

EQUIVALENTS.**1. Definition.**

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

Jones Co. *v.* Munger Co., *Locke, J.*, Nov., 1891, 58 O. G., 274.

2. The use, in a claim, of the words "or equivalent devices as described," is not objectionable where their meaning is clear and unequivocal, *as where modifications or equivalents have been described in the specification.*

Walton, *x. p.*, *Doolittle, Act. Com.*, 11 July, 1876, C. D. 162.
Of like purport, see Lockwood, *x. p.*, (7) *infra*.

3. An applicant has the right to state that, while he prefers the form of jack illustrated in his application as an element of the combination, other clamping devices which would accomplish the same purpose could be employed. The Examiner's requirement that applicant either strike out this passage or describe and illustrate the "other forms of clamping device" referred to,—*overruled.*

La Borde, *x. p.*, *Hall, Com.*, 9 July, 1888, C. D. 104.

4. It has never been held that an equivalent known at the date of the invention could be used without infringing the patent; such a holding, if generally adopted, would amount practically to destruction of the law of equivalents.

Kuhl *v.* Mueller, *Sage, J.*, 5 July, 1884, 28 O. G., 541.

5. The inventor of an improvement [in an already created art] cannot so invoke the doctrine of equivalents as to suppress all subsequent improvements, in the same

field of invention, *which are not mere colorable evasions of the earlier improvement.*

Burr v. Duryee, U. S. S. C. By *Grier, J.*, 28 Mar., 1864, 1 Wallace, 531, *.

6. The patentee of an invention, which is merely one of a train of successive improvements in an already created art, is not entitled to invoke the doctrine of equivalents; and his patent, if sustained at all, can be held to cover only the specific arrangement which it describes.

Consol. Roller Mill Co. v. Bernard, *Blodgett, J.*, 10 Feb., 1890, 53 O. G., 430.

NOTE. — *Burr v. Duryee*, (5) *supra*, and *Rodebaugh v. Jackson*, (10) *infra*, seem to mark some relaxation of the above general rule.

7. It is a well-established rule of the Office, that the words “or its equivalent” may not be used in a claim unless an equivalent device is described in the specification (*Dolph*, x. p., 89 O. G., 239; *Cook*, x. p., 43 C. D. Ms.).

Lockwood, x. p., *Fisher, Act. Com.*, 19 June, 1890, C. D. Ms. See, of same purport, *Walton*, x. p., (2) *supra*.

8. If defendants have used plaintiff's invention, *or something substantially like it*, they are estopped from denying its utility; it is fair to presume that they would not use it if they thought it of no utility (*Coleman v. Liesor*).

McClain v. Ortmayer, *Blodgett, J.*, 9 Jan., 1888, 42 O. G., 724.

9. Where a patentee says that he expects, in practical operation, to use a device — as, for example, a rivet —

to accomplish a certain purpose, but does not confine himself specifically to it, any other [then known] device which would secure the result intended, would be open to him.

Ib.

Of like purport, see *La Borde*, (3) *supra*.

10. Though the patentee of a combination whose original [broad] claim was rejected in view of the prior state of the art, and who thereupon, in order to secure allowance, presented the limited claim seen in his patent, is held strictly to the structure described in his claim, he is not thereby shut out from the doctrine of equivalents.

Rodebaugh v. Jackson, *Brown, J.*, 25 Feb., 1889, 47 O. G., 650.

NOTE. — The drift of rulings such as (6) and (10) *supra*, and (10) PUBLIC RIGHTS, ETC., would appear to permit the inventor of one of a series of steps in a known art to invoke the doctrine of equivalents no further than to include devices, which fall strictly within the terms and limitations of his claim, especially when those limitations were imposed by the applicant himself after rejection, in order to secure the patent. The connection of the author (in the capacity of expert) with the above case, and with that of *Sargent v. Hall Safe & Lock Co.*, *, enables him to state that such, practically, was the precise position of the Court in each of those cases.

ERROR OF JUDGMENT.

Where it was sought to surrender a patent for correction and have it re-issued without expense to the applicant, on the ground that certain claims in the patent were found to be anticipated, and that the Office had overlooked the anticipating patents: *Held*, that to file a disclaimer or have a re-issue would seem to be the

proper remedy, but that the case did not fall within Rule 170, as to re-issue without fee. That rule applies only to cases of *clerical* mistakes. If there was any mistake in this case upon the part of the Office, it was, so far as appeared from anything in the record, one of judgment. Whether or not claims in an application are anticipated is a matter requiring the best judgment of the Examiner, and until there is evidence to the contrary, it must be taken for granted that such judgment was exercised. Besides, it could not be said that the error, if any, was entirely the fault of the Office; for if the claims were anticipated, that fact could, by the exercise of reasonable care and diligence, have been discovered by the petitioner as well before the patent was issued as after.

Cunningham, x. p., *Fisher, Act. Com.*, 20 Aug., 1890, C. D. Ms.

Compare Edward Miller & Co. v. Bridgeport Brass Co., (2) RE-ISSUE, and Thompson, x. p., (1) OFFICIAL OVERSIGHT.

ESTOPPEL.

1. Although a patent may be void, *the patentee* is estopped from urging that plea as a defence to a suit by his assignee for infringement.

Adee v. Thomas, U. S. C. C. E. D. N. Y., *Lacombe, J.*, 25 Jan., 1890, 41 F. R., 342.

2. While applicant had an application pending, he filed a second application for improvements not shown in the first. After the second application went to patent, he continued to assert his title to broad claims upon the fundamental feature of the organization as described in the first application: *Held*, that he was under no obligation to press under the second (although first to be

patented) application — filed for the purpose of securing improvements and modifications — the broad claims originally asserted upon the first application. But if he had asserted and obtained allowance of claims under the second application which might have been based upon the structure of the first application, he would thereby have barred himself from claiming in the first application any portion of the same invention.

Schickner & Marty, x. p., *Mitchell, Com.*, 17 June, 1890, C. D. Ms.

Compare Upton, x. p., (2) DEDICATION; Suffolk Co. v. Hayden, (1), Washburn v. Barbed Wire Co., (2), (3), TWO INTERFERING PATENTS TO SAME INVENTOR; Edison, x. p., (2), Brush Elec. Co. v. Elec. Ac. Co., (5), ORDER OF ISSUE.

3. Defendant's *use* of the patented article estops him from denying its utility.

West. Elec. Co. v. La Rue, U. S. S. C. By *Brown, J.*, 35 L. ed. 294, *.

4. If the defendants have used the plaintiff's invention, or something substantially like it, they are estopped from denying its utility. It is fair to presume that they would not have used it if they thought it of no utility.

Coleman v. Liesor, Leavitt, J., 1859, Law's Digest, 281.

5. Where a patentee, in his application, had claimed a certain construction, and, upon rejection by the Patent Office, erased the claim: *Held*, that he was thereafter estopped from asserting such a claim.

Dodds v. Stoddard, Sage, J., 16 July, 1883, 24 O. G., 799.

The authorities on the doctrine laid down in *Dodds v. Stoddard, supra*, are collected in *Roemer v. Peddie*, *, (72) CLAIM. See also *Sargent v. Hall Safe and Lock Co.*, *, (10) PUBLIC RIGHTS, ETC.

For various applications of the doctrine of estoppel see *Hoeverler & McTighe v. Verner v. Nicholson, Jr.*, (62), and *Del Grande v. Mannie*, (62') INTERFERENCES.

EVIDENCE.

Where the Examiner of Interferences had denied a motion for leave to take testimony abroad, on the ground that the parties had filed a stipulation that the testimony should be taken in St. Louis: *Held*, that as it appeared that the testimony was material, that the party making the motion was acting in good faith and not seeking delay, and that it was impossible to compel the witness's attendance in this country, the strict term of the stipulation should not be insisted on, and that the leave prayed for should be granted.

Leeman v. Smith, Fisher, Act. Com., 27 June, 1890, C. D. Ms.

EXAMINATION.

1. The attitude of the Office toward an applicant should be friendly, — not obstructive.

The Rules of the Office, particularly Rules 68 and 139, point out that, at all times in the investigation of an application and in the progress of appeals, it is the duty of each tribunal having jurisdiction of the case to see to it that the inventor *shall secure a patent* for whatever patentable matter may be shown in his application. As has been frequently stated by me in decisions, the Office must put itself in the attitude of a friend — not of a litigant — with the applicant, and see that he secures every right that belongs to him. I do not mean by this that it is the duty of the Examiner to become an agent or attorney for the applicant; but I think, in all cases where he is satisfied or believes that the application contains patentable matter which is not claimed, *but which he has reason to believe the applicant is seeking*

to cover, it is his duty to advise the applicant briefly and specifically, precisely as the Examiners-in-Chief and the Commissioner are authorized to do, as above stated. By acting on this principle all tribunals of the Office become friendly to the applicant, and enable him to clearly see and understand the views of the Office as to the nature and patentability of the invention described. Such practice would undoubtedly tend to lessen the correspondence and conflicts which arise between applicants or their counsel and the Office.

Donavan, *Hall, Com.*, 9 July, 1888, C. D. 100.

Compare (1) DILATORY METHODS; (2) EXAMINER; and for restriction of above to *ex parte* cases, see OFFICIAL INFORMATION and OFFICIAL SUGGESTIONS.

2. Examiner's action must not be such as would prevent applicant obtaining full investigation of his rights on appeal.

Where the claims were neither lacking in intelligibility or definiteness, and the Examiner declined to consider the merits of certain definitely stated claims for an article of manufacture, for the reason that in his opinion "said claims fail to point out any qualities in the thing claimed which could legitimately be considered in connection with the patentability of an article of manufacture," a petition, on applicant's behalf, praying that the Examiner be "directed to make the examination required by the statute, allowing or rejecting said claim," — was granted.

No requirement of amendment insisted upon, as a condition precedent to further examination, can be either legal or permissible which tends, in the minutest degree, to prevent an applicant from obtaining a full investigation of his rights on appeal.

Rogers, x. p., *Mitchell, Com.*, 16 Nov., 1889, 49 O. G., 1361.

See to same purport; Lapham, x. p., (4) AMENDMENT; and Burt, x. p., (3) *infra*.

3. The Examiner's objections should be fully stated.

It should never be considered a work of supererogation on the part of an Examiner to give an applicant such full and complete information as to objections as will enable him to judge of the propriety of complying with the demands of the Examiner or of taking a petition on appeal.

Burt, x. p., *Fisher, Act. Com.*, 4 Dec., 1889, 49 O. G., 1986.

4. Upon final rejection following a material amendment, applicant has choice of two remedies.

When, after a material amendment, the Examiner rejects without giving new reference or reasons and announces said rejection to be final; and thereafter, applicant offers another amendment, which the Examiner refuses to consider: *Held*, that, the first amendment having been of a material character, applicant was entitled to a reconsideration or to further amend at his discretion, and having elected to take the latter course, the Examiner should have incorporated the amendment and considered the same.

Griswold, x. p., *Mitchell, Com.*, 25 June, 1890, 50 O. G., 838.

5. Examiner may reject a claim, for undue breadth, but may not refuse to entertain it.

Where the Examiner had objected to a claim because of its undue breadth only, and declined to consider it upon "the merits," until it had been restricted in form: *Held*, that the reason given was a reason why the claim should be rejected, but not why an examination should be refused.

Opdyke, x. p., *Mitchell, Com.*, 2 Dec., 1889, 50 O. G., 1293.

6. On petition by applicant for certain action and for advice, the Examiner says that "so far as he is able to

understand applicant's petition, its object appears to be twofold, namely: (i) to compel an action upon the merits of an amendment, which "in the Examiner's opinion "involves a material departure from the invention originally disclosed, and (ii) to obtain an instruction to the Examiner that he shall inform applicant as to what he is entitled to and the words in which it should be embodied, and that Examiner should then allow the case on it." It has been repeatedly held by the Commissioner, that where claims are rejected, they should be rejected for all the reasons which, in the opinion of the Examiner, are applicable, in order that each case may, upon such appeal, take a decided step toward completion (Roberts', x. p., 51 O. G., 155; Wiard, x. p., 51 O. G., 155). If, in the present case, an appeal should be taken upon the question of identity with the invention originally disclosed, and the Examiners-in-Chief should reverse the decision of the Primary Examiner, the question of novelty would remain undisposed of, and further action by the Examiner would be necessitated. Such a situation is to be deprecated, and it has been the uniform ruling of the present Commissioner that *all grounds of objection should be stated*, by the Primary Examiner, *in advance of the appeal*, in order that there may be no necessity to retrace steps for the purpose of considering questions pertaining to the jurisdiction of the inferior tribunal.

As to the second point; the Examiner states that Rule 14 is distinct and reflects the settled practice in stating that the Office cannot act as counsellor for individuals. The language, however, of the rule is that "*except as to questions arising within the Office*," it cannot so act. It is true that the cases are not relatively numerous in which *unsought* advice should be tendered, but *where advice is asked, there is, ordinarily, no reason why it should not be given*. The current practice is laid down by Mr. Commissioner Hall, in Donovan, x. p., (1888, C. D. 100).

In the present case, the Examiner holds that the applicant is entitled to nothing, and such being his opinion, he can, of course, afford the applicant no aid in the way of suggestion or advice.

Bailey, x. p., *Mitchell, Com.*, 10 July, 1890, 52 O. G., 608.
Compare Donovan, x. p., (1) *supra*.

7. An application which described a process but claimed only an article of manufacture produced by said process (which claim was finally rejected on appeal), may be amended by substituting a claim to the process.

An application for a patent which claimed an article of manufacture and which described (without claiming) a process for making it, having been rejected by the Examiner, and said rejection confirmed by the Board and by the Commissioner. was, upon petition by applicant, remanded to the Examiner for examination upon "the merits," in order that, should applicant desire to appeal to the Supreme Court of the District of Columbia, the whole case might go up at once; or so that the applicant might be fully advised of the state of the art before deciding whether to adopt a claim suggested by the Examiners-in-Chief, or a suggestion made by the Commissioner that the proper form of claim was a process.

Rogers, x. p., *Mitchell, Com.*, 16 Nov., 1889, 49 O. G., 1361.

For decision of like purport, see Butterfield and Batchelor, x. p., (2) RE-OPENING OF CASE.

Compare, however, Phelps, x. p., (14) AMENDMENT; Kinzer, x. p., (54) THE CLAIM; Jameson, x. p., (8) REINSTATEMENT OF CLAIM, and numerous cases there cited.

For conditions which permit claim to process and claim to product to be included in one and the same patent, see Blythe, x. p., JOINDER OF PROCESS AND PRODUCT.

8. 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 is corrected in form.

Ib.

See Barrett, x. p., (12) THE CLAIM; Burkhardt, (1) OPERATIVENESS.

9. Examiner's refusal to examine an application as to patentability of invention because applicant had not, in his specification, "particularly pointed out and distinctly claimed the part, improvement, or combination which he claimed as his invention," as required in Section 4888 R. S., was sustained.

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

NOTE. — Applicant's so called "claim" was to a result independent of any specified means or structure.

10. The Examiner in his second action rejected the application *finally*, not on any reference, but because he considered the claims "vague and indefinite," and based his action on ruling in Paige, x. p., 40 O. G., 807. The Assistant Commissioner directed the case to be kept open for further action, and remarked, that the Examiner seemed to have overlooked the fact that since the Paige decision there has been that of the United States Supreme Court in *Morley Sewing Machine Co. v. Lancaster* (47 O. G., 267), *, and those of the Commissioner in *Pacholder*, x. p. (40 C. D. Ms., 299); *Laskey*, x. p. (Ib. 350); and *Weidenbusch*, x. p. (Ib. 412); and that, if the Examiner's objection of vagueness and indefiniteness means that what the claims cover cannot be readily understood, it relates to a question of *form*, and hence is not a ground for final rejection; if, on the other hand, it means that the claims are too broad for allowance, it depends upon the state of the art, and is

an objection which cannot be considered apart from the state of the art.

Anderson, x. p., *Fisher, Act. Com.*, 24 Nov., 1890, C. D. Ms.
Compare Crane, x. p., (8) EXAMINER.

11. The fact that the Examiner, in the progress of the case, has once allowed a claim, is no reason why he should not subsequently reject it if necessity should demand such action.

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

12. Where applicant has two or more cotemporary applications for the same invention.

A pending application is in no-wise affected by the entry of a second or any subsequent application for the same invention by the same inventor. There is no abandonment of the earlier case, and all the applications are to be treated as if filed by independent inventors. If, however, a patent issues upon one of the applications, no claim will be allowed thereafter in the remaining case or cases which covers subject-matter set forth in the patent.

Langlois, x. p., *Spear, Com.*, 27 Feb., 1878, 14 O. G., 84.

Compare Smith, x. p., (4) THE APPLICATION; and *The Suffolk Co. v. Hayden*, ✽, (1), and *The Washburn Co. v. The Barbed Wire Co.*, ✽, (2), TWO INTERFERING PATENTS TO SAME INVENTOR. See also Gabouri, x. p., (13), and Feister, x. p., (14), *infra*.

13. The bare fact that one application is pending when another is filed [by the same applicant for the same invention] constitutes no reason for refusal or rejection of the second case, providing it has reached condition for action; but after one application, which describes and claims a particular invention or a particular feature, has been passed to issue, no other application

which describes and claims the same invention or feature should be passed.

Gabouri, x. p., *Montgomery, Com.*, 31 July, 1886, 37 O. G., 217.

14. Where an applicant has two applications pending which contain substantially the same claims, the Examiner should not require formal abandonment of one application as the condition of allowing the other to proceed to issue, nor should he require the erasure of any claims which would be allowed if no other application awaited consideration (Langlois, x. p., 14 O. G., 84). The true course for the Examiner is pointed out in Gabouri, x. p., (37 O. G., 217). In the case of Smith, x. p., (44 O. G., 183) relied on by the Examiner, the Commissioner, in that case, — although holding that the Examiner ought not to be required to proceed with all the applications, allowing or rejecting them as if they were by different inventors, — *did not decide that the applicant could be required to cancel one or more claims in the allowed application, or to abandon one or more of the other applications, as a condition precedent to such allowance.*

Feister, x. p., *Mitchell, Com.*, 31 Oct., 1890, 53 O. G., 1089.

See COMMISSIONER, ETC.; EXAMINER; OFFICE PRACTICE.

EXAMINER.

1. Ordinarily; requirement of division should precede action on the merits.

The Examiner states that the subject-matter of the amendment was such that, had it been presented in the original application, division would have been required. If such be the fact, he should, instead of incorporating the amendment and then rejecting it, have declined to incorporate it, so that, upon petition to the commis-

sioner, the question of division could have been disposed of (Regan, x. p., 188 C. D. 161).

Bailey, x. p., *Mitchell, Com.*, 10 July, 1890, 52 O. G., 608.

2. Examiners should not unnecessarily protract the examination and proceedings in the application; it should, on the contrary, be his aim to afford every facility to the applicant consistent with the rights of others.

The application, although coming before me as if it were a petition, is in fact a complaint made against the Examiner, reciting the several actions in the case which are claimed to constitute improper and oppressive practice. Without minutely inspecting the several items of the charge, I cannot resist the impression — and it is a very decided impression — that there is ground for the complaint, and it is a matter of regret, that after my predecessor had been called upon to act in this case and had made a decision, which to my mind indicates that he was clearly of the same opinion that I am compelled to entertain, the Examiner should not have taken steps to hasten rather than to protract the examination and proceedings in the application. I am not satisfied with the Examiner's explanation. Making due allowance for all obstacles, I have no doubt whatever that this case should have been in condition for allowance or for appeal to the Examiners-in-Chief, if it had been the aim of the Examiner to afford every facility to the applicant consistent with the rights of others.

Steps will be taken at once — if they have not been already taken — to put this application in condition for allowance or appeal.

Anderson, x. p., *Mitchell, Com.*, 12 June, 1889, 47 O. G., 1633.

See, of like tenor, Williamson, x. p., (1) DILATORY METHODS.

3. References should be given in detail.

On petition from applicant [objecting to want of particularity in the official letter]; the Examiner was instructed to point out the specific portions of the descriptions and drawings in the references which, in his opinion, disclose applicant's invention in whole or part, as directed in Rule 65, in order that applicant may see his way clear to withdraw or modify [or persist in?] his claims.

Goodline, x. p., *Mitchell, Com.*, 21 Feb., 1890, C. D. Ms.

4. Newly Discovered References.

The proper course to be pursued by an Examiner, on discovering a new ground for rejection subsequent to an appeal to the Examiners-in-Chief, is to direct the attention to it of both applicant and the Examiners-in-Chief. The applicant may then elect to continue the prosecution of the appeal, or to withdraw the appeal and be heard by the Primary Examiner.

Mevey, x. p., *Mitchell, Com.*, 19 Ap., 1890, 56 O. G., 805.

Compare Roach, x. p., (5), and Robbins, x. p., (6) *infra*; Clouser, x. p., (11) EXAMINATION, and Ries, x. p., REMANDMENT TO PRIMARY EXAMINER.

As to the particularity required of applicant, see Raymond, x. p., (9) EXAMINATION, and Kalteyer *et al*, EXPLICITNESS.

5. If, subsequent to filing of the appeal, the Examiner discover a further reference, or should an additional reason for rejection come to him in any way, he should notify the applicant and the Examiners-in-Chief (Mevey, x. p., 43 Ms., 33).

Roach, x. p., *Mitchell, Com.*, 9 Oct., 1890, C. D. Ms.

6. Res Adjudicata.

Nothing done by the Examiner can be considered as *res adjudicata* until the case has passed beyond his juris-

diction, and, until the Examiner has signed the file-wrapper, he cannot be said to have rendered a favorable decision. The office of the Examiner is continuing, and no Examiner is concluded by any action of his predecessor before the case has passed to issue (Fredericks & Burns, x. p., 1887, C. D. 66).

Robbins, x. p., *Fisher, Act. Com.*, 28 Feb., 1891, C. D. Ms.
Compare Roach, x. p., (11) *infra*.

7. Examiner's statement of appeal must cover all his objections.

Where one of the objections made by the Examiner was not touched upon in his statement: *Held*, that it was not necessary to consider the objections further.

McMillen & Hurst, x. p., *Frothingham, Act. Com.*, 12 Oct., 1891, C. D. Ms.

8. It is within the province of the Examiner's duties to call applicant's attention to such irregularities and informalities in claims as, in his opinion, should be corrected.

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

Compare Pacholder (1) and cases following it in PHRASEOLOGY. Also see Noyes, x. p., (9), and Atkinson, x. p., (11), THE SPECIFICATION.

9. Opinion on Fact.

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

Hine, x. p., *Simonds, Com.*, 14 July, 1892, 60 O. G., 576.

10. When a rejected application has passed all the stages specified in Rule 134, and the appeal has been

decided by the Primary Examiner to be regular in form, nothing remains for him to do — unless an amendment has been admitted under the appropriate provision of Rule 68 — except to furnish the Examiners-in-Chief with a written statement of the grounds of his decision and of the points involved in the appeal, with copies of the rejected claims and the references applicable thereto (Rule 135).

Roach, x. p., *Mitchell, Com.*, 9 Oct., 1890, C. D. Ms.

11. On transfer of a case to another division all duties devolve on the new Examiner.

When, after application has been twice rejected and an appeal taken, the application is transferred to another division, all duties of the Primary Examiner in connection with that case devolve on the Examiner in charge of that division.

Ib.

Compare Robbins, x. p., (6) *supra*.

See COMMISSIONER, ETC.; OFFICE PRACTICE.

EXECUTION.

Court may enforce transfer of a patent-right to satisfy a judgment debt.

A patent-right may be subjected by a bill in equity to a decree for assignment to satisfy a judgment debt of patentee. On neglect of the latter to assign as decreed, the court may appoint a trustee to execute an assignment in conformity with the statutory requirements for such transfer.

Alger v. Murray, U. S. S. C. By *Gray, J.*, 6 Mar., 1882, 21 O. G., 1197, *.

EXECUTOR.

See DECEASE OF INVENTOR.

EXECUTORY AGREEMENT.

A party who bases his rights, as an assignee, upon an instrument of writing, recorded in the Patent Office before application was made, and which does not explicitly identify a given invention, will not be permitted to examine the files, because such an instrument is not an assignment, but a mere *executory agreement*. The language in case of *Wright v. Randall* was used with reference to facts which make it exactly applicable to this case. No assignment of an unpatented invention is required, by Section 4895, R. S., to be recorded, unless it is an assignment on which a patent is to be issued to the assignee, and, in such a case, the invention must be so *identified in the assignment, by reference to a specification, or otherwise, that there can be no mistake as to what particular invention is intended* (*Wright v. Randall*, 14 Blatchford, 495; *Regan Vapor Engine Co. v. Pacific Gas Engine Co. et al.*, 58 O. G., 1695).

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

EX-PARTE APPLICATION.

No counter claimant and no prior patent, publication, or practice appearing; an application which clearly describes and distinctly claims a new and useful invention entitles the applicant to a patent therefor.

Sections 4887, 4888, and 4904 Revised Statutes.

EXPERIMENT.

See *Chipman v. Fales*, (1) ABANDONED EXPERIMENTS; *City of Elizabeth v. Nicholson Pavement Co.*, (9) DILIGENCE; *Root v. Third Avenue R. R. Co.*, (1) PUBLIC USE; *Bentley v. Wightman v. Sprague*, (13) REDUCTION TO PRACTICE.

ÉXPÉRTS.

1. The refusal of the Court below to hear the opinion of experts as to the construction of the patent was proper. Experts may be examined as to the meaning of terms of art, on the principle of *cuique in sua arte perito credendum*, but not as to the construction of written instruments.

Corning *v.* Burden, U. S. S. C. By *Grier, J.*, 15 Howard, 252, *.

2. 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 168, and case of *Parker*, x. p.).

Anderson, x. p., *Fisher, Act. Com.*, 18 Feb., 1890, C. D. Ms.

3. The Primary Examiner is presumed to be an expert, and is the proper judge of the sufficiency of description of an invention pertaining to his class of subjects.

Prochaska, x. p., *Frothingham, Act. Com.*, 31 Oct., 1891, C. D. Ms.

Compare *Franklin*, x. p., (3), and *Holt*, x. p., (4), THE CLAIM; *Rogers*, x. p., (8), and *Raymond*, x. p., (9), EXAMINATION; and *Crane*, x. p., (8) EXAMINER. See also *Kalteyer et al.*, x. p., EXPLICITNESS.

EXPLICITNESS.

The explicitness required in a patent claim is well illustrated by comparing with the claims originally presented by *Kalteyer & Bartholomew, Jr.*, of the re-

vised claims substituted in conformity with a suggestion of the Commissioner.

(The qualifying words, inserted at the Commissioner's suggestion, are in italics.)

ORIGINAL CLAIMS.

1. In the process of preparing and tempering slurry for Portland cement; the process of mixing and correcting the proportions, which consists of taking soft, damp, or wet, freshly-dug, and unprepared clay, and soft, damp, or wet, freshly-dug, and unprepared calcareous material, mixing and working the same when fresh, testing a portion thereof to ascertain the proportion of the mass, and then, if necessary, correcting the proportions by adding material, as described.

2. In the manufacture of Portland cement; the process of preparing and tempering slurry, which consists in weighing the freshly-dug clay and limy materials, mixing and working them when soft, damp, or wet, testing a portion of the mass, and, if necessary, adding material thereto, as described.

CLAIMS AFTER REVISION.

1. In the process of preparing and tempering slurry for Portland cement; the process of mixing and correcting the proportions, which consists of taking soft, damp, or wet, freshly-dug, and unprepared clay, and soft, damp, or wet, freshly-dug, and unprepared calcareous material, *in approximately the proportions herein set forth*, mixing and working the same when fresh, testing a portion thereof to ascertain the proportion of the mass, and then, if necessary, correcting the proportions by adding material, as described.

2. In the manufacture of Portland cement; the process of preparing and tempering slurry, which consists in mixing, *in proportions determined by weight*, the freshly-dug clay and limy materials, working them when soft, damp, or wet, testing a portion of the *mixed mass to determine proportions*, and, if necessary, adding material *to attain the desired proportions*, substantially as described.

Kalteyer *et al.*, x. p., *Simonds, Com.*, 18 Aug., 1891, 57 O. G., 1127.

Compare Franklin, x. p., (3), and Holt, x. p., (4), THE CLAIM.

EXTENSION.

The statutory provisions to enable (under certain showings) prolongation of the term of a U. S. patent for invention, ceased 2 Mar., 1875.

R. S. 4924.

EXTENT OF USE.

Where the question is upon the patentable character of the invention, evidence that it had practically superseded all other devices of its kind, with the object of establishing patentable novelty, is not material. Where there is no invention the extent of use is not a matter of moment.

Adams v. Bellaire Stamping Co. et al., U. S. S. C. By *Field, J.*, 16 Nov., 1891, 57 O. G., 1280, *.

Compare *Bruce v. Marder*, (1) UTILITY, — and cases following it.

FEES.**1. Patent Office not an Instrument of Revenue.**

While it is true that a fee accompanies each application filed, it must be borne in mind that the Patent Office does not proceed on the principle of a tax-gatherer or a store-keeper, and will not, for the mere purpose of swelling the amount of its receipts, countenance promiscuous filing of applications.

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

2. Where a new fee on a second appeal is not required.

Where, upon appeal to the Examiners-in-Chief, they rejected one of the claims upon the ground that it was “too indefinite and broad,” — a reason for rejection not raised by the Primary Examiner, — and applicant was permitted by the Commissioner to incorporate into the case another claim in place of said claim, and the Examiner rejected the new claim as being “even more broad and indefinite” than its predecessor, but refused to take action on an appeal from that rejection until another appeal fee had been paid: *Held*, that under

the facts of the case a new fee is not required, and the appeal should be transmitted.

Thomson, x. p., *Frothingham, Act. Com.*, 10 July, 1891, C. D. Ms.

3. Money paid by actual mistake, such as a payment in excess, or when not required by law, or consequent on neglect or misinformation on the part of the Office, will be refunded; but a mere change of purpose after the payment of the money, as when a party desires to withdraw his application for a patent or for a registration of a trade-mark, or to withdraw an appeal, will not entitle a party to demand such a return.

(P. O. R., 224.)

4. Where, after Examiner's rejection of a claim upon certain references, and after reversal of his decision by the Examiners-in-Chief, the Examiner again rejected the claim, upon a newly discovered reference, and applicants, considering the new reference an anticipation, cancelled the claim: *Held*, that their petition to have the appeal fee refunded could not be granted.

Ellis & Spence, x. p., *Frothingham, Act. Com.*, 29 May, 1891, C. D. Ms.

For like action, see Cunningham, x. p., ERROR OF JUDGMENT.

5. Where an attorney advanced the registration fee for a trade-mark, and shortly after, upon learning that the applicant was insolvent, requested leave to withdraw the application and asked for return of the fee: *Held*, that the payment was constructively a payment by the applicant, and that, therefore, under the established practice, the fee could not be refunded nor the application withdrawn.

The Empire City Elec. Co., x. p., *Frothingham, Act. Com.*, 6 Aug., 1891, C. D. Ms.

For like action in similar cases, see (6), (7), (8), and (9) *infra*.

6. Where, after several actions, Examiner held that the matter was not a proper subject for design patent: *Held*, that the fee of thirty dollars could not be refunded (Bailey, x. p., 1886, C. D. 39; Baer, x. p., 42 C. D., Ms. 106; Sellers, x. p., 1870, C. D. 58).

Wilson, x. p., *Frothingham, Act. Com.*, 6 Feb., 1892, C. D. Ms.

7. Applicant filed two applications for designs which were substantially the same, one for a "tablet" and the other for "soap," and (after they had been prosecuted to rejection, and, finally, became abandoned for want of prosecution) applied for a return of the fee paid on one of them, on the ground of mistake, and that it should be repaid under Rule 224 and Carty, x. p., 44 O. G., 570: *Held*, that it was clear that both applications had been filed on the theory that both were necessary to adequate protection; it was not a payment by mistake, but an intentional payment, and therefore not a case similar to that of Carty, x. p., *supra*, where the Office held that a fee accompanying a caveat for a design should be returned. There was no authority of law for filing a caveat for a design, but there is authority for filing *applications* for designs.

Chidester, x. p., *Frothingham, Act. Com.*, 28 Mar., 1892, C. D. Ms.

8. Where, upon Examiner requiring division of a joint application, an application, intended to be a divisional one, was inadvertently made a sole application by one of the co-inventors: *Held*, that the application could not be charged to, nor its fee applied to, a joint application. In this case the Acting Commissioner said: I find that this question has been passed upon by three Com-

missioners, and that they have all decided that *where the case had gone forward to the Examiner and had received action by him*, new parties could not be substituted in place of the old (Maxheimer & Trubey, x. p., 19 C. D. Ms., 155; Wilder & Kauffer, x. p., 33 C. D. Ms., 457; Hincley, x. p., 36 C. D. Ms., 486).

Hogan, x. p., *Fisher, Act. Com.*, 9 May, 1890, C. D. Ms.

9. 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 fee paid on the first application could not be applied to the second application, as the case came within the principle laid down in Hogan, x. p., 9 May, 1890.

Sereno N. Ayres, x. p., *Fisher, Act. Com.*, 13 May, 1890, 51 O. G., 1944.

"FEIGNED ISSUE."

An interference may be regarded in the light of a "feigned issue" out of chancery for the determination of a particular question, and when justice requires it, other questions can, meanwhile, be allowed to remain unsettled.

Hunter, Jr. v. Lane, *Simonds, Com.*, 3 June, 1892, C. D. Ms.

Compare Atkinson v. Bentley, (6) INOPERATIVENESS, and Hunter, Jr. v. Lane, (65) Prowattain v. Holt, (111) INTERFERENCES.

FIRST INVENTOR'S RIGHTS.

Double Use.

The principle that the inventor of a machine is entitled to the benefit of all the uses to which it can be put, — no matter whether he had contemplated that particular use or not (Roberts v. Ryer, 91 U. S. 150, *; Stone v. Chicago, 104 U. S. 547), *, applies both to pre-

venting a mere double use of an old thing being patented, and also to giving the first inventor the exclusive use of the thing invented for all purposes and uses to which it can be put.

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

Compare, of like purport, (38) *et seq.*, THE CLAIM.

FOREIGN APPLICANT.

1. Oath of invention taken abroad, by an applicant for a United States patent, must be taken before one of the kinds of officers designated in Section 4892 R. S., to wit: any minister, *chargé d'affaires*, consul, or commercial agent, holding commission under the government of the United States; or before a notary public of the country in which the applicant may be.

Gruson & Schumann, x. p., *Butterworth, Com.*, 5 Jan., 1884, 26 O. G., 274.

2. The validity of a United States patent is not made dependent on the putting the invention into use either before or after obtaining a patent, and, as it is required that a foreign patent or printed publication shall fully, clearly, and exactly describe the invention in issue before it can be considered as evidence at all, it must be held that where these requirements are complied with, the patent or publication is evidence of a perfected invention. (*Deprez & Carpentier v. Bernstein v. Hunter v. Gaulard & Gibbs*, 54 O. G., 1709).

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

3. A foreign contestant in an interference proceeding cannot set up the date of his invention or the practice thereof in a foreign country. He must rely either upon a foreign patent or printed publication, or upon the knowledge or use of the invention in the United States.

Ib.

FOREIGN PATENT.

1. The tribunals of every nation take judicial notice of the public seals of foreign states, and the seal will be presumed to have been attached by a person having custody thereof and competent to do the act.

Edison Elec. Lt. Co. *v.* U. S. Elec. Lt. Co., *Wallace, J.*, 1888, 43 O. G., 1456.

2. Rights under a Foreign Patent not recordable in the United States Patent Office.

Request to record assignment of certain foreign patents was denied. Foreign patents are not, in terms, within the statutory provisions of the United States relating to the recording of assignments, and cannot be included by implication.

Dodge & Son, *x. p.*, *Mitchell, Com.*, 27 Nov., 1889, C. D. Ms.

3. The Commissioner has no authority, under Section 4887 R. S., to grant a U. S. patent for an invention described in an expired foreign patent, and a patent so granted is without authority of law and void.

Huber *v.* Nelson M'fg Co., *Thayer, J.*, 38 F. R., 830.

FOREIGN USE.

Previous use of the invention abroad does not invalidate a United States patent.

In the absence of either a patent or a printed publication, the use of the invention in a foreign country, or the knowledge of such foreign use by persons residing in this country, will not defeat a U. S. patent granted to a *bona fide* inventor, who at the time, was ignorant of such foreign use or existence of the invention.

Coburn *v.* Schroeder, *Wheeler, J.*, 8 Mar., 1882, 22 O. G., 419.

See, also, *Schillinger v. The Greenway Brewing Co.*, 24 O. G., 495; *Illingworth v. Spaulding*, 27 O. G., 300; and *Brown et al. v. Bixby*, 57 O. G., 123.

FOREIGN VESSEL.

The right of a U. S. patentee does not extend to a foreign vessel lawfully entering one of our ports; and the use of the improvement in the construction, fitting out, or equipment of such vessel abroad, is not an infringement of the rights of an American patentee.

Brown v. Duchesne, U. S. S. C. By *Taney, Ch. J.*, Dec. term, 1856, 19 Howard, 183, *.

FORFEITED APPLICATION.

See ABANDONMENT OF AN APPLICATION; FORFEITURE; RE-INSTATEMENT OF FORFEITED APPLICATION.

FORFEITURE.

1. Of Application.

Where it appeared that, upon the last day upon which an application could be prosecuted without forfeiture, amendments, apparently of no considerable importance, were offered, including one or two formal corrections which had been called for by the Examiner, and that said amendments were made in good faith for the purpose of prosecuting the application: *Held*, that the action, so far as it went, was a proper action, and that there was not such utter failure to prosecute within two years as would warrant a judgment forfeiting rights.

Todd, x. p., *Mitchell, Com.*, 21 Oct., 1889, 49 O. G., 732.

2. Where the Examiner required a model, and, thereafter, applicant took no action until more than two years had elapsed, when he filed a petition to revive the

application, and the affidavit in support of the petition set forth that petitioner had been unable, for lack of money, to prosecute his application or to procure a model; that during a portion of the time he had been sick; that he lived in a section of the country provided with few facilities for mechanical construction, and few skilled artisans; that his solicitor lived in New York, while he lived in North Carolina, and that, consequently, communication had to be carried on with said solicitor exclusively through the mails: *Held*, that the statement did not make out such a case of *unavoidable* delay as the statute requires (Waite, x. p., 39 C. D. Ms., 431).

Cushman, x. p., *Fisher, Act. Com.*, 25 Oct., 1889, C. D. Ms.

