PATENT-OFFICE MANUAL,

INCLUDING

THE LAW AND PRACTICE OF CASES IN THE UNITED STATES PATENT OFFICE AND THE COURTS HOLDING A REVISORY RELATION THERETO.

ALSO, AN APPENDIX OF COPYRIGHT DECISIONS, Etc.

BY

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PREFACE.

THE purpose of this book is to facilitate the labors of inventors and attorneys in the United States Patent Office by a convenient summary of the more important rulings governing proceedings in that bureau down to the time of going to press. Owing to the constantly increasing activity in invention, many notable decisions are of dates so recent as to be here for the first time methodically presented. On mooted questions it has been aimed, wherever procurable, to give the conclusions of the court of last resort (herein distinguished by an asterisk), and to afford copious cross references to cases which illustrate or which seem to qualify or form exceptions to general rules.

The Patent Office Decisions, the Court of Claims Decisions, and the Treasury Department, matter contained in Gourick's Washington Digest, edited and published by DAVID A. GOURICK, Esq., of the Washington (D. C.) Bar, have been of great assistance in the preparation of the Manual, and are used by the permission of Mr. Gourick.

The close relation of literary and artistic property to franchises within the jurisdiction of the Commissioner of Patents, has made it necessary to append a chapter on Copyrights.

GEO. H. KNIGHT.

TEMPLE COURT,
NEW YORK, 1894.

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ABBREVIATIONS.

Revised Statutes of the United States	R. S.
The United States Supreme Court	U. S. S. C.
Decisions of U. S. Supreme Court and of U. S. Circuit Courts of Appeals	*
U. S. Supreme Court Reports, Official	U. S.
" " " " Lawyers' Edition	L. ed.
United States Circuit Courts	U. S. C. C.
" " " " (Federal Reporter)	F. R.
The Supreme Court of the District of Columbia,	Supr. Ct. Dist. Col.
Decisions of the Commissioner of Patents (published)	C. D.
" " " " " (manuscript)	C. D. MS.
Patent-Office Rules	P. O. R.
Official Gazette of the U. S. Patent Office	O. G.
Ex parte	x. p.

PATENT-OFFICE MANUAL.

CHAPTER I.

THE PATENT FRANCHISE.

WITH the revival of the arts of civilization in the fourteenth and following centuries, an important species of property, unknown to ancient law, began to receive recognition; this property was neither in land nor in chattels, but in constructive ideas. The imperishable and prolific character of constructive ideas renders them of far more enduring value to the world than any form of material wealth;[1] and the manifest prosperity of the countries that were first to accord such recognition of intellectual property has led to the adoption of the principle by every progressive nation.[2]

Long anterior to any statutory provision, the practice of crown grants of brief monopolies in particular industries "new to the realm" had its uses at the time, and was valuable for the legislation which it ultimately led to, but had the misfortune to share the opprobrium that justly attached to the more frequent, better known, and wholly mischievous concessions of trade monopolies in the ordinary pursuits and commodities of life. A signal illustration of the abuse to which this royal prerogative was liable was seen when so wise and (usually) so just a sovereign as Elizabeth could sell to a single speculator the exclusive privilege of dealing in salt, under which that important commodity rose to thirteen-fold

[1] Historical Review of Civilization, by Charles Morris, ii. 117.

[2] See Appendix B.

its ordinary price, and yet capriciously refuse a patent to the unfortunate William Lee, the inventor of the knitting-machine and the founder of the great textile industries of modern England.

The loose and arbitrary practice of extorting revenue by farming out, or sale for a lump sum, of monopolies in the necessaries of life, was injurious in several important directions. It kept alive the meddlesome and conceited mediæval interference with the natural and healthy channels of trade. It enriched a few greedy middlemen, who, having made one profit by bribing officials to betray the crown, made another profit by their extortionate prices to the public. It encroached alike on individual and on public rights and liberties by sequestrating the means of subsistence and by enabling a despotically inclined monarch to levy taxes without parliamentary sanction. Finally, as already intimated, it brought into unmerited contempt the comparatively rare and generally commendable grants of a temporary franchise to the inventor or introducer of an industry "new to the realm."

Toward the close of the sixteenth century these evils had become so flagrant that much of the time of English tribunals was consumed in annulment of crown grants "whereby any person was sought to be restrained from any freedom which he had before, or to be hindered in his lawful trade;"[1] and it is a noteworthy circumstance that these very tribunals usually sustained grants of exclusive privileges for limited periods "to whomsoever bringeth to and for the commonwealth a new manufacture, by his invention, costs, and charges."[2] Thus did these eminent jurists prototype and give cue to the legislation that shortly followed.

The expediency and justice being conceded of a policy which should guarantee to inventors some compensation for their pains and sacrifices and the benefits which they

[1] Hawkins. [2] Ib.

have conferred on the community, there remained only to be considered the manner of its accomplishment; and no plan ever yet proposed has approached, either in practicableness or fairness that which had already been exemplified in the practice of the crown grants already spoken of, by which the person to whom the public was indebted for the art or invention was guaranteed the exclusive control of it for a limited period. In such a system no person is deprived of a single right, liberty, or possession previously enjoyed, and each is free to use the improvement or to refrain from its use. Moreover, the system is the most equitable arrangement conceivable for the inventor, because his reward will ordinarily be commensurate with the value given, so that the patent is itself a self-regulating instrument, characterized by an interchange of benefits in accordance with the natural laws of supply and demand. The farmer who so desired could continue to break ground with the wooden implements inherited from his ancestors, could scatter the seed broadcast, could gather the ripened crop with the sickle, and could separate the grain from the husk by flail or by hoofs of his cattle, instead of availing himself of the steel plough, the grain-drill, the self-binding harvester, and the threshing and separating machine; and the like is manifestly true in every department of industry. Finally, at the expiration of the brief monopoly, the general public would fall full heir to the invention without money and without price.

Systematic grant of patents for inventions dates from the so-called "Statute of Monopolies," wrung from James I. (A. D. 1623). The main purpose of this famous enactment was to put an end to the grants of monopolies in the ordinary trades and commodities of life; but a sort of codicil was wisely appended which excepted from the prohibition "any letters-patent and grants or privilege for the term of fourteen years or under, hereafter to be

made, of the sole working or making of any manner of new manufactures which others, at the time of making such letters-patent and grants, shall not use; so, also, that they be not contrary to the law nor mischievous to the State by raising the price of commodities at home, or hurt of trade, or generally inconvenient."[1]

It is a significant fact that England (then a country at the pastoral stage whose chief export was raw wool) soon became noted for her manufactures, finally outstripping all rivals in industrial progress, and especially in those intelligent phases of it which lead most rapidly to national wealth. A like statement is applicable, in a still more marked degree, to the United States, especially in its last half-century of unprecedented progress under "the American Patent System," inaugurated by Senator John Ruggles.

The patent system of the United States dates from colonial times. Each colony operated quite independently of any other in granting patents for the prosecution of industries not then known within its limits; and hence it sometimes happened that a particular manufacture would be free on one side and subject to a patent on the other side of a State line. These inconveniences suggested the advantage of a national patent system; and at the instance of such master minds as Madison of Virginia and Pinckney of South Carolina, an enabling clause (clause 8, sec. 8, art. 1) was embodied in the Constitution, which laid the foundation for the legislation providing for the grant of patents for inventions and designs, and the registration of copyrights and labels. This clause empowered Congress "to promote the progress of science and the useful arts by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." This enabling clause in the

[1] At a later period (A.D. 1709) the Copyright Act (8 Anne, c. 19) extended a like protection to authors.

fundamental law was shortly followed by the Act of April 10, 1790, and subsequent legislation, which authorized the grant of patents "for the term of fourteen years to the first and original inventor of any new and useful art, machine, manufacture, or composition of matter not known in the United States nor published or patented elsewhere," on the payment of a trifling fee (merely such as was supposed requisite for the expenses of carrying out the provisions of the law) and the filing of a description of the invention "in such full, clear, and exact terms (describing the best mode known to the applicant of carrying out the principle of the invention) as to enable one skilled in the art to which it appertains or with which it is most nearly allied, to compound and use it without making any experiments of his own." Except in the low and merely administrative fee, and that the grant appeared as the legalization of an inherent right, the patent law of the United States during its first half-century was copied wholly from British lines of procedure;[1] hence (just as under the British law of this day) if the application appeared to be in correct legal form and the fees were duly paid, the patent issued as a matter of course, without inquiry as to whether the invention was really new or old, or whether there had been, in fact, any invention at all. Under such a system (?) patents were of course frequently issued for things either totally lacking in inventive novelty or which had already been the subject of a previous grant. In addition to these charges of abuse of the practice of indiscriminate grants, Senator John Ruggles, of Maine, brought forward[2] the still graver charge of the occasional procural of patents for pretended inventions for the sole purpose of levying black-mail.

To prevent the abuses referred to, Mr. Ruggles proposed a system of technical examination of all applica-

[1] Pennock & Sellers *v.* Dialogue, 2 Pet. 19 (21).
[2] Dec. 31, 1835.

tions. Such a system, which inaugurated a new era in the grant of letters-patent for inventions, was embodied by its author in the Statute of July 4, 1836, by which the United States Patent Office, as we now know it, was created as a distinct bureau, which was to be controlled by a Commissioner charged with both judicial and administrative duties, and having subject to his direction a corps of Examiners whose duty it was made to determine the novelty or otherwise of the device presented and the sufficiency of the description of it in the specification. The Act of 1836 was followed, in the years 1837 and 1839, by supplementary acts, in which Mr. Ruggles completed what is now known as "the American System," on the lines he had already laid down. Subsequent legislation has been directed to the improvement in details suggested from time to time in the practical working of the system; the most important being the Act of March 2, 1861, by which the term of patents thereafter to be granted was increased to seventeen years, and such longer term was declared incapable of being extended as the fourteen-year patents had been. On the 1st of December, 1873,[1] all previous patent legislation became merged in the Revised Statutes of the United States.

The institution of the Patent Bureau, with its Commissioner and corps of scientific Examiners, — while not inimical to *bona-fide* inventors, — was declared by its author to have for its prime and chief purpose the protection of the public.[2] Although it would increase several-fold the expense of administration, the Senator estimated that the then existing government charges to applicants would suffice to defray all expenses. Not only has the event justified Mr. Ruggles's estimate that the office would continue to be self-supporting, but the system itself has

[1] The Revised Statutes embrace the laws, general and permanent in their nature, in force Dec. 1, 1873; but were not enacted until June 22, 1874, and were not printed and given to the public until 1875.

[2] Speech of Senator Ruggles, Dec. 31, 1835.

proved to have been of great public benefit; and we have the competent testimony of each succeeding head of the bureau that its usefulness will become still more abundantly manifest when Congress, in its wisdom, shall permit the surplus revenue of the office to be applied to the preparation of indexed digests of the various industrial arts, and other means of thorough and exhaustive technical examination.

The Statute of Monopolies proclaimed no new species of property, still less did it recognize any pre-existing or natural right; it merely restricted within useful bounds a prerogative whose exercise had always been wholly discretionary with the crown, — which it even now is, at least in theory, as the very language employed in the English grants still shows. The authors of the Constitution of the United States, on the contrary, at the very outset of their dealing with the subject, based their action on totally different grounds. Under American law, the exclusive privilege of an invention was no longer an act of executive grace; it was the legal habilitation of an already existing *right;* the inventor was to be secured, for a specified time, in the exclusive use of *his* discovery; the inventor having deposited a complete and intelligible specification and the small fee exacted to cover expenses of the Office, it was made the *duty* of the executive to issue the patent or public certification of proprietorship. In acknowledgment of this right to an invention, which American law recognizes to be inherent in the author of it, President Ulysses S. Grant said: "The Patent System of the United States is, in many respects, radically different from that of any other country. Inferentially, at least, the purpose of the framers of the Constitution appears to have been to recognize property in a new invention as a right belonging to the inventor, not a favor conferred by the Government." [1] The eminent ex-

[1] Pres. Message (U. S. Grant) to 43d Congress, 1st Sess., Ex. Doc. 27.

pounder of the Constitution, Daniel Webster, said: "The American Constitution does not attempt to give an inventor a right to his invention, or an author a right to his composition; it recognizes an original, pre-existing, inherent right of property in the invention, and authorizes Congress to secure to inventors the enjoyment of that right; but the right exists before the Constitution and above the Constitution, and is, as a natural right, more than that which a man can assert in almost any other kind of property." [1]

According to the best authorities, letters patent for an invention may be regarded as in the nature of a contract between the inventor and the general public: [2] thus, Coryton was of the opinion that the clearest insight into the peculiarities of this species of property is from considering it as the result of a contract entered into by the executive (as the public's representative) with the patentee. The parties meet on the understanding that one has a secret to communicate, the other a favor to confer in return.[3] According to Phillips, all laws of this description (providing for exclusive privileges to authors, artists, and inventors) grant only a temporary monopoly, because they offer a compromise between the creator of the work or industry and the rest of the community by which each party surrenders something, and for which it is proposed that he shall receive an equivalent.[4] The Hon. William H. Seward said: "The productions of my mind are, confessedly, as really property as the fabrics of my hands; indeed, they are much more exclusively my own. The patent is a contract by which I convey my inventions to the commonwealth forever, in consideration of the exclusive enjoyment of it by myself for a limited period." [5] Justice Baldwin defined a patent to be a contract between

[1] Arg. of Daniel Webster in case of Goodyear *v.* Day.
[2] Kendall *et al. v.* Winsor, 21 Howard, 322.*
[3] Coryton, 41. [4] Phillips, 22.
[5] W. H. Seward, in argument before Nelson, J.

the public and the inventor of a new and useful art or manufacture, whereby, in consideration of a complete disclosure of the invention, the exclusive right thereto for a limited period is guaranteed to the inventor and his representatives.[1] In a statement of the reciprocal obligations of the patentee and the public, Professor Robinson says that the right of the public is to be put into immediate possession of a distinct knowledge of the invention, and it is the duty of the patentee to give this knowledge; the right of the patentee is to enjoy unmolested the exclusive use of the invention during the life of the patent, and it is the duty of the public to secure him in this right by the ordinary forms of legal protection and redress. These reciprocal rights and obligations are to be assured to the respective parties only by imposing upon each the necessity of fully, literally, and immediately discharging its legal duty to the other; in other words, by interpreting each side of the contract against its promisor and in favor of its promisee.[2]

As the residual beneficiaries of all lapsed or unestablished individual rights, the public at large, in every Patent-Office procedure, have interests which the law [3] makes it the duty of the Commissioner of Patents and those acting under his instructions to safeguard; all such procedures are therefore, in a certain sense, *inter-partes*;[4] but, in practice, the term "ex parte" conveniently distinguishes uncontested from contested cases; and these latter are necessarily subjected to much the more rigorous treatment, in order that exact justice shall be meted out to the contending applicants, and that the patent, if granted at all, shall be to him, and to him alone, to whom the world is indebted for the invention in controversy. A great part of the time of the Office is taken up on these strenuously contested controversies.

[1] Baldwin, J., in Whitney *v.* Emmett. [2] 1 Robinson, 59.
[3] Revised Statutes of the United States, Section 4893.
[4] Reed *v.* Landman; Cook *v.* Leech; Abbey, ex parte; (INTERFERENCES.)

CHAPTER II.

DECISIONS RELATING TO U. S. PATENTS FOR INVENTIONS.

ABANDONMENT, FORFEITURE, ETC.

1. A completed invention may be abandoned to the public.

An incomplete invention may be forfeited in favor of one later to conceive but first to reduce the invention to practice.

The questions of abandonment and of forfeiture arising in interference proceedings are distinct questions; for abandonment of an invention operates in favor of the public, while forfeiture operates in favor of a later inventor. The former has reference to a completed invention; the latter to one that was relinquished or laid aside by the originator at an immature or not fully operative stage.

Hyatt *v.* French, *Leggett, Com.*, 8 Dec., 1873, 4 O. G. 609.

ABANDONMENT OF THE INVENTION.

1. Abandonment of an invention cannot be established on mere presumption or inference. The proof must be positive and conclusive.

Abandonment or dedication of the invention is in the nature of the forfeiture of a right, which the law does not favor, and it should be made out beyond all reason-

able doubt. It can be established by positive proof only, not by mere presumption or inference.

Pitts *v.* Hall, *Nelson and Conclin, JJ.* By *Nelson, J.*, June, 1851, 2 Blatch. 237.

See also Russell *v.* Scow, *Thacher, Act. Com.*, 17 Feb., 1874, 5 O. G. 149.

2. The establishment of abandonment, by two years' public use or otherwise, requires proof so clear as to put the matter beyond all reasonable doubt.

Bury *v.* Thompson, *Simonds, Com.*, 21 Aug., 1891.

3. Abandonment of the invention may take place in one of several ways; for example, —

(*i.*) By ACQUIESCENCE: As where the inventor looks on and sees his invention going into general use, without protest.

Treadwell *v.* Bladen, *Washington, J.*, Oct., 1827, 4 Wash. 708.

(*ii.*) By DEDICATION: As where the inventor announces surrender of the invention to the public.

Pennock *v.* Dialogue, U. S. S. C. By *Storey, J.*, Jan., 1829, 2 Pet. 16.❁

(*iii.*) By INACTION: As where the inventor takes no steps to secure a patent within two years after first public use of the invention.

Sec. 4887 R. S.

4. A single public use more than two years before application constitutes abandonment.

Use *in* public and use *by* the public distinguished.

There may be a use in public of the device by an inventor or his agents for the purpose of experiment,

or there may be a use by the public of the invention with his acquiescence. In the eye of the law, the one is a private use, and may, if the nature of the invention justify it, and no contestant appear, be of several years' duration; the other is a public use of the invention, a single instance of which more than two years before application constitutes abandonment of the invention to the public.

City of Elizabeth *v.* The Nicholson Pavement Co., U. S. S. C. By *Bradley, J.*, Oct. term, 1877, 97 U. S. 126.✽

See, also, Russell *v.* Mallory, 5 Fish. 632; Egbert *v.* Lipman, 21 O. G. 71; Consol. Co. *v.* Wright, 94 U. S. 92; ✽ Rifle Co. *v.* Arms Co., 14 Blatch. 94.

5. Lapse of Time.

Lapse of time, *per se*, does not, of itself, constitute abandonment (Cartridge Co. *v.* Arms Co., 14 Blatch. 94). As to intent, — Bury's belief that he was constantly and continuously in possession of this invention negatives any attempt to give it away; and *his quick action when he heard that some one else was selling the embodied improvement*, is a similar negative.

Bury *v.* Thompson, *Simonds, Com.*, 21 Aug., 1891, 58 O. G. 1255. To same purport, see DELIBERATION; and (9) *et seq.*, DILIGENCE.

6. Abandoned Invention and abandoned Experiment distinguished.

After making a full-size working-machine which was reduced to practice and was known to two other persons besides the inventor, who were laid under no obligations of secrecy, abandonment of invention (by two years' public use or otherwise) might ensue; but the device had

advanced beyond the stage at which it could be called an abandoned experiment.

Ib.

Compare ABANDONED EXPERIMENTS.

7. Two Years' Public Use.

The invalidating two years' public use, of the statute, does not require the knowledge, consent, or allowance of the inventor.

Drawbaugh, x. p., *Simonds, Com.*, 28 Oct., 1891, 57 O. G. 693.

8. Public Use.

Where, for more than two years before applying for a patent, applicant taught his invention to a large number of persons throughout the country, with no suggestion that it was an experiment, and received pay for such instructions, *Held*, to constitute abandonment of the invention.

Inter. Tooth Crown Co. *v.* Gaylord, U. S. S. C. By *Brown, J.*, 27 Ap., 1891, 35 L. ed. 347.✱

9. Abandonment by two years' public use is not avoided by reason of the improvement having been hidden from view by its position in the machinery in which it was used.

Brush *v.* Condit, U. S. S. C. By *Blatchford, J.*, 4 Nov., 1889, 33 L. ed. 251.

10. The question of diligence arises only where one [who was first to disclose the inventive thought] is endeavoring to adapt and perfect the invention; but after such perfection of the invention, the only possible abandonment of it is to the public.

Shaffer *v.* Fraser, *Frothingham, Act. Com.*, 23 Jan., 1892, C. D. Ms.

11. An invention is not abandoned by a public use more than two years preceding a second application filed within two years after expiration of the earlier application.

A. filed an application in 1884, which application became abandoned, by reason of two years' lack of prosecution, 17 Nov., 1887. While this application was yet pending, to wit, in March, 1887, he reduced his invention to practice in public. In June, 1889, he filed a second application for the same invention. *Held*, that the reduction to practice before the abandonment of his first application, and the filing of the second application within two years after said abandonment, saved his rights from dedication to the public.

Witherow *v.* Robert, *Simonds, Com.*, 22 Ap., 1892, 59 O. G. 787.

12. Leaning to Liberality where Construction works Forfeiture.

One ground of rejection by the Examiners-in-Chief was that the method was described and its use illustrated in a prior patent to the applicant, without reservation (Mullen & Mullen, x. p., 50 O. G. 837, and Lord, x. p., 50 O. G. 987). *Held*, that it was the duty of the Office to be guided by the courts in the matter, and also to lean toward the side of liberality where strict construction works a forfeiture; and being guided by such considerations, it must be held that the delay of a month and a half between the issue of applicant's patent and the filing of the application in question did not amount to an abandonment (Eastern Paper Bag Co. *v.* Standard Paper Bag Co., 30 F. R. 63; Holmes Elec. Pro. Co. *v.* Met. Burg. Alarm Co., 33 F. R. 254; and Eastern Paper Bag Co. *v.* Nixon, 35 F. R. 752).

Scott, x. p., *Simonds, Com.*, 11 May, 1892, C. D. Ms.

NOTE. — The foregoing, and Mullen & Mullen, (3) DEDICATION, appear to mark important exceptions to the rule laid down in Hill & Prentice, (1) DEDICATION.

13. A party who had, by two years' failure to prosecute his application, forfeited to the public whatever rights he might have had in the invention, does not recover them by being subsequently made a party to interference proceedings.

Dodge, x. p., *Mitchell, Com.*, 18 Mar., 1891, C. D. Ms.

14. Abandonment of Invention by a Foreign Applicant.

In an interference contest between the holder of a United States patent and an applicant from abroad, the patentee having objected that the foreign applicant, by not having applied for the American patent within two years of the date of the first printed publication which disclosed the invention in issue, had abandoned his invention to the public: *Held*, that the objection was not well taken, as there was no proof of public use or sale, or that the invention had been introduced into public use in the United States for more than two years prior to the application, and no proof of abandonment. Alike with a foreign as with a domestic applicant, the policy of the law does not favor abandonment, — the presumption is always against it, and strict proof of it is invariably required; and the filing of an American application within a reasonable time after the foreign publication raises a presumption against abandonment.

Gueguen *v.* Westinghouse, *Mitchell, Com.*, 20 Mar., 1891, C. D. Ms.

ABANDONED EXPERIMENTS.

1. Fruitless experiments are unavailable as evidence of invention.

Mere experiments which are not followed by diligence and a perfecting of the invention, must be considered as abandoned.

Chipman *v.* Fales, *Fisher, Com.*, 1869, C. D. 44.

2. An abandoned experiment is not such a publication as will render invalid a patent for an invention similar to the thing that had been experimentally produced.

Pickering *v.* Miller, *McKennan, J.*, 25 Ap., 1883, 25 O. G. 89.

3. Where a model which embodied the inventor's earlier idea was destroyed, and the inventor proceeded to experiment in and perfect other devices for producing the same results, his acts afford a very strong presumptive evidence of abandonment of the invention shown in such model.

Barnes *v.* Clinton, *Duell, Com.*, 12 June, 1876, 9 O. G. 1158.

4. When a person, in his endeavors to devise a machine for performing certain operations, constructs a mechanism incapable of producing the results aimed at, and afterward branches off in another direction and attempts to create a new and different machine for performing the same operation, his first attempt must be regarded as an abandoned experiment.

Wicks *v.* Dubois, *Doolittle, Act. Com.*, 16 Feb. 1877, 11. O. G. 244.

Compare, of like tenor, Hunter *v.* Jenkin, (13) DILIGENCE; Clark Thread Co. *v.* Willimantic Linen Co., (30) INVENTION; and Bentley *v.* Wightman *v.* Sprague, (11) REDUCTION TO PRACTICE.

ABANDONED APPLICATIONS.

The records of abandoned applications in the U. S. Patent Office are not open to public inspection.

It is not to be conceded that inventions represented in abandoned applications in the Patent Office are the property of the public. In default of two years' public use of the invention, such an application may be re-instated or revived, and will have lost none of its original right of secrecy. To permit free inspection of such files would be to uncover to public scrutiny, inventions which are still the property of the applicants, and which may ultimately mature into patents.

Fowler, x. p., *Mitchell, Com.*, 14 Oct., 1889, 49 O. G. 562.

For exception to the above general rule, see U. S. *v.* Com. of Pat's, (1) CERTIFIED COPY.

ABANDONMENT OF AN APPLICATION.

1. All applications for U. S. patents are required to be presented in proper condition for examination (Sec. 4888 R. S.), and in default of being put in such condition within two years after filing, or of applicant's neglect to prosecute within two years after an Office action, of which he has been duly notified, such application is regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.

Sec. 4894 R. S.

2. If an applicant neglect to prosecute his application for two years after the date when the last official notice of any action of the Office was *mailed* to him, the application will be held to be abandoned, as set forth in Rule 171.

P. O. R. 77.

3. Prosecution, to save an application from abandonment, must include such "proper action" as the condition of the case may require.

P. O. R. 171.

4. A broad distinction is to be recognized between constructive abandonment of an application and constructive abandonment of the invention; the former may, and frequently does, exist without involving the latter.

Fowler, x. p., *Mitchell, Com.*, 14 Oct., 1889, 49 O. G. 562.

5. Demands of Public Policy.

Section 4894 of the Revised Statutes, requiring that an application shall be completed and prepared for examination within two years after filing, and that not more than two years shall elapse without prosecution after any action thereon, gives ample time to the applicant; and public policy demands that the Office shall consider it as exhausting the liberality which the law extends as regards forfeitures.

Price, x. p., *Simonds, Com.*, 11 Nov., 1891, 57 O. G. 1000.
Compare Cordrey, (2) DELAY.

NOTE. — Abandonment or forfeiture of an application of course does not necessarily imply a forfeiture of the invention; for if it be new and useful, a patent may be secured upon a new application, providing it be filed within two years after expiration of the first application.

Compare Fowler, x. p., (4) *supra;* and Witherow *v.* Robert (11) and Scott (12) ABANDONMENT OF THE INVENTION.

6. A requirement (not a suggestion merely) made by the Examiner of the applicant, must be acted on within two years, to avoid abandonment.

Hume, x. p., *Simonds, Com.*, 28 Sep., 1891, C. D. Ms.

7. "Action," to save abandonment of application, must be in *Writing*.

A mere oral interview with the Examiner as to what he would do, is not sufficient action upon which to base a petition to revive an application which has become abandoned by two years' inaction within the meaning of Section 4894 R. S.

Day, x. p., *Frothingham, Act. Com.*, 28 Nov., 1891, C. D. Ms.

8. Failure to Prosecute.

Where the claimant had failed to prosecute his application for over four years, *Held*, that, to negative the presumption of abandonment, it was necessary to show, to the satisfaction of the Commissioner, that the failure to prosecute within two years from the last Office action, was unavoidable *in each and every part of that period* (Root, x. p., 1887, C. D. 81), and *also* to account for the subsequent failure, for over two years more, to prosecute the application.

Chittenden, x. p., *Mitchell, Com.*, 2 April, 1891, C. D. Ms.

9. "Proper Action" Defined. — Rule 171.

Proper action, within the meaning of Rule 171, is any such action as is prescribed by Statute of by the Rules of Practice. For example: If the case has been once rejected, proper action is a request for reconsideration on an amendment; if the application has been again rejected, and on the original references, proper action is an appeal to the Examiners-in-Chief; after an objection as to form, proper action may consist in either a compliance with the Examiner's requirements, or a request for reconsideration, or a petition to the Commissioner.

Harvey, x. p., *Fisher, Act. Com.*, 25 Feb., 1890, C. D. Ms.

10. Insufficient "Action."— Rule 171.

To assert, in a broader form, claims which the Examiners-in-Chief have rejected, without applying to the Commissioner to have the case re-opened and without a "showing" (Rule 142), is not such an action as a case which is closed requires, to save it from abandonment (Rule 171).

Zimmerman, x. p., *Frothingham, Act. Com.*, 24 Aug., 1891, C. D. Ms.

11. Neglect, Misinformation, — not Excusable.

On January 30 applicant was advised that an interference had been declared between his case and another, and that his case would be held up for revision under Rule 96, after decision in interference. On November 12 the interference was decided in favor of said applicant, of which due notice was mailed to him, but he took no action for more than two years. *Held* (overruling applicant's contention that the Office should have notified him, at termination of interference, that the case was awaiting his action): Applicant and his attorney were bound to *know* what was contained in the record, and also what action its condition required; nor was applicant's neglect excused by the fact that the application in question had been confounded with another of his applications.

Brown, x. p., *Frothingham, Act. Com.*, 23 May, 1892, C. D. Ms.

12. Insufficient "Action." — Rule 77 (2).

Application was filed 11 May, 1889, and the customary acknowledgment sent to applicant. Nothing further was done in the case until 5 Feb., 1890, when, at applicant's request, action was suspended until further notice. On 28 Nov., 1891, applicant requested action, but the Examiner refused to act on the application, holding that

it had become abandoned for want of prosecution for more than two years after notice of last action. *Held*, that, under Section 4894 R. S., and part 2, of Rule 77, the two years ran from the Official action of 14 May, 1889; and that the application became abandoned by applicant's failure to call for action within two years thereof.

Carpenter, x. p., *Frothingham, Act. Com.*, 15 Feb., 1892, C. D. Ms.

13. Neglect to Appeal.

Neglect to appeal to the Supreme Court of the District of Columbia within the time prescribed, constitutes an abandonment of the application which will not be rectified by fruitless attempts to obtain a rehearing (Gandy *v.* Marble, 122 U. S. 432,* ; Kirk *v.* Com. of Patents, 37 O. G. 451,* ; Vose *v.* The Trustees, &c., 2 Woods, 647 ; Cambuston *v.* U. S., 95 U. S. 285, * ; Wylie *v.* Coxe, 14 How. 1,*).

Miller, x. p., *Mitchell, Com.*, 25 June, 1890, C. D. Ms.

14. The Office cannot act upon a protest of abandonment filed by a party having a merely equitable interest. *Quære*, whether the protest might afterward be considered as evidence of intention not to abandon the application, in case the legal title should become vested in protestant?

Smith, x. p., *Frothingham, Act. Com.*, 10 Aug., 1891, C. D. Ms.

15. Extension of Time held to be an "Action" within the Meaning of Sec. 4894 R. S.

Application was acted upon by the Office, 13 Sep., 1888. Applicant obtained, on 21 Dec., 1889, a grant of extension of time in which to amend. There was no further action until 2 Jan., 1891, when applicant filed an amend-

ment. The Examiner refused admission to this amendment on the ground that the application had become abandoned by non-action within two years from 13 Sep., 1888. *Held*, that the Office letter of 21 Dec., 1889, granting extension, constituted an action within the meaning of the law, and, consequently, applicant's amendment was within the legal limit and therefore admissible.

Barre, x. p., *Mitchell, Com.*, 29 April, 1891, C. D. Ms.

16. Sufficient "Action."

Where the Office action was of a twofold character, one branch requiring a division and the other branch relating to discrepancy between a certain claim and certain subject-matter disclaimed, and applicant responded, within two years, with an action as to the discrepancy but not as to the requirement of division: *Held*, that applicant had not failed to take steps in the prosecution of his application within the two years required by law.

Bassett, x. p., *Mitchell, Com.*, 12 June, 1891, C. D. Ms.

ABORTIVE EXPERIMENTS. See ABANDONED EXPERIMENTS; DILIGENCE; INTERFERENCE; REDUCTION TO PRACTICE.

ADAPTATION.

1. Where parts are dispensed with and other devices employed in their places, rendering necessary certain additions to meet new aspects of the case: *Held*, that here is presumptive proof of invention as distinguished from that form of skill which manifests itself in a mere change of expedients, such as the substitution of mechanical equivalents.

Armstrong, x. p., *Leggett, Com.*, 28 Dec., 1872, 2 O. G. 704.

2. When devices, however well known in other machines or for other purposes, have never been employed

in a given machine or for purposes suggestive of the new application, legitimate combinations may be formed embodying such old devices.

Underwood, x. p., *Fisher, Com.*, 3 June, 1870, C. D. 53.

3. Where an inventor merely brings an old element into his machine, he makes no invention; but where he does more, — dispenses with certain parts, duplicates others, re-arranges and simplifies the machine, — he must be held to have made an invention.

Mundy *v.* Lindergood, U. S. C. C. S. D. N. Y., *Wheeler, J.*, 23 Ap., 1884, 27 O. G. 718. See also, 1872, C. D. 25; 24 O. G. 303; 28 O. G. 96; and Blinn *v.* Gale, *Paine, Com.*, 26 Aug., 1879, 16 O. G. 723.

4. If an old device or process be put to a new use which is not analogous to the old one, and the adaptation of the process to the new use is of such a character as to require the exercise of inventive skill to produce it, such use will not be denied the merit of patentability.

Ansonia Brass & Copper Co. *v.* Elec. Sup. Co., U. S. S. C. By *Brown*, J., 14 March, 1892, 58 O. G. 1692, ✿.

Compare (31) *et seq.*, INVENTION.

5. Whoever employs an old device in a new or modified way to produce a new and useful result, must be regarded as an inventor.

The objection of "double use" can only be raised when the old device applied to the new purpose is used in substantially the old way, or with such modifications only as call for nothing more than ordinary skill.

Burnham, x. p., *Duncan, Act. Com.*, 1872, C. D. 25.

6. An elevated water-tank for railway-stations, having its top or its top and bottom protected from external

cold by a space filled with air, or some other non-conductor of heat, is not anticipated by a refrigerator having spaces in its top and walls. Such new application of the non-conductibility of confined air and kindred substances is made under such widely different conditions and with such modifications in the previous mode of use as must have called for something more than mere adaptation, — it constitutes invention.

1872, C. D. 25.

Compare ANTICIPATION; PATENTABLE INVENTION; UTILITY.

ADDITIONAL EVIDENCE.

Satisfactory "Showing" Required.

When it is sought to present, for consideration, additional evidence, the attempt must be accompanied by a satisfactory "showing" why such evidence was not introduced at the first hearing.

Spielman, x. p., *Simonds, Com.*, 16 Sep., 1891, 56 O. G. 1707.

Compare Parry & Parry *v.* Black, (108); and Van Depoele *v.* Deeke, (169) INTERFERENCE.

ADMISSIONS.

Where it appears that the filer of an application in interference with a patent already granted, had, before making his application, contracted with the original patentees to manufacture and supply them with certain articles to be made under their patent, his subsequent application, and the evidence offered to support it, should be subjected to the sharpest scrutiny.

Dillon *v.* Kimball *et al.*, *Simonds, Com.*, 9 Jan., 1892, 58 O. G. 384.

AFFIDAVIT.

TO ANTEDATE REFERENCE.

1. An applicant cannot be held to have complied with Rule 75 when he merely avers that he conceived the invention and disclosed it to others, without stating by what agency the disclosure was made, and the details of which it consisted. To permit an applicant to prevail upon his naked statement of conception and disclosure would be to transfer the seat of judgment and decision from the tribunal sitting in the case to the mind of the applicant, — a transaction radically defective in principle and contrary to all judicial usage.

Donovan, x. p., *Mitchell, Com.*, 27 June, 1890, 52 O. G. 309.
See also Hansen *v.* Davis, *Mitchell, Com.*, 55 O. G. 998.

2. Applicant was required by the Examiner to file the drawings referred to in his affidavit, and to also file affidavits of those to whom the said drawings had been disclosed, properly identifying them. *Held,* that the Examiner should undoubtedly be upheld as far as relates to the drawings (Saunders, x. p., 1883, C. D. 23), but that the requirement that the affidavits of the persons to whom the drawings were disclosed should be furnished, must be overruled.

Hurlbut, x. p., *Mitchell, Com.*, 2 Aug., 1890, 52 O. G. 1062.
See REFERENCES.

3. The Affidavit required of Applicant who demands Interference with a Patent.

The affidavit which Paragraph 2 of Rule 94 requires of an applicant who desires his application to be put in interference with a patent, does not necessarily call for the showing of facts required by Rule 75, and is merely

an *ex parte* matter. The right to call for such showing is discretionary with the Office.

Ries *v.* Thomson, *Simonds*, *Com.*, 9 Dec., 1891, 57 O. G. 1598.

AGGREGATION.

Aggregation without New Function, not Patentable.

Where all the elements of a machine were old, and no new function was performed by the combination: *Held*, that, although the machine was undoubtedly more perfect than other machines for the same purpose, yet, as it was more perfect simply because of the co-operation of a greater number of elements, and not because of any new function performed by the combination, the case came within the many rulings of the Supreme Court holding that a mere aggregation of old elements in a new relation is not patentable.

Union Edge Setter Co. *v.* Keith, U. S. S. C. By *Brown*, J., 6 Ap., 1891, 139 U. S. 530, ✱.

See, to same purport, (1), (10), and (11) COMBINATION; also (30) *et seq.*, INVENTION.

ALLOWANCE.

Allowance takes date from the day notice was mailed to applicant or to his attorney.

Notice of allowance was issued 2 July, 1889, but was erroneously dated 2 June, 1889, which attorney knew was a mere clerical error, but sought to have the case withdrawn from issue. *Held*, that it could not be held that, because of said error, the case had not been regularly passed and allowed, and that it must be assumed that the attorney knew that under the Statute (Sec. 4885 R. S.) and the rules (Rule 167), the final fee could be paid within six months from the date the notice was

actually *sent*, and, in default thereof, that the case was abandoned.

Farnum, x. p., *Frothingham, Act. Com.*, 7 Jan. 1892, C. D. Ms.

Compare ABANDONED APPLICATION; RE-INSTATEMENT OF FORFEITED APPLICATION. See also Price, x. p., (20) PUBLIC RIGHTS AND OBLIGATIONS.

AMBIGUITY.

1. Claims ambiguous in phraseology, or which relate, or may be so read as to relate, to performances or functions merely, or to abstract principles or results, — not to specified instrumentalities, — are inadmissible, and ought not to be granted. It is the duty of the Office to obviate, as far as possible, the necessity for judicial correction of its errors, and to refuse claims of purely functional form, and even those which are *susceptible* of a functional interpretation.

