

hearing. *Clark v. Broad*, 57 O. G. 1426, C. D. 1891.

19. On a motion for rehearing of a case originally heard and determined by the acting commissioner, upon the ground of decision contrary to evidence, the commissioner will not disturb the prior decision upon a showing that the testimony was closely balanced and admitted the possibility of a contrary conclusion; but it must appear that the decision was clearly against the weight of testimony. *Webb v. Blickensderfer*, 62 O. G. 159, C. D. 1893.

20. Where on a motion for rehearing no suggestion is made that anything would be brought to the attention of the commissioner beyond a representation of the same arguments and the same facts, and there is no pretense that evidence has been omitted or overlooked, or that the case could be strengthened in any way, and where every point alluded to in the motion was carefully considered before a conclusion was reached, *held*, that the motion should be denied. *Scott v. Brooks*, 71 O. G. 1314, C. D. 1895.

21. Where it was urged that the commissioner has discretion to grant rehearings even after a decision upon the question of priority by the court of appeals, *held*, that cases are conceivable in which, to prevent failure of justice, this may be so; but the discretion is governed and determined by well-established principles. (*Giant Powder Co. v. California Co.*, 5 Fed. Rep. 197.) *Id.*

22. Where it appeared that S. attempted to take an appeal to the court of appeals of the District of Columbia, but failed without any fault of his own, and on that account was not heard upon the merits before the appellate court, and the case having been dismissed and a motion to reinstate was made to that court and denied, *held*, that these facts do not appear to enlarge the discretion of the commissioner in rehearing cases, but would seem to indicate that what was denied by the appellate court, for reasons satisfactory to it, should not be presented here, except upon special circumstances clearly shown and calling for such an extraordinary course. *Id.*

23. Following the settled practice in the courts, when rehearings are sought upon alleged errors of law, that application must be made for the rehearings before the time for appeal has gone by, *held*, that whenever the time for appeal from the patent office to the court of appeals has gone by the time for a rehearing has elapsed with it. *Id.*

24. An applicant's contention upon a rehearing that he was "surprised" by the interpretation put upon his application in the former hearing is without foundation, since the application itself was his evidence, and was examined like other evidence. *Dewey v. Colby*, 75 O. G. 1360, C. D. 1896.

REHEARING IN THE COURTS.

(See NEW TRIAL.)

RE-ISSUE.

(See CORRECTION OF PATENTS.)

- I. IN GENERAL.
- II. DELAY IN APPLYING FOR.
- III. IDENTITY.
- IV. ENLARGEMENT VALID.
- V. ENLARGEMENT INVALID.
- VI. NEW MATTER.
- VII. INADVERTENCE OR MISTAKE.
- VIII. TO CORRECT ERROR OF PATENT OFFICE.

I. IN GENERAL.

1. An applicant for re-issue who has assigned his entire interest in the invention is not merely a "perfunctory affiant" in making oath to inadvertence, accident or mistake, because he is the only person who is supposed to be possessed of the requisite knowledge upon which to make and base such affidavit. *Ex parte Mahnken*, 41 O. G. 1269, C. D. 1887.

2. The right of the assignee under the statute comes from the inventor, and he can secure no broader patent than the inventor can apply for. If an applicant purposely or intentionally limits the scope or extent of the claims, his assignee cannot obtain a re-issue for an invention broader or greater than that claimed by the inventor. *Id.*

3. The rule in *Parker & Whipple Co. v. Yale Lock Co.* (123 U. S. 87, 25 O. G. 290) affirmed that the patent office model alone is not to be considered the basis for a re-issue in which a change of the invention of the original patent is sought. **Flower v. City of Detroit*, 43 O. G. 1348, C. D. 1888.

4. The specifications and claims of the original patent and re-issue being substantially the same in scope, and the re-issue having been applied for within a few months, it was held valid, although no reason for the re-issue was shown. **Maltby v. Graham*, 37 Fed. Rep. 689 (1889).

5. When the office has given a wrong title in a patent, the latter should be canceled and a new one issued. (Railway Register Mfg. Co. v. North Hudson C. R. Co., C. D. 1885.) Ex parte McManus and Hoch, 53 MS. D., Sept., 1893 (Fisher, Acting Com'r).

6. *Held*, that patentees should not be allowed to experiment and take chances in attempts to secure re-issues, to extend, enlarge or broaden their inventions, without taking the risk and subjecting themselves to the same rules and principles which apply and govern in original applications. *McCormick Harvesting Machine Co. v. C. Aultman and Co., 63 O. G. 1791, C. D. 1893.

7. *Held* that, if the claims survived the revisory action and rejection thereof by the patent office on the original application, still the unsuccessful attempt made in the re-issue proceeding to broaden or expand them must, upon well-settled principles, be held to so limit and restrict their construction as to exclude what was thus rejected and to confine them to the specific devices and combinations therein described. *Id.

8. Since patents are now re-issued strictly for the same invention covered by the original patent, the re-issue application ought to have the same standing as the original patent as to burden of proof. Huson v. Crowell, v. Yates, 64 O. G. 1006, C. D. 1898.

9. Where the office holds an applicant to be entitled to a re-issue for broader claims, it in effect holds that it was by reason of inadvertence, accident or mistake that applicant did not make the broad claims in the patent; that he has been reasonably diligent in applying for such re-issue, and therefore that there has been no such dedication to the public of the inventions covered by the broad claims as should prevent the office from considering the re-issue application a continuation of the original application. *Id.*

10. *Quære*: If a patentee applies for a re-issue of his patent, and includes among the claims under the new application the same claims as those which were included in the old patent, and the examiner of the patent office rejects some of such claims and allows others, both old and new, does the patentee by abandoning his application for a re-issue and by procuring a return of his original patent hold his patent invalidated as to those claims which the examiner rejected? (The above question is certified by the circuit court of appeals to the supreme court for decision.) *McCormick Har-

vesting Machine Co. v. C. Aultman & Co., 73 O. G. 1999, C. D. 1895.

11. Where a re-issue application is filed without fee for the purpose of correcting a mistake made by the office, *held*, that not only the mistake may be corrected, but that, if the office chooses, a full re-examination of the case may be made, as it would be improper for the office to re-issue a patent when it is known that a statutory bar exists. Ex parte Weaver, 76 O. G. 1715, C. D. 1896.

12. When an application for a re-issue of a patent is made, the original patent continues to be a valid patent until it is re-issued, when it becomes inoperative; if a re-issue be refused, the surrender never takes effect, and the patent stands as if no application had ever been made for a re-issue. *Allen v. Culp, 79 O. G. 1523, C. D. 1897.

13. While it is true that in making his surrender the patentee declares that his patent is inoperative and invalid, yet this is not necessarily so for all purposes, but for the purpose for which he desires to have it re-issued. Such a patent might be inoperative and invalid as against certain persons who had pirated the underlying principle of the patent and avoided infringing the exact language of the claims and yet be perfectly valid as against others who were making machines clearly covered by their language. *Id.

14. If the application for a re-issue be rejected, the original patent stands precisely as though a re-issue had never been applied for, unless at least the re-issue be refused upon some ground equally affecting the original patent. *Id.

(The settled law in respect to re-issues is declared by the supreme court in *Topliff v. Topliff*, 145 U. S. 50, 13 Sup. Ct. 825. See, also, *Gaskill v. Myers*, 81 Fed. Rep. 854, 1897.)

II. DELAY IN APPLYING FOR.

15. A delay of nearly three years after the date of the original patent before applying for its re-issue with broader claims is not excused by the mistake of the solicitor who applied for and procured the original patent with claims more narrow than those which he was instructed by the inventor to make. *Ives v. Sargent, 38 O. G. 781, C. D. 1887.

16. The right to a re-issue with a broadened claim is lost by a delay of four years in making application therefor. *Curran v. St. Louis Refrigerator and Wooden Gutter Co., 39 O. G. 590, C. D. 1887.

17. The delay in filing the application for the re-issue in suit not accounted for nor shown to be reasonable renders such re-issue invalid.

*Hoskin v. Fisher, 43 O. G. 509, C. D. 188.

18. If it be conceded that the inventions claimed in the re-issue were described in the original, then, such claims being expansions and more than three years having elapsed after the original was granted before the re-issue was applied for, the doctrine of laches applies and the delay must be held unreasonable in the absence of explanatory averments in the bill.

*Philadelphia Novelty Co. v. Rouss, 48 O. G. 1664, C. D. 1889.

19. The delay of nearly nine years is fatal, especially as no inadvertence, accident or mistake appears such as would authorize a re-issue with new claims. *Electric Gas Lighting Co. v. Boston Electric Co., 55 O. G. 429, C. D. 1891.

20. The presumption is in favor of the validity of a re-issue applied for and obtained in less than two years after issue of the original patent. *Alaska Refrigerator Co. v. Wisconsin Refrigerator Co., 57 O. G. 125, C. D. 1891.

21. If a re-issue be sought to enlarge a claim, a delay of two years from the original grant in applying therefor will ordinarily, though not always, be treated as evidence of abandonment of the new matter to the public. *Topliff v. Topliff, 59 O. G. 1257, C. D. 1892.

22. Where there was a period of eight years between the date of the original patent and the application for the re-issue, *held*, that the delay was unreasonable and cannot be excused on the ground that the patentee would have seasonably applied for the re-issue but for the advice of his solicitor to wait. (Dobson v. Lees, 53 O. G. 1740, 137 U. S. 258). *Wollensak v. Sargent & Co., 66 O. G. 1007, C. D. 1894.

23. Where, after the issue of an original patent and before an application for the re-issue of the same, it was shown that other parties were using the subject-matter not claimed, *held*, that the patentee has abandoned his right to a re-issue to claim such matter by his laches in not applying for the re-issue before the rights of other parties accrued. Loewer v. Ross, 76 O. G. 1711, C. D. 1896.

(The rule as to laches is more rigid in cases where applicant seeks to broaden claims. *Held*, six months was not (in the particular case) unreasonable delay. *Ex parte Matthews & Race*, 28 O. G. 823, C. D. 1884, *Butterworth, Com'r.*)

III. IDENTITY.

(See ENLARGEMENT; NEW MATTER.)

24. Under the statute the commissioner of patents has no jurisdiction to grant a re-issued patent for an invention substantially different from that embodied in the original patent, and it does not follow that what was indicated in the original specifications, drawing or model is to be considered as a part of the invention, unless the court can see from a comparison of the two patents that the original patent embodied as the invention intended to be secured by it what the claims of the re-issue are intended to cover. *Parker & Whipple Co. v. Yale Clock Co., 41 O. G. 811, C. D. 1887.

25. It is well settled that a re-issue can only be granted for the same invention intended to be embraced by the original patent, and the specification cannot be substantially changed, either by the addition of new matter or the omission of important particulars, so as to enlarge the invention as intended to be originally claimed. *Pattee Plow Co. v. Kingman & Co., 46 O. G. 1107, C. D. 1889.

25a. Re-issued letters patent, granted May 2, 1871, to John J. Schillinger, for concrete pavement, as it stood after the filing of the disclaimer, held to include no new matter. *Hurlbut v. Schillinger, 47 O. G. 1067, C. D. 1889.

26. Letters patent issued for the following claim: "The rod with its knob E and the oscillating lever C, for the purpose of releasing a suspended weight by the direct action of a gong-hammer, substantially as and for the purpose herein described." The re-issued patent contained these claims: "The trip-rod D, arranged as described, and the oscillating lever C, for the purpose of releasing a suspended weight by the movement of a gong-hammer, substantially as and for the purpose described," and "the trip-rod D, oscillating lever C, and suspended weight B, in combination with the hammer of a gong, for the purpose of operating mechanism distant from the gong, substantially as above described." *Held*, that the claims of the re-issue were fairly embraced in the claim of the original. *Walker v. City of Terre Haute, 54 O. G. 507, C. D. 1891.

27. It has been repeatedly declared by the supreme court that a re-issue can be permitted only to secure the invention which was described in the original patent, and which it was the intention of the patentee, manifest upon the face of the patent itself, to secure thereby.

*Featherstone v. George R. Bidwell Cycle Co., 57 Fed. Rep. 631 (1893).

28. It is settled by the authorities that to warrant new or broader claims in a re-issue such claims must not only be indicated in the original application, but it must further appear (1) that they constituted a part of the original invention and (2) were sought and intended to be covered or secured by the original patent. (Bantz v. Frantz, 21 O. G. 2037, 105 U. S. 160; Heald v. Rice, 21 O. G. 1443, 104 U. S. 737; Miller v. Brass Co., 21 O. G. 201, 104 U. S. 350; James v. Campbell, 21 O. G. 337, 104 U. S. 356; Topliff v. Topliff, 59 O. G. 1257, 145 U. S. 156.) *Corbin Cabinet Lock Co. v. Eagle Lock Co., 65 O. G. 1066, C. D. 1893.

IV. ENLARGEMENT VALID.

(See IDENTITY; NEW MATTER.)

29. A re-issue is not rendered void by a new description or statement in the specification of the difficulties and defects of prior inventions in the same line. The specification may also state how the patentee has avoided such difficulties and defects. *Kearney v. Lehigh Valley R. Co., 32 Fed. Rep. 320 (1887).

30. The new and broader claims of the re-issue are not for a different invention from that describing the original patent. A subcombination may be claimed in a re-issue if it was shown in the original as performing the same functions, even though it was claimed only as a part of a larger combination. (Walker on Patents, sec. 245, and cases there cited.) *Jenkins v. Stetson, 32 Fed. Rep. 398 (1887).

31. Under recent decisions of supreme court a patentee is not precluded from obtaining a re-issue with broader claims than those of the original patent, provided he is not guilty of laches and the re-issue is for the same invention as the original. In re-issues made for the purpose of enlarging the scope of the patent, the rule of laches should be strictly applied. (Citing Miller v. Brass Co., 104 U. S. 350.) *Id.

32. Certain matters found only in the re-issued patent; *held*, that all these additional features were matters of reasonable inference from the language of the original specification, as explained by testimony or by common knowledge. *Eames v. Andrews, 39 O. G. 1319, C. D. 1887.

33. Where matters found only in the re-issue, or matters where a change has been made from that described in the original patent, occur, if the additions and changes do not in fact

amount to a different invention, the case is simply one of a defective specification and a proper subject of amendment. *Id.

34. If the amended specification does not enlarge the scope of the patent by extending the claim so as to cover more than was embraced in the original, and thus cause the patent to include an invention not within the original, the rights of the public are not thereby narrowed, and the case is within the remedy intended by statute. *Id.

Original.

35. The herein-described process of sinking wells where no rock is to be penetrated, viz.: by driving or forcing a rod to and into the water under ground and withdrawing it and inserting a tube in its place to draw the water through, substantially as herein described.

Re-issue.

The process of constructing wells by driving or forcing an instrument into the ground until it is projected into the water without removing the earth upward, as it is in boring, substantially as herein described.

Held, that each of these claims is for the same invention. *Id.

36. The patent office held that a compound disk constituted but a single adjustable device or single disk, and rejected the third claim, to which rejection the owners of the patent assented. *Held*, that they did not thereby abandon the right to claim in a subsequent re-issue a double or compound disk and obtain a valid patent therefor. *Yale Lock Mfg. Co. v. New Haven Savings Bank, 43 O. G. 115, C. D. 1888.

37. While a comparison of the two patents evinces that the specification of the re-issue is amplified, yet this amplification is in matters of an explanatory nature and embraces nothing of any importance which is not plainly disclosed in the original specification and accompanying drawings. *Putnam v. The Keystone Bottle Stopper Co., 48 O. G. 113, C. D. 1889.

38. A re-issue cannot be held invalid because of enlargement of claims when the original patent is not in the case and no evidence is offered to show expansion in the re-issue beyond what is justified by the original specification and drawings. *Alaska Refrigerator Co. v. Wisconsin Refrigerator Co., 57 O. G. 125, C. D. 1891.

39. The right to expand a claim by re-issue exists for a reasonable time after the original patent is granted, provided the limits of the original invention are not exceeded and pro-

vided the error arose by inadvertence, accident or mistake, and without any fraudulent or deceptive intention. *Ex parte Pepper*, 46 MS. D. (3 G. W. D.), May, 1891 (Mitchell, Com'r).

40. All the authorities are to the effect that where, under such circumstances, the application for a re-issue merely seeks to make the claim broader and more comprehensive, it may be granted, in order to secure to the patentee his actual invention, provided he has not been guilty of any inexcusable laches, and no adverse rights have accrued. (Cases cited.) **Featherstone v. George R. Bidwell Cycle Co.*, 53 Fed. Rep. 113 (1892).

41. Where the amendment of the application as first filed is within the scope of the original invention, no charge of undue expansion can be sustained and no new oath is necessary because the amendment introduces no new invention. **Beach v. American Box Machine Co., Inman et al.*, 69 O. G. 1067, C. D. 1894.

42. A re-issue held allowable where it appeared it was the intention of the patentee to make a broader claim than was allowed, and no intervening rights have accrued, and when the patentee inadvertently omitted to mention all the points involved to his attorney, and the associate attorneys limited the claim in ignorance of the operation of the device. *Ex parte Mock*, 62 MS. D., July, 1897 (Butterworth, Com'r).

43. The claims of a re-issued patent were held valid which omitted all reference to certain parts or elements embraced in the original claims, which parts really constituted no part of the invention. **Gaskill v. Myers*, 81 Fed. Rep. 854 (1897).

44. Re-issue Letters Patent No. 11,383 held to be valid, although the claims of the original patent had been broadened by the omission of certain unpatentable elements. **Gaskill v. Myers*, 81 O. G. 1111, C. D. 1897.

45. A claim which made what was no part of the invention one of the elements, was defective, and the defect was properly cured by omitting the improper element from the re-issue. **Id.*

V. ENLARGEMENT, INVALID.

(See IDENTITY; NEW MATTER.)

46. A re-issue whose claims have been expanded to twelve from a single original claim, and in which material changes and additions have been made in the specification, is invalid.

**Columbia Rubber Co. v. Klous*, 33 Fed. Rep. 275 (1887).

47. A claim allowed in a re-issued patent, which was stricken out by the solicitor in the original application, held invalid. The patentee is bound by the acts of his counsel. **Dobson v. Lees*, 30 Fed. Rep. 625 (1887).

48. Where the specification of the original patent is so changed in the re-issue as to admit of a claim which could not have been made in the original specification, there has been a substantial alteration and the claim based thereon is void. **Hartshorn v. Saginaw Barrel Co.*, 38 O. G. 540, C. D. 1887.

49. Where the original patent described and claimed a lever applied to a whip-socket, and the re-issue described and claimed a lever applied to a part of a whip-socket, the re-issue was unduly enlarged, and is invalid. **Worden v. Searls*, 39 O. G. 359, C. D. 1887.

50. Where the claim in the re-issue omitted certain words in the corresponding original claim, if the same effected an enlargement of the invention, the re-issue is invalid. **Matthews v. Iron Clad Mfg. Co.*, 42 O. G. 827, C. D. 1888.

51. The original patent and the first re-issue having been distinctly limited to a bushing having a notch, the second re-issue, obtained nearly seven years afterward, for a bushing without any such notch, is an unwarrantable enlargement. **Cornell v. Weidner*, 43 O. G. 985, C. D. 1888.

52. Where it does not appear that any attempt has been made to secure by the original patent the inventions covered by the new claims in the re-issue, those inventions must be regarded as having been waived or abandoned so far as the re-issue is concerned. **Hoskin v. Fisher*, 43 O. G. 509, C. D. 1888.

53. A re-issue for an invention not disclosed nor suggested in the original, and there being no defective nor insufficient specification, and no inadvertence nor mistake in the wording of the claim of the original, held void. **Brewster v. Shuler*, 37 Fed. Rep. 785 (1880).

54. A claim in a re-issue for an article or product, which claim was rejected by the patent office in the original application and deliberately struck out, held invalid, because there was no mistake inadvertently committed, and the re-issue was for the mere purpose of enlarging the monopoly of the patent. Under the circumstances it is quite immaterial that the application for re-issue was made within two years from the date of the original patent.

(Cases cited.) *Union Paper Bag Machine Co. v. Waterbury, 39 Fed. Rep. 389 (1889).

55. A re-issue patent which contains claims that had previously been abandoned by the patentee in order to obtain his original letters patent must be held to be invalid as to such claims. *Yale Lock Mfg. Co. v. The Berkshire National Bank, 51 O. G. 1291, C. D. 1890.

56. Where Sargent made such a claim as claim 3 of the re-issue in his application of May, 1874, and abandoned it and filed a new application in March, 1875, on which his original patent issued, *held*, that said claim 3 of the re-issue was invalid. *Id.

57. A re-issue is invalid, first, if its claim is broadened after inexcusable delay by the patentee; and second, if the claim covers a different invention from the one actually described and shown in the original. The statute (sec. 4916) provides for "a new patent for the same invention" as such invention appears from the specification and claims of the original (many authorities cited). *Carpenter Straw-Sewing Machine Co. v. Searle, 52 Fed. Rep. 809 (1892).

58. Where a broad invalid claim has been permitted to remain unchanged for a long period of years, until adverse equities have arisen, and a re-issue is granted with a new claim which, though for a larger combination, seeks to hold, as infringements, machines which have been lawfully made for years, the re-issue is broadened, and is therefore invalid. (Hubel v. Dick, 28 Fed. Rep. 132.) *Id.

59. A re-issue cannot be permitted to enlarge the claims of the original patent by including matter once intentionally omitted. Acquiescence in the rejection of a claim; its withdrawal by amendment, either to save the application or to escape an interference; the acceptance of a patent containing limitations imposed by the patent office, which narrow the scope of the invention as at first described and claimed,—are instances of such omission. *Dobson v. Lees, 53 O. G. 1740, C. D. 1890.

60. Where it appeared that a patent was granted in 1872, and that the re-issue application was made in 1881, and that no question of inoperativeness or invalidity was raised during that period, and where the sole object of the re-issue was to expand and multiply the claims so as to cover patents issued subsequently to the original, *held*, that the re-issued patent was invalid, because the new claims therein were not for the same invention set forth in the claims of the original patent. *Electric Gas-

Lighting Co. v. Boston Electric Co., 55 O. G. 429, C. D. 1891.

61. The claim of an original patent was for an inelastic bridge or check piece arranged across the crotch of pantaloons, whereby the strain is received by this bridge or check piece, instead of at the angle of the crotch itself. The re-issue contained two claims, and in an action brought for its infringement it was successfully contended by the defendant in the lower court that the re-issue was broader than the original patent. *Patent Clothing Co., Limited, v. Glover, 57 O. G. 1281, C. D. 1891.

62. Where the sole claim of the original patent covered a process of lining barrels, casks, etc., with glue, and the re-issue included not only the claim of the original patent, but also a claim for a barrel, cask, etc., coated or sized with glue by the process described, *held*, that this was in effect an expansion of the claims in order to embrace an invention not specified in the original patent, and that the second claim of the re-issue was therefore invalid. *Leggett v. Standard Oil Co., 63 O. G. 1201, C. D. 1893.

63. Where the claim sought to be re-issued is similar to one that was presented in the original application and rejected by the office and canceled by the applicant in order to obtain his patent, *held*, that under such circumstances the applicant is estopped from setting up such claim in an application for a re-issue. *Ex parte Bowman*, 66 O. G. 1360, C. D. 1894.

64. Where the original patent made no reference to an alternative construction of the device wherein one of the elements might be omitted, while the re-issue merely retains the said element, "preferably," as another form of the device, *held*, that the effect of the insertion of the word "preferably" was to render this element non-essential, and unduly to expand the original. *Olin v. Timken, 69 O. G. 1361, C. D. 1894.

65. It is now settled that when a re-issue is sought for the purpose of enlarging or broadening claims the application must be made within a reasonable time. (Miller v. Brass, 104 U. S. 350, and other cases cited.) It must also be shown that there was a mistake, inadvertently committed. (Cases cited.) Re-issue in this case held invalid, because it broadens the original patent and was not applied for till nearly three years after the issuance of the latter. *Mast, Foos & Co. v. Iowa Windmill & Pump Co., 68 Fed. Rep. 213 (1895).

66. Where a re-issue was obtained for the

purpose of broadening the claims of the original patent to cover that which is presumed to have been once abandoned to the public, *held*, that the re-issue is void. (White v. Dunbar, 37 O. G. 1002, 119 U. S. 47; Ives v. Sargent, 38 O. G. 781, 119 U. S. 652; Dunham v. Dennison Mfg. Co., 67 O. G. 1571, 154 U. S. 103.) *Eby v. King, 71 O. G. 1454, C. D. 1895.

VI. NEW MATTER.

(See ENLARGEMENT; IDENTITY.)

67. Where an element of the invention was shown in the original drawings only as a connected portion of a certain mechanism and was so described in the original patent, the description of such element in a re-issue as an independent invention is new matter, and claims based thereon are invalid. *Ives v. Sargent, 38 O. G. 781, C. D. 1887.

68. If by the re-issue the scope of the original is so enlarged as to cover and claim as a new invention that which was not in the original specification as a part of the invention described, or, if described, was by reason of not being claimed and virtually abandoned and dedicated to public use, the re-issue is unauthorized. *Eames v. Andrews, 39 O. G. 1219, C. D. 1887.

69. The fact that courts have so uniformly sustained the validity of original patents containing different inventions is probably due to their recognition of the discretion of the commissioner in their issuance; but in the case of re-issue patents no such discretion exists, no new matter can be introduced, and the re-issue must be for the same invention shown and described in the original patent. Consequently the courts have constantly held void re-issue patents embracing any new or other invention than that defined in the original patent. *Ex parte Herr*, 41 O. G. 463, C. D. 1887.

70. There was new substantive matter introduced into the re-issued patent for the description in the specification as a foundation for the first eight claims, and these claims themselves might have been the subject of another application for a patent at the time the original patent was applied for and taken out, leaving that patent valid and operative in respect to the claims it covered. *Parker & Whipple Co. v. Yale Clock Co., 41 O. G. 811, C. D. 1887.

71. Complainant's original patent embraced hair-crimpers of two kinds—one in which the fabric is stitched to the soft-metal core, the other in which the fabric is fastened to the core

by a metal fold made by turning over the thin edges of the core, or of a strip of sheet-lead inside the fabric over the core. The original contained the clause: "I also modify my invention in various other equivalent ways, such as would suggest themselves to any intelligent mechanic," etc. The re-issued patent contained claims for fastening the fabric to the core by cementing them together. *Held*, that the re-issue was invalid, being an expansion of the original and embracing a new invention. *Philadelphia Novelty Mfg. Co. v. Rouss, 48 O. G. 1664, C. D. 1889.

72. Re-issued patent No. 6,018 *held* void because for an invention not disclosed or suggested in the original. *J. B. Brewster & Co. v. Shuler, 49 O. G. 1485, C. D. 1889.

73. The rule of law in *Railway Co. v. Sayles*, 15 O. G. 243, 97 U. S. 554, that an amendment seeking to introduce a material variation in the original application cannot be allowed, is not applicable where it introduces no new matter. *Beach v. American Box Machine Co., Inman et al., 69 O. G. 1067, C. D. 1894.

VII. INADVERTENCE OR MISTAKE.

74. The re-issue was applied for in less than six months after the grant of the original patent. The court held that it was not prepared to hold the re-issue void because no inadvertence or mistake was shown, when the object was to enlarge a claim. *Jenkins v. Stetson, 32 Fed. Rep. 398 (1887).

75. The re-issue was applied for more than thirteen years after the date of the original patent, after the defendants had begun to make plows like those complained of. The first claim of the re-issue included elements in addition to those enumerated in the corresponding first claim of the original. The re-issue was evidently taken to cover defendants' machine, which did not infringe the first claim of the original patent, and no inadvertence or mistake in the original patent was shown. *Newton v. Furst & Bradley Mfg. Co., 38 O. G. 104, C. D. 1887.

76. The plaintiff testified "that he thought there 'was a mistake and a deficiency in the patent;' that he did not consider that other manufacturers respected it; that he considered it deficient because it applied the friction-brake to the periphery of the wheel, and that he believed the patent was entitled to cover different friction-clutch devices, so as to be a better protection against infringers." This was not

regarded as proof of inadvertence or mistake in the original patent. *Id.

77. A re-issue application claiming subject-matter shown, but *intentionally* not claimed in the original patent, filed to effect a dissolution of an interference between said patent and a pending application, and for the purpose of declaring a redeclaration of the interference between the re-issue and said pending application, refused. *Held*, that the showing did not establish a case of "inadvertence, accident or mistake," but exhibited an error of judgment. *Ex parte Mahnken*, 40 O. G. 915, C. D. 1887.

78. An applicant's "opinion" that the claim now asserted in the re-issue application was not considered by him to be patentable at the time of prosecuting the original application is not an instance of an actual mistake, nor a mistake inadvertently committed. Applicant accepted his patent without objection or evidence of dissatisfaction, and with full knowledge that another application was pending in the office containing interfering claims. *Id.*

79. Applicant's "mistake," so called, being clearly an error of judgment or opinion, cannot avail him, and a re-issue of his patent is refused. *Id.*

80. It is not every inadvertence or mistake which can be corrected by re-issue. Inadvertence or mistake, within the meaning of section 4916, Revised Statutes, must be shown to exist in the form of the specification or claim in consequence of which the application does not describe or claim that which the applicant intended at the time he prepared his papers. The defect must relate to the *application* and not to the *invention*. "A re-issue can only be granted for the *same invention* which was originally patented." If applicant designedly omitted to originally claim the entire subject-matter, such failure does not present a case of inadvertence or mistake within the purview of the statute. If the omission to make such claim was the result of inadvertence or mistake in preparing the application, as if in preparing a conveyance of land a covenant is by mistake omitted, this is within the statute. *Ex parte Mahnken*, 41 O. G. 1269, C. D. 1887.

81. A party who voluntarily takes his patent with full knowledge at the time that the specification or claims are defective and fails to cover his entire invention, or that the patent in other respects is inoperative or invalid, because of the omission of an amendment which he petitioned the commissioner to admit, which petition was refused because of insufficient

showing, cannot thereafter maintain an assertion of inadvertence, accident or mistake, such as would justify the office in granting him a re-issue to correct the errors. *Ex parte Page and Krausse*, 43 O. G. 1455, C. D. 1888.

82. The inadvertence, accident or mistake contemplated by the statute relates to the form and character of the specification and claims as they stand at the date of issue. (*Ex parte Mahnken*, 40 O. G. 915, 41 O. G. 1269.) *Id.*

83. A patent for an invention cannot be re-issued for the mere purpose of enlarging the claim unless there has been a clear mistake inadvertently committed in wording the claim. **J. B. Brewster & Co. v. Shuler*, 47 O. G. 1485, C. D. 1889.

84. Re-issued Letters Patent No. 6,018, granted to Thomas H. Wood August 18, 1874, for an improvement in carriage springs, *held* void, not only because it is for an invention not disclosed or suggested in the original, but also because, as in the case of *Coon v. Wilson* (30 O. G. 889, 113 U. S. 268), there was no defective or insufficient specification and no mistake inadvertently committed in the wording of the claim of the original. **Id.*

85. Where an applicant, desiring to secure a patent on a combination of old mechanical devices, included a certain element in each claim because he thought it necessary to the usefulness of the machine as a whole, and after the grant of his patent another patent for a similar machine was granted with claims which he thought broader than his own, and in order to invalidate said second patent the first patentee applied for and obtained a re-issue with claims so broad that they substantially claimed as a separate device one of the original elements which was old, *held*, that there had been no such inadvertence, accident or mistake as to warrant a re-issue and that said broadened claims were void. **Id.*

86. A finding of the commissioner of patents as to an original patent being inoperative by reason of inadvertence, accident or mistake may be reviewed in a suit for infringement, at least to the extent of determining whether as a matter of law what was described and alleged to be a mistake was such a mistake as will warrant a re-issue. **Id.*

87. The mere fact that re-issue No. 7,947 was applied for only thirteen days after the grant of the original patent does not establish its validity; for a clear mistake, inadvertently committed, in the wording of a claim is necessary without reference to length of time. **Yale*

Lock Mfg. Co. v. The Berkshire National Bank, 51 O. G. 1291, C. D. 1890.

88. Where it appeared that the attorneys whom the inventor employed to prepare his application, either through mistake on their own part or from want of clear description on the inventor's part, failed to state the claims as broadly as the device and the invention justified, and that the inventor was in poor health and his circumstances such as to explain his claim that his application was not carefully examined before being forwarded, and there was evidence to show that when the original patent was issued he recognized its defective features, made complaint concerning it, and stated that he proposed to have the error corrected, *held*, that there was such mistake as the statute contemplated and that proper means had been taken to correct it by the re-issue. *Peoria Target Co. v. Cleveland Target Co., 52 O. G. 1063, C. D. 1890.

89. Where it appeared that the claim of a re-issued patent was not covered by the original patent, and that before the issue of the latter the claim was passed upon and rejected, withdrawn, and erased by applicant's attorney; that an interference was dissolved upon condition of the amendment, and that the issue of the original was predicated upon its abandonment, *held*, in view of the protracted proceedings in the patent office, that the applicant should not be permitted to treat the deliberate acts of his attorney as the result of inadvertence, accident or mistake; and *held*, further, that the repeated official decisions and orders, and the repeated efforts to maintain said claim, indicated anything but negligence on the part of the solicitors employed. *Dobson v. Lees, 53 O. G. 1740, C. D. 1890.

90. It is the obvious intent of the statute that a re-issue may be had for an enlarged claim, provided it is evident that there has been a mistake and that the applicant has been guilty of no want of reasonable diligence in discovering it and that no third persons have meanwhile acquired rights to manufacture or sell what he had failed to claim. *Topliff v. Topliff, 59 O. G. 1257, C. D. 1892.

91. Where an applicant for a patent in assigning his invention said that it was "fully described in the specification pertaining to said application, which I have signed under oath," and his assignee applied for a re-issue at a time when the law did not require inventor's oath to the re-issue specification, *non sequitur* that the inventor himself would ever have as-

serted that the original application contained error arising from fraud, accident or mistake, and this fact taken into consideration by the court in determining that question. *Freeman v. Asmus, 59 O. G. 1432, C. D. 1892.

92. Where a patent was re-issued for the purpose of enlarging the claims to cover apparatus patented subsequently to the date of complainant's original patent, and where the element omitted from the claims of the re-issue was shown, described and claimed in the original application and patent as an essential element of each of the combinations claimed, *held*, that the failure to claim the particular combination not claimed in the original patent, but claimed in the re-issue, was not due to any such inadvertence or mistake as would authorize the claiming of it in the re-issue, and that the re-issue is not for the same invention as the original patent and is therefore void. *Huber v. N. O. Nelson Mfg. Co., 63 O. G. 311, C. D. 1893.

93. It must appear by the description in the original patent that it was the purpose of the patentee to secure the thing specified in the claim of the re-issue, and a patent cannot be lawfully re-issued unless there has been a clear mistake, inadvertently committed, in the wording of the claim. (Cases cited.) *Featherstone v. George R. Bidwell Cycle Co., 57 Fed. Rep. 631 (1893).

94. Where there was nothing in applicant's world of fact existing at the time he took his patent upon which the alleged errors of judgment could have been based, *held*, that there was no mistake of fact and no mistake of judgment upon facts that could be recognized in an application for a re-issue of his patent. *Ex parte Bowman*, 66 O. G. 1310, C. D. 1894.

95. Where there was a mistake in the drawings, which, however, did not render the patent wholly inoperative and probably would have been discovered by a mechanic, but was of such a character that a machine constructed from the drawings would have been inoperative for some purposes which the patentee was entitled to cover by his claims, *held*, that a re-issue to correct the drawings was proper and lawful. *Beach v. American Box Machine Co., Inman et al., 69 O. G. 1067, C. D. 1894.

96. Where an applicant acquiesced in the limited construction put on his invention, and at no time during the prosecution of his original application suggested or intimated that the invention resided in the broad device now sought to be claimed in the re-issue applica-

tion, *held*, that the failure to make the claim in the original patent did not arise through inadvertence, accident or mistake, and the re-issue claim refused. *Ex parte Bryant*, 77 O. G. 451, C. D. 1896.

VIII. TO CORRECT ERROR OF PATENT OFFICE.

97. Where, by an error of the examiner, a claim was not entered and the patent issued without it, *held* that, the error being chargeable to the office (cases cited), the patent should be re-issued upon the original papers and drawings without any expense to the patentee. *Ex parte Thomson*, 44 MS. D. (2 G. W. D.), Aug., 1890 (Fisher, Acting Com'r).

RENEWAL OF FORFEITED APPLICATION.

(See FEES, PAYMENT OF.)

1. The right to file a renewed application within two years from the date of the allowance of the original is based upon and governed by a different section of the law from that which governs cases which have become abandoned or forfeited for want of prosecution for a period of two years. *Ex parte Barnitz*, 41 O. G. 575, C. D. 1887.

2. Under section 4897 an applicant who has failed to make payment of the final fee within six months from the time his case was passed to issue and allowed, and notice thereof was sent to him, has the right to make a second or renewed application; but such second application must be made *within* two years, and the commissioner of patents has no discretion to extend the time in which this right may be exercised. *Id.*

3. The commissioner's decision in *Ex parte Barnitz* (41 O. G. 575) was not designed to apply to a second application filed after the right of applicant to *renew* his original and first application had lapsed by reason of the expiration of the two years, as provided by section 4897, Revised Statutes. *Ex parte Barnitz*, 42 O. G. 1061, C. D. 1888.

4. Under section 4897, a definite and well-recognized practice of the office exists, and until congress shall see proper to change the statute the practice of the office should not be disturbed. *Id.*

5. There is no statute or rule authorizing an applicant to forfeit an application which has

been allowed, file a renewal application, and pay the application fee within the six months following such allowance. *Ex parte Manny*, 44 O. G. 700, C. D. 1888.

6. There is no authority of law permitting the renewal of an application, or the acceptance of the fee for such renewal, before the date on which the application would actually become forfeited for non-payment of the final fee. *Ex parte Nicholson*, 52 O. G. 310, C. D. 1890.

7. Where it appeared that an application was filed June 25, 1887, and allowed December 9, 1887; that due notice was given to applicant to pay the final fee, which was not paid within the six months prescribed by statute; that December 4, 1889, applicant renewed his application under section 4897, Revised Statutes of United States; that said renewed application was duly allowed and applicant notified to pay the final fee under the statute, which fee applicant neglected to pay, and that on June 7, 1890, applicant filed a second application for renewal accompanied with the renewal fee, *held*, that applicant was not entitled to allowance of letters patent, as the application for renewal now claimed under was not made within two years after the allowance of the original application, as required by Revised Statutes of the United States, section 4897. *Ex parte Nicholson*, 53 O. G. 1574, C. D. 1890.