3. Assignee.

The right to renew an application which has become forfeited by failure to pay the final fee in season, is not limited to the inventor; an assignee has that right (Section 4897 R. S.).

Barrett, x. p., *Frothingham, Act. Com.*, 14 Mar., 1891, 56 O. G., 930.

4. It has been uniformly held by the Office that, under Section 4885 R. S., or otherwise, the Commissioner has no discretion to receive the final fee later than six months after notice of allowance: *Hence*, where the last day was 30 Nov., and petition alleged that the fee was duly mailed Saturday, 29 Nov., and, presumably, lay in the Patent Office or Post-Office over Sunday, and it appeared that it was not received by the Patent Office until Monday, 1 Dec., petition to have it counted as received in time was denied.

Riley, x. p., *Frothingham, Act. Com.*, 13 Ap., 1891, C. D. Ms.

See ABANDONMENT; DEDICATION; DILATORY METHODS; DILIGENCE; LACHES; PUBLIC USE.

FORM.

See **MATTER OF FORM.**

FUNCTION.

1. It is proper to indicate the function which the parts of a device perform, provided the parts themselves are properly included in the combination.

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

See also Raymond, x. p., (14), Thompson, x. p., (15), **THE CLAIM.**

2. While the promotion of an old device (such, for example, as a torsional spring) to suit a new sphere of action in which it performs a new function, involves invention, the transfer or adaptation of the same device to a similar sphere of action, where it performs substantially the same function, does not involve invention.

Western Elec. Co. v. La Rue, U. S. S. C. By *Brown, J.*, 13 Ap., 1891, 55 O. G., 571, *.

For definition of the word "function," as used in patent jurisprudence, see *Corning v. Burden*, (48) **THE CLAIM.**

FUNCTIONAL CLAIM.

See **FUNCTION**, and (29) *et seq.*, **THE CLAIM.**

GOVERNMENT EMPLOYÉS.

1. The Secretary of the Interior and the Commissioner of Patents are authorized to grant any officer of the Government (except officers and employés of the Patent Office) a patent for any invention of the classes mentioned in Section 4886 R. S., — when such invention is to be used in the public service, — without the payment of any fee: provided that the applicant, in his

application, shall state that the invention described therein, if patented, may be used by the Government or any of its officers or employés in the prosecution of work for the Government, or *by any other person in the United States* [sic!], without the payment to him [the patentee] of any royalty thereon; which stipulation shall be included in the patent.

Act 3 Mar., 1883, c. 143., U. S. Stat. XXII., p. 625.

2. No officer or employé of the Patent Office, during the period for which he holds his appointment, may acquire or take, directly or indirectly, — except by inheritance or bequest, — any right or interest in any United States patent [for invention].

Section 480 R. S.

GOVERNMENT USE.

1. A patent right cannot be made use of by the Government, any more than it could by a private individual, without license from the inventor.

McKeever v. The United States, U. S. Court of Claims. By *Nott, J.*, 12 May, 1879, 23 O. G., 1525. Judgment affirmed by the Supreme Court of the United States 20 Nov., 1882.*

Compare (3) *infra*.

2. Where there was clearly a contract (expressed or implied) between the Government and the citizen, and the suit is brought entirely on that agreement, the Court of Claims has the exclusive [original] jurisdiction.

Ib.

Compare *Solomons v. U. S.*, (4) CONSTRUCTIVE LICENSE.

3. The Government has no more power to appropriate a man's property invested in a patent than it has to take his property invested in real estate; nor does the mere

fact that the inventor was, at the time of the invention, in the employ of the Government transfer to it any title or interest therein.

Solomons v. The United States, U. S. Court of Claims. By *Brewer, J.*, 8 Dec., 1890, 34 L. ed. 667.

HEARINGS.

All hearings in the U. S. Patent Office are had on the day designated in the official notice, and, unless otherwise specified, at the hour of 10 A. M. if before the Commissioner or Assistant Commissioner, and at the hour of 1 P. M. if before the Examiner of Interferences or the Examiners-in-Chief. Hearing before a Primary Examiner is had at the day and hour designated by him.

P. O. R., 151.

IDENTITY.

Of Specific Machine.

A party who, during the original term of the patent, possessed the right to use a specific planing machine does not forfeit that right by an extension of the term of the patent (*Wilson v. Rousseau*, 4 Howard, 646, *); nor is the right forfeited by the substitution of fresh knives for old and wornout ones.

Wilson v. Simpson, U. S. S. C. By *Wayne, J.*, Dec. term, 1849, 18 Curtis, 58, *.

Compare (1) CONSTRUCTIVE LICENSE.

For tests of identity of subjects-matter of two patents, see *Brush Elec. Ac. Co. v. Elec. Ac. Co. et al.*, (10) TERM OF A U. S. PATENT.

IGNORANCE NOT PLEADABLE.**1. Ignorance of the Law, the Practice, or Accessible Facts, — not Pleadable.**

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.

2. Where it was urged, on behalf of a motion for permission to amend the preliminary statement, that applicant had obtained the impression that, for the date of the [nascent] invention, he could go back only to the period at which he exhibited a drawing disclosing it : *Held* insufficient, and permission to amend denied.

Parker v. Jarvis, *Fisher, Act. Com.*, 28 July, 1891, C. D. Ms.

3. 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 of such payment, the case must be considered abandoned.

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

4. An applicant who, to save expense, employs counsel unfamiliar with interference proceedings to take testimony, cannot, — after discovering that he has not made out his case in such a manner as he might if the testimony had been taken by counsel familiar with such proceedings, — be allowed to retake the testimony (*Donellan v. Barry*, 37 C. D. Ms., 386).

Ricker v. Merrill, *Fisher, Act. Com.*, 24 July, 1890, C. D. Ms.

5. There is no showing that the testimony now sought to be introduced is newly discovered, or that, by the aid of competent counsel, it could not have been presented within the time originally allowed. . . . A practice which would permit a contestant to experimentally conduct his own case to a probable failure, and then, after consultation and with competent assistance, would permit him to make further endeavors to show what, — with such assistance, — he could and should have earlier shown, would be contrary to all well established rules and legal principles. Applicant's petition must be denied.

Donellan v. Barry, Hall, Com., 37 C. D. Ms., 386.

Of same general tenor, see Jameson, x. p., (1) ESTOPPEL.

For circumstances held to justify a relaxation of above general rule, see Marx, x. p., (5), and Pennington, x. p., (7) RE-INSTATEMENT.

IMPORTATION OF PATENTED ARTICLE.

No Jurisdiction for Prevention of.

The Treasury Department has no means of preventing the importation of goods which do not copy or simulate the name or trade-mark of any domestic manufacturer, although such goods may be an infringement upon a domestic patent.

Treasury notice, *Tichenor, Assistant Secretary of the Treasury*, 26 June, 1889.

NOTE:— A use or sale of such imported goods would, of course, be actionable.

Compare (52) TRADE-MARK.

IMPROVEMENTS.

The inventor has an equal right with any one else to patent improvements upon an original invention for which he is seeking a patent.

Schickner, x. p., Mitchell, Com., 17 June, 1890, C. D. Ms.

INADVERTENCE.

The question whether the facts set forth in the statement filed with a reissue application constitute "inadvertence, accident, or mistake," is one pertaining to "the merits," and is appealable, in the first instance, to the Examiners-in-Chief.

Murphy & Atkinson, x. p., *Simonds, Com.*, 10 Sep., 1891, 56 O. G., 1449.

INCIPIENT INVENTION.

See CONCEPTION; also see, INFANCY OF AN ART.

Compare INVENTION (Basic; Creative; Dominant; Embryo; Fundamental; Generic; Germinal; Pioneer; Primary).

INDIVISIBILITY.

A second patent will not be granted for substantially the same invention, from which it is distinguished only by mental figments.

Where an application was rejected on a patent granted to same applicant the application for which was pending concurrently with the present application, and it appeared that the claims of said patent and said application covered the same invention under a slightly different guise, and that the case was one in which the lines of division between the supposed different inventions existed as mental figments only, and had no corresponding existence in the concrete subjects of invention: *Held*, that the application was rightly rejected because of want of distinguishability of the invention from that claimed in the said patent.

Woodward, x. p., *Mitchell, Com.*, 30 Oct., 1890, 53 O. G., 1090.

Compare *Brush Elec. Co. v. Elec. Ac. Co.* (60) THE CLAIM; also *Faure*, x. p., (12), and *Barrett*, x. p., (14), PUB. RIGHTS, ETC.

INFANCY OF AN ART.

For germinal inventions, broad and comprehensive claims are permissible. Claims for improvements at a maturer stage of the art must be drawn subject to all reasonable restrictions.

In the case of patents which represent the infancy of an art or the stage of its earliest development, this Office is solicitous that the inventor should be accorded a breadth of claim, which is commensurate with the breadth 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 function as the protector of the inventor, leave something to the salutary and benignant agency of construction in the courts. It is the object of the law, and should be the solicitude of the Patent Office, to protect inventors and guard their inventions. In the case of patents which represent the maturity of an art, that object is best secured by taking care that claims for improvements in such an art be drawn with all the 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.

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

INFRINGEMENT.

1. Any use of the invention, even though it may be a new use, constitutes an infringement.

The adaptation of a patented device to another use, where such adaptation does not involve the exercise of the inventive faculty, is an infringement, as much as

though the new machine were an exact copy of the old.

Western Elec. Co. v. La Rue, U. S. S. C. By *Brown, J.*, 13 Ap., 1891, 35 L. ed., 294; 55 O. G., 571, *.

Of same purport, see *Nat. Type Co. v. N. Y. Type Co.*, (29) and cases following it, **THE CLAIM**; and Dalton, x. p., **FIRST INVENTOR'S RIGHTS**.

2. When a patent is for a combination, one element of which is a gear-wheel with a cone supported in a peculiar manner, and the defendant uses the gear-wheel with the cone, but the latter is supported differently, though the elements employed by the defendant are the equivalent of those of the complainant in the patented combination: *Held*, that the defendant takes the complainant's combination and infringes his patent.

Mundy v. Lidgerwood M'f'g Co., *Wheeler, J.*, 23 Ap., 1884, 27 O. G., 718.

3. Makers of separate parts of a patented device (said parts not being capable of separate use) are joint trespassers.

Where one party manufactures one portion of the device covered by a combination claim, and another party manufactures the other part of the combination, and it does not appear that the two parts are capable of separate use: *Held*, that the parties are joint infringers, and the defendants cannot protect themselves by invoking the well-stated rule that, where a patent is for a combination merely it is not infringed by a party who uses one or more of the parts, but not all, to produce the same results, either by themselves or by the aid of other devices.

Schneider v. Poultry, *Nixon, J.*, 30 Aug., 1884, 29 O. G., 84. See also 21 O. G., 1876; 27 O. G., 718.

4. The part manufacture of lens-holders, not themselves constituting an infringement, with intent to complete into the patented article immediately on the expiration of the patent, will not be enjoined, as complainant's monopoly exists only during the life of his patent.

White v. Walbridge, U. S. C. C., Vt., *Wheeler, J.*, 46 F. R., 526.

5. It constitutes an infringement to manufacture for the purpose of use, even if not actually used.

Butz Thomas Elec. Co. v. Jacobs Elec. Co., *Jenkins, J.*, 1 Oct., 1888, 45 O. G., 835.

6. The mere fact that a person sells an article to which a patented device may be attached does not make him an infringer, providing the article is not so constructed that the patent device and no other can be used with it.

Bliss v. Merrill, 1888, C. D. 182.

See also *Schmidt v. Freese*, 21 O. G., 1876.

7. To constitute infringement it must appear that all the elements of a patentable combination, or their equivalents, have been appropriated.

Saladee v. Racine Wagon & Carriage Co., *Dyer, J.*, 28 Ap., 1884, 27 O. G., 1133.

8. The scope of a patented invention may be so narrowed by the prior state of the art that infringement cannot be adjudged to exist, unless there has been an appropriation, in substantial form, of the construction of the identical elements which the inventor had a right to claim as new in his patent.

Ib.

9. The burden of proof is upon the defendant to show that the complainant is not the first inventor, and mere preponderance of the evidence in that direction is not enough. The proof must be of such convincing character as to satisfy the court beyond a doubt.

Warwick M'fg Co. *v.* City of Buffalo, *Coxe, J.*, 8 May, 1884, 27 O. G., 1239.

10. Mere colorable differences or slight improvements cannot shake the right of the original inventor.

2 Gallison, 54.

11. Where the result was the same but the means employed were different, there was no infringement.

Where the defendant substituted for one element of the combination another element, whereby the same result was accomplished, but in a manner different from that described in the patent: *Held*, there was no infringement.

Schmidt v. Freese, Benedict, J., 10 May, 1882, 21 O. G., 1876.

Compare *Kuhl v. Miller*, (6), and *Coleman v. Liesor*, (7)
EQUIVALENTS.

12. Defendant can be compelled to give the name of one customer to whom he has sold the alleged infringing article.

Roberts v. Walley, Coxe, J., Oct., 1882, 26 O. G., 107.

13. Where a device made under one patent has been adjudged to be an infringement of another patent, and where subsequently the interests in both patents became united in one person, the infringing invention may be held to be an improvement of the other as against a person infringing both patents.

Putnam et al. v. Keystone Bottle Stopper Co. et al., Acheson, J., 22 Mar., 1889, 38 F. R., 234.

14. The patentee's omission of mark does not exonerate a wilful infringer.

The court will proceed upon the hypothesis that the burden of averring and proving a failure to mark is on the defendant, and, if defendant was notified of patentee's claim, such omission of marking will not exonerate him.

Schofield et al. v. Dunlop et al., U. S. C. C., E. D. Pa., *Butler, J.*, 9 May, 1890, 42 F. R., 323.

INHERENT RIGHTS.

1. The patent is a contract between the patentee and the general public.

The productions of my mind are, confessedly, as really property, or the subject of property, as the fabrics of my hand; indeed, they are much more exclusively my own. The patent is a contract by which I convey my invention to the commonwealth forever, in consideration of the exclusive enjoyment of it by myself during a limited period.

William H. Seward, in argument before *Nelson, J.*

2. 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.

Argument of Daniel Webster in the case of *Goodyear v. Day*.

See INVENTION; PATENT FRANCHISE; PUBLIC RIGHTS AND OBLIGATIONS.

INOPERATIVENESS.**1. A Question of "Merits."**

The question of operativeness is one which goes to "the merits" of the invention, and, from rejection on this ground, appeal lies to the Examiners-in-Chief.

Ferguson, x. p., *Frothingham, Act. Com.*, 3 Sep., 1891, 56 O. G., 1334.

2. Inoperativeness is a ground for rejection which always implies an examination. It is, however, never ground for refusing to conduct an examination.

Robbins, x. p., *Mitchell, Com.*, 16 July, 1890, C. D. Ms.

3. Upon a petition from the Examiner's requirement of a model: *Held*, that as the Examiner stated that he merely wanted it as an *exhibit*, it is clear that the requirement was not made under Rule 56, and, as the applicant was unwilling to furnish the exhibit, the Examiner should reject the claims for inoperativeness (Rule 133; Ferguson, x. p., 56 O. G., 1334).

Corson, x. p., *Frothingham, Act. Com.*, 26 Feb., 1892, 43 C. D. Ms., 26.

4. Where the Examiner admitted the novelty of the device, but, doubting its operativeness, required evidence that it could be made to work: *Held*, that, inoperativeness being ground for rejection and appeal under Rule 133, the Examiner, when questioning the operativeness of the alleged invention, should, after reasonable time had been accorded applicant to demonstrate its operativeness, reject the application and permit an appeal to the Examiners-in-Chief.

Parrish, x. p., *Mitchell, Com.*, 23 Nov., 1889, C. D. Ms.

5. If there is a question in the Examiner's mind as to operativeness, and applicant declines to furnish a model, or to further illustrate or describe, or in any way demonstrate the operativeness of the [alleged] invention, it is the Examiner's duty to reject, upon the ground of inoperativeness (Corson, x. p., 43 C. D. Ms., 26; Perkins, x. p., 43 C. D. Ms., 361; Burkhardt, x. p., 44 C. D. Ms., 146).

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

6. The putting of an application in interference implies the Primary Examiner's belief that it described an operative invention; but this presumption is not a conclusive one, because cases are not wanting in the Office, in which a question of operativeness of one of the devices involved in the interference has arisen. In *McDonough v. Gray v. Bell v. Edison*, 46 O. G., 1245, Commissioner Hall distinguishes between cases involving doubt [as to operativeness] and cases in which there is no doubt. In the latter, injustice cannot be done by taking jurisdiction and disposing of the question; but it is equally clear that, when the question [of operativeness] is involved in doubt, it would constitute little less than usurpation for the Commissioner to decisively hold that one of the devices was inoperative in connection with proceedings from which no appeal can be taken.

The Commissioner suspended the interference proceedings, and remanded the case to the Primary Examiner to determine whether the alleged defect was fatal to its patentability; the Examiner's consideration of the question to be precisely as if a motion had been made by Atkinson to dissolve the interference upon the ground of the inoperativeness of Bentley's invention.

Atkinson v. Bentley, Mitchell, Com., 4 Mar., 1891, 46 C. D. Ms., 84.

Compare *Hunter, Jr. v. Lane*, (65), *Prowattain v. Holt*, (111), and *Campbell v. Brown*, (151), INTERFERENCES, and *Archer*, x. p., (7) *infra*.

7. Where, on final hearing before the Commissioner, an interference is suspended and the case remanded to the Primary Examiner for consideration of the question of operativeness, that question will not be considered *inter partes*, but will be determined by the Examiner subject to the regular course of appeal in *ex parte* proceedings. — *Atkinson v. Bentley* (46 C. D. Ms., 84) explained and applied.

Archer, x. p., *Simonds, Com.*, 15 Oct., 1891, 57 O. G., 696.

Compare *Atkinson v. Bentley*, (6) *supra*, and *Hunter, Jr. v. Lane*, (65); *Prowattain v. Holt*, (111), and *Campbell v. Brown*, (151), INTERFERENCES.

INSANE PATENTEE.

Re-issue, How made.

Where the patentee has become insane, and re-issue has been applied for and allowed, the re-issue may be made in the name of the guardian, but would be valid if issued to the insane patentee.

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

INTERFERENCES.

1. An interference in the United States Patent Office is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties who claim substantially the same patentable invention.

Sec. 4904 R. S.; P. O. R., 93.

2. The "issue" of an interference should be as broad as, but no broader than, the broadest claim to be included under it.

Zeitinger v. Reynolds v. McIntire, Frothingham, Act. Com., 7 Nov., 1891, 57 O. G., 1279. See also *Metz v. Crane et al., Frothingham, Act. Com.*, 27 Nov., 1891.

3. An interference proceeding looks to *subject-matter* rather than to parties.

Snyder v. Kanneberg, Frothingham, Act, Com., 17 Mar., 1892, 58 O. G., 1840.

NOTE. — In the above case, testimony on behalf of the patentees, *S. & B.*, in contest with an applicant, *K.*, showed that the thing patented as the joint invention of *S.* and *B.*, was, in fact, the sole invention of *S.* Thereupon *S.* made application as sole inventor, and moved for a new interference of the three parties, *S.* and *B.*, *S. solus*, and *K.* This being refused by the Examiner, on the ground that "a party could not be put in interference with himself," the Assistant Commissioner, on petition from *S.*, granted the motion, for the reasons above given.

4. In award of priority in interference contests, the crucial test is to whom is the world indebted for use of the invention in an available form.

Boyd v. Cherry, 4 McCreary, 70, 1 Robinson, 554. See also *Gill v. Scott, Marble, Com.*, 4 June, 1883, 23 O. G., 2511; *Green v. Hall, Hall, Com.*, 6 Mar., 1889, 46 O. G., 1515.

5. The several parties to an interference are presumed to have invented in the chronological order of their completed applications clearly describing the device in controversy, and the burden of proof is held to rest upon the party who seeks to establish a different state of facts.

Sec. 4904 R. S. ; P. O. R., 116.

6. The law recognizes an invention only when it reaches the condition of a working device, and awards priority to him who [either constructively or actually] is the first to reduce the invention to practice; subject only to the claims of an earlier discloser of the [nascent] invention who, with reasonable diligence, was perfecting the invention, and who succeeds in doing so.

Sawyer & Mann v. Edison, Marble, Com., 8 Oct., 1883, 25 O. G., 597. See also *Voelker v. Gray v. Edison v. Bell, Butterworth, Com.*, 30 O. G., 1092.

7. In an interference proceeding, the first discloser of the [nascent] invention establishes his right to award of priority on proving either one of two states of facts:—

(a) Actual reduction to practice of the invention in controversy, followed by application for patent without unreasonable delay after the invention has been claimed or disclosed by another, and within two years following such reduction.

(b) Reasonable and persistent diligence in perfecting the invention and in filing the application in controversy.

Monce v. Adams, Duncan, Act. Com., 24 Ap., 1872, 1 O. G., 1. See also *Millward v. Barnes, Spear, Com.*, 13 Mar., 1877, 11 O. G., 1060; *Starr & Peyton v. Farmer, Marble, Com.*, 28 Ap., 1883, 23 O. G., 2325; *Christie v. Seybold, Mitchell, Com.*, 10 Feb., 1891, 54 O. G., 957.

8. Where neither party makes a clear showing of the required facts, priority will be awarded in accordance with the preponderance of evidence, however slight it may be.

Buckingham v. Jones, Simonds, Com., 16 Sep., 1891, 58 O. G., 1413. See also *Doane v. Johnson, Simonds, Com.*, 9 Oct., 1891, 58 O. G., 1414.

9. At the outset of every interference proceeding each party is "required to file, on or before a day which is fixed by the Office, a concise preliminary statement, under oath," giving the dates of his original conception and of his earliest disclosure, and stating whether the invention had been reduced to actual practice, and, if it had, the date, place, manner, and extent thereof.

P. O. R., 110; *Washburn v. Hadfield, Simonds, Com.*, 57 O. G., 1719.

10. A party in interference who neglects to file a preliminary statement or who, having filed such a statement, neglects to take testimony, is restricted to the date and fact of his application.

P. O. R., 115.

11. Where, however, such application has grown out of a caveat filed by the same party and he files a preliminary statement, but omits to take testimony, a certified copy of such caveat may be produced at the hearing in evidence of conception as far back as the date of caveat-filing.

P. O. R., 207, and P. O. R., 154 (3).

12. Where one of the parties has already obtained a patent, that fact will not prevent an interference, for, although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to one whom he adjudges to be the first inventor, thus placing both claimants in position for final adjudication of their conflicting claims in a court of equity.

Sec. 4918 R. S. ; P. O. R., 93.

13. Where, in an interference issue, the contest is between an application for patent by one party and a patent already granted to another party, the applicant, in order to prevail, must present a case both as to first disclosure and as to reasonable and persistent diligence that does not admit of a reasonable doubt (U. S. Stamping Co. v. Jewett et al., 18 Blatch., 489 ; Duffy v. Reynolds et al., 24 F. R., 355 ; Fisk v. Church, 5 Fisher, 540 ; Taylor v. Wood, 12 Blatch., 110 ; Drill Co. v. Simpson, 37 O. G., 218), and must — anterior to patentee's reduction to practice (actual or "constructive") — have himself reduced the invention to practice in the form of an operative machine or process.

Duchemin v. Richardson, *Fisher, Com.*, 1870, C. D. 31. See also Richardson v. Denza, *Fisher, Com.*, 1870, C. D. 156 ; McCulloch v. Watkins, *Spear, Act. Com.*, 8 O. G., 1074 ; Busha v. Phelps & Edmunds et al., *Doolittle, Act. Com.*, 9 O. G., 1010 ; Packard v. Sandford, *Paine, Com.*, 16 O. G., 1182 ; Stephenson v. Goodell, *Duell, Com.*, 9 O. G., 1195 ; Hunter v. Jenkin, *Simonds, Com.*, 50 O. G., 1705 ; Eveston v. Richardson, *Simonds, Com.*, 57 O. G., 1425 ; Sargent v. Burge, *Spear, Com.*, 11 O. G., 1055 ; Christie v. Seybold, *Mitchell, Com.*, 54 O. G., 957.

14. In an interference issue between an application and a patent issued before the date of such application, the burden of proof rests 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.

See also, Deprez & Carpenter *v.* Bernstein *v.* Hunter *v.* Gaulard & Gibbs (118), *infra*.

15. In order to overcome an already granted patent, a subsequent applicant must establish : —

(1) Actual reduction of the invention to practice in public, prior to the patentee's first reduction ("actual" or "constructive"), and within two years preceding his own application.

(2) { (i) If applicant shows earliest conception, he must establish persistent diligence in reduction, and in his application for patent.
(ii) If, on the other hand, the patentee was first to conceive, applicant can prevail only by reason of lack of reasonable diligence on the part of the patentee.

Burr v. Duryee, U. S. S. C., *by Grier, J.*, 28 Mar., 1864, 68 U. S. 591. * See also *Murrill v. Chenoweth v. Wheeler*, *Fisher, Com.*, 14 July, 1869, C. D. 43; *Duchemin v. Richardson*, *Fisher, Com.*, 7 Ap., 1870, C. D. 31; *Richardson v. Denza*, *Fisher, Com.*, 9 Nov., 1870, C. D. 156; *Stephenson v. Goodell*, *Duell, Com.*, 3 June, 1876, 9 O. G., 1195; *Busha v. Phelps*, *Doolittle, Act. Com.*, 18 Aug., 1876, 9 O. G., 1010; *Peyton v. Farmer*, *Teller, Sec. Int.*, 22 Mar., 1883, 23 O. G., 2325; *Christie v. Seybold*, *Mitchell Com.*, 10 Feb., 1891, 54 O. G., 957.

16. A patent issued inadvertently while another application for the same invention was pending is, as against such application, to be treated, for the purposes of interference, as an application still pending. Decision of Commissioner Leggett cited and applied, — that when two conflicting applications are pending in the Office at the same time and, by official mistake, a patent is issued to

one of them without declaration of an interference between them, the rights of the parties will be determined on the same ground as if both were applicants: the one who has obtained a patent will derive no advantage from it in the controversy, neither will the other be prejudiced by it (*Brookfield & Hemingray v. Brooke*, — citing *Hamilton v. Foster*, 1869, C. D. 30, — *Leggett, Com.*, 4 O. G., 81.)

Boyer, x. p., *Mitchell, Com.*, 49 O. G., 1985.

17. Abandonment— of the Invention — of the Application.

W filed his original application 1884; reduced the invention to actual practice, Mar., 1887; forfeited the original application by neglect to prosecute Nov., 1887; filed second application for the same invention Jan., 1889.

Held, that *W*, having been the first to conceive, and, having, with due diligence, reduced to actual practice before the original application became abandoned, the filing of a second application before the two years' public use had accrued, saved his rights from dedication to the public, and — priority having been awarded over *R*, whose first appearance on the scene was by taking a Belgian patent in 1885 — *W* was adjudged entitled to the patent.

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

18. Abandonment and public use are questions to be determined *ex parte*, and not in an interference proceeding.

Butterfield v. Curtis, Fisher, Act. Com., 15 Feb., 1890, C. D. Ms.

19. Evidence of acts of one of the parties performed abroad must be excluded from consideration on a question of priority.

Brown & Taplin v. Bixby, Simonds, Com., 21 Sep., 1891, 57 O. G., 123.

20. Adding New Parties.

Rule 129 provides that, after taking of testimony, new parties shall not be added without a special order from the Commissioner, and, in the absence of sufficient reasons for adding new parties, such an order will be refused.

Lane v. Sturgess, Smith & Pettigrew, Mitchell, Com., 21 Jan., 1891, C. D. Ms.

21. Request of Primary Examiner for an order of suspension of interference for the purpose of adding a new party — *Refused*, in view of the fact that the testimony had all been taken, and of the further fact that the junior party to the interference had opposed the Examiner's request.

Daugherty v. Strut, Frothingham, Act. Com., 20 Nov., 1891, C. D. Ms.

22. All the grounds of contention must be presented at the original hearing.

A party who, although fully apprised of his opponent's contentions, rests his case upon one ground of defence, cannot, after a decision is made against him, have a rehearing simply to make a different defence.

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

23. Amendment of an Application in Interference.

The cases of *Ry. Co. v. Sayles* (97 U. S., 554), and *Con. Elec. Lt. Co. v. McKeesport Lt. Co.* (40 F. R., 21), should certainly place all Patent Office officials 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 subse-

quently 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.

Compare Wood *v.* Parsons, (29) *infra*.

24. Rule 109 gives no authority to file an amendment of an application involved in an interference claiming anything except an "invention claimed by another party thereto."

Hunter *v.* Knight, *Mitchell, Com.*, 3 Ap., 1890, C. D. Ms.

25. Rule 130 expressly provides that amendments to the specification will not be received during the pendency of an interference except as provided for in Rules 106, 107, and 109. The language "claimed by another party" in Rule 109 refers to claims to features of conceded patentability, not to claims rejected for want of patentability.

Crandall *v.* Sholes, *Mitchell, Com.*, 27 May, 1890, C. D. Ms.

26. Preliminary Statement. — Correction of Dates.

Where the failure to set up the proper dates in the preliminary statement was fairly attributable to the party's ignorance of the English language, and not chargeable to any fault or neglect of applicant or of his attorney: *Held*, that the Examiner of Interferences properly allowed the statement to be amended.

Schmiedl *v.* Walden, 23 Dec., 1890, C. D. Ms.

See also Washburn *v.* Hadfield, (1), and Baxter, x. p., (2) PRELIMINARY STATEMENT; also (27), (28), (29), and (113) *infra*.

27. Rule 113, which provides for amendment of a preliminary statement, makes it a condition precedent to such amendment, that the error sought to be corrected should have arisen "through inadvertence or mistake,"

and, following such rule, the decisions have been practically uniform, that where ordinary care and prudence in the fixing of dates have been wanting, amendment would not thereafter be permitted (*Cleusen v. Fowler*, 1886, C. D. 35; *Heermans v. Eichbaum*, 41 C. D. Ms., 391; *Lamb v. Spiro*, 42 C. D. Ms., 445; *Hunter v. Brill*, 44 C. D. Ms., 156).

Bell v. Overman, *Fisher, Act. Com.*, 2 Jan., 1891, C. D. Ms.
Compare *Parker v. Jarvis*, (28) *infra*.

28. Where it was urged, on behalf of a motion for permission to amend the preliminary statement, that applicant had obtained the impression that for the date of the [nascent] invention he could go back only to the period at which he produced a drawing disclosing the invention, but it did not appear how he had obtained that impression: *Held* insufficient, because it had not been shown but that, with reasonable diligence, the exact truth as to the date which applicant might have set up would have been ascertained by him. — Case distinguished from *Buckingham v. Jones* (34 C. D. Ms., 178), in which Jones, who was permitted to amend, alleged as excuse an impression similar to that of applicant in this case, but had set up an indefinite date of conception as before a given date, under the impression that such statement afforded a sufficient foundation for subsequent evidence of what had been done before that date.

Parker v. Jarvis, *Fisher, Act. Com.*, 28 Feb., 1891, C. D. Ms.
Compare *Bell v. Overman*, (27) *supra*.

29. Where the assignee knew that applicant made his preliminary statement from memory, but, apparently, made no effort to assure himself of the accuracy of the dates set up *until after he had become acquainted with his opponent's case*, during an examination about two months later, when he, thereupon, moved for leave to file a

preliminary statement: *Held*, that the Examiner of Interferences had rightly denied the motion on the ground taken by him, that the omissions and mistakes in the first preliminary statement were directly chargeable to the carelessness, indifference, and want of attention on the part of the assignee.

Wood *v.* Parsons, *Frothingham, Act. Com.*, 11 Jan., 1892, C. D. Ms.

Compare Rogers *v.* Wissinger, (23) *supra*.

30. Application for extension of time for taking testimony must be made promptly.

Where a party to an interference had had due notice as to when his testimony was to close and as to taking testimony by the other side, but took no steps toward taking of his testimony until nearly two months after his time had expired, under a grant of further time by Examiner of Interferences, based on said party's allegations of incapacity to take earlier action by reason of sickness, poverty, interruptions to his business from excessive rains and floods, and length of time required for him to communicate with his counsel: *Held*, that the extension was granted by the Examiner of Interferences on insufficient grounds, and that testimony must be refused. Case of Shinn *v.* McElroy (43 C. D. Ms., 113), — on which the Examiner of Interferences largely relied, — not thought to be in point.

Hayes *v.* Sagendorph *v.* Hawes, *Fisher, Act. Com.*, 16 Oct., 1890, C. D. Ms.

31. Burden of Proof.

Where the Examiners-in-Chief decided in favor of the junior applicant, on the ground that it appeared most probable, from the evidence, that he had originated the conception of the improvement, including the matter in

controversy, and that he communicated it to the senior applicant, who had no previous conception of the matter: *Held*, — reversing the Examiners-in-Chief, — that it is not conducive either to the promotion of sound practice before the Office or to the ends of justice, to decide upon the mere balancing of probabilities in favor of a latter applicant, who practically accuses the earlier applicant of theft of the invention and perjury in connection with the application.

Bruce *v.* Traver, *Mitchell, Com.*, 10 June, 1890, C. D. Ms.

32. Neither party having reduced the invention to practice in a machine for use prior to filing his application: *Held*, that the party who filed his application second in time had the burden of showing, by a fair preponderance of evidence, one of two states of facts, to wit: either (i), that he was the first to conceive and had used due diligence in adapting and perfecting the invention, or (ii), that he communicated the invention to the other applicant in such a sense that the latter is not an original inventor.

Illingworth *v.* Atha, *Mitchell, Com.*, 22 Nov., 1889, C. D. Ms.

33. The claims must conflict.

Applications interfere only where they *claim*, in whole or part, the same invention (Gold and Silver Ore Separating Co. *v.* U. S. Disintegrating Co., 6 Blatch., 307).

Dodd *v.* Reading, *Simonds, Com.*, 18 Sep., 1891, 58 O. G., 1413.

34. The junior applicant cannot relieve himself of the burden of proof by showing that his application in interference is a division of an earlier application filed by him, if said earlier application, although disclosing, contained no claim or statement of invention leading to the interference issue.

Van Depoele *v.* Daft, *Simonds, Com.*, 15 Jan., 1892, 58 O. G., 520.

35. Interference not conclusive as to Matter excluded by Office.

The general rule of conclusiveness of an award in interference as to all that might have been in the issue, does not apply to a claim which the Office had refused admittance into the interference on the ground that it was not patentable to the opposite party.

Crandall v. Sholes, Mitchell, Com., 27 May, 1890, C. D. Ms. Compare *Rogers v. Wissinger*, (23) *supra*, and *Prowattain v. Holt*, (111) *infra*.

36. The right cannot be usurped by mere diligence of a later inventor.

An inventor who was the earliest to conceive, disclose, and reduce to practice, and who proves connection of completion with conception by such diligence as his circumstances and the character of the invention admit of, cannot be defeated in his right to the patent by any amount of diligence, in coming to the Patent Office, of an inventor whose conception was of later date.

Hunter v. Miller, Mitchell, Com., 13 Mar., 1890, 50 O. G., 1765.

37. Where neither party had reduced to actual practice, award of priority was given to the junior applicant because he had established earliest conception and reasonable diligence in application for patent.

Doane v. Johnson, Simonds, Com., 9 Oct., 1891, 58 O. G., 1414.

See (38) *infra* for fuller statement of above ruling.

38. Earliest Conception. — Reasonable Diligence.

J was, by a few days, the "senior applicant," having filed on the 11th, whereas *D*'s application was not filed until the 14th, of Jan., 1889. Neither party proved

any "actual reduction" before filing of his application, but *D*, at the time of filing, had under way a machine containing the invention, which was completed 26 Jan., 1889. On both sides, the testimony as to "conception" was about equally meagre and unsatisfactory. *D*, however, seemed to have established, for April, 1888, conception of the invention, at least as fully as his competitor *J* did for the following September. In consideration of the above showings, the finding of the Board of Examiners-in-Chief for *D* was affirmed.

Ib.

39. Interpretation of Specification.

Where, in an interference between a patent and an application, the Examiner construed the patent by a specimen that had been used as an exhibit when the patentee's application was pending: *Held*, that it was of little consequence how the Examiner construed the patent or what means he used to aid in such construction; but if the specimen so filed had been used to construe the specification and claims of the application in interference, a different question might have been presented.

Prowattain v. Holt, Fisher, Act. Com., 3 Jan., 1891, C. D. Ms.

40. Copy of the Application of an earlier Contestant no longer in Interference, refused.

After an interference proceeding between the applications of *A* and *B*, and a decision in favor of *A*; *A*'s application was placed in interference with application of *F*, that had been filed during the pendency of the interference between *A* and *B*: *Held*, on petition of *F*, that he could not be furnished with copies of the drawings or of the contents of the file-wrapper of *B*'s application.

Fuller, x. p., Frothingham, Act. Com., 9 Jan., 1892, C. D. Ms.

40'. In a case similar to above it was held that petitioner was no more entitled to a copy of *B's* specification and drawing than any other person not a party to the first interference.

In re Henry A. Smith, Frothingham, Act. Com., 28 Jan., 1892, C. D. Ms.

41. Date of Application.

A renewal application promptly filed in place of allowed application forfeited for non-payment of final fee, is, for purposes of interference, a continuation of the earlier application, and *takes its filing date therefrom*.

Duchemin v. Priester et al., Simonds, Com., 1 Mar., 1892, 58 O. G., 1416.

42. In an interference case the important point is to fix the earliest date of [the nascent?] invention, and an issue is joined when the allegations of either party are met by the other's denial and opposing testimony. The question of date is then to be decided, like any other question of fact, upon a preponderance of evidence.

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

43. Defeated party's Right to a Claim not involved in the Interference.

Where, after judgment of priority upon the record, the defeated party refused to erase a certain claim included in the interference, alleging, as a reason, that it embraced subject-matter not disclosed by the other contestant, and no motion to dissolve had been made as to said claim: *Held*, that it was too late for the Examiner to pass upon the question whether or not applicant should be allowed the claim. *Held*, however, that applicant might make a motion to vacate the judgment in inter-

ference so far as related to subject-matter not common to both parties, and that, if the facts were found to be as alleged, proper relief might be afforded.

Booth, x. p., *Fisher, Act. Com.*, 7 Dec., 1889, 49 O. G., 1841.

Compare (44), (45), (46), (47), (48), (49), and (86) *infra*, and (12) APPEAL.