Ives, x. p., *Paine, Com.*, 4 Dec., 1878, C. D. 134.

2. A mere reference to the body of the specification, by the words "substantially in the manner described," is not good practice, under the Statute requiring that the applicant shall "*distinctly*" claim his invention.

Rice, x. p., *Leggett, Com.*, 2 May, 1874, C. D. 44.

For important qualification of the rule laid down in Rice, *supra*, — *in case of a basic invention*, see decision of the Supreme Court in Morley Machine Co. *v.* Lancaster, ❀ (39) CLAIMS. See also (40), (41), (46) CLAIMS.

ACQUIESCENCE.

Acquiescence in a rejection and acceptance of a patent for the unrejected portions, constitutes abandonment of the rejected portions.

Where an applicant has acquiesced in a rejection, by the Patent Office, of his original claims, by submitting

amended claims, and taken a patent therefor, the Court will limit him to a strict construction of the allowed claims.

The J. L. Mott Iron Works *v.* The Standard M'f'g Co., U. S. C. C. W. D. Pa., *Acheson, J.*, 28 May, 1892, 60 O. G. 2071.

To same purport, see McClain *v.* Ortmayer, ❁ (67); Roemer *v.* Peddie, ❁ (72); Phœnix Caster Co. *v.* Spiegel, ❁ (73) CLAIMS; and Sargent *v.* Hall Safe & Lock Co., ❁ (10) PUBLIC RIGHTS AND OBLIGATIONS.

AMENDMENT.

1. Amendment must have its foundation either in the drawing or in the specification.

Where there was no foundation, either in the specification or the drawing, upon which the amendment presented could be based, as required by Rule 70: *Held*, that the matter could not be helped by a supplemental oath, nor by the fact that, in a letter to his attorney, before the application was drawn, the applicant had indicated the construction which he desired to put into the case.

Scott, x. p., *Fisher, Act. Com.*, 6 Dec., 1890, C. D. Ms.

2. Substantial Amendment. — Rule 134.

The rejection of a claim based upon a consideration of the merits cannot be avoided by a mere change in the phraseology of the claim, — the substantial meaning of the claim remaining unchanged. Rule 134 provides for action upon an amended claim only when "amended in matter of substance." To be entitled, as of right, to amend after the second rejection without a "showing," — except to put the claim in better form for consideration on appeal (Rule 168), — applicant should be pre-

pared to show that the amendment prior to the second rejection was material in its scope and character.

Gibbs, x. p., *Mitchell, Com.*, 31 Oct., 1890, C. D. Ms.

As to test of materiality in framing claims, see Griswold, x. p., (4) EXAMINATION. Compare also Cheeseborough, x. p., (6) RE-OPENING CASE.

3. New Matter Inadmissible.

Where applicant sought to amend his drawing, — not to conform to the specification as it was at the time of the filing of the application, but so as to conform to the specification as proposed to be contemporaneously amended, and the Examiner refused to comply with applicant's request to "admit, consider, and reject, under Rule 133," and (on the contrary) required restoration of the drawing to its original condition as required by Rule 70: *Held*, that the question came properly, by petition, to the Commissioner, and Examiner's action was sustained (Kissner, x. p., 53 O. G. 919). Case distinguished from such as Regan, x. p. (1888, C. D. 161), in which the drawing [or the specification], as originally filed, discloses the controverted matter.

Olmsted, x. p., *Mitchell, Com.*, 11 May, 1891, 46 C. D. Ms. 489.

4. "Benefit of the Doubt."

Where the Examiner refused to admit an amendment, on the ground that it did not substantially change the scope of the claims as originally presented: *Held*, that, as applicant appeared to be shaping his claims in good faith for the purpose of avoiding the references and accommodating himself to the action of the Office, he should be given the benefit of the doubt, and the amendment should be admitted for examination.

Lapham, x. p., *Frothingham, Act. Com.*, 21 Mar., 1891, C. D. Ms.

Compare Rogers, x. p., (2) EXAMINATION; and Noyes, x. p., (9) SPECIFICATION.

5. Admissibility of a claim, founded on the original specification, is a question of "merits," and is appealable to the Examiners-in-Chief.

Applicant presented two claims which he alleged substantially conformed to a recommendation of the Examiners-in-Chief, and, consequently, had foundation in the specification and drawings originally filed; but the Examiner reported adversely to their admission, on the ground that they had no such foundation, and that their admittance for examination would therefore be in violation of Rule 70, and contrary to the decision in Olmsted, x. p. (46 C. D. Ms. 489). *Held*, that Olmsted, x. p., did not sustain the action taken by the Examiner. That decision relates to an entirely different state of facts, and distinctly holds that the question whether a proposed claim is authorized by the specification and drawing as originally filed, is a question which must be decided by the Examiners-in-Chief, on appeal.

Pugsly, x. p., *Frothingham, Act. Com.*, 12 Oct., 1891, C. D. Ms.

NOTE. — Applicant and the Examiner being at issue as to a question of fact, it would seem, from Lapham, x. p., (4) *supra*, and Rogers, x. p., (2) EXAMINATION, that the Examiner, instead of refusing to entertain the claims, should, by rejecting them, have put the case in condition for appeal to the Examiners-in-Chief. In the case of Olmsted, x. p., (3) *supra*, on the contrary, applicant admitted that his new drawing did *not* conform to his original specification.

6. Where an amendment to the statement of invention was not objected to by the Examiner, *Held*, that it could be admitted without withdrawing the case from issue.

Taylor, x. p., *Fisher, Act. Com.*, 16 Jan., 1891, C. D. Ms.

7. Claims inadmissible in a Single Application which could not be included in one and the same Patent.

It is undoubtedly well settled that the refusal to enter an amendment containing claims which, if admitted, would not free the application from its condition as containing two or more separate and independent inventions; or to enter one containing claims which would place the application for the first time in such a condition that division would have to be required, — is a proper action.

Pierce, x. p., *Frothingham, Act. Com.*, 6 June, 1892, C. D. Ms.

Compare Robbins, x. p., (3); and Bullard, x. p., (24) DIVISION.

8. An amendment to an application must, to satisfy the requirements of Rule 70, show only such a change as was within the original disclosure that was made when the application was first presented.

Smith, x. p., *Simonds, Com.*, 23 Mar., 1892, 58 O. G. 1840.

Compare Holt, x. p., (4) CLAIMS.

9. Amendments should all have been filed before appeal is taken.

Rule 68 is explained to imply that amendments filed after a case has been twice rejected, and has either been appealed or is in condition for appeal, will not be entertained as a matter of course, but only on a "showing," duly verified, of reasons, which the Commissioner shall adjudge to be sufficient, why such amendments were not earlier presented.

Donovan, x. p., *Hall, Com.*, 9 July, 1888, C. D. 100.

10. Ordinarily all claims must be presented before the appeal stage.

If, as understood, the claim rejected by the Primary Examiner and by the Examiners-in-Chief was a broad

claim, there is no reason why a narrow and limited claim should not have been presented at the same time, and the judgment of the Office thus obtained upon both at once. If a party is allowed to come into the Office with a broad claim, secure a careful and thorough examination thereof, appeal, and take the judgment of the Office rejecting it, then present another and more limited claim as a matter of right, and pursue the same course of appeals, he could occupy the time of the Office unlimitedly, depending simply upon his skill and ingenuity in gradually reducing or limiting the character of his claim from the broadest to the narrowest scope of which the described invention was susceptible. It must be borne in mind that although the original examination of an application is supposed to be thorough and comprehensive, it is impossible for the Examiner to retain the subject in his mind and be familiar with it weeks or months afterward, when he takes the case up for a second consideration upon a narrower claim. Hence it is that Rule 68 has been adopted, the purpose of which is to require applicants to present their applications with their claims fully set forth, — as broad as they see proper, or as narrow, — in order that the entire subject may receive early and thorough consideration. If applicants fail to observe this requirement, and insist upon a single broad claim, and take an appeal, their right to amend is restricted and limited. Some "showing" must then be made why it was not earlier presented.

Donovan, x. p., *Hall, Com.*, 9 July, 1888, C. D. 100.

Compare (2) *et seq.*, DILATORY METHODS.

11. Amendment preparatory to Appeal.

There is nothing in the decision in Opdyke, x. p. (50 O. G. 1293), nor in any other cases laying down the same principle, which in any way tends to excuse an applicant from making the "showing" called for by

Rule 68, in order to secure the incorporation of amendments "touching the merits of the application" after the case is in condition for appeal.

Schmitz, x. p., *Mitchell, Com.*, 21 July, 1890, C. D. Ms.

NOTE. — The clause in Rule 68, above referred to, is as follows: —

If amendments touching the merits of the application are presented after the case is in condition for appeal, or after appeal has been taken, they may be admitted, upon a showing, duly verified, of good and sufficient reasons why they were not earlier presented.

12. Exception to Rule 68.

Where, after a second rejection and as a preliminary to appeal, applicant presented a new claim, with the statement that it was for the purpose of appeal and not for delay, and it appeared that the new claim covered substantially the subject-matter of the rejected claim, except that it was somewhat more restricted, and the Examiner refused to admit the claim, on the ground that it was not an amendment of the claim in the case, but an additional claim: *Held*, that Rule 68 did not apply to a case where no additional examination was required, and where the claim was the same except with some further restrictions; and that if the amendment did not come within the letter, it certainly did come within the spirit of the rule, and that the claim should be admitted.

Dubois, x. p., *Fisher, Act. Com.*, 23 Dec., 1890, C. D. Ms.

13. Latitude accorded Applicant.

Where amendments are presented for the purpose of putting the case into better condition for appeal to the Examiners-in-Chief, applicant will ordinarily be allowed to determine for himself the form which the application and claims shall assume (Sutliff, x. p., 40, C. D. Ms.

172; Leslie, x. p., 42, C. D. Ms. 235; and Collis, x. p., 50, O. G. 992).

Tuerffs, x. p., *Fisher, Act. Com.*, 4 Nov., 1890, C. D. Ms.

14. Right, in Same Application, to present Claim for Machine after Final Rejection of Claims for Product and for Process, Denied.

After applicant has prosecuted his claims for the article to final rejection, and after his claims to the process have been rejected, he should not be permitted to shift his ground so as to cover another and distinct invention, without a "showing" of good and sufficient reasons therefor, as provided for under Rule 68. It is not, however, intended to express any opinion as to whether or not the claims for the machine might have been presented together with those for the process and the article, in the original filing.

Phelps, x. p., *Frothingham, Act. Com.*, 23 Feb., 1892, C. D. Ms.

Compare with Winterlich, x. p., JOINDER OF MACHINE AND ITS PRODUCT; Butterfield & Batchelor, x. p., (2) RE-OPENING OF CASE; and Kinzer, x. p., (54) CLAIM.

15. Amendment must be seasonably presented.

After the Examiners-in-Chief had sustained Primary Examiner's rejection, petition to remand the case to Primary Examiner for interlocutory appeal as to said claims and to permit certain new claims, was denied at this stage of the proceedings, but without prejudice to the renewal of the petition after a decision by the Commissioner on the rejected claims.

Johnson, x. p., *Mitchell, Com.*, 25 June, 1890, C. D. Ms.

Compare Ellmaker, (16) *infra*; and Cheeseborough, x. p., (6) RE-OPENING CASE.

16. It has long been held by the Office that when a case is ready for appeal, no amendment will be admitted unless good and sufficient reason be shown why it was not earlier presented. This practice was approved by the present Commissioner, in the case of Cordrey, x. p. (48 O. G. 397), and may now be considered established.

Ellmaker, x. p., *Fisher, Act. Com.*, 19 June, 1890, C. D. Ms.
Compare Johnson, x. p., (15) *supra.*

17. After a decision by the Examiners-in-Chief, an amendment with nothing to support it but an affidavit by an expert to the effect that the references do not anticipate applicant's invention, will not be received. (See Rules 142 and 68, and the case of Parker, x. p., C. D. Ms.)

Anderson, x. p., *Fisher, Act. Com.*, 18 Feb., 1890, C. D. Ms.
Compare Corning *v.* Burden, (1) EXPERTS.

18. Amendments appealable to the Commissioner and Amendments appealable to the Examiners-in-Chief, Defined and Distinguished.

Objections to the specification accompanied by the Examiner's refusal to act further on the merits until the objections have been removed, are reviewable by a petition to the Commissioner, and not by an appeal to the Examiners-in-Chief. Amendments involving departure of invention raise no question for the Examiners-in-Chief unless they consist of new claims, either in whole or in part, or enlarge the meaning of the old claims already in the case.

Cäbel, x. p., *Mitchell, Com.*, 22 Nov., 1890, 55 O. G. 863.

19. An appeal case, amended in vital particulars must, before action on "merits," be returned to the Primary Examiner.

Amendments after appeal may be admitted for the purpose of putting the rejected claim in better form for consideration on appeal. Such amendments, however, should not vary the scope of the claim. If they have been admitted, and do vary the scope of the claim, the appellate tribunal should not pass upon the "merits," but the case should be sent back to the Primary Examiner for action.

Hooper & Clark, x. p., *Frothingham*, *Act. Com.*, 18 July, 1891, 56 O. G. 929.

20. An amendment upon the "merits," after final rejection, should be accompanied by a verified "showing" of good and sufficient reasons why it was not earlier presented.

Peloubet, x. p., *Frothingham*, *Act. Com.*, 26 May, 1891, 56 O. G. 928.

21. While an allowed application cannot, ordinarily, be re-opened for revision, modern restrictions on remedy by re-issue justify some indulgence in the original application.

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. Especially is this true since under modern decisions of the courts the right of re-issue has become so restricted that any failure, in the first application, to obtain full protection of an invention is, in a vast majority of cases, without remedy.

Myers, x. p., *Mitchell*, *Com.*, 24 Sep., 1889, 49 O. G. 131.

Compare Cordrey, x. p., (2); Lowe *v.* Springer *v.* Morse *v.* Granger, (3) DELAY; Pacholder, x. p., (1); Wharton, x. p., (2) PHRASEOLOGY; Pearson, x. p., (1) PIONEER INVENTION; Holt, x. p., (1) NEW MATTER; and Noyes, x. p., (9) SPECIFICATION.

22. Amendment after Allowance.

As a general rule, applications which have been allowed will not be recalled for the purpose of amendment, but an exception to the rule must be recognized in cases where great hardship or irreparable injury would otherwise result. Hence, where the claim sought to be incorporated is so specially pertinent to the subject-matter of the application, and so inseparable in its nature from the particular invention sought to be patented, that, if allowed in another application, there would be grave doubt whether the patent therefor would be valid, amendment after allowance should be permitted.

Ib.

To same purport, see Heald *v.* Rice, (1) JOINDER OF INVENTIONS. For general rule, to which the above case forms an exception, see (2), (9), (10), (11), (14), (15), (16), (17), and (20) *supra*.

23. Amendment for the Purpose of dominating Subsequent Inventions by Others, — Discountenanced.

Officials of the Patent Office, having judicial or quasi-judicial duties, should be upon their guard against amendments made late in the history of proceedings upon an application, which are apparently inspired by the purpose of dominating inventions subsequently made by other inventors, and not embraced within the scope of the application as originally filed.

Rogers *v.* Wissinger, *Mitchell, Com.*, 7 Mar., 1891, 56 O. G. 804.

24. Applicant's attorney may insert amended claims in consonance with the specification without having them verified by a special oath of applicant.

Railway Register M'f'g Co. *v.* N. Hudson Railway Co., *Nixon, J.*, 24 Feb., 1885, 32 O. G. 519.

25. Amendment of Drawing.

Petition to amend a drawing and thereby bring out a feature of construction not shown in the drawing as originally presented, nor described in the specification, but shown in an exhibit model not a part of the application, denied (Kissner, x. p., 53 O. G. 919).

Austin, x. p., *Simonds, Com.*, 19 Aug., 1891, 56 O. G. 1059.

26. Amendment of Preliminary Statement.

Motion to amend a preliminary statement, after a delay of four months and a half, denied.

Gornall *v.* Lovejoy, *Simonds, Com.*, 12 Aug., 1891, 56 O. G. 927.

ANALYSIS.

An applicant cannot be compelled to make an analysis of his material; but the Office has no facilities for making any such analysis, and if applicant is unwilling to make one, so as to facilitate examination, he must take the consequences.

Street, x. p., *Frothingham, Act. Com.*, 23 Feb., 1892, C. D. Ms. Compare Corson, x. p., (1); and Perkins, x. p., (2)

PRACTICAL DEMONSTRATION.

ANSWER.

The defence of "No Patentable Combination" can be made by setting it up in the answer.

Hendy *v.* Goldsmith, U. S. S. C. By *Blatchford, J.*, 14 May, 1888, 43 O. G. 1117, ✽.

ANTICIPATION.

1. Prior description in a printed publication or in a patent (to invalidate a United States patent) must be such as would be sufficient in such a patent.

Parker *v.* Stiles, *M'Lean, J.*, Nov., 1849, Western Law Journal.

Compare, to same purport, Green, x. p., (16) *infra.*

NOTE. — The decision of Commissioner Butterworth, in Borden, x. p., (3) PRIOR PUBLICATION, seems to have sustained action of rejection of an application on a reference of less completeness than was required in Parker *v.* Stiles, for invalidation of a granted patent. See, however, numerous cases cited in note to Borden, x. p.

2. When genius and patient perseverance have at length succeeded, in spite of sneers and scoffs, in perfecting some valuable invention or discovery, how seldom is it followed by a reward! Envy robs the inventor of the honor, while speculators, swindlers, and pirates rob him of the profits. Every unsuccessful experimenter who did or did not come near making the discovery, now claims it. Every one who can invent an improvement or vary its form claims a right to pirate the original discovery. We need not summon Morse, Blanchard, or Woodworth to prove that this is the usual history of every great discovery or invention.

Goodyear *v.* Day, *Grier, J.*, Mar., 1852, 2 Wallace, Jr., 283.

3. How invariable it is that — after a great invention has been brought before the world and has become known to the public and put in a form to be useful — people start up in various places and declare that they invented the same thing long before! These pretended prior inventors had thought of such a thing, perhaps, but they had never carried it to the extent of

making it of practical utility, *so that the world could obtain possession of it;* but when they find that another had completed that which they had begun, they are astonished that they did not see, think they must have seen, all that is necessary, and claim that they have invented it. After having seen what has been done, the mind is very apt to blend subsequent information with prior recollections and confuse them together. Prophecy after the event is easy prophecy. I think that this is one of the cases in which several of the witnesses have been led into the illusion of believing that they knew before what they have been taught by Mr. Howe's invention and specification.

Howe *v.* Underwood, *Sprague, J.*, Feb., 1854, 1 Fisher, 161.

Of like tenor, see (5), (7), (8), (9), (10), (15), (16), (17), (18), (19), and (24) *infra.*

4. A device which was used for about two and one half months only, and was then laid aside, *Held*, to be an anticipation of the patented invention, when the use was not for the purpose of testing the device, but was a public and practical one, with as much success as was reasonable to expect at that early stage of a particular art.

Brush *v.* Condit, *Shipman, J.*, 12 July, 1884, 28 O. G., 451.

5. Allegation of prior invention is usually entirely within control of the party asserting it; and so wide is the opportunity for self-deception or mistake, that the authorities are almost unanimous in holding that it must be established by proof clear, positive, and unequivocal; nothing must be left to speculation or conjecture.

Thayer *v.* Hart, *Coxe, J.*, 28 June, 1884, 28 O. G., 542.

6. That which would infringe the patent, if later, anticipates it if earlier.

Sessions *v.* Romadka, *Dyer, J.*, 26 July, 1884, 28 O. G., 721.

7. The presumption of the law is that the patentee is the inventor of that for which letters-patent are granted to him. Whoever alleges the contrary must assume the burden of proof. Evidence of doubtful probative force will not overthrow the legal presumption.

Am. Bell Telephone Co. *v.* The People's Telephone Co. *et al.*, U. S. C. C. S. D. N. Y., *Wallace, J.*, 1884, 29 O. G., 1029.

8. To constitute an effective defence, the proof of anticipation must be as full as required in the specification of a patent.

Patented inventions cannot be superseded by the mere introduction of a foreign publication of the kind, though of prior date, unless the description and drawings contain and exhibit a substantial representation of the patented improvement, in such full, clear, and exact terms as to enable any person skilled in the art or science to which it appertains to make, construct, and practise the invention to the same practical extent as he would be enabled to do if the information were derived from a prior patent. The prior knowledge of an invention, to avoid a patent, must be knowledge equal to that to be given by a patent.

New Process Fermentation Co. *v.* Koch, *Brown, J.*, May, 1854, 29 O. G., 537. See also Seymour *v.* Osborne, U. S. S. C. By *Clifford, J.*, 9 Jan., 1871, 11 Wall., 516,*.

9. It has been frequently held that drawings alone, unaccompanied by letter-press description, will never invalidate a patent.

Ib.

See also Parsons *v.* Colgate, 24 O. G., 203; Atterbury, x. p., 9 Ib., 640; Judson *v.* Cope, 1 Fish., 615; Reeves *v.* Keystone Bridge Co., 5 Fish., 456; and Seymour *v.* Osborne, 11 Wall., 516, *.

10. The Test of Probabilities.

As a guide to truth it is safer to rely upon the actions of men than upon their expressed declarations, — when the actions and the declarations are inconsistent. All persons reason in the direction of their desires, and resolve doubts in their own favor. When the dim and distant recollection of a party concerning his own conduct or that of another, in a matter of great interest to him who speaks, is found to be wholly at variance with what the known facts in that connection would naturally suggest and prompt, the fair inference is that the recollection of the witness is at fault, and that the logic of the known facts points nearer to the truth. It is natural for persons to hunt hastily through the pigeon-holes of memory where unpleasant or damaging truths are supposed to be stored away; and, on the other hand, it is just as natural to encourage and quicken the pace of a lagging and uncertain recollection which is believed to contain even a fragmentary fact which will tend to mend a flaw in a title through which valuable interests may escape. It is in such cases that *the desire, coupled with the imperfect conception of a device, ripens and matures in the light of subsequent knowledge;* but it very frequently occurs that the inventor confounds his original device and his later conception, and gives the latter the date of the former, and does it innocently. In such cases we appeal to the inherent probabilities which are always the ear-marks of truth.

Voelker *v.* Gray *v.* Edison *v.* Bell, *Butterworth, Com.*, 3 Mar., 1885, 30 O. G., 1091.

11. Benefit of the Doubt.

Where evidence, adduced by defendant, of alleged prior use of the patented article sued upon, is such as to leave the Court in doubt whether or not the exact device

in question was ever hit upon by a prior experimenter, and where it appears that the first general use of the device came from its publication by the patentee, this doubt should be resolved in his favor.

The Washburn & Moen M'f'g Co. *et al. v.* The Beat Em All Barbed Wire Co. *et al.*, U. S. S. C. By *Brown, J.*, 29 Feb., 1892, 58 O. G., 1555, ✱.

12. A single instance of profitable use in public — anticipates.

Where there had been a public, well-known, practical use in ordinary work, with as much success as was reasonable to expect at that stage in the development of the mechanism belonging to electric arc lighting, of the exact invention which was subsequently made by the patentee; *Held*, that although only one article like the patented invention was ever made, which was used two and one half months only, and although the mechanism in question was necessarily concealed from view during its legitimate use, and notwithstanding that the invention was taken from the lamp and was not afterward used with carbon pencils, it was, nevertheless, under the established rules on the subject, an anticipation of the patented device.

Brush *v.* Condit, *Mitchell, Com.*, 24 Sep., 1889, 49 O. G., 1211.

Compare (4) ***supra.***

13. A domestic applicant is entitled to receive a patent for his invention as against all foreign knowledge or use not based on a patent or a printed publication.

De Ferranti *v.* Westinghouse, *Mitchell, Com.*, 2 July, 1890, 52 O. G., 457.

14. An English patent, in order to anticipate, must have been *sealed* prior to the date of the invention for which the domestic patent was granted.

Smith *v.* Goodyear, U. S. S. C. By *Strong*, *J.*, 8 Jan. 1877, 93 U. S., 488, ✽. See also Bliss *v.* Merrill, *Coxe*, *J.*, 7 Dec., 1887, 42 O. G., 97.

15. Prior Patent or Publication.

Novelty is not negatived by any prior patent or printed publication, unless the information contained therein is full enough and precise enough to enable any person skilled in the art to which it relates to perform the process or make the thing covered by the patent sought to be anticipated (Walker on Patents, 57; Seymour *v.* Osborne, 11 Wall., 516,✽; Cohn *v.* U. S. Corset Co. 93 U. S., 366,✽; Eames *v.* Andrews, 122 U. S., 40, ✽).

Deprez & Carpentier *v.* Bernstein *v.* Hunter *v.* Gaulard & Gibbs, *Mitchell*, *Com.*, 24 Feb., 1891, 54 O. G., 1715.

16. Defective Reference.

A printed publication that expresses a conception of the invention and nothing more, seems to be defective as a reference, in that it does not "place the invention in the possession of the public as fully as if the art itself had been practically and publicly employed" (Robinson on Patents, Sec. 330).

Green, x. p., *Mitchell*, *Com.*, 28 Ap., 1891, C. D. Ms.
Compare (1), (6), (8), (9) *supra*, and (24) *infra*.

17. Proof of anticipation must be clear, positive, and beyond reasonable doubt.

The usually uncertain character of oral testimony to alleged anticipations of a patented invention has obliged courts to subject such evidence to the closest scrutiny, and not only to impose upon defendants the burden of

proving such anticipations, but to require that the proof shall be clear, satisfactory, and beyond a reasonable doubt. Witnesses whose memories are prodded by the eagerness of interested parties to elicit testimony favorable to themselves, are not usually to be depended upon for accurate information.

Washburn & Moen M'f'g Co. *v.* The Beat Em All Barbed Wire Co., U. S. S. C. By *Brown, J.*, 27 Feb., 1892, 58 O. G., 1555, ✿.

18. Insufficient Alleged Anticipation.

To constitute anticipation of a patented invention, it is not sufficient that the device relied upon might, by modification, be made to accomplish the function performed by the patent in question, if it was not designed by its maker, nor adapted nor actually used for the performance of such functions.

Topliff *v.* Topliff *et al.*, U. S. S. C. By *Brown, J.*, 25 Ap., 1892, 59 O. G., 1256, ✿.

19. Insufficiency of Disclosure in Official Reference.

Upon appeal from a decision of the Examiners-in-Chief which denied patentable novelty upon reference to a patent the material part of which relied upon in the present action was found in the specification, the language referred to being: —

> "By changing the form of the cams, this zigzag edge-stitch can be so modified that the needle passes down first through one of the pieces to be joined, then through the joint, and then through the other piece."

The Commissioner reversed the decision of the Examiners-in-Chief, saying that the form of the cams referred to was neither shown nor described, neither was the stitch itself. Given the pending application, it was easy to find applicant's improvement in the patent referred to; but such a finding required three assumptions, to

wit: (1) that patentee's seam was the same as applicant's; (2) that the modification of cams referred to could be arrived at without invention; and (3) that the machine, thus modified, would work practically upon knit goods, as to which there was ground for much doubt. The Commissioner considered the point a nice one, but held that the patent did not make the disclosure affirmatively and with the certainty required in order to bar an applicant.

Wilcox, x. p., *Simonds, Com.*, 26 Mar., 1892, C. D. Ms.

NOTE. — The learned Commissioner's above ruling is clearly conformable to the doctrine repeatedly laid down by tribunals in such cases. All whom it may concern are thereby warned that modifications deemed of sufficient importance for mention should (equally with the typical form) be described and represented with sufficient particularity to enable its construction by a practitioner, without the exercise of invention on his part (Parker *v.* Stiles, (1); New Process *v.* Koch, (8); Deprez *et al.* *v.* Bernstein *et al.*, (15); and Topliff *v.* Topliff *et al.*, (18) *supra*; Witty & Caffrey, MODIFICATIONS; and Detwold *v.* Reeves, (42) CLAIMS. See also Walton, x. p., (2); Burr *v.* Duryee, (5); and Lockwood, x. p., (7) EQUIVALENTS).

20. Although defendant conceived the idea of his patented device from an examination of complainant's patent, he is, nevertheless, entitled, in a suit for infringement, to claim that complainant's patent was itself anticipated by still earlier devices, especially when such earlier devices show a complete anticipation of his own.

Hoff *v.* Iron Clad M'f'g Co., U. S. S. C. By *Brown, J.*, 30 Mar., 1891, 35 L. ed., 179, ✱.

21. Printed Publication.

While it is true that under the present British statutes no invention can be said to have received a

British patent — within the meaning of Sections 4886 and 4887 R. S. — until the final act of affixing the seal, yet the fact must not be overlooked that the specification of said patent may be published before the sealing of the patent, which *publication* might have the effect of a bar to the granting of an American patent.

Mason *v.* Thompson, *Frothingham, Act. Com.*, 24 Aug., 1891, C. D. Ms.

22. Foreign Patent.

A foreign patent is evidence of perfected invention if the description contained therein is sufficiently clear and definite, and reduction to practice is not necessary to constitute a title to receive an American patent based upon it.

Deprez & Carpentier *v.* Bernstein *v.* Hunter *v.* Gaulard & Gibbs, *Mitchell, Com.*, 24 Feb., 1891, 54 O. G., 1711.

23. A foreign publication is competent as evidence in regard to the state of the art, and as a foundation for the inquiry whether it required invention to pass from the invention therein described to the structure patented.

French *v.* Carter, U. S. S. C. By *Blatchford, J.*, 24 Nov., 1890, 34 L. ed., 664, ✱.

24. It is a matter of extreme doubt whether an application can ever be rejected upon a reference whose construction is not specifically described, but reliance is placed wholly or mainly upon the illustration in the drawings.

Buhlman, x. p., *Fisher, Act. Com.*, 29 May, 1890, C. D. Ms.

25. A combination producing a group of useful results, *Held*, not to be anticipated by several prior combinations of some of the elements, each producing some, but not all, of said results; the superiority of the patented

device over the prior devices resulting not from any particular part or element, but rather from the combination and arrangement of the parts as a whole.

Illinois Watch Co. *v.* Robbins & Avery, U. S. C. C. A. (7th Cir.), Harlan, Woods & Jenkins, JJ. By *Woods, J.*, 1 Oct., 1892, 61 O. G., 721, ✽.

APPARATUS.

1. In the sense of the Patent Act, an apparatus must be classed as a "machine."

Blythe, x. p., *Butterworth, Com.*, 28 July, 1884, 30 O. G., 1321.

2. A new apparatus is a separate invention from the "art" which it is intended to carry out.

Ib.

APPEAL.

1. While not required to have the fulness of a brief, the grounds of appeal should, nevertheless, be explicitly stated.

Rules 133 and 135 require that appellant shall identify the part or parts of the decision appealed from, so that the Examiner may confine his statement to the particular points involved in the appeal, and not be compelled to anticipate every possible aspect which the presentation of the case on appeal may assume; but these reasons need not constitute a brief of the argument upon which the applicant will rely at the hearing; hence the action of the Examiner — refusing to answer the appeal on the grounds that it is not regular in form, or that it did not set forth the points on which it was taken, but stated simply that it was an appeal from the rejection of the claims on the references of record — is overruled.

Callahan, x. p., *Mitchell, Com.*, 6 Feb., 1890, 50 O. G., 990.

Compare Holmes *v.* Coles, U. S. S. C. By *Lamar, J.*, 3 Feb., 1890, 51 O. G., 622, ✽. See also McMillen & Hurst, x. p., (7) EXAMINER; also, (22) INTERFERENCE, and (2), (4), and (5) *infra*.

2. If the statement of reasons required by Rule 147 is defectively short, it does not necessarily render the appeal fatally defective.

Pitney *v.* Smith & Egge, *Mitchell, Com.*, 23 Sep., 1889, C. D. Ms.

3. The rejection of an application on the ground that the subject-matter having been disclosed in a former patent to the applicant without any indication in such patent of intent to claim it elsewhere, the invention must be held to have been dedicated to the public, is a question of the "merits," and appealable to the Examiners-in-Chief.

Comacher, x. p., *Fisher, Act. Com.*, 1 May, 1890, C. D. Ms.

4. A brief statement of reasons of appeal should accompany motion, but is not indispensable.

Upon a motion to dismiss an appeal from the Examiners-in-Chief to the Commissioner, on the ground that it was not accompanied by the "brief statement of reasons" required by Rule 147: *Held*, dismissing the motion, that the Statute does not require that the reasons shall be stated in order to render such appeal valid. The rule is *directory* in its nature, and not a condition precedent to the validity of the appeal.

Holmes & Holmes *v.* Coler, *Mitchell, Com.*, 17 May, 1890, 51 O. G., 1622.

5. All the claims desired to be adjudicated on must be presented on appeal, — in the first instance.

It appears to be the settled practice of the Office that, under ordinary circumstances, the appellant should, in the first instance, bring up narrow claims with his broader claims, on appeal, if they are to be passed upon in the one application under consideration (Parker, x. p.,

C. D. 41, Ms., 390; Jerome, x. p., C. D. 49, Ms., 223, and cases there cited).

Sailor, x. p., *Frothingham, Act. Com.*, 4 Feb., 1892, C. D. Ms.

6. Remandment to Primary Examiner.

Where, upon appeal from the Examiners-in-Chief, it appeared that, in affirming the action of the Primary Examiner, they had based their decision wholly on patents which were neither cited nor relied upon by the Primary Examiner, but which applicant had referred to in his specification as indicating the state of the art and as defining the limits of his invention, and applicant desired to present reasons why such patents did not anticipate, and filed affidavits in support of his views; the case was remanded to the Primary Examiner with direction to consider such patents, and also such affidavits and exhibits as had been filed with the Commissioner, or might hereafter be filed in accordance with the request.

Rogers, x. p., *Fisher, Act. Com.*, 29 Mar., 1890, C. D. Ms.

7. Question of Division.

Refusal by Examiner to entertain a divisional application, on the ground that it covers matter that could not be legitimately divided out of the earlier application, is reviewable by the Commissioner, on petition. It does not involve a question that can be taken to the Examiners-in-Chief by way of appeal, and Examiner's refusal to forward such appeal was properly made.

Fuller, x. p., *Simonds, Com.*, 4 Dec., 1891, 57 O. G., 1883.

8. A rejected application for a patent, pending, on appeal to the Supreme Court of the District of Columbia, is not open to review by the Commissioner of Patents.

Jerome, x. p., *Simonds, Com.*, 21 Jan., 1892, 58 O. G., 945.

9. Election.

A party who moves to dissolve an interference on two grounds, and has his motion granted upon one of them, has no right of appeal upon the other.

Ries *v.* Thomson, *Simonds, Com.*, 9 Dec., 1891, 57 O. G., 1598.

Compare cases under ELECTION and ESTOPPEL.

10. No appeal, by an opposing party, can be taken to any tribunal from a decision affirming the patentability of a claim, or the applicant's right to make the same.

Edison *v.* Stanley, *Simonds, Com.*, 3 Oct., 1891, 57 O. G., 273.

Nevertheless, the Commissioner may, for adequate reasons, withhold the grant. See (7) and (8) COMMISSIONER.

11. An applicant will be required to pay only one fee on a single application, on appeal to the Examiners-in-Chief, even if such appeal be repeated.

Thomson, x. p., *Frothingham, Act. Com.*, 10 July, 1891, 56 O. G., 1203.

12. Where, in an interference proceeding, the Primary Examiner fixed twenty days in which to appeal from his decision on a motion to dissolve, and the last day fell on Thanksgiving Day: *Held*, that day being a legal holiday, the limit of appeal expired the day before.

Dean & Robie *v.* Foendle, *Fisher, Act. Com.*, 1 Mar., 1890, C. D. Ms.

APPLICANT.

1. Applicant cannot select Examiner.

After the case has been examined and the claims finally rejected in one division, it cannot, at applicant's request, be transferred to another division for further examination. An applicant is not entitled to demand, as a matter of right, that the examination shall be made by a particular Examiner.

Porter, x. p., *Frothingham, Act. Com.*, 6 June, 1892, C. D. Ms.

2. [redacted]

The right of applicants to frame their own claims must be recognized, and the Office must act upon the claim as framed, and not upon a part of the claim, or upon a construction of the claim which ignores a part of it.

Graf & Reynolds, x. p., *Mitchell, Com.*, 6 Mar., 1891, C. D. Ms.

Compare, of like purport, Noyes, x. p., (9) SPECIFICATION; Rogers, x. p., (9) EXAMINATION; Lapham, x. p., (4) AMENDMENT; and cases (1), (2), (3), (4), and (5) PHRASEOLOGY. For instances where Examiner's verbal criticisms were sustained, see Kerr, x. p., (50) and (51), and Rogers, x. p., (52) CLAIMS; Raymond, x. p., (10) EXAMINATION; and Bromley, x. p., (10) SPECIFICATION.

3. Although it is to be deprecated, there is no way in which an applicant can be deprived by the Office of the right to delay for two years before responding to each Official action.

Epstein, x. p., *Fisher, Act. Com.*, 28 Nov., 1890, C. D. Ms.

Compare Todd, x. p., (1), and Cushman, x. p., (2), FORFEITURE; Knowles, x. p., (4) RE-INSTATEMENT OF FORFEITED APPLICATION; and cases (2) *et seq.*, DILATORY METHODS.

4. Deceased Applicant.

A "patent" which purports to issue to and in the name of a deceased person is void.

De La Vergne Refrig. Mach. Co. *v.* Featherstone *et al.*, *Blodgett, J.*, 29 Feb., 1892, 58 O. G., 1842.

5. Where the person or party who would have been entitled to receive the patent dies before the sealing of the patent, a valid grant thereof can be made only to the legal representative, and only on such

representative filing proper credentials of trust or ownership.

Sections 955 and 4896 R. S., and P. O. R., 25.

Compare DECEASE OF INVENTOR.

NOTE. — For an unassigned right, the patent issues to the Executor (or Administrator) in trust for the estate; for an assigned right, the issue is to the Assignee.

6. In Interference with a Patentee.

The burden, as to priority of invention, in an issue between a patent and an application, is upon the applicant to make out such a case as would warrant a cancellation of the patent by the Office, if jurisdiction existed for that purpose.

Gosline *v.* Barney, *Mitchell, Com.*, 9 Nov., 1889, C. D. Ms.