8. *Held* further, that said facts do not raise the question whether a second application for renewal may be filed within two years after the allowance of the original application, but after the forfeiture of the first renewal application, which question is therefore not decided. *Id.*

9. When applicant seeks protection for the process in a separate application, which he subsequently allows to become forfeited, his relief is to be found in section 4897 of the Revised Statutes, which provides that applicant may file a second or renewed application for such invention or discovery within two years after the allowance of the original application. A specific relief having been thus provided, the statute would seem to impliedly prohibit relief by other methods. *Ex parte Hopkinson*, 54 O. G. 264, C. D. 1891.

10. The right to renew an application which has become forfeited by failure to pay the final fee in season is not limited to the inventor. An assignee also has that right. *Ex parte Barrett*, 56 O. G. 930, C. D. 1891.

11. In renewing an application the applicant

has the right to present new claims if he desires. *Ex parte Barrett*, 56 O. G. 1564, C. D. 1891.

12. The right of an applicant to renew a forfeited application under section 4897 is exhausted when once exercised. †Decisions of the Secretary of the Interior, 69 O. G. 639, C. D. 1894.

13. Under section 4897, Revised Statutes, a second application for renewal cannot be made, but a new application for a patent can be made. Decision of the Secretary of the Interior, 69 O. G. 639, construed. †Renewal of Forfeited Applications, 70 O. G. 493, C. D. 1895.

14. Although the third renewal of an application was received, acted upon on the merits, and pending at the date of the secretary's decision as to the right of renewal of an application (69 O. G. 639), *held*, under the decision, that application cannot be prosecuted. *Ex parte Vulte*, 70 O. G. 631, C. D. 1895.

15. An application renewed more than once prior to the date of the said decision of the secretary cannot be treated as an incomplete application. *Id.*

16. The papers in an application, forfeited and abandoned by operation of law under section 4897, cannot be withdrawn from the case to be used in a new application. *Id.*

RE-OPENING CASES IN PATENT OFFICE.

(See REHEARING; WITHDRAWAL OF CASES FROM ISSUE; AMENDMENT AFTER FINAL REJECTION; JURISDICTION OF COMMISSIONER OF PATENTS; NEW TRIAL.)

I. EX PARTE. II. INTERFERENCE.

I. EX PARTE.

1. Entry of amendment in an application on which appeal had been heard and decided by the examiners-in-chief refused, in absence of a showing that any irreparable damage would result by requiring the applicant to file a new application. *Ex parte Berger*, 34 MS. D., April, 1887 (Montgomery, Com'r).

2. Ordinarily, cases which have been appealed from the primary examiner to the examiners-in-chief, and been heard and decided by them, can be re-opened by the primary examiner only by authority of the commissioner, upon a certain showing and for a certain purpose. *Ex parte Holt*, 38 O. G. 229, C. D. 1887.

3. In such appeal cases, however, when the examiners-in-chief have annexed to their decision the "statement" and "recommendation," applicant may, if he do not appeal further, without authority from the commissioner go back to the primary examiner and propose what seems to be within the contemplation of such recommendation. *Id.*

4. If the primary examiner "should refuse to receive an amendment which might be so recommended by the board, or should refuse to act at all in pursuance thereof, applicant may petition the commissioner to order the same in the usual way; or, if he should receive an amendment in conformity to such recommendation and then reject, applicant might again go to the board on appeal." *Id.*

5. A mere suggestion upon the part of the examiners-in-chief, however, unaccompanied by any recommendation, would not authorize the re-opening of the case without the authority of the commissioner. *Id.*

6. To authorize the primary examiner to re-open a case for amendment after appeal and affirmance by the examiners-in-chief, the statement and recommendation of the board must point out with reasonable clearness and certainty "the apparent grounds, not involved in the appeal, for granting letters patent," so as to enable the examiner, who, upon a careful examination, has rejected the case, and whose decision is affirmed by the board, to understand what feature or invention in the form as claimed, or in any other form, is recommended for amendment or consideration. *Ex parte Peterson*, 40 O. G. 692, C. D. 1887.

7. A mere suggestion in the following form: "If applicant has approved upon *Stover* (the reference cited), he should clearly set forth the improvement, as provided by statute," does not come within the rule, nor does it obviate the necessity for the applicant, when presenting his amendment, to make a showing and furnish reasons why it was not offered earlier. Such a suggestion could be made in every case, and would leave the examiner to re-open the application generally, limited, if at all, only by the decision. *Id.*

8. The marginal indorsement, "Approved," signed by the board and the acting commissioner, *held* not to give any additional force to the suggestion in the decision. The case being *ex parte*, the jurisdiction of the examiners-in-chief ceased after their decision, and the case was not before the acting commissioner by petition or otherwise. *Id.*

9. The jurisdiction to pass upon amendments in such cases is with the primary examiner, subject to the applicant's right of appeal; following *Ex parte Pearson* (40 O. G. 244) and other cases cited. *Id.*

10. An application which has been finally rejected by the primary examiner, and such rejection affirmed by the examiners-in-chief, will not be re-opened on petition averring, first, that the invention was originally misunderstood by the counsel then employed and by the primary examiner, and that the references cited related to the case thus misunderstood; second, that the claim appealed to the examiners-in-chief is not broad enough to protect the actual invention, and the description is incorrect and not sufficiently clear. *Ex parte Greene*, 41 O. G. 1161, C. D. 1887.

11. Amendments after appeal may be admitted for the purpose of putting the rejected claim in better form for consideration on appeal. Such amendments should not vary the scope of the claim. If they have been admitted and do vary the scope of the claim, the appellate tribunal should not pass upon the merits, but the case should be sent back to the primary examiner for action. *Ex parte Hooper and Clark*, 56 O. G. 929, C. D. 1891.

12. A case will not be re-opened for further amendment on allegation of remissness on the part of the previous attorney, when the present attorney is also exhibiting tardiness. *Ex parte Knecht*, 61 MS. D. 267 (9 G. W. D.), April, 1897 (Fisher, Acting Com'r).

13. The original attorney having been disbarred, without applicant's knowledge, and having failed to take due action in the case, this, with applicant's poverty, makes a reasonable case of unavoidable delay. *Ex parte Hughes*, 62 MS. D., Sept., 1897 (Greeley, Ass't Com'r).

14. The examiner cannot, under the rules, after a decision by the examiners-in-chief, admit even allowable claims, unless such claims are recommended by the examiners-in-chief, without written authority from the commissioner. *Ex parte Hunter*, 81 O. G. 504, C. D. 1897.

15. To permit an applicant after decision upon appeal to present additional claims to be considered by the examiner, and if rejected by him again brought before the examiners-in-chief on appeal, is not proper practice. *Id.*

16. A petition for re-opening a case is improper when filed more than two years after appeal to the commissioner and no action has

meanwhile been taken. *Ex parte Redgrave*, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

17. Where on appeal only broad claims were presented, which were refused, *held*, that the case should not be re-opened to admit narrow claims. *Ex parte Firsching*, 80 O. G. 1272, C. D. 1897.

18. An applicant should present his whole case at one time by both broad and narrow claims. It is not considered good practice to allow an applicant to present broad claims, try them through all the tribunals of the office, and when such broad claims are refused go back to the examiner and present narrow claims. *Id.*

19. Applicants insisting upon broad claims only and appealing such claims have no vested right in a further examination if they fail to prevail on the appeal. *Id.*

II. INTERFERENCE.

20. Statement of the litigation growing out of the several interferences declared between the patents granted to A. G. Bell and the applications of later applicants; the inventions distinguished and compared with the previous state of the art, and the decisions rendered by the various tribunals in the office considered and discussed. *McDonough v. Gray*, 46 O. G. 1245, C. D. 1889.

21. *Held*, that the petition "is of no avail for any purpose whatever;" that Gray proposes no new evidence as to dates, nature or the character of his own invention; that it was conclusively shown in the evidence that Gray, at the time of filing his caveat, while having a conception of the telephone, did not understand the invention, and was unable to explain the mode of its operation; that he adhered to the idea that articulate speech must be transmitted upon the multiple-telegraph principle; that he positively conceded that he did not reduce his invention to practice for a long time after the issuance of patent to Bell; that he regarded the invention patented to Bell as trivial, and called it a "scientific toy," and turned his attention to other and, in his opinion, more important inventions; that he negligently omitted to file his application for a patent until two years after the grant of Bell's patent, and was then stimulated to do so only by other parties who had acquired an interest in his inventions; and that his present petition, filed without notice to the adverse parties, was delayed for

three years and five months after the decision of the examiner of interferences awarding priority to Bell, and was then accompanied by a request that it should not be acted upon until further motion was made. *Id.*

22. For reasons stated, the charges in Gray's petition that Bell had fraudulently secured access to his caveat, purloined his invention and interpolated a description thereof in his application, *held* not sustained. *Id.*

23. As to the petition of McDonough that he be allowed to demonstrate the operativeness of the make-and-break principle, the commissioner holds the decisions of his predecessors are conclusive on that question; that McDonough never claimed to be the original inventor of the telephone, but a mere improver upon Reis' instruments; that he accepted and still accepts the make-and-break system of Reis as the foundation of his invention; and, in view of the settled judgment of the patent office that speech cannot be transmitted by an instrument which operates solely by the making and breaking of the circuit, and also in view of the fact that the supreme court of the United States has also definitely settled this question with reference to Reis, he must regard the matter *res adjudicata*. *Id.*

24. *Held*, that the decision of Commissioner Butterworth, of March 3, 1885, was elaborately considered and deliberately rendered, and that a rehearing could only be justified upon clear and satisfactory evidence showing in such decision error in the conclusions of fact or in the application of the law, and that evidence could be produced establishing that Gray could antedate Bell's invention, that he could prove a prior conception and reduction to practice, or that, having made an earlier conception, he had diligently prosecuted it to a reduction to practice. In the absence of showing the existence of such evidence, upon the testimony filed before and considered by the various tribunals in the office, *held*, that "the award of priority of invention was justly given to Bell," and in view of the construction given by the office and the courts to the patent, the grant was properly issued, and the protection afforded the inventor was authorized. *Id.*

25. As to the petition to re-open on the merits, the commissioner holds that McDonough's original claim for the receiver having been rejected on reference to Bell's patent, and he submitting thereto and canceling the claim, and McDonough having been brought into the interference in consequence of the later appli-

cants, so as to compel them to establish an earlier date of invention than himself, it follows, inasmuch as there could have been no interference between McDonough and Bell alone, that when Gray and the other later applicants were defeated and taken out of the interference there could be left no contest between McDonough and Bell. *Id.*

26. Petitions denied because the showing is deemed sufficient to justify the commissioner in setting aside former decisions and decrees, since he is fully convinced that another trial on the question of priority would result in another award in favor of Bell. *Id.*

27. A decree of conclusiveness attaches to a correct decision based upon the record and the evidence which cannot be disturbed by a motion which admits a party's wilful and deliberate omission to take evidence and simply asks, after trial, that the very evidence which might have been originally taken may now be introduced. If such a motion could prevail there would be no end to interference proceedings. *Id.*

28. A patentee involved in interference who refused to take testimony, relying upon his record dates, and rested his case upon the weakness of his adversary's presentation rather than upon the strength of his own, will not be permitted, after testing the opinion of all the tribunals in the office and after final decision, to have the case re-opened on the ground "that the public interests require an investigation as to prior knowledge or use, and that two patents ought not to issue for the same invention." *Beardslee v. Moeslein*, 46 O. G. 1640, C. D. 1889.

29. On motion to re-open, based on newly-discovered evidence found in a printed copy of testimony given in another case eighteen months before the testimony in the present case was closed, *held* a lack of diligence on the part of the moving party not to have discovered the evidence at the proper time. *Edison v. Maxim, v. Swan*, 51 O. G. 696, C. D. 1891.

30. The decision of examiner of interferences dismissing a motion to re-open the interference for want of jurisdiction overruled, and *held*, that the motion being noticed for hearing within the time originally limited for appeal operated to stay the running of the time limited, and therefore the examiner had jurisdiction to hear and act upon the motion. *Shinn v. McElroy*, 54 O. G. 1115, C. D. 1891.

31. An application for the re-opening of an interference for the introduction of new testimony must show that the petitioner could not, with reasonable diligence, have obtained, prior

to the former hearing, the testimony sought to be introduced. *Bowen v. Bradley*, 56 O. G. 1707, C. D. 1891.

32. If the newly-discovered evidence which is submitted would not change the result which has been arrived at, the interference should not be re-opened. *Id.*

33. The primary test in determining a motion to take additional testimony after a case has been closed is whether the testimony was accessible or capable of being produced at the proper time by the exercise of diligence on the part of the party seeking its introduction. *Schniedl v. Booth*, 57 O. G. 695, C. D. 1891.

34. It is not sufficient for the party making the motion to show that he has used ordinary diligence in the matter. He must show conclusively that he left no stone unturned in the preparation of his case, and that he was zealous and diligent in a high degree. *Id.*

35. The question of materiality is not the first to be considered in determining the motion. If it becomes a question at all, it is one of secondary consideration. *Id.*

36. Motions seeking to re-open an interference case must be brought in the first instance before the examiner of interferences. *Bowen v. Bradley*, 58 O. G. 386, C. D. 1892.

37. Where a party to an interference moved to re-open the same for the correction of his record, alleging that certain testimony therein attributed to him was spurious, it having been in fact dictated by his attorney during witness' temporary absence from the room, *held*, in view of material discrepancy between party and attorney as to the exact testimony so interpolated, and since it appears that the correction asked for would not affect the decision already rendered, the motion must be denied. *Bowen v. Bradley*, 58 O. G. 1416, C. D. 1892.

38. The commissioner will not authorize the re-opening of a case by a primary examiner, in the absence of good and sufficient reason for long delay on the part of the applicant in presenting his reasons therefor, or of a showing of great hardship or irreparable injury. *Ex parte Goldsmith*, 58 O. G. 1092, C. D. 1892.

39. Where a contestant in interference was put upon notice at the time of the hearing before the examiner of interferences that there was a weak point in his evidence, and notwithstanding this he waited until an appeal had been taken to the board of examiners-in-chief and thence to the commissioner before making an effort to amend his testimony, *held*, that it was then too late to have the case re-opened

for the purpose of introducing evidence known and accessible to him at the time his testimony was taken. *Webb v. Blickensderfer*, 64 O. G. 857, C. D. 1893.

40. Notwithstanding the presentation of evidence tending to establish a fact not before in the record, the commissioner, in view of doubt as to his authority in the matter and also in view of the petitioner's remedy by bill in equity, will not re-open a case after it has been considered and decided by the court of appeals of the District of Columbia. *Northall v. Bernardin*, 75 O. G. 1853, C. D. 1896.

41. The proper procedure in seeking to have an interference case, after decision by the court of appeals, re-opened for consideration of a motion for dissolution is to file a motion before the commissioner for re-opening the case, in order to permit consideration by the examiner of interferences of a motion to transmit to the primary examiner the motion for dissolution. **Breul v. Smith*, 79 O. G. 153, C. D. 1897.

REPAIR OF PATENTED MACHINES.

1. Where a patent covers as an entirety a machine composed of several and distinct parts, the rightful purchaser of such machine does not infringe by replacing such temporary parts as wear out, so long as the identity of the machine is retained; but, if the patent is for a distinct part or element, a purchaser will infringe by replacing it. **Singer Mfg. Co. v. Springfield Foundry Co.*, 34 Fed. Rep. 393 (1888).

2. A machine purchased of the complainant, the patentee, by the employer of the defendant was repaired and its construction somewhat changed by the defendant in his capacity as an employee of the purchaser. *Held*, that the purchaser was at liberty to repair and improve it within the limits of his contract, and that so long as the identity of the machine was not destroyed its owner had the right to discard useless parts and add new ones which might improve its action. **Young v. Foerster*, 47 O. G. 1353, C. D. 1889.

3. One who has a license to use the whole of a machine does not become an infringer by the use of a part only. **Id.*

4. The right to repair a patented device is incidental to ownership. The fact that it is patented does not lessen the owner's right to put it in order when it gets out of repair, unless, considered as a whole, it is worn out and useless. **Schickle, Harrison & Howard Iron Co.*

v. St. Louis Car Coupler Co., 77 O. G. 2142, C. D. 1896.

5. When a patented machine is accidentally destroyed or when it is practically worn out, the owner thereof, under the guise of repairing it, cannot make a new machine. In such cases he must cast it aside and buy a new one from the patentee. *Id.

RESERVATION IN APPLICATIONS.

(See CROSS-REFERENCES; SUBSEQUENT APPLICATIONS; INTERFERING PATENTS.)

1. Rule 42, requiring disclaimers in cases where two or more applications are pending, all showing but only one claiming the same subject-matter of invention, is directory and not jurisdictional, and the issue of the first patent is not a bar to the issue of the second. *Ex parte Roberts*, 40 O. G. 573, C. D. 1887.

2. In cases of inventions capable of division the presumption of dedication to the public resulting from taking out a patent for part of the invention may be rebutted by incorporating in the first application a reservation of the right to apply for the unclaimed features in a second application or by filing subsequently a second application. *Id.*

3. *Ex parte Roberts* (40 O. G. 573) discussed, and distinction pointed out between cross-references and reservation clauses. *Ex parte Blair*, 43 O. G. 113, C. D. 1888.

4. The introduction of reservation clauses covering subject-matter intended to be incorporated in future applications erects a warning by which the public is deterred from entering upon the particular field of invention, and also prevents the public from knowing just what property it is purchasing in dealing with patents containing reserved rights. *Id.*

5. The natural and necessary effect of reservation clauses is to unlawfully prolong the monopoly of the invention. If as a matter of fact and law the subject-matter is properly divisible, the office is open at all times to applicant and his rights are safe without any reservation clause. If such be not the case applicant has ample protection by filing his second application and have it pending concurrently with the first. *Id.*

6. A former patent, No. 265,927, granted October 10, 1882, to Marmon jointly with one Warrington, construed, and *held*, that no one can take out a patent either jointly or severally for an invention, and, after the patent is issued

without reservation in his original application, obtain a second patent with broader claims for the device. **Consolidated Roller Mill Co. v. Coombs*, 48 O. G. 255, C. D. 1889.

7. When an applicant is detained in the office to contest priority, or for any other reason not involving his own laches, and meanwhile applies for and takes out patents for improvements upon the invention described in the first application, the improvement patents referring to the earlier application and reserving the right to obtain a patent thereon, such intermediate patents do not bar the right to a patent upon the subject-matter of the earlier application whenever the office is ready to grant the same. *Ex parte Edison*, 49 O. G. 1691, C. D. 1889.

8. 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. (Cases cited.) **Brush Electric Co. v. Julien Electric Co.*, 41 Fed. Rep. 679 (1890).

9. No presumption of dedication arises from the failure to make reservation or to file a concurrent application where the improvement described and claimed in the first patent is an independent invention from the improvement described and not claimed in the first patent. *Ex parte Mullen & Mullen*, 42 MS. D. (2 G. W. D.), Jan., 1890 (Mitchell, Com'r).

10. Where the patent on the endwise-thrust machine contained a reservation saying that "the feed-chute, guideway, and means for pushing the assembled links forward, a delivery wheel or device, the fulcrum plate or corner, operating mechanism, and such details of construction as are not herein broadly claimed form the subject of a separate application," *held*, that such reservation meant that the invention was broadly claimed in the patent, and that the patentee meant to reserve only the right to claim the elements specifically in his separate application, and that a patent on such separate application, claiming the features mentioned in the reservation broadly and generically, could not be sustained as covered by the reservation. **Fassett v. Ewart Mfg. Co.*, 64 O. G. 439, C. D. 1893.

11. A patentee cannot 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. This conclusion

is in no way affected by the reservation attempted to be made in the earlier patent of the "broad idea of a lifting-spring which acts with increased force as the beam rises," for the reason that the broad idea sought to be reserved is embodied in identically the same mechanical device constituting the invention and covered by the first patent, which completely occupies all the ground that was reserved. *Miller v. Eagle Mfg. Co., 66 O. G. 845, C. D. 1894.

RIGHT TO MAKE, USE AND SELL—IN GENERAL.

1. The purchaser of a patented machine has the right to use the machine until worn out in the manufacture of the product it is designed to make, and sell the same in the market, and to designate it by label or otherwise as the product of the invention. *Martha Washington Creamery Buttered Flour Co. of the United States (Limited) v. Martien, 47 O. G. 1488, C. D. 1889.

2. The first inventor is entitled to all the benefits which spring from the obvious uses of his invention. Others may patent the means by which they adapt it to uses not antecedently obvious; but the inventor is entitled to a free field for the exercise of all the qualities and special adaptations that belong to his invention. So, too, the public are entitled to practice the invention in all its obvious utilities when the patent has expired and may not lawfully be debarred from the enjoyment of it by subsequent patents seeking to monopolize uses which, although special, are at the same time recognized by persons skilled in the art as pertaining to it. *Ex parte Faure*, 52 O. G. 752, C. D. 1890.

3. If an inventor construct and sell a new machine or put it into use before applying for a patent thereon, he cannot afterward take out a patent and maintain a suit against his purchaser or user for infringement thereof by use of such machine. *Dable Grain Shovel Co. v. Flint, 52 O. G. 1537, C. D. 1890.

4. In such case a demand for compensation made by the inventor after he receives his patent will not affect the rights of the purchaser or user of the machine, because if the inventor had no right to compensation a demand therefor would not give him any such right. *Id.

5. Where in a suit for infringement it appeared that the alleged infringing machines were constructed and put in use in the defend-

ant's grain-elevators by the inventor himself, and with his knowledge and consent, while he was in their employment as superintendent of machinery, and before his application for either patent in suit, *held*, that according to the express terms of the statute the defendants had the right to continue to use these specific machines without paying any compensation to him or his assigns, whether asked for or not. *Dable Grain Shovel Co. v. Flint, 53 O. G. 1093, C. D. 1890.

6. The said act does not deprive the inventor of his property without compensation, and is constitutional, because the patentee has no exclusive right of property in his invention except under and by virtue of the statutes securing it to him, and according to the regulations and restrictions of those statutes, and because the machines had been set free from his monopoly by his own act, consent and permission. *Id.

7. The right to use a process apart from the things sold, which things are adapted for carrying out the process, does not follow from the sale merely of the things themselves. *Vermont Farm Machine Co. v. Gibson, 56 O. G. 1566, C. D. 1891.

8. Where the defendant bought from the patentee a creamery containing four cans made under the patent, *held*, that the defendant thereby became a licensee to use the process in connection with that creamery and its cans and their necessary repairs, but no further. *Vermont Farm Machine Co. v. Gibson, 64 O. G. 800, C. D. 1893.

9. Where the defendant purchased of the patentee an apparatus for toilet paper with which the latter was accustomed to send a roll of paper used in the same, *held*, that the sale of the apparatus carried with it the right to use and sell the apparatus upon a replenishment of the paper. *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co., 67 O. G. 271, C. D. 1894.

10. The rights to make, use or sell are completely severable rights and involve the right to confer on others such qualified privilege as the owner of the patent sees fit, whether within specified limits or under limitations of quantity, or numbers, or restricted use. *Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co., 78 O. G. 171, C. D. 1897.

(A state may require the taking out of a license for the sale of an article manufactured under a patent; but it cannot discriminate against non-resident manufacturers and favor resident manufacturers. *Webber v. State of Virginia, 20 O. G. 369, 1881.)

RIGHT OF PUBLIC TO USE NAME OF PATENT OR PATENTED ARTICLE.

(See TRADE-MARKS; NAME OF PATENTED ARTICLE.)

RIGHT OF SALE AND USE OF PATENTED ARTICLE IN OUTSIDE TERRITORY.

1. Hatch had an assignment of the patent in suit from the owner of the same "for, to and in the state of New York" "as fully and entirely as the same would have been held and enjoyed by" him "if this assignment and sale had not been made." Hatch gave an exclusive license to the defendant "to make, use and sell" the patented improvement in the cities of New York and Brooklyn, "and sell in the state of New York and elsewhere." The owner of the remaining interest in the patent gave an exclusive license to certain parties to make and sell the patented invention in certain territory other than the state of New York, and joined with his licensees as complainant in the suit. The actual sales, which were the infringements complained of, appear to have been made to dealers (apparently in the state of New York) with knowledge that their sales would be to persons outside of that state. In this case it was *held* that defendant's license did not authorize him to sell the patented article to dealers for sale outside of the state of New York. *Hatch v. Hall, 40 O. G. 1342, C. D. 1887.

2. A purchaser of a patented article, sold by the patent owner or assignee for a certain defined territory, cannot, in the course of trade, sell the article in another territory for which another person has the exclusive territorial rights. (Following Hatch v. Adams, 22 Fed. Rep. 434; Hatch v. Hall, *id.* 438, 30 Fed. Rep. 613.) *Standard Folding Bed Co. v. Keeler, 37 Fed. Rep. 693 (1889).

3. Where an assignment of territorial rights has been made, the subsequent purchase of the patented article from the inventor or a later assignee (with notice) will not entitle the purchaser to use said article within the territory of the first-mentioned assignee. *Sheldon Axle Co. v. Standard Axle Works, 48 O. G. 117, C. D. 1889.

4. Adams v. Burks (33 O. G. 114) commented upon, and *held* not to conflict. **Id.*

5. The purchaser who buys a machine or device, patented or unpatented, without any restriction as to the mode or extent of the use to which he may apply it, acquires all the rights

of the seller and may do with it whatever the seller might have done if he had not parted with it. *Morgan Envelope Co. v. The Albany Perforated Wrapping Paper Co., 50 O. G. 303, C. D. 1890.

6. A dealer residing in the United States cannot purchase in another country articles patented there, from a person authorized to sell them, and import them to and sell them in the United States, without the license of the owners of the United States patent. *Boesch v. Graff, 51 O. G. 477, C. D. 1890.

7. One who purchases a patented article from the owner of the patent right for a certain territory has no right to sell the same in the course of trade in territory for which another owns the exclusive territorial right. *Standard Folding Bed Co. v. Keeler, 51 O. G. 480, C. D. 1890.

8. The sale of a patented article by an assignee of the patent within his own territory carries the right to use it within territory owned by another, though it be known to both parties that a use outside the vendor's territory is intended. *Hobbie v. Jennison, 51 O. G. 624, C. D. 1890.

9. Where an assignee for a specified territory holds title under an otherwise unconditional and unrestricted assignment, the sale of the patented article by the assignee within his territory carries the right to use it everywhere, notwithstanding the knowledge of both parties that a use outside the territory is intended. (Following Adams v. Burke, 33 O. G. 114; 17 Wall. 453.) *Hobbie v. Jennison, 63 O. G. 1204, C. D. 1893.

10. One who buys patented articles of manufacture from an assignee for a specified territory, holding title under an otherwise unconditional and unrestricted assignment, becomes possessed of an absolute property in such articles unrestricted in time or place. *Keeler v. Standard Folding Bed Co., 71 O. G. 451, C. D. 1895.

11. Whether a patentee may protect himself and his assignees by special contracts brought home to the purchasers is a question that would arise as a question of contract and not as one under the inherent meaning and effect of the patent laws. **Id.*

12. Articles may be purchased from a licensee of certain territory, and imported into and sold in other territory which the patentee had reserved, although the purchaser had knowledge of an agreement by said licensee not to thus trespass on the territory reserved. *Jackson v. Vaughn, 73 Fed. Rep. 837 (1896).

13. It is now well settled that one who buys patented articles of manufacture from one authorized to sell them at the place where they are sold becomes possessed of an absolute property in such articles, unrestricted in time or place. (*Wilson v. Rousseau*, 4 How. 646, 648; *Bloomer v. McQuewan*, 14 How. 539; *Chaffee v. Belting Co.*, 22 How. 217, 223; *Mitchell v. Hawley*, 16 Wall. 544; *Adams v. Burke*, 17 Wall. 453, 456; *Birdsell v. Shaliol*, 112 U. S. 485, 487, 5 Sup. Ct. 244; *Hobbie v. Jennison*, 149 U. S. 355, 13 Sup. Ct. 879; *McKay v. Wooster*, 2 Sawy. 373, and others.) *Id.

14. The defendant was not a party to the license which prohibited the licensees from permitting the patented articles to be sold, directly or indirectly, west of the Rocky Mountains. The contract was not binding on Vaughn nor any other purchaser not a party to the contract. It is difficult to see how Vaughn's knowledge of the agreement could impair his right to purchase from the licensees within their territory or affect his absolute right of property in the vended articles. Having purchased them he had the right to put them to any use or dispose of them as he saw fit. By the sale from the authorized licensee they passed outside the monopoly. *Id.

15. The sale of a patented article by the patentee frees it from the grasp of the monopoly, and the purchaser may thereafter exercise the same dominion over it which he exercises over his other property. **Schickle, Harrison and Howard Iron Co. v. St. Louis Car Coupler Co.*, 77 O. G. 2142, C. D. 1896.

16. A patentee may lawfully prevent his machine from passing beyond the monopoly of the patent by a license which defines the boundaries of lawful use. **Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co.*, 78 O. G. 171, C. D. 1897.

RIGHT OF UNITED STATES GOVERNMENT TO USE PATENTED ARTICLES.

(See SUITS FOR INFRINGEMENT AGAINST THE UNITED STATES; EMPLOYER AND EMPLOYEE—GOVERNMENT.)

1. The consent of the owner of a patented device is not positively necessary in order to enable the United States to use the invention described in the letters patent, particularly in cases where it relates to the mode of construction of implements of warfare required by the

government. **Dashiell v. Grosvenor*, 74 O. G. 500, C. D. 1896.

2. The United States have no more right than any private person to use a patented invention without license of the patentee or making compensation to him, but they cannot be impleaded in a judicial tribunal except so far as they have consented to be sued. **Belknap v. Schild*, 74 O. G. 1121, C. D. 1896.

(The United States government cannot use a patented invention without compensating the patent owner. *United States v. Burns*, 12 Wall. 246; *James v. Campbell*, 21 O. G. 337, C. D. 1882; *United States v. McKeever*, 23 O. G. 1530, C. D. 1883; *Cammeyer v. Newton*, 11 O. G. 287, C. D. 1877.)

ROYALTIES.

(See SUITS; DAMAGES AND PROFITS, ESTIMATION AND MEASURE OF—LICENSE AND ROYALTIES.)

SALE OF PATENT-RIGHTS ON EXECUTION.

(A patent-right may be subjected by bill in equity to the payment of a judgment debt of the patentee. A trustee may be appointed to execute an assignment if the patentee himself should not execute one. **Ager v. Murray*, 21 O. G. 1107, C. D. 1882, U. S. Sup. Ct.; **Stephens v. Cady*, 14 How. 528.)

SERVICE OF NOTICE.

(See INTERFERENCE.)

SERVICE OF PROCESS.

(See WITNESSES, COMPELLING ATTENDANCE OF; INTERFERENCE, SERVICE OF NOTICE.)

1. Where the invalidity, irregularity or defect in the service of the writ appears upon the face of the return, a motion to quash the service or abate the writ is the proper mode of bringing the matter to the attention of the court; but where the objection does not appear upon the face of the papers the better rule of practice, where it is sought to question or dispute the facts stated therein, is to do so by plea in abatement, on which an issue may be regularly taken and tried. **United States v. American Bell Telephone Co.*, 38 O. G. 1237, C. D. 1887.

2. While the interest of a non-resident partner in a partnership doing business in Ohio in respect to such business may be subject to the

local jurisdiction if the partnership is properly served in conformity with the statutes of the state, it is, however, well settled that the non-resident partner cannot be brought personally before even the local courts, or be subjected to judgment *in personam* by service upon the resident partners. *Id.

3. The return of the subpoena which recited that the marshal had served the same upon the "American Bell Telephone Company (which is a corporation found and doing business in the southern district of Ohio) by reading the same to A. D. Bullock, the president of the City & Suburban Telegraph Company (the said City & Suburban Telegraph Company being an agent and partner of the said the American Bell Telephone Company within said district)," fails to show affirmatively the facts required to constitute a valid service, either under the judiciary acts, the rules of practice governing the court, or the statute of Ohio providing for service upon a foreign corporation having a "managing agent" in the state. No presumptions are to be indulged in favor of such a return, so as to give the court jurisdiction over a non-resident corporation. The return is also irregular and open to the objection that the marshal did not confine himself to a statement of what he did in executing the subpoenas, but states conclusions of law and fact apart from what was done. *Id.

4. In the absence of a voluntary appearance, three conditions must concur or co-exist in order to give the federal courts jurisdiction *in personam* over a corporation created without the territorial limits of the state in which the court is held, viz.: (1) It must appear, as a matter of fact, that the corporation is carrying on its business in such foreign state or district; (2) that such business is transacted or managed by some agent or officer appointed by and representing the corporation in such state; and (3) the existence of some local law making such corporation, or foreign corporations generally, amenable to suit there as a condition express or implied of doing business in the state. *Id.

5. The judiciary acts (R. S., sec. 739) and act of March 3, 1875, providing that no civil suit or action shall be brought against any person outside of the district in which he resides or may be found at the time of the service of process, do not affect the general jurisdiction of this court, but merely confer a personal privilege or exemption upon the defendant, which can be waived and is waived by a foreign cor-

poration not only by a voluntary appearance to the suit, but by doing business in a state imposing the condition of liability to suit there by service of process on its agent. *Id.

6. It is not sufficient to give this court jurisdiction *in personam* over a foreign corporation that it has property rights, however extensive, within the district, or that it has pecuniary interests, however valuable, in business managed and conducted by others. *Id.

7. An agent of a foreign corporation upon whom service can be made must be one actually appointed by or representing the corporation as a matter of fact, not one created by implication or construction contrary to the intention of the parties. *Id.

8. The term "managing agent" implies the carrying on of the corporate business, or some substantial part thereof, by means of an agent who manages and conducts the same within the limits of the state for and on account of the foreign corporation. *Id.

9. Allegations in a plea of abatement, showing that the cause of action and the subject-matter of the suit did not have its origin in Ohio, such plea being presented solely to object to the jurisdiction of the court and to quash the return of service, do not amount to an appearance of the defendant. *Id.

10. A corporation not a resident of this district cannot be sued in this court. Service of process upon the agent or officer of a non-resident corporation insufficient. *Preston v. Fire Extinguisher Mfg. Co., 46 O. G. 124, C. D. 1889.

11. A corporation created and existing solely under the laws of another state, and having its principal office and place of business in another state and district, cannot be said to be an inhabitant of this district and be sued here, even though such corporation may do business in this district through agents. *Id.

12. In a suit in equity to have an assignment of patent-rights declared void, etc., where the parties by whom the assignment was made are non-residents, an order of publication made against them and personal service thereof upon them in another jurisdiction, but to which no heed was taken, will not have the effect of personal service of process within the jurisdiction. Upon such foreign service merely the court cannot proceed as if the parties were before it and subject them to its decree passed *in personam*. Section 787, Revised Statutes of the District of Columbia, has no application to

such case. *Backus Portable Steam Heating Co. v. Commissioner of Patents, 66 O. G. 1893, C. D. 1894.

SKILL.

See PATENTABILITY, INVENTION AND SKILL.

SPECIFICATION.

I. IN GENERAL.

II. SUFFICIENCY OF DESCRIPTION.

I. IN GENERAL.

1. If the use of a proper name to designate an invention is permissible in a specification, it is only when the invention referred to has become known in the prior art by the name of its inventor or maker. *Ex parte Forbes*, 4 MS. D. (1 G. W. D.), Oct., 1889 (Mitchell, Com'r).

2. An applicant should not, under any circumstances, be allowed to make statements derogatory to the inventions of others, clearly designated by the name of the inventor or otherwise, but he may within reasonable limits point out in his specification the advantages of his invention, and also what he regards as the defects or deficiencies common to the structures representing the unimproved art. *Ex parte Shaw*, 50 O. G. 1129, C. D. 1890.

3. An applicant will not be permitted to use words in his specification that are likely to create an ambiguity in the strict construction of his claims, and an objection by the primary examiner in such a case is properly taken. *Ex parte Petzold*, 58 O. G. 1091, C. D. 1892.

II. SUFFICIENCY OF DESCRIPTION.

(For full discussion of this subject, see decision of supreme court (Justice Bradley) in **The Webster Loom Co. v. Higgins*, 21 O. G. 2031, C. D. 1882.)

4. The theory of the operation of a patented invention may be derived wholly from the testimony of experts, and need not be stated in the specification of a patent if the thing to be done is so described in the specification that it can be produced. **Eames v. Andrews*, 39 O. G. 1319, C. D. 1887.

5. It being contended that the patent did not disclose the character of the celluloid sheets to be employed, *held*, that as there was only one kind of celluloid sheet at the date of the patent which could be used for the purpose, and the mechanic had no need of definite instructions,

the description in the patent was sufficient. **Celluloid Mfg. Co. v. American Zylonite Co.*, 40 O. G. 1453, C. D. 1887.

6. A patent sufficiently describes a process when by the aid of the knowledge derived from the state of the art the same may be carried out from the description in the patent by those skilled in the particular manufacture. **Lawther v. Hamilton*, 42 O. G. 487, C. D. 1888.

7. The law does not require that a discoverer or inventor, in order to get a patent for a process, must have succeeded in bringing his art to the highest degree of perfection. It is enough if he describes his method with sufficient clearness and precision to enable those skilled in the matter to understand what the process is, and also if he points out some practical way of putting it in operation. **Dolbear v. American Bell Telephone Co.*, 43 O. G. 377, C. D. 1888.

8. An applicant has the right to state that while he prefers the form of jack illustrated in his application as an element of the combination, other clamping devices which would accomplish the same purpose could be employed. *Ex parte Borde*, 44 O. G. 700, C. D. 1888.

9. The description in the specification of the patent, which, it should be remembered, is addressed to persons skilled in the particular art to which the invention relates, is sufficiently explicit to enable a person skilled in the art to practice the invention. **Am Ende v. Seabury & Johnson*, 47 O. G. 1354, C. D. 1889.

10. It cannot be recognized as good practice to refer in the description of a process for which a patent is sought to a very few of the letters upon the drawings which illustrate a complicated machine for carrying out that process. *Ex parte Borgfeldt*, 49 O. G. 132, C. D. 1889.

11. The word "filament," used as descriptive of the size of the burner, is sufficiently definite in view of illustrations in the specification, and it is not necessary that its maximum and minimum dimensions should be specified, especially since defendant's burners indisputably lie wholly on one side of the dividing line between rods and filaments. **Edison Electric Light Co. v. United States Electric Lighting Co.*, 61 O. G. 564, C. D. 1892.