44. Where, after the application of defeated party had been returned, in due course, to the Primary Examiner, who, in accordance with Rule 132, finally rejected all applicant's claims that had been involved in interference: *Held*, upon appeal, that there was no error in the action of the Examiner in applying the rule to the case, but, it appearing that certain claims of applicant had been improperly included in interference, motion might be made for vacation of judgment in interference *as to those claims*, and, if granted, the case would be remanded to the Primary Examiner, who would allow such claims unless there was some valid reason for their rejection other than the decision in the interference cause (Booth, x. p., 49 O. G., 1841).

Erlich, x. p., *Mitchell, Com.*, 15 Nov. 1890, C. D. Ms.

Compare *Erlich v. Van Horn*, (45); and instructions of Commissioner of Patents, (49) *infra*.

45. Where, after judgment upon the record, the defeated party refused to erase a certain claim included in the interference, alleging, as a reason, that it embraced subject-matter not disclosed by the other contestant, but had made no motion to dissolve as to such claim: *Held*, that it was too late [in the proceedings] for the Examiner to pass upon such question in that manner, but that applicant might move to vacate the judgment so far as it related to subject-matter not common to the devices of both parties, and that, if the facts were as alleged, proper relief might be afforded.

Erlich v. Van Horn, Mitchell, Com., 12 Dec., 1890, 54 O. G., 506.

46. It was contended, in an argument on the part of Howe, that the defeated party in an interference contest cannot thereafter have allowed to him, as a part of the application in interference, a claim or claims which [although not expressly involved in the interference] would dominate the victorious party's device. *That* proposition is held not to be sound. The victor in an interference contest is entitled to claim everything coming fairly within the issue upon which he has been victorious; but to say that, if a specification present two features of invention only one of which is involved in an interference contest, a judgment upon that feature carries with it the fate of both, is to state a proposition whose unsoundness is demonstrated by the mere statement.

Ellis *v.* Lee *v.* Howe, *Simonds, Com.*, 5 Mar., 1892, C. D. Ms.

47. In an interference between *A* and *B*, the "issue" was in the language of *A*'s claim, and one of the steps of the process was expressed in language sufficiently broad to cover any method of cooling cream. But *A* disclosed only one method of cooling, and *B*'s specific claim was to a method different from *A*'s and which could not be claimed by *A*. Judgment on the interference issue was rendered in favor of *A*. *B* moved for vacation of judgment on his specific claim, and, his said motion being refused, appealed. *Held*, that, during the progress of the interference, *B* was constructively making a claim as broad as the issue, and that the specific claim, which the other party could not make, was merely awaiting the result of the interference. The interference having been decided in *A*'s favor, *B* was precluded from making the broad claim, and, in fact, was in the same position as if he had actually made such claim and it had been subsequently cancelled; but that, in view of the decision of the Commissioner as to the construction of Rule 132

[see (49), *infra*], there seemed to be no good ground for refusing to vacate the judgment as far as said specific claim of *B* is concerned.

Sharples *v.* De Laval, *Frothingham, Act. Com.*, 12 Mar., 1892, C. D. Ms.

48. Where, after judgment on the record in an interference proceeding and expiration of the limit of appeal and the return of the files and papers to the Primary Examiner, that officer advised the defeated party that "all his claims involved in the interference stood finally rejected," and applicant appealed from that action by a petition direct to the Commissioner: *Held*, that, under the recent instructions of the Commissioner to the Primary Examiner as to the construction of Rule 132 (56 O. G., 141), if the rejection included claims that could not be based upon the structures of the prevailing party and the claims were patentable, *they should not be rejected, — but allowed*. If, however, the Examiner was still of opinion that the claims in question were concluded by the interference proceeding, applicant could bring motion to vacate the judgment in conformity with the practice outlined in said instructions, and, should the motion be granted, the case would be remanded to the Examiner for action on the merits as to these specific claims.

Hunter, *x. p.*, *Frothingham, Act. Com.*, 1 July, 1891, C. D. Ms.

NOTE. — The instructions of Commissioner Mitchell — see (49), *infra* — and such rulings as above based thereupon — see italics — appear to mark a change in the practice, as laid down in (43), (44), and (45), *supra*, in the direction of giving the Examiner greater freedom of immediate action in favor of a patentable claim of the defeated party which had been improperly put in interference.

49. Examiner's Duties under Rule 132 Defined.

Rule 132 was established for the purpose of imposing the duty of making a formal rejection of the interfering claims in the application of the defeated party, but not for the purpose of prescribing the extent and measure of that duty.

The Examiner, after rejecting all those claims of the defeated party which are or which *could be made* by the prevailing party, may properly allow to the former such other claims as are held to be patentable.

No claim should be allowed to the defeated party which could, by any latitude of construction, be held to embrace matter common to the structures of both parties to the interference.

The cases of *Booth*, x. p. (49 O. G., 1841), and *Ehrlich v. Van Horn* (54 O. G., 506) are to be regarded as precedents establishing the practice of obtaining relief when the defeated party believes that the Examiner has erred by treating claims limited to his specific structure as if they were concluded by the interference proceeding.

Instructions of *Commissioner Mitchell* to Primary Examiner, 22 June, 1891, 56 O. G., 141.

50. Delay. — Other Engagements.

Applicant delayed application for five years after conception, being all this time possessed of adequate means and *busy upon a similar device*: *Held*, not an exercise of reasonable diligence in adapting and perfecting the invention.

Ligowski v. Peters v. Hisey, Simonds, Com., 15 Oct., 1891, 57 O. G., 1592.

51. Reasonable Diligence, Definition of.

Reasonable or due diligence in reducing an invention to practice depends, in every case, on two things, viz.:

(i) The nature of the invention; (ii) the personal circumstances of the inventor. In other words, in determining the question of diligence of the inventor first to conceive, the circumstances in which he is placed and the facilities at his command are always to be considered (*McCormick Harvesting Mach. Co. v. Minneapolis Harvesting Mach. Wks.*, 42 F. R., 152; *Hunter v. Miller*, 50 O. G., 1765). Furthermore, reasonable diligence is established by satisfactory proof of affirmative action, and — within limits — by excuses for inaction (*Ecaubert v. Hofmann*, 52 O. G., 2107).

Sessions v. Sewall, Frothingham, Act. Com., 22 Aug., 1891. C. D. Ms.

52. In a contest of priority of invention, the reasonable diligence required [of him on whom the burden of proof rests] applies alike to actual reduction to practice and to the constructive reduction to practice involved in an application.

Hunter v. Jenkin, Simonds, Com., 15 Sep., 1891, 56 O. G., 1705.

53. *Time spent on other inventions* does not excuse delay otherwise unreasonable.

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

Compare *Ligowski v. Peters v. Hisey*, (50) *supra*; *Thomson v. Ries*, (55) *infra*; and *Lowe v. Springer v. Morse v. Granger*, (4) DELAY.

54. *M* conceived the principle of the invention in June, 1888, and reduced to practice in June, 1889. *W* established conception as early 1 Jan., 1889, and reduction to practice in same month: *Held*, that although *M* justified his delay from Sep., 1888 (when he claims — but fails to satisfactorily establish — reduction to

practice), up to 1 March, 1889, by reason of illness, yet, having failed to justify his subsequent delay of over two months, or to satisfy the Office that he would have made any effort to reduce to practice if he had not been ill; decision of the Examiners-in-Chief was overruled and the priority was awarded to *W*.

Morgan v. Wheeler, Mitchell, Com., 27 Ap., 1891, C. D. Ms.

55. *T* conceived May, 1886, and reduced to practice Aug., 1888. *R* conceived latter part of 1886, reduced to practice July, 1888, and was first to make application for patent. *T* was evidently possessed of abundant means, and when [twenty-seven months after conception] he did reduce the invention to practice, it took him but a few hours to produce — from machinery which he had on hand — the requisite apparatus and effect that reduction: *Held*, that, under the circumstances, involving a delay of more than two years, with abundant means and opportunities at hand, and *busy meanwhile about other kindred inventions*, *T* [the party first to conceive] did not exercise reasonable diligence. Decision of the Examiners-in-Chief reversed, and priority awarded to *R*.

Thomson v. Ries, Simonds, Com., 14 Nov., 1891, 59 O. G., 298.

NOTE. — The above ruling seems in full agreement with the drift of recent decisions. *T*'s pre-occupation in developing "other kindred inventions" aggravated rather than palliated his *laches* in the case at issue.

Compare *Ligowski v. Peters v. Hisey*, (50), and *Hunter v. Jenkin*, (53) *supra*; also *Barnes v. Clinton*, (3), *Wicks v. Dubois*, (4), ABANDONED EXPERIMENTS; and *Millward v. Barnes*, (2), and *Wickersham v. Singer*, (14), DILIGENCE.

56. The "diligence" required in a contested case different from and greater than that required in an *ex parte* case.

The reasonable diligence in completing an invention demanded from an inventor in a contest over priority of invention is something different from the diligence in applying for patent for a completed invention which prevents abandonment to the public. The two things are differently and specifically stated in the statutes. The spirit and meaning of the statutes would seem to call for a higher degree of diligence in adapting and perfecting an invention once conceived of, in order to create a right to a patent, than is necessary in dealing with a completed invention in order to negative the finding of an abandonment to the public.

Thomson *v.* Ries, *Simonds, Com.*, 14 Nov., 1891, 59 O. G., 298.

57. A delay, in filing the application, of nearly four years after the date of conception: *Held*, not to have been an exercise of reasonable diligence, where, in the mean time, applicants were using machines which could have been readily adapted for the practice of the process in controversy.

Scott *v.* Bettendorf & Bettendorf, *Simonds, Com.*, 18 Mar., 1892, C. D. Ms.

58. Disclaimer, When Filable.

Where the Examiner of Interferences declined to transmit for examination by the Primary Examiner a disclaimer offered by one of the parties because not made before the date fixed for filing his preliminary statement, — as required by Rule 107: *Held*, that the Examiner of Interferences was correct in holding that the rule makes no distinction between interferences which involve a

conflict between co-extensive claims, and interferences which involve a conflict between generic claims and subordinate specific claims in respect of the period within which disclaimer may be made.

Clark *v.* Lord *v.* Grimes, *Mitchell, Com.*, 22 Ap., 1890, 51 O. G., 1943.

Compare (59), *infra*.

59. Where a disclaimer is tendered by one of the parties unaccompanied by any motion in the case, it is an *ex parte* question, but if a motion is made to suspend the interference pending the filing of a disclaimer or the determination of the question whether a disclaimer ought to be permitted, the case is, as to such motion, a contested one, and notice should be given as in other cases.

Diescher *v.* Walker *v.* Diescher & McGill, *Mitchell, Com.*, 24 June, 1890, 52 O. G., 549.

60. Where a party, on trial of an interference, gives notice that reference will be made to proceedings and testimony of a former interference between the parties, the whole record will be presumed to be meant unless the notice distinctly specifies a particular part of the record and the purpose for which its admission is sought.

Wilson *v.* Haines, *Simonds, Com.*, 10 Oct., 1891, 57 O. G., 1278.

61. Duties of Courts and of the Office distinguished.

The duty of a court, in conducting an interference proceeding, is judicial and is not administrative. The duties of the Patent Office, in conducting a similar proceeding, are both judicial and administrative. The court compares claims, and, if they are alike, "may adjudge and declare either of the patents void, in whole or in part," and then its duty is done. The Patent Office must not only determine between actually conflicting

claims, but it must also protect the public from more than one patent upon the same invention. Hence, it declares the interference, not between claims, but between applications which contain conflicting claims, or between an application and an unexpired patent, — as the case may be (Rule 94).

Reed v. Landman, *Mitchell, Com.*, 26 May, 1891, C. D. Ms.

62. Implied Admission.

Where, in an interference between a patent and an application, it was contended that the applicant was estopped from asserting himself the original and first inventor of the subject-matter at issue, because his application contained a reference to the patent in question: *Held*, that it was simply a reference to an existing patent for the purpose of suggesting how the material prepared by the patented process was packed, and that, whatever its effect in tending to discredit his present claim to be the original and first inventor of the invention set forth in the patent, it could not operate to prevent him from being heard to prove that he was the original inventor. Similar questions arose in *Mead v. Brown*, 48 O. G., 397; and *Kohler v. Kohler & Chambers*, 43 O. G., 247.

Del Grande v. Mannie, *Mitchell, Com.*, 19 July, 1890, C. D. Ms.

63. Estoppel.

Where it was contended that a party to an interference proceeding was estopped from claiming the invention in controversy, on the ground that the subject-matter had been claimed by him in the original application and rejected, and the rejection acquiesced in in order to obtain the original patent: *Held*, that it is well settled that claims contained in re-issued letters-patent which were asserted upon the application for the original

patent, but whose rejection was acquiesced in, will not be maintained by the courts, and therefore should not be allowed by the Office (*Leggett v. Avery*, 101 U. S., 256, *; *Mahn v. Harwood*, 112 U. S., 354, *); but *the question whether a party is estopped has no bearing upon the question who was the original and first inventor of the invention in controversy.*

Hoveler & McTighe v. Verner v. Nicholson, Jr., Mitchell, Com., 14 July, 1890, C. D. Ms.

64. On dissolving an interference all parties should be notified, and limit of appeal set. — Practice.

Where interference had been dissolved by the Commissioner between a patent of one of the parties and the application of one of the other parties, and the Primary Examiner, of his own motion and without notice to the other parties, dissolved the interference as to them also, and one of them petitioned to have the Primary Examiner or the Examiner of Interferences advised that such attempted dissolution was illegal and void, and that the interference be resumed and proceeded with in due course: *Held*, that,—without questioning the Examiner's right to dissolve the interference on his own motion,—the proper course would seem to have been for him to have given all the interested parties notice of his decision and to have set a limit of appeal therefrom, in order that they might be heard by the Commissioner if they so desired: *Also held*, that in view of the action taken by the Primary Examiner and the Examiner of Interferences, the petition was, in effect, a motion to vacate the decision of the latter as to said other parties, and that such a motion should have been brought before the Examiner of Interferences in the first instance, and that notice thereof should have been served on each of the interested parties.

Fuller, x. p., Frothingham, Act. Com., 23 Dec., 1891, C. D. Ms.

65. Feigned Issue.

It is not necessary that all questions pertaining to an application for patent should be finally settled and determined before an issue as to priority of invention can be properly formulated and tried. An interference may be regarded in the light of a "feigned issue" out of chancery for the determination of a particular question, and, when justice requires it, other questions can meanwhile be allowed to remain unsettled.

Hunter, Jr. *v.* Lane, *Simonds, Com.*, 3 June, 1892, C. D. Ms.

NOTE. — As proceedings in application for patent may be suspended *pro tem*, to await the issue of an interference contest, so, in turn, an interference procedure itself is sometimes suspended for the settlement of a question arising in the case; see Atkinson *v.* Bentley, (6) INOPERATIVENESS; and Prowattain *v.* Holt, (111) *infra*. The general practice, however, is to reserve consideration of collateral questions until after final judgment on the interference. See Strause *v.* Cook, (84'), and Arencibias *v.* Durkee, (90) *infra*.

66. Interfering generic Claim and specific Claim.

Where the claim of one applicant includes the claim of another applicant in such a sense that the broader claim could be predicated upon the subject-matter of the narrower claim, an interference exists, under the rule laid down in Upton, x. p., 1884, C. D., 26.

Dewey *v.* Thomson, *Mitchell, Com.*, 13 Ap., 1890, C. D. Ms.

Compare Edison *v.* Heysinger, (66'), and Reed *v.* Landman, (67) *infra*.

66'. Non-interfering broad and narrow Claims.

Where the declaration of interference appeared to have been made on the ground that the claims of one party, if granted, would be subordinate to those of the other party: *Held*, that that was not the question to be

determined in an interference proceeding; that interferences are not to be declared or denied because the claim of one party may or may not cover an infringement upon the invention of the other, but solely upon the ground that each party claims, substantially, the same invention.

Edison *v.* Heysinger, *Fisher, Act. Com.*, 17 Ap., 1890, C. D. Ms.

Compare Reed *v.* Landman, (67) and (68) *infra*.

67. Generic and specific Claims for substantially the same Invention.

Two applications for patent on substantially the same invention conflict, and will be put in interference, although claimed generically in the application of one party and only specifically in the application of the other party (Mullen & Mullen, x. p., 50 O. G., 837; Lord, x. p., 50 O. G., 987).

Reed *v.* Landman, *Mitchell, Com.*, 26 May, 1891, C. D. Ms.

Compare Dewey *v.* Thomson, (66), and Edison *v.* Heysinger, (66') *supra*; and Edison *v.* Stanley, (69) *infra*.

68. Non-interfering generic and specific Claims.

Where a patentee, claiming specifically, would be entitled to all of his claims (even if he held the position of an applicant only) in spite of the judgment of priority in favor of his opponent, the fact that the claim of his opponent could dominate his, is no sufficient reason for declaring or for continuing an interference. Rule 75 provides for precisely such a case and unmistakably states that, on applicant filing a proper oath, the unexpired patent shall cease to be a bar.

Ib.

NOTE. — In his application of precedents to the above case, the Commissioner referred to the case of Upton, x. p., as follows :

The case of *Upton*, x. p., (1884, C. D. 26) was relied upon by the Examiner, as authorizing a different conclusion to that to which I have come therein, but I feel certain that it was not the intention of the Commissioner (Butterworth) to override Rule 74 (now Rule 75), which was then, as it is now, a part of the law governing the conduct of the Patent Office.

69. Genus and Species.

In the case of an article of manufacture, where an applicant has claimed a genus, and a patentee a species clearly coming within this genus, and the applicant has recited *the same species* in his application as being *within that genus*, there is an interference in fact.

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

Of like general purport, see *Short v. Sprague*, 56 O. G., 1708; *Zeitinger v. Reynolds v. McIntire*, 57 O. G., 1279; and Commissioner's Instructions, (49) *supra*.

See, however, *McDougall v. Phinney*, 56 O. G., 928.

70. Omission from the motion of one of the grounds of appeal constitutes a waiver of that ground.

It has long been held by the Office that parties are concluded by the judgments against them, not only as to those issues which were expressly involved, but *also as to those which might, with reasonable diligence, have been brought forward at the same time.* (*Harlowe v. Guernsey*, 1875, C. D. 47; *Whiteley v. McCormick*, 1876, C. D. 228). These rulings are based upon the decision of the Supreme Court of the United States in *Beloit v. Morgan*, 7 Wallace, 619, *. Hence, where Examiner had denied issues, 1, 2, 4 and 6, and the party appealed on issue 4 only, his omission of issues, 1, 2 and 6 constituted a virtual acquiescence in and a waiver of his right to appeal from the Examiner's action on those issues.

Hotchkiss v. Smith & Post, *Fisher, Act. Com.*, 13 Aug., 1890, C. D. Ms.

71. Identity, Test of.

Where, in an interference, it appeared that *A* could not make the thing described and claimed by *B*, and that *B* did not make the thing described and claimed by *A*, and that the construction called for by *B*'s claim did not, of necessity, embody that called for by *A*'s claim: *Held*, that *B*'s device did not necessarily infringe *A*'s claim nor was it dominated by it, and, such being the case, there was no interference, even under the doctrine laid down in Upton, x. p., (27 O. G., 99).

Jeune v. Booth, Mitchell, Com., 7 Mar., 1891, C. D. Ms.

Compare *Rogers v. Wissinger*, (23) *supra*; and *Gould v. Case*, (72) *infra*.

72. Subject-matter claimed must conflict.

Where two claims cover the same or equivalent elements, there is an interference, regardless of mere modes of expression used, but where the claims of one party are limited to specific constructions which the other does not and *cannot claim*, it must be held that there is no interference in fact.

Gould v. Crane, Mitchell, Com., 28 Mar., 1891, C. D. Ms.

Compare *Jeune v. Booth*, (71) *supra*.

73. Inadvertent Issue of Patent.

Where a patent had, by inadvertence on the part of the Office, been issued to a party whose case should have been put in interference with a cotemporary application of another party: *Held*, that both the parties stood on the footing of applicants.

Scott v. Bettendorf & Bettendorf, Simonds, Com., 18 Mar., 1892, C. D. Ms.

See, of same purport, *Marston*, x. p., (197) *infra*.

74. Unreasonable delay is not to be presumed against any applicant. It must be conclusively proven.

Ib.

Of like general tenor to above, see Scott, x. p., (12) ABANDONMENT OF THE INVENTION.

75. International Union for Protection of Industrial Property.

Petition was received on behalf of party to an interference, residing abroad, which requested —

(1) Permission to renew a motion to dissolve, which had been dismissed on appeal. (2) To file a preliminary statement accompanying the petition. (3) To file what purported to be an exemplified copy of an original application filed on behalf of petitioner in Great Britain; and (4) that said exemplified copy be received as an application “under the provisions of the International Union for the Protection of Industrial Property.” *Held*, that, in view of the advanced stage in the proceedings: (1) The renewal of the motion to dissolve must be denied; (2) request of permission to file preliminary statement can reach the Commissioner only on petition from adverse action of Examiner of Interferences, — to whom petition must be first presented; (3) that the alleged exemplified copy of British application might be filed for what it was worth; but (4) that with respect to the request that said copy be received as an [interfering] application under the provisions of the International Union, that it would be improper for the Commissioner, at this stage, to express an opinion as to its value as evidence in the interference proceedings.

Mason *v.* Thompson, *Frothingham, Act. Com.*, 9 Dec., 1891, C. D. Ms.

76. Non-interfering claims may be withdrawn and be incorporated in a separate application.

When two applications (or an application and an unexpired patent) have been placed in interference, there may be found three classes of interrelated claims referred to in the declaration of interference, viz.: (1) conflicting claims directly in interference; (2) claims which conflict in the sense that they are involved in the result of the interference; (3) claims which are neither in interference nor involved in the result of interference. Claims which come under the third head may immediately be divided out and be embraced in another application, upon compliance with Rule 106. Such claims are not for the same invention as are either those directly or involved in interference, and may therefore be separated out without prejudice either to the public or to the opposing party.

Reed *v.* Landman, *Mitchell, Com.*, 26 May, 1891, C. D. Ms.

77. The "issue" must be as broad as the broadest claim.

In declaring an interference it is improper to include a broad claim in a narrow issue. *The issue should be as broad as the broadest claim involved therein.*

Short *v.* Sprague, *Simonds, Com.*, 19 Sep., 1891, 56 O. G., 1708.

Compare *Zeitinger v. Reynolds v. McIntire*, (78), and *Metz v. Crane et al.* (79) *infra*.

78. The "issue" of an interference should be as broad as, but no broader than, the broadest claim to be included under it.

Zeitinger v. Reynolds v. McIntire, Frothingham, Act. Com., 7 Nov., 1891, 57 O. G., 1279.

79. The objectionable practice of making the "issues" of interferences broader than any claim included thereunder, or broader than are patentable, in view of the state of the art, condemned.

Metz v. Crane et al., Frothingham, Act. Com., 27 Nov., 1891, 58 O. G., 947.

80. Joint Ownership.

The question of joint ownership does not properly arise in an interference contest; it is a question purely *ex parte* between the Office and the alleged joint inventors.

Redfield v. Goodson & Capohart, Fisher, Act. Com., 13 Jan., 1891, C. D. Ms.

Of same general purport, see *Snyder v. Kanneberg, (182) infra.*

81. Laches.

J filed his application in April, 1886, and set up a conception in March, 1886. - *L & W* filed their application in July, 1886, and (in their preliminary statement) set up conception in Sep., 1885, and reduction to practice in July, 1886, and testified that, after some experiments in Nov., 1885, they did very little on the invention, as they "considered that the problem was practically solved," and they "had to await the result of the work in practice before any further modification was deemed necessary," and that the matter of applying for a patent was delayed because they "considered the device was but a modification of another device for which they had received a patent in Nov., 1886": *Held*, that there was no evidence that the junior party [*L & W*] did anything toward adapting and perfecting the invention from Nov., 1885, to June, 1886; on the contrary, the evidence shows that they thought they had solved the

problem, — not by reason of their experiments in Nov., 1885, but by reason of what had been done in the line of the invention as covered by their said patent, — and, as it did not appear that the invention was an intricate one, or that the parties were lacking in means or facilities for reducing to practice, it must be held that they were not using due diligence in adapting and perfecting the invention, and priority was therefore awarded to the senior applicant, *J.*

Lemp & Wightman v. Johnson, Frothingham, Act. Com., 27 Jan., 1892, C. D. Ms.

Of same purport, see *Monce v. Adams*, (1) PRIORITY.

82. Misleading Issue. — Summary Dissolution.

The interference having been declared upon a misleading and improper issue, embracing a claim which, if incorporated into a patent, would be liable to invalidation by the courts (*Carr v. Rice*, 4 Blatchford, 200; *Edgerton v. M'f'g Co.*, 10 Bissell, 402), and there being a question whether, on a redeclaration on an amended issue, such issue would not be broader than the claims of the patent now in interference (*Reed v. Landman*, 55 O. G., 1275); the Assistant Commissioner, on appeal by one of the parties, deemed it advisable to exercise the supervisory power vested in the Commissioner, and to summarily dissolve the interference.

Stuart v. Elliott v. Pattison v. Demayer, Frothingham, Act. Com., 23 Ap., 1892, C. D. Ms.

83. Motion to Dissolve.

Where, after expiration of the usual limit for appeal from decision of the Examiner of Interferences, the defeated party requested that the application of the successful party be withdrawn from issue and remanded to the Primary Examiner for consideration upon a supposed erroneous omission of a certain patent from the

interference: *Held*, that it was a matter which could have been properly considered only within the time prescribed by the rule (within twenty days after approval of the preliminary statements), or, if not made within such time, upon a showing of sufficient reason why the motion was not made before.

Parry & Parry *v.* Black, *Fisher, Act. Com.*, 19 June, 1890, C. D. Ms.

Compare Laurent-Cely *v.* Payen, (84) *infra*.

84. Under Rule 122, it is the province of the Examiner of Interferences to determine, subject to appeal to the Commissioner, whether a motion to dissolve shall be "transmitted." It is for the Primary Examiner to determine the action on the motion when it has been transmitted, and it was an error for him to dismiss it as irregular and premature.

Laurent-Cely *v.* Payen, *Mitchell, Com.*, 8 Ap., 1890, 51 O. G., 621.

Compare Parry & Parry *v.* Black, (83) *supra*.

84. Collateral Questions.

The question to be decided in an interference proceeding is, which, of two or more parties, is the prior inventor, and an affidavit, or any testimony taken for the purpose of showing a want of interference in fact, is irrelevant and entitled to no weight in determining the controversy. If, however, in taking the testimony, there should incidently appear facts which indicate that the interference was not properly declared, such facts may be urged before the Commissioner when the case goes before him on final hearing, but the practice of the Office is, after testimony has been taken and the case set down for hearing, to allow it to take its usual course.

Strause *v.* Cook, *Fisher, Act. Com.*, 3 May, 1890, C. D. Ms.

Compare Hunter, Jr. *v.* Lane, (65) *supra*, and cases there cited.

85. Motions to dissolve an interference — such as contemplated by Rule 122 — are not based upon grounds arising out of the testimony taken upon questions of priority, but upon grounds which appear from the record to have existed before that time.

Cook v. Leech, Fisher, Act. Com., 24 Mar., 1890, 42 C. D. Ms., 370.

86. Under the rules, as they now stand, the only period during which a party may file a motion to dissolve the interference and demand that if in proper form it be transmitted to the Primary Examiner, is during the period between the approval of the preliminary statements and the twentieth day thereafter. If an intervening party files a motion to dissolve before the twenty days begin to run, he should show, by the face of the proceedings, or otherwise, that the hearing can be had under such circumstances as would make it just to hold the parties to the result of the contest, as *res adjudicata*.

Laurent-Cely v. Payen, Mitchell, Com., 8 Ap., 1890, C. D. Ms.

Compare *Ehrlich v. Van Horn*, (44), and *Parry & Parry v. Black*, (83) *supra*.

87. Motion by Defeated Party.

Where, in an interference proceeding, some of the parties urged that *S* had no standing to make a motion to dissolve, because judgment of priority had already been rendered against him on the record: *Held*, that he should not be prejudiced by that fact, because the rule does not now permit parties in interference to have access to each other's cases until after the preliminary statements have been opened, and, as it is the custom of the Office to immediately render judgment against a party whose preliminary statement does not overcome the record date of his competitor, *S* was not in a posi-

tion to make the motion [intelligently] until after judgment had been rendered against him.

Sprague v. Van Depoele v. Hunter v. Knight, Fisher, Act. Com., 17 Ap., 1890, 44 C. D. Ms., 24.

88. Rule 122 provides that motions to dissolve an interference should, if possible, be made not later than twenty days after receipt and approval of the preliminary statements, and, in administering this rule, it has long been held by the Office that if a motion to dissolve is made after the time fixed by the rule, some good and sufficient reason must be given why it was not sooner made. The only reason given for the delay is that the party having the burden of proof had not taken his testimony in chief within the time fixed by the Office, and that, therefore, appellant had assumed that he did not intend to take it, and did not send for or obtain a copy of the file-wrapper and contents of appellee's application: *Held*, that the reason given was insufficient.

Cornwall v. O'Neill, Fisher, Act. Com., 11 Aug., 1890, C. D. Ms.

89. Motion after Limit of Appeal.

When, the limit of appeal from Examiner of Interferences having expired, he has lost jurisdiction of the case, the Commissioner may be moved for leave to file a motion to dissolve the interference. This motion should be accompanied by an affidavit stating the facts relied upon both in excuse of delay and in justification of granting the motion at a date later than that specified in Rule 114. Should the facts relied upon appear to the Commissioner sufficient, permission will be granted, and, the jurisdiction of the Examiner of Interferences being restored, he will transmit the motion to the Primary Examiner (see Rules 109 and 122), and, in case the motion is granted, will make the proper order of vaca-

tion of judgment in the same manner as if the motion had been filed within the time originally limited for appeal.

Garrison *v.* Hubner, *Mitchell, Com.*, 10 July, 1890, C. D. Ms.
Compare Parry & Parry *v.* Black, (83) *supra*.

90. It is contrary to the practice of the Office, after part of the testimony has been taken, to suspend an interference proceeding for the purpose of considering questions relating to dissolution (Cook *v.* Leech, 42 C. D. Ms., 370 ; Strause *v.* Cook, 43 C. D. Ms., 65).

Arencibias *v.* Durkee, *Fisher, Act. Com.*, 6 Dec., 1890
C. D. Ms.

Compare Hunter, Jr., *v.* Lane, (65) *supra*.

91. Where some of *A*'s claims were drawn so broadly as, in terms, to include the device of *D*, but, when the inventions covered by the several applications were understood, it became clear that the claims did not relate to the same subject-matter and that the "interference" was purely one of *words* : *Held*, that there was no interference in fact, and that the Primary Examiner's refusal to dissolve the interference must be overruled (Shepard *v.* Mann, 42 C. D. Ms., 248 ; Hotchkiss *v.* Smith & Post, 43 C. D. Ms., 338 ; Sprague *v.* Van Depoele *v.* Hunter *v.* Knight, 44 C. D. Ms., 24).

Ib.

Compare Snyder *v.* Kanneberg, (182) *infra*.

92. Duty of prompt Examination of Opponent's case.

Under Rule 122, it is the duty of parties to an interference, *so soon as the cases of their opponents are open to them*, to take steps to ascertain whether or not the interference has been properly declared, and any motion for dissolution, on the ground of improper declaration, should be presented not later than twenty days after the approval

of the preliminary statements. Any delay beyond that time, in so moving, must have an adequate excuse.

Van Depoele *v.* Smith, *Fisher, Act. Com.*, 2 Jan., 1891, C. D. Ms.

93. Motion (by consent) prior to Preliminary Statements, and on proper showing, — granted.

Where, in an interference proceeding, the Examiner of Interferences refused to transmit, before the time for filing preliminary statements, so much of a motion to dissolve as was based on alleged want of interference in fact, because the other party had not the right to inspect the moving party's application, but transmitted to the Primary Examiner the other grounds of motion, which were thereupon denied by him, and counsel for both parties signed a stipulation to the effect (1) that the moving party's application had been submitted to the other party's counsel, and (2) that the question of interference in fact should be determined by the Commissioner in deciding the appeal; the Commissioner considered the question and held that there was no interference in fact.

Gould *v.* Case, *Mitchell, Com.*, 28 Mar., 1891, C. D. Ms.

Compare Jeune *v.* Booth, (71) *supra*.

94. Where the parties filed a stipulation that the testimony of one of them, which had been taken, and which explained the construction embodied in his application, could be considered by the Examiner of Interferences in hearing and determining a motion to dissolve: *Held*, that the construction of the device must be ascertained from the application and not from the testimony (Cook *v.* Leech, 42 C. D. Ms., 370).

Van Depoele *v.* Knight *v.* Brill *v.* Hunter, *Frothingham, Act. Com.*, 30 Ap., 1891, C. D. Ms.

95. It is well settled that, before a motion to dissolve made after testimony has begun to be taken will be

considered, a showing of conclusive reasons why the motion was not earlier presented must appear.

Ib.

96. A party who has moved for dissolution on one of the grounds set forth in Rule 122, and taken a petition to the Commissioner from the Examiner's decision, is not thereby estopped from subsequently moving for dissolution upon another ground *developed by the progress of the interference*.

Prowattain v. Holt, Mitchell, Com., 14 Ap., 1891, C. D. Ms.
Compare *Reynolds v. Haberman*, (97) *infra*.

97. There is nothing in the rules that limits the questions to be discussed upon a motion to dissolve to those which have not previously been considered by the Examiner. One object to be secured by the motion to dissolve is to enable the Examiner to decide *inter partes* what he had previously decided without a hearing.

Reynolds v. Haberman, Mitchell, Com., 23 Sep., 1889, 49 O. G., 130.

98. Reserved Question. — Practice.

Whatever appears, incidentally from the testimony, to bar the [prevailing] party's right to a patent is, under a well-established practice of the Office, not to be considered on a motion to dissolve; but the various tribunals [of the Office] passing upon the question of priority, are required to indicate to the Commissioner the existence of such a bar [against either party], so that, when the case comes to him in due course, he may—either in advance of or subsequent to the judgment on priority—refer that question to the Primary Examiner (Rule 126). Inasmuch, however, as, in its last analysis, the question of patentability becomes solely a question between the general public and the prevailing party to the interference,

the usual practice with the Commissioner is, to defer questions of patentability until after judgment of priority has been rendered. The question then becomes a purely *ex parte* one with which the defeated parties to the interference have nothing to do.

Cook *v.* Leech, *Fisher, Act. Com.*, 24 Mar., 1890, 42 C. D. Ms., 370.

99. Upon a petition from a decision of the Examiner denying a motion to dissolve the interference, the petitioner contending that his petition could lie because there had been such irregularity in declaring the interference as would preclude a proper determination of the question of priority, and, in support thereof, showed that his opponent's claim in the interference was not a part of his original application, and that, at the time of the declaration of interference, the claim had not been sustained by any supplemental oath: *Held*, that the proper amendment should have been made and the proper supplementary oath filed before the interference was declared, and, therefore, petitioner was technically right as to the practice; but that, under Rule 124, he was not entitled to be heard thereupon by means of a petition [to the Commissioner in person].

Lichenstein *v.* Crawford, *Simonds, Com.*, 18 May, 1892, C. D. Ms.

NOTE. — According to Rule 124, appeal — at that stage of the proceedings — lay, in the first place, to the Examiners-in-Chief, after due notice to the opposing party as required in Rule 153.

100. Exception to Rule 122.

Where a motion to dissolve an interference on the ground of non-patentability is made more than twenty days after the approval of the preliminary statements, it is not an abuse of discretion on the part of the Examiner

of Interferences to grant such a motion where it appears that *no testimony had been taken*, so that the case had not advanced beyond the stage which interference proceedings customarily reach within the first twenty days after approval of the preliminary statements.

Reynolds *v.* Haberman, *Mitchell, Com.*, 23 Sep., 1889, 49 O. G., 130.

To like purport, see Forslund *v.* Matthews, (101) *infra*.

101. Appeal from Primary Examiner [direct] to Commissioner to dissolve an interference on a plea of non-patentability cannot be entertained.

Forslund *v.* Matthews, *Simonds, Com.*, 14 Dec., 1891, 57 O. G., 1720.

NOTE.— Non-patentability being a question of “merits,” appeal on that ground could reach the Commissioner only in his judicial capacity after adverse decision by the Board of Examiners-in-Chief. See (100) *supra*.

102. Motion to extend.

A motion to extend the time for taking testimony is one addressed to the sound discretion of the Examiner of Interferences, and it has been frequently held that the Commissioner will not interpose in such cases unless it should appear that the Interference Examiner abused his discretion or that his action was contrary to law (Adams *v.* House & House, 40 C. D. Ms., 226).

Patterson *v.* Colby, *Fisher, Act. Com.*, 9 May, 1890, C. D. Ms.

103. Motion to re-open.

When it was claimed that, after a hearing had before the Examiner of Interferences, one of the parties had, “in the presence of a public official of high standing,” made oath to statements contradictory of his testimony in the present case and which appeared to be material,

and moreover, that one of his important witnesses had stated that his own testimony was false, a motion to re-open the case was granted, to the extent of taking testimony, *pro et con.*, on the charges made.

Creteau v. Hall, Mitchell, Com., 28 Nov., 1890, C. D. Ms.

104. A motion seeking to re-open an interference must be brought, in the first instance, before the Examiner of Interferences.

Bowen v. Bradley, Simonds, Com., 8 Jan., 1892, 58 O. G., 386.

105. Motion to suspend.

A request from the Primary Examiner that an interference be suspended and returned to him, for the purpose of adding a new party thereto; *Denied*, because (1) the effect of adding a new party at that stage of the proceedings would be practically to re-instate the senior party, who had allowed his rights to lapse by neglecting to take testimony within the allotted time, and because (2) there would [after final adjudication of the present interference] be ample opportunity for a second interference between the junior party and a third party.

Wein v. Northrup, Simonds, Com., 8 Mar., 1892, 58 O. G., 1416.

106. Motion denied to suspend interference for admission of testimony that had been, at all times within petitioner's reach.

Where, after decision by Examiners-in-Chief in an interference proceeding, defeated party made a motion for suspension of interference to permit certain testimony to be taken, on the ground that the interpretation of the issue adopted by the Examiners-in-Chief "was a surprise to him," and it appeared that the testimony now sought to be introduced had been, with exercise of a reasonable

diligence, at all times within petitioner's reach: *Held*, that the motion must be refused.

Adams v. Kinzer, Mitchell, Com., 17 Nov., 1890, C. D. Ms.