7. Legal Presumption.

In an interference between a patent and an application, where the question was not one of independent origination, but a dispute over the invention of the specific thing patented, the natural presumption in favor of the validity of the patent is greatly strengthened by the fact that the junior party to the interference had full knowledge of the patentee's proceedings before the Office, yet was fifteen months behind him in filing the application.

Hisey *v.* Peters, *Simonds, Com.*, 11 Mar., 1892, 58 O. G., 1691.

8. Where one of the contestants has a patent for the invention in dispute, and the other is an applicant for a patent, the latter, in order to prevail, must present a case, both as to conception and as to reasonable diligence, which does not admit of a reasonable doubt (U. S. Stamping Co. *v.* Jewett *et al.*, 18 Blatch., 469; Duffy *v.* Reynolds *et al.*, 24 F. R., 855; Fisk *v.* Church, 5 Fish., 540; Taylor *v.* Wood, 12 Blatch., 110; Drill Co.

v. Simpson, 37 O. G., 218); and also must (anterior to the filing of patentee's application) have reduced the invention to practical form as an operative machine (Elec. R. R. Sig. Co. *v.* Hall R. R. Sig. Co., 6 F. R., 603; Union Met. Cartr. Co. *v.* U. S. Cartr. Co., 7 F. R., 344).

Hunter *v.* Jenkin, *Simonds, Com.*, 12 Sep., 1891, 56 O. G., 1705.

NOTE. — The patentee's act, in application for patent, is regarded as the legal equivalent of an actual reduction to practice (Lowe *v.* Springer *et al.*, (1) CONSTRUCTIVE REDUCTION TO PRACTICE). To overcome this legal presumption, the later applicant must prove an *actual* reduction prior to such filing date (Lindsay *v.* McDonough, (126) INTERFERENCE). Furthermore, if, when he filed his application, patentee had already put his invention into actual practice, contestant's actual reduction must antedate the patentee's (Grant *v.* Harris, (122) INTERFERENCE).

Compare (118) to (132) inclusive, INTERFERENCE.

THE APPLICATION.

1. Application for United States Letters Patent must be within two years after the first sale or public use of the invention, and must be accompanied by Petition, Oath (or Affirmation), Drawing, Specification, and the fee ($15). It must be made by the Inventor, or (if deceased) by the Executor, or Administrator, for the benefit of the heirs.

Sections 4888 *et seq.* R. S.

2. There must accompany each application for a U. S. patent a written description of the invention (illustrated by a drawing if relating to a machine or to an apparatus), and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled

in the art or science to which it appertains or with which it is most nearly connected to make, construct, compound, and use the same; and, in the case of a machine, to explain the principle thereof and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions. Finally, he is required to distinctly particularize the part, improvement, or combination which he claims as his invention or discovery.

Sections 4888 and 4889 R. S., and P. O. R., 30.

3. An incomplete application which is suffered by applicant to remain so for the space of two years after filing, or an application which after completion he neglects for two years to prosecute, after any action thereon, and notice given him thereof, is regarded as abandoned, unless it shall be shown, to the satisfaction of the Commissioner, that such delay was unavoidable.

Section 4894 R. S., and P. O. R., 31.

Compare ABANDONMENT OF THE INVENTION; ABANDONMENT OF AN APPLICATION; RE-INSTATEMENT OF FORFEITED APPLICATION.

4. Two, or more, co-pending applications by the same applicant on the same indivisible subject-matter, inadmissible.

Applicant had two, or more, separate applications pending, which showed and described substantially the same invention, in each of which, respectively, he had broad and limited claims not, in Examiner's opinion, drawn on legitimate lines of division. *Held*, that an applicant should not be allowed to prosecute at the same time several applications for the same indivisible subject-matter. He must make clear distinctions between his respective applications, and not thrust upon the Office a task which properly belongs to himself, of de-

fining and maintaining the lines between two, or more, kindred applications.

Smith, x. p., *Hall, Com.*, 16 Aug., 1888, 44 O. G., 1183.

NOTE. — For cases where presentation of the same subject-matter in several contemporary applications was approved because the claims in the respective applications were drawn on legitimate lines of division, compare Langlois, x. p., (12), Gabouri, x. p., (13), and Feister, x. p., (14) EXAMINATION.

5. The creator of a generic invention may show and describe several species, and may claim one of them, and may also secure a generic claim inclusive of them all. Claims to other specific forms can be protected only under separate patents.

Eagle, x. p., *Fisher, Com.*, 1870, C. D. 137.

6. Applicant's election of one of several species shown, for his specific claim, bars claims to other species in the same application.

Where an application has received examination upon a specific claim which has been rejected upon references whose sufficiency was so far admitted by applicant as to cause him to cancel said claim, the Examiner held that, while it is true that the inventor of a generic invention has a right to show and describe several species and to claim one of them, and also to present a generic claim inclusive of them all, as clearly set forth in Eagle, x. p., 1870, C. D. 137, nevertheless, having claimed this species, — whether in company with a generic claim or not, — he has made an election, and, when the Office has considered the claims thus presented, and rejected them on references the sufficiency of which was so far admitted by applicant as to cause him to cancel the species claim, he has no right to come before the Office with a claim for another species in the same application; and, further-

more, that the species being fully met, the genus falls with it; that the invention claimed is anticipated in full, and that there remains nothing on which the applicant can base a demand for examination of claim to a second species under the genus. *Held*, that the Examiner's decision was strictly in accordance with the established practice of the Office.

Mitchell, x. p., *Mitchell, Com.*, 25 Sept., 1890, C. D. Ms.

Compare Eagle, x. p., (5) *supra;* also Dewey, x. p., (49), and Heaton, x. p., and Cook, x. p., (85) CLAIM.

7. Filing Date.

Where an application — filed 27 June, 1891 — was complete in all necessary parts, except in the absence from the drawing of a figure 3, called for in the specification: *Held*, upon its appearing that the numeral 4 had been inadvertently affixed to a figure instead of the numeral 3, and that the drawings were in fact complete, that the application should be given a filing date as of June 27, 1891.

Hayes, x. p., *Frothingham, Act. Com.*, 28 July, 1891, C. D. Ms.

8. Documents for Record in the Patent Office required to be Accurate and in Permanent Ink.

When the type-written part of the application and other papers is not in permanent ink, the Examiner may require applicant to furnish accurate copies and in permanent ink, because the permanent character of the written records of the Office is an important matter.

Ritter, x. p., *Simonds, Com.*, 22 Dec., 1891, 57 O. G., 1883.

9. Where, after an application had been rejected, the inventor employed an attorney to prosecute the applica-

tion, and then went into a foreign country and remained abroad for more than two years, during which time he had no communication with his attorney nor made any inquiry either of him or of the Patent Office in reference to the application: *Held*, that it was not such unavoidable delay as would warrant a revival of the application. Neither absence in a foreign country, nor pressure of business, nor intrusting the conduct of an application entirely to an attorney or an assignee, is sufficient reason for holding that a delay was unavoidable (Wickersham, x. p., 18 C. D. Ms., 358; Maxwell, x. p., 21 C. D. Ms., 222; Barrett, x. p., 39 C. D. Ms., 351).

Wiard, x. p., *Fisher, Act. Com.*, 2 Ap. 1890, C. D. Ms.

Compare RE-INSTATEMENT OF APPLICATION.

10. Two Years' Statutory Probation, — Explained and Applied.

Section 4886 of the Revised Statutes — which was in force when complainant's patent was applied for and issued — enacts that a patent may be obtained when the invention has not been "in public use or on sale for more than two years prior to the application;" and Section 4920 provides that it may be pleaded and proved as a defence, in a suit at law or in equity on the patent, that the invention "had been in public use or on sale in this country for more than two years before the application, or had been abandoned to the public."

It is contended by the plaintiff that the principles recognized by this court in Elizabeth *v.* Pavement Co. (97 U. S., 126,*) establish the patentability of his invention, notwithstanding its embodiment in the California Street Railroad. But the Circuit Court held that the proofs in the present case did not show a use of the invention *substantially for experiment*, but showed such a *public use* of it as must defeat the patent. The Circuit

Court further said that the facts were in marked contrast with those in Elizabeth *v.* Pavement Co., because there the use was solely for experiment.

We think that the present case does not fall within the principles laid down in Elizabeth *v.* Pavement Co. The plaintiff did not file a caveat, and there is no evidence that he did not intend to abandon his right to a patent. It does not appear that any part of the structure was made at his own expense, or that he put it down in order to ascertain its durability or its liability to decay, or that what he said he noticed in the spring of 1879 led him to make any further examination in that respect, or to test further the fear which he says he had at that time, or that what he then saw led him to think that the structure was weak or undesirable. It cannot be fairly said, from the proofs, that the plaintiff was engaged in good faith, from the time the road was put into operation, in testing the working of the structure he afterwards patented. He made no experiments with a view to alterations; and we are of the opinion, on the evidence, that sufficient time elapsed to test the durability of the structure, and still permit him to apply for his patent within two years. He did nothing and said nothing which indicated that he was keeping the invention under his control.

In Smith & Griggs M'f'g Co. *v.* Sprague (123 U. S., 249, 256, 257, ❋) it was said, — Mr. Justice Mathews speaking for the Court: —

A use by the inventor for the purpose of testing the machine, in order by experiment to devise additional means for perfecting the success of its operation, is admissible; and where, as incident to such use, the product of its operation is disposed of by sale, such profit from its use does not change its character; but where the use is mainly for the purpose of trade and profit, and the

experiment is merely incidental to that, the principal, and not the incident, must give character to the use. The thing implied as excepted out of the prohibition of the statute is a use which may be properly characterized as substantially for the purpose of experiment.

In addition to the above, the Court cited and applied Hall *v.* Macneale (107 U. S., 90, 96, 97, ✽) and Egbert *v.* Lippmann (104 U. S., 333, 336, ✽).

The decree of the Circuit Judge (*Wallace*) was affirmed.

Henry Root *v.* Third Avenue R. R. Co., U. S. S. C. (Oct. term, case No. 39). By *Blatchford, J.*, 21 Nov., 1892, ✽.

Compare (4), (7), and (8) ABANDONMENT OF THE INVENTION.

ARBITRATION.

Where a contract stipulates that an arbitration is to be a condition precedent to the right to sue under the contract, or even if this may be inferred upon construction, no suit can be maintained unless the plaintiff has made all reasonable efforts to comply with the conditions.

Perkins *v.* U. S. Elec. Lt. Co., *Wallace, J.*, 18 Ap. 1893, 24 O. G., 204.

ART.

1. The Words "Art," "Process," etc., as used under the Patent Law, Defined and Distinguished.

A "process," *eo nomine*, is not made the subject of a patent in our acts of Congress. It is [however] included under the general term "useful art." "An art" may require one or more "processes" or "machines," in order to produce a certain result or "manufacture." The term "machine" includes every mechanical device or combination of mechanical powers and devices to perform some "function" and produce a certain effect or result. But where the result is produced by chemical

action, — by the operation or application of some element or power of nature, or of one substance to another, — such modes, methods, or operations are called "processes." A new process is usually the result of "discovery;" a machine, of "invention." The arts of tanning, dyeing, making water-proof cloth, vulcanizing india-rubber, smelting ores, and numerous others, are usually carried on by processes, as distinguished from machines. One may *discover* a new and useful improvement in the process of tanning irrespective of any particular form of machinery or mechanical device. Another may *invent* a labor-saving machine by which the operation or process may be performed, and each may be entitled to his patent. It is for the discovery or invention of some particular *method* or *means* of producing a beneficial result or effect, that a patent is granted, and not for the result or effect itself. But the term "process" is often used in a more vague sense, in which it cannot be the subject of a patent. Thus, we say that a board is undergoing the "process" of being planed; grain, of being ground; iron, of being hammered or rolled. Here the term is used subjectively or passively, as applied to the material operated on, and not to the method or mode of producing that operation. In this use of the term it represents the function of a machine, or the effect produced by it on the material subjected to its action; but it is well settled that a man cannot have a patent for the function or abstract effect of a machine, but only for the machine which produces it.

Corning *et al. v.* Burden, U. S. S. C. By *Wayne, J.*, Dec., 1853, 15 Howard, 252, ❁.

NOTE. — For further and more comprehensive elucidation of the above legal phrases, see decision of U. S. Supreme Court in Dolbear *v.* Am. Bell Telephone Co., ❁ (16), and of *Wheeler, J.*, in MacKay *v.* Jackman, (45) INVENTION. Compare also Blythe,

x. p., (5) CLASSIFICATION; Young, x. p., (15), and Harrison, x. p., (18) PROCESS; and comments of Commissioner Simonds, in Kelly, x. p., (2), and Dalton, x. p., (3) *infra*.

2. The Word "Art," in Patent Law and Jurisprudence.

The definitions of a "process," in Corning *v.* Burden (15 Howard, 252, ✽) — quoted, with seeming approval, in Tilghman *v.* Procter (102 U. S., 707, ✽) and in Cochrane *v.* Deener (94 U. S., 780, ✽), — are understood to practically define the word "art" in the patent law.

Kelly, x. p., *Simonds, Com.*, 30 Oct., 1891, C. D. Ms.
Compare Young, x. p., (15) PROCESS.

3. Whether the word "Art," as employed in the statute, has been fully defined, — Quære.

It is not believed that the Supreme Court has ever stated the entire range of meaning belonging to the word "art." It has said, in substance, that a process is an art (Corning *v.* Burden, 15 Howard, 252, ✽; and Cochrane *v.* Deener, 94 U. S., 780, ✽). The decision of the Supreme Court, endorsing the validity of Bell's telephone patent (126 U. S. 1) shows, however, that chemical processes are not the only things which are comprehended by the word "art" in Section 4886 R. S. An important claim (Claim 5) of Bell's patent, which was presented, considered, and endorsed, presents no such process as was defined by the Supreme Court in Corning *v.* Burden, *supra*, and in Tilghman *v.* Procter (102 U. S., 707, ✽). So far as can be known, there was no change effected in the nature of any *substance* by the practice of Bell's art. The *art* which was there endorsed may be said to consist in the TRANSMISSION AND REPRODUCTION OF A VOCAL IMPULSE. Nothing appears to show that any change in the *nature* of

that impulse took place during such transmission or reproduction.

Dalton, x. p., *Simonds, Com.*, 18 Feb., 1892, C. D. Ms.

NOTE. — Compare instructive actions of the Supreme Court in construing the eighth claim of Samuel F. B. Morse, and the above-cited fifth claim of Alexander Graham Bell, (46) CLAIMS.

4. Grouped Letters for Telegraphic Purposes.

The following claim bears some analogy to that granted to S. F. B. Morse, 13 June, 1848, for certain groups of dots and dashes to represent letters of the alphabet: —

In a printing telegraph, the combination substantially as herein set forth, with a key-board having its keys designated by characters in substantially the following sequence, — BODFGMK – JYEAIOU – SCPLTHER – VIVEAIOU – SCPLTHER – QWEAIOU – BUDFGMK – XYEAIOU – SCPLTHER – VIVAEIOU – BUDFGMK – JYEAIOU – SCPLTHER – QWEAIOU – BUDFGMK – ZYEAIOU – SCPLTHER – XYEAIOU, — with a type-wheel having its periphery engraved with characters corresponding both in form and sequence to the characters upon said keys.

Claim in patent to C. F. Burke, for a printing telegraph, granted 7 Oct., 1884, 29 O. G., 6.

5. Discovery.

Whoever discovers a previously unknown mode of action in the world of physical things and reduces it to practice, getting a novel product or process within the range of patentable subject-matter, distinctly useful and lying outside the range of experience and skill, makes a patentable discovery, even though the discovery be entirely accidental.

Such accidental origin, even if true, would be immaterial unless coupled with one other fact; namely,

that the inventor did not know how he produced the article or product, and could not produce it again.

Vollrath *v.* Comstock, *Simonds, Com.*, 5 May, 1892, 59 O. G., 1105.

NOTE. — The claim in question was as follows: —

"Enamelled ironware having mechanically suspended or held in and throughout the glaze a granular or comminuted material, in color contrasting with that of the body of the enamelled coating, and comparatively infusible as compared to the glaze."

To substantially the same purport as above ruling, see (29) INVENTION.

"A process for breaking and training animals," which was found to be clearly a new and highly useful invention, did not appear to come within the terms of a patentable art such as was laid down by the Supreme Court in Corning *v.* Burden (15 How., 252, ✱), and Cochrane *v.* Deener (94 U. S., 780, ✱), and in the decision of Morton *v.* N. Y. Eye Infirmary (5 Blatch., 116); and the adverse decision of the Examiners-in-Chief was affirmed.

Kelly, x. p., *Simonds, Com.*, 30 Oct., 1891, C. D. Ms.

Compare Griggs *v.* Perrin, (4) COPYRIGHT.

ARTICLE OF MANUFACTURE.

1. Patentable novelty in process does not confer patentability on the product.

A patent for "An Article of Manufacture" cannot be sustained on the ground that it was fabricated by new and improved machinery; it must be a new and improved thing in itself, possessing novelty of its own, independent of the devices, processes, or arts by which it was produced (Cobb, x. p., 1874, C. D. 60; Rumford *v.* Lauer, 10 Blatch., 122).

Draper *v.* Hudson, *Shepley, J.*, 11 Mar., 1873, 3 O. G., 354.

For important exceptions to the above general rule, see Painter, x. p., (2), and Corscaden *v.* Recht, (3.) *infra.*

2. A claim for an article of manufacture should not, as a rule, be defined by the process of producing it. On the other hand, *when a man has made an invention, his right to a patent for it, or his right to a claim properly defining it, is not to be determined by the limitations of the English language.* When the case arises that an article of manufacture is a new thing, a useful thing, and embodies invention, and that article cannot be properly defined and discriminated from the prior art otherwise than by reference to the process of producing it, a case is presented which constitutes a proper exception to the rule. An illustration of such exceptional case was seen in that of the Globe Nail Co. *v.* Horse Nail Co. (19 F. R., 819), where the Court sustained the following claim, which defines the patented article wholly by the process of making it: —

A nail, made by cutting or punching from hot-rolled ribbed bars of metal, a headed blank substantially as described, and by elongating, hardening, and compressing the shanks of such blanks by cold-rolling from the head to the point, thereby giving to all parts of the nail so produced the peculiar qualities specified.

Painter, x. p., *Simonds, Com.*, 9 Nov., 1891., 57 O. G., 999.

3. In the case of Corscaden *v.* Recht, an exception like that announced in the case of Painter (*supra*), to the general rule laid down in Draper *v.* Hudson, was applied, and reference was made to the Supreme Court decision in the case of Plummer *v.* Sargent (120 U. S., 442, ❁), in which a claim for an article defined by the process of making it was held not to be infringed by an article which was made by a different process, although not to be distinguished by mere inspection.

Corscaden *v.* Recht, 26 Aug., 1892, C. D. Ms.

4. The rejection of a claim to an alleged new article of manufacture sustained, where the only new feature of substance which was attained by use of applicant's process was specified by other claims which had been allowed by the Examiners-in-Chief. A thing is not necessarily new because made by a new process.

Rogers, x. p., *Simonds, Com.*, 9 Mar., 1892, C. D. Ms.

5. It is a sound principle of law that the patentee of a new article of manufacture is bound to disclose how to make it, unless the description of the article itself at once suggests to those conversant with the art the means of making it.

If tools and processes for making a new article are not generally known, an illustration of them is permissible.

Amjourn, x. p., *Simonds, Com.*, 3 Mar., 1892, C. D. Ms.

6. Where applicant contended that certain references did not fully anticipate his improvement because his improvement was claimed as an article of manufacture: *Held*, that there is no magic in the use of the words "article of manufacture." *Invention* is required to make a new article of manufacture patentable, just as much as in any other case.

Bromwell, x. p., *Simonds, Com.*, 21 Dec., 1891, C. D. Ms.

ASSIGNEE.

1. An assignee of the entire interest, who, before payment of the final fee, places on record an assignment in which the invention is clearly and unmistakably identified, can have the patent issue to himself. In default of such identification, — such issue denied.

Neither Section 4895 nor Rules 26 and 215 make it *obligatory* upon the Commissioner of Patents to issue a

patent to the assignee of the inventor; and the decisions and rules of the Patent Office prescribe that a patent can issue to the assignee only where the invention is *clearly and unmistakably identified* (Galer *v.* Wilder, 10 How., 477, ❁; Consol. Elec. Lt. Co. *v.* Edison Elec. Lt. Co., 33 O. G., 1597).

In re, Samuel J. Murray, *Fisher*, *Act. Com.*, 18 Aug., 1890, C. D. Ms.

NOTE. — (i) In this case an alleged assignment which petitioner had requested to be recorded, had been returned to him with the statement that it did not identify the invention to which it related sufficiently to warrant its application to any case pending before the Patent Office. The petitioner having returned the assignment (unchanged) to the Office, with a reiteration of his request for withdrawal of the patent from the issue-docket and that it be issued to the assignee, the Acting Commissioner directed that the instrument be recorded for what it was worth, but refused to withhold the patent, — which had been already set for issue to the inventor, — the specification having been printed, the drawings photolithographed, and the Official Gazette printed and ready for delivery. (ii) Petition, the same day, addressed to the Secretary of the Interior for refusal of his signature to the patent, was denied by *Assistant Secretary Bussey*, "for reasons stated in the decision of the Acting Commissioner." (iii) The patent having, accordingly, issued to the inventor, a petition, under Rule 170, for indorsement upon the patent of certificate of Official error, was denied, "because the assignment, although subsequent to the filing of the application, did not identify it by its serial number." *In re*, S. J. Murray, *Mitchell*, *Com.*, 21 May, 1891.

2. Necessity of Precise Identification.

Where the assignments referred to applications as "of even date," but bore a date a day earlier, and the patents were issued in the name of the inventor: *Held*, upon an

application for a certificate of correction, that it would be a very dangerous practice for the Office to issue patents to assignees under such assignments, and that the Office was not at fault in failing to do so; and a certificate of correction was refused.

In re, Wirth, *Mitchell, Com.*, 30 Ap., 1891, C. D. Ms.

3. Patent not issued to Holder of a Territorial Grant.

A transfer of the exclusive right to a patent within and throughout a specified portion of the United States is, properly speaking, an assignment, and vests in the assignee a title to so much of the patent itself, with the right to sue infringers; but Section 4895 R. S., as interpreted by Section 4816 R. S., and as always and consistently understood by the framers of the rules of practice, gives no authority to the Commissioner to issue the patent to such territorial grantee, but only to an assignee of the entire interest or of an undivided part thereof.

Buchanan, x. p., *Mitchell, Com.*, 18 Feb., 1891, C. D. Ms.

4. Assignee's Right of Representation.

It is the common practice in the Patent Office to allow the assignee of an undivided part of an invention to be represented, if he so desires, by an attorney of his own selection; but an instrument which does not come within the definition of an assignment laid down by the Supreme Court in Waterman *v.* Mackenzie (U. S. S. C., 34 L. ed., 923, ❁) does not entitle the holder to such representation.

Hunter, x. p., *Frothingham, Act. Com.*, 23 Ap., 1891, C. D. Ms.
See Waterman *v.* Mackenzie, (5) ASSIGNMENT.

5. Presumptive Proof of Ownership.

Where a patent has been issued jointly to the inventor and to one named therein as his assignee, it will be pre-

sumed, in absence of proof to the contrary, that the assignment was properly made and entered of record in the Patent Office.

Whitcomb *v.* Coal Co., U. S. C. C. N. D. Ill., *Blodgett, J.*, 42 F. R., 652.

6. It is not obligatory, on the part of the Office, to issue a patent to an assignee; the terms of the statute are merely permissive, and, in a contest between parties claiming under different assignments, he may issue the patent to the inventor, and relegate the parties to the courts for settlement of their rights.

Speilman, x. p., *Simonds, Com.*, 23 Dec., 1891, C. D. Ms.

ASSIGNMENT.

1. The entire or any fractional interest in an invention may be conveyed, either before or after issue of a patent therefor, by any instrument of writing.

Such instrument, if executed before issue, should be recorded within three months after issue; if executed after issue, it should be recorded within three months after execution.

In default of such record, such conveyance will be void as against a subsequent *bona fide* purchaser.

Section 4898 R. S.

NOTE.—The assignment must clearly identify the application by its serial number or otherwise. See Lorentz, x. p., EXECUTORY AGREEMENT.

2. A patent may issue, in whole or in part, to an assignee; but the instrument of conveyance must have been entered for record at or before payment of the final fee.

R. S., 4895, P. O. R., 206; Wright *v.* Randall *et al.*, *Blatchford, J.*, 5 Sep., 1881, 20 O. G., 493.

3. Assignment of right to or under, or interest in a patent is effected by an instrument in writing (4898 R. S.), which may convey either (i) the whole patent, comprising the exclusive right to make, use, and vend the invention throughout the United States; or (ii) an undivided part or share of that exclusive right; or (iii) the exclusive right under the patent within and throughout a specified part of the United States.

Waterman *v.* Mackenzie *et al.*, U. S. S. C. By *Gray, J.*, 12 Feb., 1891, 54 O. G., 1562, ❁.

4. Such an instrument vests in the assignee a title in so much of the patent itself, with a right to sue infringers, alone in the first and third cases, and conjointly with the assignor in the second.

Ib. ❁.

5. Any other grant or transfer is a mere license, which gives the grantee no title in the patent and no right to sue at law in his own name for an infringement.

Ib. ❁.

6. The right to make and sell and the right to use are severable, but the modes of use are not severable.

The right to make and sell and the right to use are completely severable by the owner, and may be disposed of separately (Dorsey *v.* Bradley, 12 Blatch., 202); but, in the absence of any such expressed restriction or separation, a conveyance of the right to make and sell implies the right to use anywhere an article thus legitimately purchased (Adams *v.* Burke, 17 Wallace, 453, ❁); but a patentee cannot divide his right into modes of use, and grant to one man the right to use it in connection with or application to one thing, and to another in connection with another thing, to such an extent as that purchasers from any of these persons may

not use the fabric purchased precisely as they like, and, if they please, in violation of what the patentee had supposed were rights not granted by him.

The Washing Machine Co. *v.* Earle, U. S. C. C. E. D. Pa. By *Grier, J.*, 1861, 3 Wallace, Jr.

7. Conveyance of the right to make and sell a patented article includes the right to use it anywhere, and it also includes the right to sell it anywhere not in the ordinary course of trade.

Turnbull *v.* Weir Plow Co., *Drummond, J.*, Mar., 1880, 23 O. G., 91.

See also Curran *et al. v.* Birdsall, *Blodgett, J.*, 16 July, 1883, 27 O. G., 1319.

8. A conveyance of "all my right, title, and interest in and to" a certain patent, though properly recorded, does not include the right for two counties covered by a prior conveyance, although such prior conveyance was not recorded in the Patent Office.

Ib.

9. An instrument in writing granting all right, title, and interest in the invention, except as to a certain combination set forth in the application, is not an assignment; and an attorney appointed by a person holding such an instrument will not be recognized in the prosecution of the application (Waterman *v.* Mackenzie *et al.*, 54 O. G., 1562, ❁).

Hunter, x. p., *Frothingham, Act. Com.*, 23 Ap., 1891, 56 O. G., 929.

Compare Turnbull *v.* Weir Plow Co., (7) and (8) *supra.*

10. A patentee may not take advantage of his own wrong-doing.

Where a patentee, after selling all his rights under the patent, subsequently purchases an older patent to defeat

his assignee's rights: *Held*, that such proceeding is manifestly unjust and inequitable, even if the older patent clearly anticipates the device sold.

Curran *et al. v.* Birdsall, *Blodgett, J.*, 16 July, 1883, 27 O. G., 1219.

11. A patentee may not, as against the assignees of his entire interest, so restrict and qualify the claims of his patent as to make them void for want of novelty.

Adee *v.* Thomas, *Lacombe, J.*, 23 Jan., 1889, 47 O. G., 528.

12. Executory Agreement.

A party who bases his rights as an assignee upon an instrument recorded in the Patent Office before application was made, and which did not specifically identify the invention, will not be permitted to examine the files, because such an instrument is not an assignment, but a mere executory agreement.

Lorentz, x. p., *Simonds, Com.*, 28 Mar., 1892, 59 O. G., 158.

13. Instruments given by a married woman or by a minor must accord with the local law in the place of domicil.

Section 4898 R. S. requires that the assignment of a patent be by an instrument in writing. Where the grantor is a married woman or a minor, the ability to make the instrument, or the aids to a disability, must be sought in the laws of the respectives States regulating such rights.

Fetter *v.* Newhall, *Marble, Com.*, 21 Sep., 1883, 25 O. G., 502.

14. The assignee of an inventor who died without making his application has no standing as an applicant before the Patent Office; and this is true even where the

application sought to be made by the assignee is a division of one properly filed by the inventor.

Stevens, x. p., *Simonds, Com.*, 6 Ap., 1892, 59 O. G., 299.

Compare De La Vergne *v.* Featherstone, (1) PATENT, and Davis, x. p., (7) ATTORNEY.

CONFLICTING ASSIGNMENTS, see (2) OFFICE PRACTICE.

ASSISTANT COMMISSIONER.

Duties same in Kind as those of the Commissioner.

Petition that a rehearing be granted of a case decided by the Assistant Commissioner, the sole reason for such petition being that a petition upon the merits of the case by the Commissioner in person is desired by the petitioner: *Denied*, on the ground that the duties of the Assistant Commissioner are necessarily the same in kind as those of the Commissioner, and on the ground that those duties are directly prescribed by statute.

Hughes, x. p., *Simonds, Com.*, 9 Sep., 1891, 56 O. G., 1448.

ATTORNEY.

1. Applicant is bound by the action of his attorney.

Where applicant had requested her attorneys to take an appeal if they had any doubts as to the necessity, and they, believing that certain affidavits to be filed would result in the case being remanded to the Primary Examiner, but which the Office held not entitled to consideration, and the case became abandoned: *Held*, that by the rules of agency, applicant was bound by her attorney's omission to take an appeal, and her petition to revive was denied.

Binford, x. p., *Mitchell, Com.*, 17 Jan., 1891, C. D. Ms.

2. A petition to re-instate, under Section 4894 R. S., alleged that until quite recently applicant was not aware

of the law regarding abandonment by non-prosecution, and that applicant had been sick for about fourteen months and practically unable to do any work. *Held*, that while ignorance of the law was not sufficient to excuse the delay, the sickness might, if it stood alone, but petitioner had experienced attorneys to whom was intrusted the prosecution of his case; and as no reason appeared why they did not proceed to prosecute within the scope of their power, as they might have done at any time within two years, the unaccounted for inaction of the attorneys must be held to be the inaction of the applicant.

Tuoti, x. p., *Fisher, Act. Com.*, 27 Jan., 1891, C. D. Ms.

3. The rejection in the original application, having been deliberately acquiesced in by the attorneys, as indicated by the character of the correspondence that followed the numerous actions of the Office, and finally by the cancellation of the claim before patent was allowed, — the applicants would have been chargeable with knowledge of what their attorneys had done, even if it had not appeared affirmatively that they had such knowledge (Hatchman, x. p., 25 O. G., 979, — affirmed by the Supreme Court of the District of Columbia, 3 Mackey, 288; Anheim *v.* Finster, 32 O. G., 256; Dobson *v.* Lees, *Per Curiam*, 30 F. R., 625, — affirmed 137 U. S., 25, ❀; and Hoeveler & McTighe *v.* Verner *v.* Nicholson, 2 Gourick, 51).

Hoeveler & McTighe, x. p., *Mitchell, Com.*, 26 Mar., 1891, C. D. Ms.

4. Where neglect to take appeal at the proper time [proper stage of the original application] rested between applicant and his solicitor, and on the contrary, the rejected claim was cancelled, for the purpose of securing

issue of a patent, re-issue which revived and embodied this claim was pronounced void.

Anheim *v.* Finster, *Wheeler, J.*, 32 O. G., 256.

Of like purport, see (1) *et seq.*, DEDICATION; (5) ESTOPPEL; (10) PUBLIC RIGHTS AND OBLIGATIONS; (3), (4) RE-ISSUE; and (10) SCOPE OF PATENT.

5. Applicant's attorney may insert amended claims, in consonance with the specification, without having them verified by a special oath of applicant.

R'l'y Register M'f'g Co. *v.* N. Hudson R'l'y Co., *Nixon, J.*, 24 Feb., 1885, 32 O. G., 519.

6. Power of attorney, where recognized by assignee, does not cease with inventor's death.

Where the inventor, after assigning all his interest in the invention, died, and the Examiner refused admission of amendments presented by inventor's attorneys, on the ground that his death had revoked their power and held the application abandoned for want of proper prosecution: *Held*, that the Examiner's holdings would doubtless have been correct had there been no assignment of the invention (Eagle Co. *v.* West *et al.*, 18 Blatch., 218); but the inventor having parted with the entire interest, and it appearing that his attorneys were recognized by the assignees as their attorneys, it could not be held that the application had become abandoned, for it had been prosecuted by the only parties who had a right to prosecute it, although that fact did not appear of record until the filing of this petition. Furthermore, in the absence of any steps to the contrary by assignee of the entire interest, the attorneys appointed by the inventor are assumed to represent the interest, (Baker, x. p., 49 O. G., 1363).

Davis, x. p., *Fisher, Act. Com.*, 18 Feb., 1891, C. D. Ms.

Compare Stevens, x. p., (14) ASSIGNMENT; and De La Vergne *v.* Featherstone, (1) PATENT.

7. Revocation of Power.

The Patent Office has no means of enforcing the payment of fees due from applicants to their attorneys, or, indeed, of determining whether or not any fees are due; neither can it refuse to recognize the revocation of any power of attorney *which is not coupled with an interest*. If an attorney wishes to enforce his rights against a client, the courts are open to him.

In re, Osborne, *Fisher, Act. Com.*, 27 June, 1890, C. D. Ms. Compare ATTORNEY'S LIEN.

ATTORNEY'S LIEN.

A lien on the inventor does not extend to an instrument which is the property of assignee.

Where it seemed that an assignment had been placed in the hands of the assignor's attorneys upon a special trust to file it in the Patent Office and to pay the fee, which had been advanced for that purpose: *Held*, that any lien which the attorneys might possess upon papers belonging to their client, the assignor, did not extend to the assignment, which belonged to the assignee, nor authorize the attorneys to refuse to discharge the special trust referred to, and that it was the duty of the attorneys, *both to the assignee and to the Office*, to forthwith cause the assignment to be presented for record.

In re, Petition of the Dayton Fire Extinguisher Co., *Mitchell, Com.*, 12 Mar., 1891, C. D. Ms.

BASIC IDEA OF A PATENTABLE INVENTION.

Where a man has suggested the basic idea of a patentable improvement, and has made it practicable to any degree, and has never abandoned it, he cannot be de-

prived of the benefit of the invention or of the title of inventor by any other person, although that other may carry out the idea more perfectly and to a greater degree of usefulness.

Riley *v.* Barnard, *Simonds, Com.*, 2 June, 1892, 59 O. G., 1919.

BURDEN OF PROOF.

1. Burden of proof rests on him who asserts an affirmative.

It is one of the primary rules of evidence that the burden of proof is on him who asserts an affirmative, and it makes no practical difference, in considering evidence such as just indicated, and so far as shifting the burden of proof is concerned, whether the various stages or all of them are established or not. Each party, by assuming to prove an affirmative and establish a yet earlier date, introduces an independent element into the case, and one for which he alone is responsible, and naturally takes upon himself the burden of *its* proof. The issue is reached, as it is in every case, when either party meets the other's allegations with a denial, and offers evidence to impeach or weaken the other's testimony. Issue is then joined upon the particular date that is denied; and this question is to be decided, like any other question of fact, by a preponderance of evidence.

Clark *v.* Broad, *Frothingham, Act. Com.*, 18 Nov., 1891, 57 O. G., 1426.

Compare Wilson *v.* Haines, (117) INTERFERENCE.

2. Burden of proof is on applicant who contests a patent.

The burden of proof is heavily on an applicant striving to overthrow a patent. This burden is only shifted when the applicant has overcome the *prima facie* case arising from the previous grant of a patent by proof beyond a

reasonable doubt. It is not enough for the applicant to charge fraud,— which is never presumed, but must always be strictly proved, — and then to demand that he be relieved from the burden of proof which the law has imposed upon him. Such a course will not shift the burden of proof.

Hansen *v.* Davis, *Mitchell, Com.*, 4 Ap., 1891, 55 O. G., 998.

Of like purport, see (118) *et seq.*, INTERFERENCE.

3. Burden on the Junior Applicant.

A formal abandonment of the earlier application in favor of a second application by the same applicant which covers substantially the same subject-matter, does not shift the burden of proof from a rival application filed subsequently to such earlier but prior to said second application.

Parmley *v.* Hockhausen, *Frothingham, Act. Com.*, 20 Oct., 1891, C. D. Ms.

Compare (5) and (6) INTERFERENCE.

4. Where, in an interference case, the contention of the junior party was that he was the originator of the improvement in controversy, and communicated the invention to the senior party prior to the senior party's application for patent, and it appearing that there was a difference of five months between the filing dates of the respective applications, and that the senior party had constructed a machine in accordance with the idea involved in the invention, while the junior party had never done so: *Held*, that these facts raised a strong presumption in favor of the prior applicant, and that the burden was fairly and strongly upon the junior party to show the origination and disclosure which he claimed.

Decision of the Examiners-in-Chief reversed, and priority awarded to Ohl.

Zerbe *v.* Ohl, *Simonds, Com.*, 21 Mar., 1892, 58 O. G., 1839.

5. Burden of invalidation rests on defendant.

Where the defendant seeks to overthrow or weaken complainant's patent by setting up anticipations whose existence and use are proven by oral testimony only, the courts not only impose the burden of proving such devices upon the defendant, but they demand proof that shall be clear, satisfactory, and beyond a reasonable doubt, and subject such evidence to the closest scrutiny.

The Washburn & Moen M'f'g Co. *et al. v.* The Beat Em All Barbed Wire Co. *et al.*, U. S. S. C. By *Brown, J.*, 29 Feb., 1892, 58 O. G., 1555, ✿.

6. Burden, — on Complainant to prove Infringement.

In combinations the doctrine of equivalents is construed most strongly against him who alleges infringement; and each party is held to his own element or device, or to a positive and exact equivalent which performs the same functions in the same manner, the burden being upon the complainant to show this.

Jones Co. *v.* Munger Co., U. S. C. of Appeals (5th Dist.) By *Locke, J.*, Nov., 1891, 58 O. G., 274, ✿.

NOTE. — For like reasons, the burden rests on a defendant who alleges lack of novelty in complainant's device (Warwick M'f'g Co. *v.* City of Buffalo, (9) INFRINGEMENT).