12. A patent is not invalid for insufficiency of description, in that it does not state what one skilled in the art would know. **Lalancé & Grosjean Mfg. Co. v. Haberman Mfg. Co.*, 63 O. G. 1816, C. D. 1893.

13. The patent clearly describes and claims the construction of the invention whereby the

improvement in the art of glass-annealing is accomplished, though the description is silent as to the philosophical principles which cause the invention to produce the improved annealing. *Held*, that the description is sufficient, and that the patentee ought not to lose the statutory benefits of his invention because he was perhaps not aware to what the improvements effected by his device were due. *Dixon Wood Co. v. Pfeifer, 64 O. G. 156, C. D. 1893.

14. When a specification requires to be supplemented by experiment and inventive skill, it is fatally defective and the patent is void. *The Tannage Patent Co. v. Zahn, 71 O. G. 1161, C. D. 1895.

15. A specification which fails to describe any material part of an invention in a comprehensible manner is fatally defective. *Id.

16. It is not material that a patentee has not described in full all the beneficial functions to be performed by the parts of his machine if those functions are evident in the practical operation thereof and are seen to contribute to the success of his device. (Eames v. Andrews, 39 O. G. 1319, 7 Sup. Ct. 1073, 122 U. S. 40, followed.) *McCormick Harvesting Machine Co. v. Aultman & Co., 73 O. G. 1999, C. D. 1895.

17. In view of the antiquity of the art of swaging, *held*, that claims 1, 2, 3, 9 and 10 are not void for want of a sufficient description to comply with Revised Statutes, section 4888, though the process not stated in full. (Kilbourne v. W. Bingham Co., 60 O. G. 577, 1 C. C. A. 617, 50 Fed. Rep. 697, followed.) *Storm Mfg. Co. v. Weir Frog Co., 77 O. G. 1125, C. D. 1896.

18. Where a patent fails to state the inventor's conception of the state of the art, the particular advance which he understood himself to have accomplished, or the parts of his device or its functions, except incidentally and in a crude and incomplete manner, *held*, that if judicial tribunals misapprehended the scope of the invention the cause will lie in the want of a full and frank disclosure on the face of the patent of what it was, and as this is the fault of the inventor, or in law attributable to him, he must accept the result as one of his own making. *Long v. Pope Mfg. Co., 77 O. G. 1428, C. D. 1896.

19. Patents for processes should be so plain that an ordinary manufacturer in the art having such ordinary knowledge as would exist in this country at the date of the patent should be enabled by the instructions of the patent to

carry out successfully its processes. *Matheson v. Campbell, 79 O. G. 686, C. D. 1897.

20. As a rule an applicant is bound by the acts of his solicitor, but this rule will not be extended to include the case of one who seeks to void a patent upon the theory of fraudulent concealment or misrepresentation because through the solicitor's ignorance the specification, when describing the process of manufacture, contains some immaterial omission which could not mislead a person skilled in the art. *Id.

21. In a case like the present the patent should state and fully disclose the component parts of the composition claimed with clearness and precision and not leave a person attempting to use the discovery to find it out by experiment. If the description be so vague and uncertain that no one can tell with certainty, except by independent experiment, how to apply the discovery and what exact result may be expected therefrom, the patent is void. (Wood v. Underhill, 5 How. 1, 5; Tyler v. Boston. 7 Wall. 327, 330; The Incandescent Lamp Patent, 73 O. G. 1289, 159 U. S. 465, 474-75.) *Stevens v. Seher, 81 O. G. 1932, C. D. 1897.

STATUTES, CONSTRUCTION OF.

I. IN GENERAL.

II. RE-ISSUE.

I. IN GENERAL.

1. The word "unavoidable," as used in section 4894, Revised Statutes, should not be construed in its broad significance. The statute itself is one regulating a mere practice in the office and is not intended to affect *substantial* rights. *Ex parte Pratt*, 39 O. G. 1549, C. D. 1887.

2. The primary examiner mentioned in section 4904 is the examiner of interferences, while the primary examiner mentioned in section 4909 is one of the primary examiners named in section 440, Revised Statutes. *Faure v. Bradley*, 40 O. G. 243, C. D. 1887.

3. The expression "found in his possession," in section 4965 of the Revised Statutes, means found in the possession of the defendant before the cause of action accrues, and does not refer to the finding of the jury. *Thornton v. Schreiber, 42 O. G. 1165, C. D. 1888.

4. The "possession," under this statute, is not

the possession of an employee, but of his principal. *Id.

5. The argument sought to be founded upon the various phases assumed by the provisions of the act of July 8, 1870, in its passage through the two houses of congress is very unsafe and unreliable as a basis of judicial action, particularly when the only inference to be drawn is one as to what view congress took of the act of 1839 in enacting the act of 1870. *Andrews v. Hovey, 42 O. G. 1285, C. D. 1888.

6. The seventh section of the act of 1839 includes a process as well as "a machine, manufacture or composition of matter." *Id.

7. If there is no ambiguity in the statute it is the duty of the court to give effect to its obvious meaning, without entering into any inquiry as to the supposed intention of congress, notwithstanding the statute may be thought to make an unreasonable and harsh innovation. *Edison Electric Light Co. v. United States Electric Lighting Co., 43 O. G. 1456, C. D. 1888.

8. Where the meaning of the Revised Statutes is plain, the court cannot look into the source of the revision to ascertain whether errors have or have not been committed by the reviser. *Id.

9. The statute does not provide that any person who has *made* any new and useful machine, etc., will be entitled to a patent, but that any person who has *invented* any new art, machine, etc. *Ex parte* Gibford, 45 O. G. 1457, C. D. 1888.

10. *Held*, that the words "filing of the application" in section 4894 do not mean the filing of the completed application, but only the depositing of the application referred to in section 4893 and preceding sections, which may or may not be accompanied by the fee. *Ex parte* Fenno, 52 O. G. 1665, C. D. 1890.

11. The words "every party to an interference" in section 4900 of the Revised Statutes evidently mean every defeated party to an interference. *Shinn v. Baker, v. Gold*, 56 O. G. 1204, C. D. 1891.

12. The word "*decision*" in the last clause of section 9 of the act of February 9, 1893, providing that "any party aggrieved by a decision of the commissioner of patents in any interference case may appeal therefrom to said court of appeals," interpreted and *held* to mean only a decision of the commissioner of patents awarding priority of invention. *Westinghouse, Jr., v. Duncan, 66 O. G. 1009, C. D. 1894.

13. It is a sound rule of construction of a statute, where the words of an act or part of

an act are plain and clear and not inconsistent with the general object of the statute and lead to no absurd result, that the courts have no right to refuse their operation or to limit their effect by a construction based upon conjecture. *In re Drawbaugh, 67 O. G. 929, C. D. 1894.

14. The meaning of the words "surreptitiously" or "unjustly" in section 4926, Revised Statutes, and prior statutes discussed. *Yates v. Huson, 74 O. G. 1732, C. D. 1896.

II. RE-ISSUE.

15. The language of section 4916 of the Revised Statutes, that the "surrender shall take effect upon the issue of the amended patent," is not to be construed to mean that the status of the original patent is unchanged after its return to the commissioner. *Burrell v. Hackley, 44 O. G. 1400, C. D. 1888.

16. The supreme court has never so construed the statute which authorizes re-issues as to deny to a patentee, on application made in due time and before adverse rights have accrued, the right to obtain a re-issue broad enough to cover his entire invention as originally described and as he intended to claim it. *Walker v. City of Terre Haute, 54 O. G. 507, C. D. 1891.

17. The commissioner is authorized to re-issue patents in certain specified cases, and if the petition makes no pretense of setting forth facts entitling the patentee to a re-issue it is exceedingly doubtful whether he obtains any jurisdiction under section 4916, Revised Statutes, to act upon such petition. *Eby v. King, 71 O. G. 1754, C. D. 1893.

STATE STATUTES OF LIMITATION.

1. Under Revised Statutes of the United States, section 721, providing that "the laws of the several states, except where the constitution, treaties or statutes of the United States otherwise require or provide, shall be regarded as rules of decision in trials at common law in the courts of the United States in cases where they apply," an action in a federal court to recover damages for infringement of a patent is not subject to a state statute of limitations. *May v. Buchanan County, Iowa, 39 O. G. 120, C. D. 1887.

2. But such action is subject to a state statute requiring a demand against a county for unliquidated damages to be presented to the

board of supervisors of the county and payment demanded before bringing action upon it. *Id.

3. State statutes of limitations have no application to actions arising out of the infringement of patents, even though there is no federal statute in existence. *May v. County of Ralls, 40 O. G. 575, C. D. 1887.

4. There is no federal statute of limitations in force respecting infringements committed since June 22, 1874. *May v. Logan County, 41 O. G. 1387, C. D. 1887.

5. State statutes of limitations have no application to actions arising out of the infringement of patents. *Id.

6. A state statute of limitations has no effect upon suits in the federal courts for the infringement of patent-rights, and is not pleadable in bar of an action at law for such infringement. *Brickill v. City of Hartford, 58 O. G. 1417, C. D. 1892.

7. A state statute of limitations is not pleadable in bar of an action at law for infringement of a patent. (Following McGinnis v. Erie Co., 55 O. G. 718, 45 Fed. Rep. 91.) *California Artificial Stone Paving Co. v. Starr, 58 O. G. 1094, C. D. 1892.

8. Defendant in an action at law for infringement of patent pleaded state statutes of limitation, to which plaintiff demurred. Demurrer sustained for the purposes of this particular case; but the applicability of such statutes to actions for infringement under the patent laws discussed and upheld. *Brickill v. Mayor, etc. of Baltimore, 61 O. G. 1791, C. D. 1892.

STAY OF ISSUE.

(See WITHHOLDING FROM ISSUE.)

SUBSEQUENT APPLICATIONS.

(See INTERFERING PATENTS; DIVISIONAL APPLICATIONS; CROSS-REFERENCES; RESERVATION IN APPLICATIONS; CONTINUING APPLICATIONS.)

1. Where an applicant has two applications pending which contain substantially the same claims, the examiner should not require formal abandonment of one application as the condition of allowing the other to proceed to issue, nor should he require the erasure of any claims which would be allowed if no other application awaited consideration. (Ex parte Langlois, 14

O. G. 84.) The true course for the examiner is pointed out in Ex parte Gaboury, 37 O. G. 217. Ex parte Feister, 44 MS. D. (2 G. W. D.), Oct., 1890 (Mitchell, Com'r).

2. There is nothing in the provisions of Revised Statutes, section 4894, to prevent the filing of a subsequent application for a patent for subject-matter of a previously-abandoned application. Ex parte Beggs, 50 O. G. 1130, C. D. 1890.

3. The specification of a patent originally embraced matter which was erased before issue, and was after the issue presented in another application and patent issued thereon. Held not an abandonment of the parts erased from the first specification. *Sugar Apparatus Mfg. Co. v. Yuryan Mfg. Co., 53 O. G. 920, C. D. 1890.

4. Where the earlier of two pending applications of the same applicant was in condition for allowance, and the examiner refused to pass it until the later application had been formally abandoned, or until such claims in the earlier application as applied to what was shown and claimed in the later had been erased, for the reason that the later application contained substantially the same claims as the earlier, held, that the later application was no bar to the allowance of the earlier application. (Following Ex parte Langlois, 14 O. G. 84.) Ex parte Feister, 53 O. G. 1089, C. D. 1890.

5. The formal abandonment of an application should not be required as a condition precedent to allowing another application of the same inventor pending concurrently and in condition for allowance to proceed to issue, nor should the examiner require the erasure of any claims which would be allowed if no other application awaited consideration. The true course to be pursued is that pointed out in Ex parte Gaboury, 37 O. G. 214. Id.

6. Where an application was rejected on applicant's prior patent, the application for which was pending concurrently with the present application, and it appeared that the claims of said patent and application covered the same invention under a slightly different guise, and that the case was one in which the lines of division between the supposed different inventions existed as mental figments only and had no corresponding existence in the concrete subject of invention, held, that the application was rightly rejected because of want of divisibility of invention between it and said patent. Ex parte Woodward, 53 O. G. 1090, C. D. 1890.

7. Where an applicant has two applications pending for the same class of machines, the

earlier of which is involved in an interference, and where it is apparent that none of the claims of the later application could be made in either of the applications in interference, and that no judgment that might be rendered in the interference proceedings could in any way affect the claims of such later application, *held*, that the interference was no bar to the allowance of the later application. *Ex parte Woodward*, 58 O. G. 1554, C. D. 1892.

8. The lapse of two years from and after the allowance of a patent to an applicant without responsive action on his part does not *per se* work such a forfeiture of rights as will bar the applicant from making a subsequent application for the same improvements and taking a patent therefor. (Discussing and construing sections 4885, 4886 and 4897 of the Revised Statutes.) *Sibbald v. Cassidy and Smith*, 61 O. G. 1165, C. D. 1892.

SUBSEQUENT PATENTS.

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

SUBSTITUTION OF PARTS.

(See PATENTABILITY.)

SUSPENSION OF ACTION ON APPLICATION.

1. It is against public policy to permit an application for patent to lie dormant and suspended upon request of applicant or his assignee for a long term of years, and the practice of suspending action on applications for indefinite periods upon the request of the parties in interest is not sanctioned. There is no authority of law for such procedure, and a case cannot be suspended as a matter of right on the part of the applicant. *Ex parte Norton*, 42 O. G. 296, C. D. 1888.

2. A request by the parties in interest that further action should not be taken waived action by the office, and put the case in the same condition as though the office had acted and was awaiting further action on the part of the applicant or his assignee. *Id.*

3. Action should not be suspended on an application when it appears that its claims are patentable over all the disclosures of a prior

application by the same applicant in interference and over all the disclosures of the interfering applications. *Ex parte Willson*, 59 O. G. 1257, C. D. 1892.

4. While the office cannot determine disputed questions of title, it is the rule to refuse petitions to suspend action on applications, when such petitions are based on the fact that a bill in equity has been filed by the inventor or assignee. (Cases cited.) *Ex parte Martin*, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

SUITS.

(See APPEAL; DAMAGES AND PROFITS; DEFENSES; DEMURRER; INFRINGEMENT; INJUNCTION; PRACTICE IN THE COURTS.)

- I. INFRINGEMENT, IN GENERAL.
- II. INFRINGEMENT, AGAINST STATE, COUNTIES AND CORPORATE BODIES.
- III. INFRINGEMENT, AGAINST THE UNITED STATES AND UNITED STATES OFFICERS.
- IV. INFRINGEMENT, ROYALTIES; LICENSE.
- V. EQUITY, SPECIFIC PERFORMANCE.
- VI. PARTIES.
- VII. DELAY IN BRINGING.
- VIII. COSTS OF.

I. INFRINGEMENT, IN GENERAL.

1. In suits in equity the federal courts are regulated, not by state statutes, but by the judiciary acts and the rules of equity practice. **United States v. American Bell Telephone Co.*, O. G. 1237, C. D. 1887.

2. The owner of an equitable interest in a patent is not answerable in a suit for its infringement to the owners of the legal interest in the same patent. **Aspinwall Mfg. Co. v. Gill*, 40 O. G. 1133, C. D. 1887.

3. An assignment by an administrator purporting to transfer to the assignee "all the right, title, interest, claims and demands whatsoever which the estate has in, to, by, under and through" specified letters patent, and extensions thereof, covers rights of action theretofore accrued for infringements. *May v. Logan County*, 41 O. G. 1337, C. D. 1887.

4. Where the contention of the plaintiff was that the inventor only knew of the invalidity of his first re-issue by the result in an earlier suit upon the same, and did not have evidence of these facts in the record, he should have brought by *certiorari* before this court such parts of the record as the defendants had omit-

ted to bring before us. *Hoskin v. Fisher, 43 O. G. 509, C. D. 1888.

5. Where in a suit against two defendants for a joint infringement, one of the defendants had made a settlement by a writing under seal for the costs and damages by the infringement of such defendant, but by such writing the other defendant was expressly not included in such settlement, the settlement was a satisfaction of the infringement by both defendants both as to damages and costs. *Babcock & Wilcox Co. v. Pioneer Iron Works, 43 O. G. 756, C. D. 1888.

6. An action for the infringement of a patent cannot be maintained while said patent is surrendered to the commissioner of patents pending an application for re-issue on the ground that the patent is inoperative and void. *Burrell v. Hackley, 44 O. G. 1400, C. D. 1888.

7. The right of action is suspended during the time the commissioner retains jurisdiction of the patent upon the question of re-issue. *Id.

8. The complainants insist that their position is precisely the same as if they held a single patent with two claims—one for the process or composition of matter producing the coloring substance, the other for the combination of that substance with paper. This might be so if they could be considered as holding both patents; but in this suit they have carefully abstained from declaring upon the first patent or even in any way referring to it. By not declaring upon it as its present owner, they leave it to the defendant to be availed of as if it were the property of a stranger. *Underwood v. Gerber, 48 O. G. 116, C. D. 1889.

9. A suit may be entertained and decided by a state court, even though there may be pending at the same time an appeal in the United States supreme court from a judgment of the circuit court dismissing a suit brought by the patentee against the complainant for infringement of the patent. *Marsh v. Nichols, Shepard & Co., 56 O. G. 259, C. D. 1891.

10. When a patent has been surrendered and a re-issue obtained and such re-issue is held to be void, the patentee cannot proceed upon his original patent. (Moffitt v. Garr, 1 Black, 273; Reedy v. Scott, 7 O. G. 463, 23 Wall. 352, 364; Peck v. Collins, 19 O. G. 1137, 103 U. S. 660; McMurray v. Mallory, 27 O. G. 915, 111 U. S. 97, referred to and reviewed.) *Eby v. King, 71 O. G. 1454, C. D. 1893.

(See *Burrell v. Hackley, *supra*; also, *Allen v. Culp, 79 O. G. 1523, C. D. 1897.)

11. In a suit under section 4915, Revised Statutes, whether the specification in the patent issued to the defendant is sufficient is not involved in the case. It is wholly incompetent and cannot be inquired into. The question is one of priority. *Standard Cartridge Co. v. Peters Cartridge Co., 72 O. G. 742, C. D. 1895.

12. The expression "was awarded to the Western Electric Company through its agent, Mr. Kaelber," is not sufficient to establish the character of Mr. Kaelber's agency or to justify an apprehension of infringement from him. A *quia timet* action will not lie unless there is something to fear. *Edison Electric Light Co. v. Kaelber, 77 O. G. 1430, C. D. 1896.

13. The joinder in one suit of claims for infringement of two patents relating to the same subject-matter is in the interest of the public as well as of private litigants and should not be discouraged by too stringent rules as to costs or otherwise. *Green v. City of Lynn, 80 O. G. 1480, C. D. 1897.

II. INFRINGEMENT, AGAINST STATES, COUNTIES AND CORPORATE BODIES.

(See TRUSTS.)

14. Congress has the exclusive control over the grant of patents, and may authorize suits to be brought against such persons and corporations as it deems expedient, and a state cannot exempt counties from liability for infringement of letters patent because exclusive jurisdiction over that subject-matter has been vested in the federal government. *May v. County of Ralls, 40 O. G. 575, C. D. 1887.

15. A suit cannot be maintained against a sovereign state under the eleventh amendment of the constitution; but no reason is seen why a suit cannot be maintained against a quasi-municipal corporation like a county, which has been created by the laws of the state (and under the state laws may be sued for certain purposes), no matter what may be the particular policy of the state with reference to relieving counties therein from liability for acts of non-feasance of county officials. *Id.

16. No exception has been made by act of congress in favor of any wrong-doer. The provision is general in its terms, and may as well include counties as other corporations or individuals. *Id.

17. A patent is personal property, and if a county wrongfully appropriates such property

it should not be exempt from liability any more than an individual. *Id.

18. Obligations to do justice rest upon all persons, natural and artificial, and if a county obtains money or property of others without authority of law, the law, independent of any statute, will compel restitution or compensation. *Id.

19. A county has the physical power to appropriate property, and, if it does so wrongfully, it will not be exempt from liability any more than an individual. *Id.

20. The officers of a corporation engaged in a manufacture in violation of the injunction of the court cannot shelter themselves from individual liability by the plea that they are acting merely as agents for the corporation. *Iowa Barb Steel Wire Co. v. Southern Barb Wire Co., 40 O. G. 577, C. D. 1887.

21. A Kentucky county is a corporation, and an action can be maintained against it for the infringement of a patent. *May v. Mercer County, 41 O. G. 815, C. D. 1887.

22. Where the officers of a corporation are made co-defendants in an action for infringement of letters patent, a decree for an injunction and accounting will not issue against them individually where the corporation is solvent and they have not as individuals violated, and are not threatening to violate, any rights of complainant. *Howard v. St. Paul Plow Works, 45 O. G. 1067, C. D. 1888.

23. Notwithstanding the merger of the complainant with another company into a new corporation, the law of the state of New York providing that pending suits shall not be deemed to have been abated or discontinued by reason of any such consolidation is effective to accomplish that end. *Edison Electric Light Co. v. United States Electric Lighting Co., 61 O. G. 564, C. D. 1892.

III. INFRINGEMENT, AGAINST THE UNITED STATES AND UNITED STATES OFFICIALS.

24. Where an officer of the government, having been sued for the infringement of patents in his official employment, pleads to the jurisdiction and alleges that the government, being the real defendant, is a necessary party, *held*, that the plea must be overruled and that public employment is not a sufficient defense. *Head v. Porter, 60 O. G. 1052, C. D. 1892.

25. Action against the United States to recover damages for the alleged wrongful use of

the invention secured by a patent, No. 105,599, issued July 19, 1870, and re-issued May 2, 1871, No. 4,364, to John J. Schillinger, for an improvement in concrete pavements, *held* to be an action "sounding in tort" and not maintainable. *Schillinger v. United States, 69 O. G. 1505, C. D. 1894.

26. The patentee of an improvement in breeching-loading cannon brought suit against an officer of the United States navy connected with the bureau of ordnance and having charge of the manufacture of cannon at a navy yard for an alleged infringement of his patent, praying not only for an accounting and damages, but for an injunction restraining defendant and all persons acting under his authority from making the cannon alleged to infringe complainant's patent. *Held*, that the suit was, in substance, one to prevent the making of breech-loading cannon of a certain character at the navy yard, and that public policy and the rights of the government would not permit such a suit to be maintained. (62 Fed. Rep. 584, reversed.) *Dashiell v. Grosvenor, 74 O. G. 500, C. D. 1896.

27. The United States having, by act of congress, consented to be sued upon their contracts, may accordingly be sued by a patentee for their use of his invention under a contract made with him by the United States or their authorized officers. *Belknap v. Schild, 74 O. G. 1121, C. D. 1896.

28. But the United States have not consented to be liable to suits sounding in tort for wrongs done by one of their officers, though in the discharge of his official duties. They are therefore not liable to a suit for an infringement of a patent, that being an action sounding in tort. *Id.

29. A public officer is not personally liable on a contract made by him in the line of his duty and on account of the United States and inuring to their benefit and not to his own; but he is personally liable to be sued for his own infringement of a patent. *Id.

30. Where the infringing device was the property of the United States and held and used by them for the public benefit through officers, the United States were an indispensable party to the suit to enable the court to grant the relief sought. *Id.

IV. INFRINGEMENT, ROYALTIES, LICENSE.

31. In a suit for infringement, where the defense was a license to make one hundred machines, and it appeared that the licensee had

made more than that number, the hostile conduct of the licensor might make him liable to the licensee for damages, but would not extend the terms of the license. *Aspinwall Mfg. Co. v. Gill, 40 O. G. 1133, C. D. 1887.

32. The defendant is a licensee of the Detroit Lubricating Company under a license which is limited upon its face to patents owned by that company. The Detroit Lubricating Company is the licensee of the complainant under a contract which does not grant an exclusive license for the manufacture or use of the Gates patent owned by the complainant, and which is infringed. *Held*, that the defendant was not protected by its license in the manufacture of articles under the Gates patent. *The Seibert Cylinder Oil Cup Co. v. The William Powell Co., 47 O. G. 1072, C. D. 1889.

33. Where in a suit to recover royalties under a license it appeared that it was sufficiently alleged in the declaration that the defendant accepted the license and manufactured goods under it, *held*, that this was sufficient to show an implied undertaking to pay the royalties provided for in the license. *National Rubber Co. v. Boston Rubber Shoe Co., 50 O. G. 559, C. D. 1890.

34. *Held* further, that it was no defense that said goods did not contain the improvements described in any of the licensor's patents, excepting one that had expired long before the period for which recovery was sought, since it was evident that the goods made by defendant embodied inventions described in two of said patents that were still in force. **Id.*

35. When the validity of the patent and the license are admitted, a suit by a licensee to restrain a subsequent assignee from manufacturing and selling the patented article, and to recover damages, involves no question under the patent laws and was properly in the state court for determination. †Mayer v. Hardy, 56 O. G. 527, C. D. 1891.

36. When a license to make, use and sell a patented article is granted, coupled with a covenant to grant only one other license, and when the patentee was not by the terms of the agreement denied the right to manufacture and sell the patented article and was not by any express provision in it required to retain the title, a subsequent assignee of all the patentee's right, title and interest is not liable as a trespasser against the rights granted by the license. †*Id.*

37. If the bill of the licensee who has the

exclusive right to manufacture and sell a patented article alleges a combination between the owner of the patent and other persons, who are made parties defendant with the owner, to deprive the complainant of the benefits and advantages of his license, and the evidence shows that a license granted by the owner of the patent to his co-defendants was granted by him, and procured by them, for the paramount purpose of preventing the complainant from enjoying the monopoly conferred by his license, the defendants are joint infringers of the complainant's rights, and he is entitled to relief against all the parties defendant. *Waterman v. Shipman, 64 O. G. 713, C. D. 1893.

V. EQUITY, SPECIFIC PERFORMANCE.

(See EQUITY.)

38. A suit against a patentee for the specific performance of an alleged contract between the complainant and patentee, by which the former was to have the right, if the latter obtained a patent on the improvement in question, to make, use and vend said patented article, and to enjoin the patentee from interfering with such right, is not a question arising under the patent laws, since neither the validity of the patent, nor its construction, nor the patentability of the device, was brought under consideration. *Marsh v. Nichols, Shepard & Co., 56 O. G. 259, C. D. 1891.

39. A court of chancery cannot decree specific performance of an agreement to convey property which has no existence, or to which defendant has no title. *Kennedy v. Hazelton, 46 O. G. 973, C. D. 1889.

40. A contract which, entirely aside from any question of its validity in law, is unusual and oppressive in its terms, is not enforceable in equity. Specific performance is not an absolute right, but rests entirely in judicial discretion. (Citing *Hennessy v. Woolworth*, 128 U. S. 438.) *Pope Mfg. Co. v. Gormully, 59 O. G. 464, C. D. 1892.

41. An oral agreement for the sale and assignment of the right to obtain a patent for an invention is not within the statute of frauds, nor within section 4898 of the Revised Statutes requiring assignments of patents to be in writing, and may be specifically enforced in equity upon sufficient proof thereof. *Dalzell v. Dueber Watch Case Mfg. Co., 63 O. G. 1381, C. D. 1893.

42. A court of chancery will not decree specific performance unless the agreement is "cer-

tain, fair and just in all its parts," nor "if it be doubted whether an agreement has been concluded or is a mere negotiation," nor "unless the proof is clear and satisfactory both as to the existence of the agreement and as to its terms." *Id.

43. When there is a decree for specific performance of two contracts, one for a transfer of part interest of all inventions relating to a particular subject and the other for a transfer of part interest of certain specified patents relating to that subject, the assignee's rights are merged in the decree and he has no title or claim under his contracts to any other patents of the assignor or to any improvements thereon. *Independent Electric Co. v. Jeffrey Mfg. Co., 78 O. G. 797, C. D. 1897.

VI. PARTIES.

(See SUITS AGAINST STATES, COUNTIES AND THE UNITED STATES.)

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

45. Where the complainant in a bill for the infringement of a patent is only a licensee, and the patent had been assigned to another party before the suit as security for a debt not yet due, the last-named party must be joined as a complainant, and a subsequent assignment to the complainants of the assignor's entire interest in the patent will not change the legal status of the parties. *Waterman v. Mackenzie, 39 O. G. 122, C. D. 1887.

46. There is no necessity for making those parties to the suit who have been settled with and had no interest in the controversy. *Rogers v. Riessner, 41 O. G. 351, C. D. 1887.

47. Rights of action for infringements of patents survive to the personal representatives of the patentee. *May v. Logan County, 41 O. G. 1387, C. D. 1887.

48. The executor or administrator of the patentee may not only sue on such causes of action, but may assign and transfer the same to another. *Id.

49. The assignee may, in his own name, maintain an action thereon in any state the law whereof allows an assignee of a chose in action to sue thereon in his own name. *Id.

50. An interest in the net proceeds of collections for infringements of a patent does not necessarily involve an interest in the patent

itself. *Tilghman v. Proctor, 43 O. G. 628, C. D. 1888.

51. After litigation is closed in suit for infringement of a patent, a petition in behalf of a party for leave to intervene as a defendant alleging that he had actually defended respondent's case and was most interested in the defense against complainant's patent must be dismissed. *Zinsser v. Kremer, 49 O. G. 414, C. D. 1899.

52. Where a patentee granted to a complainant "the exclusive right, liberty and privilege to make, use and sell" a patented invention "during the full unexpired term thereof, and of all re-issues, renewals and improvements," throughout the United States and the territories, the complainant to pay the royalties agreed upon in a separate agreement, and it did not appear whether such grant was an absolute or defeasible conveyance, *held*, that the complainant must join the owner of the legal title in a suit to enjoin the infringement of the patent. *Clement Mfg. Co. v. Upson & Hart Co., 50 O. G. 840, C. D. 1890.

53. In such suit complainant's allegations that, by mesne assignments and grants, it became, prior to the suit, and now is, the party interested in said letters patent, "all of which, by said assignments and grants now in court produced and shown, will more fully appear," sufficiently show complainant's interest, when coupled with the profert and exhibit. *Id.

54. Where in a suit for the infringement of a patent it appeared that an individual defendant had no interest in the alleged infringing machines except as an officer of a defendant corporation, and that there was no evidence that he as an individual had violated any of the complainant's rights, or that the defendant corporation was insolvent, or that a decree against it would not protect the complainant, *held*, that the suit should be dismissed as to him. *Woven Hose Co. v. Star Rubber Co., 50 O. G. 1450, C. D. 1890.

55. 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 of demurrer, though there is no specific allegation in the bill that he personally directed or participated in the infringement complained of. *Cleveland Forge and Bolt Co. v. United States Rolling-Stock Co., 52 O. G. 1808, C. D. 1890.

56. When a mortgage has been recorded in the patent office, the title of the mortgagee is

complete and he is the only person who can thereafter sue for an infringement of the patent by third persons. *Waterman v. Mackenzie, 54 O. G. 1562, C. D. 1891.

57. A mere licensee, or one having no title in and exclusive right under the patent, cannot sue at law in his own name for an infringement. *Id.

58. A grantee, if he seeks to maintain an action in his own name, must be supreme within the assigned territory and be able to do all that the patentee could do if the conveyance had not been made, and if he does not occupy this position and possess these rights he is only a licensee. *Rice v. Boss, 55 O. G. 999, C. D. 1891.

59. Where final decrees were rendered in the circuit court in favor of two joint owners of certain patents, not being partners, and one of the complainants died after said decrees were rendered and appeals were filed and allowed and the citation ran to the surviving complainant, and no order was procured, directed to the proper representatives of the estate of the deceased owner, or notifying them of the appeals, and they did not voluntarily appear, *held*, that the cause of action did not survive to the remaining owner and that the supreme court had no jurisdiction. *Dolan v. Jennings, 55 O. G. 141, C. D. 1891.

60. The petition of a third party to be admitted as a party defendant in a suit for infringement, alleging that the petitioner makes and sells machines which he is informed the complainant claims are an infringement of the patent upon which suit is brought, and alleging that the petitioner is informed that the complainant intends, if successful in that case, to sue the petitioner on the use of machines made by petitioner, but not stating or claiming that the machines which petitioner makes are identical in structure or mode of operation with the machines made by defendant, and not stating any fact showing that petitioner is in privity in any way with the defendant, *denied*. The granting of such a petition would, in effect, be to hold that the complainant must join in the same suit all persons who have infringed the patent in question, whether acting together or not. *Thomson-Houston Electric Co. v. Sperry Electric Co., 57 O. G. 275, C. D. 1891.

61. The owner of a patent, pending a suit for damages for infringement of it, assigns his interest, reserving back damages. Upon motion by the assignee for leave to file a supplemental bill, *held*, there being no proof or claim of infringement subsequent to the assignment,

the assignee should not be joined as complainant. *New York Belting and Packing Co. v. New Jersey Car-Spring and Rubber Co., 57 O. G. 1888, C. D. 1891.

62. A corporation, owner by assignment of certain patent-rights, licensed another corporation exclusive rights to sell within limited territory. In an action brought by the licensee against another corporation infringing its territorial rights, *held*, that the licensee has, *prima facie*, implied power to join the licensor corporation, even against its will and although it appears that the infringing corporation holds a controlling interest of the stock of the licensor. *Brush-Swan Electric Light Co. v. Thomson-Houston Electric Co., 58 O. G. 807, C. D. 1892.

63. The holder of a specified territorial right in a patent, either as licensee or assignee, is not a necessary party complainant to a suit for infringement outside his own territory. *Canton Steel Roofing Co. v. Kanneberg, 61 O. G. 424, C. D. 1892.

64. A joint suit for infringement of a patent cannot be maintained by the patentee and the licensee whose license conveys no exclusive monopoly. *Blair v. Lippincott Gas Co., 61 O. G. 1792, C. D. 1892.

65. A license to manufacture lime-glass chimneys under a patent granted by the patentee with others does not estop the licensee from objecting that such other parties cannot be joined with the patentee in an action against the licensee for infringement by manufacturing lead-glass chimneys without a license. *Id.

66. A licensee may prosecute suit for infringement of a patent in his own name where the defendant is the owner of the legal title to the patent. (Citing Littlefield v. Perry, 7 O. G. 964, 21 Wall. 205.) *Adriance, Platt & Co. v. McCormick Harvesting Machine Co., 63 O. G. 1688, C. D. 1893.

67. A licensee who has the exclusive right to manufacture and sell a patented article can maintain a suit in equity against the patentee, if the latter is guilty of an infringement by making and selling himself, to redress the wrong occasioned thereby, and such suit arises under the patent laws of the United States. *Waterman v. Shipman, 64 O. G. 713, C. D. 1893.

68. Courts of the United States are bound to take notice of the persons who occupy the positions of heads of departments, etc., including that of the patent office. The commissioner made a party defendant in this suit having been succeeded in that office by another person, no decree made against him would bind the pres-

ent incumbent of the office. *Backus Portable Steam Heater Co. v. Commissioner of Patents, 66 O. G. 1893, C. D. 1894.

69. Where there are adverse parties the commissioner of patents is not a necessary party to and cannot be joined in a suit under section 4915. Revised Statutes of the United States. *Mergenthaler Linotype Co. v. Commissioner of Patents, 66 O. G. 1311, C. D. 1894.

70. Where the infringing device was the property of the United States and held and used by them for the public benefit through officers, the United States were an indispensable party to the suit to enable the court to grant the relief sought. *Belknap v. Schild, 74 O. G. 1121, C. D. 1896.

71. All parties interested in the subject-matter or issue of the suit must be made parties thereto; but employees receiving in return for their services fixed salaries are not such parties. Every agent, however, who performs acts of infringement and all officers who in the prosecution of business authorize said acts are responsible and should be enjoined. *Matthews & Willard Mfg. Co. v. Trenton Lamp Co., 75 O. G. 674, C. D. 1896.

72. It is not necessary that a person should appear upon the record as a technical party to the proceedings in order to be bound by a judgment. If he be a substantial party he will be bound by the finding in the case. *Drawbaugh v. Seymour, Com'r of Patents, 77 O. G. 313, C. D. 1896.

73. A mere licensee has no authority to sue infringers in his own name. *Chauche v. Pare, 77 O. G. 1123, C. D. 1896.

VII. DELAY IN BRINGING.

74. Demurrer to an equity action for infringement of a patent which expired three weeks after the commencement of the action, not sustained. *Kittle v. De Graaf, 30 Fed. Rep. 689 (1887).

75. In an action for infringement of letters patent, where it is shown that defendants took a license from plaintiff to make and vend the patent, and subsequently denied plaintiff's rights and claimed to make under another patent; that shortly after such denial plaintiff became bankrupt and the assignee in bankruptcy sold the patent after two years; that plaintiff entered into negotiations to get the patent back from the vendee; that, though the vendee took no steps to prevent the patent being plundered, plaintiff gave defendants notice he intended to

hold them accountable for their infringements; that after his discharge from bankruptcy, and when he had re-acquired the patent, plaintiff commenced action against defendants for infringement, the court sitting in equity will, considering all the circumstances, take jurisdiction of the cause, notwithstanding a delay of about seven years in the prosecution by plaintiff of his rights. *Kittle v. Hall, 39 O. G. 707, C. D. 1887.

76. The objection that the applicant failed to prosecute his application for a patent within two years after the last action thereon, of which notice was given (section 4894), applies to a suit in equity for a patent under section 4915. *Gandy v. Marble, 39 O. G. 1423, C. D. 1887.

77. Such a suit is in fact and necessarily a part of the application for the patent, and is to be governed by the rule as to laches and delay declared by section 4894 to be attendant upon an application. *Id.

78. In such a suit it may be shown to the satisfaction of the court that the delay in the prosecution of the application was unavoidable in support of an allegation to that effect in the bill. *Id.

79. Where an invention was assigned to the complainant in the year 1869, and shortly thereafter the defendant alleged to the complainant that the embodiment of it (said invention) in a working machine proved it to be impracticable and unsatisfactory, and where the complainant, by reason of the representations of the defendant, was led to believe that said invention had been abandoned and thrown aside, and, relying upon said representations, rested for a period of nineteen years before asserting his rights in and to said invention, having only a short time before asserting said rights become aware of the fact that said assigned invention had not been abandoned, but that it was in fact the same in principle and mode of operation as an invention at that time alleged by the defendant to be a practical one, a court in equity will consider that the complainant had a right to rely on the statements of the defendant, and that in such a case no laches could be attributed to him. *Wilson v. Keely, 43 O. G. 511, C. D. 1888.

80. While there was such delay in bringing suit as to preclude recovery of damages for prior infringement, there was neither conduct nor negligence which could be held to destroy the right to prevention of further injury. *Mendez v. Holt, 46 O. G. 971, C. D. 1889.