107. Natural Probabilities.

Where parties to an interference flatly contradict each other upon a material point, the preponderance of evidence may be determined by reference to surrounding circumstances and the natural probabilities.

Ligowski v. Peters v. Hisey, Simonds, Com., 15 Oct., 1891, 57 O. G., 1593.

Of like purport, see *Voelker v. Gray v. Edison v. Bell*, (10) ANTICIPATION. See also *Wilson v. Haines*, (117), and *Doane v. Johnson*, (137) *infra*.

108. New Testimony after Judgment.

No new testimony can be taken or considered after judgment unless, upon proper proceedings, it should appear that there was good reason for setting aside the judgment and for permitting such testimony to be taken.

Parry & Parry v. Black, Fisher, Act. Com., 17 June, 1890, C. D. Ms.

Compare *Van Depoele v. Deecker*, (169) *infra*.

109. Official Suggestions. — Practice.

A petition from the action of the Examiner amounting, in substance, to a refusal to inform applicant of the subject-matter of the "issue" in a proposed interference, in order that he might amend so as to include it in his claims: *Denied*, it not being [now] the practice of the Office to suggest claims to an applicant in order to create a possible interference.

Wheeden, x. p., *Frothingham, Act. Com.*, 18 June, 1892, 60 O. G., 1191.

NOTE. — The Assistant Commissioner referred to the ruling in the case of *McNeil v. Borton & Wilcox* (see (110) *infra*), as conclusive of the above case, but added: *After issue of patent upon the other application, an interference may probably be instituted between the patent and the present application, provided a proper claim be made.*

110. *M* having been advised by the Examiner that a certain claim, which he (the Examiner) quoted, had been adjudged patentable in a pending case, and that said claim might (under Rule 48) be included in *M*'s application; *M*, thereupon, filed an amendment containing said claim, which, having been admitted, interference was declared between *M*'s application and that of *B & W*, the pending case referred to. The Examiner sought to justify his said action on the ground that he had the power and that it was his duty to communicate the claim in question in order that *M*, should he prove priority, might secure a patent for whatever patentable subject-matter was embraced in his application, — citing *Donovan*, x. p. (44 O. G., 697), in defence of this position: *Held*, that if an interference already exists between the claims of two different parties there is no necessity for such a doctrine, and that, while it is undoubtedly true that it is the duty of the Office to place itself in the attitude of a friend, and not that of a litigant, with the applicant, and while this doctrine is one that should be [freely] followed in *ex parte* cases like that of *Donovan*, yet there is no such practice of the Office as warrants extension of the doctrine for the purpose of creating interferences, and that, therefore, the action of the Examiner was irregular.

McNeil v. Borton & Wilcox, Frothingham, Act. Com., 6 May, 1892, C. D. Ms.

Compare *Donovan*, x. p., (1) EXAMINATION; and *Wheeden*, x. p., (109) *supra*.

111. Patentability of "Issue."

When a motion to dissolve an interference between a patent and an application is made, upon the ground of lack of patentability of the "issue," the question to be determined by the Office is not whether the subject-matter of the "issue" was patentable to the patentee, for that [as far as Patent Office action can affect it] was determined by passing of his application to issue, but whether or not it is patentable to the *applicant*.

Prowattain v. Holt, Fisher, Act. Com., 31 Jan., 1891, C. D. Ms.

Compare *Atkinson v. Bentley*, (6) INOPERATIVENESS; and *Hunter, Jr. v. Lane*, (65) *supra*.

112. Preliminary Statement.

To give an applicant any standing in an interference, it is requisite that the date of disclosure given in his preliminary statement antedate the applications already included in the interference.

Freeman v. Hunter v. Zippernowski & Deri v. Edison, Fisher, Act. Com., 24 May, 1890, C. D. Ms.

113. Preliminary Statement. — The Inventive Acts.

The principal object of a preliminary statement is to fix the relative times of the *inventive acts* of the several contestants. Rule 110 requires, among other things, that the dates of the inventive acts, which relate to the subject-matter of the invention set forth in the declaration of interference, shall be given. If, however, a party to the interference has doubts as to whether the subject-matter of his application is properly involved in the "issue" as declared, then, in place of the terms "the invention set forth in the declaration of interference," he may say, "*the invention contained in the claims of my*

application (or patent) declared to be involved in this interference" (see note to Form 35 (a), Rules of Practice).

Haug v. Du Bois, Frothingham, Act. Com., 15 June, 1891, C. D. Ms.

114. Preliminary Statement. — Failure to File.

Upon appeal from decision of the Examiner of Interferences denying motion to re-open interference and permit filing of preliminary statement after judgment had been entered against appellant: *Held*, that it was, in effect, a motion to vacate and set aside the decision as to priority, and it was, therefore, necessary for appellant to make out such a "showing" as would entitle him to a new trial in equity. That the failure to file the preliminary statement within the prescribed time was not to be excused by the fact that applicant did not have the means to prosecute the interference, for it appeared that he was represented by skilled attorneys, and the expense of filing such a statement would have been very slight; nor did it appear that his attorney had been asked or had refused to file such statement.

Thayer v. Ellinwood v. Huss v. Storey v. Scribner, Frothingham, Act. Com., 15 Ap., 1892, C. D. Ms.

115. Preliminary Statement. — Constructive Reduction to Practice.

Applicant sought to amend his preliminary statement by inserting a statement that, in a prior application, he had shown in the drawings and described in the specification the matter involved in the interference: *Held*, that as it did not appear that any claim was made in the prior application, to the "issue" in the interference proceeding, applicant could derive no possible benefit from having the proposed amendment inserted in the preliminary statement so far as the question of a constructive reduction to practice was concerned, and the

decision of the Examiner of Interferences holding that the proposed amendment was "unnecessary, immaterial, and useless," was sustained.

Searle v. Frumveller v. Sessions, Frothingham, Act. Com., 18 June, 1892, C. D. Ms.

116. *The utmost care and diligence*, rather than mere reasonable care and diligence, are required in the making of a preliminary statement.

Henderson v. Noakes, Simonds, Com., 8 June, 1892, 59 O. G., 1762.

117. Preponderance of Evidence.

In doubtful cases the question of priority of invention is determined by a fair preponderance of evidence, and doubts raised as to accuracy of witnesses on minor points will not be permitted to disturb it.

Wilson v. Haines, Simonds, Com., 10 Oct., 1891, 57 O. G., 1278.

Of like purport, see *Ligowski v. Peters v. Hisey*, (107) *supra*; and *Doane v. Johnson*, 137 *infra*.

118. Contest between a Patent and a subsequently filed Application.

Where one of the parties to an interference is a patentee, the burden of proof is heavily upon his opponent, and, unless the evidence is such as would be held sufficient by a court to invalidate the patent already granted, the decision will be in favor of the patentee.

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

Of like general purport, see (119) *et seq., infra*.

119. The party upon whom rests the burden of proof of showing that he used reasonable diligence in adapting and perfecting the invention and reducing it to practice,

must also have made one or more of the invented articles in form adapted to use, not necessarily the best form or a perfect form, but a form that would do useful work.

Atkins v. Fox., Mitchell, Com., 9 Jan., 1891, C. D. Ms.

120. Where one of the contestants for priority 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.

Edison v. Swan, Simonds, Com., 22 June, 1892, 60 O. G., 158.

121. Where a motion for a rehearing of a decision in favor of the patentee in an interference between an application and a patent was made, upon the ground that the Commissioner had erred in holding that applicant's structure did not represent a practically completed invention prior to the issue of the patent, and affidavits were filed to the effect that a person skilled in the art could have completed the invention: *Held*, that in such case the least the law requires [of the contending applicant] is a *full* reduction to practice, and if that stage was not reached, it is of no purpose to urge that it could have been reached by taking a further step which would not involve invention. In many cases, — and, perhaps, in a majority of cases, — where there was a failure to reduce to practice, the omitted step did not call for further invention, but it *did* call for diligence, and *such diligence as would give to the world the completed thing in a useful form*, and that diligence being wanting in Wilson's case, there was a failure to reduce to practice.

Wilson v. Beekman, Mitchell, Com., 16 Sep., 1890, C. D. Ms.

NOTE. — The above able and instructive ruling follows the customary practice of tribunals in treating only the *res adjudicata*. To have overcome Beekman's position as patentee,

Wilson, whose date of application was subsequent to the issue of Beekman's patent, would have had, if necessary, to prove actual successful reduction to practice of the invention, prior to Beekman's reduction, — either actual or "constructive." It was, however, sufficient, as against Wilson, that he had not attained successful practice of the invention even when Beekman's patent issued. That, however (at the last analysis), the determining date is that of the patentee's "reduction," — his own act, not that of the grant, a governmental act, — would seem to have been conclusively established in numerous rulings, some of them by the same learned Commissioner. A few of these rulings are indicated below: Richardson *v.* Denza; Duchemin *v.* Richardson, and Starr & Peyton *v.* Farmer, (1), Hunter *v.* Jenkin, Lowe *v.* Springer, (2) and (3), Lindsey *v.* McDonough, (4), CONSTRUCTIVE REDUCTION TO PRACTICE; Monce *v.* Adams, (1), and Busha *v.* Phelps *et al.*, (5), PRIORITY; Millward *v.* Barnes, (1), Packard *v.* Sandford, (6), Lorraine *v.* Thurmond, (9), Murrill *v.* Chenowith *v.* Wheeler, (10), and Parkhurst *v.* Kinsman, (14), REDUCTION TO PRACTICE; and Hansen *v.* Davis, (124) *infra*. See also Law's Digest, pp. 427 *et seq.*

122. In an interference between an applicant (*G*) and the patentee (*H*), the latter had, upon his conception of the basic idea in May, 1887, formed a company for the manufacture of wheels, in the making of which the device in question was to have been used; made patterns in September; finished the device in October, and put it in operation by the first of November: *Held*, that although *G* had conceived and reduced to practice in August, he had not sustained the burden of proof, for — as it was not claimed that four months was too long to get the factory into working order, and it appeared that it was *H*'s intention to employ the device when the factory should be completed — the question of diligence should be determined in his favor.

Grant *v.* Harris, *Mitchell, Com.*, 29 Ap., 1891, C. D. Ms.

123. An applicant should not be detained in the Office to contest priority with a patentee unless he makes a claim which sets forth all the steps and stages [of the process] specified in the claim or claims of the patent; nor should the Office subject a patentee to the expense of an interference unless it is prepared to allow the applicant a claim corresponding to that already granted to the patentee.

Withrow v. Robert, Mitchell, Com., 23 May, 1890, C. D. Ms.

124. The grant of a patent vests in the patentee certain rights. It establishes certain presumptions (not conclusive, but rebuttable), among which are: (1) that the patentee was an original inventor; (2) that he was the first inventor; (3) that the invention was new and useful; (4) that it had not been known or used in this country, nor patented nor described in any printed publication either in this or any foreign country, before it was invented by the patentee; (5) that it had not been abandoned or dedicated to the public; (6) that it had not been in public use or sale within the United States for more than two years prior to the application; [(7) that the patent contains a description whereby one skilled in the art can practise the improvement without the necessity of invention on his part; and (8) that it contains a concise particularization of the part, improvement, or combination which he claims as his invention]. The burden of proof is upon any one who attempts to show that any one of these presumptions is incorrect, and it is only after such person has, by proof beyond a reasonable doubt, overcome the patentee's *prima facie* case arising from the previous grant of a patent, that he is entitled to have the burden of proof shifted to the patentee.

Hansen v. Davis, Mitchell, Com., 4 Ap., 1891, C. D. Ms.

125. An interference should not be declared between an unexpired patent which shows and claims one species of invention and a subsequent application disclosing another and different species, but making a claim of sufficient scope to include the device claimed in said patent.

Reed v. Landman, Mitchell, Com., 26 May, 1891, C. D. Ms.

126. *McD*'s only date was his "record date," viz. : that of his application, — 15 May, 1889. *L*'s dates, alleged in his preliminary statement, were: conception 1 June, 1889, ; disclosure and reduction to practice 1 July, 1889. His record dates were: application 5 Nov., 1889; and his patent 11 Mar., 1890. *L* acquired no advantage by the issue of his patent while *McD*'s application was pending (*Marston*, x. p., 21 O. G., 633). Neither party having taken any testimony, award was necessarily made *on the record* (Rules 116 and 117) and in favor of *McD*, he being the senior applicant. The petitioner (*L*) averred that the mere filing of an application for patent is not a reduction to practice of the invention, and that the inventor entitled to a patent is he who first reduces it to actual practice, although he may be the last to conceive and the last to file application for patent. The accuracy of *L*'s interpretation of the law was denied, and the Commissioner said that it must be assumed that *McD*'s allowed application discloses, in a practical and operative form, the invention specified in the interference issue, and cited and applied the ruling of Commissioner Marble, in the case of *Starr & Peyton v. Farmer* (1883 C. D., 34), where he said: —

"The issue is priority of invention. Reduction to [actual] practice may be better evidence of invention than an application, and it may be a necessary element of title in some or all cases, but the evidence furnished

by the application is all that is required by law to establish the existence of the invention, at least as early as the date of filing, for the purposes of examination and for the purpose of granting a patent thereon, and until that evidence is overthrown and some prior invention brought to view, the applicant is not called upon to furnish any better."

It results that it is immaterial whether or not *McD* reduced the invention to [actual] practice prior to the date of his application. The Office records show that he had perfected his invention before the earliest date alleged on behalf of *L*.

Lindsay v. McDonough, Mitchell, Com., 27 May, 1891, 55 O. G. 1402.

127. An application for a patent which eventuates in the grant of a patent is a constructive and 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.

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

128. 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.

Ib.

129. 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

cancellation of the patent by the Office if jurisdiction existed for that purpose.

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

130. Since patents are now re-issued strictly for the same inventions covered by the original patents, and since the surrender of the original patent does not take effect until the issue of the amended patent, it seems that the same presumptions apply to the application for the re-issue of patent as to the patent itself, and that the proof required of a contesting applicant is the same in either case.

Hansen *v.* Davis, *Mitchell, Com.*, 4 Ap., 1891, C. D. Ms.

131. In an interference contest where neither party establishes a perfectly clear case on the evidence, the presumption is in favor of a party having a patent, as against one who has not, and the latter, in order to prevail, needs to establish his case by proof which does not admit of a reasonable doubt.

Weston *v.* Richardson, *Simonds, Com.*, 17 Oct., 1891, 57 O. G., 1425.

132. Where an applicant for patent seeks to overcome a patent already granted he must make out a case, both as to conception and diligence in reduction to practice, which does not admit of a reasonable doubt (*Hunter v. Jenkin*, 56 O. G., 1705).

Hunter v. Van Depoele, *Simonds, Com.*, 15 Dec., 1891, 57 O. G., 1720.

See also *Dillon v. Kimball et al.*, 58 O. G., 384.

133. The law gives the patent to him to whose ingenuity and perseverance the world is indebted for the invention in available form.

It is not necessary for the validity of a patent that the patentee should have been the first who conceived

the practicability of the thing patented, but who, though making important experiments, was unable to bring them to any successful or patentable result. He who reduces speculation to practice ; whose experiments result in discovery ; and who puts the public into *practical and useful possession* of the compound, art, machine, or product, is entitled to the patent.

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

134. There is no evidence, in this case, that leaves the shadow of a doubt that, for all the benefit conferred upon the public by the introduction of a sewing machine, they are indebted to Elias Howe. A machine, in order to anticipate a subsequent discovery [for which a patent has issued] must have been perfected, — that is, made so as to be of practical utility, and not be merely experimental and ending in experiment. Until of practical utility, public attention is not called to the invention ; it does not give to the public that which it lays hold of as beneficial. If an invention is an experiment only and ends in experiment and is laid aside as unsuccessful, — however far it may have been advanced, however many ideas have been combined in it which, subsequently taken up, might, when perfected, have made a good machine, still, not being perfected, — it has not come before the public as a useful thing, and is, therefore, entirely inoperative as affecting the rights of those coming afterward. Though a prior inventor has gone to a certain extent, if he fall short of making a complete machine, practically useful, those who come after him may secure to themselves the advantages of his invention. The first inventor gave nothing to the public : his so called invention was an idea only, never carried out in a machine that could anticipate one subsequently invented.

Howe *v.* Underwood, *Sprague, J.*, 24 Feb., 1854, 1 Fisher, 161.

135. Patents cannot be put in interference with one another in the Patent Office.

There can be no doubt that an interference cannot be declared in the Patent Office between two patents, and it is more than possible that the objection to such a procedure is not overcome by the fact that an application is also involved in the same controversy. When, however, an interference had been declared between two patents and an application, and one of the patents had dropped out of the race by reason of judgment entered against the patentee, under Rule 114, for failure to file a preliminary statement: *Held*, that no useful purpose would be served by dissolving the interference on that ground [viz., that two of the original contestants were patentees].

Haish *v.* Rosado *v.* Aishton, *Mitchell, Com.*, 31 May, 1890, C. D. Ms.

NOTE. — A patentee's remedy against the grantee of a conflicting patent is by suit in equity, — see Sec. 4918. See, also, *Foster v. Lindsay*, 3 Dill., 127.

136. The Preliminary Statement.

Each party to an interference is required to file a concise preliminary statement (under oath), on or before a date fixed by the Office, showing (1) Date of his original conception of the invention defined in the declaration of interference. (2) Statement of whether, and at what date, he made any drawing, sketch, or model. (3) *When, where, and under what circumstances the invention was first disclosed, and to what person or persons.* (4) Whether, and at what date, the invention was reduced to practice, and the extent of its use.

P. O. R., 110.

137. Where official definition of the "issue" is defective.

If there is any doubt as to the scope of the interference issue, each applicant should confine his preliminary statement to the invention contained in those claims of his application which are declared to be involved in the interference, and not attempt to frame the statement to cover two or more possible constructions of the "Issue."

Haug v. Dubois, Frothingham, Act. Com., 15 June, 1891, 56 O. G., 1061.

See PRELIMINARY STATEMENT.

138. Preponderance of Evidence.

Where neither party made a clear showing of the required facts, priority is awarded in accordance with the preponderance of evidence, however slight it may be.

Doane v. Johnson. Jr., Simonds, Com., 9 Oct., 1891, 58 O. G., 1414.

Of like purport, see *Ligowski v. Peters v. Hisey* (107), and *Wilson v. Haines*, (117) *supra*.

139. Where actual reduction to practice is wanting and the testimony of both parties as to conception and disclosure is of like meagre and unsatisfactory character, the earlier date of disclosure will prevail. On this understanding, the decision of the Board of Examiners-in-Chief was affirmed and priority was awarded to Doane.

Ib.

140. Neither party made an actual reduction to practice before his application was filed. J was in the Office first, and presented some testimony tending to corroborate his claim to earliest conception. He did not

present a strong case, but that of his opponent, *B*, was certainly less strong. Decision of the Examiners-in-Chief in favor of *J* was affirmed.

Buckingham v. Jones, Simonds, Com., 16 Sep., 1891, 58 O. G., 1413.

141. *B*'s date of conception was practically 30 May, 1885. *J* testified to a conception and disclosure occurring earlier in the same month, and there was some testimony tending to corroborate his statement in that regard. Besides this, somewhat problematical, position as the earlier discloser, *J*, by his date of filing, sixteen days in advance of *B*, held the position of senior applicant. Neither, before the date of his application, had made an actual reduction to practice. There was no testimony for either side that was strongly decisive, and the decision admittedly went upon the ground of giving it to that side which had the least weakness. On this showing the Examiner of Interferences and the Examiners-in-Chief alike awarded priority to *J*.

Ib.

142. Priority, — Test of. — The Rule and the Exception.

The rule is well settled that he is the true inventor and the party entitled to a patent who first reduces the invention to practice, unless another, first to conceive, was using reasonable diligence.

Dickson v. Kinsman, Marble, Com., 14 Oct., 1880, 18 O. G., 1225.

NOTE. — The object of the law being to encourage invention, the presumption is necessarily in favor of him to whom the public is indebted for its earliest knowledge of the thing invented in tangible and available form (*Monce v. Adams*, (1), *Christie v. Seybold*, (2), *Disston v. Emerson*, (3), *Manny v.*

Easley, (7), and Lorraine *v.* Thurmond, (8), PRIORITY. See also Sessions *v.* Sewall, (51) and (144), INTERFERENCES). This presumption remains unless overcome by one who can show earlier claims to that necessary premise of invention, — *the original creative thought*, — and who can show reasonable and persistent diligence in completing and in making application for patent for the invention (Edison *v.* Foote & Randall, and Parkhurst *v.* Kinsman, (2) PRIORITY). Some decisions — approaching the question from another point of view — reverse the above (which is also the usual) statement of the rule and the exception; see Hunter *v.* Jenkin, (143) *infra*.

For an instructive presentation of the entire question see the decision of the Supreme Court of the United States in Smith *v.* Nichols, (3) SCOPE OF PATENT.

143. Priority — The Rule and Exception.

The general rule is that he who is the first to conceive of an invention is entitled to a patent for it if he reduces the same to practice with reasonable diligence; but if he does not reduce to practice [and that] with reasonable diligence, he who was subsequent to conceive, but first to reduce to practice, will prevail.

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

NOTE. — Decisions, such as Dickson *v.* Kinsman, (142), and Hunter *v.* Jenkin, (143) *supra*, that approach the same truth from different points of view, may, perhaps, be conveniently summarized by stating that — inasmuch as an invention has no legal status until embodiment in an available form (Detwold *v.* Reeves, (1) INVENTION) — the *prima facie* presumption of priority necessarily belongs to and remains with him who was first to give the world such an embodiment, until the appearance on the scene of another inventor, in whose favor the presumption shifts on his establishing an earlier date for the creative thought.

144. The settled rule of law is that whoever perfects a machine is entitled to the patent and is the real inventor, although others may have previously had the idea and may have made some experiments toward putting it in practice (*Agawam Co. v. Jordan*, 7 Wallace, 583, *). An exception, however, to this rule is recognized in cases where the first to conceive is diligent in adapting and perfecting the invention [and *does* perfect it] and, in all controverted cases, it must first be ascertained whether the rule or the exception to the rule is applicable to the facts involved in the controversy (*White v. Allen*, 2 Clifford, 224; *Lorraine v. Thurmond*, 51 O. G., 1781; *Ecaubert v. Hofman*, 52 O. G., 2107).

Sessions v. Sewall, *Frothingham, Act. Com.*, 22 Aug., 1891, C. D. Ms.

As to "the Rule and the Exception," compare (142) and (143) *supra*, and notes thereto. Also compare *Howe v. Underwood*, (134) *supra*; and *Edison v. Foote v. Randall*, and cases there cited; see also (12) REDUCTION TO PRACTICE.

145. In interference contests, questions of priority take precedence of questions of abandonment.

Where, pending a question of abandonment, the application has been renewed and thereafter placed in interference: *Held*, that whatever might prove to be the condition of the application as to the question of abandonment, the interests of the public would be best conserved by having the question of priority first determined, but that, if applicant were successful in the interference, the attention of the Commissioner should be called to the question of abandonment before issuing the patent.

Young, x. p., *Frothingham, Act. Com.*, 24 Dec., 1891, C. D. Ms.
Compare *Hunter, Jr. v. Lane*, FEIGNED ISSUE.

146. Process and Apparatus.

Whether a process and an apparatus [for use therein and hence, includable in a single patent] are to be

regarded as independent or dependent inventions, all agree that they are separate and distinct inventions; (Atwood, x. p. 1888, C. D. 74) so that claims for the one cannot conflict with claims for the other.

Crane v. Meriam, Mitchell, Com., 31 May, 1890, C. D. Ms.

147. The action of the Examiner denying a motion by a party to an interference to have a certain process patent to another party to the interference included, and which was conceded by the Examiner to cover a method having the same purpose in view as the subject-matter of the interference, but which interference related to an organized apparatus: *Sustained*, inasmuch as a claim for a process and a claim for an apparatus for carrying out the process do not conflict (Atwood, x. p. 44, O. G., 341 and *Crane v. Meriam*, 31 O. G., 1783).

McTighe v. Hunter v. Kennedy, Frothingham, Act. Com., 16 Dec., 1891, C. D. Ms.

148. Questions of Interference and Questions of Infringement, Defined and Distinguished.

Where it appeared that the interference had been declared, — not between claims which conflicted in the sense that they covered the same subject-matter, but, — in the sense that devices made under a patent granted to one of the parties would infringe a patent granted to the other party: *Held*, that such an issue [in an interference proceeding] is not contemplated by the statute; that the law does not intend that prospective infringements shall be a test of interference between applications for patents. It only intends that the test shall be, — Do the applications contain [and claim] the same substantial invention.

Hotchkiss v. Smith & Post, Fisher, Act. Com., 25 June, 1890, C. D. Ms.

Compare *Crane v. Meriam* (146), and *McTighe v. Hunter v. Kennedy* (147), *supra*.

149. Question of Abandonment.—Duty of the Examiner.

Where, upon awarding priority to one of several parties to an interference, on evidence which showed conception, disclosure, and reduction to practice by the prevailing party in 1883, but a failure to file his application until 1888, and it appeared that an article covered by the claims had been for a long time made by hand; the Examiner was directed, before allowing the application, to consider whether the invention had been abandoned.

Eberson v. Shea v. Reece v. Thomson & Phelps, Frothingham, Act. Com., 14 Aug., 1891, C. D. Ms.

Compare *Young*, x. p., (145) *supra*, *Deprez & Carpentier* (150) *infra*, and *Hunter, Jr. v. Lane*, FEIGNED ISSUE.

150. Where a case that has been involved in interference is before the Examiner for consideration *ex parte*, and he is of opinion that the testimony in the interference record presents a fair presumptive showing of public use [such as works abandonment], he should act accordingly and without any expression of opinion thereon from the Commissioner in advance.

Deprez & Carpentier, x. p., *Frothingham, Act Com., 27 Aug., 1891, C. D. Ms.*

151. Question of abandonment should not interrupt interference proceedings.

Where the question of public use arises in an interference proceeding, the progress of the interference should not be interrupted for the purpose of determining such question, unless for extraordinary and amply sufficient reasons.

Campbell v. Brown, Simonds, Com., 16 Sept., 1891, 56 O. G., 1565.

152. When the question of public use arises in an interference proceeding, the progress of the interference should not be interrupted for the purpose of determining such questions unless for extraordinary and amply sufficient reasons. The rules and practice of the Office afford ample opportunity for determining such [purely *ex parte*] questions at the proper time.

Ib.

For a like postponement of questions of inoperativeness, see Archer, x. p., (7) INOPERATIVENESS. For postponement to determine question of patentability, compare Fiske, x. p., (191) *infra*.

153. Recommendation by Examiner that public use proceedings be instituted as laid down in Barricklo, x. p. (1886, C. D. 39): *Denied*, because predicated on a communication which fell short of establishing a *prima facie* case (Finch, x. p., 1887, C. D. 96; Deprez, x. p., 48 C. D. Ms., 80).

Beatly, x. p., *Simonds, Com.*, 10 Sep., 1891, 56 O. G., 1563.

154. Identity a question of "Merits."

Upon a petition from Examiner's refusal to declare an interference between one of applicant's rejected claims and the claim in a patent: *Held*, that as the petitioner assumed that the claims were identical, it was a question of "merits," and his remedy was, therefore, an appeal to the Board of Examiners-in-Chief.

McDougall, x. p., *Frothingham, Act. Com.*, 30 Jan., 1892, C. D. Ms.

155. The objection to a certain patent being included in an interference, for the reason that its claims purported to cover a method, while the interference "issue" related merely to an apparatus, raises a question which

relates to the "merits," and is to be passed upon, in the first instance, by the Primary Examiner.

McTighe *v.* Hunter *v.* Spencer, *Frothingham, Act. Com.*, 17 May, 1892, C. D. Ms.

156. From a refusal of the Examiner to dissolve an interference on a motion that amounts to a denial of patentability, appeal to the Commissioner is improper.

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

157. No appeal lies to the Commissioner from a refusal of the Examiners-in-Chief to direct the attention of the Commissioner in a decision in an interference case to certain patents alleged by one of the contestants to constitute a statutory bar.

Schmiedl *v.* Walden, *Simonds, Com.*, 10 Sep., 1891, 56 O. G., 1563.

158. Where an application in interference had shown without claiming the "issue." — Remedy.

After the admission of an amendment under Rule 109, the Examiner redeclared the interference: *Held*, that, whether or not the interference proceeding be given a new number, it was evident that what the Primary Examiner had done was merely to redeclare the interference. It was not an interference *de novo*.

Jeune *v.* Brown *v.* Booth, *Frothingham, Act. Com.*, 9 Jan., 1892, C. D. Ms.

159. Non-reduction to actual Practice. — Failure to Claim the "Issue."

In June, 1881, one *M* conceived an improvement in tow-boats and illustrated the same by drawing and model. Subsequently an improvement having the same general features was conceived by one *P*. In Jan., 1882, *P* filed

an application for patent with a single broad claim. In Ap., 1882, *M* filed an application with several claims, of which *neither covered the feature common to both applications*. In May, 1882, a patent with the aforesaid broad claim issued to *P*. In June, 1882, a patent having four claims, *neither of them conflicting with P*, issued to *M*. In Jan., 1883, *M* filed a second application that described a tow-boat, which again comprised features common to both *M* and *P*. In Sep., 1889, *M*, under a division of his January application, presented a broad claim, that was at first rejected on, and subsequently put in interference with *P*'s patent. *At the date of P's application M had never put the device into actual practice.*

Decision of the Examiners-in-Chief, which awarded priority to *P*, was affirmed.

McDougall *v.* Phinney, *Simonds, Com.*, 13 Aug., 1891, 56 O. G., 928.

Compare Edison *v.* Stanley, 57 O. G., 273.

160. Of two or more interfering applicants, he is entitled to the right, who, having been the first to disclose the fundamental idea, has reduced the invention to practice and has described the same in a seasonably presented application for patent, with sufficient perspicuity to enable a person skilled in the art to put it in execution; but, when the contest is between an applicant and a patentee, such applicant is required in addition to proving earliest disclosure, to show that he had used reasonable diligence and that he had put the invention into actual practice, before the date of the patentee's reduction to practice (either actual or constructive), and with such completeness and publicity that, had it been more than two years before application, the invention would have become public property.

Duchemin *v.* Richardson, *Fisher, Com.*, 1870, C. D., 31.

See, also, Richardson *v.* Denza, 1870, C. D., 156; McCulloch

v. Watkin, Spear, Act. Com., 1 Nov., 1875, 8 O. G., 1074; *Busha v. Phelps & Edmunds, et al., Doolittle, Act. Com.*, 18 May, 1876, 9 O. G., 1010; *Stephenson v. Goodell, Duell, Com.*, 3 June, 1876, 9 O. G., 1195, 1196; *Packard v. Sandford*, 12 Dec., 1879, *Paine, Com.*, 16 O. G., 1182; *Dickson v. Kinsman, Marble, Com.*, 14 Oct., 1880, 18 O. G., 1225; *Starr & Peyton v. Farmer, Teller, Sec. Int.*, 28 Ap., 1882, 23 O. G., 2327; *Law's Digest*, pp. 427 *et seq.*

161. As between two or more interfering applications, an invention is complete when the thought conceived is *embodied* in some practical and operative form. The question is not when was the invention completed so as to compete commercially with others, but when was it completed as an operative invention.

Sawyer & Mann v. Edison, Marble, Com., 8 Oct., 1883, 25 O. G., 597.

162. The discovery must have been embodied in an operative machine.

It is not he who first notices a phenomenon who is the inventor, but he who recognizes the value of it and draws advantages from it; nearly all scientific facts have been seen and were discussed before they were utilized. He who discovers the thing anew and *makes a machine of it* is the real inventor.

DuMoncel, *Electricity as a Motive Power*, p. 179.

163. The crucial test is, to whom is the public indebted for possession of the invention.

Boyd v. Cherry, 4 *McCreary*, 70; 1 *Robinson on Patents*, 554.

See, also, *Gill v. Scott*, 23 O. G., 2511 and *Green v. Hall v. Siemens v. Field, Hall, Com.*, 6 Mar., 1889, 46 O. G., 1515.

164. Reinstatement of Interference.

Where an interference between two applications and a patent had been dissolved by the Primary Examiner upon the ground that one of the applicants, being also one of the joint patentees, was one and the same party in law: *Held*, that the Examiner's conclusions were not justified by the ground stated, and the interference was reinstated.

Blanvelty v. Stone v. Stone & Pitt, Simonds, Com., 25 Sep., 1891, C. D. Ms.

Of like general purport, see (181) *et seq., infra*.

165. Reinstatement of an Omitted Party.

Where, by an official oversight, a party had been omitted upon resumption of the interference proceedings: *Held*, that, an error having been committed by the Office, it could, of its own motion, have reinstated the party, and that it was equally within the power of the Office to vacate the judgment and reinstate the party omitted, upon petition from him and without notice to the other parties.

Freeman v. Hunter v. Zippernowski & Deri v. Edison, Fisher, Act. Com., 24 May, 1890, C. D. Ms.

Compare *Rogers v. Wissinger, (23) supra*, and (166) *infra*, and *Crandall v. Sholes, (25) supra*.

166. Remedy for Official Error.

A contestant who believes that error has been committed by the Office in applying Rule 114, may seek correction of the same, either by a motion to vacate judgment before the Examiner of Interferences or by an appeal to the Examiners-in-Chief.

Rogers v. Wissinger, Mitchell, Com., 5 Ap., 1890, C. D. Ms.

Compare *Crandall v. Sholes (25)*, and *Freeman v. Hunter v. Zippernowski & Deri v. Edison, (165) supra*.

167. Renewal Application in Interference; Filing, Date of.

A party's renewal application properly filed in place of his successful application forfeited for nonpayment of the final fee is, for purposes of interference a continuation of the earlier application and takes its filing date therefrom.

Duchemin v. Priester & Schutz, Simonds, Com., 1 Mar., 1892, 58 O. G., 1416.

168. Reopening of Interference, Where granted.

Where an assignee's attorney, before going abroad, substituted another attorney in a number of interferences in which his client was a party, but, — by reason of his oversight in not executing a power in a particular case, — his client's assignees, who had become solely interested in the invention, were in ignorance of the condition of the case until notified that judgment had been rendered against their assignor for failure to take testimony: *Held*, that it appeared that the assignees were acting in good faith, and that the Examiner of Interferences did right in granting a motion to reopen, although it might be true that there had been negligence upon the part of assignor's attorney.

Shinn v. McElroy, Fisher, Act. Com., 12 May, 1890, C. D. Ms.

169. Reopening of Interference. — When Refused.

Upon appeal from a refusal by the Examiner of Interferences to set aside judgment rendered against *A* and reopen the interference for the purpose of enabling him to take additional testimony, — the ground of said refusal being that the evidence which *A* desired to take was not newly discovered, and that, with reasonable attention and diligence, it could have been procured before the hearing: *Held*, that cases of this kind are to be governed

by the principles which govern the grant of new trials in the courts, and the decision of the Examiner of Interferences was sustained.

Van Depoele *v.* Deecker, *Fisher, Act. Com.*, 7 Ap., 1890, C. D. Ms.

Compare Parry & Parry *v.* Black, (108) *supra*.

170. An application for re-opening of an interference for the introduction of new testimony must show that the petitioner could not, with reasonable diligence, have obtained prior to the former hearing the testimony sought to be introduced. Furthermore, if the newly discovered evidence would not change the result which has been arrived at, the interference should not be re-opened.

Bowen *v.* Bradley, *Simonds, Com.*, 18 Sep., 1891, 56 O. G., 1707.

171. Sufficient "Showing" of Diligence.

It is not a sufficient showing of diligence to state that "every attempt was made that could reasonably be made" to discover the testimony, or that the party had been "diligent" in so doing; *the particular efforts and attempts* to discover the testimony must be set forth, from which the trier may be able to judge for himself whether the degree of diligence necessary for granting the motion to take additional testimony had been established.

Kanneberg *v.* Snyder & Belding, *Frothingham, Act. Com.*, 31 Oct., 1891, C. D. Ms.

172. Where, in an interference proceeding between *A*, *B*, and *C*; *A*, knowing or believing that *B* could ante-date him [on the broad claim], made no contest beyond filing a statement, and consequently the interference was contested by *B* and *C* alone, and priority was

awarded to *B*; and where *A* afterward persisted in certain claims — under narrower “issues” — which were thrown into interference with the application of *C*: *Held*, that *A*'s election to withdraw from the contest on the broader “issue” did not preclude him from contesting the narrower issues, for he was under no obligation to contend for what he knew he was not entitled to in order to preserve his footing to contest for that which, so far as the Office knows, he may all along have believed himself to be the first inventor of.

Smith v. Bentley, Mitchell, Com., 9 Ap., 1890, C. D. Ms.

173. **Res Adjudicata.**

The question whether an interference may again be litigated when a prior adjudication has been had between the same parties, involving the same invention, has often arisen in connection with hearings in the Patent Office, and for many years the propriety of disposing of such a question upon a motion to dissolve seems to have been unquestioned (*Abraham v. Fletcher*, 1869, C. D. 50; *Harlow v. Guernsey*, 1875, C. D. 47; *Richel v. De Sanno*, 1876, C. D. 203; *Whiteley v. McCormick*, 1876, C. D. 208). And where Office action such as in *Unger v. Saxlehner* (35 C. D. Ms., 430) seemed to the Examiner to establish a different practice: *Held*, that in that case the Commissioner (Hall) intended only to decide that, upon the facts of that particular case, the proper course was to treat the prior judgment as evidence to be weighed upon the final hearing in connection with the proofs in the case at issue.

Hunter v. Knight, Mitchell, Com., 3 Ap., 1890, C. D. Ms.

174. **Res Adjudicata. — Ignorance of Law or Practice not pleadable.**

An applicant who, to save expense, employs counsel unfamiliar with interference proceedings to take testi-

mony, cannot, after discovering that he has not made out his case in such a manner as he might if the testimony had been taken by counsel familiar with such proceedings, be allowed to retake his testimony.

Ricker v. Merrill, Fisher, Act. Com., 24 July, 1890, C. D. Ms.

NOTE. — In the above case the Examiner of Interferences had denied the motion upon the authority of *Donellan v. Barry*, 37 C. D. Ms., 386, in which Commissioner Hall said: —

“There is no showing that the testimony now sought to be introduced is newly discovered, or that, by the aid of competent counsel, it could not have been presented within the time originally allowed. . . . A practice which would permit a contestant to experimentally conduct his own case to a probable failure, and then, after consultation and with competent assistance, would permit him to make further endeavors to show what, with such assistance, he could and should have earlier shown, would be contrary to all well-established rules and legal principles.”