CAVEAT.

1. A caveat entitles the filer to notice of any application for substantially the same invention filed within one year thereafter.

Any citizen of the United States (or any applicant for citizenship who has been a resident for the space of one year next preceding) who desires time to test or mature an invention may file a description thereof in the confidential archives of the Patent Office (paying the pre-

scribed fee, $10), and will thereby be entitled to notification of any application, entered during the ensuing year, for a patent for substantially the same invention.

R. S., 4902.

For caveat privileges to foreign inventors, see (7) *infra*.

2. Caveator entitled to Immediate Notification.

On receipt by the Office of an application for patent within a year after filing of a caveat by another inventor for the same subject-matter, the notice which the statute provides shall be sent to the caveator must be sent *at once*, and not, as heretofore, be delayed until the invention shall have been favorably passed upon and the application found to be ready for allowance.

Ward, x. p., *Hall, Com.*, 6 Mar., 1889, 46 O. G., 1513.

3. The caveat does not confer any application rights.

The statute authorizing the filing of a caveat does not confer upon the caveator any right as an inventor, nor save him from the effect of negligence, nor give him any advantage over another inventor who has independently conceived the same invention and prosecuted his application with diligence. The statute simply provides, *as a matter of grace*, that the caveator shall be notified of any application which comes into the Office within a year, covering the subject-matter of his caveat. The filing of a caveat does not give the caveator the standing of an applicant with respect to what is called "constructive reduction to practice."

Elges *v.* Miller, *Hall, Com.*, 7 Mar., 1889, 46 O. G., 1514.

4. Lapse of Caveat Right.

Application for patent, as sole inventor, was filed by one of the parties who had previously lodged a caveat,

as joint inventors of the same device. The usual notice had been served on them to complete their application, as joint inventors, within three months. This they did not do; but, on the contrary, filed a formal abandonment of their interest in the caveat, and a request that the present application be proceeded with. The Examiner's requirement of evidence that applicant was the sole inventor is improper. The claims of the caveators, although one of them was the present applicant, ceased by non-filing of an application within the time required by law.

Drury, x. p., *Frothingham, Act. Com.*, 28 Mar., 1891, 56 O. G., 1447.

5. Copy of Caveat Refused.

Upon a petition for the file-wrapper and contents of a certain caveat, to be used as evidence in a case pending in a circuit court of the United States: *Held*, that the practice of the office was to refuse copies of caveats without the caveator's consent, and that the petition must be denied.

Spear, x. p., *Fisher, Act. Com.*, 28 Nov., 1890, C. D. Ms.

NOTE. — In support of the above ruling the Assistant Commissioner cited decisions of Commissioner Hall in Hopkins & Robinson M'f'g Co., x. p., C. D. 35, Ms., 250; and Harding, x. p., C. D. 37, Ms., 248; also Sec. 4902 R. S., and Rules 15 and 197 founded thereon, an interpretation of Rule 15 by the Secretary of the Interior, and a special order of Commissioner Duell, to the same purport.

6. Inspection and Copies Refused.

Upon a petition on behalf of defendants in a suit on a patent to inspect and have copies of a caveat filed by a person other than the petitioners: *Held*, denying the petition, that, while Section 4902 R. S. provides for the

filing of caveats, and limits their operative term to one year, it by no means says that the condition of secrecy shall terminate at the end of such year; and the uniform practice of the Office is to refuse inspection of a caveat filed by another person upon such a showing.

Pollok *et al.*, x. p., *Simonds*, *Com.*, 4 May, 1892, 59 O. G., 939.

7. Caveat Rights under International Convention.

The treaty entered into under the International Convention is a reciprocal one. Each of the high contracting parties covenants to grant, in future, to the subjects and citizens of the other parties certain special rights, in consideration of the granting of like special rights to *its* subjects and citizens. It is a contract operative in the future infra-territorially. It is, therefore, not self-executing; but to render it effective requires legislation for the modification of existing laws.

Opinion by Attorney-General Miller, 5 Ap., 1889.

CERTIFIED COPY.

1. A certified copy of an abandoned or of a rejected application is obtainable when required for evidence.

Whenever a reasonable suggestion of its necessity for the purposes of evidence is made by the person requesting it, the Commissioner cannot lawfully refuse to furnish a certified copy of an abandoned or a rejected application. The right to be furnished such a copy is given to the public by statute, and refusal thereof entitles the applicant to the Writ of Mandamus against the Commissioner, to compel a compliance with such request.

An attorney at law who has requested such a copy on behalf of his client and been refused, has such an

interest in the subject-matter as entitles him to commence proceedings in his own name as the relator for such writ.

The United States *v.* The Commissioner of Patents, — Supr. C. D. Columbia: *The Chief Justice and Associate Justices Cox and Merrick*, 12 Nov., 1888, 43 O. G., 1263.

2. Inspection by another party of abandoned cases in the U. S. Patent Office is not permissible; but a request for certified copies of one or more abandoned applications, accompanied by a reasonable suggestion of their necessity for the purposes of evidence, will be granted, under authority of Rule 179.

Fowler, x. p., *Mitchell, Com.*, 14 Oct., 1889, 49 O. G., 562.

Compare ABANDONED APPLICATIONS.

THE CLAIM.

1. Every United States patent is required to contain a clear, concise, and particular statement of the part, improvement, or combination which the inventor claims as his invention.

Sec. 4888 R. S.

2. Claims granted should be commensurate with the invention.

Pacholder, x. p., *Mitchell, Com.*, 26 Ap., 1889, 51 O. G., 295.

3. In a patent containing more than one claim, each claim must be distinct from every other in its subject-matter.

Every claim in an application in order to be valid must, in one sense, cover an independent invention, yet all the claims must pertain to one common device or subject of invention.

Franklin, x. p., *Leggett, Com.*, 24 July, 1873, 4 O. G., 105.
Of same tenor see Holt, x. p., (4) *infra.*

4. Each claim must define a complete and operative combination in direction of the invention.

Holt, x. p., *Dyrenforth, Act. Com.*, 26 Ap., 1884, 29 O. G., 171.
Compare Franklin, x. p., (3) *supra.*

5. Office of the Claim.

It is not sufficient that the claims contain words of reference to the specification where the invention is described ; for, under the statute, it is *the office* of the claim to set forth, specifically and definitely, the actual invention covered by the patent.

Dunning, x. p., *Butterworth, Com.*, 12 Mar., 1884, 26 O. G., 1207.

For decisions of like general tenor to the above, compare Holmes, x. p., (56), Rice, x. p., (57), and Supreme Court decision in White *v.* Dunbar, ❁ (65), *infra.*

For qualifying conditions, see Houchens, x. p., (6), and Laskey, x. p., (66) *infra.*

6. The special function of claims is to " point out " in the preceding description " the part or combination " for which a patent is sought. No comprehensive rule can be laid down determining how much of a description is permissible in the claims. It may be fairly said that each application is, to a large extent, a law unto itself in that regard. Requirement, however, of such description in the claim as to practically do away with the necesssity of looking to the specification for the major portion of the descriptive language applicable to it, has no warrant whatever in the statute.

Houchens *et al.*, *Mitchell, Com.*, 30 Sept., 1889, C. D. Ms.
Of like tenor, see Laskey, x. p., (66) *infra.*

7. The claim is the measure of the patentee's right to relief from infringement; and while the specification

may be referred to to limit the claim, it can never be made available to expand it.

McClain *v.* Ortmayer, U. S. S. C. By *Brown, J.*, 2 Nov., 1891, 35 L. ed., 800, ❁.

8. The practice of appropriating literally the claim of a later inventor, which is drawn with reference to the employment of terms found in the preceding specification, and then applying the claim so appropriated to a specification of an older date which does not contain words and expressions suitable to lead up to the language of the appropriated claim,—condemned. Patent Office officials should be upon their guard against amendments made late in the history of proceedings in an application, which are apparently inspired by the purpose of dominating inventions subsequently made by other inventors, and which are not embraced within the scope of the specification as originally filed (R'y Co. *v.* Sayles, 97 U. S., 556, ❁; Con. Elec. Lt. Co. *v.* McKeesport Lt. Co., 40 F. R., 21).

Rogers *v.* Wissinger, *Mitchell, Com.*, 7 Mar., 1891, 56 O. G., 804.

9. Every element of the claimed combination should be positively given,—Rule 37.

Every instrumentality or substance intended to be an element or ingredient of a claim must be positively brought in *as such*, and not merely inferentially included or only alluded to in naming some other part.

Holt, x. p., *Dyrenforth, Act. Com.*, 26 Ap., 1884, 29 O. G., 171.

For case illustrating a relaxation of the above general rule, see Crane, x. p., (10) *infra.*

10. Where the Examiner objected to the claims as indefinite, and required that the parts should be brought

in as "positive elements," the requirement was overruled, on the ground that it was clear that the several necessary elements of the alleged combination — whether positively included therein or only incidentally mentioned in connection therewith — were embraced in and formed necessary limiting features of the claim.

Crane, x. p., *Frothingham, Act. Com.*, 18 Nov., 1891, C. D. Ms.

NOTE. — The allowed claim, above referred to, — see patent No. 468, 791, to Thomas Crane, issued 16 Feb., 1892, — is given below. The Examiner wanted "the pivoted braces C, C'," and "the central bar I" brought in as "positive elements" of the combination.

CLAIM 1. In combination with the pivoted legs B and B', secured to the table-top by means of the pivoted braces C and C', one or more notched rods, E, secured to the legs on one side of the table with their free ends passing through the central bar I, and the locking device with the cord 1, all arranged to operate substantially as described.

For the general rule, see Holt, x. p., (9) *supra*.

11. Primary Invention, — Phraseology.

It is held that in a case of primary invention the description of the general nature of the invention which applicant gives near the beginning of the specification, taken with the words "substantially as described" or equivalent phrases, used in every one of the claims, makes the claims sufficiently specific.

Dalton, x. p., *Simonds, Com.*, 18 Feb., 1892, C. D. Ms.

For like permitted exceptions in patents for primary inventions, see (38) *et seq.*, *infra*.

12. The claim must be to the specific device, — not to functions or results.

No one can tell with any certainty what invention is actually covered by a claim which is functional in form

until it has received a judicial interpretation. It may be so absolutely functional, and therefore incapable of construction, as to be void, and the courts would so adjudge it. Hence the Office, in insisting on certainty and definiteness in claims, acts not only in protection of the public, but as a friend and adviser of the applicant.

Barrett, x. p., *Hall, Com.*, 24 Sep., 1888, C. D. 142.

Compare Ives, x. p., (29); and Lull *v.* Clark, (20″) *infra*.

13. A claim is not necessarily rendered functional by words and phrases ascribing functions to enumerated elements.

Houchens *et al.*, *Mitchell, Com.*, 30 Sep., 1889, C. D. Ms.

14. Specification [in a claim] of functions frequently promotes definiteness, by furnishing a law for determining what elements would be the equivalents in the combination of enumerated elements; but when a claim is so drawn as to ignore construction, and to thus cover any and every device which will accomplish the same result, the charge that the claim is functional is properly brought against it, inasmuch as it does not point out "the part, improvement, or combination" sought to be patented.

Raymond, x. p., *Mitchell, Com.*, 29 Oct., 1889, C. D. 41, Ms., 212.

15. An objection that the claims were functional overruled; for, while it is true that certain clauses in the claims set forth the functions entering into the combination, yet the recitals of function tended rather to define the statement of the claim than to render it indefinite, by furnishing a guide as to whether or not a substituted element would constitute an equivalent in the patented combination (Raymond, x. p., C. D. 41, Ms., 212).

Thompson & Thompson, x. p., *Frothingham, Act. Com.*, 25 Jan., 1892, C. D. Ms.

16. Whether or not the objection that a claim is functional is appealable to the Examiners-in-Chief depends largely upon the form which the objection takes. If it be an objection upon the ground that the thing covered by the claim is merely the function of the mechanism employed, the action involves "the merits," and is therefore appealable to the Examiners-in-Chief.

Lockwood, x. p., *Fisher, Act. Com.*, 19 June, 1890, C. D. Ms.

17. Phraseology.

Examiners should avoid, as far as possible, interference with an applicant's choice of words, or the form in which they are presented. The policy of the Office is rather to permit the greatest latitude of expression consistent with the subject-matter of invention; that the claim is not formulated in certain set expressions which may have had judicial sanction or have been usual in Office practice is quite immaterial. These have their advantages and serve as a general guide; but they are not in any sense exclusive, and should not be permitted to hamper an applicant in the free exercise of his judgment, so long, of course, as the claim is clear and explicit, and to means or instrumentalities, and not to mere abstractions, functions, or results.

Designolle, x. p., *Doolittle, Act. Co.n.*, 10 Nov., 1877, C. D. 10.
Compare Noyes, x. p., (9) SPECIFICATION.

18. Restatement sometimes Permissible.

It is admissible, under proper restrictions, for parties to put their claims in different forms, to prevent misconstructions of them by the public and by the courts.

Perry & Lay, x. p., *Foote, Com.*, 7 Sep., 1869, C. D. 3.

19. The first, second, and third claims having been rejected by the Examiner, because "for one and the same

thing," the objection was overruled for the reasons laid down by Commissioner Foote in Perry & Lay, x. p. (1869, C. D. 3).

Hahn, x. p., *Spear, Act. Com.*, 3 Sep., 1875, C. D. 107.

For general rule disapproving of two or more claims to the same subject-matter, see Johnson, x. p., (1) REDUNDANCY. See also Langlois, x. p., (12), Gabouri, x. p., (13), and Feister, x. p., (14), EXAMINATION.

20. Where the corresponding elements in two claims in the same application were a "shuttle" and a "reciprocating shuttle": *Held*, that the question whether or not the claims were different in legal effect was subject to a doubt which should be resolved in favor of the applicant.

Pearson, x. p., *Frothingham, Act. Com.*, 2 Ap., 1892, C. D. Ms.

20′. Different Expressions of the same Combination in five different Claims Sustained.

While the five claims in suit are all to the same devices arranged in a single combination, being only different expressions of that combination, and it may be that there is no essential difference between them, the court does not deem it necessary to consider how far they may be distinguished from each other, but holds them all valid.

The Watch Co. *v.* Robbins & Avery, U. S. C. C. Ap. (7 Cir.) Harlan, Woods & Jenkins, JJ. By *Woods, J.*, 1 Oct., 1892, 61 O. G. 721, *.

20″. A claim to "the so forming [substantially as described] of a self-locking shutter-hinge in two pieces, as that" certain results may follow, *held* to be a claim to mechanism; the particular mechanism covered being

determined by the description in the specification and the statement of results in the claim.

Lull *v.* Clark *et al.*, U. S. C. C. N. D. N. Y., *Blatchford, J.*, 8 Aug., 1882, 22 O. G. 1535.

Compare, of like tenor, (38) *et seq., infra.*

NOTE. — (i) The claim above referred to was as follows:

The so forming of a self-locking shutter-hinge cast in two pieces that the blind or shutter hung thereon may swing open or shut in a horizontal plane and lock when open to its limit, and so that also, when locked open, the strain shall be taken off from the spindle and thrown on to the cam-arms, and thus effectually relieve the spindle from the weight or strain of the shutter, substantially as described.

NOTE (ii). — That the Office is not justified in passing faultily worded claims, because the courts aim to so construe them as to save the patent, see (29) *et seq., infra.*

21. Customary Adjuncts not necessarily Enumerated.

It is the province of claims to relegate to the specification the enumeration of such details of construction as shall be found, upon examination, to be immaterial to the true scope of the actual invention. The object of enumerating these parts [in the body of the specification] is to enable persons skilled in the art to practise the invention in the form set out in the patent, but not to so limit the claim of the inventor as to make it the easy prey of the infringer.

Laskey, x. p., *Mitchell, Com.*, 6 July, 1889, 48 O. G., 539.

22. It is generally the case in machine patents that certain things not in the claims must be assumed as co-operating with those that are expressly mentioned; the correct rule, as regards combinations, would seem to be that the parts must necessarily be specified only up to that point beyond which the presence of the parts not

named will be presumed, as a matter of course, by reason of the known state of the art or from the very necessities of the case; for example, in claiming improvements in the cutting-apparatus of a harvester, it certainly cannot be necessary, in order to a valid claim, that the main frame, the axle, and the supporting-wheel or wheels should all be named with it, although, alone and disconnected from these other parts, the cutting-apparatus would be inoperative.

Wilder, x. p., *Duncan, Act. Com.*, 23 May, 1871, C. D. 125.

23. It was unnecessary to specify this connecting mechanism in the claim, since, from the very nature of the case, *some* mechanism capable of performing that function must be assumed, while the particular character of it would be immaterial. Applying that rule to the present case, it will be found that the function of the springs and knife is independent of the particular character of the mechanism by which the potato is driven through the springs and upon the knife (Wilder, x. p., 1871, C. D. 125).

Kent, x. p., *Duncan, Act. Com.*, 1871, C. D. 301.

24. The statute and the decisions of the courts require that an applicant shall fully and clearly describe his invention, and that he shall distinctly claim *the part or improvement made by him;* but when he has done this, the Office can require nothing more in that regard from him.

Skinner *et al.*, x. p., *Marble, Com.*, 1881, C. D. 12.

25. The law requires the applicant to "particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery." He is not obliged, in his claim, to specify

elements in a combination not invented or discovered by him, either generally or specifically. It is sufficient, as to those elements, to refer to his specification where they are described and their relation to the elements claimed pointed out.

Ib.

26. Such general terms as "means," "mechanism," and the like, may properly be employed (Holt, x. p., 1884, C. D. 43) to refer to mere adjunctive devices which connect or give co-operation to the various elements or features of the invention, but which are, in themselves, no actual or controlling part of it. It is because *any* means or mechanism may be used to carry out such adjunctive functions and need not be defined, that those terms can be thus employed.

Paige, x. p., *Hall, Com.*, 6 Aug., 1887, C. D. 71.
Compare Anderson, x. p., (11) EXAMINATION.

27. Patent No. 336,042, for an automatic weighing-machine, claims:—

A weighing-machine having an aperture for receiving a coin, a weighted lever, a dial and index-hand and intermediate mechanism connected with the same, and whereby the coin, when deposited in the receiver, shall operate the lever and cause the hand to indicate the weight of the person or body to be weighed.

Held, that the patent is for the machine as a whole having those parts with such other known parts necessary to constitute such a machine, and that, as such other necessary parts are described or referred to in the specification, the claim must be read with reference to them, and therefore covers an operative machine.

American Automaton Weighing-Machine Co. *v.* Blanvelt, *Wheeler, J.*, 29 Ap., 1892, 59 O. G. 2071.

NOTE. — The above claim will be recognized as referring to the machine popularly known by its printed direction: "DROP A NICKLE IN THE SLOT."

28. A non-essential step in a process may be omitted from the claim.

Where the specification closed the description of the process for treating certain moulds with the words "and then coated with a thin layer of varnish," but the applicant omitted from his claims this last step in the process, and the Examiner declined to act upon "the merits," on the ground that, in consequence of said omission, the claims did not come within the scope of the specification: *Held*, — as contended by applicant, — that inasmuch as the original statement of invention made no mention of the employment of varnish, as a final step in the process, and inasmuch as the claims, as originally filed, were not so limited, applicant was entitled to have that step treated as a non-essential one in the invention.

Koiler, x. p., *Mitchell, Com.*, 7 Nov., 1889, C. D. Ms.

Of like tenor are decisions in Richardson, x. p., 1875, C. D. 54; McMurray, x. p., 1875, C. D. 134; and Barnes *v.* Snedeker, 1880, C. D. 95.

29. Claims ambiguous in phraseology, or which relate (or may be so read as to relate) to performances or functions, to abstract principles, or to results (not to specified instrumentalities), are inadmissible and ought not to be granted, notwithstanding courts — after the patent has been once granted, and notably where the invention has created a new field of industry — customarily endeavor to save the patent by construing such functionally phrased claims to mean the instrumentalities by which the functions in question are performed.

But if claims functional in form have been upheld in the courts as claims to the *devices* which perform the

functions claimed, such action of tribunals has been solely to save patents from the evils incident to official negligence, and not in justification of such improper grants.

It is the duty of the Office to obviate, as far as possible, the necessity for judicial correction of its errors, and to refuse claims of purely functional form, and even those which are *susceptible* of a functional interpretation.

The rule and reasoning in Arkell's case (1871, C. D. 263) were held applicable to the case of Luther C. Ives, and Examiner's action was affirmed.

Ives, x. p., *Paine, Com.*, 4 Dec., 1878, C. D. 134.

NOTE. — It has been repeatedly held that although the result or the function itself cannot be claimed, it may — and in not a few cases *should* — be *stated* in the claim, as that quality or characteristic which distinguishes the device from every other of the same class. For examples of such rulings, see Houchens (13), Raymond (14), Thompson (15) *supra;* and Hahn (35), Keith (36), Morley *v.* Lancaster (39), Worstwick *v.* Buffalo (40, ✱), Smith & Egge *v.* Bridgeport (41), LeRoy *v.* Tatham (47, ✱), and Corning *v.* Burden (48), *infra;* also Lockwood, (1) FUNCTION. "The patentee may not claim functions, but he may claim *means definable by functions*," Blanchard *v.* Sprague, (43) *infra.*

30. The claims refused, — because *susceptible* of a functional interpretation, — were as follows: —

1. The combination with a measure, of a registering device so arranged that the passage of the striker over the measure will operate the register, substantially as described.

31. The claims having been so amended — *see italics* — as to be incapable of a functional reading were passed to issue (see pat. 211,740; 15 O. G. 108.)

1. The combination with the *portable or hand* grain-measure A, of the alarm-mechanism *which is adapted thereto, and a tappet which is operatively connected with said registering device and arranged substantially as shown and described*, so that, in passing over the measure, the striker will operate said device, by contact with the tappet, as specified.

2. The combination with a measure, of an alarm-mechanism so arranged that the passage of the striker over the measure will operate the alarm, substantially as specified.

3. The combination with a measure and registering device, of a tappet-wheel E, so constructed and arranged that the passage of the striker over the measure will turn said tappet-wheel, substantially as and for the purpose set forth.

Ives, x. p., *Paine, Com.*, 4 Dec., 1878, C. D. 134.

2. The combination with the *portable or hand* grain-measure A, of the alarm-mechanism *which is attached thereto, and a tappet which* is operatively connected *with said mechanism, and arranged substantially as shown and described*, so that, in passing over the measure, the striker will operate said mechanism by contact with the tappet as specified.

3. The combination with the tappet-wheel E, of *the pins* F, *lever* H, *spring* T *hammer* J, *and bell* K, substantially as described.

NOTE. — In the refused claims, the qualifying phrases — *e. g.*, "substantially as described" — *may* be so read as to refer to the actions; in the allowed claims these phrases have explicit reference to the *instrumentalities*.

Of the same tenor are the following: —

32. It is clear, from numerous decisions of the courts and the Patent Office, that what is known as a functional claim is one that has for its object an act or a result merely, and not the means by which the act is performed or that result attained. The faultiness of such claim consists in its not being for a substantive thing, but for its mode of use or the result which it accomplishes. The language of such claim is usually in the participial form, as "producing," "operating," "determining," "so combining," "so constructing," etc.

Applicant claimed: —

Producing in cutting-presses a successive change in the point of contact of the cutting-block with the cutting-die.

This claim is for a result or for an act, and is bad. It is in the precise form condemned in Sickles *v.* Falls Co. (2 Fisher, 202), and Sangster *v.* Miller (2 Fisher, 563). The whole genus of claims for "so constructing," "so combining," "producing," "determining," and so on *ad infinitum* through the entire range of present participles, are of the same character and obnoxious to the same objection. Some of them have been saved in the courts, "*as by fire*," by the construction given to the words "substantially as described" and the like, but *not one of them should have been granted by the Office.* A patent is for the means of producing a result, not for the result as produced.

Simonds, x. p., *Fisher, Com.*, 14 Mar., 1870, C. D. 23.

33. It is certainly the duty of the Commissioner of Patents to see to it that, so far as this result is possible of achievement, none but unambiguous claims are sent forth from the Patent Office. It is not sufficient that the claim be such as by a bare possibility may be saved through a liberal construction by the courts (Simonds, x. p., *Fisher, Com.*, 1870, C. D. 23). *The ideal claim is one which admits of but a single interpretation, and that of the most literal character.*

Continental Windmill Co., x. p., *Duncan, Act. Com.*, 27 July, 1870, C. D. 74.

NOTE. — From decisions hereinafter quoted (*e. g.* (38) *et seq. infra*), it would appear that in the exceptionally rare cases of inventions which inaugurate a new art or open an entirely new field of industry, a much broader form of claim is permissible.

34. In the matter of application by Calista E. Cox, for re-issue, the Commissioner said: —

That such a claim has been sustained in the United States Courts does not remove the one presented for

Office action from the operation of the law which requires that "every such case shall be subject to revision and restriction in the same manner as original applications are."

A participial claim to "*arranging*" devices, instead of to the devices themselves, having been granted under a former more lax practice, should, even although in the mean time it has been sustained by the courts, be made to conform to the present practice, in revising the application for re-issue.

Cox, x. p., *Thacher, Act. Com.*, 10 Jan., 1873, C. D. 4.

35. On the interlocutory appeal of Ignatius Hahn from the Principal Examiner in the matter of an application for patent for an Hydraulic Universal Machine for Shearing, the Commissioner said: —

It is clear, from numerous decisions of the courts and the Office, that what is known as a functional claim is one that has for its subject the performance of *an act merely*, and not the means by which the act is executed. The faultiness of such a claim consists in its not being for a *substantive thing*, but for the result which that thing accomplishes. Its language is usually in the participial form, as "producing," "operating," "determining," "so containing," "so constructing," etc. (Simonds, C. D. 1870, 23; Cox, 3 O. G. 2). An example is also given in the case Sickles *v.* Falls Co. (2 Fisher, 202). There the claim of the patentee was as follows: "'Imparting' a co-existing movement to two reciprocating catch-pieces in the operation of trip valves." On this the Court said: "The claim in terms is for an effect or function, and therefore not patentable." On the contrary, in Renwick *v.* Pond (3 Fisher, 579), the Court held that "claiming the arrangement of a combination when the arrangement is such as to produce a given mechanical result of the combination, is not a claim to a function. The result is

not claimed irrespective of the means of producing it. The means alone is claimed, and claimed only when specially arranged to produce a given result. This is very far from claiming a function."

Guided by these definitions, I am unable to see that the claims of the present applicant are for functions. Take, for instance, the second claim, which perhaps covers broader ground than any of the others.

2. "The combination of two carriers, each capable of revolution around a central axis, and both capable of lateral movement in the main frame, substantially as and for the purpose specified."

Clearly here the subject of the claim is a combination of the elements "two carriers," and the balance of the claim is simply descriptive of the situation of the carriers and of the mechanical result to be produced when so situated. The claim is not for *revolving* two carriers around a central axis, etc. That would be for the result; and if such a claim should be sustained by the courts, as has sometimes been the case, it would be construed as covering the *means* by which said result was produced; the means having been described in the specification, and referred to in the claims by the phrase "substantially as specified."

Hahn, x. p., *Spear, Act. Com.*, 3 Sep., 1875, C. D. 107.

36. Of like tenor was the ruling in the case of Keith, x. p. The Examiner had improperly rejected as functional the following claims: —

4. The reciprocating *punch or bending-fork* operating to sever the wire in its descent upon the former-bed, to bend the wire into a staple over a suitable mandrel or brake, and to carry the staple so formed forward into position to be driven, etc.

5. Said bending-fork constructed with a cutting edge and with internal longitudinal grooves, whereby a staple blank is

severed, bent around a suitable mandrel, and held and guided for driving, etc.

The claims were pronounced to be in proper form, and an examination was ordered on merits.

Keith, x. p., *Doolittle, Act. Com.*, 5 Ap., 1876, C. D. 93.

37. It does not follow that because a bad patent has been granted to the patentee, one equally so should be granted to the applicant.

Blackman *v.* Murray, *Doolittle, Act. Com.*, 25 Oct., 1877, C. D. 8.

38. The invention being of *basic or fundamental rank* so as to have created a new art or to have opened up a new field of industry of which a workable embodiment was intelligibly described in the patent, and the language of the claim being such as to make it *possible* for a court to construe it to be to means or instrumentalities or to means definable by functions; the claim will be sustained, and will be interpreted so broadly as to control all substantial equivalents of later date, even although improvements on the original embodiment.

A *foundation* patent is infringed by a machine in which each of the mechanisms performs the same function as the corresponding mechanism in the patented machine in substantially the same way and with substantially the same result, even though the machine of the later inventor may contain differences in form and structure tending to simplicity and perhaps improvement.

Nat. Type Co. *et al. v.* N. Y. Type Co. *et al.*, *Lacombe, J.*, 11 Mar., 1891, 56 O. G. 661.

39. When an invention is one of a primary character, and the mechanical functions performed by the machine are, as a whole, entirely new, all subsequent machines

which employ substantially the same means to accomplish the same results are infringements, although the subsequent machine may contain improvements in the separate mechanisms which go to make up the machine.

Morley, having been the first person who succeeded in producing an automatic machine for sewing buttons of the kind in question on fabrics, is entitled to a liberal construction of the claims of his first patent.

Claims 1 and 8, below given, fairly represent the four claims (1, 2, 8, and 13) pronounced *valid* and declared to be infringed :—

1. The combination in a machine for sewing shank buttons on fabrics, of button-feeding mechanism, appliances for passing the thread through the eye of the buttons and locking the loop to the fabric, and feeding mechanism substantially as described.

8. The combination, in a machine for sewing buttons to fabrics of button-feeding and sewing appliances substantially as set forth, feeding appliances, and operating mechanism, whereby the feeding devices are moved alternately different distances so as to alternate short-button stitches with long stitches between the buttons, as specified.

Morley Mach. Co. *v.* Lancaster, U. S. S. C. By *Blatchford, J.*, 4 Feb., 1889, 129 U. S. 263, ✽.

40. A like construction was given to the claims (to means definable by functions) of Edward O. Sullivan, for the invention of a harness and mode of suspending the same, which *for the first time enables the horses to remain unharnessed until the instant of alarm and yet be so quickly attached to the fire-engine as to cause no delay in getting the engine started and to the fire.*

It would seem that the fundamental and important character of the invention alone saved it from invalidation as for an abstraction. The claim was as follows :—

The combination with a harness for a fire-engine or like apparatus, of a device for suspending said harness above the

place occupied by the horse when attached to the apparatus, substantially as and for the purpose set forth.

The Court said: It is not an abstraction that Sullivan seeks to secure, but the apparatus with which the idea is carried out. With the claim thus construed and *in view of the state of the art*, very little need be said upon the question of infringement. DECREE FOR AN INJUNCTION AND AN ACCOUNT WITH COSTS.

Worstwick M'f'g Co. *et al. v.* City of Buffalo *et al.*, *Coxe, J.*, 8 May, 1884, 27 O. G. 1239.

41. In the case of the *Pioneer Invention* of Frederick Egge, of "an apparatus for the manufacture of sheet-metal chains," complainant's first three claims (although quasi-functional in form) were sustained and given the broadest possible interpretation. Claims 2 and 3, adjudged to have been infringed, were as follows:—

2. As an improvement in the art of manufacturing chain from sheet-metal by machinery, the hereinbefore described *method of automatically adjusting* a flat link in a previously bent link preparatory to bending, which consists in *feeding forward* the flat link *endwise*, *threading* it through the eyes of the bent link intersecting its line of travel at right angles and *turning it* as it is fed along after its forward widened end has passed through said eyes; substantially as set forth.

3. As an improvement in the art of manufacturing chain from sheet-metal by machinery, the hereinbefore described *method* of *connecting* and *uniting* the links, which consists in *feeding forward* the flat and partially shaped links *flatwise* or with their broad surfaces horizontal in a path intersected at right angles by that traversed by the previously connected links, *threading* the flat links successively through the eyes of the previously bent and united links, the broad surfaces of which are vertical and at right angles to the sides of the flat links; *giving a partial turn* to the flat links, and then bending them at their middles to respectively unite with the previously bent and united link; substantially as set forth.

The Court said: *In view of the primary character of the machine as a whole*, the construction which was adopted in Morley Mach. Co. *v.* Lancaster (12 U. S., 263) is the proper one for these claims. This construction excludes the idea that the claims are for a result, or for a process, or for a method of accomplishing a result irrespective of the machinery by which the work is accomplished. They are for sets of mechanisms, and are infringed by another machine in which the same sets of mechanisms are combined, provided each mechanism, individually considered, is a proper equivalent for the corresponding mechanism in the Egge patent. *But inasmuch as Egge was the first person who produced an automatic machine for the entire manufacture of sheet-metal chain, he is entitled to a liberal construction of those claims which are not restricted to described details.*

Smith & Egge M'f'g Co. *v.* Bridgeport Chain Co., *Shipman, J.*, 25 May, 1891, 56 O. G.. 1149. See, to same purport, Le Roy *et al. v.* Tatham *et al.* By *M'Lean, J.*, Dec., 1852, 14 Howard, 156, *; Corning *v.* Burden. By *Grier, J.*, Dec., 1853, 15 Howard, 252, *.

42. The inventor having made a valuable and original invention, the one remaining thing needful is that he shall place on record such a description of it as to put the world in complete possession of it for all future time.

The instances given, and many others that might be cited, show that tribunals customarily sustain a patent for an important contribution to industrial art (even although improperly summed up) where the inventor's explanation of the invention has been sufficient to enable others to practise it by the exercise of ordinary skill and judgment, but that the lack of such an explanation has invariably been adjudged fatal to the patent. For example, compare the action of Kane, J., in Detwold *v.* Reeves, and that of Story, J., in Blanchard *v.* Sprague.

The suit of one Detwold (patentee under an assignment from the inventor, Faber Du Faur) for an injunction against the use by Reeves *et al.* of the invention described and claimed in reissued patent 23 Jan., 1845, for "a new mode of collecting, conducting, and using waste gases of a blast-furnace," was dismissed, notwithstanding the Court inclined to the belief that the invention was of great value, because the specification contained no description of a new and useful invention in such full and intelligible terms as to enable others skilled in the art to practise it.

Du Faur's claim was as follows: —

> A new method of economizing fuel, by using the waste combustible gases of the upper portion of the blast-furnace by drawing them off below the upper level of the charge and conducting them through convenient passages to other fireplaces or structures, there to be burned as fuel.

The Court said: The interests involved in the controversy are very great, and may be seriously affected by the action of the Court on the present motion. It has been contended, with great apparent force, that Mr. Faber Du Faur was really the discoverer of the true theory of the blast-furnace, so as to determine from it the point at which the carbonic oxide, having performed its chemical functions, might be withdrawn without sensible injury.

The Court, after expressing its belief that *the specification contained no intelligible and explicit information of the precise location, for any given furnaces, of the point in question, intimated that if the patentee had done this,* no one can doubt that he would have conferred a signal benefit upon the arts of the world; and if, besides this, he had described some form of structure, some material arrangement by which his discovery might be applied to use, I would be most reluctant to say that

his patent should be limited to the mere mechanical illustration, and would not cover effectually the whole ground of his discovery. *But he has not done this.* The explanation is too vague, under the varying circumstances to which the invention might be applied in practice, to vindicate for the patented discovery the broader or general character.

There is no doubt that he who has discovered some new element or property of matter may secure to himself the ownership of his discovery so soon as he has illustrated its practicability and demonstrated its value. His patent in such case will be commensurate with the principle it announces to the world, and may be as broad as the mental conception itself; but the mental conception must have been susceptible of embodiment, and must, in fact, have been embodied in some mechanical device or in some process or art. The patent must be for a *thing*, not for an idea merely. It is their application to practical use which brings such conceptions within the domain of individuals, and it is the novelty of such adaptation which constitutes it the proper subject of a patent.

But the *contract of the public* is not with him who has discovered, but with *him who makes his discovery usefully known.* If he has discovered much and discloses little; if there has been revealed to him one of the arcana of Nature, and he communicates to the world only one or more of the derivative or secondary truths, *he patents no more than he has proclaimed.* He will not be allowed afterward (when the extent of his right shall be the subject of controversy, either by expanding into a general expression what was limited before to a particular form, or by tracing out for us the line that leads back from consequences to remote causes) to initiate us inferentially into the radical mystery of his invention and then argue that he had described it by implication

from the first, and so claimed ownership of it in his patent.

The interpretation, therefore, which I am constrained to give to that part of complainant's patent which is involved in the present discussion, limits his claim to the formal arrangement without any assertion of right to any dominant principle. The defendants have, perhaps, derived instruction from his description, and may even to some extent have modelled their furnace with its appendages upon a theory which he suggested; but it does not appear to me that they are infringing or have infringed his patent.

The motion for injunction must be dismissed.

Detwold *v.* Reeves *et al.*, *Kane*, *J.*, Sep., 1851, 1 Fisher, 127.

43. The suit of Thomas Blanchard against Chandler Sprague, for the use of said Blanchard's invention (a machine for turning or cutting irregular forms; patented for fourteen years, 20 Jan., 1820; extended for fourteen additional years, 20 Jan., 1834), shows a patent sustained in spite of the functional nature of its summary, in consideration of the fact that the *specification contained a full, clear, and intelligible description of* the "Machine."

"The second article," which, by the language used, is made virtually a constituent part of his "claim," is an extremely voluminous explanation (which fills several pages) of the functions and operation of his machine. The claim proper was as follows: —

"As to the mechanical powers by which the movements are obtained, he[1] claims none of them as his invention. These movements may be affected by application of various powers indifferently. Neither does he claim as his invention the cutter-wheel, or cutters, or friction-wheel, as such, nor the use

[1] Throughout the specification the inventor speaks of himself in the third person.

of a model to guide the cutting instrument. All these are common property, and have been so for years; but he claims as his invention: The method or mode of operation in the abstract, explained in the second article, whereby the infinite variety of forms, described in general terms in this article, may be turned or wrought."

The distinguished jurist, in deciding for the plaintiff, said: —

In the first place, as to the point whether the plaintiff has sufficiently expressed in his specification *the true nature, character, and extent* of the invention which he claims, I am of opinion that he *has*. . . . Looking at the present specification and construing all its terms together, I am clearly of the opinion that it is not a patent claimed for a function; but it is claimed for *the machine* specially *described in the specification*, that it is not for a mere function, but for a function as *embodied in a particular machine*, whose mode of operation and general structure are pointed out. In the close of his specification the patentee explicitly states that —

"His invention is described and explained in the second article of his specification, to which reference is made for information of that which constitutes the principle or character of his *machine* or *invention*, and distinguishes it, as he verily believes, from all other machines, discoveries, or inventions known or used before."