81. Equity will not entertain a bill for in-

fringement of letters patent which expired between the date of service and the return day, there being no special case made by the bill showing that an injunction was part of the remedy to which the complainant would be entitled by reason of special facts alleged. *American Cable Ry. Co. v. Chicago City Ry. Co., 52 O. G. 1666, C. D. 1890.

82. The defendants were notified to desist from infringement about eight months after knowledge thereof came to the plaintiff, and suit was begun within four months thereafter. *Held*, that under the circumstances the delay did not constitute laches. *Loring v. Booth, 61 O. G. 1483, C. D. 1892.

83. A party who has used a patented structure openly for a period of eleven years with the full knowledge of the patentee and without objection from him cannot be held an infringer. (Cases cited.) *Edison Electric Light Co. v. Equitable Life Assurance Society, 55 Fed. Rep. 478 (1893).

84. Where the complainant claimed to have disclosed his process to the defendant on the promise that no use would be made of it without his consent, and the bill seeking relief thereon was not filed until some fourteen or fifteen years later, *held*, that this lapse of time not only constitutes a bar such as the statute of limitations interposes, but shows such laches as will clearly preclude any right of relief. *Leggett v. Standard Oil Co., 63 O. G. 1201, C. D. 1893.

85. Poverty or pecuniary embarrassment of a party is not a sufficient excuse for postponing the assertion of his rights. (Hayward v. National Bank, 96 U. S. 611, 618.) *Id.

86. Where the facts in the case are such as are above stated, and it further appears that the patentee permitted a period of twelve years to elapse before he resorted to his remedy in court, *held* that, in the absence of any excuse for such laches, except that he preferred to receive a salary from his employer rather than to demand a royalty, the patentee is entitled to a less favorable consideration by a court of equity than if his conduct had been that of mere inaction. *Lane & Bodley Co. v. Locke, 65 O. G. 1406, C. D. 1893.

87. Complainant and its predecessors knew of the alleged infringement and acquiesced in it for a period of fourteen years. The acquiescence of the former owners has equally the same effect upon complainant's rights as its own subsequent neglect. (Cases cited.) *Held*, the bill should be dismissed for inexcusable

laches. (Cases cited.) *Woodmanse & Hewitt Mfg. Co. v. Williams, 68 Fed. Rep. 489 (1895).

88. Letters Patent Nos. 133,898, 137,495, 154,770 and 158,992, to George T. Smith for middlings purifiers, having expired prior to the commencement of the suit, afford no basis for equitable relief. *Russell v. Kern, 72 O. G. 590, C. D. 1895.

89. Letters Patent No. 164,050, granted June 1, 1875, to George T. Smith, for middlings purifier, having expired after the filing of the original bill, but before the return day of the subpoena, it was within the discretion of the court to dismiss the bill for want of equity. *Id.

90. Mere delay in prosecuting infringers, unaccompanied by circumstances amounting to equitable estoppel, will not prevent a patent owner from maintaining suits for equitable relief. *Taylor v. Sawyer Spindle Co., 77 O. G. 452, C. D. 1896.

91. The mere fact of even long-continued infringement without protest on the part of complainant does not of itself constitute such laches as should defeat a recovery. *Imperial Chemical Mfg. Co. v. Steiu, 78 O. G. 635, C. D. 1896.

92. The fact that the composition of the infringing article could not readily be determined, that its trade-name gave no indication of its composition, and that there were many other articles of the same class upon the market are to be considered in determining laches. *Id.

93. Notice of infringement was given in 1883, but suit was not begun until 1893. Even before 1883 the owners of the patent had acquiesced in its infringement. A most flagrant case of laches is presented, and the action cannot be maintained. (Cases cited.) *Richardson v. D. M. Osborne & Co., 82 Fed. Rep. 95, 80 O. G. 812, C. D. 1897.

VIII. COSTS OF.

94. In the second circuit a docket-fee of twenty dollars is not taxable for defendant when the bill is dismissed by complainant after joinder of issue on the pleadings and notice by the defendant for final hearing and a call upon the calendar. *Ryan v. Gould, 41 O. G. 1892, C. D. 1887.

95. On such dismissal the defendant cannot tax for certified copies of the file-wrapper and contents of the patent in suit or for certified copies of other patents essential to the defense. *Id.

96. Where a party to a suit incumbers the printed record with copies of some fifty imma-

terial patents, *held*, it is a proper case for the application of the tenth rule, which authorizes the court (paragraph 9) to impose costs upon the party so guilty. (*Railway Co. v. Stewart*, 95 U. S. 279, 284). **Ball and Socket Fastener Co. v. Kraetzer*, 65 O. G. 1591, C. D. 1893.

97. When it appeared that so much irrelevant testimony was introduced into the case as to make it inequitable that defendant should pay costs, *held*, that costs should not be paid by defendant in the appellate court nor costs in the circuit court which were caused by this class of evidence. **Appleton v. Ecaubert*, 71 O. G. 1617, C. D. 1895.

98. Where two patents relating to the same subject-matter were sued on in the same suit and a decree was entered for complainant on one of them and for defendant in respect to the other, the costs disbursed in regard to the patent adjudged against the complainant were not, under the circumstances, adjudged in favor of either party. **Green v. City of Lynn*, 80 O. G. 1480, C. D. 1897.

SUPPLEMENTAL BILL.

(See EQUITY — BILLS.)

SUPPLEMENTAL OATH.

(See OATH.)

SUPREME COURT OF THE UNITED STATES.

(See JURISDICTION.)

TECHNICAL TERMS.

1. The words "means," "mechanism" and "connections" are proper terms when applied to devices forming no part of the invention, but which are in common use in various kinds of machinery — for instance, when the operation of rollers is governed by gearing, belting, cranks or other appliances which in themselves are simple and have little or nothing to do with the real invention. Or, as in the present case, the term "means," when applied to the operation or shaking of certain movable screens, is proper, because evidently the same movement of the screen can be effected by an infinite variety of mechanism which would produce the

same result and be simply the equivalent of that employed by applicant. *Ex parte Stoughton*, 43 O. G. 1345, C. D. 1888.

2. The term "mechanism" is not permissible when applied to various and different devices in the several claims which are not adjunctive devices. *Ex parte Stanbridge*, 43 O. G. 1345, C. D. 1888.

3. The words "carbonaceous anode" in claim 2 cover both anodes made partly of and wholly of carbon. **Pittsburgh Reduction Co. v. Cowles Electric Smelting and Aluminum Co.*, 69 O. G. 789, C. D. 1894.

4. The word "automatically" in the patent claim is to be given its ordinary and general meaning as used in common speech. It does not apply to a case where a man of his own volition acts upon one mechanical part by means of another. **Gould Coupler Co. v. Trojan Car Coupler Co.*, 74 Fed. Rep. 794 (1896).

5. By a "detachable clip" is meant a removable clip, or one which is not positively attached by riveting or soldering. It is an attachment which accomplishes connection without creating union. **Bennett v. Schooley*, 76 O. G. 335, C. D. 1896.

TESTIMONY.

(See WITNESSES — INTERFERENCE, TESTIMONY; EQUITY, MASTER'S REPORT; EVIDENCE; INFRINGEMENT; INJUNCTION; INTERFERENCE.)

- I. IN A FOREIGN COUNTRY.
- II. IN A FOREIGN LANGUAGE.
- III. OF EXPERTS.
- IV. PRINTING.

I. IN A FOREIGN COUNTRY.

1. Testimony cannot properly be taken in foreign countries otherwise than as prescribed by rule 158 (3) unless this procedure be waived *by stipulation of the parties*. [Rule 158 (5.)] *Raffard v. De Ferranti*, 60 O. G. 439, C. D. 1892.

2. Where a party seeks to take testimony abroad under the provisions of rule 158, a mere formal allegation in his affidavit that the testimony cannot be taken in this country without "injury to the moving party greatly exceeding that to which the opposite party will be exposed by the taking of such testimony abroad" is not sufficient to satisfy the requirements of the rule in that particular. *Hall v. Latta*, 60 O. G. 736, C. D. 1892.

3. In order to constitute a proper foundation for taking testimony in a foreign country, a publication must disclose the invention in controversy and must disclose it as the invention of the party seeking to take such testimony. *Parkin and Wright v. Jenness*, 63 O. G. 759, C. D. 1893.

4. Testimony cannot be taken to prove conception, disclosure and reduction abroad, but may be to prove knowledge of introduction into this country. *Hadfield v. Washburn*, 61 MS. D., March, 1897 (Fisher, Ass't Com'r).

5. Testimony cannot be taken as to matters which took place in a foreign country tending to prove priority; but the question of originality stands on a different footing. (*Parkin and Wright v. Jenness*, 63 O. G. 759.) *Shiels v. Lawrence and Kennedy*, 81 O. G. 2085, C. D. 1897.

6. Although a party may not be able to prove priority of invention in this country by reason of the fact, appearing from his preliminary statement that he was not the first to introduce the invention into this country, *held*, that he may nevertheless establish that his opponent is not entitled to an award of priority by proving that such opponent is not an original inventor, but received a disclosure of it from him. *Id.*

7. Judgment of priority may properly be rendered on the record under these circumstances; but where afterward a reasonable suggestion is made that the successful party received a disclosure of the invention from his opponent, *held*, that the judgment should be vacated as to matters relating to originality and times set for taking testimony on this question. *Id.*

II. IN A FOREIGN LANGUAGE.

8. Testimony given by a witness in a foreign language, and translated into English by an interpreter who was not sworn, *held* admissible. When a commissioner understands the language of a witness who cannot speak English, he may translate the witness' answers and write them down. (Authorities cited.) *Rothe v. Meyer, v. Foulds*, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

III. OF EXPERTS.

9. Where expert testimony does not seem necessary to the court, it can proceed to determine the question of infringement without its aid. **Sugar Apparatus Mfg. Co. v. Yaryan Mfg. Co.*, 53 O. G. 920, C. D. 1890.

10. Where in a suit for infringement it appeared that one of the defendants, who was conversant with the art, had made application for a patent for evaporating apparatus, which was rejected on said patent in suit, and thereupon amended his application to avoid said patent, *held*, that his admissions in the patent office should be regarded as the expressions of a competent expert and as evidence in support of the validity of the patent in suit. **Id.*

11. On a suit for infringement of letters patent, where complainant calls an expert witness to point out resemblances between the patent and the alleged infringing device, and asks him to interpret the claims of the patent in so doing, he cannot be required to refrain from considering the prior state of the art in giving his testimony. **American Linoleum Mfg. Co. v. Nairn Linoleum Co.*, 55 O. G. 142, C. D. 1891.

12. Persons skilled in the art to which the specification is addressed are those of ordinary and fair information, but not those having very great technical knowledge relating to the subject-matter of the invention. **Tannage Patent Co. v. Zahn*, 71 O. G. 1161, C. D. 1895.

13. The testimony of a witness can be taken abroad, as an expert, only in very unusual cases, in which the most satisfactory and convincing showing has been made, and in which it also appears that no competent expert can be gotten in this country. *McDonough v. Joly*, 61 MS. D., April, 1897 (Fisher, Ass't Com'r).

IV. PRINTING.

14. Rule 162, requiring printed copies of the testimony to be furnished to the office and opposing parties, *held* to be of binding authority. *Plummer v. Penniston*, 67 O. G. 928, C. D. 1894.

TRADE-MARKS.

- I. ALTERNATIVES.
- II. ANTICIPATION.
- III. ARBITRARY.
- IV. ARBITRARY — DESCRIPTIVE.
- V. ASSIGNMENT.
- VI. CLASS OF GOODS.
- VII. COATS OF ARMS, SOCIETY EMBLEMS AND SYMBOLS.
- VIII. DESCRIPTIVE.
- IX. DIVISION OF APPLICATION.
- X. DRAWINGS OR FAC-SIMILES.
- XI. EQUITY.
- XII. ESSENTIAL FEATURES.

- XIII. EVIDENCE.
- XIV. FEES.
- XV. FEE, REFUNDMENT OF.
- XVI. FIRM NAME.
- XVII. FOREIGN COMMERCE.
- XVIII. FOREIGN WORDS.
- XIX. FRAUD.
- XX. GEOGRAPHICAL NAMES INDICATING MERELY LOCALITY.
- XXI. GEOGRAPHICAL NAMES USED ARBITRARILY OR FANCIFULLY.
- XXII. GOOD WILL.
- XXIII. INFRINGEMENT.
 - (a) *In General.*
 - (b) *Particular Cases.*
- XXIV. INJUNCTION.
- XXV. INTERFERENCE.
- XXVI. JURISDICTION OF COURT.
- XXVII. MANDAMUS.
- XXVIII. PARTIES TO SUIT.
- XXIX. PARTNERSHIP.
- XXX. PRACTICE IN PATENT OFFICE.
- XXXI. REGISTRATION.
 - (a) *In General.*
 - (b) *Particular Cases.*
- XXXII. RIGHT TO USE NAME OF PATENTED ARTICLES.
- XXXIII. RIGHT TO USE PERSONAL NAME.
- XXXIV. STATUTE.
- XXXV. TREATY.
- XXXVI. USE AND SALE AS ESTABLISHING TITLE.
- XXXVII. WHAT CONSTITUTES.
- XXXVIII. WITNESSES.

I. ALTERNATIVES (OR EQUIVALENTS).

1. A trade-mark must be definitely described in the statement and the essentials given. Symbols that are not alternatives in fact cannot be allowed registration. The letters "O C" and "O A" and "O E C" for copper ingots cannot be registered for alternative use. *Ex parte Orford Copper Co.*, 36 MS. D., March, 1888 (Hall, Com'r).

2. The word "Crucible" and the representation of a crucible, *held* not true alternatives. *Ex parte The Iowa Farming Tool Co.*, 51 MS. D., Aug., 1892 (Frothingham, Acting Com'r).

3. The word "Phoenix" and the representation of a phoenix, as a trade-mark for caudles, etc., refused on the ground that they are not true alternatives. *Ex parte Phoenix Candle Co.*, 53 MS. D., Aug., 1893 (Fisher, Acting Com'r).

4. The words "White Lily" and the repre-

sentation of a white lily, as a trade-mark for gin, *held* not registrable because not true alternatives. *Ex parte Richards & Sons*, 54 MS. D., May 18, 1894 (Fisher, Ass't Com'r).

5. The symbol eagle and word "Eagle," for slates, allowed registration as alternatives. *Ex parte Pritchard*, 57 MS. D., Aug., 1895 (Fisher, Acting Com'r).

6. The word "Squirrel" and figure of a squirrel, for ammunition, *held* not true alternatives. *Ex parte Fowler*, 59 MS. D., June, 1896 (Fisher, Acting Com'r).

7. The word "Star" and the symbol of a star adopted and used during many years by manufacturers of shirts, waists, underwear and furnishing goods to mark and designate their goods, in combination with the words "Star Shirts" and other words describing the articles, so that the goods become well known by such mark and by the designation of "Star Goods," constitute a valid trade-mark. **Hutchinson v. Blumberg*, 61 O. G. 1017, C. D. 1892.

(The words "The Star Shirt" and the figure of a star were registered and used as alternative marks (for shirts), and so regarded by the court in *Morrison v. Case*, 2 O. G. 544, C. D. 1872.

See decision in **Hutchinson v. Covert*, 50 Fed. Rep. 832.)

8. The application was for registration of the word "Squirrel" and the representation of a squirrel. A word and a picture which are true alternatives and invariably express the same idea may be covered by one trade-mark registration; but the rule will not cover the case of a word and a picture capable of such a variety of modifications that two of them might appear as substantially different things to an ordinary purchaser. *Ex parte Adam Roth Grocery Co.*, 62 O. G. 315, C. D. 1893.

9. The word "Crescent" and the representation of a crescent-shaped figure refused registration on the ground that they are not true alternatives. *Ex parte Lazarus, Schwarz and Lipper*, 64 O. G. 1396, C. D. 1893.

10. The representation of a rosebud and the word "Rosebud" are registrable in one application, it appearing that the trade-mark is a lawful common-law mark and the prescribed statutory requisites are present. *Ex parte Kinney*, 72 O. G. 1349, C. D. 1895.

11. The figure of Columbia cannot be regarded as more than a mere amplification of the word "Columbia" which had been previously appropriated. It conveys no further or other idea than the word and can be regarded

only as a different way of expressing it. *Morgan Envelope Co. v. Walton, 81 O. G. 1615, C. D. 1897.

12. The red cross speaks to the eye, and the article becoming known by that designation speaks also by that name to the ear. (Cases cited.) *Johnson & Johnson v. Bauer & Black, 82 Fed. Rep. 662 (1897). (Reverses former decision.)

II. ANTICIPATION.

(See CLASS OF GOODS—REGISTRATION.)

13. The word "Magnolia" and the representation of the flower of that name, for flour, refused on registered mark "Magnolia Mills" in connection with the flower. Ex parte Camp, 35 MS. D., Sept., 1887 (Vance, Acting Com'r).

14. The words "Rough on Dinner," for "Medicinal Bitters," held anticipated by registered mark "Rough on," for proprietary remedies and compounds. Ex parte Knight, 38 MS. D., Oct., 1888 (Hall, Com'r).

15. The letter "G" with the word "Anti" printed upon it is anticipated by the same letter bearing the word "Big." Ex parte Klyce, 40 MS. D., May, 1889 (Fisher, Ass't Com'r).

16. "Royal," for chocolate, held anticipated by "Royal Dutch," previously registered. Ex parte Hillyard, 41 MS. D., Nov., 1889 (Fisher, Ass't Com'r).

17. "Medical Lake Salt," held substantially the same as the trade-mark "Medical Lake," to which another party had a prior right. Ex parte Hall, 48 MS. D. (3 G. W. D.), Nov., 1891 (Frothingham, Ass't Com'r).

18. Registration of the words "White Lillie" refused in view of registration of the same words under the act of 1870, no abandonment having been proved. Ex parte Empire Mill Co., 49 MS. D. (3 G. W. D.), Dec., 1891 (Frothingham, Ass't Com'r).

19. After the registration of a trade-mark for an article a second trade-mark should not be registered for merchandise of substantially the same descriptive properties. Ex parte Kyle & Co., 57 O. G. 274, C. D. 1891.

20. The pictorial representation of a beaver, for "mixed paints and roofing composition," is anticipated by the same mark registered for "roofing composition or materials." Ex parte Beaver Mfg. Co., 50 MS. D., June, 1892 (Frothingham, Ass't Com'r).

21. Registration of the word "Yucca," ar-

anged over a representation of the Yucca plant—for soap—refused in view of registered mark consisting of a representation of the same plant. Ex parte Bogardus, 50 MS. D., March, 1892 (Frothingham, Ass't Com'r).

22. The question presented in a case of alleged anticipation is whether the trade-mark sought to be registered is so similar to any mark already registered for use on the same class of articles as to be calculated to work deception upon a purchaser using ordinary caution. (See Ex parte Coon, 58 O. G. 946; McLean v. Fleming, 13 O. G. 913.) Ex parte George B. Hurd, 59 O. G. 1763, C. D. 1892.

23. "Splendid" held anticipated by "Esplendido," already registered for the same goods (flour); also, descriptive. Ex parte Stokes, 52 MS. D., June, 1893 (Fisher, Ass't Com'r).

24. The words "Monarch Distilling Co.," enclosed between "concentric circles of broken lines and surrounded by a circle of radiating scrolls," held anticipated by the registered mark "M. V. Monarch." Ex parte Corning & Co., 53 MS. D., Sept., 1893 (Fisher, Acting Com'r).

25. Application for the registration of the word "M. V. Monarch" refused on a prior trade-mark, "Monarch Distilling Co.," used upon the same class of merchandise. Ex parte Corning & Co., 65 O. G. 751, C. D. 1893.

26. The representation of the human eye and the letter "C," as a trade-mark for optical goods, held anticipated by the previously registered mark composed of the letters "I," "C." Ex parte Short, Nerney & Co., 54 MS. D., May, 1894 (Fisher, Ass't Com'r).

27. "Antalgia," as a trade-mark for medicines, anticipated by "Antialgia." Ex parte Heyer, 54 MS. D., April, 1894 (Fisher, Ass't Com'r).

28. The word "Capitol," and the words "Capital Coffee" with a group of flags before and after the latter, held to be essentially the same mark. Dissolution of interference denied. Lown v. The Ohio Coffee & Spice Co., 57 MS. D., Aug., 1895 (Fisher, Acting Com'r).

29. "Queen Bess," for flour, held anticipated by "Queen Bee." Ex parte Blanton Milling Co., 57 MS. D., Aug., 1895 (Fisher, Acting Com'r).

30. The head of an Indian and the words "North America" refused registration on the ground that the words are geographical, and the head had been anticipated. Ex parte Spencer, 57 MS. D., Sept., 1895 (Fisher, Acting Com'r).

31. A representation of a right hand in horizontal position, as a trade-mark for foot-wear, *held* anticipated by the representation of a left-hand in the vertical position. Ex parte Foot, Schulze & Co., 58 MS. D., Jan., 1896 (Fisher, Ass't Com'r).

32. "Gold Leaf," as a trade-mark for baking powder, anticipated by the words "Silver Leaf," and a picture of a leaf used for the same class of goods. Ex parte Gold Leaf Baking Powder Co., 58 MS. D., Jan., 1896 (Fisher, Ass't Com'r).

33. Registration of a star, for safety razors, refused in view of registration of the same mark in 1876 for cutlery, and lack of proof that such razors were not then and are not still manufactured and sold. Ex parte Kampf, 58 MS. D., 306, Feb., 1896 (Fisher, Ass't Com'r).

34. "Emmet's Faultless," *held* anticipated by "Emmet's Professional," for mouth harmonicas. Ex parte Strauss, Sachs & Co., 58 MS. D., Feb., 1896 (Fisher, Ass't Com'r).

35. "Black diamond," as a trade-mark for blasting powder, *held* not registrable, because "Black" is descriptive and "Diamond" was already registered. Ex parte The New York Powder Co., 59 MS. D., June, 1896 (Fisher, Acting Com'r).

36. Registration of two circles or rings inclosing full-face bust portraits of the registrants (with other adjuncts), refused, on reference to registered mark of Smith Bros., No. 20,907. Ex parte Smith & Son, 59 MS. D., July, 1896 (Fisher, Acting Com'r).

37. "Armor clad," for leather shoes, refused registration in view of "Iron clad" previously used. Ex parte Cammeyer, 60 MS. D., 454, Jan., 1897 (Fisher, Ass't Com'r).

38. Registration of the word "Crown" and figure of a crown refused in view of a reference consisting of a garter of an oval form with a crown in the upper or center portion, since the crown in the reference could not be regarded as the non-salient feature. Ex parte Christine Baumert, 62 MS. D., July, 1897 (Greeley, Ass't Com'r).

39. The cheese to which the mark is applied would probably be known to the ordinary class of purchasers as the "crown brand." The crown is prominent, also claimed as an essential feature. *Id.*

40. "Brilhante," for flour, *held* anticipated by "Brilliant," previously registered. Ex parte Lindsay, 60 MS. D., Sept., 1897 (Fisher, Acting Com'r).

III. ARBITRARY.

41. A glove and the letters K. L. printed thereon, between which letters is arranged a circle exterior to a triangle, inclosing the word "of," *held* to be registrable, since the letters had no absolute or invariable significance, and the other elements had a due share of importance. Ex parte Turner, 34 MS. D., July, 1887 (Hall, Com'r).

42. The pictorial representation of "St. Nicholas" for tobacco, *held* registrable, although the words "St. Nicholas" had been registered. Ex parte The Pemberton & Hill Tobacco Mfg. Co., 36 MS. D., Dec., 1887 (Vance, Ass't Com'r).

43. The words "Jefferson Club" and a medallion picture of Thomas Jefferson, for liquors, *held* not anticipated by the registered mark "Jefferson Pure Old Rye Whiskey." Ex parte Magruder, 37 MS. D., July, 1888 (Hall, Com'r).

44. A heraldic eagle on a quadrilateral field and having on its breast an oblong figure bearing the word "Von Graef," for a cough remedy, *held* not anticipated by a fanciful crowned eagle and the words "Dr. Aug. Keyser's Celebrated German Elixir." Ex parte Jones, 38 MS. D., Aug., 1888 (Hall, Com'r).

45. "Kelphaline," for a remedy for neuralgia and headache, allowed registration over "Cephaline." Ex parte Daldwin, 38 MS. D., Oct., 1888 (Hall, Com'r).

46. A mark consisting of a block of compressed meat resting upon a plate, *held* not anticipated by a registered mark consisting of a block of meat having several slices cut off from it and resting on a plate together with a knife and fork, an empty can and a filled can, all placed upon a table. Ex parte Armour Packing Co., 40 MS. D., May, 1889 (Fisher, Ass't Com'r).

47. A representation of a wagon-brake lock attached to a panel of a wagon-body, and a whip-socket and whip therein, *held* registrable for a wagon-brake lock. Ex parte Hurlburt Mfg. Co., 41 MS. D., Nov., 1889 (Mitchell, Com'r).

48. "Silk," as a trade-mark for soap and soap powders, may be registered. Ex parte Ross, 44 MS. D. (2 G. W. D.), July, 1890 (Fisher, Acting Com'r).

49. The word "Hygieniques" as applied to suspenders, *held* to be a valid trade-mark. †Bailey v. Nashawannuck Mfg. Co., 51 O. G. 970, C. D. 1890.

50. The words "Warren Hose-Supporter"

in connection with the cut of a hose-supporter engaged with a stocking, *held* to be a valid trade-mark. *Frost v. Rindskopf, 51 O. G. 1131, C. D. 1890.

51. The word "Cream" in connection with the words "Baking Powder," *held* a valid trade-mark. Price Baking Powder v. Fyfe, 45 Fed. Rep. 799 (1891).

52. The word "Magico" *held* not anticipated by the word "Magic" already registered for use on a similar class of goods. Ex parte American Chemical Co., 62 O. G. 588, C. D. 1893.

53. The combined words "Fibre Chamois," as applied to a fabric used as an interlining for women's dresses, *held* to have a significance as an arbitrary mark and name, whereby the goods made by complainant are identified and distinguished in the trade as carried on. *American Fibre Chamois Co. v. De Lee & Dernberg, 71 O. G. 1458, C. D. 1895.

54. "A series of stripes having contrasting colors," applied to wheel tires, *held* sufficiently definite to be registered. Ex parte Humber & Co., America, Limited, 59 MS. D., June, 1896 (Fisher, Acting Com'r).

55. "Imperceptible," for a starch, *held* not descriptive. Ex parte Durkee & Co., 62 MS. D., July, 1897 (Greeley, Ass't Com'r).

56. Registration of the British pound mark, accompanied by the word "Sterling," allowed, although the latter had been previously used, it appearing the pound mark was the most prominent feature and would attract the attention of the ordinary purchaser. Ex parte Hall, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

IV. ARBITRARY — DESCRIPTIVE.

57. "Honey," for a vermifuge, was declared by the examiner to be a well-known vehicle for medicines which the public have a right to use; but decision was reversed. Ex parte Mansfield & Co., 35 MS. D., Oct., 1887 (Vance, Ass't Com'r).

58. *Held*, that the word "Lightning" is not merely descriptive of the quality or characteristic of a knife to which it was applied. *Hiram Holt Co. v. Wadsworth, 41 Fed. Rep. 34, C. D. 1889.

59. "Handy," as applied to a vehicle, *held* not equivalent to "convenient" and hence not merely descriptive. Ex parte Bradley & Co., 41 MS. D., Aug., 1889 (Fisher, Acting Com'r).

60. "Ginger Champagne" *held* registrable for carbonated mineral water and ginger,

"upon the benefit of a doubt." Ex parte Manitou Mineral Water Co., 44 MS. D., 2 G. W. D., Sept., 1890 (Mitchell, Com'r).

61. The words "Cough Cherries," as applied to a confection, are not descriptive of the qualities of the article, but are sufficiently arbitrary and fanciful to be appropriated as a trade-mark. *Stoughton v. Woodard, 50 O. G. 1297, C. D. 1890.

62. "O. K.," applied to root-beer, deemed "sufficiently arbitrary and fanciful" to warrant registration. Ex parte Heinle & Co., 57 MS. D., Sept., 1895 (Fisher, Acting Com'r).

63. "Better than Best," as a trade-mark for flour, *held* to be but partially descriptive, and sufficiently fanciful and arbitrary to be registrable. Ex parte Smith, 58 MS. D., Dec., 1895 (Fisher, Ass't Com'r).

64. The word "Royal" as a trade-mark for a baking powder is not descriptive of the latter. As conveying the idea of comparative excellence, it does so only through a metaphor which is in a high degree fanciful and remote. *Royal Baking Powder Co. v. Raymond, 70 Fed. Rep. 376 (1895).

65. The name "Momaja" is suggestive of a composition of Mocha, Maracaibo, and Java coffees, but is not sufficiently descriptive to invalidate it as a trade-mark. *American Grocery Co. v. Bennett, Sloan & Co., 71 O. G. 1770, C. D. 1895.

66. "Club Cocktails" allowed registration for spirituous beverages. Ex parte Heublein & Bro., 59 MS. D., May, 1896 (Seymour, Com'r).

67. If a word is merely suggestive or is figurative only it may be a good trade-mark, notwithstanding it is also indirectly or remotely descriptive. *Bennett v. McKinley, 65 Fed. Rep. 505 (1894).

68. The word "Kaiser" *held* not descriptive but a valid trade-mark. *J. M. P. Baltz Brewing Co. v. Kaiser Brauerie, Beck & Co., 74 Fed. Rep. 222 (1896).

69. "Cream of Wheat," applied to "breakfast foods," *held* registrable over the same words applied to flour, and also fanciful rather than necessarily descriptive. (Practically reversing decision in North Dakota Mills Co., 58 MS. D. 176.) Ex parte Cream of Wheat Co., 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

70. The word "Saponifier" *held* not descriptive, although its Latin derivation is suggestive. To the uneducated part of the community it would have no especial signification. Even if it suggested the ordinary chemical action of lye upon grease, such suggestiveness would not

be fatal. (Quoting "The Cottolene" Case, *Fairbanks v. Central Lard Co.*, 64 Fed. Rep. 133.)
**Pennsylvania Salt Mfg. Co. v. Myers*, 79 Fed. Rep. 87 (1897).

(This case also involved fraudulent use of the mark.)

V. ASSIGNMENT.

(See GOOD WILL.)

71. It is well established that a person may associate his own name as a trade-mark with an article of trade manufactured by himself, and so transfer the business of manufacturing said article and using his name thereon as to deprive himself of the right thereafter to use his own name upon such articles. *Richmond v. The Dr. S. A. Richmond Nervine Co.*, 52 O. G. 307, C. D. 1890.

72. The right of the owner of a trade-mark to assign the same to a partner or to a successor in business as an incident to its good will, affirmed. **Brown Chemical Co. v. Meyer*, 55 O. G. 287, C. D. 1891.

73. Where one who claims to have invented or discovered a new means for treating disease transfers for a consideration all his rights therein to a corporation and afterwards acquiesces in the use of a certain trade-mark thereon by the corporation, *held*, in a subsequent contest between himself and the corporation over title to the trade-mark, that an absolute right is vested in the corporation. *Sanche v. Electrolibration Co.*, 60 O. G. 1189, C. D. 1892.

74. Where parties entered into an agreement defining the right of each to use a trade-mark, such an agreement is not an attempt to transfer or license the use of a trade-mark, or any rights therein, or in any word thereof, but fixes and defines the existing trade-mark of each party to the agreement, and is not required to be recorded in the patent office under section 12 of the trade-mark act of 1881. **Waukesha Hygeia Mineral Springs Co. v. Hygeia Sparkling Distilled Water Co.*, 70 O. G. 1319, C. D. 1895.

(A trade-mark requires to be inventoried to pass in a general assignment in insolvency. **Bradley v. Norton*, *Cox's American Trade-mark Cases*, 333.)

VI. CLASS OF GOODS.

(See ANTICIPATION.)

75. The representation of a "Star" as a trade-mark for safety razors, *held* anticipated by the same mark used for cutlery in general. *Ex parte Kampfe Bros.*, 58 MS. D., Feb., 1896 (*Fisher, Ass't Com'r*).

76. "Hopkins" (with certain minor accessories), applied to canned hulled corn or steamed hominy, *held* not anticipated by the same word registered for flour. *Ex parte The Western New York Preserving and Mfg. Co.*, 59 MS. D., June, 1896 (*Fisher, Acting Com'r*).

77. The word "Diamond" applied to a dry paste and the same word to a semi-liquid mucilage, *held* same class of goods. *Diamond Ink Co. v. Day*, 60 MS. D., Oct., 1896 (*Fisher, Ass't Com'r*).

78. "Electric Light" for flour, and the same words for flour sacks, *held* not properly in interference, because not applied to similar goods. *Arkell and Smith v. Kirby, v. McLaughlin & Co., v. Johnston*, 60 MS. D., Oct., 1896 (*Fisher, Acting Com'r*).

79. "Kangaroo," for rubber tubing and tires, not barred by prior registration of the same word for velocipedes. *Ex parte Consolidated Rubber Works*, 62 MS. D., Oct., 1897 (*Greeley, Acting Com'r*).

80. "Cream of Wheat" applied to "breakfast foods," *held* registrable over the same words applied to flour. *Ex parte Cream of Wheat Co.*, 62 MS. D., Oct., 1897 (*Greeley, Ass't Com'r*).

VII. COATS OF ARMS, SOCIETY EMBLEMS AND SYMBOLS.

81. A trade-mark adopted by a manufacturer or dealer in distilled spirits at Milwaukee, Wisconsin, in commerce with Germany, which contains the legends "Knights of Labor Whiskey" and "K. of L. Distillery, Sour Mash," and which clearly and distinctly refers the origin and ownership of the spirits so marked to the Knights of Labor of the United States, so that the public would be induced to purchase under the belief that they were manufactured by or under the auspices of that association, and therefore possessed the excellence or superior qualities usually characterizing the productions or workmanship of artisans, workmen, etc., belonging to that association, and also from sympathy with its sentiments and principles, is fraudulent and unlawful, and must be denied registry. *Ex parte M. Bloch & Co.*, 40 O. G. 443, C. D. 1887.

82. A trade-mark, for writing paper, composed of the badge of the Grand Army of the Republic (the letters G. A. R. being a watermark), allowed registration upon the "benefit of a doubt." *Ex parte King*, 39 MS. D., Dec., 1888 (*Hall, Com'r*).

83. A red Greek cross with or without the words "Red Cross," held not registrable, irrespective of the question whether the Red Cross Society had registered the same matter, since it seems to indicate the goods are produced by such society. *Ex parte Candy*, 40 MS. D., Aug., 1889 (Mitchell, Com'r).

84. Applicant presented for registration as a trade-mark an exact representation of the well-known badge of the Grand Army of the Republic, which he proposed to use as a water-mark on writing paper. The fact that the Grand Army of the Republic have adopted a certain design for their badge, or for the letter-head of writing paper used by them, does not secure to such organization such exclusive property in the particular representation as would deprive an applicant who has complied with all the requirements of the statute of his right to register the same as a trade-mark. It is well settled that emblems which have been used by societies possess no sanctity or sacredness which precludes their being used and applied as trade-marks. *Ex parte King*, 46 O. G. 119, C. D. 1889.

85. The objection of the examiner that the trade-mark embellishes the paper is not approved. It may be said that scarcely any trade-mark can be applied to paper without incidentally embellishing it. If the design is a legitimate subject of a trade-mark and is not prohibited by law, the fact that it incidentally embellishes the page on which it appears cannot deprive it of its lawful quality as a trade-mark. *Id.*

86. The fact that the Grand Army of the Republic have previously obtained a design patent for this representation, the term of which has expired, does not constitute a legitimate bar to the employment of this design as a trade-mark in commerce with foreign nations. The mere fact that the organization originated the design would make no difference whatever if the design has been donated to the world to be used in all the ways of which it is capable. The Grand Army of the Republic retained no proprietary right after the term of their design patent expired. There is no property in the design itself vested in any one. Any person may apply the design as a trade-mark to a certain class of merchandise, and when thus applied it acquires the quality of property and becomes vested in him who first makes such new and distinct application of the design, and registration will be granted, provided the applicant has complied with all the

requirements of the statute and the mark is used in commerce with foreign nations. *Id.*

87. The patent office has not the means to investigate the question whether the applicant in the present case is simply seeking to obtain the guise of security round his trade-mark, when he really means to use it as an attractive embellishment for a particular class of persons in this country. The office is bound by the oath of the applicant, and such a question as the above must be settled by the courts. *Id.*

("Square and Compass"—a Masonic emblem—refused registration. *Ex parte Tolle*, 2 O. G. 415, C. D. 1872 (Thacher, Acting Com'r). The word "Masonic" held not registrable. *Ex parte Smith*, 16 O. G. 764, C. D. 1879 (Payne, Com'r). *Contra*, *Ex parte Thomas*, 14 O. G. 821, C. D. 1878, Doolittle, Acting Com'r).

88. Registration of a trade-mark consisting, essentially, of "the red cross on black ground in a diamond-shaped border and accompanied by the words 'Red Cross,'" for a medical compound, refused. *Ex parte Chichester Chemical Co.*, 52 O. G. 1061, C. D. 1890.

89. Such a trade-mark would naturally lead the purchaser to suppose that he was purchasing an article which, if not manufactured by the well-known Red Cross Society, had at least its sanction or indorsement. *Id.*

90. A label adopted by the International Cigar-Makers' Union, to be pasted on boxes containing cigars made by members, is not a legal trade-mark, it not indicating by what persons the cigars are made, but only that they are made by members of one of the local unions, the right to use it belonging equally to all members and continuing only while they are members. †*Weener v. Brayton*, 53 O. G. 275, C. D. 1890.

91. An injunction against the wrongful use of such label cannot be granted on the ground of special injury to plaintiffs, who are officers and members of the union, but are not manufacturers of or dealers in the cigars on which such label is used. †*Id.*

92. The seal of Minnesota with the title "Seal of Minnesota," refused registration, upon the broad ground that it is against public policy to register coats of arms of states. (*Schmachtenberg Bros.*, 51 MS. D. 204.) *Ex parte New Prague Flouring Mill Co.*, 62 MS. D., Oct., 1897 (Greeley, Ass't Com'r).

93. The members of an association may adopt and use a trade-mark to indicate that the goods on which it is placed are manufactured or sold by some member of the association, in which case the trade-mark indicates a class of persons

or firms rather than any single one. †Gravel Roofers' Exchange v. Turnbull, 64 O. G. 441, C. D. 1893.

94. The symbol, a red Greek cross, cannot be registered as a trade-mark for medicinal bitters. Ex parte Zwack & Co., 76 O. G. 1855, C. D. 1896.