For circumstances justifying some relaxation of the above doctrine where the case was an *ex parte* one, see ruling by Commissioner Mitchell in case of *Marx*, x. p., 21 July, 1891,

(5) RE-INSTATEMENT OF CLAIM.

Compare 1 *et seq.*, IGNORANCE NOT PLEADABLE.

175. Right to demand an Interference.

Until an applicant has acquired the standing of one entitled to a patent — as between himself and the public — he has no standing to demand an interference with any other applicant or with a patentee.

Abbey, x. p., *Mitchell, Com.*, 14 Mar., 1890, C. D. Ms.

176. Rule 128. — Practice.

When an interference is suspended under Rule 128, the claims deemed to be anticipated should be rejected by the Primary Examiner, and the files and papers should not be returned to the Examiner of Interferences until it has been determined whether the appellate tribu-

nals will sustain the Primary Examiner in rejecting the claims, or until there has been such delay on the part of the applicant in taking appeal as to authorize the Office either to dissolve the interference, or to issue a patent to the opposing party.

Westinghouse v. Thomson, Mitchell, Com., 26 June, 1891, C. D. Ms.

177. Secondary Evidence, — When admissible.

Where a motion was made by the opposing party to strike out certain testimony as to the construction of a machine not itself put in evidence, upon the ground that "such testimony constituted mere secondary evidence, and that, no proof having been brought forward that the alleged machine could not be found, a sufficient basis for the introduction of such evidence had not been laid," and the Examiner of Interferences had ruled that as the testimony disclosed that the whereabouts of the machine was unknown, its non-production as primary evidence was sufficiently accounted for, and the decision of the Examiner of Interferences had been affirmed on appeal; a motion for rehearing by the opposing party was denied on the ground that the answers to the several questions showed that it would have been unavailing to have made a search for the machine. Leave was, however, granted to urge the matters presented by the motion at the final hearing before the Commissioner.

Wiselogel v. Morse; Morse v. Wiselogel, Mitchell, Com., 10 Nov., 1890, C. D. Ms.

178. Skilled Assistant.

Where, in an interference proceeding, it was contended that, by reason of certain modifications and extensions made by *A*'s draftsman, that person, and not *A*, was the real inventor of the feature in the interference issue: *Held*, that the scope of the invention between *A* and

his skilled assistant was to be determined just as it would be determined if that particular question, and no other, were in issue, and priority was awarded to *A* (*Agawam Co. v. Jordan*, 7 Wallace, 583, *).

Shreve v. Evans, 12 Aug., 1891, C. D. Ms.

Compare cases cited under EMPLOYER AND EMPLOYÉ.

179. Constructive Waiver.

The Examiners-in-Chief did not err in refusing to strike out the testimony of witnesses upon the ground that no notice had been given that said witnesses were to be examined where the opposing counsel was present at the examination and *cross-examined* said witnesses (citing Rule 154).

Creteau v. Hall, Frothingham, Act. Com., 17 Nov., 1891, C. D. Ms.

NOTE (i). — The passage referred to in Rule 154 is —

If the opposing party shall attend the examination of witnesses not named in the notice, and shall either cross-examine said witnesses *or* fail to object to their examination, he shall be deemed to have waived his right to object to such examination for want of notice.

NOTE (ii). — The appeal was based principally on the Board's refusal to strike out certain testimony on behalf of Hall. Creteau's counsel had entered a protest and non-waiver on the testimony-record, but, inasmuch as he proceeded to cross-examine, that act was construed to be a waiver of his objection.

180. In an interference proceeding test of inventorship is not in suggestion of the object sought, but in production of the means to accomplish it.

It is not enough that one of the parties engaged in interference with Bell's patent should have conceived it possible to construct a device that would produce the result sought. The conception must not be of the re-

sult to be attained, but of the means, which is the patentable thing, to produce that result.

Voelker v. Gray v. Edison v. Bell, Butterworth, Com., 30 O. G., 1092.

181. The Subject-Matter must conflict.

An interference should not be declared between an unexpired patent which shows and claims one species of an invention and a subsequent application disclosing another and different species, even although the latter contains a claim of sufficient scope to include the species contained in the unexpired patent. Rule 75 provides for precisely such a case and unmistakably states that, on applicant filing the proper antedating oath, the unexpired patent ceases to be a bar. The showing, however, of the oath should of course be complete and satisfactory and should satisfy the Examiner that the facts testified to establish completed invention before the filing of the application upon which the patent was granted (*Donovan*, x. p., 52 O. G., 309; *Hurlburt*, x. p., 52 O. G., 1062).

Reed v. Landman, Mitchell, Com., 26 May, 1891, 55 O. G., 1275.

See AFFIDAVIT TO OVERCOME REFERENCES.

182. An Interference looks to Subjects-Matter rather than to Parties.

An interference looks to subject-matter rather than to parties. For all purposes of interference, a sole application filed by one of two or more joint patentees for the same invention as that for which the joint patent issued, is as independent thereof as though filed by a third party. The evidence for *S & B*, which showed *S* (as between *S* and *B*) to be sole inventor is not conclusive in a subsequent interference between an application by *S* as sole inventor and the application of a third party *K*. As between *S* and *K*, the decision in the previous inter-

ference could only show that *S & B* had failed to establish a *joint* invention as against *K*, but could not affect the claims of *S* as sole inventor.

Snyder v. Kanneberg, Frothingham, Act. Com., 17 Mar., 1892, 58 O. G., 1840.

See *Kanneberg v. Snyder & Belding* (171), *supra*; also, *Sprague v. Van Depoele v. Hunter v. Knight*, (185) and (186) and *Rogers v. Wissinger*, (187) *infra*.

183. The Claims must conflict.

Interference can exist only between conflicting claims for the same invention. There is nothing in *Upton*, x. p. (1884, C. D., 26), that affords any warrant for the view that claims can conflict which are not for the same invention, either generically or specifically.

Crane v. Meriam, Mitchell, Com., 31 May, 1890, C. D. Ms.

Of like purport, see *Rogers v. Wissinger*, (23); *Dodd v. Reading*, (33); *Edison v. Heisinger*, (66); *Jeune v. Booth*, (71); *McTighe v. Hunter v. Kennedy*, (147), and *Hotchkiss v. Smith & Post*, (148) *supra*, and cases (184), (185), (186), (187), (188) and (189) *infra*. See, however, *Dewey v. Thomson*, (66); *Reed v. Landman*, (67), *Edison v. Stanley*, (69), and *Gould v. Case*, (72) *supra*.

184. Official Suggestion in *Inter Partes* Cases, — Forbidden.

It is not the business of the Office, unless directed to such course by the claims of the parties, to search out matter which may be common but which is not disclosed or claimed by *both* parties in such a manner as to bring the common matter in conflict.

Sprague v. Van Depoele v. Hunter v. Knight, Fisher, Act. Com., 24 July, 1890, C. D. Ms.

NOTE (i). — The above dictum (which is substantially a reiteration of the doctrine laid down in the Patent Office Rule

75 and given a specific application in the case of Upton, x. p., 27 O. G., 99) marks an important departure from the practice which permitted official suggestions whereby an applicant who had described but not claimed matter which, if properly set forth in his claim, would have brought his case into interference with a cotemporary application, was given the opportunity to revise his application for that purpose.

NOTE (ii). — The doctrine laid down in *Sprague v. Van Depoele v. Hunter v. Knight*, *supra*, and in *Ricker v. Merrill*, (174) *supra*, for all *inter partes* cases; such rulings as that in *Wallis*, x. p., (3) RE-OPENING OF CASE, and, above all, the restriction of remedy by Re-issue made by the Supreme Court in *Edward Miller and Co. v. The Bridgeport Brass Co.*, (2) RE-ISSUE, have combined to *greatly increase the importance of care, judgment, and familiarity with the law and practice of those into whose hands is committed the preparation and prosecution of original applications for patents.*

185. The decision in Upton, x. p., (27 O. G., 99) explicitly states that the subject-matter *claimed* must conflict and, under recent decisions, the doctrine of that case has been held to require that the claims should be co-extensive in scope, or, at least, that the claim of one party should include that of the other party in such a sense that the broader claim can be predicated upon the subject-matter embraced in the narrower claim (*Bechman v. Johnson*, 41 C. D. Ms., 372; *Dewey v. Thomson*, 43 C. D. Ms. 44).

Ib.

Compare *Reed v. Landman*, (181), and *Snyder v. Kanneberg*, (182), *supra*, and *Rogers v. Wissinger*, (187), *infra*.

186. It is not held, — in any decision of which I am aware, — that the claim of one party can include that of another, so as to bring them into interference, when

the structures upon which the claims are based are entirely dissimilar and effect different purposes by different ends.

Ib.

187. The question whether interference in fact exists depends, not merely upon the language employed in the respective claims, but whether, in addition to similarity in phraseology, there is an interference between the *subjects-matter* of the respective claims. If, when construed in the light of their respective specifications, the claims involved in an interference are found to relate to different subjects-matter then, although the phraseology may be the same, the claims are different in a patentable sense.

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

Compare *Jeune v. Booth*, (71), *Snyder v. Kanneberg*, (182), and *Sprague v. Van Depoele v. Hunter v. Knight*, (185), and (186), *supra*.

188. Interferences in the Patent Office, like interferences in the Courts, exist only where the claimed inventions conflict.

Reed *v.* Landman, *Mitchell, Com.*, 26 May, 1891, 55 O. G., 1275.

189. It may be considered as settled that, in determining the question of interference, the Office is to look beyond mere words of the claims and consider whether or not they interfere *in substance* (*G. & S. Ore Sep. Co. v. U. S. Ore Disintegrating Co.*, 6 Blatch., 309).

Penney v. Gunn, Simonds, Com., 13 Aug., 1891, C. D. Ms.

190. Preliminary Statement, — Extension of Time for.

The provision of Rule 104 which gives the Examiner of Interferences discretion to dispense with service on

the opposing party of notice of motion to extend time for filing the preliminary statement does not contemplate a case where such service can be reasonably effected and it should not be exercised in such a case.

Stuart *v.* Elliott *v.* Pattison, *Simonds, Com.*, 20 Oct., 1892, C. D. Ms.

191. Suspension to determine Patentability of a Claim in Interference.

Where notice of a motion to stay an interference — in order that the patentability of one of the claims involved in the “issue” might be determined before proceeding with the interference — had not been given to the opposite party: *Held*, that, under Rule 153 such motion must be dismissed but, it appearing that the last Office-action on one of the claims was a distinct rejection on a reference: *Also held*, that, although it might be said that the declaration of interference implied patentability, yet applicant was entitled, under Rule 65, to a favorable decision as to the question of patentability before an interference was declared and, therefore, that the interference must be suspended until the Examiner decided whether or not so much of the invention as was declared to be in interference was patentable and announced his decision to the applicant; but that he should not delay the interference proceedings in order to allow applicant to appeal from his decision rejecting any of the claims not involved in the interference. As to those claims, applicant’s remedy was to be found in Rule 106.

Fiske, x. p., *Mitchell, Com.*, 3 Oct., 1890, C. D. Ms.

NOTE. — Rule 106 permits withdrawal of and embodiment in one or more new applications all claims not involved in interference.

Compare Archer, x. p., (7) INOPERATIVENESS, and Beatly, x. p., (152), *supra*.

192. Testimony taken abroad. — Rule 158.

The Examiner of Interferences granted *R*'s motion to take testimony abroad, under Rule 158, and denied *F*'s motion for a modified order directing that the testimony be taken orally rather than by written interrogatories and cross-interrogatories as the rule provides: *Held*, sustaining the Examiner of Interferences, that nothing short of the mutual consent of all the interested parties can avoid the strict letter of the rule.

Raffard v. De Ferranti, Frothingham, Act. Com., 13 June, 1892, C. D. Ms.

193. Two Years Public Use.

When the defeated party filed a protest against issue of a patent to the prevailing party alleging want of novelty and two years public use, the case was remanded to the Primary Examiner to consider the question of public use, which question had not been before him, the Assistant Commissioner not considering the doubt as to patentability sufficient to exercise jurisdiction on that point.

Still v. Hobler & Peck, Frothingham, Act. Com., 24 Oct., 1891, C. D. Ms.

194. Veil of Secrecy.

While each party is in ignorance of the character of his opponent's invention the interference is declared, and if one of the parties (before either party is entitled to have the veil of secrecy lifted) tenders a disclaimer, the Office determines whether the interference shall continue.

Diescher v. Walker v. Diescher & McGill, Mitchell, Com., 24 June, 1890, 52 O. G., 459.

195. Control of Witnesses.

It would be a dangerous practice for the Office to attempt to decide in advance what is proper and what

is not proper cross-examination, owing to the great latitude that is allowed in conducting such proceedings. Should the witness refuse to answer a certain question on cross-examination, and counsel thought it a material and proper one to be asked, then he would have, at the proper time, the right to move for a suppression of the deposition (*Milligan v. Neidringhaus*, 1887, C. D. 1; *Houston v. Barker et al.*, 1888, C. D. 173). Furthermore, there are precedents, in like cases, for filing a motion before the United States Court of the district where the testimony is being taken, in order to determine whether the witness shall answer a certain question or whether or not a certain line of cross-examination shall be pursued. This course was followed during the taking of testimony in the interference entitled *Osgood v. Badger v. Bennett*, No. 10,215, and the court (*Colt, J.*) ordered that the witness need not answer certain cross-interrogations or certain questions relating to a line of cross-examination. See also record of *Hisey* in the interference. *Ligowski v. Peters v. Hisey*, No. 14,006.

Brown v. Unz, Frothingham, Act. Com., 4 Aug., 1891, C. D. Ms.

For powers of the Commissioner of Patents in respect to testimony and witnesses, see *Wright v. Daggett*, WITNESSES.

196. The Commissioner of Patents has no power in the matter of taking testimony of witnesses, and has no control over the taking of their depositions nor over their conduct while such depositions are being taken. The whole matter is left in the hands of the Federal Court of the district in which the testimony is being taken, and either of the parties has full authority to apply to the district judge for orders compelling the attendance and controlling the conduct of witnesses (*Wright v. Daggett*, 1888, C. D. 116).

Ib.

197. The rights of one party to an interference are not to be prejudiced by inadvertent issue of the patent to the other party.

Where there have been two conflicting applications, and a patent has been inadvertently granted to one applicant without notice to the other, an interference may be declared *nunc pro tunc*¹ between the application and the patent, under authority of the first clause in Rule 93.

Marston, x. p., *Stockbridge, Act. Com.*, 4 Feb., 1882, 21 O. G., 633.

198. A Drawing as Proof of the incipient Invention.

An invention relating to machinery may be exhibited as well in a drawing as in a model, so as to lay the foundation to a claim to priority, if sufficiently plain to enable those skilled in the art to understand it.

Webster v. Higgins, U. S. S. C. By *Bradley, J.*, 8 May, 1882, 21 O. G., 2031, *.

199. Decision once given cannot be permitted to be disturbed by new evidence that had been purposely withheld.

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

Beardsley v. Moeslein, *Hall, Com.*, 6 Mar., 1889, 46 O. G., 1640.

200. Review of Action.

Where, after a decision of priority in favor of the applicant, in an interference between an application and

¹ Now as then.

a patent, and pending an appeal before the Examiners-in-Chief, the patentee moved that the case be referred back to the Primary Examiner for investigation as to the novelty of the issue when considered broadly in accordance with its terms, or for the reforming of the issue, or for such other proceedings as may seem proper: *Held*, in view of the advanced stage to which the proceedings had progressed, that the motion must be denied, with leave, however, to call it up at the final hearing before the Commissioner.

Adams v. Kinzer, *Mitchell, Com.*, 16 Sep., 1890, C. D. Ms.

INTERFERING PATENTS.

1. Relief in Equity.

In a suit, under Section 4918 R. S., to set aside a patent on the ground of interference with plaintiff's prior patent, defendant may lay the foundation for affirmative relief on an answer alleging the validity of his own patent and the invalidity of plaintiff's patent.

Elec. Ac. Co. v. Brush Elec. Co., U. S. C. C., N. D. O., *Brown, J.*, 26 Dec., 1890, 44 F. R., 602.

2. It is well-settled law that two patents interfere, within the meaning of the Section 4918 R. S., only when they *claim* (in whole or part) the *same invention* (Gold & Silver Ore Separating Co. v. U. S. Disintegrating Ore Co., 6 Blatch., 307; Reed v. Landman, 55 O. G., 1275; Morris v. Mfg. Co., 20 F. R., 121; Pentlarge v. Bushing Co., 20 F. R., 314; Elec. Ac. Co. v. Brush Elec. Co., 44 F. R., 602; Mowry v. Whitney, 14 Wall., 434, *). Hence, a bill in equity, under said section, for relief against a patent, alleged to interfere with patents owned by complainant, cannot be sustained, where the answer denies such interference, if it appears that the claims of the respective patents do not cover the same invention.

In the case of *Garrett v. Siebert* (98 U. S., 75, *) the answer did not deny, but rather admitted, an interference of the patents, and it is therefore not an authority against the general doctrine which the courts have laid down upon this point.

Nathan Mfg. Co. v. Craig, U. S. C. C. Mass., *Colt, J.*, 12 Feb., 1892, 49 F. R., 370.

INTERPRETATION.

Of two possible interpretations of a patent, preference is given to an interpretation that will sustain it.

In construing a patent, courts should proceed in a liberal spirit, so as to sustain the patent and the construction claimed by the patentee, if it can be done consistently with the language he has employed; and this applies to a reissue as much as to an original patent.

Judgment affirmed.

Klein v. Russell, U. S. S. C. By *Swayne, J.*, Oct. term, 1873, 19 Wallace, 433, *.

For applications of the above doctrine, see (48) *et seq.*, THE CLAIM.

NOTE (i). — The suit was on a re-issued patent to one Russell for a "Process for Treating Leather." The claims on which suit was brought were: —

1. The employment of fat liquor in the treatment of leather, substantially as described.

2. The process, substantially as herein described, of treating bark-tanned lamb or sheep skin by means of a compound composed and described essentially as specified.

NOTE (ii). — Courts have repeatedly intimated that their sustentation of claims which require (to avoid invalidation) "a liberal construction," is not to be construed into an approval of the Patent Office action in granting them. See (29) *et seq.*, THE CLAIM and, (2), CONSTRUING CLAIMS.

INVALIDATED REISSUE.**1. Restoration to Original Form.**

The reissue having been adjudged invalid, patentee sought to restore the patent to its condition as originally granted, by filing in the Patent Office a disclaimer, as provided for in Section 4917 R. S., by which (“with the exception of six consecutive words not affecting its meaning”) the specification was restored to its original form. The court, remarking the evident purpose of the patentee to abandon the reissued and resume the original patent, said: “We are of the opinion that this could *not* be done by a disclaimer. It is not competent for the patentee or his assignees, by merely disclaiming all the changes made in reissuing, to revive and restore the original patent. This could be done only — if it could be done at all — by surrender of the reissued patent and grant of another reissue.” Decree of the Circuit Court dismissing the bill, was affirmed.

McMurray et al. v. Mallory, U. S. S. C. By *Woods, J.*, 24 Mar., 1884, 27 O. G., 915, *.

2. When the patent, in its original form, was valid, but the reissue based thereon is invalid, there is no good reason why a second reissue, embracing the valid claim alone of the original patent, would not be valid.

Giant Powder Co. v. Safety Powder Co., *Sawyer, J.*, 18 Feb., 1884, 27 O. G., 99.

NOTE. — For conditions of favorable action on an application for re-issue, see (2) *et seq.*, RE-ISSUE.

INVENTION.**1. Patentable Invention defined.**

There is no doubt that he who has discovered some new element or property of matter may secure to him-

self the ownership of his discovery so 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.

Detwold *v.* Reeves, *Kane, J.*, Sept. 1851, 1 Fisher, 127.

2. Patentable invention relates to a new means for a useful result.

The plan of an invention includes the idea of means as well as the result to be attained. The idea of means is present in the definite conception of the organized machine, but the idea of means is not present in the suggestion that it is desirable to make a single new machine that will take the place of three old ones. He is the true inventor who conceives of a way of accomplishing the result sought for and *who embodies it in an operative form*.

Greenlee & Strom *v.* Roberts, *Mitchell, Com.*, 11 May, 1891, C. D. Ms.

GENERIC INVENTIONS.

3. The creator of a new art may claim the means and also the process, irrespective of the particular means.

If the Bell patent were for a mere arrangement or combination of old devices to produce a somewhat better result in a known art, then, no doubt, a person who substituted a new element not known at the date of the patent, might escape the charge of infringement; but Bell discovered a new art, — that of transmitting speech by electricity, — and has a right to hold the broadest claim for it which can be permitted in any case, not to

the abstract right of sending sounds by telegraph without any regard to means, but to all means and processes which he has both invented and claimed.

Am. Bell Tel. Co. *v.* Spencer, *Lowell, J.*, 27 June, 1881, 20 O. G., 299.

4. There can be no patent for a mere principle; the discoverer of a scientific fact or a natural force cannot have a patent for that; but if he, for the first time, invents a process by which a certain effect of one of the forces of nature is made useful to mankind, and fully describes and claims that process, and also describes a mode of apparatus by which it may be usefully applied, he is entitled to a patent for the process of which he is the first inventor, and is not restricted to any particular form of apparatus by which he carries out the process. Another, who afterwards invents an improved [or different] form of apparatus embodying the same process, may indeed obtain a patent for his improvement; but he has no right to use the process, either in his own or any other form of apparatus, without consent of the first inventor of the process.

Am. Bell Tel. Co. *v.* Dolbear, *Gray and Lowell, JJ.*, 24 Jan., 1883, 23 O. G., 535.

See also *Kane, J.*, in *Detwold v. Reeves*, DISCOVERY.

5. As was said in Spencer's case (*Bell v. Spencer*, 20 O. G., 299) Bell discovered a new art, — that of transmitting speech by electricity, — and has a right to hold the broadest claim for it which can be permitted in any case; and the invention is nothing less than a transfer to a wire, of electrical vibrations like those which a sound has produced in the air; and his patent, while not covering the abstract principle, without regard to means of transmitting speech by electricity, yet is not limited to a particular form of apparatus, but includes

the process or method, the essential elements of which are the production of what the patentee calls "undulatory" vibrations of electricity to correspond with those of the air, and transmitting them to a receiving instrument capable of echoing them.

Ib.

6. Where the invention is of a primary character and the mechanical functions performed by the machines 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 machines may contain improvements in the separate mechanisms which go to make up the machine.

Morley Sewing Machine Co. v. Lancaster, U. S. S. C. By *Blatchford, J.*, 4 Feb., 1889, 47 O. G., 267, *.

7. Primary Invention. — Claims.

Where applicant is working in a new field and no reference is cited to impugn the novelty of the invention, he is not only entitled to great breadth in construing of his claims [by the courts], but he is entitled to liberality in the framing of his claims [before the Patent Office].

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

Compare Mefford, x. p., (4) CLASSIFICATION.

8. Conception, — Evidence of.

On a motion for a rehearing, it was contended that error lay in holding that certain sketches disclosed the inventions in controversy, for the reason that they "did not show an organized machine:" *Held*, that it was not necessary that they should, for if—as found by the court in *McCormick Co. v. Harvester Wks.* (42 F. R. 152)—oral explanations of a contemplated improvement in the presence of a machine to which these improve-

ments are to be applied, is sufficient evidence on such a point, much more is it sufficient to make sketches of the contemplated improvements in the presence of the machine, as was done in this case.

Ligowski v. Peters v. Hisey, Simonds, Com., 17 Nov., 1881, C. D. Ms.

Compare (1) CONCEPTION ; (21), (22), (23), (24), (25), (26), (27), (28), THE CLAIM ; and (11), (12), THE SPECIFICATION.

9. It is the last step that wins.

In the law of patents, it is the last step that wins ; and the courts will sustain a patent in favor of the last of a series of inventors all of whom were groping to attain a certain result which only the last one of the number seemed able to grasp.

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

10. Utility as a Test.

No one of the seven references suggests the improvement which has been *arrived at* by applicant, and their very multiplicity, when all had fallen short of the result which he has practically attained, is evidence of patentable invention on his part, for, when a number of inventors had been reaching out for a desirable end and all had fallen just a little short of its attainment, that state of facts is practically conclusive evidence that he who attains the whole measure of success does so by doing something which was not obvious and which involved patentable invention.

Decision of the Examiners-in-Chief was reversed and patent ordered to issue to Shannon.

Shannon, x. p., *Simonds, Com.*, 21 Oct., 1891, 59 O. G., 297.

See, of like tenor, *Bruce v. Warder*, (1) and cases following, UTILITY, and *Washburn v. Barbed Wire Co.*, (9) *supra*.

11. A practical inventor who succeeds in making a machine that will operate upon the principles embodied in his apparatus, and is the first to disclose it to the world, should not find himself forestalled by a theorist, and be compelled to occupy the position of an infringer when he was the first person in a position to teach the world how to make the machine.

Bausset, x. p., *Mitchell, Com.*, 7 Mar., 1890, C. D. Ms.

12. Where the results in the patented process cited as a reference by the Examiner were obtained by the use of bisulphide of carbon, which was lost in the operation: *Held*, that if applicant's simple improvement had been perfectly obvious, as contended by the Examiners-in-Chief, the patentee of the reference would hardly have gone to the expense of using and losing the bisulphide of carbon. Decision of Examiners-in-Chief reversed.

Sommer, x. p., *Simonds, Com.*, 9 Oct., 1891, C. D. Ms.

NOTE. — The aim of applicant was to produce a certain "Viscid Fatty Compound," and the peculiarities of his process are set forth in his specification in the language following: —

The minute but injurious formation of chlorhydric acid is neutralized by some inorganic neutralizing agent, — which may be oxide of calcium or oxide of magnesium in form of a very fine powder, or hydroxide of sodium (or of potassium or ammonium) in a concentrated solution, or that of calcium in powder, or crystallized carbonate of sodium in form of a coarse powder, or the carbonate of sodium (or of potassium or ammonium) in a concentrated solution, or a soap of sodium, potassium, calcium, magnesium, or aluminum in powder or in oily solution. — After the compound has stood for several days (or longer if possible) the upper portion is decanted or drawn off from the sediment; but beyond this "voluntary separation" no effort is made to remove any excess of the neutralizing agent nor any of the chlorhydric acid derivatives of neutralizing action.

13. Where a step in the process was not disclosed in the references, and persons having a practical acquaint-

ance with the art made affidavits attributing to the process valuable results in saving of time and securing homogeneity of product: *Held*, reversing the decision of the Examiners-in-Chief, that there was evidence of useful novelty indicating the exercise of invention, — and claim was allowed.

Grant, x. p., *Simonds, Com.*, 23 Sep., 1891, C. D. Ms.
Compare *Hoe v. Cottrell*, (8) UTILITY.

14. Theoretical compared with consummated Invention.

Patents are granted on the condition of disclosure of a practical way of accomplishing a result which the applicant has achieved. So long as everything rests wholly in theory, and so long as everything remains to be demonstrated, nothing has been done which is patentable.

Bausset, x. p., *Mitchell, Com.*, 7 Mar., 1890, C. D. Ms.
Of like purport, see (30) *infra*.

15. Generic Invention.

Joseph F. Glidden held to have been the first and original inventor of the improvement in wire-fences claimed by him, which consisted of “a coiled barb locked and held in place by intertwisted wires,” and the patent therefor — No. 157,124 — held to be valid and to have been infringed.

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, *.

16. There may be a patent for a process irrespective of any particular means, but the specification must describe some one means of carrying it out.

A patent for a process, irrespective of the particular mode or form of apparatus for carrying it into effect,

is admissible under the patent laws of the United States. But, to sustain such a patent, the patentee should be the first and original inventor of the process, should claim it in his patent, and, if the means of carrying it out are not obvious to an ordinary mechanic skilled in the art, his specification should describe some mode of carrying it out which would produce a useful result.

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

17. The Examiners-in-Chief having rejected a process claim because it differed from a claim allowed in a prior application of the same inventor only by the addition of a step, which consisted in removing, as fast as formed, portions of the product whose presence obstructed the process: *Held*, that, as the claim under consideration must have been allowed if the other claim had not been before the Office in the earlier application, an equitable treatment of the matter required the two claims to be considered as relating to distinct improvements in the same general subject-matter, and the claim was allowed.

Manhes, x. p., *Simonds, Com.*, 27 Oct., 1891, C. D. Ms.

Of like general tenor, see Houston, x. p., (5), and Rogers, x. p., (6), PROCESS.

18. An improvement may be patented, but, during the lifetime of the original patent, can be used only subject to its claims.

If a subsequent inventor discovers a new mode of carrying out a patented process, though he may have a patent for such a new mode, he will not be entitled to use the process without consent of the patentee thereof.

Tilghman *v.* Procter, U. S. S. C. By *Bradley, J.*, 21 Jan., 1881, 19 O. G., 859, *.

19. Test of Completed Invention.

A good mechanic of proper skill in matters of the kind can take Bell's patent and, by following the speci-

fication strictly, can, without more instruction, construct an apparatus which, when used in the way pointed out, will do all that is claimed the method or process will do. Some witnesses have testified that they were unable to do it. This shows that they, with the particular apparatus they had and the skill they employed in its use, were not successful, not that others, with another apparatus, perhaps more carefully constructed or more skillfully applied, would necessarily fail. As was said in *Loom Co v. Higgins* (105 U. S., 580 and 586, *), when the question is whether a thing can be done or not, it is always easy to find persons ready to show *how not to do it*.

Dolbear et al. v. Am. Bell Tel. Co., U. S. S. C. By *Waite*, *Ch. J.*, 19 Mar., 1888, 43 O. G., 347, *.

SPECIFIC INVENTIONS.

20. An improvement on a combination is the subject of a patent, but, at the same time, the improvement cannot be used without the consent of the original patentee.

Foster v. Moore, *Curtis, J.*, 1 *Curtis*, C. C. Rep., 279; *Law's Digest*, 351.

21. Whenever the changes in the arrangement of a machine or invention and its consequences, taken together, are considerable, there is sufficient invention to support a patent; when the change, however minute, leads to consequences and results of great practical utility, this condition is satisfied.

Walsh, ex parte, Supreme Ct., District Col., 1857, *Law's Digest*, 423.

22. Later inventors, who devise different means for accomplishing the several steps of the method, are entitled only to patents for improvements upon the method

or means of the first inventor subject to his paramount right to the method itself.

Bell v. Gray, Paine, Com., 6 Mar., 1879, 15 O. G., 776.

23. Where one patentee has invented a combination for a particular purpose, the field is open to another to invent a combination of the same parts differently arranged and effecting the same result by a different mode of operation.

Ry. Register M'fg Co. v. 3rd Av. R. R. Co., Wallace, J., 19 Oct., 1887, 42 O. G., 379.

24. The prior state of the art and the express language of the specification combine to restrict the claim to the use of a stencil made by the electric pen. Thus construed, it is not infringed by the defendant's device. Defendant's "cyclostyle" shows another step in the art. It is as much an improvement on Edison's method as that was an improvement on what preceded it.

Edison v. Claber, Coxe, J., 5 Ap., 1889, 47 O. G., 1486.

25. The complainant, having come into an already created and flourishing art at so late a date and after others had covered the same ground which he attempted to cover, is not entitled to invoke the doctrine of equivalents in regard to his mechanism, in any respect; his patents therefore, if sustained at all, can only be for the special devices which characterize his particular contribution to the art separate and apart from those which the machines of both complainant and defendant possess in common with the art.

Consolidated Roller Mill Co. v. Barnard & Leas M'fg Co., Blodgett, J., 10 Feb., 1890, 53 O. G., 430.

26. The patentee of an invention which is merely one of a train of successive improvements in an already

created art, is not entitled to invoke the doctrine of equivalents, and his patent, if sustained at all, can be held to cover only the specific arrangement which it describes.

Ib.

For qualifications of above doctrine, see *Burr v. Duryee*, (5) EQUIVALENTS. See also *Rodebaugh v. Jackson*, (10) EQUIVALENTS and *Note*.

27. The origin of the invention is immaterial.

The invention, if new and useful to the public, may be the result either of long experiment and profound research, or of a sudden and lucky thought, or of a mere accidental discovery. Luck, labor, or inspiration gives an equal right.

Tindall, L. C. J., Eng.; see, to same purport, *Vollrath v. Comstock*, (5) ART. Compare *Gibford*, x. p. (34), *infra*.

THE BORDER LINE BETWEEN INVENTION AND SKILL.

28. Invention, — How determined.

The line dividing invention from non-invention is very dim, and cases lying near it often present great difficulty. In deciding them, judges have occasionally used expressions which may seem extravagant and calculated to mislead. Some of those expressions would almost justify a doubt whether a majority of the patents issued are valid, and others whether any of them are invalid. The decisions are, however, generally harmonious and establish a number of fundamental conclusions, thus: it is definitely agreed and established that, when a change in the method of making an article of manufacture produces a different and beneficial result — although the difference may exist merely in improving or cheapening the article — and the change and its advantages *had not heretofore been seen or*

made by others interested in seeing and making it, — there is sufficient evidence of invention to sustain a patent.

Zinsser v. Kremer, U. S. C. C., N. J., *Butler, J.*, 12 June, 1889.

28'. It is often no easy task to draw the true line of distinction between invention, the product of original thought, and mere obvious manual changes following the beaten track of mechanical experience: but it is obvious there is a limit beyond [within?] which mere changes cannot and ought not to receive the protection of letters-patent.

Kirby v. Beardsley, *Shipman, J.*, Sep., 1867, 3 Fisher, 265.

29. It is opposed to the true interests, alike of inventors and of the public, for the Patent Office to adopt a lower standard of invention than that recognized by the courts. In applying this rule, however, great care should of course be taken. Judge Shipman remarks, in Kirby v. Beardsley (3 Fisher, 365): *To give the inventor the benefit of any doubt as to originality or creative thought, was to nourish inventive enterprise by lending encouragement to every degree of merit (Wirt, Att.-Gen., 2 Op., 52, Myers Fed. Dec. 453).* This is the more important because simple contrivances, the offspring of simple and even involuntary thoughts, often produce great and beneficial results, while complex and elaborate ones, the product of long and profound cogitation, not infrequently prove comparatively or wholly abortive. But it is obvious that there is a limit beyond [within?] which mere changes cannot and ought not to receive protection. The test must be kept in view which was laid down by the Supreme Court of the United States in Dunbar v. Myers (11 O. G., 35, *), that invention or discovery is the requirement which constitutes the foundation of the right to obtain a patent; and it was

decided by that court, more than a quarter of a century ago, that unless more ingenuity and skill were required in making or applying a given improvement than are possessed by an ordinary mechanic acquainted with the business, there is an absence of that degree of skill and ingenuity which constitutes the essential element of every invention.

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

Compare (30) *et seq., infra.*

29'. Williams' improvement (Improvement in Cloth & Rubber Gaiter Overshoes, pat., 10 Sep., 1872, No. 131,201) approaches *the border-line of invention*, and it is very likely that, upon the testimony in the case, it would generally have been held patentable by the Circuit Courts before the recent decisions of the Supreme Court on the subject of invention. The tendency of these decisions is to confine patents within narrower limits than formerly. They especially demand that a device which is merely an improvement upon a pre-existing one, must, in order to be patentable, contain a new idea and perform some new function, and not present changes in degree only, or simply new or more extended applications of the original thought (*Smith v. Nichols, 21 Wallace, 112, **; *Burt et al. v. Ivory, 113 U. S., 349; 50 O. G., 1294, **).

Williams v. Goodyear, U. S. C. C. Ct., Shipman, J., 2 Feb., 1892, 49 F. R., 245; 58 O. G., 1257.

NOTE.—In the above case comparison with pre-existing devices reduced the invention to the single point of useful novelty of making the water-tight or "bellows" flaps *integral* with the vamp and quarter, in lieu of the separately formed and attached gores or gussets previously employed.

29". "That Impalpable Something."

To say that the act of invention is the production of something new and useful does not solve the difficulty of giving an accurate definition, since the question of what is new, as distinguished from that which is a colorable variation of what is old, is usually the very question at issue. To say that it involves "an operation of the intellect," that it is "a production of intuition," or of "something akin to genius," as distinguished from the exercise of mere mechanical skill, draws one somewhat nearer to an appreciation of the true distinction, but it does not adequately express the idea. The truth is, the word cannot be defined in such a manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not. In a given case we may be able to say that there is present invention of a very high order; in another we can see that there is lacking *that impalpable something* which distinguishes invention from mere mechanical skill. Courts adopting fixed principles as a guide have, by a process of exclusion, determined that certain variations in old devices do, and that others do not, involve invention; but whether the variation relied upon in a particular case [belongs to one or the other of these categories] cannot be answered by applying the test of any general definition.

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

LACK OF PATENTABLE INVENTION IS ILLUSTRATED IN THE FOLLOWING CASES.

30. Abortive Experiments.

A conception of the mind is not an invention until represented in some physical form: unsuccessful experi-

ments or projects abandoned by the inventor are equally destitute of that character.

Clark Thread Co. *v.* Willimantic Linen Co. *et al.*, U. S. S. C. By *Bradley, J.*, 25 May, 1891, 56 O. G., 395, ✽.

Of like purport, see (15) *supra*.

31. It is not enough that an applicant, ranging through the field of experiment, unconsciously stumbles upon that which is nearly related and very similar to the device in controversy. The conception must not be of the result to be obtained, but the *means* (which is the patentable thing) to produce that result.

Voelker *v.* Gray *v.* Edison *v.* Bell, *Butterworth, Com.*, 3 Mar., 1885, 30 O. G., 1092.

32. Use of expedients known to the art is not invention.

The result attained, being but a display of the expected skill of the calling, and involving 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, is in no sense the creative work of that inventive faculty which it is the purpose of the Constitution and the patent laws to encourage and reward.

Hollister *v.* Benedict M'f'g Co., U. S. S. C. By *Matthews, J.*, 5 Jan., 1885, 113 U. S., 59, ✽.

33. Mechanical Faculty. — Inventive Faculty.

It is not sufficient that an applicant shall have made a new and useful article or machine, he must have made an *invention* or *discovery*. It is well known that the mechanics, artisans, and laborers of the world are continually making an infinite number of new and useful contrivances, changes, and modifications in the affairs

of life, and yet they do not dream of protecting them, for the reason that they are not the result of the exercise of the inventive faculty, but simply of the mechanical faculty.

Dovin, x. p., *Hall, Com.*, 15 Oct., 1888, C. D. 166.