Now, when we turn to this "second article," we find there described, not a mere function, but a *machine of a particular structure*, whose modes of operation are pointed out to accomplish a particular purpose, function, or end. This seems to me sufficiently expressive to define and ascertain what his invention is. It is *a particular machine constituted in this way pointed out*, for the accomplishment of a particular end or object. The patent is for a *machine*, and not for a principle or function detached from machinery. I am therefore of opinion that there ought to be a judgment for the plaintiff

for the damages agreed to by the parties. Judgment accordingly.

Blanchard *v.* Sprague, *Story, J.*, May, 1839, 3 Sumner, 535.

44. The patent granted, 18 March, 1829, to Nathaniel J. Wyeth for "a new and useful improvement in the manner of cutting ice," together with machinery and apparatus therefor, as construed by the Court in Wyeth *et al. v.* Stone, may be cited in illustration of a valid — contrasted with an invalid — claim.

Invalid Claim.	Valid Claim.
1. To cut ice of a uniform size by means of an apparatus worked by any other power than human.	2. The particular application of the principle.

The Court said: In Claim 1, the patentee claims an exclusive title to the art of cutting ice by means of any power other than human power. Such a claim is utterly unmaintainable in point of law. It is a claim for an art or principle in the abstract, and not for any particular method or machinery by which the ice is to be cut. A claim broader than the actual invention of the patentee, and utterly void. Complainant's patent therefore as to Claim 1 is a nullity.

But, besides this general claim (Claim 1), there is another claim (Claim 2).

It appears to me that the language of the summary may be, and indeed ought to be, construed (ut res magis valeat quam hereat) to mean the particular apparatus and machinery described in the specification to effect the purpose of cutting ice.

I argue that the patentee is bound to describe with reasonable certainty in what his invention consists, and what his particular claim is; but it does not seem to me that he is to be bound down to any precise form of

words, and that it is sufficient if the Court can clearly ascertain, by fair interpretation, what he intends to claim, and what his language truly imports, even though the expressions are inaccurately or imperfectly drawn.

Claim 2 was sustained; but the question of infringement was not reached, because one Todor had improperly been made a party to the bill, which was accordingly dismissed with costs.

Wyeth *et al. v.* Stone, *Joseph Story and John Davis, JJ.*, Oct., 1840, 1 Story, 270.

45. Notable instances of invalidation in the one case and of sustentation in the other case, of two patents of generic rank, — such as courts are solicitous to sustain, — were those relating to the automatic steam cut-off of Frederick E. Sickles (which was invalidated) and the breech-loading fire-arm of William C. Hicks (which was sustained).

Patent, 20 July, 1843, No. 3, 189, to F. E. Sickles, Automatic Cut-Off for Steam-Engines. Extended for seven years and re-issued.

Patent, 10 Mar., 1857, to W. C. Hicks, Impt. in Breech-Loading Fire-Arms. Re-issued, No. 3,860, 1 Mar., 1870. Fire-Arms Re-issued and extended.

INVALID CLAIM.

"*Imparting a co-existing movement* to two reciprocating catch-pieces in the operation of trip cut-off valves."

VALID CLAIM.

"1. The combination, substantially as set forth, *of the breechclosing-piece, moving longitudinally with the barrel*, the *cartridge chamber* of the butt of *the barrel and the reciprocating extracting hook* arranged in such manner that its bill enters within the periphery of the said chamber, so that it may engage with the flanges of the cartridge therein when the breech is closed by the forward movement of the closing-piece, even though the cartridge be not expanded."

The patent to F. E. Sickles contained a full description of the improvement, but was nevertheless invalid on

three independent counts, of which the only one necessary to notice here was the improper phraseology of the patentee's claim. In reference to this defect, the Court said: The claim in terms is for an effect or function, and therefore not patentable.

Judgment was given for the defendant.

Sickles *v.* Falls Co., *Nelson & Shipman, JJ.*, Oct., 1861, 2 Fisher, 202.

The "summing up," on the contrary, in Hicks' patent seems a fair illustration of claims to the permitted form of "*means definable by functions.*"

Hicks' claims are explicitly to as many groups of constituent members of the improved fire-arm, although expressed as being so arranged as to operate in a certain way. Claim 1 above given is a fair example of the three claims which were adjudged valid and to be infringed. Of these claims the Court said: Claiming the arrangement of a combination so as to produce a given mechanical result is a claim to the means and not to a result. The means alone are claimed, and claimed only when specially arranged to produce a given result. This is very far from claiming a function.

There must be a decree for the plaintiff and an account with costs.

Renwick *et al. v.* Pond, *Blatchford, J.*, June, 1872, 5 Fisher, 581.

Decisions of like tenor to the above appear in Blanchard *v.* Sprague, 3 Summer, 535; Corning *v.* Burden, 15 Howard, 254, ❁; Dolbear *et al. v.* American Bell Telephone Co., 43 O. G., 377, ❁.

46. An instructive illustration of what constitutes a valid and what an invalid claim is seen in the rulings of the United States Supreme Court in suits under the respective patents of Samuel F. B. Morse for the recording telegraph and of Alexander G. Bell for the magnetic

telephone,— two inventions of confessedly transcendent merit.

Re-issue No. 117, 13 June, 1848, to Samuel F. B. Morse, Electro-Magnetic Telegraph (original patent granted 20 June, 1840).

Letters Patent No. 174, 465, granted 7 March, 1876, to Alexander Graham Bell for improvements in Electric Telegraphy.

INVALID CLAIM.

(MORSE.)

8. I do not propose to limit myself to the specific machinery or parts of machinery described in the foregoing specification and claims; the essence of my invention being the *use of the motive of the electric or galvanic current*, which I call electro-magnetism, *however developed*, for marking or printing intelligible characters, signs, or letters, at any distances, being a new application of that power, of which I claim to be the first inventor or discoverer.

VALID CLAIM.

(BELL.)

5. The method of and apparatus for transmitting vocal or other sounds telegraphically, as *herein described*, by causing electrical undulations, similar in form to the vibrations of the air accompanying the said vocal or other sounds substantially as set forth.

The patent to Samuel F. B. Morse was sustained except as to the eighth claim, which was adjudged to be invalid, and which the patentee subsequently formally abandoned by disclaimer lodged in U. S. Patent Office on the 19th June, 1854.

In Morse's case, Mr. Chief Justice Taney, in delivering the opinion of the Court, said: In proceeding to pronounce judgment in this case, the Court is sensible not only of the importance, but of the difficulties in form of the questions which it presents for decision. The case was argued at the last term, and was continued over by the Court for the purpose of giving it a more deliberate examination....

It is to the high praise of Professor Morse that he has, by a new combination of known powers, of which electro-magnetism is one, discovered a method by which

intelligible marks or signs may be printed at a distance, and for the method or process thus discovered he is entitled to a patent.

As to the specification and claims of the complainant's patent, we perceive no well-founded objection to the description which is given of the whole invention and its separate parts, nor to his right to a patent for the first seven inventions set forth in the specification of his claims. The difficulty arises on the eighth claim. It is impossible to misunderstand the extent of this claim. He claims the exclusive right to every improvement, when the motive power is the electric or galvanic current, and the result is the marking or printing intelligible characters, signs, or letters at a distance.

If this claim can be maintained, it matters not by what process or machinery the result is accomplished. . . .

The Court is of opinion that complainant's Claim 8 is too broad, and not warranted by law.

Neilson *v.* Harford (Eng.); Wyeth *v.* Stone (1 Story, 270); Blanchard *v.* Sprague (3 Duncan, 540); Le Roy *v.* Tatham (14 Howard, ❋), cited and applied.

Decree of Court below affirmed except as to costs, and each party was directed to pay its own costs both in this Court and in the Circuit Court.

O'Reilly *et al. v.* Morse *et al.* By *Taney, Chief J.*, Dec., 1853, 15 Howard, 62, ❋.

The only claim in Bell's patent seriously contested was Claim 5, which claim was, however, sustained and declared valid and to have been infringed.

Mr. Chief Justice Waite, delivering the opinion of the Court, said: The important question that meets us at the outset is as to the scope of the fifth claim. . . . It is contended that this claim embraces the art of transferring or impressing upon a current of electricity the vibrations of air produced by the human voice in articu-

late speech, in a way that the speech will be carried to and received by the listener at a distance on the line of the current. . . . We have no hesitation in saying that if the patent can be sustained to the full extent of what is now contended for, it gives to Bell and those who claim under him, the exclusive use of his art for that purpose until the expiration of the statutory term of his patented rights. Bell discovered that it could be done by gradually changing the intensity of a continuous electric current so as to make it correspond exactly to the changes in the density of the air caused by the sound of the voice. This was his *art*. He then devised *a way* in which these changes of intensity could be made and speech actually transmitted.

We see nothing in the ruling in O'Reilly *v.* Morse (15 Howard, 62) to defeat Bell's claim. On the contrary, it is in all respects sustained by that authority. In the case of O'Reilly *v.* Morse it was decided that a claim in broad terms for the use of the motive power of the electric or galvanic current, however developed, for making or printing intelligible characters at any distance, although a new application of that power first made by Morse, was void, because it was virtually a claim for a patent for an *effect* produced by the use of electro-magnetism distinct from the process or machinery necessary to produce it; but a claim for making use of the motive power of magnetism *substantially as set forth in the foregoing description* . . . was sustained. The effect of that decision was, therefore, that the use of magnetism as a motive power without regard to the particular process with which it was connected in the patent could not be claimed, but that its use *in* that connection could.

Decree of Circuit Court, so far as it was in favor of complainant, affirmed, and so far as it was against the fifth claim of patent, 23 Jan., 1877, reversed.

Dolbear *et al. v.* Am. Bell Telephone Co. By *Waite, C. J.*, 19 Mar., 1888, 43 O. G., 377, ❋.

47. In the case of Le Roy *et al. v.* Tatham *et al.*, the Supreme Court, while, on technical grounds, failing to find for the patentees, took no exception to the claim. The Court said: —

No exclusive right can be founded on the discovery of a new power; the elements of the power are free to all; the invention is not in discovering *them*, but in applying them to useful objects. In all such cases the processes or the instrumentalities used to extract, modify, and concentrate natural agencies, constitute the invention, whether the machinery consist of details separately new and useful, or be a new and useful combination of old parts.

The patentees' claim was as follows: —

We do not claim as our invention and improvement any of the parts of the above-described machinery, independently of its arrangement and combination as above set forth. What we do claim as our invention, and desire to secure, is the combination of the following parts, above described, to wit: the core and bridge or guide-piece with the cylinder, the piston, the chamber, and the die, when used to form pipes of metal under heat and pressure, in the manner set forth or in any other manner substantially the same.

Le Roy *et al. v.* Tatham *et al.* (plaintiffs in error), U. S. S. C. By *M'Lean, J.*, Dec., 1852, 14 Howard, 156, ✿.

48. Where a claim admits of two interpretations, that interpretation will be given to it which is most favorable to the patentee.

In a case before the Supreme Court, which involved the scope and validity of the patent No. 6,792, granted 16 Oct., 1849, to Henry Burden, for "Machinery for Drawing Out or Compressing Heated Iron," the Court sustained the following claim: —

1. Having thus fully made known the nature of my said improvement, and explained and exemplified the manner in which I construct the machinery for carrying the same into

operation, what I claim as constituting my invention and desire to secure by letters-patent is: the preparing of the puddlers' balls as they are delivered from the puddling-furnace (or of similar masses of iron) by causing them to pass between a revolving cylinder and a curved segmental trough adapted thereto, constructed and operating substantially in the manner of that herein described and represented in figures 2 and 3 of the accompanying drawings, or by causing the said balls to pass between vibratory or reciprocating curved surfaces operating upon the same principle and producing a like result by analogous means.

The Court said: It is true that the patentee, after describing his machine, has set forth his claim in rather ambiguous and equivocal terms, which might be construed to mean either a process or a machine. In such case the construction given to the claim should be that which is most favorable to the patentee, *ut res magis valeat quam pereat.*[1] His patent having a title which claims a machine, and his specification describing a machine, to construe his claim as for the function, effect, or result of his machine, would certainly endanger, if not destroy, its validity. His claim cannot nullify or change his previous specification with safety to his patent. Having described a machine which will perform a certain function, he cannot claim the function itself and thereby all other machines that may be invented to perform the same function.

The patent of Burden alleges no discovery of a new process, but only that he has invented a machine, and, therefore, correctly states the nature of the invention. His specification sets forth the "particulars" of his invention in exact accordance with the title in the patent, and in clear, distinct, and proper phraseology.

The case was remanded for a *venire facias de novo* on the twofold ground of irregularities and because the Court below "erred in construing Claim 1 to be for a

[1] "That the thing [*i. e., the patent*] should rather stand than fall."

mode, process, or method, irrespective of the special mechanical device."

Corning *v.* Burden, U. S. S. C. By *Wayne*, *J.*, Dec., 1853, 15 How., 252, ❁.

49. It has been so often decided that an application may not contain claims to separate species of the same invention, that the decision of every such question has become purely one of fact.

Dewey, x. p., *Frothingham*, *Act. Com.*, 24 Oct., 1891, C. D. Ms.

50. The fact that a claim is intelligible to persons like the applicant or the attorney, to whom the device in all its details and minutiæ is already familiar, is not conclusive of its language being such as to convey a clear and exact understanding *to others*.

Kerr, x. p., *Dyrenforth*, *Act. Com.*, 26 Feb., 1884, 28 O. G., 95.

51. Were a claim permissible so totally lacking in definiteness as to oblige a careful examination of the specification to get at the gist of the invention, there would be no occasion for making a claim at all, for it would be just as well to search the description in the first instance for the invention, instead of looking at what is denominated a "claim," but which is in reality a mere reference to the description.

Ib.

52. Where the claim is so unintelligible as to mean nothing, or so indefinite as to mean anything, the law warrants a refusal to enter upon the examination until the claim has been corrected in form; but where the claim did not lack in intelligibility or definiteness, and the Examiner declined to consider the case on the merits, "for the reason that said claims failed to point out any qualities in the thing claimed which could legitimately

be considered in connection with the patentability of an article of manufacture": *Held*, upon petition of the applicant, that if Examiner was still of opinion that claimant was not entitled to a patent under the law, he should reject the claims for all the reasons pertinent to examination, so as to put the case in condition for appeal to the Examiners-in-Chief in case applicant should so elect.

Rogers, x. p., *Mitchell, Com.*, 16 Nov., 1889, 49 O. G., 1361.
Compare Ives, x. p. (1), and Rice, x. p. (2), AMBIGUITY.

53. Claims forming parts of one case cannot be to alternative structures; or, in other words, no claim can be to a modification of a structure set up in another claim in one and the same case, nor may any claim be in itself to two or more alternative forms.

Holt, x. p., *Dyrenforth, Act. Com.*, 26 Ap., 1884, 29 O. G., 171.
Compare Pierce, x. p., (7) AMENDMENT.

54. Change of Claim from the Method to the Apparatus after Final Rejection, — Refused.

Where the application as originally filed was restricted to the method: *Held*, that, after its rejection upon references, applicant could not be permitted to amend by substituting a new statement of invention and new claims covering the apparatus; that it must be held that applicant had elected, and that, under Zabel, x. p. (43 O. G., 627), an applicant who in his application has elected, through ignorance or mistake, to prosecute claims for one invention must exercise diligence in presenting his amendment correcting such error, before his application has been examined and rejected.

Kinzer, x. p., *Mitchell, Com.*, 6 Feb., 1891, C. D. Ms.

For circumstances justifying a relaxation of the above general rule, see Butterfield and Batchelor, (2) RE-OPENING.

55. The objection that a claim is alternative in form stands upon an entirely different basis from the objection or requirement that the application should be divided. Objection as to alternative forms may be quite tenable, even where both forms in the alternative claim relate to the same invention.

Wilson & Mason, x. p., *Mitchell, Com.*, 15 Mar., 1890, C. D. Ms.

56. A claim presented in application which claimed the adjustment of a certain member without specifying any *means* of adjustment, was rejected because merely functional. The claim was as follows: —

A shaft C, for holding the bevel-gear wheel the cogs of which are to be planed, adjusted to turn laterally and vertically about a point D, which is upon its axis and also on the line of travel of the planing-tool *g*, and on the apex of the conical or bevelled surface to be planed, substantially as described.

Holmes, x. p., *Thacher, Act. Com.*, 31 Aug., 1874, C. D. 87.

NOTE.—The above claim, if amended by insertion, after "adjusted," of some such expression as "by the described or equivalent means" might possibly have been passed by the Office, and if passed, would probably have been sustained by the courts. See for example, Corning *v.* Burden, ✽, (48) *supra*. But compare for Office action, Ives, x. p., (29) *supra*, and Rice, x. p., (57) *infra*.

57. A mere reference to the body of the specification by the words "substantially in the manner described" is not good practice under the statute requiring that the applicant shall "distinctly claim" his invention.

Rice, x. p., *Leggett, Com.*, 2 May, 1874, C. D. 44.

For exception, — in favor of a pioneer invention, — to the above general rule, see Dalton, x. p., (11), Nat. Type Co. *v.* N. Y. Type Co., (38), Morley Mach. Co. *v.* Lancaster, ✽, (39), Worstwick M'f'g Co. *v.* City of Buffalo (40), and Corning *v.* Burden, ✽, (48), *supra*.

58. Redundancy, Duplication, Prolixity, etc.

Where a simple invention is made the subject of numerous claims, differing in mere methods of expression, with no corresponding difference in the concrete subject-matter, the Office should insist that one claim only be allowed for a given subject-matter of invention, and that mere differences in phraseology shall not be regarded when urged in defence of a needless multiplication of claims.

Johnson, x. p., *Mitchell, Com.*, 20 Jan., 1891, 54 O. G., 505.

59. The common but reprehensible practice of unnecessarily, if not improperly, splitting up and multiplying claims, illustrated in complainant's specification, — condemned.

Bostock *v.* Goodrich, *Butler, J.*, 6 Nov., 1885, 29 O. G., 278.

See, however, (18), (19), (20), and (20′), *supra*, for cases in which a re-statement, in changed phraseology, of substantially the same invention, was permitted.

60. What Mr. Brush accomplished in 1879 and 1880 can be embraced in a brief, clear, and precise statement. What he actually did is the test by which his patents must be judged. He is entitled to what he invented, and only that. His patents can receive no broader construction because he described his inventions with irksome prolixity, and gave to the same structure a wearisome variety of names. The nomenclaturist should not seek the reward for his labors in the Patent Office. A person is not entitled to a patent because he has invented a new word. The danger and impropriety of holding a number of claims relating to the same structure, and which can be differentiated only by the most abstruse and metaphysical distinctions, seem apparent. They are calculated to embarrass inventors and to mislead the public.

Brush Elec. Co. *v.* Elec. Acc'm'r Co., U. S. C. C. S. D. N. Y., *Coxe, J.*, 23 July, 1891.

61. The question of redundancy or multiplicity of claims is one of "form," and not one which involves "the merits;" hence the proper remedy is by petition to the Commissioner.

Sawn, x. p., *Mitchell, Com.*, 9 Mar., 1891, 54 O. G., 1561.

62. Where the Examiner makes the objection that there are too many claims, he should point out the reasons for such ruling, and should designate which claims are superfluous, so that applicant may be fully advised and be able to act intelligently either in limiting their number or in persisting in their retention.

Bickley, x. p., *Fisher, Act. Com.*, 29 Mar., 1890, C. D. Ms.

See REDUNDANCY.

63. Claims in a patent for invention are not like counts in a pleading, setting forth the same cause of action in different forms of language to provide against the hazards of proof; but their object is to set forth distinctly and *concisely* just what the invention is which applicant asks to have secured to him by his patent: hence, where a simple invention is made the subject of numerous claims, some of them differing from others in mere methods of expression, with no corresponding difference in the concrete subject-matter, the Office should insist that one claim only be allowed for a given subject-matter of invention, and that mere differences in phraseology shall not be regarded when urged in defence of a needless multiplication of claims.

Johnson, x. p., *Mitchell, Com.*, 20 June, 1891, 54 O. G., 505.
Compare, however, (18) to (20), inclusive, *supra*.

64. The mere fact that the Examiner calls his action on the claims a "rejection" does not in fact render them subject for appeal to the Examiners-in-Chief, unless the reasons for rejection are such as relate to the merits

of the case: hence, where the action of the Examiner amounts, in effect, to a statement that the claims, as amended, are inaccurate and misleading, a petition to the Commissioner is proper.

Hensen, x. p., *Frothingham, Act. Com.*, 21 Aug., 1891, C. D. Ms.

65. Claims must be construed according to their terms; and where the import is plain, resort cannot be had to the specification for the purpose of enlarging their scope.

White *v.* Dunbar, U. S. S. C. By *Bradley, J.*, 119 U. S., 47, ✲.
Compare Lull *v.* Clark, (20″) *supra*, and Laskey, (66) *infra*.

66. It is the province of claims to relegate to the specification the enumeration of such details of construction as shall, upon examination, be found to be immaterial to the true scope of the actual invention. The inclusion of such merely accessory parts in the description in the specification is to enable persons skilled in the art to construct the machine in the form set out in the patent, but not to so limit the invention as to make it an easy prey to the infringer.

Laskey, x. p., *Mitchell, Com.*, 6 July, 1889, 48 O. G., 539.
Compare (22) *et seq.*, *supra*.

67. Constructive Dedication.

Nothing is better settled in the law of patents than that the patentee may claim the whole or only a part of his invention, and that if he describe and claim only a part, he is presumed to have abandoned the residue to the public. The object of the patent law in requiring the patentee to "particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery" is, not only to secure

to him all to which he is entitled, but to apprise the public of what is still open to *them*. The claim is the measure of the right to relief; and while the specification may be referred to to limit the claim, it can never be made available to expand it (Keystone Bridge Co. *v.* Phœnix Iron Co., 95 U. S., 274, ❁).

McClain *v.* Ortmayer, U. S. S. C. By *Brown, J.*, 2 Nov., 1891, 57 O. G., 1129, ❁.

68. Of several possible interpretations of a claim, that interpretation will be given which, all things considered, is most favorable to the patentee (*ut res magis valeat quam pereat*). The invention was held to be confined to the machine, as the process referred to was not patentable (Corning *v.* Burden, 15 Howard, 264, ❁).

Harrison, x. p., *Doolittle, Act. Com.*, 1876, C. D. 170.

69. When the claim is susceptible of two constructions, that one will be adopted which will preserve to the patentee his actual invention; but nothing can be held to be an infringement of a patent which does not fall within the terms the patentee himself has chosen to express his invention.

McClain *v.* Ortmayer, U. S. S. C. By *Brown, J.*, 2 Nov., 1891, 35 L. ed., 800, ❁.

Of like tenor, see Corning *v.* Burden, ❁, (48) *supra.*

70. Whether or not claims should be construed as covering a complete and useful article is a question relating to "the merits," to be determined in the first instance by the Primary Examiner, then by the Examiners-in-Chief on appeal, followed by appeal to the Commissioner, if necessary; these questions must be determined before a question of substantial identity of two or more of the claims is presented to the Commissioner.

Dyer, x. p., *Frothingham, Act. Com.*, 4 Aug., 1891. C. D. Ms.

71. Combination Claim, — Scope of.

In a patent for improvement in water-closets, a combination claim, one element of which is "two jets," is not infringed by a closet having but one jet. It has been repeatedly held that a combination is an entirety, and that a patentee cannot abandon a part as immaterial and claim the rest, but he must stand by the claims as he has made them. If less *or more* [?] than the whole of his ingredients is used by another, that other is not liable as an infringer, because he has not used the invention or discovery patented. Such is the doctrine of the Supreme Court as laid down in Schumacher *v.* Cornell (96 U. S., 549, ✽).

Smith *v.* Putnam, *Colt, J.*, U. S. C. C. Mass., 45 F. R., 202.

NOTE. — While the italicized portion of the above ruling had no bearing on the case in suit, and must be considered but an *obiter dictum* of the learned judge, it may be stated that neither in Schumacher *v.* Cornell, ✽, nor in the earlier Supreme Court decision in Vance *v.* Campbell, ✽, cited in that case, is language found which either directly or inferentially justifies the above italicized portion of the decision in Smith *v.* Putnam, nor is that portion believed to be sound in law. A patented combination of mechanical elements is *not* free to any one who, without re-arranging such elements or in any way modifying their mutual or several functions, simply adds one more or any number of new elements. The word "ingredients" employed in the Circuit Court decision seems suggestive of a chemical rather than of a mechanical combination (water-closet), and it may be conceded as true that chemical combinations are not infrequently profoundly affected (as, for example, in the minute increment of carbon in steel) by an added element. A mechanical combination, even where meritorious and patented, which incorporates without changing the combination of an earlier patent is subject to its claims. See Crehore *v.* Norton, *Nelson, J.*, 1853; Crehore *v.* Moore, Law's

Digest, 351; Foster *v.* More, Curtis, C. C. Rep.; Tilghman *v.* Procter, 19 O. G., 859, ✽; Bladen *v.* Rand, McNally & Co., 27 O. G., 99; Bell *v.* Gray, 15 O. G., 776. See also Clark *v.* Ferguson, (5) COMBINATION, and Nail, x. p., (1) COMPOSITION OF MATTER.

72. Where a patentee, on rejection of his application, had inserted in his specification limitations and restrictions, for the purpose of obtaining his patent, he cannot, after he has obtained it, claim that it shall be construed as if such limitations and restrictions were not contained in it.

Roemer *v.* Peddie *et al.*, U. S. S. C. By *Blatchford, J.*, 9 Dec., 1889, 132 U. S., 313, 49 O. G., 2151, ✽.

73. Where a patentee had modified his claim in obedience to the requirements of the Patent Office, he cannot have for it an extended construction which had been rejected by the Patent Office; and, in a suit on his patent, such claim must be limited, when it is a combination of parts, to a combination of all the elements which he has included in his claim as necessarily constituting that combination. The authorities are collected in the Supreme Court decision in Roemer *v.* Peddie (132 U. S., 313–317, ✽).

Phœnix Caster Co. *v.* Spiegel, U. S. S. C. By *Blatchford, J.*, 3 Mar., 1890, 50 O. G., 1591, ✽.

See, of like purport, Sargent *v.* Hall Safe & Lock Co., ✽, (10) PUBLIC RIGHTS AND OBLIGATIONS.

74. The use of the words "substantially as described and for the purpose set forth," in a claim, throws it back to the specification for the qualification of words otherwise general.

Brown *v.* Guild, U. S. S. C. By *Bradley, J.*, Oct. term, 1874, 23 Wallace, 181, ✽.

75. A claim which might otherwise be held bad as covering a function or a result, may be construed, when containing the words "substantially as described," in connection with the specification and be limited thereby.

Seymour *v.* Osborne, U. S. S. C. By *Clifford, J.*, Dec., 1870, 11 Wallace, 516, ❋.

NOTE (i). — The claim in question was that of W. H. Seymour, for an improvement in harvesters, and was as follows: —

A quadrant-shaped platform, arranged relatively to the cutting-apparatus, substantially as herein described, for the purpose set forth.

NOTE (ii). — For present attitude of the Patent Office toward such claims as are referred to in (74) and (75) *supra*, see (29) to (37), inclusive, and (57) *supra*, and (79) to (85), inclusive, *infra*.

76. Where an inventor was the first to enter a particular field of invention, the claim of his patent should be construed broadly to cover any similar apparatus which effects the same result in substantially the same manner.

Worstwick M'f'g Co. *v.* City of Buffalo, *Coxe, J.*, 8 May, 1884, 27 O. G., 1239.

77. Claim must be to means, not to results.

Whether an inventor is a pioneer in his line or not, he cannot make a valid claim the scope of which is so extensive as to include means substantially different from those described, even though the same results may be produced by those different means. An inventor may, however, employ language sufficiently comprehensive to include colorable variations of his invention, — mechanical equivalents thereof, and (if the state of the

art will justify it) modifications differing in form but embracing the same principles.

Demming, x. p., *Butterworth, Com.*, 12 Mar., 1884, 26 O. G., 1207.

Compare (46) *supra.*

78. Infancy of the Art.

In the case of patents which represent the infancy of an art or *the stage of its earliest practical development,* this Office is solicitous that the inventor should be accorded a breadth of claim commensurate with the extent and importance of the invention which he desires and is entitled to protect. While the Office will insist on as much definiteness in the language of the claim as the statute calls for, it will also, if it properly discharge its functions as the protector of the inventor, leave something to the salutary and benign agency of construction in the courts.

Pacholder, x. p., *Mitchell, Com.*, 26 Ap., 1889, 51 O. G., 295.

79. Maturity of the Art.

No general rule can be laid down for governing the employment, in the claims of patents, of such words as "means," "mechanism," "appliances," etc. It is the object of the law, as it is the solicitude of the Office, to protect inventors and guard their inventions. This object is best secured, in the case of patents which represent the maturity of an art, by taking care that the claims shall be drawn with all reasonable restrictions, so that they shall be valid in spite of everything that is contained in existing patents and of everything previously known or used.

Ib.

80. Basic Invention.

The invention at issue, being a broad one and of acknowledged value, is entitled to be protected by claims of adequate scope. For the first time in the art it had been made possible to produce, from a continuous web, newspapers, cut, pasted, and folded into a complete pack, without any manipulation of the paper-blank from its entry into the machine to its exit, and to print newspapers more rapidly and cheaply than heretofore. In fact, a revolution in the entire art of newspaper printing is effected by the invention, so that, viewed from this standpoint alone, the quality of it cannot be seriously underrated.

Scott *v.* Ford *et al.*, *Spear, Com.*, 30 Sep., 1878, C. D. 106.

NOTE. — The claim above referred to and approved was in language as follows : —

The combination of printing, cutting, pasting, and folding mechanisms, whereby a web of paper is printed, severed into sheets, pasted on their folding lines and folded or doubled two or more times, to form complete folded packs or signatures; all substantially as described.

81. Where an applicant seeks to secure a generic patent, he should employ, in the specification and in his generic claim or claims, comprehensive designating language applicable alike to all the forms shown and described, of the device in question.

Cook, x. p., *Mitchell, Com.*, 12 Ap., 1890, 51 O. G., 1620.

82. Generic Claims and Specific Claims.

It is abundantly decided that an applicant can show and describe as many different forms of his invention as can be covered by the generic claim (or claims), and may also claim specifically the preferred form of his invention ; but more than this he is not entitled to do. The other forms can be specifically covered only in as many distinct

patents (Eagle, x. p., 1870, C. D. 137; Howland, x. p., 1877, C. D. 120; Heaton, x. p., 1879, C. D. 95).

Ib.

83. Commissioner Fisher, in the case of Eagle, x. p., 1870, C. D. 137, established on a permanent basis the practice of the Office where an applicant seeks to claim a specific form of his invention, and in the same grant to secure by generic claim the features common to two or more figures representing modified forms of his invention. In this decision, Commissioner Fisher said:

The applicant describes a new genus, to wit, a box provided with a follower. He may fairly describe several species of this genus, and he may make any claim that is generic in its character and that includes them all. In addition to this [any representation of the genus being necessarily one of its specific forms] he may select one of the embodiments of his invention for specific claims, but he cannot [in one and the same patent] found one claim on one species, a second on another, a third on another, and so on.

The same doctrine was laid down in Howland, x. p., 1877, C. D. 120; in Heaton, x. p., 1879, C. D. 95; and in Cook, x. p., 51 O. G., 1620.

Payne, x. p., *Mitchell, Com.*, 25 July, 1890, C. D. Ms.

84. Pioneer Inventor.

Where a party is the first inventor [in the class] of the devices on which he seeks a patent, and not a mere improver upon previous inventions, he is entitled to employ general words of description in the claims, such as, "constructed, arranged, and operated as set forth," to express the co-operation of certain parts with others of the machine. The restrictions laid down in Rubens, x. p. (1869, C. D. 107), do not apply to a fundamental invention such as that now in controversy.

Knight *v.* Amman, *Duncan, Act. Com.*, 20 Feb., 1871, C. D. 34.

85. Applicant may describe a genus and several species of the genus, and he may take a generic claim covering them all; he may also select one of the embodiments of his invention for a specific claim. Other embodiments may be protected in as many separate patents.

Heaton, x. p., *Payne, Com.*, 16 Dec., 1878, 1879, C. D. 95, 15 O. G., 1054.

86. In a process claim it is only necessary to define the *steps* of the process, leaving to the specification to fully point out the manner in which such steps are carried out.

Zalinski, x. p., *Fisher, Act. Com.*, 4 Mar., 1890, C. D. Ms.

Compare Vorel, x. p., (11) PROCESS.

87. The Necessary Operation of a given Machine not claimable as a Process.

Where a structure of a special and particular form necessarily produces, by its operation, certain results, it alone can be claimed, and not the results. It is very important to discriminate between a process [properly so called] which may consist of a series of steps or acts carried on by *any* mechanical means necessary to produce them in a certain order, and a "process," so called, which amounts to nothing more than the functions of, or the effects necessarily produced by, a machine of a particular form. It is difficult to make this discrimination in all cases; and yet, where it can be made, it is a vital matter in the proper examination of an application or the grant of a valid patent.

Roloson, x. p., *Doolittle, Act. Com.*, 14 Jan., 1879, 15 O. G., 471.

Compare Corning *v.* Burden, (1) ART, and McKay *v.* Jackson, (35) INVENTION.

88. Compound or Composition of Matter.

The claim presented was: —

As a new article of manufacture, the petroleum-product hereinbefore specified and having the characteristics herein described.

The Examiner refused to entertain the claim because "not specific." Examiner's decision was reversed, and consideration of the case upon its merits was directed, because the product must be regarded as an entity, and, if new, the inventor or discoverer is entitled to all the known or hereafter discovered characteristics it may possess. It is impossible to mention all these in the claim, and to mention less would restrict the claim within too narrow limits.

Where new products are discovered incapable of being definitely described in the claims except by a general reference to the specification, the rule requiring that the applicant "shall particularly point out and distinctly claim the invention" is relaxed, the case being considered anomalous (Goodyear *v.* R. R., 2 Wallace, Jr., 365).

Tweddle, x. p., *Doolittle, Act. Com.*, 28 Oct., 1876, C. D. 221.

89. A claim for a compound consisting of certain known ingredients should enumerate them.

The above rule, which is of general application, is relaxed only in such rare and anomalous cases as Tweddle (1876, C. D. 221) and Goodyear *v.* R. R. (3 Wall., Jr., 365), in which a substance never before known and of great industrial value had been produced by a chemical process which was also new, and which could be defined only by reference to the entire specification.

Williams, x. p., *Doolittle, Act. Com.*, 31 Oct., 1876, C. D. 227.

NOTE. — The claim objected to was worded as follows: —

The hereinbefore described compound or composition of matter consisting of the ingredients mentioned, prepared in the manner and proportion substantially as described for the purpose set forth.

CLASSIFICATION.

1. Devices of which each has obtained a distinct status in an industry or trade, should be the subjects of separate applications.

Sawn, x. p., *Mitchell*, *Com.*, 9 Mar., 1891.

2. The creator of an art — as, for example, the inventor of the first watch — would be entitled to a patent including in it as many claims as the several distinctive elements of the mechanism; but when, in the progress of the art, the efforts of inventors have been directed to separate parts of the watch, and, at their requests, patents have been issued upon such separate parts, a corresponding classification of subjects necessarily arises.

Combs, x. p., *Duncan*, *Act. Com.*, 2 Aug., 1871, C. D. 209.

3. Ordinarily, two or more independent inventions should not be included in one patent.

When a part of an application relates to an independent invention, it should not be allowed to remain merely because there is no Office Classification applicable to the case. Applicant should not be granted an invalid patent because of the [imperfect] classification [of inventions] in the Office.

Martin, x. p., *Marble*, *Com.*, 21 Sep., 1883, 25 O. G., 502.

NOTE. — Examiner was directed to make a sub-class of MATCH-TRAYS.

4. Two or more inventions capable of independent operation may be included in one patent if capable of co-action for a single useful result.

Although distinct and independent inventions which are differently classified may not ordinarily be embraced in one application; nevertheless, when dependent upon each other and co-operating toward the production of a single result, the Office Classification, when it obstructs, must give way.

Mefford, x. p., *Butterworth*, *Com.*, 15 Nov., 1883, 25 O. G., 881.

Compare Dalton, x. p., (7) INVENTION.

5. The words "Art," "Machine," "Manufacture," "Composition of Matter," and "Improved Art," etc., — Defined.

A patent is a creature of the statute, and must be covered by its provisions. It is evident that the words "art," "machine," "manufacture," and "composition of matter," were carefully chosen to cover what were regarded as four great and distinct classes of invention. It is undoubtedly the intention of the law to distinguish as separate inventions "a new art," "a new machine," "a new manufacture," "a new composition of matter," "an improved art," "an improved machine," "an improved manufacture," "an improved composition of matter," — eight in all. These may be called the statutory classes of invention between which the lines of division are sharply drawn.

Blythe, x. p., *Butterworth*, *Com.*, 28 July, 1884. 30 O. G., 1321.

Compare Corning *v.* Burden, (1), Kelly, x. p., (2), and Dalton, x. p., (3), ART.

6. When one particular element of a machine is dependent upon and acts with the other elements

thereof to produce a single beneficial result, it may be claimed in the same application with them, without regard to the Office Classification.

Coe, x. p., *Fisher, Act. Com.*, 27 May, 1889, 48 O. G., 1119.

Compare Designolle, x. p., (17) THE CLAIM; Carter, x. p., (5), and McMahan, x. p., (31), DIVISION OF APPLICATION; and Hunter, (2) RULES AND FORMS.

NOTE. — Equally inadmissible with the crowding of two or more distinct and independent inventions into a single patent is the converse procedure of attempting to cover one indivisible subject-matter of invention under two separate patents differing only in verbiage. See, for example, Smith, x. p., (4) APPLICATION; Brush *v.* Elec. Co., (60) THE CLAIM; Langlois, x. p., (12), Gabouri, x. p., (13), and Feister, x. p., (14), EXAMINATION.

For inadmissibility of two or more patents for different uses merely of one and the same thing, see Faure, x. p., (12), and Barrett, x. p., (13), PUBLIC RIGHTS AND OBLIGATIONS.

COLLATERAL QUESTIONS.

See Hunter, Jr., *v.* Lane, (65), and Strause *v.* Cook, (84′), INTERFERENCE.