95. There is no real conflict between the decisions in the cases of Ex parte Chichester Chemical Co. (52 O. G. 1061) and Ex parte Candy (40 MS. D. 474) and the decisions in the cases of Ex parte King (46 O. G. 119) and Ex parte Turner (34 MS. D. 469). Id.

96. Authority conceded by the Red Cross Society in foreign country to applicant to use as a trade-mark the symbol "Red Greek Cross" does not extend beyond the boundaries of that country. Id.

97. As the International Union has not the force or effect of law in this country, applicant cannot claim, under article VI thereof, the privilege of registering in this country an unlawful mark. Id.

VIII. DESCRIPTIVE.

98. The capital letters "LL" held not to be a valid trade-mark for cotton sheetings in view of the facts that they were well known in the trade to indicate a class or grade and had been previously used by others on cotton sheetings similar to those of the plaintiff. *Lawrence Mfg. Co. v. Tennessee Mfg. Co., 31 Fed. Rep. 776 (1887).

99. The word "Kaiser" is a name given to a number of mineral springs in different places in Europe long before its adoption by complainants. Their selection of it as a trade-mark for natural mineral waters is open to the objection that it was already descriptive of similar products, which others had a prior right to sell by the same name. *Luyties v. Hollender, 40 O. G. 119, C. D. 1887.

100. As against the complainants, it is legitimate for the owners of any of the "Kaiserquelle" waters of Europe to sell them in this country by the name of "Kaiser Spring" waters, or to sell them anywhere by a name which in any language would signify to a purchaser the true name of the article and its origin and ownership. *Id.

101. The words "Best Six Cord" are merely descriptive of quality, and the figures merely denote the size of the thread, and they could not be appropriated by the plaintiffs. *J. & P.

Coats v. Merrick Thread Co., 45 O. G. 347, C. D. 1888.

102. The proper designation of an article cannot be appropriated as a trade-mark. *Colgan v. Danheiser, 35 Fed. Rep. 150 (1888).

103. The words "Taffy Tolu" held to be descriptive and hence incapable of exclusive appropriation. *Id.

104. The words "Iron Bitters" for bitters, held indicative of the composition of the article. (*Chemical Co. v. Myer, 31 Fed. Rep. 453.) *Brown Chemical Co. v. Frederick Stearns & Co., 37 Fed. Rep. 360 (1889).

105. "Acid Phosphate" held to be descriptive, and hence not capable of exclusive appropriation as a trade-mark for a preparation used as a medicine, condiment or beverage. *Rumford Chemical Works v. Muth, 35 Fed. Rep. 524 (1888).

106. The true test is whether the words as commonly used by those who understand their meaning are reasonably indicative and descriptive of the thing intended. If they are, they cannot become the exclusive property of any one. *Id.

107. The words "Indurated Fibre" held to be descriptive of the quality, ingredients or characteristics of the manufactured article. *Indurated Fibre Co. v. Amoskeag Indurated Fibre Ware Co., 37 Fed. Rep. 695 (1889).

108. The name "Goodyear Rubber Company" is not one capable of exclusive appropriation as a trade-mark. "Goodyear Rubber" are terms descriptive of well-known classes of goods produced by the process known as Goodyear's invention. Names which are thus descriptive of a class of goods cannot be adopted as trade-marks and be thereby appropriated to the exclusive right of any one. *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co., 46 O. G. 122, C. D. 1889.

109. The word "Sleuth," being a word having a place and meaning in the language, cannot be appropriated as a trade-mark for a book or periodical. †Munro v. Beadle, 46 O. G. 448, C. D. 1889.

110. "Tablet" denied registration as descriptive for snuff compressed into tablets. Ex parte Reed, 44 MS. D., 2 G. W. D., Sept., 1890 (Mitchell, Com'r).

111. Complainants have no trade-mark in the word "Tycoon," as applied to a certain kind of tea, it appearing that the word was in common and general use, as descriptive of a certain class of teas, for many years before

complainants' adoption of it. *Corbin v. Gould, 51 O. G. 622, C. D. 1890.

112. The word "Elastic" as applied to suspenders *held* to be descriptive in the ordinary sense. †Bailly v. Nashawannuck Mfg. Co., 51 O. G. 970, C. D. 1890.

113. Words which are but inferentially or remotely descriptive, indicating neither origin nor ownership, but merely some special quality or peculiarity of the article itself, may properly be regarded as fanciful or arbitrary in the legal sense. †*Id.*

114. The words "Headache Capsules," applied to a medicine for curing headaches, refused registration as being descriptive. Ex parte Lichty, 46 MS. D., May, 1891 (Mitchell, Com'r).

115. The words "Cramp Cure," used as a trade-mark for a medicine for the cure of cramps, are descriptive of the nature and qualities of the medicine, and cannot be exclusively appropriated. *L. H. Harris Drug Co. v. Stucky, 46 Fed. Rep. 624 (1891).

116. Registration of "Nerve Food" refused because descriptive, and also because used by others at a prior date. Ex parte Robertson, 49 MS. D. (3 G. W. D.), Dec., 1891 (Frothingham, Ass't Com'r).

117. An exclusive right cannot be acquired to the use of words, letters or symbols to indicate merely the quality of the goods to which they are attached. *Lawrence Mfg. Co. v. Tennessee Mfg. Co., 55 O. G. 1528, C. D. 1891.

118. While, if the primary object of the mark be to indicate origin or ownership, the mere fact that the article has obtained such a wide sale that it has also become indicative of quality is not of itself sufficient to debar the owner from protection, and make it the common property of the trade, yet, if the device or symbol was not adopted for the purpose of indicating origin, manufacture or ownership, but was placed upon the article to denote class, grade, style or quality, it cannot be upheld technically as to a trade-mark. **Id.*

119. It is well established that words which are merely descriptive of the character, qualities or composition of an article, or of the place where it is manufactured or produced, cannot be monopolized as a trade-mark. *Brown Chemical Co. v. Meyer, 55 O. G. 287, C. D. 1891.

120. "Tamarac Balsam," for medicines, *held* descriptive or deceptive. Ex parte Johnson, 51 MS. D., Aug., 1892 (Frothingham, Acting Com'r).

121. The word "Famous" is merely descriptive in its nature and not registrable as a trade-mark. Ex parte Brand Stove Co., Limited, 62 O. G. 588, C. D. 1892.

122. "Splendid" *held* descriptive, and also anticipated by "Esplendido," already registered for the same goods (flour). Ex parte Stokes, 64 O. G. 437, C. D. 1893.

123. "Silver Finish," for wire netting and cloth, *held* descriptive. Ex parte Clinton Wire Cloth Co., 52 MS. D., April, 1893 (Frothingham, Ass't Com'r).

124. "Zylonite" or "Xylonite," as a trade-mark for pyroxyline compounds, *held* to have been used descriptively. Ex parte The Celluloid Co., 52 MS. D., June, 1893 (Fisher, Acting Com'r).

125. "The Favorite," as a trade-mark for toilet boxes, *held* a "qualifying term," therefore not registrable. Ex parte Pattberg & Bros., 53 MS. D., Aug., 1893 (Fisher, Ass't Com'r).

126. "Surefit," as a trade-mark for garment patterns, *held* essentially descriptive. Ex parte Christiansen, 53 MS. D., Dec., 1893 (Fisher, Acting Com'r).

127. Generally any words, marks or symbols may be adopted as a trade-mark which are indicative of the origin or ownership of the manufactured article, but those used simply to describe the quality, kind or nature of the article cannot be so appropriated. *Improved Fig Syrup Co. v. California Fig Syrup Co., 64 O. G. 158, C. D. 1893.

128. Words in common use, with some exceptions, may be adopted, if, at the time of their adoption, they were not employed to designate the same or like articles of production. (*Canal Co. v. Clark, 13 Wall. 322 — supreme court decision.) **Id.*

129. "Standard," as a trade-mark for desks, *held* descriptive. Ex parte Standard Furniture Co., 54 MS. D., Jan., 1894 (Fisher, Ass't Com'r).

130. "Peerless," as a trade-mark for tea, *held* descriptive. Ex parte Butler, 54 MS. D., Feb., 1894 (Fisher, Ass't Com'r).

131. Descriptive words like "Cough Syrup" cannot be appropriated as trade-marks. *Meyer v. Dr. B. L. Bull's Vegetable Medicine Co., 66 O. G. 1755, C. D. 1894.

132. Numerals used by a medicine company to identify specific remedies for various ailments are in effect descriptive terms, and their use will not be protected as a trade-mark.

*Humphrey's Homeopathic Medicine Co. v. Hilton, 67 O. G. 1193, C. D. 1894.

133. It may be that numerals, which are arbitrarily selected, without any purpose of identifying the article to which they are affixed from other articles of a similar class, may become the subject of a trade-mark; but the use of numerals as a short method of identifying the several members of a class and distinguishing one of them from another is old. *Id.

134. "Bromo-Quinine" is a compound word descriptive of the preparation to which it is applied, indicating that it contains bromine or a bromide and quinine. If it does not contain bromide the description is false, and in either case the term is not a valid trade-mark. Ex parte Grove, 67 O. G. 1447, C. D. 1894.

135. The words "Cherry Pectoral," "Taffe Tolu," "Rye & Rock," "Straight Cut," "Macassar," "Crosylic Ointment" and "Iron Bitters," which have been claimed as trade-marks, were either originally descriptive, or have come to be recognized as descriptive of the articles they are applied to. *N. K. Fairbank Co. v. Central Lard Co., 70 O. G. 635, C. D. 1895.

136. The word "instantaneous" was applied to tapioca which "requires no soaking, but softens instantly." Held descriptive. *Bennett v. McKinley, 65 Fed. Rep. 505 (1895).

137. The words "Syrup of Figs" or "Fig Syrup" being descriptive cannot be sustained as a valid trade-mark or trade-name as applied to a syrup one of the characteristic ingredients of which is the juice of the fig. *California Fig Syrup Co. v. Stearns, 73 O. G. 140, C. D. 1895.

138. The use of the name "Syrup of Figs," in connection with a description of the preparation as a "Fruit Remedy," "Nature's Pleasant Laxative," applied to a compound whose active ingredient is senna, and containing but a small proportion of fig juice, which has no considerable laxative properties, is deceptive and deprives one so using it of any claim to equitable relief. (California Fig Syrup Co. v. Improved Fig Syrup Co., 61 O. G. 155, 51 Fed. Rep. 296; on appeal, 64 O. G. 158, 4 C. C. A. 264, 54 Fed. Rep. 175, distinguished.) *Id.

139. A facing strip for suspenders, with adjuncts, is not registrable. Applicant can have no exclusive right to such strip. Ex parte Silvermann & Co., 56 MS. D., March, 1895 (Seymour, Com'r).

(See Ex parte Silvermann & Co., 59 MS. D., 1896, *infra*.)

140. The words "Gauze" and "Scientific," applied to suspenders, held descriptive. Ex parte Silvermann & Co., 56 MS. D., March, 1895 (Seymour, Com'r).

141. "Hygienic," for graham flour and white oats, held descriptive. Ex parte Williams & Co., 57 MS. D., July, 1895 (Fisher, Ass't Com'r).

142. "Common Sense" held descriptive as applied to weather strips. Ex parte Yung, Jr., 57 MS. D., Sept., 1895 (Fisher, Acting Com'r).

143. "Crushed Roses," as a trade-mark for perfumes, held descriptive or deceptive. Ex parte De Merville & Co., 58 MS. D., Oct., 1895 (Fisher, Acting Com'r).

144. The word "Success" as a trade-mark for medical compounds, held a "descriptive and advertising term," and therefore public property. Ex parte The Success Remedy Co., 58 MS. D., Oct., 1895 (Fisher, Acting Com'r).

145. "The 'Formosa' Doubly Woven Finger Tips," as a trade-mark for gloves, refused registration on the ground that "Doubly Woven Finger Tips" is descriptive, and "Formosa" is geographical. Ex parte Lord & Taylor, 58 MS. D., Nov., 1895 (Fisher, Acting Com'r).

146. "Cold Tea," as a trade-mark for a medical compound, held descriptive or deceptive. Ex parte Andrews, 58 MS. D., Dec., 1895 (Fisher, Ass't Com'r).

147. "Superior Coffee Helper," as a trade-mark for a "coffee substitute," held descriptive. Ex parte Sipher & Friedman, 58 MS. D., Jan., 1896 (Seymour, Com'r).

148. "Honestrop," as a trade-mark for razor strops, held descriptive. Ex parte Brooks, 58 MS. D., Jan., 1886 (Fisher, Ass't Com'r).

149. "Steel-Porcelain," as a trade-mark for enameled metal wares, held descriptive. Ex parte Kny, 58 MS. D., Jan., 1896 (Fisher, Ass't Com'r).

150. The words "Royal-Salted-Codfish" refused registration on the ground that "Salted" and "Codfish" are merely descriptive, and "Royal" had been anticipated. Ex parte Pew & Son, 58 MS. D., Feb., 1896 (Fisher, Acting Com'r).

151. "Superior," as a trade-mark for clothes wringers, held descriptive. Ex parte The American Wringer Co., 58 MS. D., Feb., 1896 (Fisher, Ass't Com'r).

152. "Sterling," for wringers, held descriptive. Ex parte The American Wringer Co., 58 MS. D., Feb., 1896 (Fisher, Ass't Com'r).

153. The words "Astringent Pencil," applied to a stiptic cylinder or stick not tapered, held

descriptive; but registration was allowed upon adding the accessories of colored label, contrasting border and a symbol. *Ex parte Harned*, 58 MS. D., March, 1896 (Fisher, Ass't Com'r).

154. The words "Don't Cook Out," as a trade-mark for flavoring extracts, *held* descriptive. *Ex parte Canz*, 58 MS. D., March, 1896 (Fisher, Acting Com'r).

155. "Solvent," as a trade-mark for medicines, *held* descriptive or deceptive. *Ex parte Packer*, 59 MS. D., April, 1896 (Fisher, Acting Com'r).

156. "Bromo-Quinine" *held* descriptive or deceptive, as applied to a remedy for coughs, colds, etc. (rehearing). *Ex parte Grove*, 59 MS. D., May, 1896 (Fisher, Acting Com'r).

157. "The representation of a hole formed in the front or back facing-strip of a suspender or like article" is not entitled to registration. Other dealers in suspenders have a right to use true pictures of their goods." *Ex parte Silvermann Co.*, 59 MS. D., May, 1896 (Seymour, Com'r).

(See *Ex parte Silvermann & Co.*, 56 MS. D., 1895, *supra*.)

158. "Bromo-Celery," for medicines, *held* descriptive or deceptive. *Ex parte Bromo-Celery Co.*, 59 MS. D., May, 1896 (Seymour, Com'r).

159. "Unrivalled" and "Excellent" as trade-marks for fish, *held* descriptive. *Ex parte Pew and Son*, 59 MS. D., June, 1896 (Fisher, Acting Com'r).

160. "Roman Punch," as a trade-mark for beverages, *held* descriptive. *Ex parte Countie & Co.*, 59 MS. D., June, 1896 (Fisher, Acting Com'r).

161. "Black diamond," as a trade-mark for blasting powder, *held* not registrable, because "Black" is descriptive, and "Diamond" was already registered. *Ex parte The New York Powder Co.*, 59 MS. D., June, 1896 (Fisher, Acting Com'r).

162. The representation of a bundle of cigars, with stripes across its face, as a trade-mark for cigars, *held* descriptive. *Ex parte Rosenberger & Co.*, 59 MS. D., June, 1896 (Fisher, Acting Com'r).

163. "Kola-Malto," as a trade-mark for a certain powder, *held* descriptive. *Ex parte The Thomson & Taylor Spice Co.*, 60 MS. D., Nov., 1896 (Fisher, Ass't Com'r).

164. The exclusive use of the word "Matzoon" as applied to a form of fermented milk, when such word is well known in a foreign country with the same application of meaning, cannot be permitted, although in this country, prior to the introduction of the compound, said

word, save to a few persons acquainted with the language of the foreign country, possessed no significance. **Dadirrian v. Yacubian*, 75 O. G. 1856, C. D. 1896.

165. The word "Imperial," though close to the border line between terms that signify quality and those that do not, *held* descriptive, since it is safer to protect the use of those terms only which clearly do not refer to grade or quality. **Beadleston & Woerz v. Cooke Brewing Co.*, 74 Fed. Rep. 229 (1896), 76 O. G. 1576, C. D. 1896.

(This decision discusses the element of quality or descriptiveness quite fully.)

166. The word "Imperial" is an adjective in general use to indicate superior quality and cannot be used as a valid trade-mark. **Id.*

167. The word "Imperial" having been adopted and used by appellant to characterize a particular grade of beer, he is not entitled to be protected in the exclusive use of the word as a lawful trade-mark. **Id.*

168. A descriptive word does not indicate origin or ownership. The monopoly of use granted by the law of trade-marks should not be extended to embrace terms of doubtful signification. **Id.*

169. A trade-mark must be designed, as its primary object and purpose, to indicate the owner or producer of the commodity and to distinguish it from like articles manufactured by others, and the device or symbol employed cannot be sustained as a valid trade-mark if it be used for the purpose of identifying the class, grade, style or quality of the article. (*Columbia Mill Co. v. Alcorn*, 65 O. G. 1916, 150 U. S. 460.) **Id.*

170. Color cannot be exclusively appropriated for packages of goods. The words "White Wrapper," *held* not registrable for canned salmon. (*Ex parte Landreth*, 31 O. G. 1441; *Fleischmann v. Starkey*, 25 Fed. Rep. 127; *Fisher v. Blank*, 33 N. E. Rep. 1040.) *Ex parte Lord*, 61 MS. D. 389, June, 1897 (Butterworth, Com'r).

171. The name "Air-Brush," applied to an instrument or machine for the distribution of pigments by means of an air-blast, is plainly descriptive and not arbitrarily selected as a mark of origin. **Air-Brush Mfg. Co. v. Thayer*, 79 O. G. 683, C. D. 1897.

172. The word "Gyrator," if applied to bolt-ing-machines having a gyratory motion, is used descriptively or, if applied to other bolt-ing-machines, it is used deceptively, and in either case it should not be registered as a

trade-mark. *Ex parte Wolf*, 80 O. G. 1271, C. D. 1897.

173. Where a word is formed by joining or combining English, Latin or other words the meaning of which is understood, and said new word is descriptive of the goods to which it is applied, it should not be registered as a trade-mark. *Id.*

174. The word "Yale" refused registration as a trade-mark for locks on the ground that it is public property, being descriptive of a lock of a certain kind. *Ex parte Yale & Towne Mfg. Co.*, 81 O. G. 801, C. D. 1897.

175. The word "peerless" being an adjective meaning "unequaled, unmatched, matchless, unsurpassed," etc., registration as a trade-mark refused on the ground that it is descriptive of the quality of the goods to which it is applied. To give to one person the exclusive right to its use as a trade-mark would be to deprive the public of its lawful use in language. *Ex parte Peerless Carbon Black Co., Limited*, 81 O. G. 803, C. D. 1897.

(Whether a word claimed as a trade-mark is fanciful or arbitrary, or whether obnoxious to objection of being descriptive, must depend upon the circumstances of each case. If it is merely suggestive, or is figurative only, it may be a good trade-mark, notwithstanding it is also indirectly or remotely descriptive. **Bennett v. McKinley*, 65 Fed. Rep. 505, 1895.)

IX. DIVISION OF APPLICATION.

176. There is no authority for requiring division of an application for the registration of a trade-mark to accord with the subdivisions of the office classification. *Ex parte Silvers*, 67 O. G. 811, C. D. 1894.

X. DRAWINGS OR FAC-SIMILES.

177. The Revised Statutes relating to the registration of trade-marks require that the mark shall be represented by *fac-simile*, the mode of application being indicated by a statement. *Ex parte Hudson*, 55 O. G. 1401, C. D. 1891.

178. The rules of the patent office provide that where the trade-mark can be represented by a *fac-simile* that conforms to the rules for drawings for mechanical patents, such a drawing may be furnished by the applicant. *Id.*

179. A *fac-simile* is an exact counterpart of an original, and a *fac-simile* represented by a drawing is an exact counterpart of an original so far as the nature of a drawing permits. *Id.*

180. While perhaps it would be going too far to require in all cases that the trade-mark and nothing but the trade-mark be represented in

the drawing, it is certainly within the discretion of the office to so insist where otherwise legitimate doubts would arise as to whether protection should not be sought through the law relating to designs. *Id.*

181. The cases are very rare in which the registration of a trade-mark requires or should permit of the representation of any other matter than the *fac-simile* of the trade-mark itself. *Id.*

182. Illustrations of a trade-mark presented for record by the applicant must conform substantially as to shape and size with the rules governing drawings of patents. *Ex parte Archer*, 57 O. G. 410, C. D. 1891.

XI. EQUITY.

183. An objection to the bill on the ground that it was uncertain whether complaint was made of the use of the words "Fig Syrup" or "Syrup of Figs" by themselves or in combination with other words, devices, etc., could not be sustained, it being enough for the purposes of a demurrer that complainant was entitled to relief in respect of the combined use, which was clearly set forth in the bill. **California Fig Syrup Co. v. Improved Fig Syrup Co.*, 61 O. G. 155, C. D. 1892.

184. The laxative medical compound manufactured by the California Fig Syrup Company under the name "Syrup of Figs" is a preparation which a court of equity will look upon with favor as entitled to protection under the trade-mark laws. **Improved Fig Syrup Co. v. California Fig Syrup Co.*, 64 O. G. 158, C. D. 1893.

185. The representations and statements on the bottles and packages of the California Fig Syrup Company's medical compound "Syrup of Figs" are not such as will deprive the California Fig Syrup Company of standing in a court of equity in respect to infringement of its trade-mark or trade-name. **Id.*

XII. ESSENTIAL FEATURES.

186. A trade-mark must be described with definiteness and certainty; but it was suggested in this case that some statement might be made as to what change would be considered as substantially included in the scope of the registration. *Ex parte Bengé & Co.*, 41 MS. D., Sept., 1889 (Fisher, Acting Com'r).

187. The essential feature of a trade-mark is not that which the registrant elects to designate as such, but that which would strike the

public mind as its most salient feature and as lending character to the entire mark. *Ex parte Metropolitan Watch Co.*, 44 MS. D. (2 G. W. D.), Oct., 1890 (Mitchell, Com'r).

188. The representation of a dog as a trade-mark for flour cannot be properly registered without any described limitation as to attitude, position or view of the animal. (Rehearing.) *Ex parte Duluth Imperial Mill Co.*, 52 MS. D., Aug., 1893 (Fisher, Ass't Com'r).

189. Registration of the words "Buffalo Brand" and head of a bison refused for indefiniteness of statement of essential features. *Ex parte Lathrop & Co.*, 55 MS. D., Dec., 1894 (Fisher, Ass't Com'r).

190. The words "dark" and "light," used in a statement to describe a mark for dress-stays, *held* indefinite, and the substitution of the words "Contrasting Colors" suggested. *Ex parte Janowitz*, 56 MS. D., March, 1895 (Fisher, Ass't Com'r).

191. A figure described as "red or reddish and of definite shape and limited dimensions on or local to a portion of the tire having a definite outline," *held* too indefinite in description to be registrable. *Ex parte Boston Woven Hose and Rubber Co.*, 59 MS. D., June, 1896 (Fisher, Acting Com'r).

XIII. EVIDENCE.

(See INJUNCTION; INFRINGEMENT.)

192. The registry of a trade-mark under the act of March 3, 1881, may be evidence in a suit to restrain infringement of a common-law trade-mark used for the same article in domestic commerce to show what complainant really claimed. (*Kohler Mfg. Co. v. Beshore*, 59 Fed. Rep. 572, followed.) **Richter v. Reynolds*, 67 O. G. 404, C. D. 1894.

193. Although registration of a trade-mark under the act of March 3, 1881, may not prevent the adoption of another device as a common-law trade-mark for the same article in domestic markets, such registry may be evidence, in a suit to restrain infringement of such common-law trade-mark, to show what complainant really claimed. *Kohler Mfg. Co. v. Beshore*, 67 O. G. 678, C. D. 1894.

194. Where affidavits are filed which are not entitled in the cause, they cannot properly be considered by the court. (*Buerk v. Imhauser*, 10 O. G. 907. See, also, *Hawley v. Donnelly*, 8 Paige, 415.) **Goldstein v. Whelan*, 69 O. G. 124, C. D. 1894.

195. Testimony of witnesses hired to secure evidence against infringers that they purchased of defendant imitation bitters put up in genuine bottles procured for the purpose, *held* insufficient where they relied solely on opinions formed from tasting the liquid and where they were opposed by the testimony of defendant and his employees and others that the bitters so sold were genuine and that he had never procured or sold any imitation article. **Hos-tetter Co. v. Bower*, 76 O. G. 1856, C. D. 1896.

XIV. FEES.

196. A petition that a fee for a trade-mark, registered under the act of 1870, be applied to the present application, granted. *Hinrichs & Co.*, 54 MS. D., Jan., 1894 (Fisher, Acting Com'r).

XV. FEE, REFUNDMENT OF.

197. There is no authority for the repayment of fees paid in trade-mark cases where registration is refused. †*Ex parte Thayer*, 54 O. G. 957, C. D. 1891.

198. The agent of a foreign corporation filed an application for the registration of a trade-mark used by the corporation, which was refused on the ground that he was not the exclusive owner. Subsequently the corporation by its proper officer filed its application as "exclusive owner." *Held*, upon a request for the refunding of the fee paid by Hill, as having been "paid by mistake," that the mistake, being one of law and not of fact, is not within rule 224, and that Hill's application having been rejected on the merits he is not entitled to have the fee refunded. *Ex parte Coventry Machinist Co., Limited*, 59 O. G. 1923, C. D. 1892.

199. A filing fee of ten dollars having been paid on an application for registration of a trade-mark in 1879, under the law and rules in force at that time, *held*, that it was not paid under a mistake and that it could not properly be refunded. *Ex parte Leeson & Co.*, 60 O. G. 297, C. D. 1892.

200. Where the domestic branch of a business firm having offices in this country and abroad filed application for trade-mark registration, and subsequently learned that application for the same mark had already been filed through the London agent, *held*, that the second filing was a case of mistake under the law, and the fee refunded. *Ex parte Finlayson, Bousfield & Co.*, 61 O. G. 152, C. D. 1892.

201. The registration fee in a trade-mark

case cannot be returned because of rejection of the application. *Ex parte McDaniel & Morrow*, 54 MS. D., March, 1894 (Fisher, Ass't Com'r).

202. A fee paid on an application for a trade-mark cannot be returned, whether registration be granted or not. *Ex parte Zwack & Co.*, 55 MS. D., Aug., 1894 (Fisher, Ass't Com'r).

XVI. FIRM NAME.

(See GOOD WILL.)

203. It is common for a dealer to retain on a label the name of a firm to which he has succeeded, and the public are not deceived nor injuriously affected by such course. **Jennings v. Johnson*, 37 Fed. Rep. 364 (1888).

XVII. FOREIGN COMMERCE.

204. The statutory basis of the right to registration is the fact that the trade-mark is used in foreign commerce or commerce with Indian tribes. *Ex parte Proctor, Jr.*, 51 O. G. 1785, C. D. 1890.

205. Inasmuch as the applicant invokes the right as it stands related to foreign commerce, it cannot be said that the absence of Cromarty herrings from the home market authorizes registration. *Id.*

206. Where an applicant for a trade-mark appears on the record as "located" in a foreign country other than that of which he is a citizen, his application will be governed by the existing treaty, convention or law of the country of location rather than that of citizenship. *Ex parte Haggemacher*, 60 O. G. 438, C. D. 1892.

207. An applicant for trade-mark registration, relying upon commerce with Indian tribes to bring him within the statute, will be required in his oath to specify by name the tribe or tribes with which such commerce is carried on. *Ex parte Schotten & Co.*, 60 O. G. 576, C. D. 1892.

208. Registration must be denied when there has been no foreign commerce prior to the application. *Stewart v. Einstein, v. Sawhill*, 64 O. G. 1533, C. D. 1893.

209. Upon an application showing the adoption of the trade-mark after the death of the originator, and its use in foreign commerce after the filing of the application, but not before, a supplemental application may be filed. *Id.*

210. The commissioner of patents under the

trade-mark statute of March 3, 1881, is not invested with discretionary power to determine whether the applicant for registration is *lawfully* engaged in foreign trade. **United States ex rel. The State of South Carolina v. Commissioner of Patents*, 65 O. G. 1221, C. D. 1893.

(Decision of supreme court of the District of Columbia.)

211. The discretion of the commissioner, under that statute, is to decide the presumptive lawfulness of claim to the ownership of the alleged trade-mark, not whether such mark is lawfully used in foreign commerce. **Id.*

212. The commissioner having denied registration to the state of South Carolina on the ground that, in his judgment, the statute under which the state's officers and agents were acting did not authorize a trade with foreign nations, *held*, that that question was one for the courts in a proper case and the people of the state to determine, it not being a matter in which the United States, the commissioner of patents or the general public had any concern or interest. **Id.*

213. The decision of the commissioner goes to the question of the lawful use of the trade-mark in commerce with foreign nations or the Indian tribes, and whether the applicant has actually used the trade-mark in such commerce. **United States ex rel. The State of South Carolina v. Commissioner of Patents*, 66 O. G. 1167, C. D. 1894.

(Decision of court of appeals of the District of Columbia.)

214. Whether an isolated sale in a foreign country for the purpose of giving foundation to the affidavit is foreign commerce within the meaning of the law, *quære*. **Id.*

215. There is nothing in the dispensary law of the state of South Carolina intended to give authority for trade in liquors outside the limits of the state. It follows, therefore, that the sale of a case of state liquors in Canada by the state commissioner was not authorized by the law and was not the act of the state, but of the officer. **Id.*

216. The commissioner did not err in the conclusion that the trade-mark applied for had not been lawfully used in foreign commerce. **Id.*

217. An Indian tribe or nation within the United States is not a foreign state, in the sense of the constitution, or the statutes creating and conferring jurisdiction on the federal courts. (Citing *Cherokee Nation v. State of Georgia*, 5 Pet. 1; *Cherokee Nation v. Southern Kansas*

Ry. Co., 135 U. S. 641; *Karahoo v. Adams*, Fed. Cas. No. 7,614, 1 Dill. 344.) **Paul v. Chilsouie*, 70 Fed. Rep. 401 (1895).

218. The first to adopt and use a trade-mark is the owner of it, and it is immaterial whether K. used her mark in foreign commerce before filing date of B.'s application for registration. *Kirschbaum v. Berriman*, 58 MS. D., March, 1896 (Fisher, Acting Com'r).

219. The question of foreign trade is *ex parte*, and has no influence on the question of priority in an interference proceeding (*Hance v. Flower*, 54 MS. D. 230), and it is not necessary for a party to take testimony to establish it. The oath to the application is *prima facie* evidence of such trade. *Oberhaeuser & Landauer v. Pastor Kneipp Med. Co.*, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

XVIII. FOREIGN WORDS.

220. The word "Matzoon," as applied to fermented milk, cannot be regarded in this country as descriptive, although the Armenians give the name "Maadzoon" to a semi-solid or custard-like preparation of fermented milk made in Turkey and there is sufficient resemblance in the sound to signify to them that the preparation "Matzoon" is some sort of fermented milk. †*Dadirrian v. Theodorian*, 74 O. G. 1902, C. D. 1896.

221. Where a foreign word has no descriptive character which anybody in this country could comprehend except the persons here who are acquainted with the foreign language, *held*, the word to be a valid trade-mark. †*Id.*

222. When the article was first imported or made in this country and called by the name "Matzoon," the right to such importation or making and to the use of the name belonged to any one, and there is no rule in law by which that right can be taken away or abridged. The fact that the plaintiff long monopolized the trade in the article in this country and introduced it to the trading public gives him no exclusive use in the word as a trade-mark. **Dadirrian v. Yacubian*, 75 O. G. 1856, C. D. 1896.

223. The ignorance of people in this country touching "Matzoon," its uses and its name cannot be treated as property and be in a manner capitalized as an element in the good-will of the complainant, as would be the case if no one else were permitted to tell what it is and what a considerable portion of the race has long found it useful for. **Id.*

XIX. FRAUD OR UNFAIR COMPETITION.

(See INJUNCTION; INFRINGEMENT; RIGHT TO USE PERSONAL NAME.)

224. A manufacturer is not allowed to impose his goods upon the public as the goods of another manufacturer, and so derive a profit from the reputation of the latter. †*McCann v. Anthony*, 38 O. G. 333, C. D. 1887.

225. The imitation need not be exact. It is sufficient if it be so close as to deceive the incautious and unwary. †*Id.*

226. It is not necessary to prove that actual fraud was intended by the infringer. †*Id.*

227. A trade-mark which contains a misrepresentation, clearly and distinctly referring the origin or ownership of the article to another person, class of persons or nationality than the true one, and thereby evidently depriving the public from freedom of choice and the exercise of discrimination in selection and purchase, according to their tastes and judgment, is a fraudulent and unlawful trade-mark, not entitled to registry. *Ex parte M. Bloch & Co.*, 40 O. G. 443, C. D. 1887.

228. The fraud or misrepresentation which renders a trade-mark unlawful is not restricted to cases where the trade-mark so nearly resembles that of another as to be calculated to deceive, but embraces those that mislead or deceive the public in any of the particulars by which they would mislead or deprive people from enjoying and realizing their choice of selection as to quality, character, etc., of the article marked or as to its origin, ownership, etc. It is not essential to the unlawfulness of such trade-mark that the articles sought to be purchased by the public do not actually possess the superior qualities attributed to them. It is sufficient that they are believed to possess them. *Id.*

229. It is the object of the law relating to trade-marks to prevent one man from unfairly stealing away another's business and good-will. Fair competition in business is legitimate and promotes the public good; but unfair appropriation of another's business by using his name or trade-mark, or an imitation thereof calculated to deceive the public, or in any other way, is justly punishable by damages, and will be enjoined by a court of equity. **Celluloid Mfg. Co. v. Cellonite Mfg. Co.*, 41 O. G. 693, C. D. 1887.

230. The Brown Chemical Company manufactured "Brown's Iron Bitters." The defendants sold "Brown's Iron Tonic." The two titles, being descriptive, were not technical

trade-marks, and the question, therefore, was whether there was unfair competition in trade. *Held*, that there was not, because "Brown's Iron Tonic" was prepared from a different formula by another Brown, and that the respective bottles and wrappers were unlike in form, shape and color, so that the public could not mistake one article for the other. *Brown Chemical Co. v. Meyer, 31 Fed. Rep. 453 (1887).

231. Plaintiff's and defendant's liniments bore the same title, namely, "Johnson's Anodyne Liniment," and the bottles were the same size, the wrappers similar in color and the labels differed but little. *Held*, the public were deceived, and injunction issued accordingly. *Jennings v. Johnson, 37 Fed. Rep. 364 (1888).

232. *Held*, that defendant's simulation of the trade-mark and labels of the Hostetter Company and of the bottles in which the bitters are put up prove that its purpose was to deceive the public. *Myers v. Thiller, 38 Fed. Rep. 607 (1889).

(See Hostetter Co. v. Sommers, 82 O. G. 753. Defendant enjoined.)

233. The use of the name "St. Louis" on white lead manufactured in Chicago tends to deceive and defraud the public and the complainant, who manufactures white lead in St. Louis. (Cases cited.) *Southern White Lead Co. v. Coit, 39 Fed. Rep. 492 (1888).

234. That the manufacturers of scythe-stones have sometimes put upon labels bearing their brand the names of jobbers to whom they have sold stones does not show that any deceit has been practiced upon the public, because the purchaser obtained the same goods which he would have purchased if the name of the jobber had not been upon them. *A. F. Pike Mfg. Co. v. Cleveland Stone Co., 45 O. G. 947, C. D. 1888.

235. Although there may be no infringement, a bill for an injunction may lie, and affords the only adequate relief when there is continuous fraud by simulating a trade-mark. *Adee v. Peck Bros. & Co., 48 O. G. 823, C. D. 1889.

236. The delivery of a soap called "Pride of the Kitchen" to fill orders for a soap called "Sapolio," *held* unlawful and fraudulent. *Enoch Morgan's Sons v. Wendover, 43 Fed. Rep. 420 (1890).

237. The law does not visit with its reprobation a fair competition in trade; its tendency is rather to discourage monopolies, except where protected by statute, and to build up new enterprises from which the public is likely

to derive a benefit. It is only when such competition is based upon fraud that the law will interfere. *Brown Chemical Co. v. Meyer, 55 O. G. 287, C. D. 1891.

238. A trade-mark, clearly such, when wrongfully used by a third party, is in itself evidence of an illegal act. It is of itself evidence that the party intended to defraud, and to palm off his goods as another's. (Putnam Nail Co. v. Bennett, 43 Fed. Rep. 800.) *Lawrence Mfg. Co. v. Tennessee Mfg. Co., 55 O. G. 1528, C. D. 1891.

239. If the letters LL formed an important part of plaintiff's label, and the defendant had used them in such a way and under such circumstances as to amount to a false representation, which enabled it to sell and it did sell its goods as those of plaintiff, and this without plaintiff's consent or acquiescence, then plaintiff might obtain relief on the ground of deceitful representation. *Id.

240. The name "Webster's Dictionary" cannot be exclusively appropriated on editions the copyrights for which have expired, since it is not a trade-mark. But defendant cannot lawfully so advertise the book as to confuse his publication with the plaintiff's in the public mind. (Cases cited.) *Merriam v. Texas Siftings Publishing Co., 44 Fed. Rep. 944 (1892).

241. Defendants' labels are almost the exact reproduction of complainant's, and the cigar boxes, thus labeled, so closely imitate complainant's as to deceive an ordinarily careful purchaser. Although defendants do not themselves make, pack or sell the fraudulent cigars, their obvious purpose is to palm off their goods as those of complainants. *Cuervo v. Jacob Henkell Co., 50 Fed. Rep. 471 (1892).

242. "Cherry Cocktail," applied to "temperance or non-alcoholic beverages," *held* deceptive. Ex parte Bowe, 50 MS. D., May, 1892 (Frothingham, Ass't Com'r).

243. "Premium," as a trade-mark for "whalebone products," refused as deceptive, the goods having received no premium. Ex parte New England Whalebone Mfg. Co., 51 MS. D., Aug., 1892 (Frothingham, Acting Com'r).

244. Independently of any right of complainants to the exclusive use as a trade-mark of the name applied by them to their product, the sale by the defendants of a deleterious substance represented by the latter to be in part or in whole the same substance in which complainants are dealing, and of which they are the sole producers, and which is admittedly of a beneficial character, will be restrained. *City

of Carlsbad v. Tibbetts, 61 O. G. 1166, C. D. 1892.