34. The statute does not say that any person who has made any new and useful machine, etc., will be entitled to a patent, but that any person who has *invented* a new art, machine, etc., is so entitled; the courts have uniformly held that the thing said to be new and useful must be the result of *invention*. A new change or modification; or a new shop device, which any intelligent artisan or mechanic would suggest or make upon knowing the necessity or requirement, is not an invention within the meaning of the patent law.

Gibford, x. p., *Hall, Com.*, 3 Dec., 1888, C. D., 168.

35. Mere mechanical operations, like the looping and drawing of threads to form stitches in sewing, either by machinery or by hand, do not amount to arts or processes, in a legal sense, and such operations, apart from the means of performing them, do not appear to be within the reach of protection by the patent laws. Hence, where a person has invented a machine for sewing together the soles and uppers of boots and shoes by a stitch without any welt, the stitch and the manner of forming it producing a well-known seam in a well-known manner, in a different place, heretofore inaccessible by any means that had been discovered, and the inventor had taken out separate patents for the machine, the process and the product: *Held*, that the entire invention lay in the machine, and that the patents for the process and product were invalid for lack of invention.

MacKay v. Jackman, *Wheeler, J.*, 15 Ap., 1882, 22 O. G., 85.

See also *Forncrook v. Root*, 27 O. G., 774; *Morris v. McMillan*, 29 O. G., 951, *.

36. One person receiving from another a full and accurate description of a new and useful improvement cannot appropriate it to himself, and a patent obtained by him therefor will be void.

Atlantic Works v. Brady, U. S. S. C. By *Bradley, J.*, 5 Mar., 1882, 23 O. G., 1330, *.

37. A difference of construction, perfectly obvious to any competent mechanic, does not constitute a patentable invention.

National Wire Mattress Co. v. N. Y. Braided Wire Mattress Co., *Butler, J.*, 19 May, 1884, 28 O. G., 96.

38. When the claim was for a blank from which an old article had been made, and the only improvement suggested was a more convenient form of handling and packing for transportation, the purchaser to form the article from the blank in the old way: *Held*, that this could not be regarded as an improvement in an art or manufacture such as contemplated in the statute.

Forncrook v. Root, *Matthews, J.*, Nov., 1884, 29 O. G., 774.

39. The only field of invention left for the patent to cover was the application of the old and familiar arrangement of shafts, cog-wheels, and auxiliary engine to a capstan instead of to a windlass. It is plain that no such ingenuity as merited the issue of a patent was required for this improvement, but only the ordinary judgment and skill of a trained mechanic: *Held*, that the patent was void.

Morris v. McMillan, U. S. S. C. By *Woods, J.*, 17 Nov., 1884, 29 O. G., 951, *.

40. Merely putting rollers under an article to make it movable when without the rollers it would not be movable, does not involve patentable invention.

Hendy v. Golden State Works, U. S. S. C. By *Blatchford, J.*, 14 May, 1888, 43 O. G., 1117, *.

41. The state of the art showing that dies could be used to compress and finish articles of vulcanizable gum and to compress plastic material surrounding a metal core or skeleton, in making articles of harness-trimmings, it required no exercise of invention to use dies to compress and finish similar articles in which vulcanizable gum was used to envelop a metal core.

Rubber & Celluloid Co. *v.* India Rubber Co., *Wallace, J.*, 23 May, 1888, 44 O. G., 343.

42. Two 17-year patents were granted as follows:

Patent No. 336,242: An improvement in the art of decorating surfaces to be ornamented, which consists in applying thereto, by pins or screws passing through holes in the tile, ornamented tiles of appropriate patterns and glazed to their bases; substantially as, etc.

No. 336,243: An improvement in the art of decorating metallic or other surfaces, a medallion-tile formed with a rabbet on its edge and glazed into the rabbet, in combination with a perforated plate suited to the contour of the projecting medallion and with suitable backing to the tile attached to said perforated plate; substantially as, etc.

Held, both patents may describe tiles which present a very pleasing and artistic appearance to the eye; but it does not follow from this that it required, in the sense of the patent-law, the exercise of the inventive faculty to produce them. The patents are manifestly void for want of invention.

Lowe v. Barstow Stove Co. and Low v. Magic Furnace Co., *Colt, J.*, 18 Dec., 1888, 48 O. G., 262.

43. Claim to means for lubricating pulleys within the tunnel of a cable-railway, lacks invention and is not patentable in view of the well-known use of tubes to carry oil to inaccessible journals.

Nat. Cable Ry. Co. v. Mt. Adams Ry. Co., *Jackson, J.*, 24 May, 1889, 48 O. G., 1400.

44. The elements of the alleged combination being old in themselves, and their operation as associated being only that of their well-known separate operation in older machines, there is no patentable combination, although there may be some convenience in bringing these parts together and making a more compact machine. Such a change is merely mechanical and *does not rise into the realm of invention.*

Ide v. Ball Engine Co., Blodgett, J., 22 July, 1889, 49 O. G., 283.

45. Where it appeared that a turnover seam was an old and well-known substitute for the ordinary seam in making garments, and that such seam had been used in hat-sweats, as shown in a prior patent, as a substitute for the ordinary seam and for the purpose of protecting the hat from perspiration: *Held*, not to be invention to unite, in a hat-sweat, the tacking-slip to the leather band by a turn-over seam, instead of by the ordinary seam in which the stitches perforate the outer face of the band.

Hat-Sweat M'fg Co. v. Davis Sewing Mach. Co., Wallace, J., 12 Oct., 1889, 49 O. G., 1214.

46. Where the employment of a device to effect a certain purpose was such as would naturally suggest itself to any mechanic, and the device was used, in the new relation, to perform an office exactly analogous to that in which it had been frequently formerly employed: *Held*, such employment of said device did not constitute invention.

*Day v. Fair Haven Ry. Co., U. S. S. C. By Fuller, Ch. J., 11 Nov., 1889, 49 O. G., 1364, **

47. Patents should not be granted for trifling improvements, such as would spontaneously occur to any skilful mechanic.

The design of the patent laws is to reward those who make some substantial discovery or invention which adds to our knowledge and makes a step in advance in the useful arts. It was never their object to grant a monopoly for any trifling device, for every shadow of a shade of an idea, such as would naturally and spontaneously occur to any skilful mechanic or operator in the ordinary progress of manufactures.

Atlantic Works v. Brady, U. S. S. C. By *Bradley, J.*, 5 Mar., 1883, 23 O. G., 1330, *.

48. Packages of wool, feathers, and plug-tobacco have been put up into small packages made into a larger package, and the whole compressed; in view of which, no invention is displayed in treating hair in the same way.

King v. Gallum, U. S. S. C. By *Woods, J.*, 29 Oct., 1883, 25 O. G., 980, *.

49. The application of an old process or machine to a similar or analogous subject, with no change in the manner of applying it, and no result substantially distinct in its nature, will not sustain a patent even if the new form of result has not before been contemplated.

Pa. R. R. Co. v. Locomotive Safety Truck Co., U. S. S. C. By *Gray, J.*, 3 Mar., 1884, 27 O. G., 207, *.

50. Use of Matters of common Knowledge not Invention.

The court will take judicial notice of matters of common knowledge, such as a strap used by the driver at the front of an omnibus to open and close the rear door, devices for opening or closing valves at a distance in

steam and hydraulic apparatus, and devices used at railway switches for opening and closing the rails.

Although the patentee may be entitled to the merit of being the first to conceive of the convenience and utility of the mechanism in question for accomplishing a certain purpose, his right to a patent must rest upon the novelty of the means he has contrived to carry his idea into practical operation.

To do that which any competent mechanic familiar with devices well known in the art could have done readily and successfully upon the mere suggestion of the purpose which it was desirable to effect, does not constitute invention.

Aaron *v.* Manhattan Ry. Co., U. S. S. C. By *Blatchford, J.*, 11 Nov., 1889, 49 O. G., 1365, *.

51. Mere changes of material accompanied by the expected skill of the mechanic is not a patentable invention.

Where the only change involved is a change of material [substitution of cotton for jute as a material to be employed in the manufacture of bagging], accompanied by the expected skill of the calling in effecting the substitution and making it efficient, and notwithstanding that the result was reached only after careful experiment, and proved a commercial success, such result is not patentable.

Odesheimer, *x. p.*, *Mitchell, Com.*, 27 Nov., 1889, 49 O. G., 1693.

52. It does not constitute invention to stir by a well-known and simple mechanical device [revolving blades driven by a power-shaft] a liquid which had before been stirred by hand.

Marchand *v.* Emken, U. S. S. C. By *Blatchford, J.*, 25 Nov., 1889, 49 O. G., 1841, *.

53. Mere utility and novelty in the common meaning of those terms not sufficient. *There must be invention or discovery.*

This court has repeatedly held that, under the Constitution and the Acts of Congress, a person, to be entitled to a patent, must have invented or discovered some new and useful art, machine, manufacture, or composition of matter, or some new and useful improvement thereof, and that it is not enough that a thing shall be new in the sense that, in the shape or form in which it is produced, it shall not have been before known and that it shall be useful, but that the thing produced must amount to an invention or discovery. The cases on this subject are collected in *Thompson v. Boisselier* (114 U. S., 1, 11, 12, *). To them may be added *Stephenson v. Brooklyn R. R. Co.* (114 U. S., 149, *); *Yale Lock Co. v. Greenleaf* (117 U. S. 544, *); *Gardner v. Herz* (118 U. S., 180, *); *Pomace Holder Co. v. Ferguson* (119 U. S., 335, *); *Hendy v. Miner's Iron Works* (127 U. S., 370, *); *Holland v. Shipley* (127 U. S., 396, *); *Patterson Plow Co. v. Kingman* (129 U. S., 294, *); *Brown v. Dist. of Columbia* (130 U. S., 87, *); *Day v. Fairhaven Ry. Co.* (132 U. S., 98, *); *Watson v. Cin'ti Ry. Co.* (132 U. S., 161, *); *Marchand v. Emken* (132 U. S., 195, *); *Royer v. Roth* (132 U. S., 201, *).

The decree of the Circuit Court is reversed, and the case is remanded to that court with a direction to dismiss the bill with costs.

Hill et al. v. Wooster, U. S. S. C. By *Blatchford, J.*, 13 Jan., 1890, 50 O. G., 560, *.

Of like purport, see *Hollister v. M'f'g Co.*, 113 U. S., 59, *.

54. A mere carrying forward or more extended application of an original idea — a mere improvement in degree — is not invention.

Where certain parts of a water-tight shoe were old, a simple change in the form and arrangement of such

parts, subserving the same purpose as like parts of shoes constructed under earlier patents, and without causing any new function to be performed, does not constitute invention.

Burt et al v. Ivory, U. S. S. C. By *Lamar, J.*, 3 Feb., 1890, 50 O. G., 1294, ✽.

55. The application of an old process or machine to a similar or analogous subject, with no change in the manner of applying it and no result substantially distinct in its nature, will not sustain a patent, even though the new result had not before been contemplated.

Howe Machine Co. v. National Needle Co., U. S. S. C. By *Fuller, Ch. J.*, 24 Mar., 1890, 51 O. G., 475, ✽. Also see *St. Germain v. Brunswick*, U. S. S. C. By *Fuller, Ch. J.*, 28 Ap., 1890, 51 O. G., 1129, ✽.

56. The patentee having [in the manufacture of feather-dusters] merely applied the old process of dressing feathers, to feathers other than those to which it was commonly applied, simply accomplished by common reasoning from existing known facts, a result such as any one skilled in the art and desiring a cheap article would be likely to reach, although others had not in fact reached it: *Held*, that this did not amount to invention (*Hollister v. Benedict M'f'g Co.*, 113 U. S., 59, ✽).

The American Split Feather Duster Co. v. Levy, *Butler, J.*, 13 June, 1890, 52 O. G., 1807.

57. In view of the testimony as to the state of the art: *Held*, that it required no invention to make a single die to cut dough on a flat surface into any particular shape desired, whether the shape of a bretzel or any other shape.

Butler et al. v. Steckel et al., U. S. S. C. By *Blatchford, J.*, 3 Nov., 1890, 53 O. G., 1090.

58. To make a suspender-end of flat cord in substantially the same way that suspender-ends of round cord had been made, for the purpose of securing other articles of wearing apparel than trousers, does not involve invention.

Shenfield v. Nashawannuck M'f'g Co., U. S. S. C. By *Fuller*, *Ch. J.*, 23 Nov., 1890, 53 O. G., 1092, *.

59. The judgment of the Circuit Court awarding damages reversed and the case remanded for new trial, because said court, on the evidence presented, should have directed a verdict for the defendant on the ground that the patent was void; the patentee having merely used the same device which had before been used by other persons between one side of an interposed barrier and the other, with the same mechanical effect as when used without the barrier, and therefore the case was one merely of double use.

Inasmuch as the mechanical operation and effect of the patented devices were the same whether there was a grating or other barrier or not: *Held*, that there was no patentable combination between said devices and the grating. The case was one of mere aggregation.

County of Fond du Lac v. May, U. S. S. C. By *Blatchford, J.*, 15 Dec., 1890, 53 O. G., 1884, *.

60. It is a familiar rule that the application of an old process, or machine, or apparatus to a similar or analogous subject, *with no change in the manner of application, and no result substantially distinct in its nature*, will not sustain a patent, although the new form of result may not have before been contemplated.

St. Germain v. Brunswick, U. S. S. C. By *Fuller, Ch. J.*, 28 Ap., 1890, 34 L. ed., 122, *.

61. Not every new and useful application of an old constructive idea amounts to patentable invention. For

instance ; the Supreme Court has held, in one case, that, a diagonal brace being old in structures generally, it was not patentable to use such a brace for holding a track-clearer in place (*Day v. Fairhaven & W. Ry. Co.*, 132 U. S., 98, *). The same court has held that, a shifting device being old in mechanism generally, the application of the same to a machine for fulling raw hides constitutes no invention (*Royer v. Roth*, 132 U. S., 201, *). It has more than once laid down the principle that it is *not invention* "to combine old devices in a new article without producing any new mode of operation" (*Burt v. Evory*, 133, U. S., 349, *).

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

62. A combination is not patentable whose result is the necessary and obvious result having nothing in it of *the unknown or unexpected*, which is generally *the factor that determines for patentability in an otherwise doubtful case*.

Rutherford, x. p., *Simonds, Com.*, 14 Oct., 1891, C. D. Ms.

63. The tying and banding of bales of merchandise being a matter of common knowledge and shown by specific references, the pressing and baling of a well-known vegetable matter unaccompanied by any chemical action, must be considered simply in its mechanical aspect, and, being so considered : *Held*, that there was no substantial difference between using whisps of hay as a binder for pressed manure and using such whisps as binders for the vegetable matter of the application, although, in the latter case, the whisps were more irregularly distributed.

Towers, x. p., *Simonds, Com.*, 10 Oct., 1891, C. D. Ms.

64. The employment of alkalies to check or neutralize acidity, being a common and well-known expedient

in the industrial arts, the addition to a particular liquid of an alkali merely for the purpose of neutralizing its acid constituents is not patentable.

Sommer, x. p., *Simonds, Com.*, 9 Oct., 1891, C. D. Ms.

65. Where applicant had brought together in one structure a number of features which were old when considered singly, and also in sub-combinations, and the specification read like the specification for the erection of a building and was as destitute of any suggestion of novelty outrunning mere mechanical skill, — patentability denied.

Hamilton, x. p., *Simonds, Com.*, 4 Nov., 1891, C. D. Ms.

66. An improvement which, although new and useful, and a refinement upon the previous forms, is simply an extension of the old idea, is not patentable.

Edison, x. p., *Simonds, Com.*, 5 Dec., 1891, C. D. Ms.

67. Mere changes, such as modifications of the form of the raker's seat to enable him to face the falling grain, pertain to the simple, well known, and common property of the art.

A construction whereby a seat may be moved on a fixed centre, freely or rigidly, so that its front may be presented at any angle most convenient to the worker, is no more patentable than revolving the seat-board of a piano-stool or changing the position of a common chair on the floor of a parlor.

Decree entered dismissing the bill, — with costs.

Kirby v. Beardsley, Shipman, J., Sep., 1867, 3 Fish., 265.

68. It being old to bind the cut edges of cloth, either for ornament or to prevent ravelling, and also to make dress shirts by securing a linen bosom to the body of the shirt by a row of stitches passing through the edge

of the bosom: *Held*, that attaching the bosom to the shirt by a separate line of stitches through the binding involves nothing which, under a most liberal construction, could be held to be an exercise of the inventive faculty. In view of the simplicity of this device, we find it impossible to escape the conviction that plaintiffs are laboring under a strong bias of self-interest in asserting that this improvement was "the result of careful and prolonged study and experiment." We think this case must be added to the already long list of those reported in the decisions of this court wherein the patentee has sought to obtain the monopoly of a large manufacture by a trifling deviation from ordinary and accepted methods.

Cluet et al. v. Chaffin et al., U. S. S. C. By *Brown, J.*, 11 May, 1891, 55 O. G., 999, ✽.

69. There is not, in the matter described and exhibited in either the specification or claims, any invention within the meaning of that word as developed in recent decisions of this court (*Hollister v. Benedict M'f'g Co.*, 113 U. S., 59, ✽; *Thompson v. Boisselier*, 114 U. S., 11, ✽; *Howe Mach. Co. v. Nat. Needle Co.*, 134 U. S., 388, ✽; *McClain v. Ortmayer*, 141 U. S., ✽ 57 O. G. 1129, ✽); and, for that reason, the patent, alike in its original form and as it now appears in the re-issue, must be pronounced void. . . . By either of the processes described the tension was placed largely upon the strip of cloth instead of solely upon the thread. But this was no new idea, it is as old as pantaloons themselves. It has been illustrated in the experience of every boy, for, in his sports, he not infrequently tears his pantaloons, and his good mother, not content with sewing the torn ends together, and thus holding them by the direct strength of the thread, was wont to place underneath a piece of cloth, and fasten it to the main body of the

garment for some distance on either side of the tear. . . Surely, when this idea is so well known and has been so practically illustrated for generations, it cannot be that there was any exercise of the skill of the inventor in applying the same process to any part of the pantaloons. Action of the court below, dismissing the bill, was affirmed.

Pat. Clothing Co. *v.* Glover *et al.*, U. S. S. C. By *Brewer, J.*, 16 Nov., 1891, 57 O. G., 1281,*.

70. The application of an old process or machine to a new but analogous purpose does not involve invention, even if the new result had not before been contemplated. Where a patent sued upon describes a method which differs only in degree, and not in kind, from a previously employed method, and where the utmost that can be said of the patented process is that it produces a somewhat more perfect article: *Held*, that the patented method involves no novelty within the meaning of the patent law.

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

71. Where it appeared that all that applicant professed to do was to take an old and well-known bolt and nut, and screw them together in the ordinary way, and then take an old and well-known chisel and make an incision in the bolt lengthwise and nearest the upper surface of the nut, in order to prevent rotation: *Held*, that applicant had displayed only the expected skill of the calling, and accomplished what a skilful mechanic would do whenever required.

Shields, *x. p.*, *Mitchell, Com.*, 5 Jan., 1891, 54 O. G., 587.

72. Mere application to a new use, but without a new organization or adaptation of parts, does not constitute patentable invention.

Decision of Primary Examiner and of Examiners-in-Chief affirmed that there is nothing of patentable invention in using a time-fuse in connection with a flash-light, the same having been used in connection with time-signals as well as in exploding expedients generally where it was an object to gain time. Neither is there anything patentable in putting up a specified charge of an explosive in a case or cartridge, nor in aggregating both features in a single vendible commodity, although it may possess commercial advantages.

White, x. p., *Mitchell, Com.*, 12 Sep., 1890, 54 O. G., 387.

73. The patent — covering an improvement in mere workmanship or finish over a device which had been in public and business use for more than two years prior to the filing of the application — was pronounced invalid.

International Tooth Crown Co. v. Gaylord et al., U. S. S. C. By *Brown, J.*, 27 Ap., 1891, 55 O. G., 864, ✽.

74. A mere carrying forward of the original conception of an earlier patent, — a new and more extended application of it, — involving only change of form, proportions, or degree, — the substitution of equivalents doing the same thing as did the original invention by substantially the same means, although with better effects, — is not such an invention as will sustain a patent. It is the invention of what is new, and not the arrival at comparative superiority or greater excellence in that which is already known, which the law

protects by letters-patent. Decree of Circuit Court dismissing bill affirmed.

Smith *v.* Nichols, U. S. S. C. By *Swayne, J.*, Oct. term, 1874, 21 Wallace, 112, *.

See INVENTIVE ACTS; NOVELTY; PATENTABILITY; PUBLIC ADOPTION; REDUCTION TO PRACTICE; UTILITY.

INVENTIVE ACTS.

1. The true date of the invention is at the point where the work of the inventor ceases and the work of the mechanic begins. Before that time applicant was inventing but had not yet *invented*.

Cameron *et al. v.* Brick, *Leggett, Com.*, 1871, C. D., 89.

2. Rule 110 requires, among other things, that the dates of the *inventive acts* which relate to the subject-matter of the invention set forth in the declaration of interference, shall be given by each party thereto.

Haug *v.* Dubois, *Frothingham, Act. Com.*, 15 June, 1891, C. D. Ms.

3. The "inventive acts," of which each party to an interference is required to furnish a sworn statement, are —

(1) The date of original conception of the invention set forth in the declaration of interference.

(2) The date upon which a drawing [if any] of the invention was made.

(3) The date upon which a model [if any] of the invention was made.

(4) The date upon which the invention was first disclosed to others.

(5) The date [if any] of reduction to practice of the invention.

(6) The extent of use [if any] of the invention.

If a drawing or model has not been made or if the invention has not been disclosed to others prior to applicant's application, or has not been reduced to actual practice, the fact or facts must be stated.

P. O. R., 110.

See (1) DILIGENCE, AND (9) REDUCTION TO PRACTICE.

JOINDER OF INVENTIONS.

1. Office-classification, — State of the Art.

The creator of an art — as, for example, the inventor of the first watch — would be entitled to a patent including, in as many claims, the several distinctive elements of its mechanism; but when, in the progress of the art, the efforts of inventors have been directed to the separate parts of the watch and, at their requests, patents have been issued upon such separate parts, a corresponding classification of subjects necessarily arises in the Office, and must be observed in considering any subsequent application relating to the general class.

Combs, x. p., *Duncan, Act. Com.*, 2 Aug., 1871, C. D., 219.

2. Under an Original Application. — Under a reissue.

Because an apparatus patent cannot be reissued to cover a process, or *vice versa*, it does not follow that an original patent cannot be granted to cover both apparatus and process. A reissue patent is limited to the precise invention covered or intended to be covered by the original patent, but an original application may cover different inventions provided they are connected in design and operation; and the Supreme Court has been very careful to exclude a contrary inference (*Heald v. Rice*, U. S. S. C. By *Matthews, J.*, 6 Mar., 1882, 21 O. G., 1443, *).

Harrison, x. p., *Mitchell, Com.*, 15 Feb., 1890, C. D. Ms.

Of like purport, see Myers, x. p., (21) AMENDMENT; Noyes x. p., (9) SPECIFICATION.

3. Joinder of separately classified Devices.

Where a lamp, specially designed for photographers, had, attached to it, an apparatus for feeding a magnesium spray to the flame for the purpose of sudden and intense illumination: *Held*, that said feeding device constituted with such camera a *unitary invention*, and that, therefore, all the parts could be included in a single application.

Jljinsky, x. p., *Fisher, Act. Com.*, 24 Aug., 1889, 48 O. G., 1399.

4. Improper Joinder.

Telescopes having obtained a distinct status in the arts and manufactures: *Held*, that improvements in the special construction of telescopes adapted to their use generally, should not be joined with claims for a detachably connected sight for ordnance of which a telescope is an element.

Jljinsky, x. p., *Mitchell, Com.*, 23 Dec., 1889, C. D. Ms.

5. Capacity for Joint Use.

That two or more inventions capable of joint use, although not always used conjointly, may be joined in the same patent, is beyond question (*Hoag v. Emerson*, 5 Howard, 437, *). It does not, however, follow, in all cases, that the Patent Office must or will permit such inventions to be joined. Such permission will, however, ordinarily be given if no wider range of search is required for all than for one.

Fefel, x. p., *Simonds, Com.*, 9 Oct., 1891, 571 O. G., 409.

See, however: *Herr*, x. p., 41 O. G., 463; *Carter*, x. p., 46 O. G., 1392; *McMahan*, x. p., 48 O. G., 255; *Norwood*, x. p., 50 O. G., 1129; *Hyde*, x. p., 50 O. G., 1293, DIVISION; *Jljinsky*, x. p., (4), *supra*, and Patent Office Rule 41.

6. Although several distinct inventions which are dependent upon each other and mutually contribute to produce a single result may be claimed in one application, yet independent inventions (even when associated in 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, x. p., *Simonds, Com.*, 17 Dec., 1891, 57 O. G., 1720.

For various conditions precedent to joinder of two or more distinct inventions in a single patent, see cases cited in (5) *supra*, and cases (7) *et seq.*, *infra*.

7. Generic and Specific Inventions.

Several specific devices embodying the same general features of construction may be retained in a single application, provided a generic claim is made which will cover each and which is patentable.

Howland, x. p., *Doolittle, Act. Com.*, 3 Nov., 1887, 12 O. G., 889.

8. Where a generic claim of such scope and character as to indicate *the same basis of invention* for each device cannot be maintained there is such diversity as to require a division of the application.

Ib.

9. Although they may all be retained [in the description], applicant is not at liberty to make [in one and the same patent] specific claim to more than one of the devices.

Ib.

Of like purport, see *Eagle*, x. p., (5) THE APPLICATION.

10. A generic claim may be joined in an application with a specific claim for one of the constructions covered by the generic claim.

Heaton, x. p., *Paine, Com.*, 7 Ap., 1879, 15 O. G., 1054.

11. An applicant may *elect the specific claim* to be joined with the generic claim in one application. When the applicant, in his specification, describes one construction as the substance of his invention, and only refers to the other as a modification, he thereby elects to take the first, and cannot, in the same application, claim the modified form.

Ib.

12. Where an applicant makes oath that he is the inventor of the thing described and claimed, but his claims are *all generic* and applicable equally to both the forms shown, his oath, while it shows that he invented the genus, does not show that he invented the species referred to as a modification of the invention, and, *under that oath*, he cannot by amendment claim such modification.

Ib.

13. Besides the generic claim for the general construction the application should contain a specific claim for the preferred form.

An applicant can show and describe as many different forms of his invention as can be covered by a generic claim, and may also claim, specifically, the preferred form of his invention; but more than this [in one and the same patent] he is not entitled to do. If applicant can comprehend, in some form of expression, the patentable novelty which is common to all the forms shown and described, he is entitled to employ that expression to cover the generic invention (Eagle, x. p., 1870, C. D., 137; Howland, x. p., 1877, C. D., 120; Heaton, x. p., 1879, C. D., 95).

Cook, x. p., *Mitchell, Com.*, 12 Ap., 1890, 51 O. G., 1620.

14. Equivalents.

An inventor is always entitled to equivalents, that is to say, to devices which operate in substantially the same way to accomplish substantially the same result. He cannot in one and the same patent control diverse forms beyond what the law of equivalents gives him.

Ib.

15. When necessary for protection of a given invention, the Office classification must give way.

Where one particular element of a machine is dependent upon its co-operation with the other elements thereof to produce a certain result, it may, under Rule 41, be claimed under the same application with them *without regard to the Office Classification*.

Coe, x. p., *Fisher, Act. Com.*, 27 May, 1889, 48 O. G., 1119.

JOINDER OF MACHINE AND PRODUCT.

Permissible only where Machine is essential for that Product and can produce no other Product.

If the machine and the manufacture are so related that the former cannot operate without producing the latter, and the latter can only be produced by the former, both may be included [and each distinctly claimed] in a single patent. This is an exception to the general rule which forbids joinder of the machine and its product in one and the same application.

Winterlich, x. p., *Paine, Com.*, 1871, C. D., 171.

Of same tenor, see Morningstar, x. p., *Mitchell, Com.*, 14 Dec., 1889.

JOINDER OF PROCESS AND APPARATUS.

1. Of several possible Apparatus only one claimable in same Patent with the Process.

But one substantive apparatus for carrying out the process can be claimed in the same application with the process claims.

Bayne, x. p., *Mitchell, Com.*, 21 Feb., 1890, C. D. Ms.

2. Although the present practice permits the joinder, in proper cases, of apparatus and process, it places limitations upon amendments to applications for inventions in one class which seek to incorporate inventions of the other.

Carpenter, x. p., *Mitchell, Com.*, 13 June, 1891, C. D. Ms.

3. An application confined to the apparatus cannot be withdrawn from issue for the purpose of inserting a claim to the process, although the process claim might have been included in the original application.

Adams, x. p., *Frothingham, Act. Com.*, 29 June, 1891, C. D. Ms.

JOINDER OF PROCESS AND PRODUCT.

There are, perhaps, only two cases where claims to a process and a product of that process can properly be included in one patent; those cases are: (i) when the product is entirely new, and hence the process also; (ii) 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.

See also Tainter, x. p., 47 O. G., 137.

See CLASSIFICATION; DIVISION; PROCESS.

JOINT INVENTION.

A mere suggestion, not acted upon by the person making it, but carried out and perfected by another, will not entitle the former to be considered a joint inventor; nor is it necessary that exactly the same idea should have occurred to two persons at the same time, and that they should work out together the embodiment of this idea in a perfected machine, to constitute them joint inventors. If an idea is suggested to one, and he even goes so far as to construct a machine embodying the idea, but it is not a completed and working machine, and another person takes hold of it, and by their joint labors — one suggesting one thing and the other another — a perfect machine is made, a joint patent may properly issue to them. If, on the other hand, one person invents a distinct part of a machine, and another person invents another distinct and independent part of the same machine, then each should obtain a patent for his own invention.

Warden *v.* Fisher, *Brown, J.*, 21 O. G., 1957.

See also *Arnold v. Bishop*, *Cranch, Ch. J.*, Sup. C. Dist. of Col., 1841.

JOINT OWNERS.

The right of joint owners of a patent to operate separately has been variously interpreted by rulings of different authorities, which (in default of adjudication by the Supreme Court) are here given. Decisions favoring liberty of independent action appear to preponderate.

1. Joint owners of a patent may operate independently.

A part owner of a patent may, in the absence of any contract, assign his interest in it, or any fractional part thereof; or he may, either alone or in company with

others, purchase or make as many machines as he pleases, and may sell them to others with the right to use or sell them; but he has no power to control the action of nor to exercise any supervision over a co-proprietor, nor to compel a contribution of profits or losses, nor to enforce a partition of the right; nor is either party under any obligation to make the property profitable. Such parties must be regarded as having interests which are distinct and separate in their nature, though derived from the same instrument; and having the same interests, with the right to use them separately, they cannot, by any legal use of them, incur any obligation to each other.

Vose v. Singer, Supreme Court of Massachusetts, 1864, *Chapman, J.*, Allen's Mass. Rep., 225.

2. If one joint owner of a patent appropriates any portion of the exclusive right or common property to his separate use or benefit, by either the use or the sale of a patented machine, he does what is in principle the same as the conversion of the joint property by a tenant in common, which authorizes his co-tenant to maintain trover.

Persons interested in a patent are simply joint owners, or tenants in common, of the rights and property secured by the patent; and their rights, powers, and duties, as respects each other, are substantially those of the joint owners of a chattel.

One joint owner can legally grant, assign, license, or sell only in respect to his own share or right. He cannot sell and give a good title to his co-owner's right, for the same reason that one joint owner of a chattel cannot transfer the share of his co-proprietor.

Pitts v. Hall, Nelson & Conclin, JJ., Oct., 1854, *Blatch.*, 201.

3. Owners of a patent are tenants in common, and each, as an incident of his ownership, has the right to use the patent or to manufacture under it. But neither can be compelled by his co-owner to join in such use or work, or be liable for the losses which may occur, or to account for the profits which may arise from such use.

DeWitt v. Elmira Nobles M'fg Co., 12 N. Y. Supr., 201.

4. Where there are several patentees, they are tenants in common. One of them has no superiority of right over another. One of them can manufacture and use the article patented without the consent of the others.

Dunham v. Ind. & St. Louis R. R., U. S. C. C., N. D. Ill., *Drummond, J.*, June, 1876, 7 Biss., 223; 2 Bann. & Ard., 327.

5. Joint owners of a patent-right are not co-partners, and, in the absence of any express contract, each is at liberty to use his moiety as he may think fit without liability to an accounting to the other for profits or losses.

Vose v. Singer, *Chapman, J.*, 4 Allen (Mass.), 226; *DeWitt v. Elmira Nobles M'fg Co.*, 12 N. Y. Supr., 301.

6. One of two joint owners can legally grant, assign, license, or sell his own share or right in the patent.

May v. Chaffee, 5 Fish. 160; 2 Dillon, 385.

7. Where a party owning less than the whole right makes a grant or license, he shall be answerable to the others, rather than that the other patentees shall look to the grantee or licensee.

Dunham v. Ind. & St. Louis R. R., 7 Biss. 223; 2 Bann. & Ard., 327.

JURISDICTION.

1. The official decisions and directions of the Commissioner and Acting Commissioner are binding upon all in the Patent Office until reversed by the Secretary of the Interior; but when a rule of the Patent Office (although promulgated by the Commissioner of Patents and approved by the Secretary of the Interior) is found to be in conflict with a decision of a United States court, the office practice must conform to such decision.

Clymer v. Riley, Leggett, Com., 17 July, 1874, 6 O. G., 505.
See also *Becker v. Throop, Thacher, Com.*, 8 O. G., 1.

2. Judicial decisions of the Commissioner of Patents are not appealable to the Secretary of the Interior.

Workman v. McNaught, Paine, Com., 25 Ap., 1879, 16 O. G., 216.

3. It appearing that what was intended to be a complete system of remedies by appeal from the decisions of the Commissioner has been provided by the same statute which provides for the directory power of the Secretary: *Held*, that, in the absence of any express provision for appeal to the Secretary, an inferential right of appeal is excluded.

Applying the above rule of construction to the commissioner's decisions in cases of interference: *Held*, that they are not subject to the directory power of the Secretary either by contemporaneous dictation or by appeal and reversal, described as direction.

U. S., ex rel. R. Hoe & Co. and George C. Gill v. Benjamin Butterworth, Commissioner of Patents, Supr. Ct., Dist. Col. By James, J., Mar., 1884, 27 O. G., 519.

4. The provision of the statute, giving the Secretary the power of directing, is general, and the provisions

relating to the duties and powers of the Commissioner are specific. It is the latter which must control. When the sections of the statutes are considered together, it must be held that the Commissioner must perform his duties under the direction of the Secretary, except when he is already directed by the superior directory power of the Legislature.

Upon the above consideration it is furthermore held that the appellate proceedings and reversal by the Secretary in the case at hand were unauthorized, and therefore a nullity; and that consequently the Commissioner of Patents, having finally adjudicated that the relators are entitled to a patent, improperly refuses to issue the same, and ordered that the writ of peremptory mandamus shall issue.

The duties of the Commissioner of Patents are in part administrative and in part of a judicial nature. In his judicial capacity he acts as the direct representative and expounder of the law subject to no appeal except to the tribunals expressly designated by the statute.

Daniels v. Morgan, Mitchell, Com., 1 May, 1889, 47 O. G., 811.

5. While the Secretary of the Interior has a supervising jurisdiction over the Patent Office to the extent of prescribing proper rules for the business of that Office, and to the extent of enforcing a due observance of such rules, yet, over the acts of the head of that Office involving the exercise of *judicial* functions conferred upon him by law, the Secretary has no jurisdiction.

Petithomme v. Bedbury, Chandler, Act. Sec. Int., 25 June, 1890, 52 O. G., 805.

6. A peddler is not exempt from municipal license fees by reason of the articles vended being patented ones.

A state may require the taking out of a license for the sale of a manufactured article, and the fact that the

article is produced under a patent will not defeat this power; but a state (or other municipal body) may not discriminate against a non-resident manufacturer as such.

*Webber v. The State of Virginia, U. S. S. C. By Field, J., 2 May, 1881, 20 O. G., 369, **

7. A city ordinance prescribed a tax upon peddlers, etc. The defendant was convicted of selling from door to door without a license, a patented article: *Held*, that the patent did not prohibit the municipality from imposing such a tax.

People v. Russell, Supreme Ct., Mich., Cooley, Ch. J., 3 Jan., 1883, 25 O. G., 504.

8. State laws which impose disabilities on sale or other disposal of patents are void.

The Act of February 18, 1873, entitled "An Act to Regulate the Sale of Patent Rights in the State of Nebraska and prevent Frauds Connected therewith" (and which sought to impose special disabilities on the sale of patent rights) is in conflict with the Constitution and laws of the United States and void.

Wilch v. Phelps, Supreme Ct., Nebraska, Lake, Ch. J., 23 Mar., 1883, 25 O. G., 981.

9. Secretary of the Interior.

A decision of the Commissioner of Patents denying an interfering party's motion to amend his preliminary statement, is a judicial rather than a ministerial act, and, consequently, one over which the Secretary of the Interior has no appellate jurisdiction (citing *Petithomme v. Bedbury, 52 O. G., 605*).

Noakes, x. p., Noble, Sec., 15 July, 1892, 60 O. G., 575.

10. When the sections of the statute are construed together, it is held that when there are two interfering patents, the Circuit Court of the district whereof the defendant is an inhabitant or where he may be found is the court having cognizance, and where an original application for a patent has been refused and a remedy is sought in equity, and the process is to be served on the Commissioner of Patents, then the Supreme Court of the District of Columbia is the tribunal to entertain the suit.

Prentiss v. Ellsworth, the late Commissioner of Patents, *Randall, J.*, 11 Ap., 1846, 27 O. G., 623.

11. An objection to the jurisdiction of the Circuit Court in Pennsylvania is that it has no mode of enforcing obedience to its decree, since the Circuit Courts outside of the District of Columbia have no authority to issue a writ of mandamus to an officer of the United States in that district commanding him to do a ministerial act.

Ib.

12. The Federal Courts have exclusive jurisdiction in all causes arising under the Patent and Copyright Laws without reference to the amount involved.

Miller v. Carpenter, *Jackson, J.*, 7 May, 1888, 43 O. G., 1118.

See, also, *St. Paul Plow Wks. v. Starling*, U. S. S. C. By *Gray, J.*, 14 May, 1888, 43 O. G., 1350, *.

Also see ORIGINATION OF CIRCUIT COURTS OF APPEALS.