COLLUSION.

It being made to appear to the Court, by petition of strangers to the record, that a decree was obtained by collusion between complainant and defendant in a patent suit, the decree was annulled, and the cause dismissed.

Barker *v.* Todd, *Wallace, J.*, 29 Nov., 1882, 23 O. G., 438.

COMBINATION.

1. Legitimate Combination, — Defined.

To render patentable a combination of devices old in themselves, the combination must produce a result new

in itself, and distinct from any mere aggregate of the results formerly produced by any or all of the devices when acting separately.

Cocs, x. p., *Leggett*, *Com.*, 29 June, 1874, 6 O. G., 1.

2. There is a combination between two or more elements if there is a concert of action between them to accomplish a result *due to their conjoint action*, even where the device is capable of separation into elements capable of performing distinct and independent functions.

McKisson *v.* Caindick, *Blatchford*, *J.*, 8 Ap., 1881, 21 O. G., 137.

3. It appearing that some of the elements of the combination claim formed a new combination of parts to secure a useful result, it became immaterial to inquire whether all the elements of the claim are strictly in combination and not merely aggregated.

Strobridge *v.* Landers, *Blatchford*, *J.*, 3 Dec., 1881, 21 O. G., 1027.

4. In a patentable combination of elements all the parts must so enter into it that *each qualifies every other*. The combination must either form a new machine of a distinct character and functions, or must produce a result due to the joint and co-operating action of all the elements, and not to the mere adding together the separate contributions.

The Clark Pomace-Holder Co. *v.* Ferguson, *Coxe*, *J.*, 10 Jan., 1883, 24 O. G., 1090.

See, however, Strobridge *v.* Landers, (3) *supra*.

5. Considered as a generic term, a combination may be defined to be *a co-ordination of individual functions so as to constitute a common function*. Co-ordination

necessarily implies some modification of the individual function of each part as it existed prior to the combination. To be patentable, a combination must conform to the definition given above, and must also contain two other elements; namely, novelty and utility.

Marshall, x. p., *Butterworth, Com.*, 12 Nov., 1883, 25 O. G., 882.

6. In reference to a patent to one Prouty for a new and useful combination of old and well-known elements, the Supreme Court held: The patent is for a combination, and the improvements consist in arranging different portions of the plough and combining them together in the manner stated in the specification for the purpose of producing a certain effect. None of the parts referred to are new, nor is any portion less than the whole claimed as new or stated to produce any given result. The end in view is proposed to be accomplished by the union of all, arranged and combined together in the manner described.

Prouty *v.* Ruggles, U. S. S. C. By *Taney, Ch. J.*, 1842, 16 Peters, 340 U. S., 987, ❋.

See also Broughton, x. p., McArthur, Pat. Cas., 285; citing Barrett *v.* Hall, 1 Mason, 474, and Parr *v.* Little, 3 Wash., 196.

7. The separate parts of *a process* being old, the only field left for invention was either a new order in which the steps were to be applied, or some new method of using one or more of the devices by which the process was accomplished, or both these combined, so as to produce some new product or some old product in a cheaper or otherwise advantageous manner.

Downtown *v.* Yeager Milling Co., U. S. S. C. By *Woods, J.*, 7 May, 1883, 25 O. G., 697, ❋.

8. A legitimate combination may not be rejected piecemeal.

A legitimate combination, in an application for patent, should be met as such, or not at all. The practice of dissecting a machine and rejecting it by piecemeal is without sanction of either reason or law. Under such practice the Office might very soon close its doors; for the lever, the inclined plane, and the pulley are very old and very well known, and might soon become sufficient references for every possible mechanical device.

Smith, x. p., *Leggett, Com.*, 24 Ap., 1872, 1 O. G., 403.

9. The Examiners-in-Chief rejected an application for a certain process on nine distinct references: *Held*, on appeal, that as no one of the references disclosed all the steps of the process claimed, none of the references were anticipations, and the decision was reversed.

Keene, x. p., *Simonds, Com.*, 29 Jan., 1892, C. D. Ms.
Compare Smith, x. p., (8) *supra*, and Dubbs, x. p. (10) *infra.*

10. Step by Step Argument.

The patentability of an alleged process having been denied, upon the ground that a claim, by the same applicant, in a former application for a process for manufacturing asphaltum having been held destitute of patentability, it did not make a new process to practise the same operation in the treatment of crude petroleum, or of a residuum of the same free from paraffine wax: *Held* that of that proposition two things were to be said: (i) That it is never safe to determine patentability upon such a *step-by-step argument*; (ii) That the substitution of material in a process where chemical or quasi-chemical actions take place may involve a change of substance. The probabilities of the presence of patentable novelty being in applicant's favor, the decision of the Examiners-in-Chief was reversed.

Dubbs, x. p., *Simonds, Com.*, 15 June, 1892, C. D. Ms.
Compare Tweddle, x. p., (88) THE CLAIM; Crippen, x. p., COMPOUND; and Nail, x. p., (1) COMPOSITION OF MATTER.

11. An aggregation of old devices, each working out its own effect without securing some new and useful result as the joint product of the combination, does not constitute a patentable invention (Hailes *v.* Van Wormer, 20 Wallace, 353,✵ ; Pickering *v.* McCullough, 104 U. S., 310, ✵).

Adams *v.* Bellaire Stamping Co. *et al.*, U. S. S. C. By *Field, J.*, 16 Nov., 1891, 57 O. G., 1280, ✵.

12. The objection of incompleteness of combination, it is well settled, relates to "the merits," and is appealable to the Examiners-in-Chief.

Lockwood, x. p., *Fisher, Act. Com.*, 19 June, 1890, C. D. Ms.

COMMERCIAL SUCCESS.

Public Adoption as a Test of Patentability.

Where the question of invention is in doubt, the fact that the device has gone into general use and has displaced other devices which had previously been employed for analogous uses, is generally sufficient to turn the scale in favor of sufficiency of invention (Smith *v.* Goodyear Co., 93 U. S., 486, ✵ ; Hollister *v.* Benedict Co., 113 U. S., 59, ✵ ; Hill *v.* Biddle, 27 F. R., 560). But where an applicant has merely carried forward or made a new or more extended application of an old method, and it simply involves the expected skill of the calling, a finding that such a doubt exists would be unwarrantable, and the fact that the improved device was a commercial success, and had been adopted, to the exclusion of similar devices not having the feature sought to be patented, is immaterial.

Spielman, x. p., *Mitchell, Com.*, 19 Sep., 1890, C. D. Ms.

Compare Washburn *v.* Barbed Wire Co., ✵,(5), and McClain *v.* Ortmayer, ✵, (6), PATENTABILITY.

COMMISSIONER, ETC.

1. Powers and Duties.

The Commissioner of Patents must be governed in his practice by decisions of the Federal Courts; hence, an interference having been declared under authority of a rule (Rule 51) promulgated by the Commissioner of Patents with the approval of the Secretary of the Interior, but the Supreme Court of the District of Columbia having ruled (Mayal, x. p.) that the Commissioner has no authority of law to declare an interference between an application for re-issue and a patent granted subsequently to that sought to be re-issued: *Held*, that the said decision must hereafter control the Patent Office in the declaration of interferences so far as it applies. Rule 51 may therefore be regarded as amended by striking out its last paragraph.

Becker *v.* Throop, *Thacher, Com.*, 7 July, 1875, 8 O. G., 1.

NOTE. — In the Patent Office pamphlet of April 1, 1892, the parties between whom interferences may lie are particularized under Rule 94.

2. It is the first and highest duty of every officer connected with the Patent Office having judicial functions, when he makes a decision, to be guided by the decisions of the United States Supreme Court, and, failing an appropriate Supreme Court decision, by the decisions of the United States Circuit Courts whenever they furnish a guide for his action.

Penney *v.* Gunn, *Simonds, Com.*, 13 Aug., 1891, C. D. Ms.

Compare Reffard *v.* De Ferranti, (1) RULES AND FORMS, and Jerome, x. p., (8) APPEAL.

3. Questions of Constitutionality.

Whatever doubts may exist with reference to an act prescribing duties for the Patent Office, it remains for

this Office to treat it as a valid part of the law until the Supreme Court declares it unconstitutional.

Palmer, x. p., *Simonds, Com.*, 13 Jan., 1892, 58 O. G., 383.

4. Jurisdiction.

A rejected application, pending on appeal in the Supreme Court of the District of Columbia, is not open to review by the Commissioner of Patents.

Jerome, x. p., *Simonds, Com.*, 21 Jan., 1892, 58 O. G., 945.

5. The Commissioner the Judicial Head of the Patent Office.

It is a matter of course that there must be some head, both executive and judicial, in this Office. The Supreme Court (Com'r *v.* U. S. *ex rel.*, Howe, 1884, C. D., 429) has said that the Secretary of the Interior is not that judicial head. It follows that the Commissioner of Patents must be.

Strong, x. p., *Simonds, Com.*, 7 Oct., 1891, 57 O. G., 274.

6. Plenary Powers of the Commissioner.

Where it was insisted that it was the Commissioner's duty to look into any case to which his attention is called by appeal or otherwise, at any stage of the proceedings, where there is a reasonable ground for belief that a fraud or wrong is about to be perpetrated either by his subordinates, or by applicants or their attorneys: the Commissioner dismissed the appeal [in this particular instance] for want of merit; but held that he would be very slow to lay down any proposition, as to his duties, which is to any extent antagonistic to the view — insisted upon by counsel — that the law places upon the Commissioner the responsibility for the proper administration of the Office; and any theory of his powers which does not make them co-extensive with his responsibility must necessarily be erroneous.

Slutz & Slutz *v.* Dunning, *Mitchell, Com.*, 12 Ap., 1890, C. D. Ms.

7. Commissioner can withhold issue of patent.

A favorable decision of an Examiner or of the Board of Examiners-in-Chief upon an application for patent is not conclusive upon the Commissioner, and it does not follow thereupon that he has only the ministerial duty to perform of countersigning and sealing the patent.

Hull *v.* The Com'r of Patents, Supreme Court of the District of Columbia. By *Wylie, J.*, 13 Mar., 1875, 7 O. G., 559.

8. The Commissioner has power to withhold a patent even after a favorable decision by one of the lower tribunals. Such supervision is necessarily incident to his position as the head of the bureau, but is exercised only when a clear case of necessity therefor is apparent.

Strong, x. p., *Simonds, Com.*, 7 Oct., 1891, 57 O. G., 274.

Compare (9) *infra.*

9. Where the effect of action by the Commissioner, on an appeal from an Examiner, would be to review a decision of that Examiner which was favorable to the application in question, such appeal is repugnant to Rule 124, and will not lie.

Hochhausen *v.* Eichmeyer, *Simonds, Com.*, 19 Jan., 1892, 58 O. G., 521.

Compare (7) and (8) *supra.*

10. Acts of the Assistant Commissioner.

Upon petition to the Commissioner from the Assistant Commissioner: *Held*, that the law makes no provision for such an appeal, and the petition was treated as a motion for a re-hearing.

Clanton, x. p., *Fisher, Act. Com.*, 21 Mar., 1890, C. D. Ms.

See ASSISTANT COMMISSIONER.

11. Acts of Predecessor.

Where Commissioner Montgomery had re-instated an application: *Held*, that it was a judgment on the part

of the then Commissioner over which his successors have no jurisdiction; that the application thereby acquired the status of a pending application, and that all successive Commissioners were bound by the decision.

In re Strong, *Mitchell, Com.*, 16 Sep., 1890, C. D. Ms.

12. A finding of fact by a former Commissioner should not be reconsidered, unless no evidence was presented at the hearing on which a finding might be based, or unless the finding was clearly against the evidence.

Spielman, x. p., *Simonds, Com.*, 16 Sep., 1891, 56 O. G., 1707.

13. The official decisions and corrections of the Commissioner and of the Acting Commissioner are binding upon all in the Office, including the Examiners-in-Chief, until reversed by the Secretary of the Interior. There is but one course open to officers and employés in the Patent Office who deny the relation between the head of the Office and the subordinates.

In re Clymer & Riley, *Leggett, Com.*, 17 July, 1874, 6 O. G., 505.

14. Objections to the specification, accompanied by a refusal to act further on the merits until the objections have been removed, are reviewable by a petition to the Commissioner, and not by an appeal to the Examiners-in-Chief.

Cäbel, x. p., *Mitchell, Com.*, 22 Nov., 1890, 55 O. G. 863.

15. All appeals in which (under Rule 124) the party only whose claim is affected has a right to be heard, such as questions involving the merits of an invention, go to the Examiners-in-Chief, and, if decided adversely by them, to the Commissioner, and if by him decided

adversely, to the Supreme Court of the District of Columbia. All appeals in which both the Examiner and the applicant have a right to be heard go directly to the Commissioner, and from his decision there is no further appeal.

Zeidler *et al. v.* Leach *et al.*, *Mitchell, Com.*, 19 Jan., 1891, 54 O. G., 503.

16. The Commissioner will not consider an appeal to him direct from action of the Primary Examiner rejecting the application. For that reason the petition is dismissed. If, however, the Examiner has any other reasons why a patent should not be granted, he will state them prior to an appeal to the Examiners-in-Chief, so that the whole case may be brought up on appeal.

Kuhn, x. p., *Simonds, Com.*, 25 Feb., 1892, 28 O. G., 1256.

17. Examiner's refusal to entertain an application as properly a division of an earlier one, is reviewable on petition to the Commissioner, and is not appealable to the Examiners-in-Chief.

Freeman, x. p., *Frothingham, Act. Com.*, 19 Jan., 1892, 58 O. G., 522.

18. Before considering the case for final action the Assistant Commissioner called for separate reports from Examiner and Board, of reasons for their diverse grounds of like action.

In a case where the Examiners-in-Chief affirmed the rejection, but based their conclusions on other references than those cited by the Primary Examiner, and the case, having been appealed to the Commissioner on "the merits," was remanded to the Primary Examiner for consideration and report on relevancy of the references relied on by the Examiners-in-Chief, in connection with such additional evidence as should be submitted by applicant;

and where, thereupon, the Primary Examiner adhered to his original grounds of action: *Held*, that, before final determination by the Commissioner, he should be explicitly advised of the Examiners-in-Chief's reasons for their totally different grounds of action, and the case was accordingly returned to the Examiners-in-Chief.

Rogers, x. p., *Fisher*, *Act. Com.*, 31 Jan., 1891, C. D. Ms.

NOTE. — In the above case the Assistant Commissioner said: —

In case the Commissioner's action should be adverse to the appellant, and an appeal should be taken to the Supreme Court of the District of Columbia, all grounds appearing by the record to have been taken in the rejection of the application should be shown to the court to have been regularly passed upon by the legally constituted tribunals of the Office.

See ASSISTANT COMMISSIONER; EXAMINER; JURISDICTION; OFFICE PRACTICE.

COMMON KNOWLEDGE.

It appears, from the testimony, that it was not new, at the time of said alleged invention, to use channelled iron in making dash-frames; nor was it new to use dies for swaging or welding together two pieces of iron. All that remained to be done, in the present case as in other cases, was to adapt the form of the dies to the shape desired in the article to be acted upon by them. Dies which act upon two pieces of metal that are capable of being welded to each other, and which are brought to a welding heat, necessarily will weld them together by the impact and action of the dies. All this was old and of common knowledge, and devoid of patentable invention.

Peters *v.* Active M'f'g Co., U. S. S. C. By *Blatchford*, *J.*, 13 May, 1889, 47 O. G., 1219, ✽.

Compare (29) *et seq.* INVENTION; (1) *et seq.* ORDINARY RESOURCES OF THE ART; and (18) and (21) PUBLIC RIGHTS AND OBLIGATIONS.

COMPOSITION OF MATTER.

1. Effect of Added Ingredient.

A claim for a compound consisting of five different ingredients, designed as an internal remedy for a certain disease, cannot be joined with a claim covering a compound having the same ingredients as the first with the addition of another ingredient, and designed to be used as an external remedy for the same disease, if the additional ingredient in the second claim changes the character of the compound in the first claim both physically and medicinally.

It is contended, on behalf of applicant, that the two compounds are to be used simultaneously, and that they mutually contribute to produce a single beneficial result. This contention is not supported by anything in the specification. Even if there were such support, it is more than doubtful whether that would afford adequate ground for retention of both claims in the case. The mutual dependence and contribution of inventions, designated in Rule 41, cannot properly be held to mean such interdependence as obtains between two remedies for the treatment of a disease which differ in form, composition, and effect.

Nail, x. p., *Frothingham, Act. Com.*, 8 Aug., 1891, C. D. Ms.

NOTE.—It is further manifest that a contention that the ingredient added in the second claim did *not* change the character of the compound set forth in the first claim, would be equally a concession of non-patentability of the subject-matter of said second claim, for there would be an admitted lack of legitimate combination, and hence, of invention.

Compare Crehore *v.* Norton, (71), Tweddles, x. p., (88), THE CLAIM; Dubbs, x. p., (10) COMBINATION; and Crippen, x. p., COMPOUND.

2. It is improper to take two or more references to build up an anticipation of a true combination; but the position that the doctrine of aggregations does not properly apply to compositions of matter cannot be sustained. A [patentable] composition of matter is always a true combination (1 Robinson, Sec. 193).

Hammond, x. p., *Mitchell, Com.*, 31 July, 1891, C. D. Ms.

Compare Dubbs, x. p., (10) COMBINATION.

COMPOUND.

Medicinal.

A remedial compound which is nothing more than such a compound of medicinal agents as could be made by the exercise of the skill of a physician, is not patentable.

Crippen, x. p., *Fisher, Act. Com.*, 24 May, 1890, C. D. Ms.

Compare Dubbs, x. p., (10) COMBINATION; and Hammond, x. p., (2) COMPOSITION OF MATTER.

CONCEPTION.

1. The nascent or incipient invention takes its legal date from the first intelligible disclosure.

Conception must generate an idea of practically operative means, and, in its legal aspects, takes date from the day when those means were disclosed, in intelligible language or by sketches or model, to another person (1 Robinson on Pat's, 534 to 537). The point of time at which [the nascent] invention, in such sense as to merit the protection of the law, dates, is neither when the first thought of it was conceived, nor when the practical working machine is completed; but it is when the thought or conception [of the means] is practically complete, — when it has assumed such shape in the mind that it can be described and illustrated when the "embryo" has taken

some definite form in the mind and seeks deliverance, *and when this is evidenced by description or illustration.*

Cameron *v.* Brick, *Leggett, Com.*, 1 Ap., 1871, C. D. 89.
Compare Ligowski *v.* Peters *v.* Hisey, (8) INVENTION.

2. Perfection of embodiment is not essential to lay a foundation for a claim of priority (Williams *v.* Haile, 40, C. D. Ms., 532). It is sufficient, in such a case, to show a conception of the issue at the time in question.

Gosline *v.* Barney, *Mitchell, Com.*, 9 Nov., 1889, C. D. Ms.
Compare Dickson *v.* Kinsman, (142) INTERFERENCES.

CONCESSION OF PRIORITY.

Where one party to an interference makes a formal concession of priority to his opponent, and a judgment of the Examiner of Interferences is based thereon, such party is estopped from afterward claiming the conceded subject-matter. This decision, however, is made without prejudice to the right of applicant to move to vacate the judgment upon consent of parties, and upon showing that the concession was based upon a mistake of fact.

Eddy, x. p., *Simonds, Com.*, 1 Ap., 1892, 59 O. G., 298.

CONSTRUCTIVE ABANDONMENT.

A broad distinction is to be recognized between constructive abandonment of an application and constructive abandonment of the invention itself; the former may and frequently does exist without involving the latter.

Fowler, x. p., *Mitchell, Com.*, 14 Oct., 1889, 49 O. G., 562.

Compare (2) ABANDONMENT, ETC., and (1), (2), (3), FORFEITURE.

CONSTRUCTIVE DEDICATION.

Nothing is better settled in the law of patents than that the patentee may claim the whole or only a part of his invention, and that if he only claim a part, he is presumed to have abandoned the residue to the public. The object of the law in requiring the patentee to "particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery," is not only to secure to him all to which he is entitled, but to apprise the public of what is still open to *them*. *The claim is the measure of the right to relief*, and, while the specification may be referred to to limit the claim, it can never be made available to expand it (Keystone Bridge Co. *v.* Phœnix Iron Co., 95 U. S., 274, ❁).

McClain *v.* Ortmayer, U. S. S. C. By *Brown, J.*, 2 Nov., 1891, 57 O. G., 1129.❁

CONSTRUCTIVE ELECTION.

1. Estoppel.

Where the Examiner had required a division of the article and the process claims, and thereupon applicant had elected to retain the article claims, and, upon their rejection, sought to re-instate the process claims: *Held*, that applicant could not be permitted to re-instate the process claims, notwithstanding the fact that the Examiner's original action was erroneous, and that the two inventions might have been properly included in the same application. Applicant stands bound by his election.

Jameson, x. p., *Fisher, Act. Com.*, 18 Feb., 1890, C. D. Ms.

2. Where an applicant makes a full assignment of one of two applications, together with a certain inven-

tion common to both applications, he thereby conclusively elects to give the preference to the assigned application, and is estopped from asserting in the unassigned application any claims tenable under the assigned application; and it follows that the assignee is entitled to prosecute the assigned application precisely as if the other application had never been filed.

McLaughlin, x. p., *Mitchell, Com.*, 30 Jan., 1891, C. D. Ms.

Compare Curran *et al. v.* Birdsall, (10), and Adee *v.* Thomas, (11), ASSIGNMENT.

CONSTRUCTIVE LICENSE.

1. Construction, at expense of employer and with the assent of employé, of a machine embodying the invention of the latter, becomes a *Constructive License* to the former to use that particular machine.

In a case where A, while in the employ of B, constructed, at B's expense and for B's use, a machine for which A afterward secured a patent; B is entitled to the use of that particular machine without liability to A, notwithstanding the grant to A of such patent.

Dable Grain Shovel Co. *v.* Flint *et al.*, *Blodgett, J.*, 31 Mar., 1890, 52 O. G., 1537.

2. Where, in a suit for infringement, it appeared that the alleged infringing machines were constructed and put in use in the defendants' grain-elevators by the inventor himself, and with his knowledge and consent, while he was in their employ as superintendent of machinery and before his application for either patent in suit: *Held*, that, according to the expressed terms of the statute, defendants had a right to use these specific machines without paying any compensation to him or his assigns, whether asked for or not.

Ib.

NOTE. — The statute above referred to is as follows : —

Every person who purchases of the inventor or discoverer, or, with his knowledge and consent, constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor.

Sec. 4899 R. S.

See also Kendall *v.* Winsor, (3) *infra*, ❁ ; Sargent *v.* Seagrave, 2 Curt. C. C.; Root *v.* Ball & Davis, 4 M'Lean, 177.

3. If the defendants had these machines constructed before the plaintiff's application for his letters patent, under the belief, authorized by him, that he consented and allowed them to do so, then they might lawfully continue to use the same after the date of plaintiff's letters-patent and the plaintiff would not recover in this action.

Kendall *v.* Winsor, U. S. S. C. By *Daniel, J.*, Dec. Term, 1858, 21 Howard, 322, ❁.

NOTE. — That the right to use those specific machines did not imply a right to use other like machines without authority from the patentee. See Vt. F'm Mach. Co. *v.* Gibson (5), *infra*.

4. Where the inventor of a self-cancelling stamp was in the employ of the Government, and notified the Government that he would make no charge [for Governmental use of the invention], if the Government adopted his recommendation and used his stamp, — for the express reason that he was in the Government employ and had used the Government machinery in perfecting his invention, and that he had never proposed, personally, to make any charge against the Government : *Held*, that his subsequent assignee could not recover [for such Governmental use].

Solomons *v.* U. S., U. S. C. Claims. By *Brewer, J.*, 8 Dec., 1890, 34 L. ed., 667.

5. The constructive license implied in the purchase from the patentee of a creamery with cans for raising cream by his process (practised by water-sealing the cans), gives the purchaser no right to practise the process by water-sealing *other* cans purchased from a different manufacturer.

Vt. F'm. Mach. Co. *v.* Gibson, *Wheeler, J.*, 46 F. R., 488.

CONSTRUCTIVE REDUCTION TO PRACTICE.

1. A patent is conclusive evidence that, in the judgment of the Office, the device claimed has passed beyond the region of experiment, and has been reduced to the practicable and useful form of a perfected invention.

Murrill *v.* Chenoweth *v.* Wheeler, *Fisher, Com.*, 4 July, 1869, C. D. 43.

See also, Duchemin *v.* Richardson, 1870, C. D. 31; Richardson *v.* Denza, 1870, C. D. 156; and Starr & Peyton *v.* Farmer, 23 O. G., 2325.

2. The doctrine that the senior applicant's application for patent clearly describing and claiming the invention is to be regarded as the legal equivalent of the reduction to practice of a completed invention, — applied as being established.

Lowe *v.* Springer *v.* Morse *v.* Granger, *Mitchell, Com.*, 9 Nov., 1889, C. D. Ms.

3. An application which eventuates in a patent constitutes a presumptive reduction to practice. In a contest for priority of invention, the presumption referred to is conclusive against all the parties to the proceeding, because each one is, by the fact of his making a claim to the improvement in dispute, estopped from denying its operativeness and completeness (Heath *v.* Hildreth, McA. Pat. Cas., 12).

Hunter *v.* Jenkin, *Simonds, Com.*, 12 Sep., 1891, 56 O. G., 1705.

4. The theory upon which Rule 114 proceeds is that the filing of an application, which is pronounced by the experts of the Patent Office to be sufficient to authorize the grant of a patent is, for interference purposes, conclusive evidence of perfected invention by the applicant at or before the filing date (Huntley *v.* Smith, 1880, C. D. 182; Starr & Peyton *v.* Farmer, 1883, C. D. 34; Lorraine *v.* Thurmond, 51 O. G., 1781).

Lindsay *v.* McDonough, *Mitchell, Com.*, 27 May, 1891, 55 O. G., 1402.

NOTE. — *L.*, in his petition, demanded award of priority, on the ground of alleged actual reduction to practice, but he presented no testimony to that effect; and, in fact, neither party presented any testimony. Judgment was, therefore, necessarily awarded in *McD.'s* favor, "*on the record*," as the senior applicant, in accordance with Rules 116 and 117.

5. An application or patent relied upon to establish a constructive reduction to practice must contain a *claim* to the invention.

Searle *v.* Frumveller *v.* Sessions, *Frothingham, Act. Com.*, 18 June, 1892, C. D. Ms.

See BURDEN OF PROOF; PRIORITY OF INVENTION; REDUCTION TO PRACTICE.

CONSTRUING CLAIMS.

1. Fair Interpretation.

A claim passed to issue by the Patent Office and acquiesced in by the patentee should not be enlarged by construction beyond the fair interpretation of its terms.

Haines *v.* McLaughlin, U. S. S. C. By *Fuller, Ch. J.*, 19 May, 1890, 34 L. ed., 290, ✱.

Compare, to same purport, Sargent *v.* Hall Safe & Lock Co., ✱, (13) PUBLIC RIGHTS AND OBLIGATIONS.

2. The claims of a patent must, wherever possible, be so construed as to uphold the patent; and, though their language may be faulty in including results as well as devices, yet, where the specific devices are set out in the drawings and specifications, the claims will be construed as for the devices there shown.

Robbins *v.* Aurora Watch Co., U. S. C. C. N. D. Ill., *Blodgett, J.*, 43 F. R., 521.

Compare, of same purport, Corning *v.* Burden, ✿, (48), and McClain *v.* Ortmayer, ✿, (69), THE CLAIM.

3. State of the Art.

Claims of patents should receive such interpretation (whether broad or restricted) as to cover the actual invention when not absolutely inconsistent with the language used by the patentee (Winans *v.* Denmead, 15 Howard, 330, ✿; Van Martyr *v.* Miller, 15 Blatchford, 562). If, upon one hand, the state of the art shows the invention to have been a narrow one, a strict interpretation will be given to the claims (M'f'g Co. *v.* Ladd, 102 U. S., 408, ✿), and *it is of no practical consequence whether such restrictions were imposed by the Patent Office or not* (Toepfer *v.* Goetz, *Blodgett, J.*, 5 July, 1887, 41 O. G., 933). If, upon the other hand, the patentee has taken a decided step in advance of the state of the art at the time his application was filed, courts will, if possible, so construe the language of his claim as to give him the full benefit of his discovery (Turril *v.* R. R. Co., 1 Wallace, 491, ✿; Rubber Co. *v.* Goodyear, 9 Wallace, 788, ✿).

The Consol. Roller Mill Co. *v.* Coombs, *Brown, J.*, 20 May, 1889, 48 O. G., 255.

Of same purport, compare (29) *et seq.* THE CLAIM.

CONSUMMATED INVENTION.

The consummated invention takes date at the point where the work of the inventor ceases and the work of the mechanic begins.

It may still need much patience and mechanical skill, and perhaps a long series of experiments, to give the conception birth in a useful working form. The true date of the [consummated] invention is at the point where the work of the inventor ceases and the work of the mechanic begins. Up to that point he was inventing, but had not *invented*, and he must have invented before the law will come to his protection.

Cameron *v.* Brick, *Leggett, Com.*, 1 Ap., 1871, C. D. 89.

See REDUCTION TO PRACTICE.

Compare Smith *v.* Dent. Vulc. Co., (1), Consol. Valve Co. *v.* Crosby Valve Co., (2), THE DECISIVE STEP. See also Goodyear *v.* Day, (133) INTERFERENCES.

See THE DECISIVE STEP; INVENTION; INVENTIVE ACTS; REDUCTION TO PRACTICE.

CO-OPERATION OF PARTS.

"Co-operation," in the Sense of the Patent Law,—Defined.

The simultaneous co-operation of the parts is not essential to a patentable combination if the parts are so arranged that the *successive* action of each *contributes* to produce some one practical result; this result, when attained, may be the product either of the simultaneous or of the successive action of all the elementary parts viewed as one entire whole. The term "co-operation" does not necessarily mean acting together or simultaneously, but it means acting unitedly to a common end.

Holmes Burg. Al. Tel. Co. *v.* Domestic Tel. Co., *Wales, J.*, 12 Ap., 1890, 51 O. G., 2083.

COTEMPORARY APPLICATIONS WHICH CONTAIN IDENTICAL SUBJECT-MATTER.

Where two applications are before the Office at the same time from the same applicant, which embrace the same subject-matter, it should not be required of the applicant that he abandon one application before claims can be allowed on the other; nor should the Examiner require erasure of claims which would be allowed if no other application awaited consideration (following Langlois, x. p., 14 O. G., 84, and Gabouri, x. p., 37 O. G., 217; and distinguished from Smith, x. p., 44 O. G., 1183).

Feister, x. p., *Mitchell*, *Com.*, 31 Oct., 1890, 53 O. G., 1089.

See Smith, x. p., (11), Langlois, x. p., (12), and Gabouri, x. p., (13), EXAMINATION.

CREATION OF AN ART.

In the inauguration of a new art, both discovery and invention, in the popular sense of these terms, may be involved, — discovery in conceiving the art, and invention in devising the means to make it useful.

What Bell claims, in his patent of March 7, 1876, is the ART of creating changes of intensity in a continuous current of electricity exactly corresponding to the changes in density in the air caused by the vibrations which accompany vocal or other sounds, and of using that electrical condition thus created for sending and receiving articulate speech telegraphically. This claim is not in opposition to the decision in Reilly *v.* Morse (15 How., 62), but is sustained by it; as Bell's claim is not for the use of a current of electricity in its natural state as it comes from the battery, but for putting a continuous current in a closed circuit into a certain specific condition suited to the transmission of vocal and other sounds, and using it in that condition for that

purpose. In doing this both discovery and invention, in the popular sense of these terms, were involved, — discovery in finding the art, and invention in devising the means to make it useful. A patent for the art does not necessarily involve a patent for the particular means for doing it, and the mention of means in the specification is only necessary to show that the art can be used to advantage. Bell's invention comprised: —

1. The *method* of transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations similar in form to the vibrations of the air accompanying the said sounds, substantially as set forth.

2. The *apparatus* for transmitting vocal or other sounds telegraphically, as described, by causing electrical undulations, substantially as set forth.

Dolbear *et al. v.* American Bell Telephone Co., U. S. S. C. By *Waite, Ch. J.*, 19 Mar., 1888, 43 O. G., 377, ❋.

CREATIVE WORK OF THE INVENTIVE FACULTY.

With reference to Dennis C. Gately's invention of a vulcanized packing, the Supreme Court (speaking by Mr. Justice Blatchford) said: —

Within the requirements of Atlantic W'ks *v.* Brady (107 U. S., 192, ❋), we think that Gately made a substantial discovery or invention, which added to our knowledge and made a step in advance in the useful arts; and that, within the case of Hollister *v.* Benedict M'f'g Co. (113 U. S., 59, ❋), what Gately did was not *merely* the work of a skilled mechanic, who, perceiving the reason of the failure of McBurney's packing, supplied what was obviously wanting, and that the present case involves, not simply the display of the expected skill of the calling, requiring only the exercise of the ordinary faculties of reasoning upon the materials supplied by a special knowledge and the facility of manipulation which results from its habitual and intelligent practice, — but shows *the creative work of the inventive faculty.*

That the Gately packing went at once into general use, so as almost to supersede all packings made under other methods, was pregnant evidence of its novelty, value, and usefulness (Smith *v.* Goodyear Dental Vulc. Co., 93 U. S., 486, ❁; Loom Co. *v.* Higgins, 105 U. S., 580, ❁). It may also be added that the Gately packing was put upon the market at a price from fifteen to twenty per cent higher than the old packings, although it cost ten per cent less to produce it.

McGowan *et al. v.* N. Y. Belting and Packing Co., U. S. S. C. By *Blatchford, J.*, 26 Oct., 1891, 57 O. G., 845, ❁.

See Scott *v.* Ford, (80) THE CLAIM, and (1) *et seq.* UTILITY.

CROSS-EXAMINATION.

Waives Objection.

Attorney for C. — after having caused to be entered on the testimony-record, a protest against certain witnesses produced on behalf of H. and that any cross-examination would be under said protest, and that he reserved the right to demand expungement of their entire testimony — proceeded to cross-examine said witnesses. *Held*, that said *cross-examination constituted a waiver of the objection*, and that the Examiners-in-Chief did not err in refusing to strike out the testimony (Rule 154).

Creteau *v.* Hall, *Frothingham, Act. Com.*, 17 Nov., 1891, C. D. Ms.

Compare Shapleigh *v.* Chester, (1) TESTIMONY.

CROSS-REFERENCES.

1. In case of a mere improvement, the specification must particularly point out the parts to which the improvement relates, and must, by explicit language, distinguish between what is old and what is claimed as

new; and the description and the drawings, as well as the claims, should be confined to the specific improvement and such parts as necessarily co-operate with it. When applicant files two or more applications relating to the same subject-matter of invention, all showing, but only one claiming the same thing, the applications not claiming it must contain references to the applications claiming it.

P. O. R., 36 and 43.

2. Reference, in the specification of one application to a cotemporary pending application for a fuller description, is not permissible. *It cannot be assumed* that the application referred to will mature into a patent.

Borgfeldt, x. p., *Mitchell, Com.*, 23 Sep., 1889, 49 O. G., 132.

3. A reference to another pending application for a description of the machine to which the present improvement relates, does not satisfy Rule 36. Applications pending in the Office are no part of the prior art, and may not be resorted to in order to supplement a description which would otherwise be insufficient.

Chadwick, x. p., *Mitchell, Com.*, 12 Feb., 1890, 57 O. G., 124.

Compare Fowler, x. p., (1) ABANDONED APPLICATION.

DAMAGES.

1. The amount of fee which plaintiff customarily collects from his licensees may be the measure of damages against an infringer.

When the sale of a license by a patentee has been sufficient to establish a price for such licenses, that price should be the measure of his damages against an infringer; but a royalty or a license fee, to be binding on

a stranger to the licenses which established it, must be uniform.

Westcott *v.* Rude, *Woods, J.*, 1 Ap., 1884, 27 O. G., 719.

2. Fees exacted under a qualified license are not a suitable criterion for assessment of damages against an infringer.

Agreements made to secure the manufacture and introduction of a patented machine are not to be considered as unqualified licenses fixing a royalty or license fee, which can be accepted as establishing within the language of the court in Seymour *v.* McCormick (16 How. 480, ❁) the average of actual damages sustained by a patentee when his invention is used without license.

Graham *v.* Geneva M'f'g Co., *Dyer, J.*, 10 May, 1885, 32 O. G., 1603.

3. In cases of *wilful* infringement, respondent should be held to the most rigid accountability, and the measure of damages may be the profits which would have accrued to the complainants upon the quantity of goods sold by respondent.

Bigelow Carpet Co. *v.* Dobson, *McKennan, J.*, 27 Jan., 1882, 21 O. G., 1200.

4. While a license fee affords proper guidance in the ascertainment of damages, yet regard should be had also to the qualifying circumstances of the case, to the end that the finding may be for the *actual damages* sustained by the plaintiff agreeably to the principles announced by the Supreme Court in Birdsall *v.* Coolidge (93 U. S., 64, ❁).

Keller *v.* Stolzenbaugh, U. S. C. C. W. D. Pa., 43 F. R., 378.

DATE OF ISSUE.

As a U. S. Patent, to be valid, must issue not later than six months from allowance (Rev. Stat., 4885, 4935) and as preparations for printing the drawing and specification do not take place until receipt of the final fee, payment thereof should be made at least three weeks before the expiration of said six months. The Office will, it is true, on receipt of fee any time within six months after allowance, but too late for issue within the six months, save the application from forfeiture by a new letter of allowance, but it is manifestly desirable to avoid this added complication, with its chances of oversight and error.

See P. O. R., 167.

DECEASE OF INVENTOR.

1. Prosecution of Decedent's Application.

The general law governing prosecution of the case of a deceased person is seen in the following section: —

When either of the parties . . . in any suit in any court of the United States dies before final judgment, the Executor (or Administrator) of such deceased party may (in case the cause of action survives by law) prosecute or defend such suit to final judgment.

Sec. 955 R. S.

2. The application of the law to Patent Office procedures is seen in the following Section of the Revised Statutes and Patent Office Rule: —

When any person, having made any new invention or discovery for which a patent might have been granted, dies before the patent is granted, the right of applying for and obtaining the patent shall devolve on his Executor (or Administrator) in trust for the heirs, . . . and when the application is made

by such legal representative, the oath or affirmation required to be made shall be varied in form so that it can be made by such representative.

Sec. 4896 R. S.