245. While descriptive words like "Cough Syrup" and proper names cannot be appropriated by one to exclusion of another, they also may be used for the purpose of perpetrating a fraud which affects the public. (Cases cited.) *Meyer v. Dr. B. L. Bull Vegetable Medicine Co., 58 Fed. Rep. 884 (1893).

246. The controversy between the parties is the single question whether, comparing the two designs upon the upper ends of the spools, there is such resemblance between them as to indicate an intent on the part of defendants to put off their thread upon the public as that of plaintiffs', and thus to trade upon their reputation. *Coats v. Merrick Thread Co., 63 O. G. 1531, C. D. 1893.

247. Irrespective of the technical question of trade-mark, the defendants have no right to dress their goods up in such manner as to deceive an intending purchaser and induce him to believe he is buying those of the plaintiffs. *Id.

248. The plaintiffs' and defendants' devices examined and compared with each other and found to be hardly possible to mistake one for the other. *Held*, consequently, that the defendants had clearly disproved any intention to mislead purchasers. *Id.

249. The addition of the initials "L. F." to the surname "Pillsbury" is not such a difference as would prevent deception of the ordinary observer. *Pillsbury v. Pillsbury-Washburn Flour Mills Co. (Limited), 64 Fed. Rep. 841 (1894).

250. Descriptive words, like "Cough Syrup," cannot be appropriated as trade-marks. Nevertheless they may be used for the purpose of perpetrating a fraud which affects the public, and in which cases a court will, as against the fraudulent party, afford relief to the party injured. (Coats v. Merrick Thread Co., 63 O. G. 1531, 149 U. S. 866, and other authorities cited.) *Meyer v. Dr. B. L. Bull Vegetable Medicine Co., 66 O. G. 1755, C. D. 1894.

251. When the evidence warrants the conclusion that the dress of the article is only used in order to deceive purchasers into the belief that the goods are those of another, *held*, it is not required to establish that any particular person had been so deceived. *Von Mumm v. Frash, 68 O. G. 143, C. D. 1894.

252. "Quince & Shrub," for medicinal lotions, refused as deceptive. *Ex parte* Queenan, 59 MS. D., July, 1896 (Fisher, Acting Com'r).

253. Where the defendant used the name

"De Long Hook and Eye Company" on their goods, with intent to identify its business with that of the plaintiffs, whose goods are known as "De Long's Hooks and Eyes," *held*, that defendant should be restrained from such use, although one of them was named De Long. †De Long v. De Long Hook and Eye Co., 74 O. G. 809, C. D. 1896.

254. While there might be slight differences in the name, variation of coloring, and size of package and shape of goods, and in printed matter on the package, yet similarity, not identity, is the usual recourse where one party seeks to benefit himself by the good name of another. (Celluloid Mfg. Co. v. Cellonite Mfg. Co., 41 O. G. 693, 32 Fed. Rep. 94.) †Id.

255. The real test in such cases is whether the thing offered for sale is so arranged and exhibited that when it strikes the eye of an intending purchaser possessed with ordinary intelligence and judgment a false impression is likely to be produced that the goods of another are being offered for sale; and when answered in the affirmative the courts will interfere to protect the public, as well as the plaintiffs, and to suppress unfair and dishonest competition. (Fischer v. Blank, 138 N. Y. 251; Coats v. Merrick Thread Co., 63 O. G. 1531, 149 U. S. 566; Lawrence Mfg. Co. v. Tennessee Mfg. Co., 55 O. G. 1528, 138 U. S. 537.) †Id.

256. The fact that defendants might have used another name which in another foreign country indicates the same product cannot be construed as indicating unfair competition. *Dadirrian v. Yacubian, 75 O. G. 1853, C. D. 1896.

257. The trade-mark "Cuticura" *held* infringed by the word "Curative," both applied to soap, it also appearing that defendant's article was put upon the market in such imitative manner as to deceive the public. *Potter Drug & Chemical Corp. v. Miller, 75 Fed. Rep. 656 (1896).

258. The good-will of a manufacture will be protected from a colorable artifice in the use of a name or from one who merely buys from an indifferent third person who happens to have the name which the buyer wants to use; but it is not unfair competition on the part of the defendants to use in their business the name of a man who is a stock-owner in their company and who has been for years engaged in the same line of manufacture. Such a man is not an indifferent third person. *American Cereal Co. v. Eli Pettijohn Cereal Co., 76 O. G. 610, C. D. 1896.

259. Although the corporate name of defendant, "The William Clark Company," was not improper, yet when he called his goods "Clark's Spool Cotton" he was attempting to make the public believe that the goods belonged to another Clark, and he was restrained from the use of the name. *Clark Thread Co. v. Armitage, 76 O. G. 1419, C. D. 1896.

260. The acts of the defendant in imitating the label of complainant are a fraudulent invasion of the good-will of complainant and an unfair and inequitable competition, and defendant is enjoined against the use, by labels, circulars, etc., of the designation "Clark's" as the name of the thread manufactured by the William Clark Company and from selling thread manufactured by said company under the name of "Clark's," or "Clark's Spool Cotton," or "Clark's Thread," and from the use of the letters "N-E-W" upon labels, etc. *Id.

261. Where it is alleged that defendant deceives the public by purchasing spurious articles and sells to the public from packages which once contained the genuine article and still contain complainant's labels and trade-marks, *held*, that the burden is upon complainant to establish the charge by clear preponderance of proof. *Hostetter Co. v. Bower, 76 O. G. 1856, C. D. 1896.

262. It is sufficient to justify the interposition of a court of equity if articles manufactured by the defendant are purposely constructed and marked in the similitude of those manufactured by the complainant, with the intention and result of deceiving the trade and the public and inducing them to purchase the articles of the defendant in the belief that they are purchasing those of the complainant. *Buck's Stove and Range Co. v. Kiechle, 77 O. G. 1785, C. D. 1896.

263. It is unfair to conspicuously use the name "Hoff" upon the face of the bottle containing malt extract made by Leopold Hoff and to use a small side label containing the statement that Leopold Hoff is the manufacturer, when another man by the name of Hoff was in the same business under his own name before Leopold Hoff. *Tarrant & Co. v. Hoff, 78 O. G. 1107, C. D. 1897.

264. It is unfair competition for the defendant to advertise that his chocolate business was established in 1785, though his ancestors of the same name had been engaged in a wholesale grocery business since about that date, when it appears that the complainant advertises truthfully of his chocolate business that it was

established in 1780. *Walter Baker & Co. (Limited) v. Baker, 78 O. G. 1427, C. D. 1897.

(The court restrained the defendant from using in connection with his name the words "Established in Mercantile Business in 1785," and also from using yellow labels and otherwise using his name so that it would be confused with plaintiff's name.)

265. The use by a manufacturer of imitative labels and devices in connection with an inferior article which is sold to retailers at a reduced price with the purpose and result of enabling them to sell it to consumers as the goods of another will be enjoined. *Garrett v. T. H. Garrett & Co., 79 O. G. 1681, C. D. 1897.

266. While it is true in the abstract that every one has a right to use white paper, yet no one has a right to use it in such a way as to imitate another's labels and thereby appropriate the good-will of his business. *Id.

267. Where a corporation organized to manufacture and sell snuff had assumed the name of an employee holding a few shares of its stock with the evident purpose of appropriating the trade of others of the same name who had long used the name in connection with their snuff, *held*, that such corporation would be enjoined from using the name as part of its corporate name or in its business. *Id.

268. It is unfair competition to use names or symbols intended or calculated to represent that the business of one person is that of another; but equity will refuse to aid a complainant who is himself guilty of making materially false statements in connection with the property he seeks to protect. *Hilson Co. v. Foster, 80 Fed. Rep. 896 (1897).

269. If the word "Columbia" cannot be used as a trade-mark (Columbia Mills Co. v. Alcorn, 65 O. G. 1916, C. D. 1893), it is to be treated as a descriptive word to the benefit of which the first user is entitled; and no other person should be permitted to use the name as the sole mark for like goods, and in that manner mislead the public. *Morgan Envelope Co. v. Walton, 81 O. G. 1615, C. D. 1897.

XX. GEOGRAPHICAL NAMES INDICATING MERELY LOCALITY.

270. "Mexican," for plated silver ware, *held* geographical. *Ex parte* The Holmes & Edwards Silver Co., 36 MS. D., Dec., 1887 (Hall, Com'r).

271. "Atlanta," for pills, *held* geographical. *Ex parte* Rogers & Irwin, 38 MS. D., Oct., 1888 (Vance, Ass't Com'r).

272. Where a bill was filed for the purpose of enjoining the defendants from using the word "Rosendale" in describing their cement, and to obtain damages and an account of profits for such use, and it appeared that the suit was brought at the instance of a private party, who was only one of the many who manufactured cement at Rosendale and truly denominated their cement "Rosendale cement," *held*, that the bill should be dismissed, although conceding that the name "Rosendale cement" was understood by the public as designating the place where it was made and came from, and that the defendants untruly called their cement by that name. *New York and Rosendale Cement Co. v. Coplay Cement Co., 53 O. G. 1408, C. D. 1890.

273. If a person seeks to restrain others from using a particular trade-mark, trade-name or style of goods, he must show that he has an exclusive ownership or property therein. To show that he has a mere right, in common with others, to use it is insufficient. *Id.

274. Whether a geographical name may become a trade-mark, when adopted as such, where its owner is the owner of the place of origin, and has the monopoly of the vendible product, is perhaps an open question (cases cited); but that such a name will be protected against infringement by other persons not obtaining their products from the same locality is too well settled for discussion. (Following Canal Co. v. Clark, 13 Wall. 311, and other cases.) *La Republique Francaise v. Schultz, 57 Fed. Rep. 37 (1893).

275. The word "Columbia" is not a valid trade-mark, because it is not the subject of exclusive appropriation under the general rule that a word or words in common use as designating locality or section of a country cannot be appropriated by any one as his exclusive trade-mark. (Canal Co. v. Clark 13 Wall. 311; Hochler v. Sanders, 122 N. Y. 65; Connell v. Reed, 128 Mass. 477; Glendon Iron Co. v. Uhler, 75 Pa. St. 467; Loughman v. Piper, 128 Pa. St. 1; Amoskeag Mfg. Co. v. Spear, 2 Sandf. 599.) *Columbia Mill Co. v. Alcorn, 65 O. G. 1916, C. D. 1893, 150 U. S. 160.

276. "Turkish" *held* not registrable for a veterinary remedy, because geographical. Ex parte Nau, 55 MS. D., July, 1894 (Fisher, Ass't Com'r).

277. "New England," as trade-mark for crackers, biscuit, etc., *held* geographical. Ex parte Schmidt Baking Co., 55 MS. D., July, 1894 (Fisher, Ass't Com'r).

278. "Columbia," as trade-mark for water-wheels, *held* geographical. Ex parte The James Leffel Co., 55 MS. D., Aug., 1894 (Fisher, Acting Com'r).

279. "Bay State," as trade-mark for optical goods, *held* geographical. Ex parte Bay State Optical Co., 57 MS. D., Aug., 1895 (Fisher, Acting Com'r).

280. "Crawford," for bicycles, *held* merely geographical, besides being objectionable as the name of the applicant. Ex parte The Crawford Mfg. Co., 57 MS. D., Aug., 1895 (Fisher, Acting Com'r).

281. "Cedar Valley," as a trade-mark for spirituous liquors, refused as geographical. Ex parte Bowman, 57 MS. D., Sept., 1895 (Fisher, Acting Com'r).

282. The head of an Indian and the words "North America" refused registration on the ground that the words are geographical and the head had been anticipated. Ex parte Spencer, 57 MS. D., Sept., 1895 (Fisher, Acting Com'r).

283. "The 'Formosa' Doubly Woven Finger Tips," as a trade-mark for gloves, refused registration on the ground that "Doubly Woven Finger Tips" is descriptive and "Formosa" is geographical. Ex parte Lord & Taylor, 58 MS. D., Nov., 1895 (Fisher, Acting Com'r).

284. "Argyle," as a trade-mark for bitters, *held* geographical. Ex parte Brunswig, 58 MS. D., Oct., 1895 (Fisher, Acting Com'r).

(This case subsequently remanded to examiner without prejudice, and, upon further consideration, registration allowed.)

285. The words "Green Mountain," applied to grapes and provisions and indicating local origin, *held* not to constitute a valid trade-mark. *Hoyt v. J. T. Lovett Co., 71 Fed. Rep. 173 (1895).

286. Injunction granted restraining defendants from combining the words "Genesee," "Salt," "Co." and "Factory Filled" to resemble plaintiff's combination, but denied as applied to the word "Genesee" alone, which represents the locality of the manufacture, and which the defendants are entitled to use. *Genesee Salt Co. v. Burnap, 73 O. G. 451, C. D. 1895.

287. The word "Cloverdale" primarily has a geographical meaning and should not be registered. (Columbia Mill Co. v. Alcorn, 65 O. G. 1916, followed.) Ex parte Hendley, 72 O. G. 1654, C. D. 1895.

288. The classes of geographical names which may not be registered as trade-marks are: 1. Common and well-known names, such

as New York, San Francisco, United States. 2. Terms having primarily a geographical meaning; for example, those ending with such words as "city," "town," "mount" or "mont," "shire." *Id.*

289. "Florence," as a trade-mark for knitted goods, *held* geographical. *Ex parte* Camden Knitting Co., 58 MS. D., March, 1896 (Fisher, Ass't Com'r).

290. The word "Genesee," as used, obviously refers to the place of production and is not a trade-mark. The defendants may rightfully call their salt "Genesee Salt" or "Genesee County Salt," provided they do not mislead the public into buying their salt as the salt of the complainant. **Genesee Salt Co. v. Burnap*, 73 Fed. Rep. 818 (1896).

291. "Old Yorkshire Hills," as a trade-mark for paper, refused registration on the ground of being geographical, and also as being anticipated by "York Mills," previously registered. *Ex parte* The George C. Gill Paper Co., 62 MS. D., Sept., 1897 (Greeley, Acting Com'r).

292. The manufacture of artificial Carlsbad mineral water, begun before the importation of the natural water into this country, will not be restrained, though the manufacturer will be required to use the word "artificial" upon his labels in order to describe his product more fully. **City of Carlsbad v. Schultz*, 79 O. G. 1361; C. D. 1897.

293. W. used the word "Columbia," and M. used the figure of the goddess Columbia with the name "Columbia." Both marks were applied to paper, which became known by the name "Columbia." W. then added a figure of Columbia similar to that used by M. Although W. was the first to use the word "Columbia" on his goods, it cannot be said that he acquired a technical trade-mark in the word "Columbia" in view of the decision in *Columbia Mills Co. v. Alcorn* (150 U. S. 160). **Morgan Envelope Co. v. Walton*, 81 O. G. 1615, C. D. 1897.

294. Inasmuch as W. appeared to have been the first to put upon his goods the distinguishing mark "Columbia," and as his goods were the first to become known to purchasers as "Columbia," no other person should be permitted to use the name as the sole distinguishing mark for like goods, whether expressed in letters or figures, and in that manner mislead the general public into buying his goods as those of his competitors. If the word could not be used as a trade-mark, it is to be treated as a descriptive word, to the benefit of which W. is entitled. **Id.*

XXI. GEOGRAPHICAL NAMES USED ARBITRARILY OR FANCIFULLY.

295. "Concord," for soap, *held* arbitrary. *Ex parte* Proctor & Gamble, 38 MS. D., Aug., 1888 (Hall, Com'r).

296. Complainant and its predecessors had for many years manufactured and sold scythe-stones under the trade-marks "Lamoille," "Green Mountain," "Black Diamond," "Indian Pond," "Magic" and "Willoughby Lake." Defendants, having succeeded to a company which had contracted to purchase complainant's scythe-stones for a series of years, refused to carry out that contract, but, having procured quarries near to some of complainant's quarries, were manufacturing and selling scythe-stones under the above names, except that they used in place of "Willoughby Lake" "Willoughby Ridge," and in place of "Black Diamond" "Diamond Gem," these names never having been used to designate stones taken from defendants' quarries. *Held*, that a preliminary injunction would be granted restraining defendants' use of all the names whatever the decision might be were the question alone as to the terms "Willoughby Ridge" and "Diamond Gem." **A. F. Pike Mfg. Co. v. Cleveland Stone Co.*, 45 O. G. 947, C. D. 1888.

297. It cannot be said that the above terms, as applied to scythe-stones, indicate alone quality of the stones; but they must be held to indicate a selection and care in manufacturing. **Id.*

298. The manufacturer of goods who has for many years used as a trade-mark the geographical terms "Lamoille" and "Willoughby Lake" will be protected in their use as against one who does not carry on business in the districts so designated. **Id.*

299. The word "Dover" *held* to be registrable as a trade-mark, it not being used by applicant in its geographical but in a fanciful or arbitrary sense. *Ex parte* Dover Stamping Co., 51 O. G. 1784, C. D. 1890.

300. The word "Cromarty," being the name of a town in Scotland famous for its herring fisheries, is not registrable as a trade-mark for cured fish. Others with at least equal truth might use it upon packages containing the same article of merchandise. *Ex parte* Proctor, Jr., 51 O. G. 1785, C. D. 1890.

301. The word "Vienna" declared entitled to registration as a trade-mark for flour, it appearing that no flour made in any town called "Vienna" in this country has been placed upon

the market under the name "Vienna;" that no flour is upon the market coming from Vienna, Austria; that the word was arbitrarily selected by the petitioner, and that it is the custom in the flour trade to use fanciful names to designate flour, rather than the names of places of production. *Ex parte Jenkins*, 53 O. G. 759, C. D. 1890.

302. While the fact that flour from Vienna, Austria, is not on sale upon this market would not of itself authorize registration, when foreign commerce is invoked as a basis of registration, it does not appear in the present case that flour from Vienna, Austria, has any reputation in the markets of the world or that the word "Vienna" would indicate to a purchaser that the flour upon which it was used came from that city. *Id.*

303. "Berlin" *held* registrable for cotton goods known as silesia, since it had no connection with the city of that name, and it was not shown that such place was well known as producing the article to which the mark was to be applied. *Ex parte Hyde and Son*, 45 MS. D., 246, 3 G. W. D., Jan., 1891 (*Fisher, Ass't Com'r*).

304. A mere geographical name is not registrable as a trade-mark unless from some unusual state of facts it has obtained an arbitrary or fanciful meaning of greater substance and value than its mere geographical sense. *Ex parte American Saw Co.*, 58 O. G. 521, C. D. 1892.

305. The name "Columbia" as applied to a hotel is a fanciful name, indicating no people, no locality, and no particular service which a hotel will render, and the person first selecting it is entitled to its use. *†Whitfield v. Loveless*, 64 O. G. 412, C. D. 1893.

(See decision of supreme court in *Columbia Mill Co. v. Alcorn*, 65 O. G. 1916, C. D. 1893.)

306. A name, although generic and geographical, is within the rule of protection in law if it does not indicate that the business carried on is to be patronized by the people of any particular locality, or that any specific product is therein to be sold, or any particular language is there to be spoken. *†Id.*

307. The registration of the word "Florentine" as a trade-mark for glass granted, as Florence is not noted as a place for the manufacture of glass, and therefore no deception as to the quality or origin of the manufacture can occur. *Ex parte Mississippi Glass Co.*, 64 O. G. 713, C. D. 1893.

308. As was held in *Ex parte Green* (8 O. G.

1875), "a geographical name, like any other word, may be chosen and arbitrarily applied, and in such instance become a lawful trade-mark." *Id.*

309. The word "Waverley," while it is used to designate localities, yet it is not "merely a geographical name" in the sense employed by the supreme court in *Columbia Mill Co. v. Alcorn* (65 O. G. 1916), and may be registered. *Ex parte Indiana Bicycle Co.*, 72 O. G. 1654, C. D. 1895.

310. "Como," for water-closets, *held* not merely geographical in character. *Ex parte L. M. Rumsey Mfg. Co.*, 58 MS. D., Jan., 1896 (*Fisher, Ass't Com'r*).

311. "Runnymede," as a trade-mark for whisky, *held* to be used in a romantic sense overcoming its geographical significance. *Ex parte The Mellwood Distillery Co.*, 58 MS. D., Jan., 1896 (*Fisher, Ass't Com'r*).

312. "Berkeley," for whisky, registered upon evidence that it was a family name, used in New York, and had no connection with any place of that name, and that registration had been once granted to another party. (*Rehearing.*) *Ex parte Nicholas*, 58 MS. D. 315, Feb., 1896 (*Fisher, Ass't Com'r*).

313. The word "Alpine," as a trade-mark for medicinal lozenges, *held* fanciful, and not geographical. *Ex parte Haviland*, 59 MS. D., June, 1896 (*Fisher, Acting Com'r*).

314. Words which in their primary signification are not geographical, even though they appear in the Postal Guide or similar publications, are registrable. Such words as "Trilby," "Creole," "Puritan," "Volunteer," are good examples of this class. They are not words in common use as designating locality or section of a country. *Ex parte Hendley*, 72 O. G. 1654, C. D. 1895.

315. While it is true that "Menlo Park" is a geographical term, it does not stand on the same footing as the word "Columbia" or "Lackawanna" or "International" or "East India," all of which have been held not to be lawful trade-marks. (*Columbia Mills v. Alcorn*, 65 O. G. 1916.) *Ex parte Hampden Watch Co.*, 81 O. G. 1282, C. D. 1897.

316. While it is true that Menlo Park is the name of a small town in New Jersey and is also the name of a town in San Mateo county, California, it does not appear that either of these localities is a manufacturing town. Certainly in neither of these towns is the manufacture of watch movements carried on. (*Examiner reversed.*) *Id.*

XXII. GOOD-WILL.

(See ASSIGNMENT, *supra*.)

317. Where the proprietor of a medicine transfers the right to use his trade-mark and formula without transferring the place of manufacture, or plant used, or the good-will of the business, and there is no exclusive right to manufacture the medicine in any one, and there is nothing in the trade-mark to indicate that the medicine comes from a particular manufactory, the grantee cannot restrain another person from using it, as the only effect of the trade-mark is to indicate a class of goods which any one who knows how may manufacture. †Chadwick v. Covell, 51 O. G. 2087, C. D. 1890.

318. Where the said proprietor of said trade-mark and formula had no exclusive right to the use of his formula, *held*, that his only right was to prevent any one from obtaining or using said formula through a breach of trust or contract, and that any one who came honestly to the knowledge of it could use it without the proprietor's permission and against his will. †*Id.*

319. *Held*, that the title "Prince's Metallic Paint" had become so localized — so identified with the Prince Mine and place of manufacture — that it was inseparable therefrom (cases cited), and the trade-mark passed as an incident of the property with the possession of the works. *Prince's Metallic Paint Co. v. Prince Mfg. Co., 57 Fed. Rep. 938 (1893).

320. A trade-mark is a means for rendering more distinctive and valuable the "good-will" of a business. The right to the mark will ordinarily pass, as incidental to the good-will, to a successor who takes the business, and it becomes extinct when the business, including the good-will, becomes extinct. *Royal Baking Powder Co. v. Raymond, 70 Fed. Rep. 376 (1895).

321. The good-will may persist for a time after the business itself has ceased. It, including the trade-marks used, may exist even for a series of years after the stoppage of business by accident or design, and may be found valuable upon resumption. **Id.*

(The sale of a business is the sale of the good-will, and good-will need not be in evidence. *Browne on Trade-marks, sec. 522.)

XXIII. INFRINGEMENT.

(See FRAUD; INJUNCTION.)

(a) *In General.*

322. The mere addition of the word "improved" will not justify the use of a trade-

mark which is objectionable because of resemblance to a trade-mark in use by another person. †Russia Cement Co. v. La Page, 44 O. G. 823, C. D. 1888.

323. Where in suit for the infringement of a trade-mark exhibits of the devices used by both complainant and defendant accompany the bill, the court will sustain a demurrer to the bill where the exhibits show that there is no infringement. *Collins Chemical and Mfg. Co. v. Capitol City Mfg. Co., 52 O. G. 162, C. D. 1890.

324. The sale of merchandise in bulk under a trade-mark of the maker does not justify the vendee in using the same trade-mark on smaller and retail packages. *Krauss v. Jos. R. Peebles' Sons' Co., 58 Fed. Rep. 585 (1893).

325. The court may compare the trade-mark of complainant with the device used by the respondent to determine their identity, and does not necessarily require the testimony of witnesses to prove the likeness. *Von Mumm v. Frash, 68 O. G. 143, C. D. 1894.

326. Selling an imitation, as such, without any suggestion or arrangement that it be sold again for the genuine article, although with assent to such suggestions from others, does not infringe the right of the manufacturer of the genuine. *Hostetter Co. v. Van Vorst, 69 O. G. 1648, C. D. 1894.

327. The likelihood of deception of an ordinary purchaser exercising ordinary care is the test applied to alleged infringement of trade-marks, but regard must be had to the class of persons who purchase the article for consumption, and also to the circumstances ordinarily attending their purchase. In determining whether packages are so dressed up as to deceive purchasers, we should regard rather the effect on the consumer than the jobber. In such cases the danger of deception rather than the intent governs the court. *N. K. Fairbank Co. v. R. W. Bell Mfg. Co., 77 Fed. Rep. 869 (1897).

328. A decree of a circuit court in one circuit enjoining infringement and unfair competition is not conclusive in a suit by the same party in another circuit against an agent of the principal where such decree is merely interlocutory and still subject to the control or modification of the court. *Walker Baker & Co., Limited, v. Sanders, 80 O. G. 1476, C. D. 1897.

(b) *Particular Cases.*

329. Trade-mark must be confined to the name adopted, with the form and color of the

letters used on the printed label. *Held*, that the title or name "Sapota Tolu" is not infringed by "Elastic Tolu." *Adams v. Heisel, 31 Fed. Rep. 279 (1891).

330. The word "Celluloid" is a lawful trade-mark, and the word "Cellonite" is sufficiently like it to produce the mischief which is in the purview of the law. "Cellonite Manufacturing Company" is an infringement of "Celluloid Manufacturing Company." *Celluloid Mfg. Co. v. Cellonite Mfg. Co., 41 O. G. 693, C. D. 1887.

331. When a trade-mark has been extensively used nearly twenty years prior to date of suit, and there is no evidence of fraud, or even knowledge of complainants' right, on the part of the defendant, he cannot be held liable to account for past sales and damages in view of such laches. *Low v. Fels, 35 Fed. Rep. 361 (1888).

332. The complainant's mark — a star made of tin a little over one-half inch in diameter, having five points and a round hole in the center and attached to the plug by prongs at the back — is not infringed by the defendant's mark, consisting of a round piece of gilded paper over three-fourths of an inch in diameter, having on it a red star, under which the word "Light" is printed, forming by the figure and word the word "Starlight." *The Liggett and Myers Tobacco Co. v. Finzer, 45 O. G. 943, C. D. 1888.

333. The head of an elk and the word "Elk," *held* a valid trade-mark, and infringed by substantially the same symbols. *Lichtenstein v. Goldsmith, 37 Fed. Rep. 359 (1889).

334. Where it is charged that the defendant has imitated the packages of the plaintiff for the purpose of imposing the goods of the former upon the public as those of the latter, not only must the fact of imitation be shown, but it must also appear that the imitation was made with intent to impose upon the public as aforesaid, and such intention may be presumed from the fact of imitation; but the presumption is not conclusive, and may be overcome by facts showing that the imitation was for other and innocent purposes. †Hoeb v. Bishop, 49 O. G. 1845, C. D. 1889.

335. Complainant puts up its hair-crimpers in packages, in a red pasteboard box, on the cover of which is a white label with a black border and in the center the head of a woman with hair curled, together with the words "Madam Louie, Common-Sense Hair-Crimper." Defendant dealt in crimpers packed in a simi-

lar manner, in red boxes with white labels, and in the center of the label is the head of a female surrounded by the words "The Langtry, Elegantes, One gross No. 1, Black, Hair-Crimpers." Complainant's crimpers were smaller than defendant's and much heavier, and the wrappers were unlike in length and in the words printed thereon. Defendant had the prior right to the use of the white label and the central vignette, and the labels were dissimilar in form, language, type and general appearance. There was no evidence that any one was ever misled by any resemblance between the two. *Held*, that defendant did not infringe complainant's trade-mark. *Philadelphia Novelty Mfg. Co. v. Rouss, 50 O. G. 1594, C. D. 1890.

336. In a suit for infringement, although it seemed to be clear that when the defendants made what are known as "Warren Hose-Supporters" they had the right to designate them as such, *held*, that that did not include the right to represent in any manner that their goods came from others, and that complainants' trade-mark was infringed by the use of the word "Warranted" in place of "Warren," with a cut similar to that of complainants' label, and with numbers and words indicating sizes and quantity in similarity to those on complainants' label. *Frost v. Rindskopf, 51 O. G. 1131, C. D. 1890.

337. Where in an action for infringement the complaint alleged that defendants had appropriated and used on their advertisements, circulars, letter-heads, etc., relating to their publication, the device of an open book which complainants had theretofore been in the habit of using for like purposes; that defendants used the words "Webster's Dictionary" or "Webster's Unabridged Dictionary" placed in the same relation to their publication that complainants placed them, and that the date of defendants' publication on the title-page was given as of the year 1890, when, in fact, the book was a reprint or photolithographic copy of the edition of Webster's Dictionary of 1847, *held* that, as there might be some evidence of a fraudulent intent on defendants' part to get the benefit of the reputation of the edition of Webster's Dictionary published by complainants, and as the public might possibly be deceived and the complainants damaged to some extent in consequence of the facts averred, a demurrer to the complaint should be overruled. *Merriam v. Holloway Publishing Co., 53 O. G. 1409, C. D. 1890.

338. A trade-mark with the words "Brown's

Iron Tonic" upon it does not infringe another bearing the words "Brown's Iron Bitters," when the cartons and bottles in which the two medicines were offered to the public were wholly different in size, color and appearance, and the labels and wrappers were correspondingly different. *Brown Chemical Co. v. Meyer, 55 O. G. 287, C. D. 1891.

339. Plaintiff having failed to establish the existence of a trade-mark in the letters "LL" or that they constitute a material element in its trade-mark, relief cannot be accorded upon the ground of an infringement by defendant of an exclusive right in the plaintiff to use the letters as against all the world. *Lawrence Mfg. Co. v. Tennessee Mfg. Co., 55 O. G. 1528, C. D. 1891.

("LL" indicated class or quality and were used by other manufacturers.)

340. Complainants' trade-mark "G. F." held infringed by the use of defendants' trade-mark "G. & F." on a similar class of goods, with the ampersand much smaller than the initials, when as registered and used on other goods the ampersand and initials are of uniform size. *Giron v. Gartner, 57 O. G. 1430, C. D. 1891.

341. "Bromidia," a coined word, held a lawful trade-mark, and defendant's use of it held an infringement, although in respect to the rest of the title and the appearance of the label there was a considerable dissimilarity. *Battle & Co. v. Finlay, 45 Fed. Rep. 796 (1891).

342. Complainants' and defendants' wrappers and labels for tobacco packages so closely resemble each other as to deceive dealers and purchasers, although the names "Sweet Lotus" and "Peach Blossom," used by the respective parties, are not similar. *Wellman & Dwire Tobacco Co. v. Ware Tobacco Works, 46 Fed. Rep. 289 (1891).

343. The words "Cramp Cure" were described in the statement as used in connection with a pictorial illustration but not as an essential part of the trade-mark. Held, that a suit for infringement could not be maintained, the words being descriptive. *L. H. Harris Drug Co. v. Stucky, 46 Fed. Rep. 624 (1891).

344. The complainant's place of business was in Paris, Kentucky, and the defendant's in Boston. Complainant had no knowledge of defendant's label or infringement prior to 1889, and suit was brought in 1890. Held, there was no laches. *G. G. White Co. v. Miller, 50 Fed. Rep. 277 (1892).

345. The trade-mark consisting mainly of

the picture of a chicken cock standing upright within a circle, surrounded by the words "Old Bourbon Whiskey, Bourbon County, Ky.," held infringed by a trade-mark consisting of a cock standing upright in a circle, the whiskies to which such marks were applied being known respectively as "Chicken Cock" and "Game Cock." *Id.

346. The word "Lone" prefixed to Star, held not to avoid infringement of complainant's Star trade-mark. *Hutchinson v. Covert, 50 Fed. Rep. 832 (1892).

347. "Epicure" was used by complainant as a trade-mark for canned salmon, and a business built up under it. At a prior date defendants had used the word as a trade-mark for canned tomatoes and canned peaches. Held, this did not entitle the defendants to use it on canned goods of every variety, salmon included. *George v. Smith, 52 Fed. Rep. 830 (1892).

348. Hohner's harmonicas are made in Württemberg and sold in this country under his name. Defendant uses the word "Improved Hohner" with other less prominent advertising matter. Held, this constitutes infringement. *Hohner v. Gratz, 52 Fed. Rep. 871 (1892).

349. Complainant's trade-mark—a representation of the sun and rays with a certain legend on the face thereof,—held not infringed by a design having an imperfect outline resembling the sun's rays, but having a distinctly different and prominently-printed legend, and where it does not appear that the alleged infringing device ever worked deception upon a purchaser. *Jaros Hygienic Underwear Co. v. Simons, 58 O. G. 1095, C. D. 1892.

350. Complainant, California Fig Syrup Company, manufactured a syrup from figs and put it up in packages, having as a device thereon a fig-tree, with leaves and fruit, and the words "Syrup of Figs" as a trade-mark. Respondent, Improved Fig Syrup Company, made and put up the same article in a package with the same device and the words "Improved Syrup of Figs" as a trade-mark. Respondent, on remonstrance, changed its device to the figure of a woman holding up a fig, with the words "Fig Syrup" as a trade-mark, all of which occupied the same place and space on the package as complainant's device and was, besides, an imitation of complainant's newspaper advertising device. Held, that complainant was entitled to an injunction. *California Fig Syrup Co. v. Improved Fig Syrup Co., 61 O. G. 155, C. D. 1892.

351. A trade-mark consisting of the word

"Star" and the symbol of a star is infringed by marking similar goods with a star and crescent, making the star so prominent that such goods may also be designated as "Star Goods," and purchasers may be readily deceived into the belief that the goods were made by the proprietors of the trade-mark, even though the star so used is not of the color usually employed for the trade-mark, and of a five-pointed star, while that in the trade-mark is uniformly six-pointed. *Hutchinson v. Blumberg, 61 O. G. 1017, C. D. 1892.

(See foot-note under "Alternatives.")

352. "One Night Cure," held not infringed by words "Beshore One Night Cough Cure." *Kohler Mfg. Co. v. Beshore, 62 O. G. 592, C. D. 1894.

353. A trademark registration held conclusive as to description of plaintiff's mark where he sought to enlarge its terms on a suit for infringement. *Id.

354. Defendants infringe the trade-mark rights of the California Fig Syrup Company when they apply to their laxative compound the name "Syrup of Figs" or any colorable imitation of that name, as such a name does not describe defendants' compound, but merely serves to induce the public to believe that the goods made and sold by them are those manufactured by the California Fig Syrup Company. *Improved Fig Syrup Co. v. California Fig Syrup Co., 64 O. G. 158, C. D. 1893.

355. While there may be a difference between defendants' packages of laxative compound and the packages of the California Fig Syrup Company's laxative compound, and such a difference as to probably put the general trade dealer on his guard, yet, defendants having adopted the trade-name of the California Fig Syrup Company, the consumer is likely to be deceived thereby, and it is against the probability of such imposition upon the consuming class of the public that courts will extend their protection. *Id.

356. Two classes of labels are recognized by cigar manufacturers — "factory brands" and "customers' brands." The latter are originated by a customer, and used only on goods manufactured for him. A cigar merchant ordered a lot of cigars, of a certain size and quality, under the name of "Blackstone," which he originated. This order the manufacturer filled; but the cigars were not taken by the merchant, and were sold to other parties. Held, that the

manufacturer acquired no right to use the word "Blackstone" as a trade-mark. *Levy v. Waitt, 65 O. G. 893, C. D. 1893.

357. "One Night Cure," used as a trade-mark for a cough remedy and for a corn remedy, is not infringed by the use of the words "Beshore's One Night Cough Cure." (62 O. G. 592, 53 Fed. Rep. 262, affirmed.) *Kohler Mfg. Co. v. Beshore, 67 O. G. 678, C. D. 1894.

358. When the complainants applied a name to a small lot of cigars made to a special order in 1878, and did not again apply the name to cigars until 1884, and then for the purpose of competing with another party who had applied the same name to cigars in 1881, and not again until 1889, and when the defendants, in 1885, without knowledge of what had been done by complainants, and in good faith, applied the name to cigars of their own manufacture, and made continued and extensive sales and advertisements thereof for five years without objection, held, that the complainants are not entitled to assert a right to a trade-mark in the name as against the defendants. *Levy v. Waitt, 68 O. G. 1521, C. D. 1894.

359. The use of the word "Cottoleo" on the tierces and tubs containing a compound of cotton-seed oil and the product of beef-fat is an infringement of the trade-mark "Cottolene" previously registered for the sale of the same substance and used in marking tierces and tubs. *N. K. Fairbank Co. v. Central Lard Co., 70 O. G. 635, C. D. 1895.

360. It is no defense to a suit for infringement of the trade-mark "Cottolene" by the use of the word "Cottoleo" that defendant sold under his own name, and made no attempt, other than by the use of the word "Cottoleo," to sell his goods as if manufactured by plaintiff. *Id.

361. Where the defendant had the right to use the words "Waukesha Hygeia Mineral Springs" and the complainant the word "Hygeia" as trade-marks, held, that the defendant did not infringe the complainant's mark by making the word "Hygeia" more conspicuous than other words. *Waukesha Hygeia Mineral Springs Co. v. Hygeia Sparkling Distilled Water Co., 70 O. G. 1321, C. D. 1895.

362. The word "Mojava" so nearly resembles "Momaja" as to cause confusion. *American Grocery Co. v. Bennett, Sloan & Co., 71 O. G. 1770, C. D. 1895.

363. The registered trade-mark "S. B.," for cough drops, held not infringed by the use of

the trade-mark "B. & S." *Burt v. Smith, 71 Fed. Rep. 101 (1895).

