one Heller, in 1877-78, of an extension butt-adjuster connected with an Appleby machine is not sufficient to create the bar of public use. *Deering v. Winona Harvester Works, 69 O. G. 1641, C. D. 1894.

25. Where it appears that a fire-alarm box was offered for sale in no other manner than as a part of a fire-alarm system to be installed by the seller and nothing was done evincing an intention on his part to transfer to the buyer a fire-alarm box except upon an executory contract containing conditions and requiring of the buyer much to be done precedent to the transfer of title, *held*, that the fire-alarm box was not on sale within the meaning of section 4886, Revised Statutes, although the box was completed, tested and ready for immediate use at the date of the contract. (Burton v. The Town of Greenville, 18 O. G. 411, 3 Fed. Rep. 642, and other cases referred to.) Ruddick v. Milliken, 72 O. G. 1651, C. D. 1895.

26. Importation of goods by a firm shown to have been accustomed to exhibit goods of that character promptly, though admissible as evidence, is insufficient to establish public use or sale within the United States. *Hanifen v. E. H. Godshalk Co., 79 O. G. 510, C. D. 1897.

27. A defense of two years' public use must relate back to the first or original application and not to the second application filed as a division thereof. *Stirling Co. v. St. Louis Brewing Ass'n, 79 Fed. Rep. 80 (1897).

(Experimental use distinguished in Elizabeth v. Pavement Co., 97 U. S. 126; also secret use in Egbert v. Lippman, 21 O. G. 75, C. D. 1882. Article may be made more than two years before application for patent. Sandusky Seat Co. v. Comstock, 13 Brodix, 222. Secret use distinguished from proper concealed use. Brush v. Condit, 49 O. G. 1211, C. D. 1899. Public and private use distinguished. Manning v. Cape Ann Co., Ising Glass & Glue Co., 23 O. G. 2418, C. D. 1883.)

II. KNOWLEDGE AND CONSENT OF INVENTOR.

28. The inventor's consent to or allowance of the public use or sale of his invention is not requisite to invalidate a patent. (Andrews v. Hovey, 42 O. G. 1285.) *Campbell v. Mayor, etc. of New York, 44 O. G. 1185, C. D. 1888.

29. The circuit courts having in several instances held that under the section in question a patent was not invalid by a public use and sale without the consent or allowance of the inventor, these decisions are not controlling in the supreme court of the United States where

no direct adjudication has been made by that court upon the particular point. *Andrews v. Hovey, 42 O. G. 1285, C. D. 1888.

30. The fact that in an interference in the patent office, where the question has been distinctly raised, a patent was issued to Green with the knowledge on the part of the patent office that there had been a public use of the invention more than two years before his application, is not controlling upon this court. *Id.

31. The promulgation and enforcement of a rule of the patent office, that a patent would not be granted if the invention had been in public use or on sale, with the consent or allowance of the inventor, for more than two years before his application, cannot be regarded as having the effect of a judicial or authoritative adjudication of the question. *Id.

32. Under sections 6, 7 and 15 of the act of 1836, in connection with section 7 of the act of 1839, purchase, sale or use of the invention more than two years before the application, without regard to the consent or allowance of the inventor, renders the patent invalid. *Id.

33. The invalidating two years' public use of the statute does not require the knowledge, allowance or consent of the inventor. *Ex parte* Drawbaugh, 57 O. G. 693, C. D. 1891.

34. An inventor using due diligence by experiments toward perfecting his invention, and making application for a patent within two years after its completion, will not be deprived of his right to a patent for it because of the construction and sale of a form of it by another, without his knowledge, during the time of experiments and before its completion, although more than two years before his application. *Campbell v. Mayor, etc. of New York, 57 O. G. 1427, C. D. 1891.

35. The plain import of the words "not in public use or on sale for more than two years prior to his application" is the creation of a limitation of two years within which a patent for an invention must be applied for after it has gone into public use, either with or without the knowledge, consent or allowance of the applicant for the patent. *In re Drawbaugh, 67 O. G. 929, C. D. 1894.