Rubber Co. *v.* Goodyear, 9 Wallace, 788, ✽.

In case of the death of the inventor, the application will be made by, and the patent will issue to, his Executor (or Administrator). In such case the oath required by Rule 46 will be made by the Executor (or Administrator). In case of the death of the inventor during the time intervening between the filing of his application and the granting of a patent thereon, the letters patent will issue to the Executor (or Administrator) upon proper intervention by him.

Rule 25, — as amended 23 Jan., 1893.

See De La Vergne *v.* Featherstone, (11) THE PATENT.

NOTE. — Proper evidence of the executorship (or administratorship) must, of course, be filed in the case.

3. Where the record shows that, at the time of applicant's decease, there was a conveyance of the entire interest, the right to prosecute the application and to receive the patent devolves on the assignee.

Sec. 4895 R. S.

Rule 26. — N. W. Fire Extin'r Co. *et al. v.* Phil. Fire Extin'r Co. *McKennan, J.*, Ap., 1880, 6 O. G., 34; Galer *v.* Wilder, 10 Howard, 477, ✽. *Re* Samuel J. Murray, (1), Wirth, (2), ASSIGNEE; Davis, x. p., (6) ATTORNEY.

4. In case of a joint (or of a partially assigned) application there is a joinder, both of powers and interests, between the surviving applicant (or the assignee) on his own behalf, and the executor (or administrator) on behalf of the decedent's estate.

Rules 26 and 28.

Hunter, x. p., (4), Waterman *v.* Mackenzie, (5), and Whitcomb *v.* Coal Co., (6), ASSIGNEE.

THE DECISIVE STEP.

1. Patentability conferred by the Final and Perfecting Step. — Test of Public Adoption.

We do not say that the single fact that the device has gone into general use and has displaced other devices which had previously been employed for analogous uses, establishes in all cases that the device involves a patentable invention. Such a fact may, however, always be considered, and when other facts in the case leave the question in doubt, it is sufficient to turn the scale (McGowan *v.* N. Y. Belting Co., 141 U. S., 332, 57 O. G., 845, ✽.

Smith *v.* Dental Vulc. Co., U. S. S. C. By *Strong, J.*, 8 Jan., 1877, 93 U. S., 486, ✽.

2. Richardson's invention brought to a success what other inventors had essayed and partly accomplished. He used, it is true, some things which had been used before, but he added *just that* which was necessary to make the whole a practically valuable and economical apparatus. The fact that the known valves were not used, and that Richardson's valves were speedily and extensively adopted, are facts in harmony with the evidence that his valve contained just what the prior valves lacked, and go to support the conclusion at which we have arrived on the question of patentable novelty.

Consol. Valve Co. *v.* Crosby Valve Co., U. S. S. C. By *Blatchford, J.*, 19 Jan., 1885, 113 U. S., 157; 30 O. G., 991, ✽.

Compare Scott *v.* Ford, (80) CLAIM; Cameron *v.* Brick, CONSUMMATED INVENTION; McGowan *v.* N. Y. Belting Co., CREATIVE WORK OF THE INVENTIVE FACULTY; Bruce *v.* Marder, (1), and Washburn & Moen Co. *v.* Barbed Wire Co., (12), UTILITY.

DECREE OF COURT.

1. Sections 629 and 4915 R. S.

The section (4915 R. S.) under consideration having but a single object, namely, to provide a way by which an unsuccessful [but meritorious] applicant may obtain the patent through an adjudication in favor of his right thereto by a Court of Equity having cognizance of the subject-matter, and as the object of the section is single, so is the power of the court plainly limited under it to the accomplishment of that object. The prayer of a bill of complaint exhibited to the Court under and by virtue of this section, would be for a decree that the complainant has established his right to have the patent issue to him. So far may the Court go, but no farther. The Commissioner of Patents, not being an inhabitant of this judicial district (New Jersey), cannot (under Sec. 629 R. S.) be brought within its jurisdiction.

Illingworth *v.* Atha, U. S. C. C., N. J., *Green, J.*, 25 Mar., 1890, 42 F. R., 141.

See, of like purport, Butterworth *v.* Hill, (13) JURISDICTION.

2. Where patent had been refused by the Patent Office, and applicant availed himself of his remedy by bill in equity, and the Court, after notice to adverse parties and other due proceedings, had, having adjudged that the applicant was entitled to a patent for his invention, and the applicant having filed in the Patent Office a copy of the adjudication in which were specified the claims for which it authorized the Commissioner to grant a patent: *Ordered*, that, in accordance with Section 4915 R. S., a patent be issued to the applicant for his invention as specified in his claims, upon his complying with the requirements of the law.

Daniels, x. p., *Mitchell, Com.*, 10 Jan., 1891, 54 O. G., 1113.

NOTE (i). — The patent to Daniels, above referred to, was issued in obedience to a decree of the United States Circuit Court for the District of Massachusetts. Daniels' application had been in interference with an application of one Morgan, and, after issue of the patent to Daniels, Morgan's attorney filed an appeal to the Supreme Court of the United States. At the time of going to press this appeal had not reached a hearing.

NOTE (ii). — The case of Daniels, x. p., will be seen to differ from such as that of Butterworth *v.* Hill, ✱, (13) JURISDICTION, and that of Illingworth *v.* Allen, (1) *supra*, in that the Commissioner was not made by the complainant (Daniels) a party defendant to the suit. In Daniels' case the Commissioner, in putting Daniels' application in train for issue, as directed by the Court, acted in a simply ministerial capacity.

Compare Daniels *v.* Morgan, (4) JURISDICTION.

DEDICATION.

1. By Showing and Describing without Claiming.

An inventor cannot, in a subsequent patent, claim matter that was shown and described, but not claimed, in an earlier patent.

Hill & Prentice, x. p., *Marble, Com.*, 26 Ap., 1883, 24 O. G., 1176.

NOTE. — For important qualifications of the above general rule see Suffolk Co. *v.* Hayden, ✱, (6) *infra*, which permits such matter to be claimed in a later patent, providing: (i) the application therefor was filed before issue of the earlier patent, and (ii) providing the earlier patent contain an express reservation of such claim or claims for such later patent. In Scott, x. p., (12) ABANDONMENT, it was ruled that such claim may be included in a later patent *if promptly applied for*, even in the absence of express reservation in the earlier patent.

In Johnston, x. p., (2), and likewise in Mullen & Mullen, x. p., (3) *infra*, it was held that a claim to matter which had been shown or described, but neither claimed nor reserved in the earlier patent, would hold good *if for a totally distinct invention* from that claimed in the earlier patent. The general rule laid down in Hill *v.* Prentice seems qualified in still another aspect by the dictum of Commissioner Simonds in Rogers, x. p., (2) PRIOR ART, which held the Examiner to have been "in error in citing a former patent of the same applicant as a part of the prior art." The ruling of the same Commissioner in the case of Scott, *supra*, and that of Rennyson *v.* Merritt, (5) *infra*, would seem to imply that the requirement of incorporation in one application of a claim to a feature described but not claimed in a cotemporary application is directory only, and that the inadvertent omission so to do is not necessarily fatal, providing application be made promptly and in good faith and before conflicting rights have intervened. For instructive commentary on the distinction between reserved and dedicated rights, see ruling of Commissioner Mitchell in Stanford, x. p., RESERVATION, — DESIGNATION.

2. A patentee who in a prior patent showed, but did not claim, a certain invention which is distinct and separate from that claimed in said patent, and which could not have been prosecuted in that application, did not thereby necessarily dedicate that invention to the public.

Johnston, x. p., *Hall, Com.*, 20 Mar., 1889, C. D. Ms.

3. An invention — absolutely independent of that claimed in the patent — which was described and shown in the specification, but was not [expressly] reserved for claim in either a concurrent or a subsequent application, was not thereby dedicated to the public. For example; a prior patent granted to applicant for certain details in the feed-regulating mechanism of a grain-drill, *Held* to be no bar to a subsequent application for patent for an

improvement in grain-drill teeth which said prior patent disclosed but did not claim. The two inventions being independent, there was no dedication of the improvement from failure to claim it in the prior patent.

Mullen & Mullen, x. p., *Mitchell, Com.*, 28 June., 1890, 50 O. G., 637.

4. It must be remembered that the claim [by the patentee] of a specific device or combination and an omission to claim other devices or combinations apparent on the face of the patent, imply an admission that the latter are not his invention, or constitute a dedication of them to the public. This legal effect of the patent cannot be revoked unless the patentee promptly surrenders it, and proves that the specification was so framed by real inadvertence, accident, or mistake, and without any fraudulent or deceptive intention on his part. If two years' public enjoyment of an invention with the consent and allowance of the inventor is evidence of abandonment and a bar to application for a patent, a public disclaimer [disclaimer by implication] in the patent itself should be construed equally favorable to the public.

Edward Miller & Co. *v.* The Bridgeport Brass Co., U. S. S. C. By *Bradley, J.*, 9 Jan., 1882, 21 O. G., 201, ✽.

5. Where an applicant claims an improvement which is shown but not claimed in his prior patent, and the application was pending before the patent issued, the Office is not justified by existing court decisions in finding that the disclosure in the patent bars the claim in the application (Thomson *v.* Waterhouse, 30 O. G., 177).

Rennyson *v.* Merritt, *Simonds, Com.*, 29 Feb., 1892, 58 O. G., 1415.

6. Where a party, having made application for patent for certain improvements, afterwards, with his claim still on file, makes application for another but distinct

improvement in the same branch of art, in which second application he describes the former improvement, but does not in said second application claim it as original: the description in said second application and non-claim of it there is not a dedication of the first invention to the public. Judgment for complainant affirmed.

The Suffolk Co. *v.* Hayden, U. S. S. C. By *Nelson, J.*, Dec., 1865, 3 Wallace, 315, ❁.

DEFAULT.

Where, upon appeal from the denial of a motion to dissolve, and where neither party appeared at the hearing or filed a brief: *Held*, that it could not be expected that, with the limited time at his disposal, the Commissioner should investigate the intricate questions involved, with no assistance whatever from the parties or their counsel, and the decision of the Primary Examiner was therefore affirmed.

Jones *v.* Collins, *Mitchell, Com.*, 21 Jan., 1891, C. D. Ms.

DEFECTIVE PATENT.

A document issued by the Commissioner of Patents in the form and guise of a patent, but which lacked the signature of the Secretary of the Interior (by whom, or by his assistant in his absence, all patents must be signed), is *no patent* and without legal force, and, even if the defect be subsequently cured, cannot act retrospectively, but becomes effective only from the date of correction. Thus limited, such patent is in harmony with the law relating to re-issues which allows the inventor, upon surrender of his patent with a defective specification, to have a new patent for the remainder of his term.

Marsh *v.* Nichols, U. S. S. C. By *Field, J.*, 10 Dec., 1888, 46 O. G., 239, ❁.

Compare Marsh *v.* Sheppard, U. S. S. C. By *Field, J.*, 10 Dec., 1888, 128 U. S. 605, ❁.

DEFECTIVE PRINCIPLE.

A wide distinction is to be recognized between a machine defective by fault of principle and one defective by fault of construction or proportions. From the former, a subsequent successful machine is patentably different; while a machine defective only in structure or proportions may be, and often is, identical in a patentable sense, in plan, mode of operation, and function, with the subsequent practical device.

Gosline *v.* Barney, *Mitchell, Com.*, 9 Nov., 1889, C. D. Ms.

DELAY.

1. In Filing Amendment.

Where the Office had called the attention of an applicant to his right to cover in his claim certain specific matter, and advised him to amend accordingly, and the applicant, without doing so, entered into an interference contest on the broad issue, in which he was finally defeated, he cannot, after acquiescing for a long period in such award of priority and waiting nearly ten years after filing his application, return to the Office for the purpose of submitting such amendment, which, if admitted, would result in a new interference.

Gray, x. p., *Hall, Com.*, 23 Feb., 1889, 46 O. G., 1277.
Compare Spielman, x. p., (22) INTERFERENCES.

2. Where an amendment touching "the merits" is presented nearly two years after the case is in condition for appeal to the Examiners-in-Chief, and no showing or attempt at any showing whatever is made why the amendment was not presented earlier: a petition that the case be re-opened and that applicant be heard upon the amendment must be denied.

Cordrey, x. p., *Mitchell, Com.*, 6 July, 1889, 48 O. G., 397.

3. In Reduction to Practice.

Failure for more than two years after conception to do anything to reduce the invention to practice could not be excused where the only reason assigned for the inaction was engagement in other matters.

Lowe *v.* Springer *v.* Morse *v.* Granger, *Mitchell, Com.*, 9 Nov., 1889, C. D. Ms.

Of like tenor, see Ligowski *v.* Peters *v.* Hisey, (50), Hunter *v.* Jenkin, (53), and Thomson *v.* Ries, (55), INTERFERENCES.

4. Motion to amend a preliminary statement after a delay of four months and a half, — denied.

Gornall *v.* Lovejoy, *Simonds, Com.*, 12 Aug., 1891, 56 O. G., 927.

Compare Wood *v.* Parsons, (29) INTERFERENCES.

DELIBERATION.

1. Postponement of application to gain time for actual test of and for careful specification of the invention, — commended.

It is undeniably true that the limited and temporary monopoly granted to inventors was never designed for their exclusive profit or advantage: *the benefit to the public or community at large* was another, and, doubtless, *the primary object* in granting and securing that monopoly. This was, at once, the equivalent given by the public for the benefits bestowed by the genius, meditations, and skill of individuals, and the incentive to further efforts for the same important objects.

But the relations borne to the public by inventors, and the obligations they are bound to fulfil in order to secure from the former protection and the right to remuneration, by no means forbid a delay requisite for completing an invention, or for a test of its value or

success by a series of sufficient and practical experiments; nor do they forbid a discreet and reasonable forbearance to proclaim the theory or operation of a discovery during its progress to completion, and preceding an application for protection in that discovery: the former may be highly advantageous as tending to a perfection of the invention; the latter may be indispensable in order to prevent a piracy of the rights of the true inventor.

Kendall *et al. v.* Winsor, U. S. S. C. By *Daniel, J.*, Dec., 1858, 21 Howard, 322, ✽.

2. Forbearance to apply for a patent during the progress of experiments and until the party has perfected his invention and tested its value by practical experiment, affords no ground for presumption of abandonment.

Agawam Co. *v.* Jordan, U. S. S. C. By *Clifford, J.*, Dec., 1869, 7 Wallace, 583, ✽.

3. A use by the inventor [more than two years prior to application] for the purpose of testing the machine, in order, by experiment, to devise additional means for perfecting the success of its operation, is admissible; and even where, as incident to such use, the product of its operation is disposed of by sale, such profit from it does not change its character.

Smith & Griggs M'f'g Co. *v.* Sprague, U. S. S. C. By *Mathews, J.*, 123 U. S., 249, ✽.

See also City of Elizabeth *v.* The Nicholson Pavement Co., 7 Otto, 126, (4) DEDICATION, ✽.

DESCRIPTION.

See DISCLOSURE; THE SPECIFICATION.

DESCRIPTIVE CHARACTERS.

1. The different views on the drawing of a U. S. patent should be consecutively numbered. Letters and figures of reference are required to be carefully formed. They should, if possible, measure $\frac{1}{8}$ inch in height (so that they may bear reduction in the Official Gazette to $\frac{1}{2}\frac{1}{4}$ inch), and they may be much larger when there is sufficient room. They must be so placed in the close and complex parts of drawings as not to interfere with a thorough comprehension of the same, and therefore should rarely cross or intermingle with lines. When necessarily grouped around a certain part, they should be placed at a little distance, where there is available space, and be connected by short broken lines with the parts to which they refer. They must never appear upon shaded surfaces, and, when it is difficult to avoid this, a blank space must be left in the shading where the letter occurs. The same part or member appearing in different views must always be represented by the same character, and the same character must never be used to designate different parts.

P. O. R., 51 (6).

2. The parts must be sufficiently designated by letters or other symbols, to convey a clear comprehension of the device.

Brogfeldt, x. p., *Mitchell*, *Com.*, 23 Sept., 1889, 49 O. G., 132.

3. Present Rule 51 prohibits the use of the same reference symbol (letter or numeral) to designate parts which, although claimed to be equivalents, are, nevertheless, different in structure. If alternative constructions or modifications are shown, a permissible method is to employ the same letter with an appended figure or exponent, — as A, A′, A″, A‴, — thereby conforming to

the rule and at the same time suggesting the presence of similarity and the absence of sameness.

Cook, x. p., *Mitchell, Com.*, 12 Ap., 1890, 51 O. G., 1620.

4. Where "an inverted **V**" [**Λ**] was used to designate a form involved in the application, and the Examiner required descriptive language instead of it: *Held*, that a valid objection to such a character could be raised only on one of two grounds, —(i) that it was not descriptive in such full, clear, and exact terms as to enable any one skilled in the art to construct the form from it (R. S., 4888), or (ii) that it cannot be properly represented in the specification by the ordinary resources of the printer; and that, as the character was an exact representation of the shape in question and could be readily printed, the position of the Examiner could not be sustained.

Krueger, x. p., *Fisher, Act. Com.*, 12 May, 1890, C. D. Ms.

5. Upon requirement of the Examiner that modified forms of certain bars should be designated by different reference letters: *Held*, that as the difference was not one of kind, but only of degree, it did not require different reference letters (Kook, x. p., 1879, C. D. 202; Emanuel, x.p., C. D. 40, Ms. 240; Wilcox, x. p., C. D. 44, Ms. 428).

Wiles & Wendell, *Frothingham, Act. Com.*, 15 Feb., 1892, C. D. Ms.

6. Rule 51 (6) is imperative that if more than one view is presented of a given article, the corresponding portions of the different figures must always be represented by the same character; but it does not require a diverse lettering of such parts or members which vary only in respect of connecting or attaching devices, which latter, so far as they differ in the different figures, are

also lettered differently. I have in this case undertaken to apply the distinctions recognized in Kook *et al.*, x. p., (1879, C. D. 202) between modifications that disclose patentable differences and modifications that disclose differences not patentable. The difficulty of doing so is recognized and is very apparent; but the rule of distinction is in that case clearly laid down, and should be applied in similar cases.

Wilcox, x. p., *Mitchell, Com.*, 21 Nov., 1890, C. D. Ms.

7. Such details as the shading of the drawing and the place and size of the reference letters, belong to the province of the Draftsman rather than the Examiner; but if they are such as to obscure the parts and thus render examination troublesome, the Examiner has a right to insist upon a correction.

Heidbrink, x. p., *Fisher, Act. Com.*, 8 Ap., 1890, C. D. Ms.

See THE DRAWING.

DEVIATION.

In reducing his patent to a practical application, a patentee is not held to follow, strictly and entirely, the mere mechanical device shown in his drawings, but he may deviate as long as he does not violate the principle involved in his patent.

Weir *v.* N. Chic. Rolling Mill Co., *Blodgett, J.*, Oct., 1880, 23 O. G., 191.

See also Hill & Prentice, x. p., *Marble, Com.*, 26 Ap., 1883, 24 O. G., 1176.

DICTUM.

Upon an application for label registration, the Examiner of trade-mark and label applications has to decide only the question whether or not the matter presented to him is registrable as a label; and any opinion which he may express as to the propriety of covering the mat-

ter by a mechanical application is purely *dictum*, and cannot bind the Examiner before whom comes the question of patentability in regular order.

Eiche, x. p., *Fisher*, *Act. Com.*, 26 Oct., 1889, C. D. Ms.

DISCOVERY.

A court in equity has the inherent power, on motion of the complainant, to grant him an order of inspection of the apparatus in possession of the defendant which is alleged to embody the invention in controversy, to the end that the complainant may be enabled to adduce evidence in support of the allegations of his bill.

Wilson *v.* Keely, Phil'a Court of Common Pleas, *Finletter*, *J.*, 16 Mar., 1888, 43 O. G., 511.

DILATORY METHODS.

1. By Examiner.

While the recommendations of the Examiners-in-Chief are not binding upon the Primary Examiner, there is, nevertheless, no good reason why an applicant should be put to the delay of a second appeal simply to have the Examiners-in-Chief formally affirm what they have already decided in substance.

Williamson, x. p., *Simonds*, *Com.*, 20 Aug., 1891, 56 O. G., 1060.

NOTE. — The Primary Examiner was directed to allow the application as amended in conformity with the recommendation of the Examiners-in-Chief; with permission to note on the record that his said action was made in compliance with a mandate of the Commissioner based upon said recommendation.

Of like tenor, see Donavan, x. p., (1) EXAMINATION; and Anderson, x. p., (2) EXAMINER.

2. By an Applicant. — Dilatory Tactics.

Petition for suspension of an interference, in order that the question of patentability of a newly offered claim might be considered, denied; it appearing that the same interference had been previously suspended by the same petitioner for nearly two years *for the same ostensible purpose.*

Holt *v.* Mills, *Simonds, Com.*, 19 Aug., 1891, 56 O. G., 1059.

3. To negative abandonment of an application pursuant to provisions of Section 4894, R. S., applicant was required to show, to the satisfaction of the Office: (*i*) that the failure to prosecute within two years from notice of the last action was unavoidable in *each and every part* of this period; (*ii*) that the delay of action, subsequent to the expiration of two years, was also unavoidable. (*iii*) It is a general rule of law that a party is bound by the deliberate acts of his attorney (Robinson, Sec. 435); hence the neglect imputed by applicant to his attorney, even if proven, would not excuse the delay, and therefore the alleged neglect of the attorney in this case did not render the delay unavoidable (Binford, x. p., C. D. 45, Ms. 320; Pratt, x. p., 1887, C. D. 31). It did not appear, from the showing made, that applicant's financial condition *during the whole period of delay* was such as to excuse the failure to prosecute. Petition denied, — without prejudice.

Murray, x. p., *Frothingham, Act. Com.*, 5 June, 1891, 56 O. G., 1060.

4. A petition for revival of an abandoned application should aver facts [which should be established at the hearing] showing that the delay *for the whole period,* from the last official action to the filing of the petition, was unavoidable. Petition was denied, — without prejudice.

Edison, x. p., *Frothingham, Act. Com.*, 17 June, 1891, 56 O. G., 1061.

5. 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. — Petition denied.

Brand, x. p., *Frothingham, Act. Com.*, 18 July, 1891, 56 O. G., 1062.

Compare Donavan, x. p., (10) AMENDMENT; Epstein, x. p., (3) APPLICATION; and Price, x. p., (20) PUBLIC RIGHTS, ETC.

DILIGENCE.

1. Of two or more contestants for patent, questions of diligence affect only the earliest to conceive the nascent invention. A later conceiver has no status unless first to reduce to practice.

No matter what degree of diligence he may have manifested, the second conceiver has not even a *prima-facie* right to the patent unless he was the first to reduce to practice; and if he has anticipated the other in reduction, it is on this ground, and *this only*, that his claims are based. The law regards him with no such indulgence as it does the first conceiver. It takes no notice of the difficulties with which *he* has contended, nor of the efforts which *he* may have made to confer the benefit of the invention on the public. The *fact* that he *has* so conferred is sufficient, *in the absence of reasonable diligence on the part of the prior conceiver*. But earlier reduction avails the second conceiver nothing if the first has properly endeavored to complete [and has, in fact, completed] his own inventive act, and thus fulfilled the obligation which the law imposes upon him. Hence there can be no comparison of diligence as between rival inventors; no "race of diligence" in any sense of a competing effort to obtain a prize.

1 Robinson, 544, and cases there cited.

For evidence of completed invention afforded by application in interference, see Lindsay *v.* McDonough, (4) CONSTRUCTIVE REDUCTION TO PRACTICE.

2. No "Race of Diligence."

Respecting the matter of diligence, as bearing upon the question of priority, I do not regard it as comparative, or as it is sometimes termed a "race of diligence," where one was first to conceive and the other to reduce to practice.

Millward *v.* Barnes, *Spear, Com.*, 13 Mar., 1877, 11 O. G., 1000.

3. If the first person to adequately conceive and disclose an invention actually reduces it to practice, and connects his conception and completion by such diligence as his circumstances and the character of the invention admit of, his right to a patent cannot be defeated by any amount of diligence in coming to the Office of an inventor whose conception is of later date.

Hunter *v.* Miller, *Mitchell, Com.*, 13 Mar., 1890, 50 O. G., 1765.

4. In cases involving priority of invention, it is well settled that the party second to conceive the [nascent] invention does not prevail by virtue of his own diligence, but by reason of the lack of diligence on the part of his competitor in adapting and perfecting the invention (Merwin on Patents of Invention, Sec. 301; Lorraine *v.* Thurmond, 51 O. G., 1781).

Holmes & Holmes *v.* Coler, *Mitchell, Com.*, 21 July, 1890, C. D. Ms.

5. "Reasonable Diligence."

It has been held, in interference contests, that the "reasonable diligence" exacted of the party who was first to conceive, means only that he shall have used such efforts as a careful man would ordinarily use in attending to matters of business. That there was no *intention* to abandon makes no difference, and [for the purposes of the

interference] it makes no difference whether or not a new application is precluded by reason of the subject-matter having been in public use more than two years.

Field, x. p., *Fisher*, *Act. Com.*, 4 Jan., 1890.

NOTE. — Where question of abandonment of the invention by two years' public use arises in course of an interference proceeding, such question is placed in abeyance until after the interference contest is disposed of, upon which it becomes a purely *ex parte* question between the Office and the successful contestant.

Compare Butterfield *v.* Curtis, (18), Hunter, Jr., *v.* Lane, (65), and Cook *v.* Leach, (98), INTERFERENCES.

6. The "reasonable diligence" demanded [from the inventor who establishes first conception] to avoid forfeiture to a rival inventor, is something differing from and greater than that required of the inventor of a completed invention, in order to avoid abandonment to the public. The two things are specifically and differently stated in the statutes.

Thomson *v.* Ries, *Simonds*, *Com.*, 14 Nov., 1891, 59 O. G., 298.

7. A review of all the cases, in connection with the language of the statute, satisfies me that if the first person to conceive would prevail over his rival who has first reduced the invention to practice, he must show: (*i*) that he was using reasonable diligence in adapting and perfecting the invention when his competitor entered the field; (*ii*) that his diligence antedates the inceptive invention of his rival; (*iii*) that his diligence extends back to his own conception.

Christie *v.* Seybold, *Mitchell*, *Com.*, 10 Feb., 1891, 54 O. G., 957.

See also Gray *v.* Hale (9), *infra*.

8. The question of reasonable diligence in any particular case is dependent on various considerations, such as the nature of the invention (City of Elizabeth *v.* The Nicholson Pavement Co., 7 Otto, 126, ❀; Johnson *v.* Root, 2 Cliff. 108; White *v.* Allen, 2 Cliff. 224), and the circumstances of the inventor, etc. (Morse *v.* Clarke, 1 O. G., 275).

Hunter *v.* Miller, *Mitchell, Com.*, 13 Mar., 1890, 50 O. G., 1765.

9. Where there has been delay in application of the first inventor until after a subsequent inventor had reduced and applied, it becomes incumbent upon the former to show persistent intention to apply for patent as promptly as circumstances permitted.

Gray *v.* Hale, *Duncan, Act. Com.*, 27 May, 1871, C. D. 129.

See also Monce *v.* Adams, *Duncan, Act. Com.*, 1 O. G., 2; and Habel *v.* Tucker, *Shipman, J.*, 16 July, 1886, 36 O. G., 939.

10. Where the first to conceive did nothing for nearly two years thereafter, and failed to give a satisfactory reason for not filing his application sooner, and neither party had reduced to actual practice: *Held*, that the one who, although later in the field, had constructively reduced to practice by being the first to apply in due form for a patent was entitled to award of priority.

Bentley *v.* Wightman *v.* Sprague, *Mitchell, Com.*, 19 Mar., 1890, C. D. Ms.

Compare Christie *v.* Seybold, (7) *supra*, and (1) *et seq.* CONSTRUCTIVE REDUCTION.

11. Where there were two interferences between the same parties on applications which described the same subject-matter, and where with each inventor both process and apparatus were necessarily invented together, and consequently there was but one question at issue,—

Thomson's application (14 June, 1889) for a patent on the *apparatus* being put in interference with patent granted to Ries, 14 May, 1889 ; Ries' application (10 Dec., 1888) for a patent on the *process* being put in interference with patent granted to Thomson, 8 Jan., 1889, — Thomson, who was the first to conceive and disclose the incipient idea, and who made the earliest application for patent, suffered fifteen months to elapse before reduction to actual practice, and twenty months before making said application for patent. Ries' actual reduction, ante-dating both the actual and the constructive reduction of Thomson, threw the burden of diligence wholly on the latter as the first conceiver; and Thomson being adjudged not to have employed reasonable diligence, priority was awarded to Ries.

Thomson *v.* Ries, *Simonds, Com.*, 14 Nov., 1891, 59 O. G., 298.

NOTE (i). — The issues were: —

PROCESS INTERFERENCE.	APPARATUS INTERFERENCE.
The herein-described method of riveting, consisting in heating the rivet or rivet-blank electrically while in place, and then heading either or both ends of the same.	An electric riveting apparatus, consisting essentially of a metallic anvil and a metallic heading tool, and a charged electric circuit including the anvil and tool, substantially as described.

NOTE (ii). — The almost equally prolonged tardiness of Ries was not charged against him, because diligence is exacted from the senior inventor only, and therefore Ries, as junior inventor, had simply to establish first reduction. See Christie *v.* Seybold, (7) *supra*, and (1), (2), (3), (4) DILIGENCE.

12. Where an applicant had delayed for more than two years after his conception of invention [in interference] before reducing it to practice, and where it appears that he had abundant means and was busy

meanwhile upon other inventions, and the actual reduction to practice was a simple matter and one not involving great time or expense: *Held*, applicant had not been reasonably diligent.

Ib.

13. Time spent on other inventions does not excuse delay.

Time spent on other inventions does not excuse delay otherwise unreasonable (Wickersham *v.* Singer, 1 *McA. P. C.*, 645).

Hunter *v.* Jenkin, *Simonds, Com.*, 12 Sep., 1891, 56 O. G., 1705.

Compare Barnes *v.* Clinton, (3), and Wicks *v.* Dubois, (4), ABANDONED EXPERIMENTS. See also Thomson *v.* Ries, (12) *supra*, and Wickersham *v.* Singer, (14) *infra*.

14. Circumstances to extenuate Delay.

If a man be utterly destitute of money and without friends, and be incapable thereby of prosecuting an enterprise, much indulgence may be shown him; but where he has the means of carrying on sundry enterprises of a kindred sort, equally demanding money and friends, and does carry them on, his election to pursue those other enterprises will not, under the patent law, be regarded as an excuse for delay where valuable rights of others — equally meritorious with himself, and, in the outset of their successful struggles, equally poor — are to be prejudiced. An election thus made for his supposed advantage or gratification at the time must, according to the plainest principles of equity, not be invoked for the subsequent detriment of another innocent party.

Wickersham *v.* Singer, 1 *McArthur Pat. Cas.* 645.

15. The question whether due diligence was exercised depends in a great degree upon the personal circumstances of the inventor. The rule is well stated in Merwin on Patents, page 697 (see also **Lowe** *v.* Springer *v.* Morse *v.* Granger, 1 Gourick, 84 ; and Illingworth *v.* Atha, *Mitchell, Com.*, 22 Nov., 1889).

Bentley *v.* Wightman *v.* Sprague, *Mitchell, Com.*, 19 Mar., 1890, C. D. Ms.

16. In determining the question of diligence of an inventor first to conceive, the circumstances in which he was placed and the facilities at his command are always to be considered (McCormick Harvester Mach. Co. *v.* Minneapolis Harvester Works, *Nelson, J.*, 42 F. R., 152 ; Hunter *v.* Miller, *Mitchell, Com.*, 50 O. G., 1765).

Brahn *v.* Snow *v.* Hopkins & Bryant, *Fisher, Act. Com.*, 29 Dec., 1890, C. D. Ms.

17. Where, in an affidavit filed under Rule 75, petitioner averred that he had used "every diligence possible in putting the invention into use" : *Held*, that a mere statement of this character, unaccompanied by any facts which tend to show such diligence, is not a sufficient compliance with the rule as interpreted by the Office (Gasser, x. p., 1880, C. D. 94 ; Saunders, x. p., 1883, C. D. 23).

Hunter, x. p., *Fisher, Act. Com.*, 23 Oct., 1889, 49 O. G., 733.

DISCLAIMER.

1. When by inadvertence, accident, or mistake, a patentee has claimed more than that of which he was the first inventor, a disclaimer may be filed, either by the original patentee or by any of his assignees. Fee, $10.

R. S., 4917.

2. Disclaimer available for Elimination only.

A disclaimer under Section 4917 R. S. cannot be used to change the character of the invention. If an amended specification or a supplementary description is required to make a claim altered by disclaimer intelligible or relevant, it may possibly present a case for surrender and re-issue, but it is clearly not adapted to a disclaimer.

Collins Co. *v.* Coes, U. S. S. C. By *Fuller, Ch. J.*, 5 Mar., 1889, 47 O. G., 523, ❁.

DISCLOSURE.

1. An oral explanation was sufficient to establish conception that disclosed an intelligible way of carrying out the invention.

Oral explanation of an invention in interference is sufficient only where the descriptive language used is such as to disclose the invention as a drawing would disclose it. The description on its face, as detailed by the witness, must show, not only that the applicant had a conception of the way of doing it, but a way so definitely thought out and explained that the listener, if skilled in the art, could hav produced the device from the description, at least in a rude form of embodiment.

Wherry *v.* Heck, *Mitchell, Com.*, 14 Oct., 1889, 49 O. G., 559.

Compare Ligowski *v.* Peters *v.* Hisey, *Simonds, Com.*, (2) *infra.*

2. Incipient Invention.

To constitute a disclosure of invention [at the nascent stage] of improvements of a known machine, it is not necessary that sketches made and shown by the inventor should have shown an organized machine. It is sufficient if the invention of the particular improvements was clearly and intelligently made known.

Ligowski *v.* Peters *v.* Hisey, *Simonds, Com.*, 17 Nov., 1891, 57 O. G., 1595.

3. The patent must contain a complete disclosure of *the thing* invented.

There is no doubt that he who has discovered some new element or property of matter may secure to himself the ownership of his discovery as soon as he has been able to illustrate its practicability and to demonstrate its value. His patent, in such case, will be commensurate with the principle it announces to the world, and may be as broad as the mental conception itself; but the mental conception must have been susceptible of embodiment, and must, in fact, *have been embodied* in some mechanical device or in some process or art. The patent must be for a *Thing*, not for an idea merely. It is the adaptation of the materials and forces of Nature to practical use which brings them within the domain of individuals, and it is the novelty of such adaptation that constitutes them the proper subjects of protection by patent. But the contract of the public is not with him who has discovered [even though he may have put his discovery to actual use], but with him who makes his discovery usefully known. If he has discovered much and disclosed little, — if there has been revealed to him one of the arcana of Nature, and he communicates to the world only one or more of its derivative or secondary truths, he patents no more than he has proclaimed. He will not be allowed afterward, when the extent of his right shall be the subject of controversy, — either by expanding into a general expression what was limited before to a particular form, or by tracing out for us the line that leads back from consequence to remote causes, — to initiate us inferentially into the radical mystery of his invention, and then argue that he had described it, by implication, from the first, and so claim ownership of it in his patent.

Detwold *v.* Reeves, *Kane, J.*, Sep., 1851, 1 Fisher, 127.

DISCOVERY.

When Patentable.

The limitation of the patent franchise to something industrially available may seem to deny to some of the more important products of the human mind what it concedes to others of lower grade; but it is not the less true, on that account, that mankind may be enriched or made happy by physical as well as by moral or political truths, which, nevertheless, go without pecuniary reward for their authors. He who devised the art of multiplication could not restrain others from using it. The miner who first found out that the deeper veins were the richer in metal could not compel his neighbor to continue digging near the surface. The more comprehensive truths of all philosophy, whatever specific name we give them, cannot be specially appropriated by any one. They are almost elements of our being. We have not reasoned them out, perhaps, and may be even unconscious of their action; yet they are about us and within us, entering into and influencing our habitual thoughts, pursuits, and modes of life, — contributing to our safety and happiness; and they belong to us as effectively as any of the gifts of heaven. Air, water, and other materials found in Nature, and the laws under which they co-operate, are the common property of mankind; and those theories of the learned which we dignify with the title of *law* partake, just so far as they are true, of the same universally diffused ownership. It is the adaptation of the materials and forces of Nature to practical use which brings them within the domain of individuals, and the novelty of such adaptations constitutes them the proper subjects of protection by patent.

Detwold *v.* Reeves, *Kane, J.*, Sep., 1851, 1 Fisher, 127.

Compare Corning *v.* Burden, (1) ART, ✱; and Dolbear *v.* Am. Bell Tel. Co., (16) INVENTION, ✱.

DIVISION OF APPLICATION.

1. Two or more distinct and independent inventions cannot be included in the same application.

The authority vested in the Commissioner of Patents to define, and in any particular case to determine, what shall be admitted for examination in a single application is inferred as a necessary attribute of his duties prescribed in Sec. 4893 R. S. The only explicit reference in the statute to subdivision and separation in distinct applications is found in Sec. 4916 R. S., which has relation to re-issue, but by parity of reasoning (Herr, x. p., 41 O. G., 470) has been held to be applicable to original applications. The language of this section is: —

The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented upon demand of the applicant, and upon payment of the required fee for a re-issue for each of such re-issued Letters Patent.

(R. S., 4916.)

2. In pursuance of the authority thus vested in him, the Commissioner has prescribed the following rule for guidance, alike of Examiners and attorneys: —

Rule 41. — Two or more independent inventions cannot be claimed in one application; *but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result, they may be claimed in one application.*

(Rules of Practice, 1 Ap., 1892).

Interpretation of the law and of the above rule thereunder is seen in the following decisions: —

3. May be ordered at any Stage of the Application.

The requirement of division may be made at any time before the case goes to issue, if the interdependence of the inventions is not clear (Rule 42).

Robbins, x. p., *Fisher, Act. Com.*, 28 Feb., 1891, C. D. Ms.

4. Ordinarily a device which has obtained a distinct status in the industries and trade should be the subject-matter of a separate application.

Sawn, x. p., *Mitchell, Com.*, 9 Mar., 1891, 54 O. G., 1561.

See, however, for an exception to the above general rule, Westphal, x. p., (16) *infra.*

5. The rules were made for the cases that arise, not the cases for the rules.

It must be remembered that the rules were made for the cases that arise, and *not* the cases for the rules. The *spirit and prime purpose* of a system of practice must always be kept in mind, and mere details and incidentals subordinated thereto.