364. M. A. Thedford, being engaged with others, under the firm-name of M. A. Thedford & Co., in the manufacture and sale of "Simmons' Liver Medicine," sold to his partners all his rights therein, and bound himself not to engage in manufacturing the said medicine "under any name or style." Afterward he formed a partnership, under the firm-name of M. A. Thedford Medicine Company, which made and sold a compound called "M. A. Thedford's Liver Invigorator," which they placed upon the market in wrappers and packages and with symbols and literature calculated to induce the belief that it was the "Simmons' Liver Medicine." *Held*, that this was a clear infringement upon the rights of his transferees, and that it was no defense that the latter had discontinued the use of the word "Simmons" and called their medicine "M. A. Thedford & Co.'s Original and Only Genuine Liver Medicine, or Black Draught." (58 Fed. Rep. 347, reversed.) *Chattanooga Medicine Co. v. Thedford, 73 O. G. 2163, C. D. 1895.

365. A trade-mark consisting of a label upon which appears, on a white background, in two colors—red and black—certain words, in the midst of which is displayed, in a large-sized cut, in prominent black colors, an old-fashioned flat-iron, is not infringed by another trade-mark in the form of a label having certain words prominently displayed on a deep-red background, in three colors—white, yellow, and black—having about the middle of this display, on a steel-colored background, a full-length picture of a colored woman holding up prominently in her extended arms a freshly-ironed shirt-bosom, underneath which is a table, upon which appears a diminutive-sized flat-iron. The phraseology, the display, the colors, and the symbols of the two labels are each and all essentially different. *J. C. Hubinger Bros. Co. v. Eddy, 76 O. G. 1120, C. D. 1896.

366. No trader can adopt a trade-mark so resembling that of another trader as that ordinary purchasers, buying with ordinary caution, are likely to be misled. No person of ordinary discernment could be deceived by the presence of this little iron, and any supposed similarity between it and the complainants' well-displayed large flat-iron, and thus led to believe he was purchasing complainants' article. *Held*.

367. "Fairbank's Gold Dust" soap was put up in yellow paper and "Buffalo Soap Powder" was put up in a similar wrapper. *Held*, that a buyer of ordinary prudence would not be imposed upon by the similarity of the yellow packages in view of the printed matter thereon. (Following Novelty Co. v. Blakesley, 40 Fed. Rep. 588; Novelty Co. v. Rouss, id. 585; Munn v. Kirk, id. 589.) *N. K. Fairbank Co. v. R. W. Bell Mfg. Co., 71 Fed. Rep. 295 (1896).

368. "Curative" for soap, *held* an infringement of the coined word "Cuticura." *Potter Drug & Chemical Corporation v. Miller, 75 Fed. Rep. 657 (1896).

369. The words "German Sweet Chocolate" (German being the name of the individual who registered the trade-mark) are proper in a trade-mark, since "German" is not used in a geographical sense, and is infringed by the words "Germania Sweet Chocolate." *Walter Baker & Co., Limited, v. Baker, 78 O. G. 1427, C. D. 1897.

370. *Held*, that the Greek cross has not such individuality as to give the complainants the exclusive right to use it; and *held*, that the Maltese cross, having a red center and dark projections, is not an infringement of it. *Johnson v. Bauer, 79 Fed. Rep. 954 (1896).

371. "No-To-Bac," *held* an arbitrary term, and not infringed by "Baco-Curo," also an arbitrary term. The test is whether one is likely to be taken for the other by persons of ordinary intelligence. *Sterling Remedy Co. v. Eureka Chemical and Mfg. Co., 80 Fed. Rep. 105 (1897).

372. A trade-mark consisting of a red Greek cross, used to designate "Red Cross Plasters," is infringed by a Maltese cross having a red center. *Johnson & Johnson v. Bauer & Black, 82 Fed. Rep. 662 (1897).

XXIV. INJUNCTION.

(See FRAUD; INFRINGEMENT.)

373. The marks, designs, symbols, directions and other *indicia* placed upon the boxes or packages containing the articles upon which the patent had expired may be treated as a kind of trade-mark, and a manifest imitation be enjoined. Greene v. Woodhouse, 38 O. G. 1491, C. D. 1887.

374. Equity will enjoin the fraudulent use of bottles having complainant's name blown in them. It will also enjoin the fraudulent

use of a bottle having the same general appearance as that employed by complainant. *Sawyer v. Crystal Blue Co. v. Hubbard, 41 O. G. 580, C. D. 1887.

375. A court of equity will prevent the piracy of a business name, and the fact that the defendant's name is a corporate name is of no moment. *Celluloid Mfg. Co. v. Cellonite Mfg. Co., 41 O. G. 693, C. D. 1887.

376. An injunction declared for the word "Chatter-box" as a trade-mark name for juvenile books, although it had been previously used on other publications, for youthful persons. The defendant's publications were similar to the plaintiff's in external appearance, but their contents were dissimilar. *Estes v. Worthington, 31 Fed. Rep. 151 (1887).

377. Injunction under Trade-mark No. 16,473, registered April 9, 1889, by Moses Lyman, for a game, "Pigs in Clover." *Lyman v. Burns, 47 O. G. 669, C. D. 1889.

378. The word "Valvoline," compounded and used on packages of lubricating-oils by plaintiffs, and registered as a trade-mark, may be used for that purpose, and the use thereof by defendant in the same manner will be enjoined, though defendant uses his own name in connection with the word. *Leonard v. White's Golden Lubricator Co., 48 O. G. 1461, C. D. 1889.

379. In a suit to restrain use of plaintiff's trade-name or trade-mark applied by him to an article for which he had obtained a patent, held, no action for violation of right to the name apart from right to the patent could be maintained. †Waterman v. Shipman, 49 O. G. 892, C. D. 1889.

380. In such case plaintiff must obtain redress either by a suit for infringement of the patent, if he has a legal title to the patent, of which the federal courts alone have jurisdiction, or by a direct action to compel a re-assignment of the patent, in which the defendants can be made to account for any profits. †Id.

381. The manufacture of an uncooked pudding, put up in packages under the trade-mark name of "Puddine," cannot enjoin the maker of a similar preparation from using the word "Pudding" in describing it. *Clotworthy v. Schepp, 52 O. G. 161, C. D. 1890.

382. The use of the word "Rose" in connection with the word "Vanilla" as a trade-mark is no ground for enjoining a rival maker of similar products containing those well-known flavors from using those words in describing his goods. *Id.

383. A manufacturer who falsely represents the composition of his goods by the labels on his packages is in no position to enjoin a rival manufacturer from using similar labels and packages, on the ground that the latter thereby deceives the public. *Id.

384. As it appears that the plaintiff manufactures and sells Hostetter's Bitters" and is the owner of trade-marks, brands, labels, etc., used in connection with such sale; that the defendant makes an article closely resembling such bitters, which it sells in bulk, advising its customers to refill bottles that had originally contained Hostetter's Bitters with the spurious article, and to offer them for sale, it is held that the plaintiff is entitled to an injunction restraining the defendant from selling the spurious article, and that the customers using the bottles and labels in the way indicated are guilty of a wrongful act, which a court of equity will enjoin. *Hostetter Co. v. Brueggeman-Remhart Distilling Co., 56 O. G. 530, C. D. 1891.

385. A manufacturer of cigars whose goods are protected by trade-mark is entitled to an injunction against a manufacturer of cigar-boxes who, although he does not make cigars, furnishes the trade with boxes supplied with labels confessedly counterfeits of the complainant's registered mark. *Cuervo v. Jacob Henkell Co., 60 O. G. 440, C. D. 1892.

386. The fact that plaintiff's trade-mark, "Syrup of Figs," being merely descriptive, was deceptive as a designation of the compound did not affect plaintiff's right to an injunction, the matter in controversy being not the right to the exclusive use of the words, but respondent's simulation of complainant's devices and packages with a view to deceive customers. *California Fig Syrup Co. v. Improved Fig Syrup Co., 61 O. G. 155, C. D. 1892.

387. The facts that the infringer of a trade-mark, on being notified of his infringement, told his customers to erase the trade-marks from their goods and had since gone out of business, are not ground for denying an injunction to the true owner of the trade-mark, where every step of the suit for an injunction and accounting has been contested by the infringer, and he has put the complainants to the expense of proving every fact necessary to establish their right and his infringement. *Hutchinson v. Blumberg, 61 O. G. 1017, C. D. 1892.

388. Query, whether equity will intervene by injunction to protect the use of words claimed

as a trade-mark between owners of quack medicines. *Kohler Mfg. Co. v. Beshore, 67 O. G. 678, C. D. 1894.

389. It seems that an injunction should not be granted to protect the use of words as the trade-mark of a medicinal preparation which assert a manifest falsehood or physiological impossibility. *Id.

390. In such a suit the statement filed to obtain registration and attached to the affidavits on motion for a preliminary injunction may be considered on the final hearing. *Id.

391. The words "Social Register," as applied to a list of persons resident in a certain locality, compiled by its publisher with reference to the personal and social standing of such persons, constitute a valid trade-mark, and their use by the publisher of a competing list will be restrained. *Social Register Association v. Howard, 67 O. G. 1418, C. D. 1894.

392. Plaintiffs have used the name "Carlsbad" on genuine "Carlsbad Sprudel Salts," and defendants used it upon artificial salts having no connection with that name. *Held*, that this was calculated to deceive customers, and injunction granted. *City of Carlsbad v. Kutnow, 68 Fed. Rep. 794 (1895).

393. Complainants sold Hostetter's Bitters. Defendants sold bitters called "Host-Style Bitters" and put them in bottles bearing Hostetter labels. Injunction granted. *Held*, also, that defendant might use "Host-Style," provided he did not simulate any labels of complainant. *Hostetter Co. v. Becker, 73 Fed. Rep. 297 (1896).

394. Where the court had decreed that the defendant company be enjoined from using, selling, or placing upon the market in connection with hooks and eyes the name "De Long" alone or with other words in any manner which might deceive the public as to the identity of the goods sold by the plaintiffs and defendant, respectively, the use by the president of the defendant company of the words "Oscar A. De Long Hook" was a violation of the injunction. ‡De Long v. De Long Hook and Eye Co., 74 O. G. 811, C. D. 1896.

395. Where it is shown that defendant failed to accompany the use of the word "Singer" on the machines made and sold by it with sufficient notice of their source of manufacture to prevent them from being bought as machines made by the Singer Manufacturing Company, and thus operate an injury to private rights and a deceit upon the public, *held*, that he should be enjoined from using the word

"Singer" or any equivalent thereto upon sewing machines or upon any plate or device connected therewith or attached thereto without clearly and unmistakably specifying in connection therewith that such machines are the product of the defendant or a manufacturer other than the Singer Manufacturing Company. *Singer Mfg. Co. v. June Mfg. Co., 75 O. G. 1703, C. D. 1896.

396. Complainant is entitled to an injunction *pendente lite* against the further use by defendants of a square-shaped bulging-necked bottle as a package for "Mount Vernon" whisky, when it appears that complainant was the first to use a bottle of this shape as a package for whisky, and when it also appears that said shape has come to be principally, if not exclusively, relied upon by ordinary customers as a means of identifying this bottling of "Mount Vernon" whisky from all other bottlings. *Cook & Bernheimer Co. v. Ross, 76 O. G. 613, C. D. 1896.

397. Where it clearly appeared that the use by defendants of the name "The Tuerk Water-Meter Company" and the practice in respect thereto adopted by the defendants led to confusion arising from its similarity to the name of the motor of the plaintiff, and that the similarity was such as to cause persons dealing in the articles to suppose it to be the same, *held*, that defendants should be restrained from using the name of "The Tuerk Water-Meter Company," or any other substantial imitation of the name "The Tuerk Water-Motor Company," by which the plaintiff is generally known, or from printing, publishing, issuing or circulating any of the cases, pictures, prints or printed matter used by the plaintiff in catalogues or circulars prior to the formation of the defendants' firm, or any substantial imitation thereof. †Tuerk Hydraulic Power Co. v. Tuerk, 76 O. G. 1274, C. D. 1896.

398. Where exceptions were taken during the trial to a referee's admissions and rejections of evidence, *held*, that such exceptions should be disregarded unless the appellant can show that injustice has been done upon the whole case or that the ruling complained of may have affected the result. †Id.

399. It does not follow that because the complainant is not exclusively entitled to use the words "Clark's Spool Cotton" that therefore it cannot rightfully enjoin a person who is fraudulently making use of its label. *Clark Thread Co. v. Armitage, 76 O. G. 1419, C. D. 1896.

400. When a trade has been built up for "Johann Hoff's Malt Extract" or "Hoff's Malt Extract," a branch house conducted by Leopold Hoff, manufacturing such extract in competition with another branch or with the original business, may not use the name of "Hoff" without indicating which of the Hoff family is the maker. *Tarrant & Co. v. Hoff, 78 O. G. 1107, C. D. 1897.

401. Equitable relief for infringement of a trade-mark will not be denied by reason of inaccurate statements in the complainant's labels when such statements are immaterial. *Id.

402. The defendants having discontinued the sale of the articles for the complainant and having also discontinued the use of the trade-mark, which had been applied thereto, a preliminary injunction is refused. *Saxlehner v. Graef, 81 O. G. 972, C. D. 1897.

403. The question as to whether laches or inaction has in any way impaired the complainant's right to an injunction and whether the continued use of the word "Hunyadi" after sale of complainant's water was discontinued was or was not proper may appropriately be left for final hearing where it appears that this word is not now being used. *Id.

404. Defendants having been the exclusive importers of the Hunyadi Janos waters and having pasted their own individual mark on each bottle sold by them, in addition to the mark of the complainant, and having discontinued the sale of such waters, *held*, that they cannot be restrained from placing the same individual mark on the water which they thereafter handle on the ground of unfair competition, since the complainant has no title to such individual mark. *Id.

XXV. INTERFERENCE.

(See USE AND SALE AS ESTABLISHING TITLE.)

405. The right to registration as between two interfering applicants or between an applicant and a registrant belongs to the one who, if a party to a suit in a court of equity, would be adjudged the owner of the trade-mark. Manitowoc Mfg. Co. v. Dickerman, 57 O. G. 1721, C. D. 1891.

406. Where the subject-matter of application for trade-mark is clearly anticipated by a mark registered under the act of 1870, and the examiner properly refused to declare an interference because of the nullity of such prior registration, and also properly refused registration to the present applicant because the

prior registry makes the mark an anticipation, *held*, the proper course for the office in such a case is to give the applicant under the law of 1870 notice that an application is pending with which his registry would interfere if it were under the existing act and allow him sixty days to make a new application. Ex parte American Lead Pencil Co., 61 O. G. 151, C. D. 1892.

407. The dates of adoption as set forth in interfering applications for the registration of a trade-mark are not conclusive as to the question of lawful title to the mark. Stewart v. Einstein, v. Sawhill, 61 O. G. 287, C. D. 1892.

408. The main question to be determined in a trade-mark interference is priority of such adoption and use as will establish ownership, and this will not be determined in advance of the evidence introduced by the parties in the usual way. *Id.*

409. Trade-mark rule 13, which states that "each applicant and registrant will be held to the date of adoption alleged in the statement filed with his application," *held* to be not inconsistent with law, and therefore has the force of a statute. Stuart Medicine Co. v. Goldaine, 64 O. G. 1005, C. D. 1893.

410. The word "interference" in section 9 of the act establishing the court of appeals of the District of Columbia interpreted and *held* not to mean and include disputes in trade-marks under section 3 of the trade-mark law of 1881, but to be confined to an interference in patent law. *Einstein v. Sawhill, 65 O. G. 1918, C. D. 1893.

411. A trade-mark consisting of the words "Electric Light" alone and another trade-mark consisting of these words accompanied by the representation of the upper part of an electric-light bulb with zigzag rays emanating from it conflict, the words being the "prominent, essential and vital feature" of the marks, and a motion to dissolve the interference denied. Kirby v. McLaughlin & Co., v. Johnston, 72 O. G. 1785, C. D. 1895.

412. The difference in sound between "Capitol" and "Capital" is too small to be noticed by the ordinary purchaser, though the trade-marks themselves are specifically different, and motion to dissolve the interference denied. Lown v. Ohio Coffee and Spice Co., 73 O. G. 1136, C. D. 1895.

413. It is a rule applicable to trade-marks as well as patents that a motion to dissolve should not be transmitted if based on facts brought out in the testimony, instead of on the applica-

tions, or on facts which appeared of record prior to the declaration. The case must take its regular course to final hearing. *Oberhaeuser and Landauer v. Pastor Kneipp Med. Co.*, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

414. In interferences in trade-mark cases a broad claim should not be placed under a narrow issue, but the practice in patent cases of making the issue as broad as the broadest claim should be followed. *S. Hershheim, Bros. & Co., Limited, v. J. H. Hargrave & Son*, 81 O. G. 503, C. D. 1897.

XXVI. JURISDICTION OF COURTS.

415. In a suit for infringement of a trade-mark when both parties are citizens of the same state, a United States circuit court can only entertain jurisdiction on the theory that the complainants have a valid trade-mark, registered pursuant to the act of March 3, 1881, and no relief can be granted because of unlawful competition in trade. The question for the court is whether the complainants have an exclusive right to the alleged trade-mark. **Luyties v. Hollender*, 40 O. G. 119, C. D. 1887.

416. The jurisdiction of a court of equity to give relief against the violation of a trade-mark rests not upon the ground that the defendant is committing a fraud on the public, but entirely on the ground that the defendant is violating a property right of the complainant. *†Schneider v. Williams*, 44 O. G. 1400, C. D. 1888.

417. Under act of congress of March 3, 1881, relating to registration of trade-marks used in foreign commerce, the circuit court has no jurisdiction of a bill for infringement where both parties reside in the state and it does not appear that the trade-mark is used in foreign commerce. **Gravelly v. Gravelly*, 50 O. G. 1538, C. D. 1890.

418. The decision of the supreme court in *Trade-mark Cases* (100 U. S. 82) does not affect the jurisdiction of federal courts in matters relating to trade-marks where the jurisdiction is otherwise secured by reason of diverse citizenship of the parties, since property rights in trade-marks come from the common law and not from the statute. *Battle v. Finlay*, 59 O. G. 2072, C. D. 1892.

419. The court of appeals of the District of Columbia has no jurisdiction of disputes in trade-marks under section 3 of the law of 1881. **Einstein v. Sawhill*, 65 O. G. 1918, C. D. 1893.

XXVII. MANDAMUS.

420. In an application for *mandamus* to compel the collector of customs to examine into the validity of a certain registered trade-mark which he had declared simulated on certain imported goods which he had declined to admit to entry under the provisions of section 7 of the tariff act of October 1, 1890, *held*, that the circuit court had no jurisdiction to grant a *mandamus*, and that whether the decision of such officer that any particular import is within the statute's prohibition is reviewable in the courts was not before the court in this proceeding. **Vintschger et al.*, 60 O. G. 441, C. D. 1892.

421. The commissioner, in the present case, having exercised and exhausted his discretion, and having refused to register simply on the ground that he has decided that the act of engaging in foreign trade is *ultra vires* the relator, *held* proper case for peremptory *mandamus*, the relator having complied with the provisions of the trade-mark statute and the lawful regulations of the patent office. **United States ex rel. the State of South Carolina v. Commissioner of Patents*, 65 O. G. 1221, C. D. 1893.

(Decision of the supreme court of the District of Columbia.)

422. The duties imposed upon the commissioner of patents by the trade-mark act of March 3, 1881, are not ministerial, but their discharge requires the exercise of judgment and discretion, and his action in refusing to issue a certificate of registration of a trade-mark cannot be controlled by a writ of *mandamus*. **United States ex rel. the State of South Carolina v. Commissioner of Patents*, 66 O. G. 1167, C. D. 1894.

(Decision of court of appeals of the District of Columbia. For original decision of commissioner of patents, see 61 O. G. 1395, C. D. 1893.)

423. The authority to make regulations and requiring applicants to comply with them seems to imply that the commissioner is left free to institute the necessary inquiry in his own mind. **Id.*

424. *Mandamus* will not lie save in a plain case and where there is no other legal remedy, and under no circumstances can the writ of *mandamus* be made to operate as a writ of error. **Id.*

425. The action of the head of a department in construing the law for his guidance is not subject to revision by *mandamus*. **Id.*

426. The refusal of the commissioner of patents to register a trade-mark does not involve the right to the trade-mark, but the registration of the mark, and it is the value of the registration and not the value of the trade-mark that determines the sum of money involved. *United States ex rel. the State of South Carolina v. Commissioner of Patents, 67 O. G. 1191, C. D. 1894.

427. Where upon the refusal of the commissioner to register a trade-mark a writ of *mandamus* was unsuccessfully sought against him, upon the ground that upon the facts submitted his duty was ministerial and not discretionary, no objection to the validity of the trade-mark law under which the commissioner acted being made, nor the existence or lawfulness of his authority thereunder being drawn in question, and the only controversy upon the proceedings being as to the construction of the law as to the extent of the commissioner's authority, *held*, that such controversy did not draw into question the validity of an authority exercised under the United States. *Id.

428. Neither the question whether the commissioner rightly decided upon the presumptive lawfulness of the right of the state of South Carolina to the trade-mark sought to be registered, nor the question whether his duty was of such a character that a writ of *mandamus* would lie to compel its performance, involved a question of the validity of the authority exercised by him under the United States. *Id.

(Decision of United States supreme court.)

XXVIII. PARTIES TO SUIT.

429. The bill alleged that respondents B. and others were using respondent corporation as a means of infringement, they being themselves substantially the corporation. *Held*, that there was no misjoinder in making them parties defendant. *California Fig Syrup Co. v. Improved Fig Syrup Co., 61 O. G. 155, C. D. 1892.

430. In a bill against a corporation for infringing a trade-mark plaintiff included the directors of the defendant corporation as parties defendant. Upon demurrer, *held* not a misjoinder, and demurrer overruled. *Armstrong & Co. v. Savannah Soap Works, 61 O. G. 1018, C. D. 1892.

431. A trade-mark may be adopted, owned and used by a number of parties engaged in the same business as separate firms, and all of them may join as complainants in a suit to

restrain infringement. †Gravel Roofers' Exchange v. Turnbull, 64 O. G. 441, C. D. 1893.

XXIX. PARTNERSHIP.

432. Copartners, upon a dissolution of partnership, will together be entitled to exclusive use of trade-marks of the firm, and perhaps each of them will be entitled to such exclusive use as to all persons except their associates in ownership. *New York and R. Cement Co. v. Copley Cement Co., 45 Fed. Rep. 212 (1891).

433. Another druggist who had a commercial partnership with the physician up to the time of his death, in the business of dispensing the remedies used by the physician, the two having an extensive trade in them, domestic and foreign, has a right as surviving partner to the trade which had become established, to the good-will connected with it, and to the inchoate trade-mark right which was incident to it, at least to the extent of treating them as assets of the partnership for the purpose of closing out the partnership business. Stewart v. Einstein, v. Sawhill, 64 O. G. 1533, C. D. 1893.

XXX. PRACTICE IN PATENT OFFICE.

434. A certificate of registration of a trade-mark will not be issued to the assignee of the applicant, even though the assignment may have been previously recorded. *Ex parte Bassett*, 55 O. G. 997 (1891).

435. 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).

436. Where the examiner of interferences refused to recognize a concession of priority of trade-mark adoption executed by an officer of a corporation without the corporate seal, *held*, that a concession of priority is not such an instrument as requires the use of a seal by corporation or individual, and that, if satisfactorily appearing on the record that the officer was empowered to execute the paper, the office will accept it. *Jersey City Packing Co. v. Jacob Dold Packing Co.*, 62 O. G. 317, C. D. 1893.

437. A certificate of correction refused in a trade-mark case to correct an alleged error of statement of essential features, made by applicant in complying with an official requirement. (Rehearing.) *Ex parte Wood Drug Co.*, 53 MS. D., Jan., 1894.

438. The action of the primary examiner of trade-marks is but the report of a partial examination made by a subordinate. *United States ex rel. the State of South Carolina v. Commissioner of Patents, 66 O. G. 1167, C. D. 1894.

439. A certificate of registration will not be issued to an assignee in a trade-mark case. Ex parte Roasted Cereals Co., 57 MS. D., Sept., 1895 (Fisher, Acting Com'r).

440. The words "Black Lion" and figure of a lion for leaf tobacco, having been refused registration on a similar mark registered under the prior law, which had been declared unconstitutional. *held*, the former registrants should be notified an application is pending and sixty days allowed them to make application for new registrations. (Ex parte American Lead Pencil Co., C. D. 1892, 199.) Ex parte Hershheim Bros. & Co., Limited, 60 MS. D., Sept., 1896 (Fisher, Acting Com'r). Similar decision, on same date, in case of application by the same parties for "Black Tiger," for cigars and tobacco.

XXXI. REGISTRATION.

(See ANTICIPATION; CLASS OF GOODS.)

(a) *In General.*

441. It was not contemplated by the act of congress and is not provided for by the rules that a certificate of registration of a trade-mark should be issued to the applicant and his assignee jointly. Ex parte Spinner, 35 MS. D., July, 1887 (Hall, Com'r).

442. The signature and oath of a firm to a trade-mark application cannot be properly made by one who is not a member of the firm but merely a so-called "director." Ex parte Kirker, Greer & Co. (Limited), 37 MS. D., July, 1888 (Hall, Com'r).

443. The certificate of registration is only *prima facie* evidence of an admission on the part of the government that the applicant for registration is the owner of a valid trade-mark. It is not a grant of any right or privilege, and does not conclude a third party. *United States v. Braun, 39 Fed. Rep. 775 (1889).

444. A trade-mark including, with other arbitrary matter, a representation of an article for which a patent is still in force may be registered. Ex parte Hurlburt Mfg. Co., 41 MS. D., Nov., 1889 (Mitchell, Com'r).

445. The incorporation of a company in the

name of an article of commerce, without other specification, will not create any exclusive right to the use of the name. *Goodyear's India Rubber Glove Mfg. Co. v. The Goodyear Rubber Co., 46 O. G. 126, C. D. 1889.

446. A trade-mark adopted for use in dealing in real estate is not proper subject for registration. Ex parte Roy and Nourse, 54 O. G. 1267, C. D. 1891.

447. Where the mark sought to be registered was affixed to bill-heads, letter-heads, cards and circulars which applicants used in their business, *held*, that such a use did not come within the statute. *Id.*

448. Registration of signs or symbols is provided for only when they are applied to transportable articles of commerce — that is, "goods, wares and merchandise." *Id.*

449. The mere name of a corporation will not be registered as a trade-mark. Ex parte Creedmoor Carriage Co., 56 O. G. 1333, C. D. 1891.

450. Whenever in the opinion of the office the thing offered for registry as a trade-mark is so nearly like some prior registered trade-mark as to be likely to lead to mistake or confusion, registration will be denied. Ex parte Coon, 58 O. G. 946, C. D. 1892.

451. An applicant will not be granted independent registration of a trade-mark when it appears that he is one of two or more parties who have a right to use such mark, section 2 of the trade-mark act requiring it to appear that than the applicant "no other person, firm or corporation has the right to such use." Ex parte Langdon, 61 O. G. 286, C. D. 1892.

452. The recital in the statement of the adoption and several transfers of the trade-mark sought to be registered, *held* allowable. Ex parte Bonnell, 52 MS. D., June, 1893 (Fisher, Ass't Com'r).

453. The commissioner must decide whether the applicant has the right to use the trade-mark at all, whether the alleged trade-mark is in itself a lawful trade-mark, or is identical with the trade-mark of another, or a deceptive imitation, or the property of the applicant. *United States ex rel. the State of South Carolina v. Commissioner of Patents, 66 O. G. 1167, C. D. 1894.

454. If the fact of registry confers any benefits, it is only those which are specially provided in the act of congress and not covered by the common-law rule. The trade-mark, when established, is valid and entitled to protection,

whether registered or not. *Waukesha Hygeia Mineral Springs Co. v. Hygeia Distilled Water Co., 70 O. G. 1319, C. D. 1895.

(After a design patent has been granted to one party, registration of the same design as a trade-mark will not be allowed to another party. Ex parte Lee & Shepard, 24 O. G. 1271, C. D. 1883.)

(b) *Particular Cases.*

455. The name of the applicant and his place of business, held not registrable. Ex parte Brown, 37 MS. D., July, 1888 (Hall, Com'r).

456. The words "10 cents for each one dollar," held not registrable, since they indicate no origin or ownership, but point merely to a source of profit, the object being the sale of the article to which the label is affixed. Ex parte Force Tobacco Co., 41 MS. D., Dec., 1889 (Mitchell, Com'r).

457. Messrs. Holt & Co., New York, N. Y., adjudged to have acquired and to hold the exclusive right to the use of the words "La Favorita," registered by them February 28, 1882, as a trade-mark for flour. *Menendez v. Holt, 46 O. G. 971, C. D. 1889.

458. But one trade-mark can be registered for goods of substantially the same descriptive properties. A trade-mark for drawers and pantaloons prohibits registration of the same mark for overalls. Ex parte Kyle & Co., 57 O. G. 274, C. D. 1891.

459. A fac-simile of the certificate issued by a state board of pharmacy to registered pharmacists is not registrable as a trade-mark. Ex parte Kuppenheimer Brothers, 60 O. G. 439, C. D. 1892.

460. "The arrangement of two panels, one in red and one in blue, each bearing a shield," etc., is proper subject-matter for a trade-mark rather than a label. Ex parte National United States Stamp Delivery Co., 60 O. G. 893, C. D. 1892.

461. A "representation of a band with eyelets therein and cross-lacings connecting the eyelets," held not registrable as a trade-mark, since its function is purely decorative in the connection in which it is intended for use. Ex parte Peyser & Co., 62 O. G. 588, C. D. 1893.

462. The state of South Carolina applies to register the trade-mark "Palmetto" in the patent office, to be applied by labels to bottles of intoxicating liquors to be regularly sold by the state outside its own limits in commerce with foreign nations or with Indian tribes. 1. It

seems that a state may take upon itself the character of a trading corporation while retaining in other respects the essentials of a sovereign state. 2. While it is not necessary to decide how, if in any manner, a state may enter the domain of commerce, whether by an express authorizing provision in its constitution supplemented by appropriate legislation to carry it into effect, or otherwise, the executive officers of a state may not, in the absence of legislation, embark the state in such trade. 3. The act of the state of South Carolina, approved December 24, 1892, entitled "An act to prohibit the manufacture and sale of intoxicating liquors as a beverage within this state, except as herein provided," is a measure for the suppression of the liquor traffic within the state by private individuals and to substitute therefor its complete control by the state, and is not a law which authorizes a regular trade in liquors by way of sale to foreign purchasers. 4. The state of South Carolina, notwithstanding the acts of its governor and state board of control, has no authorized trade in liquors outside its own limits. It is not the owner of any trade-mark, has not at this time the right to the use of the trade-mark sought to be registered, and therefore, 5, the application is denied. Ex parte State of South Carolina, 64 O. G. 1395, C. D. 1893.

(See MANDAMUS.)

463. A druggist whose only relation with a physician was that he filled the latter's prescriptions occasionally cannot, upon the death of the physician, adopt the *fac-simile* of his signature and picture, or either of them, as a trade-mark without showing to the office in some manner the consent of the physician that this should be done, or acquiring the right to do so from the personal representative of the decedent. Stewart v. Einstein, v. Sawhill, 64 O. G. 1533, C. D. 1893.

464. The person attempting to do this is not the owner of the trade-mark; his use of it in commerce with foreign nations or otherwise is unlawful, and in interference proceedings judgment of priority cannot be rendered in his favor. Id.

465. The registry of a trade-mark, the essential feature of which is described as "the representation of a red anchor in an oval space," is not proof of intention to adopt a trade-mark consisting of the word "Anchor" and the symbol of an anchor, irrespective of color and surroundings. (Richter v. Anchor Remedy Co.

52 Fed. Rep. 455, affirmed.) *Richter v. Reynolds, 67 O. G. 404, C. D. 1894.

466. Registration of "Swan-down," for soap, refused, because the prevailing party to the interference proved no exclusive right. Tetlow v. Bloomingdale and Levy, v. Tappan, 56 MS. D., Jan., 1895 (Fisher, Ass't Com'r).

467. A device which is an entirely subordinate feature in an alleged trade-mark, and constitutes merely a printer's symbol, is public property and not registrable. Ex parte Brunswig, 57 MS. D., Aug., 1895 (Fisher, Acting Com'r).

468. The words "Silver Club" and a representation of a group of four heads, representing four congressmen noted for their advocacy of free silver, refused registration on the ground that the consent of each of the congressmen must be obtained. "Without the group of heads, the words 'Silver Club' would lose their significance." Ex parte Davis & Co., 58 MS. D., Dec., 1895 (Fisher, Ass't Com'r).

469. The difference in appearance, as written or printed, in sound and in meaning are sufficient to differentiate the words "Electric Light" from the word "Electric," and therefore the prior registration of the latter word does not bar the registration of the former words. Kirby v. McLaughlin & Co., v. Johnston, 72 O. G. 1785, C. D. 1895.

470. "League," for base-balls, held not registrable in view of lack of proof of exclusive right. Ex parte Spalding & Bros., 60 MS. D., Sept., 1896 (Fisher, Acting Com'r).

XXXII. RIGHT TO USE NAME OF PATENTED ARTICLE.

471. A name which has been applied in a patent to a particular article manufactured under it cannot become a trade-mark after the patent has expired. *Green v. Woodhouse, 38 O. G. 1491, C. D. 1887.

472. A patented printing-press was called by the patentee the "Universal," and the presses were stamped with that name and the names of the manufacturers, who made them for the patentee or his licensees. Held that, after the expiration of the patent, the patentee was not entitled to be protected in the use of the word "Universal" as a trade-mark. *Gally v. Colt's Patent Fire Arms Mfg. Co., 41 O. G. 576, C. D. 1887.

473. The term "Weymouth's Patent," used on knives made, patented and sold by the plaintiff, held to be free to the public after the

expiration of the patent. *Hiram Holt Co. v. Wardsworth, 41 Fed. Rep. 34 (1889).

474. Where it appears in a suit to restrain defendants from using plaintiff's trade-name or trade-mark, applied by him to an article for which he had obtained a patent, that the defendants claimed title to the patent under assignment from plaintiff to secure payment of a note, manufactured under it, and applied the name to the patented article, held, that this action for violation of right to the name, apart from the right to the patent, could not be maintained. †Waterman v. Shipman, 49 O. G. 892, C. D. 1889.

475. After the expiration of plaintiffs' design patent in 1877 for embossing the ends of sewing-thread spools, the public had the right to use it. *Coats v. Merrick Thread Co., 63 O. G. 1531, C. D. 1893.

476. It is the universal American, English and French doctrine that where, during the life of a monopoly created by a patent, a name, whether it be arbitrary or be that of the inventor, has become, by his consent, either express or tacit, the identifying and generic name of the thing patented, this name passes to the public with the cessation of the monopoly which the patent created. *Singer Mfg. Co. v. June Mfg. Co., 75 O. G. 1703, C. D. 1896.

477. When a patent expires, the public may make the article and use a name for it which originated from or was naturally derived from the patent specification as a descriptive title of the invention. *Air-Brush Mfg. Co. v. Thayer, 79 O. G. 683, C. D. 1897.

478. No one has the right to the exclusive use of the word "Yale" as a trade-mark for locks, as any one who makes a lock disclosed by any one of the expired patents taken out by the Yales has a right to designate such lock as a "Yale lock," and it would be the proper and true name of such lock. Ex parte Yale & Towne Mfg. Co., 81 O. G. 801, C. D. 1897.

479. It is well settled by all the authorities that when an inventor obtains a patent on a device and said patented device is known by a certain name, the name becomes public property at the expiration of the patent. Id.

XXXIII. RIGHT TO USE PERSONAL NAME.

(See FRAUD; INFRINGEMENT; INJUNCTION.)

480. A person cannot make a trade-mark of his own name, and thus debar another having

the same name from using it in his business honestly and without any intention to wrongfully appropriate the good-will of a business already established. †*Russia Cement Co. v. Le Page*, 44 O. G. 823, C. D. 1888.

481. But although one may honestly use his own name as a trade-mark, although the incidental result may be to injure the business of another, he cannot resort to any artifice, or do any act calculated to mislead the public as to the identity of the business or article, and thus produce injury to such other person beyond that which results from the similarity of name. †*Id.*

482. One may so sell or part with the right to use his own name as a description of a manufactured article as to deprive himself of the right to use it as such, and confer such right upon another, and in such case he will be enjoined from such use of his own name. †*Id.*

483. It is not upon the ground of the invasion of the trade-name adopted by another, but by reason of the contract he has made, that he is deprived of the right himself to use his name as all others of the same name may use theirs. †*Id.*

484. Where one Le Page had used the trade-mark "Le Page's Liquid Glue" to indicate a particular kind of glue manufactured by him, and had thereafter formed a corporation to which he sold his business, with the right to use the trade-marks belonging to or in use by him, which corporation continued to manufacture the same glue under the same name, and he subsequently left the corporation and engaged in the manufacture of glue in the same town, using the name "Le Page's Improved Liquid Glue" to advertise the article produced by him, *held*, that he should be enjoined from so using such name and from describing his business as "Le Page's Liquid Glue Co.," whether with or without any addition, without deciding that he may not use the words "liquid glue" or other appropriate words to describe his product, or state in that connection that he is himself the manufacturer of it. †*Id.*

485. The principles applicable to trade-mark cases involving personal names are doubtless applicable to trade-mark cases involving what may be called "portrait" trade-marks. *Richmond v. The Dr. S. A. Richmond Nervine Co.*, 52 O. G. 307, C. D. 1890.

486. No person can acquire by adoption such an interest in the name of another person as to prevent that person from using his own name

in a fair and honest manner in the ordinary course of business. *Id.*

487. To justify the exclusive use by a person or corporation of any man's name or portrait as against the man who bears the name or is represented by the portrait, some contract relation or estoppel must be found to exist, operating to deprive the latter of what would otherwise be his right. *Id.*

488. An ordinary surname cannot be appropriated by any one person as against others of the same name who are using it for a legitimate purpose. **Brown Chemical Co. v. Meyer*, 55 O. G. 287, C. D. 1891.

489. Cases are not wanting, however, in which injunctions have been issued to restrain the use of even one's own name where fraud upon another was manifestly intended or where the party had assigned or parted with his right to use it. (Cases cited.) **Id.*

490. While the right of no one can be denied to employ his name in connection with his business or with articles of his own production, so as to show the business or product to be his, yet he is not allowed to designate his article by his own name in such way as to cause it to be mistaken for the manufacture or goods of another already on the market under the same or similar name. (*Brown Chemical Co. v. Meyer*, 55 O. G. 287, 139 U. S. 540; *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 55 O. G. 1523, 138 U. S. 537.) **Meyer v. Dr. B. L. Bull Vegetable Medicine Co.*, 66 O. G. 197, C. D. 1894.