13. Courts outside of the District of Columbia have no mandatory jurisdiction over the Commissioner of Patents.

On appeal of the Commissioner of Patents, from a decision of U. S. Circuit Court for District of Vermont,

made under Sec. 4915, R. S., adjudging Samuel Hill and Benjamin B. Prentice entitled to a patent for their improvement in milk-coolers, and directing the said Commissioner to issue the same: *Held*, that by Sec. 739, R. S., as well as by Act March 3, 1875, Chapter 137, Sec. 1, it is provided that, "no civil suit shall be brought before any Circuit or District Court of the United States against an inhabitant of the United States, by any original process, in any other district than that of which he is an inhabitant, or in which he may be found at the time of serving the writ." We entertain no doubt that this statute applies to suits brought under Sec. 4915. The official residence of the Commissioner of Patents being in the Patent Office in the District of Columbia, and the subpoena having been served on him there, and he having refused to appear in the case, we are of the opinion that the court was without jurisdiction, and had no authority to enter the decree which has been appealed from, and the decree is accordingly reversed and the bill dismissed, without prejudice, for want of jurisdiction.

Butterworth, Commissioner of Patents *v.* Hill, U. S. S. C. By *Waite, Ch. J.*, 30 Mar., 1885, 31 O. G., 1043, ✱. See, also, U. S., *ex rel.* R. Hoe & Co. *et al.*, 27 O. G., 519 and 623; Butterworth, Commissioner of Patents (Hoe *et al.*) *v.* U. S., *ex rel.*, U. S. S. C. By *Matthews, J.*, 3 Nov., 1884, 29 O. G., 615, ✱.

Compare, however, Daniels, x. p. (16), *infra*.

14. A court outside the District of Columbia has no such jurisdiction over the Commissioner of Patents (the Commissioner's official residence being in said district) as to make him a party or compel his attendance in a suit outside of said district.

Illingworth v. Atha et al., U. S. C. C., N. J., 42 F. R., 141.

15. The rule (144), while limiting the power of the Commissioner to review an action taken by his prede-

cessor in his executive capacity, is not binding upon him in the discharge of his judicial duties.

Daniels *v.* Morgan, *Mitchell, Com.*, 1 May, 1889, 47 O. G., 111.

16. The action taken by Mitchell, Commissioner, in the case of Daniels, *x. p.* (see DECREE OF COURT) shows that the Commissioner will obey a mandate from a U. S. Circuit Court upon a suit in which he has not been made a party and which calls for merely ministerial action on his part.

Daniels, *x. p.*, 10 Jan., 1891, 54 O. G., 1113.

17. This was a bill to restrain the publication of a libel that injuriously affects complainant's business.

Is the fact that the statement was made with reference to a patented article sufficient to oust the State court of jurisdiction, although both parties are citizens of Missouri? I think not. The right of action does not grow out of the Patent law, but is given by the common law (*Benton v. Pratt*, 2 Wend., 385; *White v. Merritt*, 7 N. Y., 352; *Townsh. Sland & Lib.*, § 206). That the statement made affects the sale of a patented device is purely accidental. In no aspect of the case can the question of infringement be the sole or even the cardinal issue.

Complainants being in the wrong forum, injunction was refused.

Flint et al. v. Hutchinson Smoke Burner Co., U. S. C. C., E. D. Mo., *Thayer, J.*, 4 May, 1889, 38 F. R., 546.

18. Slander of Right to make, vend, etc., a certain Device.

Where complainants' bill alleged that they were the owners of a patented device, and that defendants owned a similar patent, and had published and were about

to publish a notice that complainants' device was an infringement of defendants' patent; that such allegation was false and was known by defendants to be false; that said allegation was made maliciously and with intent to injure complainants' business; and complainants prayed for an injunction to restrain such further publication: *Held*, that the question of infringement was not the sole, nor even the principal issue in such a case; and that — as has been several times held — the State courts were not ousted of their ordinary jurisdiction merely because trial of the case may involve the determination of some question under the Patent law; that complainants were in the wrong forum, and that, for that reason, — and without prejudice to the merits of the case, — injunction must be refused.

Ib.

JURY.

1. Questions of Fact.

Whether a patented invention is one of "a primary character" and the patent "a pioneer patent," and whether, on a proper construction of the patent, defendant's machine infringed its claims, are questions for the jury to determine.

Royer v. Schultz Belting Co., U. S. S. C. By *Blatchford, J.*, 5 May, 1890, 34 L. ed., 214, *.

2. In a suit for infringement of a patent for invention, the question of anticipation is a question of fact, and is exclusively for the jury to determine.

Haines v. McLaughlin, U. S. S. C. By *Fuller, Ch. J.*, 19 May, 1890, 34 L. ed., 290, *.

LACHES.

An unexplained delay of over seven years in bringing suit for infringement of a patent deprives the complain-

ants of the right to a preliminary injunction and perhaps to an account. Further infringements will, however, be prevented by an injunction, notwithstanding previous laches.

Price et al. v. Joliet Steel Co., Gresham, J., May, 1891, 56 O. G., 664.

See ABANDONMENT, DILIGENCE, FORFEITURE, INTERFERENCES.

LICENSE.

1. A license to manufacture at a certain place is a personal license not transferable.

Searles v. Bouton, Wheeler, J., Oct., 1881, 21 O. G., 1784.

2. A license will not carry the right to any one but the licensee personally, unless there are express words to show an intent to extend the right to an executor, administrator, or assignee.

*Oliver, Finny & Co. v. Rumford Chemical Wks., U. S. S. C. By Blatchford, J., 29 Oct., 1883, 25 O. G., 784, *.* See, also, *Keller et al. v. Stolzenbach et al., (3) infra.*

3. During the existence of a partnership between two persons, one of them invented a machine upon which a patent was granted to him. The firm paid the fees and costs of procuring the patent and the expenses of an experimental trial of the invention, and also paid the expenses of some litigation which ensued. It appeared, however, that all the outlay by the firm was more than repaid by the benefits arising from the use of the invention in the partnership business: *Heid*, that upon these facts no implied license arises to the member of the firm not the inventor, to make, vend, and use the patented machine after the dissolution of the partnership.

Keller et al. v. Stolzenbach et al., Acheson, J., 20 Mar., 1884, 27 O. G., 209.

4. Rights of, — How enforced.

A grant under a patent which excludes either the right to make, the right to use, or the right to sell, is not a grant of the entire patent-right, and is, therefore, only a license. Complaints of infringement of a patent-right can be enforced *only* through or in the name of the owner of the patent; the name of the licensee — if necessary to protect the rights of all parties — being joined with that of the owner as plaintiff.

. *Waterman v. McKenzie*, U. S. S. C. (by *Gray, J.*), 34 L. ed., 923, #.

5. Revocation.

When a license contains no power of revocation the licensor cannot annul it without assent of the licensee; but must proceed at law for any breach of the contract.

Chace v. Cox, *Butler, J.*, 19 June, 1890, 41 F. R., 475.

NOTE. — In a grant of exclusive license within and throughout the United States, or any portion thereof, it is customary to insert in license contracts two clauses for the protection, one of the licensor, and the other of the licensee, viz.: (i) That the licensee's payments shall, in no one year, fall short of a specified *minimum*; (ii) That the licensor shall take prompt legal action against piratical users within the licensee's territory.

See ASSIGNMENT; CONSTRUCTIVE LICENSE.

LIMITATION OF TERM OF A UNITED STATES PATENT BY EXPIRATION OF FOREIGN PATENT.

Section 4887 of the Revised Statutes, which limits the term of the United States patent for an invention previously patented abroad to that of the foreign patent having the shortest term (which has been variously construed by different judges of circuit), is now definitely construed in decisions of the United States Supreme Court.

(1) Section 4887 R. S. must be held to mean that the subsequently granted United States patent "shall be so limited as to expire at the same time with the term expressed on the face of the foreign patent which had the then shortest time to run." There is nothing in the statute which admits of the view that the declaration of the United States patent is to be limited by anything but the duration of the legal term of the foreign patent in force at the time of issuing of the United States patent, or that it is to be limited by any lapsing or forfeiture of any portion of the term of such patent by means of the operation of a condition subsequent, according to the foreign statute.

(2) Where the term of grant in the written instrument which constituted the previously issued foreign patent was five years, which it was entirely within the patentee's option, by payment of an additional fee, to extend to fifteen years from the original grant; the effect of such instrument upon the duration of the United States patent is precisely that of a foreign patent granted for fifteen years.

Carl Pohl *et al.* v. Anchor Brewing Co., 33 U. S., 953, *.

See, however, (1) *et seq.*, TERM OF A U. S. PATENT.

LIMITATION OF TIME FOR ACTION FOR INFRINGEMENT OF PATENTS.

1. In the absence of any Federal Statute, and likewise of any conclusive decision of the Supreme Court which bears on the question, authorities are divided, but preponderate in denying any such limitation (estoppel) either generally for the United States or locally, under any law of the State in which the action is brought.

May v. Logan and Seneca Counties, Ohio, *Jackson & Welker, JJ.*, 22 Mar., 1887, 41 O. G., 1387; 3 Robinson on Patents, 173-179. See, however, Sec. 721 R. S.; and Hayden v. The Oriental Mills, *Lowell, J.*, 12 Mar., 1883, 24 O. G., 601.

2. A state statute of limitations is not pleadable in bar of an action at law for infringement of a patent. In this case the court said: In the absence of any decision of the Supreme Court on the question we are disposed to adhere to the rule laid down by Judge Grier (*Parker v. Hallock*, 2 Fish., 543), and the more so in view of similar rulings in other circuits (*May v. Buchanan Co.*, 29 Fed. Rep., 469; *May v. Cass Co.*, 30 Fed. Rep., 762; *May v. Ralls Co.*, 31 Fed. Rep., 473).

McGinnis v. Erie Co., McKennan & Acheson, JJ., 29 Dec., 1890, 55 O. G., 718.

LIMITATION OF TIME FOR APPEAL TO SUPREME COURT.

An appeal from the final decree of a Circuit Court must be taken within two years from the entry of such decree or it will not be entertained.

Fowler v. Hamill, U. S. S. C. By *Fuller, Ch. J.*, 18 Ap., 1891, 55 O. G., 715,*.

MANDAMUS.

See DECREE OF COURT.

MANUFACTURE — SALE — USE.

1. A patented article purchased of the patentee or one owning under him may be used or be sold for use (not in the ordinary course of trade) anywhere.

Whatever may be the rule where patentees subdivide their patents [territorially], as to the exclusive right to make or sell within a given territory, we hold that, in the class of machines or implements which we have described (*Hat-Felting Machines*, 16 Wallace, 545; *Planing Machines*, 1 Wallace, 340; *Water-proof Fabric*, 22 Howard, 221, etc.), when they are once lawfully made

and sold, there is no restriction upon their use to be implied for the benefit of the patentee or his assignees or licensees.

Adams v. Burke, U. S. S. C. By *Miller, J.*, 8 Dec., 1873, 17 Wallace, 455, *.

2. Sale of the patented article, in the ordinary course of trade, outside the territorial limits to which the right of sale is restricted by the patentee's grant, is unwarranted.

Hatch v. Adams, *McKernan, J.*, 20 Oct., 1884, 29 O. G., 776.

Unconditional sale of a patented article confers the whole title therein, and impliedly warrants full ownership on the part of the vendor; title so passed even where the sale was in a foreign country, is good everywhere and carries the right to use, or sell for use, anywhere.

Holliday v. Matheson, *Wheeler, J.*, 9 Dec., 1884, 30 O. G., 452.

See TERRITORIAL RIGHTS.

MARKING.

1. Patentees are required to mark each article made or vended under their patent (or when this is impracticable, to mark the package or wrapper) with the word "patented," and the day and year of the grant; but infringers who have been duly notified, are liable, notwithstanding omission of such marking.

R. S., 4900.

2. When, from the small size of the article or other cause, it is difficult or impracticable to mark it with the word "patented" and date of patent, the law is

complied with by marking the wrapper in which the goods are exposed for sale.

Sessions v. Romadka, U. S. C. C., E. D. Wis., *Dyer, J.*, 26 July, 1884, 28 O. G., 721.

See PENALTY.

3. *Willful* infringers are not absolved by the patentee's neglect to mark.

The court will proceed upon the hypothesis that the burden of averring and proving a failure to mark is on the defendant, the plaintiff not being held to proof of marking, in the first instance; but where defendant has shown an instance of plaintiff's failure to mark, the burden falls upon the plaintiff to show that defendant was notified, before suit was brought, that he was infringing.

Schofield v. Dunlop, U. S. C. C., E. D. Pa., *Butler, J.*, 9 May, 1890, 52 O. G., 1369, 42 F. R., 323.

4. Burden of Proof.

It is only after defendant has proved that the patented article was not marked with the required notice that it is incumbent on the complainant to prove that defendant had knowledge of the patent.

Ib.

MATERIAL.

See NEW MATERIAL.

MATERIALITY.

See (4) EXAMINATION; (6) RE-OPENING OF CASE; SUBSTANTIAL AMENDMENT.

MATTER OF FORM.

In reference to petition "for an order on the Primary Examiner requiring him to dispose of claims 2

and 3 on their “merits,” the Commissioner said: The Examiner has not yet formally rejected the claims, but has twice objected to the use of the word “*moieties*.” If all that applicant means or intends to mean by his use of the word “*moieties*,” is parts of equal size, it is easy for him to use those words and avoid what is believed to be an ambiguity. The Examiner’s action pertains to a matter of form, and therefore he *objects* instead of *rejects*.

Petzold, x. p., *Simonds, Com.*, 12 Feb., 1892, 58 O. G., 1091.

MATURED INVENTION.

See *Stephenson v. Goodell*, (1), *Sawyer v. Edison*, (4), *Dolbear v. Am. Bell Tel. Co.*, (5), and *Bury v. Thompson*, (2),
REDUCTION TO PRACTICE.

MATURITY OF AN ART.

See INFANCY OF AN ART.

“MEANS,” “MECHANISM,” ETC.

1. Comprehensive Expressions.—When and in what way permissible.

Such expressions as “*means*” and “*mechanism*” are generally objectionable as being indefinite. They are always objectionable where, by their use, the claim does not distinguish what is believed to be new. It is not, however, intended by this to intimate that any particular expression or form of words is always to be excluded from a claim, — that, for example, such expressions as “*means*” and “*mechanism*” may never be employed. On the contrary, if such words, coupled with the necessary words of qualification, ever *express the exact invention*, or if they refer to *merely adjunctive devices*, readily understood, they are not objectionable. Comprehensive

terms and phrases are quite proper (Demming, x. p., 26 O. G., 1207), if they are clear, that is, if they distinctly express the invention and are warranted by the specification.

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

2. Where, in a claim, the language qualifying the word "means" referred to function, and contained no limitation whatever in respect to construction or mode of operation as distinguished from the result, and the word "means" designated that portion of the claim in which the novelty resided: *Held*, that such a claim was indefinite and should not be allowed.

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

3. Where, in a claim, the language following the words "means" and "mechanism," was employed to set forth function, but *contained limiting or qualifying words other than those which set forth the result accomplished*: *Held*, that such a claim was not vague or indefinite.

Ib.

4. Where the Examiner rejected several claims on the ground that the words "*mechanical connections*" used therein covered more in some claims than in others, and that therefore the claims were faulty, under the decision in Stanbridge, x. p. (43 O. G., 1345): *Held*, that the objection did not go to the merits, and was besides not tenable, because, within the scope of the claims against which the objection was raised, the devices described as "*mechanical connections*" could be clearly distinguished in the several claims, and there could, therefore, be no doubt as to what the term was intended to cover.

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

Compare Nordenfelt, x. p., (5), and Jacobson, (6) *infra*; and Noyes, x. p., (9) SPECIFICATION.

See also Laskey, x. p., (21), Wilder, (22), and Skinner, x. p., (24), CLAIM, CUSTOMARY ADJUNCTS; Designolle, x. p., (17) CLAIM; and Kent, x. p., 1871, C. D. 301; Richardson, x. p., 1875, C. D. 54; McMurray, x. p., 1875, C. D. 134; Barnes *v.* Snedeker, 1880, C. D. 95; Pearson, x. p., (1 and 3) PIONEER INVENTION.

See, however, Rogers, x. p., (8 and 9), and Raymond, x. p., (10), EXAMINATION.

5. The question whether or not a pioneer inventor is entitled to claims covering his invention broadly by the use of such terms as “means” and “mechanism,” is one which is to be determined by a consideration of the state of the art rather than by objections to the form of the claims. Such questions of form are subordinate to the question of patentability, and *no form of claim is to be prescribed which will prevent an applicant from obtaining claims to amply protect his invention within limits set by the state of the art.*

Nordenfelt, x. p., *Fisher, Act. Com.*, 11 Feb., 1890.

6. Where the Examiner maintained that the term “means” alone could not be used to designate an element of a combination which might be omitted from the claim without impairing its validity in any respect, and relied upon *Anders v. Gilliland* (1881, C. D. 1); *Deming*, x. p. (1881, C. D. 71); *Pacholder*, x. p. (39 C. D. Ms., 473); and *Stoughton*, x. p. (43 O. G., 1345): *Held*, that the Examiner’s proposition was utterly untenable, and that in each of the cases cited, where the term “means” was held to be objectionable, the thing covered by the term was of the essence of the invention, and not a mere subsidiary device. The Supreme Court, in *Morley Sewing Mach. Co. et al. v. Lancaster* (47 O. G., 267), sustained claims which fairly bristled with the words “means” and “mechanism,” applied not only to sub-

sidiary, but also to the principal features of the invention covered by them.

Jacobson & Jacobson, x. p., *Fisher, Act. Com.*, 3 Jan., 1890.

Compare Clouser, (4) *supra*, and cases there cited; also Pearson, x. p., (1) PIONEER INVENTION.

MECHANICAL SKILL.

1. As distinguished from Invention.

Where an application was rejected on a reference and applicant based his right to a patent upon the ground that his device could be applied more readily and in less time than the device in the reference patent and other well-known devices, and that it could be more cheaply made because composed of less metal: *Held*, that, although the device might be better than any other, yet the result and mode of operation were substantially the same as in the device cited, and the applicant, in the production of the improved form, had brought into play the skill of the mechanic only.

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

2. A patent for improvements upon the subject-matter of a prior patent is void, — even although made by the original patentee, — where the improvements consisted only of such modifications and changes as the use of the original form would suggest to any skilled mechanic, and which therefore did not require the exercise of invention.

Root *v.* Sioux City Cable Ry. Co., *Shiraz, J.*, U. S. C. C., N. D. Ia., 42 F. R., 412.

3. A combination of old elements does not constitute patentable invention, which merely shows great industry in acquiring knowledge of what others had done, good judgment in selecting and combining the same, and

mechanical skill in their application, but which presents no discoverable trace of original thought; and is an improvement in degree merely upon earlier patents, patentable.

Busell Co. v. Stevens. By *Lamar, J.*, 15 Dec., 1890, U. S. S. C., 34 L. ed., 719, *.

Compare *Voelker v. Gray v. Edison v. Bell*, (31) *et seq.*, INVENTION; and *Torrance*, (1) *et seq.*, ORDINARY RESOURCES OF THE ART.

"THE MERITS."

1. Questions involving "the merits" are questions concerning the meritorious or unmeritorious attitude of an alleged invention to the antecedent rights of the public; or, in other words, all questions other than questions of "form" arising between the applicant and the Office. All questions which under Rule 124 the party only whose claim is affected has a right to be heard, are questions of "merits," and can reach the Commissioner only in his judicial capacity on appeal from the Examiners-in-Chief. All questions in which both the Examiner and the applicant have a right to be heard are questions of "form," and are appealable direct to the Commissioner acting in his executive capacity.

Zeidler et al. v. Leech et al., *Mitchell, Com.*, 19 Jan., 1891, 541 O. G., 503.

2. Where the question as to the lawful scope of a claim is a question involving "the merits" and not one of form merely, it is to be disposed of by the Primary Examiner, subject to appeal to the Examiners-in-Chief.

Ambler, x. p., *Mitchell, Com.*, 31 Oct., 1889, C. D. Ms.

3. The question of inoperativeness is one which goes to "the merits" of the invention, and from a rejection on this ground an appeal lies to the Examiners-in-Chief.

Ferguson, x. p., *Frothingham, Act. Com.*, 3 Sep., 1891, 56 O. G., 1334.

4. Statutory bar is a question of "merits."

On a petition from the action of the Examiner rejecting an application on the ground that the grant of a patent would be in violation of the Act of 10 Feb., 1891, to prevent counterfeiting, etc.: *Held*, that the action was in effect a rejection, upon the ground that the subject-matter was not patentable by reason of an alleged statutory bar, and, therefore, clearly a question relating to the "merits," and the petition was dismissed.

Thompson, x. p., *Frothingham, Act. Com.*, 24 Oct., 1891, C. D. Ms.

5. Upon petition that the Examiner be instructed to examine the case "as a proper subject for a patent under the head of a 'manufacture'": *Held*, that it was a question relating to the "merits," and therefore not properly [on petition] before the Commissioner.

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

MINORS. — MARRIED WOMEN. — WARDS, ETC.

Either as inventor or as assignee, a married woman or a minor may apply for and become possessor of a patent; but their ability to dispose of such right or possession will be subject to the laws governing such procedures where the transaction takes place.

R. S., 721 and 722; *Fetter v. Newhall*, U. S. C. C., S. D. N. Y., *Wheeler, J.*, 29 Aug., 1883, 25 O. G., 502.

MODELS.

1. Applications complete in all other respects are now admitted and filed whether accompanied by models or not. A model is neither required nor admitted unless called for by the Examiner in charge.

R. S. 4891; P. O. R. 56.

2. To accompany Application.

Unless filed because a requirement of the Office, a model forms no part of the application record, and cannot be endorsed on the file-wrapper.

Beaumel, x. p., *Frothingham, Act. Com.*, 30 Ap., 1891, 56 O.G., 1208.

3. Where applicant presented a model with his application without being called for by the Office, and the Examiner refused to endorse it upon the file-wrapper as a part of the application, on the ground that he had no authority, in any case, to enter upon the file-wrapper of an application the date of the reception of a model until after it had been called for in the manner and for the purposes stated in Rule 56; petition praying that the Examiner be overruled denied.

Ib.

4. Examiner having allowed a claim, one of whose elements was the "plug valve" which he now pronounces inoperative, his requirement, at this stage, for a model is overruled. The case is remanded for action under Rule 133.

Ferguson, x. p., *Frothingham, Act. Com.*, 3 Sep., 1891, 56 O. G., 1334.

5. Where, after calling for a model, the Examiner states that it could not be accepted, but that [nevertheless] the application had been examined in connection with it as an exhibit employed as a guide by which to criticise the drawings and specification: *Held*, that the law knows of but one kind of model as a source of information to the Office, and that is such a model as complies with the rules, and if it is not such a model,

only confusion can result from references to it in the record.

Crissey, x. p., *Mitchell, Com.*, 12 Feb., 1891, C. D. Ms.

6. When Returnable.

Where a model had been called for but its receipt and application to the case under consideration had never been entered on the file-wrapper, as required by Rule 56, and the Examiner had stated that he did not consider a model was necessary: *Held*, that it had not been regularly filed, and, therefore, applicant's request for its return should be granted.

Hunter, x. p., *Frothingham, Act. Com.*, 17 June, 1892, 60 O. G., 1477.

7. It is a well-settled law that a model alone, designed and intended as such, even though it be a working model, is not a reduction to practice.

Green v. Hall v. Siemens v. Field, *Hall, Com.*, 6 Mar., 1889, 46 O. G., 1515.

8. A model or drawing, although (as was held in *Loom Co. v. Higgins*, 105 U. S., 580, *) a sufficient foundation for a claim to priority of conception, must be followed up with reasonable diligence and with actual reduction to practice, in order to establish full title to priority.

Green v. Hall v. Siemens v. Field, *Mitchell, Com.*, 10 June, 1889, 47 O. G., 1631.

See PRIORITY and REDUCTION TO PRACTICE.

MODIFICATIONS.

Modifications suggested in the specification must be shown in the drawings.

Examinations are conducted, in the main, by an inspection of the drawings. It is, therefore, not only

proper, but necessary that each drawing shall disclose, as fully as possible, the invention, and also the substantial modifications thereof, in order to avoid injustice to the public and to other patentees by the issue of two patents for the same thing.

Witty v. Caffery, x. p., *Butterworth, Com.*, 25 Nov., 1884, 29 O. G., 862.

MULTIPLICITY OF CLAIMS, see REDUNDANCY.

MORTGAGED PATENT.

Mortgagee's Rights and Powers.

The recording of a mortgage of a patent-right in the Patent Office is equivalent to a delivery of possession, and makes the title of the mortgagee complete toward all other persons as well as against the mortgagor, and the mortgagee thereby becomes the only person who can sue for an infringement of the patent.

Waterman v. Mackenzie, U. S. S. C. By *Gray, J.*, 2 Feb., 1890, L. ed. 923,*.

MOTION.

1. To dissolve Interference.

There is no rule which requires that the facts upon which a motion to dissolve an interference is based should be stated in the motion. If, however, facts are relied upon other than those disclosed by the record, they should be stated in order to receive consideration.

There is nothing in the rules that limits the questions to be discussed upon a motion to dissolve an interference, to those which have not been previously considered by the Primary Examiner. One object to be secured by such motions is to enable the Examiner to decide *inter partes* what he had previously decided without a hearing.

Law v. Wolf, *Mitchell, Com.*, 9 June, 1891, 55 O. G., 1527.

2. After Judgment.

A motion after judgment must be made with such promptness that it can be heard before expiration of limit set for appeal, because otherwise the tribunal which rendered the judgment would not have jurisdiction at the day of hearing (*Holton et al. v. Merrow*, 41 C. D. Ms., 457; Rule 114).

Meyrose v. Jahn, Frothingham, Act. Com., 28 Mar., 1891, 56 O. G., 1447.

3. To strike from Record.

Until the proper court has been applied to to heal the defect, the Office will not act upon a motion to strike from the record of a case pending before it the deposition of a witness because he refused to answer a proper question on cross-examination; but it will, in a proper case, give the moving party a reasonable time to make the proper application to court within whose jurisdiction the testimony was taken.

NOTE. — Thirty days from the date of this decision were allowed for such application to court and the completion of Robert P. Frist's testimony; the other dates and times in the case being correspondingly extended.

Reuter v. Frist, Simonds, Com., 7 Jan., 1892, 58 O. G., 386.

Compare (195) and (196) INTERFERENCES.

See dicta under captions WAIVER and WITNESSES.

See also *Brunger v. Smith, Colt, J.*, 58 O. G., 388.

MULTIFARIOUSNESS.

If a bill charge infringement of separate patents in one machine, it will not be rendered multifarious by the mere fact that the several inventions relate to different and distinct parts of the machine.

Deering v. Winona Harvester Wks. et al., U. S. C. C., D. Min., *Nelson, J.*, 19 June, 1885, 32 O. G., 654.

NASCENT INVENTION.

See CONCEPTION.

NAME.

Where the applicant employed in the specification the words "Forbes Combined Slide-Hinge Joint," to designate a feature which he believed himself to have invented, *but there was no evidence that such name was known in the art: Held*, that the Examiner was correct in requiring the words to be eliminated. If the use of such an expression is permissible in a specification, it is only when the machine or mechanism referred to has become known by such name in the prior art.

Forbes, x. p., *Mitchell, Com.*, 14 Oct., 1889, C. D. Ms.

NAME OF APPLICANT.

See SIGNATURE. See also McGee, x. p., (18) DRAWING.

NECESSARY FUNCTIONS OF THE MACHINE.

1. An objection that the claims are for the necessary functions of the mechanism described is not a question of form but of merits, and, therefore, an appeal lies to the Examiners-in-Chief.

Zalinski, x. p., *Fisher, Act. Com.*, 4 Mar., 1890, C. D. Ms.

2. Where Examiner objected that the claims were for the necessary functions of the mechanism described, but made no examination upon the merits: *Held*, that unless descriptions and claims are of such a character that the inventions covered by them cannot be understood, an examination into the state of the art should be made so that applicant can have the benefit of it in case it becomes necessary to appeal.

3. One claim covered a hammer, and another an alleged method carried out in the ordinary use of the

hammer: *Held*, overruling a requirement of division, that the case was not one requiring division, but one involving the question whether the claim covering the tool could be joined with one for a mode of using it; that the subject-matter of both claims could be examined in the same division, and that the case fell within the doctrine in *Lord*, x. p., 50 O. G., 938, and *Norwood*, x. p., 50 O. G., 1129.

Woltentarsky, x. p., *Frothingham, Act. Com.*, 26 Feb., 1892, C. D. Ms.

Compare *Mackay v. Jackman*, (85) INVENTION.

NEW MATERIAL.

1. While mere change of material in a fabric may not involve invention, and consequently not be patentable, yet where it is sought and accomplished for the purpose of producing a new effect or for accomplishing a new and improved result, then it becomes more than a mere change of material and may be patentable.

Love, x. p., *Leggett, Com.*, 4 Nov., 1871, C. D., 276.

See, however, *Hotchkiss v. Greenwood*, (3) *infra*, *.

2. Patent was sought on a claim for an alleged useful novelty depending on the use of a certain material. The question to be decided is whether it is a mere change of material, — whether all the advantages attained are such as were known in advance would be attained by selection of the tissue in question. The answer must be that it (limbered and perforated bladder tissue) is a mere change of material, and that its new use has no quality not indicated by its known character. The decision of Board of absence of patentable novelty, affirmed.

Foss, x. p., *Simonds, Com.*, 12 Sep., 1891, 56 O. G., 1564. Reiterated on rehearing, 23 Nov., 1891, 57 O. G., 1277.

3. The use of clay to make a particular kind of door-knob being known, and clay having been used to make door-knobs of other kinds, and *the practicability of using it for this kind of knob being obvious to an ordinary mechanic acquainted with the business*, is not the subject of letters-patent.

Hotchkiss v. Greenwood. U. S. S. C. By *Nelson, J.*, Dec., 1850, 18 Curtis, 615, *.

4. Where substantially the only difference between the application and the reference was that the material used by one was pure lead where the other used one part tin and nine parts lead: *Held*, that the change in material did not amount to invention.

Harrington, x. p., *Simonds, Com.*, 16 Jan., 1892, C. D. Ms.
Compare Aimbach, x. p., *infra*.

5. All the steps of the process being old, the substitution of one well-known variety of cement for another that is also well-known as a binding material, in carrying out the process, does not amount to invention unless the character of the substituted material is such that its use in the present relation involved something more than mere selection.

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

For Supreme Court decision of like purport, see *Hotchkiss v. Greenwood*, * (3) *et seq.*, *supra*. For an instance, where the material employed constituted an element of patentability, see *Love*, x. p., (1) *supra*. For a general exposition of the subject, see decision of *Simonds, Com.*, in the case of *Foss*, x. p., (2) *supra*.

6. Where the alleged invention consisted principally in the substitution of cotton for jute in the manufacture of bagging: *Held*, (following *Brown v. Dist. of Col.*,

130 U. S., 87, *) that, notwithstanding the experiments and trials made by the applicant and the advantages and commercial success of the alleged invention, all that applicant did was to substitute one well-known material for another and to apply to the substituted material the resources of the weaver's art, and that such substitution and application were not the creative work of the inventive faculty such as the patent laws were formed to encourage and reward.

Odenheimer, x. p., *Mitchell, Com.*, 27 Nov., 1889.

7. To support a patent there must have been something more than a mere substitution of one material for another, which substitution neither involved a change of method nor developed novelty in use, even though the substitution resulted in a superior article.

Florsheim *et al. v. Schilling*, U. S. S. C. By *Lamar, J.*, 10 Nov., 1890, 53 O. G., 1737, *.

8. Although patentable novelty may inhere in a machine or a process, or both, whereby a useful fiber is produced from some natural object, — e. g., “pine-needles,” — the product itself is not a subject for patent. A contrary ruling would result in granting to one inventor the exclusive use of one species of fiber, to another, that of another species, and so on indefinitely; separate patents might thus be obtained upon the fibrous constituents of each of the various trees of the forest, plants of the earth, etc., which, being natural products, are no more the subjects of patents when eliminated from their surroundings, than wheat that had been cut by some new method of reaping could be patented as wheat cut by such a process.

Latimer, x. p., *Hall, Com.*, 12 Mar., 1889, 46 O. G., 1638.

See (28) *et seq.*, INVENTION.

See also Johnston, x. p., (2) ORDINARY RESOURCES OF THE ART.

“NEW MATTER.”

1. The expression is not appropriate in actions on original applications.

Examiner having refused to permit description or exhibition of more than one “knocker,” because, as only a single knocker had been mentioned or described in the application as filed, such additional knocker would be “new matter;” the objection was overruled because the term “new matter” in the statute and the Rules of Practice had reference to re-issues only.

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

Of like tenor, see Noyes, x. p., (13) SPECIFICATION; and Myers, x. p., (21) AMENDMENT.

2. The rights of the applicant must stand or fall upon his original application. Only such changes may be made as are authorized by the drawing, model, or specification as filed in connection with the application. A drawing may not be altered so as to exhibit features neither disclosed in the drawing nor described in the specification as originally presented. Amendments cannot be received on the ground that they represent features contained in a model that was never filed.

Kissner, x. p., *Mitchell, Com.*, 30 Oct., 1890, C. D. Ms.

See also Edison, x. p., (9) *infra*.

Compare, however, Holt, x. p., *supra*; Myers, x. p., (21) AMENDMENT; and Noyes, x. p., (13) SPECIFICATION.

For ruling that in an original application an omitted device is not “new matter,” if it was described in an earlier application by the same inventor, see Scott, x. p., (10) ABANDONMENT; and Rennyson *v.* Merritt, (5) DEDICATION.

3. A new claim justified by subject-matter found in the original specification may be introduced into a

pending application if said claim be fortified by a supplemental oath, as required in Rule 70; but new subject-matter — either with or without a corresponding claim — may not be introduced, or, if it has been introduced, cannot be permitted to remain in an application (Con. Elec. Lt. Co. v. McKeesport Lt. Co., 40 Fed. Rep., 21). Had the new subject-matter in the present case been accompanied by a claim based thereupon, the appeal must have been to the Examiners-in-Chief, but, as no such claim was made, the question was properly on petition to the Commissioner. The decision of the Primary Examiner is affirmed and the petition dismissed.

Burson, x. p., *Simonds, Com.*, 26 Feb., 1892, 58 O. G., 1414.

4. Where a claim was made on amendment with the object of putting the application in interference with a patent on which it had been rejected, and the Examiner refused to entertain the claim because subject-matter not contained in the original application: *Held*, that the question of new matter is appealable to the Examiners-in-Chief, and must be disposed of in applicant's favor before an interference can be declared.

Rasor, x. p., *Mitchell, Com.*, 28 Sep., 1889, C. D. Ms.

5. If the Examiner is of the opinion that the proposed process claim, seasonably presented, covers new matter, he should incorporate the claim and reject it, in order that an appeal may be taken to the Examiners-in-Chief.

Perkins, x. p., *Mitchell, Com.*, 4 Mar., 1891, 55 O. G., 139.

6. Examiner's Duties.

When claims are presented which appear to the Examiner to involve new matter, his proper course is to admit the claims into the case and to reject them upon that ground.

Stone, x. p., *Fisher, Act. Com.*, 17 Mar., 1890, C. D. Ms.

7. Under Rule 133, the question whether or not a proposed amendment constitutes new matter, is one of "merits," from which an appeal in the first instance lies to the Examiners-in-Chief and not to the Commissioner.

Edison, x. p., *Mitchell, Com.*, 15 Ap., 1890, C. D. Ms.

8. Among the leading cases relating to the doctrine of "New Matter" in connection with original applications, are the following: *C. & N. W. R. R. Co. v. Sayles*, 97 U. S., 554, *; *Eagleton M'f'g Co. v. West Bradley & Carey M'f'g Co.*, 111 U. S., 490, * and *Consol. Elec. Lt. Co. v. McKeesport Lt. Co.*, 49 O. G., 1536.

Ib.

9. Upon a petition from the Examiner's decision that certain matter described in a substitute specification was new matter and inadmissible: *Held*, that, no question of division having been raised, the Examiner should have incorporated the amendment and have rejected the claim as covering new matter (*Bailey*, x. p., 52 O. G., 608; *Turner, Van Beck & Brown*, x. p., 56 O. G., 1708).

Tittle, x. p., *Frothingham, Act. Com.*, 6 Feb., 1892, C. D. Ms.

10. After an amendment supposed to contain new matter has been once incorporated in the application, Rule 70 is no longer applicable. The question whether or not said amendment really contains new matter then becomes one involving the "merits," and hence is appealable to the Examiners-in-Chief.

Nicolin et al., x. p., *Frothingham, Act Com.*, 26 May, 1891, 56 O. G., 1565.

See Fuller, x. p., (45) DIVISIONAL APPLICATION.

NEW PARTIES.

See Hogan, x. p., (8), FEES, and *Dougherty v. Street*, (21) INTERFERENCES.

NEW SPHERE OF ACTION.

Distinguished from a mere "Double Use."

The promotion of an old device to a *new sphere of action* in which it performs a *new function*, involves invention; but the transfer or adaptation of the same device to a similar sphere of action where it performs substantially the same function, does not involve invention.

Western Elec. Co. *v.* La Rue, U. S. S. C. By *Brown, J.*, 13 Ap., 1891, 55 O. G., 571, *.

Of like purport, see *Ansonia Co. v. Supply Co.*, * (2)
PATENTABILITY.

See ADAPTATION; DOUBLE USE.

NON-INVENTION.

Analogous Use.

The state of the art showing that dies could be used to compress and finish articles of vulcanizable gum and, in like manner, to compress plastic material surrounding a metal core or skeleton in making articles of harness trimming; it required no exercise of invention to use dies to compress and finish similar articles in which a vulcanizable gum was used to envelop a metal core.

The Rubber and Celluloid Harness Trimming Co. v. The India Rubber Comb Co., U. S. C. C., S. D. N. Y. *Wallace, J.*, 23 May, 1888, 44 O. G., 343.

See (30) *et seq.*, INVENTION; (1) *et seq.*, MECHANICAL SKILL; and (1) *et seq.*, ORDINARY RESOURCES OF THE ART.

NOTARY.

Where the notary taking depositions in an interference case was an employé of a company holding the interest

of one of the parties, and also appeared as a witness in the case, the other party having formally objected at the proper time to the taking of the testimony before him: *Held*, that, on motion to that effect, the testimony must be stricken from the record.

Vanness v. Shettler, Simonds, Com., 31 Oct., 1891, 57 O. G. 843.