Carter, x. p., *Hall, Com.*, 1 Mar., 1889, 46 O. G., 1392.

See also Franklin, x. p., (17), *infra*, and McMahan, x. p., 48 O. G., 255, (31) *infra;* Designolle, (17) THE CLAIM, Coe, x. p., (6) CLASSIFICATION, and Hunter, Jr., *v.* Lane, (2) RULES AND FORMS.

6. How Determined.

While classification is desirable and necessary for the purpose of speedy examination of applications for patents, *it is not the controlling circumstance* in determining the question of division. The things to be considered are: —

Are the devices interdependent?

Are they connected in design and operation?

Are they capable of use in other relations than that in which they are shown?

Have they acquired a recognized standing in the art as subjects of separate manufacture and sale?

Bennett, x. p., *Fisher, Act. Com.*, 21 July, 1890, C. D. Ms.

7. Must be the Proximate Result.

The contribution must be the proximate, immediate, direct act of the inventions respectively, so that *their*

combined operation is a resultant operation, just as two bodies, moving in different lines impinging upon each other, move in a new direction. The result must be the proximate and direct result, and not a remote one.

Herr, x. p., *Hall, Com.*, 19 Oct., 1887, 41 O. G., 463.

8. It is the proximate result of the process and not an ultimate result, which is to be considered in disposing of questions of joinder or of division (Arnold, x. p., 42 U. S., 57, ✽).

Greenfield, x. p., *Frothingham, Act. Com.*, 11 Dec., 1891, 58 O. G., 274.

9. Office Classification.

The law requiring that but one subject of invention be comprehended in the same patent, must always form the basis of division of an application; it is not, however, always possible or admissible to divide an application for the mere purpose of conformity to the classification of inventions adopted in the Office. The Commissioner has no arbitrary power to require applications to be divided merely for such reason.

Franklin, x. p., *Leggett, Com.*, 24 July, 1873, 4 O. G., 105.
Compare, of same tenor, Carter, x. p. (5), *supra*.

10. Where not required, — Rule 41.

Where the inventions, however distinct, are dependent upon each other, and constitute portions of one machine, a division should not be insisted upon by the Office, and that even although it may be objected that the claims sought to be incorporated are for a different invention from that constituting the subject-matter of certain other claims in such a sense that they might, if applicant so elected, be embodied in another application: such claims are not necessarily for independent inventions within the meaning of Rule 41.

Forbes, x. p., *Mitchell, Com.*, 26 Mar., 1889, 51 O. G., 297.

11. Elements in Common.

Although it appears that certain claims in an application are for a mechanism capable of use in other relations than that which forms the specific subject-matter of the application, division will not be required if those claims have elements in common with the more specific claims of the application.

Kerr, x. p., *Simonds, Com.*, 3 Mar., 1892, 58 O. G., 1553.

12. Several improvements upon the respective parts may be embraced in a single patent, provided they cooperate to effect a common result, and provided they have not become subjects of recognized distinct manufactures.

Whenever the original invention is such that it could properly be the subject of a patent, and the organism has not changed in its identity or general structure, it is believed that several improvements upon its respective parts may be embraced in one patent, providing they cooperate in affecting the whole organism, *that is, in improving it as a whole*, and provided, also, invention and art [invention and the art, — not official classification merely] have not subsequently so advanced as to segregate the improved parts as distinct subjects of invention. These separate inventions in the improvement of each respective part are connected in design and operation; they are dependent upon each other, for they are parts of a specific organism, and they mutually contribute to a single result, which is the single function of the whole. . . . Such improvements may be embodied in one patent so long as the original invention retains its distinctive character and identity *and the state of the art has not advanced so as to resolve some or all of its parts into distinct subjects of manufacture.* . . . If the improvements did not disturb the identity of the original inven-

tion, and the progress of [the] art had not subdivided its elements into *distinct and well-recognized subjects of invention and manufacture*, the improvements could all be included in one patent.

Herr, x. p., *Hall, Com.*, 19 Oct., 1887, 41 O. G., 463.

13. "Interdependence" Defined.

To justify retention in the same application, "interdependence" does not mean that the several devices sought to be claimed in the same application must be of such a character that some other device effecting the same purpose may not be substituted for one or both of them. It is necessary only that they should have interdependence with relation to the operation which they perform.

Williams, x. p., *Fisher, Act. Com.*, 6 Dec., 1890, C. D. Ms.

14. A requirement of division, on the ground that the claims covered three separate and independent inventions, overruled where, on petition to the Commissioner, it was found that the first of the three groups into which the Examiner had divided the claims included an element which was also an element in the second group, and that the second group included an element of the third group; and further, that the improvements covered by the claims were not improvements upon parts or devices which had acquired a definite status in the arts, industries, and trades.

Williamson, x. p., *Frothingham, Act. Com.*, 26 Aug., 1891, C. D. Ms.

15. Commercial Status.

Where it was sought to secure under a single patent improvements on distinct parts of a pre-existing machine, and Examiner required division: *Held*, that it is

only when such part has acquired a distinct commercial status as a subject of independent manufacture and sale, that division should be required. So long as (1) the several improvements contribute to a single result, and (2) none of the parts improved upon has a recognized independent position in the industries and trade, division should not be required.

Galley, x. p., *Mitchell, Com.*, 5 Mar., 1890, Ms.

16. Requirements Defined.

It has not been held that where different parts or sub-mechanisms are claimed in combination, and also separately, that division should be required merely because such parts or sub-mechanisms have acquired distinct places in the arts and industries, unless they may also be used in other relations than those in which they are used in the particular application under consideration (see Scheckbauch, x. p., 54 O. G., 1265).

Westphal, x. p., *Frothingham, Act. Com.*, 19 Jan., 1892, C. D. Ms.

For the general rule to which the above conditions constitute an exception, see Sawn, x. p., (4) *supra.*

17. "New Fundamental Organization."

Where the principal claims are of such a fundamental character as to indicate that unless they shall be found to be anticipated, the machine is to be regarded as new in its fundamental organization, then, in advance of examination, it must be assumed that the machine is broadly new, and that division cannot properly be required.

Hatteberg, x. p., *Mitchell, Com.*, 13 Mar., 1890, C. D. Ms.

Compare Combs, x. p., (2), CLASSIFICATION, and Culver, x. p., (18), and Stearnes, x. p., (42), *infra.*

18. Where not Required.

Where it was clear, from an examination of the specification, and especially from one of the claims, that applicant claimed the entire machine as new, and that he was not seeking a patent for mere improvements upon an old machine: *Held*, that the doctrine set forth in Stearnes, x. p. (50 O. G., 1768), did not apply, and that the question of division could not be reached until it was determined whether the broader combinations claimed were true combinations within the meaning of the law, and also whether [in view of the then state of the art] they were patentable as combinations.

Culver, x. p., *Mitchell, Com.*, 18 Sep., 1890, C. D. Ms.

Compare Hatteberg, x. p., (17) *supra*, and Stearnes, x. p., (42) *infra*.

19. New Fundamental Organization.

Where the application included claims for an insole and claims for the method of making such a shoe, and the principal claims for the shoe were of such a fundamental character as to indicate that, unless found to be anticipated, the shoe was to be regarded as new in its fundamental organization: *Held* (assuming, for the purpose of deciding the question of division, that the shoe was new), that — as it is well settled that the right in such cases carries with it sub-combinations — petition, from Examiner's requirement of division at this stage, was granted.

Kinsella, x. p., *Frothingham, Act. Com.*, 29 Aug., 1892, C. D. Ms.

20. Distinct Commercial Status.

Upon requirement of division in an application where four of the claims were drawn wholly upon a ticket-register, and the other claims were drawn entirely upon

the ticket itself, and such registers and tickets fell under separate classes in the Patent Office: *Held*, that the Office classification was not alone sufficient to control the question; but as it was obvious that the ticket could be used in other relations than that in which it was shown and described, and as it was furthermore known to have acquired a distinct status in manufacture and trade, it followed that, although the ticket and ticket-register were used together and to a certain extent mutually contributed to produce a single result, the claims for such register and ticket could not be joined in the same application.

McDuffie, x. p., *Frothingham, Act. Com.*, 4 Aug., 1892, C. D. Ms.

21. Where the subject-matter was a harness, and some of the claims related to separate parts of a harness, — for example, some of the claims related to the saddle, some to the breast-strap, and other some to the entire structure, embracing both these parts, — and the Examiner required a division of the application: *Held*, that the mere fact that parts of the harness may possibly be used with other parts of a differently constructed harness, or that the Office recognizes separate sub-classes of invention which embrace such parts when separately applied for, was not sufficient ground upon which to base requirement for division.

Wells, x. p., *Fisher, Act. Com.*, 11 Nov., 1889, C. D. Ms.

22. "Dividing Line."

Where inventions are so near the dividing line as to render impossible the determination with certainty whether, in a proper sense, co-ordination and combination exist, so as to constitute them one invention or combination, *the doubt should be resolved in favor of the*

inventor, and he should be allowed to unite them in one application, if he so elect.

Herr, x. p., *Hall, Com.*, 19 Oct., 1887, 41 O. G., 463.

23. Distinct Status in the Arts.

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

Hine, x. p., *Simonds, Com.*, 8 Jan., 1892, 58 O. G., 385.

24. Co-acting Devices.

Where the claim covered two sets of mechanism, and the plunger and its pitman were elements of both sets, not only in operation, but also as claimed: *Held*, that the fact that each device or sub-mechanism performed a function different from the other was clearly immaterial to the question of division, and the requirement of division was overruled.

Brown & Gehrt, x. p., *Frothingham, Act. Com.*, 18 Mar., 1892.

25. Not required where one Claim in each Group included both Sub-mechanisms.

The Examiner separated the claims into five groups, and required division: *Held*, as to two of the groups, that as one claim in each group included both sub-mechanisms, division was improperly required, but that the requirement of division as to the other groups was proper, as each related to a specific improvement upon a separate part of an old machine (see Stearnes, x. p., 50

O. G., 1768; Scheckbauch, x. p., 54 O. G., 1265; and Cornely & Cornely, 46 C. D. Ms., 415).

Jackson, x. p., *Frothingham, Act. Com.*, 25 Jan., 1892, C. D. Ms.

NOTE. — In this case the Assistant Commissioner said: "While the requirement for division has been in part sustained, yet it is not improbable that claims might be drawn in such a way as to obviate, at least in part, the necessity for division."

26. Question of "Merits."

The Examiner refused to entertain the application on its "merits," and required division because,—

There is no combination between the specific means for regulating the supply of oil to the tank and the burner *per se*. Each device performs its expected and independent function (Herr, x. p., 41 O. G., 463).

This action being carried up on interlocutory appeal, the Commissioner's ruling was substantially as follows: When a claim covers a combination, it cannot be refused consideration on the ground of want of combination. The Examiner should first reject on that ground, so as to place the case in condition for appeal to the Board of Examiners-in-Chief. If the Board reverses the Examiner's action, the case goes back to the Primary Examiner for action on "merits." If, on the other hand, the Board sustains the Examiner's position as to combination, then division may be called for by the Examiner, and this question should be disposed of either by acquiescence on the part of applicant, or by the Commissioner on petition before action on "merits."

Bullard, x. p., *Hall, Com.*, 17 Dec., 1888, 45 O. G., 569.

27. Implication.

A requirement to file a divisional application implies that the article embraced is not patentable in the pending

application. In such a case Rule 44 impliedly permits a reservation clause in the existing application.

Forbes, x. p., *Mitchell, Com.*, 14 Oct., 1889, C. D. Ms.

28. "Parent" and "Divisional" Applications.

Where the earlier of two applications described an apparatus and a process, and claimed the former, and, without claiming the process, stated that it formed the subject of another application which was identified by serial number and date, and the other and the later application declared itself to be a division of the application first filed, which was also identified by serial number and date: *Held*, that the later application was, technically, a division of the earlier.

Forbes *v.* Thomson, *Mitchell, Com.*, 13 Dec., 1890, 53 O. G., 2042.

29. There are, perhaps, only two cases where claims to a process and to a product can be properly included in one patent. These cases are: —

1. When the product is entirely new, and hence the process also.

2. When the exercise of the process would produce no other product, and when the product could be produced by no other process.

Blythe, x. p., *Butterworth, Com.*, 28 July, 1884, 30 O. G., 1321. Compare Tainter, x. p., 47 O. G., 135.

30. The Examiner's requirement that the process and an apparatus therefor must be absolutely interdependent for protection in one patent, — overruled.

The requirement of the Examiner for division, on the ground that the process and apparatus cannot be mutually dependent upon each other unless each is absolutely indispensable to the exercise of the other, overruled; and *Held*, that such a construction of Rule 41 is unwarranted.

It is sufficient to justify joinder of process and apparatus if, as a matter of fact, the single result had in view by the inventor, as the proximate purpose of his invention, is contributed by both process and apparatus. In such case there is mutual contribution and interdependence within the meaning of the rule.

It appearing that the method could not be carried out in any other way than by an apparatus substantially like that claimed: *Held*, that division should not be required.

Norwood, x. p., *Mitchell, Com.*, 17 Feb., 1890, 50 O. G., 1129.

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

Hyde, x. p., *Fisher, Act. Com.*, 10 Aug., 1889, 50 O. G., 1293.

32. It has been held by the courts and by the Patent Office that a clear line of division exists between apparatus and process; the fact that the Office has at some periods regarded division as imperative, while at other periods it has been looked upon as optional, does not alter the fact that the *capacity* for division has always been recognized.

Chambers, x. p., 51 O. G., 1943.

33. The process, and also an apparatus for carrying out that process, may be separately claimed in one patent.

In a case where the Primary Examiner required division of the application upon the lines of "Process" and "Apparatus" before examination on the merits, his action was overruled, on the ground that there is no

provision of the statute which prevents the joinder of a process and its apparatus in the same application, and for the further reasons that the law, the decisions of the courts, and the Patent-Office rule (Rule 41) afford no warrant for such demand unless there is such a total lack of interdependence between the two matters claimed as would render them absolutely independent and distinct inventions.

McMahan, x. p., *Fisher, Act. Com.*, 10 June, 1889, 48 O. G., 255.

34. Examiners were instructed to avoid unnecessary interference with the choice of the applicant.

It may further be said that the law provides that any person who has made an invention shall receive a patent granting to him the exclusive right to make, use, and vend the same within the United States and its Territories. Under a requirement by which an invention might thus be split up into separate parts, the patent for making and vending might fall into the hands of one assignee and that for using into those of another, perhaps antagonistic. Such interference with the rights of inventors was never contemplated by the statute, and the Patent Office should take no action which would accomplish it.

Ib.

Compare Designolle, (17) THE CLAIM; Carter, (5) *supra*.

35. Although a process and an apparatus for carrying out the process are separate inventions, they are not necessarily independent inventions within the meaning of Rule 41; and when they are dependent upon each other and mutually contribute to produce a single result, they may be joined in one application. Rule 41 does not require that, in order to authorize a single patent for several distinct inventions which mutually contribute

to a single result, there must be such intimacy of interconnection and co-operation as to result in a third invention or combination.

Lord, x. p., *Mitchell, Com.*, 13 Feb., 1890, 50 O. G., 987.

36. Method — Product.

It is *not a sufficient ground for requiring division* between a claim for a method and a claim for the product produced by practising that method, that if the claims were presented in separate applications, such applications would be assigned to and examined in different divisions of the Office, *provided the method could produce no other product, and the product could be produced by no other method.*

Stanwood, x. p., *Frothingham, Act. Com.*, 18 June, 1892, C. D. Ms.

37. Process and Machine.

Where an application, as filed, discloses an apparatus and also a patentable process, and the relation between them is such that they could be joined in one application, and the apparatus only is embraced in the statement of invention and claims as originally presented, claims for the process may be subsequently incorporated, if they are seasonably presented and are supported by a supplemental oath.

Perkins, x. p., *Mitchell, Com.*, 4 Mar., 1891, 55 O. G., 139.

38. Apparatus and Process.

Appeal was taken from the decision of the Primary Examiner which required division of an application as between claims for apparatus and claims for process, which process may be practised by the apparatus, but is also capable of being practised otherwise. Both inventions pertain to the same subject-matter. No wider

range of search is required for the two than for the one. Following Lord, x. p., (50 O. G., 987), the requirement of division is overruled.

Curtis, x. p., *Simonds, Com.*, 4 Nov., 1891, 57 O. G., 1128.

39. Where method and product should be presented in separate applications.

Where the Examiner refused admission to two claims on the ground that division would be required for the reason that if the proposed claims were presented in different applications such applications would be assigned to and examined in different divisions of the Office, and it was apparent that the method set forth in one of the claims could produce only the product of the other claim, but, on the other hand, it was also apparent that the product of the second claim *could* be produced otherwise than by the method set forth in the first claim: *Held*, that the Examiner's action was proper.

Stanwood, x. p., *Frothingham, Act. Com.*, 18 June, 1892, C. D. Ms.

40. Range of Search.

Where it appeared that if claims for a method and claims for an article of manufacture were presented in separate applications, such applications would be assigned to and examined in different divisions of the Office: *Held*, that Fefel, x. p. (57 O. G., 409), and Curtis, x. p. (57 O. G., 1128), presented no grounds for overruling the requirement of division.

Greenfield, x. p., *Frothingham, Act. Com.*, 11 Dec., 1891, 58 O. G., 274.

41. Process and Product.

A requirement of division between a claim for a brush or mirror handle and back, and a claim for an alleged

process of making the same: *Sustained*, on the ground that the article and process were distinct inventions, and, if presented in separate applications, the applications would be assigned to and examined in different divisions of the Office.

Welling, x. p., *Frothingham, Act. Com.*, 15 Mar., 1892, 40 C. D. Ms., 173.

42. Distinct Specific Improvements on an Old Machine not joinable in a Single Application.

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

Stearnes, *Mitchell, Com.*, 15 Mar., 1890, 50 O. G., 1768.

43. Independent Inventions in the same Structure.

Independent inventions, although pertaining to the same structure, cannot be joined in one application, especially when the Office classification is such as to require their examination in different divisions.

Steinhilber, *Simonds, Com.*, 17 Dec., 1891, C. D. Ms.

44. Where Division is required.

Where the article of manufacture claimed could be made by other methods than that claimed, and the method, if practised, would not necessarily eventuate in that particular article of manufacture: *Held*, that division was properly required (Peters, x. p., 48 Ms., 301).

Greenfield, x. p., *Frothingham, Act. Com.*, 11 Dec., 1891, 58 O. G., 274.

45. Two Distinct Inventions.

The Examiner properly required elimination from an application for patent for improvements in a mangle or ironing-machine, of claims for a special form of belt-shifting device shown in the same application; there being no necessary connection between applicant's ironing-machine, considered as such, and the peculiar kind of belt-shifter which he shows in his application.

Wendell, x. p., *Simonds, Com.*, 20 Ap., 1892, 59 O. G., 630.

46. After the product claim has been withdrawn, in obedience to Examiner's requirement of division, and claims to the process have been rejected, a claim to *another* product cannot be introduced in the same application.

Where the application contained claims for a process, and also a claim for an article produced by it, and, upon Examiner's requirement of division, the article-claim was stricken out; and where, after final rejection of the process-claim, applicant sought to introduce a new article-claim: *Held*, that although the new claim was not in the precise language or for the precise article originally claimed, yet its admissibility does not depend upon whether it covered the same or a different product. The only question is, did the application originally present a claim which, in one form or another, covers a product of the process claimed.

Steffin, x. p., *Fisher, Act. Com.*, 3 Nov., 1890, C. D. Ms.

47. Filing Date.

Where applicant, being required to remove from a divisional application new matter not contained in the parent application, filed a third application containing the new matter, with the statement that it was a division of the second application, and the Examiner objected to

the statement, on the ground that the subject-matter was never properly a part of the subject-matter of the second application: *Held*, overruling the Examiner, that there was no adequate reason why the applicant should not have the benefit of the filing date of the application in which his present invention was first claimed (case distinguished from Buell, x. p., 26 O. G., 437).

Hunter, x. p., *Mitchell, Com.*, 27 Feb., 1891, C. D. Ms.
Compare Fuller, x. p., (48) *infra*.

48. New Matter Inadmissible.

The subject-matter of a *divisional* application must always be a part of the subject-matter of the original application, without any additions to that original subject-matter.

Fuller, x. p., *Simonds, Com.*, 30 Jan., 1892, 58 O. G., 804.
Compare Hunter, x. p., (47) *supra*.

NOTE. — This ruling manifestly does not prevent applicant, should he so elect, combining the divisional (segregated) matter with such new matter in a *de novo* application, either in lieu of or contemporaneously with, but distinct from, such divisional application. Such *de novo* application would, however, be restricted to its own filing date, and could not date back to the day of filing of the parent application, as a divisional application can.

49. Divisible Subject-Matter.

The application under discussion held not admissible as a division of the earlier application, because its subject-matter is not reached by any claim or statement of invention contained in said earlier application.

Freeman, x. p., *Frothingham, Act. Com.*, 19 Jan., 1892, 58 O. G., 522.
See note to Fuller, x. p., (48) *supra*.

50. Description must be restricted to the divisional case.

Where an applicant acquiesces in the requirement of division, he is bound (by Rule 142) to "limit the description, drawings, and claims of the pending application to whichever invention he may elect."

Rupp, x. p., *Fisher, Act. Com.*, 19 Mar., 1890, C. D. Ms.
See note to Fuller, x. p., (48) *supra.*

51. Rejection accompanying requirement of division is improper; but if applicant waives the irregularity, he is afterward bound by it.

Where the Examiner rejects upon references, in his first letter requiring division, the applicant is not bound thereby, but may insist that the rejection be withdrawn until the question of vital form is disposed of, and may appeal to the Commissioner from a refusal to grant his request, as provided in Rule 145. But applicant has a right to waive the irregularity, and to treat the rejection precisely as if the question of vital form had been previously disposed of; and if he does so waive, he is thereafter estopped from objecting to such rejection on the ground of irregularity.

Lorimer, x. p., *Mitchell, Com.*, 24 June, 1890.
Compare Stearnes, x. p., (42) *supra.*

52. Question of division is a question of "form," is appealable to the Commissioner, and takes precedence of question of functional claim, which is a question of "merits," and is appealable to the Examiners-in-Chief.

Whether or not the process claims cover anything more than the use or function of the machine is a question for the Examiner, and the appellate tribunals acting upon "the merits" (Harrison, x. p., C. D. 42, Ms. 178); but where the question of division is also raised, it must

be settled *before* the applicant is obliged to take his appeal to the Examiners-in-Chief on the question whether or not the process amounts to a mere function of the machine.

Heuser, x. p., *Frothingham*, *Act. Com.*, 30 Ap., 1891, C. D. Ms.

53. Non-Essential Elements.

Examiner basing requirement of division on alleged immateriality of certain elements common to all the claims: *Held*, if the Commissioner were to hold, *for the purpose of division and therefore in advance of examination on "merits,"* that any of the elements of a combination were immaterial and could be ignored, it would be, in effect, holding that they were immaterial and could be ignored for any and all purposes, and would thus deprive the applicant of the substantial right of appeal to the Examiners-in-Chief in the event of an adverse decision of the Primary Examiner on the question of legitimacy of the combination; *Held further*, that it would be unsafe to assume such a state of facts, in any case, in advance of consideration of the claims upon their merits, in the regular course of procedure; and the requirement of division was overruled.

Lewis, x. p., *Frothingham*, *Act. Com.*, 21 Mar., 1892, C. D. Ms.

54. Upon the Examiner's insisting upon a requirement of division on the ground that certain elements, common to all the claims, were merely nominal elements: *Held*, that every element included in a legitimate combination is presumably essential to that combination, and it has been well settled that the question whether a combination is or is not legitimate, pertains to the "merits" of the claim; and the requirement of division was overruled.

Ib.

55. When an application containing claims for a process, and containing also claims for a described apparatus for practising the process, has been divided in compliance with the official requirements, and a patent thereafter issues for the apparatus: the Examiner is not warranted in subsequently rejecting the application for the process, on the ground that the patent for the apparatus disclosed and discovered the process. Such action is, in effect, a reversal of his decision requiring division; and if his present action be correct, division should not have been required.

Chambers, x. p., *Mitchell, Com.*, 31 May, 1890, 51 O. G., 1943.

56. Cursory Examination.

An exhaustive search cannot be made in advance of compliance with the requirement of division; but the best references which the Examiner can furnish as the result of a cursory examination should be furnished, upon request, to assist the applicant in determining what course to pursue in view of the decision of the Office that the application must be divided.

Stearnes, x. p., *Mitchell, Com.*, 15 Mar., 1890, 50 O. G., 1768.

Compare Lorimer, x. p., (51), also Culver, x. p., (18), *supra*.

57. Official Information.

Where a division was required subsequent to Examiner's first letter: *Held*, that not only should the requirement of division have been made in the first action, but *information of the state of the art should also have been given, both as to the claims which the Examiner thought examinable in the parent case, and also as to those which he was of opinion should be divided out.*

Harris, x. p., *Fisher, Act. Com.*, 4 Jan., 1890.

See Robbins, x. p., (1) DRAWING; JOINDER OF APPLICATION; CLASSIFICATION.

DOUBLE USE.

See (31) *et seq.* INVENTION.

THE DRAWING.

1. Wherever the nature of the invention admits of it, each application for a U. S. patent is required to be accompanied by a drawing of the device, of which, in case a patent is granted, a photolithographic copy (made in the Patent Office) is attached to the patent as a part of the specification.

Sec. 4889 R. S., P. O. R., 49, 50, 51, 52, 53, 54, and 55.

2. Drawings for the Patent Office are required to be made upon pure white paper or cardboard, of a thickness corresponding to 3-ply Bristol-board. The drawing is required to consist wholly of lines made with a pen, and each line is required to be sharp, distinct, and absolutely black. Where the drawing contains more than one view or figure, the several figures must be consecutively numbered. For transmission to the Office, drawings may be rolled, never creased or folded.

P. O. R., 51 (1), (3), (6), (9).

NOTE.—A mode of transmission favored by some careful attorneys is flat, protected by one or more stiff tar-boards.

3. Rule 51 clearly sets forth the character of the drawings which must be furnished by applicants; and as the Office Draftsman is an expert and is intrusted with the duty of seeing that the drawings conform to the required standard, the Commissioner has usually, if not always, felt constrained to follow the Draftsman's judgment in such matters.

Benjamin, x. p., *Fisher, Act. Com.*, 28 May, 1890, C. D. Ms.

4. The number of sheets of drawing should never exceed what is absolutely necessary. Rule 51 (5). The statute requires that the drawings shall be *signed* by applicant or his attorney, and by two witnesses. Stamped signatures are not sufficient. Sec. 4889, R. S., Rule 51 (7).

Krause, x. p., *Simonds, Com.*, 18 Sep., 1891, 56 O. G., 1708.

5. Upon the requirement of the Examiner that "each view of each part should be designated as a separate figure," and that "where two views of the same part are given, as in Fig. 8, one should be numbered 8 and the other 8 *a*": *Held*, sustaining the Examiner's action, that it is stated in Clause 6 of Rule 51, that "the different views should be consecutively numbered," and in Rule 38, that "the description will refer to the different views by figures;" and no good reason was seen for departing from these rules, nor was it apparent that compliance with them would entail any hardship upon an applicant, and that while it is true that patents have been granted in which Rule 51 has been departed from, yet such practice is not approved.

Wharton, x. p., *Frothingham, Act. Com*, 18 June, 1892, C. D. Ms.

6. When the Examiner had required further illustration of the mechanism "whereby certain conveyors were rotated at different rates of speed": *Held*, that it was clear, from an examination of the drawing, that the conveyors were to be rotated, and, from an examination of the claims, that applicant did not claim that the conveyors were rotated at different rates of speed, and that the illustration was sufficient.

Bates, x. p., *Frothingham, Act. Com.*, 16 Nov., 1891, C. D. Ms.

7. Where Examiner, having required a division, objected to certain of the figures: *Held*, that one of the figures, being connected in design and operation with the other devices shown, might therefore be allowed to remain in the case, although it might also be considered to represent a distinct invention.

Robbins, x. p., *Fisher, Act. Com.*, 28 Feb., 1891, C. D. Ms.

8. Modifications, where shown, must come within the scope of some claim.

Generally speaking, where a preferred form and modified forms of the same invention are illustrated by different figures in the drawings of an application, applicant should be required to strike out each figure (other than the one representing the preferred form) which is not the subject of a claim that is also applicable to all the represented modifications.

Payne, x. p., *Mitchell, Com.*, 25 July, 1890, C. D. Ms.

Compare Witty *v.* Caffrey, MODIFICATIONS; and Wilcox, x. p., (19) ANTICIPATION.

See also DESCRIPTIVE CHARACTERS.

9. Amendment of Drawing.

When, without direction or permission of the Office, a figure is added to the original drawings on file, it must be erased or cancelled, even although it was added in good faith.

Cordrey, x. p., *Mitchell, Com.*, 6 July, 1889, 48 O. G., 397.

10. A drawing cannot be altered to correspond with a model which has been merely filed in the case as an exhibit, and never accepted by the Office as a model under the provisions of Rule 56. Such a case comes within the principle of Kissner, x. p. (53 O. G., 919).

Austin, x. p., *Frothingham, Act. Com.*, 27 July, 1891, C. D. Ms.

11. It was not intended to hold, in Wharton, x. p. (40 O. G., 917), that a *drawing* could never be changed by addition or erasure for the purpose of correcting an error merely clerical in its nature.

Law, x. p., *Mitchell, Com.*, 10 Feb., 1891, C. D. Ms.

12. The statement, in Rule 73, that amendments must be made "on sheets of paper separate from the papers previously filed," etc., clearly applies to the specification and claims only. The statement that erasures and mutilations of the papers and records must not be made by the applicant includes drawings; but it does not necessarily mean that corrections of the drawings may never be made by erasure and new delineation, *by permission of the Office and under its superintendence*; and Rule 71 no more authorizes amendment and revision of drawings by mutilation than it authorizes amendment and revision of the specification by the same method. Rule 72 affords no warrant for withdrawal of the drawing for correction or any other purpose, except when there is a model in the case, which must remain on file.

Ib.

13. All requirements of amendment by an Examiner in a case where no accepted model is filed, whether they relate to the specification or the drawings, must (unless the contrary is stated or suggested) be assumed to imply that the amendment is to be affected, not by erasure or mutilation, — obliterating portions of original record, — but by means of such *additional* description or drawing as will effect the amendment and leave the record intact. The furnishing a tracing or a blue print of the original will not justify a relaxation of this rule. Of course in *de minimis* matters, analogous to the correction of clerical errors in manuscript, the original drawings may be

corrected, even in a case where no model is filed; the correction being superintended by the Examiner.

Crissey, x. p., *Mitchell, Com.*, 2 Feb., 1891, C. D. Ms.

14. Where the Examiner required a tracing showing the condition of the drawings as they were before certain amendments were made by the applicant: *Held*, that the requirement should not be insisted upon, as the changes were made in compliance with requirements of the Office, and the record was, therefore, clear as to what changes were made and why they were made.

Flowers, x. p., *Fisher, Act. Com.*, 22 Nov., 1890, C. D. Ms.

15. Competency of the Witnesses.

While the language of the statute, if read literally, implies that it is the drawing or the document signed by the applicant, and not his signature, which is the thing to be attested by two witnesses, yet the uniform practice of the Patent Office, so far as the Commissioner's investigations enabled him to know, has been to regard the attestation as referring to the *signature*, and accordingly as requiring two competent witnesses for each signature. Examiner was sustained in his refusal to accept the name of a member of the firm as a witness to that firm's signature as applicant's attorneys.

Kyle, x. p., *Mitchell, Com.*, 19 Ap., 1890, 51 O. G., 1621.

16. Where an application was filed to take the place of one which had been stricken from the files because signed and sworn to "in blank": *Held*, that the old sheet of drawings could not be applied to the new application.

Ayres, x. p., *Fisher, Act. Com.*, 13 May, 1890, C. D. Ms.

NOTE.—On this point the Acting Commissioner said that in a recent case the Commissioner, through a letter to the applicant, refused permission to transfer certain sheets of

drawings in an original application to a divisional application, and referred the applicant to two orders bearing on the subject published in 30 O. G., 777, and 32 O. G., 139.

17. It is a matter of extreme doubt whether an application can ever be rejected upon a reference whose construction is not specifically *described*, but reliance is placed wholly or mainly upon the illustration in the drawings.

Buhlman, x. p., *Fisher, Act. Com.*, 29 May, 1890, C. D. Ms.

For like insufficiency (as reference) to description without *drawing*, see Wilcox, x. p., (19) ANTICIPATION.

18. Section 9 of Rule 51, which forbids advertisements on the face of patent drawings, relates to the advertisements and business addresses of agents and attorneys only. There is no valid objection to the name and address of *the inventor* appearing upon the face of the drawing *when placed there merely for the purpose of illustrating his invention.*

McGee, x. p., *Mitchell, Com.*, 8 June, 1889, C. D. Ms.

For DUPLICATION see REDUNDANCY.

ELECTION.

Estoppel.

The principle recognized in general jurisprudence that a party entitled to one of two or more rights or remedies must elect which to pursue, and, having made the election with full knowledge, is bound thereby and is estopped from taking another remedy, is applicable to proceedings for patents. A party cannot occupy two inconsistent positions. Cases illustrating this general rule are very numerous: *e. g.*, Bigelow on Estoppel cites Roderınund *v.* Clark (46 N. Y., 354); Sawyer *v.* Wood (3 Johnson's Chan. Cas., 416); Littlefield *v.* Brown

(1 Wend., 398); Do. Supr. Ct. — in Error — (11 Wend., 467).

Williams & Raidabaugh, x. p., *Hall, Com.*, 9 Sep., 1887, 40 O. G., 1337.

See ESTOPPEL.

ELEMENTS.

Where the applicant's invention is such as, by simple interchange or reversion, to admit of several combinations in a single patent, he should be permitted to include them where the prior art admits of such a course.

Tobie, x. p., *Mitchell, Com.*, 6 Feb., 1890, 50 O. G., 992.

EMBRYO INVENTION.

See CONCEPTION.

EMPLOYER AND EMPLOYÉ.

1. The presumption is in favor of the employer as against the claims of a workman who has been specially employed and paid to embody the invention.

As between an employer and a party employed for a special purpose, features suggested by the employé which are merely tributary to the main invention can give to him no claim as an inventor; and even in regard to such features as amount to independent inventions, a presumption exists in favor of the employer. . . . Hall and Harrison were acting as machinists employed for a special purpose, and are therefore liable to all the presumptions of law against them by reason of such fact.

Harrison *v.* Hogan, *Marble, Com.*, 6 Sep., 1880, C. D., 191.

See also (2), (3), (4), (5), (6), and (7) *infra.*

2. Improvements made by workmen, working under the pay of an inventor and making experiments under his directions, are to be considered for the credit and benefit of such inventor.

Goodyear *v.* Day, U. S. C. C., N. J., *Dickerson, J.*, 1852. Law's Digest.

3. Claims are regarded with disfavor made by mechanics or draftsmen who have been called in to assist in the embodiment of a new idea, and, having been paid for their materials, time, and skill, turn upon their employers and claim to be independent inventors.

Spofford *v.* Moore, *Fisher, Com.*, 10 Feb., 1870, C. D. 6.

4. An inventor who employs workmen to embody his invention is not to lose it because they make suggestions or alterations which are mere modifications of it or auxiliary to it.

Hale *v.* Field, *Fisher, Com.*, 16 Feb., 1870, C. D. 12.

5. Where a skilled workman is employed to embody an inventor's idea in practical form, the results are the property of such employer, unless they show that the workman has discarded the original idea and has proceeded upon a wholly distinct and separate plan.

Hisey *v.* Peters, *Simonds, Com.*, 11 Mar., 1892, 58 O. G., 1691.

6. Where an employer discloses the general idea and plan of his invention to an employé, no suggestion from the latter which does not involve a radical departure therefrom will give him any rights as an inventor. (Citing Agawam Co. *v.* Jordan, 7 Wallace, 583, ❋.)

Hayes *v.* Hopkins, *Simonds, Com.*, 19 Dec., 1891, 59 O. G., 157.

7. Where it appeared that one of the parties to the interference had been employed by the other party to put said employer's previously conceived ideas into mechanical form: *Held*, that it imposed a burden upon the employé which could be removed only by evidence of the most conclusive character; and as both the Examiner of Interferences and the Examiners-in-Chief concurred in finding that the employer was entitled to the award of priority, the further burden was imposed upon said employé of showing to the Commissioner that the former decisions were contrary to law and against the weight of evidence.

Redfield *v.* Goodson & Capehart, *Fisher*, *Act. Com.*, 13 Jan., 1891, C. D. Ms.

8. There is no presumption in favor of an employer against a workman who produces an invention while employed in the general service of the former, but who is not employed to reduce that specific invention to practice.

Hale *v.* Field, *Fisher*, *Com.*, 16 Feb., 1870, C. D. 12.

Of like purport see Hapgood *et al. v.* Hewitt, (11) and (12) *infra*.

9. In a case where A, while in the employ of B, constructed at B's expense and for B's use a machine for which A afterward secured a patent, such construction made B the owner, with the right to use that particular machine without liability to A, notwithstanding the grant to A of such patent.

Dable Grain Shovel Co. *v.* Flint *et al.*, *Blodgett*, *J.*, 31 Mar., 1890, 53 O. G., 1093.

10. Although a mechanic may be employed to devise and perfect a machine, and although the employer may clearly indicate the *result* to be attained by the ma-

chine proposed, yet if the idea of *means*, including the *general plan* and the *specific details*, was conceived and reduced to practice by the employé, the *latter*, and not the former, is the inventor, and to him the patent should be granted.

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

Even where the relation of the employer to the employé may entitle the former to an equitable interest in the invention and the patent therefor, it does not entitle him, on that account, to take the inventor's place as the lawful grantee..

Greenlee & Ström *v.* Roberts, *Mitchell, Com.*, 11 May, 1891, 55 O. G., 1399.

11. Persons are not deprived of the right to their inventions while in the service of others unless they have been hired and paid to exercise their inventive faculties for their employers.

Hapgood *et al. v.* Hewitt, *Gresham, J.*, 22 March, 1882, 21 O. G., 1786.

12. A contract by which one person agrees to pay a sum of money for the time, labor, and skill of another for a given period gives the employer no right to the assignment of a patent that is issued to the employé for an invention made during the period of his employment.

Ib.