491. The defendant corporation devised, constructed and arranged the names as well as the wrapper of its article for the fraudulent purpose of causing it to be mistaken and sold in the market for complainant's article. Perpetual injunction allowed. **Id.*

492. "Although the use of a personal name as a trade-mark will not be protected against its use in good faith by a defendant who has the same name, the reason of the rule ceases and the rule no longer applies where the defendant, as in the case of a corporation, selects its own name, especially where it appears that such name is selected with intention to mislead." (Citing *Wm. Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co.*, 11 Fed. Rep. 485, and distinguishing *Wm. Rogers Mfg. Co. v. Simpson*, 54 Conn. 527, 9 Atl. Rep. 395.) **William Rogers Mfg. Co. v. R. W. Rogers Co.*, 73 O. G. 970, C. D. 1895.

493. The name of a corporation is an essential part of its being, and the courts will pro-

fect it independently of statutory provisions. (Cases cited.) *Investor Publishing Co. of Massachusetts v. Dobinson, 72 Fed. Rep. 603 (1896).

494. A man may use his own name, because he cannot truthfully do business under any other, and the law protects that right ordinarily, even though such use may be injurious to another who has established a prior business of the same kind; but the name must not be used in such a way as to mislead the public into purchasing his goods under the belief that they are the manufacture of another. (Higgins Co. v. Higgins Soap Co., 144 N. Y. 462; William Rogers Mfg. Co. v. R. W. Rogers Co., 73 O. G. 970, 66 Fed. Rep. 66.) †De Long v. De Long Hook and Eye Co., 74 O. G. 809, C. D. 1895.

495. Where another avails himself of this public dedication to make the machine and use the generic designation, he can do so in all forms, with the fullest liberty, by affixing such name to the machines, by referring to it in advertisements, and by other means, subject, however, to the condition that the name must be so used as not to deprive others of their rights or to deceive the public, and, therefore, that the name must be accompanied with such indications that the thing manufactured is the work of the one making it as will unmistakably inform the public of that fact. *Singer Mfg. Co. v. June Mfg. Co., 75 O. G. 1703, C. D. 1896.

496. A man has a right to the use of his own name so long as he uses it honestly and so as not to injure another having the same name, and to prevent such injury he may be required to use his name in a specific manner, pointed out in an injunction. *Walter Baker & Co., Limited, v. Baker, 78 O. G. 1427, C. D. 1897.

497. One who enters into competition with another person of the same name who has an old and well-established business must differentiate his goods more carefully than is necessary in the case of a competitor of a different name. *Id.

498. The doctrine is well settled that equity will direct how a man shall use his name in his purpose to denote his own individuality. He will not be allowed to so use it as to work an injury to another having the same name, nor to perpetrate a fraud upon the public. *Garrett v. J. H. Garrett & Co., 79 O. G. 1681, C. D. 1897.

499. Where by long use the words "Baker's

Chocolate" have come to indicate to purchasers of ordinary intelligence complainant's goods, *held*, that a subsequent manufacturer should not be allowed to use his surname, Baker, whether his given name or initials are prefixed or not, so as to indicate upon labels or advertisements that the goods he sells are "Baker's Chocolate." *Walter Baker & Co., Limited, v. Sanders, 80 O. G. 1476, C. D. 1897.

500. A corporation will not be protected in the use of its name against another corporation adopting and using the same name under such circumstances and in such locality as not to interfere with the former corporation's prior right to the name. *Investor Publishing Co. v. Dobinson, 82 Fed. Rep. 56 (1897).

501. In the use of a trade journal published in Los Angeles, California, under the name of "The Investor," there is no infringement of the right of the journal published in Boston, Massachusetts, under the name of "United States Investor," in view of the absence of proof of financial injury. *Id.

XXXIV. STATUTE.

502. An indictment under the trade-mark statutes (act of 1876) of the United States cannot be found. Said act fell with the act of 1870, which provided for the registration of trade-marks, and which was declared to be unconstitutional by the supreme court of the United States, and is as much a dead letter as said act of 1870, and was not revived or given operative force by the act of 1881. *United States v. Koch, 49 O. G. 891, C. D. 1889.

503. The commerce clause of the statute merely gives jurisdiction to the patent office, and to the United States courts in trade-mark causes arising between citizens of the same state. The common-law owner of a trade-mark is entitled to registration whenever he shall show use "in commerce with foreign nations or with the Indian tribes," and he cannot be deprived of his right to such registration by reason of the use of the mark in foreign trade by another person, even though the mark has been registered by such other person. Manitowoc Mfg. Co. v. Dickerman, 57 O. G. 1721, C. D. 1891.

504. The purpose of section 3449 of the Revised Statutes of the United States, prohibiting the shipment of spirituous liquors, etc., under any other than their proper name or brand as known to the trade, is solely to facilitate the

enforcement of the revenue laws, and the fact that the statute may sometimes operate for the incidental protection of a trade-mark does not affect its constitutionality within the meaning of the Trade-mark Cases (100 U. S. 82). *United States v. Loeb, 59 O. G. 1766, C. D. 1892.

(The act of July 8, 1870, was the first enacted by congress in reference to trade-mark registration. See sections 76 to 84 inclusive. This part of the act was declared unconstitutional, null and void by the supreme court of the United States at its October term of 1870. (16 O. G. 999, C. D. 1870, 619, 100 U. S. 82.) Congress passed a penal statute in 1876 which fell with the original act of 1870. A new and remedial act was passed by congress and approved March 3, 1881; but the act of 1876 was not included in it. This act of 1881, supplemented by a single amendment, dated August 5, 1882, is the one under which all registrations have since been effected. It provides for no appeal to any tribunal outside the patent office. (*Einstein v. Sawhill, 65 O. G. 1918, C. D. 1893.)

Section 7 of the act of October 1, 1890 (see circular of treasury department, dated October 31, division of customs), prescribes that no article of imported merchandise shall be allowed entry at United States ports which copies or simulates domestic trade-marks, and owners of the latter may file *fac-similes* of the same for transmission to collectors of customs.)

XXXV. TREATY.

505. The name "Vichy" is a commercial name, and, as such, is protected under the industrial property treaty of March 20, 1883, without obligation of deposit (art. 6 of the treaty), whether it does or does not form part of a trade or commercial mark. *La Republique Francaise v. Schultz, 57 Fed. Rep. 37 (1893).

506. Our word "trade-mark" comprehends both the *marque de fabrique* and *marque de commerce* de France. (Browne, Trade-marks, sec. 85.) *Id.

507. Although a German citizen cannot register the word "Goliath" in Germany, as a trade-mark for certain tools, under the convention (1872) between that country and the United States, registration will be allowed here. (Ex parte Manske & Co., 64 O. G. 858.) Ex parte Schmidt, 53 MS. D., July, 1893 (Fisher, Acting Com'r).

(Trade-mark treaties between United States and Germany, and Germany and Austria, referred to in *J. M. P. Baltz Brewing Co. v. Kaiser Brauerel, Beck & Co., 74 Fed. Rep. 222, 1896.)

508. A trade-mark consisting of the word "Germania" may be registered in the United States by a German citizen, under the provisions of article XVII of the convention of December 11, 1871, although the German statutes make no provisions for the registration of mere words as trade-marks. Ex parte Portland-

Cement-Fabrik "Germania" H. Manske & Co., 64 O. G. 858, C. D. 1893.

509. The treaty of 1871, between the United States and Germany (art. 17, 17 Stat., 931), which provides that, with regard to the marks of labels of goods or of their packages, the citizens of Germany shall enjoy in the United States the same protection as native citizens, does not give to a citizen of Germany who has acquired the right to a trade-mark in that country a similar right to the trade-mark in the United States. *Richter v. Reynolds, 67 O. G. 404, C. D. 1894.

510. Citizens of Canada who are engaged in the manufacture of trade-marked articles and who have a place of business in the state of New York, where they make and ship such articles for sale in the United States, are within the international convention of March 20, 1883, for the protection of industrial property, and they may sue in the United States courts for the infringement of their trade-marks by its citizens. *Kerry v. Toupin, 67 O. G. 931, C. D. 1894.

511. The international union has not the force nor effect of law in this country. (Citing opinion of Att'y-Gen. Miller, 47 O. G. 398, C. D. 1889.) Ex parte Zwack & Co., 76 O. G. 1855, C. D. 1896.

(See "International Convention.")

XXXVI. USE AND SALE AS ESTABLISHING TITLE.

512. An application for registration of a trade-mark allowed in absence of evidence that the reference has been used. Ex parte Jones, 34 MS. D., July, 1887 (Hall, Com'r).

513. Registration does not create a trade-mark. It can only be acquired by the actual application of a proper symbol to goods, wares or merchandise of a certain class. *United States v. Braun, 39 Fed. Rep. 775 (1889).

514. The exclusive right to use as a trade-mark a word coined and given currency by a manufacturer is not affected by a subsequent use of the word by the public in a descriptive sense. Selchow v. Baker (93 N. Y. 59) approved. *Celluloid Mfg. Co. v. Cellonite Mfg. Co., 41 O. G. 693, C. D. 1887.

515. Mere adoption of a mark, and a public declaration that the mark so adopted will be used to distinguish goods to be put on the market at a future time, create no right. No title arises until the thing is actually on the market marked with the particular mark.

‡Schneider v. Williams, 44 O. G. 1400, C. D. 1888.

516. Three things are requisite to the acquisition of a title to a trade-mark: First, the person desiring to acquire title must adopt some mark not in use to distinguish goods of the same class or kind already on the market belonging to another trader; second, he must apply his mark to some article of traffic; and third, he must put his article marked with his mark on the market. †Id.

517. It appearing that the mode in which the complainants packed their cigars, the kind of boxes used by them, the number of cigars in each bunch, the particular color of ribbon or tape around each bunch, and the size and shape of the cigars were all old in the trade, and that the name "La Normanda" had been used for cigars resembling the "La Normandi" cigars in size and shape, etc., in different parts of the country several years prior to the adoption of the words "La Normandi" by the complainants or their assignor, the adoption of these words as a trade-mark and their registration could not take away the right previously acquired by the public in the use of the words "La Normanda" as indicating a particular kind of cigars. *Stachelberg v. Ponce, 46 O. G. 337, C. D. 1889.

518. Where it appeared that as against the applicant a certain corporation and its successors in business, down to and including the registrant, were and are clothed with the exclusive right to make, sell and use a certain medical compound to which the portrait of the applicant had been applied as a trade-mark, *held*, that as against the registrant the applicant could not register said portrait for use in connection with the same medical compound; and *held*, also, that the use by the applicant of such portrait as a trade-mark for a limited period before the actual incorporation of the registrant, but at a time when the exclusive right to manufacture and sell the article was in the successors of the original company, created no right in the applicant. Richmond v. The Dr. S. A. Richmond Nervine Co., 52 O. G. 307, C. D. 1890.

519. When a party has rejected a trade-mark for an article and announced his intention to use it upon a similar article, it is incumbent upon an applicant who wishes to register a trade-mark for such similar article to show that the registrant has not used it thereupon. *Ex parte* Kyle & Co., 57 O. G. 274, C. D. 1891.

520. Whoever is the first to adopt and use a

mark in either domestic or foreign trade is the owner of such trade-mark. Manitowoc Mfg. Co. v. Dickerman, 57 O. G. 1721, C. D. 1891.

521. It is the party who first uses a trade-mark, and not the one who first thought of using it, that is entitled to protection. *George v. Smith, 52 Fed. Rep. 830 (1892).

522. Intermittent use of a trade-mark, coupled with registration, cannot prevail over a continuous use begun at a later period. *Brower v. Boulton, 53 Fed. Rep. 389 (1892).

523. The filing of an application for registration is not conclusive that the mark has been adopted and used at the time of filing said application. Stewart v. Einstein, v. Sawhill, 61 O. G. 287, C. D. 1892.

524. A mere adoption of a mark carries no rights unless there concur a continuous use of it and public familiarity with it. To establish a proprietary right in such a mark, it is necessary that the public understanding respecting the purpose of its use shall be fully proved. *Kohler Mfg. Co. v. Beshore, 62 O. G. 592, C. D. 1893.

525. That which is prior in time is first in right. †Whitfield v. Loveless, 64 O. G. 442, C. D. 1893.

526. Sales of medical preparations in this country by a foreign manufacturer, to a limited extent, upon special orders, to supply particular customers, do not amount to use in such circumstances as to publicity and to length of use as show an intention to adopt a symbol placed upon such preparations as a trade-mark. (Kohler Mfg. Co. v. Beshore, 67 O. G. 592, 59 Fed. Rep. 572, followed; Richter v. Anchor Remedy Co., 52 Fed. Rep. 455, affirmed.) *Richter v. Reynolds, 67 O. G. 404, C. D. 1894.

527. Sales of a few dozen bottles of a medicinal preparation, with written labels affixed, bearing a name different from that previously used for such preparation, do not amount to use in such circumstances as to publicity and to such length of use as to show an intention to adopt the written words as a trade-mark. (62 O. G. 592, 53 Fed. Rep. 262, affirmed.) *Kohler Mfg. Co. v. Beshore, 67 O. G. 678, C. D. 1894.

528. A trade-mark used for a time by a party, then discontinued for a series of years, cannot be lawfully resumed as against another, who, meanwhile, has begun its use and continued the same persistently. *Royal Baking Powder Co. v. Raymond, 70 Fed. Rep. 376 (1895).

529. It is immaterial who suggested the word "Triumph" for dress-stays; priority must be awarded the one who first adopts and uses

a mark. *Trisdorfer & Co. v. Estate of Eassett*, 60 MS. D., Sept., 1896 (Fisher, Acting Com'r).

530. "Cat-al-gine," for a medical compound, held not anticipated by "Katalgen," in view of lack of proof of use of the latter. *Ex parte Hartmiller Bros.*, 60 MS. D., Dec., 1896 (Fisher, Ass't Com'r).

531. A merely casual, interrupted or temporary use will not support a title to a trade-mark. **J. M. P. Baltz Brewing Co. v. Kaiser Brauerei, Beck & Co.*, 74 Fed. Rep. 222 (1896).

532. Defendants have the right to use the name "Eli Pettijohn" and to make as pronounced as possible upon their labels the personality of this man when it appears that he was for many years engaged in another section of the country in the manufacture of the product to which the labels applied, and when it also appears that complainants had previously joined with him in the manufacture of the same product in such other section. **American Cereal Co. v. Eli Pettijohn Cereal Co.*, 76 O. G. 610, C. D. 1896.

533. Ephemeral and experimental use of a mark does not amount to adoption, establishing a reputation for the goods in the market. *Jenkins v. Burke*, 61 MS. D., May, 1897 (Fisher, Ass't Com'r).

XXXVII. WHAT CONSTITUTES.

(See REGISTRATION.)

534. In all the legislation of congress upon this subject there is contained a requirement that a trade-mark offered for registration in the patent office shall be lawful, not calculated to deceive the public. "The commissioner of patents shall decide the presumptive lawfulness or claim to the alleged trade-mark." *Ex parte M. Bloch & Co.*, 40 O. G. 443, C. D. 1887.

535. There is no legislation defining what constitutes a lawful trade-mark, and to determine this resort must be had to the common law as disclosed in commercial usages and shown by the commentators and the decisions of courts. *Id.*

536. No rule can be adopted by which to determine what is or is not a lawful trade-mark. In many cases the misrepresentation may not appear upon the face of the trade-mark and accompanying application, and the office may not be in possession of the facts which would enable it to guard against the registry of a false trade-mark; but whenever it clearly and distinctly appears that the proposed trade-mark

constitutes a misrepresentation of such a character that it would not be protected in a court of equity, it is the duty of the office to refuse its registration. Probably doubtful cases should be resolved favorably to applicants, leaving all parties affected to their remedies in the courts. *Id.*

537. The office of a trade-mark is to point out distinctively, either by itself or by association, the origin or ownership of the article to which it is affixed, or, in other words, to give notice who was the producer. While this may be done in many cases by a name, a mark or a device well known, but not previously applied to the same article, it is not necessary that the word or device should be a new creation never before known or used. (*Canal Co. v. Clark*, 13 Wall. 322.) *Id.*

538. The name which is given to a patented device to distinguish it as a patented article from other articles of the same character is not, properly speaking, a trade-mark. **Adee v. Peck Bros. & Co.*, 48 O. G. 823, C. D. 1889.

539. It designates nothing except that the structure has a definite character as the structure that was patented, and indicates nothing in regard to the character of the workmanship or the person by whom it was manufactured. **Id.*

540. A trade-mark is something different from the article itself, which the mark designates, and is a name, mark or device attached to the article to indicate its origin. **Id.*

541. A label which does not indicate with any degree of certainty by what particular person or firm the articles to which it may be affixed were manufactured, or serve to distinguish the goods of one manufacturer from the goods of another, and in which complainant appears to have no vendible interest, but merely a right to use it on articles of his own make, so long and only so long as he remains a member of a certain union, is not a valid trade-mark. **Carson v. Ury*, 49 O. G. 411, C. D. 1889.

542. A small metallic frame containing a portrait fastened to a pin, so as to be used as a personal ornament, does not constitute a valid trade-mark when so attached to and sold with a cigar as to be readily detached and used separately in the manner indicated. †*Hoeb v. Bishop*, 49 O. G. 1845, C. D. 1889.

543. An article having a distinct commercial value of its own cannot be made a trade-mark for another article by being attached to and sold with it. †*Id.*

544. A trade-mark may, in form, serve as a

label, but it differs from a mere label in that it is not confined to a designation of the article to which it is attached, but is a symbol or device which, affixed to a product of one's manufacture, distinguishes it from articles of the same general nature manufactured or sold by others, thus securing to the producer the benefits of any increased sale by reason of any peculiar excellence he may have given to it. A mere label is not intended to accomplish any such purpose, but only to indicate the article contained in the bottle, package or box to which it is affixed. *Higgins v. Keuffel, 55 O. G. 1139, C. D. 1891.

545. The primary function of a trade-mark is to denote the origin of the article which bears it. A "representation" which upon its face appears clearly to have another purpose, such as decoration, and which by reason of that decorative character creates no suspicion that it is intended as a trade-mark, is not registrable as such. *Ex parte Peyser & Co.*, 62 O. G. 588, C. D. 1893.

546. Complainants manufactured a medicinal compound under the name of "Syrup of Red Spruce Gum," and for some twenty years or more that name was placed conspicuously on the package in which the compound was sold, and in connection therewith appeared a cut of an Indian against a background of spruce-trees and a water-fall. *Held*, that the adoption and continuous use of this distinctive name and device entitle complainants to claim it as a trade-mark and to be protected against its infringement by persons making similar goods. *Kerry v. Toupin, 67 O. G. 931, C. D. 1894.

547. Where a firm has for many years used the name of its predecessors in connection with its goods and has built up an extensive trade thereunder, such name, even if it could not be used as a trade-mark, is to be treated as a descriptive term, to the benefit of which they are entitled. *Garrett v. T. H. Garrett & Co., 79 O. G. 1681, C. D. 1897.

("Form is necessary to make color an essential element of a trade-mark." *Browne on Trade-marks*, sec. 229, 2d ed.)

XXXVIII. WITNESSES.

548. Witnesses hired by the manufacturer of a proprietary medicine to secure evidence against suspected infringers are not disinterested and their testimony should be scrutinized with unusual caution. *Hostetter Co. v. Bower, 76 O. G. 1856, C. D. 1896.

TREATIES.

(See INTERNATIONAL CONVENTION; TRADE-MARKS, TREATY.)

The treaty of April 16, 1869, between the United States and France is impliedly repealed by the treaty of March 20, 1883. (Cases cited.) **La Republique Francaise v. Schultz*, 57 Fed. Rep. 37 (1893).

TRUSTS.

(See CONTRACTS, ILLEGAL; CORPORATIONS.)

USE, DOUBLE.

(See PATENTABILITY.)

USE OF NAME OF PATENT OR PATENTED ARTICLE BY THE PUBLIC.

(See RIGHT OF PUBLIC TO USE NAME OF, ETC.)

USE OF PATENTED ARTICLE BY UNITED STATES GOVERNMENT.

(See RIGHT OF SAME TO USE.)

UTILITY.

(See PATENTABILITY.)

VOID PATENTS.

(See PATENTS, DEFECTIVE OR VOID.)

WITHDRAWAL FROM ISSUE.

(See AMENDMENT AFTER FINAL REJECTION; CLAIMS, REINSTATEMENT OF.)

1. An applicant who has had his day in the office, and whose application has received full consideration and has been passed to issue, ought not to be permitted to withdraw his case from issue and submit amendments which should have been earlier proposed, and thus put the office to the trouble of making a re-examination. Unless a showing of *irreparable injury* is made to appear, such petition will be denied and applicant required to file a new ap-

plication covering the subject of his proposed amendment, or he may abandon his original application, pay a new fee, and file another application in the form desired. *Ex parte Page and Krausse*, 43 O. G. 1455, C. D. 1888.

2. While it is a general rule that applications which have been allowed will not be recalled for the purpose of amendment, an exception to the rule must be recognized in cases where great hardship or irreparable injury would otherwise result. *Ex parte Myers*, 49 O. G. 131, C. D. 1889.

3. Where the claims sought to be introduced by amendment were so specially pertinent to the subject-matter of the application, and were so inseparable in their nature from the particular invention sought to be patented, that if they were to be allowed in another application there would be grave doubt whether the patent therefor would be a valid patent, amendment after allowance was permitted. *Id.*

4. Before a claim deliberately erased can be reinstated some good showing must be made of especial hardship to the inventor, or of inadvertence, accident or mistake in erasing such claim. *Ex parte Potter*, 53 O. G. 760, C. D. 1890.

5. An application confined to the apparatus cannot be withdrawn from issue for the purpose of inserting a claim for the process, although the process claim might have been included in the original application. *Ex parte Adams*, 47 MS. D. (3 G. W. D.), June, 1891 (*Frothingham, Ass't Com'r*).

6. Where it appeared that the petitioner had erased a certain claim from his application for a specific purpose and had specifically abandoned it, so far as said application was concerned, in order to obtain an allowance, and subsequently desired to withdraw the case from issue for the purpose of reinstating said claim, *held*, that the petition should be denied. *Ex parte Potter*, 53 O. G. 760, C. D. 1890.

7. There is no warrant in rule 165 for withdrawing an application which has been passed to issue and allowed to enable a party to preserve rights to patents in foreign countries when it appears that the six months within which the final fee must be paid under the statute would necessarily elapse before the expiration of the time during which the case would be withdrawn from issue. *Ex parte Simonson*, 53 O. G. 1571, C. D. 1890.

8. Rule 105 only provides for a new notice of allowance when applications are "withdrawn for further action on the part of the

office," and no provision exists in the rule for a new notice where the effect of the petition to withdraw the application from issue, if granted, is intended to be and would be to permit the final fee to be paid more than six months after that allowance of the application which resulted from proceedings in the office. *Id.*

9. A petition to be allowed to withdraw an application for an apparatus from the issue, and to amend it by incorporating therein the claims of an application for a process which has been permitted to become forfeited for non-payment of the final fee within six months from notice of allowance, must be denied. Such action would in effect revive the forfeited claims without the payment of the fee required by law. *Ex parte Hopkinson*, 54 O. G. 264, C. D. 1891.

10. Where an application has been passed to issue, permitted to become forfeited by failure to pay the final fee, thereafter renewed and again allowed, a petition to withdraw such application from the issue to add amended claims, unaccompanied by any showing of "hardship or irreparable injury," was denied. *Ex parte Meyer*, 54 O. G. 265, C. D. 1891.

(*Ex parte Gaboury*, 37 O. G. 217, C. D. 1886.)

11. The necessity of advancing the work of the office compels conformity to the rule laid down in *Ex parte Myers* (49 O. G. 131). *Id.*

12. Amendments not affecting the merits of the application, but intended to correct formal matters, may be admitted under rule 78, without withdrawing case from issue. *Ex parte Cornelius*, 56 O. G. 929, C. D. 1891.

13. When amendments made after issue affect the merits, they cannot be made without withdrawing the case from issue. Such withdrawal will be made only upon a proper showing. *Id.*

14. Under rule 165 an application will not be withdrawn from issue to permit applicant to reinsert therein a claim originally presented but voluntarily erased. *Ex parte Wood*, 58 O. G. 273, C. D. 1892.

15. An application will not be withdrawn from issue if such withdrawal will have the effect of directly or indirectly extending the time allowed by law for the payment of the final fee. *Ex parte Brand*, 56 O. G. 1062, C. D. 1891.

16. The rule that an application will not be withdrawn from issue for the purpose of allowing an applicant to amend his claims is subject

to exception only in cases where its enforcement would work irremediable injury. *Ex parte Gold*, 59 O. G. 2067, C. D. 1892.

17. An application will not be withdrawn from issue for the purpose of adding claims to a feature described and reserved but not claimed in a prior patent to the same inventor, because of the fact that more than two years have elapsed since said prior patent was issued, when it appears that a new application can be filed in such a manner that the two applications may be considered continuous. *Ex parte Nash*, 60 O. G. 159, C. D. 1892.

18. An application will not be withdrawn from issue because of more than two years' public use of the invention when it appears that a second application for the same invention may be filed as a continuation of the first application, such first application having been filed before the expiration of the two years. *Ex parte Schilling*, 60 O. G. 160, C. D. 1892.

19. An application will not be withdrawn from issue for the insertion of a claim in the absence of any showing of great hardship or irremediable injury. *Ex parte Blakeslee*, 63 O. G. 1201, C. D. 1893.

20. The withdrawal of an application from issue for the purpose of inserting a claim previously presented and voluntarily canceled will not be permitted. *Id.*

21. Withdrawal of an application from issue will not be allowed for admission of an amendment that would require re-examination of the case. *Ex parte Dean*, 63 MS. D., July, 1897 (Greeley, Ass't Com'r).

WITHHOLDING FROM ISSUE.

(See APPLICATION, SUSPENSION OF ACTION ON; WITHDRAWAL FROM ISSUE.)

1. The filing of a bill in equity in the circuit court of the United States by the defeated party to an interference will not operate to stay the issue of patent to the successful contestant, nor will it justify the commissioner of patents in delaying or withholding it until such proceeding in equity is terminated. *Wells v. Boyle*, 43 O. G. 753, C. D. 1888.

2. There is no reason for withholding from issue an allowable application for process until an interference between a companion application for apparatus and other applications for apparatus which show but do not claim the process is disposed of. *Ex parte Atwood*, 44 O. G. 341, C. D. 1888.

3. An applicant who has completed his invention and diligently and successfully prosecuted his application for patent ought not to be delayed in the issuance of his patent by a caveator who is under no obligation to be diligent or to file his application for patent. *Ex parte Ward*, 46 O. G. 1573, C. D. 1889.

4. Where petitioners prayed that patents to be issued upon certain applications of the inventor should not be issued to the assignee of record, and requested that time be given them to determine in the courts their rights in the premises before the patents were issued, and that the examiner in charge of such applications be required to suspend action thereon until the legal owners of the right thereto should have been determined; or, in the event of the refusal of this request, that the patents be issued to the inventor, and it appeared that whatever title petitioners had was one which could only be established in a court of equity, and that the legal title to the invention was in the assignee, *held*, that the petition must be denied. *Shedlock v. Hannay*, 50 O. G. 166, C. D. 1890.

5. A claim by the government to an interest in an invention, either as licensee or assignee, will not stay the issue of a patent to an inventor, since that is a question for the courts and not the patent office to determine. *Riley v. Barnard*, 59 O. G. 1919, C. D. 1892.

6. An application having been withheld from issue four months, and it being probable from the manner in which the case is being prosecuted it will be several months more before an interference can be declared, it should be passed to issue. (*Abel & Dewar v. Maxim, v. Nobel*, 56 O. G. 139; *Ex parte Lombard*, 43 O. G. 1347.) *Ex parte Holt*, 63 MS. D., Dec., 1897 (Greeley, Acting Com'r).

WITNESSES.

(See TESTIMONY.)

- I. TO APPLICATIONS.
- II. COMPELLING ATTENDANCE OF.
- III. COMPULSORY TESTIMONY OF.
- IV. CROSS-EXAMINATION OF.
- V. HUSBAND AND WIFE.

I. TO APPLICATIONS.

1. While the grammatical construction of section 4889, Revised Statutes, seems to indicate that the drawing or the document signed by

the applicant and not his signature is the thing which is to be attested by two witnesses, the uniform practice of the office has been to regard the attestation as referring to the signature, and accordingly to require two competent witnesses for each signature. *Held*, therefore, that a member of the firm of applicant's attorneys who signs the firm name to the drawing is not also a competent witness to the signature of the firm. *Ex parte Kyle*, 57 O. G. 1621, C. D. 1887.

2. The attestation by *two* witnesses of the inventor's signature to the specification forming part of his application for patent is made imperative by section 4888, Revised Statutes, and rule 40. *Ex parte Ackroyd*, 63 O. G. 466, C. D. 1893.

II. COMPELLING ATTENDANCE OF.

3. The manner of taking depositions and the whole conduct of such proceedings rest with the federal courts, and parties taking testimony should apply to the district judge for an order to compel the attendance of witnesses. Before a deposition should be suppressed when a witness fails to present himself for cross-examination, the court will look into the character of the deposition, and from that determine whether the aggrieved party ought not to have applied to the district court for an order compelling attendance, instead of resorting to a motion to suppress, which motion, while noticed at the time the deposition was taken, was not urged until the hearing of the case upon the question of priority before the patent office. *Wright v. Daggett*, 44 O. G. 948, C. D. 1888.

4. The commissioner of patents has no control over witnesses. Their production, attendance and conduct are under the control of the United States courts. If a witness fails to attend or refuses to answer questions without the fault or interference of the adverse party, application should be made to the federal court for such orders as the circumstances demand. (*Wright v. Daggett*, 44 O. G. 943.) *Osgood v. Badger, v. Bennett*, 44 O. G. 1065, C. D. 1888.

5. It should be an extreme case which would justify the commissioner of patents in suppressing a deposition on motion of a party who omits to take the proper steps to secure such orders from the courts as would protect him in taking the depositions. *Id.*

6. The statute points to the federal courts as the tribunals having power to govern the con-

duct of witnesses in interference cases, rather than to the patent office. *Brungger v. Smith*, 57 O. G. 273, C. D. 1891.

7. The proper form of application to enforce obedience to a subpoena issued under section 4906, Revised Statutes, is a petition for an attachment for contempt. **Brungger v. Smith*, 58 O. G. 388, C. D. 1892.

8. Section 4906, Revised Statutes, providing that, on the application of any party to a contested case pending in the patent office, the clerk of any federal court shall issue a subpoena for a witness commanding him "to appear and testify," does not include an authority to issue a subpoena *duces tecum*. **Ex parte Moses*, 62 O. G. 1826, C. D. 1893.

9. The commissioner of patents has no judicial power over the production and conduct of witnesses in interference proceedings, but this whole matter is left in the hands of the federal courts of the district in which the testimony is being taken. (*Wright v. Daggett*, 44 O. G. 943; *Osgood v. Badger, v. Bennett*, 44 O. G. 1065.) *Kelly v. Park*, 81 O. G. 1931, C. D. 1897.

10. Where a party fails to avail himself of his right to apply to the court for the control of a refractory witness, the commissioner will not interfere, except in an unusual case, but will, in passing upon the question of priority, give to the testimony of such witness only such weight as is justified by the circumstances. *Id.*

11. The fact that the witness is a volunteer witness does not relieve him from the jurisdiction of the federal court, and the remedy from his refusal to answer proper questions is by application to the judge of such court. *Id.*

12. Where the taking of testimony has been closed, the printed record filed, and the day set for final hearing has passed, application for leave to apply to the court comes too late. *Id.*

III. COMPULSORY TESTIMONY OF.

13. The defendant may be compelled to state whether or not he, subsequent to the date of the patent and prior to the commencement of the suit, had in his possession the machine which is alleged to be an infringement of plaintiff's patent, though the plaintiff had not previously made out a *prima facie* case of infringement. **Delamater v. Reinhardt*, 53 O. G. 434, C. D. 1890.

14. An inventor has no right to withhold from the public any material fact involved in a discovery or invention for which he holds a patent, and section 4908 will not protect a wit-

ness from answering a question when the effect of his answer would be to make such disclosure. *Dornan v. Keefer, 58 O. G. 1003, C. D. 1892.

15. The vendor of an infringing device, who is not a party to the suit, may be compelled to testify to the purchase and use thereof by the defendant without violating the constitutional provision that no witness shall be compelled to testify against himself in any criminal case, for Revised Statutes, sections 4919, 4921, do not subject an infringer to penalties or forfeitures, but merely authorize the court in its discretion and "according to the circumstances of the case" to impose additional damages. *Massetth v. Johnston, 67 O. G. 143, C. D. 1894.

IV. CROSS-EXAMINATION.

16. "Where a witness is called to give his deposition, is examined in chief in relation to a subject properly involved in the controversy, and upon cross-examination refuses to answer a proper, pertinent and material question, his testimony will not be considered" at the hearing. *Milligan v. Niedringhaus, 38 O. G. 103, C. D. 1887.

17. Ordinarily, objections which may be obviated by issuing a new commission and re-examining the witness, as well as formal objections to the interrogatories and answers, should be raised by motion to suppress. *Id.

18. Such motion to suppress should be made without unreasonable delay, so that the omissions may be corrected by a further examination. *Id.

19. The better and safer practice in a case like the present, where the witness declined to answer a proper, pertinent and material cross-interrogatory, is to move for the suppression of the deposition in advance of the hearing and as soon as reasonably possible after such deposition be taken. *Id.

20. It is well settled that when a party has had an opportunity to cross-examine a witness and has neglected to do so, the case is the same in effect as if he had cross-examined, otherwise the admissibility of the evidence would be made to depend upon his pleasure whether he would cross-examine or not, which would be a most uncertain and unjust rule. Wright v. Daggett, 44 O. G. 943, C. D. 1888.

21. A party who omits to cross-examine, relying upon his motion before the commissioner to suppress the depositions, elected what course to pursue and is bound thereby. A court

of law or equity might relieve him from the consequences of his election and by process compel the witness to appear for cross-examination, or the commissioner of patents could order the witness to be produced for cross-examination, under penalty of suppressing his deposition. Osgood v. Badger, v. Bennett, 44 O. G. 1065, C. D. 1888.

22. Until the proper court has been applied to to heal the defect the office will not act upon a motion to strike from the record of a case pending before it the deposition of a witness because he refused to answer a proper question on cross-examination; but it will in a proper case give the moving party a reasonable time to make such application to court. Rueter v. Frist, 58 O. G. 386, C. D. 1892.

V. HUSBAND AND WIFE.

23. The question as to whether husband and wife are competent and compellable to testify for or against each other must be determined by the law in force in the jurisdiction in which the patent office is located, whether that jurisdiction may be said to be the entire United States or the District of Columbia. The question of competency must be determined in accordance with either the common law, the statute law, or both. Marsh v. Rein, v. Ruppel, 43 O. G. 1453, C. D. 1888 (Hall, Com'r).

24. Inasmuch as it seems to be well settled that the common-law provision as to husband and wife is in force in the District of Columbia, it follows that husband and wife are not competent witnesses for or against each other in the tribunals and for the purposes mentioned in sections 876 and 877 of the Revised Statutes of the District of Columbia. Id.

25. A wife is not a competent witness in proceedings before the patent office where her husband is a real party in interest and her testimony is offered on his behalf. Dobeck v. Novotny, 58 O. G. 804, C. D. 1892 (Simonds, Com'r).

26. A wife is non-competent as a witness in proceedings before the patent office where her husband is a real party in interest and her testimony is offered on his behalf. (Affirming Dobeck v. Novotny, 58 O. G. 804.) Crawford v. Lichtenstein, 61 O. G. 1480, C. D. 1892 (Simonds, Com'r).

(The wife is a competent witness for her husband in an interference proceeding in the patent office to which he is a party. Koen v. Quint, 23 O. G. 1329, C. D. 1883, Marble, Com'r.)

APPENDIX.

THE INTERNATIONAL UNION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

This Union was established by the convention concluded at Paris, March 20, 1883, and conferences have been held from time to time, at which the United States has been represented. The last conference was at Brussels, December, 1897. The United States has been a member of the Union since 1887, but no statute has been enacted to carry out the treaty, and its force and validity are more or less in doubt. (See opinion of the Attorney-General of the United States — vol. 47, O. G. 398, Com'rs Dec., A. D. 1889, 253, and the decision of the United States Circuit Court (Coxe, J.) in *Electrical Accumulators Co. v. Julien Electric Co. et al.*, vol. 64, O. G. 559, Com'rs Dec., A. D. 1893, 437.)

The following are the most important articles of the convention :

“ART. II. The subjects or citizens of each of the contracting states shall enjoy, in all the other states of the Union, so far as concerns patents for inventions, trade or commercial marks, and the commercial name, the advantages that the respective laws thereof at present accord, or shall afterward accord, to subjects or citizens. In consequence, they shall have the same protection as these latter, and the same legal recourse against all infringements of their rights, under reserve of complying with the formalities and conditions imposed upon subjects or citizens by the domestic legislation of each state.

“ART. IV. Any one who shall have regularly deposited an application for a patent of invention, of an industrial model, or design, of a trade or commercial mark, in one of the contracting states, shall enjoy, for the purpose of making the deposit in the other states, and under reserve of the rights of third parties, a right of priority during the periods hereinafter determined.

“In consequence, the deposit subsequently made in one of the other states of the Union, before the expiration of these periods, cannot be invalidated by acts performed in the interval, especially by another deposit, by the publication of the invention or its workings by a third party, by the sale of copies of the design or model, by the employment of the mark.

“The periods of priority above mentioned shall be six months for patents of invention and three months for designs or industrial models, as well as for trade or commercial marks. They shall be augmented by one month for countries beyond the sea.

“ART. VI. Every trade or commercial mark regularly deposited in the country of origin shall be admitted to deposit and so protected in all the other countries of the Union.

“Shall be considered as country of origin, the country where the depositor has his principal establishment.

“If this principal establishment is not situated in one of the countries of the Union, shall be considered as country of origin that to which the depositor belongs.

“The deposit may be refused if the object for which it is asked is considered contrary to morals and to public order.

“ART. VIII. The commercial name shall be protected in all the countries of the Union without obligation of deposit, whether it forms part or not of a trade or commercial mark.”

An international union for regulating international registration of trade-marks was initiated in 1890, and established April 14, 1891.

The United States has not become a member of it.

(The international office for the protection of industrial property is located at Berne, Switzerland, M. Morel, director.)

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*Joint patent law of Austria-Hungary expired July 7, 1895. New Hungarian law went into operation March 1, 1896.

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