NOVELTY.

1. The fact that an invention is of great utility and has gone largely into use goes far to show that the inventor had discovered and put to use what others skilled in the art had overlooked, and that it would have been found out before if ordinary skill in that art could have discovered it.

Bruce v. Marder, Wheeler, J., 22 Feb., 1882, 10 F. R., 750.

2. Invention is displayed by simplification accompanied with reconstruction producing useful results.

Invention is as often displayed in simplifying and cheapening mechanical constructions as in the discovery of new machines. When a machine consisting of fourteen or fifteen elements is so reconstructed as to accomplish the same or better results with seven or eight of these elements, invention is displayed and a useful result is obtained, and that result is new so far as concerns the more complicated machine. In such a case the complicated machine would not be a sufficient reference on which to reject the improved construction.

Sampson, x. p., Leggett, Com., 4 Nov., 1871, C. D. 277.

3. An incomplete and practically inoperative device does not furnish sufficient grounds for rejecting an operative one, though the two devices may have some features in common.

Mason, x. p., Leggett, Com., 27 Nov., 1872, 2 O. G., 644.

4. The application of a known device may be deemed novel if it lies so far out of the beaten track as not to be suggested by the former use of it.

Cheesebrough, x. p., *Fisher, Com.*, 11 May, 1869, C. D. 18.

5. Where the patent covers an entirety it cannot be defeated by showing that the several component parts are old in other connections. It must appear that they have existed together in the same relation.

Parks v. Booth, U. S. S. C. By *Clifford, J.*, Oct. 1880, 26 L. ed., 54; 12 Otto., 96, *.

6. A patent cannot be introduced in evidence to impeach the novelty of the plaintiff's invention if it has not been set up in the answer.

Am. Saddle Co. v. Hogg, 1 Holmes, 133.

7. Evidence of want of novelty cannot be introduced in the general issue without thirty days' notice.

Blanchard v. Putnam, U. S. S. C. By *Clifford, J.*, 29 Nov., 1869, 8 Wall., 420, *.

8. Notice of defence of want of novelty should be set up in the answer with sufficient particularity to enable the plaintiff to know what he has to meet.

Brown v. Hall, *Blatchford, J.*, 10 Ap., 1869, 6 Blatch., 401.

9. Evidence to sustain a want of novelty must be strong and conclusive to sustain a judgment setting aside the patent.

Whitney v. Mowry, U. S. S. C. By *Strong, J.*, 22 Ap., 1872, 2 Bond, 45; 14 Wall., 434, *.

10. The presumption of novelty is in favor of a patent, and is strengthened by running a long time without successful challenge.

Proctor v. Brill, *Butler, J.*, 15 Oct., 1880, 4 F. R., 415.

11. Omission followed by reorganization may constitute patentable novelty, but mere omission does not.

McRoy, x. p., *Fisher, Com.*, 4 Sep., 1869, C. D. 58.

12. Patentee may not, for some special use not involving invention, virtually prolong a monopoly which at the conclusion of the original term, falls of right to the public.

Camille A. Faure, inventor and patentee of the well-known secondary battery which bears his name, sought (in an application for patent filed 25 May, 1887) to virtually prolong the monopoly of such battery for a special use (propulsion of vehicles) beyond the 17 years of the original grant made on 3 Jan., 1882. The scope of the additional patent sought for was indicated in his first claim, which was, in substance, as follows: —

The combination of a moving vehicle propelled by rotary motion imparted to a shaft or axle, a secondary battery of the "Faure Type," an electro-magnetic motor electrically connected to said battery, and a mechanical connection from a moving part of said motor to said axle, substantially as described.

The application was refused because lacking in the essence of patentable invention; each one of the four elements being conceded to be old, and, as thus associated, discharging only their old and well-known separate functions, and because the sole benefits were due — as applicant himself admits — to the excellencies and capabilities of that special form of battery of which the inventor was, through his original patent, the sole beneficiary, and of which, at the expiration of that patent, the public were the indisputable heirs; benefits from which they could not be lawfully or equitably debarred by subsequent patents seeking to monopolize uses which,

although special, are at the same time recognized by persons skilled in the art appertaining to it.

Faure, x. p., *Mitchell, Com.*, 52 O. G., 752.

NOTE. — The above decision of the Commissioner of Patents was affirmed by the Supreme Court of the District of Columbia, 7 July, 1890 (52 O. G., 754), in the following ruling: —

“Where an applicant for Letters-patent claimed to have invented ‘an improvement upon devices for propelling vehicles by electrical energy through storage-batteries carried by the vehicles moved, and not connected with any arrangement of wires outside of the carriage,’ and it appeared that one constituent of the alleged new invention was a secondary or storage battery upon which applicant had received letters-patent prior to the filing of the present application, and it further appeared that the mechanical arrangements for applying the power were old, and that the result, viz., the movement of a vehicle by electrical storage-batteries [carried upon it] was old: *Held*, that a patent for said improvement was rightly refused — for want of invention — by the Patent Office, although said patented storage-battery of applicant was superior to all others of its kind for the purpose, and rendered the device commercially practicable. *Held further*, that otherwise the monopoly granted upon applicant’s said storage-battery would be prolonged.”

Supr. Ct. of Dist. of Col. in Gen. Term, appeal by Camille A. Faure from decision of the Com’r of Patents, *Bingham, Ch. J., Hayner & James, Assoc. Justices*, 7 July, 1890, 52 O. G., 754.

13. To secure a bolting-cloth upon its frame by means of bars or wires attached to its edges, held to be anticipated by corsets made with stays or wires secured to the lined edges of the cloth.

Schoenberg, x. p., *Fisher, Com.*, 11 Ap., 1870, C. D. 36.

14. A wind-mill consisting of a wheel with cones so arranged upon the arms that on one side the bases are presented to the wind and the points on the other, is an anticipation of a water-wheel with blades which on one

side of the shaft present their broad side to the waves and their edges to the other.

Glasgow, x. p., *Fisher, Com.*, 14 Ap., 1870, C. D. 40.

15. Such a "combination" as applicant proposes *has not the remotest, shadowy ghost of novelty or invention about it.* Such combination of colors has been common ever since the day of Jacob's speckled cattle. The mere substitution of aniline colors for others is an act possessing no feature of invention, for aniline colors have become so common that they are in use in almost every family in the country.

Landenberger, x. p., *Leggett, Com.*, 10 Jan., 1871, C. D. 179.

16. A device [to take up the "sag"] which is old and well-known when applied to bridges is not novel when applied to gates and for the same purpose.

Holmes *et al.*, *Duncan, Act. Com.*, 5 July, 1871, C. D. 205.

17. To cast the handle of a screw-driver upon the tang of the blade does not possess the merit of novelty, since it is common to attach the handles of knives and other implements in the same way. It is also, common to cast such handles hollow, and a screw-driver so constructed is not new as "an article of manufacture."

Clark, x. p., *Leggett, Com.*, 6 Mar., 1873, 3 O. G., 239.

See ANTICIPATION; INVENTION.

OATH.

Form for American Inventor.

In applications for patents for inventions which have not been patented abroad, it will be deemed a sufficient compliance with Rule 46, if the American inventor

makes oath that the invention has not been patented to himself or others with his knowledge or consent, in any foreign country.

Order No. 562, *Mitchell, Com.*, 2 July, 1889.

OBITER DICTUM.

See DICTUM.

OFFICE CLASSIFICATION.

Office Classification subordinate to the Proper Issues of the Case.

While the Office classification is a factor to be considered in determining the question of division, it is not absolutely controlling. It must yield to the well-known and well-established rule that process and product or apparatus and product *may* be contained in the same application when they bear such an intimate relation to each other as to constitute practically one invention (Foster, x. p., C. D. 40 Ms., 411; Eades, x. p., C. D. 41 Ms., 13; Whitaker, x. p., C. D. 41 Ms., 396; Morningstar, x. p., C. D., 41 Ms. 399; Rood & Rood, x. p., C. D. 41 Ms., 406; Richardson, x. p., C. D. 41 Ms., 421).

Osborne, x. p., *Fisher, Act. Com.*, 24 Nov., 1890, C. D. Ms.

Compare Carter, x. p., (5), Bennett, x. p., (6), Franklin, x. p., (9), Forbes, x. p., (10), Kerr, x. p., (11), Herr, x. p., (12), Williams, x. p., (13), Williamson, x. p., (14), Gally, x. p., (15), Westphal, x. p., (16), Halteberg, x. p., (17), *et seq.*, DIVISION OF APPLICATION.

OFFICE PRACTICE.

I. New Ground of Rejection.

The proper course to be pursued by an Examiner, on discovering a new ground of rejection subsequent to an appeal to the Examiners-in-Chief, is to direct the atten-

tion to it both of the applicant and the Examiners-in-Chief. The applicant may then elect to continue the prosecution of the appeal, or to withdraw the appeal and be heard by the Primary Examiner.

Mevey x. p., *Mitchell, Com.*, 19 Ap., 1890, 56 O. G., 805.

2. Conflicting Assignments.

The statute (R. S., 4895) authorizing the Commissioner to issue a patent to an assignee of record is not mandatory, and, in case of contest between two parties each claiming to hold valid title by assignment, the Commissioner may in his discretion issue the patent to the inventor.

Spielman, x. p., *Simonds, Com.*, 23 Dec., 1891, 58 O. G., 141.

3. Two Applications by same Applicant.

Where an applicant has two applications pending in the same class of machines, the earlier of which is involved in an interference, and where it is apparent that none of the claims of the later application could be made in either of the applications in interference, and that no judgment that might be rendered in the interference proceedings could in any way affect the claims of such later application: *Held*, that the interference was no bar to the later application.

Woodward, x. p., *Frothingham, Act. Com.*, 4 Mar., 1892, 58 O. G., 1554.

See COMMISSIONER; ETC.; EXAMINER; EXAMINATION.

OFFICIAL ERRORS.

Patent re-issued to rectify Mistake of Office without Charge to Applicant.

Where an amendment was presented containing an additional claim, and the applicant was advised, on inquiry after allowance, that the case as allowed con-

tained the claim, but, by error of the Examiner, it was not entered and the patent issued without it, and the patent having been returned for correction: *Held*, that the error being such as might, under suitable circumstances, properly have been corrected by re-issue had it been due to inadvertence or accident on the part of the applicant, and it having long been the practice of the Office to grant re-issues in such cases (Cochrane, x. p., 1869, C. D. 60; Havemeyer, x. p., 1870, C. D. 6; and Rule 170), and the error having arisen through the fault of the Office; that, in accordance with the action of the Commissioner in the parallel case of Andrew Jackson, Patent No. 287,028, 23 Oct., 1883, Re-issue No. 10,440, 29 Jan., 1884, the patent should be re-issued upon the original papers and drawings without any expense to the patentee.

Thompson, x. p., *Fisher, Act. Com.*, 16 Aug., 1890, C. D. Ms.

Compare Cunningham, x. p., 20 Aug., 1890, (1) ERROR OF JUDGMENT.

OFFICIAL INFORMATION.

A petition from the action of the Examiner which amounted, in substance, to a refusal to inform the applicant of the subject-matter of the issue in a proposed interference: *Denied*.

Wheeden, x. p., *Frothingham, Act. Com.*, 18 June, 1892, 60 O. G., 1191.

See (109) and (194) INTERFERENCES.

OFFICIAL SUGGESTIONS.

Are proper, but are not binding on Applicant.

It is not improper for the Examiner to call the applicant's attention to such portions of the specification and claims as, in his opinion, would be improved by amendment, but, having called the applicant's attention to

such matters, he has performed his whole duty in the premises, providing no law or rule be violated by permitting the specification and claims to remain as they were framed by the applicant.

Wharton, x. p., *Frothingham, Act. Com.*, 18 June, 1892, C. D. Ms.

OMISSION.

1. Omission followed by re-organization may constitute invention, but mere omission cannot.

McRoy, x. p., *Fisher, Com.*, 4 Sep., 1869, C. D. 58.

2. The omission of one step of an old process with an improved result constitutes a new process.

Lawther v. Hamilton, U. S. S. C. By *Bradley, J.*, 9 Jan., 1888, 42 O. G., 487, *.

3. A construction of a machine so that a less number of parts will perform all the functions of the greater, may be invention of a high order; but the omission of a part with a corresponding omission in function, the retained parts doing just what they did before in the combination, cannot be other than a mere matter of judgment, depending merely upon whether it is desirable to have the machine do all or less than it did before.

McClain v. Ortmyer, *Blodgett, J.*, 9 Jan., 1888, 42 O. G., 724.

See REARRANGEMENT; REORGANIZATION.

OPERATIVENESS.

1. Examiner is the proper judge of operativeness.

Upon the contention that an application cannot be rejected on the ground of inoperativeness unless the Examiner fully understands its subject-matter: *Held*, that the Examiner must be considered to have acted upon such matter as he did understand it. Until or in

default of a description in the specification of a workable device in terms intelligible to the Examiner, his rejection is proper, and should be adhered to until reversed on appeal.

Burkhart, x. p., *Fisher, Act. Com.*, 25 Aug., 1890, C. D. Ms.

Compare Rogers, x. p., *Mitchell, Com.*, 16 Nov., 1889, (8)

EXAMINATION.

NOTE. — The above ruling is obviously grounded in sound reason and the necessities of the case. A patent is a grant, by the sovereign power, of right or possession in something to the exclusion of everybody else. Everybody else has, therefore, a right to know explicitly the exact metes and bounds of that from which he is excluded. The doctrine is, moreover, clearly deducible from the law, thus: Sec. 4886 R. S. authorizes grant of a patent for “any new and USEFUL art, machine, manufacture, or composition of matter.” Sec. 4888 R. S. requires that the inventor shall file such a description as shall enable an expert to “*construct and use*” the device; and Sec. 4893 R. S. empowers the Commissioner to “cause an examination to be made” of the thus described invention, and to judge whether it is “*sufficiently useful and important*” to justify the grant of a patent.

2. Burden of Proof of Operativeness on the Applicant.

Whether or not a device is operative is a matter of judgment upon the case as presented, and, instead of the burden of proof being upon the Office to show inoperativeness, it is the duty of the applicant, if challenged by the Office, to furnish proof of operativeness, either by a practical demonstration or otherwise.

Ib.

ORDER OF COURT.

See DECREE OF COURT.

ORDER OF ISSUE.

1. In the case of an application for patent for a specific improvement on an invention broadly covered by a separate application (whether by the same or a different applicant), it has been ruled (Upton, x. p.), that the spirit of the law and public policy are opposed to the issue of a patent for the specific improvement in advance of the patent which dominates it. This ruling is in language as follows:—

Neither the spirit of the law nor public policy sanctions the granting of patents with specific claims while applications with generic claims are still pending, the objection being that (whether the application with the generic claims belongs to the same party who has a specific claim under the genus, or is an application of a different party) a patent covering by a generic claim, if a subsequent patent, improperly extends the monopoly.

Upton, x. p., *Butterworth, Com.*, 21 Mar., 1884, 27 O. G., 99.

2. Ordinarily a specific patent precludes a subsequent generic patent to same inventor.

To grant a patent on an application claiming an invention broadly or generically after a patent has been granted to the same inventor for the same invention embodied in the same structure but more restrictedly stated, would be, in effect, to grant a reissue of the previous patent and, at the same time, to extend its term.

Edison, x. p., *Mitchell, Com.*, 6 Jan., 1891, 54 O. G., 263.

Compare (1, 2, 3) TWO PATENTS TO SAME INVENTOR, also (1) DEDICATION, and accompanying notes.

3. Where a subsequent patent with a claim which holds a generic relation to the subject-matter of the earlier patent is sought by the same applicant, an addi-

tional objection arises from the fact that the omission to claim a certain invention in an issued patent will ordinarily be held to imply a dedication of that invention to the public, who may thereby be induced to embark in undertakings predicated on such assumption, and to whom the subsequent issue of the patent with a broad claim will operate as a surprise (*Edward Miller & Co. v. The Bridgeport Brass Co.*, 21 O. G., 201). This particular objection, however, is overcome if a clause was incorporated in the earlier patent which warned the public of applicant's purpose to embody such a generic claim in a later patent (*Holmes Elec. Prot. Co. v. Met. Burglar Alarm Co.*, *Coxe, J.*, 33 F. R., 254). Of course in cases such as *Upton*, x. p., where the party filing the broad claim was not the patentee of the specific claim, no presumption of dedication arises and the objection last named disappears.

Ib.

NOTE. — Equitable considerations, however, made manifest in the adjudication of special cases since that of *Upton* (*supra*), have necessitated important qualifications of the general rule there laid down, thus: —

In a case where the application for the patent for the primary invention was detained in the Office by circumstances beyond control of the inventor, — such, for example, as an interference proceeding, — and he had, in a later or simultaneous application for a specific embodiment of said invention which had passed to patent, given public notice of such contemporaneous foundation application, it would do violence to the spirit and purpose of the patent law that he should suffer for conditions for which he was in no wise responsible. As was said by *Com. Mitchell* in *Edison*, x. p., 27 Nov., 1889, 49 O. G., 1693: If the difficulty is not inherent in the patent system, then it must be due to some defect in the administration of that system. The *inventor*, certainly, should not suffer by reason either of a defective system, or a defective administration of a satisfactory system.

4. The complainant, Chas. F. Brush, has two patents for as many specific embodiments of the invention, for which the patent sued on (and whose generic claim dominates said embodiments) was issued to him *four years later*. The later, although broader, patent was sustained, in view of the facts: (a) The application for the generic patent antedated by about two years those for the specific embodiments. (b) It was detained in the office by circumstances (interference procedures) *beyond applicant's control*. (c) *Public notices of those facts were incorporated in the specifications of the specific patents*. In summing up for this case, the Court said: —

It is true that (in these specific patents) the broad invention was described, but it is equally true that it was not claimed. It was hardly possible for the patentee to describe the subsidiary invention without disclosing his main invention. Having thus disclosed it, had he permitted the subordinate patents to issue without warning or reservation, and, after the broad invention became public property, had filed an application for what he had thus relinquished to others, it is probable that he would have been informed, either in the Patent Office or in the courts, that his application came too late. But that is not the case. Before his applications for the subordinate inventions he had applied for the superior one. In the former he expressly informed the public that they were but divisions of the latter. He could do no more. The delay in the Patent Office cannot be charged to him. Even had he been responsible for issue of the divisional patents before the principal patent, — and he was not, — the fact of such prior issue in no way misled the public. They never for a moment acquired the right to use the broad invention. An infringer with the statement on the face of patent No. 260,653 before him, would scarcely have the hardihood to assert, that he supposed the broad invention was

released. No court would listen to such a plea. The claims of that patent did not protect Mr. Brush in the use of the broad invention. A person who did not use an etagére-shaped plate could, if no other patent prevented, use the broad invention with perfect impunity. The patent No. 337,299 was intended to prevent such use. The court has not been able to discover an authority holding a broad patent invalid under such circumstances.

The Brush Elec. Co. v. The Elec. Ac. Co., *Coxe, J.*, 23 July, 1891, 56 O. G., 1334.

5. An important exception to the general rule laid down in Upton, x. p. (27 O. G., 99) is seen where, on sufficient showing (Rule 75), a patent is allowed (without declaration of interference) to issue with a generic claim which dominates a generically allied but specifically different device (which is only specifically claimed) in an already issued patent to another inventor.

Reed v. Landman, *Mitchell, Com.*, 26 May, 1891, C. D. Ms.
Compare Edison v. Heysinger, (66) INTERFERENCES.

ORDINARY RESOURCES OF THE ART.

I. Not Patentable.

Any one who can practise the art of marbleizing is entitled to apply it to any old and well-known article, unless there are special difficulties in applying the marbled coating which calls for the exercise of inventive skill or ingenuity.

NOTE. — The Commissioner gave the following as some of the more recent decisions applying to cases in which the device, although new in a commercial sense, contains no novelty in a patentable sense: Stephenson v. Brooklyn R. R. Co., 114 U. S.,

149, * ; Yale Lock Co. v. Greenleaf, 117 U. S., 554, * ; Gardner v. Herz, 118 U. S. 180, * ; Pomace Holder Co. v. Ferguson, 119 U. S. 335, * ; Hendy v. Miners' Iron Works, 127 U. S., 370, * ; Holland v. Shipley, 127 U. S., 396, * ; Pattee Plow Co. v. Kingman, 129 U. S., 294, * ; Brown v. Dist. of Col., 130 U. S., 87, * ; Day v. Fairhaven Ry. Co., 132 U. S. 161, * ; Marchand v. Emken, 132 U. S., 195, * ; Royer v. Roth, 132 U. S., 201, * ; Hill v. Wooster, 132 U. S., 693.

Torrance, x. p., *Mitchell, Com.*, 2 Ap., 1891, C. D. Ms.

Compare COMMON KNOWLEDGE, (28) *et seq.*, INVENTION, (19) PROCESS; and (18) and (21), PUBLIC RIGHTS AND OBLIGATIONS.

2. Substitution of New Material.

Where the patentee of a grinding-wheel filed an application in which he claimed, in effect, the union of a grinding-wheel of the specific form shown in his patent with a specific composition set forth therein, and which consisted of the substitution of a soft for a hard "binder:" *Held*, that although by such substitution in this specific form of wheel he had reached an important result, yet, in view of the fact that both compositions were old in grinding-wheels of the common form, the substitution of material must be held to be an obvious one for the purpose intended, and consequently not patentable.

Johnston, x. p., *Frothingham, Act. Com.*, 31 Aug., 1891, C. D. Ms.

Compare Latimer, x. p., (1), Hotchkiss v. Greenwood, (3), Foss, x. p., (4), NEW MATERIAL.

NOTE. — On a re-hearing of this case (see Johnston, x. p., (3) PATENTABILITY), the above decision was sustained as to the claim in which the water-supply was not brought distinctly

into the combination, but was reversed as to the other, and a patent allowed.

Of numerous decisions to same purport, see *Forg*, (1) *et seq*, MECHANICAL SKILL; and *Voelker v. Gray v. Edison v. Bell*, (31) *et seq.*, INVENTION.

ORGANIZATION OF COURTS OF APPEAL.

By Act of Congress of March 3, 1891, nine Federal Courts of Appeals, holding annual sessions, were created, — one court being assigned to each judicial circuit, — each court being composed of the (Chief or the Associate) Justice assigned to the respective circuit and two other judges, making three in all, of which any two constitute a quorum (Sec. 3). The said courts are invested with *final appellate jurisdiction in all cases arising under the patent laws*, appealed from the District or Circuit Courts of their respective circuits (Sec. 6).

An Act to establish Circuit Courts of Appeals and to define and regulate, in certain cases, the jurisdiction of the courts of the United States, and for other purposes. Approved March 3, 1891. PUB. Doc., 118; 61 O. G., 1019.

THE PATENT.

To whom Issuable.

1. A patent is an instrument whereby some exclusive right is granted by the sovereign power to the person named therein, and, in the United States, is the creature of statute. A patent for an invention then is a GRANT, and must have a grantor and a grantee. It must grant the franchise or monopoly to a person [or party] named and who is capable of taking. The Statutes of the United States recognize only three classes of persons to whom a patent for an invention can issue, viz. : —

(1) To the inventor himself (4886 R. S.).

(2) To an assignee (either *in toto* or in joint interest with the inventor) on an assignment made and recorded before the issue of the patent (4895 R. S.).

(3) In event of decease of the inventor before issue, to the Administrator [or Executor] in trust for the heirs (4896 R. S.).

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

2. A U. S. patent for an invention is a grant, presumably to the first and true inventor or inventors (whether citizen or alien), his, or their heirs or assigns, for the term of 17 years, of the exclusive right to make, use, and vend a [specific] invention or discovery throughout the United States and the Territories thereof, and is not a grant of a monopoly in the prohibited sense, — that is, one which restrains others from the exercise of a right or liberty which they had before the grant was made. It is a contract between the public and the patentee, to be supported on the ground of mutual considerations, and, being essentially a *bargain*, is to be construed like other contracts to which there are two parties, each having rights and interests involved in its stipulations. In this respect, the public, as party of the first part, through the medium of the Government, makes the grant above mentioned, while the inventor, as party of the second part, divulges his secret and causes benefit to flow to the public in two forms: first, by immediate practice of the invention under the patent, and, secondly, by the practice of (or opportunity to practise) the invention when free to the public on the expiration of the patent. To guard against the inventor's concealment of the process by which the invention is practised, and to guard against its loss, he is required to deposit in the Patent Office a written description of

the invention sufficiently clear and explicit to enable others to practise the same therefrom.

C. A. Yale Cigar M'fg Co. v. C. A. Yale, *Dryenforth, Act. Com.*, 19 July, 1884, 30 O. G., 1183.

3. The Commissioner of Patents has charge and direction of the issue of two kinds of patents for invention, — *mechanical patents* and *design patents*. A mechanical patent covers a concrete invention, one in the nature of a manufacturing art, a machine, an article of manufacture, or a composition of matter, and is issued for the term of 17 years. A design patent covers an abstract invention, one in the nature of a configuration of a manufacture [or of an artistically designed figure for attachment to an article of manufacture]. Design patents are issued for 3½, 7, or 14 years.

Ib.

NOTE. — In this treatise, the word “patent” (or “U. S. patent”) standing alone, means a mechanical patent.

4. Patents for inventions are different in origin and principle from patents for land.

A patent for land has, in the legislation of Congress, a two-fold operation. It conveys a title which had previously remained in the United States, or, when issued upon the recognition and confirmation of a claim to a previously existing title, it is evidence of record to the existence of that title, or of equities respecting the land requiring recognition by a quitclaim from the Government. It always imports that the Government conveys or has previously conveyed interests in the lands, — something which it at the time owns or which its predecessor once owned (*Langdeau v. Hanes*, 21 Wall., 531). A patent for an invention rests upon a totally different basis. It conveys nothing which the Government owns

or which it or its predecessors ever owned. The invention is the product of the inventor's brain, and, if made known, would be subject to the use of any one if that use were not secured to him. Such security is afforded to him by the issue of the patent, which, legalizing the inventor's exclusive right, may be said to create a property interest in that particular invention. Until the issue of a patent for it, there is no property-right in it; that is to say, there is no such right as the inventor can enforce. Until then, there is no *exclusive* power over its use, which is one of the elements of property in anything capable of ownership.

Marsh *v.* Nichols, U. S. S. C. By *Field, J.*, 10 Dec., 1888, 46 O. G., 239, *.

5. A United States patent is granted — for 17 years — to the first inventor of a new and useful art, machine, manufacture, or composition of matter, or an improvement thereof, not heretofore known in the United States nor published nor patented elsewhere.

R. S., 4886.

6. A U. S. Patent the creation of Statute.

An inventor has no right to a patent for his invention at common law. He has no natural exclusive right to his invention. To hold that he has is to hold to the impossible proposition that a dozen different men may each have an exclusive right to the same thing. The records of this Office show that the same thing is invented over and over again by different persons. The inventor's right is founded wholly upon statute. It is a right founded wholly upon conditions.

Nickola, x. p., *Simonds, Com.*, 27 Nov., 1891, 57 O. G., 1475.

Compare Robinson on the Law of Patents for Useful Inventions. pp. 59 *et seq.*

7. 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 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. This is its language: "The Congress shall have power 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."

President Ulysses S. Grant, Ex. Doc. 27.

8. 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-existent, inherent right of property in such invention or composition, and authorizes Congress to secure to the inventor or author the enjoyment of that right; but the right exists before the Constitution and above the Constitution, and it is, as a natural right, more than that which a man can assert in almost any other kinds of property.

Daniel Webster, Argument in case of Goodyear v. Day.

9. It is evident that a patent issued under the system inaugurated by the Statute of 4 July, 1836 (that is to say, after an inquisition or examination made by skilful and sworn public officers appointed for the purpose of protecting the public against false claims or useless inventions), is entitled to much more respect, as evidence of novelty and utility, than those formerly issued without any such investigation. Consequently, such a patent may be, and generally is, received as *prima facie* evidence of the truth of the facts asserted in it. And in cases where the evidence is nicely balanced, it may have weight with a jury in making up their decision as to the plaintiff's right.

If so it is not easy to perceive why a defendant who uses a machine protected by a separate patent should not have the benefit of a like presumption in his favor arising from a like investigation of the value of *his* invention. It goes at least to show that he has acted in good faith, and is not a *wanton* infringer. If complainant's patent, in a doubtful case, may have some weight in turning the scale in his favor, it is but just that the defendant should have the same benefit from his, *valeat quantum valeat*. The parties should contend on an equal field and be allowed to use the same weapons.

Corning *v.* Burden, U. S. S. C. By *Wayne, J.*, Dec., 1853, 15 How., 252, *.

10. *The date of the application*, and not the date of the patent, controls in determining the legal effect to be given to two patents issued at different dates to the same inventor, and the order in which they are to be considered.

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

11. A patent to a dead man is void.

A [so-called] "patent" issued in the name of an applicant who died while his application was pending and before issue, is void for want of a grantee.

In the case of the decedent James Boyle there was no grantee. The person named as grantee or patentee was dead at the time of the grant, and therefore there was no person to take the thing granted, and hence the grant never took effect.

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

Compare Stevens, x. p., (19) ASSIGNMENT; and Davis, x. p., (7) ATTORNEY.

See GOVERNMENT USE; INHERENT RIGHT; LIMITATION OF TERM; PUBLIC RIGHTS AND OBLIGATIONS.

PATENTABILITY.

1. Office action must conform to decisions of the courts.

In determining what does or what does not amount to a patentable invention in cases where the references do not disclose every feature of the alleged invention sought to be patented, recourse to the decisions of the courts, wherein such questions are considered, is necessary.

Jones, x. p., *Frothingham, Act. Com.*, 21 Dec., 1891, C. D. Ms.

2. An adaptation of an Old Device to a New Purpose which required inventive skill — patentable.

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

Ansonia Co. v. Supply Co. U. S. S. C. By *Brown, J.*, 14 Mar., 1892, 58 O. G., 1692, *.

3. Old Elements.—Combination.

Upon a rehearing of Johnston, x. p. (Johnston, x. p., (2) ORDINARY RESOURCES OF THE ART): *Held*, that the union of a grinding-wheel which disintegrates under a less heat than will draw the temper of steel, and of a water-supply, originated with the applicant, and that, by it, a new and useful result was attained; therefore that the union was patentable, reversing the former decision as to one of the claims, but sustaining it as to the other, in which the water-supply was not brought distinctly into the combination.

Johnston, x. p. (Re-hearing), *Simonds, Com.*, 18 Nov., 1891, C. D. Ms.

4. Useful Novelty.

A conceded difference of construction between the device claimed and the references cited, together with a clear advantage as a result of it, constitutes patentable novelty.

Scriven, x. p., *Simonds, Com.*, 9 Sep., 1891, 57 O. G., 1128.
Compare Schadi, x. p., (12) *infra*.

5. Public Adoption as a Test of Useful Novelty.

It appearing that the first general use of the device in question came from its publication by the patentee, and the court being in doubt whether the exact device had ever been hit upon by a prior inventor: *Held*, that the doubt should be resolved in favor of the patentee.

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, *.

6. It is true that the affixing barbs to a fence-wire does not apparently give a wide scope to the ingenuity of the inventor; but, from the crude device of Hunt to the perfected wire of Glidden, each patent has marked a step of progress in the art. The inventions of Hunt and Smith appear to have been scarcely more than tentative, and never to have gone into general use. Between the Kelly fence and the Glidden fence the difference seems not a radical one, but, slight as it may seem to be, it was apparently THIS which made the barbed wire fence a practical and commercial success. The sales of the Kelly patent appear never to have exceeded 3000 tons per annum, while plaintiff's manufacture and sales of the Glidden device (substituting a sharp barb for a blunt one) rose rapidly from 50 tons in 1874 to 44,000 tons in 1886, while those of its licensees in 1887 reached the enormous amount of 173,000 tons.

Indeed, one who has travelled on the Western plains of this continent cannot have failed to notice the very large amount of territory inclosed by these fences which otherwise, owing to the great scarcity of wood, would have been left unprotected.

Under such circumstances, courts have not been reluctant to sustain a patent to the man who has turned a failure into a success. In the law of patents it is the last step that wins. It may seem strange that, considering the important results obtained by Kelly in his patent, it did not occur to him to substitute a coiled wire in place of a diamond-shaped prong, but evidently it did not; and the man to whom it did ought not to be denied the quality of inventor. There are many instances in the reported decisions of this court where a monopoly has been sustained in favor of the last of a series of inventors, all of whom were groping to attain a certain result which only the last one of the number seemed able to grasp.

Ib. *

Compare *McClain v. Ortmayer*, (7) *infra*; * *Spielman*, x. p., COMMERCIAL SUCCESS.

7. While this court has held, in a number of cases, that, in a doubtful case, the fact that a patented article had gone into general use is evidence of its utility, it is not *conclusive* even of that, — much less of its patentable novelty. That the extent to which a patented device has gone into use is an unsafe criterion even of its actual utility, is evident from the well-known fact that the general introduction of an article is as often effected by extensive and judicious advertising, activity in putting the goods upon the market, and large commissions to dealers, as by the intrinsic merit of the article itself.

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

8. Slight change satisfying a long felt want,— patentable.

Whenever, in an art, machine, manufacture, or composition of matter, a change, however minute, is made which is not obvious and which results in marked advantages, a patentable invention has been produced; and when such a change had remained unmade for a considerable time, in spite of inducements to make it by reason of its value, that is evidence approaching the conclusive that the change was not obvious.

Champney, x. p., *Simonds, Com.*, 13 June, 1892, 60 O. G., 1051.

Compare *Smith v. Goodyear Dent. Vulc. Co.*, (1) *; *Consol. Valve Co. v. Crosby*, (2); * THE DECISIVE STEP; *Edison Elec. Co. v. The U. S. Elec. L't'g Co.*, (1) SUCCESS AS A TEST; also *Loom Co. v. Higgins*, (9) *; *infra*.

9. Patentability of a device that satisfied a long-felt want and answered all reasonable requirements.

In determining what constitutes invention and what is a new and useful result, a new function or a new sphere of action, the court will give weight to facts showing:—

(1) That the improvement, though desired for years, was not secured until brought out by the patentee.

(2) That the product of the new machine or process displaced, wholly or in a great degree, prior products.

(3) That while, from lack of cheapness or of adaptation, the prior products had been unsuitable, the new product answered all reasonable expectations.

Loom Co. v. Higgins, 105 U. S., 580, *. See, also, *McClain v. Otmayer*, 141 U. S., 419, *; and "The Barbed Wire Case," 143 U. S., 275, *; *Watson v. Stevens et al.*, U. S. C. C. of Appeals, 1st Circuit (before Gray, Colt, and Putnam, JJ.). By *Putnam, J.*, 6 Sep., 1892, 60 O. G., 1884, *.

10. Prior Art.

Strong doubt existing whether a certain feature of construction reached beyond mere mechanical skill, but lack of analogy appearing in the prior art, applicant was given the benefit of the doubt and application allowed.

Warner, x. p., *Simonds, Com.*, 28 Dec., 1891, C. D. Ms.

11. In deciding the question of patentability it is necessary to determine what differences, if any, there are of structure, of mode of operation, or of result, between the alleged invention for which a patent is sought and the state of the art as disclosed by the references.

Jones, x. p., *Frothingham, Act. Com.*, 21 Dec., 1891, C. D. Ms.

12. Reference must be positive, — not inferential merely.

Where the improvement was a very simple one, consisting in locating an ordinary circular enlargement of a lengthwise slot, at the foot of the slot instead of at the top, and the reference was a patent in which it was stated that "a circular enlargement is sometimes made in the slot *B*, near one end or the other end, but this is not claimed here as original:" *Held*, that the word "near" meant near, and nothing else; that it did not mean at the end of the slot; and that the patented device would not work if the circular enlargement were made at the end of the slot, while, on the other hand, applicant's improvement was not practicable unless the enlargement was at the end.

Schade, x. p., *Simonds, Com.*, 18 Mar., 1892, C. D. Ms.

Compare Scriven, x. p., (4) *supra*.

13. Difference from known devices must be one of kind, not of degree merely.

Where the patent sued upon describes a method which differs only in degree, and not in kind, from a previously employed method, and where the utmost that can be said of the patented process is that it produces a somewhat more perfect article than was previously produced: *Held*, that the patented method involves no novelty within the meaning of the patent law.

Ansonia Co. v. Supply Co., U. S. S. C. By *Brown, J.*, 14 Mar., 1892, 58 O. G., 1692, *.

14. New use for analogous purpose not patentable.

The application of an old process or machine to a new and analogous purpose does not involve invention, even if the new result had not been contemplated.

Ib.

15. Where several inventors are striving for the same end, and all of them fall a little short of its attainment, the existence of that state of facts is practically conclusive evidence that he who attains the whole measure of success does so by doing something that was not obvious and that involved patentable novelty.

Shannon, x. p., *Simonds, Com.*, 21 Oct., 1891, 59 O. G., 297.

16. Benefit of the Doubt.

Where clear differences of construction between the device claimed and the references cited against it are such that a doubt is raised as to whether they constitute patentable invention, the applicant should have the benefit of it.

Fanshawe, x. p., *Simonds, Com.*, 10 Sep., 1891, 57 O. G., 1127.

17. Where invention is in doubt, the grant of a United States patent constitutes a presumption in favor of the patentable novelty of the device.

Where the question of invention is closely balanced, the presumption in favor of the patentee, arising from his recognition as an inventor by the United States Patent Office, will incline the court to sustain his patent.

Watson v. Stevens et al., U. S. C. C. of Appeals, 1st Circuit (before Justices Gray, Colt, and Putnam). By *Putnam, J.*, 6 Sep., 1892, 60 O. G., 1884, *.

18. Reorganization and Simplification.

In one possible view of the claim it appeared as a mere aggregation of elements shown in the references, but regarded from another point of view there could be seen to be a useful and valuable reorganization and simplification which comprised a feature (rocking arm) that performed a double function: *Held*, that, although one might doubt whether applicant's improvement involved patentable invention, yet, on the other hand, the organization and simplicity are actually apparent, the double function of the rocking arm is clearly apparent, and the doubt should be resolved in favor of the applicant.

Prince, Jr., x. p., *Simonds, Com.*, 7 July, 1892, C. D. Ms.

See, of like purport, Ennis, x. p., PATENTABLE NOVELTY.

19. When Invention doubtful, — Protracted Nonuser, fatal.

The entire field of invention (nursery chairs) shown by the exhibits in the case, seems a dreary one nowhere enlivened by a single exhibition of the genius of invention, or even of "the happy thought" which, under the patent laws, sometimes answers in its place. . . . It