III. IN FOREIGN COUNTRIES

36. Sections 4886 and 4887 of the Revised Statutes must be construed together, and when this is done the two years' prior public use or sale, which under section 4886 operates as a

bar to the grant of a patent, is such a use or sale within the United States and has no reference to foreign countries. *Gandy v. Main Belting Co., 59 O. G. 1106, C. D. 1892.

37. There is no inconsistency between the law providing that a foreign public use shall not in itself invalidate a patent and the law of evidence under which it is competent to prove such foreign use and sale in order to fix the date of an invention. *Hanifen v. E. H. Godshalk Co., 79 O. G. 510, C. D. 1897.

PUBLIC-USE PROCEEDINGS.

(Public-use proceedings date from the decision of Commissioner Marble in *In re Von Hefner-Alteneck*, 23 O. G. 2233, C. D. 1883.)

1. The commissioner has authority to refer a case to the examiner of interferences for investigation of the question of public use or sale. Such examiner may, according to the nature of the order of reference to him, report the facts with his conclusions to the commissioner, or he may decide the questions investigated by him. The commissioner may remand the case to the primary examiner with such instructions as he may see proper. The primary examiner only has authority to *reject* the application on the findings in the first instance. From such rejection an appeal lies, upon payment of fees, to the examiners-in-chief, as in any other *ex parte* case. *Ex parte Finch*, 40 O. G. 1027, C. D. 1887.

2. The examiners-in-chief acted without authority in entertaining jurisdiction of the appeal taken in the present case from the decision of the examiner of interferences. *Id.*

3. When an allegation of public use comes up for consideration in connection with an application which is being considered *ex parte* after the termination of interference proceedings, the proper practice is for the examiner to pass upon the question whether or not a *prima facie* case of public use has been established, rejecting the claims in the case if he decides the question in the affirmative. *Ex parte Beatty*, 56 O. G. 1563, C. D. 1891.

4. Unsworn statements not identifying with certainty the thing alleged to have been in public use do not constitute a *prima facie* case. *Id.*

5. When public use is alleged it should be set forth in the affidavits by specific acts. *Ex parte Shettler*, 60 O. G. 158, C. D. 1892.

6. With the small sum appropriated by congress for conducting public-use proceedings

the patent office is not justified in instituting such proceedings unless a strong *prima facie* case is presented. *Fay v. Conradson*, 65 O. G. 751, C. D. 1893.

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

REHEARING IN PATENT OFFICE.

(See AMENDMENT AFTER FINAL REJECTION; RE-OPENING; WITHDRAWAL FROM ISSUE; JURISDICTION OF COMMISSIONER OF PATENTS; NEW TRIAL.)

I. EX PARTE.

II. INTERFERENCE.

I. EX PARTE.

1. Petition that a rehearing be granted in case of an appeal decided by the assistant commissioner, the sole reason for such petition being that a decision upon the merits of the case by the commissioner in person is desired by the petitioner, denied on the ground that the duties of the assistant commissioner are necessarily the same in kind as those of the commissioner, and on the ground that such duties are directly prescribed by statute. *Ex parte Hughes*, 56 O. G. 1448, C. D. 1891.

2. A motion for rehearing ought to be governed, as far as practicable, by rules which in courts govern new trials. *Ex parte Spielman*, 56 O. G. 1707, C. D. 1891.

3. When it is sought to present for consideration additional evidence, the attempt must be accompanied by a satisfactory showing why such evidence was not produced at the first hearing. *Id.*

4. A finding of fact by a former commissioner should not be reconsidered, unless no evidence was presented at the hearing on which such a finding might be based, or unless the finding was clearly against the weight of evidence. *Id.*

5. Where a party who, with full knowledge at the outset of the other party's ground of contention, has underestimated the importance of it and set up his defense on a different line, a

motion for rehearing simply to make a different defense will not be considered. *Ex parte Spielman*, 58 O. G. 141, C. D. 1892.

6. A motion for a rehearing will not be entertained by the commissioner for the purpose of enabling an applicant to make a fuller presentation of his case when there is no satisfactory showing that he might not have done so in the first instance. *Ex parte Utley*, 58 O. G. 1091, C. D. 1892.

7. Motion for rehearing in matter of protests of *Riley v. Barnard* denied in view of certain evidence herein quoted. *Ex parte Riley*, 62 O. G. 1515, C. D. 1893.

8. Rehearings are not favored in any case, and only upon special circumstances. Motion for rehearing will not be entertained where there has been long delay in bringing it. Rehearings must be applied for within the limit of appeal. *Ex parte Messinger*, 78 O. G. 1903, C. D. 1897.

II. INTERFERENCE.

9. Rule 144, based upon the procedure in courts of law, does in terms confer, and was intended to confer, upon the commissioner jurisdiction to rehear the decisions of his predecessor when grounds other than those based on fraud, error in computation, or newly-discovered evidence are alleged and set forth in motions filed for the rehearing of such decisions. **Daniels v. Morgan*, 47 O. G. 811, C. D. 1889.

10. It certainly would be a hardship if in an interference proceeding, when the commissioner who rendered the decision would on sufficient showing have been swift to afford a rehearing, the defeated applicant should be without remedy because of the succession to office of a new commissioner, and a rule adapted to prevent such a result certainly commends itself as a part of a system of procedure designed to do justice between parties who are asking the patent office to determine which of them is the prior inventor of an invention which can be patented to but one of them. **Id.*

11. The practice of splitting up cases and allowing separate parties to file separate motions and present them at different times condemned. In interference proceedings motions for rehearings presented by the parties thereto ought to be heard at the same time, in order that the entire case may be disposed of at once. *Green v. Hall, v. Siemens, v. Field*, 47 O. G. 813, C. D. 1889.

12. *Green's* motion for rehearing overruled because (*first*) it involves a question of merits

which is *res adjudicata* by reason of the previous decision of the commissioner and also that of his predecessor, and (*second*) because it shows no error in the former decision which *Green* seeks to have set aside. *Id.*

13. Manifest error in law, being ground for new trial, is also ground for a rehearing under the patent office rule relating to such matters. *Green v. Hall, v. Siemens, v. Field*, 47 O. G. 1631, C. D. 1889.

14. Where the junior party to an interference proved that before any date of invention which could be given to the senior party he had in his possession and sent to his son in this country a full description of the invention in controversy, and his *prima facie* standing as an original inventor was not challenged by any testimony to the contrary, and a judgment of priority was rendered upon final hearing in favor of said junior party, *held*, upon a motion for rehearing upon the ground that there was error in not requiring further proof of the *fact* of his invention, that the supposed error was no error. *Gessner v. Miller*, 50 O. G. 433, C. D. 1890.

15. *Held* further, that it was not necessary to consider that part of rule 110 which provides that when the invention was made abroad the preliminary statement must set forth that the applicant made the invention, it appearing that there was no such provision in the rule when the testimony was taken. *Id.*

16. Where in a motion for a rehearing the claim that the evidence had been newly discovered simply amounted to an assertion that a party litigant erred in judgment, and that in consequence of such error he failed to introduce testimony of the existence of which he had knowledge before the submission of the case for hearing and which subsequently to the decision thereof he came to regard as material and important, *held* not to bring the case within the general rule relating to rehearings. Evidence does not become newly discovered when errors in judgment as to its legal effect are rectified. *Lorraine v. Thurmond*, 52 O. G. 1949, C. D. 1890.

17. *Held* further, that a rehearing should be denied because the exhibits referred to in the affidavits upon which the motion for rehearing was based do not show the invention embodied in the issue, so that if in the case as originally heard they would not have altered the result. *Id.*

18. Except under extraordinary circumstances the commissioner will consider only alleged errors of law upon a motion for re-